

D THREE ENTERPRISES, LLC v. SUNMODO CORPORATION, Appeal Nos. 2017-1909 and -1910 (Fed. Cir. May 21, 2018). Before Reyna, Clevenger and Wallach. Appealed from D. Colo. (Judge Shaffer).

Background:

D Three sued SunModo and Rillito River for infringing claims of three patents directed to roof mount sealing assemblies. SunModo's products were available to the public in 2010, and Rillito River's products were available in 2009. In order to antedate these products, D Three needed to rely on the earliest effective filing date of the priority application (February 5, 2009) for written description support.

The district court determined that the asserted claims could not rely on the February 5, 2009, priority date because the asserted claims were broader than the invention disclosed in the priority application. As a result, the district court found the defendants' products to be intervening prior art that rendered the asserted claims invalid. D Three appealed.

Issue/Holding:

Did the district court err in holding that the claims were not entitled to the priority date and thus invalid? No, affirmed.

Discussion:

On appeal, D Three argued that the district court erred in granting summary judgment because there was a genuine issue of material fact as to whether the priority application provided sufficient written description for the asserted claims. In particular, D Three asserted that the priority application adequately disclosed and envisioned the claimed embodiments.

The asserted claims were divided by the district court into two categories: "washerless" claims that did not recite a washer, and washer claims that recited a washer. With respect to the washerless claims, the Federal Circuit found that, although there was one washerless embodiment in the priority application, the embodiment required a very specific type of attachment bracket. Because the asserted washerless claims were broad enough to cover other types of attachment brackets, the Federal Circuit affirmed the district court's holding that the priority application lacked written description for the overly broad washerless claims. The Federal Circuit further held that the boilerplate catch-all paragraph at the end of the priority application was insufficient to provide written description for other unidentified specific washerless embodiments.

With respect to the washer claims, the Federal Circuit found that the priority application disclosed only embodiments with the washer located above a flashing. Thus, there was no support for the asserted washer claims reciting the washer below the flashing, or reciting the washer as either above or below the flashing. D Three argued that the disclosure of a washerless embodiment in combination with the disclosure of an embodiment locating the washer above the flashing clearly envisioned various washer arrangements and thus supported the asserted claims placing the washer below the flashing. The Federal Circuit disagreed, emphasizing that the written description inquiry addresses what is clearly disclosed, not what is permissible. The district court's judgment of invalidity was affirmed.