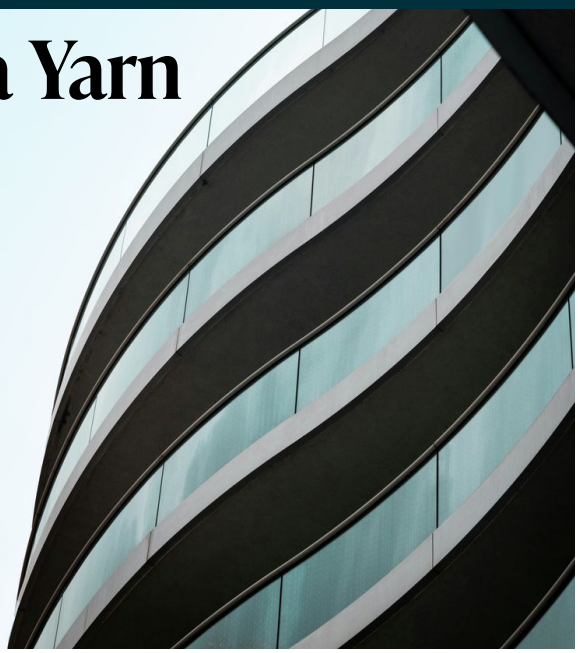
axinn

The Federal Circuit Spins a Yarn



3 MIN READ

November 27, 2023, 11:49 AM
By: Ted Mathias, Matthew S. Murphy

The Federal Circuit's decision on claim construction, *Barrday, Inc. v. Lincoln Fabrics, Inc.*, 2023-1903, 2023 WL 7871688 (Fed. Cir. Nov. 16, 2023), takes a dizzy dive into the age-old question of when a claim should be construed more narrowly than its plain language would suggest. *Barrday* is required reading for patent litigators because it touches on so many doctrines of claim construction.

Some Federal Circuit cases say that narrowing a term's plain meaning is "only" appropriate where the patentee has expressly defined the term or disavowed subject matter otherwise covered by that term's plain meaning. Other cases take a more flexible approach and allow narrowing where "a patent repeatedly and consistently characterizes a claim term in a particular way." The latter, more flexible approach serves as the starting point for the court's analysis, but what makes the case so notable, and so dizzying, are all of the other claim construction considerations in play.

Claim 1 covers a multi-layer woven fabric with "securing yarns" interwoven to "secure" an upper and lower layer. The dispute was whether yarns from the upper and lower layers could constitute "securing yarns." The preferred embodiments and the figures all featured "separate" securing yarns, i.e., distinct from the yarns in the upper and lower layers, and the specification criticized fabrics where yarns from the upper and lower layers were used to secure those layers. The claims refer to the upper, lower, and securing yarns as separate

structures, thus triggering a presumption that they are "distinct." Primarily for those reasons, the district court construed "securing yarns" to exclude yarns from the upper and lower layers, and the majority (Judges Hughes and Cunningham) affirmed.

But as the dissent (Judge Stark) outlined, there were strong countervailing arguments. Claims 10-14 depend from claim 1, and they recite fabrics where the securing yarns include yarns from the upper and/or lower layer. The district court's construction rendered these claims "unintelligible" – and thus strongly disfavored – according to the dissent because the claims would both allow and prohibit upper and lower layer yarns from being securing yarns. The dependent claims were also broader than independent claim 1 under the construction, thus achieving a result contrary to statute.

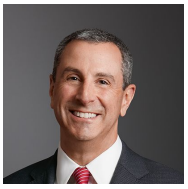
The Federal Circuit also applies a strong presumption against constructions that exclude an embodiment. The specification describes embodiments where upper or lower layer yarns "could be used in addition to, or in place of, one or more securing yarns" and describes a way of implementing such embodiments. The majority dismissed this passage as only describing "the functional equivalent of securing yarns." But as the dissent observed, "the definition of securing yarns is all about their function, i.e., to hold two layers together."

To add some extra spice, the majority and the dissent clashed over how to factor in the dependent claims' provenance. The claims were only added after the suit was filed and the defendant informed the patentee that the accused products "interweave" the upper and lower layers rather than using separate securing yarns. The majority used that fact as a basis to give the dependent claims little weight and distinguish cases rejecting constructions that rendered dependent claims meaningless. The dissent's view was that the litigation-driven tactic was permissible and there was no legal basis to give weight to the circumstances around the claims' origins.

It is a rare case where a construction excludes an embodiment, renders dependent claims unintelligible, and causes those claims to be broader than their independent claim. *Barrday* is a barn burner.

> **The district court's construction is problematic for the additional reason that it renders dependent claims 10-14 unintelligible, as it means these claims simultaneously allow and prohibit warp and weft yarns serving as securing yarns. We have directed courts to "strive[] to reach a claim construction that does not render claim language in dependent claims meaningless.**
>
> cafc.uscourts.gov/...

Related People



Ted Mathias

Matthew S. Murphy

Related Services

Intellectual Property

To subscribe to our publications, click here.

News & Insights

- CCWC 21st Annual Career Strategies Conference
  SPEAKING ENGAGEMENT
- SCCE 23rd Annual Compliance & Ethics Institute
  SPEAKING ENGAGEMENT **ANTITRUST**
- HNBA/VIA Annual Convention 2025
  SPONSORSHIP **ANTITRUST**
- Key Appellate Decisions Shaping Antitrust Strategy
  WEBINAR **ANTITRUST**
- ACI 12th Annual Summit for Women Leaders in Life Sciences Law
  SPEAKING ENGAGEMENT **INTELLECTUAL PROPERTY**
- National LGBTQ+ Bar Association Lavender Law Conference and Career Fair 2025
  SPONSORSHIP
- National Bar Association 100th Annual Convention and Exhibits
  SPONSORSHIP **ANTITRUST**

- Axinn Attorneys Named to the 2025 Lawdragon 500 X – The Next Generation Guide

  AWARDS & RECOGNITIONS

- Keeping Pace: Updates in Cartel Enforcement

  WEBINAR **ANTITRUST**

- Hanging in the Balance: Supreme Court Declines to Decide the Uninjured Class Member Question in Labcorp v. Davis

  AXINN VIEWPOINTS **ANTITRUST**