

BELDEN, INC. v. BERK-TEK, LLC, Appeal No. 2014-1575, 1576 (Fed. Cir. November 5, 2015). Before Newman, Dyk and Taranto. Appealed from PTAB.

Background:

Belden's patent related to a method for making communications cables. In an inter partes review, the PTAB cancelled claims 1-4 as obvious over a combination of prior art references, but confirmed claims 5 and 6 (which were added by Belden in a 2010 ex parte reexamination). In upholding claims 5 and 6, the PTAB held that the prior art references being relied upon by Berk-Tek could not be understood to reasonably teach or suggest a method of manufacturing all types of twisted cable having a separator, in particular conventional twisted cable that includes twisted pairs of individually-insulated conductors. Belden appealed the cancellation of claims 1-4 and Berk-Tek appealed the upholding of claims 5 and 6.

Issue/Holding:

Did the PTAB err in (i) rejecting claims 1-4 of the patent and (ii) upholding claims 5 and 6 of the patent? No and yes.

Discussion:

While the Federal Circuit gives substantial deference to PTAB factual findings (such as the factual support for the obviousness analysis), it reviews questions of law (such as the ultimate determination of obviousness) de novo. On appeal, with respect to claims 1-4, Belden argued that the prior art reference does not teach making cables, but only transmission lines and disputed the PTAB's finding that the structure in the reference could be used to prevent twisting. The Federal Circuit held that neither of Belden's arguments had merit and that the findings of the PTAB were supported by substantial evidence. The reference discloses that the description relates to a method of manufacturing plastic insulated communication cables and that the claims of the patent did not limit the meaning of a "cable" to exclude a category of cables as taught in a JP reference. The Federal Circuit further held that in circumstances involving a simple point in a mechanical field and one very close piece of art, which the Federal Circuit felt were the circumstances in the present case, the PTAB was entitled to rely on its own reading of the reference. The Federal Circuit also held that the PTAB had ample basis for its obviousness determination based further on expert testimony.

Regarding claims 5 and 6, the PTAB did not deny that two pieces of prior art in combination suggest the subject matter recited in these claims, but found that there was no motivation to combine the references. The PTAB reasoned that the secondary reference shows conductors that are not individually insulated such that one of ordinary skill would not have been motivated to substitute twisted pairs of insulated conductors for bare metal conductors. The Federal Circuit held that the alignment problem being solved does not depend on whether the wires are insulated and stated that the PTAB violated the principle that a reference must be considered for everything it teaches by way of technology and is not limited to the particular invention it is describing and attempting to protect. The Federal Circuit similarly dismissed reasoning used by the PTAB with respect to the method used to twist the wires being a reason not to combine the references.

The Federal Circuit also affirmed the PTAB's denial of a motion to exclude the declaration of Berk-Tek's expert, finding that it was properly submitted in a Reply because it fairly responded to a declaration by Belden's expert.