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Continental Circuits LLC v. Intel Corp., et al: Federal Circuit Reemphasizes Prohibition on Importing a Preferred Embodiment into Patent Claims

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The Court of Appeals for the Federal Circuit (CAFC) recently issued a precedential [opinion](#) finding that a lower court had improperly incorporated an embodiment from the specification of the asserted patents into the claims. In its decision, the CAFC reaffirmed longstanding claim construction law: the claims of a patent are interpreted in light of a specification, but not everything expressed in the specification must be read into all of the claims.

Continental Circuits asserted four related patents against Intel and its distributor, all directed to multilayer electrical devices having a unique surface structure comprising “teeth” which enable one layer to mechanically grip to a second layer and methods for making such devices. The shared specification of the asserted patents discussed a “double desmear process” as a technique for forming the “teeth,” as distinguished from the prior art single pass desmear process. Both parties disputed the interpretation of multiple claim terms, and contested the proper impact of the desmear process on the scope of the claims.

Intel successfully argued that the specification’s description of the “double desmear process” requires the claimed “surface,” “removal,” or “etching” of the dielectric material to be “produced by a repeated desmear process.” The district court adopted this construction, explaining that the specification repeatedly distinguishes the patented invention from the prior art use of the “single desmear process” and characterizes “the present invention” as using a “double desmear process.” The district court also noted an expert declaration submitted during prosecution of the patent that indicated that the process disclosed in the specification utilized two separate “swell and etch steps.” Based upon the court’s claim construction order, the parties stipulated to non-infringement and the court entered judgment accordingly.

On appeal, Continental argued that the district court’s construction requiring the double—or “repeated”—desmear process improperly imported into the claims limitations found in the specification. The CAFC agreed, finding that none of the asserted claims actually recite a “repeated desmear process” and none of the statements in the specification rise to the level of a “clear and unmistakable disclaimer” that would limit the claim scope absent that express limitation. Even though the specification exclusively referred to a double or repeated desmear process, each reference described that process as “one technique” for forming the claimed teeth, as a way the present invention “can be carried out”, or as an “example.” The CAFC concluded that these equivocal and non-limiting statements are simply a description of how to make the claimed invention using a preferred process. As a result, they did not clearly limit the claimed devices and methods.

The court also emphasized its previous holdings that the claims of a patent are not necessarily limited to the only embodiment the specification might describe, and that even criticism of another potential embodiment does not



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rise to the level of clear disavowal such that it limited claim scope. Further, the court noted that the inventor declaration that the district court felt corroborated its claim construction finding merely explained that the written description disclosed “a technique” for forming the teeth of the claimed invention. Here again, the court concluded that this language does not rise to the level of a clear disavowal of claim scope.

Accordingly, the CAFC found that the district court erred in reading a “repeated desmear process” limitation into the asserted claims, despite its prevalence in the specification. This opinion provides helpful reminders to practitioners and patent owners on how claim terms must be construed. Notably, the CAFC reiterated that (1) the claims, themselves, provide substantial guidance as to the meaning of particular claim terms, (2) the specification can only re-define the plain and ordinary meaning of a word if done “clearly” and “unmistakably,” and (3) importation of a preferred embodiment into the claims as a limitation is impermissible.

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