

PRESIDIO COMPONENTS, INC. v. AMERICAN TECHNICAL CERAMICS CORP., Appeal Nos. 2016-2607, 2016-2650 (Fed. Cir. November 21, 2017). Before Dyk, Moore, and Taranto. Appealed from S.D. Cal. (Judge Huff).

Background:

Presidio sued American Technical Ceramics Corp. ("ATC") for infringement of the '356 patent, directed to a multilayer integrated network of capacitors. While the suit was pending, ATC successfully sought *ex parte* reexamination. During reexamination, Presidio amended claim 1 to recite, in the relevant portion, contacts sufficiently close "in an edge to edge relationship in such proximity as to form a first fringe-effect capacitance... that is capable of being determined by measurement in terms of a standard unit." Presidio amended its infringement complaint in view of the amended claims. The district court granted ATC's motion for summary judgment on the affirmative defense of absolute intervening rights. In a subsequent jury trial, the jury found infringement of all asserted claims. The court rejected ATC's contention that the claims of the '356 patent were invalid for indefiniteness.

Issues/Holdings:

1. Are the claims of the '356 patent invalid for indefiniteness? No, affirmed.
2. Did the amendment to claim 1 during reexamination entitle ATC to absolute intervening rights? Yes, affirmed.

Discussion:

Regarding the indefiniteness issue, the main consideration was whether a POSITA would have understood how to measure fringe-effect capacitance of a multilayer capacitor. While methods of measuring the overall capacitor performance were known, ATC argued that it was unclear how fringe-effect capacitance could be measured using any known methods. The Federal Circuit found that although the '356 patent does not describe any method of measuring fringe-effect capacitance, a POSITA would have known how to measure fringe-effect capacitance by modifying the established method for measuring overall capacitance disclosed in the '356 patent. This was substantiated by expert testimony from Presidio. The Federal Circuit further opined that, unlike situations in which the claims recite a value (or range of values) for which different tests may produce different results, the claims at issue do not specify any particular amount of fringe-effect capacitance, instead merely reciting an amount capable of being measured. The Federal Circuit then distinguished the indefiniteness at issue from disputes as to infringement, in which the fact that different test methodologies produce different values is relevant. Thus, the Federal Circuit found the claims were not indefinite.

Regarding intervening rights, during the reexamination, Presidio added the underlined language above to claim 1. Presidio argued it did not intend to change the claim scope, but intended only to match the claims to the claim construction from a prior lawsuit. The Federal Circuit stated that the Patentee's intent is not determinative or controlling; instead, the relevant inquiry is whether the scope of the amended claims is actually identical to the scope of the original claims. Presidio's reexamined claim 1 did not exactly match the language from the claim construction from the prior lawsuit and was considered to narrow the scope of the original claim. Thus, the Federal Circuit held that ATC was properly afforded a defense of absolute intervening rights.