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The PTAB Strategies and Insights newsletter provides timely updates and insights into how best to handle proceedings at the USPTO. It is designed to increase return on investment for all stakeholders looking at the entire patent life cycle in a global portfolio.

This month we cover:

- What you need to know about the latest requests for the Supreme Court to resolve alleged Fed. Circ. intra-circuit split on claim construction law; and
- How the Federal Circuit issued a rare reversal of a PTAB final determination of obviousness because the principal reference used in the obviousness combination was not “self-enabled,” and no other record evidence cured that defect.

We welcome feedback and suggestions about this newsletter to ensure we are meeting the needs and expectations of our readers. So if you have topics you wish to see explored within an issue of the newsletter, please reach out to me.

Best,

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WHAT YOU NEED TO KNOW ABOUT THE LATEST REQUESTS FOR THE SUPREME COURT TO RESOLVE THE ALLEGED FEDERAL CIRCUIT INTRA-CIRCUIT SPLIT ON CLAIM CONSTRUCTION LAW



By: Yuke Wang and [Jason D. Eisenberg](#)

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TAKE CARE WHEN RELYING ON NON-SELF-ENABLING REFERENCES

By: [Jon E. Wright](#)

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The Intel Cert Petition

Stemming from *Continental Circuits LLC v. Intel Corporation*, 915 F. 3d 788 (Fed. Cir. 2019), Intel’s [cert petition](#) was denied on December 9, 2019. The Intel petition (“*Intel petition*,” *October 28, 2019*) asserts that the case presents a fundamental question of patent law on which the judges of the Federal Circuit are intractably divided, because some cases follow a “two-step” approach while some other cases follow an allegedly conflicting “single-step” approach. Specification of a patent affects the meaning of a claim term in different ways according to the “two-step” approach or the “single-step” approach.

The Akeva Cert Petition

Stemming from *Akeva L.L.C. v. Nike, INC.*, 817 Fed. Appx. 1005 (Fed. Cir. 2020), Akeva’s [cert petition](#) was denied on February 22, 2021. The Akeva petition (“*Akeva petition*,” *December 14, 2020*) asserts a similar intra-circuit split in claim construction cases. For cases following a “heavy presumption” of ordinary meaning principle, the specification can affect the meaning of a claim term only by meeting the “exacting” standard and demonstrating (i) a “clear” disclaimer of claim scope, or (ii) “clear” lexicography. On the other hand, for cases following a “holistic” approach, the specification can affect the claim meaning even when it does not demonstrate an “exacting” disclaimer or lexicography.

The *Akeva petition* asserts that *Nystrom v. TREX Co.*, 424 F.3d 1136, (Fed. Cir. 2005) follows the “holistic” approach and restricts a claim term - without regard to any “heavy presumption” of ordinary meaning or showing of a clear disclaimer or lexicography. The *Akeva petition* also cites to *SciMed Life Systems, Inc. v. Adv. Cardiovascular Systems, Inc.*, 242 F.3d 1337 (Fed. Cir. 2001) as an example of the “holistic” approach case when specification statements indicate limitations by “all embodiments.”

Comparing Intel and Akeva's Arguments and their definition of single v two-step claim construction

Even though worded slightly differently, the "two-step" approach in the *Intel petition* is similar to the "heavy presumption" of ordinary meaning principle in the *Akeva petition*. And the "single-step" approach in the *Intel petition* is similar to the "holistic" approach in the *Akeva petition*.

The *Intel petition* asserts that the "two-step" approach is incorrect in general, and claim constructions should follow the "single-step" approach. For example, a different result will be allegedly reached if the "single-step" approach is applied to *Continental Circuits*.

On the other hand, the *Akeva petition* asserts that the cases following the "single-step/holistic" approach are often unpredictable as to what aspect of the specification or analysis can affect the scope of the claim-at-issue. Instead, the "two-step/heavy presumption" of ordinary meaning approach should be applied. The *Akeva petition* further asserts that in deciding *Akeva*, the Federal Circuit incorrectly followed the "holistic" approach, and a different result would have been reached if the "heavy presumption" of ordinary meaning approach were to be applied.

Intel's Case for Cert

Defendant Intel asked the district court and Federal Circuit to limit disputed claim terms to a specific process, a "repeated desmear" process, used in manufacturing computer chip components. The asserted claims include phrases, such as "etching the dielectric material," "removal of a portion of the dielectric material," "a surface of a layer of a dielectric material," or other similar terms used to describe a process for manufacturing computer chip components. A general process for manufacturing computer chip components may include a single desmear process or a double desmear process. But Defendant Intel contended that each disputed phrase should be construed to include a requirement that the etching, removal, or modification of the dielectric material be "produced by a repeated desmear process," which are not the actual words of the claims.

In deciding the case, the district court used the "two-step" approach. First, the district court applied *Phillips*, that words of a claim are generally given the ordinary and customary meaning. The district court found the plain and ordinary meaning did not include the Defendants' proposed limitation. Second, the district court applied "clear and unmistakable" disavowal and found that the patent disavowed the single desmear process because various statements in the specification disparaged the "single desmear" process, the use of "present invention," the prosecution history, and extrinsic evidence.

On appeal, following the same "two-step" approach, the Federal Circuit reached an opposite decision, deciding that the disputed phrases should not be limited to be "produced by a repeated desmear process." The Federal Circuit first concluded that "at least based on the plain language, the claims are not limited to a repeated desmear process," concurring the district court's opinion at this step. Thereafter, the Federal Circuit concluded that "none of the statements relied upon by the district court rises to the level of 'a clear and unmistakable disclaimer.'" The Federal Circuit held that disparaging statements distinguishing the double desmear process as "contrary to" or "in stark contrast" with the single desmear process appear within the context of disclosures of the preferred embodiment, hence are not clear and unmistakable limiting statements. The use of "the present invention" throughout the specification does not uniformly require use of a repeated desmear process. The descriptions of "the present invention," which also appear within the discussion of the preferred embodiment, are not limiting. In other words, the Federal Circuit took into consideration not only what is said, but also where the statements are located within the specification.

The *Intel petition* asserts that the "two-step approach" and the "single-step" approach stand in stark contrast to each other, and which one to adopt often dictates the case outcome. The *Intel petition* further asserts that a different result would be reached if the "single-step" approach were applied to *Continental Circuits* based on the disparaging statements about the "single desmear" process, and the use of "present invention." The *Intel petition* further asserts that similar language in the specification can and does result in different claim constructions in "single-step" approach based cases, e.g., *Aptalis Pharmatech, Inc. v. Apotex Inc.*, 718 F. Appx. 965 (Fed. Cir. 2018).

Akeva's case for Cert

The district court construed the disputed term "rear sole secured" to require a rear sole that "can be rotated or replaced, but not permanently fixed in position" when attached to a shoe. The district court relied on various statements in the specification. In particular, the district court

relied on the express statements, “[t]he general features of the first embodiment, such as the shape of the rear sole and the material composition of the shoe elements, will apply to all embodiments unless otherwise noted.” The Federal Circuit affirmed the district court’s decision, citing to numerous statements in the specification, including under Field of Invention, the Background, the Summary of the Invention, in addition to the preferred embodiments, including the statement that features of the first embodiment “will apply to all embodiments unless otherwise noted.”

The *Akeva petition* asserts that the Federal Circuit applied the “holistic” approach, and by doing so, incorrectly construes the claim term “rear sole secured.” The *Akeva petition* further argues the claim construction in *Akeva* should start from the ordinary meaning of “secured” that indicates the term is sufficiently broad as to cover both permanently and temporarily “fixed” (or “secured”) rear soles.

The patent bar’s comments on Intel’s positions

First, the assertion by the *Intel petition* that the adoption of the “two-step” approach or the “single-step” can dictate the claim construction result may be countered because it appears the district court and the Federal Circuit adopted the same “two-step” approach, but reached the opposite conclusion. Hence there may be other factors in play when determining the claim construction result, and the choice of the “two-step” or “single-step” approach does not dictate the claim construction result.

Second, the *Intel petition* asserts that, if the “single-step” approach is used, the disparaging statements distinguishing the double desmear process as “contrary to” or “in stark contrast” with the single desmear process, and the use of “the present invention” would be enough to construe the disputed phrase to be limited as “produced by a repeated desmear process.” Yet it appears the *Intel petition* may not have addressed the Federal Circuit’s reasoning that such disparaging statements and the use of “the present invention” are not limiting because they only appear within the discussion of the preferred embodiment, but not in other sections, e.g., a summary of the specification, and not a uniform requirement. In other words, the *Intel petition* only argues what is said, but may not fully consider where the statements are located, which is emphasized by the Federal Circuit.

Third, the *Intel petition* asserts that similar statements have reached a different result if the “single-step” approach were to be adopted, citing *Aptalis Pharmatech*. Some say *Aptalis Pharmatech* adopts the “two-step” approach, not the “single-step” approach. For example, in *Aptalis Pharmatech*, the claim term “coating” is first construed to have an ordinary meaning as a “continuous outer film,” which is further supported by the specification at the second step. *Aptalis Pharmatech*, 718 F. Appx. 969. Therefore, some argue that the *Intel petition* presents an example that similar statements can reach a different result in the “two-step” approach instead of the “single-step” approach.

The patent bar’s comments on the Akeva petition

First, the *Akeva petition* may be seen to ignore the district court and the Federal Circuit statement that the specification said “will apply to all embodiments unless otherwise noted.” Accordingly, the *Akeva petition* does not appear to address why the Federal Circuit was wrong in applying the “holistic” approach when the *Akeva* patent has a “apply to all embodiments” statement similar to *SciMed Life* where the “holistic” approach is applied.

Second, the *Akeva petition* following the “heavy presumption” of ordinary meaning approach may not be seen as addressing how the “apply to all embodiments” statement will fail to meet the standard of clear disclaimer or lexicography to limit the disputed claim term “rear sole secured.” Hence, it is not clear how the “apply to all embodiments” statement can be interpreted differently under the “heavy presumption” of ordinary meaning approach to lead to a different claim construction outcome.

Finally, the *Akeva petition* alleges that *Nystrom* follows the “holistic” approach instead of the “heavy presumption” of ordinary meaning approach. Some might say *Nystrom* states that “both parties acknowledge the ordinary meaning of ‘board’ as ‘a piece of sawed lumber,’” which is defined by Webster’s dictionary, and further decides that there is no support in the written description or prosecution history to broaden the ordinary meaning. Thus some believe *Nystrom* follows the “heavy presumption” of ordinary meaning approach and decides that the meaning of “board” should be its ordinary meaning.

Take Away

We will continue to monitor this alleged inter-circuit split until a case finally raises the right issue

for Supreme Court's to grant review. For now, it would be wise to frame your claim construction issues on appeal to make sure your case will win regardless of what panel is assigned your case.

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Raytheon owns U.S. Patent No. 9,695,751. The '751 patent is directed to a multi-stage, geared, gas turbine aircraft engine. The independent claims include traditional features of gas-turbine engines like a fan, a compressor section, a combustor, and a fan-driven turbine section. The claims also include a “speed change system,” which refers to internal gearing between the turbine section and fan section. General Electric (“GE”) petitioned for *inter partes* review of the '751 patent.

The “key distinguishing feature” of the '751 patent claims, according to the court, was the recitation of a “power density” range for the engine that the patent describes as being “much higher than in the prior art.” GE’s primary reference in the IPR was a 1987 NASA technical memorandum (“Knip”). That reference envisioned superior performance characteristics for a future “advanced [turbofan] engine” that would incorporate “all composite materials.” According to the court, those advanced materials “allowed the author of Knip to assume aggressive performance parameters for an ‘advanced engine,’ including then-unachievable pressure ratios and turbine temperatures.” On the record developed before the PTAB, such an all-composite engine was unattainable as of the '751 patent’s invention date.

GE did not dispute that Knip relied on revolutionary materials that were unavailable as of the invention date to support the disclosed aggressive performance parameters. Nor did GE argue that a skilled artisan could have achieved those aggressive performance parameters by some other means. Rather, GE argued that the issue of whether Knip enabled its advanced engine was “irrelevant” to the question of whether a skilled artisan “reviewing Knip could make the '751 Patent’s engine (using any already available materials) without undue experimentation.”

The issues before the court on appeal were whether Knip was an enabling reference; and if not, could it nonetheless support an obviousness case. To tee up its analysis, the court observed that “[t]here is usually no dispute about whether an asserted prior art reference is ‘self-enabling.’” It also observed that “there is no absolute requirement for a relied-upon reference to be self-enabling in the § 103 context, so long as the overall evidence of what was

known at the time of invention establishes that a skilled artisan could have made and used the claimed invention.” But “if an obviousness case is based on a non-self-enabled reference, and no other prior art reference or evidence would have enabled a skilled artisan to make the claimed invention,” the court reiterated that on those facts, “the invention cannot be said to have been obvious.”

Here, the court determined that Knip was *not* a self-enabling reference. The court explained that such references *can* be used to provide a motivation to combine, and they *can* be used to supply claim elements enabled by other prior art or evidence. But where the primary reference is *not* enabling as to the relied-upon disclosure, and no other evidence cures that defect, it cannot prove unpatentability—whether for obviousness or anticipation. So where a party relies on speculative or forward looking embodiments in a prior art reference, it should provide additional evidence to support enablement, or risk the same fate GE suffered here.

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