



FENWICK & WEST LLP



# Intellectual Property Bulletin

Fenwick & West LLP — Fall 1999



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## Predictability in Patent Cases: Supreme Court Review of Federal Circuit Decisions

by [Charlene M. Morrow](mailto:cmorrow@fenwick.com) ([cmorrow@fenwick.com](mailto:cmorrow@fenwick.com))

Recently, it seems as if the U.S. Supreme Court has become more active in patent cases. Numerous articles discuss the three most famous recent Supreme Court patent decisions, *Pfaff*, *Warner-Jenkinson* and *Markman*. This article takes a broader look at what the Supreme Court has decided to review, and at how the standards set by the Court of Appeals for the Federal Circuit have fared on review. It concludes that the Supreme Court has taken to heart the concerns about lack of uniformity in patent cases that led Congress to vest authority for all appeals in patent cases with the Federal Circuit, and that the Supreme Court has viewed the uniformity to be achieved as not just the application of a single set of rules in all patent cases, but also the application of a set of rules that will lead to more-predictable results.

Since 1982, appellate review of patent decisions from all of the federal district courts in the country has been conducted by the Federal Circuit. 28 U.S.C. § 1295(a)(1). One impetus for this centralized review was a perception that serious conflicts between the regional circuits in the construction of the patent laws had led to forum shopping. *See, e.g.*, H.R. Rep. No. 97-312, p. 20 (1981), quoted in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 109 S. Ct. 971 (1989). As a result, except in those instances where the Supreme Court chooses to review a decision by the Federal Circuit, the Federal Circuit is the final arbiter of patent law.

Since 1982, the Supreme Court has chosen to review decisions of the Federal Circuit on eight occasions. The Supreme Court has considered the jurisdiction of the Federal Circuit. *Christianson v. Colt Indus. Operating Corp.*, 486 U.S. 800, 108 S. Ct. 2166 (1988). It has also considered issues relating to the distinction between fact and law in patent cases. *Dennison Mfg. Co. v. Panduit Corp.*, 476 U.S. 809, 106 S. Ct. 1578 (1986); *Markman v. Westview Instruments*, 517 U.S. 370, 116 S. Ct. 1384 (1996); *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 117 S. Ct. 1040 (1997). It has also reviewed specific patent law doctrines as enunciated by the Federal Circuit. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 109 S. Ct. 971 (1989); *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55, 119 S. Ct. 304 (1998). In each of these types of cases, the Supreme Court has addressed the role of the Federal Circuit in promoting uniformity in patent laws, and has reasoned from that principle in order to reject or reformulate analyses that did not in its judgment provide acceptably bright lines.

First, the Supreme Court has adopted a bright-line test for determining whether claims “arise under” the patent laws such that jurisdiction in any appeal vests in the Federal Circuit. In *Christianson*, the Supreme Court held that the well-pleaded complaint rule should be applied to determine from the face of a complaint if a claim is one “arising under” the patent laws such that the Federal Circuit has jurisdiction over an appeal.

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Second, on other procedural issues, the Supreme Court has expressed a policy in favor of certainty in patent cases. From 1987 until the Supreme Court's 1993 decision in *Cardinal Chem. Co. v. Morton Int'l.*, 508 U.S. 83, 113 S. Ct. 1967, it had been the Federal Circuit's practice to vacate any declaratory judgment on patent validity or invalidity as moot when it affirmed a finding of noninfringement. The Supreme Court held that an adjudication of noninfringement does not necessarily moot an issue of validity or invalidity, applying what it described as "a strong public interest in the finality of judgments in patent litigation" to conclude that the Federal Circuit's practice encouraged "endless litigation (or at least uncertainty) over the validity of outstanding patents." The Supreme Court has also granted certiorari to review the propriety of settlements that request that the Court of Appeals vacate a district court's judgment, but then dismissed the case due to a standing issue. *Izumi Seimitsu Kogyo Kabushiki Kaisha v. U.S. Philips Corp.*, 510 U.S. 27, 114 S. Ct. 425 [1993].

Third, the Supreme Court has emphasized the importance of predictability in addressing what are legal (judge) and factual (jury) determinations in patent cases. One occasion in which the Supreme Court addressed the fact/law dichotomy was in the much-publicized decision in *Markman*, which involved whether the proper construction of a patent claim is an issue of law, and whether it would impinge on the Seventh Amendment right to a jury trial if a judge determined what patent claims mean. After reviewing historical practice, the Supreme Court went on to analyze whether judges or juries are better equipped to handle the task of patent claim construction. After concluding that judges are better suited for the task, the Supreme Court went on to emphasize the need for certainty and uniformity in patent cases, stating that, "It was just for the sake of such desirable uniformity that Congress created the Court of Appeals for the Federal Circuit . . ." Thus, it concluded, it would prefer to treat claim construction as a purely legal issue, subject to the application of *stare decisis*, in later cases.

The next occasion in which the Supreme Court addressed the fact/law dichotomy was in *Warner-Jenkinson*. This case followed on the heels of the decision in *Markman* and was widely anticipated to be the case that would address the issue of whether the application of the doctrine of equivalents, which expands patent claims beyond their literal scope, could be decided by a judge rather than by a jury. *Warner-Jenkinson* had been heard by the Federal Circuit *en banc*, with the majority opinion finding jury trial appropriate, and with a number of dissenting judges voicing concerns that this practice led to uncertainty in trial and virtual unreviewability on appeal. While the Supreme Court declined to address this issue, it reformulated the applicable analysis, creating a presumption that amendments to proposed claim language during patent prosecution create an estoppel, adopting an element-by-element analysis that focuses on whether the accused devices have an equivalent to each claim element, rather than whether it is more generally equivalent, and rejecting the Federal Circuit majority opinion's foray into a multifactor analysis that would have considered issues

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such as copying versus independent development or design-around efforts by the accused infringer. In rejecting the latter analysis, the Supreme Court expressed its concern that “one wonders how ever to distinguish between the intentional copyist making minor changes to lower the risk of legal action, and the incremental innovator designing around the claims, yet seeking to capture as much as is permissible of the patented advance.”

Fourth, the Supreme Court has emphasized uniformity when it has addressed substantive issues of patent law. The first of these substantive decisions involved a conflict between the Federal Circuit and the Florida Supreme Court on the scope of preemption by the patent laws of state statutes protecting design ideas that are unpatentable subject matter. In *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 109 S. Ct. 971 (1989), the Supreme Court affirmed the judgment of the Florida Supreme Court holding that a state law prohibiting direct molding to duplicate unpatented boat hulls impermissibly conflicted with federal patent law, rejecting the result previously reached by the Federal Circuit in *Interpart Corp. v. Italia*, 777 F.2d 678 (Fed. Cir. 1985), reviewing California law prohibiting the use of direct molding. Among other considerations, the Supreme Court noted the concern for uniformity that led Congress to confer exclusive jurisdiction on all patent appeals on the Federal Circuit and reasoned that state laws directed at protecting local industry, like the state direct molding statutes, would undermine that goal. 489 U.S. at 162-163.

Similarly, in its most recent decision in *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55, 119 S. Ct. 304 (1998), the Supreme Court reviewed the Federal Circuit’s application of the on-sale bar and rejected it in favor of a simpler analysis that it viewed as producing greater certainty in application. The on-sale bar provision seems simple: a patent is not valid if “the invention . . . [is] on sale in this country more than one year prior to the date of the application for patent in the United States.” 35 U.S.C. § 102(b). The Federal Circuit had held that the issue to be determined was whether there was an “intent to commercialize” the invention, such intent to be evaluated considering the “totality of the circumstances” surrounding the alleged offer to sell or sale. *See, e.g., Envirotech Corp. v. Westech Engineering, Inc.*, 904 F.2d 1571 (Fed. Cir. 1990). Under the Federal Circuit’s precedent, the list of what circumstances could be considered in determining whether the bar applies was long, nonexclusive (meaning there was room for argument that additional categories of evidence could be relevant) and not weighted. In *Pfaff*, the Supreme Court rejected the multifactor “totality of the circumstances” analysis with respect to the on-sale bar. The Supreme Court emphasized the need to provide “a definite standard for determining when a patent application must be filed,” criticizing the totality of the circumstances standard as “unnecessarily vague.” It instead created a two-factor analysis: whether the invention was both ready for patenting and the subject of a commercial offer for sale prior to the bar date. 119 S. Ct. 304, 311-12.

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## Separate Spheres: Addressing the Confusion Surrounding Patent Law's Enablement Requirement

by Douglas B. Luftman

Once again, the U.S. Court of Appeals for the Federal Circuit has brought to light the tendency for the enablement requirement to be misapplied to the patent specification. *See, e.g., Personalized Media Communications L.L.C. v. International Trade Comm'n*, 161 F.3d 696 (Fed. Cir. 1998). The enablement requirement focuses on whether the written description of the patent specification teaches one skilled in the art how to make and use the claimed invention without undue experimentation. 35 U.S.C. Section 112(1).

The *Personalized Media* court stressed that the International Trade Commission's application of the enablement requirement to the claim section of the patent specification was erroneous.

To avoid misusing the requirement, attorneys must recognize that the claims section and the written-description section are distinct portions of the patent specification and that the enablement requirement is applicable solely to the written-description section.

By recognizing this clear distinction, and that the judiciary loosely applies the statutory terms "written description" and "specification," applying the enablement requirement under 35 U.S.C. Section 112(1) should become less confusing to the patent practitioner. In particular, when analyzing a patent specification for compliance with the enabling requirement, an attorney should focus primarily on the written description.

A patent specification, as defined by 35 U.S.C. Section 112, includes two sections, a written description and at least one claim. The sections serve distinct purposes, with each section having its own specific requirements.

Section 112, first paragraph specifically requires that the written description describe the subject matter of the invention, enable those skilled in the art to make and use the invention as broadly as it is claimed without undue experimentation and describe the best mode the inventor contemplated for carrying out the invention.

Section 112, second paragraph requires that after the written description, the specification must conclude with at least one definite claim that particularly points out and distinctly claims the subject matter that the applicant regards as his or her invention.

With the judiciary often misusing the statutory terms "written description" and "specification" (which have statutorily varied over the years), this distinct separation of the written description from the claims can become muddled. *In re Dossel*, 115 F.3d 942 (Fed. Cir.

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1997). For example, in *Markman v. Westview Instruments Inc.*, 52 F.3d 967 (Fed. Cir. 1995), *aff'd*, 116 S. Ct. 1384 (1996), the Federal Circuit stated that “[t]o ascertain the meaning of claims, [the court must] consider three sources: the claims, the specification, and the prosecution history.” The Dossel court noted that what actually was meant by this statement was that claim interpretation must be based on the claims, the written description and the prosecution history. The misuse of these related, but different, statutory terms had caused some to incorrectly view the enablement requirement as applicable to the specification as a whole, rather than solely to the written description.

Even though the Federal Circuit’s misstatement in *Markman* was corrected later in *Dossel*, synonymous use of the terms is still being repeated, reinforcing the notion that the specification and the written description are one and the same. *See, e.g., National Recovery Tech. v. Magnetic Separation Sys. Inc.*, 166 F.3d 1190 (Fed. Cir. 1999); *Burke Inc. v. Bruno Independent Living Aids Inc.*, 183 F.3d 1334 (Fed. Cir. 1999). To further contribute to the confusion about the applicable scope of the enablement requirement, the written description and the claims have some degree of interplay with each other. For the enablement requirement, a court is required to analyze the written description in light of both the claims and the knowledge of one of ordinary skill in the art. For the “definiteness” requirement, a court must determine whether one skilled in the art would understand the bounds of the claim by viewing it in light of the written description and the other claims.

Even with such an interplay between these two sections of the specification, the underlying requirements for both the written description and the claims still remain distinct from each other. *See Process Control Corp. v. Hydrexclaim Corp.*, 1999 U.S.App.Lexis 21409 (Fed. Cir. Sept. 7, 1999). The definiteness requirement still remains focused on ensuring that the claims, as a matter of law, place one skilled in the art on notice as to the extent of the protection sought. In this context, the written description primarily is used to assist the court in determining whether the true meaning of each claim term has been defined within the specification.

For the enablement requirement, the focus still remains on ensuring, as a matter of law based on underlying factual inquiries, that the written description teaches those skilled in the art how to make and use the claimed invention without undue experimentation. In this context, the claims solely are used to establish the scope of the claimed invention, which must be described in an enabling manner within the written description. In neither the enablement nor the definiteness context does the primary focus of the requirements specifically apply to the other separate and distinct section of the specification.

In one instance, however, the interplay between the written description and the definiteness requirement does increase. Under 35 U.S.C. Section 112, paragraph 6, a means-plus-function claim limitation (an alternative claiming technique when only functional language is used,



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*e.g.*, “a means for storing data”) results in the written description serving more of a primary role in defining the scope of a claim. In particular, rather than serving to merely define a claim term, in the means-plus-function context, the written description is primarily responsible for describing the specific structure that corresponds to the functional language used within the means-plus-function limitation in the specification’s claims section. *WMS Gaming Inc. v. International Game Tech.*, 184 F.3d 1339 (Fed. Cir. 1999).

This alternative manner of claiming, however, does not alter the application of the enablement requirement for the written description. Rather, the enablement requirement remains solely focused on whether the written description teaches one skilled in the art how to make and use the claimed invention without undue experimentation. The Dossel court attempted to address the misunderstanding between the means-plus-function claim limitations and the enablement requirement by stating that if the enabling disclosure of the written description is not commensurate in scope with the subject matter encompassed by a claim, that fact does not render the claim indefinite. Rather, the claim is based on an insufficient written description and should be rejected as nonenabling.

Personalized Media attempted to further resolve the confusion about applying the enablement requirement to the patent specification. The court explained that focusing upon the operability of an invention for indefiniteness purposes was misplaced. Such a factual inquiry was not relevant to the imprecision of the claims; rather, it was pertinent, if at all, to the underlying factual inquiry of the sufficiency of the written description in enabling the practice of the claimed invention.

Once the focus of enablement is properly directed toward the written description, attention shifts to the proper application of the two primary concepts of the enablement requirement. First is a determination of the level of knowledge of a hypothetical person skilled in the art, who would read the written description. Second is whether that hypothetical person, after reading the written description, would have to perform undue experimentation to understand how to make and use the claimed invention.

In analyzing the level of knowledge of the hypothetical person the Federal Circuit warned that such a determination is not intended to compensate for a nonenabling written description, which merely provides vague intimations of general ideas and mere germs of ideas. Rather, this determination of the level of knowledge of one skilled in the art is intended to establish the perspective for understanding the written description, thereby ensuring that mere minor omissions in the written description are not perceived as fatal in the enablement analysis. *Genetech Inc. v. Novo Nordisk A/S*, 108 F.3d 1361 (Fed. Cir. 1997).

With regard to the issue of avoiding the need for undue experimentation, a written description must provide “a reasonable amount of guidance with respect to the direction in which the experimentation should provide to enable the determination of how to practice a

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desired embodiment of the invention claimed.” *PPG Indus. Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558 (Fed. Cir. 1996).

When the written description provides such “guidance in selecting the operating parameters that would yield the claimed result, it is fair to conclude that the experimentation required to make a particular embodiment is not ‘undue.’”

## Quick Updates

### License to Create Derivative Works Implied

In *Edwin Kennedy v. Nat’l Juvenile Detention Association, et al.*, 51 U.S.P.Q.2d (BNA) 1677 (7th Cir. 1999), the United States Court of Appeals for the Seventh Circuit ruled that an agreement giving a licensee a right to “use” a copyrighted work, without mentioning the right to create derivative works, permitted the licensee to make derivative works of that copyrighted work.

Edwin Kennedy, the plaintiff in the case, was a contractor hired by the National Juvenile Detention Association (“NJDA”), the defendant, to produce a report. The agreement between the parties assigned ownership of the copyright in the finished report to Kennedy, but gave the NJDA “a royalty-free non-exclusive and irreversible license to reproduce, publish, and use such materials in whole or in part and to authorize others to do so.” After Kennedy completed the report, the NJDA requested Kennedy to make certain revisions to the report. Kennedy was willing to make some of the revisions, but did not revise the report to the satisfaction of the NJDA. The NJDA then hired another contractor to make final revisions to the report.

After the NJDA published the revised report, Kennedy sued for copyright infringement on the theory that the NJDA’s license to “use” the report did not give the NJDA the right to make derivative works of the report. Kennedy contended that, because the right to make derivative works is one of the enumerated exclusive rights conferred on a copyright owner, and that this right was not explicitly licensed to the NJDA, the NJDA did not have this right.

The district court dismissed the suit for failure to state a claim upon which relief can be granted. Because the rights granted to the NJDA were to “reproduce, publish, and use” the report, the district court held that the word “use” must include more than just reproducing and publishing. Considering the broad rights contemplated by the agreement, the district court interpreted the right to “use” to include the right to make derivative works. On appeal, the Court of Appeals for the Seventh Circuit affirmed the lower court’s ruling.

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### **Sale of “Playboy” and “Playmate” Metatags Allowed**

In *Playboy Enterprises, Inc. v. Netscape Communications Corp.*, 99 U.S. Dist. LEXIS 9638 (C.D. Cal. June 24, 1999), a federal district court denied preliminary injunctive relief to the plaintiff, finding that the defendant’s sale of the terms “playmate” and “playboy” as metatags neither infringed nor diluted plaintiff’s marks. The court reasoned that the words at issue were common words as well as the plaintiff’s trademarks. Issuing an injunction against the defendant would allow the plaintiff to “remove a word from the English language merely by acquiring trademark rights in it.”

### **Federal Circuit Disallows Registration of “Phantom” Trademarks**

In *In re International Flavors & Fragrances, Inc.*, 51 U.S.P.Q.2d (BNA) 1513 (Fed. Cir. 1999), the Federal Circuit upheld the Patent and Trademark Office’s refusal to allow registration of “phantom” marks (marks containing missing elements, such as “XXX for Dummies”). Affirming the Patent and Trademark Office’s administrative decision, the Federal Circuit reasoned that trademark registration was designed to afford constructive notice to the public of the registrant’s ownership of a particular mark. Registration of “phantom” marks would defeat this purpose because registration of marks containing missing elements would allow too many combinations to allow third parties to effectively screen their marks.

### **Trademark-Related Legislation**

On August 5, 1999, President Clinton signed into law a bill, Pub. L. No. 43, S. 1259, 106th Cong., 1st Sess. §2 (1999), allowing dilution as a grounds for filing a trademark cancellation or opposition proceeding before the Trademark Trial and Appeal Board (TTAB). Currently, most TTAB actions are based on likelihood of confusion, as the TTAB has refused to adjudicate dilution claims.

On August 5, 1999, the Senate passed legislation to curb cybersquatting. The Senate bill, S. 1255, 106th Cong., 1st Sess. (1999), creates a cause of action against anyone who, with a bad faith intent to profit from the goodwill of another’s mark, “registers, traffics in or uses a domain name that is identical to, confusingly similar to, or dilutive of [another’s mark] without regard to the goods or services of the parties.” The bill allows for traditional trademark remedies as well as statutory damages, ranging from \$1,000 to \$100,000 per trademark identifier. The bill also creates a procedural advantage for trademark owners by allowing owners to bring an in rem action against the infringing domain name rather than an action against an infringer, who may be difficult to locate or sue. The bill now moves to the House.

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### **Covenant not to Compete Enforceable in Illinois under Narrow Circumstances**

In *Outsource International, Inc. v. Barton and Barton's Staffing Solutions, Inc.*, 1999 U.S. App. LEXIS 22445 (7th Cir. Sept. 17, 1999), defendant Barton and his company Barton's Staffing and Solutions, Inc. ("Barton"), appealed a temporary restraining order ("TRO") and preliminary injunction awarded to Outsource International ("OSI") on the basis of violation of a confidentiality and noncompete clause in an employment agreement between Barton and OSI. Under Illinois law, a restrictive covenant is enforceable "(1) where the customer relationships are near-permanent and but for the employee's association with the employer the employee would not have had contact with the customers; and (2) where the former employee acquired trade secrets or other confidential information through his employment and subsequently tried to use it for his own benefit."

The 7th Circuit Court of Appeals affirmed the district court finding of the first element of a near-permanent relationship because the evidence supported the fact that OSI was held in high regard as being a reliable staffing provider and had strong customer loyalty. Moreover, the evidence supported a finding that but for Barton's association with OSI he would not have had contact with the customers that he obtained from OSI after leaving its employ. The appeals court also found that the district court did not abuse its discretion in finding that Barton had acquired OSI's data, which was protected as trade secret based on the hiring of former OSI employees, and the fact that all of Barton's clients were OSI clients that Barton quickly engaged upon leaving OSI's employ.

Chief Judge Posner dissented with the majority on the basis that the district court record did not support a finding that Barton had in fact stolen any confidential or trade secret materials from OSI such as customer lists or worker roster lists. Moreover, Posner reasoned that customers who used Barton's service knew Barton had left OSI and still trusted Barton to provide a quality service. That is, Barton's ability as a salesperson rather than the allegedly confidential information was the basis for Barton's success in obtaining OSI's clients. Thus, according to Posner there was a basis for concluding that a TRO and preliminary injunction were improperly granted.

### **Federal Circuit Overturns Infringement, Finding the Terms "a" and "an" Limit Claims at Issue under Doctrine of File Wrapper Estoppel**

In *Elkay Manufacturing Co. v. Ebco Manufacturing Co.*, 1999 U.S. App. LEXIS 22279 (Fed. Cir. Sept. 15, 1999), Ebco appealed a decision of the United States District Court for the Northern District of Illinois finding that the claims at issue were valid and infringed, and the Federal Circuit reversed the finding of infringement for improper claim construction.

The claim construction issue centered on "an upstanding feed tube . . . to provide a hygienic flow path for delivering liquid from . . . and for admitting air . . . into said container," a limitation found in each of the claims at issue. Ebco argued that the normal accepted meaning of the use of the articles "a" and "an" required that these terms be interpreted as

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describing a single feed tube having a single path for both air and water. Accordingly, Ebco argued that since their design had multiple tubes with different paths for air and water, they could not be infringing.

In analyzing the claim language at issue, the Federal Circuit recognized that use of the terms “a” or “an” can mean either “one” or “more than one” depending upon the context in which the article is used. The court cited to several of its previous cases recognizing that use of the word “comprising” in the transitional claim language implies that the terms “a” and “an” are to be given their broader meaning and interpreted as “one or more.” The Federal Circuit emphasized that since each of the claims at issue used the open term “comprising” in their transitional phrase, the limitation of “an upstanding feed tube . . .” would not necessarily be limited to a single feed tube having a single flow path for both liquid and air.

Next, the Federal Circuit turned to the written description in the specification in order to determine whether the terms “a” and “an” were intended to be limited to a single feed tube. Although the preferred embodiment explicitly used terms such as “a feed tube” and “the feed tube,” and the figures all showed only a single feed tube with a single flow path for liquid and air, the court refused to read a singular limitation into the claims since the general rule is that the claims of a patent are not limited to the preferred embodiment, unless so limited by their own language. Moreover, both patents at issue contained explicit clauses explaining that the description was directed only toward a preferred embodiment and was not intended to limit the claims.

Finally, the Federal Circuit turned to the prosecution history in order to determine whether the use of the terms “a” and “an” could properly be construed as limiting the claims to a single feed tube. Here, the court noted that in the prosecution history of one of the patents at issue, Elkay had specifically argued that a prior art reference cited by the patent office examiner was distinguishable because it did not teach a single tube having a single path for both air and water. Accordingly, under the doctrine of file wrapper estoppel, the terminology “a” and “an” was specifically limited by Elkay to a single feed tube having a single path for both air and water.

Interestingly, although no similar arguments were entered by Elkay in the second patent at issue, the court stated that “[w]hen multiple patents derive from the same initial application, the prosecution history regarding a claim limitation in any patent that has issued applies with equal force to subsequently issued patents that contain the same claim limitation.”

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