



Cioffi v. Google, Inc.
Claim Differentiation v Prosecution History

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Summary – Cioffi v. Google

- ❖ Alfonso Cioffi and The Estate of Allen Rozman (“Cioffi”) filed suit against Google, Inc. on February 5, 2013 in the Eastern District of Texas alleging that Google’s chrome web browser infringed four reissue patents.
- ❖ The district court construed several disputed terms, including “web browser process” and “critical file.”
- ❖ Based on the district court’s claim construction claim 21 was held to be invalid as indefinite and the parties stipulated to non-infringement of all the other asserted claims.

Background

- ❖ U.S. Patent No. 7,484,247 issued January 27, 2009
- ❖ In 2010, the inventors filed four broadening reissue applications:

| | |
|----------|-------------------------------|
| RE43,528 | 3/9/2010 – 1-20 +claims 21-70 |
| RE43,500 | 3/9/2010 - +claims 21-70 |
| RE43,103 | 8/10/2010 - +claims 21-71 |
| RE43,529 | 11/7/2010 - +claims 21-65 |
- ❖ In 2011, a reissue continuation was filed RE43,987 which included original claims 1-20 and adding new claims 21-25*

*There is a second reissue continuation filed in 2013 which is currently pending.

Reissue Patents - Overview

The patents-at-issue describe computer processes separated either logically or physically (using separate processors), into first and second browser processes. Potential malware downloaded from the Internet is directed to execute within the second browser process, but is not allowed to execute outside of the second browser process.

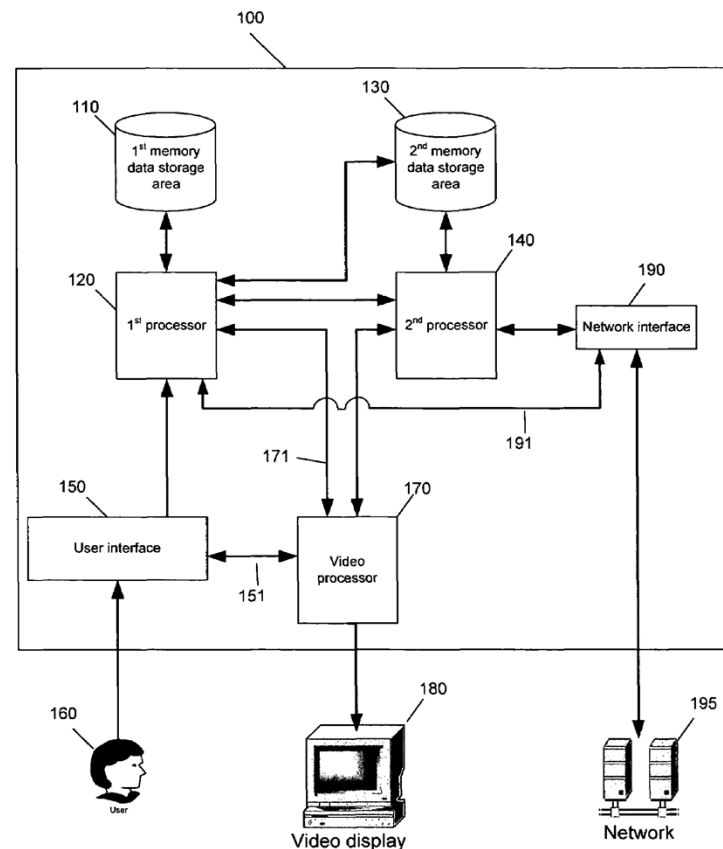


Fig. 1

Prosecution History

- ❖ All the claims of the reissue applications under 35 U.S.C. 102(b) as being anticipated by U.S. Publication No. 2002/0002673 to Narin (“Narin”)
- ❖ The Examiner found that Narin taught:
 - (1) a first logical process capable of accessing data in a first memory space and a second logical process capable of accessing data in a second memory space;
 - (2) the second logical process hosts non-secure software objects; and
 - (3) the data residing in the first memory space is protected from corruption by malware downloaded from the network and operating as part of the second logical process.

Prosecution History

- ❖ Cioffi responded by arguing that “Narin teaches away from the closed program [corresponding to the first browser process] being a browser process.”
- ❖ The examiner responded that the claims when read in view of the specification did not limit the browser process to a “web browser process”
- ❖ Cioffi amended all the independent claims to replace “browser process” with “web browser process”

District Court's Claim Construction

- ❖ The district court adopted its preliminary construction of “web browser process” as a “process that can access data on websites.”
- ❖ The court found that Cioffi had distinguished Narin during prosecution by arguing that Narin discloses a “secure” or “closed” application that controls a separate process that runs an “open or untrusted application” and the “secure” application cannot be a web browser.
- ❖ The court found that the patentees relied on the added “web” limitation to overcome the examiner’s rejection and “that reliance should be given effect by requiring that the ‘web browser process’ is capable of accessing the data on websites.”

District Court's Claim Construction

- ❖ The district court further stated (in response to statements Google made during Markman) that introducing the word “direct” would confuse rather than clarify the scope of the claims, but for “the capability to be meaningful and consistent with the prosecution history, however, a “web browser process” must be capable of accessing a website without using another web browser process.”

District Court's Claim Construction

- ❖ The court found that references to “critical user files” found in the specification and prosecution history suggest that the term “critical file” includes critical “user” files.
- ❖ Additionally, the court held that what is critical to a user is “entirely subjective,” and that “critical file” therefore, fails to inform a person of skill in the art about the scope of the invention with reasonable certainty under *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120 2122 (2014).

Google Wins

- ❖ The parties then agreed that, based on the court's claim constructions, Cioffi could not prevail on the issue of infringement.
- ❖ Cioffi's infringement contentions has identified Chrome's browser kernel as reading on the "first web browser process" and the rendering engine as reading on the "second web browser process."
- ❖ The district court found that chrome's rendering engine "is not capable of and cannot access data of websites without using the chrome browser kernel."

Cioffi Appeals to Fed. Cir.

- ❖ Cioffi disputes the district court's construction of "web browser process" as erroneously requiring "direct" access capability.
- ❖ Cioffi disputes the district court's construction of "critical file" as erroneously including "critical user files" (the inclusion of "user" rendering the term indefinite).

Cioffi Argues Claim Differentiation

- ❖ Cioffi argued that “web browser process” should have been given its plain and ordinary meaning.
- ❖ Under claim differentiation principles, the term “web browser process” alone cannot be read to require a “direct” access capability.
- ❖ Cioffi first points to independent claim 21 of the ‘528 patent which states the “first web browser process” needs to be “capable of passing data to the second web browser process.”

Cioffi - Claim Differentiation

- ❖ Cioffi argues that claim 21 implies that the “second web browser process” can access data on websites indirectly with assistance from the “first web browser process.”
- ❖ In contrast, claim 24 of the ‘528 patent requires the “second web browser process” to be “capable of directly exchanging data with the network interface and with the first web browser process.”
- ❖ The “directly exchanging data with the network interface” limitation of claim 24 would be superfluous if claim 21 already required direct web access capability.

Claim 21 '528 Patent

A portable computer capable of executing instructions using a common operating system...

execute **a first web browser process, capable of accessing data of the at least one website via the network**, in a first logical process within the common operating system, wherein the first logical process is capable of accessing data contained in the first memory space;

...a **second web browser process in a second logical process** within the common operating system, wherein the second logical process is capable of accessing data contained in the second memory space and is further capable of generating video data from the at least one website accessed via the network...

wherein the first web browser process is capable of opening the second web browser process and is further capable of passing data to the second web browser process;

wherein further the portable computer is configured such that the at least one system file residing on the first memory space is protected from corruption by a malware process downloaded from the network and executing within the second web browser process.

Claim 24 '528 Patent

24. The portable computer of claim 21 wherein the second web browser process is capable of directly exchanging data with the network interface device and with the first web browser process.

Google Rebutts Claim Differentiation

- ❖ The court's construction requiring the web browser process have the capability to access data on a website directly does not render claims 21 and 24 of the '528 patent identical in scope.
- ❖ Because claim 24 has *two* additional limitations compared to claim 21, only one of the limitations would be subsumed by the court's construction.
- ❖ Claim 24, not only adds a "directly exchanges data with the network interface" limitation, but also a "directly exchanges data with" "the first web browser process" limitation.

Google Argues Prosecution History Trumps

- ❖ “[a]lthough claim differentiation is a useful analytic tool, it cannot enlarge the meaning of a claim beyond that which is supported by the patent documents, or relieve any claim of limitations imposed by the prosecution history” See, e.g., *Retractable Techs.*, 653 F.3d at 1305 (“[A]ny presumption created by the doctrine of claim differentiation “will be overcome by a contrary construction dictated by the written description or prosecution history.”).” *Fenner Invs. Ltd. V. Cellco P’ship*, 778 F.3d 1320,1327 (Fed. Cir. 2015).

Google – Prosecution History

- ❖ Google argues that Cioffi would not have been able to distinguish its claims from Narin if its “web browser process” was permitted to indirectly access data on websites through another browser process.
- ❖ Google contends that the examiner rejected Cioffi’s initial claim for a “browser process” because it would encompass prior art video games in which a rendered (i.e., the first process) relies on a second process to receive interactive network data.
- ❖ Therefore, Cioffi surrendered indirect access to website data when it amended “browser process” to “web browser process” to exclude video game and word processing applications from the prior art.

Google – Prosecution History

- ❖ Google points to the following passage to show that Cioffi disclaimed “indirect” access to website data

As an example application 312 [the secure application in Narin] may provide some type of web browsing capability to its user, but rather than performing the actual web browsing functions itself, application 312 may call upon a general-purpose browsing program to perform the web browsing.

Google – Prosecution History

- ❖ Google further points to the following passage to show that Cioffi disclaimed “indirect” access to website data

Narin provides a technique for allowing an open or untrusted application to provide untrusted or open features for a secure application that are ***not directly implemented*** within the secure application (or closed application). In accordance therewith, an open or untrusted application is run in a separate auxiliary process from the closed or protected application...The auxiliary process is started by the closed process; the closed process controls the lifetime of the auxiliary process and terminates it when the open features that it provides are no longer necessary.

Cioffi rebuts prosecution history

- ❖ Cioffi contends they never suggested in the course of amending “browser process” to “web browser process” that the “Web browser process” must be capable of “directly” accessing website data without the assistance of another “web browser process.”
- ❖ Cioffi asserts that the key to overcoming Narin was not that the first “web browser process” could “directly” access website data but, rather, was that the first “web browser process” could access website data *at all*.

Federal Circuit

- ❖ The limitation in claim 24 gives rise to a presumption that claim 21 lacks such a limitation.
- ❖ Google's argument does not change the fact that the "directly exchanges data with a network" limitation would be rendered superfluous.
- ❖ In addition, they did not find anything in the prosecution history that overcome the presumption created by the claim differentiation principles.

Federal Circuit

- ❖ Unlike *Fenner*, the alleged disavowal of claim scope is far from unequivocal in Cioffi's case.
- ❖ Cioffi distinguished Narin by arguing that its first browser process was not functionally equivalent to Narin's "secure" or "trusted" application because the first browser process of the reissue claims was capable of accessing untrusted data from websites, which would constitute "executable code from other sources that may not be trusted."
- ❖ The Fed. Cir. Found that the first passage relied on by Google simply confirms that the "secure" process of Narin cannot perform web browsing functions itself, but can call upon the "open" process to perform such functions. Nothing here suggests that the "secure" process thereby gains access to website data.

Federal Circuit

- ❖ Nothing contained in second passage clarifies that the “untrusted or open features” that the untrusted application provides the secure application include anything more than general web browsing capability, as opposed to *website data*. And even if such “features” included data from websites, nothing suggests that “are not directly implemented” equates to “are indirectly accessed.”
- ❖ Whatever the “untrusted features” provided to the “secure” application might include they *cannot include* “executable code from unknown sources.”
- ❖ Thus, nothing from the prosecution history constitutes a clear and unmistakable disavowal of “indirect” access.

Federal Circuit

- ❖ “There is no ‘clear and unmistakable’ disclaimer if a prosecution argument is subject to more than one reasonable interpretation, one of which is consistent with a proffered meaning of the disputed term.” *Scandisk Corp. v. Memorex Prods.*, 415 F.3d 1278, 1287 (Fed. Cir. 2005).
- ❖ Cioffi has offered a reasonable alternative interpretation – that it differentiated Narin by explaining that its first web browser process, unlike Narin’s “secure” process, had access to website data.

Critical File - Specification

The opinion refers to the following references:

- ❖ With the network interface program constrained in this way, malware programs are rendered unable to automatically corrupt critical system and user files located on the main memory storage area.
- ❖ It is an object to the present invention to provide a computer system capable of preventing malware programs from automatically corrupting critical user and system files.
- ❖ It is another object of the present invention to provide a user with an easy and comprehensive method of restoring critical system and user files that may have been corrupted by a malware infection.

Critical File – Prosecution History

Prosecution History

- ❖ Critical user data residing on the first electronic memory space is thereby protected from corruption by a malicious (malware) process downloaded from the network and executing on the second logical process.
- ❖ [M]alware programs are rendered unable to automatically corrupt critical system and user files located on the main memory storage area.

Federal Circuit

- ❖ The question is whether these five references to “user” files or data in the specification and prosecution history are sufficient to require that we read a “user files” limitation into the claim term “critical file.”
- ❖ “A claim term should be given its ordinary meaning in the pertinent context, unless the patentee has made clear its adoption of a different definition or otherwise disclaimed that meaning.” *Ancora Techs., Inc. v. Apple, Inc.*, 744 F.3d 732, 734 (Fed. Cir. 2014)

Federal Circuit

- ❖ The Experts from both sides agreed that “critical file” has a well-understood and objective definition to one of skill in the art.
- ❖ Cioffi’s expert stated one skilled in the art would understand that a “critical file” refers to files required for the proper operation of the computer’s systems.”
- ❖ Google’s expert testified that one skilled in the art knows that “system files” are synonymous with “critical file” and “critical system file.”
- ❖ Both experts further agreed that “critical user file” was entirely subjective, but disagreed on whether “critical file” must be construed to include “critical user files” based on reference to such files in the specification.

Questions?