

Federal Circuit Clarifies Applicability of Size Limitations

APRIL 8, 2020

Tech. Consumer Prod., Inc. v. Lighting Sci. Grp. Corp., No. 2019-1361 (Fed. Cir. Apr. 8, 2020)

The Federal Circuit construed a device claim comprising a ring-shaped heat sink within a particular size limit. The court held that only ring-shaped heat sinks count toward the size limit. The prior art from prosecution showed a device having both a traditionally shaped heat sink of a different size and a ring-shaped flange having the claimed size. The prosecuting examiner overlooked the ring-shaped flange's function as a second heat sink.

In the underlying *inter partes* review, the Patent Trial and Appeal Board (PTAB) held that the prior art did not anticipate the claim limitation because the combined size of the flange plus the undisputed traditional heat sink exceeded the claimed size. The PTAB also held that removing the traditionally shaped heatsink to leave only the ring-shaped flange for sizing would render the device inoperable.

On appeal, the Federal Circuit held that the proper claim construction requires the size measurement to exclude the traditionally shaped heat sink. As written, the size limitation modifies only ring-shaped heat sinks. The claim also uses "comprising," without any limitations against additional heat sinks of other shapes and sizes. The law requiring prior art to enable an alleged invention to anticipate that alleged invention does not come into play. Here, the prior art's disclosure anticipates the claims, so the court had no need to decide whether the prior art further enabled removing the traditional heat sink. No substantial evidence supported the patent owner's argument that the flange and traditional heat sink formed a single, unified heat sink.

A copy of the opinion can be found [here](#).

1 Min Read

Related Locations

Charlotte

Chicago

Dallas

Los Angeles

San Francisco

Silicon Valley

Related Topics

Prior Art

Patent Trial and Appeal Board (PTAB)

Markman/Claim Construction

Related Capabilities

Patent Litigation

Intellectual Property

Related Regions

North America

Related Professionals



David Enzminger



Ivan Poullaos



Mike Rueckheim



Danielle Williams