"Inherency Requires More Than Probabilities" - Motorola Mobility, LLC v. Int'l Trade Comm'n

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Motorola Mobility, LLC v. Int'l Trade Comm'n

Addressing whether an essential claim limitation is inherently present in a prior art reference for purposes of an anticipation analysis, the U.S. Court of Appeals for the Federal Circuit affirmed a ruling out of the U.S. **International Trade Commission (ITC)**, emphasizing that the burden remains on defendants to prove inherent anticipation. **Motorola Mobility, LLC v. Int'l Trade Comm'n,** Case No. 12-1535 (Fed. Cir., Dec. 16, 2013) (Rader, C.J.).

Microsoft filed a complaint at the ITC against Motorola for the importation and sale of mobile devices. Microsoft asserted multiple patents against Motorola, but only one was at issue in the appeal. That patent is directed to a mobile device having a personal information manager—an application that manages scheduling, communications, etc. The claimed **mobile device** requires "a synchronization component for synchronizing" information with a remote device.

After Motorola conceded infringement during the ITC proceeding, it was left with arguing anticipation, obviousness, and failure to establish the domestic industry requirement. The administrative law judge and the Commission rejected all three defenses. Motorola appealed.

Motorola asserted **Apple's Newton MessagePad** as anticipatory prior art. A manual for the Newton system disclosed that the MessagePad may initiate synchronization with a desktop. Based on this disclosure, Motorola argued that the MessagePad must inherently include a synchronization component. To support its analysis, Motorola asserted that the claimed synchronization component merely facilitates, instead of actively manages, synchronization.

The Federal Circuit rejected Motorola's argument as an untimely claim construction position and applied the plain and ordinary meaning of the term. The Court further found that substantial evidence supported the Commission's holding that Motorola failed to prove inherent anticipation by clear and convincing evidence. Although it is possible that the disclosure implies the presence of a synchronization component, the fact that the MessagePad initiates synchronization does not necessitate such an implication. The Federal Circuit succinctly summarized its position, concluding that "[i]nherency requires more than probabilities or possibilities."

The Federal Circuit also rejected Motorola's obviousness arguments. The obviousness arguments were not based on the MessagePad, but were instead based solely on generic statements made by Microsoft's expert. As a result, the Court found that Motorola failed to identify the scope and content of the prior art, a prerequisite to establishing obviousness. The statements from Microsoft's expert alone were insufficient to carry Motorola's high burden of proof.

The Federal Circuit also rejected Motorola's argument that Microsoft failed to establish the domestic industry requirement. Motorola attacked Microsoft's reliance on mobile devices for the technical prong of the analysis and mobile device operating systems for the economic prong. Motorola argued that these were two separate products that could not be the basis to meet the requirement. The Court rejected this argument, however, because the operating system on a mobile device is a significant part of that device. An investment directed to a significant aspect of an article is still directed to the article.

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