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TECHNOLOGY LAW UPDATE

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

On-Line Techs., Inc. v. Bodenseewerk Perkin-Elmer GmbH

No. 04-1291 (Fed. Cir. Oct. 13, 2004)

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On October 13, 2004, the Federal Circuit vacated and remanded the district court's summary judgment that Bodenseewerk did not infringe U.S. Patent No. 5,440,143, which related to long-path gas cells used to check emissions from industrial plants, but affirmed the portions of the summary judgment with respect to On-Line's state law claims and with respect to the order dismissing Sick, A.G., for lack of personal jurisdiction.. The Federal Circuit stated:

On-Line contends that the district court erred in ruling that objective mirrors having a toroidal surface are not within the scope of claim 1 of the '143 patent. We agree with On-Line that, properly construed, the reference to a "substantially spherical, concave reflective surface . . . having a cylindrical component added thereto to increase coincidence of focii in two orthogonal planes" defines a set of curved surfaces that includes a toroidal surface. We reach that conclusion because the specification makes clear that the claim language referring to spherical surfaces with cylindrical components includes toroidal surfaces. . . .

Although the parties agree that the term "toroidal" has a well-understood definition, neither party suggests that the term "substantially spherical, concave reflective surface . . . having a cylindrical component added thereto," used in the claims of the '143 patent, has a precise and well-established meaning in the art. [Because the pertinent claim terms have] no precise and generally understood meaning in the art as applied to reflective surfaces, we look to the intrinsic evidence, in this case the specification, for guidance as to the meaning of that language as used in the patent. Although in this case, as in others, "the guidance [in the specification] is not provided in explicit definitional format," the specification of the '143 patent nonetheless demonstrates that the claim language encompasses toroidal surfaces. First, the specification refers to the curved surfaces in the preferred embodiment of the invention as toroidal surfaces, and in doing so it describes those surfaces by using the same language that is used in claim 1. Accordingly, the specification makes it clear that, for purposes of the '143 patent, a toroidal surface is a substantially spherical reflective surface that has a cylindrical component superimposed thereupon.

Second, even if the specification were less explicit in equating the term "toroid" with a generally spherical surface having a cylindrical component added thereto, the reference to the preferred embodiment as having mirrors with toroidal surfaces would give rise to a very strong inference that the claim should be construed to include such surfaces. As this court has explained before, "a claim interpretation that excludes a preferred embodiment from the scope of the claim 'is rarely, if ever, correct.'" [W]hile the claim language in the '143 patent does not either expressly include a toroidal surface or exclude other similar surfaces, the characteristics and function of the surface described in the specification and the claims are consistent with the characteristics and function of a toroidal surface. . . .

Extrinsic evidence, however, cannot be used to alter a claim construction dictated by a proper analysis of the intrinsic evidence. In any event, we do not agree with the district court's analysis of the extrinsic evidence. . . . Because of the lack of precision in the language used to define the claimed surfaces of the objective mirrors, this case was made more difficult than it needed to be, and the district court was required to invest considerable effort in trying to ascertain the meaning of the critical claim language. While the district court conducted a careful analysis of the claim language in light of the specification and the extrinsic evidence, we are nonetheless persuaded, particularly in light of the specification, that the district court's claim construction was too restrictive