



Federal Circuit Overturns PTAB's Unreasonably Broad Claim Construction in Favor of Previously Affirmed District Court Construction

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In 2004, Power Integrations, Inc. asserted U.S. Patent No. 6,249,876 (“the ’876 patent”) against Fairchild Semiconductor International, Inc. in the District of Delaware. The ’876 Patent is entitled “Frequency Jittering Control for Varying the Switching Frequency of a Power Supply” and describes a “technique for reducing electromagnetic interference (“EMI”) noise by jittering the switching frequency of a switched mode power supply.” Decision at 2. Each of the asserted claims involves the coupling of a “counter” and an “oscillator” or other similar component. For example, claim 1 requires “a counter coupled to the output of the oscillator, the digital to analog converter coupled to the counter, the counter causing the digital to analog converter to adjust the control input and to vary the switching frequency of the power supply.” Decision at 2. At issue in these proceedings was the construction of the term “coupled” as used in the asserted claims.

The patent-at-issue was the subject of multiple district court proceedings, appeals to the Federal Circuit and an *ex parte* reexamination. In the first district court proceeding, the court adopted the patent owner’s proposed construction for the “coupled” term, “concluding that it was ‘consistent with the claim language and the context of the specification which describes the purpose.’” Decision at 4 (internal citations omitted). Subsequently, the jury returned a verdict of nonobviousness, and the Federal Circuit affirmed on appeal. In a second proceeding, the Federal Circuit affirmed another jury’s determination of no anticipation.

During the pendency of the district court proceedings, the U.S. Patent and Trademark Office (USPTO) granted a request for *ex parte* reexamination of several claims of the patent-at-issue.

The examiner rejected the claims. On appeal to the Board, the patent owner pointed to the district court's claim construction, but its arguments were rejected in favor of a broader construction based solely on a "generalist dictionary." Decision at 6.

Following the Board's denial of a petition for rehearing, the Federal Circuit vacated the Board's decision because "it had 'fundamentally misconstrued [Patent Owner's] principal claim construction argument and failed to provide a full and reasoned explanation of its decision.'" Decision at 7. The Federal Circuit explained further that, although the Board "is not generally bound by a prior judicial construction of a claim term," because patent owner's "principal argument to the [B]oard about the proper interpretation of the term . . . was expressly tied to the district court's claim construction, . . . the [B]oard had an obligation . . . to evaluate that construction and to determine whether it was consistent with the broadest reasonable construction of the term." Decision at 7.

On remand, the Board determined that "a comparison of its claim construction with that of the district court was 'unwarranted'" and affirmed the examiner's rejection based on the same construction that it had applied previously. Decision at 8. The patent owner subsequently appealed.

On appeal, the Federal Circuit addressed the differences between the district court and Board claim constructions and found that the Board's "claim construction [] was unreasonably broad and improperly omitted any consideration of the disclosure in the specification." Decision at 10. In particular, the Federal Circuit noted that the USPTO "acknowledge[d] that claim 1 requires some type of 'functional relationship,'" but the Board's "claim construction d[id] not define what type of functional relationship [was] required." Decision at 10-11. The Federal Circuit further noted that the Board's claim construction "renders [the] claim language meaningless" and is "unsupported by the specification." Decision at 11-12. For these reasons, the Federal Circuit determined that the district court's construction, which was "firmly rooted in the plain claim language and the specification, comports with the broadest reasonable construction of the term." Decision at 16. Based on this construction, the Federal Circuit reversed the Board's affirmation of the examiner.

In this instance, the Federal Circuit demonstrated a willingness to overturn the Board's determination of the broadest reasonable interpretation where that interpretation was unsupported by the intrinsic record. It further provided an example of a claim limitation for

which the proper construction was the same under both the district court and USPTO standards.

In Re: Power Integrations, Inc., No. 2017-1304 (Fed. Cir. Mar. 19, 2018)

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Federal Circuit

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