Reversing in part a district court summary judgment of non-infringement for two asserted patents, the court determined that the claim construction of a term in one patent was overly narrow because it added a limitation to a “caching” step in a process for identifying, storing and using network distribution information for related packets in a network protocol message. For the second patent, however, the district court correctly determined that the preamble term “forwarding device” limited the scope of the claims at issue.

StorageTek owns two patents for network packet distribution technology. Its U.S. Pat. No. 5,842,040 covers a method and apparatus to determine the network distribution rules, or “policy” applicable to a set of related packets traveling through a communication device, such as the packets that might comprise an email message. Upon determining the applicable network policy, the method of claim 1 specifies storing or “caching” an identifier for the network policy. The disputed issue for infringement is whether the claim construction should also require that the network policy information itself be cached.

StorageTek asserted the ’040 patent against Cisco, who successfully argued before the district court that the claim 1 preamble term “policy caching method” limited the claim. The limitation required the accused infringing device to additionally cache the network policy information separately and in addition to caching the identifying information.

The court disagreed for a number of reasons.

The claim does not include any step relating to caching the . . . network policy or any limitation indicating that the . . . network policy is stored in or retrieved from a cache. According to its plain language, the limitation construed by the district court, “caching policy identification information,” requires only the identification information . . . to be cached.

The preamble term merely referred to the invention as a whole. Each claim used it consistently to label the invention. While Figure 1 shows two caches, other Figures did not. StorageTek made prosecution history statements that arguably supported Cisco’s position, but the court would not allow these to be used to override clear claim language.

While on its face this statement appears to limit claim scope, it cannot do so absent some claim language referring to the caching of the . . . network policy. The prosecution history statement describes generally the features of the claimed invention and erroneously suggests that the independent claims include a cache for the . . . network policy. The applicants’ inaccurate statement cannot override the claim language itself, which controls the bounds of the claim.

StorageTek’s other patent, U.S. Pat. No. 5,566,170, intercepts the network packet in a first processor before it enters the communications device, which has a second processor. It modifies the packet header in the first processor to add “next operation information” to the header. The second processor uses this additional information to distribute the packet. The disputed issue was whether the preamble claim term “forwarding device” should be taken to mean that both processors must be in a single device, or, whether they can be distributed along the network. The court agreed with the district court’s analysis that the term was limiting because, among other reasons, StorageTek effectively distinguished its invention from the prior art saying that in its invention both operations occur in one device.