

Keywords: Disavowal; USITC; Claim Construction

General: Broad claims supported by one embodiment consistently described in the specification can result in disavowal of claim scope beyond that described embodiment.

Techtronic Indus. v. International Trade Commission and The Chamberlain Group

United States Court of Appeals for the Federal Circuit

No. 2018-2191

Decided December 12, 2019

I. Facts

Chamberlain Group Inc. (“Chamberlain”) develops and markets garage door opener technology. Chamberlain obtained U.S. Patent No. 7,161,319 (the ‘319 patent), which is a continuation with broadened claims of application U.S. Pat. No. 6,737,968 (the ‘968 patent). The background section of the ‘968 and the ‘319 patents describes the use of passive infrared detectors in a head unit of a garage door opener to control the garage’s lighting and noted that locating the passive infrared detector in the head unit was expensive, complicated, and unreliable. This results in a need for a passive infrared detector for controlling illumination from a garage door operator which could be quickly and easily retrofitted to existing garage door operators.

The patents describe a passive infrared detector for a garage door operator, where the infrared detector is contained in a wall control unit along with an ambient light comparator and a microcontroller. The ambient light comparator provides a signal to the microcontroller indicating the status of the lights in the garage, and the microcontroller communicates over the lines carrying the normal wall control switch signals with a microcontroller in a head unit of the garage door, using conventional signaling channels. Also described is a preferred embodiment containing a wall control unit embodying the present invention that includes a passive infrared sensor and a microcontroller programmed to command a counterpart microcontroller in the head unit using digital signaling techniques, like pulse width modulation. The ‘968 patent (parent) generally claims a wall control unit inclusive of a passive infrared detector and a wired connection to a head unit to communicate signals from the detector. In contrast, the ‘319 patent (the child continuation at issue) generally claims a wall console having a microcontroller connected to a microcontroller of a head unit by means of a digital data bus.

The accused infringer of the ‘319 is Techtronic Industries Co. Ltd. (“TTI”). TTI owns Ryobi, the maker of the accused infringing garage door opening system. Chamberlain filed its case in the United States International Trade Commission (USITC). USITC decisions are made by the six commissioners (currently only five), but the Commission tasks an Administrative Law Judge (ALJ) to conduct the trial. Here, the ALJ narrowly construed the “wall console” term of the ‘319 patent, holding that Chamberlain disavowed wall consoles lacking a passive infrared detector. This construction is important because Ryobi’s wall console does not have a passive infrared detector thus, the narrow construction meant no infringement of the ‘319 patent. The Commissioners took-up the ALJ’s decision and disagreed, ultimately giving “wall console” its ordinary meaning that resulted in an infringement of claims 1–4, 7–12, 15, and 16 of the ‘319 patent. TTI appealed from the final determination of the USITC to the Federal Circuit.

II. Issue

Did Chamberlain disavowed coverage of garage door openers with wall consoles without a passive infrared detector?

III. Discussion

Yes. The Appellants (TTI) argued that Chamberlain disavowed coverage of garage door openers with wall consoles lacking a passive infrared detector. The Appellants point to the '319 patent's consistent description of the invention as a wall console with a passive infrared detector—a feature included in the described preferred embodiment—and the patent's disparagement of prior art garage door openers that placed the detector in the head unit. The Applicants maintained that under *Poly-America* and similar cases, these descriptions as a whole constitute a disavowal of claim scope.

Chamberlain argued in response that locating the passive infrared detector in the wall console is only one aspect of the invention. It cited the '319 patent as describing the use of digital signaling techniques, along with disclosed methods of programming the wall console's microcontroller, as means for controlling the operation of the garage door opener. Chamberlain also highlighted portions of the specification that describe the invention more broadly as relating in general to movable barrier operators or to garage door operators, which include passive infrared detectors associated with them. As a result, Chamberlain contended that the characterization of the invention in the '319 patent does not rise to the level of a disavowal of claim scope at least because (I) the patent recites a separate invention relating to programming of the microcontrollers, the disavowal is not clear because nothing in the specification suggests that it would be impossible or infeasible to put a passive infrared detector elsewhere, and the parent application specifically claims a passive infrared detector in a wall console.

The court rejected these arguments from Chamberlain, concluding that the '319 patent disavows coverage of wall consoles lacking a passive infrared detector because the specification, in each of its sections, discloses as the invention a garage door opener improved by moving the passive infrared detector from the head unit to the wall console. The court noted that where the specification describes “the present invention” as having a feature, that representation may disavow contrary embodiments. With respect to the '319 patent, by consistently representing the invention as the placement of the detector in the wall console, Chamberlain was found to have effected a disavowal of alternative locations.

In reviewing the suggested recitation of another invention related to the programming of the microcontroller, the court found that its disclosure did not undermine the conclusion that the infrared detector must be on the wall unit. The court found that the purpose for this portion of the description was to enable placement of the detector in the wall console. The court also noted that while criticism of the prior art having a sensor in the head unit alone does not rise to the level of a disavowal, the claims must be construed in view of both the criticism and in light of the specification with a view to ascertaining the invention. The court found that since the '319 patent plainly represents the scope of the invention to the exclusion of some embodiments, it is unnecessary to concede that these elements are infeasible or impossible. Finally, court found nothing in the prosecution history of the '319 patent inconsistent with disavowal.

IV. Conclusion

In view of the consistent disclosure of a wall console as inclusive of a passive infrared detection, the court found that the '319 disavows coverage of wall consoles lacking the passive infrared detector. The court, accordingly, reversed the claim construction by the Commission as well as the determination of the Commission of non-infringement.