Patent Law

Prof. Roger Ford
Monday, November 13, 2017
Class 21 – Infringement: indirect/divided infringement; means-plus-function claims

Recap

Recap

→ Infringement by equivalents

→ Prosecution history estoppel

Today's agenda

Today's agenda

- → Secondary liability / indirect infringement
- → Divided / joint infringement
- → Infringement of means-plus-function claims

Secondary liability

(post-AIA) 35 U.S.C. § 271 — Infringement of Patent

* * *

(b) Whoever **actively induces** infringement of a patent shall be liable as an infringer.

(c) Whoever offers to sell or sells within the United States or imports into the United States a **component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process**, constituting a material part of the invention, knowing the same to be **especially made or especially adapted for use in an infringement** of such patent, and **not a staple article** or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

* * *

Wallace v. Holmes (1871)

- → Tech: a new burner for an oil lamp
- → Claim: a new oil lamp with new burner AND standard fuel reservoir, wick tube, chimney
- → Accused product: new oil lamp minus the chimney
- → Court: this is "palpable interference" with the patent rights

Wallace v. Holmes (1871)

→ How could the patentee have prevented this problem?

Wallace v. Holmes (1871)

→ How could the patentee have prevented this problem?

- Just claim the novel burner separately
- Today: this totally works
- In 1871: not allowed

→ A lot of indirect-infringement issues could be avoided with better drafting

Wallace v. Holmes (1871)

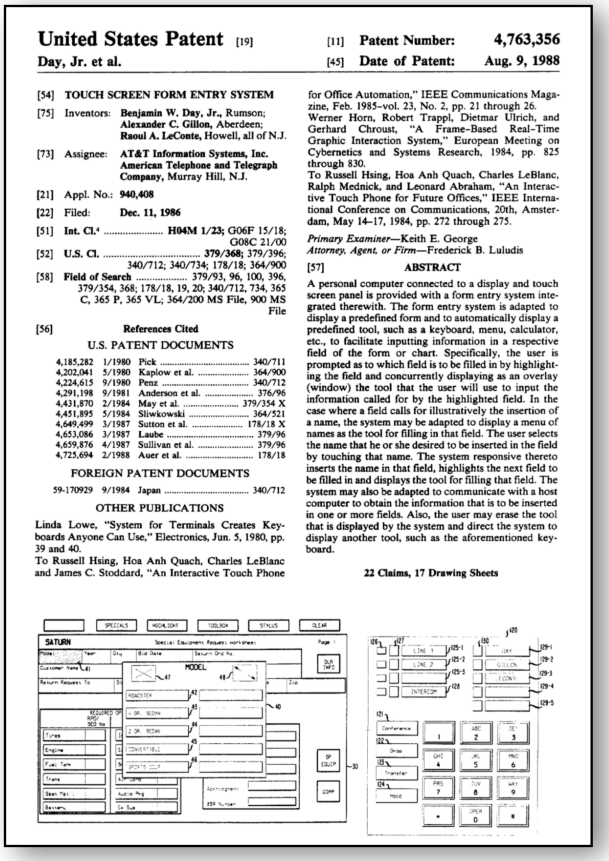
→ Now codified in § 271(b)–(c):

- § 271(b): inducing infringement
- § 271(c): selling a component of a patented invention, knowing it to be especially made for infringement and not a staple article of commerce

Lucent v. Gateway

→ Tech: Methods of inputing information without using a keyboard

- Basically, a pop-up date picker instead of a field where you can type in a date



United States Patent [19]
Day, Jr. et al.

[11] **Patent Number: 4,763,356**
[45] **Date of Patent: Aug. 9, 1988**

[54] **TOUCH SCREEN FORM ENTRY SYSTEM**

[75] Inventors: **Benjamin W. Day, Jr.**, Rumson; **Alexander C. Gillon**, Aberdeen; **Raoul A. LeConte**, Howell, all of N.J.

[73] Assignee: **AT&T Information Systems, Inc. American Telephone and Telegraph Company**, Murray Hill, N.J.

[21] Appl. No.: **940,408**

[22] Filed: **Dec. 11, 1986**

[51] **Int. Cl.**[4] **H04M 1/23**; G06F 15/18; G08C 21/00

[52] **U.S. Cl.** **379/368**; 379/396; 340/712; 340/734; 178/18; 364/900

[58] **Field of Search** ..... 379/93, 96, 100, 396, 379/354, 368; 178/18, 19, 20; 340/712, 734, 365 C, 365 P, 365 VL; 364/200 MS File, 900 MS File

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4,451,895	5/1984	Sliwkowski	364/521
4,649,499	3/1987	Sutton et al.	178/18 X
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To Russell Hsing, Hoa Anh Quach, Charles LeBlanc and James C. Stoddard, "An Interactive Touch Phone for Office Automation," IEEE Communications Magazine, Feb. 1985–vol. 23, No. 2, pp. 21 through 26.

Werner Horn, Robert Trappl, Dietmar Ulrich, and Gerhard Chroust, "A Frame-Based Real–Time Graphic Interaction System," European Meeting on Cybernetics and Systems Research, 1984, pp. 825 through 830.

To Russell Hsing, Hoa Anh Quach, Charles LeBlanc, Ralph Mednick, and Leonard Abraham, "An Interactive Touch Phone for Future Offices," IEEE International Conference on Communications, 20th, Amsterdam, May 14–17, 1984, pp. 272 through 275.

Primary Examiner—Keith E. George
Attorney, Agent, or Firm—Frederick B. Luludis

[57] **ABSTRACT**

A personal computer connected to a display and touch screen panel is provided with a form entry system integrated therewith. The form entry system is adapted to display a predefined form and to automatically display a predefined tool, such as a keyboard, menu, calculator, etc., to facilitate inputting information in a respective field of the form or chart. Specifically, the user is prompted as to which field is to be filled in by highlighting the field and concurrently displaying as an overlay (window) the tool that the user will use to input the information called for by the highlighted field. In the case where a field calls for illustratively the insertion of a name, the system may be adapted to display a menu of names as the tool for filling in that field. The user selects the name that he or she desired to be inserted in the field by touching that name. The system responsive thereto inserts the name in that field, highlights the next field to be filled in and displays the tool for filling that field. The system may also be adapted to communicate with a host computer to obtain the information that is to be inserted in one or more fields. Also, the user may erase the tool that is displayed by the system and direct the system to display another tool, such as the aforementioned keyboard.

22 Claims, 17 Drawing Sheets

U.S. Patent No. 4,763,356

→ "Touch screen form entry system

United States Patent [19]
Day, Jr. et al.

[11] **Patent Number: 4,763,356**
[45] **Date of Patent: Aug. 9, 1988**

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[52] **U.S. Cl.** **379/368**; 340/712; 340/734; 178/1

[58] **Field of Search** ..... 379/93, 96; 379/354, 368; 178/18, 19, 20; 340/71 C, 365 P, 365 VL; 364/200 MS Fil

[56] **References Cited**

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59-170929	9/1984	Japan	

OTHER PUBLICATIONS

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To Russell Hsing, Hoa Anh Quach, Charles and James C. Stoddard, "An Interactive Tou

19. A method for use in a computer having a display comprising the steps of

displaying on said display a plurality of information fields,

identifying for each field a kind of information to be inserted therein,

indicating a particular one of said information fields into which information is to be inserted and for concurrently displaying a predefined tool associated with said one of said fields, said predefined tool being operable to supply information of the kind identified for said one field, said tool being selected from a group of predefined tools including a tool adapted to supply an individual entry from a menu of alternatives and at least a tool adapted to allow said user to compose said information, and

inserting in said one field information that is derived as a result of said user operating said displayed tool.

U.S. Patent No. 4,763,356

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entry
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Lucent v. Gateway

→ When is this claim infringed?

Lucent v. Gateway

→ When is this claim infringed?

- Under § 271(a), infringement requires making, using, selling, offering for sale, or importing the patented invention
- But here, the patented invention requires a user to use the method
- So only when a user actually uses it!

Lucent v. Gateway

→ Why let Lucent sue Gateway (really, Microsoft) under § 271(c) instead of suing the actual infringers?

Lucent v. Gateway

→ Why let Lucent sue Gateway (really, Microsoft) under § 271(c) instead of suing the actual infringers?

- It's much more efficient to go after the seller
- And if Microsoft knows about the patent, it's morally culpable

Lucent v. Gateway

→ What's required to find for Lucent?

Lucent v. Gateway

→ What's required to find for Lucent?

1. Microsoft's product is used to commit acts of infringement
2. Microsoft's product is a "material part of the invention"
3. Microsoft knew that the product was especially made or adapted for infringement; and
4. The product was not a staple article of commerce suitable for noninfringing uses

Lucent v. Gateway

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Lucent v. Gateway

→ Did Microsoft know about the patent?

Lucent v. Gateway

→ Did Microsoft know about the patent?

- Under *Global-Tech*, they must have
- Likely, Lucent sent a demand letter telling Microsoft about the patent and Microsoft kept selling Outlook

Lucent v. Gateway

→ What's required to find for Lucent?

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Lucent v. Gateway

→ But isn't Microsoft Outlook capable of substantial noninfringing uses?

Lucent v. Gateway

→ But isn't Microsoft Outlook capable of substantial noninfringing uses?

- Yes!
- But the date picker isn't
- With software, you have to look at the feature, not the entire product, or § 271(c) liability would basically never apply

Global-Tech v. SEB

→ § 271(b): whoever "actively induces infringement" is liable

→ Question: what mental state is required?

- Actual knowledge
- Willful blindness
- Recklessness
- Deliberate disregard of a known risk
- Should have known
- Negligence
- Strict liability

Global-Tech v. SEB

→ Federal Circuit: Deliberate disregard of a known risk is sufficient

→ Supreme Court: No, actual knowledge is required

→ However: Willful blindness is a form of actual knowledge

- Requires: subjective belief that there is a high probability of a patent, and deliberate action to avoid learning about it

Global-Tech v. SEB

→ What was the inducement?

Global-Tech v. SEB

→ What was the inducement?

- Here: encouraging others to sell infringing deep fryers
- In general: actively and knowingly aiding and abetting

CR Bard v. Advanced Cardiovascular Sys.

→ Bard patent: method of using a catheter in coronary angioplasty

→ ACS product: only catheter approved by FDA for use in coronary angioplasty

→ Claims:

- § 271(b) – inducing doctors to infringe
- § 271(c) – selling catheter for infringing use

CR Bard v. Advanced Cardiovascular Sys.

→ Problem: three ways to use the catheter

- (1) all side openings in aorta: not infringing
- (2) all side openings in coronary artery: infringing
- (3) some in each place: maybe infringing

→ So, a jury could conclude there are substantial noninfringing uses

- If so, no § 271(c) contributory infringement

CR Bard v. Advanced Cardiovascular Sys.

→ § 271(b) induced infringement:

- Requires actively and knowingly aiding and abetting another's direct infringement
- If instructions taught doctors how to infringe, then ACS is liable <u>even if there are other uses</u>

Commil v. Cisco

→ Commil patent: methods of improving wifi performance

→ Cisco product: wifi equipment that allegedly induced others to infringe (by using wifi)

→ Cisco's defense: we believed the patents were invalid

- Whoops, turns out they were wrong

Commil v. Cisco

→ Legal question: Is a good-faith belief that the patents are invalid a defense?

- *Global-Tech:* "[W]e now hold that induced infringement … requires knowledge that the induced acts constitute patent infringement."
- Federal Circuit: "It is axiomatic that one cannot infringe an invalid patent." Therefore, it is a valid defense

Commil v. Cisco

→ Supreme Court: No, infringement and validity are separate questions

- "[I]nvalidity is not a defense to infringement, it is a defense to liability."
- (This is stupid.)

Commil v. Cisco

→ So:

- Good-faith belief that a patent is not infringed: valid defense
- Good-faith belief that a patent is invalid: not a valid defense

→ What effects will this asymmetry have?

Secondary liability

→ Contributory infringement:

- Sale of an article, that is especially made to infringe and not a staple article of commerce, with knowledge of the patent and infringement

→ Induced infringement:

- Aiding and abetting, with knowledge of the patent and infringement
- Possibly active encouragement

→ After *Global-Tech,* the line between the two is very blurry

Divided / joint infringement

(post-AIA) 35 U.S.C. § 271 — Infringement of Patent

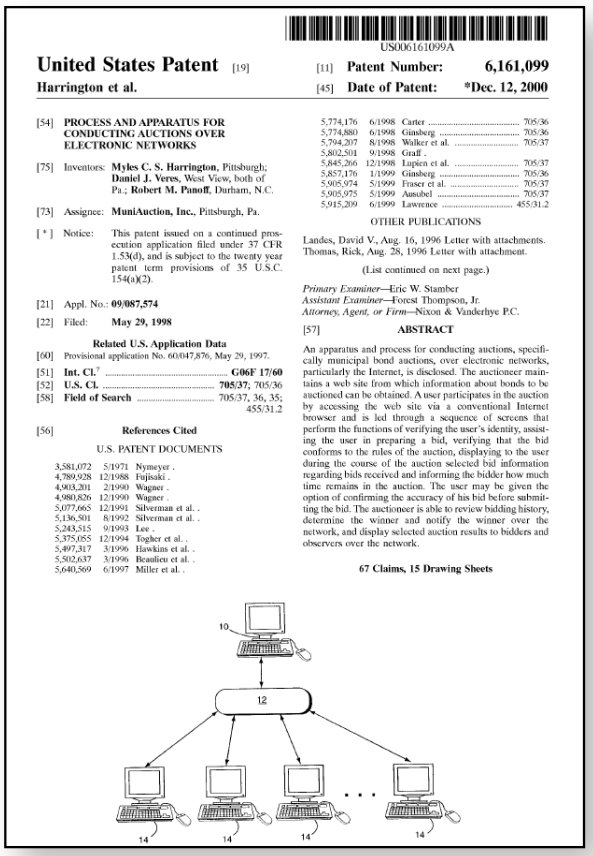
(a) Except as otherwise provided in this title, whoever without authority **makes, uses, offers to sell, or sells any patented invention**, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

* * *

Muniauction v. Thomson

→ Muniauction patent: process for auctioning municipal bonds online

→ Issue: Does Thomson's auction system infringe?



US006161099A

United States Patent [19]
Harrington et al.

[11] **Patent Number: 6,161,099**
[45] **Date of Patent: *Dec. 12, 2000**

[54] **PROCESS AND APPARATUS FOR CONDUCTING AUCTIONS OVER ELECTRONIC NETWORKS**

[75] Inventors: **Myles C. S. Harrington**, Pittsburgh; **Daniel J. Veres**, West View, both of Pa.; **Robert M. Panoff**, Durham, N.C.

[73] Assignee: **MuniAuction, Inc.**, Pittsburgh, Pa.

[*] Notice: This patent issued on a continued prosecution application filed under 37 CFR 1.53(d), and is subject to the twenty year patent term provisions of 35 U.S.C. 154(a)(2).

[21] Appl. No.: **09/087,574**

[22] Filed: **May 29, 1998**

Related U.S. Application Data

[60] Provisional application No. 60/047,876, May 29, 1997.

[51] **Int. Cl.**[7] **G06F 17/60**

[52] **U.S. Cl.** **705/37**; 705/36

[58] **Field of Search** 705/37, 36, 35; 455/31.2

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5,136,501	8/1992	Silverman et al. .	
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5,375,055	12/1994	Togher et al. .	
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(List continued on next page.)

Primary Examiner—Eric W. Stamber
Assistant Examiner—Forest Thompson, Jr.
Attorney, Agent, or Firm—Nixon & Vanderhye P.C.

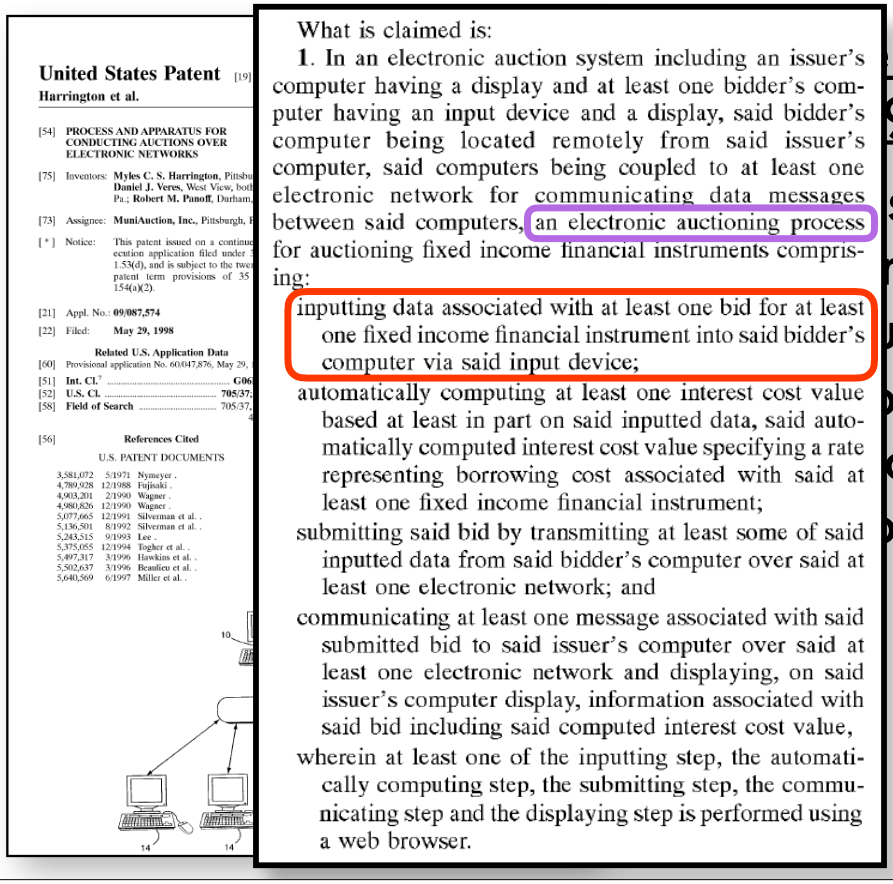
[57] **ABSTRACT**

An apparatus and process for conducting auctions, specifically municipal bond auctions, over electronic networks, particularly the Internet, is disclosed. The auctioneer maintains a web site from which information about bonds to be auctioned can be obtained. A user participates in the auction by accessing the web site via a conventional Internet browser and is led through a sequence of screens that perform the functions of verifying the user's identity, assisting the user in preparing a bid, verifying that the bid conforms to the rules of the auction, displaying to the user during the course of the auction selected bid information regarding bids received and informing the bidder how much time remains in the auction. The user may be given the option of confirming the accuracy of his bid before submitting the bid. The auctioneer is able to review bidding history, determine the winner and notify the winner over the network, and display selected auction results to bidders and observers over the network.

67 Claims, 15 Drawing Sheets

U.S. Patent No. 6,161,099

→ Process and apparatus for conducting auctions over electronic networks



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[75] Inventors: Myles C. S. Harrington, Pittsbu... Daniel J. Veres, West View, both... Pa.; Robert M. Panoff, Durham,...

[73] Assignee: MuniAuction, Inc., Pittsburgh, ...

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[51] Int. Cl.[7] ..... G06...

[52] U.S. Cl. ..... 705/37...

[58] Field of Search ..... 705/37...

[56] References Cited

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4,980,826	12/1990	Wagner .	
5,077,665	12/1991	Silverman et al. .	
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5,243,515	9/1993	Lee .	
5,375,055	12/1994	Togher et al. .	
5,497,317	3/1996	Hawkins et al. .	
5,502,637	3/1996	Beaulieu et al. .	
5,640,569	6/1997	Miller et al. .	

What is claimed is:

1. In an electronic auction system including an issuer's computer having a display and at least one bidder's computer having an input device and a display, said bidder's computer being located remotely from said issuer's computer, said computers being coupled to at least one electronic network for communicating data messages between said computers, an electronic auctioning process for auctioning fixed income financial instruments comprising:

inputting data associated with at least one bid for at least one fixed income financial instrument into said bidder's computer via said input device;

automatically computing at least one interest cost value based at least in part on said inputted data, said automatically computed interest cost value specifying a rate representing borrowing cost associated with said at least one fixed income financial instrument;

submitting said bid by transmitting at least some of said inputted data from said bidder's computer over said at least one electronic network; and

communicating at least one message associated with said submitted bid to said issuer's computer over said at least one electronic network and displaying, on said issuer's computer display, information associated with said bid including said computed interest cost value,

wherein at least one of the inputting step, the automatically computing step, the submitting step, the communicating step and the displaying step is performed using a web browser.

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"With respect to the '099 patent, the parties do not dispute that **no single party performs every step of the asserted claims**. For example, at least the inputting step of claim 1 is completed by **the bidder**, whereas at least a majority of the remaining steps are performed by **the auctioneer's system** (e.g., Thomson's BidComp/Parity® system). The issue is thus **whether the actions of at least the bidder and the auctioneer may be combined** under the law so as to give rise to a finding of direct infringement by the auctioneer."

Muniauction v. Thomson, slip op. at 15–16

Muniauction v. Thomson

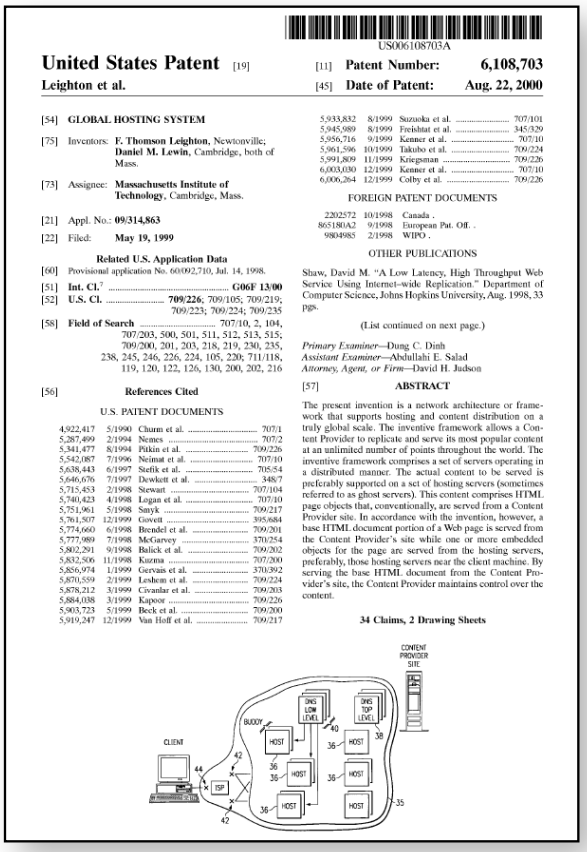
→ Court: A single party must perform, or be responsible for, every step of the method claim to infringe

- "[W]here the actions of multiple parties combine to perform every step of a claimed method, the claim is directly infringed only if one party exercises 'control or direction' over the entire process such that every step is attributable to the controlling party, i.e., the 'mastermind.'" –*Muniauction* (per J. Gajarsa)

Limelight v. Akamai

→ Akamai patent: content distribution network (CDN) for internet traffic

→ Limelight product: Limelight performs most steps; leaves "tagging" and "serving" steps to customers to perform



US006108703A

United States Patent [19]
Leighton et al.

[11] **Patent Number: 6,108,703**
[45] **Date of Patent: Aug. 22, 2000**

[54] **GLOBAL HOSTING SYSTEM**

[75] Inventors: **F. Thomson Leighton**, Newtonville; **Daniel M. Lewin**, Cambridge, both of Mass.

[73] Assignee: **Massachusetts Institute of Technology**, Cambridge, Mass.

[21] Appl. No.: **09/314,863**

[22] Filed: **May 19, 1999**

Related U.S. Application Data

[60] Provisional application No. 60/092,710, Jul. 14, 1998.

[51] **Int. Cl.**[7] **G06F 13/00**

[52] **U.S. Cl.** **709/226**; 709/105; 709/219; 709/223; 709/224; 709/235

[58] **Field of Search** 707/10, 2, 104, 707/203, 500, 501, 511, 512, 513, 515, 709/200, 201, 203, 218, 219, 230, 235, 238, 245, 246, 226, 224, 105, 220; 711/118, 119, 120, 122, 126, 130, 200, 202, 216

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(List continued on next page.)

Primary Examiner—Dung C. Dinh
Assistant Examiner—Abdullahi E. Salad
Attorney, Agent, or Firm—David H. Judson

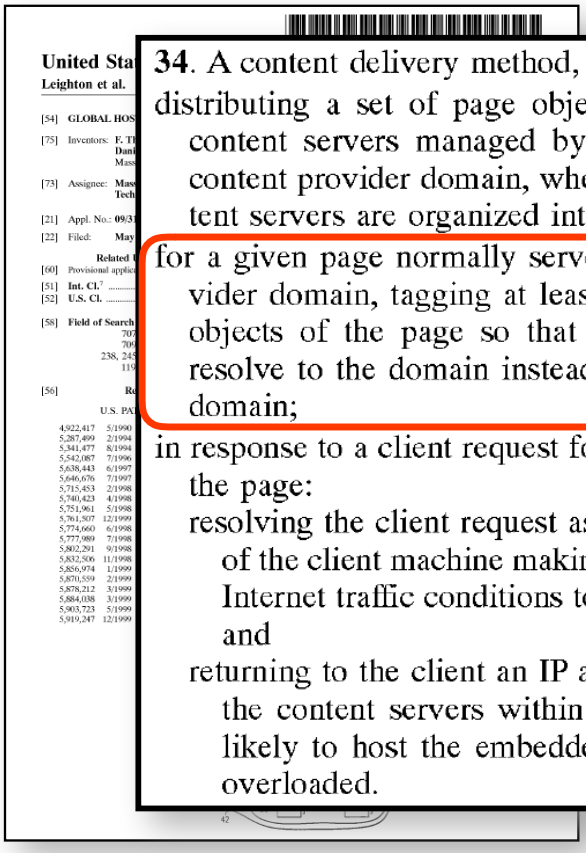
[57] **ABSTRACT**

The present invention is a network architecture or framework that supports hosting and content distribution on a truly global scale. The inventive framework allows a Content Provider to replicate and serve its most popular content at an unlimited number of points throughout the world. The inventive framework comprises a set of servers operating in a distributed manner. The actual content to be served is preferably supported on a set of hosting servers (sometimes referred to as ghost servers). This content comprises HTML page objects that, conventionally, are served from a Content Provider site. In accordance with the invention, however, a base HTML document portion of a Web page is served from the Content Provider's site while one or more embedded objects for the page are served from the hosting servers, preferably, those hosting servers near the client machine. By serving the base HTML document from the Content Provider's site, the Content Provider maintains control over the content.

34 Claims, 2 Drawing Sheets

U.S. Patent No. 6,108,703

→ Global hosting system



34. A content delivery method, comprising:

distributing a set of page objects across a network of content servers managed by a domain other than a content provider domain, wherein the network of content servers are organized into a set of regions;

for a given page normally served from the content provider domain, tagging at least some of the embedded objects of the page so that requests for the objects resolve to the domain instead of the content provider domain;

in response to a client request for an embedded object of the page:

resolving the client request as a function of a location of the client machine making the request and current Internet traffic conditions to identify a given region; and

returning to the client an IP address of a given one of the content servers within the given region that is likely to host the embedded object and that is not overloaded.

U.S. Patent No.

osting

Limelight v. Akamai

→ Federal Circuit, en banc: There is no direct infringement (§ 271(a)) but there is induced infringement (§ 271(b))

- No party directs or controls all steps, so no direct infringement has occurred
- Inducement requires direct infringement
- But "infringement" can mean something different for the two sections – infringement for purposes of § 271(b) can exist when multiple parties cooperate, even if the steps aren't attributable to one party

Limelight v. Akamai

→ Supreme Court: this is stupid

- "The Federal Circuit's analysis fundamentally misunderstands what it means to infringe a method patent." (Ouch.)
- Induced infringement requires, well, infringement, and under *Muniauction,* that requires one defendant responsible for all elements of the claim

Akamai v. Limelight

→ The Supreme Court invited the Federal Circuit to reconsider *Muniauction,* so they did…

- …and changed the law just enough to find Limelight infringing

Akamai v. Limelight

→ Now, to infringe under § 271(a):

- One party must perform, direct, or control all elements, OR
- Two or more parties in a joint enterprise can be charged with each others' acts:
  - agreement
  - common purpose
  - community of pecuniary interest
  - equal right of control

Akamai v. Limelight

→ Are Limelight and its customers a joint enterprise?

Akamai v. Limelight

→ Are Limelight and its customers a joint enterprise?

- No – no common purpose, community of pecuniary interest, or equal right of control

Akamai v. Limelight

→ Does Limelight direct or control its customers' actions?

Akamai v. Limelight

→ Does Limelight direct or control its customers' actions?

- Yes – it requires customers to take certain steps for the system to work
- But – the same thing was true of Thomson's auction system!

Means-plus-function claims

(post-AIA) 35 U.S.C. § 112 — Specification

* * *

(f) **Element in Claim for a Combination.—**

An element in a claim for a combination may be **expressed as a means or step for performing a specified function** without the recital of structure, material, or acts in support thereof, and **such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof**.

Williamson v. Citrix

→ Tech: distributed-classroom system with a "distributed learning control means"

→ Issue: How do we decide if a claim limitation is means-plus-function and so governed by § 112(f) / § 112¶6?

Williamson v. Citrix

→ Longtime law: We presume that claims with the word "means" correspond to § 112(f) claims

- But this is a rebuttable presumption

→ *Lighting World / Flo Healthcare / Apple*: This is a strong presumption that is not easily overcome

→ *Williamson*: Actually, not "strong"

Williamson v. Citrix

→ What's wrong with a strong presumption?

Williamson v. Citrix

→ What's wrong with a strong presumption?

- "It … has resulted in a proliferation of functional claiming untethered to § 112, para. 6 and free of the strictures set forth in the statute." (Nard 626)

Williamson v. Citrix

→ What's wrong with a strong presumption?

- § 112(f) carefully limits claim scope of means-plus-function claims
- If you evade § 112(f), you get broad, vague claims that are easy to infringe
- "fastener" instead of "fastening means"; things like that

Williamson v. Citrix

→ Why would the court have adopted a strong presumption?

Williamson v. Citrix

→ Why would the court have adopted a strong presumption?

- The goal is to figure out what the patent applicant intended the claim to cover
- Bright-line rules about claim scope make the system more predictable
- Abuse is subject to §§ 102, 103, 112

Williamson v. Citrix

→ But under the "strong" presumption, claim scope was too indeterminant and abuse was too easy

Williamson v. Citrix

→ Once construed as a § 112(f) claim, the Williamson patent becomes invalid as indefinite

- No corresponding structure for the functions named in the claim limitation
- One of the functions: "coordinating the operation of the streaming data module"
- Only disclosed structures: UIs of possible interfaces, not algorithms

Odetics v. Storage Tech

→ One of the quirks of § 112(f) infringement: Two kinds of equivalents

- Identical function, equivalent way and result: Literal infringement (per § 112)
- Equivalent function, way, and result: Infringement by equivalents
- Both are possibilities

Odetics v. Storage Tech

→ Why does this difference matter?

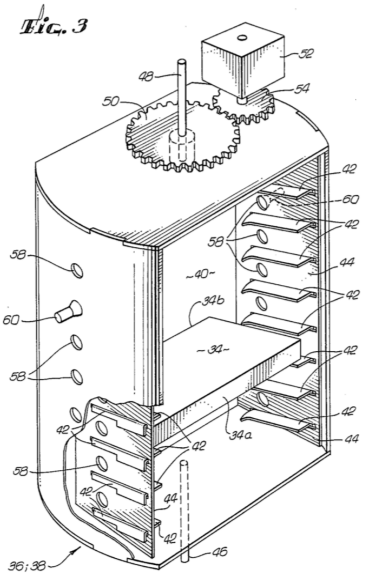
Odetics v. Storage Tech

→ Why does this difference matter?

- Literal infringement is not subject to prosecution history estoppel – even when it has an equivalents step under § 112(f)

Odetics v. Storage Tech

→ Tech: Robotic tape storage system with a "rotary means ... for providing access to the storage library"



Ode Tech

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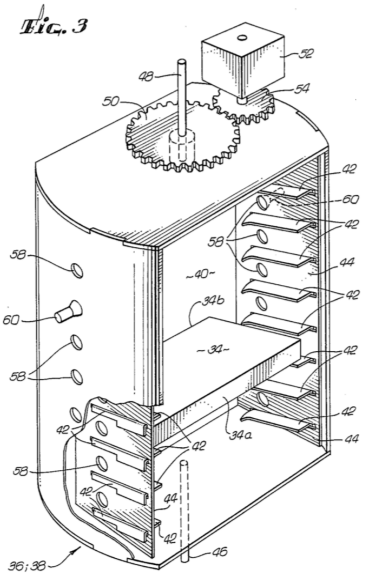
9. A tape cassette handling system comprising:
a plurality of tape transports;
a housing including a cassette storage library having a plurality of storage bins and at least one cassette access opening for receiving cassettes to be moved to the storage bins or to the tape transports, or for receiving cassettes to be removed from the library or from the tape transports;
a rotary means rotatably mounted within the library adjacent the access opening for providing access to the storage library, the rotary means having one or more holding bins each having an opening for receiving a cassette, wherein the rotary means is rotatable from a first position in which the opening of at least one holding bin is accessible from outside of the housing to a second position in which the opening of at least one holding bin is accessible from inside of the housing; and
cassette manipulator means located within the housing for selectively moving cassettes between the rotary means, said storage bins and said tape transports.

Odetics v. Storage Tech

- → Structure described in the spec: rod, gear, and rotary loading and loading mechanisms
- → Accused device: cam followers attached to bottom of the array



Odetics v. Storage Tech

- → Identical function?
- → Substantially the same way?
- → Substantially the same result?

Next time

Next time

→ Infringement: the geographic scope of patent infringement