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Federal Circuit Affirms PTAB Claim Construction

On February 10, 2014, the Federal Circuit issued an important ruling on how patent claims are to be construed by the PTAB. The Court emphasized that its general rule that the evidence in the patent and the patent application proceedings (intrinsic evidence) outweighs other evidence (extrinsic evidence) applies not only to district court claim constructions but also to the Patent and Trademark Office (PTO). Here, the examiner's dictionary-based claim interpretation violated that canon because it conflicted with the prosecution history. *Tempo Lighting, Inc. v. Tivoli, LLC*.¹

¹ *Tempo Lighting, Inc. v. Tivoli, LLC*, ---F.3d ---, 2014 WL 503128 (Fed. Cir. Feb. 10, 2014) (appeal no. 2013-1140).

Background: Reexamination Incident to Infringement Litigation

Tivoli sued Tempo for patent infringement. Tempo responded by seeking an *inter partes* reexamination at the PTO. The patent claims specified a lighting apparatus for mounting on a stair step, where the apparatus includes “a material *inert to light*.” Declaring the claims unpatentable, the examiner used a dictionary to construe this phrase as calling for a material that does not react by degrading when exposed to light or which includes some additive or treatment that inhibits degradation from light exposure. The PTO Board reversed the examiner and rejected the dictionary definition because Tivoli, the patent owner, had defined this phrase in an amendment during the original patent application proceedings and because the examiner's original construction was inconsistent with the specification of the patent.² Before the patent issued, Tivoli in responding to a rejection changed the claim language to introduce the *inert to light* feature as a positive recitation which, Tivoli explained, “indicat[ed] that the material ... is non-photoluminescent and not activated to glow by absorbing ambient light.”³ The Board saw that prosecution statement as providing the broadest reasonable interpretation in light of the specification of the patent. However, the Board then relied on the

examiner's finding that each primary prior art reference was deficient as to the "inert to light" feature.⁴

² *Slip op.* at 7.

³ *Id.* at 4.

⁴ *Id.* at 2, 4, 6.

Federal Circuit Rejects Extrinsic Evidence Inconsistent With Intrinsic Evidence

The Court of Appeals sustained the Board ruling on claim interpretation, rejecting the dictionary definition for several reasons. The court stressed the primacy of intrinsic evidence:

In claim construction, this court gives primacy to the language of the claims, followed by the specification. Additionally, the prosecution history, while not literally within the patent document, serves as intrinsic evidence for purposes of claim construction. This remains true in construing patent claims before the PTO.⁵

The examiner's construction voiced "multiple limitations that lack support in any form of intrinsic evidence." The intrinsic evidence did not refer to additives or material degrading, as the examiner posited. While the extrinsic evidence (the dictionary) is not irrelevant, the examiner erred by using extrinsic evidence that was inconsistent with the intrinsic evidence, which is more reliable.⁶

⁵ *Id.* at 6.

⁶ Ultimately, the Court reversed the Board. Though it used the correct claim interpretation, it erred by relying on factual findings that rested on the wrong claim construction.

What This Means To You

The America Invents Act is changing the profile of patent litigation by providing fast track review of certain patent validity issues before the Patent Trial and Appeal Board (the new name of the PTO Board). More and more accused infringers are turning to the PTAB to review patent validity questions despite the newness of the "*inter partes* review" procedure and the current uncertainty of how the cases will be decided. This ruling establishes that the evidentiary standards for claim construction will remain the same for the PTAB as for other litigation and gives more certainty to all PTO litigants on how to argue claim construction.

Contact Us

If you have questions about this or other legal issues, please contact your Husch Blackwell attorney.