

## Claim Construction Looks at More than Prosecution History

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Addressing a lower court's ruling of non-infringement after claim construction, the U.S. Court of Appeals for the Federal Circuit vacated and remanded the non-infringement decision, finding that the lower court construed relevant terms too narrowly. ***Frans Nooren Afdichtingssystemen BV v. Stopaq Amcorr Inc.***, Case No. 13-1200 (Fed. Cir., Feb. 21, 2014) (Taranto, J.).

Nooren owns a patent directed to a composition used for insulating and protecting substrates, such as manhole covers, from corrosion, water ingress and mechanical stresses. The sole independent claim requires a shaped article including a substrate having applied thereon a coating composition and "a filler comprising a plurality of fractions each comprising different size particles, and wherein said different fractions have different particle size distributions." A Dutch company manufactures products that prevent corrosion and water leaks. The products, which are distributed within the United States by Amcorr, contain mixtures of polybutene, polypropylene and aluminum trihydrate or calcium carbonate.

Nooren sued Amcorr alleging infringement of its patent. As agreed to by the parties, the suit focused on the "filler" and "fractions" limitations of the independent claim. The court found non-infringement of the patent based on its claim construction of "filler," which the court determined could contain only one material. The court further found that the accused products did not infringement because there was no discussion that polypropylene contains more than one "fraction," as the filler/fractions limitation requires. Nooren appealed.

The Federal Circuit disagreed with the lower court's claim construction of "filler" and determined that there was no basis in the claim or specification to limit that term to only one material. Instead of relying on the claim language or the specification, the lower court based its one-material construction entirely on prosecution history, where the examiner rejected the claims indicating that polymer-based coatings with two fillers have already been patented. The applicants never stated or implied the exclusion of dual-material fillers, nor did the examiner's language clearly focus on the number of materials in what constitutes a filler. Accordingly, the Federal Circuit concluded that there was no clear language in the prosecution history that limited "filler" to a single material.

The Court also disagreed with the lower court's determination that polypropylene should not be considered a filler. The sole explanation from the lower court for such a determination was that the polypropylene in the accused products mixes with polybutene to form a homogenous polymer mixture. The Federal Circuit stated that the lower court failed to explain the connection between its

homogenous polymer mixture finding and any construction of a filler.

The Court declined to construe the terms and answer the question of infringement, reasoning that there was insufficient exploration in the record, both in the present suit and in the lower court, of many questions of apparent relevance to identify a proper claim construction of the filler/fractions limitation. The Court concluded by reviewing various flaws in the lower court's analysis that would help during remand in arriving at a proper claim construction for the terms at issue.

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