

Elbex Video, Ltd. v. Sensormatic Elecs. Corp.

No. 07-1097, Federal Circuit (Dyk, Moore, Cote*)

“For a prosecution statement to prevail over the plain language of the claim, the statement must be clear and unmistakable such that the public should be entitled to rely on any ‘definitive statements made during prosecution.’”

On November 28, 2007, the Federal Circuit affirmed the portion of the district court’s summary judgment that Sensormatic’s RS-422 and SensorNet systems did not infringe claim 1 of U.S. Patent No. 4,989,085, which related to closed circuit television (CCTV) systems, but reversed and remanded the portion of the summary judgment pertaining to Sensormatic’s Intellix IP systems. The Federal Circuit stated:

Claim terms are entitled to a “heavy presumption” that they carry their ordinary and customary meaning to those skilled in the art in light of the claim term’s usage in the patent specification. However, when a patent applicant surrendered claim scope during prosecution before the PTO, the ordinary and customary meaning of a claim term may not apply. This doctrine of prosecution disclaimer has been “adopted . . . as a fundamental precept in our claim construction jurisprudence.” Prosecution disclaimer “promotes the public notice function of the intrinsic evidence and protects the public’s reliance on definitive statements made during prosecution.” This doctrine does not apply “where the alleged disavowal is ambiguous;” the disavowal must “be both clear and unmistakable” to one of ordinary skill in the art.

In the present case, the district court found that the inventor limited the “receiving means” that receives the first code signal to a “monitor” that receives the first code signal. Implicit in its determination is a finding that the inventor clearly and unmistakably surrendered any claim scope between the “receiving means” that receives first code signals as expressly recited in the claims, and a “monitor” that receives first code signals. We cannot agree. The statements to the effect that the code signal is received by the monitor did not amount to a clear and unmistakable surrender of claim scope.

First, the statement in the prosecution history is unsupported by even a shred of evidence from the specification. The specification never suggests that the monitor of the receiving means receives first code signals and returns a corresponding code to the cameras. . . . There is nothing in the specification to suggest that the first code signal ever reaches the monitor.

Second, read in isolation, the statement in the prosecution history could be argued to be a disclaimer. When the prosecution history as a whole is considered, the inventor’s response to the PTO is not as clear. Because of the potential for such ambiguities, we have recognized that “because the

prosecution history represents an ongoing negotiation between the PTO and the applicant . . . it often lacks the clarity of the specification and thus is less useful for claim construction purposes.” . . . The specification equates the “display device” and the “receiving device.” This statement, unlike the alleged disclaimer, is fully supported by the written description and provides further indication that the earlier statement in the same document was not a clear and unmistakable surrender.

Third, reading the specification and remainder of the intrinsic record as a whole would lead those skilled in the art to the conclusion that the inventor’s statement that the monitor received the first code signals and, “based upon” that code, transmits a second code signal “back to the camera” was not a clear and unmistakable surrender of claim scope. This prosecution statement if taken literally would result in an inoperable system. . . .

For a prosecution statement to prevail over the plain language of the claim, the statement must be clear and unmistakable such that the public should be entitled to rely on any “definitive statements made during prosecution.” On this unique amalgamation of facts, including (1) the absence of support in the specification or drawings for a monitor that receives code signals from and returns code signals to the cameras; (2) the ambiguity created by other statements in the same prosecution document; (3) the fact that Sensormatic’s own technical witness did not understand how the system would operate consistent with the erroneous statement; and (4) the inoperability of a device constructed in accordance with the incorrect statement, we conclude that this is not a case of prosecution disclaimer. One of skill in the art would understand the claim to cover a receiving means (not limited to a monitor) for receiving the video signals and the first code signals.

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