

Sinorgchem Co., Shandong v. Int'l Trade Comm'n

No. 06-1633, Federal Circuit (Newman, Dyk,* Yeakel)

When the specification explains and defines a term used in the claims, without ambiguity or incompleteness, there is no need to search further for the meaning of the term [and where] multiple embodiments are disclosed, we have previously interpreted claims to exclude embodiments where those embodiments are inconsistent with unambiguous language in the patent's specification or prosecution history.

On December 21, 2007, the Federal Circuit vacated and remanded the ITC limited exclusion order that found Sinorgchem infringed U.S. Patents No. 5,117,063 and No. 5,608,111, which were owned by Flexsys America L.P. and which related to a rubber antidegradant, 6PPD. The Federal Circuit stated:

The main issue on appeal is the meaning of the claim term "controlled amount." The parties here agree that "controlled amount" does not have any well-accepted meaning in the field of chemistry. Sinorgchem contends that the ITC misconstrued the term "controlled amount" and on that basis erred in finding infringement. [We] have repeatedly encouraged claim drafters who choose to act as their own lexicographers to clearly define terms used in the claims in the specification. [T]he specification [is] "the single best guide to the meaning of a disputed term. "[O]ur cases recognize that the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs. Here the drafters have done just that.

The specification states: A "controlled amount" of protic material is an amount up to that which inhibits the reaction of aniline with nitrobenzene, e.g., up to about 4% H₂O solvent. The term "controlled amount" is set off by quotation marks—often a strong indication that what follows is a definition. Moreover, the word "is," again a term used here in the specification, may "signify that a patentee is serving as its own lexicographer." As such, the patentee must be bound by the express definition. Here the drafter clearly, deliberately, and precisely defined the term "controlled amount" . . . Elsewhere in the same paragraph, the specification again refers to the 4% limit.

The ITC agreed that the patentee had expressly defined the term "controlled amount" in the specification but held that the language "e.g., up to about 4% H₂O based on the volume of the reaction mixture when aniline is utilized as the solvent" should not be considered part of that definition for two reasons. Neither of these reasons is persuasive. First, the ITC dismissed the 4% limit as merely an example that did not apply to all situations in which aniline was used as the solvent. The ITC relied particularly on the emphasized language in the

following passage: [T]he amount of protic material tolerated will vary with type of base, amount of base, and base cation, used in the various solvent systems. However, it is within the skill of one in the art, utilizing the teachings of the present invention, to determine the specific upper limit of the amount of protic material for a specific solvent, type and amount of base, base cation and the like. The ITC found that this language made clear that the “e.g., up to about 4% H₂O” language was used in the specification as an example and not a definition of the amount of water permitted when aniline is the solvent.

We disagree. This vague language cannot override the express definitional language. . . . “When the specification explains and defines a term used in the claims, without ambiguity or incompleteness, there is no need to search further for the meaning of the term.” When aniline is used as the solvent, the express definition is neither ambiguous nor incomplete – the “controlled amount” is “up to about 4% H₂O based on the volume of the reaction mixture” – and we need look no further for its meaning. Nor is the specification passage relied on by the ITC inconsistent with the express definition of “controlled amount,” since the passage refers generally to at least six different solvents while the definition refers specifically to reactions in which aniline is the solvent. . . . Quite tellingly, aniline and DMSO were the only two solvents of the six solvents mentioned in the specification for which an express numerical limit was given for the “controlled amount.” The quoted “will vary” language appears to refer to the four other solvents for which a specific percentage was not provided.

Second, the ITC found that the 4% language was inconsistent with Example 10 (which appears identically in both the ‘063 and the ‘111 patents), a “preferred embodiment,” which uses more than 10% water in a reaction where aniline is the solvent. [B]oth the ITC and Flexsys support the ITC’s decision by relying on statements in our case law that we do “not normally interpret a claim term to exclude a preferred embodiment,” as would be the case if the 4% limit were applied to the claims. This rule has particular force where the claims as construed do not encompass any disclosed embodiments. This is not the case here. Example 10 is merely one of twenty-one distinct examples set out in the two specifications, all of which are described as “preferred embodiment[s].” Where, as here, multiple embodiments are disclosed, we have previously interpreted claims to exclude embodiments where those embodiments are inconsistent with unambiguous language in the patent’s specification or prosecution history.

The previous statements are for information purposes only, and do not constitute legal advice. Questions regarding the matters discussed above, and any requests to be subscribed to the free electronic distribution of this publication, may be directed to Lawrence M. Sung, Ph.D., at +1 202.862.1025 or lsung@dl.com, or to any other Dewey & LeBoeuf LLP attorney with whom you regularly consult.

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