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PTAB Puts the Brakes on Applying the Same Element in a Reference to 2 Elements in a Claim

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August 13, 2015 — In a decision denying institution of *inter partes* review, the PTAB declined to let a single structure in an applied reference satisfy two elements in a challenged claim.

[IPR2015-00613 – Hopkins Manufacturing Corporation v. Cequent Performance Products, Inc. \(Paper 9, August 7, 2015\)](#)

Petitioner filed a petition requesting *inter partes* review of a patent directed to controlling the brakes on a trailer being towed by a vehicle. The patent describes a brake control system having a single accelerometer. The patent explains that the output of the accelerometer is processed to obtain a tilt/inclination of the vehicle and a rate of deceleration of the vehicle. Based on an “inclination signal” and “deceleration signal,” a controller controls the brakes of the trailer. The independent claims referred to both of these signals.

Petitioner asserted that certain claims were anticipated by a reference that taught a similar structure – a brake control system with a single accelerometer. Petitioner’s reference, however, referred to the output of the accelerometer as one signal with two components. To draw parallels between the patent and reference, Petitioner proposed construing the inclination signal and deceleration signal as components of an accelerometer output.

The Board refused to adopt Petitioner’s claim constructions, and instead, determined that the deceleration signal and inclination signal are separate and distinct. This determination was made, in part, because the claim language referred to the signals in a way that implied they were separate and distinct. Specifically, the claim recited “both said deceleration and said inclination signals.”

Under appropriate circumstances, two elements in a claim may be satisfied by a single element in a reference. *See, e.g., NTP, Inc. v. Research in Motion, Ltd.* 418 F.3d 1282, 1310 (Fed. Cir. 2005). Citing another case, Petitioner asserted this idea as “black letter law” and argued that the prior art teaching of an accelerometer with an output signal having two components met the “deceleration signal” and “inclination signal” of the claims. The Board didn’t buy it. The Board noted that, in the case the Petitioner cited, “the Specification of the patent at issue did ‘not suggest that the *claim terms require separate structures.*’” Thus, on the basis of its determination that the claims require separate and distinct signals, the Board distinguished this case from those applying the black letter law and rejected Petitioner’s arguments.

The Leahy-Smith America Invents Act established new patent post-issuance proceedings, including the inter partes review, post grant review and transitional program for covered business method patents, that offer a less costly, streamlined alternative to district court litigation. With the U.S. Patent and Trademark Office’s Patent Trial and Appeal Board conducting a large and increasing number of these proceedings, and with the law developing rapidly, Banner & Witcoff will offer weekly summaries of the board’s significant decisions and subsequent appeals at the U.S. Court of Appeals for the Federal Circuit.



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