Exhibit J

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

Before The Honorable Paul J. Luckern
Chief Administrative Law Judge

In the Matter of **CERTAIN ELECTRONIC DEVICES WITH MULTI-TOUCH ENABLED TOUCHPADS AND TOUCHSCREENS**	**Inv. No. 337-TA-714**

COMMISSION INVESTIGATIVE STAFF
MOTION FOR SUMMARY DETERMINATION
OF CLAIM CONSTRUCTION

Pursuant to Order No. 9 (June 22, 2010), which directed the parties to address the issue of claim construction under Rule 201.18, the Commission Investigative Staff ("Staff") respectfully moves for summary determination that the claim terms at issue in U.S. Patent No. 5,825,352 should be construed as proposed by the Staff.[1] As set forth in the supporting memorandum, the Staff's proposed constructions are consistent with the claim language, patent specification, and prosecution history, and no genuine issue of material fact exists with respect to the Staff's proposed constructions. Accordingly, summary determination is appropriate.

In conjunction with adjudicating the proper claim construction, the Staff seeks a ruling holding that claims 19, 24, 26, and 30 are invalid as indefinite. These means-plus-function claims have no supporting structure disclosed in the specification. Thus, claims 19, 24, 26, and

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[1] In Investigation 337-703, the Commission is reviewing whether an ID is the correct procedural mechanism for issuing a claim construction ruling.

30 are incapable of being construed and are therefore indefinite. *Cardiac Pacemakers Inc. v. St. Jude Medical, Inc.*, 296 F.3d 1106, 1114 (Fed. Cir. 2002) (holding that a means-plus-function claim cannot be construed and is invalid where the specification fails to disclose corresponding structure).

The Staff's accompanying memorandum also serves as the Staff's opposition to the private parties' summary determination motions concerning claim construction to the extent the private parties' proposed constructions differ from the Staff's proposed claim constructions.

Respectfully submitted,

s/Kevin Baer
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July 26, 2010

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CERTAIN ELECTRONIC DEVICES WITH MULTI-TOUCH ENABLED TOUCHPADS AND TOUCHSCREENS

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COMMISSION INVESTIGATIVE STAFF'S
MEMORANDUM IN SUPPORT OF SUMMARY DETERMINATION
OF CLAIM CONSTRUCTION

The Commission Investigative Staff ("Staff") respectfully submits this memorandum in support of its motion for summary determination on its proposed claim constructions. As set forth below, the Staff's proposed claim constructions are consistent with the claim language, specification, and prosecution history, and no genuine issue of material fact exists with respect to the Staff's proposed constructions. Accordingly, summary determination is appropriate.

As set forth below, claims 19, 24, 26, and 30 are incapable of being construed and thus are indefinite. Therefore, a ruling holding that claims 19, 24, 26, and 30 are invalid as indefinite is appropriate.

I.   LEGAL STANDARDS

A.   Summary Determination

Motions for summary determination are governed by Commission Rule 210.18, 19 C.F.R. §210.18, which provides that any party may move with necessary supporting affidavits for a

summary determination of any or all of the issues to be decided in the investigation. "The

determination sought by the moving party shall be rendered if the pleadings and any depositions,

answers to interrogatories, and admissions on file, together with the affidavits, if any, show that

there is no genuine issue as to any material fact and that the moving party is entitled to a

summary determination as a matter of law." 19 C.F.R. §210.18(b); *see also Becton Dickinson*

and Co. v. C.R. Bard, Inc., 922 F.2d 792, 795 (Fed. Cir. 1990); *Certain Telephonic Digital*

Added Main Line Systems, Inv. No. 337-TA-400, Order No. 6: Initial Determination Granting

Complainant's Motion No. 400-1 For Partial Summary Determination Re Economic Prong at 2-3

(Nov. 6, 1997).

B.   Claim Construction

Claim construction is determined as a matter of law. *Cybor Corp. v. FAS Technologies,*

Inc., 138 F.3d 1448, 1455-56 (Fed. Cir. 1998) (en banc); *Markman v. Westview Instruments, Inc.*,

52 F.3d 969, 976 (Fed. Cir. 1995) (en banc), *aff'd*, 116 S.Ct. 1384 (1996). The claim language

defines the scope of the claims. *Catalina Marketing International, Inc. v. Coolsavings.com, Inc.*,

289 F.3d 801, 807 (Fed. Cir. 2002).

In interpreting a claim, three sources must be considered: the claims, the specification,

and the prosecution history. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir.

1996); *Markman*, 52 F.3d at 976. The claim is to be interpreted from the perspective of the

"person of ordinary skill in the field of the invention," who "is deemed to read the words used in

the patent documents with an understanding of their meaning in the field, and to have knowledge

of any special meaning and usage in the field." *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133

F.3d 1473, 1477 (Fed. Cir. 1998). Words in a claim are presumed to carry their ordinary and

customary meaning to one of ordinary skill in the art at the time of the invention. *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, (Fed. Cir. 2002); *Toro Co. v. White Consolidated Industries, Inc.*, 199 F.3d 1295, 1299 (Fed. Cir. 1999). Moreover, the same term or phrase should be interpreted consistently where it appears in claims of common ancestry. *Epcon Gas Sys. v. Bauer Compressors*, 279 F.3d 1022, 1030 (Fed. Cir. 2002); *Elkay Mfg. Co. v. Ebco Mfg. Co.*, 192 F.3d 973, 980 (Fed. Cir. 1999).

Claims are to be read in view of the specification. *Markman*, 52 F.3d at 979. The specification may act as a dictionary, explaining the invention and defining terms used in the claims. If a patentee is his or her own lexicographer, any special definition given to a word must be clear in the specification. *Vitronics*, 90 F.3d at 1582-83; *Markman*, 52 F.3d at 979. The claims, however, and not the written description part of the specification, delimit the right to exclude others from making, using, selling or importing the claimed invention. *Markman*, 52 F.3d at 979. Additionally, "[c]laims are not necessarily and not usually limited in scope simply to the preferred embodiment." *RF Delaware, Inc. v. Pacific Keystone Technologies, Inc.*, 326 F.3d 1255, 1263 (Fed. Cir. 2003), *citing Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1370 (Fed. Cir. 2003).

Consulting information extrinsic to the patent and its file history, while not absolutely prohibited in constructing claims, is "less reliable than the patent and its prosecution history." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1318 (Fed. Cir. 2005) (noting that litigation-derived expert reports and testimony are especially suspect). "[E]xpert testimony at odds with the intrinsic evidence must be disregarded." *Network Commerce, Inc. v. Microsoft Corp.*, 422 F.3d 1353, 1361 (Fed. Cir. 2005) (holding that unsupported conclusions concerning patent claims

provide little weight for suggested claim construction). Not all extrinsic information, however, must be disregarded. For example, if "the ordinary meaning of the claim term as understood by a person of skill in the art may be readily apparent even to lay judges," then general purpose dictionaries may be helpful. *Phillips*, 415 F.3d at 1314.

With any functional means-plus-function claiming, review of the specification for the necessary structure to support the claimed function is required. *See Aristocrat Technologies v. International Game Technology*, 521 F.3d 1328, 1031 (Fed. Cir. 2008) ("the scope of that claim limitation had to be defined by the structure disclosed in the specification plus any equivalents of that structure"). In exchange for the convenience of employing § 112, ¶ 6, the Patent Act requires that the specification must disclose corresponding structure. *See Kahn v. General Motors*, 135 F.3d 1472, 1476 (Fed. Cir. 1998). The purpose of means-plus-function claiming is to allow a function to be described in the claim as long as there is structure disclosed in the specification to accomplish the function. *See Biomedino, LLC v. Waters Tech. Corporation*, 490 F.3d 946, 953 (Fed. Cir. 2007) ("The inquiry is whether one of skill in the art would understand the specification itself to disclose a structure, not simply whether that person would be capable of implementing a structure.")

In addition, failure to disclose *any* corresponding structure to carry out the claimed function renders the claim indefinite under 35 U.S.C. § 112 ¶ 2. *See Cardiac Pacemakers Inc. v. St. Jude Medical, Inc.*, 296 F.3d 1106, 1114 (Fed. Cir. 2002) (holding that a means-plus-function claim cannot be construed and is invalid where the specification fails to disclose corresponding structure); *see also Default Proof Credit Card System, Inc. v. Home Depot U.S.A., Inc.,* 412 F.3d 1291, 1302 (Fed.Cir. 2005) ("the testimony of one of ordinary skill in the art cannot supplant the

total absence of structure from the specification. . . . [Patentee] cannot use the declaration of its expert to rewrite the patent's specification.")

Where the means-plus-function claim is directed to a computer program, the disclosed structure is limited to the disclosed program (or algorithm) found in the specification and does not encompass any program that could accomplish the claimed function. *See WMS Gaming v. International Game Technology*, 184 F.3d 1339, 1348-49 (Fed. Cir. 1999) (holding that for means-plus-function claims, the structure that includes a general purpose computer must also include the disclosed algorithm). Without disclosing an algorithm as a necessary part of the disclosed structure, the claim becomes a purely functional claim – any device that accomplishes the function. Such claiming in means-plus-function format is prohibited. *See Aristocrat*, 521 F.3d at 1333 (to avoid purely functional claiming "this court has consistently required that the structure disclosed in the specification be more than simply a general purpose computer or microprocessor"); *see Finisar Corporation v. The DirectTV Group*, 523 F.3d 1323, 1340-41 (Fed. Cir. 2008) ("Simply reciting 'software' without providing some detail about the means to accomplish the function is not enough."). Failure to disclosure an algorithm in the specification for a computer-implemented means-plus-function claim renders the claim invalid as indefinite under 35 U.S.C. § 112. *See Aristocrat*, 521 F.3d at 1335-39.

II. CLAIM CONSTRUCTION DISCUSSION

A. The '352 Patent

The '352 patent, entitled "Multiple Fingers Contact Sensing Method for Emulating Mouse Buttons and Mouse Operations on a Touch Sensor Pad," issued on October 20, 1998, 2001, based on an application that was filed on February 28, 1996. The patent application is a

continuation of an application that was filed on January 4, 1996. The named inventors are

Stephen J. Bisset and Bernard Kasser.

The patent's abstract states:

> Method and apparatus for detecting an operative coupling between
> one or more fingers or other appropriate objects and a touch pad
> includes processes for detection of multiple maxima with
> intermediate minima in appropriate sequences to emulate the
> operations of cursor control and button actuations in a pointing and
> control device.

Complainant Elan asserts independent claims 1 and 18. Independent claim 1 is a method claim,

with dependent claims 2, 4, 7, 10, 12, 14 and 16 also asserted by Elan. Independent claim 1

reads:

> A method for detecting the operative coupling of multiple fingers to a touch
> sensor involving the steps of
>
> 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, (c) identify a
> second maxima in a signal corresponding to a second finger following said
> minima, and
>
> providing an indication of the simultaneous presence of two fingers in response to
> identification of said first and second maxima.

Independent claim 18 is an apparatus claim, with dependent claims 19, 21, 24, 26 and 30 also

asserted by Elan. Independent claim 18 reads:

> 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.

B. Level of Ordinary Skill in the Art

Complainant Elan and Respondent Apple do not appear to have a disagreement concerning the level of ordinary skill in the art. *Compare* Elan Memo. at 9 *with* Apple's Expert Declaration (Balakrishnan) ¶ 10. For purposes of claim construction, the Staff agrees with Elan that "one of ordinary skill would have an undergraduate degree in electrical engineering or computer science with class work on electrical circuits, and about three years of experience in the design and operation of touch-sensitive input devices. One with a more advanced degree may have less practical experience." *See* Elan Memo. at 9.

C. Staff's Proposed Claim Construction

1. "scanning the touch sensor" (Claim 1)

Elan and Apple concur that the term "scanning the touch sensor" of claim 1 should be construed to mean: "Measuring the values generated by a touch sensor to detect operative coupling and determining the corresponding positions at which the measurements are made." *See* Joint Claim Construction Submission (June 9, 2010). The Staff agrees with that proposed claim construction, in part. The Staff believes that the claim element "scanning the touch sensor" should be construed to mean "obtaining the values generated by a touch sensor to detect operative coupling." The plain language of the claim and the patent specification teach that the touch pad merely obtains raw data generated by touching the touch sensor, whereas a computer analyses the data to obtain position information. The scanning of a touch pad does not provide position information – that is a later step in the method claim.

2. "identify a first maxima in a signal corresponding to a first finger" (Claim 1)[1]

Elan and Apple disagree on the proper construction and each offers the following proposed claim construction.

Elan's Proposed Construction	Apple's Proposed Construction
Identify a first highest absolute value in the a first set of values derived from the coupling of a first finger with the touch sensor	Identify a first peak value in a finger profile taken on an axis obtained from scanning the touch sensor

In the Staff's view, Apple's proposed claim construction is correct and the Staff proposes the same claim construction. The '352 patent repeatedly teaches that the "signal" is a finger profile taken on an axis. *See, e.g.,* Figs. 3, 4 and 7B-7F-2. Moreover, figures 3 and 4 of the '352 patent are specifically referred to as "the present invention." Col. 4:56-59. In addition, the specification, while discussing the timing element of the first and second finger, states that the invention requires that the finger profile caused by touching the touchpad be along an axis so that a minimum can be distinguished from a peak value. With each and every example in the specification, including the examples describes as "the present invention," showing that the signal is a finger profile derived on an axis, the claim should likewise be construed.

The prosecution history supports this claim construction. In arguing that certain prior art did not invalidate the claims, the applicant emphasized that "the invention" used profile

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[1] Both Elan and Apple treat the discussion concerning this claim element as relevant to both claim 1 and claim 18. The Staff, however, will treat the two claims separately. Claim 18 is an apparatus claim written in means plus function format. As will be discussed below, the necessary structure found in the specification to support the claimed function of Claim 18 includes a computer, and thus the disclosed algorithm becomes part of the claimed structure for this means plus function claim.

information for detecting maxima. Amendment at 3-4 (April 8, 1998) (Apple Ex. U). The applicant pointed out to the Patent and Trademark Office that asserted claims 1 and 18 (then application claims 1 and 35) "are directed to the feature of the invention which detects multiple fingers by detecting multiple maxima in the profile on the touchpad." *Id*. at 3. Thus, the prosecution history supports the Staff's proposed claim construction.

Elan's arguments (Memo. at 10-12) concerning this claim element fails to discuss the complete specification or the prosecution history. Moreover, even Elan's brief discussion does not show that the signal is anything other than a finger profile on an axis. At most, Elan demonstrates that the invention is not limited to an X or Y axis, but that other axes could be used. Regardless of which axis is used, however, a finger profile is required.

Elan's argument should also be rejected on judicial estoppel grounds. In a previous litigation, Elan's predecessor-in-interest (Elantech) successfully argued that "the claimed 'first maxima' simply means a first peak value, which can be derived by examining a finger profile." Apple Ex. E at p. 6 (Elantech Reply Brief). Elan's then-opponent had unsuccessfully sought a narrower construction which limited a maximum to a point where the measured value ceased to increase and began to decrease. Having successfully argued for a particular claim construction, Elan should not now be heard to argue against the same construction.

3. "identify a minima following the first maxima" (Claim 1)

Elan's Proposed Construction	Apple's Proposed Construction
Identify a lowest absolute value that follows the first maxima	Identify the lowest value in the finger profile taken on said axis that occurs after the first peak value, and before another peak value is identified

This claim element and the following are discussed together immediately below.

4.   **"identify a second maxima in a signal corresponding**
to a second finger following said minima " (Claim 1)

Elan's Proposed Construction	Apple's Proposed Construction
Identify a second highest absolute value in a set of values derived from the coupling of a second finger with the touch sensor that follows the minima	After identifying the lowest value in the finger profile taken on said axis, identify a second peak value in the finger profile taken on said axis.

In addition to the discussion above concerning "identify a first maximum," which is equally applicable to the claim elements "identify a minima" and "identify a second maxima," Elan and Apple disagree whether these latter two claim elements require a sequential operation (*e.g.,* whether they include a temporal limitation). The disputed claim term is "following" and the debate is whether "following" means "in time" or "in space." Apple argues that both time and space are incorporated into the term "following." Elan argues that in means only "in space" and there is no timing element in the claim. In the Staff's view, the plain language of the claim governs that the method steps are performed sequentially in time. The claimed second "maxima" must happened afterwards in time with respect to the previously identified "said minima." In other words, the "said minima" must first exist in order for the second maxima to be found. The "said minima" needs to exist prior in time (and in space) or otherwise one could not begin to search for the second maxima.

Elan's proposed construction should not be adopted because it incorporates the word "follow" into its definition of the disputed claim element that includes the word "following." The key question is what does "following" mean, so defining the disputed claim element with the disputed term lends little assistance in understanding what the disputed term means. In addition,

Elan's argument fails to explain how the second maxima could be found prior in time to finding the minima when the minima is used to identify the second maximum.

5. "identify" (Claim 1)

Elan's Proposed Construction	Apple's Proposed Construction
plain meaning[2]	recognize a value to be

The Staff proposes that the claim term "identify" be defined to mean "to ascertain the origin, nature or definitive characteristics of." The American Heritage Dictionary, Second College Ed. 1982 at p. 639. This definition is consistent with the plain meaning and with Apple's proposed construction. The dictionary definition also provides an alternative definition: "to establish the identity of" (*id.*) with "identity" defined as "The collective aspect of the set of characteristics by which a thing is definitively recognizable or known." *Id.* The plain meaning dictionary definitions provide a firm context for the word "identify" and requires the maxima/minima/second maxima be definitively recognized as existing as defined values as compared to just being a collection of raw data from which one might extract a value.

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[2] Elan's argument that the plain meaning should control without offering any definition of what the plain meaning actually means is not helpful to providing a static definition of the claim term.

6. "in response to" (Claim 1)

Elan's Proposed Construction	Apple's Proposed Construction
plain meaning	after and in reaction to

The Staff agrees that Apple's proposed construction is correct. The proposed construction is consistent with a dictionary definition for "response:" "a reply or answer." The American Heritage Dictionary, Second College Ed. 1982 at p. 1053. The various definitions for "response" or "respond" connote a subsequent action in reaction to a previous action. Elan has offered no proposed construction; merely stating that the plain meaning should apply without providing any definition of the plain meaning.

7. "pointing device click function (claim 2)

Elan and Apple concur that the term "pointing device click function" of claim 2 should be construed to mean: "function that would normally result from the button click of a pointing device." *See* Joint Claim Construction Submission (June 9, 2010). The Staff agrees with this proposed claim construction .

8. select function (claim 4)

Elan and Apple concur that the term "select function" of claim 4 should be construed to mean: "A selection of an item or range of items." *See* Joint Claim Construction Submission (June 9, 2010). The Staff agrees with this proposed claim construction .

9. control function (14, 19)

Elan's Proposed Construction	Apple's Proposed Construction
A function in response to contact with the touch sensor other than or in addition to movement of a cursor	Function that would normally be provided by the actuation of the buttons or switches on a mouse.

The Staff agrees with Apple's proposed claim construction for the term "control function," found in method claim 14. Elan does not appear to have included this term in its motion for summary determination, although the disputed term was identified in the private parties' Joint Claim Construction Submission. The specification fully supports Apple's proposed claim construction. First, the title of the patent is "Multiple Fingers Contact Sensing Method for Emulating Mouse Buttons and Mouse Operations on a Touch Screen Pad." The language in the title pertaining to a computer mouse was added during prosecution, which strongly suggests that the inventors wanted the invention for a substitute for the traditional computer mouse. Second, the specification also defines "the present invention" as one finger controlling movement of the cursor, and the second finger as controlling functions equivalent to a mouse button or switch." Col. 2:56-60.

10. "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" (Claim 18)

In the Staff's view, the private parties failed to identify correctly the full function of this means plus function limitation. Instead, the private parties agreed that for the term "means for scanning the touch sensor," the function is "scanning the touch sensor" and that the corresponding structure found in the specification is "an analog multiplexer, a circuit to measure

changes in capacitance of sensor conductors, an analog to digital converter, a microcontroller,

and equivalents thereof." Joint Claim Construction Submission at 5.

However, the plain language of claim 18 details that the claimed function is not merely

scanning, but "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." Thus, the

corresponding structure must accomplish the entirety of the claimed function, not merely

scanning the touch sensor. The Staff agrees, in part, that the disclosed structure includes "an

analog multiplexer, a circuit to measure changes in capacitance of sensor conductors, an analog

to digital converter, a microcontroller." By including the microcontroller, however, the

algorithms disclosed in the specification for performing the claimed function are necessarily

included as part of the required structure. *"In cases involving a computer-implemented*

invention in which the inventor has invoked means-plus-function claiming, this court has

consistently required that the structure disclosed in the specification be more than simply a

general purpose computer or microprocessor." Aristocrat Tech., 521 F.3d at 1333. In the

specification the disclosed algorithm to accomplish the claimed function is Fig. 5 (items, 400-

440) and Fig. 6-1 (items 200-278).[3]

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[3] As noted, the private parties have not identified the correct function of claim 18 and
thus have not yet identified the correct corresponding algorithm. To the extent the private parties
identify different algorithms in a reply filing, the Staff will continue to work with the private
parties in an attempt to narrow any disagreement concerning the scope of the disclosed structure.

11. **"means for providing an indication of the simultaneous presence of two fingers in response to the identification of said first and second maxima" (Claim 18)**

Elan's Proposed Construction	Apple's Proposed Construction
The function is providing an indication of the simultaneous presence of two fingers in response to identification of said first and second maxima. The corresponding structure is firmware or software that provides data indicating the presence of two fingers in response to the identification of two maxima and equivalents thereof See e.g. Figs. 5 (steps 465, 540), 6-1, 6-2 (step 310), 8-1 (steps 860, 915), 9-1 and 9-2 (steps 980), 7:1-6, 7:49-8:15, 14:3-55 and 15:12-31	This limitation is governed by 35 U.S.C. § 112(6). The recited function is providing an indication of the simultaneous presence of two fingers in response to identification of said first and second maxima. The corresponding structure is the algorithm found in Fig. 8-1, which sets a Finger value equal to two after determining if a scan in either the X direction or the Y direction has detected two fingers.

The Staff agrees that the private parties have correctly identified the claimed function.[4] In the Staff's view, the correct corresponding structure is a microcontroller programmed as shown in Fig. 5 (items 450-540) or as shown in Fig. 8-1 (item 850) to fig. 8-2 (915). This disclosure sets forth the patentee's disclosure of how to accomplish the claimed function. Apple's proposed structure is a bit imprecise by failing to detail which steps of Fig. 8-1 should be included as necessary structure disclosed in the specification and Apple fails to include Fig. 5 as an alternative disclosed algorithm. With regard to Elan's proposed structure, Elan fails to identify

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[4] The Staff notes that for this claim element and for the subsequent means plus function claim elements, the private parties include the entirety of the claim term as the claimed function. As noted earlier however, the private parties failed to do the same for Claim 18's "means for scanning" claim term.

correctly the structure at all. Instead, Elan improperly attempts to define the necessary structure

in functional terms: "firmware or software that provides data indicating the presence of two

fingers in response to the identification of two maxima and equivalents thereof." However, as

well established precedent requires, any computer based structure for means-plus-function

claiming must include (and be limited) by a disclosed algorithm. *Aristocrat Tech.*, 521 F.3d at

1333; *WMS Gaming v. International Game Technology*, 184 F.3d 1339, 1348 (Fed. Cir. 1999)

("the court erred by failing to limit the claim to the algorithm disclosed in the specification").

Here, Elan improperly attempts to define the claim as including any software that could

accomplish the claimed function. Elan's minimal citation to the algorithms found in the

specification is, at best, incomplete. Moreover, it is not clear whether Elan is arguing that the

algorithms delineate the scope of the claim, or whether Elan argues that the algorithms are mere

examples that do not delineate the scope of the claim. Additionally, to the extent that Elan is

attempting to identify required algorithms, Elan's citations to the algorithms are incomplete. For

example, Elan points to Fig. 5 (steps 465, 540), but those steps do not set forth the complete

algorithms to accomplish the claimed function. Instead, those steps are the result of the function.

It appears that Elan argues that the claim would read on any software routine that reports an

indication of two fingers. That approach is no different that pure functional claiming, which is

prohibited. *Aristocrat Tech.*, 521 F.3d at 1333.

12. **"means for selecting 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" (Claim 19)**

Elan's Proposed Construction	Apple's Proposed Construction
The function is selecting an appropriate control function based on a combination of a number of fingers detected, and amount of time said fingers are detected , and any movement of said fingers The corresponding structure includes the structure of claim 18 and firmware, software or hardware that receives as inputs the number of fingers detected, the amount of time the fingers are detected and any movement of said fingers and selects an appropriate control function and equivalents thereof See, e.g. Figs 7-9; 2:38-4:16; 7:1-5; 11:24-16:5	This limitation is governed by 35 U.S.C. § 112(6). The recited <u>function</u> is selecting 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. Because the specification does not disclose a corresponding structure, this limitation is indefinite.

In the Staff's view, claim 19 is invalid as indefinite because the specification fails to set forth any structure to accomplish the claimed function in the means plus function claim.[5] The failure to disclose *any* corresponding structure to carry out the claimed function renders the claim indefinite under 35 U.S.C. § 112 ¶ 2. *See Cardiac Pacemakers Inc. v. St. Jude Medical, Inc.*, 296 F.3d 1106, 1114 (Fed. Cir. 2002) (holding that a means-plus-function claim cannot be construed and is invalid where the specification fails to disclose corresponding structure); *see also Default Proof Credit Card System, Inc. v. Home Depot U.S.A., Inc.,* 412 F.3d 1291, 1302 (Fed.Cir. 2005) ("the testimony of one of ordinary skill in the art cannot supplant the total absence of structure

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[5] The Staff agrees with private parties's definition of the claimed function.

from the specification. . . . [Patentee] cannot use the declaration of its expert to rewrite the patent's specification."). Given that there is no corresponding structure disclosed in the specification, there is nothing to construe and hence, the claims must be found to be invalid.

In particular, the specification is devoid of any algorithm to accomplish the claimed function. As noted above, Elan points to no disclosure within the specification itself that teaches how to accomplish the function. Elan Memo. at 17-20. Elan's claim chart for claim 19 is devoid of any corresponding algorithm to accomplish the claimed function. Instead, Elan merely cites "software, firmware or hardware performing the claimed function." Elan Memo. at 17 (chart). In addition, regardless of which portion of the specification Elan cites in its argument, none has any disclosure concerning the amount of time over which fingers are detected on the touch pad as the claim requires. Elan attempts to overcome the lack of any disclosure within the specification by arguing that a person of skill in the art could create software to accomplished the claim function. Elan Memo. at 18. This is irrelevant, however, because the test for claim construction is whether the specification itself includes an adequate disclosure. *See Finisar Corp.*, 523 F.3d at 1340-41. As the Federal Circuit explained in *Finisar*:

> The district court correctly determined that the structure recited in the '505 specification does not even meet the minimal disclosure necessary to make the claims definite. Simply reciting "software" without providing some detail about the means to accomplish the function is not enough.

Id. Here, claim 19, as in *Finisar*, likewise fails to provide the minimal disclosure necessary by simply reciting "software" as the alleged disclosed structure.

The Federal Circuit's decision in *Biomedino* is also instructive. In *Biomedino*, the disputed claim language was "control means for automatically operating valves" and the

specification disclosed a figure with a box labeled "control" and a statement that the invention

"may be controlled automatically by known differential pressure, valving and control

equipment." *Biomedino*, 490 F.3d at 950. The District Court found the claim to be indefinite,

stating:

> The specification says nothing more than that unspecified
> equipment may be used to control the regeneration process. The
> fact that one skilled in the art could envision various types of
> equipment capable of automatically operating valves does not
> change the fact that no structure capable of performing that
> function was disclosed by the inventor.

Id. at 949 (quoting district court opinion). The Federal Circuit affirmed the decision based on the

same reasoning. *Id.* at 952-53. Whether or not one of ordinary skill in the art could envision

matters extrinsic to the specification to supplement the lack of adequate disclosure is not

relevant.

In light of the specification disclosing no structure to accomplish the claimed function of

claim 19, the claim is invalid and not capable of being construed.[6]

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[6] Elan misreads *AllVoice Computing PLC v. Nuance Communications, Inc.*, 504 F.3d 1236 (Fed.Cir. 2007). In *AllVoice*, the Federal Circuit confirmed that failure to include the necessary structure in the specification for means plus function claims renders the claim invalid. *Id.* at 1241 ("a means-plus-function clause is indefinite if a person of ordinary skill in the art would be unable to recognize the structure in the specification and associate it with the corresponding function in the claim"). The unremarkable conclusion in *AllVoice* was that the specification did contain sufficient structure (*id.* at 1245), not that the absence of any disclosure could be cured by expert opinion as Elan now argues.

13. "means for detecting a distance between said first and second maxima" (claim 24)

Elan's Proposed Construction	Apple's Proposed Construction
The function is detecting a distance between the first and second maxima and equivalents thereof	This limitation is governed by 35 U.S.C. § 112(6).
The corresponding structure includes the structure of claim 18 and firmware, software or hardware that determines the distance between the location of the first maxima and the location of the second maxima, and equivalents thereof. See, e.g. 3:21-26, 6:59-67	The recited function is detecting a distance between said first and second maxima. Because the specification does not disclose a corresponding structure, this limitation is indefinite.

In the Staff's view, claim 24 is invalid as indefinite because the specification fails to set forth any structure to accomplish the claimed function in the means plus function claim. *See Cardiac Pacemakers Inc.*, 296 F.3d at 114. Similar to claim 19, the specification fails to set forth any algorithm to accomplish the claimed function and Elan simply points to "software" that can accomplish the task. Additionally, Elan's reference to col. 3:21-26, and col. 6:59-67 fails to disclose the necessary algorithm. Instead, those portions of the specification do nothing more than disclose the idea, or claimed function. And, as noted earlier, Elan does not appear to be arguing that those portions of the specification are limitations of the claim.

14. **"means for providing a click function in response to the removal and reappearance of said second maxima within a predetermined period of time" (claim 26)**

Elan's Proposed Construction	Apple's Proposed Construction
The function is providing a click function in response to the removal and reappearance of said second maxima within a predetermined period of time The corresponding structure includes the structure of claim 18 and firmware, software or hardware that outputs a value corresponding to a click function in response to the removal and reappearance of the second maxima within a predetermined period of time and equivalents thereof. See, e.g. Figs 7; 2:38-4:16; 7:1-5; 11:24-16:5	This limitation is governed by 35 U.S.C. § 112(6). The recited function is providing a click function in response to the removal and reappearance of said second maxima within a predetermined period of time. Because the specification does not disclose a corresponding structure, this limitation is indefinite.

In the Staff's view, claim 26 is invalid as indefinite because the specification fails to set forth any structure to accomplish the claimed function in the means plus function claim. *See Cardiac Pacemakers Inc.*, 296 F.3d at 114. Similar to claims 19 and 24, the specification fails to identify any algorithm to accomplish the claimed function and Elan simply points to "software" for accomplishing the claimed function. Here, Elan appears to argue that the "software" is too simple to need to be disclosed and presumably could be easily provided by one of ordinary skill in the art. Elan Memo. at 24. Elan's argument simply confirms that the specification is devoid of corresponding structure. Also, as noted above, none of the disclosed algorithms contains any time limitations as claimed in claim 26.

15. "means for calculating first and second centroids corresponding to said first and second fingers" (claim 30)

Elan's Proposed Construction	Apple's Proposed Construction
The function is calculating first and second centroids corresponding to the first and second fingers The corresponding structure includes the structure of claim 18 and hardware, firmware or software that calculates the centroids of the measured values corresponding to the first and second fingers and equivalents thereof See, e.g. Figs 6 and 9, 10:31-51	This limitation is governed by 35 U.S.C. § 112(6). The recited function is calculating first and second centroids corresponding to said first and second fingers. Because the specification does not disclose a corresponding structure, this limitation is indefinite.

In the Staff's view, claim 30 is invalid as indefinite because the specification fails to set forth any structure to accomplish the claimed function in the means plus function claim. *See Cardiac Pacemakers Inc.*, 296 F.3d at 114. Similar to claim 19, 24, and 26, the specification fails to identify any algorithm to accomplish the claimed function and Elan simply argues that "software" accomplishes the task. Here, the specification specifically states that it is not providing any details about the claimed function and thus the patent is explicit that there is no disclosure of any algorithm to accomplish the claimed function. Col. 10:40-45 ("In a second implementation, a centroid value may be calculated for each maximum, yielding multiple centroid values when multiple fingers interact with the pad. [i.e., the function of claim 30]. ***For purposes of clarity, the following description will be limited to the first implementation.***") (emphasis added). In sum there is not disclosure of a method to accomplish the claimed function. The acknowledged absence of any disclosure does not equate to an adequate disclosure for purposes of § 112 ¶ 6.

III. CONCLUSION

For the forgoing reasons, the Staff respectfully request that the disputed claim terms be

construed as set forth above, and that claims 19, 24, 26, and 30 be found indefinite.

Respectfully submitted,

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Office of Unfair Import Investigations
U.S. International Trade Commission
July 26, 2010   (202) 205-2221

CERTIFICATE OF SERVICE

The undersigned certifies that on July 26, 2010, he caused the foregoing Commission Investigative Staff Motion for Summary Determination Of Claim Construction to be served by hand upon Chief Administrative Law Judge Paul J. Luckern (2 copies), and served upon the parties in the manner indicated below:

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