

Claim Construction During Reexamination with Parallel District Court Proceedings

In re Suitco Surface Inc.
94 USPQ2d 1640 (Fed. Cir. 2010)

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BACKGROUND

During the course of infringement litigation, 3M filed an *ex parte* reexamination request in 2004, citing three prior art references not previously on record. The district court stayed the case after the request for reexamination had been granted. The PTO rejected Suitco's claims as being anticipated (lacking novelty). On appeal, the Board of Appeals affirmed the examiner's rejection, construing the claims so as to read on (i.e., encompass) the prior art. On appeal to the Federal Circuit, the court found that the PTO's rejection was based on an unreasonable construction of claim terms, vacated the decision of the Board of Appeals affirming the examiner's rejection, and remanded the case back to the USPTO.

MPEP 2111 STANDARD FOR CLAIM CONSTRUCTION DURING PROSECUTION

- During patent examination, the pending claims are "given their **broadest reasonable interpretation consistent with the specification.**"
- More particularly, the PTO determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "**in light of the specification as it would be interpreted by one of ordinary skill in the art.**"

- **Applicant always has the opportunity to amend the claims during prosecution**, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified.
- **PTO is not required to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit.**

Example 1:

The Board's construction of the claim limitation "restore hair growth" as requiring the hair to be returned to its original state was held to be an incorrect interpretation of the limitation. The court held that, consistent with applicant's disclosure to require only some increase in hair growth, one of ordinary skill would construe "restore hair growth" to mean that the claimed method increases the amount of hair grown on the scalp, but does not necessarily produce a full head of hair.

Example 2:

1. A separator, comprising a flexible nonwoven *having a porous inorganic coating on and in said nonwoven*, and wherein the material of said nonwoven is selected from nonwoven, non-electroconductive polymeric fibers, and wherein said nonwoven has a thickness of less than 30 μm , a porosity of more than 50% and a pore radius distribution, in which at least 50% of the pores have a pore radius from 75 to 150 μm .

On appeal of the examiner's rejection, the Board found that the language "inorganic coating," given its broadest reasonable interpretation necessarily means that the coating must be entirely "inorganic." The Board found no basis in the language of the appealed claims or in the specification to interpret this term as including "organic" ingredients.

U.S. Patent 4,944,514

The '514 patent relates to a "floor finishing material" for use on basketball courts, bowling lanes and other floor surfaces made of wood, linoleum, etc. The invention is essentially a thin plastic sheet placed over a floor surface connected by an adhesive layer.

4. On a floor having a flat top surface and an improved material for finishing the top surface of the floor, the improvement comprising:

at least one elongated sheet including a uniform flexible film of clear plastic material having a thickness between about one mil and about twenty-five mils and

a continuous layer of adhesive material disposed between the top surface of the floor and the flexible film, the adhesive layer releasably adhering the flexible film onto the top surface of the floor.

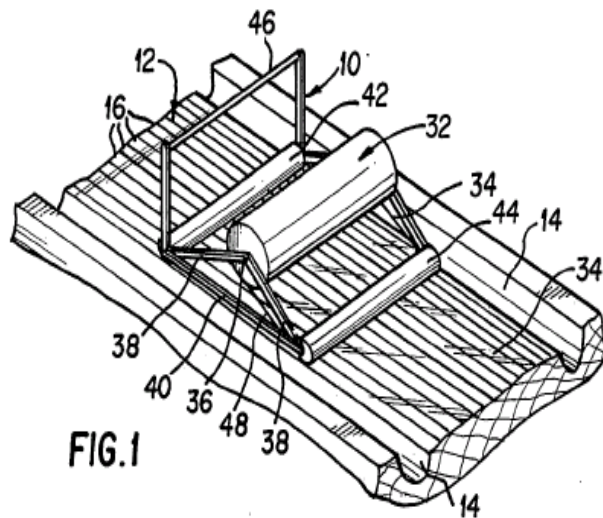


FIG. 1 shows a bowling lane with a thin sheet 34 of a clear adhesive backed finish material being applied to the lane surface from a roll 32 of the material in an applicator process.

PRIOR ART APPLIED IN REEXAMINATION

U.S. Patent 3,785,102 to Amos
U.S. Patent 4,453,765 to Barrett

Claim 4 Anticipated by Amos:

Amos discloses a floor-covering pad comprised of a plurality of plastic sheets connected together by a plurality of adhesive layers. It is designed to be used right before entry into a clean room or hospital bay to remove any dirt from the shoes or wheels of incoming traffic. The pad 15 consists of a plurality of plastic sheets 16 with acrylic latex adhesive layers 17 above and below each of them. The adhesive layer beneath the lowermost plastic sheet releasably attaches the sheet, along with the rest of the pad, to the top surface of the floor. Over time, once the top layer fills with dirt, the next plastic sheet can be peeled off to expose a new adhesive layer. The plastic sheets are made of polyethylene or polypropylene which may be transparent and between 0.0002 to 0.0003 inches in thickness.

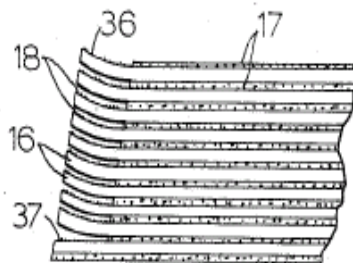
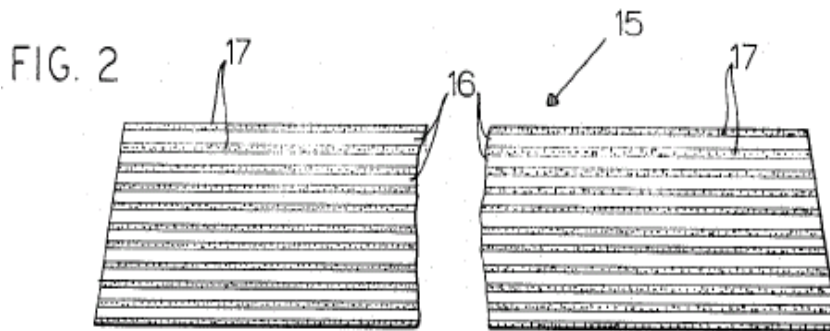


FIG. 4

Claim 4 Anticipated by Barrett:

Barrett discloses the use of a clear plastic film connected to a floor with an adhesive layer. Barrett's cover sheet temporarily protects a floor during construction. The sheet is removed whenever the building or room

APPEAL TO THE FEDERAL CIRCUIT

Suitco appealed the Board's decision to the Federal Circuit, challenging the Board's construction for the "material for finishing the top surface of the floor" and contending that no cited prior art reference taught the "uniform" limitation.

DECISION OF THE FEDERAL CIRCUIT

Limitation of "material for finishing the top surface of the floor"

- During reexamination, as with original examination, the PTO must give claims their broadest reasonable construction consistent with the specification. The Federal Circuit therefore reviews the PTO's interpretation of the disputed claim language to determine whether it is "reasonable."
- The express language of the claims requires a "material for *finishing* the top surface of the floor." A material cannot be finishing any surface unless it is the final layer on that surface. Otherwise, the material would not be "finishing" the surface in any meaningful sense of the word.
- The PTO's construction (noting that the claims use the open-ended term "comprising") ignores the express claim language by allowing the finishing material to fall anywhere above the surface being finished regardless of whether it actually "finishes" the surface.
- The PTO construction is unreasonably broad. In this regard, the express language of the claim and the specification require the finishing material to be the top and final layer on the surface being finished. It is not any intermediate, temporary, or transitional layer.

Because the court found that the PTO based its rejection on an unreasonable construction, the court remanded (to the PTO), with instructions to conduct a new patentability analysis using the appropriate construction.

My Comment:

- The Board had it correct. The claims are open-ended. As long as the plastic sheet is disposed on the top surface of the floor via an adhesive layer, there is nothing in the claim which precludes placing carpet or wood over the plastic sheet (or under for that matter). This is not an instance where the claim overrules the open-ended language “comprises” by reciting that the plastic sheet is an uppermost sheet) or perhaps even a “finishing sheet”).
- The language “improved material *for finishing the top surface of the floor*” is an intended use, and the claim is met by any material that is capable of finishing the top surface (independent of whether or not the plastic sheet is the uppermost layer).
- It was reasonable for the examiner to require Suitco to amend its claims during reexamination to explicitly recite that the plastic sheet is the uppermost layer or surface, if that is what Suitco was arguing as distinguishing over the prior art.
- Suitco most surely did not want to do that because (i) if the claims are amended during reexamination, damages do not accrue for infringing activities which occurred prior to grant of a reexamination certificate, where such activity did not infringe a claim of the reexamined patent that was in the original patent (intervening rights), (ii) the patent expired in 2007.

2. Limitation of “uniform flexible film”

While Amos and Barrett do not expressly use the work “uniform,” each discloses the claim element in question.

Amos teaches the use of “very thin” plastic sheets being from 0.002 to 0.003 inches in thickness.

Despite Suitco’s contention that Amos teaches a “thickness variation of 50%,” a more reasonable interpretation is that the plastic sheets can be anywhere between 2 or 3 mils – not that there is any thickness variation therein. The court then noted that Amos discusses a preferred

embodiment where the bottom plastic sheet is 4 mils without reference to any thickness variation. The court also noted that Barrett teaches a “four mil low density polyethylene film” can be used.

Based thereon, the court held that substantial evidence supports the Board’s findings (i.e., the court agreed with the Board that the prior art disclosed the “uniform” limitation).

My Comment:

- Unless the specification defines “uniform,” the tendency of the PTO is to assert that any prior art flexible film is uniform to at least some extent and therefore meets subject limitation (i.e., broadest, reasonable interpretation).
- In the context of litigation, words in a claim are given their plain, ordinary and accustomed meaning (being what one of ordinary skill in the art at the time of the invention would have understood the terms to mean), unless the specification *or prosecution history* provide a special, different meaning or definition.

PRIOR PROCEEDINGS

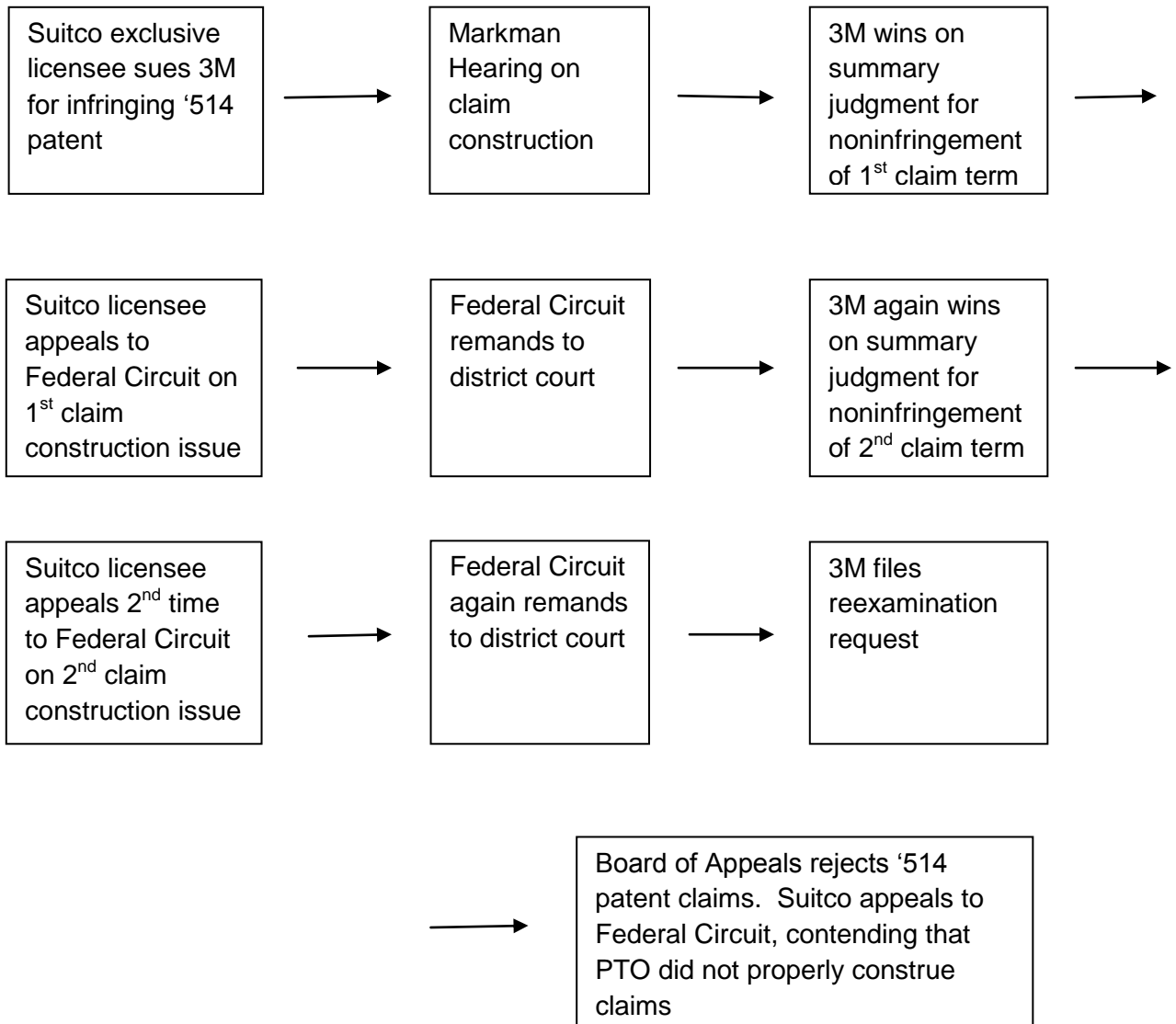
In prior proceedings, Suitco’s exclusive licensee brought suit against 3M in district court for infringement of the patent. After a Markman hearing, the district court construed the terms “material for finishing” and “uniform flexible film.” “Material for finishing” was construed to mean a “material that makes more *durable* the underlying surface of the floor, and is applied for that purpose.” “Uniform flexible film” was construed to mean “the material must be of a uniform thickness, and excludes material in which there are any variations in thickness.” The district court granted 3M’s motion for summary judgment of non-infringement based on the “material for finishing” limitation.

On appeal to the Federal Circuit, the court vacated and remanded (to the district court) finding nothing in the specification or prosecution history supporting a “durability” aspect to the asserted claims.

On remand, the district court granted 3M's motion for summary judgment of noninfringement a second time, based on the "uniform flexible film" limitation, where 3M "intentionally manufactured in a manner that results in uneven thickness throughout the film.

On appeal to the Federal Circuit (second appeal), the court again remanded (to the district court) finding that "uniform flexible film" includes a flexible film having the same thickness throughout, as well as a flexible film having the same textured surface throughout.

It is at this point that 3M filed its reexamination request.



PATENT BAR CRITISIM OF THE FEDERAL CIRCUIT DECISION

(1) The Federal Circuit failed to take into consideration the earlier Markman claim construction ruling and/or instruct what role the Markman ruling should play in the PTO during reexamination.

My Comment: Presumably, the reexamination request was granted on account of 3M presenting a “substantial new question of patentability,” which in this case involved prior art not previously considered. In a Markman hearing, the court construes the claims based on intrinsic evidence, namely, the claim language, the description in the specification and the prosecution history. If there is additional prosecution history, then the claim construction should take into account what had transpired during reexamination subsequent to the Markman ruling.

(2) The “broadest reasonable interpretation” standard is not appropriate during reexamination, because from a practical standpoint, the patent owner does not have the same freedom to amend claims.

My Comment: I tend to agree. A favored tactic of accused infringers is to request reexamination of the patent that is being asserted. Often, the court will stay infringement proceedings pending outcome of the reexamination. During reexamination, the claims are given their “broadest reasonable construction.” If the accused infringer is able to force the patent owner to substantively amend its claims during reexamination, which is not so difficult given the “broadest reasonable construction” standard, then “intervening rights” could well limit any damages to those occurring after the reexamination certificate issues. Intervening rights can be especially valuable for cutting off past damages on a patent that is nearing expiration.

(3) By taking a broader claim construction during reexamination, the PTO “whipsaws” the patent owner because the district court must follow well established claim construction canons (e.g., the claims are construed the same way for both invalidity and infringement).

My Comment: I agree that there is a difference between the way claims are construed by the PTO and the way that claims are construed by the district court. One reason is that the Markman ruling takes the

prosecution history into account which includes what transpired during reexamination. The rule “claims are construed the same way for both invalidity and infringement” is needed to prevent the patent owner from taking inconsistent positions when asserting its patent and when defending validity of the patent over prior art. That situation is not a factor during reexamination.