

Practice Update

Not All Smiles for McRO Even Though Federal Circuit Vacates Invalidity Based on Enablement

August 18, 2020

The Federal Circuit affirmed a California district court's judgment of noninfringement but vacated its judgment of invalidity for lack of enablement since the defendants' proposed non-enabling facial animation techniques did not fall within the scope of the claims. *McRO, Inc. v. Bandai Namco Games America Inc., et al.*, No. 2019-1557, __ F.3d __ (Fed. Cir. May 20, 2020).

Background

This is the second time the Federal Circuit has considered this case. In 2012, McRO, Inc. d/b/a Planet Blue (McRO) filed suit against more than a dozen video game developers (Developers) alleging infringement of 3 method claims of U.S. Patent No. 6,611,278 (the '278 patent). The '278 patent describes methods that allow for automatically animating lip synchronization and facial expression of three-dimensional characters to create a wide variety of animation products (e.g., movies, videos, games, and cartoons).

The district court held the claims invalid for ineligibility under 35 U.S.C. § 101. In *McRO, Inc. v. Bandai Namco Games America, Inc.*, 837 F.3d 1299, 1313 (Fed. Cir. 2016) (*McRO I*), the Federal Circuit reversed the district court's holding by noting that the '278 patent did not preempt the field of rules-

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based animation. In July 2018, while on remand, the district court tentatively granted the Developers' motion for summary judgment of noninfringement but refused to issue a final ruling until it determined whether the asserted claims satisfied the enablement requirement. Then, in November 2018, the district court granted the Developers' motion for summary judgment of invalidity. Specifically, the district court concluded the specification did not enable two animation techniques identified by the Developers (*i.e.*, the bones technique and the BALDI system). McRO appealed.

Asserted Claims

McRO asserted independent Claim 1 and two dependent claims. Claim 1 of the '278 patent recites, in part, a method for “automatically animating lip synchronization and facial expression of three-dimensional characters”. The relevant limitation in Claim 1 recites “obtaining *a first set of rules* that defines a *morph weight set* stream as a function of phoneme sequence and times associated with said phoneme sequence”.

Noninfringement

Neither party disputed the construction of the term “morph weight set,” which the district court defined as a “set of values, one for each delta set, that, when applied, transform the neutral model to some desired state, wherein each delta set is the set of vectors from each vertex on the neutral (reference) model to each vertex on a model of another mouth position.” *Slip. Op.* at *4. Both parties, however, disputed the meaning of “vector” within that construction. The Developers argued that “vectors constituting the ‘delta set’ must be vectors in three-dimensional space” and McRO argued that a vector is “an ordered set of numbers.” *Id.* The district court construed “vector” as “a vector with direction and magnitude in three-dimensional space”, which aligned with the Developers' position and required a judgment of noninfringement. Noting that “[n]othing in the specification shows a use of ‘vector’ ... other

than the ordinary, geometric, three-dimensional one”, *id.* at *6, the Federal Circuit concluded that the district court correctly held as a matter of law that “vector” as used in the ’278 patent must have “3-D magnitude and direction computed by pure subtraction/addition between the neutral and target models, with one vector corresponding to each set of two vertices.” *Id.* As both McRO and the Developers agreed that there was no infringement under this construction, the Court affirmed the district court’s judgement of noninfringement.

Enablement

Turning to enablement of the term “first set of rules,” the Court agreed with McRO that the Developers did not identify with specificity any animation method falling within the scope of Claim 1 that also was not enabled. Without specific examples, the district court’s reasoning was “too abstract, too conclusory, to support summary judgment.” *Id.* at *6.

The Federal Circuit explained that Section 112 requires enablement only of the claimed invention. *Id.* at *7. Section 112 does not concern matter outside the claims. To this end, a court must first define the precise scope of the claimed invention before it can consider the question of whether undue experimentation is required to make and use the full scope of the embodiments of the claimed invention. *Id.* In view of this framework, the Federal Circuit dismissed the relevance of those enablement cases relied upon by the district court and the Developers because “none of the cases ... involved an abstract assertion of breadth, without concrete identification of matter that is not enabled but is or may be within the claim scope.” *Id.* at *8.

The Court reminded practitioners that a “patent need not teach, and preferably omits, what is well known in the art” and that “the specification must reasonably teach how to make and use [the novel] aspect of the invention.” *Id.* at *9. Accordingly, the Developers did not meet their burden of identifying

a set of rules for automatically outputting chosen mouth shapes that is or may be within the scope of the claim. Given the construction of the term “morph weight set”, both examples offered by the Developers’ expert fall outside the scope of the claims making them “irrelevant to enablement”. *Id.* Specifically, bones animation does not use three-dimensional geometric vectors to move vertices and BALDI’s process “parameter target values corresponding to each phoneme do not represent delta sets as construed”. *Id.* at *9. Having eliminated the need for the specification to enable these two examples, the “district court’s reasoning is too abstract and too conclusory to support summary judgment.” *Id.* at *10.

Because “[s]pecifics have always mattered”, the Federal Circuit refused to depart from its requirement that the challenger (here the Developers) identify specifics that are or may be within the claims but are not enabled. *Id.* As additional fact-finding is required to decide the enablement issue, the Federal Circuit remanded the case for further proceedings.

Key Takeaways

Satisfying the enablement requirement does not require a patentee to describe what is well known to the art, but a patentee should ensure that the specification enables all claimed embodiments. In addition, any invalidity challenge based on enablement should first focus on whether the subject matter that is allegedly not enabled falls within the scope of the challenged claims.

This information is intended to inform firm clients and friends about legal developments, including recent decisions of various courts and administrative bodies. Nothing in this Practice Update should be construed as legal advice or a legal opinion, and readers should not act upon the information contained in this Practice Update

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