

KRATZ, QUINTOS & HANSON, LLP – IP Newsletter

**RECENT COURT CASES REMIND US OF CERTAIN PITFALLS TO AVOID
IN THE PROCUREMENT OF U.S. PATENTS****By: Mel R. Quintos**

The two precedential cases discussed in this Newsletter alert patent practitioners of certain pitfalls that may occur if care is not taken in following U.S. patent rules and statutes in the procurement of U.S. patents.

The *first* case (*Knowles Electronics LLC v. Cirrus Logic, Inc.* decided on March 1, 2018) concerns the U.S. Court of Appeals for the Federal Circuit's ("Federal Circuit") finding that substantial evidence supports the U.S. PTO Patent Trial and Appeal Board's ("Board") determination of lack of adequate written description to support certain claims in U.S. Patent No. 6,781,231 owned by Knowles Electronics.

The claims at issue recite a MEMS package wherein the solder pads are "configured to mechanically attach and electrically connect the pads *using a solder reflow process.*" The Board took the position that "the present [s]pecification merely discloses a *genus* - solder pads that are capable of being connected to a board [but the claimed species of pads connectable to a board specifically by using a reflow process is not disclosed in the specification]." In affirming the Board's decision, the Federal Circuit held that: "[i]t is not sufficient for purposes of the written description requirement of [35 U.S.C.] §112 that the disclosure * * * would lead one to speculate as to the modifications that the inventor might have envisioned, but failed to disclose."

Despite Knowles' insistence that the Board "fail[ed] to consider the extensive extrinsic and full intrinsic evidence" how a person having ordinary skill in the art would understand that solder pads were capable of attachment via solder reflow processing, the Federal Circuit nevertheless agreed with the Board and further held that the specification "does not require solder pads to connect to the circuit board by any particular process, including the solder reflow process."

Knowles also listed prior art references that disclose solder reflow as a well-known process of connecting mount devices. The Federal Circuit, however, rejected Knowles' list of prior art references as non-persuasive because with the mere reference to solder pads in the specification, a person of ordinary skill in the art "would not have recognized that the inventor possessed solder pads 'configured to' connect to a printed circuit board through a reflow process."

Knowles also argued that the specification describes solder pads "on the bottom of the inventor's package," which would make clear to a person having ordinary skill in the art that the solder pads would necessarily attach to a user's board via solder reflow. The Federal Circuit also rejected this argument because "the consideration for adequate written description asks what the applicant conveyed with reasonable clarity, and [Knowles' patent] 'failed to even mention, much less spell out *any* detail of, the claimed reflow process.'"

The Federal Circuit affirmed the Board's finding of lack of adequate written description for certain claims in Knowles' patent.

In the *second* case (*Dell Inc. v. Accelaron, LLC* decided on March 19, 2018), the Federal Circuit reminds patent practitioners that under U.S. PTO guidelines, "[n]o new evidence or arguments may be presented at the oral argument." This case involves an *inter partes* review of Accelaron's U.S. Patent No. 6,948,021.

The primary prior art reference relied upon by Dell is directed to a high-density server network in which a large number of web server processing cards are installed within a single chassis with an articulating door in front of the chassis. Accelaron defended its patent by arguing that "[its] claim recited that the single chassis comprises *multiple* caddies," while the prior art reference "includes only a *single* articulating door" (emphasis in original).

For the first time, at oral argument before the Board, Dell argued that "slides," on which power supplies rest in the prior art reference, are also "caddies," and therefore the reference teaches *multiple* caddies and meets Accelaron's claim. Although Dell was permitted to argue this point at oral argument before the Board, Accelaron was not permitted to respond. Both Dell and Accelaron appealed and the Federal Circuit remanded on the grounds that the Board erred when it failed to give Accelaron an opportunity to respond.

On remand, the Board refused to consider both Dell's new argument and Accelaron's proposed reponse. Despite Dell's contention that "ignoring evidence of unpatentability is against public policy because it will not improve quality," the Federal Circuit held that "under these circumstances, due process and preserving the Board's discretion outweigh any negative effects of not invalidating a patent claim."

The Federal Circuit affirmed the Board's decision not to consider Dell's new argument against the prior art reference and held the patentability of Accelaron's claim on appeal.

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