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An Exhausted Analysis of “Non-Exhaustive”: “Funny Things Are Everywhere”

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March 29, 2018 — *Inter partes* reviews (IPRs) at the United States Patent and Trademark Office’s Patent Trial and Appeal Board (PTAB) often turn on matters of claim interpretation. The decisions whether to cancel patent claims or maintain them depend on the broadest reasonable interpretation (BRI) of the patent claims’ terms.

Yet interpretation can include “funny things.” Few IPR cases illustrate more the “funny things” that “are everywhere” in claim interpretation than a recent one on appeal, that turned on interpretation of the term “non-exhaustive.” *Google LLC v. Network-1 Techs., Inc.*, No. 2016-2509 (Fed. Cir. March 26, 2018). The case reads like Seuss, Dr. Seuss, and fits, “One Fish, Two Fish,” of Seuss fame: “From there to here, from here to there, funny things are everywhere.”

A single claim was representative of all claims on appeal in four patents. *Id.* at 4. The claim included a limitation of comparing features of a computer file with data “using a non-exhaustive ... search.” Simple enough. But “funny things are everywhere,” and “what a lot of fish there are” when it comes to claim interpretation.

The PTAB found “one fish” in finding that “non-exhaustive search” meant “a search that locates a match without a comparison of all possible matches.”

Google, on appeal, found “two fish” in arguing for PTAB reversal with “non-exhaustive search,” meaning “a search [with] a match without ... a brute force comparison of all possible matches, [or a comparison of] all possible data within all possible matches.”

The Federal Circuit moved on to “red fish,” rather than decide between “one fish” and “two fish.” The meaning of “non-exhaustive” was to be determined, it said, not on the meaning of “non-exhaustive,” but on the meaning of “exhaustive.” *Id.* at 7.

In sentences Seuss himself could admire, it reasoned “the linchpin ... is ... what an ‘exhaustive’ search is. ... This is so because ... non-exhaustive ... is necessarily ... not ‘exhaustive.’ ... the ... limitation ... does not require ... ‘exhaustive’ ... Rather, it requires ... ‘non-exhaustive’ ...” *Id.* “As a result ... “what must be determined is the meaning of ... ‘exhaustive.’” *Id.*

“One fish, two fish, red fish ...,” now “blue fish.”

Google argued that the PTAB erred in adopting Network-1’s interpretation that “a search qualifies as ‘exhaustive’ as long as it considers ‘any portion of each potential match.’” Google argued that an “‘exhaustive’ search must consider all data within each potential match, because only such a search will ensure ‘find[ing] the correct answer.’” *Id.* at 7-8.

Again to Seuss-y-ish sentences went the Court: “Google’s argument is ... that the broadest construction of ‘non-exhaustive’ ... corresponds to the *narrowest* construction of ‘exhaustive,’ ... As ‘exhaustive’ narrows ..., ‘non-exhaustive’ must broaden ... a narrower ... ‘exhaustive’ ... corresponds to a broader ‘non-exhaustive.’” *Id.* at 8 and n. 4.

“Say! what a lot of fish there are. ... Why? ... Go ask your Dad,” says Seuss.

And *Network-1 Techs.* does not disappoint. It asks “Dad” what “exhaustive” means, in this case asking the Federal Circuit judges themselves.

Analyzing intrinsic and extrinsic evidence is necessary in claim interpretation, of course, and the Court does that analysis first. But at the end of the effort, the Court says it has exhausted the analysis, to no result: it “view[s] both the intrinsic and extrinsic evidence ... as inconclusive.” *Id.* at 14.

Left with no basis for decision in the evidence, it goes to Dad: “Bearing in mind ...the way in which the inventor claimed his invention (by saying do not do what is exhaustive) ... we [Dad] conclude that ... [q]uite simply, without considering all data within all possible matches, a search is not guaranteed to find [a] match, or it may stop prematurely before finding one.” The Court used an example from “Dad’s” surroundings to support its decision: “For example, [with] a database of court names [that] contains a possible match ‘Court of Appeals for the Federal Circuit,’ and [a] query ... ‘Federal Circuit’ ...[t]he Board’s construction would find a search ‘exhaustive’ if it looked at the first letter ... ‘F’ ... and moved on.” *Id.* at 14.

So with Seuss and fish, but also PTAB IPR claim interpretation, “From there to here, from here to there, funny things are everywhere. One fish, two fish, red fish, blue fish. ... Say! what a lot of fish there are.” And with IPR as with Seuss and fish, there’s a “Dad,” who you can “go ask.” Among the many possibilities of ultimate claim interpretation, paraphrasing Seuss, “Which one is good, and which one is bad? I do not know. Go ask your Dad.” Because “what a lot of [possibilities] there are,” and “funny [results] are everywhere.”

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