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Federal Circuit Patent Bulletin: *Wi-LAN USA, Inc. v. Apple, Inc.*

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August 1, 2016

"Claim differentiation cannot 'overcome . . . a contrary construction dictated by the written description or prosecution history.' Nor can claim differentiation apply untethered from the reasonable meaning of the difference in claim language on which it rests."

On August 1, 2016, in *Wi-LAN USA, Inc. v. Apple, Inc.*, the U.S. Court of Appeals for the Federal Circuit (Lourie, Bryson, Chen*) affirmed the district court's summary judgment that Apple did not infringe U.S. Patents No. 8,311,040 and No. 8,315,640, which related to an enhanced efficiency wireless network using intermediary nodes between the base station and the user devices. The Federal Circuit stated:

We begin our analysis with the words of the claim itself as an ordinary artisan would have understood them at the time of the invention. Although the term "specified connection" in the claims is singular, the claims' usage of the term (e.g., "each SDU being associated with a specified connection") indicates that each service data unit—in a claim that contemplates multiple service data units—is associated with exactly one "specified connection," not that the intermediary node maintains only one "specified connection." This fact thus offers no clues as to whether the invention excludes embodiments incapable of maintaining multiple specified connections. . . .

Consistent use of a term in a particular way in the specification can inform the proper construction of that term. Here, we find the specification's consistent references to multiple "specified connections" to weigh in favor of a construction excluding embodiments where the intermediary node is capable of maintaining only one "specified connection." We also find the claims' discussion of allocating bandwidth based on a specified connection's priority to support the district court's conclusion. Each independent claim at issue contains a limitation related to allocating bandwidth based on a specified connection's priority. . . . To "allocate" something is to distribute it among multiple recipients. Thus when the claims describe allocating bandwidth to a specified connection, they imply that the intermediary node distributes this bandwidth among multiple specified connections. The claims further describe this allocation as based on a specified connection's "priority." Priority is a relative concept: a specified connection only has a "priority" in comparison to other specified connections' priorities. The specification reinforces this conception of "priority" as necessarily relative. . . .

Wi-LAN admits that it cannot show that Apple infringes claim 6 of the '640 patent, and it does not appeal the district court's grant of summary judgment of noninfringement on that claim. But when attempting to overcome a prior-art rejection during prosecution, it tied important language now in claim 1 to parallel language in the application claim that would become claim 6. That statement tying these two claims together is inconsistent with the position it now takes. A patentee cannot make representations about claim language during prosecution to avoid prior art and then escape these representations when trying to show infringement. . . .

The doctrine of claim differentiation provides a presumption that differently worded claims cover different claim scope. This doctrine finds root in the legal canon of construction against superfluity. A construction that would cause two differently worded claims to cover exactly the same claim scope would render one of the claims superfluous, so we apply a presumption against such constructions. "Claim differentiation is a guide, not a rigid rule." "It is not unusual that separate claims may define the invention using different terminology, especially where (as here) independent claims are involved." Claim differentiation cannot "overcome . . . a contrary construction dictated by the written description or prosecution history." Nor can claim differentiation apply untethered from the reasonable meaning of the difference in claim language on which it rests. Although we might see some significance in the patentee's decision to modify "connections" with "UL" in claim 1 but not in claim 6, that significance must be grounded in reasonable meanings of the term "UL." . . . Faced with a choice between two possible understandings of "UL connections," we reject Wi-LAN's proposed construction, which conflicts with (1) the bandwidth-allocation scheme the patent sets out, (2) the patent's description of a network architecture where the intermediary node maintaining one connection with the base station and multiple connections with its user devices, and (3) statements Wi-LAN made in prosecution. Instead, we agree with the district court's construction of "UL connections" as corresponding to the connections between the intermediary node and its user devices. Wi-LAN does not claim any other source of error with regard to the '640 patent beyond this construction. We therefore also affirm the district court's grant of summary judgment of noninfringement.