Keywords: claim construction, enablement requirement, prosecution history estoppel

Iridescent Networks, Inc. v. AT&T Mobility, LLC
Court of Appeals for the Federal Circuit
No. 2018-1449
Decided August 12, 2019

I. Facts

Iridescent Networks ("Iridescent") is the assignee of U.S. Patent No. 8,036,119 ("the '119 patent"), which is directed to a system and method of network communication that provides "high quality" bandwidth "on demand" using custom routes to maximize the availability of bandwidth, minimize packet loss, and reduce latency during transmission. Iridescent brought suit against AT&T Mobility, LLC and Ericsson, Inc. (collectively, "AT&T") for infringement of independent claim 1 of the '119 patent. During claim construction proceedings for the term "high quality of service connection" in claim 1, the magistrate judge determined that "high quality of service connection" is a term of degree that is not a known term of art but rather a coined term by the patentee. The magistrate judge explained that FIG. 3 of the '119 patent and Iridescent's statements during prosecution of the parent application of the '119 patent provide some standard for measuring this term of degree. In particular, the magistrate judge adopted AT&T's proposed construction of the term to mean "a connection that assures connection speed of at least approximately one megabit per second and, where applicable based on the type of application, packet loss requirements that are about 10^{-5} and latency requirements that are less than one second."

Iridescent subsequently objected to the magistrate judge's construction, but the district judge overruled Iridescent's objections and determined that the magistrate judge's construction was not clearly erroneous or contrary to law. The parties then stipulated to non-infringement because AT&T's network products and services were excluded from infringement under the district court's construction of the term "high quality of service connection." Iridescent appealed after the court entered a final judgment against Iridescent.

II. Issue

Was the district court's construction of the term "high quality of service connection" in independent claim 1 proper?

III. Discussion

Yes. The Federal Circuit affirmed the district court's construction of the term "high quality of service connection" in independent claim 1 to mean "a connection that assures connection speed of at least approximately one megabit per second and, where applicable based on the type of application, packet loss requirements that are about 10^{-5} and latency requirements that are less than one second."

The Federal Circuit first determined that the language of the claims on its face is not sufficiently clear to provide guidance to a person of ordinary skill in the art as to the meaning of the term "high quality of service connection." In particular, the Federal Circuit stated that the claim language expressly requires the connection to provide high quality of service but is silent as to what amount of quality is sufficient to be "high." The Federal Circuit then turned to the specification of the '119 patent and the prosecution history of the '119 patent. During prosecution of the '119 patent, Iridescent relied on Figure 3 (below) to support an amendment that gave rise to the term "high quality of service connection" in independent claim 1. The Federal Circuit stated that Figure 3 of the '119 patent indicates the minimum requirements for connection speed, packet loss, and latency, and shows a box labeled "High QoS" (High Quality of Service) drawn around some of the listed applications. The Federal Circuit indicated that the listed applications placed within the "High QoS" box have connection parameter requirements consistent with the district court's construction of the term "high quality of service connection."

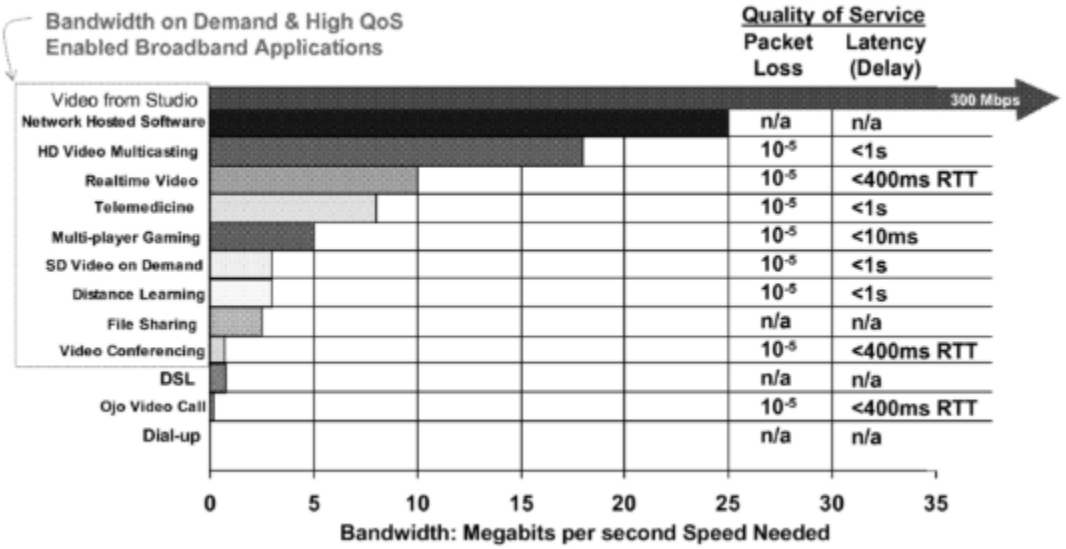

Figure 3

Additionally, during prosecution of the parent application of the '119 patent, Iridescent argued that the connection parameters illustrated in Figure 3 supported the term "high quality of service connection." During prosecution of a parent application to the '119 patent, to overcome an enablement rejection, Iridescent amended the claims to include the "high quality of service connection" recitation and argued that the amended language "may be viewed in the present application as having speeds varying from approximately 1-300 megabits per second, packet loss requirements that are typically about 10^{-5}, and latency requirements that are typically less than one second." Thus, the Federal Circuit affirm the district court's construction of the term "high quality of service connection."

Iridescent presented several arguments against the claim construction found by the district court. Iridescent argued that the prosecution history is irrelevant to claim construction of the term "high quality of service connection" because Iridescent made no clear and unmistakable disavowal of claim scope. *See 3M Innovative Properties Co. v. Tredegar Corp.*, 725 F.3d 1315 (Fed. Cir. 2013) (holding that where there is no clear disavowal, the ordinary and customary meaning of the claim term will be given its full effect). However, the Federal Circuit distinguished *3M* and held that where there is no clear, ordinary, and customary meaning of a coined term of degree, the court may look to the prosecution history for guidance to the meaning of the term, even without a finding of a clear and unmistakable disavowal.

Iridescent also argued that even if Iridescent's statements during prosecution may be considered, Iridescent's statements are still irrelevant to the construction of the term because such statements were made in response to an enablement rejection. Iridescent argued that unlike an indefiniteness rejection, an enablement rejection is not issued to force the applicant to define the metes and bounds of the claim. However, the Federal Circuit stated that enablement serves to prevent inadequate disclosure of an invention and overbroad claiming. Thus, the Federal Circuit held that Iridescent's statements made to overcome the enablement rejection inform claim construction analysis by demonstrating how Iridescent understood the scope of the term.

IV. Conclusion

The Federal Circuit affirmed the district court's construction of the term "high quality of service connection" in independent claim 1.

V. Appendix

Claim 1 of the ‘119 patent:

1. A method for providing bandwidth on demand comprising:

receiving, by a controller positioned in a network, a request for a ***high quality of service connection*** supporting any one of a plurality of one-way and two-way traffic types between an originating end-point and a terminating end-point, wherein the request comes from the originating end-point and includes at least one of a requested amount of bandwidth and a codec;

determining, by the controller, whether the originating end-point is authorized to use the requested amount of bandwidth or the codec and whether the terminating end-point can be reached by the controller;

directing, by the controller, a portal that is positioned in the network and physically separate from the controller to allocate local port resources of the portal for the connection;

negotiating, by the controller, to reserve far-end resources for the terminating end-point; and

providing, by the controller to the portal, routing instructions for traffic corresponding to the connection so that the traffic is directed by the portal based only on the routing instructions provided by the controller, wherein the portal does not perform any independent routing on the traffic, and wherein the connection extending from the originating end-point to the terminating end-point is provided by a dedicated bearer path that includes a required route supported by the portal and dynamically provisioned by the controller, and wherein control paths for the connection are supported only between each of the originating and terminating end-points and the controller and between the portal and the controller.