

CONVOLVE, INC. v. COMPAQ COMPUTER CORP., Appeal No. 2014-1732 (Fed. Cir. February 10, 2016). Before Dyk, Taranto, and Hughes. Appealed from S.D.N.Y. (Judge Daniels).

Background:

Convolve sued Seagate and Compaq for infringement of a patent directed to computer hard drives. Seagate's accused products are hard drives, and Compaq's accused products are computers that are used in combination with Seagate's hard drive. The district court granted summary judgment of non-infringement, and Convolve appealed. In the first appeal, the Federal Circuit reversed the district court's ruling and remanded for further proceedings. On remand, the district court again granted summary judgment of non-infringement, based on alternative grounds.

As a first ground for granting summary judgment, the district court held that Seagate's hard drives do not meet the "user interface" limitation of the claims. As a second ground for granting summary judgment, the district court held that Compaq's computers do not meet the "commands" limitation of the claims. In the alternative, as the third ground, the district court held that liability is precluded based on intervening rights arising from amendments to the claims made during reexamination.

Issues/Holdings:

Did the district court err in holding that Seagate's and Compaq's products do not infringe the claims? Yes, affirmed-in-part and reversed-in-part. Did the district court err in holding that liability is precluded by intervening rights arising from amendments to the claims? Yes, reversed.

Discussion:

The Federal Circuit affirmed-in-part, and reversed-in-part on the issues of whether Seagate's hard drives and Compaq's computers infringe the claims. In particular, the Federal Circuit affirmed the district court's holding that Seagate's hard drives do not meet the "user interface" limitation of the claims because Seagate's device-to-device interface does not require a "user" as required by the claims. The Federal Circuit reversed the district court's holding that Compaq's interface does not meet the "commands" limitation because the claims do not require the user interface to issue commands as the district court assumed.

Regarding the issue of intervening rights, the Federal Circuit reversed the district court's summary judgment ruling because the claims as amended during reexamination were "substantially identical" to the claims in the original patent. During the reexamination proceedings, Convolve added the limitation "seek" before "acoustic noise" after a prior art rejection. In considering whether the term "seek" altered the scope of the claims, the Federal Circuit noted that the original claims only recited "acoustic noise," which could include any type of acoustic noise. Further, the specification does not use the term "seek acoustic noise." However, because the focus of the specification is on the seek process and the noise it generates, the Federal Circuit reasoned that one skilled in the art would understand the claims to be limited to "seek acoustic noise." This conclusion is reinforced by reading "seek acoustic noise" in conjunction with the remaining claim limitations, and in light of the specification and prosecution history.