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107 F.3d 1565
United States Court of Appeals,
Federal Circuit.

Lawrence B. LOCKWOOD, Plaintiff–Appellant,

v.

AMERICAN AIRLINES, INC., Defendant–Appellee.

No. 96–1168.

|
March 4, 1997.

Holder of patents for computerized system of tailoring sales presentations to travel agents' customers brought action against airline, claiming that airline's computerized reservation system was infringing. The United States District Court for Southern District of California, [William B. Enright](#), J., held that patents were invalid and not infringed, [877 F.Supp. 500](#), [834 F.Supp. 1246](#), and patent holder appealed. The Court of Appeals, [Lourie](#), Circuit Judge, held that: (1) one patent was invalid in light of prior art; (2) patent claim required device with compact physical dimensions that could be easily transported; (3) patent required device that could produce audio-visual presentation; (4) “customer” within meaning of patent did not include travel agents; and (5) prosecution history precluded finding of infringement under doctrine of equivalents.

Affirmed.

Attorneys and Law Firms

*1567 [Robert M. Taylor, Jr.](#), Lyon & Lyon, Costa Mesa, CA, argued, for plaintiff-appellant.

[Don W. Martens](#), Knobbe, Martens, Olson & Bear, Newport Beach, CA, argued, for defendant-appellee. With him on the brief were [Joseph R. Re](#) and Paul A. Stewart.

Before [MAYER](#), [LOURIE](#) and [RADER](#), C.J.

Opinion

[LOURIE](#), Circuit Judge.

Lawrence B. Lockwood appeals from the final judgment of the United States District Court for the Southern District of California, *Lockwood v. American Airlines, Inc.*, No. 91–1640E (CM) (S.D.Cal. Dec. 19, 1995), granting summary judgment in favor of American Airlines, Inc. In that summary judgment, the court held that (1) [U.S. Patent Re. 32,115](#), [U.S. Patent 4,567,359](#), and [U.S. Patent 5,309,355](#) were not infringed by American's SABREvision reservation system, and that (2) the ['355 patent](#) and the asserted claims of the ['359 patent](#) were inval *1568 id under [35 U.S.C. § 102](#) and [35 U.S.C. § 103](#), respectively. *Lockwood v. American Airlines, Inc.*, [834 F.Supp. 1246](#), [28 USPQ2d 1114 \(S.D.Cal.1993\)](#), *req. for reconsideration denied*, [847 F.Supp. 777 \(S.D.Cal.1994\)](#) (holding the ['115](#) and ['359 patents](#) not infringed); *Lockwood v. American Airlines, Inc.*, [877 F.Supp. 500](#), [34 USPQ2d 1290 \(S.D.Cal.1994\)](#) (holding the asserted claims of the ['355 patent](#) invalid and not infringed); *Lockwood v. American Airlines, Inc.*, [37 USPQ2d 1534](#), [1995 WL 822659 \(S.D.Cal.1995\)](#) (holding the ['359 patent](#) invalid). Because the district court correctly determined that there were no genuine issues of material fact in dispute and that American was entitled to judgment as a matter of law, we affirm.

BACKGROUND

The pertinent facts are not in dispute. Lockwood owns the ['115](#), ['355](#), and ['359 patents](#), all of which relate to automated interactive sales terminals that provide sales presentations to customers and allow the customers to order goods and services. Lockwood sued American asserting that American's SABREvision airline reservation system infringed all three patents. SABREvision is used by travel agents to access schedule and fare information, to book itineraries, and to retrieve photographs of places of interest, including hotels, restaurants, and cruises, for display to consumers. It improves upon American's SABRE reservation system, which originated in the 1960s and which cannot display photographs.

The ['115 patent](#), reissued in 1986, relates to a self-service sales terminal that presents audio-visual travelogs to customers. Claim 11, the only asserted claim, reads in pertinent part:

A substantially self-contained apparatus dimensioned to be easily transported and installed at a commercial location comprising:

an audio-visual means for selectively dispensing information from a plurality of data sources;

customer operated means for selecting information to be dispensed on said audio-visual means, including means for sequentially and interactively displaying alternate selections of information on said audio-visual means in response to customer's commands;

...

at least one electromechanical means for accepting payment for said item from the customer;

....

The district court held that American's SABREvision did not infringe the ['115 patent](#) because it lacked four limitations of the asserted claim. Specifically, the court found that SABREvision was not a "substantially self-contained apparatus dimensioned to be easily transported" and that it lacked the claimed "audio-visual means," "customer operated means," and "means for collecting payment."

The ['359 patent](#) discloses a system of multiple interactive self-service terminals that provide audio-visual sales presentations and dispense goods and services from multiple institutions. Claim 1, the only independent claim, reads in pertinent part:

A system for automatically dispensing information, goods, and services for a plurality of institutions in a particular industry, comprising:

...

at least one customer sales and information terminal ...

...

said sales and information terminal including:

audio-visual means for interaction with a customer, comprising:

means for storing a sequence of audio and video information to be selectively transmitted to a customer;

means for transmitting a selected sequence of said stored information to the customer;

***1569** customer operated input means for gathering information from a customer....

The district court held that SABREvision did not infringe the ['359 patent](#) because it lacked the "audio-visual means" and "customer operated input means." The court also held the ['359 patent](#) invalid because it would have been obvious in light of the original SABRE system in combination with the self-service terminal disclosed in [U.S. Patent 4,359,631](#), which issued in 1982 and was subsequently reissued as the ['115 patent](#).

Finally, the ['355 patent](#), which issued in 1994, discloses a system for augmenting the sales and marketing capabilities of travel agents, in conjunction with airline reservation systems, by allowing travel agents to compose individual customized sales presentations for their clients. Claim 1, the only independent claim, reads in pertinent part:

A system for automatically dispensing information, goods or services for a plurality of institutions in a particular industry, comprising:

a central data processing center including means for storing service, price rate information or sales information for each institution;

at least one merchandising apparatus ...

...

said merchandising apparatus including:

a means for composing and displaying individualized sales presentations according to determinants entered into said apparatus and based on a customer's profile and requests ...

storage means holding a plurality of randomly accessible segments of data;

...

means for selectively combining said determinants to address and retrieve at least one of said segments....

The district court held that SABREvision did not infringe the '355 patent because, *inter alia*, it did not compose “individualized sales presentations” or “selectively combine” customer information to retrieve its photographs. The court further held the '355 patent invalid under 35 U.S.C. § 102(b) on the ground that its claims were anticipated by the '359 patent. The '355 patent issued from a chain of applications originating with the application that issued as the '359 patent. The district court held that the '355 patent is not entitled to the filing date of the original parent application and thus concluded that the '359 patent is anticipating prior art. Lockwood now appeals to this court arguing that the district court erred in its construction of the claims of all three patents and contending that summary judgment in favor of American on each issue is precluded because genuine issues of material fact remain in dispute.

DISCUSSION

[1] We review a district court's grant of summary judgment *de novo*. *Conroy v. Reebok Int'l, Ltd.*, 14 F.3d 1570, 1575, 29 USPQ2d 1373, 1377 (Fed.Cir.1994). Summary judgment is appropriate when no genuine issue as to any material fact exists and the moving party is entitled to judgment as a matter of law. *Fed.R.Civ.P. 56(c)*. Thus, summary judgment may be granted when no “reasonable jury could return a verdict for the nonmoving party.” See *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248, 106 S.Ct. 2505, 2510, 91 L.Ed.2d 202 (1986); *Conroy*, 14 F.3d at 1575, 29 USPQ2d at 1377 (“The moving party ... may discharge its burden by showing the district court that there is an absence of evidence to support the nonmoving party's case.”). In determining whether there is a genuine issue of material fact, we view the evidence in the light most favorable to the party opposing the motion with doubts resolved in favor of the opponent. *Transmatic, Inc. v. Gulton Indus., Inc.*, 53 F.3d 1270, 1274, 35 USPQ2d 1035, 1038 (Fed.Cir.1995).

A. Validity

[2] [3] The district court held that the asserted claims of the '359 patent would have *1570 been obvious in light of the prior art '631 patent and the original SABRE system. A determination of obviousness under 35 U.S.C. § 103 is a legal conclusion involving factual inquiries. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050, 5 USPQ2d

1434, 1438 (Fed.Cir.1988). Lockwood argues that the subject matter of the '359 claims would not have been obvious and that the district court impermissibly drew adverse factual inferences in concluding that the patent was invalid. Lockwood first argues that the district court erred in concluding that the SABRE system qualified as prior art.

American submitted an affidavit averring that the SABRE system was introduced to the public in 1962, had over one thousand connected sales desks by 1965, and was connected to the reservation systems for most of the other airlines by 1970. Lockwood does not dispute these facts, but argues that because “critical aspects” of the SABRE system were not accessible to the public, it could not have been prior art. American's expert conceded that the essential algorithms of the SABRE software were proprietary and confidential and that those aspects of the system that were readily apparent to the public would not have been sufficient to enable one skilled in the art to duplicate the system. However, American responds that the public need not have access to the “inner workings” of a device for it to be considered “in public use” or “used by others” within the meaning of the statute.

We agree with American that those aspects of the original SABRE system relied on by the district court are prior art to the '359 patent. The district court held that SABRE, which made and confirmed reservations with multiple institutions (*e.g.*, airlines, hotels, and car rental agencies), combined with the terminal of the '631 patent rendered the asserted claims of the '359 patent obvious. The terminal of the '631 patent admittedly lacked this “multiple institution” feature. It is undisputed, however, that the public was aware that SABRE possessed this capability and that the public had been using SABRE to make travel reservations from independent travel agencies prior to Lockwood's date of invention.

If a device was “known or used by others” in this country before the date of invention or if it was “in public use” in this country more than one year before the date of application, it qualifies as prior art. See 35 U.S.C. § 102(a) and (b) (1994). Lockwood attempts to preclude summary judgment by pointing to record testimony that one skilled in the art would not be able to build and practice the claimed invention without access to the secret aspects of SABRE. However, it is the claims that define a patented invention. See *Constant v. Advanced Micro-*

[Devices, Inc.](#), 848 F.2d 1560, 1571, 7 USPQ2d 1057, 1064 (Fed.Cir.1988). As we have concluded earlier in this opinion, American's public use of the high-level aspects of the SABRE system was enough to place the *claimed* features of the '359 patent in the public's possession. See *In re Epstein*, 32 F.3d 1559, 1567–68, 31 USPQ2d 1817, 1823 (Fed.Cir.1994) (“Beyond this ‘in public use or on sale’ finding, there is no requirement for an enablement-type inquiry.”). Lockwood cannot negate this by evidence showing that other, *unclaimed* aspects of the SABRE system were not publicly available. Moreover, the '359 patent itself does not disclose the level of detail that Lockwood would have us require of the prior art. For these reasons, Lockwood fails to show a genuine issue of material fact precluding summary judgment.

[4] Lockwood further argues that even if the SABRE system is effective prior art, the combination of that system and the '631 patent would not have yielded the invention of the '359 patent. The terminal in the claims of the '359 patent includes a number of means-plus-function limitations, subject to 35 U.S.C. § 112, ¶ 6, including “means for gathering information from a customer” and “means for storing a sequence of audio and video information to be selectively transmitted to a customer.” Means-plus-function clauses are construed “as limited to the corresponding structure[s] disclosed in the specification and equivalents thereof.” *In re *1571 Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed.Cir.1994) (in banc); see 35 U.S.C. § 112, ¶ 6 (1994). Lockwood argues that the structures disclosed in the '359 patent differ substantially from the terminal disclosed in the '631 patent and that, at the very least, his expert's declaration raised genuine issues of material fact sufficient to preclude summary judgment.

We do not agree. We believe that American has met its burden, even in light of the presumption of patent validity, to show that the means limitations relating to the terminal in the claims of the '359 patent appear in the '631 specification. Lockwood has failed to respond by setting forth specific facts that would raise a genuine issue for trial. Specifically, Lockwood has not alleged that the '631 disclosure lacks the structures disclosed in the '359 patent specification or their equivalents. As the district court noted, Lockwood's expert, Dr. Tuthill, relied on structures that are not mentioned in either the '631 or the '359 patents. For example, Tuthill states that the claimed invention differs from the '631 patent

because the terminal described in the '631 patent uses a “backward-chaining” system to solve problems while the '359 patent uses a “forward-chaining” system. Yet neither the '359 nor the '631 patents mentions backward- or forward-chaining. Nor does the '359 specification describe any hardware or software structure as being limited to any particular problem-solving technique. In addition, Lockwood argues that the hardware and software disclosed in the two patents are not equivalent to each other. However, the '359 patent claims the hardware and software in broad terms, and the patents both describe similar computer controlled self-service terminals employing video disk players that store and retrieve audio-visual information. For example, with regard to the “means for controlling said storage and transmitting means,” Lockwood's expert avers that the “structure described in the '359 patent which corresponds to this means is the processor unit and the application program which the processor executes.” Yet, the only software descriptions in the '359 patent consist of high level exemplary functional flowcharts. Lockwood's arguments and his expert's statements are thus conclusory. They fail to identify which structures in the '359 patent are thought to be missing from the '631 patent disclosure. Accordingly, we agree with the district court that Lockwood's and his expert's declarations have not adequately responded to American's motion by raising genuine issues of material fact, and we therefore conclude that the district court properly held the asserted claims of the '359 patent to have been obvious as a matter of law.

[5] Lockwood also argues that the district court erred in holding the '355 patent invalid as anticipated by the '359 patent. The '359 patent issued in 1986 from the first application in a chain of five applications which ultimately issued as the '359 patent. It is undisputed that the '359 patent discloses the invention ultimately claimed in the '355 patent. Because the third, fourth, and fifth applications were filed more than one year after the '359 patent issued, the validity of the '355 patent turns on whether it is entitled to the filing date of the second application, the relevant subject matter of which is undisputedly entitled to the benefit of the original application.

[6] In order to gain the benefit of the filing date of an earlier application under 35 U.S.C. § 120, each application in the chain leading back to the earlier application must comply with the written description requirement of 35

[U.S.C. § 112](#). [In re Hogan](#), 559 F.2d 595, 609, 194 USPQ 527, 540 (CCPA 1977). The district court held that two of the three intervening applications failed to maintain the continuity of disclosure and thus concluded that the ['355 patent](#) was not entitled to the necessary earlier filing date.

[\[7\]](#) [\[8\]](#) [\[9\]](#) [\[10\]](#) [\[11\]](#) Lockwood argues that the district court erred by looking solely at the applications themselves. We do not agree. It is the disclosures of the applications that count. Entitlement to a filing date does not extend to subject matter which is not disclosed, but [*1572](#) would be obvious over what is expressly disclosed. It extends only to that which is disclosed. While the meaning of terms, phrases, or diagrams in a disclosure is to be explained or interpreted from the vantage point of one skilled in the art, all the limitations must appear in the specification. The question is not whether a claimed invention is an obvious variant of that which is disclosed in the specification. Rather, a prior application itself must describe an invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought. See [Martin v. Mayer](#), 823 F.2d 500, 504, 3 USPQ2d 1333, 1337 (Fed.Cir.1987) (stating that it is “not a question of whether one skilled in the art *might* be able to construct the patentee’s device from the teachings of the disclosure.... Rather, it is a question whether the application necessarily discloses that particular device.”) (quoting [Jepson v. Coleman](#), 50 C.C.P.A. 1051, 314 F.2d 533, 536, 136 USPQ 647, 649–50 (1963)). Lockwood argues that all that is necessary to satisfy the description requirement is to show that one is “in possession” of the invention. Lockwood accurately states the test, see [Vas-Cath Inc. v. Mahurkar](#), 935 F.2d 1555, 1563–64, 19 USPQ2d 1111, 1117 (Fed.Cir.1991), but fails to state how it is satisfied. One shows that one is “in possession” of *the invention* by describing *the invention*, with all its claimed limitations, not that which makes it obvious. *Id.* (“[T]he applicant must also convey to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the ‘written description’ inquiry, *whatever is now claimed*.”) (emphasis in original). One does that by such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention. Although the exact terms need not be used *in haec verba*, see [Eiselstein v. Frank](#), 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed.Cir.1995) (“[T]he prior application need not describe the claimed subject matter in exactly the same terms as

used in the claims”), the specification must contain an equivalent description of the claimed subject matter. A description which renders obvious the invention for which an earlier filing date is sought is not sufficient.

[\[12\]](#) Lockwood further argues that his expert’s declaration was sufficient to raise a genuine issue of material fact regarding what the intervening applications disclosed to one skilled in the art. However, as American argues, one intervening application failed to disclose a computer system connected to multiple vendors and another, while disclosing a central computer with a video disk player, failed to disclose individual merchandising apparatus that contained video disk players or other equivalent storage means. Lockwood’s expert averred that the disclosed terminal in the former application “can be connected” to multiple vendors and that, although the latter application only “discusses the use of a television set and a keypad at a consumer’s home,” it would have been apparent to one skilled in the art that “Lockwood also envisioned the use of a terminal” containing a video disk player. That does not solve Lockwood’s problem. Lockwood claimed a distinct invention from that disclosed in the specification. It is not sufficient for purposes of the written description requirement of [§ 112](#) that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose. Each application in the chain must describe the claimed features. It is undisputed that one of the intervening applications does not describe an individual terminal containing a video disk player. Therefore, the declaration by Lockwood’s expert does not raise a genuine issue of material fact. The district court correctly held that the ['355 patent](#) was invalid as anticipated by the ['359 patent](#).

B. Infringement

[\[13\]](#) [\[14\]](#) [\[15\]](#) Determining whether a patent claim has been infringed requires a two-step analysis: “First, the claim must be properly construed to determine its scope and meaning. [*1573](#) Second, the claim as properly construed must be compared to the accused device or process.” [Carroll Touch, Inc. v. Electro Mechanical Sys., Inc.](#), 15 F.3d 1573, 1576, 27 USPQ2d 1836, 1839 (Fed.Cir.1993). Claim construction is to be determined by the court. [Markman v. Westview Instruments, Inc.](#), 517 U.S. 370, —, 116 S.Ct. 1384, 1387, 134 L.Ed.2d 577, 38 USPQ2d 1461, 1463 (1996) (“We hold that the

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