

Claim Construction Error Fuels Remand

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The US Court of Appeals for the Federal Circuit vacated and remanded a district court's noninfringement decision, finding that the district court improperly construed the asserted claims as requiring a dual-fuel system. *Ethanol Boosting Sys., LLC v. Ford Motor Co.*, Case No. 21-1949 (Fed. Cir. July 18, 2022) (**Moore**, Hughes, JJ.) (Newman, J., dissenting) (non-precedential).

Ethanol Boosting Systems (EBS) filed suit against Ford for infringement of three patents relating to fuel management systems for spark ignition engines that include both a direct injection and a port fuel injection fueling system. During claim construction, Ford argued that the direct injection fuel system required "a fuel that contains an anti-knock agent . . . that is different from the fuel used for port injection." The district court agreed with Ford, relying on the patents' titles, figures and background sections. The district court noted that no figures depicted a single fuel engine, and that the specification repeatedly referenced direct injection of a non-gasoline fuel, such as ethanol, into a gasoline engine. The district court acknowledged that the specification made a singular reference to a 100% ethanol embodiment but found that this disclosure did not teach a single fuel engine and that it was in the context of a dual-fuel engine. In view of this construction, the parties stipulated to judgment of noninfringement. EBS appealed.

Reviewing claim construction *de novo*, the Federal Circuit found that nothing in the asserted claim language required the use of different fuels in the direct-injection and port-injection systems. The Court also found that the specification imposed no such requirement, relying on one embodiment that disclosed "100% of the fuel . . . come[s] from ethanol with a smaller fraction being port injected." The Court rejected Ford's citation to multiple passages requiring the use of two fuels, finding that those statements could not describe the invention as a whole because they did not describe all embodiments (namely, the aforementioned 100% ethanol embodiment). Ford also cited to an earlier Federal Circuit decision in which family members of the asserted patents were construed to require dual fuels. The Court disagreed, concluding that those patents had different specifications that did not disclose the 100% ethanol embodiment. The Court finally turned to the prosecution history of a different patent family member that has the same specification as the asserted patents. In that application's prosecution history, the patent holder distinguished a prior art reference on the ground that it only used a single fuel type. The Court declined to import such a limitation from a statement made in that prosecution history because it did not reflect the claim language. The Court concluded that the district court erred in construing the claims to require a dual-fuel system and remanded the case for further proceedings.

Judge Newman issued a stinging dissent, taking the panel majority to task for departing from what she regarded as settled claim construction law. She agreed with the district court that the 100% ethanol example, considered in context, was “merely discussing how this dual fuel engine can adjust the relative amounts of ethanol and gasoline used and contemplating the fact that under certain conditions the use of ethanol may go up to 100 percent.” Judge Newman also found compelling Ford’s explanation that the 100% ethanol example was merely comparative data included to demonstrate the advantages of the claimed dual fuel system. Judge Newman disagreed with the majority’s “discarding” of the language of the patents’ titles, citing to multiple other cases in which the Federal Circuit referenced a patent’s title in construing and limiting a claim’s language and scope. Finally, Judge Newman found that the prosecution history of the same-specification patent family member showed that the patentee viewed the dual fuel system as distinct from the prior art and concluded that construing the claims to include a single-fuel system disregarded the specification and prosecution history.

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National Law Review, Volume XII, Number 216

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