

PROVERIS SCIENTIFIC CORP. v. INNOVASYSTEMS, INC., Appeal No. 2013-1166, -1190 (Fed. Cir. January 13, 2014). Before Lourie, Schall, and Prost. Appealed from D. Mass. (Judge Young).

Background:

Proveris sued Innova, alleging that Innova's Optical Spray Analyzer ("OSA") infringed Proveris' patent. Innova conceded the OSA infringed claims of the patent. The district court granted a permanent injunction prohibiting Innova from making, using, or selling the OSA. Innova then modified the OSA and began selling a new Aerosol Drug Spray Analyzer ("ADSA"). Innova argued the ADSA did not infringe the patent because the ADSA does not capture image data "at a predetermined instant in time," as recited in claim 3 of the patent. The district court entered a contempt order against Innova, implicitly finding the ADSA was not more than colorably different from the OSA. The district court issued sanctions against Innova based on the sales of the ADSA. Innova appealed both the contempt order and sanctions.

Issue/Holding:

Did the district court err in holding that Innova violated the injunction against continued infringement without engaging in claim construction analysis? Yes, vacated and remanded.

Discussion:

On appeal, the Federal Circuit applied a two-step test in evaluating whether an injunction against continued infringement has been violated: (i) whether the newly accused product is not more than "colorably different" from the infringing product; and (ii) if the differences are not more than "colorably different," whether the newly accused product in fact infringes the relevant claims. The Federal Circuit agreed with the district court's finding that the ADSA product is not more than colorably different than the infringing OSA product, because the two products are functionally identical.

The Federal Circuit then turned to the question of whether the ADSA actually infringed the patent, concluding that the district court erred by failing to engage in a claim construction analysis during the contempt proceedings. The district court declined to construe the disputed term because Innova had not raised arguments about the construction of claim 3 in the underlying infringement action. However, the Federal Circuit held that no prior claim construction had taken place due to Innova's concession that the OSA infringed the claim and that, accordingly, claim construction was required.

The Federal Circuit found that the preamble of the asserted claim imports a limitation into the claim. The preamble of a claim is limiting if it "recites essential structure or steps . . . necessary to give life, meaning, and vitality to the claim," or when "limitations in the body of the claim rely upon and derive antecedent basis from the preamble." Because the disputed term in the preamble of the claim satisfied these criteria, the Federal Circuit vacated and remanded for proper construction of the disputed language and to determine whether the ADSA infringes the claim and thus constitutes a violation of the injunction.