



Patent Owner's Statements Made During Inter Partes Review Constitute Disclaimer, Leading to Summary Judgment of Noninfringement

Nov 21, 2018

Reading Time : **1 min**

By: Matthew George Hartman, Rubén H. Muñoz

In the litigation, patent owner Radware and accused infringer F5 Network, each filed summary judgment motions on the issue of infringement, which centered on the construction of the claim term “decision function.” Both parties agreed to construe the term as “function used to decide which data route is selected based on its parameters;” however, the court determined that the agreed-upon definition was ambiguous because “its” could refer to either “data route” or “function.” To resolve the conflict, the court relied on Radware’s argument during IPR that “its” referred to “data route” parameters to conclude that—as a matter of law—the input for “decision function” was limited to data route parameters. The court held that Radware could not broaden the meaning of the term in view of its IPR statements.

Relying on Federal Circuit law, the court explained that “statements made by the patent owner during inter partes review put the public on notice of how the patent owner views its patent.” The court held that “[e]ven if the PTAB may not have expressly adopted Radware’s interpretation, the public is still entitled to rely on it.” Accordingly, the court denied Radware’s motion for summary judgment and granted F5 Network’s summary judgment motion of noninfringement.

Practice Tip:

When presenting arguments in an IPR proceeding to distinguish prior art, patent owners must be cognizant of the potential disclaimer effects of their arguments on ongoing or future litigation. In district court litigation, patent owners will be bound by their IPR arguments,

which may foreclose certain infringement theories. Further, whether the PTAB relies on such arguments is immaterial to whether the arguments serve as a disclaimer.

F5 Networks, Inc. v. Radware, Inc., No. 17-cv-03166-VC, slip op. (N.D. Cal. Nov. 19, 2018).

Categories

District Court

Non-Infringement

Inter Partes Review

© 2025 Akin Gump Strauss Hauer & Feld LLP. All rights reserved. Attorney advertising. This document is distributed for informational use only; it does not constitute legal advice and should not be used as such. Prior results do not guarantee a similar outcome. Akin is the practicing name of Akin Gump LLP, a New York limited liability partnership authorized and regulated by the Solicitors Regulation Authority under number 267321. A list of the partners is available for inspection at Eighth Floor, Ten Bishops Square, London E1 6EG. For more information about Akin Gump LLP, Akin Gump Strauss Hauer & Feld LLP and other associated entities under which the Akin Gump network operates worldwide, please see our Legal Notices page.