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The Fed. Circ. In July: A 'Prior Art' Decision To Know

By **Paul Stewart and Michael Friedland** (July 29, 2022, 4:01 PM EDT)

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The U.S. Court of Appeals for the Federal Circuit recently addressed the issue of circumstances under which a purported disclosure in a prior art reference may be corrected or disregarded on the ground that the purported disclosure was merely the result of a typographical or similar error.

In its July 11 LG Electronics Inc. v. Immervision Inc. decision,[1] the Federal Circuit permitted erroneous prior art text to be disregarded when the error was not discovered for 20 years, and then only in litigation when an expert witness reconstructed the prior art embodiment and engaged in extensive analysis to uncover the error.

The LG Electronics decision is consistent with, but arguably broader than, the only relevant authority identified by the Federal Circuit — the 1970 In re: Yale decision of the Court of Customs and Patent Appeals.

The facts of the LG Electronics decision are detailed, but important to understanding the decision. The case arose when LG Electronics filed a petition for inter partes review against two of Immervision's patents. The patents related to a lens used for capturing panoramic images, also known as wide-angle images.

The lens compressed the center and edges of the image, while expanding the remaining intermediate zones of the image, a feature that Immervision claimed distinguished its invention from the prior art.

In its petition for inter partes review, LG Electronics relied upon a prior art U.S. patent for a super wide angle lens system, called Tada, which claimed priority to a published Japanese patent application.

In support of the petition, LG Electronics' expert witness reconstructed one of the lenses described in the U.S. Tada patent.

The expert testified that when he built the lens using certain optical coefficients disclosed in Table 5 of Tada,[2] the lens met the claims' requirement of compression at the center and edges, with expansion in the remaining intermediate zones. Accordingly, LG Electronics argued, Tada rendered the challenged claims invalid.

In response, Immervision retained its own expert witness who also reconstructed the Tada lens in accordance with Table 5. Immervision's expert did not dispute that the lens as constructed met the critical limitation.

However, he noticed that the images created by the lens were badly distorted, and in precisely the way that Tada sought to avoid. In addition, the physical surface of the reconstructed lens did not match the relevant figures in Tada.

Immervision's expert also noticed that the coefficients from Table 5 were exactly the same as the coefficients for a different lens set forth in Table 3 of Tada.

In addition, Immervision's expert reviewed the Japanese priority application and discovered that the

coefficients in Table 5 of the priority application were different than the coefficients in Table 5 of the U.S. Tada patent. Substituting the coefficients from Table 5 of the Japanese publication, Immervision's expert determined that the resulting lens perfectly matched the relevant figures of Tada.

Based upon all of this, Immervision's expert concluded that there was a simple transcription or cut-and-paste error in Tada.

When Tada's U.S. application was prepared, the data from Table 3 of the Japanese priority application was mistakenly repeated in Table 5 of the U.S. application.

Immervision's expert also concluded that a person of ordinary skill in the art would be convinced that there was a significant error in the disclosure of Table 5 of Tada's U.S. patent. The Patent Trial and Appeal Board agreed with Immervision's expert and upheld the validity of the patents.

The Federal Circuit affirmed. Relying upon the 1970 decision in Yale, the Federal Circuit held that when a prior art reference includes an obvious typographical or similar error that would be apparent to one of ordinary skill in the art, and the skilled artisan would correct or disregard the errant information, "the errant information cannot be said to disclose subject matter."

The court also held that the board's finding that an obvious error occurred was factual in nature and reviewed only for substantial evidence.

Applying that deferential standard of review, the Federal Circuit affirmed. The court rejected LG Electronics' argument that the amount of work Immervision's expert needed to perform to uncover the error undermined the obvious nature of the error.

The court held that this was merely one factor to consider in the totality of the circumstances. Those circumstances, described in detail above, constituted substantial evidence of the obviousness of the error.

Federal Circuit Judge Pauline Newman dissented on this point, reasoning that the amount of work done by the expert, and the 20-year delay before the error was uncovered, were essentially dispositive.

The majority and dissent were apparently applying different definitions of the word obvious. Though not clearly articulated, the majority appeared to assume that an error is obvious if, after investigation, the erroneous nature of the disputed text is readily apparent to one skilled in the art. The dissent, in contrast, argued that an error is obvious only when it is apparent without significant investigation.

It will be interesting to see if the majority's approach is adopted by the Federal Circuit in other areas of the law that also apply an obvious error standard.

In particular, in the June 3 Pavo Solutions LLC v. Kingston Technology Company Inc.[3] **decision**, the Federal Circuit held that a district court may correct an obvious error in a patent claim.

That case did not require the court to discuss whether an error may be obvious even when substantial investigation is required to uncover the error.

Instead, the court held that typographical and clerical errors in claim language may be corrected when "the correction is not subject to reasonable debate based on consideration of the claim language and the specification," according to the decision.

That standard seems flexible enough to permit either the approach of the majority or the dissent in LG Electronics.

Regardless, when it comes to errors in the prior art, the law is now clear that even errors requiring significant investigation to uncover may be considered obvious errors, depending on the totality of the circumstances.

The obviously erroneous information does not form a part of the disclosure of the prior art and may not be used to invalidate a subsequent patent claim. The LG Electronics decision thus provides patent owners with a way to defend their claims against prior art that appears at first glance to be invalidating.

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[1] LG Elecs. Inc. v. Immervision, Inc., 2022 U.S. App. LEXIS 18948.

[2] Id. Fig. 11, Tbl. 5.

[3] Pavo Solutions LLC v. Kingston Tech. Co., 2022 U.S. App. LEXIS 15317.

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