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PATENT OWNER AMENDING CLAIMS DURING IPR

By *Reina Kakimoto*

[Am. Nat'l Mfg. v. Sleep Number Corp.](#), Appeal Nos. 2021-1321, 2021-1323, 2021-1379, 2021-1382 (Fed. Cir., Nov.14, 2022, Stoll, Schall, Cunningham)

- A patent owner is free to amend claims during an IPR, consistent with the procedures for such amendments, to address issues other than novelty and obviousness so long as the amendments include elements responsive to a ground of unpatentability on which IPR was instituted.
- 专利所有人可以在知识产权复审期间根据此类修改的程序自由修改权利要求，解决新颖性和显而易见性以外的问题，只要该修改所包括的要素能够回应该知识产权复审提出时所基于的不可专利性理由。
- IPR手続き中特許権利者は、そのIPRが提起された非特許性自由に対する要点を含む新規性・自明性以外の争点を解消するため、自由にクレームを補正できる。
- IPRO이 개시되게 했던 특허 무효사유에 대응하는 요소를 포함하는 보정이라면, 특허권자가 신규성과 진보성 외에 다른 이슈에 대해서는, 상응하는 절차에 따라 청구항을 자유롭게 보정할 수 있다.

In two Inter Partes Review (IPR) proceedings, American National Manufacturing (“American”) challenged claims in the U.S. Patent Nos. 8,769,747 and 9,737,154 owned by Sleep Number Corp (“Sleep Number”) asserting that most of the challenged claims would have been obvious over various prior art references. The patents relate to systems and methods that purport to adjust the pressure in an air mattress “in less time and with greater accuracy” than previously known. In opposition, Sleep Number argued that industry praise and commercial success strongly indicates non-obviousness, and that American’s arguments were deficient. The Board found the evidence cited by Sleep Number as industry praise slightly probative because only one of two references could be interpreted as praising the technology while the other did not. The Board found Sleep Number’s evidence of commercial success

did not show the success was due to the claimed features and not, for example, increased advertising or lower prices. The Board rejected Sleep Number’s other allegations of deficiency in American’s arguments.

Sleep Number filed a motion to amend to add elements from claims the Board found not unpatentable and other elements that were not responsive to the ground of unpatentability at issue. American objected to the proposal to add the other elements on grounds that the proposed amendments did not respond to grounds of unpatentability at issue in the proceeding, and that the specification did not enable or describe the proposed amendments. The Board rejected American’s challenge to the amendments, finding all the amendments not unpatentable.

On appeal, the Federal Circuit considered what types of claim amendments are permitted by the procedures of an IPR proceeding. Noting that 37 CFR § 42.121 states, “[A] motion to amend may be denied where: (i) The amendment does not respond to a ground of unpatentability involved in the trial,” American argued that the Board erred by permitting Sleep Number to present proposed amended claims that both responded to the unpatentability ground and the enablement ground. The reviewing court agreed with the Board decision in *Lectrosonics, Inc. v. Zaxcom, Inc.* (IPR2018-01129, PTAB, 2020) 37 C.F.R. 42.121, which held that the rule “does not require . . . that every word added to or removed from a claim in a motion to amend be solely for the purpose of overcoming an instituted ground.” Finding that nothing in either the America Invents Act (AIA) or the patent regulations “precludes a patent owner from amending a claim to both overcome an instituted ground and correct other perceived issues in the claim,” the reviewing court found no error in allowing the amendments.

The reviewing court rejected American’s argument that allowing correction of section 112 issues during an IPR goes beyond the statutory scope of the IPR proceeding, explaining that the petitioner is free to challenge proposed amendments on grounds other than novelty and obviousness, as American in fact did in this IPR. Because each proposed amendment included at least one responsive narrowing amendment, Sleep Number was free to propose other amendments addressing any perceived issues beyond novelty and obviousness, and the Board was free to determine whether such amendments were patentable.

The Federal Circuit also addressed American’s other arguments in opposition to the Board’s final decision, finding none of them persuasive. The reviewing court found that the Board did not err in finding that the specification enabled the claims despite an obvious error in the specification, that the amendments did not introduce an inventorship issue, and the Board’s approach in considering evidence of commercial success did not determine infringement.

EFFECT OF DISCLAIMER IN IPR

By [Reina Kakimoto](#)

[CUPP Computing AS v Trend Micro, Inc.](#), Appeal Nos. 2020-2262, 2020-2263, 2020-2264 (Fed. Cir., November 16, 2022, Dyk, Taranto, and Stark)

- The Patent Trial and Appeals Board is not required to accept concurrent disclaimer as evidence of patentability during an Inter Partes Review proceeding.
- 專利審判和上訴委員會不需要在多方複審程序中接受同時放棄聲明作為可專利性的證據。
- 特許審理審判部 (PTAB) は、IPR手続き中に特許性の証拠として、共通ディスクレーマを認容することを要求されない。
- PTAB 는 IPR 절차 중에 동시배제를 특허성의 증거로 인정할 필요는 없다.

The Court of Appeals for the Federal Circuit affirmed an Inter Partes Review (IPR) decision by the Patent Trial and Appeals Board that petitioner Trend Micro, Inc. had shown challenged claims in CUPP Computing AS (“CUPP”)’s U.S. Patents Nos. 8,631,488 (“488 patent”), 9,106,683 (“683 patent”), and 9,843,595 (“595 patent”) to be unpatentable as obvious over two prior art references: U.S. Patent No. 7,818,803 (“Gordon”) and U.S. Patent App. Pub. No. 2010/0218012 A1 (“Joseph”).

The challenged claims recite “a mobile device having a mobile device processor different than the mobile security system processor.” CUPP argued that the claim requires the security system processor be “remote” from the mobile device processor, and neither Gordon nor Joseph disclose this limitation because both references teach a security processor bundled within a mobile device.

The Federal Circuit reviewed the language of the claims, the specification, and the disclaimers made during the original examination and the IPR proceedings, and agreed with the Board’s interpretation that the claim language at issue does not require the security system processor be remote from the mobile device processor. Resorting to ordinary usage and dictionary definitions, the reviewing court explained that “different” does not mean the two processors are remote from one another. The court also explained that the specification explicitly discloses an embodiment where the mobile security system “may be incorporated within the mobile device.” The court rejected CUPP’s argument that statements in the specification that the security system is to send a wake signal “to” the mobile device, and elements of some claims reciting communication with the mobile device via a data port, require the two components to be remote, finding such evidence unpersuasive.

CUPP argued that non-remote embodiments were disclaimed during initial examination of one of the patents at issue. The reviewing court found that CUPP’s purported disclaimer did not clearly disavow a system with both processors embedded in the same device. CUPP argued, during prosecution, that a cited reference did not disclose a security system processor different than a mobile device processor because the Trusted Platform Module taught in the reference could be part of the motherboard. The court explained that this statement does not unmistakably disavow the scope asserted by CUPP.

CUPP also argued that non-remote embodiments were disclaimed during review, and, relying on *Aylus Networks, Inc. v. Apple Inc.*, that the Board should have accepted the disclaimer as evidence of non-obviousness. The Federal Circuit disagreed, explaining that the Board is not required to accept a disclaimer made during an IPR in its final decision. The reviewing court explained that *Aylus* requires a disclaimer in an IPR proceeding to limit claims in any *subsequent* proceeding, but does not require the Board to accept a disclaimer during the IPR. Indeed, the court explained, there is a statutory mechanism for amending claims during an IPR, and patent owners should use that mechanism, which addresses numerous issues that amending claims during an IPR can create. It would be particularly perverse, the court reasoned, for the court to supplant the statutory mechanism with a disclaimer mechanism proposed by CUPP, because such a disclaimer would effectively enable a patent owner to amend their claims, during an IPR proceeding, for reasons outside the scope of the IPR proceeding without scrutiny by the Board or protection for the public.

COURTS CAN ADOPT BROADER CLAIM CONSTRUCTION THAN PATENT OWNER

By Bobbie Wu

[*VLSI Technology LLC v. Intel Corp.*](#), Appeal No. 21-1826
(Fed. Cir., November 15, 2022, Bryson, Chen, Hughes)

- Courts may adopt a claim construction broader than the position of the patent owner.

- 法院可能会采用比专利所有人的立场更为宽泛的权利要求解释。
- 裁判所は特許権利者が主張するよりも広いクレーム解釈を採用してもよい。
- 法院可能会采用比专利所有人的立场更为宽泛的权利要求解释。
- Courts construing the claims are not limited to “preferred embodiments or specific examples in the specification.”
- 法院在对权利要求进行解释时，权利要求不局限于“说明书中的优选实施例或具体示例”。
- 裁判所がクレームを解釈する際、明細書中の“好適な実施例あるいは特定の例”に縛られない。
- 청구항을 해석하는 법원은 명세서의 “우선 실시예” 또는 “구체적인 예”에 제한되지 않는다.

Background:

VLSI sued Intel for infringement of VLSI’s U.S. Patent No. 7,247,552. Concurrently, Intel filed an IPR challenging the validity of claims 1, 2, 11 and 20 of the ‘552 Patent. The ‘552 patent relates to “[a] technique for alleviating the problems of defects caused by stress applied to bond pads” of an integrated circuit. The parties agreed, before the district court and the Patent Trial and Appeals Board, on a construction of the claim term “force region,” but subsequently before the Board, the parties disagreed on meaning of the term “die attach,” which was a component of the construction of “force region,” and which the district court did not address. The Board resolved all claim interpretation issues and found all of the challenged claims to be unpatentable. VLSI appealed to the Court of Appeals for the Federal Circuit, arguing that (1) the Board erred in its treatment of the “force region” limitation of claims 1, 2, and 11 and (2) the Board erred in construing the phrase “used for electrical interconnection” in claim 20 to encompass a metallic structure that is not connected to active circuitry.

Holding:

- (1) The appellate court found no error in the Board’s interpretation of the term “force region,” and affirmed the Board’s decision that claims 1, 2, and 11 are unpatentable.
- (2) The appellate court held that the Board erred in interpreting the phrase “used for electrical interconnection,” reversed the Board’s interpretation regarding active circuitry, and remanded the case for further proceedings regarding the validity of claim 20.

Discussion:

Regarding the first issue, the appellate court rejected VLSI’s argument that the Board’s interpretation of “force region” was inconsistent with the district court construction of that term. Reasoning that the Board was “well aware” of the district court’s claim construction because the parties argued that construction before the Board, and that the Board did not reject the district court’s claim construction but adopted a consistent interpretation, the appellate court found no error in the Board’s interpretation of the term “force region.” Observing that the party disagreement over the meaning of the term “die attach” in the agreed claim construction phrase had to be resolved by the Board, requiring the

Board to “go beyond” the district court’s claim construction to resolve whether the claim was limited to flip chip bonding or covered wire bonding as well, the appellate court found that resolving this question did not make the Board’s result inconsistent with the district court claim construction. In addition, the appellate court held that the Board was not required to expressly acknowledge the district court’s claim construction, and failure to do so was at most harmless error. Finding no error in the Board’s interpretation, the appellate court affirmed the holding of unpatentability as to claims 1, 2 and 11.

As to the second issue, the appellate court held that the phrase “being used for electrical interconnection” should have been interpreted “to require that the interconnect layers be connected to active circuitry or have the capability to carry electricity,” and concluded that the Board’s interpretation that the claim covers interconnect layers not connected to any active circuitry was too broad. The appellate court reasoned that the use of the phrase “being used for” implies a requirement to use the metal interconnect layers to carry electricity, and the recitation of the term “dummy metal lines” elsewhere in the claim “implies that the claimed ‘metal-containing interconnect layers’ are capable of carrying electricity; otherwise, there would be no distinction between the dummy metal lines and the rest of the interconnect layer.” The appellate court adopted VLSI’s proposed interpretation of “being used for electrical interconnection,” covering interconnect layers capable of carrying electricity or connected to active circuitry, thus reversing the Board’s interpretation. The appellate court remanded the case for reconsideration of the patentability determination and Intel’s obviousness arguments in light of the proper interpretation.

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