

Docket No. 22-2042

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

K-FEE SYSTEM GMBH,
Plaintiff - Appellant,

v.

NESPRESSO USA, INC.,
Defendant - Appellee.

Appeal from the U.S. District Court for the Central District of California in Case No. 2:21-cv-03402-GW-AGR (Judge George H. Wu)

**CORRECTED PETITION FOR PANEL REHEARING AND
REHEARING EN BANC OF DEFENDANT-APPELLEE
NESPRESSO USA, INC.**

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CERTIFICATE OF INTEREST

Pursuant to Federal Circuit Rule 47.4, the undersigned Counsel certifies:

1. Name of every party or amicus represented by me: Nespresso USA, Inc.

2. Name of the Real Party in Interest represented by me is: None.

3. Parent corporations and publicly held companies that own 10% or more of stock in the party: Nestlé Holdings, Inc., NIMCO US, Inc., Nestlé US Holdco, Inc., Société des Produits Nestlé S.A., and Nestlé S.A.

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 agency or that are expected to appear in this Court (and who have not or will not enter an appearance in this case) are: Andrew Philip Blythe, Darish Huynh, Gibson Dunn & Crutcher LLP, 3161 Michelson Drive, Irvine, CA 92612-4412; and Wendy Cai, Gibson, Dunn & Crutcher LLP, 1050 Connecticut Avenue, N.W., Washington, DC 20036-5306.

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: *K-fee Sys. GmbH v. Nespresso USA, Inc., et al.*, Civil No. 2:21-cv-00525-GW (AGRx).

6. There are no organizational victims or debtors or trustees.

Dated: January 26, 2024

Respectfully submitted,

/s/ Y. Ernest Hsin

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STATEMENT OF COUNSEL

Based on my professional judgment, I believe that this appeal requires an answer to the following precedent-setting question of exceptional importance: whether the printed matter doctrine requires that a claim limitation bearing on patentability must have some functional relationship to the claim.

Dated: January 26, 2024

Respectfully submitted,

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INTRODUCTION

The panel issued a novel claim construction of a widely used term—“barcode”—that conflicts with settled doctrine and threatens to upset the numerous patents that rely on barcode limitations. The panel interpreted the term “barcode” as “characterized by the varying width *visual appearance* of the bars.” That construction reads the “code” out of “barcode” and defines that critical term in the claims based on whether something *looks* like a barcode rather than whether it *functions* as a barcode. The panel’s construction was not requested by either party, was unnecessary to the panel’s decision, and raises grave concerns under this Court’s printed matter doctrine. Rehearing is warranted.

First, the panel’s new construction conflicts with longstanding legal doctrine. The printed matter doctrine provides that printed matter elements of a patent claim must be functionally related to their “substrate.” Otherwise, the claim limitation cannot receive any patentable weight. Construing functional claim limitations based solely on *visual appearance* is contrary to that doctrine. Indeed, this Court previously concluded that a barcode limitation had no patentable weight because, as recited, it had no bearing on the functionality of the claimed

invention. *In re Taylor*, 771 F. App'x 1005 (Fed. Cir. May 22, 2019) (per curiam). Neither party has raised the printed matter doctrine to this point because neither party asked for a construction based on the visual appearance of a barcode. But the panel's claim construction creates a conflict with *Taylor* and with the Court's printed matter jurisprudence more generally. It endangers the validity of the asserted patents, whose barcode identifier is central to K-fee's invention—contrary to the canon to preserve validity.

Second, the panel's construction conflicts with the intrinsic record, as well as K-fee's arguments on appeal. The panel did not adopt the district court's claim construction, or the constructions urged by either party—instead choosing its own entirely new construction of “barcode” based on visual appearance. But K-fee's representations to the European Patent Office (EPO), the district court, and this Court have consistently emphasized the functional nature of the term barcode.

Third, the panel's construction of barcode would create a host of problems in this case and beyond. It is overbroad and encompasses any logo or trademarked image that conveys a message and looks like it has bars of varying width—regardless of whether or how such image is

encoded with readable data necessary to function as a barcode. At the same time, it would exclude symbols that actually function as barcodes but are not visible to the naked eye, a type of barcode that is in fact contemplated by the asserted patents. More broadly, the panel's construction risks blurring the line between utility patents and other intellectual property, frustrating the purpose of the printed matter doctrine and inviting confusion in the district courts.

Nespresso respectfully requests that the panel grant rehearing to simply strike its novel construction of "barcode" from the opinion, and either remand for further proceedings consistent with the panel's decision or construe "barcode" as "a code having bars of variable width, which includes the lines and gaps," which K-fee itself proposed as an appropriate alternative construction. BB 65. Alternatively, Nespresso seeks rehearing en banc because the panel's construction of a claim limitation that clearly bears on patentability, based simply on its visual appearance and not its function, presents a question of exceptional importance and conflicts with this Court's printed matter doctrine jurisprudence.

BACKGROUND

This case concerns Nespresso's highly successful Vertuo® line of coffee capsules and brewing machines. K-fee alleges Vertuo infringed three patents related to beverage systems and methods using single-use capsules: U.S. Patent Nos. 10,858,176 (the "176 Patent"); 10,858,177 (the "177 Patent"); and 10,870,531 (the "531 Patent"). Appx71–109 (Complaint). Each claim of every asserted patent, whether directed to a method or a system, requires a capsule with a "barcode" on the bottom side of the flange or rim of the capsule. Appx136–138 ('176 Patent claims); Appx165–166 ('177 Patent claims); Appx193–194 ('531 Patent claims).

During claim construction, the parties disputed the plain and ordinary meaning of "barcode." Nespresso proposed that "barcode" be construed as "machine readable code consisting of parallel bars of different widths that encode more than only two unique binary characters such as 0 or 1." Appx737. In support, Nespresso pointed to statements made by K-fee in a related EPO proceeding that successfully distinguished the "barcode" claimed in a European counterpart to the Asserted Patents from the code disclosed in Nespresso's affiliate's Jarisch

prior art reference (PCT Publication No. WO 2011/141532) (“Jarisch”). Appx1085–1086; Appx2969–2988.

In distinguishing the Jarisch code from the “barcode” claimed in its patents, K-fee focused on the symbols from which the codes are “constructed” and thus on *how* they encode the information that is communicated when that code is read. In particular, K-fee argued that, unlike a “barcode,” the Jarisch code is “*constructed of two different areas: a reflective area that represents ‘1’ and an absorbing area that represents ‘0’*”—in other words, that it is not a “barcode” but a “bit code,” which is “strictly a binary code *constructed of two binary symbols (‘0’ and ‘1’)*.” Appx1111.¹ K-fee clarified that a “barcode,” unlike the Jarisch bit code, “is always constructed of bars having variable widths, and therefore contains more than only two binary *symbols*, such as ‘0’ and ‘1.’” *Id.* (underline in original).

The district court accepted K-fee’s representations to the EPO that a “barcode” could be distinguished from other codes based on the symbols from which it was constructed, and construed “barcode” as “having its

¹ Any emphasis in this petition is added unless otherwise indicated.

plain and ordinary meaning (*i.e.*, a code having bars of variable width, which includes the lines and gaps), the scope of which is understood by the clear and unequivocal statements K-fee made to the EPO (*i.e.*, the scope of barcode does not include the type of bit code disclosed in Jarisch/D1).” Appx34–36 (quoting Appx1111).

Because the accused “barcode” in the Nespresso Vertuo products is the very same bit code disclosed in Jarisch—a patent owned by Nespresso’s European affiliate—Nespresso moved for summary judgment of non-infringement. Appx2911–2926. In opposition, K-fee argued that the accused Vertuo bit code was distinct from Jarisch and thus fell within the district court’s construction. Appx3310–3337. The district court rejected K-fee’s distinction and thus granted Nespresso summary judgment. Appx3–22. K-fee appealed.

On December 26, 2023, the panel reversed the district court’s construction of “barcode” and its summary judgment order. The panel focused its opinion on the district court’s determination that the “barcode” recited in K-fee’s claims excludes bit codes, whether as part of the ordinary meaning of the term (Op. at 6–12), or because the ordinary meaning was modified by K-fee’s statements to the EPO (Op. at 12–14).

But rather than remand for further proceedings with the exclusion of bit codes excised from the claim construction, the panel then went a step further and imposed its own construction. The panel construed “barcode” as “defined by its visual appearance as lined-up bars of varying widths” (Op. at 15)—a construction that neither party has ever requested.

The panel justified its visual-appearance-based construction in two principal ways, neither of which were raised in briefing or at oral argument.

First, the panel declared that “[t]he ordinary, common-sense, natural English meaning of ‘bars having variable widths’ is a matter of visual appearance.” Op. at 8; *see also id.* at 11. K-fee never argued for this meaning; to the contrary, K-fee focused on how barcodes are *constructed* from and *read* as variable-width bars. BB 7, 8, 37, 50.

Second, the panel noted that the parties agree that retail barcodes are barcodes, and that the “only evidence” K-fee presented to the EPO regarding retail barcodes is that “the visual presentation of the coded messages [in a retail barcode] is as a series of bars of varying widths, independently of how the messages are read.” Op. at 11; *see also id.* That

was incorrect. In the EPO proceeding, K-fee and its expert relied on how barcodes are read, *not* on what they look like, to distinguish Jarisch. Appx 1161 (Jarisch “contains no immediate and unambiguous indication ... that a barcode is to be used (e.g. that more than two different *optically readable* elements or symbols that can be analyzed when the barcode is read, in the sense of a two-width barcode or in the sense of a multi-width barcode, are to be used).”); Appx1119 (K-fee opposition brief citing the same). Both parties understood “barcode” as a functional element—a way of constructing and reading code.

THE COURT SHOULD GRANT REHEARING

I. The Panel’s Claim Construction Conflicts with Longstanding Legal Doctrine and the Intrinsic Record.

The panel should excise the paragraph in its opinion construing “barcode” based on visual appearance, and either remand for further proceedings consistent with the panel’s decision or construe “barcode” as “a code having bars of variable width, which includes the lines and gaps,” which K-fee itself proposed as an appropriate alternative construction. BB 65. Neither party requested a visual-appearance construction, it was unnecessary to the panel’s decision, it contradicts the intrinsic record, and it conflicts with this Court’s printed matter doctrine.

A. The Panel’s Construction Is in Tension with the Printed Matter Doctrine.

The panel construed “barcode” as something that *looks* like a barcode, rather than something that *functions* as a barcode. By focusing on the “visual appearance” of bars and divorcing “barcode” from its function, the panel’s construction is at odds with the printed matter doctrine and *Taylor*.²

The printed matter doctrine “fullfil[s] an important role in maintaining the integrity of patentability doctrine” by ensuring “novelty and nonobviousness inquiries” are directed toward “the functionality [the printed matter] confers.” Andrew Chin, *Gene Probes as Unpatentable Printed Matter*, 20 Fed. Cir. B. J. 527, 537 (2011). Under the doctrine,

² The parties did not previously raise or brief the printed matter doctrine because it was not at issue until the panel adopted a claim construction based on visual appearance. That doctrine is nonetheless a proper basis for panel or en banc rehearing. *See Apple Inc. v. Samsung Elecs. Co., Ltd.*, 839 F.3d 1034, 1038–39, 1042–43 (Fed. Cir. 2016) (granting en banc review where panel decision imposed new claim construction not advocated by either party); *O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co., Ltd.*, 521 F.3d 1351, 1359 (Fed. Cir. 2008) (“While a waiver may occur if a party raises a new issue on appeal a waiver will not necessarily occur if a party simply presented new or additional arguments in support of the scope of its claim construction.” (cleaned up)).

“printed matter encompasses any information claimed for its communicative content, and the doctrine prohibits patenting such printed matter unless it is ‘functionally related’ to its ‘substrate,’ which encompasses the structural elements of the claimed invention.” *C R Bard Inc. v. AngioDynamics, Inc.*, 979 F.3d 1372, 1381 (Fed. Cir. 2020) (citations omitted); *see also Praxair Distrib., Inc. v. Mallinckrodt Hosp. Prods. IP Ltd.*, 890 F.3d 1024, 1032–33 (Fed. Cir. 2018). Put simply, the focus is on what the printed-matter element of a claim *does*—and whether it bears on the function of the claimed invention.

Taylor illustrates this principle in the specific context of a barcode limitation. *Taylor* involved a claimed method of printing advertising content that included a barcode on floor mats in areas with high consumer traffic. 771 F. App’x at 1006. In upholding a finding of invalidity, this Court determined that the “barcode is nothing more than another type of printed matter within an advertisement that does not change the function of the claimed advertising mat.” *Id.* at 1010. The Court reached that conclusion because, as claimed, the barcode “[wa]s not positively recited as actually being used to change or affect the manner

of printing or placing or functioning of the advertisement mat.” *Id.* at 1009.

What was true in *Taylor* is true here: when construed based on visual appearance, “barcode” is a nullity under the printed matter doctrine because the visual appearance of “lined-up bars of varying width” does not relate to how the coffee capsule functions (i.e., how the coffee machine reads the information encoded by the “barcode”). Without this function ascribed to the “barcode,” K-fee’s asserted patents risk invalidity, as discussed further below. This presumably explains why even K-fee did not advocate a purely visual construction of the term.

Aside from *Taylor*, the panel’s construction based on “visual appearance” is in tension with decades of printed matter precedent articulated by this Court and its predecessor.

For example, *In re McKee*, 64 F.2d 379, 380 (CCPA 1933), set forth an early synthesis of printed-matter case law and distinguished between “the mere *arrangement* of printed matter”—which “did not constitute patentable subject-matter”—and cases where “the material upon which the printing appeared had a novel form, *which form served a new and useful purpose.*”

In *In re Marco Guldenaar Holding B.V.*, 911 F.3d 1157, 1161 (Fed. Cir. 2018), the Court determined that dice markings did not functionally relate to the substrate of the dice. In doing so, the Court distinguished the “recited claim limitations” from those it found patentable in *In re Gulack*, 703 F.2d 1381, 1385–87 (Fed. Cir. 1983): the case was “[u]nlike [*Gulack*], where digits were printed on a band in such a manner that ... *the particular sequence of digits was critical to the invention.*” See also *In re Distefano*, 808 F.3d 845, 850 (Fed. Cir. 2015) (explaining that the *Gulack* Court held “that while a sequence of digits printed on a wrist band constituted printed matter, the sequence deserved patentable weight because *the informational content of the sequence (what numbers were represented) was functionally related to the endless-band physical structure of the substrate*”).

These and similar cases reflect the established rule that utility patents protect only *functional* elements, not purely visual printed matter. Construing a limitation based entirely on visual appearance can raise a slew of problems—obviousness, anticipation, and even eligibility. *CR Bard*, 979 F.3d at 1383 (“a claim may be found patent ineligible under § 101 on the grounds that it is directed solely to non-functional printed

matter”). And this Court has made clear that problems under the printed matter doctrine may arise during claim construction. *Praxair*, 890 F.3d at 1033 (“Applying precedent to this case, we agree with Praxair that the Board properly addressed the printed matter doctrine during claim construction.”). This Court likewise has instructed that construction must be done with an eye toward preserving the validity of the claim. *See Ruckus Wireless, Inc. v. Innovative Wireless Sols., LLC*, 824 F.3d 999, 1004 (Fed. Cir. 2016) (canons of claim construction “favor[] constructions that preserve claim validity”).

Here, the recited “barcode” bears on the patentability of the asserted patents. The whole purpose of the purported invention of the asserted patents is to use an identifier, which in the claims is a barcode, to ensure that only suitable capsules are used with the coffee machine. *See, e.g.*, ’176 Patent at 1:22–34, Appx131 (“The object of the present invention is therefore to provide a portion capsule which is only suitable for a specific coffee machine ... The object is accomplished according to the present invention by a portion capsule ... [that] has an *identifier*, which allows to individualize the respective portion capsule.”); *id.* at Title, Appx111 (“Portion Capsule Having an *Identifier*”); *see also id.* at

3:1–6, Appx132 (“Preferably the identifier is a machine-readable imprint ... Preferably the print is a barcode, a logo or a repeat pattern.”). The centrality of the barcode to K-fee’s invention is reflected in the EPO proceedings, where K-fee vigorously distinguished its invention from the prior art based on how barcodes are constructed and read. *Infra* at 16. Yet under the Court’s visual-appearance based construction, the recited barcode bears no patentable weight under the printed matter doctrine. That cannot be correct.

B. The Panel’s Construction Is at Odds with the Intrinsic Record and Contradicts K-fee’s Position Throughout This Case.

Throughout this litigation and before the EPO, Nespresso and K-fee have agreed that “barcode” entails a method of constructing and reading code.³ K-fee advanced that functional understanding of “barcode” to the EPO, the district court, and this Court. The panel’s claim

³ While Nespresso argued that K-fee’s conception of “modular barcodes” ultimately (and inappropriately) turns on the visual appearance of symbols, that argument critiqued a logical result of K-fee’s position; Nespresso did not suggest that K-fee was advocating that “barcode” be construed solely based on visual appearance, and K-fee vigorously argued that its view was *not* based on nonfunctional appearance but rather that the varying-width bars represent information. BB at 8; Reply at 25.

construction is directly contrary to the parties' shared understanding and the records in this case and before the EPO.

For instance, K-fee's own expert witness—cited in the panel opinion—unequivocally testified in the intrinsic record that a barcode is defined by optically *readable* data represented by symbols.

- “the disclosure in [Jarisch] contains no immediate and unambiguous indication that the employed ‘code’ or ‘bit code’ specifically represents a barcode or that a barcode is to be used (e.g. that more than two different *optically readable* elements or symbols *that can be analyzed when the barcode is read ...*).” Appx1161.
- “barcodes—in contrast to binary codes—are based on information printed onto a medium in the form of bars and gaps, which are then strictly *optically readable* by detecting lines and gaps.” Appx1161.
- “the use of barcodes regularly implies that more than two different *optically recordable elements and/or symbols are used that can be analyzed when the barcode is read.*” Appx1161 (emphasis in original).

Construing barcode based on visual appearance directly conflicts with this record. It likewise is contrary to the K-fee patent specifications, which contemplate that the barcode may not even be visible to the human eye. '176 Patent at 8:45–47, Appx134 (“This barcode may be printed by material removal or may be generated by a medium that is integrated in the foil and can be detected optically such as a fluorescence agent.”).

Jarisch also contemplates this. Appx 2973, ll. 18–19 (bitcode visible under UV light).

K-fee has steadfastly maintained this position on appeal:

- In a barcode, “more than two different *optically recordable elements* and/or symbols are used that can be analyzed *when the barcode is read.*” BB 37 (underlining in original).
- “Because the width of the bars are variable they contain more than two optical symbols that *can be read by a scanner.*” BB 8.

These are just a few examples of the ways in which the panel’s claim construction is incompatible with the intrinsic record and the record on appeal. The parties have not previously had an opportunity to brief and argue this issue. This Court should avoid this thicket and simply remove the “visual appearance” construction from its opinion, allowing the parties to wrestle with this issue on remand with the benefit of the remainder of the Court’s opinion.

II. Construing “Barcode” Based on Visual Appearance Invades the Province of Other Intellectual Property and Threatens Barcodes Everywhere.

If the panel does not grant rehearing, the Court should rehear the case en banc because the panel’s “visual appearance” construction is contrary to the printed matter doctrine and creates myriad issues.

Barcodes have been a fundamental feature of modern commerce since adoption of a uniform code in the 1970s. Jordan Frith, *The surprising history of the barcode*, CNN (Jan. 18, 2024), <http://tinyurl.com/2yhcyjab>. The panel’s construction creates uncertainty as to whether a “barcode” recited in a patent claim may now be determined based solely on its visual appearance, regardless of whether it is actually a barcode.

The panel’s construction is at once overbroad and underinclusive: it encompasses images that in no way act as barcodes, while excluding some actual barcodes explicitly within the scope of K-fee’s asserted patents. Under the panel’s construction, any arrangement of bars of varying width—such as a company logo, abstract painting, toddler’s drawing, or decorative design—could constitute a barcode, even though no person of skill in the field would understand it to be a barcode. The “message” aspect of the Court’s construction does not help: each of these elements may convey a message—for example, that a product is produced by a certain company. Yet an actual barcode printed in invisible ink and readable by a special scanner would fall outside the panel’s definition of a barcode simply because it is not visible to the naked eye. *But see* ’176

Patent at 8:45–47, Appx134. In short, the panel’s construction entails wide-ranging consequences extending far beyond the immediate litigation that warrant en banc correction.

More broadly, by construing a functional limitation in a utility patent based on visual appearance, the panel set a precedent that risks blurring the line between utility patents and distinct forms of intellectual property, such as design patents and trademarks. This is no nominal concern. Utility patents serve different goals than design patents and are subject to a distinct standard of patentability.

An exclusive focus on visual appearance is characteristic of design patents—not utility patents. “Unlike an invention in a utility patent, a patented ornamental design has no use other than its visual appearance, and its scope is limited to what is shown in the application drawings. Therefore, in considering prior art references for purposes of determining patentability of ornamental designs, the focus must be on appearances and not uses.” *In re Harvey*, 12 F.3d 1061, 1064 (Fed. Cir. 1993) (internal quotation marks and citations omitted); *see also Contessa Food Prods., Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1376 (Fed. Cir. 2002) (“[T]he scope of the claimed design encompasses ‘its visual appearance as a whole,’ and

in particular “the visual impression it creates.” (internal quotation and citation omitted)), *abrogated on other grounds by Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008).

By construing a functional limitation based on its visual appearance, the panel construction disregarded these boundaries in a way that frustrates the printed matter doctrine and risks engendering significant confusion in the district courts tasked with differentiating valid utility patents from other intellectual property.

CONCLUSION

Nespresso respectfully requests that the panel grant rehearing to remove the portions of its opinion referencing a construction based on the visual appearance of the barcode, and either remand to the district court for further proceedings consistent with the remainder of the panel’s opinion or construe “barcode” as “a code having bars of variable width, which includes the lines and gaps.” *See* BB 65. Alternatively, this case warrants en banc review to clarify whether a claim limitation bearing on patentability must have some functional relationship to the claim.

Dated: January 26, 2024

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Addendum

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

K-FEE SYSTEM GMBH,
Plaintiff-Appellant

v.

NESPRESSO USA, INC.,
Defendant-Appellee

2022-2042

Appeal from the United States District Court for the
Central District of California in No. 2:21-cv-03402-GW-
AGR, Judge George H. Wu.

Decided: December 26, 2023

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CHRISTINE RANNEY, Denver, CO.

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

TARANTO, *Circuit Judge*.

K-fee System GmbH owns U.S. Patent Nos. 10,858,176, 10,858,177, and 10,870,531, which all descend, via division and continuation, from a single application and share a specification. K-fee filed suit against Nespresso USA in the Central District of California alleging infringement of the three patents. The district court issued a claim-construction order in which it construed, among other terms, “barcode,” a term present in every claim of the asserted patents. *K-fee Systems GmbH v. Nespresso USA, Inc.*, No. 2:21-cv-03402, 2022 WL 2826443, at *5 (C.D. Cal. March 10, 2022) (*Claim Construction Order*). Nespresso then filed a motion for summary judgment of non-infringement, arguing that its products did not meet the “barcode” claim limitations under the court’s construction and thus it did not infringe any asserted claims. The district court agreed and granted Nespresso’s motion for summary judgment. *K-fee Systems GmbH v. Nespresso USA, Inc.*, No. 2:21-cv-03402, 2022 WL 2826441, at *1 (C.D. Cal. June 17, 2022) (*Summary Judgment Opinion*).

After final judgment was entered, K-fee appealed. We agree with K-fee that the district court erred in construing “barcode,” and we reverse the district court’s construction. Because the erroneous construction of “barcode” was also the basis for the district court’s grant of summary judgment of non-infringement, we reverse that grant as well and remand for further proceedings.

I

A

The asserted patents describe and claim coffee-machine portion capsules that display information that, when read by a device associated with the coffee machine, can prevent the capsules from being used in incompatible machines. ’176 patent, col. 1, lines 11–34, 60–62. The displayed information may also specify capsule-specific

brewing parameters, such as temperature and amount of water. '176 patent, col. 3, lines 23–27. Critically for this appeal, the patents implement this concept by encoding the information in a “barcode.” '176 patent, col. 8, line 54–55, col. 12, line 67, through col. 13, line 2. Claim 1 of the '176 patent is representative for the purposes of this appeal and reads, in relevant part:

1. A method of making a coffee beverage comprising:

providing an apparatus including a barcode reader;

inserting a first portion capsule into the apparatus, the first portion capsule including . . . an opposing bottom side with a first barcode located on the bottom side, . . . ;

reading the first barcode with the barcode reader;

controlling a production process of a first coffee beverage based upon the reading of the first barcode;

. . .

inserting a second portion capsule into the apparatus, the second portion capsule including . . . an opposing bottom side with a second barcode located on the bottom side and being different from the first barcode, . . . ;

reading the second barcode with the barcode reader;

controlling a second production process of a second coffee beverage based upon the reading of the second barcode, the second

production process being different than the first production process;

....

'176 patent, col. 12, line 52 through col. 13, line 41.

B

In its claim-construction order, the district court noted that “the parties agree that plain and ordinary meaning applies, but dispute what that meaning is.” *Claim Construction Order*, at *5. The district court characterized the core of the dispute as “whether statements made by K-fee System GmbH . . . before the EPO [European Patent Office] concerning the meaning of ‘barcode’ should influence the plain and ordinary meaning of that limitation in these proceedings.” *Id.*, at *6. K-fee, through its patent attorney, made the statements in a motion asking the EPO to deny an opposition filed by Nespresso’s foreign affiliate, Nestec S.A., that challenged the validity of K-fee’s related European patent, EP 3 023 362. K-fee was seeking to distinguish a particular piece of prior art, WO 2011/141532 A1 (Jarisch, referred to in the EPO as D1). *Id.*, at *7; see J.A. 1101–25.¹ The district court concluded that “the EPO prosecution records . . . were provided to the PTO” by K-fee when it was prosecuting what became its ’176 patent in the U.S. Patent and Trademark Office, and the district court therefore analyzed them as part of the intrinsic record. *Claim Construction Order*, at *6.

The district court concluded that K-fee had “argued strenuously” before the EPO for a particular “plain and

¹ Along with the legal submission, K-fee filed an expert declaration by Ralf Jesse. J.A. 1156–61. The district court, in its rulings on appeal, did not rely on that declaration—which, we note, would not alter our conclusion about the proper claim construction.

ordinary meaning,” which excluded “bit codes”—codes made up of two binary symbols. *Id.*, at *8. Based on the EPO submission by K-fee, the district court construed “barcode” to have

its plain and ordinary meaning (*i.e.*, a code having bars of variable width, which includes the lines and gaps), the scope of which is understood by the clear and unequivocal statements K-fee made to the EPO (*i.e.*, the scope of barcode does not include the type of bit code disclosed in Jarisch/D1).

Id. The district court did “not resort to extrinsic evidence to construe th[e] term.” *Id.*

Based on that claim construction of “barcode,” Nespresso moved for summary judgment of non-infringement of its accused products. Nespresso primarily argued that the capsules of its accused products operated identically to the Jarisch capsules that K-fee had distinguished before the EPO in that both used a machine-readable code having only two binary symbols, J.A. 2914, so that the accused capsules did not meet the “barcode” limitations of the claims, J.A. 2922. The district court, granting the motion, reiterated that bit codes using only two symbols could not be barcodes, placing particular weight on K-fee’s statement to the EPO that Jarisch “discloses a ‘bit code,’ but not a barcode, because the barcode—as shown above—is always constructed of bars having variable widths, and therefore contains more than only two binary symbols, such as ‘0’ and ‘1.’” J.A.1111, *Summary Judgment Opinion*, at *2, *7. The district court found that there was no dispute that Nespresso’s accused products used a code having only two symbols and concluded that Nespresso therefore did not infringe. *Summary Judgment Opinion*, at *7, *9.

The district court entered final judgment on June 28, 2022, dismissing K-fee’s invalidity counterclaims without prejudice. K-fee timely appealed on July 14, 2022. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

II

We first address the proper construction of “barcode.” The district court’s ruling relied only on intrinsic evidence, *see Claim Construction Order*, at *8; the court did not purport to make, and neither party argues on appeal that the court did make or should have made, a factual finding about disputed extrinsic evidence concerning extra-patent understandings of the term. We therefore decide the proper claim construction de novo. *Intel Corp. v. Qualcomm Inc.*, 21 F.4th 801, 808 (Fed. Cir. 2021). “We generally give words of a claim their ordinary meaning in the context of the claim and the whole patent document; [and] the specification particularly, but also the prosecution history, informs the determination of claim meaning in context, including by resolving ambiguities”; but “even if the meaning is plain on the face of the claim language, the patentee can, by acting with sufficient clarity, disclaim such a plain meaning or prescribe a special definition.” *World Class Technology Corp. v. Ormco Corp.*, 769 F.3d 1120, 1123 (Fed. Cir. 2014) (first citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-17 (Fed. Cir. 2005) (en banc); and then citing *Thorner v. Sony Computer Entertainment America LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012)); *see Personalized Media Communications, LLC v. Apple Inc.*, 952 F.3d 1336, 1339–40 (Fed. Cir. 2020).

Broadly, K-fee argues that the district court narrowed the ordinary meaning of “barcode,” implicitly finding prosecution disclaimer (though the district court never framed it as disclaimer) when it used K-fee’s statements to the EPO to interpret the term. K-fee asserts that this effective holding of disclaimer was improper and that its statements to the EPO did not meet the standard for disclaimer. Nespresso contends that the court correctly invoked the prosecution history to clarify the ordinary meaning, not to narrow an otherwise apparent ordinary meaning. Nespresso also argues that applying the standard required for disclaimer would nevertheless lead to the same result.

At the outset, we note that the term “barcode” has been used in this matter in two different ways. In one use, it refers to an individual message to be read and decoded, *e.g.*, the sequence of bars shown on the bottom side of a flange on a single capsule, so that two different-sequence capsules have two different “barcodes.” The claim language quoted *supra* suggests that meaning. In another use, “barcode” refers to the coding “system” used to produce the multiple, individual messages, *e.g.*, “the Jarisch code” or “the Vertuo code” (used in the accused products). Nespresso’s Br. at 2; *see also, e.g.*, K-fee’s Br. at 14–15.

The parties essentially disregard that usage difference, instead focusing entirely on whether the term refers to visually non-uniform-width bars, either with (as the district court held) or without (as we hold) an additional narrowing “bit code” restriction. We proceed, given the language of the claims, by first addressing in full the individual-message use of “barcode,” often using “message” expressly, for which we hold that an individual message must display such non-uniformity. After that discussion, we briefly address the coding-system use of “barcode.”

A

We consider the ordinary meaning of “barcode” in the context of the patent and prosecution history and then turn to the question of whether K-fee surrendered claim scope by clear disclaimer or redefinition.

1

The parties agree that the meaning of “barcode” is not clarified by the claims themselves or the shared specification. K-fee also no longer challenges the status of the EPO filings as intrinsic evidence, although it did so before the district court. Thus, putting to one side for the moment the possibility of clear surrender (discussed *infra*), we address first what K-fee’s motion to deny the opposition in the EPO indicates about ordinary meaning—here, what a relevant

artisan would understand the meaning of “barcode” in the field to be. On considering K-fee’s submission, we disagree with the district court that the ordinary meaning of “barcode” excludes “bit codes” (in some sense, two-value codes) or even bit codes of “the type . . . disclosed in Jarisch” to the extent that the latter is different. *Claim Construction Order*, at *8.

K-fee’s motion to the EPO was a response to Nestec’s validity challenge, which argued that Jarisch (Nestec’s own international application) defeated the novelty of K-fee’s European patent EP 3 023 362. Like K-fee’s EP 3 023 362 and its patents asserted in the present case, Jarisch discloses a beverage capsule displaying information, “by means of a code,” that the coffee machine can read and use. J.A. 2971. In its opposition, Nestec contended that this code was a “barcode,” a term used by K-fee in EP 3 023 362. J.A. 1086. In response, K-fee first provided evidence about the meaning of “barcode” to a relevant artisan—evidence in the form of quotes from publications in the field, not created for this litigation. J.A. 1102–09. It concluded that “the [relevant artisan] at all times defines the term ‘barcode’ as a line code constructed of bars having variable widths.” J.A. 1109.² That understanding is reflected, as well, in a Wikipedia entry and a dictionary entry submitted to the district court by K-fee. *See* J.A. 974–1004, 1006–07. The ordinary, common-sense, natural English meaning of “bars having variable widths” is a matter of visual

² “Line code” refers to a code whose message components are set out linearly—*e.g.*, from left to right—rather than, say, in a two-dimensional display (like that of a QR—quick response—code). This aspect of a “barcode” is not in dispute between the parties. In particular, there is no suggestion before us that a line code’s messages must be set out in a straight line, rather than along (say) the circumference of a circle.

appearance: “bars” are two-dimensional shapes having length and width (even if not exactly rectangular),³ and the widths (in the direction of the linear reading) are not uniform.

Before the EPO, K-fee, after setting forth the foregoing, then argued, with the support of an expert declaration, that the teaching of Jarisch did not meet this definition and (under European law) that a barcode could not be “directly and unambiguously inferred” from Jarisch. J.A. 1110, 1118; *see* J.A. 1110–19. Jarisch discloses, among other codes, a code whose messages are “formed of a succession of small rectangular surfaces” that can encode two states, corresponding to 0 and 1. J.A. 2978. It was against this background that K-fee made its statement that Jarisch “discloses a ‘bit code,’ but not a barcode, because the barcode—as shown above—is always constructed of bars having variable widths and therefore contains more than only two binary symbols such as ‘0’ and ‘1.’” J.A. 1111.

The district court relied on that assertion, and surrounding material in the K-fee EPO submission, to conclude that “the scope of barcode does not include the type of bit code disclosed in Jarisch.” *Claim Construction Order*, at *8. The district court further made clear, when applying the construction at summary judgment, that by “the type of bit code disclosed in Jarisch,” it meant “a binary code containing only ‘0s’ and ‘1s.’” *Summary Judgment Opinion*, at *2, *9. Thus, the district court read the statement that a barcode “is always constructed of bars having variable widths and therefore contains more than only two binary symbols such as ‘0’ and ‘1’” to mean that a barcode *must* “contain[] more than only two binary symbols” and,

³ We have no dispute before us about what geometric shapes may qualify as “bars” for purposes of a “barcode,” so we do not address that question.

by extension, that any code that contains only two binary symbols could not be a barcode. *Id.* at *8.

K-fee's other statements to the EPO, however, demonstrate that the district court's conclusion was too confining. Elsewhere in the same filing, K-fee also noted that "a barcode can be, but is not necessarily, a bit code. It is therefore a special form of the binary code." J.A. 1112. K-fee further asserted, in its EPO filing, that "while the barcode is a 'bit code,' it is also a 'special case' and therefore represents a subset of the 'bit code.'" J.A. 1114. And K-fee's expert, using the terms "bit code" and "binary code" interchangeably, stated that "[b]arcodes can therefore principally be regarded as a version of binary codes." J.A. 1157.

The district court referred to some of those statements. *Claim Construction Order*, at *8. It erred, however, in determining that, taken together, a relevant artisan would still conclude that no bit code could be a barcode. While K-fee suggested that a *consequence* of being "constructed of bars having variable widths" would be the existence of "more than only two binary symbols," the reason it gave for Jarisch not disclosing a barcode was that Jarisch's messages were not "constructed of bars having variable widths." J.A. 1111. K-fee's remarks all suggest that K-fee understood the relationship between barcodes and bit codes to be more complex than simply that bit codes cannot be barcodes.

In its motion to deny the opposition before the EPO, K-fee also clearly stated that retail barcodes, known as EAN [European Article Number] or UPC [Universal Product Code] barcodes, fell within the scope of its claims. J.A. 1102–03. Indeed, Nespresso does not seem to dispute that such codes are within the ordinary meaning of "barcode" for this patent. The record indicates that EAN/UPC barcodes (messages) can be broken down into binary "modules," where each module has only two possible states, as in a bit code. J.A. 18, 1106, 3347, 3354–55, 3962. The

modules are then combined into “symbols”—sequences of seven modules—that encode the digits from 0 to 9. *Id.* Nespresso argues that these messages are barcodes—and *not* bit codes—because, despite having binary modules, they have more than two symbols, and there is no evidence that they are read at the module level, and thus no evidence that the unit of the code that is read is binary. Nespresso’s Br. at 49–50; Oral Arg. at 25:12–26:11. While it is true that no evidence in the record describes how retail barcodes are read, the absence of such evidence highlights that Nespresso’s argument is divorced from what K-fee actually represented to the EPO when it plainly invoked retail barcodes as examples of barcodes. There, K-fee presented no evidence to the EPO about how retail barcodes encode information or how they are read. *See* J.A. 1102–03. It did not describe retail codes as made up of “symbols” and “modules.” The only evidence it *did* present was that the visual presentation of the coded messages is as a series of bars of varying widths, independently of how the messages are read (one binary module at a time or some other way). *Id.* Instead, retail barcodes are barcodes, and the code used by Jarisch is not, because messages of the former contain bars of visually varying widths, and messages of the latter do not.

In sum, on the point in dispute, all that is clear from K-fee’s submission to the EPO about a relevant artisan’s understanding of “barcode” is that barcode messages use bars of varying widths—a matter of visual appearance. K-fee cited numerous sources before the EPO to support such an understanding of “barcode,” ranging from Wikipedia to barcode standards to textbooks. J.A. 1102–09. The sources discuss various barcodes for various settings, but all have in common an emphasis on “bars” or “stripes” of varying widths. J.A. 1102–09. This is consistent with K-fee’s explicit representation to the EPO that “the [relevant artisan] at all times defines the term ‘barcode’ as a line code constructed of bars having variable widths.” J.A. 1109.

That understanding of K-fee's EPO submission is consistent with K-fee's bottom-line purpose (which it fulfilled) of persuading the EPO that Jarisch did not involve a "barcode." On its face, Jarisch is easily understood to fall outside a definition of "barcode" that invokes visual appearance: It does not clearly reveal any bars of varying widths. And the EPO itself concluded that it was "not evident" that Jarisch discloses "a barcode having variable widths." J.A. 1209; *see also infra* p. 14.

Nespresso objects to a visual-appearance definition of "barcode," but the law asks us to determine the meaning of a term "to the [relevant] artisan after reading the entire patent." *Phillips*, 415 F.3d at 1321. The evidence persuades us that a relevant artisan identifies a barcode by appearance and not by other criteria such as a particular encoding of data of the sort reflected in the district court's claim construction. We conclude that the relevant artisan reading the asserted patents and their prosecution history (the latter now accepted by the parties to include the EPO opposition submission) would understand "barcode" to refer to line-code messages, displaying bars, that are characterized by the varying-width visual appearance of the bars in the messages.

2

What remains to be considered is the question of surrender by K-fee in the EPO submission. To determine whether K-fee disclaimed or otherwise surrendered claim scope that comes within the claim language, on all the evidence of a relevant artisan's understanding of that language, we consider whether, despite the apparent ordinary meaning evident from the intrinsic evidence, K-fee "act[ed] with sufficient clarity" before the EPO to "disclaim . . . [the] plain meaning or prescribe a special definition." *World Class Technology*, 769 F.3d at 1123. This inquiry is related to but distinct from the inquiry into what the prosecution history shows about a relevant artisan's understanding of

the claim language in context. We conclude that K-fee did not act with the clarity required either to prescribe a new meaning for “barcode” or to disclaim any portion of the apparent meaning.

First, Nespresso contends only in passing—and primarily in a footnote—that K-fee changed the scope of the term “barcode” through lexicography. But arguments raised only in footnotes are generally forfeited, especially where not developed through discussion and application of the governing legal standards. *CommScope Technologies, LLC v. Dali Wireless Inc.*, 10 F.4th 1289, 1296 (Fed. Cir. 2021); *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1319–20 (Fed. Cir. 2006). Regardless, putting aside forfeiture, we see no indication of any attempt at redefinition by K-fee. “To act as its own lexicographer, a patentee must ‘clearly set forth a definition of the disputed claim term’ other than its plain and ordinary meaning” and must “‘clearly express an intent’ to redefine the term.” *Thorner*, 669 F.3d at 1365 (first quoting *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002); and then quoting *Helmsderfer v. Bobrick Washroom Equipment, Inc.*, 527 F.3d 1379, 1381 (Fed. Cir. 2008)). Before the EPO, however, K-fee consistently argued that its view of barcodes was the ordinary meaning. Further, as discussed above, K-fee’s representations to the EPO were far from “clear[.]” *Id.*

Second, Nespresso argues that because K-fee’s statements were “repeated, unequivocal, and unambiguous,” a conclusion of disclaimer is appropriate. Nespresso’s Br. at 23–24. We disagree that K-fee’s statements to the EPO were “unequivocal” or “unambiguous” and hold that they were not clear enough to support disclaimer. Disclaimer or disavowal of claim scope “must be both clear and unmistakable.” *Baxalta Inc. v. Genentech, Inc.*, 972 F.3d 1341, 1348 (Fed. Cir. 2020) (quoting *3M Innovative Properties Co. v. Tredegar Corp.*, 725 F.3d 1315, 1325 (Fed. Cir. 2013)). Further, “[e]ven if an isolated statement appears to

disclaim subject matter, the prosecution history as a whole may demonstrate that the patentee committed no clear and unmistakable disclaimer.” *Ecolab, Inc. v. FMC Corp.*, 569 F.3d 1335, 1342 (Fed. Cir. 2009). As discussed above, the statements K-fee made about bit codes were not clear and, if anything, were decidedly ambiguous. Taken as a whole, the prosecution history certainly demonstrates “that the patentee committed no clear and unmistakable disclaimer.” *Id.*

The only thing K-fee clearly distinguished before the EPO was Jarisch itself, which nowhere declares that its messages have bars of variable widths. Nespresso argues that Figure 5 of Jarisch shows regions of varying widths; that anticipation by Jarisch at the EPO therefore cannot have been avoided based on its lack of bars of variable widths; and further, that any disavowal of Jarisch is inconsistent with K-fee’s arguments about the ordinary meaning of barcode. Nespresso’s arguments about Figure 5—raised at summary judgment rather than at claim construction—are unpersuasive. As K-fee notes, there is no clear evidence in Jarisch that the wider regions of Figure 5 are part of the code. K-fee’s Opening Br. at 43; *see* J.A. 2978–79, 2985. The EPO itself noted that “[i]t is also not evident that the reflective and/or absorbing/diffracting surfaces [of Jarisch] disclose a barcode having variable widths.” J.A. 1209. We conclude that Jarisch was distinguished not through any clear disavowal of claim scope, but because it was never within the scope of the claim.

Finally, we note that K-fee makes the legal argument that a conclusion of disclaimer cannot be premised on statements made when defending a related but distinct patent against a different legal standard—here the European standard for novelty. We do not address that contention because we have concluded that K-fee’s statements were too unclear to constitute disclaimer.

B

Having addressed the individual-message use of “barcode,” we briefly address the coding-system meaning of “barcode” the parties have sometimes used before us. For that meaning, what is crucial is whether any messages produced by the coding system (to be read and decoded), though not necessarily all such messages, have non-uniform-width bars—for all the reasons set out in discussing the individual-message meaning of “barcode.” No argument has been made to us that a coding system, to be a “barcode” system, must *never* produce an individual equal-width-bar message, *e.g.*, a message that simply alternates same-width bars, among the large set of messages produced. In other words, we recognize that there might exist one or more messages that have a uniform-bar-width appearance (*e.g.*, 0101 represented by alternating same-width bars) in a “barcode” coding system that otherwise produces messages “constructed of bars having variable widths.” J.A. 1109.

* * *

We agree with K-fee that the full scope of the ordinary meaning of “barcode” should apply, and we conclude that the ordinary meaning that a relevant artisan would arrive at after reading the intrinsic evidence is that a barcode is defined by its visual appearance as lined-up bars of varying widths. We reverse the district court’s claim construction and construe “barcode” to refer to code messages consisting of a linearly arranged sequence of bars of visually non-uniform widths (or a coding system producing such messages).

III

The district court’s grant of summary judgment of non-infringement followed directly from its claim construction. *Summary Judgment Opinion*, at *9. Reversing the district court’s claim construction necessitates reversing its grant of summary judgment as well, because the infringement

analysis under the new construction will necessarily differ. For example, the similarity between the accused products and Jarisch that the district court relied on relates to how the messages are read by the reader (uniform-width module by uniform-width module), not to their visual appearance. *Summary Judgment Opinion*, at *6. That is not the correct analysis under the claim construction we adopt. A new analysis is required on remand.

IV

We have considered Nespresso's other arguments, and we find them unpersuasive. For the foregoing reasons, we reverse the district court's claim construction of "barcode" and its summary-judgment determination. We remand for further proceedings consistent with this opinion.

Costs awarded to K-fee.

REVERSED AND REMANDED

CERTIFICATE OF COMPLIANCE

1. This petition complies with the type-volume limitations of Fed. R. App. P. 35(b)(2). This brief contains 3,573 words, excluding the parts exempted by Fed. R. App. P. 32(f) and Federal Circuit Rule 32(b).

2. This petition complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. of App. P. 32(a)(6).

Dated: January 26, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

I, Y. Ernest Hsin, 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 January 26, 2024.

Dated: January 26, 2024

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