



UNIVERSITY OF
MARYLAND
SCHOOL OF LAW

**PATENT LAW
UPDATE**

*Electro Sci.
Indus.
v.
Dynamic
Details, Inc.*

No. 02-1010
Federal Circuit
Oct. 7, 2002

“Because this appellate court possesses no tools or mandate for fact-finding, a change in the claim construction at the appellate level generally necessitates a remand to the district court to resolve any new factual issues raised by the new claim construction.”

On October 7, 2002, the Federal Circuit vacated and remanded the district court’s summary judgment that Dynamic and GSI Lumonics did not infringe U.S. Patent No. 5,847,960, which related to a method for accurate high-speed drilling of small holes (vias) in circuit boards. The Federal Circuit stated:

[T]he district court determined that the claim required separate “circuit boards,” not a single workpiece that could be separated after processing. In that determination, the district court impermissibly limited claim scope. Properly construed, the claims require processing of multiple circuit boards without regard to whether those boards are separated or not. . . .

The preamble defines “circuit boards” as “at least first and second substantially identical circuit boards each having at least a first conductor layer, a dielectric layer, and a second conductor layer.” . . . This preamble definition narrows the meaning of “circuit boards” to at least two substantially identical boards. Nonetheless it does not state or suggest that those circuit boards must be separated.

The specification also supports the interpretation that the term “circuit boards” does not require separated workpieces This comports with common understanding in the field of electrical component fabrication. . . . GSI Lumonics contends, however, that the preamble and specification modify this customary meaning of ECB in this field of art to require physical separateness. Specifically, GSI Lumonics argues that the preamble defines ECBs as workpieces, and that the preferred embodiment of the patent shows physically separate workpieces.

To the contrary, neither the ordinary meaning of workpiece nor the inventor’s preferred embodiment limits the claim scope. More particularly, even assuming that the preamble defines ECB as a workpiece, that definition imposes no separateness requirement. Workpiece is a broad term that means generally “the object which is worked on with a machine or tool.” Physical separateness, or lack thereof, simply does not enter into the ordinary meaning of workpiece. The term “workpiece” makes the ECBs the objects of work, but says nothing about physical separateness. An object may be worked upon irrespective of whether it is physically separate. The patentee has not altered this ordinary meaning. . . . The prosecution history of the ‘960 patent is also not a source of a separateness requirement. . . .

Because this appellate court possesses no tools or mandate for fact-finding, a change in the claim construction at the appellate level generally necessitates a remand to the district court to resolve any new factual issues raised by the new claim construction, except, of course, in the rare instance that the record on appeal leaves no genuine issues of material fact and entitles the movant to judgment as a matter of law. . . . Under a correct claim construction, the undisputed evidence shows literal satisfaction of that limitation. Nevertheless, the parties dispute other claim limitations not construed by the district court. This court, therefore, vacates the district court’s judgment of non-infringement and remands for additional claim construction on other limitations of the claims, and for a determination of infringement based on a complete claim construction.