

Be Cool: Don't Construe the Construction

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The US Court of Appeals for the Federal Circuit vacated and remanded a Patent Trial & Appeal Board decision after concluding that the patent owner's proposed construction would require the parties to construe the construction. *CoolIT Systems, Inc. v. Katherine Vidal, Director of the United States Patent & Trademark Office*, Case No. 22-1221 (Fed. Cir. March 7, 2024) (**Lourie**, Bryson, Stark, JJ.) (nonprecedential).

CoolIT Systems owns a patent directed to a system for fluid heat transfer to cool electronic devices. The patent focuses on a heat exchange system comprising various components including a heat sink, a housing member and a compliant member. The patent claims priority from two provisional applications. Asetek Danmark petitioned for *inter partes* review (IPR) of the patent based on anticipation and obviousness. During the IPR proceeding, the parties disputed the meaning of the term "matingly engaged," a term introduced in the later provisional application. To preserve validity, CoolIT argued that the term should be construed narrowly to mean "mechanically joined or fitted together to interlock." Asetek sought a broader construction of "joined or fitted together to make contact," which would encompass all methods of joining two surfaces.

The Board found both interpretations extreme and partially construed the term as being satisfied when at least a portion of the compliant member fits within the recessed region of the housing member. Despite agreement on the term "mate" to mean "join or fit together," there was disagreement on the term "engage." However, the Board did not determine whether "matingly engaged" could encompass forms of engagement beyond fitting.

The Board found that the cited prior art suggested a compliant member fitting the housing, thus rendering the claims obvious. CoolIT appealed. The US Patent & Trademark Office (PTO) intervened after Asetek withdrew from the appeal based on settlement.

CoolIT argued that the Board's interpretation was flawed, and that the prior art did not meet the requirements of the "matingly engaged" limitation irrespective of the interpretation adopted. CoolIT contended that its proposed construction aligned with the invention's purpose and properly distinguished between the 2007 and 2011 provisional applications. CoolIT also argued that the compliant member must partition features to control coolant flow, necessitating a specific type of joining or fitting.

In response, the PTO argued that CoolIT's proposed construction read limitations from the

specification into the claim. The PTO contended that neither the claims nor the specification required “interlock” and disputed CoolIT’s interpretation of the 2007 provisional application. The PTO did not propose an alternative construction, however.

The Federal Circuit concluded that “matingly engaged” should properly be construed as “mechanically joined or fitted together,” as that construction accurately reflected the term’s meaning and aligned with arguments presented by both parties. The Court rejected CoolIT’s proposal to add the word “interlock” because it would cause more confusion than clarity, noting that even CoolIT and the PTO still disagreed over what the term “interlock” meant and thus adding that term to the construction would provide little guidance.

The Federal Circuit found that the Board failed to address whether the prior art met the requirements of “matingly engaged” under the newly adopted construction and therefore remanded for further consideration.

Practice Note: This decision demonstrates the importance of accurately construing terms in patent claims, particularly when disputes hinge on specific juxtaposition language such as “matingly engaged.” Practitioners should pay close attention to the nuanced interpretations of such terms, ensuring they align with both intrinsic and extrinsic evidence.

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