

PRESIDIO COMPONENTS, INC. v. AVX CORP., Appeals Nos. 2019-2181 and 2019-2182 (Fed. Cir. September 23, 2020). Before O'Malley, Bryson, and Reyna. Appealed from PTAB.

### Background:

Presidio owned a patent directed to capacitor structures with monolithic bodies containing several capacitors. AVX filed a petition for IPR, arguing that the independent claim of the patent was unpatentable as obvious. The claim limitation most at issue recited that at least one of two external surfaces along which conductors of the capacitor lie is "adapted to be positioned substantially parallel to a major surface of a circuit board."

The PTAB did not specifically determine whether "adapted to be" in this context should be interpreted as "designed to be" or merely as "capable of being," but it instead held that the claim would be unpatentable as obvious under either interpretation. The PTAB thus ruled the claim at issue to be unpatentable over two references, Kuroda and Li, which the PTAB asserted disclosed the feature under either interpretation of "adapted to be." Presidio appealed.

### Issue/Holding:

Was the PTAB's finding of obviousness supported by substantial evidence? Yes, affirmed.

### Discussion:

Presidio argued that Federal Circuit precedent requires "adapted to" to be construed as "made to," "designed to," or "configured to" and that, under this construction, the conductors in Kuroda were not "adapted to be positioned substantially parallel to a major surface of a circuit board," as the claim required. Specifically, Presidio argued that this limitation requires the external surface to be configured to be vertically mounted to a circuit board. Presidio thus asserted that, because the conductors in Kuroda were shown to be mounted horizontally, they were not "adapted" for bonding to the surface of a circuit board, which, in turn, would require vertical mounting.

The Federal Circuit disagreed with Presidio. Although it acknowledged that Federal Circuit precedent has held that "adapted to" should be construed as "made to," "designed to," or "configured to" when the specification discloses structural features that render the claimed apparatus suitable for a particular claimed function, these precedents did not create a bright-line rule for interpreting "adapted to." Instead, the Federal Circuit determined that, in the present case, Presidio had "failed to identify for the [PTAB] any structural features of the claimed device as described in the specification that make it especially suitable for vertical mounting" and thus for bonding to a surface of a circuit board. The Federal Circuit thus held that the claim was unpatentable, so long as the capacitor in Kuroda was "capable of" being mounted vertically.

The Federal Circuit pointed to uncontested evidence that the device in Kuroda had all of the structural features shown in a figure of the patent at issue, which had been acknowledged as embodying the claim, and determined that the only relevant difference between the figure and the device in Kuroda was a 90-degree rotation. Accordingly, the Federal Circuit found the device in Kuroda to be "adapted to" be mounted vertically. Thus, the Federal Circuit held that the PTAB's finding that the claim was unpatentable as obvious over Kuroda and Li, which taught the benefits of vertical mounting to a circuit board, was supported by substantial evidence.