

19-1365

**United States Court of Appeals
For the Federal Circuit**

MASS ENGINEERED DESIGN, INC.

Plaintiff-Appellee,

v.

PLANAR SYSTEMS, INC.

Defendant-Appellant.

*Appeal from the United States District Court for the District of Oregon
No. 3:16-cv-01510-SI, Judge Michael H. Simon*

**APPELLANT PLANAR SYSTEMS, INC.'S
COMBINED PETITION FOR PANEL REHEARING AND REHEARING EN BANC**

David W. Long
ESSENTIAL PATENT LLC
PO Box 710868
Oak Hill, VA 20171

Jenny W. Chen
CHEN IP LAW GROUP
7F, No. 1, Alley 30, Lane 358, Rueiguang
Road
Taipei, Taiwan 114
+886-2-7721-8855

Andrew T. Oliver
AMIN, TUROCY & WATSON LLP
160 West Santa Clara Street
Suite 975
San Jose, CA 95113
(650) 618-6477

April 22, 2021

*Attorneys for Appellant
Planar Systems, Inc.*

Certificate of Interest

Counsel for Appellant Planar Systems, Inc. certifies the following:

1. Represented Entities. The full name of every Party represented by me. Fed. Cir. R. 47.4(a)(1).

- Planar Systems, Inc.

2. Real Party in Interest. The name of Real Party in interest (Please only include any real party in interest NOT identified in Question 3) represented by me. Fed. Cir. R. 47.4(a)(2).

- Planar Systems, Inc.
- HighGrade Tech. Co., Ltd.

3. Parent Corporations/Stockholders. Parent corporations and publicly held companies that own 10% or more of stock in the party. Fed. Cir. R. 47.4(a)(3).

- Leyard Optoelectronic Co., Ltd.
- Leyard (Hong Kong) Co., Ltd.
- Leyard American Corp.

4. Legal Representatives. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court (and who have not or will not enter an appearance in this case). Fed. Cir. R. 47.4(a)(4)

- STOLL STOLL BERNE LOKTING & SCHLACHTER, PC: Jacob S. Gill, Nadia Dahab, Timothy DeJong
- POTTER MINTON P.C.: Earl Glenn Thames Jr.
- TROP, PRUNER & HU, P.C.: Timothy Trop, Diana Sangalli
- MOUNT, SPELMAN & FINGERMAN, PC: Daniel Mount, Kathryn Spelman, Daniel Fingerman, Jing Cherng, William Stewart

5. Related Cases. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. *See* Fed. Cir. R. 47.4(a)(5) and 47.5(b).

- None.

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in

criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

- None.

Dated: April 22, 2020

/s/ David W. Long
David W. Long
Attorney for Appellant
Planar Systems, Inc.

Table of Contents

Table of Authorities	iv
Federal Circuit Rule 35(b)(2) Statement of Counsel	vi
I. Introduction.....	1
II. Points of Law and Fact Overlooked By The Court	6
III. Argument	7
A. The Supreme Court’s <i>Halliburton</i> Decision and Patent Statute Preclude Extending Means-Plus-Function Limitations To Cover All Structures That Perform The Claimed Function	8
B. Particularized Testimony And Linking Argument Is Required To Establish §112(f) Structural Equivalents Because The Standard Is Simple To Articulate, But Conceptually Difficult To Apply.....	10
IV. Conclusion	15
Addendum	
Certificate of Compliance	
Certificate of Service	

Table of Authorities

Cases

<i>Akzo Nobel Coatings, Inc. v. Dow Chemical Co.</i> , 811 F.3d 1334 (Fed. Cir. 2016)	12
<i>American Calcar, Inc. v. American Honda Motor Co., Inc.</i> , 651 F.3d 1318 (Fed. Cir. 2011)	12
<i>Amgen Inc. v. F. Hoffman-La Roche Ltd.</i> , 580 F.3d 1340 (Fed. Cir. 2009)	11
<i>Applied Medical Resources Corp. v. U.S. Surgical Corp.</i> , 448 F.3d 1324 (Fed. Cir. 2006)	12, 13
<i>AquaTex Industries, Inc. v. Techniche Solutions</i> , 479 F.3d 1320 (Fed. Cir. 2007)	12
<i>Cephalon, Inc. v. Watson Pharmaceuticals, Inc.</i> , 707 F.3d 1330 (Fed. Cir. 2013)	12
<i>Dawn Equipment Co. v. Kentucky Farms, Inc.</i> , 140 F.3d 1009 (Fed. Cir. 1998)	12
<i>Gemalto S.A. v. HTC Corp.</i> , 754 F.3d 1364 (Fed. Cir. 2014)	11, 12
<i>Halliburton Oil Well Cementing Co. v. Walker</i> , 329 U.S. 1 (1946)	passim
<i>Hewlett-Packard Co. v. Mustek Systems, Inc.</i> , 340 F.3d 1314 (Fed. Cir. 2003)	12
<i>Intellectual Science and Technology, Inc. v. Sony Electronics, Inc.</i> , 589 F.3d 1179 (Fed. Cir. 2009)	13
<i>Laitram Corp. v. Rexnord, Inc.</i> , 939 F.2d 1533 (Fed. Cir. 1991)	7
<i>Lear Siegler, Inc. v. Sealy Mattress Co.</i> , 873 F.3d 1422 (Fed. Cir. 1987)	11
<i>Motionless Keyboard Co. v. Microsoft Corp.</i> , 489 F.3d 1376 (Fed. Cir. 2007)	12
<i>Odetics, Inc. v. Storage Tech. Corp.</i> , 185 F.3d 1259 (Fed. Cir. 1999)	9, 10

PC Connector Solutions LLC v. SmartDisk Corp.,
406 F.3d 1359 (Fed. Cir. 2005)12

Perkin-Elmer Corp. v. Westinghouse Elec. Corp.,
822 F.2d 1528 (Fed. Cir. 1987)11

Stumbo v. Eastman Outdoors, Inc.,
508 F.3d 1358 (Fed. Cir. 2007)12

Texas Instruments Inc. v. Cypress Semiconductor Corp.,
90 F.3d 1558 (Fed. Cir. 1996) 11, 12

Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.,
520 U.S. 17 (1997).....10

Statutes

35 U.S.C. §112(f)..... passim

Other Authorities

P.J. Federico, *Commentary On The New Patent Act* (1952)9

Rules

Federal Circuit Rule 36..... 6, 14

Federal Circuit Rule 35(b)(2) Statement of Counsel

Based on my professional judgment, I believe that the Panel decision is contrary to the following precedents of this Court and the Supreme Court:

- *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1 (1946) that precludes claim limitations on the function performed by a novel structure that will cover every way to perform the claimed function and stifle others from innovating other ways to perform the function, which decision was codified in 35 U.S.C. §112(f).
- *Texas Instruments Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558 (Fed. Cir.) that requires particularized testimony and linking argument to establish Doctrine of Equivalents infringement and whose rationale applies equally to 35 U.S.C. § 112(f) structural equivalents.

Based on my professional judgment, I believe this appeal requires an answer to the following precedent-setting question of exceptional importance:

Whether a party seeking to establish 35 U.S.C. §112(f) statutory equivalents is required to provide particularized testimony and linking argument of equivalents as is required to establish infringement under the Doctrine of Equivalents..

Dated: April 22, 2020

/s/ David W. Long
David W. Long
Attorney for Appellant
Planar Systems, Inc.

Planar Systems, Inc. (“Planar”) respectfully files this Petition seeking Panel or En Banc rehearing on an issue of first impression of whether the well-established evidentiary requirement to provide *particularized testimony and linking argument* to prove Doctrine of Equivalents infringement equally applies to proving statutory 35 U.S.C. §112(f) structural equivalents consistent with Supreme Court precedent that precludes claims covering every way to perform a claimed function.

I. Introduction

U.S. Reissue Patent No. RE36,978 (the ‘978 Patent) concerns mounting a monitor to a stand using “a novel ball-and-socket joint”¹ that allows adjusting the monitor’s angle. The ball-and-socket joint is corresponding structure for *mounting means/adjusting means* limitations subject to §112(f).

In the accused Planar products, however, a monitor is mounted using a three-hinge joint—one hinge for each axis of rotation (tilt, swivel and pivot). The image below shows these three hinge joints as follows:²

- Joint A that allows Link 2 to swivel (left/right) relative to Link 1
- Joint B that allows Link 3 to tilt (up/down) relative to Link 2
- Joint C that allows Link 4 to pivot (clockwise) relative to Link 3

¹ Blue Br. at 42.

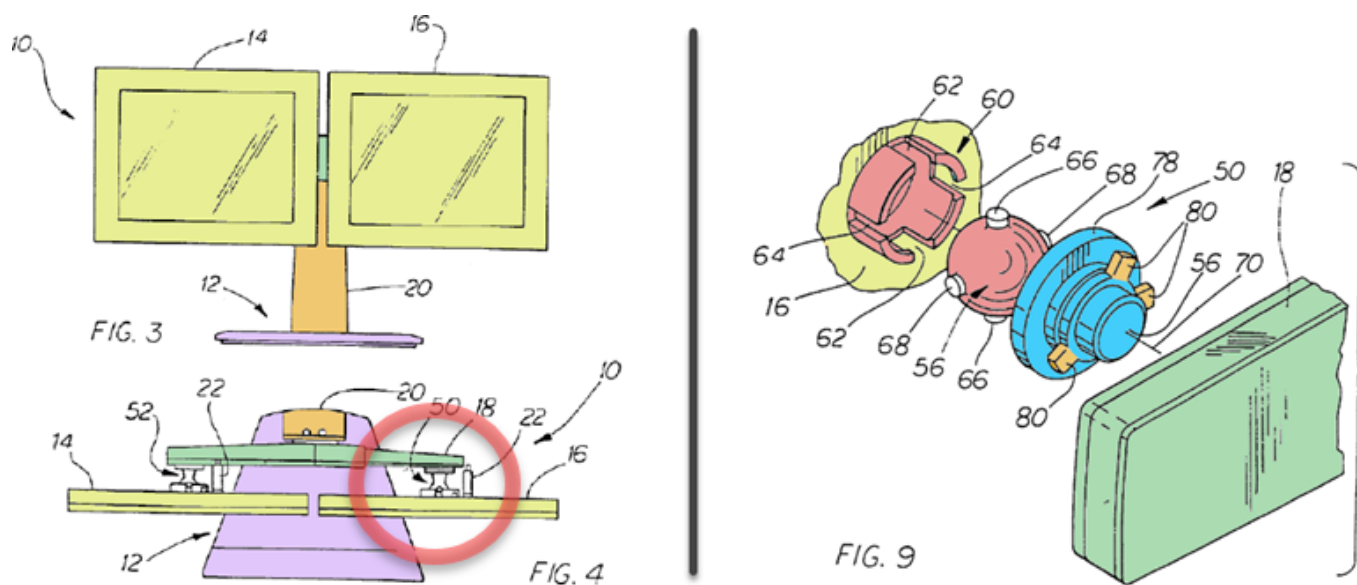
² Blue Br. at 45; Grey Br. at 9-10.

This three-hinge joint design allows independent tuning of the force required to rotate hinges about their own axis and a biasing spring between Link 2 and Link 3 of Joint B (up/down) to counteract the monitor's weight (that otherwise tilts the monitor down) without increasing the force required to move Joints A and B.³

³ Blue Br. at 46-47; Grey Br. 9-10.

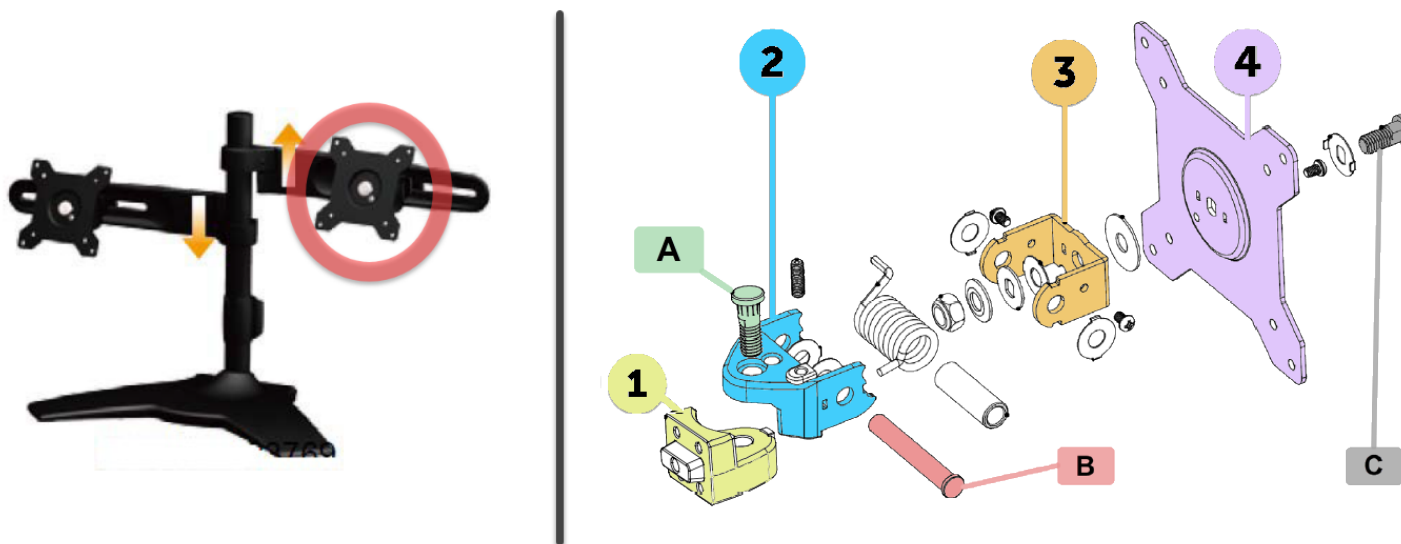
'978 Patent

Right-Side Exploded View: Ball (56) and Socket (60) Joint



Planar Product

Right-Side Exploded View: Joints A (Links 1-2), B (Links 2-3) and C (Links 3-4)



At trial, Mass proffered testimony from technical expert Dr. Akin who sought to establish §112(f) structural equivalents two ways. First, the bulk of his testimony tried to show §112(f) equivalents by arguing the two different structures

were kinematically equivalent.⁴ Second, he gave short testimony purporting to present a function-way-result (FWR) test. But he actually presented a *function-function-function* test, because he equated the *way* and *result* to the claimed *function*—*i.e.*, both *way* and *result* “allow” the rotation of the claimed *function*.⁵

Dr. Akin’s erroneous *function-function-function* analysis

function “adjusting the angular orientation of [*i.e.*, rotating] each of the displays relative to the arm assembly”

way “allow[] rotation about three axis”

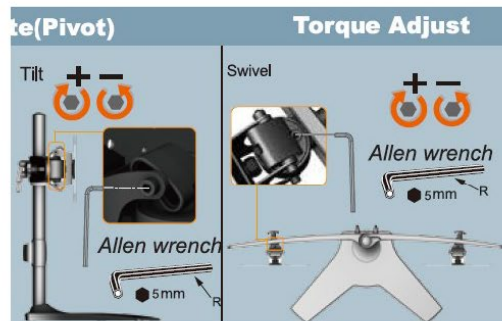
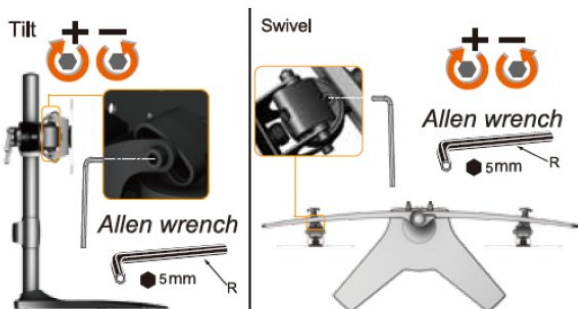
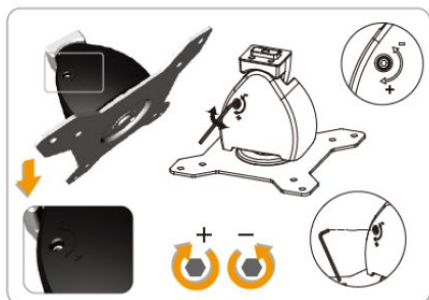
result “allow[] the displays to be rotated relative to the arm assembly”

On the FWR issue, the only other evidence was Planar’s products themselves along with instruction manuals and schematics showing operation of the three-hinge joints, including the biasing spring and independently tunable hinge joints, as shown below:⁶

⁴ Blue Br. at 49-50; Grey Br. at 12.

⁵ Blue Br. at 47-49; Grey Br. at 11-12.

⁶ Blue Br. at 47.

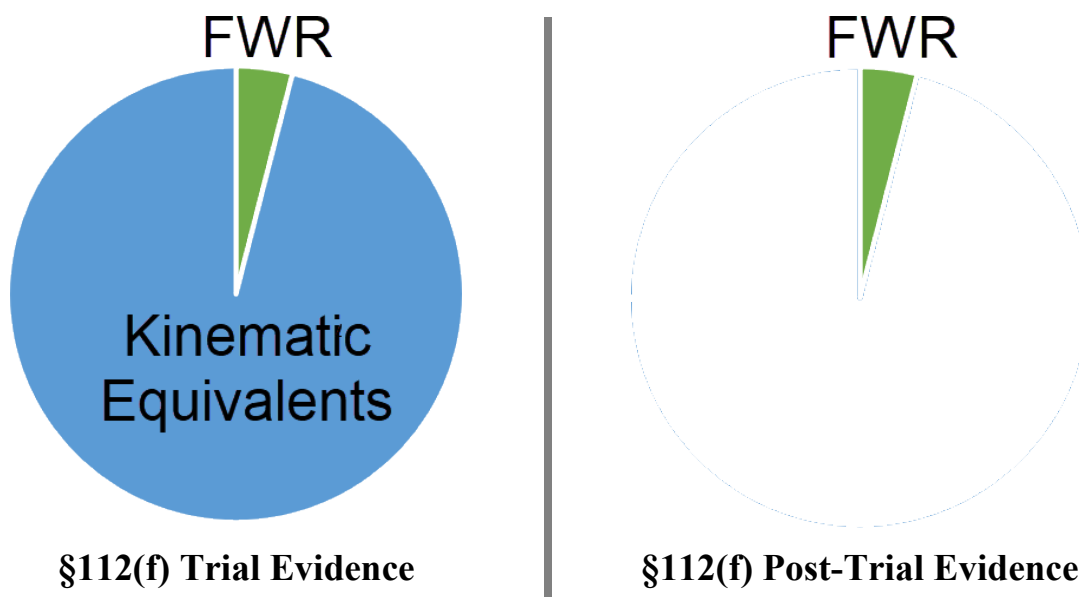


Accordingly, the only evidence before the jury on Mass’s purported function-way-result theory were (1) Dr. Akin’s *function-function-function* testimony showing nothing more than that both structures performed the claimed function (as they must do for §112(f) to apply in the first instance) and (2) Planar’s products, manuals and schematics.

The jury returned a verdict of infringement. Planar filed a new trial motion challenging the foregoing part of the verdict.⁷ The bulk of that briefing concerned Mass’s kinematic equivalents theory. During that briefing, Mass agreed that “whether an accused structure is ‘kinematically equivalent’ to a patent structure is

⁷ At the Panel hearing Mass agreed that Planar’s new trial motion preserved for appeal the *mounting means/adjusting means*. Hearing Audio at 19:49-20:30.

not the test for determining equivalents.”⁸ Accordingly, the evidence of §112(f) equivalents for pre-judgment and post-judgment motions changed drastically:



The district court denied Planar’s post-trial motions and Planar appealed.

II. Points of Law and Fact Overlooked By The Court

On April 22, 2021, the Panel issued a Rule 36 Judgment about three-and-a-half months after the Panel hearing. To enter Rule 36 judgment, the Panel must have determined (1) “an opinion would have no precedential value,” (2) “the evidence supporting the jury’s verdict is sufficient,” or (3) “a judgment or decision has been entered without an error of law.” To permit reviewability while giving deference to the Panel, Planar respectfully identifies the following points of law or

⁸ Blue Br. at 50; Red. Br. at 28; Grey Br. at 12.

fact the Panel apparently overlooked and/or misapprehended in view of the Panel hearing that focused on this particular infringement issue:

First, the Panel overlooked or misapprehended the significant precedential value of a written decision here given the issue of whether and to what extent Mass was required to present *particularized testimony and linking argument* in presenting a function-way-result test of §112(f) equivalents to ensure compliance with the Supreme Court's *Halliburton* decision that precludes limitations covering every way to perform a claimed function.⁹ There is a wealth of precedential cases applying that evidentiary standard to the Doctrine of Equivalents, but we found no precedential decision on whether to apply that evidentiary standard to §112(f) equivalents even though its rationale applies equally here, if not more so.

Second, the Panel overlooked or misapprehended that the bulk of Mass expert Dr. Akin's testimony about §112(f) equivalents concerned kinematic equivalents that Mass later disclaimed in post-trial briefing.

III. Argument

Dr. Akin's *function-function-function* testimony led to an unguided jury extending the scope of *mounting means/adjusting means* beyond the corresponding ball-and-socket structure disclosed in the '978 Patent and §112(f) equivalents thereof. The jury's decision and Panel's affirmance thereof erroneously captures

⁹ *Accord, Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1536 (Fed. Cir. 1991).

manifestly different structure because it performs the claimed function. This violates Supreme Court *Halliburton* precedent, and such violation was inevitable without particularized testimony and linking argument as this Court requires for proving infringement under the Doctrine of Equivalents.

A. The Supreme Court’s *Halliburton* Decision and Patent Statute Preclude Extending Means-Plus-Function Limitations To Cover All Structures That Perform The Claimed Function

In the early 1900s, patent owners would disclose *a single* structure that performed a particular function and then seek purely functional claim limitations directed to anything that performs that function. In its 1946 *Halliburton* decision, however, the Supreme Court ruled that functional patent limitations (in that case “means ... for tuning said receiving means”) were invalid “because they do not describe the invention but use conveniently functional language at the exact point of novelty”¹⁰ Broadly claiming a function that is unbound by any specific structure for performing that claimed function “frighten[s] ...inventive genius [that] may evolve many more devices to accomplish the same purpose”:

In this age of technological development there may be many other devices beyond our present information or indeed our imagination which will perform that function and yet fit these claims. And unless frightened from the course of experimentation by broad functional claims like these, inventive genius may evolve many more devices to

¹⁰ *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1, 8-9 (1946).

accomplish the same purpose.¹¹

The 1952 Patent Act codified *Halliburton* by statutorily allowing means-plus-function claim limitations but with a *Halliburton*-string attached: Under 35 U.S.C. §112 ¶6 (1952) (now 35 U.S.C. §112(f)) any claim limitation directed to a specific function is limited to corresponding structure in the specification that performs the claimed function and equivalents thereof.¹²

The §112(f) *Halliburton*-string has particular force here. The ‘978 Patent characterizes the structure that performs the claimed function as “a novel ball-and-socket joint.”¹³ The *Halliburton* Court was particularly concerned with “functional language at the exact point of novelty,” because the broad patent right may “frighten[.]” away others from creating “many more devices to accomplish the same purpose.”¹⁴

Accordingly, Planar respectfully asserts that the Panel appears to have overlooked or misapprehended one or both of the following:

(1) Mass’s only §112(f) structural equivalents evidence was expert testimony that both structures performed the claimed function (which they must do

¹¹ *Halliburton*, 329 U.S. at 12.

¹² See P.J. Federico, *Commentary On The New Patent Act* at 25 (1952); *Odetics, Inc. v. Storage Tech. Corp.*, 185 F.3d 1259, 1267 (Fed. Cir. 1999).

¹³ Blue Br. at 42.

¹⁴ *Halliburton* at 8-9, 12.

for §112(f) to apply in the first instance), because Mass disclaimed its kinematic equivalents theory, and/or

(2) Under the *Halliburton*-string attached to §112(f), functional claim language cannot extend to all structures that perform the claimed function, particularity here where the patent asserts that the ball-and-socket joint is “novel.”

B. Particularized Testimony And Linking Argument Is Required To Establish §112(f) Structural Equivalents Because The Standard Is Simple To Articulate, But Conceptually Difficult To Apply

Although the Doctrine of Equivalents is not at issue here, its legal standard informs the evidentiary standard required to establish §112(f) structural equivalents. The Supreme Court has stated that structural equivalence under §112(f) is “an application of the doctrine of equivalents ... in a restrictive role.”¹⁵ “[T]heir tests for equivalence are closely related” and involve “similar analysis of insubstantiality of differences.”¹⁶ For example, both may be proven by similar function, way and result analysis *except that* §112(f) equivalent structure must perform the specific function claimed.

This Court recognizes that evidentiary safeguards are required to guide juries to reliably apply the Doctrine of Equivalents that “is simple to articulate,

¹⁵ *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 28 (1997) (citing prior codification at §112 ¶(6) (emphasis added)).

¹⁶ *Odetics*, 185 F.3d at 1267.

[but] conceptually difficult to apply.”¹⁷ Thus, for example, *particularized testimony and linking argument* are required before the jury reliably can determine whether differences are substantial:

[A]lthough the standard for infringement under the doctrine of equivalents is simple to articulate, it is conceptually difficult to apply. These evidentiary requirements assure that the fact-finder does not, under the guise of applying the doctrine of equivalents, erase a plethora of meaningful structural and functional limitations of the claim on which the public is entitled to rely in avoiding infringement. Moreover, without these requirements, the fact-finder has no analytical framework for making its decision and is put to sea without guiding charts when called upon to determine infringement under the doctrine [of equivalents]. In addition, we, as the reviewing court, would lack the assurance that the jury was fully presented with a basis for applying the doctrine of equivalents.¹⁸

To obviate those concerns, “a patentee must ... provide particularized testimony and linking argument as to the insubstantiality of the differences ... with respect to the function, way, result test,” because “[g]eneralized testimony as to the overall

¹⁷ *Texas Instruments Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1566-67 (Fed. Cir. 1996).

¹⁸ *Texas Instruments* at 1566-67; accord *Lear Siegler, Inc. v. Sealy Mattress Co.*, 873 F.3d 1422, 1426 (Fed. Cir. 1987); *Perkin-Elmer Corp. v. Westinghouse Elec. Corp.*, 822 F.2d 1528 (Fed. Cir. 1987); *Gemalto S.A. v. HTC Corp.*, 754 F.3d 1364, 1374 (Fed. Cir. 2014); *Amgen Inc. v. F. Hoffman-La Roche Ltd.*, 580 F.3d 1340, 1382 (Fed. Cir. 2009).

similarity between the claims and the accused infringer’s product or process will not suffice.”¹⁹

Notwithstanding the plethora of Federal Circuit cases on this evidentiary standard for infringement under the Doctrine of Equivalents, counsel found no Federal Circuit case on whether that same evidentiary standard applies to statutory §112(f) equivalents. We found only two cases where the issue was even discussed, and neither of those cases provide precedential guidance here.

First, the *Applied Medical* decision in 2006 stated in a *footnote* that the Federal Circuit had only required “particularized testimony and linking argument ... in applying the function, way, result test in the context of proving infringement of a claim under the doctrine of equivalents.”²⁰ The *Applied Medical* Court did not need to rule on that issue, however, because the Court determined that—even if the

¹⁹ *Texas Instruments* at 1567; *accord, Dawn Equipment Co. v. Kentucky Farms, Inc.*, 140 F.3d 1009, 1017 (Fed. Cir. 1998); *Hewlett-Packard Co. v. Mustek Systems, Inc.*, 340 F.3d 1314, 1322-23 (Fed. Cir. 2003); *AquaTex Industries, Inc. v. Techniche Solutions*, 479 F.3d 1320, 1329 (Fed. Cir. 2007); *Akzo Nobel Coatings, Inc. v. Dow Chemical Co.*, 811 F.3d 1334 (Fed. Cir. 2016); *Stumbo v. Eastman Outdoors, Inc.*, 508 F.3d 1358, 1364-65 (Fed. Cir. 2007); *American Calcar, Inc. v. American Honda Motor Co., Inc.*, 651 F.3d 1318, 1338-39 (Fed. Cir. 2011); *Motionless Keyboard Co. v. Microsoft Corp.*, 489 F.3d 1376, 1382-1383 (Fed. Cir. 2007); *PC Connector Solutions LLC v. SmartDisk Corp.*, 406 F.3d 1359, 1364 (Fed. Cir. 2005); *Cephalon, Inc. v. Watson Pharmaceuticals, Inc.*, 707 F.3d 1330, 1340 (Fed. Cir. 2013); *Gemalto S.A. v. HTC Corp.*, 754 F.3d 1364, 1374 (Fed. Cir. 2014).

²⁰ *Applied Medical Resources Corp. v. U.S. Surgical Corp.*, 448 F.3d 1324, 1334 n.5 (Fed. Cir. 2006) (emphasis added).

Doctrine of Equivalents high evidentiary standard also applied to the means-plus-function limitation at issue: The patent owner “ha[d] satisfied even the heightened standard of providing particularized testimony and linking argument.”²¹ So the *Applied Medical* decision provides no guidance for cases such as here where the patent owner failed to provide sufficient (or any) particularized testimony or linking argument of §112(f) equivalents.

Second, the *Intellectual Science* decision in 2009 ruled that the patent owner failed to establish §112 ¶6 structural equivalents for a “data transmitting means,” because its technical expert did not pinpoint the relevant structure in the accused device alleged to perform the claimed function.²² In doing so, the *Intellectual Science* Court observed that the *Applied Medical* footnote about only requiring particularized testimony in Doctrine of Equivalents cases was dicta:

This court [in *Applied Medical*] concluded that the expert had adequately established that the identified structure was equivalent because he provided an explanation as to why one of skill in the art would view the structure as functioning in substantially the same way to achieve substantially the same result. In dicta, this court said “we have only require [particularized testimony and linking argument] in applying the ‘function, way, result’ test in the context of proving infringement of a claim under the doctrine of equivalents.”²³

²¹ *Id.*

²² *Intellectual Science and Technology, Inc. v. Sony Electronics, Inc.*, 589 F.3d 1179, 1184-87 (Fed. Cir. 2009).

²³ *Intellectual Science* at 1186-87 (citing *Applied Medical*, 448 F.3d at 1335 n.5).

The *Intellectual Science* decision provides little (if any) precedential value, because the patent owner failed from the start to *identify the structure* in the accused product alleged to be equivalent, so no comparison of structures to determine their differences could occur. The Court never got past that threshold issue to decide whether the evidentiary standard applies to §112(f) structural equivalents. So the *Intellectual Science* decision also provides no guidance in cases such as this where the patent owner *has identified* the accused corresponding structure and the issue is the evidentiary standard for proving whether that structure is a §112(f) structural equivalent.

Planar searched and could not find any other precedential Federal Circuit cases discussing whether particularized testimony and linking argument is required to establish §112(f) structural equivalents. We found numerous Doctrine of Equivalent cases. Such disparity in decisions between Doctrine of Equivalents and §112(f) structural equivalents is a very strong indication that a Rule 36 affirmance is not applicable here, because a written opinion would have *significant* precedential value on this issue and may even be the seminal case on it.

The absence of Federal Circuit precedence on this issue indicates that a written decision in this case would have precedential value warranting rehearing.

Further, this case presents the precise concern of unguided juries deciding §112(f) structural equivalents infringement as the Court found was a similar

problem for determining Doctrine of Equivalents, so a written decision in this case would have significant precedential value:

- The §112(f) equivalent standard is (somewhat) simple to articulate, but conceptually difficult to apply.
- A jury may, under the guise of applying §112(f) structural equivalents, erase a plethora of meaningful structural differences: *e.g.*, the three-hinge joints that are independently tunable and biasing spring that are manifestly different from the ‘978 ball-and-socket joint.
- The jury has no analytical framework and is put to sea without guiding charts: *e.g.*, Mass provided no guidance of how the jury was to decide that the different “way” the structures performed the claimed function was an insubstantial change adding nothing of significance under the §112(f) standard.
- An increased risk of violating *Halliburton* and the statutorily authorized scope of §112(f) equivalents, because—unlike many structural limitations considered when applying Doctrine of Equivalents—the plain language of limitations subject to §112(f) are by definition functional and an unguided jury foreseeably will extend that limitation to every structure that performs the claimed function—as plainly was the case here.
- The reviewing court lacks assurance that the jury was fully presented with a basis for applying §112(f).

IV. Conclusion

Planar respectfully requests that the Panel grant rehearing to provide a written decision, or the En Banc court grant rehearing to address this important

issue and ensure the decision is consistent with Supreme Court precedence, §112(f) statutory limits and other authority cited herein.

Dated: April 22, 2021

/s/ David W. Long
David W. Long
Attorney for Appellant
Planar Systems, Inc.

Addendum

NOTE: This disposition is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

MASS ENGINEERED DESIGN, INC.,
Plaintiff-Appellee

v.

PLANAR SYSTEMS, INC.,
Defendant-Appellant

2019-1365

Appeal from the United States District Court for the District of Oregon in No. 3:16-cv-01510-SI, Judge Michael H. Simon.

JUDGMENT

JOHN J. EDMONDS, Edmonds & Schlather, PLLC, Houston, TX, argued for plaintiff-appellee. Also represented by STEPHEN F. SCHLATHER.

DAVID W. LONG, Essential Patent LLC, Oak Hill, VA, argued for defendant-appellant. Also represented by ANDREW TIMOTHY OLIVER, Amin Turocy & Watson LLP, San Jose, CA; JENNY CHEN, Chen IP Law, Taipei, Taiwan.

2

MASS ENGINEERED DESIGN, INC. v. PLANAR SYS., INC.

THIS CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

PER CURIAM (LOURIE, DYK, and STOLL, *Circuit Judges*).

AFFIRMED. See Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

March 22, 2021
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

Certificate of Compliance

The undersigned certifies that the foregoing complies with the relevant type-volume limitation of the Federal Rules of Appellate Procedure and Federal Circuit Rules because the filing has been prepared using a proportionally-spaced typeface and includes 3,225 words as counted automatically by Microsoft Word, which is under the 3,900 word limit under Federal Rule of Appellate Procedure 40(b)(1).

Dated: April 22, 2021

/s/ David W. Long
David W. Long
Attorney for Appellant
Planar Systems, Inc.

Certificate of Service

I certify that, on April 22, 2021, I electronically filed the foregoing with the Clerk of the United States Court of Appeals for the Federal Circuit using the CM/ECF System and served on all counsel of record via electronic mail.

Dated: April 22, 2021

/s/ David W. Long
David W. Long
Attorney for Appellant
Planar Systems, Inc.