

TEMPO LIGHTING, INC. v. TIVOLI, LLC, Appeal No. 2013-1140 (Fed. Cir. February 10, 2014). Before Rader, Moore, and Wallach. Appealed from PTAB.

Background:

Tivoli sued Tempo for patent infringement. In response to the suit, Tempo requested *inter partes* reexamination which stayed the litigation. During reexamination, the Examiner rejected the claims based, in part, on the Examiner's new construction of the claim limitation "inert to light."

The claims are drawn to a stair-step lighting apparatus which uses a reflective strip to render visible the edge of a step in a darkened environment. During the original prosecution, Tivoli amended the claims to recite a "non-photoluminescent material." The Examiner objected to the phrase as an improper negative limitation. In response, Tivoli amended the claims to recite a material "inert to light," also providing a definition of this phrase in the Amendment. The patent issued. Years later during the reexamination, the Examiner used a newly cited dictionary definition of "inert to light" to reject the claims.

Tivoli appealed the Examiner's decision to the Patent Trial and Appeal Board. The Board found the Examiner's claim construction based on extrinsic evidence to be improper and reversed the rejections. Tempo filed a request for rehearing which the Board denied. Tempo then appealed to the Federal Circuit.

Issue/Holding:

Did the Examiner improperly construe a claim limitation based on the use of extrinsic evidence that contradicted intrinsic evidence? Yes, vacated in-part and remanded.

Discussion:

The Federal Circuit sustained the Board's construction of the limitation "inert to light." Neither the language of the claims nor the disclosure of the patent provides a definition for "inert to light." Nevertheless, the Federal Circuit found that reliable intrinsic evidence existed in Tivoli's Amendment which included the change in claim language from "non-photoluminescent material" to material "inert to light." The definition provided in Tivoli's Amendment for the phrase "inert to light" became intrinsic evidence of the file history. The Federal Circuit maintained that extrinsic evidence may not be used to construe claim limitations where such extrinsic evidence is inconsistent with more reliable intrinsic evidence, such as definitions from the specification or the file history. The Federal Circuit also confirmed that the definition provided by Tivoli during prosecution did not contradict the disclosure, and thus held that the limitation "inert to light" should be construed in accordance with the definition provided by Tivoli in its Amendment.

Despite agreeing with the Board that the Examiner erred in claim construction, the Federal Circuit vacated the Board's decision reversing the Examiner's rejections because the Board improperly relied on factual findings that rested on the Examiner's improper claim construction.