

Keywords: claim construction, disavowal of claim scope, written description, defining terms, essential elements

General: Describing elements in the specification as essential rises to the level of disavowal of claim scope

X2Y Attenuators, LLC v. Int'l Trade Comm'n

U.S. Court of Appeals Federal Circuit

Case No. 2013-1340

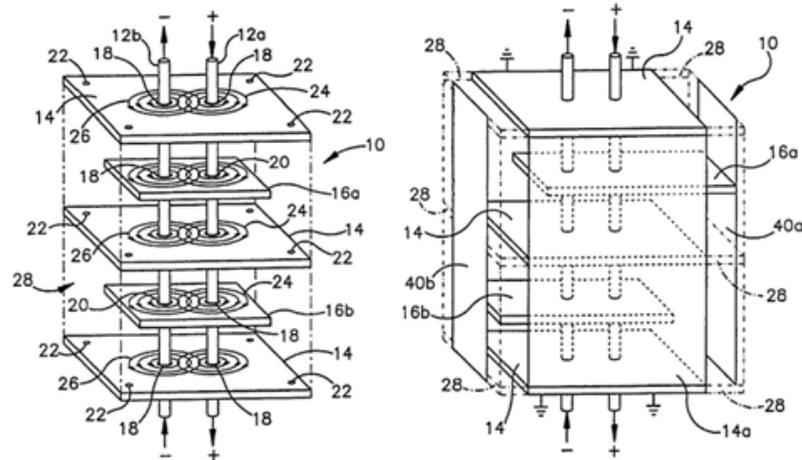
Decided July 7, 2014

I. Facts

Anthony A. Anthony, founder of X2Y Attenuators (X2Y), obtained U.S. Patent Nos. 7,609,500 ('500 patent), 7,916,444 ('444 patent), and 8,023,241 ('241 patent). Generally, the technology disclosed in the '500, '444, and '241 patents relates to systems and components (e.g., shielding electrodes) that reduce electromagnetic interference in electrical circuits. For example, the shielding electrodes reduce a buildup of charge known as "parasitic capacitance" between shielded electrodes. In particular, the patents relate to an alternating order of shielding and shielded electrodes. A portion of representative claim 26 of the '444 patent is reproduced below:

26. An arrangement for energy conditioning, comprising: ... a first electrode including a first shielding electrode portion, *a third electrode including a third shielding electrode portion*, and a fifth electrode including a fifth shielding electrode portion ... a second electrode including a second shielded electrode portion; a fourth electrode including a fourth shielded electrode portion ... wherein said second shielded electrode portion and said fourth shielded electrode portion are in a first superpose alignment with each other; ... and *wherein said second shielded electrode portion is physically shielded from said fourth shielded electrode portion by said third shielding electrode portion.* (Emphasis added.)

For clarity, FIGS. 1A and 1B of the '500 patent are shown below.



‘500 Patent, FIGS. 1A (left) and 1B (right).

As shown in the figures above, shielding electrodes (e.g., common conductive pathways 14) and shielded electrodes (e.g., differentially conductive pathways 16) are disposed in an alternating order. The alternating arrangement of the shielding and shielded electrodes 14, 16 is referred to as a “sandwich” configuration in the ‘500 patent, the ‘444 patent, and the ‘241 patent. The “sandwich” refers to, in particular, two differentially conductive electrodes 16 shielded by a common conductive pathway electrode 14 disposed between the two differentially conductive electrodes 16. The sandwich configuration is not expressly recited in representative claim 26.

X2Y filed a complaint in the United States International Trade Commission (ITC) accusing Intel of unlawful importation of products that allegedly infringe certain of the claims in the asserted ‘500, ‘444, and ‘241 patents. Intel argued that the claims should be limited to the sandwich configuration described above, while X2Y argued that the claimed electrode terms do not require the sandwich configuration. The ITC ruled in favor of Intel based on an alleged disavowal of claim scope in the specification of at least one of the asserted patents, asserting that the claims at issue are limited to “a common conductive pathway electrode positioned between paired electromagnetically opposite conductors.” For example, the ITC pointed to a portion of the ‘500 patent that states “[c]enter common conductive pathway electrode 14 is an essential element among all embodiments or connotations of the invention.” ‘500 Patent, col. 19, ll. 21-23. Further, the ITC asserted that other X2Y patents of which the asserted patents claim priority include similar language regarding the essential nature of the sandwich configuration. X2Y conceded non-infringement on the basis of the claim construction requiring the sandwich configuration, but appealed to the Federal Circuit, asserting that the claim interpretation based on the alleged disavowal of claim scope in the specification was improper.

II. Issues

Did the ITC err in its construction of the electrode terms?

III. Discussion

No. In the appeal, X2Y argued that the ITC improperly read certain limitations into the meaning of the claim term “electrode.” For example, X2Y asserted that the plain meaning of “electrode” denotes a single electrode, as opposed to three electrodes arranged in a sandwich configuration. X2Y also argued that the specification of the ‘444 patent contradicts the ITC’s claim construction. For example, X2Y asserted that the ‘444 patent describes how the shielded electrodes on either side of the central shielding electrode may be “electrically null, electrically complementary, ... or electrically opposite,” and that, accordingly, the claims should not be limited to “electrically opposite” electrodes that sandwich a central shielding electrode. ‘444 Patent, col. 5, ll. 10 and 11. Further, X2Y argued that the statements pointed to by the ITC do not constitute disavowal of claim scope *as applied by the ITC*. For example, X2Y asserted that the ‘500 patent actually describes only the “common conductive pathway electrode 14” as the essential element common among all embodiments of the invention.

The Federal Circuit concluded that the ITC correctly construed all the electrode terms and that the statements in the asserted patents pointed to by the ITC do constitute disavowal of claim scope *as applied by the ITC*. Specifically, the Federal Circuit agreed with the ITC that the asserted patents clearly recite that the common conductive pathway electrode sandwiched between the two shielded electrodes is essential to all embodiments of the invention, and that labeling an element as essential to all embodiments of the invention rises to the level of disavowal.

The Federal Circuit further asserted that the portion of the ‘444 patent pointed to by X2Y as allegedly contradicting the ITC’s claim construction is not mutually exclusive from the ITC’s claim construction. For example, the Federal Circuit noted that the possibility of conductive pathways (e.g., the shielded electrodes) having “electrically null, electrically complementary, electrically differential, or electrically opposite” structures does not preclude the sandwich configuration.

IV. Conclusion

The Federal Circuit stressed that referring to elements as “essential” to all embodiments or connotations of the invention does rise to the level of disavowal of claim scope. Further, the Federal Circuit indicated that language in a parent application can also rise to the level of disavowal of claim scope in a child application that claims priority to the parent application, *even if* the child application is a continuation-in-part of the parent application.

V. Practice Strategies

Although the USPTO prefers particularly defined claim terms, in general, avoid using terms like “essential.” Also, when preparing a continuation application, consider that disavowals of claim scope in the specification of a parent application may still apply to claims in a child application claiming priority to the parent, *even if* the child application is a continuation-in-part of the parent application.