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INFRINGEMENT VERDICT ON PATENT FOR ALLEVIATING INTERNET CONGESTION UPHELD IN PART, REVERSED IN PART

Massachusetts Institute of Technology (MIT) obtained US Patent, 6,108,703 for a "global hosting system." The patent included methods for decreasing congestion and delay in accessing web pages on the Internet. As claimed by the patent, a Web page content delivery system is provided that uses separate sets of services to provide various aspects of a single web page. The patent was exclusively licensed to Akamai Technologies.

Following a jury trial, it was determined that Cable & Wireless ("C&W") had infringed four of the apparatus claims and three of the method claims. The jury also upheld the validity of the apparatus claims but invalidated the method claims under 35 U.S.C. §§ 102 and 103(a). C&W then filed a motion for judgment as a matter of law asserting that claims 1, 3, 5, and 9 were invalid and/or not infringed. The District Court of Massachusetts denied that motion and issued an injunction enjoining C&W from making, using, selling, offering for sale, or importing into the United States inventions covered by the patent.

C&W appealed the order denying its motion for judgment as a matter of law and further appealed the grant of a permanent injunction based upon the jury verdict. [Akamai Technologies, Inc. v. Cable & Wireless Internet Services, Inc., 2003 U.S. App. LEXIS 19065 (Fed. Cir. 2003).]

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The Federal Circuit initially noted that, “with regard to factual findings, we must presume that the jury resolved all factual disputes in favor of the prevailing party, and we must leave those findings undisturbed as long as they are supported by substantial evidence.” The court noted, however, that the factual question of whether there is infringement is contingent on the proper claim construction, which is a question of law that is reviewed de novo.

#### Anticipation Claims 1 and 3

In assessing anticipation, the first issue was whether, in the construction of claims 1 and 3, the presence of load balancing software at the DNS servers is required. Akamai argued that the prior art 6,185,598 patent differed from the claims in the asserted '703 patent in the placement of the load balancing software. C&W argued that claims 1 and 3 did not include a load balancing limitation. The court agreed with C&W and concluded that claims 1 and 3 did not include a load balancing limitation even though the written description contemplated a preferred location for load balancing software.

The only remaining issue was whether “identified by the modified embedded object URL” in the claim included load balancing. This question turned on whether “the written description or prosecution history unequivocally showed that the inventors imparted a novel meaning to the term ‘identifying’ to include load balancing.” After reviewing the specification and noting that the parties did not identify anything in the prosecution history relevant to “identifying,” the court concluded that “identifying” did not include load balancing. Therefore, claim 1 did not “include the limitation of the placement of the load balancing mechanism.”

#### Obviousness Claims 5 and 9

C&W next claimed that it was entitled to judgment as a matter of law because the '703 patent was obvious in view of the '598 patent and the prior art product information for the Cisco's Distributed Director product.



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The court reviewed the determination of obviousness de novo. "A claimed invention is unpatentable due to obviousness if the differences between it and the prior art 'are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.'" After reviewing the evidence presented to the jury, the court was not persuaded that no reasonable jury could have found claims 5 and 9 nonobvious over the prior art. For that reason, the court declined to disturb the factual findings of the jury.

The court held that claims 1 and 3 of the '798 patent were anticipated by the cited '598 patent and therefore invalid under 35 U.S.C. § 102. Thus, the case was remanded to the district court for modification of the permanent injunction in view of this holding. However, the permanent injunction with respect to claims 5 and 9 was upheld.