

# Lawyer Insights

## Patent Prosecution Carries Consequences For Later Litigation

By Steven Wood

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Four 2023 opinions concerning claim construction from the [U.S. Court of Appeals for the Federal Circuit](#) offer lessons on how patent prosecution can affect later litigation:

- Salazar v. AT&T Mobility;<sup>1</sup>
- Finjan LLC v. SonicWall Inc.;<sup>2</sup>
- ABS Global Inc. v. Cytonome/St LLC;<sup>3</sup> and
- Actelion Pharmaceuticals Ltd. v. Mylan Pharmaceuticals Inc.<sup>4</sup>The first three address issues of whether a claim term is singular or plural and the last addresses interpretation of a claimed range.

### Salazar

In its April 5, 2023, Salazar v. AT&T Mobility decision, the Federal Circuit [addressed](#) a dispute over the meaning of claim terms "a microprocessor" and "said microprocessor."

The [U.S. District Court for the Eastern District of Texas](#) had construed the terms to mean "one or more microprocessors, at least one of which is configured to perform" the actions in the claim.<sup>5</sup>

The Federal Circuit affirmed — importantly, the patent owner had argued the terms require one or more microprocessors, any one of which may be capable of performing the claimed actions.

In reaching its holding, the court relied on its 2016 decisions in *Convolve Inc. v. Compaq Computer Corp.* and *In re: Varma*, because each involved claims with the indefinite article "a" further defined by certain characteristics.<sup>6</sup>

It also relied on its 2008 *Baldwin Graphic Systems, Inc. v. Siebert Inc.* decision for the exception to the rule that "a" means more than one based on the claim language, specification prosecution history.<sup>7</sup>

The Federal Circuit analogized "[f]or a dog owner to have a dog that rolls over and fetches sticks, it does not suffice that he has two dogs, each able to perform just one of the tasks" and held

[h]ere, it does not suffice to have multiple microprocessors, each able to perform just one of the recited functions; the claim language requires at least one microprocessor capable of performing each of the recited functions.<sup>8</sup>

This reinforces that the Federal Circuit is not willing to expand coverage of a claim where the record does not support doing so — i.e., a broad claim interpretation is not possible without more in the language, specification, or prosecution history.

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### Finjan and ABS Global

Following Salazar, and relying on similar precedent, including Convolve and Baldwin, the Federal Circuit issued opinions in Finjan v. SonicWall and ABS Global Inc. v. Cytonome/St LLC, addressing whether certain claim terms have singular or plural meanings. Issued less than one week apart, on Oct. 13, 2023, and Oct 19, 2023, respectively, these decision reach slightly different conclusions on claim scope.

In Finjan, an appeal from the [U.S. District Court for the Northern District of California](#), the Federal Circuit [found](#) that the same, singular, computer that satisfies the "a computer" claim limitation must perform the subsequent functions listed in the claims.<sup>9</sup>

In contrast, in ABS Global, an appeal from a final written decision of the Patent Trial and Appeal Board, the Federal Circuit [found](#) that "the" in the term "the sample stream" refers back to the first instance of the term and takes any singular or plural meaning thereof.<sup>10</sup>

When the court's analyses are reviewed, distinct differences in the issues presented appear to have caused the divergence in holdings.

In Finjan, the court found the issue presented was like that in Salazar and agreed with the defendant that "even if the reference to 'a computer' may mean 'one or more computers,' the subsequent references to 'the computer' can only be satisfied by the same 'one or more computers' that satisfied the first limitation."<sup>11</sup>

This holding confirms the importance of having a detailed patent specification that provides support for plural interpretations of certain language, if desired, as well as the need for clearly drafted claims with language that can only be interpreted in the way intended by the inventor.

In ABS Global, the full claim language at issue was "a fluid focusing region configured to focus the sample stream," where "the sample stream" refers back to "a sample stream" earlier in the claim.

Rejecting the PTAB's singular interpretation of "the sample stream," the court observed that two factors "strongly support" a plural meaning here.<sup>12</sup>

First, the use of "a" generally allows for a construction of "one or more."<sup>13</sup> Second, there is language in the patent specification demonstrating that terms such as "a" or "an" could refer to one or more of an entity, and "a" or "an" and "one or more" or "at least one" could be used interchangeably.

As most patent practitioners are aware, the inventor's lexicography generally governs — with narrow exceptions.<sup>14</sup> Here, neither the prosecution history nor the specification nor a dependent claim<sup>15</sup> provided a reason to disavow the plural interpretation.

Key in these cases is how the claim interpretation in ABS Global was broader than Finjan or Salazar because the specification and claims themselves supported either a singular or plural meaning. The patents in the earlier cases lacked clarifying language.

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### Actelion

On Nov. 6, 2023, the Federal Circuit issued its opinion in *Actelion Pharmaceuticals. v. Mylan Pharmaceuticals*, an appeal from the [U.S. District Court for the Northern District of West Virginia](#).

This case presents a slightly different but related issue to the three cases discussed above. Here, the Federal Circuit [held that](#) extrinsic evidence must be considered to determine how a person of ordinary skill in the art would understand the claim language of "a pH of 13 or higher."<sup>16</sup>

Both parties had proposed a plain and ordinary meaning for the term, but disagreed on what that meaning was.<sup>17</sup>

Citing three chemistry textbooks that discuss pH measurement errors and significant digits, Actelion argued the number is "subject to rounding" and proposed that, e.g., a pH of 13 could mean 12.5 rounded to 13.<sup>18</sup>

Mylan argued that the claim language did not allow for any pH values less than 13 and noted that if the court were inclined to consider pH measurement errors, Actelion's textbooks supported only a narrow range of 12.995-13.004.<sup>19</sup>

The district court had reasoned that the claims consistently used two significant digits for pH and no further precision is needed; thus, the term "a pH of 13" includes values that round up or down to 13.<sup>20</sup>

The Federal Circuit looked at the plain language of the claim and noted it did not foreclose rounding, stating "there is no blanket rule that ranges, or specifically open-ended ranges, must foreclose rounding."<sup>21</sup>

The court next turned to the specification as "the single best guide to the meaning of a disputed term."<sup>22</sup> However, the inventor "inconsistently" described the level of specificity for a pH of 13 and "the specification supplies the same clarity as to the desired level of precision as muddied water."<sup>23</sup>

Finally, the court turned to the prosecution history, which, according to its opinion, "can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution."<sup>24</sup> The claim was amended in prosecution to limit the pH because this range had unexpected results, but the amendment did not specify whether values that round to 13 are within the scope of the language.

The Federal Circuit thus remanded, faulting the district court for not reviewing the extrinsic evidence offered by the parties, including the chemistry textbooks, as part of the claim construction process, and noting that the [U.S. Supreme Court](#) has endorsed turning to extrinsic evidence if required to understand the background of a term or the meaning of a term in the art.<sup>25</sup>

The court further found that reliance on extrinsic evidence may be required if a term remains ambiguous after analysis of the intrinsic evidence.<sup>26</sup>

The court found the extrinsic evidence presented was highly relevant to how a person of ordinary skill would interpret the claim language because the specification and prosecution history did not provide sufficient clarity as to the proper interpretation of the claimed range.

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This demonstrates how important it is for a specification to include details supporting claim language that recites numbers — e.g., a claimed range — to try to prevent this type of claim construction scenario in litigation.

### Takeaways

These cases serve as a reminder to attorneys to draft a patent specification clearly and in a way that provides specific support for claim terms, particularly terms that include ranges and terms that may be interpreted as singular or plural.

For example, if there are multiple computers — or processors — used, how many are there? Which computers perform which functions? Does one computer perform all functions, or can different computers perform different functions?

If there are claimed ranges, the specification should include details regarding the range and what it means in the specification, as well as details regarding what range is suitable for a claimed embodiment — is a range permitted above and below a certain threshold?

Consistency in defining terms is key — e.g., the number of significant digits in a number.

A patentee likely does not want a court deciding whether 13 means 13 or 12.5 or 12.9 or 12.995, or all of the above. A good specification should answer these questions to avoid leaving interpretation up to the courts.

Last, boilerplate language, such as that used in *ABS Global*, is important when it comes to claim interpretation. Such specification language was lacking in *Salazar and Finjan*.








Thus, when drafting claims, a patent prosecutor should keep in mind potential claim construction issues that may arise in subsequent patent litigation. Patents should be drafted with litigation in mind, a fact of which patent prosecutors can easily lose sight.

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### Notes

1. [Salazar v. AT&T Mobility LLC](#) , 64 F.4th 1311 (Fed. Cir. 2023).
2. [Finjan LLC v. SonicWall Inc.](#) , 84 F.4th 963 (Fed. Cir. 2023).
3. [ABS Global Inc. v. Cytonome/St LLC](#) , 84 F.4th 1034 (Fed. Cir. 2023).
4. [Actelion Pharmaceuticals Ltd. v. Mylan Pharmaceuticals Inc.](#) , 85 F.4th 1167 (Fed. Cir. 2023).
5. Salazar, 64 F.4th. at 1314-15.
6. Id. at 1315-18 (citing [Convolve Inc. v. Compaq Computer Corp.](#) , 812 F.3d 1313 (Fed. Cir. 2016) and [In re Varma](#) , 816 F.3d 1352 (Fed. Cir. 2016)).
7. Id. (citing [Baldwin Graphic Systems Inc. v. Siebert Inc.](#) , 512 F.3d 1338 (Fed. Cir. 2008)).
8. Id. at 1318. ((quoting Varma) (internal quotations omitted).
9. Finjan, 84 F.4th at 974.
10. ABS Global, 84 F.4th at 1040.
11. Finjan, 84 F.4th at 974.
12. ABS Global, 84 F.4th at 1040-41.
13. Id. at 1040.
14. Id. at 1041.
15. Id. at 1041-42.
16. Actelion, 85 F.4th at 1168.
17. Id. at 1169.
18. Id.
19. Id.
20. Id. at 1170.
21. Id. at 1171.

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22. Id. at 1172 (quoting [Phillips v. AWH Corp.](#), 415 F.3d 1303 (Fed. Cir. 2005)).
23. Id.
24. Id. at 1173 (quoting Phillips).
25. Id. at 1173-74 (citing [Teva Pharmaceuticals USA Inc. v. Sandoz Inc.](#), 574 U.S. 318 (2015)).
26. Id. at 1174 (citing [Pickholtz v. Rainbow Technologies Inc.](#), 284 F.3d 1365 (Fed. Cir. 2002)).

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