
No. 2022-2291

**United States Court of Appeals
for the Federal Circuit**

IMPACT ENGINE, INC.,

Plaintiff-Appellant

v.

GOOGLE LLC,

Defendant-Appellee

Appeal from the United States District Court for the Southern District
of California, No. 3:19-cv-1301-CAB-DEB,
Judge Cathy Ann Bencivengo

**IMPACT ENGINE'S PETITION FOR REHEARING
BY THE PANEL AND *EN BANC***

Garret A. Leach, P.C.
KIRKLAND & ELLIS LLP
300 North LaSalle
Chicago, IL 60654
(312) 862-2000

Jason M. Wilcox, P.C.
Stephen C. DeSalvo
KIRKLAND & ELLIS LLP
1301 Pennsylvania Ave., N.W.
Washington, D.C. 20004
(202) 389-5000

Sharre Lotfollahi, P.C.
KIRKLAND & ELLIS LLP
2049 Century Park East
Los Angeles, CA 90067
(310) 552-4200

Counsel for Plaintiff-Appellant Impact Engine, Inc.

August 2, 2024

CERTIFICATE OF INTEREST

Counsel for Impact Engine, Inc. certify the following:

1. Represented Entities	2. Real Party in Interest	3. Parent Corporations and Stockholders
The full names of all entities represented by undersigned counsel in this case are:	The full names of all real parties in interest for the entities are:	The full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities:
Impact Engine, Inc.	None/Not Applicable	None

4. Legal Representatives. The law firms, partners, and associates that (a) appeared for the entities in the originating court or (b) are expected to appear in this Court for the entities, but who have not already entered an appearance in this Court, are:

KIRKLAND & ELLIS LLP: Xaviere Giroud, Kyle Kantarek, Nikhil Krishnan, Caroline Lourgou, Megan New, Katherine O’Sullivan, Justin Singh, Benjamin Yaghoubian

RUTTENBERG IP LAW, PC: Guy Ruttenberg

5. Related Cases. The titles and numbers of the cases known to be pending in this Court or any other court or agency that will directly affect or be directly affected by this Court’s decision in the pending appeal are:

None/Not Applicable

6. Organizational Victims and Bankruptcy Cases. Information required under Fed. R. App. P. 26.1(b) and 26.1(c): None/Not Applicable

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Note: All quoted emphasis is added unless otherwise indicated.

RULE 35(B)(2) STATEMENT

Based on my professional judgment, I believe the panel’s decision is contrary to *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016); *CommScope Techs. LLC v. Dali Wireless Inc.*, 10 F.4th 1289 (Fed. Cir. 2021); and *Liquid Dynamics Corp. v. Vaughan Co., Inc.*, 355 F.3d 1361 (Fed. Cir. 2004), and that this appeal requires answers to the following precedent-setting questions of exceptional importance:

- a) Whether means-plus-function claims subject to §112(f) are patent-eligible under §101 as a matter of law.
- b) Whether means-plus-function claims must be properly construed before assessing their eligibility under §101.

/s/ Jason M. Wilcox

Attorney of Record for Plaintiff-Appellant

RULE 40 STATEMENT

The panel misapprehended that the correct construction of the “project viewer” claim term must be resolved before adjudicating both the §101 eligibility and infringement of claims reciting that term. It also overlooked Impact Engine’s argument that it showed Google infringed certain claims under any reasonable “project viewer” construction.

/s/ Jason M. Wilcox

Attorney of Record for Plaintiff-Appellant

INTRODUCTION

This case presents critical questions at the intersection of §112(f) means-plus-function claiming and §101 patent-eligibility determinations. Those questions include: (1) whether means-plus-function claims that are limited to specific corresponding structure in the specification for performing the claimed functions are patent-eligible as a matter of law; and separately (2) whether the corresponding structure required for a means-plus-function claim must be identified before adjudicating its patent eligibility at summary judgment.

Here, even though the district court held that claims reciting a means-plus-function “project viewer” required over 300 lines of specific structure recited in the specification, the panel majority concluded those claims are abstract, do not recite an inventive concept, and are not patent-eligible under §101. Nowhere in its patent-eligibility analysis did the panel majority even attempt to grapple with the district court’s claim construction. That was error. This Court recognized in *Enfish, LLC v. Microsoft Corp.* that the specific structures limiting means-plus-function claims can render those claims non-abstract. 822 F.3d 1327, 1336-39 (Fed. Cir. 2016). This Court should hold that such means-plus-function

claims—which require specific structures that necessarily are neither conventional nor well-known as used in the claims—are non-abstract or recite an inventive concept as a matter of law and are thus patent eligible. Alternatively, this Court should at least hold that the specific corresponding structure required for a means-plus-function term must be identified before determining whether claims using that term are patent eligible. The panel majority did neither here, and thus, as the dissent found, erred in affirming the district court’s §101 ruling. SlipOp.Dissent2-4.

Relatedly, the Court should also grant rehearing to correct the panel majority’s noninfringement analysis, which conflicts with this Court’s precedent and overlooks record facts. Despite this Court’s cases stating that infringement decisions require first properly construing claims and then comparing those claims to the accused products, the panel majority affirmed the district court’s grant of summary judgment of noninfringement for two claims requiring a “project viewer” without resolving whether the district court’s disputed construction of that term is correct. Making matters worse, as Judge Reyna correctly noted in his dissent, the district court’s “project viewer” construction is plainly wrong.

SlipOp.Dissent4. Alternatively, as also noted in the dissent, SlipOp.Dissent4-6, the panel should at least rehear the case to consider Impact Engine’s unresolved argument that, even under the district court’s erroneous “project viewer” construction, record evidence exists that precludes summary judgment of noninfringement.

Leaving these errors uncorrected will have a profound impact on future cases. Virtually all means-plus-function claims would flunk the *Alice* two-part test under the panel majority’s approach because eligibility would be determined based solely on the claimed function without taking into account the corresponding structure; a function divorced from its corresponding structure is inherently abstract. Congress could not have intended this result when it **both** enacted §101’s threshold eligibility requirement **and** approved of means-plus-function claiming in §112(f). But that is the unmistakable take-away from the panel’s decision for litigants and district courts. Only the Court’s *en banc* review can correct the district court’s serious and consequential errors before those errors have a destabilizing effect and cast significant doubt on the invalidity of all means-plus-function claims.

RELEVANT BACKGROUND

A. Facts

Impact Engine invented a new way to make, manage, and distribute media-rich online ads. Appx47(2:57-62); Appx11316-11317(¶1083). The patented invention allows lay users for the first time to make, revise, and distribute high-quality, custom-tailored communications—which “can be created in a layered fashion” as a series of “slides,” which can further be “a grouping of design layers, design elements, and content containers”—using an intuitive builder engine accessed over a network. Appx31(Fig.1); Appx47(1:33-35); Appx48(3:30-32, 3:42-43); Appx51(10:4-10); Appx11186(¶¶82-83). The patented builder includes multiple components, such as a media repository, project viewer, and distribution program. Appx31(Fig.1); Appx48(3:9-29). This approach enabled dynamic, real-time modifications and conserved users’ bandwidth. Appx11333-Appx11336(¶¶1200-1206).

This technology is described and claimed in seven related patents at issue in this case—U.S. Patent Nos. 7,870,497; 8,356,253; 8,930,832; 9,361,632; 10,068,253; 10,565,618; and 10,572,898—which all share a common specification. Most relevant to this petition, a number of the asserted claims recite a “project viewer” that performs different functions

in different claims. Claim 1 of the '6,253 patent recites “a project viewer” that “renders [a] communication in the graphical user interface” and displays slides of the communication “using either auto-play on or auto-play off.” Appx78-79(14:64-15:3). Claim 9 of the '497 patent requires a project viewer that performs the rendering function and “transmits the rendered communication via the network to the client computer.” Appx54(16:5-9). The asserted claims of the '832 and '632 patent recite a project viewer that “send[s] the communication” over “the network.” Appx105(15:17-20, 16:10-12, 16:22-24); Appx132(15:11-14, 15:20-24, 16:23-26, 16:39-42). And claims 1, 7, and 12 of the '8,253 patent require a project viewer that “allow[s] the user to view both the online advertisement templates and the media assets” and “to select a media asset for integration with an advertisement template.” Appx159(15:25-31, 15:60-63, 16:28-35).

B. Procedural History

1. District Court Proceedings

Impact Engine sued Google for patent infringement, accusing (among other things) its Google Ads, Google Display & Video 360, and YouTube Video Builder products. Appx1250; *see, e.g.*, Appx2648; Appx5288; Appx6027.

The district court construed the “project viewer” term appearing in ten asserted claims as a means-plus-function term because it was “ascribed functions” for which a skilled artisan would not “understand the structure that would perform these functions.” Appx6-7. The district court recognized that the claimed project viewer performed four different functions across different claims, and identified corresponding structure for those functions as being “described at Col. 4:27 through Col. 9:19” of the ’497 patent. Appx7. It thus “limited” the claimed project viewer “to those disclosed structures and their equivalents,” which encompassed over 300 lines of specific structure. *Id.*

The district court rejected Google’s motion to dismiss certain “project viewer” claims as ineligible because the claimed “project viewer” was not “a known generic program construct” but rather was limited to specific structures in the specification. Appx11485-11486. But at summary judgment, ignoring its means-plus-function construction and overlooking its prior ruling, the district court *sua sponte* held the “project viewer” of the ’832, ’632, and ’8,253 patents was “a known programming construct” that “operate[s] in its known and familiar capacity,” and that those claims were thus not patent eligible. Appx25-26.

With respect to two other patent claims requiring a “project viewer”—claim 9 of the ’497 patent and claim 1 of the ’6,253 patent—the district court took a different approach and held they were patent eligible but not infringed. It recognized the “project viewer” in these claims was limited to the corresponding structure it had identified in the specification, but concluded Impact Engine’s expert Dr. Wicker had not shown those structures were present in the accused products. Appx24-25. Dr. Wicker offered two infringement opinions: (1) that the particular structures in columns 4:27-9:29 required for the subset of claimed “project viewer” functions in claim 9 of the ’497 patent and claim 1 of the ’6,253 patent were in the accused products, Appx8351-8354(¶¶249-254); Appx8357-8388(¶¶259-282); Appx8392-8393(¶¶293-296); Appx8483-8486(¶¶375-379); Appx8658-8666(¶¶509-516); Appx8885-8889(¶¶741-750); and (2) alternatively, that all the structures in the 300-plus lines of the specification identified in the district court’s claim construction were in the accused products, Appx8354(¶255); Appx8388-8391(¶¶283-287); Appx8666-8669(¶¶517-521); Appx8721-8723(¶¶594-596); Appx8889-8890(¶¶751-754); Appx11456-11457(¶1213). The district court rejected Dr. Wicker’s first opinion because, despite the disparity in claimed

“project viewer” functions across different claims, every claimed project viewer required *all* the structure “identified [in] a significant portion of the specification” from columns 4:27-9:19. Appx24. The district court failed to address Dr. Wicker’s second opinion.

2. The Federal Circuit Panel’s Decision

A panel majority of this Court affirmed the district court’s judgment. SlipOp.22. Without resolving the disputed construction of the claimed “project viewer,” the majority concluded claims reciting that term were patent-ineligible under §101 because they “are directed to an abstract idea” of “processing information,” they do not “recite an inventive concept,” and the claimed “project viewer” performs “well-known, routine, and conventional computer functionality.” SlipOp.14-16. It reached that conclusion without identifying the corresponding structure for “project viewer” in those claims, much less considering whether that corresponding structure renders the claims non-abstract or provides an inventive concept. *Id.* The majority then affirmed the district court’s noninfringement determination, but without determining whether the district court’s “project viewer” construction upon which the noninfringement judgment was based was correct. SlipOp.16-20.

Judge Reyna dissented-in-part, stating he would vacate the district court’s noninfringement and patent-ineligibility rulings on the “project viewer” claims. SlipOp.Dissent1. He reasoned that the “project viewer” undisputedly is a means-plus-function term, the district court’s construction requiring over 300 lines of structure from the specification regardless of the claimed function was wrong, and this flawed construction necessarily infected the district court’s patent-ineligibility and noninfringement rulings for the “project viewer” claims. SlipOp.Dissent2-3. Judge Reyna also noted that neither the district court nor panel majority considered Impact Engine’s theory that Google’s accused products infringe claims of the ’497 and ’6,253 patents under any “project viewer” construction. SlipOp.Dissent6.

ARGUMENT

I. The Panel Majority Erred By Holding The Means-Plus-Function “Project Viewer” Claims Are Patent Ineligible.

The panel or en banc court should rehear this case to resolve critical issues relating to the patent eligibility of means-plus-function claims. *First*, this Court should hold that means-plus-function claims limited to specific structure described in the specification are *per se* patent-eligible. *Second*, and alternatively, this Court should hold that the specific

corresponding structure required to perform functions recited in a claim subject to §112(f) must be identified before assessing §101 eligibility.

A. This Court Should Hold Means-Plus-Function Claims, Which Are Limited To Specifically Described Structures, Are Patent-Eligible Under §101.

The Court should grant panel or en banc rehearing to hold that means-plus function claims, which require specific structures adequately described in the specification for performing claimed functions, are patent-eligible under §101. This Court has recognized that claims “directed to a specific” way of implementing a “specific solution to then-existing technological problems” using “specific steps” are not directed to an abstract idea. *Data Engine Techs. LLC v. Google LLC*, 906 F.3d 999, 1008 (Fed. Cir. 2018); *see also Core Wireless Licensing S.A.R.L. v. LG Elecs., Inc.*, 880 F.3d 1356, 1363 (Fed. Cir. 2018); *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1313 (Fed. Cir. 2016). Such claims have also been found to recite inventive concepts. *See Coop. Entm’t, Inc. v. Kollektive Tech., Inc.*, 50 F.4th 127, 135 (Fed. Cir. 2022); *BASCOM Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1352 (Fed. Cir. 2016).

Under that precedent, whether at step one or step two of the §101 framework set forth in *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208, 217 (2014), means-plus-function claims with sufficiently definite structure constitute patentable subject matter. *See, e.g., Enfish*, 822 F.3d at 1336-39 (holding claims reciting means-plus-function terms limited to a specific four-step algorithm were non-abstract and patent-eligible). Such means-plus-function claims—like the “project viewer” claims at issue here that the district court held require 300-plus lines of structure from the specification—are “directed to a specific” way of implementing a “specific solution” to a technological problem using “specific steps.” *Data Engine*, 906 F.3d at 1008. Those limitations on the scope of the claims remove them from the abstract and imbue them with an inventive concept. *Id.*; *BASCOM*, 827 F.3d at 1352. Indeed, holding otherwise would lead to the absurd result that a means-plus-function claim term with sufficiently definite structure could be both abstract *and* recite nothing more than well-known, conventional, or generic components, for which §112(f) should not apply in the first place. *See Zeroclick, LLC v. Apple Inc.*, 891 F.3d 1003, 1007 (Fed. Cir. 2018) (noting claimed means

with “sufficiently definite meaning as the name for structure” do not invoke §112(f).

B. The Panel Majority At Least Erred By Holding The “Project Viewer” Claims Are Not Patent-Eligible Without Identifying The Corresponding Structure.

Alternatively, the Court should grant rehearing to correct the panel majority’s failure to construe the means-plus-function “project viewer” claims before holding they are patent-ineligible. Patent-eligibility analyses “must focus on the language of the Asserted Claims themselves, considered in light of the specification.” *TecSec, Inc. v. Adobe Inc.*, 978 F.3d 1278, 1292 (Fed. Cir. 2020) (citation and internal quotation marks omitted). Although claim construction is not an inviolable prerequisite to §101 analyses in every case, it was at least required here where the challenged claims involved a means-plus-function term allegedly sweeping into the claims 300-plus lines of corresponding structure. *See McRO*, 837 F.3d at 1311 (recognizing “claim construction is helpful to resolve the question of patentability under §101”); *cf. Aatrix Software, Inc. v. Green Shades Software, Inc.*, 882 F.3d 1121, 1125 (Fed. Cir. 2018) (discussing claim construction “at the Rule 12(b)(6) stage” for §101 analyses).

The reason is simple: claims “directed to a specific” way of implementing a “specific solution to then-existing technological problems” using “specific steps” are not directed to abstract ideas and have been found to recite inventive concepts. *Data Engine*, 906 F.3d at 1008. The panel majority skipped that analysis by failing to identify the specific structure required to perform claimed “project viewer” functions before assessing whether claims using that term are directed to an abstract idea or recite an inventive concept. That was error and will signal to district courts that they should take similar analytical shortcuts in future means-plus-function cases.

This Court’s decision in *Enfish* illustrates the panel’s mistake. In *Enfish*, the Court considered whether means-plus-function patent claims reciting, among other things, a “means for configuring” memory that “requir[ed] a four-step algorithm” were patent-eligible under §101. 822 F.3d at 1336. This Court held those claims were not abstract and were thus patent-eligible. *Id.* at 1336, 1339. It reasoned that, in view of the specific means-plus-function construction afforded to the claims, *see id.* at 1336-39, they recited “a *specific type* of data structure” and were “directed to a *specific implementation* of a solution to a problem in the

software arts,” rendering them non-abstract and patent-eligible. *Id.* at 1339. The specific corresponding structure in the specification, in other words, saved what otherwise would have been abstract and patent-ineligible claims.

Here, the panel majority did not conduct the claim-specific inquiry this Court endorsed in *Enfish* because the panel failed to identify the specific structure required to perform the claimed “project viewer” functions. It is undisputed that the claimed “project viewer” is a means-plus-function term that performs different functions in different claims. SlipOp.Dissent3; BlueBr.51-52; RedBr.21; RedBr.51. The district court concluded that, irrespective of the claimed functions, every “project viewer” requires over 300 lines of structure in columns 4:27-9:19 of the specification. Appx7; Appx24-25. Judge Reyna correctly concluded that this construction—which requires structures unnecessary to the claimed functions—cannot possibly be right, SlipOp.Dissent3, and the panel majority nowhere disputes that irrefutable conclusion. Yet the panel majority, bucking the analysis in *Enfish*, ignored this critical claim construction issue drastically affecting the scope of the “project viewer”

claims, failed to assess what the claims actually require, and simply concluded they are ineligible. SlipOp.13-16.

Consistent with this Court’s *de novo* review of claim construction and §101 determinations, *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318, 331 (2015); *Endo Pharms. Inc. v. Teva Pharms. USA, Inc.*, 919 F.3d 1347, 1352 (Fed. Cir. 2019), the panel should have assessed whether the district court’s “project viewer” construction was correct before analyzing the lower court’s patent-eligibility decision. *See, e.g., Bancorp Servs., L.L.C. v. Sun Life Assur. Co. of Canada (U.S.)*, 687 F.3d 1266, 1273-74 (Fed. Cir. 2012) (noting “it will ordinarily be desirable—and often necessary—to resolve claim construction disputes prior to a §101 analysis”). Had it done so, the panel would have found that, just like the claims at issue in *Enfish*, the “project viewer” claims here are non-abstract and thus patent eligible. Alternatively, as Judge Reyna noted in his dissent and consistent with this Court’s precedent, this case should have at least been remanded for the district court to properly construe the claimed “project viewer” before assessing patent eligibility. SlipOp.Dissent4; *see, e.g., MyMail, Ltd. v. ooVoo, LLC*, 934 F.3d 1373, 1381 (Fed. Cir. 2019).

II. The Panel Majority's Analysis Of The District Court's Noninfringement Finding Contravened This Court's Precedent And Overlooked The Factual Record.

Rehearing should also be granted because the panel majority's affirmation that claim 9 of the '497 patent and claim 1 of the '6,253 patent are not infringed is inconsistent with bedrock claim construction and summary judgment principles. *First*, the panel erred by affirming summary judgment that these "project viewer" claims are not infringed without first resolving the disputed construction of that term. *Second*, the panel failed to consider Impact Engine's argument that the accused products infringe under any plausible construction of "project viewer."

A. The Panel Majority Erred By Affirming Summary Judgment Of Noninfringement Without Confirming If The District Court's Claim Construction Was Correct.

The panel or en banc court should consider whether the district court's "project viewer" claim construction was correct before reviewing its grant of summary judgment of noninfringement based on that construction. Claim construction is a necessary prerequisite to determining patent infringement, which "requires a two-step analysis." *Liquid Dynamics Corp. v. Vaughan Co., Inc.*, 355 F.3d 1361, 1367 (Fed. Cir. 2004); *see also CommScope Techs. LLC v. Dali Wireless Inc.*, 10 F.4th 1289, 1295 (Fed. Cir. 2021). The court must first "*determine the scope*

and the meaning of the asserted patent claims,” and then “compare the *properly construed claims* to the allegedly infringing” product. *Liquid Dynamics*, 335 F.3d at 1367. The first step—claim construction—“is a matter of law that [this Court] review[s] de novo.” *Id.*; *Teva*, 574 U.S. at 331. The panel erred by skipping to step two (assessing infringement) without resolving step one (claim construction). District courts will take the panel’s decision as permission to similarly skip over claim construction in future summary judgment motions.

Here, although the “project viewer” term undisputedly performs different functions in different claims, the district court construed that term as requiring all 300-plus lines of structure described in columns 4:27-9:19 of the specification, regardless of the claimed functions (if any) to which those structures correspond. Appx7; Appx24. Applying that construction, the district court held Impact Engine’s expert had not shown “this detailed description” applied to the accused products. Appx24-25. As Judge Reyna recognized in his dissent, the district court’s construction is plainly wrong and thus its noninfringement finding must be set aside. SlipOp.Dissent4. This Court has consistently held §112(f) does not “permit incorporation of structure from the written description

beyond that necessary to perform the claimed function.” *Micro Chem., Inc. v. Great Plains Chem. Co., Inc.*, 194 F.3d 1250, 1258 (Fed. Cir. 1999); see *Northrop Grumman Corp. v. Intel Corp.*, 325 F.3d 1346, 1350, 1352 (Fed. Cir. 2003). Impact Engine explained what it believed the correct construction should be, mapping claimed functions to corresponding structure in the specification. BlueBr.58-67.

Even though it was the basis for the district court’s noninfringement decision, the panel majority ignored the district court’s “project viewer” construction. It never assessed whether it was correct or comported with this Court’s precedents. Instead, the panel focused myopically on Impact Engine’s proposed construction and, after rejecting it, jumped immediately to affirming the district court’s finding that the “project viewer” claims were not infringed without any resolution of the actual meaning of that claim term. See SlipOp.16-20. That mode of analysis—which left that means-plus-function term without any construction at all—is legally erroneous. It contradicts this Court’s precedents laying out a clear two-step framework for determining patent infringement, and is inconsistent with the Court’s *de novo* review of both claim construction and summary judgment. See *Teva*, 574 U.S. at 331;

Adasa Inc. v. Avery Dennison Corp., 55 F.4th 900, 907 (Fed. Cir. 2022); *Liquid Dynamics*, 355 F.3d at 1367.

On rehearing, this Court should take the same approach it has used in past cases by first construing the “project viewer” claims and then reversing the district court’s grant of summary judgment of noninfringement under that correct construction. *See, e.g., Epos Techs. Ltd. v. Pegasus Techs. Ltd.*, 766 F.3d 1338, 1347 (Fed. Cir. 2014); *Liquid Dynamics*, 355 F.3d at 1369. Alternatively, as Judge Reyna suggested in his dissent, the Court should vacate the district court’s noninfringement decision and remand for the district court to reassess the issue after properly construing the “project viewer” claims. *See SlipOp.Dissent4; Edgewell Personal Care Brands, LLC v. Munchkin, Inc.*, 998 F.3d 917, 922 (Fed. Cir. 2021).

B. The Panel Majority Erred By Overlooking Impact Engine’s Argument That It Showed Google’s Accused Products Infringe The “Project Viewer” Claims Even Under The District Court’s Omnibus Construction.

The panel should at least reconsider its decision with respect to whether Google’s accused products infringe claim 9 of the ’497 patent and claim 1 of the ’6,253 patent. Even if the district court’s omnibus construction were correct (which it is not), Impact Engine provided expert

testimony from Dr. Wicker that all the structures in columns 4:27-9:19 or their equivalents—which necessarily includes any possible subset of those structures—are present in the accused products. *See, e.g.*, Appx8352-8353(¶¶249-251); Appx8354(¶255); Appx8388-8391(¶¶283-287); Appx8395(¶301); Appx8660-8669(¶¶512-521); Appx8721-8723(¶¶594-596); Appx8886-8890(¶¶744-754); Appx11456-11457(¶1213).

As Judge Reyna correctly noted, neither the district court nor the panel majority considered this argument and evidence. SlipOp.Dissent6.

To the extent the panel majority discounted Dr. Wicker’s analysis as only identifying a subset of structures for the rendering function, that was error. SlipOp.17(n.2). Dr. Wicker found *all* the structures in columns 4:27-9:19 of the specification in the accused products under the district court’s view of its construction. *See* p.8, *supra*. The panel was obligated to review that opinion *de novo* to determine whether it raised a material factual dispute.

The panel’s failure to review Dr. Wicker’s alternative opinion is even more troubling if the district court’s claim construction is wrong—an issue the panel again erroneously left unresolved despite its obligation to perform *de novo* review. Under those circumstances, Dr. Wicker

should at least be given the opportunity to address that new construction, consistent with this Court's cases. *See Zhejiang Med. Co., Ltd. v. Kaneka Corp.*, 676 F. App'x 962, 965 (Fed. Cir. 2017); *3M Innovative Props. Co. v. Avery Dennison Corp.*, 350 F.3d 1365, 1374 (Fed. Cir. 2003).

The panel should thus grant rehearing to consider this evidence and either hold it is sufficient to overcome summary judgment or at least remand for the district court to cure its "incomplete infringement analysis" and determine whether limited expert discovery based on a new "project viewer" construction is warranted. SlipOp.Dissent4; *see Epos*, 766 F.3d at 1347; *Edgewell*, 998 F.3d at 922.

CONCLUSION

Impact Engine respectfully requests panel and en banc rehearing.

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Respectfully submitted,

/s/ Jason M. Wilcox

Garret A. Leach, P.C.
KIRKLAND & ELLIS LLP
300 North LaSalle
Chicago, IL 60654
(312) 862-2000

Jason M. Wilcox, P.C.
Stephen C. DeSalvo
KIRKLAND & ELLIS LLP
1301 Pennsylvania Ave., N.W.
Washington, D.C. 20004
(202) 389-5000

Sharre Lotfollahi, P.C.
KIRKLAND & ELLIS LLP
2049 Century Park East
Los Angeles, CA 90067
(310) 552-4200

Counsel for Plaintiff-Appellant Impact Engine, Inc.