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SONY CORP. v. IANCU, Appeal No. 2018-1172 (Fed. Cir. May 22, 2019). Before Prost, Newman, and Dyk. Appealed from PTAB.

Background:

The Board instituted an inter partes review of Sony's patent and issued a final decision finding the claims unpatentable as obvious.

During claim construction, the Board construed the structure of the claimed "reproducing means" limitation as discrete hardware elements and not a computer-implemented algorithm. Sony appealed the claim construction of the claimed "reproducing means."

Issue/Holding:

Did the Board err in construing the "reproducing means" limitation as discrete hardware elements and not a computer-implemented algorithm? Yes, vacated and remanded.

Discussion:

The steps for construing a means-plus-function claim limitation include (1) determining the function of the limitation and (2) determining the corresponding structure disclosed in the specification. For inventions with computer-implemented algorithms, the corresponding structure disclosed must be more than a general purpose computer or microprocessor. Further, a computer or microprocessor programmed to carry out an algorithm is construed as a special purpose computer programmed to perform the disclosed algorithm and not as a general purpose computer.

In disagreeing with the board's construction of the "reproducing means" as discrete hardware, the Federal Circuit noted that the patent, on its face, refers to a computer-implementation of the "reproducing means." In particular, the specification states that "[i]n reproducing such a recording medium by using the reproducing device of the present invention, the processing as shown in FIG. 16 is executed," and FIG. 16 discloses an algorithm in the form of a flowchart.

Further, the Federal Circuit noted that the patent does not describe or refer to the circuitry of the controller that would be required for a hardware controller to perform the claimed function, which is expected if the controller were meant to be hardware.

In light of the above, the Federal Circuit concluded that the "reproducing means" limitation is a computer-implemented algorithm, and that the corresponding structure is a synthesizer and controller that performs the algorithm disclosed in the specification. The Federal Circuit vacated the Board's decision and remanded for further consideration of whether the cited art discloses a synthesizer and controller that performs the algorithm disclosed in the specification and whether the claims would have been obvious over the cited art.