

Looking Below the Surface for Claim Construction

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In *University of Massachusetts v. L'Oréal S.A.*, the Federal Circuit reversed the district court's claim construction that underlay its finding of indefiniteness, which was vacated. The district court's claim construction had been advanced by the patent owner and adopted by the USPTO Patent Trial and Appeal Board during Inter Partes Review (IPR) proceedings, and helped the patents avoid IPR review. Thus, although the Federal Circuit's adoption of a different claim construction may spare the patents from indefiniteness, it may leave them vulnerable to challenge on other grounds.

This decision also is interesting because the Federal Circuit found that the claim language at issue was ambiguous, and so relied on the prosecution history for its claim construction without requiring the prosecution history to reveal "clear and unmistakable disclaimer" of a plain meaning,

The Patents At Issue

The patents at issue were U.S. Patent No. 6,423,327 and U.S. Patent No. 6,645,513, owned by U. Mass. The patents are related as parent and child, and are directed to "methods for enhancing the condition of non-diseased skin by topical application of ... adenosine."

The Federal Circuit treated claim 1 of the '327 patent as representative:

1, A method for enhancing the condition of unbroken skin of a mammal by reducing one or more of wrinkling, roughness, dryness, or laxity of the skin, without increasing dermal cell proliferation, the method comprising topically applying to the skin a composition comprising a concentration of adenosine in an amount effective to enhance the condition of the skin without increasing dermal cell proliferation, wherein the adenosine concentration applied to the dermal cells is 10^{-4} M to 10^{-7} M.

The Claim Construction At Issue

The patents describe human skin as including "a surface layer called the epidermis and a deeper layer called the dermis." Thus, on its face, claim 1 of the '327 patent recites topically applying a composition to skin (i.e., to a skin surface) and also that a certain concentration is applied to dermal cells (i.e., cells in a layer below the surface). The claim construction issue was focused on the meaning of the last clause, while the indefiniteness issue focused on the "applying" clause.

In the IPR proceedings, L'Oréal argued that the concentration in the last clause is the “adenosine concentration in the composition that is topically applied to the skin surface,” while U. Mass argued that it is “the adenosine concentration applied to the dermal cells in the dermis below the epidermis.” The PTAB adopted U. Mass's construction, and denied institution of the IPRs because L'Oréal “had not pointed to any measurement of concentrations beneath the skin surface in the prior art invoked against the patents.”

The district court adopted the same claim construction, and granted L'Oréal's motion for summary judgement of indefiniteness because “the concentration recited in the wherein clause concerns application to the subsurface dermal cells” and “does not establish the adenosine concentration in the composition topically applied to the skin.”

On appeal, U. Mass challenged the holding of indefiniteness, but maintained that the last clause refers to the adenosine concentration achieved in the dermal cells after application of the composition to the skin surface.

The Federal Circuit Decision

The Federal Circuit decision was authored by Judge Taranto and joined by Judges Prost and Mayer.

The Federal Circuit reviews claim construction de novo, and in this case found the district court had erred. The Federal Circuit noted, “the relevant claim language, especially when viewed in the context of the whole claim, is not plain on its face,” but rather “contains evident uncertainties” that weighed against U. Mass's construction. On the other hand, the court found that the specification and prosecution history “show that the wherein clause should be read to refer to the concentration of adenosine in the composition applied to the skin's surface.”

The Federal Circuit commented on the following:

- The specification describes compositions having adenosine concentrations of 10^{-4} M to 10^{-7} M.
- The specification does not describe “specific numerical molar concentration figures ... after seepage through the skin into the dermis” or “a measurement of concentration as an amount of adenosine per unit of volume of dermal cells.”
- The last clause was added during prosecution based on a dependent claim that recited “wherein the adenosine concentration is 10^{-4} M to 10^{-7} M” and the amendment was characterized as “merely include[ing] a range of concentrations of adenosine recited in dependent claims.”
- The applicants distinguished prior art references “in which concentrations are measured before application to the skin ... at least in part by directly comparing” the concentrations “with no suggestion of a difference in location of concentration measurement.”
- The examiner's reasons for allowance stated. The “[i]nstant claims are directed to a method of enhancing the condition of unbroken skin . . . where the method comprises administering adenosine at a concentration of 10^{-4} M to 10^{-7} M, to the skin.”
- Although the applicants filed comments on the reasons for allowance in the '327 patent

noting that “the claimed concentration of adenosine is applied to the dermal cells,” the comments “merely recited the ambiguous claim language; it did not communicate a disagreement with the examiner’s clear statement of what that language meant.”

- Applicants did not make the same statement in the comments on the reasons for allowance in the ’513 patent.

The Federal Circuit concluded:

We hold that this prosecution history requires that the wherein clause’s reference to the recited concentrations being “applied to the dermal cells” be read as referring to concentrations of the composition applied to the skin’s surface.

The Foundational Nature of Claim Construction

The history of this case underscores the foundational nature of claim construction, and the widespread consequences a given claim construction may have. U. Mass’s claim construction appears to have spared the patents from IPR review, but led them to be invalidated as indefinite. The Federal Circuit’s claim construction could lead to a finding of non-infringement by L’Oréal, or leave the patents vulnerable to challenge on other grounds.

The Federal Circuit’s discussion of the prosecution history suggests that if applicants have specific concerns about a statement in an examiner’s reasons for allowance, they should consider filing comments that “communicate a disagreement” and clarify the record. Boilerplate language may not be sufficient to disavow specific statements.

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