

Exhibit A

**UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C.**

In the Matter of

CERTAIN ELECTRONIC DEVICES WITH
MULTI-TOUCH ENABLED TOUCHPADS
AND TOUCHSCREENS

Investigation No. 337-TA-714

**COMPLAINANT'S PETITION FOR REVIEW OF INITIAL DETERMINATION OF
INVALIDITY OF CLAIMS 19, 24 AND 30 (ORDER NO. 15)**

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INTRODUCTION

In Order No. 15, which issued as an initial determination, the Chief Administrative Law Judge (“CALJ”) determined that means-plus-function claims 19, 24 and 30 of U.S. Patent No. 5,825,352 (“the ’352 patent”) were indefinite because the patent specification did not disclose corresponding structure. *See generally* Order No. 15 at 10, 13, 15. Complainant Elan Microelectronics Corporation (“Elan”) respectfully requests that the Commission review Order No. 15 because the CALJ incorrectly applied Federal Circuit law and disregarded the testimony of both experts in finding that there is no corresponding structure disclosed in the patent specification.

The claims at issue are implemented in computer software, firmware or hardware logic. Thus, the corresponding structure will be an algorithm – a description of the steps a program would follow to perform the claimed function. The claim will be valid if “some” algorithm is disclosed. Despite consistent testimony that some algorithms are disclosed to perform the claimed functions, the CALJ ruled otherwise. To arrive at that determination, the CALJ erroneously applied a level of detail for the disclosure not required by Federal Circuit precedent. First, the CALJ dismissed written descriptions in the specification that Apple's own expert agreed disclosed corresponding algorithms. The CALJ would apparently require depictions of flow charts or logic diagrams to satisfy as an algorithm. Federal Circuit law, however, recognizes that algorithms may be disclosed in writing. Further, the CALJ also demands the verbatim recitation of elementary mathematical functions well-known to those skilled in the art. The patent law not only does not include such a requirement, it actively discourages such unnecessary description. Finally, the CALJ would require the complete repetition of a detailed algorithm each time an alternative or modification is disclosed for a particular step, even when

the consistent testimony of the experts shows that there is a written description of the alternative. When reviewed in light of the proper requirements, the patent discloses algorithms corresponding to dependent claims 19, 24 and 30. The initial determination should therefore be reviewed and reversed. Elan also respectfully requests the Commission to review whether this motion, based upon the parties claim construction positions set forth in the *Markman* proceedings should be subject to a partial initial determination.

PRELIMINARY STATEMENT

I. STATEMENT OF THE ISSUES FOR REVIEW

1. Whether the CALJ erred in finding that an algorithm necessary to provide structure for a means plus function claim element relating to computer logic must be disclosed in the form a flow chart and not in a written description of the steps of the algorithm, and whether the CALJ's decision is clearly erroneous based on the testimony by both private parties' experts that algorithms corresponding to the claims are disclosed in the patent.

2. Whether the resolution of this issue, stemming from a *Markman* proceeding should be the subject of a partial summary determination ruling.

II. PROCEDURAL BACKGROUND

This investigation was initiated on April 23, 2010 based on Elan's Complaint filed on March 28, 2010. The subject of the investigation is whether Apple, Inc. has violated section 337 by its importation and sale of products practicing Elan's '352 patent. The '352 patent relates to touch sensitive input devices, such as computer touchpads and touchscreens. In particular, the '352 patent claims a novel method of capturing and analyzing the data from the touch sensitive surface to determine the number of fingers simultaneously present. The patent also discloses and claim refinements to and uses for that determination, for example by translating the number

of fingers present, along with motion and/or the time the fingers are in contact, into input commands. Independent claim 1 is a method claim, while independent claim 18 is a means-plus-function claim, where the function corresponds to the steps of method claim 1. *See* JX-1 at 16:17-20, 17:29-34. Dependent claims 19, 24, and 30 are means-plus-function claims where the functions correspond to the steps of method claims 14, 10, and 16 respectively. *See* JX-1 at 16:57-60, 17:10-15, 17:21-23.

In this investigation, the CALJ ordered the parties to file competing motions for summary determination regarding claim construction by July 14, 2010. Order No. 8. As part of their motion for partial summary determination on claim construction, Apple and the Staff alleged that certain means plus function claims were invalid as indefinite. After receiving briefing and supporting declarations, the CALJ held a two-day hearing, with live testimony from the parties' experts. On September 3, 2010 and September 10, 2010 the parties filed opening and responsive post-hearing briefs. Order No. 15 followed on September 28, 2010.

ARGUMENT

I. STANDARD OF REVIEW

The Commission derives its authority to review initial determinations from section 557(b) of the Administrative Procedure Act, which provides:

When the presiding employee makes an initial decision, that decision then becomes the decision of the agency without further proceedings unless there is an appeal to, or review on the motion of, the agency within the time provided by rule. On appeal from or review of the initial decision, the agency has all the powers which it would have in making the initial decision except as it may limit the issues on notice of by rule.

5 U.S.C. § 557(b).

Commission Rule 210.43(b)(1) establishes the standard the Commission employs when considering whether to review an initial determination. Review is appropriate where:

- (i) a finding or conclusion of material fact is clearly erroneous;
- (ii) a legal conclusion is erroneous, without governing precedent, rule or law, or constitutes an abuse of discretion; or
- (iii) the determination is one affecting Commission policy.

19 C.F.R. § 210.43(b)(1). The Commission will grant review “if it appears that an error or abuse of the type described in paragraph (b)(1) of this section is present or if the petition raises a policy matter connected with the initial determination, which the Commission thinks it necessary or appropriate to address.” 19 C.F.R. § 210.43(d)(2).

Once the Commission orders review of an initial determination, its review is *de novo*. See *Certain Polyethylene Terephthalate Yarn and Products Containing Same*, Inv. No. 337-TA-457, Comm’n Op. (June 18, 2002).

II. THE CALJ ERRED IN DETERMINING THAT CLAIMS 19, 24 AND 30 ARE INVALID

The Commission should review Order No. 15 under Commission Rule 210.43(b)(1)(ii) because the CALJ’s determination that claims 19, 24 and 30 of the ’352 patent are invalid for indefiniteness is “a legal conclusion [that] is erroneous.” 19 C.F.R. § 210.43(b)(1)(ii). The CALJ concludes that “the Federal Circuit requires disclosure of an algorithm for performing the function of the claim term, *regardless of how well-known or simple that algorithm may be.*” (Order No. 15 at 5) (emphasis added). However, the CALJ misapprehends what constitutes an algorithm and applies an unreasonable standard for the level of disclosure required of such an algorithm. The cases relied upon by the CALJ address instances where no algorithm is disclosed in the patent-at-issue. In *Encyclopaedia Britannica, Inc. v. Alpine Electronics, Inc.*, 355 Fed. Appx. 389 (Fed. Cir. 2009) (unpublished), the specification “fail[ed] to disclose anything more than a computer designed to perform a particular function” without disclosing

any actual algorithm. *Id.* at 394. The Federal Circuit explicitly distinguished the patent in *Encyclopaedia* from other cases where it found definiteness “because algorithms were in fact disclosed in those cases.” *Id.* Likewise, in *Biomedino, LLC v. Waters Tech. Corp.*, 490 F.3d 946 (Fed. Cir. 2007), the issue was whether there was any structure disclosed by the patent. *Id.* at 952. The Federal Circuit rejected the patentee’s reliance on a bare statement that known techniques or methods can be used as structure. *Id.* at 953. Thus, the cases relied upon by the CALJ relate to whether *any* structure is disclosed – not the sufficiency of the disclosed structure.¹ The proper test for definiteness under 35 U.S.C. § 112 ¶ 6 for a claim relating to a special purpose computer “is not whether the algorithm that was disclosed was described with sufficient specificity, but *whether an algorithm was disclosed at all.*” *Aristocrat Techs. Austral. Pty Ltd. v. Int’l Game Tech*, 521 F.3d 1328, 1337 (Fed Cir. 2008) (emphasis added).

Here, the claims in dispute, claims 19, 24, and 30, are dependent claims that are dependent on an independent means plus function claim 18. Independent claim 18 reads as follows:

18. A touch sensor for detecting the operative coupling of multiple fingers comprising:

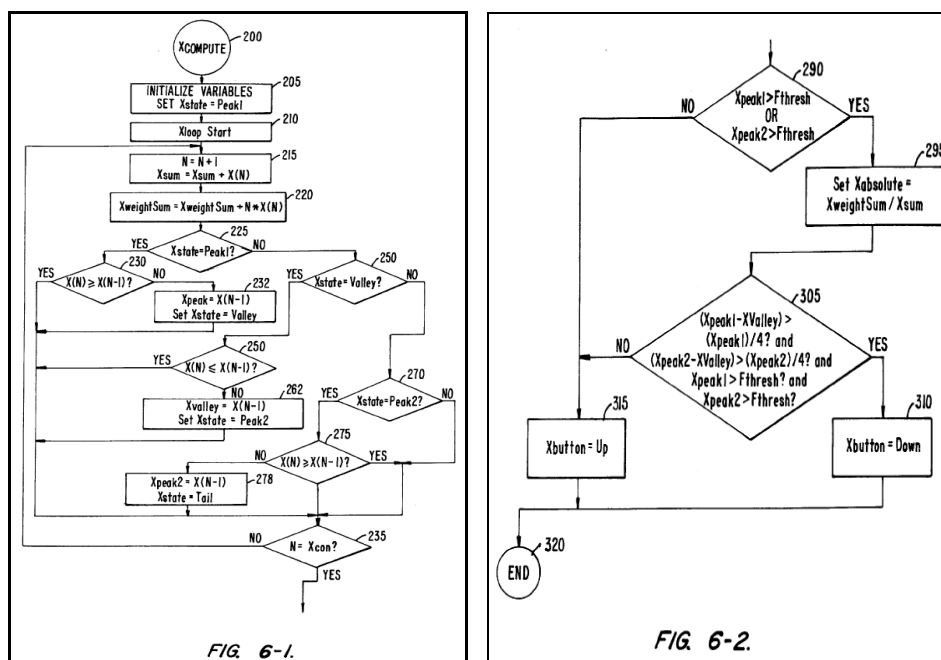
means for scanning the touch sensor to (a) identify a first maxima in a signal corresponding to a first finger, (b) identify a minima following the first maxima, and (c) identify a second maxima in a signal corresponding to a second finger following said minima, and

means for providing an indication of the simultaneous presence of two fingers in response to identification of said first and second maxima.

(JX-1 at 17:27-38).

¹ The CALJ also relies upon *Lucent Techs., Inc. v. Gateway Inc.*, 543 F.3d 710 (Fed. Cir. 2008). However, in *Lucent*, the issue regarding whether the specification disclosed “sufficient structure” for a means plus function claim was for determining a contract dispute regarding the priority date of that claim and was unrelated to whether the specification satisfied the definiteness requirement. *Id.* at 719-20.

For asserted independent claim 18, the parties agree that there is structure, including detailed algorithms, disclosed in the '352 patent. For instance, the patent makes clear that the operation of the claimed touch sensor may be “controlled in either firmware, software or hardware,” (JX-1 at 7:1-6), and that specific functions may be performed in driver software running on the host or firmware in the pointing device. (*Id.* at 7:29-33). The patent further discloses exemplary algorithms that respond to the identification of two maxima and minima to provide an indication of the simultaneous presence of two fingers. For example in the flowchart shown in Fig. 6-1, the maximas and minima are identified in steps 232, 262, and 278. (*Id.* at Fig. 6-1 & Fig. 9-1).



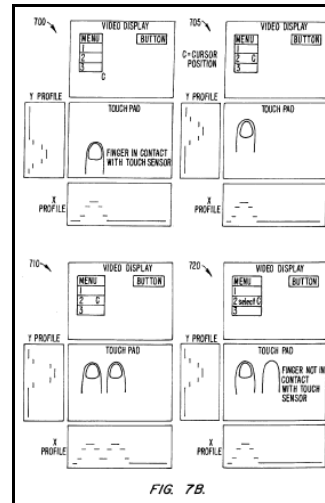
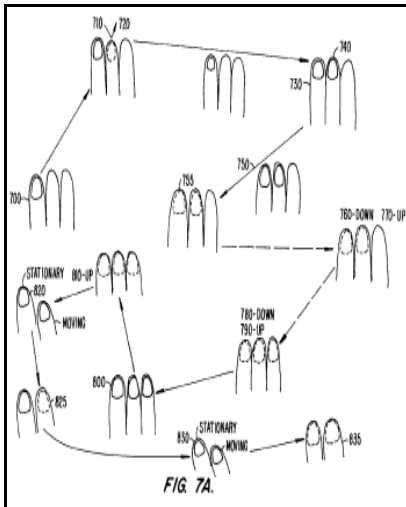
(JX-1 at Fig. 6-1 & 6-2)

The dependent claims at issue, claims 19, 24, and 30, all depend on independent claim 18 and further limit the claim to functions based on the independent claim. (JX-1 at 17:38-42; 18:14-16; 18:44-46). For instance, dependent claim 24 requires means for detecting distance

between the first and second maxima that were already identified by the means required in independent claim 18. (JX-1 at 18:14-16). Dependent claim 30 requires means for calculating the centroids of the first and second finger already identified by the means required in independent claim 18. (JX-1 at 18:44-46). The dependent claims rely upon the structure (i.e. hardware, software, and algorithms) required by the independent claim. Thus, the proper inquiry is whether there is structure for the additional means plus function limitations of the dependent claims. As explained further, the specification includes such structure for each disputed dependent claim.

A. Claim 19 – “means for selection an appropriate control function based on a combination of a number of fingers detected, an amount of time said fingers are detected, and any movement of said fingers”

The CALJ erred by too narrowly limiting the definition of algorithm to only flowcharts and by failing to apply the correct standard for whether structure is disclosed. An algorithm is a series of steps taken to achieve a goal, (DeBruine, Markman Hr’g at 102:3-13; Powers, *id.* at 102:17-20; Baer, *id.* at 102:23-24), and the disclosure of which maybe achieved through *written description, flow chart, or any other means* that conveys the requisite steps. *Tech. Patents LLC v. Deutsche Telekom AG*, Slip. Op. 2010 WL 3385397 at *20 (D. Md. Aug. 25, 2010) (emphasis added). The test for whether a disclosure, of any kind, satisfies the requirement of an algorithm is whether one of ordinary skill would recognize the patent disclosure to contain the requisite steps. *Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1385 (Fed. Cir. 2009).



(JX-1 at Fig. 7A & 7B)

Here, the CALJ found that Figs. 7A-7F, partially reproduced above, and column 13, lines 1-58 “do not constitute an algorithm, as said figures merely show various finger positions and capacitance profiles.” (Order 15 at 7). While true of the drawings, the written description corresponding to these figures disclose the algorithms that react to those “positions and capacitance profiles” to choose a control function. The CALJ’s conclusion is directly contradicted by the testimony of both Elan’s and Apple’s expert witnesses, each of whom testified that these portions of the specification do disclose algorithms. (Dezmelyk, Marman Hr’g at 307:11-311:3) (“So it is a way of the patentee of explaining this series of events on the hand that are related to what is happening on the surface of the touchpad.” *Id.* at 308:6-9). In particular, when Apple’s expert witness, Dr. Balakrishnan, was explicitly asked whether Figs. 7A-7F and column 13, lines 1-58 disclosed an algorithm, he responded:

Q. And that’s an algorithm, isn’t it?

A. This is an example algorithm, yeah.

(Balakrishnan, Markman Hr’g at 610:24-25).

The intrinsic evidence further contradicts the CALJ's finding. As explained above, an algorithm is a series of steps taken to achieve a goal. Figs. 7A-7F "show in diagrammatic form an exemplary sequence of finger contacts and movements across a touch sensor." (JX-1 at 4:65-67). Importantly, the written specification of the patent explains the Figs. 7A-7F by discussing the reaction of the touch sensor firmware or software to the sequence of the number of fingers and length of contact, along with movements (i.e. each step) and the corresponding choice of an appropriate function in response. (JX-1 at 12:15-13:58) ("The scans of the sensor then detect both the first and second finger being moved together across the sensor until the scan . . ." *Id.* at 12:49-51). Thus, the figures together with its corresponding written description constitute an algorithm that would be recognizable to a person of ordinary skill in the art, as confirmed by both experts. The initial determination of the CALJ to the contrary is therefore inconsistent with the controlling law and unsupported by the evidence.

B. Claim 24 – “means for detecting a distance between said first and second maxima”

The CALJ also erred by requiring the explicit disclosure of well known mathematical operations within otherwise detailed algorithms. Well known operations can be omitted when there is a detailed explanation, or algorithm, such that a person of ordinary skill in the art would recognize the omitted operation. *Aristocrat*, 521 F.3d at 1336. Thus, well known operations that are part of an algorithm can be omitted. *Id.* The CALJ relies on *Encyclopaedia Britannica* for the premise that “regardless of the simplicity of the algorithm involved, the specification must ‘explicitly disclose’ an algorithm for performing the claimed function.” (Order 15 at 12). However, in *Encyclopaedia* the specification “fail[ed] to disclose anything more than a computer designed to perform a particular function” without disclosing any actual algorithm and

thus the holding in that case is limited to when there is no underlying algorithm at all. *Encyclopaedia*, 355 Fed. Appx. at 394. That is not the case here.

As explained above, there is no dispute whether there is sufficient structure for determining the location of the first and second maxima as required in independent claim 18, for which claim 24 depends upon. This includes explicit hardware, software, and algorithms described in great detail in the patent figures and specification. (*See e.g.*, JX-1 at Fig. 9-1 & 9-2). As explained by Elan’s expert, the variables indicating the locations of the two maxima are calculated by the same algorithms and involve the additional omitted step of subtraction – namely subtracting the location of the first maxima from the location of the second maxima. (Dezmelyk, Marman Hr’g at 343:7-13). As subtraction is a well known operation that is part of a disclosed algorithm, the subtraction step was properly omitted by the patentee. The CALJ’s holding would be contrary to the goal of the patent system to disclose novel ideas and would instead distract the public as the patentee would be required to disclose every well known and minor step regardless of how elementary and miniscule.

C. Claim 30 – “means for calculating first and second centroids corresponding to said first and second fingers”

The CALJ erred by requiring the redundant disclosure of an already disclosed algorithm. As explained in the preceding section, an operation can be omitted if it is known to one of ordinary skill in the art and there is already a detailed explanation or algorithm. *Aristocrat*, 521 F.3d at 1336. It is undisputed that the ’352 patent provides sufficient structure for the calculation of one centroid. (Order 15 at 14). For the second centroid corresponding to a second finger, the patent states:

In a second implementation, a centroid value may be calculated for each maxima, yielding multiple centroid values when multiple fingers interact with the pad. *For*

purposes of clarity, the following description will be limited to the [determination of the first centroid].

(JX-1 at 8:40-45) (emphasis added).

Thus, the patent explicitly recognizes that it would be well known to a person of ordinary skill in the art to adapt the underlying algorithm for the first centroid to apply for multiple centroids. This was confirmed by Elan's expert who explained that the disclosed algorithm for determining the centroid of one finger would be used to determine the centroid for two fingers for each of the two maxima, (Dezmelyk, Markman Hr'g at 353:1-7), and agreed upon by Apple's expert. (Balakrishnan, *id.* at 637:5-8). Elan's expert explained that one skilled in the art would understand the patent's teaching of how to distinguish between the two fingers for calculating centroids by looking to the identified valley point. (Dezmelyk, *id.* at 353:1-7). Under the CALJ's holding, if the claim was directed to a third, fourth, and fifth finger the patentee would be required to explicitly disclose the underlying algorithm multiple times for each finger regardless of redundancy. This result runs contrary to the goal of the patent system for efficient disclosure.

III. THE COMMISSION SHOULD REVIEW ORDER NO. 15 BECAUSE IT IS ONE "AFFECTING COMMISSION POLICY" THAT PRESENTS A QUESTION IN WHICH THE COMMISSION "IS PARTICULARLY INTERESTED"

The Commission should review Order No. 15 for the same reasons it has determined to review the CALJ's initial determination on claim construction in the 703 investigation. *See Certain Mobile Telephones and Wireless Communication Devices Featuring Digital Cameras, and Components Thereof*, Inv. No. 337-TA-703, July 22, 2010 Comm'n Notice ("*Digital Cameras*"). Order No. 15 is inherently an initial determination on claim construction of the kind in which the Commission recently declared it "is particularly interested" and one that deserves

review as an issue “affecting Commission policy” under Commission Rule 210.43(b)(1)(iii).
See id. at 2; *see also* 19 C.F.R. § 210.43(b)(1)(iii).

First, Order No. 15 presents an issue of claim construction. “Indefiniteness is a matter of claim construction, and the same principles that generally govern claim construction are applicable to determining whether allegedly indefinite claim language is subject to construction.” *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1306, 1319 (Fed. Cir. 2008) (citing *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342 (Fed. Cir. 2005)). Section 112 of the Patent Act, which at paragraph 2 catalyzed the indefiniteness doctrine, requires that a specification include claims “particularly pointing out and distinctly claiming subject matter which the applicant regards as his invention.” 35 U.S.C. § 112 ¶ 2. The indefiniteness doctrine exists to avoid “[a] zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field.” *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 223, 236 (1942). This “zone of uncertainty” is avoided if “one skilled in the art would understand the bounds of the claim when read in light of the specification.” *E.g., Exxon Research & Eng’g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001). Because the indefiniteness doctrine is sourced in an analysis of how one of ordinary skill in the art would understand a patent specification’s claim terms, “[d]etermination of claim indefiniteness is a legal conclusion that is drawn from the court’s performance of its duty as the construer of patent claims.” *E.g., Personalized Media Communications, L.L.C. v. U.S. Int’l Trade Comm’n*, 161 F.3d 696, 702 (Fed. Cir. 1998), *quoted in Exxon Research & Eng’g*, 265 F.3d at 1376.

The indefiniteness doctrine is not only sourced from the judiciary’s role as a construer of patent claims, but it mechanically “requires a construction of the claims according to familiar

canons of claim construction.” See e.g., *Oakley, Inc. v. Sunglass Hut Int’l*, 316 F.3d 1331, 1340-41 (Fed. Cir. 2003), *quoted in Datamize*, 417 F.3d at 1348; see also *Enzo Biochem, Inc. v. Applera Corp.*, 599 F.3d 1325, 1333-34 (Fed. Cir. 2010) (“[W]hen a claim limitation is defined in ‘purely functional terms,’ a determination of whether the limitation is sufficiently definite is ‘highly dependent on context (e.g., the disclosure of the specification and the knowledge of a person of ordinary skill in the relevant art area).” (quoting *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1255 (Fed. Cir. 2008))). An analysis of indefiniteness is thus governed by “general principles of claim construction.” See, e.g., *Young v. Lumenis, Inc.*, 492 F.3d 1336, 1346 (Fed. Cir. 2007) (quoting *Datamize*, 417 F.3d at 1348), *quoted in Enzo Biochem*, 599 F.3d at 1332 (“Indefiniteness requires a determination whether those skilled in the art would understand what is claimed. To make that determination, we have explained that ‘[i]n the face of an allegation of indefiniteness, general principles of claim construction apply.’”).

At the appellate level, review of an initial indefiniteness determination often hinges on review of the claim construction giving rise to the finding of indefiniteness. See generally *Enzo Biochem*, 599 F.3d at 1332-36 (reversing the lower court and deeming claim language “not indefinite” based on a claim construction analysis); *Praxair*, 543 F.3d at 1319-21 (reversing the lower court’s finding of indefiniteness and adopting the appellant’s proposed claim construction of the relevant claim term); *Young*, 492 F.3d at 1344-47 (reversing the lower court’s finding of indefiniteness based on a claim construction focusing on intrinsic evidence); *Exxon Research & Eng’g*, 265 F.3d at 1375-80 (reversing the lower court’s finding of indefiniteness based on a claim construction analysis). Thus, the Commission’s review of the CALJ’s invalidity determination requires an analysis of the CALJ’s construction of claims 19, 24 and 30.

Second, Order No. 15 presents an issue “affecting Commission policy” under Commission Rule 210.43(b)(1)(iii) because the Commission has recently decided to consider whether initial determinations that contain claim construction analyses are properly issued under Commission Rules 210.18 and 210.42. Because the Commission has taken an interest in initial determinations involving claim construction issues and because the invalidation of a patent based on indefiniteness of certain claim terms requires an implicit construction of those terms, the Commission should review Order No. 15. In the 703 investigation, the Commission determined to review the CALJ’s initial determination on claim construction because:

[t]he Commission is particularly interested in briefing on the question of the legal authority for addressing the issue of claim construction as a matter for summary determination and treating the claim construction ruling as an initial determination under the Commission’s rules of practice and procedure as currently written.

Digital Cameras, July 22, 2010 Comm’n Notice at 2. Order No. 15 presents the Commission with the opportunity to consider whether initial determinations that implicitly rely on claim construction decisions and are governed by principles of claim construction are properly issued as initial determinations. And because the Commission’s review in the 703 investigation remains pending, the Commission has the opportunity to resolve these important questions of Commission policy coterminously.

Because Order No. 15 is an issue that “address[es] the issue of claim construction as a matter for summary determination and . . . an initial determination,” an issue in which the Commission is “particularly interested,” the Commission should review Order No. 15 under Commission Rule 210.43(b)(1)(iii). *See* 19 C.F.R. § 210.43(b)(1)(iii); *Digital Cameras*, July 22, 2010 Comm’n Notice at 2.

CONCLUSION

For the foregoing reasons Elan respectfully requests that the Commission review Order No. 15.

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing
**COMPLAINANT'S PETITION FOR REVIEW OF INITIAL
DETERMINATION OF INVALIDITY OF CLAIMS 19, 24 AND 30
(ORDER NO. 15)** was served on the indicated dates by the indicated means to the
persons at the addresses below:

The Honorable Marilyn R. Abbott Secretary U.S. International Trade Commission 500 E Street, S.W., Room 112-A Washington, D.C. 20436	Via EDIS (October 6, 2010) and Hand Delivery (12 copies on October 7, 2010)
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