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Contact Us:

P. Branko Pejic

www.gbpatent.com

bpejic@gbpatent.com

703-716-1191 (phone)

703-716-1180 (fax)

The Supreme Court Declines to Review Alleged Federal Circuit Split on How to Use a Specification to Determine the Meaning of Patent Claims

On December 7, 2015, the U.S. Supreme Court, in *Fivetech Technologies Inc. v. Southco, Inc.*, denied Fivetech's petition to review the issue of when a court should look to a patent specification to determine the meaning of a patent claim, which is a question that Fivetech asserted has divided members of the Federal Circuit bench. Fivetech's petition for writ of certiorari asserted that the Federal Circuit's 2005 *en banc* ruling in *Phillips v. AWH* resulted in inconsistent rulings, such that a litigant's chances of success were dependent upon which Judges sat on the particular appeal panel.

Fivetech specifically asserted that there was a "long-standing, fundamental split" at the Federal Circuit regarding how and when to use a patent's specification to clarify claim term meanings when claim terms are ambiguous. That is, one group of Federal Circuit Judges answers this question by starting with the premise that the patent specification defines the invention, which then informs the claim terms. Whereas, the other group of Judges start by giving claim terms their plain and ordinary meaning, and then looks for any express disclosure in the specification modifying this meaning, i.e., only if the inventor provided a different meaning, "acting as his or her own lexicographer," or explicitly disavowed the plain and ordinary meaning.

Fivetech asserted that the split is captured in quotes from the 2-1 Federal Circuit panel decision in *Retractable Technologies Inc. v. Becton, Dickinson & Co.*, where both the majority and the dissent claimed to be adhering to the claim construction standards set forth in *Phillips v. AWH Corp.* as follows:

1. In reviewing the intrinsic record to construe the claims, we strive to capture the scope of the actual invention, rather than strictly limit the scope of claims to disclosed embodiments or allow the claim language to become divorced from what the specifications conveys is the invention.
2. [T]his court recognized as 'a bedrock principle of patent law' that the claims themselves, not the written description portion of the specification, define the patented invention.

By way of background, Fivetech asserts that the Federal Circuit panel, in the Fivetech appeal, employed the latter approach as its rationale in

overturning the District Court's interpretation of the claim term "rigidly secure" in Southco Inc.'s patent claims. The District Court held that the term "is not defined in the intrinsic record [i.e., the specification and prosecution history] and nothing in the intrinsic record clearly and unmistakably redefines the term."

The unanswered questions presented in Fivetech's petition for writ of certiorari were:

1. Is it proper for the Federal Circuit to limit the role of the intrinsic evidence in construing patent claims under the exacting "lexicography and disavowal" standard?
2. Does the Federal Circuit's exacting "lexicography and disavowal" standard improperly circumscribe the objective standard of the person of ordinary skill in the art in construing claim terms?

Given the Supreme Court's decision not to review the issue, litigants will have to await further rulings clarifying the alleged split in claim construction jurisprudence.

Massachusetts District Court Rules that Exergen Forehead Thermometer Patent may Have Claims that are Separately Directed to Patentable and Unpatentable Subject Matter Under 35 U.S.C. §101

In *Exergen Corp. v. Kaz USA, Inc.*, the U.S. District Court for the District of Massachusetts recently held that just because one Judge held, in a different litigation against another defendant, that some of Exergen's forehead scanning thermometer patent claims, in U.S. Patent No. 7,787,938 ("the '938 patent"), were directed to subject matter ineligible for patent protection does not mean that all of the claims are directed to unpatentable subject matter under 35 U.S.C. §101.

The alleged infringer, Kaz argued that all claims in a patent should rise or fall together with respect to patentable subject matter eligibility in view of the USPTO's regulation requiring each patent to be directed to only one "independent and distinct" invention. In rejecting Kaz' arguments, the Kaz Court noted that this argument "amounts to an impermissible bypass of the required claim-by-claim analysis." The Kaz Court further noted that its decision was based upon the "well-understood, routine, conventional activity" applicable to patent eligibility, versus procedures known in the technological field that are considered when looking at invalidity by reason of being obvious.

By way of background, Exergen filed separate patent infringement suits in the U.S. District Court for the District of Massachusetts against (i) Kaz, (ii) Brooklands Inc., and (iii) Thermomedics Inc. and Sanomedics International Holdings Inc., which cases were assigned to three different Judges. Thereafter, two of the respective Judges granted summary judgment of invalidity under Section 101 in favor of Brooklands and Thermomedics, with


the respective Judges finding four asserted method claims of the '938 patent invalid as directed to unpatentable subject matter under 35 U.S.C. § 101.

Kaz also sought summary judgment of invalidity under Section 101 requesting the Kaz Court to extend the same patent ineligibility judgment to 16 claims, i.e., 13 other claims of the '938 patent and three claims of U.S. Patent No. 6,292,685, arguing that the rulings in the other cases with respect to the four claims at-issue in those cases requires a finding of invalidity as to the claims at-issue with Kaz. In doing so, Kaz cited 37 C.F.R. §1.141 (a USPTO rule requiring examiners, when they identify multiple inventions in one application, to issue a "restriction" forcing the patent applicant to limit his/her claims to a single invention), and concluded that if the previously adjudicated claims are drawn to an ineligible "inventive concept," the claims at-issue with Kaz must likewise be invalid as directed to unpatentable subject matter.

The Kaz Court looked at each of the 16 claims at-issue with Kaz that had not been analyzed in the other two cases and applied the "law of nature" test set forth by the Supreme Court in *Mayo Collaborative Services v. Prometheus Labs. Inc.* In the words of the Kaz Court, the test bars patenting a "law of nature"—here, a formula for converting the surface forehead temperature into internal temperature, which bar is not overcome when "any additional steps consist of well-understood, routine, conventional activity already engaged in by the scientific community."

The Kaz Court thus granted summary judgment of invalidity as to claims that were not "patentably distinct from claims 51 and 54 under the Thermomedics analysis," e.g., claims 26, 27, 29, and 37 of the '938 patent only added "a generic piece of equipment [that] does not materially alter the validity analysis." However, method claims 14, 17, and 24, in the Kaz Court's view, added a step of "making at least three radiation readings per second while moving the radiation detector." The Kaz Court further noted that "It is important to differentiate an analysis under § 101 (patentability) from one under § 103 (obviousness)," and that "Although measuring temperature or radiation is a fundamental technique in the field of thermometry, innovations on basic practices merit patent protection."

In denying Kaz' summary judgment motion, the Kaz Court also noted that "Kaz cites no authority for the proposition that rules of prosecution have any effect on a judicial determination of validity," and further observed that the U.S. Supreme Court, in fact, "simultaneously invalidated and upheld different claims of the same patent under § 101" in one of its opinions in the last few years that have expanded patent ineligibility, *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*; i.e., in the Kaz Court's view the Myriad claims directed to "isolated" DNA were not eligible for patenting, while claims directed to complementary DNA (cDNA) recited patentable subject matter.



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