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Federal Circuit Patent Bulletin: *ArcelorMittal France v. AK Steel Corp.*

May 15, 2015

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On May 12, 2015, in *ArcelorMittal France v. AK Steel Corp.*, the U.S. Court of Appeals for the Federal Circuit (Dyk, Wallach, Hughes*) affirmed-in-part, reversed-in-part, and remanded the district court's summary judgment that U.S. Patent No. RE44,153E (reissue of U.S. Patent No. 6,296,805), which related to a coated steel sheet having very high mechanical resistance after thermal treatment, was invalid under 35 U.S.C. § 251. The Federal Circuit stated:

The law-of-the-case doctrine "posits that when a court decides upon a rule of law, that decision should continue to govern the same issues in subsequent stages in the same case." "The mandate rule, encompassed by the broader law-of-the-case doctrine, dictates that 'an inferior court has no power or authority to deviate from the mandate issued by an appellate court.'" Under the mandate rule and the broader law-of-thecase doctrine, a court may only deviate from a decision in a prior appeal if "extraordinary circumstances" exist. But "such departures are rare."

ArcelorMittal argues that the Patent Office's reissue of the RE153 patent is "new evidence" sufficient to constitute "extraordinary circumstances" to deviate from our clear mandate and construction of "very high mechanical resistance" in claim 1. The "new evidence" exception permits courts to reconsider a previously decided issue in limited circumstances. "This exception . . . makes sense because when the record contains new evidence, 'the question has not really been decided earlier and is posed for the first time.'" "But this is so only if the new evidence differs materially from the evidence of record when the issue was first decided and if it provides less support for that decision." That is not the case here.

The successful prosecution of the RE153 patent is not "new evidence" sufficient to trigger the extraordinary circumstances exception to the mandate rule and the law-of-the-case doctrine. Permitting a reissue patent to disturb a previous claim construction of the original claims would turn the validity analysis under 35 U.S.C. § 251 on its head. The basic inquiry under § 251 requires comparing the scope of the claims of the reissue patent to the scope of the original claims to determine if the reissue patent "contains within its scope any conceivable apparatus or process which would not have infringed the original patent." If the reissue claim itself could be used to redefine the scope of the original claim, this comparison would be meaningless. . . .

[T]he dispositive question is whether the original claim has the meaning sought by ArcelorMittal for the reissue claims-not what the original claim means in light of the reissue claims. . . . Under certain circumstances, the prosecution history of reissue or reexamination proceedings may be relevant to determine the scope of an original claim. But we have never found that such reissue prosecution history is relevant to whether an applicant broadened the scope of an original claim in the§ 251 analysis. Nor could we, since such a finding would run contrary to the plain language and purpose of § 251.

Moreover, the prosecution history of a reissue claim can certainly be relevant to determine the scope of the reissue claim, and it is entirely possible that the prosecution history includes disavowals of claim scope that could preserve the reissue claim in the face of an apparent broadening. But that is not the case here. The only relevant change is the addition of a dependent claim which has the practical effect of expanding the scope of claim 1 to cover claim scope expressly rejected by a previous claim construction ruling, and ArcelorMittal makes no argument that the reissue claims are otherwise narrowed. . . .

Accordingly, the prosecution history of the reissue patent here is not "new evidence" of the scope of the original claims for the purposes of the § 251 inquiry. Under the law-of-the-case doctrine, therefore, the district court was bound by this court's prior construction of the original claims, which ArcelorMittal concedes was narrower than the scope of the reissue claims. Based on this prior construction, the district court correctly found that claims 1 through 23 of the reissue patent impermissibly broadened the original claims and are invalid under 35 U.S.C. § 251.

Having found claims 1 through 23 invalid under § 251, we must next determine the fate of claims 24 and 25, which both parties agree have the same scope as claim1 of the '805 patent-that is, they were not broadened on reissue. For the reasons set forth below, we find that the district court improperly focused on whether the patent had been improperly broadened, instead of undertaking a claim-by-claim analysis as required by statute and our precedent. . . .

Section 251 provides that "[n]o reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent" and a reissue patent may only be issued absent "deceptive intention" by the applicant. . . . Section 282 plainly states that a patent's claims are presumed valid independent of one another. And § 282 uses the same language to reference § 251 as it does §§ 100 et seq., which we have long held to only apply on a claim-by-claim basis. Moreover, the plain language of § 253 confirms that "[w]henever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid." Additionally, we have previously rejected the argument that a defective reissue application invalidates not only newly added reissue claims, but also original claims carried over from the original application. . . .

While claims 24 and 25 are not identical to the claims of the '805 patent since they identify the specific level "1500 MPa" as being the level of "mechanical resistance" rather than referring to "very high mechanical resistance," they nevertheless "repeat[ ] and separately state[ ]" the scope of claim 1 of the '805 patent as construed by the district court and later affirmed by this court. Appellees concede as much, and we are not persuaded to conclude otherwise. And, while we are mindful of the concerns over ArcelorMittal's attempts to modify the district court's claim construction through the reissue process, we are not persuaded that these policy concerns demand we part from our precedent. Accordingly, we find the district court erred in invalidating claims 24 and 25 of the RE153 patent.