

The Fed. Circ. In June: A Few Decisions To Know

By **Paul Stewart** (July 1, 2022)

The U.S. Court of Appeals for the Federal Circuit issued a June decision regarding the circumstances under which a district court may correct errors in a patent claim, and one explaining the disclosure necessary to support a negative claim limitation.

The June 3 Pavo Solutions LLC v. Kingston Technology Company Inc. decision seemingly pulls back from prior precedent that appeared to severely restrict those circumstances, while the June 21 Novartis Pharmaceuticals Corp. v. Accord Healthcare Inc. decision reversed on rehearing an earlier precedential decision from the same Federal Circuit panel.



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Pavo Solutions v. Kingston Technology

In Pavo, the error case, the patent was directed to a USB apparatus, commonly known as a thumb drive or flash memory drive. The claims recited a "main body" including a rectangular "case" for housing the memory element, and a pivotable "cover" for shielding the memory element when not in use.

In addition, the claims recited that the cover includes a pair of parallel plates having a hinge "for pivoting the case with respect to the flash memory main body."

During claim construction proceedings, the plaintiff argued that the use of the highlighted word "case" was an obvious error, and that the intended word was "cover." The district court agreed and, at the plaintiff's request, substituted the word "cover" in place of the word "case."

The Federal Circuit affirmed. Citing established precedent, the Federal Circuit held that a district court may correct "obvious minor typographical and clerical errors in patents" when "the correction is not subject to reasonable debate based on consideration of the claim language and the specification."

Here, the court held, the claim language itself made clear that the claim contained an obvious error. The full context of the claims unambiguously recited elements that made clear that the "cover," not the "case," pivots with respect to the main body. In particular, the claims describe the "case" as part of the "main body" of the device.

Yet, the claims, as literally written, required "pivoting the case with respect to the flash memory main body." The case cannot be pivoted with respect to the main body, the court reasoned, because the case is part of the main body.

What makes the Pavo case notable is the manner in which it distinguished the Federal Circuit's rather famous 2004 Chef America Inc. v. Lamb-Weston Inc. decision.

In Chef America, the claim required heating dough "to a temperature in the range of about 400° F to 850° F." This language, taken literally, required the dough itself to reach greater than 400 degrees Fahrenheit, which would result in dough that was "burned to a crisp."

The plaintiff argued that the claim should be construed to require heating dough "at" a temperature of about 400 F to 850 F, thus requiring the oven temperature, not the dough, to be at about 400 F to 850 F. The Federal Circuit rejected this argument in *Chef America*, holding that "courts may not redraft claims" even if the result is nonsensical.

Pavo distinguished *Chef America* on multiple grounds, but perhaps the most important is that in *Chef America* the plaintiff did not ask the district court to "correct" the claim; it only asked the court to construe the claim. Pavo thus takes what seemed to be an important substantive holding from *Chef America* that courts may not rewrite claims, and turns it into a procedural requirement.

District courts may indeed rewrite claims to correct obvious typographical or clerical errors, provided the plaintiff asks the court to do so.

Taken together, Pavo and *Chef America* thus provide an important lesson to litigators. When a claim includes an obvious error, it is critical to ask the district court to correct the error, rather than couching the argument as merely an ordinary claim construction dispute.

Moreover, the line between correcting a typographical error and merely construing a claim term is not always a bright one. Accordingly, even where a party believes it is merely asking the court to construe a claim term, it may be prudent in some cases to present an alternative argument asking the court to correct any error in the claim.

Novartis Pharmaceuticals v. Accord Healthcare

In the June 21 *Novartis Pharmaceuticals Corp. v. Accord Healthcare Inc.* decision, the Federal Circuit addressed the support needed in a patent's written description for a "negative" claim limitation.

A negative limitation is one that recites a feature that is affirmatively excluded from the invention. For example, the claim in *Novartis* was directed to a method of treating multiple sclerosis that included administering a certain drug "at a daily dosage of 0.5 mg, absent an immediately preceding loading dose regimen."

The highlighted limitation excludes from the claim any dosing regimen that includes any dose larger than 0.5 milligrams, administered immediately before the daily dosage of 0.5 milligrams begins.

The issue in *Novartis* was whether the patent specification described to a skilled artisan a dosage regimen that specifically excluded a loading dose, as required by the written description requirement of Title 35 of the U.S. Code Section 112. In a 2-1 decision authored by Judge Kathleen O'Malley and joined by Judge Richard Linn, the Federal Circuit initially held that the specification included an adequate written description.

However, in a very unusual move, the Federal Circuit granted rehearing, vacated its original decision, and issued a new decision reaching the opposite result. The new decision was also a split decision, with the original dissenter, Chief Judge Kimberly Moore, authoring the opinion, joined by Judge O'Malley, who changed her position. Judge Linn dissented.

The new majority held that the specification contained no description of the concept of avoiding a loading dose, saying: "Loading doses — whether to be used or not — are simply not discussed." And "[s]ilence is generally not disclosure."

Instead, the specification must in some fashion affirmatively disclose the inventor's possession of the negative element.

This occurs most commonly when the specification describes a reason to exclude the relevant element, such as by listing a disadvantage of the element.

The court did, however, leave the door open just a crack to allow silence to constitute disclosure where "a particular limitation would always be understood by skilled artisans as being necessarily excluded from a particular claimed method or apparatus if that limitation is not mentioned."

This appears to be a very narrow exception. The majority was clearly concerned that permitting silence to constitute disclosure generally would allow patentees to add any negative limitation they want "so long as the patent makes no mention of it." That is the opposite of disclosure.

The Novartis majority also emphasized that its decision is not intended to "create a heightened standard for negative claim limitations."

The Novartis majority added that "[j]ust as disclosure is the hallmark of written description for positive limitations, so too for negative limitations" and "as with positive limitations, the disclosure must only reasonably convey to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date."

The Novartis decision makes clear to patent prosecutors the importance of including at least some reasonable disclosure of a negative claim limitation within the four corners of the patent specification.

Indeed, Novartis rejected expert testimony that attempted to impute disclosure of the negative limitation from silence. Thus, expert testimony is unlikely to save the day if the specification itself has no disclosure of a negative limitation.

The Novartis decision is also an important reminder to appellate practitioners. While panel rehearing is a long shot, it can be successful.

It certainly remains true that most requests for panel rehearing are a waste of the court's time and the client's money, but the possibility of panel rehearing should not be rejected outright by counsel.

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