

Trading Techs. International, Inc. v. eSpeed, Inc.

Nos. 08-1392, -1393, -1422, Fed. Cir. (Lourie, Rader,* Clark)

Because an inventor must evince a “clear intention” to limit the claim terms to a specification embodiment, this court examines other claims to detect any contrary intentions.

On February 25, 2010, the Federal Circuit affirmed the district court’s judgment that one of eSpeed’s products infringed (but not willfully) U.S. Patents No. 6,772,132 and No. 6,766,304, which related to software for displaying the market for a commodity traded in an electronic exchange, two other products did not literally infringe (but TT was barred from asserting infringement under the doctrine of equivalents), the patents were entitled to the earlier filing date of a provisional application, the on-sale bar of 35 U.S.C. § 102(b) did not apply, the patent claims were not indefinite, and the patents were not unenforceable due to inequitable conduct. The Federal Circuit stated:

To construe a claim, courts must determine the meaning of disputed terms from the perspective of one of ordinary skill in the pertinent art at the time of filing. The claim terms “are generally given their ordinary and customary meaning.” “[T]he claims themselves provide substantial guidance as to the meaning of particular claim terms.” But the claims “must be read in view of the specification, of which they are a part.” A patent’s specification “is always highly relevant to the claim construction analysis.” When consulting the specification to clarify the meaning of claim terms, courts must not import limitations into the claims from the specification. Therefore, when the specification uses a single embodiment to enable the claims, courts should not limit the broader claim language to that embodiment “unless the patentee has demonstrated a clear intention to limit the claim scope using ‘words or expressions of manifest execution or restriction.’” In addition, “other claims of the patent . . . can also be valuable sources of enlightenment as to the meaning of a claim term.” In claim construction “a court ‘should also consider the patent’s prosecution history’” “[T]he prosecution history 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, making the claim

scope narrower than it would otherwise be.” For example, “a patentee may, through a clear and unmistakable disavowal in prosecution history, surrender certain claim scope to which he would otherwise have an exclusive right by virtue of the claim language.” At the same time, because prosecution history represents an ongoing negotiation between the PTO and the inventor, “it often lacks the clarity of the specification and thus is less useful for claim construction purposes.”

TT disputes the construction of the word “static” in the phrase “static display of prices” in the ’132 patent and in the phrase “common static price axis” in the ’304 patent. All asserted claims of the ’132 patent include the limitation “static display of prices.” Likewise, all asserted claims of the ’304 patent include the limitation “common static price axis.” TT and eSpeed agree that the difference in terminology between “static display of prices” and “common static price axis” is immaterial. The inventors acted as their own lexicographers and defined the word “static.” The values in the price column are static; that is, they do not normally change positions unless a re-centering command is received The district court made two important changes to this express definition in construing the word “static.” First, the district court added the word “manual” in front of the term “re-centering command.” Second, it deleted the word “normally.” The district court’s definition may seem narrower than the inventors’ express definition at first glance. However, the claims, the rest of the specification, and the prosecution history support the district court’s definition. Therefore, this court, after reconstruing this term based on its own understanding of the claims, specification, prosecution history, and record, agrees with the district court’s claim construction of the word “static.” . . . This court recognizes that this interpretation relies heavily on the specification and risks reading improperly a preferred embodiment into the claim. This court takes some comfort against this risk from the inventors’ use of the term “the present invention” rather than “a preferred embodiment” or just “an embodiment.” The inventors’ own specification strongly suggests that the claimed re-centering feature is manual. Because an inventor must evince a “clear intention” to limit the claim terms to a specification embodiment, this court examines other claims to detect any contrary intentions. In that respect, this court observes that all claims of the ’132 patent have a “wherein” clause explaining that “the static display of prices does not move in response to a change in the inside market.” Although the “wherein” clause does not exclude automatic re-centering from the claim scope (it does not exclude software that automatically re-centers whenever the trader enters an order, for example), it expressly excludes software that

automatically re-centers when the inside market changes. These clauses thus support the district court's claim construction.

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