

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, DC

In the Matter of

**CERTAIN AUTOMATED TELLER
MACHINES, ATM MODULES,
COMPONENTS THEREOF, AND
PRODUCTS CONTAINING THE SAME**

Inv. No. 337-TA-972

COMMISSION CLAIM CONSTRUCTION OPINION

I. INTRODUCTION

The Commission instituted this investigation on November 20, 2015, based on a complaint filed by Diebold Incorporated and Diebold Self-Service Systems (collectively, “Diebold”). 80 *Fed. Reg.* 72735-36 (Nov. 20, 2015). The complaint alleged violations of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337, in the importation into the United States, the sale for importation, and the sale within the United States after importation of certain automated teller machines, ATM modules, components thereof, and products containing the same by reason of infringement of certain claims of six United States Patents: 7,121,461 (“the ’461 patent”); 7,249,761 (“the ’761 patent”); 7,314,163 (“the ’163 patent”); 6,082,616 (“the ’616 patent”); 7,229,010 (“the ’010 patent”); and 7,832,631 (“the ’631 patent”). *Id.* The notice of investigation named as respondents Nautilus Hyosung Inc. of Seoul, Republic of Korea; Nautilus Hyosung America Inc. of Irving, Texas; and HS Global, Inc. of Brea, California (collectively, “Nautilus”). *Id.* at 72736. The Office of Unfair Import Investigations was not named as a party. *Id.*

The ’461 patent, the ’761 patent, and the ’163 patent were previously terminated from the investigation. *See* Order No. 12 (Apr. 28, 2016), *not reviewed*, Notice (May 11, 2016); Order

No. 21 (June 28, 2016), *not reviewed*, Notice (July 28, 2016). The presiding administrative law judge (“ALJ”) conducted an evidentiary hearing from August 29, 2016, through September 1, 2016. On November 30, 2016, the ALJ issued the final Initial Determination (“final ID” or “ID”). The final ID found a violation of section 337 with respect to the ’616 and ’631 patents, and no violation with respect to the ’010 patent. ID at 207-09. The ALJ recommended that a limited exclusion order and cease and desist orders issue against Nautilus.

Nautilus and Diebold each filed a petition for review of the ID.¹ Their petitions included, *inter alia*, arguments concerning claim construction for the ’616 patent. In particular, Diebold petitioned for review of the construction of “service opening.” Diebold Pet. 4. Nautilus filed a contingent petition asking that, if the construction of “service opening” were reviewed by the Commission, the Commission also review the construction of “second position.” Nautilus Pet. 33. On January 30, 2017, the Commission determined to review the ID in part, including as to these two claim constructions for the ’616 patent. This Opinion sets forth the Commission’s reasoning in support of its claim construction determinations for the ’616 patent.

II. BACKGROUND

Independent claims 1, 26, and 27 are asserted. In addition, asserted claims 5-8, 10, and 16, are dependent upon claim 1. The limitations of those dependent claims are not at issue. The invention and asserted claims all concern the “service opening” on an automated teller machine (“ATM”). Independent claim 1 is representative of the asserted claims. It reads in its entirety as follows, with claims terms at issue italicized:

1. An automated banking machine apparatus comprising:

¹ Compl’ts Pet. for Rev. and Contingent Pet. for Rev. of the Final Initial Determination (Dec. 12, 2016) (“Diebold Pet.”); Resp’ts Pet. for Rev. of Initial Determination on Violation of Section 337 (Dec. 13, 2016) (“Nautilus Pet.”).

a housing bounding an interior area, the housing having a first opening to the interior area;

a rollout tray movably supported on the housing, the rollout tray including a wall portion, *a service opening* extending through the wall portion, wherein the rollout tray is movable between a first position wherein the tray extends outward from the first opening and the service opening is accessible from outside the housing, and *a second position wherein* the tray is within the interior area and *the service opening is not accessible from outside the housing*;

a first serviceable component mounted in supporting connection with the tray and overlying the service opening, the serviceable component having a service point, and wherein the service point is accessible from outside the housing by extending a tool upwardly through the service opening when the tray is in the first position.

The ALJ's claim constructions were originally set forth in the *Markman* Order, Order No. 17 (June 13, 2016). That order construed two limitations of the '616 patent (and no limitations of the other asserted patents). In pertinent part, the ALJ construed the term "service opening" to mean "an opening through which serviceable components are accessible for servicing."² Order No. 17 at 23. This was Diebold's proposed construction. *Id.* at 14. Nautilus had argued for broader construction: "an opening through which serviceable components are more readily accessed for servicing." *Id.* The ALJ rejected that proposed construction as ambiguous. *Id.* at 15.

Subsequent to the *Markman* Order, Nautilus moved for summary determination that Diebold failed to satisfy the technical prong of the domestic industry requirement. In denying that motion in a non-ID order, the ALJ construed the claim language "a second position wherein the tray is within the interior area and the service opening is not accessible from outside the housing." Order No. 24 at 7 (Aug. 23, 2016). In particular, the ALJ explained that the "claims

² The other construction was "in supporting connection" in claims 1, 6, 7, 10, 26, and 27. The ALJ construed that term to mean "connected to and supported by," and she noted that the "connection may be direct or indirect." Order No. 17 at 23. That construction is not at issue.

do not require that the service opening be ‘only’ accessible in the first position or ‘never’ accessible in the second position.” *Id.* at 8.

In that same order, the ALJ provided further explanation for the construction of “service opening.” At issue in Order No. 24 was what the claims mean when they recite “the service opening” being “accessible” in the first position, and “not accessible” in the second position. Order No. 24 sought to answer whether such language means that the opening is itself accessible or whether the components inside are accessible. In Order No. 24, and as urged by Diebold, the ALJ adopted the former interpretation regarding accessibility of the opening. Order No. 24 explained that in the earlier claim construction filings, “there was no dispute that the service opening was tied to accessibility for servicing.” *Id.* That order continues:

If the service opening is defined by allowing access for servicing, then the claim language “service opening is accessible” implies that the opening is accessible for servicing. And when the “service opening is not accessible,” it is not accessible for servicing. This is confirmed by the additional claim language regarding the “service point,” which uses the term “accessible” in the context of servicing Nautilus argues that this service point limitation only defines “accessible” with respect to the first position of the rollout tray . . . , but claim terms are normally used consistently throughout the patent. . . . The “accessible” and “not accessible” limitations should therefore be read to consistently refer to accessibility for servicing.

Order No. 24 at 8-9 (citations omitted). Order No. 24 noted that different parts of the specification supported Diebold and Nautilus. *Id.* at 9-11. Nonetheless, Order No. 24 found that Diebold’s proposed construction “most naturally aligns with the patent’s description of the invention.” *Id.* at 11. Accordingly, “[w]hen properly construed, the service opening ‘is not accessible’ when it is not accessible for servicing, and there is no requirement that it be ‘never accessible’ in the second position.” *Id.* Based on this construction, Order No. 24 rejected Nautilus’s argument that Diebold’s domestic industry products fail to practice the asserted

claims. *Id.*; *see also id.* at 5 (noting that there “is no serious dispute about the operation of the” Diebold domestic industry articles).

The ALJ continued further to expand upon these claim constructions in the final ID. In particular, it can be recalled that Order No. 17 (and then Order No. 24) defined “service opening” as including an “accessible for servicing” requirement. In connection with the hearing and thus the final ID, Nautilus argued that its products were not “accessible for servicing” because, Nautilus alleged, “the purpose of the openings in the accused products is not ‘for servicing,’” and that to practice the asserted claims there must be “real” or “meaningful” service. Final ID at 16-17. The final ID explained:

There is no evidence for a construction that considers the intent of the designer, as suggested by Nautilus, but there is support for a limitation requiring that servicing of serviceable components is “enabled” by the service opening. . . . This limitation is not clearly embodied in the construction for “service opening” adopted in the *Markman* Order, where I observed that “[t]he specification repeatedly describes the ‘service opening’ in terms of allowing access to the serviceable component.” Order No. 17 at 16. Instead of using the term “allow,” however, the specification repeatedly uses the term “enable” in the context of the service opening. . . . In the examples of service for the keypad and the image adjusting knobs in the preferred embodiment, the service opening enables access to these two components that are not accessible through other means.

Final ID at 20.³

³ The Commission notes that, by accepting the parties’ invitations to define the meaning of “accessible for servicing” in the claim construction, the final ID may have inappropriately treated an issue of infringement analysis as one of claim construction. *See, e.g., Tessera, Inc. v. ITC*, 646 F.3d 1357, 1364 (Fed. Cir. 2011) (“Tessera’s contention at best is a disagreement over the Commission’s *application* of Tessera’s construction to the accused wBGA devices.”) (emphasis in original); *Versata Software, Inc. v. SAP Am., Inc.*, 717 F.3d 1255, 1262 (Fed. Cir. 2013) (“Whether ‘computer instructions’ can include source code thus becomes a pure factual question.”); *PPG Indus. v. Guardian Indus. Corp.*, 156 F.3d 1351, 1355 (Fed. Cir. 1998) (“[A]fter the court has defined the claim with whatever specificity and precision is warranted by the language of the claim and the evidence bearing on the proper construction, the task of determining whether the construed claim reads on the accused product is for the finder of fact.”).

The final ID also found the prosecution history helpful toward a conclusion “that the claimed service opening must enable access to serviceable components.” ID at 21-22. The ID explains as follows:

... Requiring that the service opening enable access to serviceable components is further consistent with the expert testimony requiring that the claimed service be “meaningful, real service.” Tr. (Kurfess) at 279:11-24. Service that is conducted through an opening is not meaningful if there is no need to use the opening.

Accordingly, the intrinsic evidence supports a modification of the construction for “service opening” as an opening through which serviceable components are accessible for servicing, where the opening enables access to the serviceable component.

ID at 23. Thus, the final ID’s construction of “service opening” is “an opening through which serviceable components are accessible for servicing, where the opening enables access to the serviceable component.” *Id.*

III. ANALYSIS

We find the claim constructions on review to be both more complicated, and less clear, than the claim terms themselves. Instead of focusing on interpreting the claim language, the parties invited the ALJ to construe the constructions, and then to construe the constructions of the constructions. Doing so caused the constructions to lose sight of the claim language itself.

Claim construction “begin[s] with and remain[s] centered on the language of the claims themselves.” *Storage Tech. Corp. v. Cisco Sys., Inc.*, 329 F.3d 823, 830 (Fed. Cir. 2003); *see also Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc). The language used in a claim bears a “heavy presumption” that it has the ordinary and customary meaning that would be attributed to the words used by persons skilled in the relevant art. *Id.* at 1312-13. Moreover, the language is read in the context of the entire patent, including the specification. *Id.* at 1313-14. To help inform the court of the ordinary meaning of the words, a court may consult

the intrinsic evidence, including the claims themselves, the specification, and the prosecution history, as well as extrinsic evidence, such as dictionaries and treatises and inventor and expert testimony. *Id.* at 1314. Extrinsic evidence is “less reliable” and “less significant than the intrinsic record in determining the legally operative meaning of claim language.” *Id.* at 1317 (quotations omitted).

“There are only two exceptions to this general rule” that the claims are “given their ordinary and customary meaning as understood by a person of ordinary skill in the art when read in the context of the specification and prosecution history.” *Thorner v. Sony Computer Entm’t Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012). Those exceptions are “(1) when a patentee sets out a definition and acts as his own lexicographer, or 2) when the patentee disavows the full scope of a claim term either in the specification or during prosecution.” *Id.* “To act as its own lexicographer, a patentee must clearly set forth a definition of the disputed claim term other than its plain and ordinary meaning. It is not enough for a patentee to simply disclose a single embodiment or use a word in the same manner in all embodiments, the patentee must clearly express an intent to redefine the term.” *Id.* (quotations and citations omitted). “The standard for disavowal of claim scope is similarly exacting,” requiring “expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope” that is a “clear and unmistakable disclaimer.” *Id.* at 1366-67 (quotations and citations omitted). “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.” *Id.* at 1366. “It is likewise not enough that the only embodiments, or all of the embodiments, contain a particular limitation.” *Id.*

The term “service opening” consists of two simple English words. Neither party asserts that there is a special meaning in the art,⁴ and the Commission finds based on the record of the investigation that there is no such special meaning. As *Phillips* explains, “claim construction in such cases involves little more than the application of the widely accepted meaning of commonly understood words.” *Phillips*, 415 F.3d at 1314. As discussed above, in Order No. 17, the ALJ construed “service opening” as “an opening through which serviceable components are *accessible for servicing*.” Order No. 17 at 23 (emphasis added). Further disputes before the ALJ involved the meaning of “accessible for servicing,” a term in the construction, not in the claim limitation itself.

The Commission finds that “service opening” should receive its plain and ordinary meaning, which the Commission finds to be: “an opening through which a component may be serviced.” The specification uses the term “service opening” approximately twenty times. ’616 Abstract; col. 2 lines 13-32; col. 2 line 65; col. 4 lines 13-17; col. 4 lines 37-45; col. 4 line 66 – col. 5 line 3; col. 5 lines 21-32; col. 5 lines 38-56. None of these uses modifies the plain meaning of the terms, much less rises to the level of lexicography. Rather, all uses consistently refer to the service opening as an opening through which a component may be serviced.

We read the specification differently than did the ALJ. The last element of claim 1 calls for a “serviceable component having a service point, and wherein the service point is accessible from outside the housing by extending a tool upwardly through the service opening when the tray is in the first position.” Col. 8 lines 22-25. Order No. 24 finds that the patent’s discussion of the accessibility of service points means that a construction of “service opening” should have an “accessibility” requirement as to the service points. *See* Order No. 24 at 8-9. However, when the applicants wished to talk about accessibility to components inside the opening, they knew exactly

⁴ *See, e.g.,* Compl’ts’ Initial *Markman* Br. 27-29 (Apr. 1, 2016); Resp’ts’ Initial *Markman* Br. 5-8 (Apr. 1, 2016).

how to claim that, which they did in limitations concerning the “serviceable component” and the “service point.” *See, e.g.*, claim 1 (col. 8 lines 19-25); claim 26 (col. 11 lines 15-19); claim 27 (col. 11 lines 25-39). As noted in Order No. 24, some passages of the specification discuss the opening itself and other passages discuss accessing the service points inside. Order No. 24 at 8-12. To the extent that the specification discusses access to the service point for service, however, those passages are more fairly read to discuss what is encompassed in the claimed “serviceable component” and “service point” limitations, and not the service opening itself.

Nor was there disavowal of claim scope in the prosecution history. As discussed in Order No. 17 at pages 8-13, there was one office action during prosecution, and the applicant amended the claims, *inter alia*, to clarify that tools are inserted through the service opening, to distinguish prior art in which the components themselves (via tabs and screws) are mounted into the service opening. Order No. 17 at 10-11. Our construction above is fully consistent with the prosecution history. Further, in reviewing the prosecution history, the final ID states: “Service that is conducted through an opening is not meaningful if there is no need to use the opening.” Final ID at 23. To the extent the final ID finds, based on the prosecution history, that the service opening must provide the exclusive way to service the components, *see id.* at 20-23, we disagree with that requirement. There is nothing in the file history regarding exclusive access, much less an expression of manifest exclusion or restriction concerning such exclusive access.

In view of our determination to review the construction of “service opening,” we have also determined to review the construction of “a second position wherein . . . the service opening is not accessible from outside the housing.” The Commission finds this claim language to be clear and that construction is unnecessary. The claim language expressly states that “the service *opening* is not accessible from outside the housing” in the second position; it does not state that the “service

point” is not accessible from outside the housing in the second position. As discussed earlier, the applicants understood how to claim the accessibility of the service point, rather than the service opening, and did so for the last element of claim 1. There is no statement of lexicography to the contrary. Nor are all of the preferred embodiments read out of the claim when it is construed to mean what it says. In particular, the patent specification explains that in a preferred embodiment, upper wall **28** on chest **2**, *see* Figs. 1 & 8, completely blocks access to the opening for tamper resistance. Col. 5 lines 52-58. Other portions of the patent specification are in accord. Col. 4 line 62 – col. 5 line 3; col. 2 lines 26-32; *see also* Nautilus Pet. 34-35. Thus, the plain language of the claims comports with the specification. Nor is there a statement of disavowal in the prosecution history, which, as noted above, dealt with inserting a tool through the opening, and not the accessibility of the service opening in the second position.

We are not persuaded by the reliance in Order No. 24 on Figure 10 of the '616 patent, discussed at column 6 line 14 to column 7 line 39. That second preferred embodiment includes a rear opening **108** (accessed through rear door **110**) and a side door **130**. Order No. 24 assumes that these added doors might permit access to the service opening even when the rollout tray is closed, but that the service points therein would remain inaccessible. Order No. 24 at 10. But as acknowledged in that order, the patent does not actually state this, *id.*, and we find no reason to infer such a structural requirement from the specification. In particular, the patent explains that the side opening enables access to “the area of the card reader where captured cards are held” so that a serviceperson can remove the captured cards and retracted receipts. Col. 6 line 62 - col. 7 line 6. It need not provide access to the service opening. Thus, the claim language is not expressly or inherently incompatible with the Figure 10 embodiment. Moreover, to the extent that the side opening shown in Figure 10 provides an alternate route for accessing the service opening, that does

not mean that the claims must be construed so that the Figure 10 embodiment falls within the scope of the patent claims. While claim constructions that read out all embodiments are disfavored, there is no requirement that a claim be broad enough to encompass all preferred embodiments. *See, e.g., Helmsderfer v. Bobrick Washroom Equip., Inc.*, 527 F.3d 1379, 1383 (Fed. Cir. 2008).

For the foregoing reasons, we construe “service opening” to be afforded its plain and ordinary meaning, namely, “an opening through which a component may be serviced.” The Commission further finds that “a second position wherein . . . the service opening is not accessible from outside the housing” is to be afforded its plain and ordinary meaning, and should not be construed to mean that the “service *point* is not accessible.”

By order of the Commission.



Lisa R. Barton
Secretary to the Commission

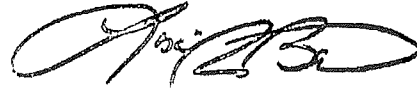
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**CERTAIN AUTOMATED TELLER MACHINES, ATM
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Inv. No. 337-TA-972

PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **OPINION** has been served by hand upon the following parties as indicated, on January 30, 2017



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