



HTC v. IPCOM - Federal Circuit Decision a Reminder to Avoid Ambiguity When Using Modifiers in Claims

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On January 30, 2012, the Federal Circuit issued an opinion in *HTC Corp. v. IPCom GmbH* that reversed the district court's award of summary judgment of invalidity of claims 1 and 18 of U.S. Patent No. 6,879,830. The district court concluded that those claims were indefinite because they claimed both an apparatus and method steps. The Federal Circuit reversed, holding that the claims at issue covered only an apparatus.

The '830 patent is directed to a "handover" in a cellular telephone network. A handover occurs when a mobile station switches from one base station to another. Handovers occur, for example, when a person using a cellular telephone travels in a car between coverage areas. The invention of the '830 patent is intended to reduce the chance of interrupted service during a handover.

Representative claim 1 is recited below (including the annotations and emphases added by the court to facilitate its analysis):

[1] A **mobile station** for use with a **network including** a first base station and a second base station **that** achieves a handover from the first base station to the second base station by:

[2] storing link data for a link in a first base station,

[3] holding in reserve for the link resources of the first base station, and

[4] when the link is to be handed over to the second base station:

[5] initially maintaining a storage of the link data in the first base station,

[6] initially causing the resources of the first base station to remain held in reserve, and

[7] at a later timeout determined by a fixed period of time predefined at a beginning of the

handover, deleting the link data from the first base station and freeing up the resources of the first base station, **the mobile station comprising**

[8] an **arrangement for reactivating** the link with the first base station if the handover is unsuccessful.

The parties' disagreement centered on whether the mobile station or the network, both recited in paragraph 1, implemented the six functions enumerated in paragraphs 2-7. As the court noted, if the network performed the functions, the claims would not be indefinite because the recited steps would merely describe the network environment in which the mobile station must be used. On the other hand, if it were the claimed mobile station that implemented the functions, the claims would be indefinite because they would recite both an apparatus—the mobile station—and method steps—the functions enumerated in paragraphs 2-7. Such "hybrid claims" as they are sometimes called are indefinite pursuant to the Federal Circuit's earlier decision in *IPXL Holdings, LLC v. Amazon.com, Inc.* (Fed. Cir. 2006). Citing Strunk and White's *Elements of Style* for the proposition that "modifiers should be placed next to the words they modify," the court reasoned that "[a] reader, therefore, may assume that the phrase beginning with 'including' and the clause beginning with 'that achieves' modify 'network.'" The court held that this assumption was supported by the claims' reintroduction of the mobile station in paragraph 7 and by the patent's specification. Accordingly, the court concluded that the claims were not indefinite. Instead, "[t]he claims merely establish [the functions in paragraphs 2-7] as the underlying network environment in which the mobile station operates."

It is worth noting that this dispute could have been avoided by clearer claim drafting. Patent drafters should take care to ensure that it is unambiguous which claim term a modifier refers to. For example, in this case, it would have been possible to rewrite paragraph 1 as follows: "A mobile station for use with a network including a first base station and a second base station, **the network** being configured to achieve a handover?"

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