

X2Y ATTENUATORS, LLC v. INTERNATIONAL TRADE COMMISSION, Appeal No. 2013-1340 (Fed. Cir. July 7, 2014). Before Moore, Reyna, and Wallach. Appealed from International Trade Commission.

Background:

X2Y filed a complaint with the ITC alleging that Intel unlawfully imported certain products covered by X2Y's patents in violation of 19 U.S.C. §1337. During the investigation, the ITC found sufficient "specification disavowal" for the claims to require a particular configuration. Specifically, specifications of asserted patents state that this particular configuration is "an essential element among all embodiments or connotations of the invention" and incorporate by reference a statement that the particular configuration is "universal to all the embodiments." X2Y had conceded noninfringement to a claim construction including this particular configuration. As such, the ITC found no violation on the part of Intel. X2Y appealed.

Issue/Holding:

Did the ITC err in its claim construction? No, affirmed.

Discussion:

X2Y argued that the ITC erred in its construction of the claims requiring the particular configuration. First, X2Y argued that the specifications of the asserted patents contradict ITC's claim construction. In response, although the Federal Circuit acknowledged that the passages relied upon as contradicting the ITC's claim construction state that materials may vary, the Federal Circuit pointed out that the specification further states that the particular configuration is required "no matter which material is used." And, the Federal Circuit explained that this amounted to a clear and unmistakable disavowal of claim scope.

Further, X2Y argued that some of the disclaimers should not apply because they appear in priority patents that are related to the asserted patents only as continuations-in-part. With respect to this argument, the Federal Circuit noted that the disavowal appears in one of the asserted patents. Further, the Federal Circuit explained that "incorporated patents are 'effectively part of the host [patents] as if [they] were explicitly contained therein'" and thus any disavowal of an incorporated patent is part of the asserted patents.

Last, X2Y argued that the ITC relied upon permissive rather than mandatory language in its claim construction requiring the particular configuration. However, the Federal Circuit explained that the asserted patents contain statements that the particular configuration is "a feature universal" and "an essential element" of the inventions of the asserted patents. Thus, based on this clear disavowal of claim scope, the Federal Circuit agreed with the ITC's claim construction requiring the particular configuration.

Accordingly, the Federal Circuit affirmed the ITC's determination of no violation of 19 U.S.C. §1337.