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TECHNOLOGY LAW UPDATE

A report of the latest Federal Circuit updates brought to you by Preston Gates.

3M Innovative Props. Co. v. Avery Dennison Corp.

No. 03-1203 (Fed. Cir. Dec. 2, 2003).

“When the patentee has expressly defined a term in the specification and remarks made to distinguish claims from the prior art are broader than necessary to distinguish the prior art, the full breadth of the remark is not ‘a clear and unambiguous disavowal of claim scope as required to depart from the meaning of the term provided in the written description.’”

On December 2, 2003, the Federal Circuit vacated and remanded the district court’s summary judgment that Avery did not infringe U.S. Patent No. 5,897,930, which related to a release liner for adhesive back-films that avoids positioning and air-entrapment difficulties. The Federal Circuit stated:

While limitations in the specification must not be routinely imported into the claims because a patentee need not describe all embodiments of his invention, a definition of a claim term in the specification will prevail over a term’s ordinary meaning if the patentee has acted as his own lexicographer and clearly set forth a different definition. “This court also considers the prosecution history . . . to determine whether the applicant clearly and unambiguously ‘disclaimed or disavowed [any interpretation] during prosecution in order to obtain claim allowance.’ . . . 3M clearly acted as its own lexicographer, and the definition provided requires only that the “two or more embossing patterns” be “superimposed.” Despite Avery’s arguments to the contrary, the use of “superimposed” in this definition neither transforms claim 1 into a product-by-process claim nor even limits the scope of the claim to a serial method of manufacture; it describes only the structural relationship between the embossing patterns. Furthermore, even words of limitation that can connote with equal force a structural characteristic of the product or a process of manufacture are commonly and by default interpreted in their structural sense, unless the patentee has demonstrated otherwise.

Nothing in the intrinsic evidence of the patent requires that a limitation of sequential creation of the “multiple embossed pattern” should be included in claim 1. . . . A broadening claim amendment made during the prosecution history of the ‘930 patent supports a plain-meaning construction of claim 1 without a sequential-embossment limitation. . . . Avery argues that 3M thus expressly disclaimed any patent scope beyond sequential embossment of patterns when it used language pregnant with temporal implications—the first pattern “survives” the embossing of the second—to traverse the examiner’s rejections. 3M’s use of the term “survives” in the prosecution history, however, does not constitute the clear and unambiguous disavowal of claim scope that is required to read a limitation into an expressly defined term. To distinguish the prior art in question, 3M needed only to argue, as it did in the last two sentences of the quotation above, that the ‘930 patent claimed “two embossed patterns” rather than “one embossed pattern.” When the patentee has expressly defined a term in the specification and remarks made to distinguish claims from the prior art are broader than necessary to distinguish the prior art, the full breadth of the remark is not “a clear and unambiguous disavowal of claim scope as required to depart from the meaning of the term provided in the written description.” . . .

3M never responded to [the examiner’s statement that claim 1 was drafted in product-by-process format] because the objection was overcome In this context, the examiner’s statement does not constitute a clear and unmistakable surrender of claim scope. An applicant’s silence in response to an examiner’s characterization of a claim does not reflect the applicant’s clear and unmistakable acquiescence to that characterization if the claim is eventually allowed on grounds unrelated to the examiner’s rebutted characterization.