

Federal Circuit Patent Bulletin: *GPNE Corp. v. Apple Inc.*

August 1, 2016

"Where a district court has resolved the questions about claim scope that were raised by the parties, it is under no obligation to address other potential ambiguities that have no bearing on the operative scope of the claim."

On August 1, 2016, in *GPNE Corp. v. Apple Inc.*, the U.S. Court of Appeals for the Federal Circuit (Prost,* Taranto, Chen) affirmed the district court's judgment that Apple did not infringe U.S. Patents No. 7,570,954 and No. 7,792,492, which related to a two-way paging system with paging devices capable of not only receiving messages but also sending messages back in response. The Federal Circuit stated:

The words of a claim are generally given their ordinary and customary meaning, which is the meaning that the term would have to a person of ordinary skill in the art at the time of the invention. "Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification." Accordingly, "the only meaning that matters in claim construction is the meaning in the context of the patent."

We have recognized that when a patent "repeatedly and consistently" characterizes a claim term in a particular way, it is proper to construe the claim term in accordance with that characterization. Here, the words "pager" and "pager units" appear in the specification over 200 times, and, apart from the Abstract, the specification repeatedly and exclusively uses these words to refer to the devices in the patented system. Although GPNE is correct that the

Authors

Lawrence M. Sung
Partner
202.719.4181
lsung@wiley.law

specification discloses information about the features the devices have and the network they operate on, none of this is inconsistent with characterizing the devices as a type of pager. The prosecution history also supports construing “node” as a type of “pager” because the inventor’s Rule 131 declaration consistently and exclusively describes the invention as a system of pagers. In light of this consistent disclosure, the district court did not err in characterizing a “node” as a “pager.”

GPNE’s claim differentiation argument does not alter this conclusion. Claim differentiation is “not a hard and fast rule,” but rather a presumption that will be overcome when the specification or prosecution history dictates a contrary construction. Because the specification and the prosecution history so consistently describe “nodes” as “pagers,” such is the case here. In addition, the claims that GPNE contrasts differ in more ways than just their use of “node” or “pager,” so the inference that “different words or phrases used in separate claims . . . indicate that the claims have different meanings and scope,” is weak at best. Accordingly, we agree with the district court that “node” is properly characterized as a “pager.” . . .

[T]he phrase “operates independently from the telephone system” appears in only one sentence of the Detailed Description section, but disagree that it was improper for the district court to limit the claims in this way. “When a patent . . . describes the features of the ‘present invention’ as a whole, this description limits the scope of the invention.” As GPNE recognizes, this is a summation sentence which describes “the invention” as a whole. This characterization is bolstered by the prosecution history, as the inventor’s Rule 131 declaration several times states that the invention operates independently of a telephone network. Accordingly, it was proper for the district court to conclude that a “node” should have the capability to “operate[] independently from a telephone network.” . . .

Where a district court has resolved the questions about claim scope that were raised by the parties, it is under no obligation to address other potential ambiguities that have no bearing on the operative scope of the claim. This is because “[s]uch an endeavor could proceed ad infinitum, as every word—whether a claim term itself, or the words a court uses to construe a claim term—is susceptible to further definition, elucidation, and explanation.” Here, the district court’s construction was sufficient to resolve the parties’ dispute over the scope of “node.” Its construction specifies that “node” is not simply any “pager,” but one that must be capable of “two-way communications,” “transmit[ing] wireless data communications on a paging system,” and functioning on a “paging system that operates independently from a telephone network.” . . .

At bottom, then, GPNE’s complaint rests not with the district court’s failure to define claim scope, but with its allowing Apple to make certain arguments to the jury. The focus of GPNE’s argument is that Apple allegedly devoted a substantial amount of time at trial to comparing the accused iPhones and iPads to 1990s-era legacy pagers. Accurately characterized, this is an argument about whether Apple’s arguments to the jury were improper by “offering the jury appealingly simplifying ways to determine . . . infringement thus inviting the jury to shirk its key factfinding function.” . . . On the record before us, we conclude that the district court did not abuse its discretion when it found that Apple’s arguments did not require a new trial. Whether Apple’s accused iPhones and iPads could be “pagers” was extensively debated at trial. GPNE had ample opportunities to present rebuttal testimony and argument that the iPhones and iPads were “pagers,” and it took advantage of these opportunities on a number of occasions. . . . Given this counter-balancing testimony

and argument, it was within the district court's discretion to conclude that the jury was not misguided in carrying out its role as infringement factfinder and that a new trial was not warranted.