IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

ANCORA TECHNOLOGIES, INC., Ancora, v. LG ELECTRONICS INC. and LG ELECTRONICS U.S.A., INC., Defendants.	CIVIL ACTION NO. 1:20-cv-0034 JURY TRIAL DEMANDED
ANCORA TECHNOLOGIES, INC., Ancora, v. SAMSUNG ELECTRONICS CO., LTD. and SAMSUNG ELECTRONICS AMERICA, INC., Defendants.	CIVIL ACTION NO. 1:20-cv-0034 JURY TRIAL DEMANDED

DEFENDANTS' OPPOSED MOTION FOR RECONSIDERATION OF COURT'S CONSTRUCTION OF "USING AN AGENT" LIMITATION IN LIGHT OF THE FEDERAL CIRCUIT'S *EGENERA* DECISION

I. INTRODUCTION

On August 28, 2020, the Federal Circuit issued a precedential opinion addressing when a claim term which does not use the word "means" invokes § 112, ¶ 6. *Egenera Inc. v. Cisco Systems, Inc*, --- F.3d ----, 2020 WL 5084288 (Fed. Cir. Aug. 28, 2020). In *Egenera*, the Federal Circuit rejected a proposed construction of the claim term "logic to modify" as "software, firmware, or circuitry" because such a construction lacked "sufficient structure" to avoid application of § 112, ¶ 6, regardless of the location of that element in the larger structure of the invention. *Id.* at *4. Because the *Egenera* decision is on all fours with this case, Defendants

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request that the Court reconsider its construction of the "using an agent" limitation in claim 1 of the '941 patent, which rejected application of § 112, ¶ 6.

The table below underscores the similarity between the "logic to modify" term in *Egenera* and the "agent" term at issue in the instant litigation:

	Egenera	The '941 Patent
Claim Term	"logic [to modify]"	"an agent [to set up]"
Claimed Function	"modify said received messages to transmit said modified messages to the external communication network and to the external storage network"	"set up a verification structure in the erasable, non-volatile memory of the BIOS, the verification structure accommodating data that includes at least one license record"
Patentee's Construction	"software, firmware, circuitry, or some combination thereof"	"a software program or routine"
Proper Construction	35 U.S.C. § 112, ¶ 6 invoked – no sufficient structure recited in the claim to perform the claimed function	35 U.S.C. § 112, ¶ 6 invoked – no sufficient structure recited in the claim to perform the claimed function

In *Egenera*, the Federal Circuit has made clear for the first time that "a software program or routine," as this Court has construed the "agent" term, is not "sufficient structure" to avoid application of § 112, ¶ 6. *Id.*; ECF No. 93 at 34-36. *Egenera* also clarifies that "[m]ere inclusion of a limitation within a structure does not automatically render the limitation itself sufficiently structural," and therefore the Court's reliance on the operation of the "agent" "in the memory system" is similarly inadequate. 2020 WL 5084288 at *5; ECF No. 93 at 34-36. Defendants respectfully ask the Court to reconsider its construction of the "using an agent" limitation in light of the precedential opinion in *Egenera* and construe the limitation under § 112, ¶ 6 as proposed by Defendants.

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II. LEGAL STANDARD

"Under Rule 54(b), 'the trial court is free to reconsider and reverse its decision for any reason it deems sufficient." *Austin v. Kroger Tex., L.P.*, 864 F.3d 326, 336 (5th Cir. 2017) (quoting *Lavespere v. Niagara Mach. & Tool Works, Inc.*, 910 F.2d 167, 185 (5th Cir. 1990)); *see also Melancon v. Texaco, Inc.*, 659 F.2d 551, 553 (5th Cir. 1981) ("As long as a district . . . court has jurisdiction over the case . . . it possesses inherent procedural power to reconsider, rescind, or modify an interlocutory order for cause seen by it to be sufficient."). "Rule 54(b)'s approach to the interlocutory presentation of new arguments as the case evolves can be [] flexible, reflecting the 'inherent power of the rendering district court to afford such relief from interlocutory judgments as justice requires,'" *Austin*, 864 F.3d at 336-7 (quoting *Cobell v. Jewell*, 802 F.3d 12, 25-26 (D.C. Cir. 2015)), and is particularly appropriate to the continually revisable process of claim construction. *See, e.g.*, *Jack Guttman, Inc. v. Kopykake Enterprises, Inc.*, 302 F.3d 1352, 1361 (Fed. Cir. 2002) ("District courts may engage in a rolling claim construction, in which the court revisits and alters its interpretation of the claim terms as its understanding of the technology evolves."); *Cisco Sys., Inc. v. Telcordia Techs., Inc.*, 590 F. Supp. 2d 828, 830 (E.D. Tex. 2008) ("Claim construction orders are not final and may be altered by the court prior to, or during, trial.").

III. ARGUMENT

The Federal Circuit's precedential *Egenera* decision mirrors this case and dictates that the "using an agent" limitation is governed by § 112, ¶ 6. Accordingly, the Court should reconsider its ruling that the "using an agent" limitation is not governed by § 112, ¶ 6.

A. In *Egenera*, the Federal Circuit Made Clear That "software" Is Not "sufficient structure" to Avoid Application of § 112, ¶ 6

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The Federal Circuit made clear in *Egenera* that when determining whether a claim term is covered by § 112, ¶ 6, "[t]he question is not whether a claim term recites any structure but whether it recites *sufficient* structure" for performing the claimed function. 2020 WL 5084288 at *4 (emphasis in original) (quoting *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1348 (Fed. Cir. 2015)). At the district court, the appellant had argued that the claim term at issue ("logic") should be construed to mean "software, firmware, circuitry, or some combination thereof." *Id.* While noting the patent specified that the "logic" "has to be implemented" and that "such implemented logic could be 'software logic' or 'BIOS-based,'" the district court concluded that Egenera's construction was itself "so broad and formless as to be a generic black box for performing the recited computer-implemented functions." *Id*.

The Federal Circuit held that even if appellant's proposed construction could amount to "some possible structure," that construction's "general sense of software, firmware, or circuitry" did not amount to "sufficient structure for performing the [claimed] function," which is the requirement imposed by the statute. *Id.* In other words, the Federal Circuit for the first time ruled that a construction primarily based on "software" and "firmware" did not connote sufficient structure.

The Federal Circuit then evaluated whether the "larger claim context" provided sufficient structure for the "logic" term. *Id.* at *5. The appellant argued that this term was structural because it was part of the claimed "control node." *Id.* But the Federal Circuit held that this was "not enough. Mere inclusion of a limitation within a structure does not automatically render the limitation itself sufficiently structural." *Id.* Unmoved by the appellant's case law because "none of [that] precedent consider[ed] *Williamson*" and was, in any case, inapplicable, the Federal Circuit held that the "logic" term was subject to § 112, ¶ 6. *Id.*

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B. This Court Held That the "using an agent" Limitation Was Not Subject to § 112, ¶ 6

The Court's Order, ECF No. 93, addressed, *inter alia*, limitation (b) of claim 1 below:

> using ***an agent*** to set up a verification structure in the erasable, non-volatile memory of the BIOS, the verification structure accommodating data that includes at least one license record.

'941 patent at 6:64-67 (emphasis added). Defendants argued that the limitation fell within the ambit of pre-AIA § 112, ¶ 6 because it only recites function of the "agent" without providing sufficient structure for performing that function. *See* ECF No. 45 at 5-11, ECF No. 49 at 7-12, ECF No. 52 at 4-7. Plaintiff argued that the limitation was not subject to § 112, ¶ 6 and proposed that the term "agent" should be construed as "a software program or routine." ECF No. 44 at 22-26; ECF No. 50 at 7-14.

The Court construed the term "agent" as "a software program or routine," and determined that this term had sufficient structure because the "claim language at issue describes a piece of software within a specific piece of hardware for a specific purpose." ECF No. 93 at 35-36. In particular, the Court found that the patent did not describe the limitation in functional terms because "the claims specifically disclose the operation of the agent in the memory system." *Id.* The Court also concluded that the specification, dictionary definitions, and a 2001 paper authored by the inventor of the '941 patent "provide the specificity required to connote structure." *Id.* at 34-35.

C. Defendants Request Reconsideration in Light of the Federal Circuit's Ruling

The Court held that the "using an agent" limitation is not a means-plus-function limitation because it "recites definite structure." ECF No. 93 at 35. Neither the Court's construction of "agent" as "a software program or routine" nor its observation that the "agent" operates "within a specific piece of hardware for a specific purpose" provides sufficient structure

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