

Federal Circuit Patent Bulletin: *Indacon, Inc. v. Facebook, Inc.*

June 6, 2016

"[Where claim] terms have no plain or established meaning to one of ordinary skill in the art . . . they ordinarily cannot be construed broader than the disclosure in the specification."

On June 6, 2016, in *Indacon, Inc. v. Facebook, Inc.*, the U.S. Court of Appeals for the Federal Circuit (Newman, Reyna, Stoll*) affirmed the district court's judgment, entering the parties' stipulation based on the claim construction, that Facebook did not infringe U.S. Patent No. 6,834,276, which related to a system and method for searching, indexing, perusing, and manipulating files in a database, particularly through the insertion of automatically generated hyperlinks. The Federal Circuit stated:

"[T]he specification 'is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.'" The prosecution history of a patent is also part of the intrinsic evidence and "can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution."

Several of the claims require a link to be established between an "alias" or "alias term" and a plurality of files. The district court construed the claim term "alias" as a "textual expression that the user can define to serve as an alternative name or label." . . . We agree with the district court that "alias" and "alias term" are limited to textual expression. The district court first construed "term" as "textual expression, such as words," finding an express definition of "term" in the specification as "words, numbers, spaces, etc." Then, finding that the specification described an alias as a term, the district court looked to this construction of "term" to determine that "alias" is similarly limited to textual expression. . . .

The '276 patent defines "term" by referring to forms of textual expression ("words, numbers, spaces, etc."). As the district court explained, the use of "etc." in this definition implies additional, but similar forms of expression and does not reasonably encompass graphical expression. Indacon also recognizes that exemplary claim 1 is not directed to just an "alias," but actually requires an "alias term." Thus, Indacon's argument that the construction of "term" is irrelevant to the construction of "alias" is unconvincing. Further, nothing in the specification suggests that "alias" encompasses graphical expression. Instead, the specification consistently describes an alias as a term, which, as explained above, is limited to textual expression. . . . The prosecution history also fails to support an interpretation of an "alias" encompassing graphical expression. . . .

The district court construed “custom link” as “a link the user can define using a chosen term that allows each instance of the term in the plurality of files to be identified and displayed as a link to a file chosen by the user, without modifying the original database files”; “custom linking relationship” as “a linking relationship the user can define using a chosen term that allows each instance of the term in the plurality of files to be identified and displayed as a link to a file chosen by the user, without modifying the original database files”; and “link term” as “a term chosen by a user that can be displayed as a link to a file specified by the user whenever the user encounters the term in the plurality of files.” [We] adopt the district court’s constructions of the link claim terms as being limited to allowing each instance of a link term to be identified and displayed as a link.

Facebook argues that the link claim terms have no accepted meaning in the art. We agree with Facebook that these terms have no plain or established meaning to one of ordinary skill in the art. As such, they ordinarily cannot be construed broader than the disclosure in the specification. . . . The specification repeatedly demonstrates that all link terms are capable of being identified and displayed as a link. Thus, we agree with the district court that, consistent with the teachings of the specification, the link claim terms are properly construed as allowing each instance of a defined term to be identified and displayed as a link. . . .

Because the link claim terms lack a plain or ordinary meaning in the art, and because the specification suggests limiting the scope of these claim terms to allowing each instance of a defined term to be identified and displayed as a link, we need not determine whether the patentees’ statements during prosecution rise to the level of clear and unmistakable disclaimer. . . . Moreover, “the interested public has the right to rely on the inventor’s statements made during prosecution, without attempting to decipher whether the examiner relied on them, or how much weight they were given.” Here, the patentees repeatedly described their invention both in the specification and the prosecution history as allowing “every instance” or “all instances” of a defined term to be identified and displayed as a link. Under these circumstances, the district court did not err in limiting the link claim terms as such. . . .

[W]e have declined to apply the doctrine of claim differentiation where, as here, the claims are not otherwise identical in scope. Further, “[a]lthough claim differentiation is a useful analytic tool, it cannot enlarge the meaning of a claim beyond that which is supported by the patent documents, or relieve any claim of limitations imposed by the prosecution history.” Thus, we adopt the district court’s constructions of the link claim terms.