

**Keywords:** *Ex parte* reexamination and intervening rights

**General:** damages prior to reexamination certificate

*R+L Carriers, Inc. v. Qualcomm, Inc.*  
2014-1718 (Fed. Cir. September 17, 2015)

## I. Facts

R+L Carriers is the owner of U.S. Patent No. 6,401,078 (“the ‘078 patent”), which is directed to consolidating freight into trailers to optimize delivery efficiencies for the loads in each trailer by transmitting the contents of a trailer to the central terminal so that load planning can occur while the trailer is en route. The originally issued ‘078 patent included only one independent claim (independent claim 1).

On June 28, 2013, R+L filed for ex parte reexamination of the ‘078 patent based on prior art identified by a third party. Independent claim 1 was rejected during the reexamination and R+L amended independent claim 1 as follows:

1. A method for transferring shipping documentation data for a package from a transporting vehicle to a remote processing center *comprising the steps of:*  
placing a package on the transporting vehicle;  
using a portable document scanner to scan an image of the documentation data for the package, said image including shipping details of the package;  
providing a portable image processor capable of wirelessly transferring the image from the transporting vehicle;  
wirelessly sending the image to a remote processing center;  
receiving the image at said remote processing center; and  
prior to the package being removed from the transporting vehicle, utilizing said documentation data at said remote processing center to prepare [a] *an advance loading manifest document for another transporting vehicle* which includes said package for further transport of the package on another transporting vehicle.

(Emphasis added.)

The PTO allowed amended claim 1, noting that the key prior art reference only discussed loading a “manifest for the *current* shipping vehicle and not an advance loading manifest document for *another* transporting vehicle.” The reexamination was issued on March 21, 2014, with amended claim 1 replacing original claim 1.

On June 25, 2009 R+L filed suit against Qualcomm alleging infringement of the '078 patent. The case was consolidated into a multidistrict litigation (MDL) and on June 7, 2012 the Fed. Circuit held that R+L's induced infringement claims survived a motion to dismiss by Qualcomm and the case was remanded for further proceedings.

On May 19, 2014, after the reexamination of the '078 patent, the district court determined that R+L's amendment to original claim 1 substantively narrowed the claim, thereby precluding recovery of damages for infringement prior to the date the PTO issued the reexamination certificate. The district court agreed with the accused infringers in the MDL that, although original claim 1 covered both manual and computer-prepared loading manifests, amended claim 1 covered only computer-prepared loading manifests. The district court reasoned that the specification of the '078 patent disclosed both manual and computerized extraction of information from bills of loading and preparation of loading manifests, the language in original claim 1 did not limit methods for preparing loading manifests to only computerized systems, and the term "advance" in amended claim 1 was added to get around the N&M prior art, which, among other things, disclosed manual entry of the loading manifest. For these reasons, the district court concluded that amended claim 1 must encompass only the preparation of computer-generated loading manifests.

Because Qualcomm sold its allegedly infringing business unit before the PTO issued the reexamination certificate for the '078 patent, R+L conceded that it could not recover any damages against Qualcomm based on the district court's determination that claim 1 was substantively narrowed during reexamination. Accordingly, R+L appealed the determination of the district court that independent claim 1 had been substantively narrowed.

## **II. Issue**

Whether the amendments incorporated in a reexamination proceeding must create a substantially narrower claim, as compared to the originally issued claim, to prevent the recovery of damages prior to the issuance of the reexamined claim?

## **III. Discussion**

No, claims that are amended after reexamination need not be substantially narrower to prevent the recovery of damages prior to the issuance of the re-examination. Instead, a patentee of a patent that survives re-examination is only entitled to infringement damages for a time period between the date of issuance of the original claims and the issuance of the re-examined claims if the original claims and the re-examined claims are "substantially identical." 35 U.S.C. § 252 (2012).

It is actually irrelevant why an amended claim is narrowed during reexamination, or even whether the patentee intended to narrow the claim in a particular way. Instead, if the scope of the amended claim is not "substantially identical" to the scope of the original

claim, the patentee is not entitled to damages prior to the issuance of the reexamination certificate. To determine whether the amended claim is “substantially identical” to the scope of the original claim, it is useful to consider whether there is a method that would infringe the original claim, but not infringe the amended claim.

In the present case, the Federal Circuit held that R+L amended “loading manifest” to claim an “advance loading manifest document for *another transporting vehicle*.” In the reexamination proceeding, the examiner expressly stated that he allowed amended claim 1 because “the manifest discussed by [the prior art] is a manifest for the current shipping vehicle and not an advance loading manifest document for *another transporting vehicle*.” As such, the examiner’s commentary reveals that a method that would be covered by original claim 1 but not amended claim 1: the process of preparing a loading manifest “for the *current shipping vehicle*.” Thus, the amended claim 1 is not “substantially identical” to original claim 1 because original claim 1 encompassed scope that amended claim 1 does not. Moreover, since Qualcomm did not perform any allegedly infringing contact after the PTO issued the reexamination certificate, the district court properly entered judgment dismissing the case against Qualcomm.

#### **IV. Conclusion**

When determining whether a patentee is entitled to damages prior to the issuance of a reexamination certificate, the newly reexamined claim must be “substantially identical” to the original claim to be entitled to the damages. “Substantially identical” claims are evaluated based on whether there is a product or process exists that would infringe the original claim, but not infringe the amended claim.