

ALFRED E. MANN FOUND. FOR SCIENTIFIC RESEARCH v. COCHLEAR CORP., Appeal Nos. 2015-1580, 2015-1606, 2015-1607 (Fed. Cir. November 17, 2016). Before Newman, Chen and Hughes. Appealed from C.D. Cal. (Judge Olguin).

Background:

The Alfred E. Mann Foundation (The Foundation) owns two patents relating to manufacturing of cochlear implants, and sued Cochlear for willful infringement of two claims of one of the patents, and two claims of the other of the patents.

The district court found claim 1 of the first patent and both claims of the second patent indefinite under 35 U.S.C. §112(b). In response to Cochlear appealing a finding of infringement for claim 10 of the first patent, the Foundation cross-appealed the finding of invalidity for indefiniteness of claim 1 of the first patent and both claims of the second patent.

Issues/Holding:

Did the district court err in finding claim 1 of the first patent and both claims of the second patent invalid for indefiniteness? Yes, with respect to claim 1 of the first patent, but no with respect to both claims of the second patent. Affirmed in part, reversed in part.

Discussion:

The claims subject to the indefiniteness review were means-plus-function claims.

Claim 1 of the first patent recites, in relevant part, "external processor means ... for receiving and processing the status-indicating signals to derive information therefrom regarding the operation of the implanted stimulator and its plurality of tissue stimulating electrodes." In reversing indefiniteness of claim 1 of the first patent, the Federal Circuit found that the means for receiving and processing included an algorithm whereby the microprocessor accepts signals representative of voltage, and then applies Ohm's law to convert voltage to impedance. The Federal Circuit found that the claimed feature was thus necessarily tied to the microprocessor, and further held that one skilled in the art would have known to have used Ohm's law to calculate the necessary impedance.

One claim of the second patent recites, in relevant part, "including means for generating data indicative of the audio signal." In affirming indefiniteness of the contested claims of the second patent, the Federal Circuit indicated that while it was clear that a microprocessor was the requisite structure, it was unclear where the logarithmic conversion algorithm necessary to generate the data was implemented, and particularly whether or not it was even performed in the microprocessor. The Federal Circuit pointed to expert testimony indicating that the conversion could occur in a converter.

Judge Newman concurred in part and dissented in part, dissenting on the issue of indefiniteness of the second patent claims. Judge Newman held that even though there are multiple ways of carrying out the logarithmic conversion, the use of logarithmic conversion would have been well understood by one skilled in the art, and the claims should not have been found indefinite.