
Case No. 2018-1049

In the
United States Court of Appeals
for the
Federal Circuit

ALFONSO CIOFFI, MELANIE ROZMAN,
MEGAN ROZMAN, MORGAN ROZMAN,
Plaintiffs-Appellees

v.

GOOGLE LLC,
Defendant-Appellant

*Appeal from the United States District Court for the Eastern District of Texas,
Case No. 2:13-cv-00103-JRG · Honorable J. Rodney Gilstrap, Chief Judge*

**COMBINED PETITION FOR PANEL REHEARING
AND REHEARING *EN BANC***

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May 18, 2023



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**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF INTEREST

Case Number 2018-1049

Short Case Caption Cioffi v. Google LLC

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STATEMENT OF COUNSEL

Based on my professional judgment, I believe the Panel decision is contrary to the following precedential decisions of this Court and the Supreme Court of the United States: *In re Muller*, 417 F.2d 1387 (C.C.P.A 1969); *In re Amos*, 953 F.2d 613 (Fed. Cir. 1991); *Revolution Eyewear, Inc. v. Aspex Eyewear, Inc.*, 563 F.3d 1358 (Fed. Cir. 2009); and *U.S. Indus. Chems., Inc. v. Carbide & Carbon Chems. Corp.*, 315 U.S. 668 (1942).

Based on my professional judgment, I also believe this appeal requires an answer to these precedent-setting questions of exceptional importance:

1. What is the proper construction of Section 251’s requirement that, upon certain conditions being met, the Patent Office shall “reissue the patent for the invention disclosed in the original patent”?
2. Does Section 251 permit reissue claims that (1) are narrowed—not broadened—and (2) meet Section 112’s written-description requirement?

Date: May 18, 2023

/s/ Eric Benisek
Eric Benisek

INTRODUCTION

This case should be reheard by the Panel or the full Court. This Petition concerns the correct construction of Section 251’s requirement that reissue claims be “for the invention disclosed in the original patent,” a provision that this Court has long-held is analogous to Section 112’s written-description requirement.

In this case, it was undisputed that the original patent disclosed a genus (a “logical process”) and a sub-genus (an “interactive network process”) and that the reissue claims were drawn to a species (a “web browser process”). The patent also identified the web-browser species (one of only three identified “interactive network processes” and one of only six identified “logical processes”), and there was no question that the reissue claims had written-description support under Section 112. The Defendant did not even raise a written-description challenge at trial. On this record, the District Court entered judgment (after a jury trial and bench trial) of validity and infringement and awarded the individual inventors¹ that brought this case \$20,000,000 in past damages.

The Panel Opinion reversed and invalidated the claims. To reach that conclusion, it applied a new heightened standard for “the invention disclosed in the original patent” that conflicts with Section 251 and how this Court has construed it.

¹ Because one of the inventors (Allen Rozman) passed away, the plaintiffs include his three daughters.

The Panel Opinion invalidated the claims because the exact words “web browser process” did not appear in the specification and the evidence did not show that “the terms ‘interactive network process’ and ‘web browser process’ are synonymous or otherwise equivalent in meaning.” Op. at 11. The Opinion labeled the patent’s express disclosure as a series of impermissible “inferences” that could be ignored in the analysis, even though such “inferences” are ones that “might well be drawn by a skilled artisan” after reading the original patent. *Id.* at 14.

This standard—requiring, in substance, word-for-word disclosure—conflicts with the statute (which only requires the invention be “disclosed”). It conflicts with this Court’s original-patent precedent (which only requires that a skilled artisan would “identify the subject matter of the new claims as invented and disclosed by the patentees”).² And it conflicts with established written-description law that disclosing a small genus discloses each species within that genus—especially when the patent expressly identifies the species.³ And even though the Opinion is

² *Revolution Eyewear*, 563 F.3d at 1367 (quoting *Amos*, 953 F.2d at 618).

³ See, e.g., *Bos. Sci. Corp. v. Johnson & Johnson*, 647 F.3d 1353, 1367–68 (Fed. Cir. 2011) (explaining that, even when the specification does not identify a claimed species or sub-genus, the specification has adequate written-description support if it discloses “blaze marks”); see also *Bristol-Myers Squibb Co. v. Ben Venue Lab’ys, Inc.*, 246 F.3d 1368, 1380 (Fed. Cir. 2001) (“[T]he disclosure of a small genus may anticipate the species of that genus even if the species are not themselves recited.”); see also <https://www.jdsupra.com/legalnews/original-patent-vs-written-description-28015> and <https://www.vklaw.com/ImagineThatIPLawBlog/potential-issue-with->

designated as non-precedential, it will impact future cases. Commentators have already noted that the case imposes a heightened standard.⁴

The correct construction of Section 251 is vitally important to the patent system because it impacts the reissue process, a valuable tool for inventors to correct errors. Because of the investment required for the process, reissue patents cover valuable inventions. And the process disproportionately benefits individual inventors—like the patentees here—who lack the resources to build a portfolio of co-pending applications that cover each facet of the invention (and are not subject to a heightened original-patent requirement).

The Panel Opinion, however, effectively forecloses the reissue process for genus-species claims and invalidates countless patents—despite those patents meeting each condition of patentability. And because reissue requires surrender of the original patent, the Panel Opinion leaves inventors with no patent rights—even though the invention is novel, non-obvious, and fully described in the specification. For these reasons, Cioffi respectfully requests the Court rehear this case and reinstate the judgment of the District Court.

reissue-patents (both commentators noting the conflict between the Court’s original patent and written description standard for broadening reissue claims).

⁴ *See, e.g.*, 4 Annotated Patent Digest § 25:34 (citing Panel Opinion as reflecting that “[t]he standard is high” to survive an original-patent challenge).

BACKGROUND

I. The Invention

The four reissue claims require two “web browser processes.” The original patent disclosed “logical processes” of which the patent identified six varieties: electronic mail, instant messaging, internet browser, interactive gaming, virtual private network, and a reader application. Appx110. The patent also disclosed an “interactive network process,” and the patent identified three types of such processes: gaming, instant messaging, and web browsing. Op. 5-6, 12-13.

The original patent claims required two processors and two “logical processes.” Appx110-111. The inventors (Mr. Cioffi and Mr. Rozman) prosecuted the patent application on their own behalf and did not hire counsel. Later, the inventors sought reissue and narrowed the claims from a “logical process” to a “web browsing process.” Appx15, Appx20. For two of the asserted claims, the reissue claims do not require two processors and could be implemented on one processor (claim 67 of the ’528 Patent and claim 43 of the ’500 Patent). In that sense, the reissue applications were broadening reissues for these two claims. The other two claims, however, still required at least two processors and, in substance, were only narrowed.

II. The District Court Proceedings And The Prior Appeal

Cioffi brought suit against Google in 2013, alleging that Google Chrome infringed the asserted reissue claims. The District Court initially construed the term

“web browser process” as requiring a direct connection to the network, which resulted in Cioffi stipulating to a judgment of noninfringement. This Court reversed, concluding that the term did not have the direct access capability requirement. *Cioffi v. Google, Inc.*, 632 F. App’x 1013, 1021–22 (Fed. Cir. 2015) (“*Cioffi I*”).

Notably, in describing the patent’s teachings regarding “logical processes,” the *Cioffi I* Court recognized that a “web browser process” was a predominant species of the broader term. It explained that the specification “describe[s] computer processes, separated . . . into first and second browser processes” and that Figure 1 (which refers to “logical processes”) illustrates “a first web browser process executed within first processor 120 . . . [and] a second web browser process executed within second processor 140[.]” *Cioffi I*, 632 F. App’x at 1014–15.

On remand, the District Court held a trial and Cioffi prevailed. The jury found that the reissue claims were valid and infringed and awarded past damages. In a bench trial following the verdict, the District Court rejected Google’s Section 251 defense because it was undisputed that a web browser process was a species of a “logical process” and a “interactive network process” and the Patent described the “interactive network process” architecture in sufficient detail. Appx47-52.

In finding Google did not meet its burden of clear-and-convincing evidence that two web browser processes were not properly disclosed, the District Court relied on the following facts:

- The “interactive network process” embodiment was expressly not limited to an online gaming process, but instead made clear online gaming was just one example. Appx48.⁵
- That “interactive network process status data” disclosed in Figure 6 and Column 14 was likewise not limited to “game status data,” and was again just one example where earlier in the specification it discloses “gaming, messaging, and browsing” as interactive applications that are the subject of the invention. Appx49. The District Court further noted the “interactive network process” embodiment disclosed P1 120 connecting to the “network,” which is defined in the specification as “Internet, a LAN, WAN, VPN, etc.” Appx49.
- That Plaintiffs’ expert, Dr. Dunsmore, testified credibly that a person of skill in the art would recognize that (1) “interactive network process” encompasses web browser processes, and (2) “interactive network process status data” encompasses “website data” and thus Figure 6 and Column 14 discloses the use of two web browser processes. Appx52.
- Google conceded “web browser processes” are a narrower subspecies of “logical processes” and Google’s invalidity expert went so far as to call the ’247 Patent’s “first logical process” the “same as the first web browser process.” Appx52.

The Court also found that Google’s arguments were contradictory:

Google contends that the ’247 Patent specification does not clearly disclose a first “web browser process” for purposes of the original patent requirement because the specification’s disclosure of a first “logical process” is not specific enough and that “logical processes” could refer to a number of different software processes besides “web browser processes.” However, when alleging improper recapture, Google contends that the patents’ “first logical process” includes a process that “could ‘access website data,’” which is the precise

⁵ While the District Court did not need to make this point, it is well known and uncontested that in 2004 online games were also played through web browsers. As noted in Appellee’s opening brief, the idea for the invention came to Cioffi from his son repeatedly crashing the family computer from playing online games through Internet Explorer in 2004.

definition of a “web browser process.” If a person of ordinary skill would recognize that the ’247 Patent specification’s disclosure of a “first logical process” encompasses a “web browser process,” then narrowing the disclosed “logical process” to directly claim a known subspecies (i.e., the “web browser process” of the Asserted Claims) is clearly and unequivocally within the scope of the original invention disclosed in the ’247 Patent specification.

Appx53 (internal citations omitted).

III. The Panel Decision

The Panel reversed. The Panel Opinion accepted that the District Court’s findings that the use of two web browser processes were encompassed within the scope of the expressly disclosed “interactive network process” embodiment. Op. 12. But the Opinion concluded that this disclosure was insufficient because the exact words “web browser process” did not appear in the specification and the evidence did not show that “the terms ‘interactive network process’ and ‘web browser process’ are synonymous or otherwise equivalent in meaning.” *Id.* at 11.

ARGUMENT

I. Panel Rehearing Is Appropriate

Cioffi submits that panel rehearing is appropriate for the following reasons.

A. The Opinion Adopted An Overly-Strict Original-Patent Test

1. The Opinion’s Word-For-Word Test Conflicts With Settled Authority

The Panel Opinion first applied a word-for-word test that conflicts with *Amos* and *Revolution Eyewear*. Under those cases, courts “examine the entirety of the

original disclosure and decide whether, through the ‘objective eyes’ of the hypothetical person having ordinary skill in the art, an inventor could fairly have claimed the newly submitted subject matter in the original application[.]” *Amos*, 953 F.2d at 618. “The essential inquiry for the ‘original patent’ requirement is ‘whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees.’” *Revolution Eyewear*, 563 F.3d at 1367 (quoting *Amos*, 953 F.2d at 618). This inquiry “is analogous to the analysis required by § 112 ¶ 1.” *Id.* (quoting *Amos*, 953 F.2d at 618). And this established test pre-dates the formation of this Court. *See Amos*, 953 F.2d at 618 (citing *In re Rowand*, 526 F.2d 558 (C.C.P.A 1975) and *In re Mead*, 581 F.2d 251 (C.C.P.A 1978)). Under this inquiry, the claims survive Defendant’s challenge (indeed, Defendant did not contest written-description at trial).

The Panel Opinion, however, did not apply this established test. The Opinion instead relied on this Court’s 2014 *Antares* decision, which states that “the specification must clearly and unequivocally disclose the newly claimed invention as a separate invention.” *Antares Pharma, Inc. v. Medac Pharma Inc.*, 771 F.3d 1354, 1362 (Fed. Cir. 2014). But the Panel Opinion’s heightened standard goes beyond what even *Antares* requires. *Antares* does not require a word-for-word disclosure, and the case does not preclude a disclosed genus supporting reissue claims that narrow the claims to an identified species. And to the extent *Antares* and

Amos and *Revolution Eyewear* conflict, the prior decisions control. *Deckers Corp. v. United States*, 752 F.3d 949, 959 (Fed. Cir. 2014) (“[A] later panel is bound by the determinations of a prior panel, unless relieved of that obligation by an *en banc* order of the court or a decision of the Supreme Court.”).

2. ***Antares* Does Not Apply Because The Reissue Claims Are Narrower The Web-Browser-Process Limitations**

As a separate ground for rehearing, the Panel Opinion overlooked that the four asserted reissue claims narrowed from a “logical process” to a “web browser process.” *Antares* applies to the opposite situation—when a patentee broadens the claims by removing a limitation that the specification described as an integral part of the invention. *Antares*, 771 F.3d at 1362 (invalidating claims that removed a “jet injector” limitation where “[t]he specification discussed only one invention: a particular class of jet injectors”); *see also Forum US, Inc. v. Flow Valve, LLC*, 926 F.3d 1346, 1352 (Fed. Cir. 2019) (invalidating claims under *Antares* that removed an “arbor” limitation where it was undisputed that the patent did not “disclose an arbor-less embodiment of the invention” and the specification did not disclose that “arbors are an optional feature of the invention”).

It is true that claims 67 and 43 are technically broadening reissues, but they were broadened in a way unrelated to their challenge under original patent. That is because the original claims required two processors, while claims 67 and 43 removed the two processor limitation. But asserted claim 5 of the ’528 Patent and

49 of the '529 Patent retain the two-processor limitation: the only meaningful change in reissue was narrowing from logical processes to web-browser processes. In sum, the challenged aspect of all four asserted claims related to a narrowing, and two of the claims were purely narrowing. *Antares* does not apply in this circumstance.

As the Opinion notes, the *Antares*-line of cases originate from authority that predates the 1952 Patent Act and focused on the legal test to support “new and broader claims in a reissue.” Op. 9 (quoting *Corbin Cabinet Lock Co. v. Eagle Lock Co.*, 150 U.S. 38, 42–43 (1893)); *see also* 4A Chisum on Patents § 15.02 (explaining that the Supreme Court in the 1800s strictly applied the “same invention” to police patentees improperly enlarging the scope of their claims).

Antares ultimately relies on the Supreme Court’s *Industrial Chemicals* recitation of the “same invention” test, which focused on if “the broader claims in the reissue are not merely suggested or indicated in the original specification but constitute parts or portions of the invention which were intended or sought to be covered or secured by the original patent.” *U.S. Indus. Chemicals v. Carbide & Carbon Chemicals Corp.*, 315 U.S. at 676 (1942) (citing *Corbin*, 150 U.S. at 42) (emphasis added). But *Antares* ratcheted up that test to require that “the specification must clearly and unequivocally disclose the newly claimed invention as a separate invention.” *Antares*, 771 F.3d at 1362 (Fed. Cir. 2014). That standard

is not recited in *Industrial Chemicals*. And the Panel Opinion went even further, raising the *Antares* bar to require, in substance, word-for-word disclosure.

The Panel Opinion need not have traveled down this road at all. The line of cases that resulted in *Antares* were all directed at reissue claims that eliminated an essential limitation and thus enlarged the scope of the reissue claims. In contrast, the challenged aspect of the asserted reissue claims was a narrowing from “logical process” to “web browser process.” And in particular, claims 5 and 49 were purely narrowed because the claims retained the two-processor limitation. This Court has never applied the *Industrial Chemicals* standard (including as heightened by *Antares*) to reissue claims that narrowed the challenged limitations. *Cf. Forum*, 926 F.3d at 1351 (reciting *Antares* and *U.S. Industrial Chemical* standards as applying to “broadening reissue claims”). The Court instead has applied the written-description-type of analysis laid out above. And the asserted claims undisputedly meet that test.

B. The Opinion Overlooked That The Patent Expressly Discloses Two Web Browser Processes

Cioffi also respectfully submits that the Panel Opinion also overlooked that the original patent expressly discloses two web-browser processes that satisfied the original-patent test, whether under *Amos* or *Antares*.

The Patent describes an embodiment with two interactive network processes, which is a sub-genus of a logical process. The Patent identified three types of interactive network processes: gaming, instant messaging, and web browsing. This

was an express disclosure of all three species. While the Patent further expounded on the online gaming example in Figure 6 and column 14, that was not at the exclusion of web browsing.

The Opinion labels the patent's disclosure as requiring a series of "inferences" and recognizes that these "are ones that might well be drawn by a skilled artisan after reading the '247 patent." Op. at 14. But the "inferences" referred to by the Opinion are disclosures in the Patent—and linking up related passages in the specification does not run afoul of the original-patent rule. And it has long been law that disclosing a small genus is a sufficient disclosure of each member species.

The Court encountered a similar situation in *In re Muller*. There, the Court upheld the validity of narrowed reissue claims that related to using (1) a filtering body depicted in one figure and (2) a filter material depicted in different figure. 417 F.2d 1387, 1390 (C.C.P.A 1969). The Court reached this result because the law did not require that "every feature recited in a claim must appear in a single figure of the drawing" and it was unnecessary for the applicant to illustrate each body with disclosed material "since it is clear how it could be done." *Id.*

Similarly, it is undisputed that the specification does not limit the "interactive network process" embodiment to "online gaming." Instead, like *Muller*, the non-limiting disclosure of an "interactive network process" acts as "a direction to persons skilled in the art to use any of the disclosed forms" of interactive network processes,

including web-browser processes. *Muller*, 417 F.3d at 1390. There is no requirement under *Muller* (or *Antares*) that Cioffi needed to repeat each example “interactive network process”—one for gaming, one for messaging, and one for web browsing—to satisfy the original-patent doctrine. That cannot be the law, and the outcome here conflicts with *Muller* and established genus-species case law.

II. The Court Should Rehear This Case *En Banc*

Cioffi also respectfully requests that the Court rehear this case *en banc*. Section 251 explains that the reissue claims must be for the “invention disclosed in the original patent.” As detailed above, this Court had a written-description-type standard for the doctrine for over 50 years. That standard harmonized the doctrine with the other portions of the 1952 Patent Act, which also use the terms “disclosure” or “description.” Then, in 2014, this Court’s *Antares* decision upset that balance by creating a new “clear and unequivocal disclosure” test for broadening reissues based on inferences from Supreme Court doctrine that pre-dated the 1952 Act. The Panel Opinion then took *Antares* even further, requiring word-for-word disclosure, and applied to claims that were narrowed in relevant respect.

The result is now an exacting standard to meet Section 251. That standard does not further progress of science and the useful arts: the reissue patents it invalidates are new, nonobvious, and adequately described. It does not protect a legitimate interest of the interested public—any company that might infringe a

patent whose scope has changed during reissue is protected by intervening rights. *See* 35 U.S.C. § 252(b). And it conflicts with this Court’s construction of other portions of the Patent Act.

For example, the analogous provision in Section 112 requires the specification to “contain a written description of the invention.” This Court’s cases hold that disclosure of a genus can provide written-description support for a species—even if the species is not disclosed in the specification. *See, e.g., Fujikawa*, 93 F.3d at 1571 (describing “blazemarks” analysis for written description). The Panel Opinion, however, held the opposite when it invalidated these claims under Section 251.

Similarly, Section 102 anticipation applies if the claimed invention was “described” in a prior art reference. And this Court’s cases hold that a reference’s “disclosure of a small genus can be a disclosure of each species within the genus,” even if the claimed species is not specifically disclosed in the reference. *See, e.g., Ineos USA LLC v. Berry Plastics Corp.*, 783 F.3d 865, 872 (Fed. Cir. 2015). And such disclosure of a small genus can be clear-and-convincing evidence for each species. *See id.* The Panel Opinion, again, holds the opposite: disclosure of a small genus has no legal relevance—even if the Patent also identifies the claimed species. *En banc* rehearing of this case is appropriate to correctly construe Section 251 and harmonize it with the other sections of Title 35.

The proper construction of a statute is generally important, but the construction of the original-patent requirement Section 251 is particularly important. The Panel Opinion's heightened standard calls into question the validity of countless reissue patents that otherwise meet the conditions of patentability. In this case, for example, it was undisputed on appeal that the invention claimed on reissue was novel and nonobvious and that the specification described the invention in sufficient detail. But the Panel Opinion invalidated the claims—and voided a jury verdict—because the inventors did not use the exact right words to describe their invention claimed on reissue. That type of result will apply in other cases if the Panel Opinion remains unreviewed. And it will devalue the patent system through a defense untethered to the substantive requirements to obtain a patent.

This case is also an appropriate vehicle to address the construction of Section 251. There are few cases from this Court addressing the original-patent doctrine, and there are no cases (to Cioffi's knowledge) that address the doctrine in the context of claims that were narrowed in the relevant respect. This decision, while non-precedential, raises the standard for the original-patent doctrine to a point that few reissue patents can meet—especially where the patentee has narrowed the claims in relevant respects from a disclosed genus to a particular species. This case is thus the appropriate vehicle to consider the standard for the original-patent doctrine.

CONCLUSION

The Court should grant the petition for rehearing or rehearing *en banc*.

Respectfully submitted this 18th day May 2023.

VASQUEZ BENISEK & LINDGREN LLP

/s/ Eric Benisek
Eric Benisek
Robert McArthur

-- and --

THE DAVIS FIRM, PC

Christian Hurt
William E. Davis

Counsel for Appellees

FORM 19. Certificate of Compliance with Type-Volume Limitations

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July 2020

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

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Case Number: 2018-1049

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Date: 05/18/2023

Signature: /s/ Eric Benisek

Name: Eric Benisek

ADDENDUM

NOTE: This disposition is nonprecedential.

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

**ALFONSO CIOFFI, MELANIE ROZMAN, MEGAN
ROZMAN, MORGAN ROZMAN,**
Plaintiffs-Appellees

v.

GOOGLE LLC,
Defendant-Appellant

2018-1049

Appeal from the United States District Court for the
Eastern District of Texas in No. 2:13-cv-00103-JRG, Chief
Judge J. Rodney Gilstrap.

Decided: April 18, 2023

CHRISTIAN JOHN HURT, The Davis Firm, PC, Longview,
TX, argued for plaintiffs-appellees. Also represented by
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SIMMONS, DARIN W. SNYDER, O'Melveny & Myers LLP, San Francisco, CA.

Before REYNA, BRYSON, and TARANTO, *Circuit Judges*.

BRYSON, *Circuit Judge*.

The plaintiffs-appellees (collectively, “Cioffi”) brought this patent infringement action against defendant-appellant Google LLC, alleging infringement of a total of four claims across three patents. Following a trial, the jury found the asserted claims to be infringed and not invalid. The district court then addressed the question whether the asserted claims were invalid under 35 U.S.C. § 251 and held that they were not. We reverse the district court’s determination that the claims were not invalid.

I

A

Cioffi asserted four patent claims against Google in this case: claim 43 of U.S. Patent No. RE43,500 (“the ’500 patent”); claims 5 and 67 of U.S. Patent No. RE43,528 (“the ’528 patent”); and claim 49 of U.S. Patent No. RE43,529 (“the ’529 patent”). Each of the asserted patents is a reissue patent of U.S. Patent No. 7,484,247 (“the ’247 patent”).

The asserted patents and the ’247 patent are all directed to the use of multiple processors or processes in a computer system to prevent malware obtained over a network from accessing certain data stored on the computer. As the specification of the ’247 patent explains, prior art computer systems would frequently run “a known and trusted set of programs” concurrently with an “Internet browser” and other programs such as “Java applets[] or EXE/COM executables.” ’247 patent, col. 4, ll. 60–65. Those latter programs, the specification notes, could “possibly contain[] malware.” *Id.* at col. 4, ll. 65–66. When the known and trusted programs share memory and resources

with programs that may contain malware, the malware may be “capable of corrupting critical files on the shared memory storage medium.” *Id.* at col. 6, ll. 56–64.

To address that problem, the ’247 patent discloses “a means of isolating the network interface program [e.g., a web browser] from the main computer system such that the network interface program does not share a common memory storage area with other programs.” *Id.* at col. 7, ll. 1–4. In such a system, the specification explains, “malware programs are rendered unable to automatically corrupt critical system and user files located on the main memory storage area.” *Id.* at col. 7, ll. 9–11.

For purposes of this appeal, claim 49 of the ’529 patent is generally representative of the asserted claims. Claim 49 depends from claim 36 of the ’529 patent. Those claims recite:

36. A method of operating a portable computer based system employing a common operating system and configured with a first memory space and a second protected memory space and at least one electronic data processor, comprising:

storing at least one system file within the first memory space;

downloading website content potentially containing malware from a network of one or more computers using a secure web browser process, wherein the secure web browser process is configured to execute on the at least one electronic data processor, and comprises a first web browser process and at least one second protected web browser process, the first web browser process and the at least one second protected web browser process being configured to access the website content via the network of one or more computers;

executing instructions in the first web browser process, wherein the first web browser process is configured to access data contained in the first memory space and to initialize the at least one second protected web browser process;

passing data from the first web browser process to the at least one second protected web browser process;

executing instructions in the at least one second protected web browser process, wherein the at least one second protected web browser process is configured to access data contained in the second protected memory space and to execute instructions from the downloaded website content, wherein the downloaded website content is capable of accessing the second protected memory space but is denied access to the first memory space;

displaying digital content generated by the secure web browser process;

wherein the secure web browser process is configured such that the at least one system file residing on the first memory space is protected from corruption by website content potentially containing malware downloaded from the network and executing as part of the at least one second protected web browser process.

* * *

49. The method of claim 36 further comprising:

executing instructions from the first web browser process on a first core of a multi-core processor; and

executing instructions from the at least one second protected web browser process on a second core of the multi-core processor.

'529 patent, claims 36, 49. The asserted claims of the '500 and '528 patents are similar, although claim 43 of the '500 patent and claim 67 of the '528 patent recite a “computer program product” configured to perform certain steps rather than a method of operating a computer system.

The specification of the '247 patent discloses several embodiments that are relevant to this appeal. Figure 1 of the '247 patent depicts a computer system that contains a first processor (“P1”), a first memory (“M1”), a second processor (“P2”), and a second memory (“M2”). '247 patent, col. 9, ll. 30–47; *id.* at col. 10, ll. 29–37; *id.* at Fig. 1. In that embodiment, P1 can access the data stored in M1 and M2, while P2 can access only the data stored in M2. *Id.* at col. 10, ll. 43–58. Additionally, only P2 is used to access the network. *See id.* at col. 10, ll. 29–31. That arrangement has the effect of “isolat[ing]” P1 and M1 from the network such that malware may not “initiat[e] unwanted intrusions on [P1].” *Id.* at col. 10, ll. 40–43.

Figure 2 of the '247 patent depicts a “process flow” according to which the system of Figure 1 operates. *Id.* at col. 10, ll. 64–66. In that embodiment, a user may open a “protected process,” such as a web browser program, that executes on P2. *Id.* at col. 11, ll. 2–11. Meanwhile, P1 “receives user interface data,” such as keystrokes, from a user and passes that data to P2 when the protected process is active. *Id.* at col. 11, ll. 17–22. P2 then generates “video data” from the protected process and passes that data to a “video processor,” which is separate from P1 and P2. *Id.* at col. 11, ll. 27–29; *id.* at Fig. 1. The video processor then “interleaves” video data from the processes being executed on P1 and P2 and transmits that data to a “video display.” *Id.* at col. 11, ll. 29–33.

Figure 6 of the '247 patent depicts another exemplary process flow for the system shown in Figure 1. In that embodiment, the computer system carries out “an interactive network process, such as online gaming.” *Id.* at col. 14, ll.

28–31. The user “initiates an interactive network process” via P2, and P2 “receives interactive network process status data from [the] network.” *Id.* at col. 14, ll. 31–34. Next, P2 “informs [P1] that interactive network process status data is available.” *Id.* at col. 14, ll. 34–36. P1 then “retrieves interactive network process status data from P2” and uses that data “to update the interactive network process and update [the] video display.” *Id.* at col. 14, ll. 36–39. After that, P1 “passes the updated interactive network process status data to P2,” which sends that data to the network. *Id.* at col. 14, ll. 39–42. The specification adds that P1 may be configured to accept only “game status information in the proper format, thereby minimizing the chance” that malware may be loaded onto P1 or M1. *Id.* at col. 14, ll. 50–54.

Figure 9 of the ’247 patent discloses a different configuration of the computer system that is described in the specification of that patent. *Id.* at col. 16, ll. 6–8. In that configuration, the computer system contains a single processor that comprises “multiple processor cores.” *Id.* at col. 16, ll. 8–12. Alternatively, the specification explains, the functions carried out by the two processors “may comprise separate, secure logical processes executing on the same physical processor.” *Id.* at col. 16, ll. 22–24. In such a configuration, the first logical process “may comprise executing instructions necessary to carry out the functions of an operating system,” or a computer program, “including but not limited to a word processor.” *Id.* at col. 16, ll. 24–30. The second logical process “may comprise executing instructions necessary to carry out the functions of a web browser program . . . [or] an instant messenger program.” *Id.* at col. 16, ll. 30–34.

B

This case has come to this court before. After the claim construction proceedings, the district court held one of the claims that is no longer at issue in the case to be indefinite,

and the parties stipulated to a judgment of non-infringement of the other asserted claims. *Cioffi v. Google, Inc.*, 632 F. App'x 1013, 1014 (Fed. Cir. 2015). In the appeal from that judgment, we reversed the district court's construction of two claim terms and remanded for further proceedings. *Id.* As relevant to this appeal, we construed the term "web browser process" to mean a "process that can access data on websites" either directly or indirectly. *Id.* at 1018–22.

C

At the trial on remand, Google argued that the asserted claims were invalid under 35 U.S.C. § 251 because the subject matter of the reissue claims was not disclosed in the original patent (in violation of the "original patent" requirement) and reclaimed subject matter surrendered during prosecution of the original patent (in violation of the "rule against recapture"). The jury found that the asserted claims were infringed and not invalid. J.A. 3922–23. Google moved for judgment as a matter of law on several issues, including non-infringement and invalidity under section 251. J.A. 3905, 3909.

After reviewing Google's post-trial submissions, the district court determined that the issue of invalidity under section 251 was for the court to decide instead of the jury. J.A. 5634–42. The court then entered an order rejecting Google's arguments on that issue, concluding that Google had failed to prove by clear and convincing evidence that the asserted claims were invalid under section 251. J.A. 70.

Google argued that the asserted claims did not satisfy the original patent requirement because the specification of the '247 patent did not clearly and unequivocally disclose an embodiment containing two "web browser processes," as recited in the asserted claims. J.A. 3913–14. The district court disagreed, finding that the disclosure of an embodiment containing "interactive network processes" in the

specification constituted a clear and unequivocal disclosure of two web browser processes. J.A. 54. In particular, the district court relied on the testimony of Dr. Hubert Dunsmore, Cioffi's expert, who explained that "those skilled in the art reading Column 14 [of the '247 patent specification] would understand that P1 and P2 can refer to two processes, both of which are accessing data from the Internet, which thus meets the Court's construction of 'web browser process.'" J.A. 21.

The district court also held that Google had not shown that the asserted claims violated the rule against recapture. J.A. 70. In a subsequent order, the court denied the remainder of Google's motion for judgment as a matter of law, including on the issue of non-infringement. J.A. 72–88. This appeal followed.

II

Google argues that the district court erred in holding that the asserted claims were not invalid under the original patent requirement and the rule against recapture. Google also argues that the district court erred in denying its motion for judgment as a matter of law that Google did not infringe the asserted claims. Because we conclude that the asserted claims are invalid under the original patent requirement, we reach only that issue.

A district court's determination of validity under 35 U.S.C. § 251 is a question of law that we review de novo. *Forum US, Inc. v. Flow Valve, LLC*, 926 F.3d 1346, 1350–51 (Fed. Cir. 2019). The legal conclusion regarding compliance with section 251, however, "can involve underlying questions of fact." *Id.* at 1351. For that reason, the court "may consider expert 'evidence to ascertain the meaning of a technical or scientific term or term of art so that the court may be aided in understanding not what the instruments mean but what they actually say.'" *Id.* (quoting *U.S. Indus. Chems. v. Carbide & Carbon Chems. Corp.*, 315 U.S. 668, 678 (1942)).

In 1893, the Supreme Court explained in *Corbin Cabinet Lock Co. v. Eagle Lock Co.*, 150 U.S. 38, 42–43 (1893), that “to warrant new and broader claims in a reissue, such claims must not be merely suggested or indicated” in the original patent, “but it must further appear from the original patent that they constitute parts or portions of the invention, which were intended or sought to be covered or secured by such original patent.” In *Industrial Chemicals*, the Court expanded on that standard by noting that “[i]t must appear from the face of the instrument that was it covered by the reissue was intended to have been covered and secured by the original.” 315 U.S. at 676. The Court’s decision in *Industrial Chemicals* interpreted 35 U.S.C. § 64, which provided that reissue patents could be issued only for “the same invention.” *Id.* at 670 n.3 (quoting 35 U.S.C. § 64 (1934)). That requirement was referred to as the “same invention” requirement. *Forum*, 926 F.3d at 1351.

In 1952, Congress amended the Patent Act to replace the phrase “the same invention” from section 64 with “the original patent.” *Id.*; 35 U.S.C. § 251 (1952). The statutory language embodying the original patent requirement currently provides that the Director of the United States Patent and Trademark Office may grant a reissue patent “for the invention disclosed in the original patent.” 35 U.S.C. § 251(a) (2012).

Despite the change in statutory language enacted by Congress after the Supreme Court’s decision in *Industrial Chemicals*, courts have continued to apply the principles of *Industrial Chemicals* when evaluating whether a reissue claim satisfies the original patent requirement. *Antares Pharma, Inc. v. Medac Pharma Inc.*, 771 F.3d 1354, 1360–61 (Fed. Cir. 2014) (collecting cases). In our recent cases addressing the original patent requirement, we have held that in order to satisfy the original patent requirement, the invention claimed on reissue must be “more than merely suggest[ed] or indicat[ed]” by the specification of the

original patent. *Forum*, 926 F.3d at 1351; *see also Antares*, 771 F.3d at 1362. Instead, we have explained, the specification of the original patent “must clearly and unequivocally disclose the newly claimed invention as a separate invention.” *Antares*, 771 F.3d at 1362; *Forum*, 926 F.3d at 1352. That is, we have interpreted the original patent requirement to require that “the exact embodiment claimed on reissue [be] expressly disclosed in the specification.” *Antares*, 771 F.3d at 1363.

Google argues that the original patent requirement is not satisfied because there is no clear and unequivocal disclosure in the ’247 patent of an embodiment that comprises two web browser processes. Cioffi responds that the original patent requirement is satisfied because the embodiment disclosed in Figure 6 and column 14 of the ’247 patent represents a clear and unequivocal disclosure of an embodiment having two web browser processes. As noted above, the embodiment depicted in Figure 6 contains an “interactive network process” that includes an exchange of “interactive network process status data” between P2 and P1. ’247 patent, col. 14, ll. 28–45.

As Cioffi acknowledges, the specification of the ’247 patent does not use the claim term “web browser process.” Appellees’ Br. 24. Nonetheless, Cioffi argues that “web browsing is clearly within the scope and definition of ‘interactive applications’ and thus the ‘interactive network process’ disclosed in Figure 6.” *Id.* at 30. The district court accepted that general argument, holding that “the ’247 Patent specification’s ‘interactive network processes’ embodiment encompasses the dual-web-browser process limitations set forth in the Asserted Claims.” J.A. 54. In support of its holding, the district court relied on the testimony of Dr. Dunsmore, who testified, in relevant part, as follows:

Q: Professor Dunsmore, let’s move to [Google’s expert’s] second argument. Do you agree with

[Google's expert] that the specification does not disclose the use of two web browser processes?

A: No, I do not.

Q: Okay. . . . So, Professor Dunsmore, directing your attention to Column 14, Lines 28 through 45, why do you disagree with [Google's expert] that there is -- why do you disagree with his position that there is no disclosure of using two web browser processes?

A: I disagree because of the things that are in -- highlighted here. Here we have two processors, P1 and P2. And both of them are retrieving data from the network, and that's exactly what needs to be done by the processes of a web browser.

Q: And does P1 and P2 accessing website data meet the definition -- the Court's definition of what a web browser process is?

A: Yes, it does.

Q: So, in your opinion, Professor Dunsmore, does the [247] patent specification adequately disclose use of -- or does it adequately disclose use of a first and second web browser process?

A: Yes.

J.A. 5044–45.

Dr. Dunsmore's testimony essentially amounts to an assertion that a web browser process is a type of interactive network process because both processes "retriev[e] data from the network." J.A. 5045. He did not state, however, that the terms "interactive network process" and "web browser process" are synonymous or otherwise equivalent in meaning. Thus, Dr. Dunsmore's testimony serves to "assert[] what a person of ordinary skill in the art would purportedly understand" from the specification rather than

what is apparent “*from the face of the instrument.*” See *Forum*, 926 F.3d at 1351–52 (citation omitted). As we explained in *Forum*, testimony directed to the former point “is insufficient to comply with the standard set forth in *Industrial Chemicals* and *Antares*.” *Id.* at 1352.

The district court characterized Dr. Dunsmore’s testimony as explaining what the disclosures in the ’247 patent specification would “convey to a person of ordinary skill in the art.” J.A. 52. The court further noted that Dr. Dunsmore’s testimony established (1) that the term “‘interactive network process’ encompasses web browser processes,” and (2) that the term “‘interactive network process status data’ encompasses ‘website data.’” *Id.* But that falls short of showing that the specification of the ’247 patent clearly and unequivocally discloses, on its face, the use of two web browser processes. Instead, it reflects a conclusion that a skilled artisan would be able to infer that the ’247 patent specification discloses an embodiment that “encompasses” the use of two web browser processes. J.A. 54; see also J.A. 53. Under the standard applied by the district court, a disclosure of a broad embodiment in the original patent specification would represent a clear and unequivocal disclosure of a narrow embodiment that was not expressly described in the specification, as long as the narrow embodiment was nevertheless encompassed by the broad disclosure. That standard is more lenient than the one we have adopted in our cases applying the original patent requirement.

Turning to the ’247 patent specification itself, there are three related inferences that a skilled artisan would need to draw from the Figure 6 embodiment to arrive at the embodiments recited in the asserted claims. First, a skilled artisan would have to conclude that an “interactive network process,” as described in column 14 of the specification, includes web browsing. It is true that in the “Background” section, the specification states that “many applications[,] such a[s] gaming, messaging, and browsing”

may have an “interactive nature.” ’247 patent, col. 6, ll. 17–18. In the opening discussion of the Figure 6 embodiment, however, the only “interactive network process” that is expressly disclosed is “online gaming.” *Id.* at col. 14, ll. 3–45. A skilled artisan would need to infer that the embodiment of Figure 6 could be applied to the other types of programs described in the background section of the specification.

Second, a skilled artisan would need to infer that the “interactive network process status data” described in column 14 of the ’247 patent specification includes website data. According to Cioffi, one of the web browser processes recited in the asserted claims is the process running on P1 in the Figure 6 embodiment of the ’247 patent. *See* Appellees’ Br. 27. As the specification explains, that process “retrieves interactive network process status data from P2.” ’247 patent, col. 14, ll. 36–37. In order to fall within the scope of the claimed “web browser process,” the process running on P1 must be capable of accessing “website data,” either directly or indirectly. *Cioffi*, 632 F. App’x at 1021–22. In the context of online gaming, the specification suggests that interactive network process status data refers to “[i]nformation about the current and new state of the game [that is] exchanged between various users’ computer systems.” ’247 patent, col. 14, ll. 10–13. The specification does not expressly indicate that interactive network process status data would be equivalent to data available on a website. A skilled artisan would need to draw the inference that the interactive network process status data discussed in column 14 of the ’247 patent specification either includes or could be replaced with website data.

Third, a skilled artisan would need to infer that a web browser process could be executed on P1 in the first place. Although not expressly disclosed with respect to Figure 6 of the ’247 patent, web browsers are discussed with respect to various embodiments of the invention. For example, the specification explains that the embodiment

depicted in Figure 2 may be used to run a “protected process, such as browsing the internet.” *Id.* at col. 11, ll. 9–10. That protected process is described as running on P2. *Id.* at col. 11, ll. 4–21. And the specification explains with respect to Figure 9 that “[a] second logical process may comprise executing instructions necessary to carry out the functions of a web browser program,” while disclosing that other types of processes, such as an “operating system” or a “word processor,” may operate as a “first logical process.” *Id.* at col. 16, ll. 24–32. Notably, however, in neither case is a web browser, with its associated functions, described as being executed on P1. Thus, a skilled artisan would need to infer that it is possible to execute a web browser process on P1, particularly in view of the specification’s description of such a process as “protected.” *Id.* at col. 11, ll. 9–10.

To be sure, the above inferences are ones that might well be drawn by a skilled artisan after reading the ’247 patent. Dr. Dunsmore testified essentially to that effect, and the district court found that testimony to be credible. However, our precedent requires more than that a skilled artisan be able to infer that the embodiment claimed on reissue was described in the specification of the original patent. There must be an “express disclosure” of the “exact embodiment claimed on reissue.” *Antares*, 771 F.3d at 1363. An express disclosure of an embodiment containing two web browser processes “is exactly what was missing here,” *see id.*, and the asserted claims are therefore invalid under the original patent requirement of 35 U.S.C. § 251.

Accordingly, we reverse the judgment of the district court that the asserted claims are not invalid under 35 U.S.C. § 251.

REVERSED

CERTIFICATE OF SERVICE

I hereby certify that on May 18, 2023, I electronically filed the foregoing with the Clerk of the Court for the United States Court of Appeals for the Federal Circuit by using the appellate CM/ECF system.

I certify that all participants in the case are registered CM/ECF users and that service will be accomplished by the appellate CM/ECF system.

/s/ Eric Benisek
Eric Benisek