CHEWY, INC. v. IBM CORP., Appeal No. 2022-1756 (Fed. Cir. March 5, 2024). Before Moore, Stoll, and Cunningham. Appealed from S.D.N.Y. (Judge Rakoff).

Background:

IBM sued Chewy for infringement of its patent directed to improved methods for presenting web-based advertisements to users of an interactive service. The alleged infringement was based on Chewy's website and mobile applications. The claimed methods minimize advertising traffic's interference with other data for providing webpages by storing and managing advertising on the user's computer before it is requested by the user, referred to as "pre-fetching." Following claim construction of the phrase "selectively storing advertising objects" as requiring pre-fetching of advertising objects, the district court granted summary judgment of noninfringement of the patent because Chewy's website uses different channels for advertising and website traffic but does not perform pre-fetching. IBM appealed.

Issues/Holdings:

Did the district court err in finding that Chewy did not infringe the asserted patent? No, affirmed.

Discussion:

The Federal Circuit upheld the district court's construction of the phrase "selectively storing advertising objects," referring to the fact that the specification consistently describes the invention as including pre-fetching of advertising objects to minimize interference and delay. IBM argued that pre-fetching is not required because, based on case law, the use of the phrase "the present invention" in the specification should not be limiting. IBM also argued that pre-fetching is described in dependent claims and, therefore, should be differentiated.

First, the Federal Circuit held that IBM's reference to case law is misapplied because the case law stands for the proposition that the use of the phrase "present invention" is not limiting when references to a certain limitation as being the invention are not uniform. Here, the phrase is used consistently to describe pre-fetching as a feature of the claimed invention. Regarding the dependent claims, the Federal Circuit held that the presence of these dependent claims does not negate the clear and limiting disclosures in the specification. The Federal Circuit noted that patentees are free to use different terminology in different claims to define the invention, but that this different language does not undermine the uniform description in the specification of pre-fetching as a feature of the invention.

Second, the Federal Circuit notes that during the prosecution history, IBM had summarized the claimed subject matter as follows: "[t]he method which is described provides for storing and managing advertising objects so that advertising objects may be separately pre-fetched…" The Federal Circuit found this to be a clear indication that the phrase "selectively storing advertising objects" requires pre-fetching.