

Elcommerce.com, Inc. v. SAP AG, Appeal No. 2011-1369 (Fed. Cir. February 24, 2014).
Before Newman, Plager and Wallach. Appealed from E. D. Pa. (Judge Dubois).

Background:

Plaintiff's patent includes several claims in means-plus-function (MPF) format. In the District Court, Defendant argued that there was no structure at all in the patent specification corresponding to the functions. No expert testimony was provided by Defendant in support of Defendant's position.

The District Court agreed with Defendant and held that the means-plus-function claims were invalid and indefinite for lack of structural support. Plaintiff appeals and states that an expert witness is required to make this holding.

Issue/Holding:

Did the District Court err in ruling the MPF claims invalid without requiring expert testimony to determine if there was sufficient structural support for the MPF claims? Yes, vacated and remanded.

Discussion:

A substantial number of MPF claims have been invalidated as lacking definiteness under §112(b). Courts follow the following logic: (a) the statute requires that a MPF claim element be defined according to corresponding structure found in the specification; (b) if no corresponding structure is found in the specification then the term cannot be defined and (c) the claim is therefore invalid as indefinite. The patent's presumption of validity can only be overcome with clear and convincing evidence that there is no structural support from the perspective of one skilled in the art.

In this case, Judge Newman stated that there was no way, *without evidence*, that "a general purpose judge could ascertain the position of persons of skill in the art and conclude that there is not a shred of support for any of the eleven interrelated means-plus-function claim limitations" as argued by Defendant. Judge Newman states that the "burden was on [Defendant] to prove its case, and in the absence of evidence provided by technical experts who meet the *Daubert* criteria there is a failure of proof. *Attorney argument is not evidence.*" Thus, the court was clear that expert testimony -- not attorney arguments -- was necessary to prove indefiniteness.

Thus, since no expert testimony was provided by Defendant, the presumption of validity was not overcome, and the Federal Circuit vacated the District Court's decision.

Judge Wallach dissented, stating that the patentee must show in the specification the algorithm corresponding to each recited function, and *only* then, "expert testimony may be helpful in determining whether the algorithm is adequate corresponding structure in the view of a skilled artisan." In support of this position, he said that prior precedent has held that expert testimony is not required where the specification contains no algorithm *at all* corresponding to each recited function.