Appeal No. 24-1685

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United States Court of Appeals for the Federal Circuit

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APPLICATIONS IN INTERNET TIME, LLC,
Plaintiff-Appellant

v.

SALESFORCE, INC.,
Defendant-Appellee.

_____

Appeal from the U.S. District Court for the District of Nevada

Case No. 3:13-CV-00628-RCJ-CLB, District Judge Robert C. Jones

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APPELLEE SALESFORCE, INC.'S COMBINED PETITION FOR PANEL REHEARING AND REHEARING *EN BANC*

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CERTIFICATE OF INTEREST

Case Number 2024-1685

Short Case Caption Applications In Internet Time, LLC v. Salesforce, Inc

Filing Party/Entity Salesforce, Inc.

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: November 12, 2024   Signature: */s/ Derek L. Shaffer*

Name: Derek L. Shaffer

1. Represented Entities. Fed. Cir. R. 47.4(a)(1).	2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2).	3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3).
Provide the full names of all entities represented by undersigned counsel in this case.	Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities. ☒ None/Not Applicable	Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities. ☒ None/Not Applicable
Salesforce, Inc.		

4. **Legal Representatives.** List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4). ☐ None/Not Applicable ☐ Additional pages attached		
James DuBois Judah Quinn Emanuel Urquhart & Sullivan, LLP	Leigh Goddard McDonald Carano LLP	Philip Mannelly McDonald Carano LLP
John J Frankovich McDonald Carano LLP		

5. **Related Cases.** Other than the originating case(s) for this case, are there related or prior cases that meet the criteria under Fed. Cir. R. 47.5(a)?

☒ Yes (file separate notice; see below)   ☐ No   ☐ N/A (amicus/movant)

If yes, concurrently file a separate Notice of Related Case Information that complies with Fed. Cir. R. 47.5(b). **Please do not duplicate information.** This separate Notice must only be filed with the first Certificate of Interest or, subsequently, if information changes during the pendency of the appeal. Fed. Cir. R. 47.5(b).

6. **Organizational Victims and Bankruptcy Cases.** Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

☒ None/Not Applicable   ☐ Additional pages attached

TABLE OF CONTENTS

TABLE OF AUTHORITIES

Page(s)

Cases

v

Other Authorities

RULE 35(b) STATEMENT

Based on my professional judgment, I believe the panel decision is contrary to the following decision(s) of the Supreme Court of the United States or the precedent(s) of this court:

Techtronic Indus. Co. v. ITC, 944 F.3d 901 (Fed. Cir. 2019); *Quanergy Sys., Inc. v. Velodyne Lidar USA, Inc.*, 24 F.4th 1406 (Fed. Cir. 2022); *Meds. Co. v. Mylan, Inc.*, 853 F.3d 1296 (Fed. Cir. 2017).

Based on my professional judgment, I believe this appeal requires an answer to one or more precedent-setting questions of exceptional importance:

Whether a patent's specification limits claims so as to require a particular feature when the specification (1) disparages prior art for omitting that feature, (2) describes "the invention" as containing that feature, and (3) discloses only a single embodiment comprising that feature and does not illustrate or describe any alternative to that feature.

/s/ Derek L. Shaffer
Derek L. Shaffer

Counsel for Appellee Salesforce, Inc.

<u>INTRODUCTION</u>

The panel's decision reflects an intra-circuit split over whether and when a patent's specification limits its claims. Specifically, different panels now divide over whether a defining feature can limit a claim when the specification disparages prior art for omitting that feature, describes "the invention" as containing that feature, and discloses only a single embodiment comprising that feature and does not illustrate or describe any alternative to that feature. Multiple precedential cases—including *Techtronic*, *MedCo.*, and *Quanergy*—hold that a specification is limiting in these very circumstances. Yet this panel has held otherwise in an opinion that, while unpublished, relies on and expands the holdings of other cases. Thus, the panel's decision either introduces or exacerbates an intra-circuit split relative to the *Techtronic* line of cases—such that indistinguishable patents may now be construed differently depending on which line of precedent a particular panel prefers. Absent rehearing, district courts can only guess which line of precedent should control in these recurring circumstances. The panel should grant rehearing to align this case with *Techtronic*, or the Court should grant rehearing *en banc* to bring consistency and predictability to its precedent.

FACTUAL STATEMENT

A.   Patent Background

U.S. Patent Nos. 7,356,482 and 8,484,111[1] are directed to a software system for "managing changes in regulatory and nonregulatory requirements for business activities at an industrial or commercial facility." Appx74.[2] The patents particularly focus on regulations related to "[g]eneration and use of hazardous substances" such as toxic agents, carcinogens, and nuclear waste, Appx89, 1:45-66, and as such, catalog various regulatory regimes governing hazardous waste and environmental protection, *see* Appx89-92. To comply with such "voluminous regulations," facilities must monitor regulatory changes and ensure they comply with ever-shifting requirements. Appx89, 2:1-24. The patents' purported solution is a software system that searches online networks and "identif[ies] changes using intelligent network agents . . . and automatically effect[s] modifications in the system." Appx92, 7:56-67.

B.   District Court Proceedings

On September 12, 2023, after ten years of litigation, the district court granted Salesforce's motions for summary judgment of invalidity and non-infringement.

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[1] The '482 and '111 patents have substantively identical specifications and both derive from the same application. All cites herein are to the '482 patent.

[2] All record citations are made to the joint appendix filed in case no. 24-1133.

Appx1-48. It relied on its prior construction of "a change management layer for automatically detecting changes that affect the application" in representative claim 1 of the '482 patent. Appx4-5; Appx11. As the court ruled, the term "automatically detecting" requires the use of an "intelligent agent," defined as "a specialized program that resides on a network, or at a server as an applet, and can make decisions and perform tasks based on pre-defined rules." Appx60-62; Appx93, 10:42-45.

To support its construction, the district court relied on this Court's precedent alongside the patents' specifications. The court noted "[t]he patents repeatedly discuss intelligent agents as an integral component of the claimed invention." Appx61. For example, the specifications explain "[t]he invention begins tracking change using one or more intelligent agents," (Appx93, 10:41-49); "[t]he system operates at four layers," including "a change management layer" that "uses one or more intelligent agents (IA's) that continually search on the Web for relevant changes in a selected business area," (Appx93, 9:33-38; Appx96, 16:18-33); and "[t]he system" tracks "relevant regulatory and non-regulatory changes that are identified by one or more Intelligent Agents," (Appx100, 24:7-18). Figure 1 "schematically illustrates the relationship of four layers that are the primary components of the invention," while Figure 2 "is a flowchart illustrating use of the invention"; both disclose the invention as using "INTELLIGENT AGENTS" or "IA." Appx92, 8:50-54.
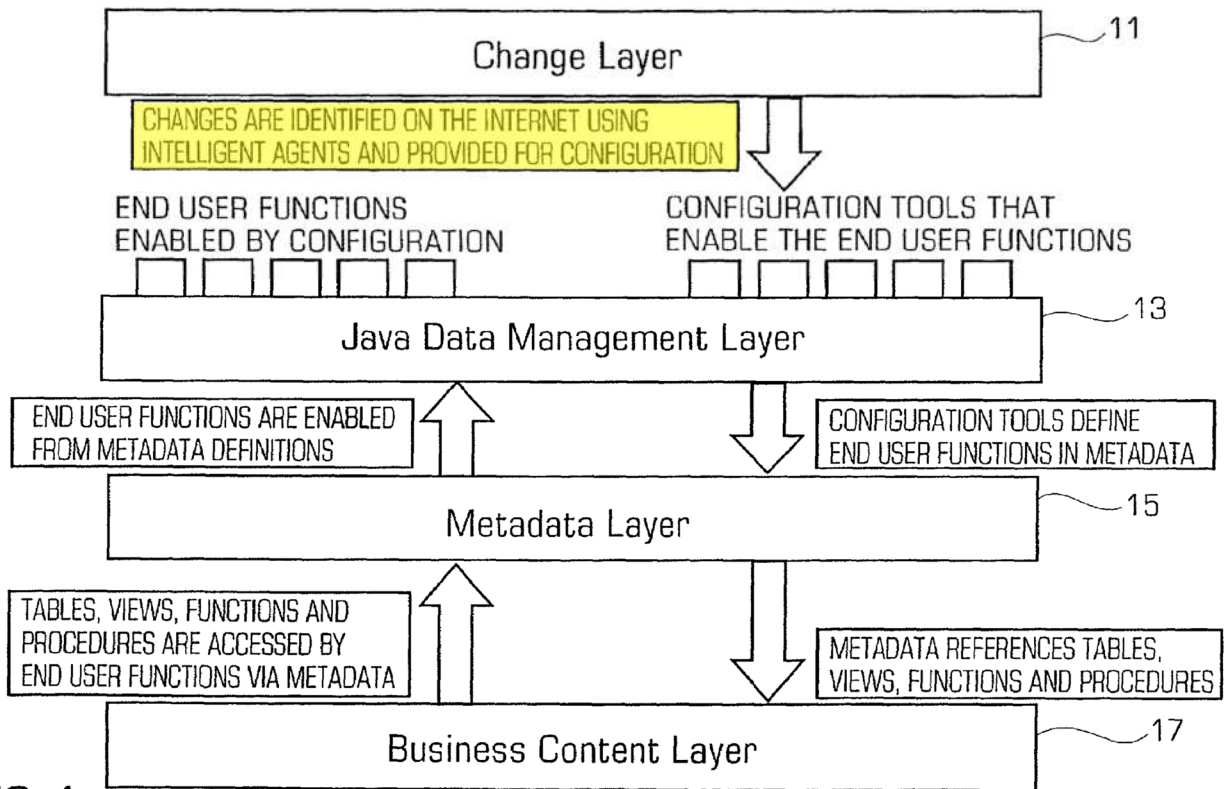
FIG. 1

Appx76 (highlighting added).
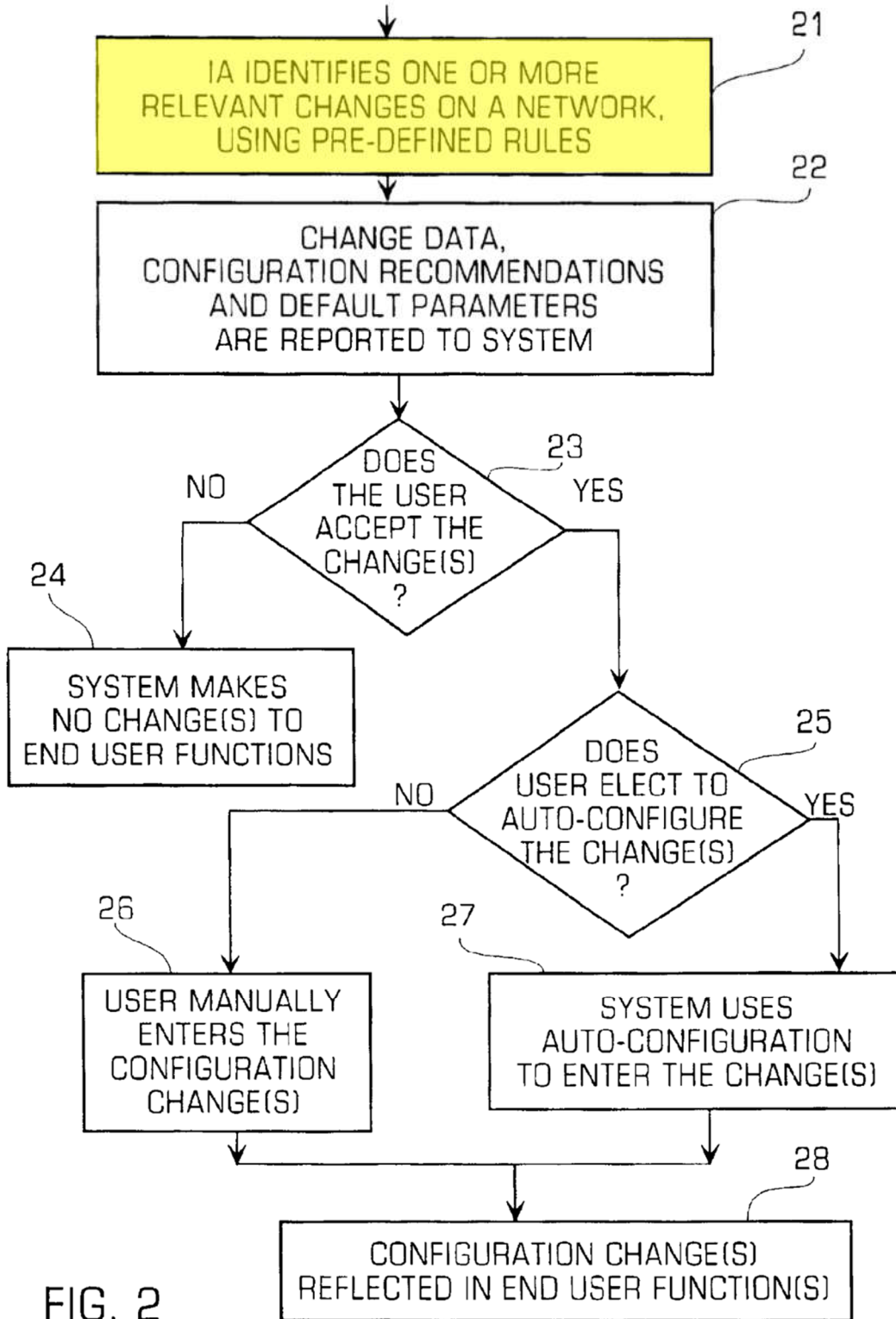
FIG. 2

Appx77 (highlighting added). Likewise, the sole disclosed embodiment uses

intelligent agents to track changes. *See* Appx93, 10:41-49; Appx97, 17:29-34;

Appx98, 19:66-20:6. Because "[c]ourts frequently construe statements made in the patents about 'the invention' as limiting the scope of the claims," the district court followed suit by ruling that the asserted claims require use of intelligent agents. Appx61 (citing *Forest Labs., LLC v. Sigmapharm Labs., LLC*, 918 F.3d 928, 933 (Fed. Cir. 2019)).

The district court further observed that "the specification distinguished itself from prior art," which omitted intelligent agents. *Id.* As the patents explain, "[v]arious attempts have been made to manage regulatory compliance, but no solution has been developed before that provides a comprehensive, integrated framework for . . . automatically making application and database changes using intelligent agent routines . . . ." *Id.* (quoting Appx92, 7:47-53). Citing this Court's precedent, the court reasoned that "[s]uch statements should be construed to circumvent the criticized art." Appx61-62 (citing *Chi. Bd. Options Exch., Inc. v. Int'l Secs. Exch., LLC*, 677 F.3d 1361, 1372 (Fed. Cir. 2012)).

Per this construction, the district court granted Salesforce's motion for summary judgment of non-infringement because the accused product did not use intelligent agents. Appx47. It also granted summary judgment of invalidity because the prior art disclosed automatically detecting changes using intelligent agents. *Id.*

C.   Federal Circuit Appeal

In a non-precedential decision, a panel of Judges Lourie, Linn, and Stoll modified the district court's construction of "automatically detecting" to shed the requirement of intelligent agents and vacated summary judgment of non-infringement and invalidity. Op. 16-17. According to the panel, "claim differentiation provide[d] a strong reason not to limit" the claims to require intelligent agents because independent claim 1 does not explicitly mention intelligent agents, while claim 8 does. Op. 7. Addressing the specification's disclosure that "the invention begins tracking change using one or more intelligent agents," the panel characterized that as merely "exemplary and not descriptive of the invention as a whole." *Id.* Similarly, the panel declared it "improper to read limitations from a preferred embodiment described in the specification—even if it is the only embodiment—into the claims absent a clear indication in the intrinsic record that the patentee intended the claims to be so limited." Op. 8 (quoting *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 913 (Fed. Cir. 2004)). And the panel dismissed the patents' "criticism of the prior art for failing to use intelligent agent routines" because "[m]ere criticism of a particular embodiment encompassed in the plain meaning of a claim term is not sufficient to rise to the level of clear disavowal" of claim scope. *Id.* (quoting *Thorner v. Sony Comput. Ent. Am. LLC*, 669 F.3d 1362, 1366 (Fed. Cir. 2012)).

7

ARGUMENT

I. **THE PANEL'S DECISION REFLECTS AN INTRA-CIRCUIT SPLIT THAT SHOULD EITHER BE CORRECTED BY THE PANEL OR ADDRESSED *EN BANC***

The panel decision reflects an intra-circuit split. This Court has held that a patent's specification limits claims so as to require a particular feature when, as here, it (1) disparages prior art for not including that feature, (2) describes "the invention" as containing that feature, and (3) discloses only a single embodiment comprising that feature and does not illustrate or describe any alternative to that feature. In ruling otherwise, the panel's decision departs from this precedent, relying on cases that either differ on their facts or else, if read as the panel does, reflect a split. The panel should grant rehearing to align this case with the Court's precedent. Alternatively, the Court should grant rehearing *en banc* to resolve the intra-circuit split.

A. Multiple Precedential Decisions Confirm That The Specification Here Is Limiting

The panel's decision contravenes multiple precedential decisions of this Court that *did* limit claims in such circumstances as described above. That settled precedent squarely controls this case.

In *Techtronic*, the Court concluded that the disclosed garage door opener required "a passive infrared detector" in its wall console for the same reasons cited by the district court. *Techtronic Indus. Co. v. ITC*, 944 F.3d 901, 910 (Fed. Cir.

8

2019). First, "the background section" of the patent disparaged prior art garage door openers that lacked passive infrared detectors in the wall console, noting that "locating the detector in the head unit was expensive, complicated, and unreliable." *Id.* at 908. Second, the specification "consistently represent[ed] the invention as the placement of the detector in the wall console." *Id.* Third, the sole embodiment in the specification "disclose[d] a straightforward solution: moving the detector to the wall console." *Id.* These disclosures overcame any "presumption created by the doctrine of claim differentiation." *Id.* at 909-10 (quoting *Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 653 F.3d 1296, 1305 (Fed. Cir. 2011)). The Court therefore limited the claims, noting the detector was "both responsive to the prior art deficiency the '319 patent identifie[d] and repeatedly set forth as the objective of the invention." *Id.* at 909.

The Court held the same in *MedCo.*, limiting a patent's claims to require an "efficient mixing" technique described in Example 5 of the specification. *Meds. Co. v. Mylan, Inc.*, 853 F.3d 1296, 1309 (Fed. Cir. 2017) ("*MedCo.*"). First, the patent distinguished the invention from prior art that inefficiently mixed the solution. *Id.* at 1303. Second, the applicant explained during prosecution that "the present invention" disclosed a "new process" for mixing the solution so as to overcome deficiencies in prior art. *Id.* at 1304-05. Third, as to the claimed invention, Example 5 was "not merely the only disclosed *embodiment* of efficient mixing—it [wa]s the

9

only *description* of efficient mixing in the patents in suit that cast[] light on what efficient mixing [wa]s and that enable[d] one of ordinary skill in the art to achieve the objects of the claimed invention." *Id.* at 1309. In view of these disclosures, the Court "constru[ed] 'efficiently mixing' to incorporate the mixing conditions of Example 5," absent disclosure of any alternative method for achieving the claimed objective. *Id.*

Likewise, the Court in *Quanergy* held that the term "lidar" was limited to a "pulsed time-of-flight" lidar technique for the same reasons. *Quanergy Sys., Inc. v. Velodyne Lidar USA, Inc.*, 24 F.4th 1406, 1414-16 (Fed. Cir. 2022). First, the specification "identifie[d] the shortcomings of existing" systems that did not use the pulsed time-of-flight technique, criticizing them as "limited by the number of pulses per second that a single laser can emit." *Id.* at 1414-15. Second, "the specification focuse[d] exclusively on pulsed time-of-flight lidar" by "disclos[ing] a lidar system that collects time-of-flight measurements" using the pulsed time-of-flight technique. *Id.* Third, the "preferred embodiment"—which included the only embodiment of the claimed lidar technique—employed pulsed time-of-flight lidar; no alternatives to time-of-flight lidar were disclosed. *Id.* at 1412, 1414-15.

Here, the claims are limited to intelligent agents for precisely the reasons set forth in *Techtronic*, *Quanergy*, and *MedCo*.[3] The patents disparage prior art that does not use intelligent agents for automatic change detection. Appx92, 7:47-67. They then purport to improve upon the deficient prior art because "[t]he invention" tracks changes "using one or more intelligent agents." Appx93, 10:41-49; *see also* Appx76; Appx77; Appx92, 8:50-54; Appx93, 9:33-38; Appx96, 16:18-33; Appx100, 24:7-18. And the patents disclose only one embodiment of the invention, which uses intelligent agents. Appx93, 10:41-49; Appx97, 17:29-34; Appx98, 19:66-20:6. No other method is even suggested in the specification, and neither AIT nor the panel have advanced one. Having obtained patents by distinguishing its invention from prior art that omitted intelligent agents, the applicant cannot turn

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[3]   These are just three of the many decisions that limit claims under such circumstances. *E.g.*, *Chewy, Inc. v. IBM Corp.*, 94 F.4th 1354, 1359-60 (Fed. Cir. 2024) (limiting claims to "pre-fetching" method of "advertising objects" because the patent "uniformly refers" to such method "as an aspect of the invention as a whole"); *Poly-Am., LP v. API Indus., Inc.*, 839 F.3d 1131, 1137 (Fed. Cir. 2016) (limiting claims to exclude trash bags with "short seals that do not extend inwardly" because "every section of the specification indicates the importance of inwardly extended short seals"); *Trs. of Colum. Univ. in City of N.Y. v. Symantec Corp.*, 811 F.3d 1359, 1367-68 (Fed. Cir. 2016) (limiting "probabilistic model of normal computer system usage" to those built using "only attack-free data" because no embodiment "uses attack data to build the model"); *Retractable Techs.*, 653 F.3d at 1305 (limiting a syringe "body" to "a body that is a single piece" because the only disclosed embodiments were expressly limited as such); *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1301 (Fed. Cir. 1999) (limiting claims to exclude "restriction rings" not "permanently attached" to "air inlet covers" because no other method of "automatically" inserting or removing rings from the cover was disclosed).

around and expand the claims' scope beyond intelligent agents. *See MedCo.*, 853 F.3d at 1305 ("Divorcing efficient mixing from the batches limitation would also have the impermissible result of 'extend[ing] [Medicines'] monopoly beyond the invention' disclosed, and potentially to the prior art." (alterations in original) (quoting *Gen. Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 371 (1938))).

The district court's limiting construction followed naturally from the precedents cited above. Although the panel asserted that the purported invention "requires automatically detecting and making changes, irrespective of whether that is done by intelligent agents," Op. 8-9, it did not reconcile that assertion with *Techtronic*, *Quanergy*, *MedCo.*, and other binding precedents.[4] Indeed, the panel ran headlong into *MedCo.*'s stated concern that such an unbounded construction "would expand the scope of" the disputed term "to cover any way of" automatically detecting changes rather than the method "justified by the specification disclosure." *MedCo.*, 853 F.3d at 1306-07.

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[4]   Commenters note how the Court frequently relies on one or more of the three disclosures to limit claims based on their specifications. *See* Robert Fram et al., *Claim Construction and Implicit Definitions Based on the Specification Since Phillips*, 8 SEDONA CONF. J. 65, 68-76 (2007); Peter S. Menell et al., *Patent Claim Construction: A Modern Synthesis and Structured Framework*, 25 BERKELEY TECH. L.J. 711, 745-53 (2010).

B.   **The Panel's Reliance On Other Cases Marks A Split**

Breaking with this precedent, the panel holds that a specification cannot limit a claim even in these circumstances. To so hold, the panel incorrectly considers each of the above three features in isolation—disparagement or criticism of prior art, "the invention" language, and the inclusion of a sole embodiment—and deems each alone incapable of limiting a patent's claims. But that siloed approach departs from precedent and ultimately denies the specifications as a whole the weight they are due. The above cases instruct that these features of a specification, when combined, *do* properly limit the patent's claims. The upshot is a split that will occasion recurring confusion among district courts and divergence between panels.

1.   **Disclosing That "The Invention" Uses Intelligent Agents Is Not Merely "Exemplary," But Limiting**

The patents' repeated disclosure that "the invention" uses intelligent agents limits the claims to require intelligent agents. *See Verizon Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1308 (Fed. Cir. 2007) ("When a patent thus describes the features of the 'present invention' as a whole, this description limits the scope of the invention."). The panel characterized the patents' description of "the invention" as merely "exemplary and not descriptive of the invention as a whole," presumably because the disclosure is in a subsection styled "Example." Op. 7; *see* Appx93, 10:29-49. That this language appears in the subsection titled "Example," however, does not diminish its import. For one, other disclosures

13

outside of the "Example" subsection confirm that the invention uses intelligent agents. For instance, the '482 patent discloses that "[t]he invention provides an integrated system" that "operates at four layers," including "a change management layer" "*us[ing] one or more intelligent agents* (IA's) that continually search on the Web for relevant changes in a selected business area." Appx92, 8:66-67; Appx93, 9:33-38; Appx96, 16:18-33 (emphasis added). Figures 1 and 2 in the '482 patent also depict "primary components of the invention" and "use of the invention" respectively, both of which use intelligent agents. Appx76; Appx77; Appx92, 8:50-54. Notably, the "example" that the panel focuses on is "not merely the only disclosed *embodiment* of" automatically detecting changes, "it is the only *description* of [automatically detecting changes] in the patents in suit that casts light on what [that term] is and that enables one of ordinary skill in the art to achieve the objects of the claimed invention." *MedCo.*, 853 F.3d at 1309.

The panel relies on *Continental* to support its position, but that case differs on its facts. Op. 7-8. The specification in *Continental* used permissive language to describe "one technique" that "can be carried out" "as a way of" performing the invention. *Cont'l Cirs. LLC v. Intel Corp.*, 915 F.3d 788, 797 (Fed. Cir. 2019). This permissive language negated the use of the phrase "the present invention," which otherwise would limit the invention's scope. *Id.* at 798. And the examples provided in the specification in *Continental* did "not uniformly require use of" the limiting

14

feature. *Id.* Here, by contrast, the patents **do not** contain similarly permissive language and **do** uniformly describe "automatically detecting changes" by using intelligent agents. Intelligent agents are not merely "a way of" performing the invention, but **the only way** of performing the invention.

Tellingly, neither AIT nor the panel identifies any way of "automatically detecting changes that affect an application" without intelligent agents. Elsewhere, this Court limits claims to what is described in a sole embodiment when the patent does not disclose any other way to perform the invention. *See, e.g.*, *Quanergy*, 24 F.4th at 1414-16 (limiting the term "lidar" to "pulsed time-of-flight" lidar); *Trs. of Colum. Univ. in City of N.Y. v. Symantec Corp.*, 811 F.3d 1359, 1367-68 (Fed. Cir. 2016) (limiting "probabilistic model of normal computer system usage" to those built using "only attack-free data" because no embodiment "uses attack data to build the model"). As in *Quanergy*, because "the written description focuse[s] exclusively" on intelligent agents, intelligent agents are not merely exemplary but "foundational to the claimed invention" and therefore limiting. 24 F.4th at 1414.

2.   The Patents Sufficiently Disparage The Prior Art For Not Using Intelligent Agents

The patents also disparage prior art that does not use intelligent agents. A patent's "repeated derogatory statements about [prior art] reasonably may be viewed as a disavowal of that subject matter from the scope of the Patent's claims." *Chi. Bd. Options Exch.*, 677 F.3d at 1372. The panel, quoting *Thorner*, nevertheless

15

dismissed this disparagement as "[m]ere criticism" that "is not sufficient to rise to the level of clear disavowal." Op. 8.

But *Thorner* in fact supports the district court's construction. The Court in *Thorner* distinguished a case that *did* limit the claims to require a limiting feature disclosed in the specification because, there, "the specification repeatedly described the 'present invention' as" having the limiting feature and included the feature in "*all embodiments of the present invention contemplated and disclosed herein.*" *Thorner*, 669 F.3d at 1366 (emphasis in original) (quoting *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1339-43 (Fed. Cir. 2001)). That is exactly what the patents do here. And they disparage the prior art by explaining that "no solution has been developed before that . . . automatically mak[es] application and database changes using intelligent agent routines." Appx92, 7:47-67. They double down on this disparagement by saying "[t]hese partial solutions also do not provide a 'closed loop' approach to identifying changes using intelligent network agents." *Id.* Then, to overcome this deficiency in the prior art, the patents repeatedly emphasize that "the invention" uses intelligent agents to track regulatory changes. *See supra* § I.B.1. Read fully and fairly, the patents propose using intelligent agents "for the express purpose of remedying these perceived deficiencies" in the prior art. *Chi. Bd. Options Exch.*, 677 F.3d at 1372.

Nor is it a satisfying answer to rely, as the panel did, on "[t]he lack of any discussion of intelligent agents in the solution described in the Abstract, Background, and Summary." Op. 8 (citing *Cont'l Cirs.*, 915 F.3d at 798). To start, the Background *does* disclose "automatically making application . . . changes using intelligent agent routines." Appx92, 7:51-53. Although the panel relies on *Continental* for the proposition that disparagement must appear in the Abstract and/or Summary in order to be limiting, that proposition is by no means apparent from *Continental* itself. That the feature addressed in *Continental* did "not appear in the summary of the invention section at all" mattered insomuch as "it [wa]s difficult to say that the present invention 'as a whole'" necessarily included that feature. 915 F.3d at 798. This conclusion flowed from the specification's permissive language, which explained that the feature was merely "one technique" that "can be carried out" "as a way of" performing the invention. *Id.* at 797. As discussed above, far from speaking in such permissive terms, these patents specify that "the invention" and "the system" use intelligent agents. *See supra* § I.B.1. When read in light of its facts, *Continental* does not lay down a categorical rule that the Abstract and/or Summary must contain the particular feature that distinguishes the prior art before the disparagement can be limiting. Either the panel has erred in its reading of *Continental*, or else *Continental* itself reflects a preexisting split that this Court should address.

17

3.   These Disclosures Overcome The Presumption Of Claim Differentiation

As noted, these patents overcome claim differentiation by (1) disparaging the prior art for not using intelligent agents, (2) describing "the invention" as using intelligent agents, and (3) disclosing a sole embodiment of the invention that uses intelligent agents to automatically detect changes. The panel nonetheless observed that, because claim 1 recites generally "automatically detecting changes," whereas claim 8 specifies using "intelligent agents" to detect changes, "claim differentiation provides a strong reason not to limit claim 1 to intelligent agents." Op. 7 (citing *Liebel-Flarsheim*, 358 F.3d at 910). But claim differentiation is not insurmountable—it "will be overcome by a contrary construction dictated by the written description." *Retractable Techs.*, 653 F.3d at 1305 (citation omitted); *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1302 (Fed. Cir. 1999) ("[C]laim differentiation does not serve to broaden claims beyond their meaning in light of the specification.").

Claim differentiation has been overcome when, as here, the specifications "expressly recite that 'the invention' has a [particular feature], expressly distinguish the invention from the prior art based on this feature, and only disclose embodiments that are expressly limited to having [this feature]." *Retractable Techs.*, 653 F.3d at 1305. For example, the Court has limited claims covering trash bags to require "inwardly extended short seals" where the specification described it as "one of the

characteristics *of the present invention*," disparaged prior art for lacking this feature, and was confined to embodiments exhibiting this feature. *Poly-Am., LP v. API Indus., Inc.*, 839 F.3d 1131, 1136-37 (Fed. Cir. 2016) (emphasis in original). Similarly, the Court limited claims covering wall consoles to require "passive infrared detectors" because the specification "consistently represent[ed] the invention" as having that feature, disparaged prior art for lacking that feature, and contained a sole embodiment including that feature. *Techtronic*, 944 F.3d at 906-08. In each of those cases, the Court held claim differentiation was readily overcome such that it merited little discussion. *Poly-Am.*, 839 F.3d at 1137; *Techtronic*, 944 F.3d at 909-10; *see also Retractable Techs.*, 653 F.3d at 1305 (same); *Chewy, Inc. v. IBM Corp.*, 94 F.4th 1354, 1359-60 (Fed. Cir. 2024) (same). The panel's contrary conclusion marks a stark departure from precedent in this respect too.

CONCLUSION

For the foregoing reasons, this Court should grant either panel rehearing or rehearing *en banc* to bring uniformity and predictability to its precedent governing an important, recurring issue of claim construction.

19

Dated: November 12, 2024   Respectfully submitted,

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CERTIFICATE OF COMPLIANCE WITH RULE 32(g)

This petition complies with the type-volume limitation of Rule 40(b)(1) of the Federal Rules of Appellate Procedure ("FRAP") because this brief contains 3,896 words, excluding the parts of the brief exempt by FRAP 32(f).

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Dated: November 12, 2024   */s/ Derek L. Shaffer*
                                                                Derek L. Shaffer

ADDENDUM

NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

APPLICATIONS IN INTERNET TIME, LLC,
Plaintiff-Appellant

v.

SALESFORCE, INC.,
Defendant-Appellee

2024-1133

Appeal from the United States District Court for the District of Nevada in No. 3:13-cv-00628-RCJ-CLB, Senior Judge Robert Clive Jones.

APPLICATIONS IN INTERNET TIME, LLC,
Plaintiff-Appellant

v.

SALESFORCE, INC.,
Defendant-Appellee

2024-1685

Appeal from the United States District Court for the District of Nevada in No. 3:13-cv-00628-RCJ-CLB, Senior Judge Robert Clive Jones.

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Decided: October 10, 2024

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MICHAEL DEVINCENZO, King & Wood Mallesons LLP, New York, NY, argued for plaintiff-appellant. Also represented by ANDREA PACELLI, CHARLES WIZENFELD; STEVEN C. SEREBOFF, SoCal IP Law Group LLP, Westlake Village, CA.

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————————————

Before LOURIE, LINN, and STOLL, *Circuit Judges*.

LINN, *Circuit Judge*.

Applications in Internet Time ("AIT") appeals the grants of summary judgment of non-infringement and invalidity of the asserted claims of U.S. Patent Nos. 7,356,482 (the "'482 patent") and 8,484,111 (the "'111 patent"). *See Applications in Internet Time, LLC v. Salesforce.com, Inc.*, 691 F. Supp. 3d 1223, 1228, 1230–31 (D. Nev. 2023) ("*Summary Judgment Order*"). Further, AIT challenges the district court's construction of "automatically detecting" as requiring the use of intelligent agents. *See Applications in Internet Time, LLC v. Salesforce.com, Inc.*, No. 3:13-CV-00628-RCJ-CLB, 2021 WL 5238767, at *13, (D. Nev. Nov. 9, 2021) ("*Markman Order*"). AIT also appeals the district court's conclusion that its case was exceptional under 35 U.S.C. § 285 and the award of nearly

$6.9 million in attorneys' fees. *See Applications in Internet Time, LLC v. Salesforce*, Inc., 3:13-CV-00628-RCJ-CLB, 2024 WL 1199594, at *6 (D. Nev. Mar. 20, 2024) ("*Fee Order*").

For the reasons that follow, we modify the district court's claim construction of "automatically detecting," vacate the district court's grants of summary judgment of non-infringement and invalidity, and reverse its exceptional case determination.

BACKGROUND

In 2013, AIT sued Salesforce in the District of Nevada for patent infringement of the '482 and '111 patents. The '482 and '111 patents have substantially identical specifications. The asserted patents are directed to methods and systems for automatically detecting changes to business requirements and incorporating such changes into an application. Representative claim 1 of the '482 patent recites:

> 1. A system for providing a dynamically generated application having one or more functions and one or more user interface elements; comprising:
>
>> a server computer;
>>
>> one or more client computers connected to the server computer over a computer network;
>>
>> a first layer associated with the server computer containing *information about the unique aspects of a particular application*;
>>
>> a second layer associated with the server computer containing information about the user interface and functions common to a variety of applications, a particular application being generated based on the data in both the first and second layers;

> a third layer associated with the server computer that retrieves the data in the first and second layers in order to generate the functionality and user interface elements of the application; and
>
> a change management layer for *automatically detecting changes that affect an application*,
>
> each client computer further comprising a browser application being executed by each client computer, wherein a user interface and functionality for the particular application is distributed to the browser application and dynamically generated when the client computer connects to the server computer.

'482 patent col. 32 ll. 9–34 (emphases added).

Relevant to this appeal, unasserted claim 8 recites:

> 8. The system of claim 1, wherein the change management layer further comprises *one or more intelligent agents that detect changes that affect an application*.

'482 patent col. 32 ll. 59–61 (emphasis added).

In its *Markman* order, the district court construed "automatically detecting" as requiring the use of one or more intelligent agents, concluding that the specification made clear that intelligent agents were integral to the invention. *Markman Order*, at *6–7. Additionally, the district court afforded "changes that affect" its plain and ordinary meaning. *See id.* at *8.

Salesforce moved for summary judgment of non-infringement of all asserted claims. *Summary Judgment Order*, 691 F. Supp. 3d at 1227. Salesforce also moved for summary judgment of invalidity, contending that the claims were anticipated by U.S. Patent No. 6,249,291

("Popp") and rendered obvious by the combination of Popp with an academic reference ("Amati"). *Id.* at 1237. AIT filed a motion for summary judgment of no anticipation, contending that Salesforce failed to prove that Popp disclosed an intelligent agent. *Id.* at 1227, 1242.

The district court granted summary judgment of noninfringement, reasoning that because AIT's expert, Mr. Zatkovich, failed to compare the accused products to the specification's description of intelligent agents, no reasonable jury could find in AIT's favor. *Summary Judgment Order*, 691 F. Supp. 3d at 1234–35. The district court also granted summary judgment of invalidity, concluding that the asserted claims were anticipated by Popp and rendered obvious by the Popp–Amati combination. *Id.* at 1253. Determining that its *Markman* order ended any reasonable likelihood of AIT prevailing on the merits, the district court held that AIT's continued litigation after the *Markman* order made this case exceptional and awarded Salesforce $6,890,328.28 in attorneys' fees. *See Fee Order*, at *6. These appeals followed. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

ANALYSIS

I.   Standard of Review

"Claim construction is ultimately a question of law, decided de novo on review, as are the intrinsic-evidence aspects of a claim-construction analysis." *Intel Corp. v. Qualcomm Inc.*, 21 F.4th 801, 808 (Fed. Cir. 2021). "To the extent the district court, in construing the claims, makes underlying findings of fact based on extrinsic evidence, we review such findings of fact for clear error." *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1346 (Fed. Cir. 2015); *see also Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318, 321–22 (2015). Claim terms generally carry their ordinary and customary meaning as understood by an ordinarily skilled artisan. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc). "But where the

inventor has clearly set forth a different definition of a claim term, or has manifested that the invention does or does not include a particular aspect, that intention is regarded as dispositive." *Techtronic Indus. Co. v. Int'l Trade Comm'n*, 944 F.3d 901, 907 (Fed. Cir. 2019) (internal quotations omitted). Establishing disavowal requires "clear and unequivocal evidence that the claimed invention includes or does not include a particular feature." *Poly-Am., L.P. v. API Indus., Inc.*, 839 F.3d 1131, 1136 (Fed. Cir. 2016).

We review a grant of summary judgment under the law of the regional circuit. *Adasa Inc. v. Avery Dennison Corp.*, 55 F.4th 900, 907 (Fed. Cir. 2022). The Ninth Circuit "review[s] the district court's grant of summary judgment *de novo*, determining whether, viewing all evidence in the light most favorable to the nonmoving party, there are any genuine issues of material fact and whether the district court correctly applied the relevant substantive law." *Kraus v. Presidio Tr. Facilities Div./Residential Mgmt. Branch*, 572 F.3d 1039, 1042–43 (9th Cir. 2009) (internal quotations omitted).

The determination of whether a case is exceptional under § 285 is a factual determination reviewed for clear error. *Superior Fireplace Co. v. Majestic Prods. Co.*, 270 F.3d 1358, 1376–77 (Fed. Cir. 2001). The subsequent determination of a reasonable award is reviewed for an abuse of discretion. *Id.*

II. Claim Construction

Claims 1 and 21 of the '482 patent recite "automatically detecting changes" and claim 13 of the '111 patent recites a fourth portion of a server that is configured to "automatically detect changes." '482 patent col. 32 ll. 27–28, col. 33 ll. 52–53; '111 patent col. 34 ll. 5–6. The district court concluded that the specification expressly disavowed automatically detecting changes without intelligent agents and the specification distinguished the invention from the prior art

by its use of intelligent agents. *Markman Order*, at *7. Accordingly, the district court construed "automatically detecting" as limited to "detecting without human intervention through the use of one or more intelligent agents." *Id.* at *13.

AIT contends that the statements the district court treated as express disavowals are merely exemplary and, thus, do not limit the invention as a whole. AIT also argues that because unasserted claim 8 expressly recites the use of intelligent agents, claim differentiation weighs against incorporating that limitation into the broader independent claim. Salesforce responds that the district court correctly construed "automatically detecting" to require the use of intelligent agents because intelligent agents are essential to the invention as a whole and the specification consistently describes the invention as including intelligent agents without providing any alternative.

We agree with AIT that the district court erred in construing "automatically detecting" as requiring the use of an intelligent agent. First, because claim 1 recites "automatically detecting changes" and claim 8 requires that the changes be detected by "one or more intelligent agents," claim differentiation provides a strong reason not to limit claim 1 to intelligent agents. '482 patent col. 32 ll. 27–28, 59–61; *see Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 910 (Fed. Cir. 2004) ("[W]here the limitation that is sought to be 'read into' an independent claim already appears in a dependent claim, the doctrine of claim differentiation is at its strongest.").

Second, the specification does not disavow "automatically detecting" without "intelligent agents." The portion of the specification that describes "the invention" as detecting changes using intelligent agents is exemplary and not descriptive of the invention as a whole. '482 patent col. 10 ll. 29–42; *see Cont'l Cirs. LLC v. Intel Corp.*, 915 F.3d 788, 798 (Fed. Cir. 2019) (recognizing that descriptions of "the

present invention" or "this invention" do not limit the claims where the intrinsic evidence does not support applying the limitation to the entire patent). The repeated use of intelligent agents in the description of the best mode merely indicates that intelligent agents may be the best way of implementing the invention, not that the invention cannot be implemented without intelligent agents. *See Phillips*, 415 F.3d at 1323 ("To avoid importing limitations from the specification into the claims, it is important to keep in mind that the purposes of the specification are to teach and enable those of skill in the art to make and use the invention and to provide a best mode for doing so."). Moreover, "it is improper to read limitations from a preferred embodiment described in the specification—even if it is the only embodiment—into the claims absent a clear indication in the intrinsic record that the patentee intended the claims to be so limited." *Liebel-Flarsheim*, 358 F.3d at 913.

The lack of any discussion of intelligent agents in the solution described by the Abstract, Background, and Summary of the Invention sections of the patent weighs against concluding that the inventor intended to limit the invention to the use of intelligent agents. *See Cont'l Cirs.*, 915 F.3d at 798 (noting that the Summary of the Invention's silence on desmear processes weighed against concluding "that the present invention 'as a whole' necessarily include[d] the repeated desmear process" (citations omitted)). Moreover, the Background section's criticism of the prior art for failing to use intelligent agent routines similarly fails to limit the claim scope. "Mere criticism of a particular embodiment encompassed in the plain meaning of a claim term is not sufficient to rise to the level of clear disavowal." *Thorner v. Sony Comput. Ent. Am. LLC*, 669 F.3d 1362, 1366 (Fed. Cir. 2012). Further, when discussing "[w]hat is needed" to address the problems in the prior art, the Background section merely explains that the solution

requires automatically detecting and making changes, irrespective of whether that is done by intelligent agents.

For these reasons, the district court erred in limiting the claims to require the use of one or more intelligent agents.

III. Non-Infringement

The district court granted summary judgment of non-infringement because "AIT failed to put forth evidence sufficient to raise a genuine dispute of material fact that the accused products use any such 'intelligent agent' to detect changes." *Summary Judgment Order*, 691 F. Supp. 3d at 1233. Because we conclude that the district court erred in construing the asserted claims to require intelligent agents, we vacate the district court's grant of summary judgment of non-infringement as to all asserted claims.

IV. Anticipation

Anticipation is a question of fact that may be resolved on summary judgment only when there are no genuine issues of material fact. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1294 (Fed. Cir. 2002). For the reasons detailed below, we disagree with the district court's analysis and vacate the district court's summary judgment order of anticipation as to all asserted claims.

A. First Layer

The district court concluded that Popp discloses the claim limitation "a first layer associated with the server computer containing information about unique aspects of a particular application," because that phrase does not exclude data used by an application, such as the data contained on the websites in Popp. *Summary Judgment Order*, 691 F. Supp. 3d at 1239–40 (noting that "aspects" is broad enough to include "data" and that dependent claim 23 expressly adds a limitation that "the first layer comprises . . . data").

The district court erred because it did not consider the limitation as a whole. The limitation at issue claims a particular kind of information; namely, that which is "about *unique aspects of a particular application*." '482 patent col. 32 ll. 16–17 (emphasis added). Other information, such as information unrelated to a particular application, would not necessarily satisfy this limitation, even if "data" is considered a kind of information. The question for anticipation should have been whether the data disclosed in Popp is about unique aspects of Popp's application. The district court did not ask, much less answer this question, because it erroneously treated its conclusion that "information" may include data as dispositive of the anticipation inquiry.

The district court's reliance on the testimony of Salesforce's expert, Dr. Bederson, was therefore misplaced. Although Dr. Bederson opined that Popp's application fetches all the data from the database such as "all of the models of cars" within a shopper's price range, J. App'x at 2075–76,[1] Dr. Bederson does *not* explain how "models of cars" (i.e. "data") stored on a database and subsequently displayed on a webpage are "about a unique aspect" of the webpage.

Because the district court's summary judgment order fails to explain why a reasonable jury could not find that Popp fails to disclose the "first layer" limitation, we vacate that portion of the district court's order.

B.   Changes that Affect an Application

At the *Markman* stage, the district court afforded the term "changes that affect" its plain and ordinary meaning. *Markman Order*, at *8. At summary judgment, the district court purported to apply that construction, holding that "a skilled artisan would find the claim language broad enough

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[1] "J. App'x" refers to the appendix filed under appeal No. 2024-1133.

to encompass any 'changes' related to an application," and relying heavily on Dr. Bederson's opinion that Popp's "detection of a name entered in a field to be a change that affects an application under at least . . . AIT's interpretation." *Summary Judgment Order*, 691 F. Supp. 3d at 1243.

AIT argues that the district court's adoption of Dr. Bederson's opinion on anticipation was not based on the plain and ordinary meaning of "changes that affect," but on a new and overly broad construction that fails to appreciate the limitation as a whole, which requires the detected changes to be "changes that *affect an application*" rather than just "*related to an application*." *See id.* (emphasis added). AIT also argues that the district court failed to view all inferences in AIT's favor (as it was required to do on summary judgment) by baselessly rejecting Mr. Zatkovich's testimony that the information entered into Popp's data field leaves the application "entirely unaffected." J. App'x 2904 at ¶ 255.

Salesforce argues that the ordinary meaning of "changes that affect" is not limited to changes affecting the functionality of an application, but can encompass changes to the input data on which the application operates. Further, Salesforce contends that without such a limitation, there can be no genuine issue of material fact that Popp discloses automatically detecting changes to such inputs.

We agree with AIT that the district court failed to apply the proper standard for summary judgment. Rather than viewing the evidence in the light most favorable to AIT, the non-moving party, the district court adopted the perspective of Dr. Bederson, and rejected the testimony of Mr. Zatkovich without explanation. The district court did not explain why any reasonable jury must accept Dr. Bederson's testimony and reject Mr. Zatkovich's. Moreover, the district court analyzed anticipation under "Dr. Bederson's understanding of AIT's interpretation" of the

12   APPLICATIONS IN INTERNET TIME, LLC v. SALESFORCE, INC.

claim language, rather than the claim construction it previously adopted. This was error.

To the extent the district court's holding was based on a modification or clarification of its "plain and ordinary meaning" claim construction, this too was error, because the district court failed to provide any reason for any such modified construction. Moreover, to the extent that the district court resolved a dispute between the parties about the proper application of the court's claim construction, the district court erred by resolving a factual issue on summary judgment.

C. AIT's Impeachment Evidence

AIT additionally argues that the district court erred by relying on Dr. Bederson's report, even though AIT presented credible evidence that Dr. Bederson's report did not accurately represent his personal expertise, but was copied from Dr. Schmidt's declaration. From this, AIT argues that a reasonable jury could have reasonably disbelieved Dr. Bederson's report and testimony, and thus the district court erred in granting summary judgment based so heavily on his evidence.

We also agree with AIT that the district court erred in holding that summary judgment should not be denied simply because AIT asserted that Dr. Bederson's testimony is not to be believed. *Summary Judgment Order*, 691 F. Supp. 3d at 1251 (citing *TypeRight Keyboard Corp. v. Microsoft Corp.*, 374 F.3d 1151, 1158 (Fed. Cir. 2004) ("Summary judgment should not be denied simply because the opposing party asserts that the [movant's] witnesses are not to be believed.")). AIT did not merely "assert[] that the movant's witness[is] not to be believed." *See id.* Instead, AIT reasoned that Dr. Bederson's opinions as to Popp were questionable based on the fact that much of his testimony was identical to that of Dr. Schmidt—Salesforce's expert in a separate *ex parte* reexamination proceeding—and that Dr. Bederson could not specify how much of his report he

wrote or edited. These allegations provide specific bases for doubting the credibility of Dr. Bederson's testimony and go to the kinds of facts that *TypeRight* recognized *could* preclude summary judgment. *See* 374 F.3d at 1159 ("[S]ummary judgment is not appropriate where the opposing party offers specific facts that call into question the credibility of the [movant's] witness[]."). The district court here failed to explain why a reasonable jury was required to accept Dr. Bederson's testimony in light of AIT's allegations.

D. Claims 23–26

The district court concluded that there was no genuine issue of material fact that Popp anticipates claims 23–26 of the '482 patent because they are substantially identical to claims 14–17 of the '111 patent. *Summary Judgment Order*, 691 F. Supp. 3d at 1248.

AIT argues that the district court erred in so concluding because claims 23–26 include additional limitations—"a business content database" in claim 23 and its dependent claims and "a metadata database" in claim 25—not present in claims 14–17. AIT argues that Dr. Bederson provided no opinions as to whether Popp anticipates claims 23–26 and that his opinions as to claims 14–17 do not compel a determination of anticipation as a matter of law for claims 23–26.

Salesforce defends the district court's grant of summary judgment on the grounds that "[t]he differences in claim language are minor" and that Popp discloses "an enterprise's corporate database." Salesforce also disputes AIT's claim that Dr. Bederson did not opine that Popp anticipates claims 23–26, arguing that Salesforce filed an opposed motion to file a supplemental invalidity report including Dr. Bederson's opinions as to claims 23–26 that the district court denied as moot.

We agree with AIT that the district court erred. First, the district court failed to grant every reasonable inference in AIT's favor. The "business content database" and "metadata database" elements recited in Claims 23–26 have facially different scopes than the "business knowledge" and "metadata" elements recited in claims 14–17. Therefore, a showing that Popp anticipates the latter does not necessitate a conclusion that Popp likewise anticipates the former. Second, the anticipation inquiry is a search for strict, not substantial, identity. *See Trintec Indus.*, 295 F.3d at 1296. Here, the district court acknowledged that claims 23–26 of the '482 patent differ from claims 14–17 of the '111 patent. *Summary Judgment Order*, 691 F. Supp. 3d at 1248 ("The only differences between these two sets of claims identified by AIT are the 'business content database' (claim 23) and 'metadata database' (claims 25–26), but claims 14–17 of the '111 patent already require 'information associated with one or more predetermined business applications' (claim 14), 'business knowledge' (claim 15), and 'metadata' (claims 16–17).'"). The district court failed to explain, however, why the scope of claims 23–26 is necessarily congruent with the scope of claims 14–17.

*   *   *

For these reasons, we vacate and remand the district court's grant of summary judgment of anticipation of all asserted claims.

V. Obviousness

The district court also granted summary judgment of invalidity, concluding that all the asserted claims were obvious over the combination of Popp and Amati. This was error. The district court's obviousness determination depended in some measure on both its erroneous conclusion, discussed above, that Popp discloses each of the asserted claims' limitations as a matter of law, and on its erroneous claim construction requiring an "intelligent agent," also

discussed above, that led to its conclusion that if Popp did not disclose an "intelligent agent," Amati did, and a person of ordinary skill would have been motivated to combine the references. Further, the district court rejected AIT's evidence of commercial success and technical advantages of the accused product as objective indicia of non-obviousness given its finding of non-infringement. The district court's determination of non-infringement, however, was based on the absence of intelligent agents in the accused product, an absence that no longer leads to non-infringement in light of our holding on claim construction, *supra*.

Because the district court's grant of summary judgment of obviousness depended on its erroneous claim construction, non-infringement, and anticipation determinations, we vacate the district court's grant of summary judgment of obviousness.

VI. Fees

The district court determined that AIT's case was exceptional under 35 U.S.C. § 285 because AIT continued to litigate "after claim construction end[ed] any reasonable likelihood of prevailing on the merits." *Fee Order*, at *6. Because the district court's determination relied on an incorrect claim construction, and because we have now vacated the district court's summary judgments of non-infringement, anticipation, and obviousness, we reverse as moot the district court's finding that AIT's case was exceptional under § 285.

Additionally, "[w]hether or not a district court ultimately finds a case exceptional on motion for attorney fees, it is important that the court provide some indication of the reasoning underlying its decision to provide a basis for meaningful review." *Superior Fireplace*, 270 F.3d at 1377. The district court, however, failed to explain why its claim construction order ended any reasonable likelihood of AIT succeeding on the merits. Specifically, the district court did not articulate whether its claim construction order

prevented AIT from proving infringement, avoiding invalidity, or both. Because infringement and invalidity cannot be assessed by looking to the claims alone, the district court needed to specify how its claim construction order prevented AIT from prevailing on the merits in view of the nature of the accused product or Salesforce's proffered prior art references.

The district court's assessment of the reasonableness of Salesforce's attorneys' fees was similarly threadbare. The district court simply concluded that "Salesforce is entitled to the $6,890,328.28 incurred after the Court's Claim Construction Order" because "Salesforce has satisfied its burden under the Court's Local Rules to provide a 'reasonable itemization and description of the work performed,' and the Court finds that the requested amount is reasonable considering the context of the case and the substantial amount in dispute." *Fee Order*, at *6. But the district court provided no explanation as to why it held Salesforce's attorneys' fees to be reasonable, even though the narratives for *all* of Salesforce's time entries were redacted.

Should the district court encounter these questions again on remand, consistent with our discussion above, the district court should articulate the factual findings underpinning its assessment of exceptionality and explain its rationale as to why the fees awarded are reasonable.

CONCLUSION

For the foregoing reasons, we modify the district court's claim construction; reverse the district court's exceptional case determination; vacate the district court's grants of summary judgment of non-infringement, anticipation, and obviousness; and remand for further proceedings consistent with this opinion. Because "denials of summary judgment are ordinarily not appealable," *M. Eagles Tool Warehouse, Inc. v. Fisher Tooling Co.*, 439 F.3d 1335, 1344 (Fed. Cir. 2006), we do not address AIT's

passing arguments that the district court erred by denying summary judgment of no anticipation.

REVERSED-IN-PART, VACATED-IN-PART, AND REMANDED

COSTS

Costs are awarded to AIT.