



Archetype IPSM

Federal Circuit Friday

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February 2018

Question: When is a process step in a product-by-process limitation really a structural limitation to be considered in determining patentability during prosecution?

Answer: Either when the applicant demonstrates that it connotes structure *or* when the structural nature "can be gleaned from the plain claim language and the specification."

In re Nordt (Fed. Cir., February 8) reversed a Board rejection of a claim to a knee brace that recited several "injection molded" parts. The rejection was maintained because (i) the specification described injection molding only as a preferred process of manufacturing the knee brace, (ii) the Examiner and the Board interpreted the claim as a product made by a recited process, and (iii) the patentee failed to explain what structural limitation was provided by the injection molding process.

The Federal Circuit cited the general rule of *In re Thorpe*, 777 F.2d 695 (Fed. Cir. 1985) that process steps in a product claim are not given patentable weight and patentability is therefore determined based solely on the recited product itself, but explained that where "the process limitation connotes specific structure and may be considered a structural limitation, however, that structure should be considered."

Acknowledging that the patentee failed to explain what structure was imparted by "injection molded," the Federal Circuit found that the specification nevertheless described injection molding as "forming an integral component" wherein multiple sub-components are "integrally formed from elastomeric materials," thus suggesting "an integral structure." Further, where claim language "can connote with equal force a structural characteristic of the product or a process of manufacture," the words are "commonly and by default interpreted in their structural sense, unless the patentee has demonstrated otherwise." Because the specification indicated structure and the patentee consistently (albeit not persuasively) argued that it was structural, the Federal Circuit held that the words "injection molded" should be interpreted as structural and given weight for purposes of patentability.

So, how does this case fit into the overall analytic framework for product-by-process claims?

In prosecution, the algorithm is:

- 1) Identify putative process-of-making language in a claim;
- 2) Using standard claim construction principles, determine whether that putative process language connotes structure, and . . .
 - a. *if so*, then the claim is not really "product-by-process" and the language receives patentable weight as structure;
 - b. *if not*, then the claim is "product-by-process," the Examiner may reject the claim over a similar prior art product (regardless of how made or whether the prior art reveals how it was made), and the burden is on the applicant to distinguish the claimed product from the prior art product based on structure; and
 - c. If the words can equally refer to structure or process of making, then presume that it is structural absent contrary statements by the patentee.

Remember that in litigation, however, process-of-making language in a product claim is always a limitation such that an accused product that is not made using the recited process does not infringe. See, e.g., *Abbott Laboratories v. Sandoz, Inc.*, 566 F.3d 1282, 1291-93 (Fed. Cir. 2009)(en banc).

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