



PTAB Changes Final Written Decision Upon Rehearing and Finds Additional Claim Unpatentable

Feb 15, 2017

Reading Time : **2 min**

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On rehearing, the PTAB concluded that it misinterpreted Claim 2 and modified its Final Written Decision to find Claim 2 anticipated by the prior art. The PTAB's modification was based on the disputed limitation: "a plurality of the coordinate-designated set of traces have the same coordinates." In its original decision, the PTAB temporally limited the disputed limitation to occur after the organizing step of Claim 1. The patent owner argued that the "plurality" of traces cited in Claim 2 must be the plurality of traces that were organized into a bin in Claim 1. The petitioner asserted that the disputed limitation is not temporally limited and is instead tied to the creation of the coordinates from the survey data and survey geometry, found earlier in Claim 1, and not the later organization step. The disputed limitation defined a characteristic, namely, that the plurality has the same coordinates as each other and not a timing sequence. The Board acknowledged that it did not explicitly construe Claim 2 as requiring the organizing step to be performed before it could be determined whether "a plurality of the coordinate-designated set of traces have the same coordinates." The Board agreed with the petitioner that the disputed limitation is tied to the assignment of coordinates, not to the organizing step. Thus, the Board held that it misconstrued Claim 2, and, under the correct interpretation, the prior art disclosed Claim 2.

The dissent disagreed with the majority's finding that the disputed limitation in Claim 2 modifies only the "assigning" limitation in Claim 1. The majority, however, rejected the patent owner and dissent's attempt to propose a construction that looked to exemplary embodiments disclosed in the specification to unduly narrow the claim. The majority declared that such a construction would exclude the broader, plain and ordinary meaning,

and that it runs counter to the law prohibiting the import of limitations from an embodiment in the specification into the claims. *Citing Phillips v. AWH Corp.*, 415 F.3d 1303, 1320 (Fed. Cir. 2005) (en banc). The dissent also looked at two other claims to make its point, but the majority dismissed its use of one claim that did not include the limitations that were at issue, and determined that the other claim was different from Claim 2.

Westerngeco LLC v. PGS Geophysical AS, Case IPR2015-00313 (PTAB Feb. 3, 2017) (Paper No. 43).

Categories

Patent Trial & Appeal Board

Unpatentability

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