

OPENWAVE SYSTEMS, INC. v. APPLE INC., Appeal No. 2015-1108 (Fed. Cir. December 15, 2015). Before Moore, O'Malley, and Chen. Appealed from D. Del. (Judge Andrews).

Background:

Openwave sued Apple for infringing claims of its three related patents having the same specification. The asserted claims of Openwave's patents are directed to a mobile device that includes a *client* module executed on a microcontroller for enabling communication. In order to distinguish from prior art mobile devices, the specification for Openwave's patents disparaged prior art mobile devices which combined a *computer* module and a wireless communication module, as the use of a computer module in the prior art mobile devices rendered such devices heavy and expensive.

In view of the several disparaging remarks against the use of a computer module in the specification of Openwave's patents, the district court found that patents' specification disavowed mobile devices that include a computer module. The district court subsequently construed the term "mobile device" in Openwave's claims to mean "a portable wireless two-way communication device that does not contain a computer module." Based on this construction, Openwave stipulated to Apple's non-infringement and appealed the district court's construction of mobile device.

Issue/Holding:

Did the district court err in its construction that Openwave's patent specification disavowed claim scope? No, affirmed.

Discussion:

Recognizing that the standard for disavowal of claim scope is "exacting," the Federal Circuit reviewed the specification of Openwave's patents to determine whether the specification is "both so clear as to show reasonable clarity and deliberateness, and so unmistakable as to be unambiguous evidence of disclaimer" and to further determine, whether "the specification goes well beyond expressing the patentee's preference ... [such that] its repeated derogatory statements about [a particular embodiment] reasonably may be viewed as a disavowal."

Relying on this standard, the Federal Circuit identified a number of telling examples of disclaimer in the patents' specification in which the patentee expressly disclaimed the inclusion of a computer module in its mobile device. As an example, the Federal Circuit found very persuasive the disclosure in the patents' specification specifying that "cellular telephone **100** is not a combination of a computer module and a wireless communication device as in prior art."

The Federal Circuit reasoned, as a result, that the high bar for finding disavowal of claim scope through disparagement was met in the specification of Openwave's patents. Thus, the Federal Circuit agreed with the district court's claim interpretation of "mobile device" and affirmed the judgment of the district court.