

Predicate Logic, Inc. v. Distributive Software, LLC

No. 07-1539, Fed. Cir. (Newman, Lourie, Linn*)

In analyzing the breadth of the claim before and after amendment [that occurs during reexamination], the district court [may] ask whether any conceivable process would infringe the amended claim, but not infringe the original claim.

On October 9, 2008, the Federal Circuit reversed and remanded the district court's summary judgment that U.S. Patent No. 5,930,798, which related to a universal data measurement, analysis, and control method that can be used in the software development process, was invalid under 35 U.S.C. § 305. The Federal Circuit stated:

Under 35 U.S.C. § 305, “[n]o proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding.” Claims that are impermissibly broadened during reexamination are invalid, and “a violation of 35 U.S.C. § 305 is an invalidity defense in a patent infringement action.” “Whether amendments made during reexamination enlarge the scope of a claim is a matter of claim construction, which this court reviews de novo.” . . . In analyzing the breadth of the claim before and after amendment, the district court was correct to ask whether any conceivable process would infringe the amended claim, but not infringe the original claim. But the district court's analysis in considering its hypothetical infringing process was flawed. The district court described its hypothetical infringing process as a process that “generated four indexes, stored four indexes, instantiated only two of those indexes, stored the results of those instantiations and then compared those results.” . . . This hypothetical process plainly infringes the amended claim. [T]he hypothetical infringing process described by the district court would infringe not only the claim as amended, but also the original claim. The hypothetical process does not demonstrate that the claim was broadened. Moreover, we can imagine no conceivable process—and the parties have identified none—that would infringe the amended claim but would not infringe the original claim. We therefore conclude that the amendment of “said at least one index” to “at least one said index” did not broaden the scope of claim 1.

Although our conclusion concerning the shifting of “said” alone requires that we reverse the district court's grant of summary judgment, we nonetheless address the district court's conclusion that the amendment of “instantiating” to “first instantiating” and “second instantiating” was a substantive change. . . . Under 35 U.S.C. § 307, a claim that is amended in reexamination has the same effect as a claim that is amended in reissue proceedings under 35 U.S.C. § 252. Correspondingly, under 35 U.S.C. § 252, a reissued patent is enforceable against infringing activity that occurred after the issuance of the original patent, “to the extent that its claims are substantially identical” to the claims of the original patent. Thus, “[u]nless a claim granted or confirmed upon reexamination is identical to an original claim, the patent can not be enforced against infringing activity that occurred before issuance of the reexamination certificate.” “Identical” does not mean verbatim, but means at most without substantive change. . . . An

amendment that clarifies the text of the claim or makes it more definite without affecting its scope is generally viewed as identical”

The district court concluded that the amendment replacing the step of “instantiating said at least one index” with steps of “first instantiating at least one said index” and “second instantiating at least one said index” changed the scope of claim 1. . . . Despite the “comparing” step’s requirement of two instantiations, the district court found that the amendment changed the scope of the claim for two reasons. First, the district court reasoned that, in the original claim, only one instantiation might occur during the “instantiating” step, then that instantiation would be compared with a previously stored instantiation, which was generated outside of the claimed process. But critically, the “comparing” step does not compare data sets linked to “an instantiated index” with data sets linked to “another instantiated index”; it compares data sets linked to “one of said instantiated indexes” with data sets linked to “another of said instantiated indexes.” The “said instantiated indexes” must be instantiated indexes with an antecedent basis elsewhere in the claim—namely, the indexes that are instantiated during the “instantiating” step. Thus, the district court was incorrect to conclude that the instantiated indexes in the “comparing” step could be indexes other than those generated as part of the claimed process.

Second, the district court reasoned that the “comparing” step might allow a comparison between data sets linked to two different instantiations of the same index, rather than two instantiations of different indexes. We agree that in both the original and the amended claim, the “comparing” step permits a comparison between data sets linked to either multiple instantiations of the same index, single instantiations of multiple indexes, or some combination. But the “comparing” step still requires that at least two instantiations (either of the same index, or of different indexes) be performed, because of the language “one of said instantiated indexes” and “another of said instantiated indexes.” There is nothing in the amended claim that suggests that the “first instantiating” and “second instantiating” steps must be performed on data linked to the same index; likewise, there is nothing in the amended claim that suggests that the “first instantiating” and “second instantiating” steps must be performed on data linked to different indexes. . . . We conclude that the amendment of the “instantiating” step to the “first instantiating” and “second instantiating” steps did not result in a substantive change to claim 1 of the ’798 patent. The original and amended claims are “identical” for purposes of § 252 and, correspondingly, § 307.

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