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Federal Circuit Patent Bulletin: *Starhome GmbH v. AT&T Mobility LLC*

February 25, 2014

"[A] construction that excludes a preferred embodiment 'is rarely, if ever, correct and would require highly persuasive evidentiary support.'"

On February 24, 2014, in *Starhome GmbH v. AT&T Mobility LLC*, the U.S. Court of Appeals for the Federal Circuit (Moore, Schall,* Reyna) affirmed the district court's entry of the stipulated judgment that AT&T did not infringe U.S. Patent No. 6,920,487, which related to a way of improving the functionality of phone services for users in a roaming telephone network. The Federal Circuit stated:

"The words of a claim are generally given their ordinary and customary meaning as understood by a person of ordinary skill in the art when read in the context of the specification and prosecution history." "There are only two exceptions to this general rule: 1) when a patentee sets out a definition and acts as his own lexicographer, or 2) when the patentee disavows the full scope of a claim term either in the specification or during prosecution." We have made clear that dictionaries and treatises can often be useful in claim construction, particularly insofar as they help the court "'to better understand the underlying technology' and the way in which one of skill in the art might use the claim terms." Moreover, judges are free to rely on dictionaries at any time during the process of construing claims "so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents."

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Both asserted claims recite an "intelligent gateway." The term "gateway" had a well-understood meaning in the art at the time the patentees filed the application that led to the '487 patent. As evidenced by technical dictionaries, one of ordinary skill in the art would have understood a "gateway" to be a connection between different networks.

Considering "gateway" in the context of the claims and specification of the '487 patent, one of ordinary skill would have understood that the inventors did not depart from the ordinary meaning of "gateway" with their use of the term "intelligent gateway." The gateway is intelligent because it includes a database of information and is adapted to do things such as translate dialing sequences, deliver short messages, provide assistance, and obtain information for call completion. But, consistent with its ordinary meaning, the specification also explains that it connects different networks. . . . After reading the claims and specification, one of ordinary skill in the art would therefore have understood that "intelligent gateway" carries its ordinary meaning as a device that connects different networks.

Starhome relies on Figure 2 to support its proposed construction, arguing that the figure shows an intelligent gateway operating within a single network, thus constituting a preferred embodiment excluded by the district court's construction. If true, Starhome's argument would carry force because a construction that excludes a preferred embodiment "is rarely, if ever, correct and would require highly persuasive evidentiary support." However, although Starhome correctly points out that Figure 2 does not show a connection to a packet-switch network, we disagree that it constitutes a separate embodiment. . . . At best, Figure 2 inserts ambiguity as to whether the patentees intended to depart from the ordinary meaning of "intelligent gateway." But such ambiguity does not rise to the level of the clear intent our case law requires. Accordingly, we find nothing in the specification that indicates a clear intent to depart from the ordinary meaning of "intelligent gateway."

Starhome further argues that the doctrine of claim differentiation supports its proposed construction. . . . The doctrine of claim differentiation is "based on the common sense notion that different words or phrases used in separate claims are presumed to indicate that the claims have different meanings and scope." The doctrine is not a hard and fast rule, but instead "a rule of thumb that does not trump the clear import of the specification. " The doctrine does not control the outcome here. The district court's construction of "intelligent gateway" requires that it transfer information to and from a "network external to the mobile network." Claims 1 and 47, however, claim a specific type of external network; namely, a packet-switch network. The claims differ in scope, therefore, and the district court's construction neither imports limitations from one claim to another nor renders any claims redundant.

To bolster their case, Defendants point to the prosecution history of a related European application. We have previously held that statements made before foreign patent offices are sometimes relevant to interpreting the claims. But we have also cautioned against indiscriminate reliance on foreign file histories. In this case, Starhome argued in a related foreign application that "a gateway provides access to an external environment beyond the immediate network," and that "the term 'intelligent gateway' is defined in this way, that is in terms of an access means from one network to another." Although we view Starhome's statements with the requisite caution, they do provide yet another indication that the patentees did not intend to depart from the ordinary meaning of "intelligent gateway." . . .

Turning to infringement, the parties stipulated that "the accused systems do not directly transfer information to and from a network external to the mobile network." In addition, the parties agree that the accused systems are not connected to an external packet-switch network or other external network. Because the term "intelligent gateway" requires connection to an external packet-switch network or other external network, there can be no infringement. Accordingly, we affirm the district court's judgment of noninfringement.