

KRATZ, QUINTOS & HANSON, LLP

IP NEWSLETTER

RECENT C.A.F.C. DECISIONS ON PATENT CLAIM INTERPRETATION UNDER THE DOCTRINE OF EQUIVALENTS

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This issue of our IP Newsletter outlines three recent cases of the Court of Appeals for the Federal Circuit (C.A.F.C.), and the reasons given by the court in interpreting patent claim language under the doctrine of equivalents.

(1) *Lucent Technologies, Inc. v. Gateway, Inc.* (decided May 8, 2008). The claim language at issue in one of the patents (U.S. Patent No. 4,701,954) is the step of forming N pulses “for each successive time frame ... by iteratively forming a sequence of pulses for said time frame, ... each successive iteration including the steps of [steps 1-5].” The issue is whether each pulse is formed by: (1) performing each of steps 1-5, or (2) performing only step 5 and relying on the results of past steps 1-4.

In interpreting the claim language, the C.A.F.C. looked into the claim itself, and held that steps 1-5 must each be performed in forming each pulse because “[t]his court has consistently interpreted ‘including’ and ‘comprising’ to [mean] that the listed elements (i.e., method steps) are essential but other elements may be added.”

(2) *Decisioning.com, Inc. v. Federated Department Stores, Inc.* (decided May 7, 2008). The relevant patent in this case is U.S. Patent No. 6,105,007 directed to a system for assisting a person to apply from a far distance for, for example, a loan or credit card, and to receive an approval within minutes. A significant claim element is: “a remote interface adapted to: i. allow an applicant to remotely request an account; and ii. receive data from an applicant.” The issue is whether the term “remote interface” should be broadly interpreted to include both (a) kiosks located in public places for public access and (b) a user’s personal computer, or narrowly construed to include only kiosks.

The court narrowly interpreted “remote interface” to include only kiosks, and to exclude a user’s personal computer, because the specification describes: (i) the use of “kiosk” as the invention itself, (ii) the use of “convenient locations” consistent with the common dictionary meaning of a “kiosk” as a publicly-accessible location, and (iii) various features of the kiosk (e.g., touch-screen or voice recognition technology) that would not be associated with consumer-owned personal computers.

(3) *Symantec Corporation v. Hilgraeve, Inc.* (decided April 11, 2008). The patent at issue is U.S. Patent No. 5,319,776, which is directed to a method of scanning for and detecting computer viruses in data files that are downloaded or copied from a remote server via, for example, the internet onto a computer. The preamble of the claim recites “a method of screening the data as it is being transferred,” while the claim body recites “screening the ... data prior to storage.” The issue is whether the claimed invention scans and detects for viruses: (1) only before the data is stored and made accessible to other computer programs (“prior to storage” as recited in the claim body), or (2) after the data is stored, but before the data becomes accessible to other computer programs (“as it is being transferred” as recited in the preamble of the claim).

The court held that the language in the preamble and the body of the claim have the same and consistent meaning, and construed the claim term “as it is being transferred” (as recited in the preamble) to only mean that virus scanning occurs “prior to storage” (as recited in the body of the claim) because: (1) “it is assumed that the preamble language is duplicative of the language found in the body of the claims or merely provides context [and not an additional limitation] for the claims absent any indication to the contrary in the claims, specification or the prosecution history,” (2) during the prosecution history, both terms were added concurrently to overcome the same prior art, and thus, the language “as it is being transferred” did not have a different significance, and (3) it only makes sense that scanning for viruses occurs “completely before any data is written [or stored] to the computer” to avoid the spread of any viruses.