

Keywords: Best mode, claim construction

General: Description of a preferred embodiment does not limit the scope of the claims.

Continental Circuits LLC v. Intel Corporation, Ibidem U.S.A. Corporation, Ibidem Company Limited

United States Court of Appeals for the Federal Circuit
No. 2018-1076
Decided: February 8, 2019

I. Background

Continental Circuits LLC (“Continental”) owns four patents – U.S. Patent Nos. 7,501,582; 8,278,560; 8,581,105; and 9,374,912 (hereinafter “the Continental patents”), which are continuations of one another sharing a substantially similar specification. The Continental patents are directed toward circuit board construction techniques that improve adhesion between layers of multilayered electrical devices to reduce delamination or blistering of the layers. Particularly, the Continental patents aim to solve the problem of layer delamination by “forming a unique surface structure...comprised of teeth that are preferably angled or hooked like fangs or canine teeth to enable one layer to mechanically grip a second layer.”¹ The Continental patents explain that “[o]ne technique for forming the teeth is...the swell and etch or desmear process, except that *contrary to all known teachings in the prior art...a ‘double desmear process’* is utilized,” and that “the peel strength produced in accordance with the present invention is greater than the peel [sic] strength produced by the desmear process of the prior art, i.e., a *single pass desmear process.*”² The Continental patents further explain that “[i]n stark contrast with the etch and swell process of the known prior art...a *second pass* through the process...is used” because it “make[s] use of [the] non-homogeneity [sic] in bringing about a formation of the teeth.”³

In 2016, Continental sued Intel Corp., Ibidem U.S.A. Corp., and Ibidem Co. Ltd. (collectively “Intel”) for infringement of the Continental patents in the District of Arizona. Each of the asserted claims included claim limitations regarding the “surface,” “removal,” or “etching” of “a dielectric material” or “epoxy.” The district court construed these claim limitations to require that the “surface,” “removal,” or “etching” of the dielectric material or epoxy be “produced by a repeated desmear process.” The district court found that the specification of the Continental patents not only repeatedly distinguished the disclosed circuit board construction process from the prior art and its use of a single desmear process, but also characterized “the present invention” as using a repeated desmear process. Additionally, the district court relied on the prosecution history to support its claim construction noting that, in response to indefiniteness and written description rejections during the prosecution of U.S. Patent No. 8,278,560 (the ‘560 patent), Continental submitted an expert declaration explaining that the “etching” process disclosed in the specification uses “two separate swell and etch steps” as “a technique which forms the teeth.” The district court found that the expert declaration clearly described the patented method of the ‘560 patent as involving two etching processes. Moreover, the district court observed that extrinsic documents authored by the

¹ See e.g., U.S. Patent No. 7,501,582, col. 1, ll. 52-57.

² See e.g., U.S. Patent No. 7,501,582, col. 5, ll. 40-44; col. 7, ll. 3-6.

³ See e.g., U.S. Patent No. 7,501,582, col. 9, ll. 1-5.

inventors conceded the use of a “two pass desmear cycle” and that “we use a double pass desmear to achieve the tooth structure.”⁴ Based on the district court’s claim construction and the fact that all of the asserted claims involve the question of whether they should be limited to a repeated desmear process, the parties stipulated to non-infringement.

II. Issue

Did the district court err in its claim construction and judgement of non-infringement?

III. Discussion

Yes. The Federal Circuit concluded that the district court erred in limiting the claims of the Continental patents to require a repeated desmear process. In beginning its analysis, the Federal Circuit noted that none of the asserted claims actually recite a “repeated desmear process.” Therefore, at least based on the plain language, the claims are not limited to a repeated desmear process. Moreover, the Federal Circuit noted that disclosure in the specification identifying the double desmear process as “one technique” for forming teeth in a dielectric material “contrary to all known teachings in the prior art” simply describes how to make the invention in a new way that is different from the prior art process, and does not require a repeated desmear process to be performed. Particularly, the Federal Circuit noted that a goal of the specification is to provide a best mode to make and use an invention; phrases such as “one technique” only describe one method for making the invention and do not automatically lead to finding a clear disavowal of claim scope. The Federal Circuit expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment.

Additionally, the Federal Circuit determined that distinguishing the double desmear process as “contrary to” or “in stark contrast” with the single desmear process of the prior art is not a clear and unmistakable statement for disavowal of claim scope. Specifically, the Federal Circuit noted that comparing and contrasting a disclosed technique to that of the prior art does not rise to the level of a clear disavowal of claim scope. Moreover, the Federal Circuit noted that while descriptions “of the ‘present invention’ as a whole” could limit the scope of an invention, use of the phrases such as “present invention” or “this invention” are not necessarily limiting where other portions of intrinsic evidence do not support applying a limitation to the entire patent. Therefore, the Federal Circuit found that the statements relied on by the district court during its analysis of the Continental patents “do not characterize the present invention ‘as a whole,’” but instead “disclose one way to carry out the present invention.” The Federal Circuit further noted that certain portions of the specification, such as the summary, describe the invention with respect to its “unique surface structure” without any requirement that the invention must encompass a repeated desmear process. Thus, the Federal Circuit determined that, due to the lack of clear and unmistakable language suggesting otherwise, the scope of the claims at question should not be limited to a repeated desmear process.

The Federal Circuit determined that the expert declaration relied on by Continental in response to both the indefiniteness and the written description rejections of the ‘560 patent demonstrated that the written description disclosed “a technique which forms the teeth” by “performing two separate

⁴ See e.g., Claim Construction Order, 2017 WL 3478659, page 6.

swell and etch steps.” However, the Federal Circuit noted that clearly describing a particular claim term to overcome an indefiniteness or written description rejection is not the same as clearly disavowing claim scope. The Federal Circuit further reiterated that the statements in the expert declaration, as well as those made by inventors, merely explain one technique for forming teeth and again do not amount to clear statements of disavowal. Therefore, the Federal Circuit concluded that the cited statements in the prosecution history of the ‘560 patent, as well as the extrinsic evidence authored by the inventors, do not clearly and unmistakably disavow any claim scope.

IV. Conclusion

The Federal Circuit concluded that the district court’s judgement is to be vacated and remanded for further proceeding. The Federal Circuit expressed that, because the patentee has not made clear that the repeated desmear process is an essential part of the claimed invention, it was improper for the district court to read this limitation the claims.