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Federal Circuit Patent Bulletin: *X2Y Attenuators, LLC v. Int'l Trade Comm'n*

July 7, 2014

"[I]t is certainly possible that a clear and unmistakable disavowal in an incorporated patent is no longer so when placed in the context of the disclosure of the host patent. This, however, is not that case."

On July 7, 2014, in *X2Y Attenuators, LLC v. Int'l Trade Comm'n*, the U.S. Court of Appeals for the Federal Circuit (Moore,* Reyna, Wallach) affirmed the International Trade Commission's (ITC) decision that Intel Corporation and other intervenors did not violate 19 U.S.C. § 1337 because Intel's products were not covered by U.S. Patents No. 7,609,500, No. 7,916,444, and No. 8,023,241, which related to structures for reducing electromagnetic interference known as "parasitic capacitance" in electrical circuits. The Federal Circuit stated:

We conclude that the ITC correctly construed the electrode terms. The patents' statements that the presence of a common conductive pathway electrode positioned between paired electromagnetically opposite conductors is "universal to all the embodiments" and is "an essential element among all embodiments or connotations of the invention" constitute clear and unmistakable disavowal of claim scope. The standard for finding disavowal, while exacting, was met in this case. Specifically, we have held that labeling an embodiment or an element as "essential" may rise to the level of disavowal. Here, not only does the specification state that the "center common conductive pathway electrode" flanked by two differential conductors is "essential," but it also spells out that it was an "essential element among all embodiments or connotations of the invention."

The '350 patent's statement that the sandwich configuration is a "feature[] universal to all the embodiments" reinforces this conclusion. Like the "essential element" label, this phrase demonstrates a clear intention to limit the claim scope "using words or expressions of manifest exclusion or restriction." . . . X2Y's argument that some of the disclaimers are inapplicable because they appear only in priority patents to which the asserted patents are only related as continuations-in-part is without merit on the facts of this case. First, the "essential element" disavowal explicitly appears in one of the asserted patents, the '500 patent. Second, the asserted '500 and '444 patents incorporate by reference the priority '350 patent (which includes the "features universal" disavowal), and the '444 patent also incorporates by reference the '249 patent (which includes the "essential

element" disavowal). The incorporated patents are "effectively part of the host [patents] as if [they] were explicitly contained therein." As a result, the disclaimers of the incorporated patents are a part of the asserted patents. Of course, "incorporation by reference does not convert the invention of the incorporated patent into the invention of the host patent."

And it is certainly possible that a clear and unmistakable disavowal in an incorporated patent is no longer so when placed in the context of the disclosure of the host patent. This, however, is not that case. Although the '444 patent mentions that, "[a]s used generally therein," a conductive pathway could include electrode pairings that are "electrically null, electrically complementary, electrically differential, or electrically opposite," this teaching is not sufficient to blur the clear disavowals. The possibility that conductive pathways may include these structures is not inconsistent with the patents' statements that, of all the conceivable configurations, the sandwich configuration is a "feature[] universal" and "an "essential element" of the inventions of the asserted patents. These disavowals therefore limit the scope of the claims of the '444 and '500 patents. We agree with the ITC that, in light of the clear disavowals, the claims at issue are limited to "a common conductive pathway electrode positioned between paired electromagnetically opposite conductors." Because X2Y conceded noninfringement based on this construction, we need not reach any other issues.