

Case No. 2020-1283

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

SPEX TECHNOLOGIES, INC.,

Plaintiff-Appellant,

v.

WESTERN DIGITAL CORPORATION, WESTERN DIGITAL
TECHNOLOGIES, INC., HGST, INC.,

Defendants-Appellees.

On Appeal from the United States District Court for the Central District of
California, Case No. 8:16-cv-01799-JVS-AGR, Judge James V. Selna

**PETITION FOR PANEL REHEARING AND
REHEARING *EN BANC* FOR DEFENDANTS-APPELLEES**

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CERTIFICATE OF INTEREST FOR DEFENDANTS-APPELLEES

Counsel for Defendants-Appellees certify the following:

1. The full name of every party or amicus represented by me is:

Western Digital Corporation
Western Digital Technologies, Inc.
HGST, Inc.

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

None.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

None.

4. 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 are expected to appear in this court (and who have not or will not enter an appearance in this case) are:

Taylor W. King
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Rustin Mangum (no longer associated with Gibson, Dunn & Crutcher LLP; will not appear)

5. 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).

SPEX Techs., Inc. v. Kingston Tech. Co., Inc., No. 8:16-cv-01790 (C.D. Cal. Filed Sept. 27, 2016);

SPEX Techs., Inc. v. Toshiba Am. Elecs. Components Inc., No. 8:16-cv-01800 (C.D. Cal. Filed Sept. 28, 2016); and

SPEX Techs., Inc. v. Apricorn, No. 2:16-cv-07349 (C.D. Cal. Filed Sept. 28, 2016).

6. 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).

None.

Dated: June 28, 2021

Respectfully submitted,

/s/ Frank P. Côté

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TABLE OF CONTENTS

	<u>Page</u>
STATEMENT OF COUNSEL	1
POINTS OF LAW AND FACT OVERLOOKED OR MISAPPREHENDED BY THE COURT	2
INTRODUCTION	4
BACKGROUND	5
ARGUMENT	9
I. The Panel Decision Includes Demonstrably False Statements	10
II. The Panel Decision Failed To Apply <i>Williamson</i> , Which Requires The Disclosed Structure Be Adequate To Achieve The Recited Functions.....	14
A. Memory Section 612a Alone Cannot Store Target Information.....	15
B. Memory Section 612a Alone Cannot Provide Target Information.....	17
III. The Panel Decision Improperly Supplants The Absence Of Structure With Expert Assertions.....	17
CONCLUSION	20

TABLE OF AUTHORITIES

Page(s)

Cases

AllVoice Computing PLC v. Nuance Commc’ns, Inc.,
504 F.3d 1236 (Fed. Cir. 2007)1, 3, 18

Aristocrat Techs. Australia Pty. Ltd. v. Int’l Game Tech.,
521 F.3d 1328 (Fed. Cir. 2008)16

Biogen MA Inc. v. EMD Serono, Inc.,
No. 19-1133 (Fed. Cir. Nov. 20, 2020)14

Blackboard, Inc. v. Desire2Learn, Inc.,
574 F.3d 1371 (Fed. Cir. 2009)16, 17

Default Proof Credit Card Sys., Inc. v. Home Depot U.S.A., Inc.,
412 F.3d 1291 (Fed. Cir. 2005)1, 3, 4, 14, 18

Diebold Nixdorf, Inc. v. Int’l Trade Comm’n,
899 F.3d 1291 (Fed. Cir. 2018)16

Encyclopaedia Britannica, Inc. v. Alpine Elecs., Inc.,
355 F. App’x 389 (Fed. Cir. 2009)18

Media Rts. Techs., Inc. v. Cap. One Fin. Corp.,
800 F.3d 1366 (Fed. Cir. 2015)18

Nazomi Commc’ns, Inc. v. Arm Holdings, PLC,
403 F.3d 1364 (Fed. Cir. 2005)19

Newell Cos. v. Kenney Mfg. Co.,
864 F.2d 757 (Fed. Cir. 1988)18

Noah Sys., Inc. v. Intuit Inc.,
675 F.3d 1302 (Fed. Cir. 2012)3, 4, 14, 17, 19

Outside the Box Innovations, LLC v. Travel Caddy, Inc.,
695 F.3d 1285 (Fed. Cir. 2012)19

Teva Pharms. USA, Inc. v. Sandoz, Inc.,
574 U.S. 318 (2015).....19

TABLE OF AUTHORITIES
(continued)

	<u>Page(s)</u>
<i>Va. Innovation Scis., Inc. v. Samsung Elecs. Co.</i> , 614 F. App'x 503 (Fed. Cir. 2015)	19
<i>Western Digital Corp. v. SPEX Techs., Inc.</i> , Case IPR2018-00082 (P.T.A.B.)	6
<i>Williamson v. Citrix Online, LLC</i> , 792 F.3d 1339 (Fed. Cir. 2015)	1, 2, 4, 15, 18
<i>Zenith Radio Corp. v. Hazeltine Rsch., Inc.</i> , 395 U.S. 100 (1969).....	19

STATEMENT OF COUNSEL

Based on my professional judgment, I believe the panel decision is contrary to at least the following precedents of this Court: *Williamson v. Citrix Online, LLC*, 792 F.3d 1339 (Fed. Cir. 2015); *Default Proof Credit Card Sys., Inc. v. Home Depot U.S.A., Inc.*, 412 F.3d 1291 (Fed. Cir. 2005); and *AllVoice Computing PLC v. Nuance Commc'ns, Inc.*, 504 F.3d 1236 (Fed. Cir. 2007).

/s/ Frank P. Coté
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*Counsel for Defendants-Appellees
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Western Digital Technologies, Inc.,
and HGST, Inc.*

**POINTS OF LAW AND FACT OVERLOOKED OR MISAPPREHENDED
BY THE COURT**

Pursuant to Federal Circuit Rule 35(e)(1)(F) and Federal Rule of Appellate Procedure 40(a)(2), Defendants-Appellees Western Digital Corporation, Western Digital Technologies, Inc., and HGST, Inc. (collectively, “WD”) respectfully identify these points of fact and law overlooked or misapprehended in the panel decision.

1. The panel misapprehended the relationship between the disclosures in SPEX’s U.S. Patent Nos. 6,088,802 (“’802 patent”) and 6,003,135 (“’135 patent”), which led the panel to make findings of fact inconsistent with both patents’ disclosures and SPEX’s own admissions. The patents’ disclosures and SPEX’s admissions belie the panel’s findings that relevant portions of the patents’ disclosures are “virtually identical” and that “none” of the ’135 patent’s unique disclosures relate to the recited functions. Op. 13 & n.4. In fact, only the ’135 patent discloses how to, and the structure necessary to, perform the recited functions of the ’802 patent’s “means for providing” limitation.

2. The panel overlooked the *Williamson* requirement that “[e]ven if the specification discloses corresponding structure, the disclosure must be of ‘adequate’ corresponding structure to achieve the [recited] function.” *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1352 (Fed. Cir. 2015) (emphasis added). Judge Selna

correctly performed this required analysis in concluding that the “means for providing” limitation is indefinite, finding that only the ’135 patent described structure sufficient to perform the recited functions. Appx37–38, Appx74–75.

3. The panel also misapprehended the holding in *AllVoice Computing PLC v. Nuance Communications, Inc.*, 504 F.3d 1236 (Fed. Cir. 2007). Here, unlike *AllVoice*, because the disclosed structure is not capable of performing all of the recited functions (as the district court correctly concluded, Appx74–75), the Court must treat the specification as if *no* structure has been disclosed at all. *Noah Sys., Inc. v. Intuit Inc.*, 675 F.3d 1302, 1318–19 (Fed. Cir. 2012). The panel therefore wrongly concluded that the ’802 patent discloses sufficient structure based on Mr. Gomez’s assertions simply because his was “the only assessment.” This is impermissible under this Court’s precedents. *Default Proof Credit Card Sys., Inc. v. Home Depot U.S.A., Inc.*, 412 F.3d 1291, 1302 (Fed. Cir. 2005). At a minimum, the panel should have remanded for the district court to make findings of fact based on this extrinsic evidence in the first instance.

INTRODUCTION

Judge Selna was correct: The “means for providing” limitation is indefinite. The ’802 patent’s memory section 612a is not “‘adequate’ corresponding structure to achieve the [recited] function[s].” *Williamson*, 792 F.3d at 1352. Although the memory section 612a may support *some* of the recited functions, it does not support all of them, so the Court must treat the specification as if *no* structure has been disclosed at all. *Noah Sys.*, 675 F.3d at 1318–19. Under this Court’s precedents, neither SPEX, nor the panel, can supplant this absence of structure from the specification with a conclusory statement from an expert declaration. *Default Proof*, 412 F.3d at 1302. Nonetheless, breaking new ground in a startling direction, a panel of this Court did exactly that and reversed Judge Selna’s ruling with respect to this claim limitation, a ruling with which the USPTO had already agreed.¹

The panel performed only half of the required analysis. This Court’s precedents require that, “[e]ven if the specification discloses corresponding structure,” as the panel found here (Op. 11–14), the disclosure must *also* be of “‘adequate’ corresponding structure to achieve the [recited] function.” *Williamson*, 792 F.3d at 1352. The panel did not address the adequacy of the disclosed structure to perform the

¹ The panel affirmed the district court’s grant of summary judgment of noninfringement. WD does not challenge that ruling.

recited functions, but held only that the '802 patent “sufficiently links” memory section 612a to the function recited in the “means for providing” limitation. Op. 11, 13. This Court should grant panel rehearing or en banc rehearing and affirm the district court’s indefiniteness determination or, in the alternative, remand.

The panel’s decision also includes two statements of fact that are demonstrably false. The panel should grant rehearing and affirm the district court’s determination that the “means for providing” limitation is indefinite for this reason alone. At a minimum, the panel should issue an errata deleting its incorrect factual findings.

BACKGROUND

The '802 patent relates generally to computer peripheral devices—devices that operate outside of a host computing device and are connected to the host computing device—that include both security (*e.g.*, encryption) and target (*e.g.*, memory) devices or modules. *See* '802 patent 4:52–55, 5:50–58. In general, computer peripheral devices can include devices such as memory cards, smart cards, and CD-ROMs. *Id.* at 1:29–38.

Claims 6, 7, 23, and 25 of the '802 patent each include the “means for providing” limitation, which requires:

[M]eans for providing to a host computing device, in response to a request from the host computing device for information regarding the type of the peripheral device, information regarding the function of the target means.

'802 patent claim 6.

The “means for providing” limitation refers to two different types of information—“information regarding the type of the peripheral device,” and “information regarding the function of the target means.” *Id.* The recited functions require providing to the host computing device “target means” information in response to a request for something different, *i.e.*, “peripheral device” information. *Id.*

Judge Selna correctly concluded that the “means for providing” limitation is indefinite “[g]iven the ’802 Patent’s failure to disclose sufficient structure” corresponding to the recited functions. Appx75. He held that the memory section 612a alone is inadequate to perform the recited functions because the ’802 patent “does not provide that the memory section 612a stores information about the function of the target means, let alone provide[] information about the function of the target means in response to a request from the host computing device.” Appx74–75. In fact, the PTAB *also* ruled that the ’802 patent “fail[s] to disclose that memory 612a stores such information regarding the function of the target means, let alone provides such information to the host computing device.” *Western Digital Corp. v. SPEX Techs., Inc.*, Case IPR2018-00082, Paper 40 at 14 (P.T.A.B. Apr. 18, 2019).

The district court further explained that the ’802 patent’s insufficient disclosure is “in contrast to the ’135 Patent, which similarly discloses a memory section 612a, but explicitly states that target module identification data is stored in memory section 612a.” Appx75 (citing ’135 patent 11:32–39). The ’135 patent disclosure

highlights the deficiencies with the '802 patent's disclosure. *Compare* '802 patent 9:51–11:67, *with* '135 patent 7:17–8:45. Most of the disclosure that relates to the “means for providing” limitation is unique to the '135 patent and does not appear in the '802 patent at all. '135 patent 10:50–60, 11:11–67. Within these unique sections, the '135 patent makes it abundantly clear that the memory section 612a *alone* cannot perform the recited functions; rather, a variety of interoperating structures—disclosed only in the '135 patent—are required to perform this recited functionality. *Id.*

The '135 patent explains that, in order to “result[] in identification of the modular device 602 by the host computing device 601 as a device of the type of the target module 620”—*i.e.*, perform the recited functions—the '135 patent discloses a startup program that: “[C]an include instructions to cause the processing device 616 of the target module 620 to access the memory section 617a in the memory device 617, and transfer to [the memory section 612a in] the security module 610, via the I/O interface 618, the data representing the type of the target module 620.”² *Id.* at 11:26–36.

The '802 patent does not disclose any of these structures. For example, the '135 patent discloses that the “[t]he target module 620 [green box] of the modular

² Under the district court's construction, uncontested on appeal, “modular device” and “peripheral device” mean the same thing. Appx48.

device 602 includes a processing device 616, a memory device 617, and an input/output (I/O) device 618 for enabling communication with the security module 610. The devices 616, 617 and 618 ... can communicate with each other via a conventional computer bus 619.” *Id.* at 9:4–11. By contrast, the target functionality 614 (green box) in the ’802 patent Figure 6 is an empty box. ’802 patent 6:37–45. Nor does the ’802 patent disclose instructions in the security module’s startup program that cause the target module to access and transfer to the security module information identifying the type of target module.

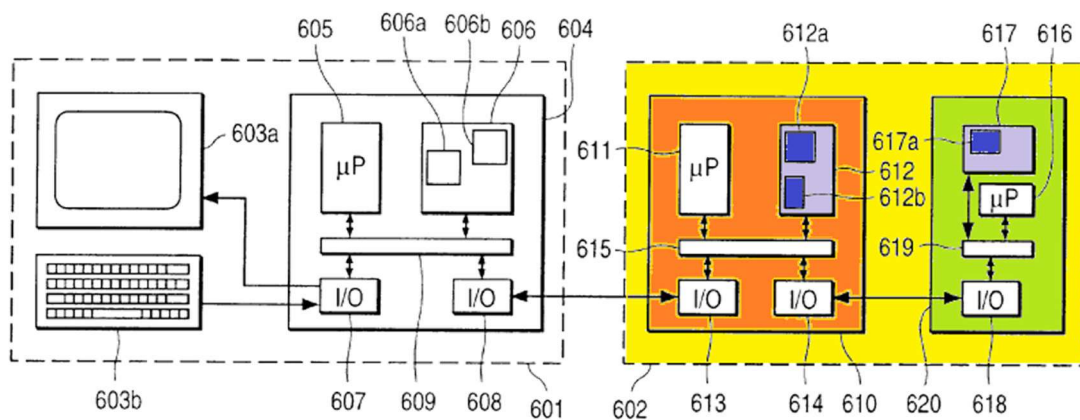


FIG. 6

’135 patent FIG. 6 (annotated).

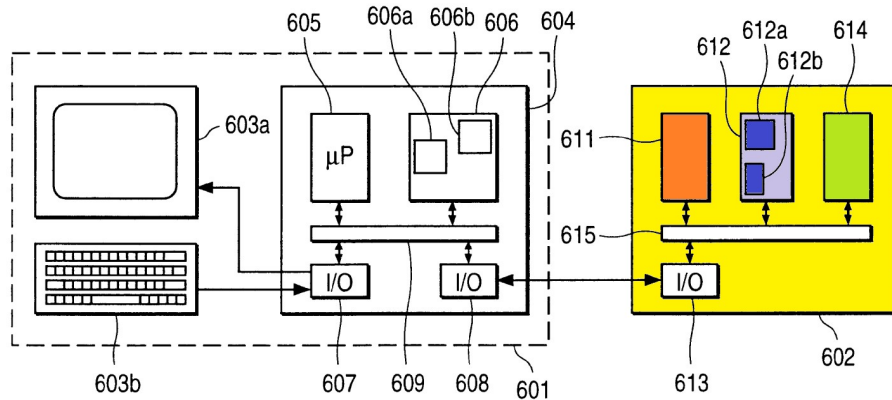


FIG. 6

'802 patent FIG. 6 (annotated).

ARGUMENT

The Court should grant panel rehearing or rehearing en banc and affirm the district court's determination that the "means for providing" limitation is indefinite. The panel's indefiniteness decision suffers from three key errors, each warranting rehearing. Unless corrected by the Court, the panel decision will fundamentally alter the indefiniteness analysis for means-plus-function elements having multiple recited functions. The panel's decision will excuse patentees' failure to disclose adequate corresponding structure to perform *all* of the recited functions and permit them to supplant the absence of structure from the specification with conclusory expert assertions simply because they constituted the only expert commentary regarding the specification's adequacy.

I. The Panel Decision Includes Demonstrably False Statements

The panel decision includes two statements that are demonstrably false. The panel should grant rehearing and affirm the district court’s indefiniteness determination for this reason alone. At a minimum, the panel should issue an errata deleting its misstatements.

A. The panel’s statement that “the portion of the ’802 patent specification referenced by Mr. Gomez for this aspect of the [recited] function is virtually identical to the disclosure in the ’135 patent’s specification, which Western Digital references as an example of sufficient disclosure,” (Op. 13) is incorrect.

The only portion of the ’802 patent specification that Mr. Gomez referenced (7:60–8:14) is *not* “virtually identical” to the corresponding disclosure in the ’135 patent (10:26–49). Although both passages reference Figure 6 and device 602, peripheral device 602 in the ’802 patent is consequentially different from device 602 in the ’135 patent.

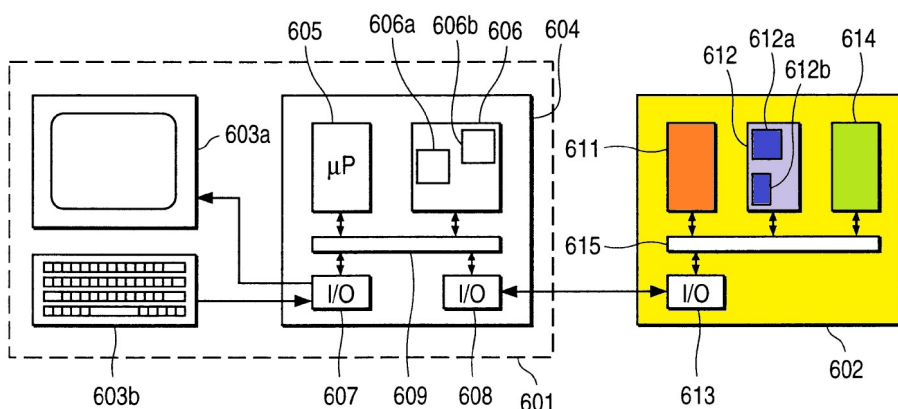


FIG. 6

'802 patent FIG. 6.

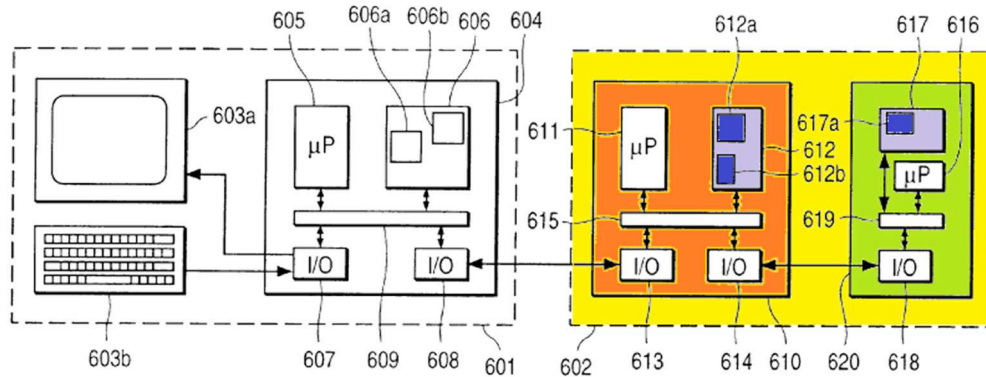


FIG. 6

'135 patent FIG. 6.

In the '802 patent, device 602 (yellow) includes black-box target functionality 614 (green). By contrast, in the '135 patent, device 602 (yellow) includes target module 620 (green) having memory device 617, memory section 617a, processing device 616, I/O interface 618, and computer bus 619. These additional structures (disclosed in the '135 patent but not the '802 patent) are significant because, along with the memory section 612a, they perform the recited functions—they provide “information regarding the function of the target means” in response to a request for information regarding the type of the peripheral device.

Nor did WD reference the disclosure in the '135 patent (10:26–49) corresponding to the portion of the '802 patent Mr. Gomez referenced (7:60–8:14), as “sufficient disclosure” *on its own*. As WD explained, most of the disclosure in the '135 patent that relates to the “means for providing” limitation does not appear in

the '802 patent. Red Br. 59. Indeed, WD did not reference this portion of the '135 patent in this section of its brief at all. *See id.* at 59–60. Rather, as WD explained, the “sufficient disclosure” is in the disclosure “unique” to the '135 patent (*e.g.*, 11:11–39), which discloses the interoperating structures required to perform the recited functions. *Id.* at 59.

B. The panel’s statement that “none of the cited disclosures unique to the '135 patent relate to the function of providing the target functionality information in response to a request from a host computing device,” (Op. 13 n.4) is also incorrect. As SPEX itself conceded, the disclosures unique to the '135 patent that WD cited in its brief *do* relate to the function of providing the target functionality information. SPEX explained that “[t]he specification of the '135 Patent includes details about an embodiment where the invention is practiced by replacing the existing data in memory section 612a with ‘target module identification data.’” *Compare* Blue Br. 50 (citing '135 patent 11:12–61), *with* Red Br. 59–60 (citing '135 patent 11:11–67). The district court pointed to these same '135 patent disclosures to explain that “in contrast to” the '802 patent, “the '135 Patent, which similarly discloses a memory section 612a, but explicitly states that target module identification data is stored in memory section 612a.” Appx75 (citing '135 patent 11:32–39).

The recited functions require providing information regarding the function of the *target* means. But, as SPEX explained, “[i]n the standard implementations,

memory section 612a would typically ‘store[] data representing the type of the *peripheral* device,’ calling the data ‘*peripheral* device identification data.’” Blue Br. 51 (emphasis added) (citing ’802 patent 7:60–8:14). In the invention, SPEX argued, “the recited function is practiced by *replacing* the peripheral device information in memory section 612a ... with information about the functionality of the target means.” *Id.* at 52 (emphasis added). But the memory section 612a *alone* is not capable of transferring information about the target means or “replacing” the peripheral device information with that target device information.

As SPEX admits, the ’135 patent discloses the additional required structures. *Id.* at 52. Citing disclosures unique to the ’135 patent (11:12–46), SPEX concedes that “[t]he specification of the ’135 Patent includes details about an embodiment where the invention is practiced by *replacing* the existing data in memory section 612a with ‘target module identification data.’” Blue Br. 52–53 (emphasis added).

In particular, the ’135 patent (11:12–46) discloses that in order to “result[] in identification of the modular device 602 by the host computing device 601 as a device of the type of the target module 620” (*i.e.*, perform the recited functions), a startup program: “[C]an include instructions to cause the processing device 616 of the target module 620 to access the memory section 617a in the memory device 617, and transfer to the security module 610, via the I/O interface 618, the data representing the type of the target module 620.” *Id.* at 11:26–32 (emphasis added).

In other words, memory section 612a is not capable of providing the *target* functionality information unless, and until, the target processing device 616 accesses the target memory section 617a and transfers, via the I/O interface 618, data representing the type of the target module to the memory section 612a. These disclosures unique to the '135 patent (as recognized by WD, SPEX, and the district court) thus clearly “relate to the function of providing the target functionality information in response to a request from a host computing device.” Op. 13 n.4.

The panel should grant rehearing to consider the implications of these points of fact overlooked and misapprehended and affirm the district court’s indefiniteness determination. At a minimum, the panel should issue an errata deleting its misstatements. *See, e.g., Biogen MA Inc. v. EMD Serono, Inc.*, No. 19-1133 (Fed. Cir. Nov. 20, 2020), Dkt. No. 98 (errata modifying factual statements).

II. The Panel Decision Failed To Apply *Williamson*, Which Requires The Disclosed Structure Be Adequate To Achieve The Recited Functions

As the panel explained, “[a] structure qualifies as ‘corresponding structure’ if the specification clearly links the structure to the [recited] function.” Op. 11 (citing *Noah Sys.*, 675 F.3d at 1311). But that is not the end of the inquiry.

The panel failed to follow this Court’s precedents, which require that the disclosed structure *also* actually be “capable of performing” the function recited by the means-plus-function limitation. *Default Proof*, 412 F.3d at 1299. “Even if the spec-

ification discloses corresponding structure,” as the panel held (Op. 11), “the disclosure must be of ‘adequate’ corresponding structure to achieve the [recited] function.” *Williamson*, 792 F.3d at 1352. And, “[w]here there are multiple [recited] functions,” as the panel held here (Op. 12), “the patentee must disclose adequate corresponding structure to perform *all* of the [recited] functions.” *Id.* at 1351–52 (emphasis added). The panel failed to conduct this mandatory analysis.

The panel explained that the specification must disclose that the memory section 612a “both store[s] data regarding the target functionality and provide[s] that data to a host computing device” Op. 12. Even assuming the memory section 612a is capable of storing data and providing data to a host computing device, the specification does not disclose how, or even that, the memory section 612a is capable of storing and providing *target functionality* data. Red Br. 56, 58–60. The ’802 patent disclosure thus fails under a proper *Williamson* analysis: the memory section 612a alone cannot perform the recited functions.

A. Memory Section 612a Alone Cannot Store Target Information

The panel held that “it is clear that memory section 612a is used to store information regarding the target functionality,” Op. 12, but it points to no disclosed structure actually capable of transferring the target functionality data to the memory section 612a in the first place. As SPEX itself argued, “the recited function is practiced by *replacing* the peripheral device information in memory section 612a ... with

information about the functionality of the target means.” Blue Br. 52 (emphasis added). The panel does not (nor can it) point to disclosure of *how* memory section 612a performs the function of storing *target functionality* data, specifically, or how the peripheral device information in memory section 612a is “replac[ed].” *See Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1384 (Fed. Cir. 2009) (claim indefinite because the specification language simply described the function to be performed without explaining *how* the function was to be performed).

The panel explains that:

The peripheral device “can take a variety of identities,” and can “assume[] the identity of the target functionality,” which “enables the host computing device 601 to interact with the peripheral device 602 as though the peripheral device 602 were a device of the type of the target functionality”

Op. 12 (alteration in original) (quoting ’802 patent 7:43, 8:15–24). But these passages “describe only function, not structure, and therefore [are] insufficient to constitute “adequate” corresponding structure to achieve the [recited] function.”” *Diebold Nixdorf, Inc. v. Int’l Trade Comm’n*, 899 F.3d 1291, 1303 (Fed. Cir. 2018) (citation omitted). Because this disclosure merely “describes an outcome, not a means for achieving that outcome,” it is insufficient. *Aristocrat Techs. Australia Pty. Ltd. v. Int’l Game Tech.*, 521 F.3d 1328, 1334 (Fed. Cir. 2008).

B. Memory Section 612a Alone Cannot Provide Target Information

Similarly, the panel wrongly held that it is “clear” that memory section 612a provides the target functionality identity to the host computer in response to requests for peripheral device information. Op. 13. The panel only points to disclosure that “the host computing device can identify the type of *peripheral device*’ by accessing memory section 612a via ‘an interface standard developed for that type of *peripheral device*.’” *Id.* (emphasis added). The panel does not (nor can it) point to any disclosure of how (or even if) the memory section 612a actually provides the *target functionality* identity to the host computer rather than the identity of the peripheral device. This disclosure is therefore also insufficient. *Blackboard*, 574 F.3d at 1384.

* * * *

As the district court correctly concluded, Appx74–75, and as WD argued in its briefing to the panel, Red Br. 56, 58–60, the memory section 612a is thus not an “adequate” corresponding structure because it alone is not capable of achieving all of the recited functions.

III. The Panel Decision Improperly Supplants The Absence Of Structure With Expert Assertions

The panel incorrectly relied on Mr. Gomez’s testimony. Under this Court’s precedents, because the memory section 612a supports at most some, but not all, of the recited functions, the Court must treat the specification as if *no* structure has been disclosed at all. *Noah Sys.*, 675 F.3d at 1318–19; *see also Media Rts. Techs., Inc. v.*

Cap. One Fin. Corp., 800 F.3d 1366, 1374 (Fed. Cir. 2015). And because there is an absence of structure, *Default Proof* controls, not *AllVoice*. To the extent *AllVoice* and *Default Proof* are in direct conflict, *Default Proof* came first and is the binding precedent. *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 765 (Fed. Cir. 1988).

The panel wrongly relied on *AllVoice*. In that case, unlike here, the *specification* disclosed sufficient structure. See *Encyclopaedia Britannica, Inc. v. Alpine El-ecs., Inc.*, 355 F. App'x 389, 394 (Fed. Cir. 2009) (nonprecedential) (distinguishing *AllVoice*). And there, without any record evidence to contradict the patent owner's expert's detailed explanation as to the adequacy of that disclosure, the Court held that the claims satisfied the definiteness requirement. *AllVoice*, 504 F.3d at 1245–46. Here, by contrast, the disclosed structure is *not* capable of performing all of the recited functions. The panel thus wrongly concluded that the '802 patent disclosed sufficient structure based on Mr. Gomez's assertions simply because his was “the only assessment.”

Under *Default Proof*, “the testimony of one of ordinary skill in the art cannot supplant the total absence of structure from the specification.” 412 F.3d at 1302. “The prohibition against using expert testimony to create structure where none otherwise exists is a direct consequence of the requirement that the *specification* adequately disclose corresponding structure.” *Williamson*, 792 F.3d at 1354 (emphasis added). The Court “cannot allow,” as the panel has done here, “disclosure as to one

function to fill the gaps in a specification as to a different, albeit related, function.” *Noah Sys.*, 675 F.3d at 1319. The district court was correct to not consider Mr. Gomez’s testimony—the panel should have followed suit.

Even assuming *AllVoice* controls (it does not) and Mr. Gomez’s testimony could supplant the missing structure (it cannot), the panel should have remanded for the district court to make findings of fact based on this extrinsic evidence in the first instance. The Court must review underlying findings of fact based on extrinsic evidence for clear error (*Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318, 322 (2015)) but, as SPEX explained, the district court “did not consider Mr. Gomez’s opinion at all.” Blue Br. 53. The panel was wrong to engage in its own fact-finding. *Zenith Radio Corp. v. Hazeltine Rsch., Inc.*, 395 U.S. 100, 123 (1969) (appellate courts are “not to decide factual issues de novo”).

“This [C]ourt’s review of a district court’s claim construction, albeit without deference, nonetheless is not an independent analysis in the first instance.” *Nazomi Commc’ns, Inc. v. Arm Holdings, PLC*, 403 F.3d 1364, 1371 (Fed. Cir. 2005). The Court must remand unless it is “furnished [with] ‘sufficient findings and reasoning to permit meaningful appellate scrutiny.’” *Id.* (citation omitted); *see also Outside the Box Innovations, LLC v. Travel Caddy, Inc.*, 695 F.3d 1285, 1299 (Fed. Cir. 2012) (remanding for new obviousness determination considering expert testimony); *Va. Innovation Scis., Inc. v. Samsung Elecs. Co.*, 614 F. App’x 503, 510–11

(Fed. Cir. 2015) (nonprecedential) (remanding for new claim construction considering expert testimony).

CONCLUSION

For any one of the three reasons set forth above, this Court should grant panel rehearing or en banc rehearing and affirm the district court's determination that the "means for providing" limitation is indefinite or, in the alternative, remand for Judge Selna to find the relevant facts in the first instance. At a minimum, the panel should grant rehearing or issue an errata to correct its factual errors.

Dated: June 28, 2021

Respectfully submitted,

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ADDENDUM

NOTE: This disposition is nonprecedential.

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

SPEX TECHNOLOGIES, INC.,
Plaintiff-Appellant

v.

**WESTERN DIGITAL CORPORATION, WESTERN
DIGITAL TECHNOLOGIES, INC., HGST, INC.,**
Defendants-Appellees

2020-1283

Appeal from the United States District Court for the
Central District of California in No. 8:16-cv-01799-JVS-
AGR, Judge James V. Selna.

Decided: May 28, 2021

MARC AARON FENSTER, Russ August & Kabat, Los An-
geles, CA, argued for plaintiff-appellant. Also represented
by PAUL ANTHONY KROEGER, BENJAMIN T. WANG.

FRANK P. COTE, Gibson, Dunn & Crutcher LLP, Irvine,
CA, argued for defendants-appellees. Also represented by
JESSICA A. HUDAK, WILLIAM C. ROOKLIDGE.

Before REYNA, CLEVINGER, and STOLL, *Circuit Judges*.

CLEVINGER, *Circuit Judge*.

SPEX Technologies, Inc. (“SPEX”) charged Western Digital Corporation, Western Digital Technologies, Inc., and HGST, Inc. (collectively “Western Digital”) with infringing claims 1, 2, 6, 7, 11, 12, 23, and 25 of U.S. Patent No. 6,088,802 (“the ’802 Patent”).¹ In its claim construction order, the United States District Court for the Central District of California held that claims 6, 7, 23, and 25 were indefinite because the specification failed to provide corresponding structure for a means-plus-function limitation. *SPEX Techs., Inc. v. Kingston Tech. Corp.*, No. 8:16-cv-01799-JVS-AGR, 2017 WL 5495149, at *15–17 (C.D. Cal. Oct. 18, 2017). In a separate decision, the district court granted Western Digital’s motion for summary judgment of noninfringement of claims 1–2 and 11–12 because SPEX failed to identify an equivalent infringing structure in Western Digital’s accused products. *SPEX Tech., Inc. v. W. Digital Corp.*, No. 8:16-cv-01799-JVS-AGR, 2019 WL 8194736, at *5–6 (C.D. Cal. Nov. 22, 2019). For the reasons set forth below, we *affirm* the district court’s grant of summary judgment of noninfringement but *reverse and remand* the district court’s holding of indefiniteness.

I

The ’802 Patent, entitled “Peripheral Device With Integrated Security Functionality,” discloses a peripheral device, such as a portable hard drive, that is designed to perform security operations on data transmitted to a host computing device (i.e. computer) or from the host computing device to the peripheral device. The peripheral device operates outside of the host computing device and includes security (e.g., encryption) and target (e.g., memory)

¹ SPEX had originally included claims 38 and 39 but those are not at issue in this appeal.

SPEX TECHNOLOGIES, INC. v.
WESTERN DIGITAL CORPORATION

3

elements within it. The peripheral device may also take on various identities, for example a target functionality, so that the computer can interact with the device as though it were just a memory device without recognizing the security functionality.

Claim 1 of the '802 Patent recites a “means for mediating” limitation and reads as follows:

1. A peripheral device, comprising:

security means for enabling one or more security operations to be performed on data;

target means for enabling a defined interaction with a host computing device;

means for enabling communication between the security means and the target means;

means for enabling communication with a host computing device;

means for operably connecting the security means and/or the target means to the host computing device in response to an instruction from the host computing device; and

means for mediating communication of data between the host computing device and the target means so that the communicated data must first pass through the security means.

'802 Patent, 18:54–19:4 (emphasis added to highlight language of particular significance to the issues on appeal). Independent claim 11 is similar for the relevant issue and claims 2 and 12 depend from claims 1 and 11, respectively.

Claim 6 recites the same limitations as claim 1, but instead of the “means for mediating” limitation, it includes a “means for providing” limitation and reads as follows:

6. A peripheral device, comprising:

. . . . ; and

means for providing to a host computing device, in response to a request from the host computing device for information regarding the type of the peripheral device, information regarding the function of the target means.

Id. at 19:15–33 (emphasis added to highlight language of particular significance to the issues on appeal). Independent claim 23 is similar for the relevant issue and claims 7 and 25 depend from claims 6 and 23, respectively.

The district court held in its claim construction order that the “means for mediating” limitation in claim 1 and the “means for providing” limitation in claim 6 invoke 35 U.S.C. § 112, ¶ 6. *SPEX Tech.*, 2017 WL 5495149, at *13–17. With respect to the “means for mediating” limitation, the district court construed the function as “mediating communication of data between the host computing device and the target means so that the communicated data must first pass through the security means” and the corresponding

SPEX TECHNOLOGIES, INC. v.
WESTERN DIGITAL CORPORATION

5

structure as “Interface control device 910 (as shown in Fig. 9B).” *Id.* at *15. Figure 9B is shown below:

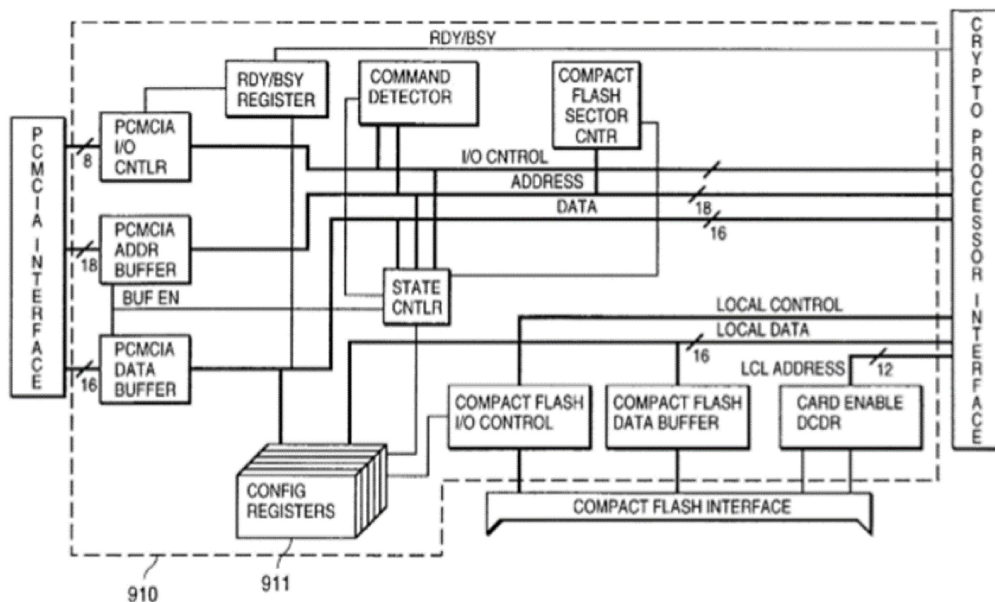


FIG. 9B

'802 patent, Fig. 9B. In Figure 9B, “the host computing device communicates via a PCMCIA interface and the target functionality is embodied by a compact flash memory device.” *Id.* at 17:18–21. According to the district court’s construction, “Figure 9B is dedicated to setting out components of an exemplary interface control device 910 and that device’s relationship to surrounding interfaces,” which include the PCMCIA, compact flash, and crypto processor interfaces. *SPEX Tech.*, 2017 WL 5495149, at *14. Neither party disputes the district court’s construction with respect to this limitation.

The parties also agreed that the function for the “means for providing” limitation is “providing to a host computing device in response to a request from the host computing device for information regarding the type of the

peripheral device, information regarding the function of the target means,” and SPEX identified memory section 612a in the peripheral device as the corresponding structure. *Id.* at *15. But the district court ultimately found that the term was indefinite under 35 U.S.C. § 112, ¶ 2 because the specification “does not provide that the memory section 612a stores information about the function of the target means, let alone provides information about the function of the target means in response to a request from the host computing device.” *Id.* at *17. The district court considered SPEX’s argument that U.S. Patent No. 6,003,135 (“the ’135 patent”) was incorporated by reference into the ’802 patent’s specification and also provided sufficient corresponding structure for the limitation, but ultimately rejected that argument finding that the ’135 patent was not properly incorporated. However, the district court noted that the ’135 patent sufficiently linked memory section 612a to the function of storing target module identification data.

After the district court entered its *Markman* ruling, Western Digital moved for summary judgment of noninfringement of claims 1–2 and 11–12 on the basis that SPEX failed to identify an overall equivalent structure in Western Digital’s accused products that met the “means for mediating” limitation. The district court agreed, holding that no reasonable jury could find that Western Digital’s accused products infringed because SPEX could not point to a single equivalent structure that met interface control device 910, and instead selected various individual components spread out in the accused products’ interfaces that corresponded to other individual components in interface control device 910.

SPEX timely appealed. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

SPEX TECHNOLOGIES, INC. v.
WESTERN DIGITAL CORPORATION

7

II

We review summary judgment decisions under the law of the regional circuit, which in this case is the Ninth Circuit. *Momenta Pharms., Inc. v. Teva Pharms. USA Inc.*, 809 F.3d 610, 614 (Fed. Cir. 2015). The Ninth Circuit reviews the district court’s grant of summary judgment *de novo*. *Blight v. City of Manteca*, 944 F.3d 1061, 1065–66 (9th Cir. 2019). The district court’s decision will be upheld when the non-moving party fails to present evidence of a genuine dispute of material fact. *Nissan Fire & Marine Ins. Co. v. Fritz Cos.*, 210 F.3d 1099, 1103 (9th Cir. 2000).

The issue of whether an accused device infringes under § 112, ¶ 6 as an equivalent is a question of fact. On appeals from grants of summary judgment of noninfringement, “we determine whether, after resolving reasonable factual inferences in favor of the patentee, the district court correctly concluded that no reasonable jury could find infringement.” *Sunovion Pharms., Inc. v. Teva Pharms. USA, Inc.*, 731 F.3d 1271, 1275–76 (Fed. Cir. 2013). “The district court may find the absence of an equivalent where no reasonable jury could have found that the accused device has an equivalent to the disclosed structure.” *Frank’s Casing Crew & Rental Tools, Inc. v. Weatherford Int’l, Inc.*, 389 F.3d 1370, 1378 (Fed. Cir. 2004) (internal quotations omitted).

On issues of claim construction, we review the district court’s claim construction *de novo*, with factual findings based on extrinsic evidence reviewed for substantial evidence. *See Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318, 331–33 (2015). Once we determine whether § 112, ¶ 6 is invoked, we also review a determination that the claim complies with the definiteness requirement under § 112, ¶ 2 *de novo*. *Noah Sys., Inc. v. Intuit Inc.*, 675 F.3d 1302, 1311 (Fed. Cir. 2012).

III

There are two issues on this appeal: whether the district court properly found (1) that there was no genuine dispute of material fact that the accused products did not infringe the “means for mediating” limitation, and (2) that the “means for providing” limitation is indefinite because the ’802 patent’s specification lacks sufficient disclosure clearly linking memory section 612a to the claimed function. We address each in turn.

A

According to SPEX, the district court erred because there was a genuine dispute as to whether Western Digital’s accused products literally infringed the “means for mediating” limitation as equivalents under § 112, ¶ 6 or infringed under the doctrine of equivalents. We disagree with SPEX on both theories. As the district court correctly found, SPEX failed to raise a genuine dispute that any of the accused products had an equivalent overall structure to interface control device 910.

Literal infringement of § 112, ¶ 6 requires that the “relevant structure in the accused device perform the identical function recited in the claim and be identical or equivalent to the corresponding structure in the specification.” *Odetics, Inc. v. Storage Tech. Corp.*, 185 F.3d 1259, 1267 (Fed. Cir. 1999). The assertedly equivalent structure must also perform the same function in substantially the same way to achieve substantially the same result. *Id.* at 1268. The doctrine of equivalents standard is similar but requires that the function, way, and result are substantially similar. *Id.* at 1267. “Because the ‘way’ and ‘result’ prongs are the same under both the section 112, paragraph 6 and doctrine of equivalents tests, a structure failing the section 112, paragraph 6 test under either or both prongs must fail the doctrine of equivalents test for the same reason(s).” *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 1364 (Fed. Cir. 2000).

SPEX TECHNOLOGIES, INC. v.
WESTERN DIGITAL CORPORATION

9

SPEX failed to provide any genuine dispute that the accused products have an equivalent overall structure to interface control device 910. Dr. Rhyne, SPEX’s expert, simply provided a component-by-component analysis for each accused product in which he identified a few physically separate elements throughout the accused products’ complex integrated circuit, and then compared each of those individual components with its allegedly equivalent component in interface control device 910. For instance, in the Gannett system-on-a-chip (“SoC”), which is present in at least one of the accused products, Dr. Rhyne identified components that corresponded to the PCMCIA interface and identified other separate components that corresponded to the Compact Flash Interface in interface control device 910. *See* J.A. 3190–92, ¶¶ 104–110; *see also* J.A. 3217–21, ¶¶ 236–249.² Yet, he never identified an equivalent overall structure; instead, he stated that he “pick[ed] out specific hardware elements within the Gannet SoC rather than the whole thing.” J.A. 2350 at 13:21–24. “The individual components, if any, of an overall structure that corresponds to the claimed function are not claim limitations. Rather, the claim limitation is the overall structure corresponding to the claimed function.” *Odetics*, 185 F.3d at 1268. Thus, his approach to infringement fails to raise any genuine dispute that would allow a reasonable jury to conclude the accused products have an equivalent overall structure.

Dr. Rhyne further failed to explain how the accused products perform the claimed function in substantially the same way to achieve substantially the same result, or why the differences between the accused products and interface

² Citations to “J.A. ___” refer to the joint appendix filed by the parties to this appeal.

control device 910 were insubstantial.³ “The proper test [for determining whether an accused product meets the means-plus-function limitation] is whether the differences between the structure in the accused device and any disclosed in the specification are insubstantial.” *Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus., Inc.*, 145 F.3d 1303, 1309 (Fed. Cir. 1998). For the same reasons above, SPEX also fails to present a genuine dispute under its doctrine of equivalents theory because it could not identify an overall equivalent structure or explain why the differences in the structures were insubstantial. *See Chiuminatta*, 145 F.3d at 1310 (“[A] finding of a lack of literal infringement for lack of equivalent structure under a means-plus-function limitation may preclude a finding of equivalence under the doctrine of equivalents.”).

SPEX’s attorney-annotated diagrams attempt to remedy the flaw in Dr. Rhyne’s testimony by drawing a box around the components it believes form the overall equivalent structure in the accused products. However, this is unavailing as this characterization of the overall equivalent structure is unsupported by Dr. Rhyne’s testimony. It also fails to account for any of the differences between the accused products’ interfaces and interface control device 910 or explain why those differences are insubstantial.

SPEX cites to *Odetics* as support for Dr. Rhyne’s component-by-component analysis, but SPEX misinterprets

³ The integrated circuits in the accused products contain intervening components between the relevant components that are not in interface control device 910. Dr. Rhyne did not address these intervening components in his equivalence analysis. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1346 (Fed. Cir. 2016) (finding that accused products are not equivalent under § 112, ¶ 6 because plaintiff failed to explain how differences between accused product and claims were insubstantial).

SPEX TECHNOLOGIES, INC. v.
WESTERN DIGITAL CORPORATION

11

Odetics. In *Odetics*, the expert had first clearly identified an equivalent overall structure and only then did the expert look to particular components in order to explain why any differences between the equivalent accused product and the claims were insubstantial. 185 F.3d at 1269–70. Indeed, *Odetics* rejected an isolated component-by-component analysis that pays no regard to an equivalent overall structure. *Id.* at 1268 (“The component-by-component analysis used by the district court finds no support in the law.”). For these reasons, we affirm the district court’s grant of summary judgment of noninfringement.

B

We now turn to the district court’s indefiniteness determination. SPEX argues that the ’802 patent sufficiently links memory section 612a as the corresponding structure to the recited function in the “means for providing” limitation. In the alternative, SPEX contends that if the ’802 patent does not recite sufficient structure, then the ’135 patent, which is alleged to be properly incorporated by reference, provides the necessary structure. However, we do not reach the issue of whether the ’135 patent was properly incorporated as we hold that the ’802 patent sufficiently links memory section 612a to the function recited in the “means for providing” limitation.

A structure qualifies as “corresponding structure” if the specification clearly links the structure to the claimed function. *Noah Sys., Inc.*, 675 F.3d at 1311. In order to determine whether the specification adequately links a structure that corresponds to the claimed function, we must look at the disclosure from the perspective of a person of ordinary skill in the art. “Under 35 U.S.C. § 112 ¶ 2 and ¶ 6, a means-plus-function clause is indefinite if a person of ordinary skill in the art would be unable to recognize the structure in the specification and associate it with the corresponding function in the claim.” *AllVoice Computing PLC v. Nuance Commc’ns, Inc.*, 504 F.3d 1236, 1241 (Fed. Cir.

2007). Thus, from the perspective of a person of ordinary skill in the art, the '802 patent's specification must clearly link memory section 612a to the claimed function of (1) providing to the host computing device information regarding the function of the target means in response to (2) a request from the host computing device for information regarding the type of peripheral device. In other words, memory section 612a must both store data regarding the target functionality and provide that data to a host computing device when the host computing device requests information regarding the type of peripheral device it is connected to. The '802 patent's specification clearly discloses this as discussed below.

First, it is clear that memory section 612a is used to store information regarding the target functionality. The specification teaches that memory section 612a stores data referred to as "peripheral device identification data." '802 patent, 8:9–14. The peripheral device "can take a variety of identities," *id.* at 7:43, and can "assume[] the identity of the target functionality," which "enables the host computing device 601 to interact with the peripheral device 602 as though the peripheral device 602 were a device of the type of the target functionality . . . ," *id.* at 8:15–24. The host computing device is able to "identify the type of a peripheral device" that it is connected to by "access[ing] a known memory section of a memory device of the peripheral device" referenced as memory section 612a. *Id.* at 7:62–8:14. Therefore, the specification links memory section 612a because that component is responsible for storing identification data that the host computing device accesses, and one type of identity that the host computing device accesses is the target functionality data. This is further supported by SPEX's expert, Mr. Gomez, who provided the only cited expert testimony and stated that "[a] person having ordinary skill in the art would understand 'peripheral device identification data' to be information identifying the functionality of the 'target means.'" J.A. 983, ¶ 69.

SPEX TECHNOLOGIES, INC. v.
WESTERN DIGITAL CORPORATION

13

Second, it is clear that memory section 612a provides the target functionality identity to the host computer when the host computer requests information about the identity of the peripheral device. As discussed previously, “the host computing device can identify the type of peripheral device” by accessing memory section 612a via “an interface standard developed for that type of peripheral device.” ’802 patent, 8:1–8. One such standard is PCMCIA. Mr. Gomez testified that “in protocols such as PCMCIA . . . the computer asks a connected device to identify itself.” J.A. 983–984, ¶ 70. He further testified that “[m]emory section 612a provides this information by making information about the target means available to the computer.” *Id.* Western Digital does not reference any rebuttal expert testimony or dispute Mr. Gomez’s conclusion as to this portion of the recited function. And the portion of the ’802 patent specification referenced by Mr. Gomez for this aspect of the claimed function is virtually identical to the disclosure in the ’135 patent’s specification, which Western Digital references as an example of sufficient disclosure.⁴ *Compare* ’802 patent, 7:62–8:14 *with* ’135 patent, 10:26–49.

Here, there is a clear footprint in the specification linking memory section 612a to the claimed function, and un-rebutted persuasive testimony from the vantage point of a person of ordinary skill further supporting the sufficiency

⁴ Western Digital contrasts the ’135 patent’s specification with that of the ’802 patent to highlight the alleged deficiencies in the ’802 patent. It asserts that the ’135 patent properly links corresponding structure to the recited function, but none of the cited disclosures unique to the ’135 patent relate to the function of providing the target functionality information in response to a request from a host computing device. Yet Western Digital does not appear to take issue with the ’135 patent’s disclosure linking the structure to this function.

of the disclosure. *See AllVoice*, 504 F.3d at 1246 (holding that the specification contained sufficient structure because the plaintiff's expert provided "the only assessment" on record of the specification's adequacy and the record contained no contradictory evidence). For these reasons, we reverse the district court's finding that the "means for providing" limitation is indefinite and remand the case for the district court to proceed in a manner consistent with this opinion.

IV

For the reasons discussed above, the judgment of the district court regarding summary judgment of noninfringement is affirmed, and the judgment regarding indefiniteness is reversed and remanded for further proceedings consistent with this opinion.

AFFIRMED-IN-PART, REVERSED-IN-PART AND REMANDED

COSTS

No costs.

CERTIFICATE OF SERVICE

I, Frank P. Coté, hereby certify that I caused the foregoing to be filed via the Court's CM/ECF system and served on counsel of record who have registered for such service on June 28, 2021.

/s/ Frank P. Coté
Frank P. Coté

CERTIFICATE OF COMPLIANCE

1. This brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 28. In compliance with Federal Rule of Appellate Procedure 40, this brief contains 3,877 words, excluding the parts of the brief exempted by Federal Circuit Rule 32(b).

2. This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the typestyle requirements of Federal Rule of Appellate Procedure 32(a)(6) because this brief has been prepared in a proportionally spaced typeface using Microsoft Word 2010 in Times New Roman, 14-point font.

/s/ Frank P. Côté
Frank P. Côté