

## ALERT

## Federal Circuit Patent Bulletin: *Golden Bridge Tech., Inc. v. Apple Inc.*

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July 14, 2014

*"[Where there has been] a clear and unmistakable assertion by the patentee to the PTO of the meaning and scope of the [claim term, the fact that the disclaimer] was contained in documents accompanying an IDS does not change this result."*

On July 14, 2014, in *Golden Bridge Tech., Inc. v. Apple Inc.*, the U.S. Court of Appeals for the Federal Circuit (Moore,\* Mayer, Chen) affirmed the district court's summary judgment that did not infringe U.S. Patents No. 6,574,267 and No. 7,359,427, which related to an improved Code Division Multiple Access (CDMA) system that reduces the risk of interference between the signals sent from various mobile stations. The Federal Circuit stated:

Claim terms are generally given their plain and ordinary meanings to one of 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 the claim term either in the specification or during prosecution." Prosecution disclaimer or disavowal must be clear and unmistakable.

We conclude that GBT's submissions during prosecution of its stipulated construction for the term preamble constitute disclaimer. Although we generally construe terms according to their plain and ordinary meanings to one of ordinary skill in the art, we depart from that meaning where there is disclaimer. Here, GBT clearly and unmistakably limited the term preamble to "a signal used for communicating with the base station that is spread before transmission." During reexamination of the '267 patent and prosecution of the '427 patent, GBT submitted and requested that the PTO "expressly consider[]" its stipulated construction of preamble from the Texas Litigation. The stipulation required the preamble to be spread before transmission. It would have been natural for both the PTO and the public to rely upon the stipulation in determining the scope of the claimed invention.

It is correct that “mere disclosure of potentially material prior art to the [PTO] does not automatically limit the claimed invention.” However, this is not a typical IDS, and GBT did more than simply disclose potentially material prior art. It submitted its own stipulated construction of a claim term in the context of the particular patents being reexamined (‘267 patent) and prosecuted (‘427 patent). This is a clear and unmistakable assertion by the patentee to the PTO of the meaning and scope of the term preamble. The fact that the stipulation was contained in documents accompanying an IDS does not change this result. We have held that “an applicant’s remarks submitted with an [IDS] can be the basis for limiting claim scope.” On the facts of this case, we see no meaningful difference between limiting claim scope based on an applicant’s stipulations contained in IDS documents and an applicant’s remarks contained in the IDS itself. GBT’s stipulation tells the PTO how preamble should be construed, and we conclude that GBT is bound by this representation. We construe preamble in accordance with the stipulation as “a signal used for communication with the base station that is spread before transmission and that is without message data.”

Although our precedent allows applicants to rescind a disclaimer during prosecution, GBT did not avail itself of this route and never notified the PTO that it sought a meaning of preamble that was different from its stipulated construction. Indeed, there is no dispute that GBT did not rescind or retract its stipulated construction of preamble during prosecution of the patents-in-suit. We hold that GBT’s submission of its stipulation to the PTO thus constitutes a clear and unmistakable disclaimer of the broader claim scope that GBT now seeks. . . .

GBT accused Apple’s mobile devices that use a third generation (3G) cellular technology of infringing various claims of the ‘267 and ‘427 patents. The accused Apple mobile devices send an access signal—called a Physical Random Access Channel (PRACH) preamble—to a specific base station to establish a communication link with the base station. The PRACH preamble is made of a combination of (1) a base station specific scrambling code and (2) a signature sequence. The signature sequence is created first and is then spread using the scrambling code to create the PRACH preamble. The completed PRACH preamble is then transmitted to the base station. . . .

We hold that the district court properly granted summary judgment of noninfringement. The preamble must be “spread prior to transmission.” The PRACH preamble is not spread. The signature sequence is spread by the scrambling code to create the PRACH preamble. This step cannot constitute spreading the PRACH preamble because a preamble cannot be spread before it exists. Because there is no dispute that the PRACH preamble is not spread, it cannot meet the preamble limitations in the asserted claims. The district court properly granted summary judgment of noninfringement on this basis.

GBT also argues that the district court erred by declining to modify its judgment of noninfringement on reconsideration. GBT's argument is two-fold. First, it contends that it did not waive its signature sequence infringement theory because that theory was not introduced for the first time in its motion for reconsideration. Second, on the merits, GBT argues that there is a genuine issue of material fact with respect to infringement based on its theory that the signature sequence in the accused devices meets the preamble limitations. . . .

An argument made for the first time in a motion for reconsideration comes too late and is ordinarily deemed waived. Indeed, new arguments are beyond the scope of a motion for reconsideration. "Such motions are not to be used as an opportunity to relitigate the case; rather, they may be used only to correct manifest errors of law or fact or to present newly discovered evidence." We conclude that GBT's signature sequence infringement theory was raised for the first time in its motion for reconsideration. Prior to its motion for reconsideration, GBT did not argue that the signature sequence alone in the accused device was itself a preamble, but instead that the PRACH preamble met the preamble limitations in the claims. Having failed to persuade the court that a genuine issue of material fact remained with respect to its PRACH preamble infringement theory, GBT presented anew infringement theory on reconsideration. This was improper.