

COCHLEAR BONE ANCHORED SOLUTIONS AB v. OTICON MEDICAL AB,  
Appeal Nos. 2019-1105, -1106 (Fed. Cir. May 15, 2020). Before Newman, O'Malley, and  
Taranto. Appealed from PTAB.

Background:

Oticon sought inter partes review of patented claims directed to a bone-anchored hearing aid, which transmits soundwaves transcranially from a patient's deaf side to the patient's non-deaf ear by selectively amplifying higher-frequency soundwaves (which weaken in strength as they traverse the skull).

The claims recited in the preamble that the hearing aid was "for rehabilitation of unilateral hearing loss." The patentee argued that the prior-art references taught away from use of their devices in patients with profound hearing loss, and the references were not combinable in light of the preamble. The Board disagreed, holding that the language of the preamble was not limiting.

The Board decided that it was impossible to conduct a prior-art analysis with respect to certain claims that recited means-plus-function limitations where the specification did not disclose any corresponding structure, and thus concluded that unpatentability could not be shown with respect to those claims.

Issues/Holdings:

Did the Board err in its claim construction? No—affirmed.

Did the Board err in its conclusion that unpatentability could not be determined with respect to the claims reciting means-plus-function features? Yes, in part—affirmed in part, vacated in part, and remanded.

Discussion:

The Federal Circuit agreed with the Board that the claim preamble was not necessary to "give life, meaning, and vitality to the claim" and therefore was not limiting. The court held that the preamble language was merely a statement of intended use, and added no structural elements. The preamble also did not provide antecedent basis for the body of the claim.

The court also held that the Board was correct not to conduct a prior-art analysis with respect to any claims reciting a means-plus-function limitation where there was no disclosed corresponding structure if the limitation was an essential element of the claim. One of the claims at issue recited one such means-plus-function limitation in the alternative (using "and/or" language), and thus the feature was not an essential element because a prior-art analysis could still be conducted with respect to the claimed embodiment that did not require the means-plus-function limitation. The court noted that with respect to the other claims for which unpatentability could not be determined, the petitioner would not be estopped from challenging those claims in other proceedings.