

Seyfarth PTAB Blog



A legal look at Patent Trial and Appeal Board decisions and trends

Close Enough - Structure-less Prior Art Found to be Enabling

By Patrick T. Muffo

Challenging the novelty of a patent or patent application often requires a showing that the invention was publicly disclosed prior to the filing date of the patent. The prior art disclosure rarely discusses the invention in the exact same words as used in the patent, so there is often a question of when the prior art sufficiently “discloses the invention” to invalidate the claims of the patent. The case of *Silicon Laboratories, Inc. v. Cresta Technology Corporation*, Case IPR2014-00809, (Final Written Decision, October 21, 2015) draws that line well for a particular claim term that was disclosed functionally in the prior art, but not physically.

The *Silicon Labs* case is a lengthy opinion where several issues are discussed at length and, ultimately, decided in favor of Petitioner Silicon Labs. One of these issues is whether the prior art disclosed a “frequency conversion circuit,” which the PTAB construed as “a circuit for converting the frequency of the input RF signal to an intermediate frequency signal having an intermediate frequency.” The construction therefore requires a physical component (the circuit) and a functional component (“for converting the frequency of the input RF signal to an intermediate frequency signal having an intermediate frequency.”).

Cresta, the patent owner, argued the prior art was “skeletal at best” in its disclosure of the *physical* frequency conversion circuit. At the same time, Cresta did not dispute that the prior art disclosed the *function* as construed by the PTAB. The PTAB did not specifically dispute whether the disclosure of the physical circuit was “skeletal” or more, but held no detailed structure was required:

Petitioner is entitled to presume the enablement of the prior art, i.e., the circuit associated with the outdoor unit. The burden of production as to whether the circuit must be disclosed in order for the disclosure to be enabled is on the Patent Owner.

The PTAB then determined Cresta failed to meet its burden of production, focusing on its expert declaration:

Paragraph 66 of the Opris Declaration (Ex. 2003) is a conclusory denial, i.e., “Thomson does not teach the circuitry.” Patent Owner has not persuaded us that Petitioner failed to meet its burden of persuasion.

Following a review of the other claim terms, the PTAB cancelled as unpatentable all claims of the asserted patent.

Takeaway

The *Silicon Labs* case has many moving parts, but they all stem from the claim construction given to the term “frequency conversion circuit.” This term was construed broadly rather than Cresta’s more narrow proposed construction, which ultimately led to it being determined to be disclosed in the prior art. Despite losing the construction issue, Cresta could have provided more than conclusory statements in its expert declaration to show the lack of enablement in the prior art reference. The lack of any such evidence was ultimately fatal for Cresta, at least for this claim term.

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