

ARENDI S.A.R.L.v. GOOGLE LLC, Appeal No. 2016-1249 (Fed. Cir. Feb. 20, 2018). Before Newman, Bryson, and Moore. Appealed from the PTAB.

Background:

The Patent Trial and Appeal Board (PTAB) instituted *inter partes* review (IPR) of a patent owned by Arendi and concluded that the patent would have been obvious over prior art. The patent claims a process for substituting information in an electronic document upon "a single entry" of the execute command. The prior art discloses an e-mail system that automatically searches, retrieves and inserts information based on typing-in of a recipient name. Arendi argued the prior art does not disclose the "single entry" feature, and the scope of its patent claim was narrowed by a prosecution disclaimer. During prosecution, Arendi amended the claim to recite "a single entry" limitation to overcome a reference which is similar to the prior art cited in the IPR. Arendi's prosecution attorney explained during an interview with the examiner and in the remarks accompanying the amendment that, unlike the reference, the claim does not require the user to select a text string to be searched. The examiner cited this difference as a reason for allowance in the Notice of Allowability.

In invalidating Arendi's patent for obviousness, the PTAB concluded that a prosecution disclaimer does not apply because it was the examiner, not applicant, who narrowed the scope of the claim. Thus the "single entry" of the patent was interpreted to include the typing-in of the recipient name of the prior art, thereby rendering the patent obvious. Alternatively, the PTAB held that even if a prosecution disclaimer applies, the claim still would have been obvious over the prior art.

Issue/Holding:

Did the PTAB error in holding that Arendi's patent would have been obvious over the prior art? No, affirmed.

Discussion:

The Federal Circuit held that the PTAB erred in finding no prosecution disclaimer. During prosecution, Arendi amended the claim to explicitly recite the "single entry" limitation, and explained during the interview with the examiner and in the remarks accompanying the amendment why the amendment was being made and how it distinguished the cited reference. Thus, it was Arendi, not the examiner, who narrowed the scope of the claim, and Arendi's statements were sufficient to rise to a prosecution disclaimer.

However, the Federal Circuit held that the PTAB's alternative ruling is correct in that the narrower scope of the claim still would have been obvious over the prior art. The Federal Circuit agreed with the PTAB that, unlike Arendi's argument, the prior art system does not require the user to select a text string to be searched, which is the subject matter disclaimed. Rather, a person of ordinary skill in the art reading the prior art would understand that the "check names" command in the prior art is the same as the single execution command of the patent, and thus the prior art discloses analyzing presence of certain information (i.e., recipient name) upon a single entry of the execution command (i.e., "check names" command), and automatically searching and inserting other information, as claimed. Thus, the Federal Circuit held that substantial evidence supports the PTAB's finding that there are no patentable differences between the prior art and Arendi's patent, and the PTAB's decision of unpatentability is affirmed.