

KAMSTRUP A/S v. AXIOMA METERING UAB, Appeal No. 2021-1923 (Fed. Cir. August 12, 2022). Before Reyna, Mayer, and Cunningham. Appealed from PTAB.

Background:

Kamstrup owns a patent directed to an ultrasonic flow meter housing in the form of a monolithic polymer structure being cast in one piece. The specification explains the flow meter "can be fabricated with a reduced number of steps compared to existing meters, since only a single step is used to form the monolithic polymer structure."

Axioma petitioned for *inter partes* review (IPR) of all claims of Kamstrup's patent. The Board found each claim unpatentable as either anticipated or obvious because the Board construed the claim term "being cast in one piece" to be a product-by-process claim element (among other things). Kamstrup appealed.

Issue/Holding:

Did the Board err in construing "being cast in one piece" as a product-by-process claim element? No, affirmed.

Discussion:

The Federal Circuit explained that product-by-process claims enable an applicant to claim an otherwise patentable product that resists definition other than by the process by which it is made. Where a product-by-process element is recited in the claim, structural and functional differences distinguishing the claimed product from the prior art must be shown in order for that claim element to be relevant to an anticipation or obviousness determination. If no structural or functional differences are shown, the element is given no patentable weight. The differences do not have to be explicitly recited in the claim, but the specification, the prosecution history, and any extrinsic evidence must enlighten whether structural and functional differences exist. Turning to this case, there are two questions at issue.

The first question is whether the Board correctly determined that "being cast in one piece" is a product-by-process claim element. The Federal Circuit agreed with the Board that the claim element is directed to a product-by-process since it describes the structure "being" cast in a particular way. Furthermore, Kamstrup's argument related to the description in the specification (i.e., the flow meter "can be fabricated with a reduced number of steps compared to existing meters, since only a single step is used to form the monolithic polymer structure") was considered as additional support that the phrase "being cast in one piece" constitutes a product-by-process claim element.

The second question is whether the product-by-process claim element imparts patentable weight to the claims. The Federal Circuit agreed with the Board that it did not. In that respect, Kamstrup did not identify any disclosure in the specification, prosecution history or extrinsic evidence of any structural or functional differences between the claimed housing element and the prior art. The Federal Circuit thus held that, because Kamstrup failed to show that the "casting" process imparts "structural and functional differences" that distinguished the claimed housing from the prior art, it is not entitled to patentable weight.