FEDERAL CIRCUIT PATENT LAW CASE UPDATE

Lizardtech, Inc. v. Earth Res. Mapping, Inc., 05-1062 (Fed. Cir. Oct. 4, 2005) (Bryson, J.)

The court affirmed the non-infringement and invalidity determination for Lizardtech's patent claiming an image data compression technology. The single disclosed embodiment did not provide sufficient support to satisfy § 112, ¶ 1 for a broad claim reciting an expansive genus for "a seamless array of [compression] coefficients generically."

Lizardtech owns U.S. Pat. No. 5,710,835, for a compression technology.

> Wavelet transforms allow digital images to be greatly compressed with very little loss of information. In particular, they help in the image compression process because they can be used to transform image data into a form in which it is easier to determine what information in the data is relevant, so that irrelevant and redundant data can be filtered out. . . . [One type of transform is a] discrete wavelet transform ("DWT"). . . . Reducing edge artifacts while performing a DWT on individual tiles of an image for compression purposes is the object of the '835 patent. . . . The '835 patent [calculates] DWT coefficients outside the boundary of the tile.

Earth Resource Mapping (ERM)'s software, ER Mapper, did not meet the claim limitations related to calculations based on coefficients outside the tile.

> In the context of the '835 patent, "maintaining updated sums" means "summing the DWT coefficients of one tile together with overlapping DWT coefficients from one or more adjacent tiles." Overlapping in that context can only mean that the DWT coefficient at a given position, obtained from the data in one tile, is added to the DWT coefficient at the same position, obtained from the data in an adjacent tile. As explained above, that process is the basis for forming a seamless DWT in the '835 patent . . . and that process was clearly encompassed by the court's claim construction from the start. . . . ER Mapper calculates DWT coefficients only for locations within the tile.

The court affirmed the invalidity of claim 21.

> The trouble with allowing claim 21 to cover all ways of performing DWT-based compression processes that lead to a seamless DWT is that there is no support for such a broad claim in the specification. The specification provides only a single way of creating a seamless DWT, which is by maintaining updated sums of DWT coefficients. There is no evidence that the specification contemplates a more generic way of creating a seamless array of DWT coefficients. . . . Whether the flaw in the specification is regarded as a failure to demonstrate that the patentee possessed the full scope of the invention recited in claim 21 or a failure to enable the full breadth of that claim, the specification provides inadequate support for the claim under section 112, paragraph one. . . . Thus, a patentee cannot always satisfy the requirements of section 112, in supporting expansive claim language, merely by clearly describing one embodiment of the thing claimed. For that reason, we hold that the description of one method for creating a seamless DWT does not entitle the inventor of the '835 patent to claim any and all means for achieving that objective.
