

THE U.S. COURT OF APPEALS FOR THE FEDERAL CIRCUIT RECENTLY APPLIES THE DOCTRINE OF CLAIM DIFFERENTIATION IN AN INFRINGEMENT CASE

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In this newsletter, we see how the U.S. Court of Appeals for Federal Circuit (CAFC) has recently applied the doctrine of claim differentiation in its July 24, 2009 decision of *Orenshtyn v. Citrix Systems, Inc.* However, prior to a discussion of the *Orenshtyn* case, we first define what this doctrine means.

In the 1987 case of *Tandon Corporation v. United State International Trade Commission*, the CAFC defined the doctrine of claim differentiation as follows:

There is presumed to be a *difference in meaning and scope* when different words or phrases are used in separate claims. To the extent that the absence of such difference in meaning and scope would make a claim superfluous, the doctrine of claim differentiation states the presumption that the difference between claims is significant. [Emphasis added.]

In line with this doctrine, the court later said in the 2004 case of *Liebel-Flarsheim Co. v. Medrad, Inc.* that “[t]he presence of a dependent claim that adds a particular limitation raises a presumption that the limitation in question is not found in the independent claim.”

The pertinent patent at issue in the 2009 case of *Orenshtyn v. Citrix Systems, Inc.* is U.S. Patent No. 5,889,942 owned by Mr. Alexander Orenshteyn, which is directed to a secured system for accessing application services. The system includes a client station, which is connected through an interface with an application server. The client station consists of a controller, along with a number of “low-level application independent logics.” Claim 1, in pertinent part, recites as follows:

1. A secured system for accessing application services from at least one application program, comprising:

at least one client station having low-level application independent logics stored therein and at least one controller for controlling said low-level application independent logics....

Claim 2, which is dependent on claim 1, recites that “said at least one client station *lacks a general purpose central processing unit* [i.e., a CPU].”

The issue in the *Orenshtyn* case is whether the term “controller” of the claimed client station, in independent claim 1, can be construed to include either a CPU or a non-CPU. If “controller” is construed as a CPU, there is infringement.

Mr. Orenshtyn appealed this case to the CAFC after having lost in the district court when the district court found that Citrix Systems, Inc., the alleged infringer of his patent, did not infringe Mr. Orenshtyn’s patent because the claimed “controller” in claim 1 is “construed as something other than a general purpose CPU,” whereas Citrix’s products use a general purpose CPU.

On appeal, the CAFC found that, under the doctrine of claim differentiation, the district court erred in its interpretation of the claimed “controller” and therefore, the district court erred in its finding of non-infringement of claim 1 in Mr. Orenshtyn’s patent by Citrix’s products.

The CAFC's reasons for finding the district court's decision of non-infringement as being erroneous are as follows:

(1) Claim 2 specifically recites the non-use of a general purpose CPU "so as to decrease cost and protect said at least one client station." However, under the doctrine claim differentiation, to interpret independent claim 1 as similarly using a controller that is a non-CPU makes claim 2 "identical to claim 1 and therefore superfluous."

(2) The specification may indicate a distinction between a "controller" and a general purpose CPU. More particularly, the specification explains that "expensive general purpose processing CPUs are preferably replaced with inexpensive but powerful controllers, such as DSP chips." However, these portions of the specification only suggest a distinction between CPUs and non-CPUs, but do not define the term "controller" as being limited to non-CPUs. In fact, another portion of the specification explains that:

It should be understood that general purpose computers will also work with the present invention (with little or no modifications), such that existing owners of PCs can access any specialized server to spawn a selected application, if desired.

(3) Mr. Orenshteyn's following deposition testimony also contradicts Citrix's interpretation of the term "controller" as lacking a general purpose CPU:

Question: What's a controller?

Mr. Orenshteyn: A processing element.

Question: What's an example?

Mr. Orenshteyn: A processor, a chip, an integrated circuit.

Question: Could a Pentium chip be a controller?

Mr. Orenshteyn: It could be.

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