



## **GPNE HOISTED BY ITS OWN PETARD**

### **A LESSON FOR DRAFTING STRUCTURED PATENT SPECIFICATION**

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That the claims form the heart of a patent may sound cliché, but is reiterated by a plethora of court judgments across various jurisdictions. The terms used in the claims are relied upon by the judges in determining the scope of the claimed invention. This becomes increasingly complex as the technical jargon used in the claims may be obvious to some, but not to others. In such cases, the courts apply a two-step process to determine occurrence of infringement. The first is to determine the literal meaning of the terms used in the claims. The second is to determine whether the claims cover the alleged infringement.

One such interesting case which demonstrates the process of claim construction by the US Court of Appeals for the Federal Circuit is *GPNE Corp. v. Apple Inc.* (Fed. Cir. Aug. 1, 2016). GPNE held the U.S. Patents No. 7,570,954 and 7,792,492 relating to a two-way paging system, where the paging devices are capable of not only receiving messages but also responding to the received messages. All claims of the '954 and '492 patents referred to the paging devices as "nodes".

In 2012, GPNE sued Apple, for direct infringement of the '954 and '492 patents. GPNE argued that Apple's iPhones and iPads came under the ambit of the term "nodes", and therefore, directly infringed the '954 and '492 patents. Similarly, GPNE claimed that nine Apple products, including the iPhone 5, the iPad 3, and the iPad Mini infringed the '954 and '492 patents.

During the proceedings, the Federal Circuit observed that apart from the Abstract, Title and Claims, the word "node" was nowhere mentioned in the entire

specification. Instead '954 and '492 patents exclusively referred to the nodes as "pagers or "paging units" over 200 times in the specifications. The Federal Circuit also stated that it was proper for the district court to conclude that Apple's products did not infringe the '954 and '492 patents.

Therefore, on August 1, 2016, the Federal Circuit gave the verdict in favour of Apple, thereby affirming the judgement given by the United States District Court for the Northern District of California that Apple's products had not infringed the '954 and '492 patents.

In the world of patent litigation, specification and claims always go hand-in-hand. Specification deems to be particularly important when a court interprets the patent claims because the claims are always read in the light of the specification. In one of the most famous cases, *Phillips v. AWH Corp.*, the Federal Circuit gave its judgement related to this context. It clarified the role of the specification when the district court had sought to ascertain the proper scope of patent claims. The Federal Circuit held that "the specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term." So, a carefully drafted specification can resolve a dispute over claim terms without resort to any extrinsic evidence. A good strategy for a patent applicant is, thus, to take advantage of the *Phillips* case and assume more control over claim construction in any future litigation by carefully drafting the specification.

The claims can be amended during the prosecution to redefine the scope of patent protection, but, the specification can rarely be changed during prosecution. This implies that the applicant gets only one opportunity to explain the working of the invention in detail. Also, drafting the claims carefully is an essential part of the patent protection as the claims set the scope and boundaries of the patent rights.

During patent drafting, the subject matter of the invention has to be thoroughly understood and the claims must be planned while drafting the specification. The claims should provide information, to the public or a person with ordinary skill in the art, of the boundaries of infringement of the claimed subject matter. A person

with ordinary skill in the art must be able to perceive the boundary from the construction of the claim.

As in the case of *GPNE v Apple*, the words of a claim are generally given their ordinary and customary meaning, which is the meaning that the term would have to a person of ordinary skill in the art at the time of the invention.

Consequently, one should take a note that the components, once referred to by a certain term, should ideally be referred to by the same term throughout the entire specification. The specification, thus, provides the context for the claims. The specification is also used to understand the terms in the claims because the terms in the claim should be interpreted consistently with their usage in the specification. When the ordinary meaning of the terms in a claim makes the scope of the claim unclear, the specification is used to determine the meaning of the term.

Therefore, the consistency in the terms used in the claims and the specification may prove to be a decisive factor in determining the occurrence of the infringement.