

United States District Court
Northern District of California

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

ON24, INC.,
Plaintiff,
v.
WEBINAR.NET, INC.,
Defendant.

Case No. 21-cv-07721-EMC

**ORDER GRANTING DEFENDANT’S
MOTION FOR PARTIAL SUMMARY
JUDGMENT**

Docket No. 70

Plaintiff ON24, Inc. has filed suit against Defendant webinar.net, Inc., asserting a variety of business torts, including patent infringement. Now pending before the Court is webinar’s motion for partial summary judgment on the patent infringement claim. According to webinar, the patent at issue – the ‘480 patent – is invalid based on indefiniteness. Having considered the parties’ briefs and accompanying submissions, as well as the oral argument of counsel, the Court hereby **GRANTS** webinar’s motion.

I. FACTUAL & PROCEDURAL BACKGROUND

ON24 has asserted the following causes of action against webinar:

- (1) Infringement of ON24’s ‘480 patent.
- (2) Interference with contractual relations between ON24 and its customers.
- (3) Unfair competition.
- (4) Violation of the Lanham Act by making false or misleading representations about ON24.

The pending motion for partial summary judgment focuses on the patent infringement claim only.

ON24’s ‘480 patent is titled “Communication Console with Component Aggregation.”

1 The field of the invention is online communications applications. *See* ‘480 patent, col. 1:14-15.

2 The abstract for the patent describes the invention at issue as follows:

3 Systems methods and devices are provided for a presentation
4 including a communications console with component aggregation.
5 In one potential implementation, a computing device with an
6 application framework receives a communication manager object
7 via a network connectivity device and executes the communication
8 manager object within the application framework. The computing
9 device may then receive and execute communications components
and a presentation component[] within the application framework
using the communication manager object. The communication
manager object may then manage interface and display of the
presentation information via the application framework, as modified
by communication components.

10 ‘480 patent, abstract; *see also* Overby Decl. ¶ 21 (stating that there are four main components: “(1)
11 the ‘presentation component,’ which is the main presentation (*e.g.*, a speaker’s video stream); (2)
12 the ‘communications components,’ which are audio-visual add-ons to the presentation (*e.g.*, a
13 slide show, a Twitter feed, a menu ribbon); (3) the application framework, where the user interacts
14 with the first two components (*e.g.*, the user’s browser); and . . . (4) the ‘communication manager
15 object,’ which manages the two components so they work seamlessly on the application”).

16 As background, the specification for the patent acknowledges that there are “numerous
17 structures . . . for direct online communications” but notes that

18 [t]he current solutions for providing interactivity and user control . . .
19 . are limited in the amount of user control that they provide for an
20 audience member. These online communications applications limit
21 flexibility, integration, and user selections in a variety of ways in
order to streamline and limit the size and complexity of the
application.

22 For example, current direct online applications limit flexibility by
23 restricting the amount of customization that can be achieved within
24 an individual communications component. None of the existing
25 direct online platforms use a completely separate, encapsulated
26 architecture for implementing communications component
27 customization per webcast, and none of them allow an audience
28 member to set up and view a webcast per their own interests. They
also limit integration by restricting the amount of interactivity
provided to a highly-customized communications. For example,
existing webcasting platforms do not have an open platform for
integrating third-party communications components of any
significant size or complexity. The integration of third-party
communications components in communication applications are
limited in direct communications to simple image or animation

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components. Attempts to expand flexibility in current solutions involve creation of a collection of closed “widgets” which become the non-expandable limitations of the application.

Downloaded executable installed applications do exist currently that use a component model, but the requirement to download, execute, and install a desktop executable application in a client computer make the current use of these indirect executable applications less secure and more cumbersome from an initial use perspective. None of the existing applications function in a context that is fully-online, without a downloaded desktop application.

‘480 patent, col. 1:19-54; *see also* Overby Decl., Ex. H (in a decision on a petition brought by webinar against ON24, PTAB stating that “[t]he ‘480 patent addresses the problem of customizing webcast presentations by being ‘fully online’ without the need for a separate downloaded desktop application”).

A representative independent claim for the ‘480 patent is as follows:

1. An audience computing device comprising:

a processing device;

a memory device;

an application framework that receives a **communication manager object** via a network connectivity device and executes the **communication manager object** within the application framework;

wherein the application framework receives and executes at least two communications components and a presentation component within the application framework using the **communication manager object** and each component exchanges data with the **communication manager object** within the application framework during a presentation to present the presentation to a user of the audience computing device without downloading and installing an application, and the **communication manager object** manages interface and display of the presentation via the application framework; and

wherein the communication components are at least two of a slide communications component, a media communications component and a menu ribbon component, each of the communication components comprises graphical interface information, and the **communication manager object** automatically modifies the graphical interface information to a standardized interface format.

‘480 patent, claim 1 (emphasis added).

As reflected by the bolded language above, the key term in dispute at summary judgment is “communication manager object.” webinar takes the position that “communication manager

1 object” is an indefinite term.

2 “Communications manager object” is discussed in the specification in column 4.

3 The complex interaction within the various components is managed
 4 by a central “Communications Manager” object, which registers
 5 events or requests from individual components, identifies the
 6 priority of each event, and determines the callback mechanism to
 7 deliver information back to the calling component. This object then
 8 applies a layer of security filters to verify that the calling component
 9 has the appropriate permissions to access the resources it is
 10 requesting, and that it has not exceeded its quota of requests within a
 11 given time frame. Once all these filters are passed and the
 12 Communications Manager determines that the event or method
 13 being called can in fact be acted on – the event or method is allowed
 14 to proceed in a metered and organized way. Registered event
 15 listeners, or method calls return the information to the component
 16 via a callback method, including the requested information, if any,
 17 and status of the original request. In this way, the platform enables
 18 the limited resources available on the browser to be allocated with
 19 the appropriate priority and rationing so as to allow for a smooth,
 20 seamless, and integrated user experience. Contrast this organized
 21 platform approach with a mashup of components – each unaware of
 22 the other, and each competing for the limited resources available to
 23 the browser (CPU, threads, number of concurrent request to the
 24 back-end systems available, etc.), degrading performance in
 25 unpredictable and undesirable ways.

26 ‘480 patent, col. 4:24-48.

27 **II. DISCUSSION**

28 **A. Legal Standard**

Federal Rule of Civil Procedure 56 provides that a “court shall grant summary judgment [to a moving party] if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a). An issue of fact is genuine only if there is sufficient evidence for a reasonable jury to find for the nonmoving party. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248-49 (1986). “The mere existence of a scintilla of evidence . . . will be insufficient; there must be evidence on which the jury could reasonably find for the [nonmoving party].” *Id.* at 252. At the summary judgment stage, evidence must be viewed in the light most favorable to the nonmoving party and all justifiable inferences are to be drawn in the nonmovant’s favor. *See id.* at 255.

In the instant case, patent invalidity is an affirmative defense. webinar, as the alleged infringer, has the burden of proving that defense. *See Impax Labs., Inc. v. Aventis Pharm., Inc.*,

1 468 F.3d 1366, 1378 (Fed. Cir. 2006) (“An issued patent is presumed to be valid, and the burden
2 of establishing invalidity as to any claim of a patent rests upon the party asserting such
3 invalidity.”). “Clear and convincing evidence is required to invalidate a patent.” *Id.* “When
4 evaluating a motion for summary judgment, the court views the record evidence through the prism
5 of the evidentiary standard of proof that would pertain at a trial on the merits.” *Eli Lilly & Co. v.*
6 *Barr Labs., Inc.*, 251 F.3d 955, 962 (Fed. Cir. 2001).

7 **B. Law on Indefiniteness and Means-Plus-Function Claims**

8 The Supreme Court has held that “a patent is invalid for indefiniteness if its claims, read in
9 light of the specification delineating the patent, and the prosecution history, fail to inform, with
10 reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v.*
11 *Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014); *see also* 35 U.S.C. § 112(b) (“The
12 specification shall conclude with one or more claims particularly pointing out and distinctly
13 claiming the subject matter which the inventor or a joint inventor regards as the invention.”).¹
14 Indefiniteness is a question of law. *See Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 789 F.3d 1335,
15 1341 (Fed. Cir. 2015); *see also ePlus, Inc. v. Lawson Software, Inc.*, 700 F.3d 509, 517 (Fed. Cir.
16 2012). (“[I]ndefiniteness is a question of law and in effect part of claim construction.”).

17 In the instant case, webinar claims indefiniteness based on its assertion that the term
18 “communication manager object” is a means-plus-function term. Title 35 U.S.C. § 112(f) covers
19 means-plus-function claims. It provides as follows:

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21 An element in a claim for a combination may be expressed as a
22 means or step for performing a specified function *without* the recital
23 of structure, material, or acts in support thereof, and such claim shall
be construed to cover the *corresponding structure, material, or acts*
described in the specification and equivalents thereof.

24 35 U.S.C. § 112(f) (emphasis added).² If there is, in fact, a means-plus-function term, then the
25 first step in construing that term is to “identify the claimed function.” *Rain Computing, Inc. v.*

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¹ Section 112(b) was formerly referred to as paragraph 2 of § 112.

28 ² Section 112(f) was formerly referred to as paragraph 6 of § 112.

1 *Samsung Elecs. Am., Inc.*, 989 F.3d 1002, 1007 (Fed. Cir. 2021). Next, a court looks at the
2 specification of the patent to see what structure, if any, is disclosed that corresponds to the claimed
3 function. *See id.* If no corresponding structure is sufficiently disclosed, then the means-plus-
4 function term is deemed indefinite. *See id.*

5 ON24, however, disputes webinar’s claim that the term at issue – “communication
6 manager object” – is a means-plus-function term. Whether a claim is in fact a means-plus-
7 function claim is also a legal question. *See Williamson v. Citix Online, LLC*, 792 F.3d 1339, 1346
8 (Fed. Cir. 2015). A court presumes that a claim limitation is subject to § 112(f) – *i.e.*, is a means-
9 plus-function term – “when the claim language includes the term ‘means.’” *Dyfan LLC v. Target*
10 *Corp.*, 28 F.4th 1360, 1365 (Fed. Cir. 2022). “The inverse is also true – we presume that a claim
11 limitation is *not* [a means-plus-function term] in the absence of the term ‘means.’” *Id.* (emphasis
12 added).

13 This presumption, however, “is rebuttable. The presumption can be overcome if a
14 challenger [here, webinar] demonstrates that the claim term ‘fails to “recite sufficiently definite
15 structure.”’” *Id.* The Federal Circuit has explained that

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17 “[n]once words that reflect nothing more than verbal constructs may
18 be used in a claim in a manner that is tantamount to using the word
19 ‘means,’” and can invoke § 112[(f)]. We have emphasized that “the
20 essential inquiry is not merely the presence or absence of the word
21 ‘means,’ but *whether the words of the claim are understood by*
persons of ordinary skill in the art to have a sufficiently definite
meaning as the name for structure.” “What is important is . . . that
the term, as the name for structure, has a reasonably well understood
meaning in the art.”

22 Intrinsic evidence, such as the claims themselves and the
23 prosecution history, can be informative in determining whether the
24 disputed claim language recites sufficiently definite structure or was
25 intended to invoke § 112[(f)]. In addition, because this inquiry turns
on the understanding of a person of ordinary skill in the art, we often
look to extrinsic evidence when determining whether a disputed
limitation would have connoted structure to a person of ordinary
skill.

26 *Id.* (emphasis added); *see also Zeroclick, LLC v. Apple Inc.*, 891 F.3d 1003, 1007 (Fed. Cir. 2018)
27 (repeating that the “essential inquiry remains ‘whether the words of the claim are understood by
28 persons of ordinary skill in the art to have a sufficiently definite meaning as the name for

1 structure”).

2 C. Whether “Communication Manager Object” Is a Means-Plus-Function Term

3 In the case at bar, the term “communication manager object” does not use the word
4 “means.” Therefore, there is a presumption that the term is not a means-plus-function term.
5 According to ON24, the specification of the ‘480 patent, combined with a declaration from its
6 expert Walter Overby, also establish that a communication manager object has a particular
7 structure.

8 As a practical matter, the Court focuses on the Overby declaration because his declaration
9 discusses the language used in the specification; the basic issue is “whether the words of the claim
10 are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the
11 name for structure.” *Dyfan*, 28 F.4th at 1365.

12 The Overby declaration sufficiently demonstrates that the broader term “object” would be
13 understood by a person of ordinary skill in the art to be a structure of some kind. Mr. Overby
14 explains that a person of ordinary skill in the art would understand that the term “object” means a
15 “particular type of software structure with specific characteristics.” Overby Decl. ¶ 7; *see also*
16 Overby Decl. ¶ 9 (“An object resembles an autonomous unit in that it has capabilities and may be
17 asked to perform services by other units.”) (emphasis omitted). “By 2010, in object-oriented
18 programming or coding, such as what is addressed in the ‘480 patent, ‘object’ meant a software
19 construct that has state, exhibits some well-defined behavior, and has a unique identity.”³ Overby
20 Decl. ¶ 11; *see also* Overby Decl., Ex. C (Encyclopedia Britannica online) (defining “object-
21 oriented programming”; stating that “[o]bject-oriented languages help to manage complexity in
22 large programs,” and “[o]bjects package data and the operations on them so that only the
23 operations are publicly accessible and internal details of the data structures are hidden”).

24 Furthermore, as Mr. Overby points out, there is some language in the specification indicating that
25 the term “object” reflects a structure. *See* ‘480 patent, col. 6:62-7:1 (“The innovations herein may

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27 ³ In Exhibit D to the Overby declaration, there is a lengthy excerpt about objects from a
28 publication titled *Object-Oriented Analysis and Design with Applications* (3d ed). Mr. Overby,
however, seems to rely on this exhibit only for the proposition that there are three aspects of a
software object: state, behavior, and identity. *See* Overby Decl. ¶ 12.

1 be described in the general context of computer-executable instructions, such as program modules,
2 being executed by a computer, computing component, etc. In general, program modules may
3 include routines, programs, *objects*, components, data structures, and such that perform particular
4 tasks or implement particular abstract data types.”) (emphasis added).

5 But just because a person of ordinary skill in the art would understand the broader term
6 “object” to mean a structure of some kind, that is not the end of the inquiry. The term at issue here
7 is not simply “object,” but the phrase “communication manager object.” Mr. Overby does not
8 claim anywhere in his declaration that this specific term has a commonly understood meaning,
9 other than that it is some kind of software. *Cf. Rain*, 989 F.3d at 1006 (noting that the parties did
10 “not dispute that ‘user identification module’ has no commonly understood meaning and is not
11 generally viewed by one skilled in the art to connote a particular structure”).

12 At the hearing, ON24 seemed to suggest that it is enough for a person of skill in the art to
13 recognize that a communication manager object is software of some kind – *i.e.*, that fact alone
14 means that there is sufficient structure such that the term is *not* a means-plus-function term. The
15 Court does not agree.

16 In this regard, *Dyfan* is a particularly instructive case. In *Dyfan*, the patents at issue (which
17 shared the same specification) “describe[d] improved systems for delivering messages to users
18 based on their locations. For example, the shared specification discloses a communications
19 system that provides users with information tailored to their particular interests or needs based on
20 their presence within a specified location. . . .” *Dyfan*, 28 F.4th at 1362. A representative claim in
21 one of the patents referred to a “system” comprised of multiple elements, including “code”
22 configured to perform certain functions when executed. *See id.* at 1363. The issue before the
23 Federal Circuit was whether “code”/“application” was a means-plus-function term.

24 The court noted first that “structure can be recited in various ways, including through the
25 use of ‘a claim term with a structural definition that is either provided in the specification or
26 generally known in the art,’ or a description of the claim limitation’s operation and ‘how the
27 function is achieved in the context of the invention.” *Id.* at 1366.

28 It then noted that, because the term “code”/“application” did not include the word

1 “means,” there was a presumption that the term was not a means-plus-function term. “To
2 overcome this presumption, [the defendant] had to show, by a preponderance of the evidence, that
3 persons or ordinary skill in the art would not have understood the ‘code’/’application’ limitations
4 to connote structure in light of the claim as a whole.” *Id.* at 1367.

5 The Federal Circuit ultimately held that the defendant failed to overcome this presumption.
6 It pointed out there was un rebutted testimony from the defendant’s own expert that a person of
7 ordinary skill in the art would have understood the term “application” as a particular structure.
8 “More specifically, [the defense expert] Dr. Goldberg testified that the term ‘application’ would
9 have been commonly understood to mean a ‘computer program intended to provide some service
10 to a user,’ *and that developers could have, at the relevant time, selected existing ‘off-the-shelf*
11 *software’ to perform specific services and functions.” Id.* (emphasis added). Similarly, the
12 defense expert testified that “a person of ordinary skill would understand that ‘code’ is ‘a bunch of
13 software instructions’” *and that “a person of ordinary skill would have known that the claimed*
14 *function of displaying information could be implemented using ‘off-the-shelf’ code or*
15 *applications.” Id.* at 1368 (emphasis added). “[I]n view of Dr. Goldberg’s un rebutted testimony
16 that ‘code’ and ‘application’ would have connoted structure to a person of ordinary skill *and given*
17 *the availability of off-the-shelf code to perform the recited claim functions,” the Federal Circuit*
18 *rejected the defendant’s contention that “code”/’application” was a means-plus-function term. Id.*
19 (emphasis added).

20 Unlike in the mechanical arts, the specific structure of software code
21 and applications is partly defined by its function. *Apple*, 757 F.3d at
22 1298-99. In determining whether software limitations like those at
23 issue here recite sufficient structure, we can look beyond the initial
24 “code” or “application” term to the functional language to see if a
25 person of ordinary skill would have understood the claim limitation
26 as a whole to connote sufficiently definite structure. *Zeroclick*, 891
27 F.3d at 1008 (concluding that the disputed terms are used “not as
28 generic terms or black box recitations of structure or abstractions,
but rather as specific references to conventional . . . code, existing in
prior art at the time of the inventions.”); *Linear Tech.*, 379 F.3d at
1320 (“[W]hen the structure-connoting term . . . is coupled with a
description of the [term’s] operations, sufficient structural meaning
generally will be conveyed to persons of ordinary skill in the art, and
§ 112[(f)] presumptively will not apply.”); *Apple*, 757 F.3d at 1298-
99. *Dr. Goldberg explained that here, “code” and “application”*
(which themselves connote structure) in combination with the

1 *recitation of the code or application's operation would have*
 2 *connoted structure to persons of ordinary skill.*

3 Reviewing the alleged means-plus-function limitation in full, the
 4 claim requires code configured to be implemented on a mobile
 5 device to display information via a display of the mobile device,
 6 receive information (including location-relevant information) via a
 7 wireless communications protocol, and display visual information
 8 based on the received location-relevant information after certain
 9 conditions are met. See J.A. 906 (Goldberg Dep. 140:23-141:13).
 10 *Dr. Goldberg testified that persons of ordinary skill in the art would*
 11 *have known of off-the-shelf code and applications for displaying any*
 12 *desired information. . . . Accordingly, because the recited functions*
 13 *can be performed by conventional off-the-shelf software, a person of*
 14 *ordinary skill in the art would have understood the alleged means-*
 15 *plus-function "code" limitations in the asserted claims to connote*
 16 *structure.*

17 *Id.* at 1368-69 (emphasis added); *see also Zeroclick*, 891 F.3d at 1008 (concluding that “a person
 18 of ordinary skill in the art could reasonably determine from the claim language that the words
 19 ‘program’ . . . and ‘user interface code’ . . . are not used as generic terms or black box recitations
 20 of structure or abstractions, but rather as specific references to conventional graphical user
 21 interface programs or code, existing in prior art at the time of the inventions”).

22 As indicated above, the *Dyfan* court did not hold that “application” and “code” had
 23 sufficient structure (and thus were not means-plus-function terms) because both terms were
 24 understood to be software or computer programs. Rather, the Federal Circuit also considered what
 25 function the software provided *and how that function would be carried out, i.e.*, through off-the-
 26 shelf code available at the time. *Cf. Sisvel Int'l S.A. v. Sierra Wireless, Inc.*, No. 2022-1493, 2023
 27 U.S. App. LEXIS 26590, at *26 (Fed. Cir. Oct. 6, 2023) (stating that, “for a means-plus-function
 28 limitation where the corresponding structure is an algorithm, the specification need not disclose *all*
 the details of the algorithm to satisfy the definiteness requirement of § 112 ¶ 2,” but “what is
 disclosed [should] be sufficiently definite to a skilled artisan”) (emphasis added). It was because
 of this additional information that the court could conclude that there was no “black box
 recitation[] of structure.”⁴ *Dyfan*, 28 F.4th at 1368; *see also Takadu Ltd. v. Innovyze LLC*, No.
 21-291-RGA, 2023 U.S. Dist. LEXIS 45115, at *21-23 (D. Del. Mar. 17, 2023) (“agree[ing] with

⁴ See note 7, *infra*.

1 Defendant that ‘analysis engine’ is a means-plus-function limitation”; “[t]he parties agree that an
 2 ‘engine’ in this context refers to a program or part of a program to perform a function or manages
 3 data,” but “[t]he term ‘analysis’ does not add sufficient structure to take the term out of §
 4 112(f)[:] Defendant’s expert states that a POSA ‘would not have been familiar with a specific
 5 combination of software and/or hardware referred to as an “analysis engine,”” and “Plaintiff’s
 6 expert does not state that the term is commonly used to connote structure nor that the term is used
 7 to reference conventional programs that a POSA would recognize as an ‘analysis engine’”);
 8 *Western DI Identity Sec. LLC v. Apple, Inc.*, No. 1:22-CV-58-LY, 2022 U.S. Dist. LEXIS 199275,
 9 at *12-14 (W.D. Tex. Nov. 2, 2022) (underscoring that the patent did not simply recite to an
 10 “algorithm” but rather an “encryption” or “encoding” algorithm specifically, and plaintiff provided
 11 “extrinsic evidence from technical dictionaries, government publications, and other publicly
 12 disclosed sources showing that the claim language references ‘conventional’ or ‘off-the-shelf’
 13 encryption or encoding algorithms known to persons of ordinary skill in the art at the time of
 14 invention”).

15 In his declaration, Mr. Overby maintains: “One of skill in the art would understand the
 16 phrase ‘communication manager object’ in the ‘480 patent to correspond to a particular set of
 17 functions, which is fleshed out specifically in at least two places in the ‘480 patent, but also
 18 generally in the entirety of the disclosure and how the inventors described their invention as a
 19 whole.” Overby Decl. ¶ 17. The problem with this statement is that it simply conveys what the
 20 function of a communication object manner is⁵; it does not shed any light as to how that
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22 ⁵ See, e.g., ‘480 patent, col. 4:24-48 (stating, *inter alia*, stating that the communication manager
 23 object “registers events or requests from individual components, identifies the priority of each
 24 event, and determines the callback mechanism to deliver information back to the calling
 25 component”; it also “applies a layer of security filters to verify that the calling component has the
 26 appropriate permissions to access the resources it is requesting, and that it has not exceeded its
 27 quota of requests within a given time frame,” and, “[o]nce all these filters are passed and the
 28 Communications Manager determines that the event or method being called can in fact be acted on
 – the event or method is allowed to proceed in a metered and organized way”); ‘480 patent, claim
 1 (providing, *inter alia*, that “the application framework receives and executes at least two
 communications components and a presentation component within the application framework
 using the communication manager object”; that “each component exchanges data with the
 communication manager object within the application framework”; and that “the communication
 manager object manages interface and display of the presentation via the application framework”).

1 functionality is achieved. *See also* Overby Decl. ¶ 21 (testifying that the communication object
2 manager “manages the two components [*i.e.*, the presentation component and the communications
3 component] so they work seamlessly on the application”); *cf. Sisvel*, 2023 U.S. App. LEXIS
4 26590, at *18-19, 27-29 (indicating that, where software protocols are mentioned by name in a
5 specification, whether those protocols constitute sufficient specific structure must be considered
6 from the perspective of a skilled artisan).

7 In his declaration, Mr. Overby also asserts that the ‘480 patent “lay out what this object
8 does, *how it does it*, and with what other components it interacts.” Overby Decl. ¶ 18 (emphasis
9 added). But Mr. Overby does not convey the “how.” For example, he contends that “the claims
10 themselves show how the pieces of this invention interact,” Overby Decl. ¶ 22, but the Federal
11 Circuit has indicated that this kind of information is not enough to show how a function is
12 achieved. *See Rain*, 989 F.3d at 1006 (noting that, in a prior Federal Circuit decision, “we held
13 that the written description of a ‘copyright compliance mechanism,’ *including how it was*
14 *connected to various parts of the system*, how it functioned, and its potential functional
15 components, was not enough to provide sufficient structure to the claimed ‘compliance
16 mechanism’”) (emphasis added). As another example, Mr. Overby claims that the patent
17 “provide[s] an algorithm or structure for the Communication Manager Object, which would allow
18 one of skill in the art to understand how to code the object, given that the steps to or functions of
19 the algorithm are sufficiently definite such that one of skill in the art would be expected to be able
20 to code for them.” Overby Decl. ¶ 24. But the Overby declaration does not go on to pinpoint
21 what the steps of the algorithm are. Therefore, there is simply a black box recitation of structure
22 as there was in *Dyfan*. In contrast to *Dyfan*, Mr. Overby does not point to or even suggest that the
23 communication manager object is an off-the-shelf object or software known in the field. ON24’s
24 argument is particularly problematic given that, apparently, the claimed novelty in the ‘480 patent
25 *is* in fact the communication manager object.⁶

26 ON24 protests still that the PTAB did not have “difficulties in construing” the term
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28 ⁶ At the hearing, webinar asserted that the communication manager object is the claimed novelty
of the ‘480 patent; ON24 did not disagree.

1 “communication manager object” during an inter partes review which was instigated by webinar
2 against ON24. Overby Decl. ¶ 27 (adding that the PTAB concluded a communication manager
3 object exchanges data with the communication components). The problem with this statement is
4 that the PTAB simply defined the word in terms of its functionality. Moreover, on inter partes
5 review, invalidity based on indefiniteness technically cannot be raised. *See Molo Design, Ltd. v.*
6 *Chanel, Inc.*, No. 21-CV-01578 (VEC), 2022 U.S. Dist. LEXIS 79480, at *13 (S.D.N.Y. May 2,
7 2022) (“Petitioners before the PTAB may only seek to cancel patent claims ‘on a ground that
8 could be raised under section 102 [novelty] or 103 [non-obvious subject matter] and only on the
9 basis of prior art consisting of patents or printed publications.’ All other claims relating to the
10 validity of a patent are outside the scope of inter partes review, including claims of
11 indefiniteness.”).

12 Accordingly, for the reasons stated above, the Court concludes that the term
13 “communication manager object” is a means-plus-function term. webinar has successfully
14 rebutted the presumption that the term is not a means-plus-function term.

15 D. Indefiniteness

16 Having concluded that “communication manager object” is a means-plus-function term,
17 the Court now turns to whether there is an indefiniteness problem.

18 The first step in construing a means-plus function claim is to
19 “identify the claimed function.” After identifying the function, we
20 then “determine what structure, if any, disclosed in the specification
21 corresponds to the claimed function.” “Under this second step,
22 structure disclosed in the specification is corresponding structure
23 only if the specification or prosecution history clearly links or
24 associates that structure to the function recited in the claim.”

25 *Rain*, 989 F.3d at 1007. As discussed below, where the function is software performed by a
26 general-purpose computer or microprocessor, the specification must disclose more.

27 In *Rain*, the Federal Circuit considered the term “user identification module.” It noted that,
28 at step one, there was no dispute that “the function of ‘user identification module’ is ‘to control
29 access to one or more software application packages to which the user has a subscription.’” *Id.*
30 As for step two, the structure in the specification that was linked with the function of controlling
31 access was, as the lower court found, computer-readable media or storage devices (*e.g.*, a SIM

1 card, IC card, flash memory drive, memory card, CD-ROM) which “amount[ed] to nothing more
2 than a general purpose computer.” *Id.* The Federal Circuit then explained, where “the function is
3 performed by a general-purpose computer or microprocessor, the second step generally further
4 requires that the specification disclose the algorithm that the computer performs to accomplish that
5 function.” *Id.*

6 “[C]ontrol[ling] access to one or more software application
7 packages to which the user has a subscription” requires more “than
8 merely plugging in a general purpose computer.” Rather, some
9 special programming, *i.e.*, an algorithm, would be required to
10 control access to the software application packages. . . . Under these
11 circumstances, where a general purposes computer is the
12 corresponding structure and it is not capable of performing the
13 controlling access function absent specialized software, an algorithm
14 is required.

15 Nothing in the claim language or the written description provides an
16 algorithm to achieve the “control access” function of the “user
17 identification module.” . . . Without an algorithm to achieve the
18 “control access” function, we hold the term “user identification
19 module” lacks sufficient structure and renders the claims indefinite.

20 *Id.* at 1007-08.⁷

21 *Rain* is consistent with earlier Federal Circuit case authority holding that, “when a patentee
22 invokes means-plus-function claiming to recite a *software* function, it accedes to the reciprocal
23 obligation of disclosing a sufficient algorithm as corresponding structure.” *EON Corp. IP*

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25 ⁷ The Court notes that indefiniteness and enablement are distinct and different inquiries. *Compare*
26 *Nautilus*, 572 U.S. at 901 (stating that “a patent is invalid for indefiniteness if its claims, read in
27 light of the specification delineating the patent, and the prosecution history, fail to inform, with
28 reasonable certainty, those skilled in the art about the scope of the invention”); *with Liquid*
Dynamics Corp. v. Vaughan Co., 449 F.3d 1209, 1224 (Fed. Cir. 2006) (noting that, “[i]n order to
enable the claims of a patent pursuant to § 112, the patent specification must teach those of
ordinary skill in the art ‘how to make and use the full scope of the claimed invention without
undue experimentation’”). That being said, the indefiniteness issue here (*i.e.*, a means-plus-
function term that involves a general-purpose computer or software) is similar to the issue of
enablement. *See Haddad v. United States*, 164 Fed. Cl. 28, 67-68 (2023) (noting that “enablement
and indefiniteness may conceptually overlap,” but adding that “the legal standards are distinct”
and “lack of enablement and lack of written description[] are not proper to address during claim
construction”); *cf. ASM Am., Inc. v. Genus, Inc.*, No. C-01-2190 EDL, 2002 U.S. Dist. LEXIS
15348, at *44-45 (N.D. Cal. Aug. 15, 2002) (stating that, “[i]f a person of ordinary skill in the art
can determine what the claim language means, but the specification does not show how to perform
the invention, the claim may be invalid for lack of enablement, not for indefiniteness[;] [b]ecause
analysis of enablement focuses on the adequacy of the specification in teaching a person of
ordinary skill in the art how to make and use the invention, it cannot be considered to be part of
claim construction”).

1 *Holdings LLC v. AT&T Mobility LLC*, 785 F.3d 616, 623 (Fed. Cir. 2015) (emphasis added; also
2 noting that “[a] microprocessor or general purpose computer lends sufficient structure only to
3 basic functions of a microprocessor” but “[a]ll other computer-implemented functions require
4 disclosure of an algorithm”); *see also Function Media, L.L.C. v. Google Inc.*, 708 F.3d 1310, 1318
5 (Fed. Cir. 2013) (stating that “[i]t is well settled that ‘[s]imply disclosing software, . . . “without
6 providing some detail about the means to accomplish the function[,] is not enough”’); *Noah Sys.,
7 Inc. v. Intuit, Inc.*, 675 F.3d 1302, 1313 (Fed. Cir. 2012) (stating that, “while ‘[i]t is certainly true
8 that the sufficiency of the disclosure of algorithmic structure must be judged in light of what one
9 of ordinary skill in the art would understand the disclosure to impart,’ in a situation in which the
10 specification discloses no algorithm, ‘[t]hat principle . . . has no application’”).

11 In *Function Media*, the Federal Circuit noted that the ““specification can express the
12 algorithm in any understandable terms including as a mathematical formula, in prose, or as a flow
13 chart, or in any other manner that provides sufficient structure.”” *Function Media*, 708 F.3d at
14 1318. That being said, an algorithm is not sufficient if all that it does is simply state functionality
15 without explaining *how* the function is performed. *See Blackboard, Inc. v. Desire2Learn, Inc.*,
16 574 F.3d 1371, 1384 (Fed. Cir. 2009) (stating that a sentence on which the plaintiff relied “merely
17 states that the access control manager enables different types of users to interact with the system in
18 a manner that preserves confidentiality (i.e., it works as intended)”; the “language ‘simply
19 describes the function to be performed’” and “says nothing about how the access control manager
20 ensures that those functions are performed,” and, “[a]s such, the language ‘describes an outcome,
21 *not a means for achieving that outcome*’”) (emphasis added).

22 In the instant case, the Court accepts, for purposes of this order, that the function of a
23 communication manager object is to exchange data with the communication components (as found
24 the PTAB during the inter partes review proceeding). *See also* Overby Decl. ¶ 27 (noting that the
25 PTAB concluded a communication manager object exchanges data with the communication
26 components). Nothing in the specification suggests this function is accomplished by anything
27 other than software performed by a general-purpose computer or microprocessor. The critical
28 question then is whether the ‘480 patent specification provides an algorithm as to how that

1 function is achieved. The patent does not. The patent simply states functionality without
2 explaining how the function is performed. *See, e.g.*, note 4, *supra*.

3 The Court, therefore, concludes that the means-plus-function term “communication
4 manager object” is indefinite and, accordingly, the ‘480 patent is invalid even under the clear-and-
5 convincing standard.⁸

6 **III. CONCLUSION**

7 For the foregoing reasons, the Court grants webinar’s motion for partial summary
8 judgment on the claim for patent infringement.

9 This order disposes of Docket No. 70.

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11 **IT IS SO ORDERED.**

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13 Dated: October 16, 2023

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EDWARD M. CHEN
United States District Judge

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⁸ All independent claims of the ‘480 patent contain the term “communication manager object.”