

**ALERT**

## **Federal Circuit Patent Bulletin: *Eidos Display, LLC v. AU Optronics Corp.***

March 11, 2015

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On March 10, 2015, in *Eidos Display, LLC v. AU Optronics Corp.*, the U.S. Court of Appeals for the Federal Circuit (Wallach, Taranto, Chen\*) reversed and remanded the district court's summary judgment that U.S. Patent No. 5,879,958, which related to manufacturing processes for an electro-optical device, such as a liquid crystal display (LCD), was invalid as indefinite. The Federal Circuit stated:

A patent must "conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as [the] invention." Keeping in mind that "patents are not addressed to lawyers, or even to the public generally, but rather to those skilled in the relevant art," the patent claims "must be precise enough to afford clear notice of what is claimed, thereby appris[ing] the public of what is still open to them." A claim fails to satisfy this statutory requirement and is thus invalid for indefiniteness if its language, when read in light of the specification and prosecution history, "fail[s] to inform, with reasonable certainty, those skilled in the art [at the time the patent was filed] about the scope of the invention." . . .

The limitation-at-issue, "a contact hole for source wiring and gate wiring connection terminals," by itself, might suggest to someone unknowledgeable in the field of LCD manufacturing that one contact hole is formed for all the source wiring connection terminals and gate wiring connection terminals, as the Display Manufacturers argue. But the limitation, by itself, might also indicate that many contact holes are formed for the connection terminals. To analogize, a person familiar with cars, when reading the sentence "I am going to create an electric car for the United States and United Kingdom," would likely expect different electric cars to be created, one set with the steering wheel located on the left for driving in the United States, and another set with the steering wheel on the right for driving in the United Kingdom. The intrinsic record here makes sufficiently clear that a person of ordinary skill in the art—someone with knowledge of LCD manufacturing—after considering the limitation "in the context of the particular claim in which the disputed term appears, [and] in

the context of the entire patent, including the specification," would understand the limitation-at-issue to call for separate, different contact holes for the source wiring connection terminals and gate wiring connection terminals, rather than one shared contact hole.

As an initial matter, no party disputes that the state of the art for manufacturing LCD panels always had been to form contact holes for source wiring connection terminals that are separate from contact holes for gate wiring connection terminals. Consistent with that well-established practice, the specification teaches that each connection terminal for the electro-optical device would receive its own contact hole, for two reasons. First, nothing in the 172 figures or 58 columns of the '958 patent describes how a person of ordinary skill in the art would deviate from the known industry practice to create a novel shared contact hole for all the connection terminals. If the patentee wanted to deviate from the standard practice and claim a novel shared contact hole, some teaching of how to depart from the common practice would not only be expected, but is required.

Second, the only description corresponding to "a contact hole for source wiring and gate wiring connection terminals" in the specification teaches that separate contact holes are formed for the different connection terminals. This teaching is evident when considering the history of the '958 patent, in particular the patent application to which the '958 patent claims priority, application number 08/459,925. The '925 application originally contained seventeen independent claims, which were subject to a seventeen-species restriction. The specification in the '925 application, which is substantially the same as the specification in the '958 patent, contains seventeen embodiments that match with and describe the seventeen original independent claims. The limitation-at-issue, "a contact hole for source wiring and gate wiring connection terminals," appeared in five of the original claims; claim 3 (embodiment B), claim 4 (embodiment C), claim 5 (embodiment D), claim 7 (embodiment F), and claim 8 (embodiment G). Original claim 8 ultimately became claim 1 of the patent before us-the '958 patent. . . . Both parties agree that, as recited in original claim 5 (which corresponds to embodiment D), "a contact hole for source wiring and gate wiring connection terminals" requires separate contact holes for each connection terminal, consistent with Eidos' proposed construction. After reviewing the specification as well as the claims originally filed with the Patent Office, we see no reason to ascribe a different meaning to the same limitation in original claim 8, i.e., claim 1 of the '958 patent. Even without considering the priority application, the specification makes clear that the limitation-at-issue requires formation of separate contact holes. . . .

Relatedly, Display Manufacturers argue that the different embodiments have a different number of steps and have a different sequence in which the patterns are etched, which they argue results in "a fundamentally different approach to manufacturing a [device]." Different embodiments, however, are expected to have differences, and neither the magistrate judge nor Display Manufacturers explain how the noted differences in

the structures of the embodiments impact the structure of the limitation-at-issue or impact how a person of ordinary skill in the art would have understood the limitation. Instead, the embodiments all similarly describe manufacturing processes for an electro-optical device using a reduced number of photolithographic steps over the prior art, and the structure for the limitation-at-issue is formed in the same context in each embodiment-in a "photolithographic step [] of patterning the passivation film." This similar context of the limitation-at-issue, in similar embodiments, supports the conclusion that a person of ordinary skill in the art would adopt the same understanding for the same limitation recited in claim 1 of the '958 patent. . . .

The '958 patent teaches a person of ordinary skill in the art that "a contact hole for source wiring and gate wiring connection terminals" is formed by etching separate contact holes for the source wiring connection terminals and for the gate wiring connection terminals, as described in the specification and prosecution history. Therefore, the limitation "a contact hole for source wiring and gate wiring connection terminals" in claim 1 of the '958 patent is not indefinite under 35 U.S.C. § 112, ¶ 2. We reverse the judgment of indefiniteness and remand to the district court for further proceedings consistent with this opinion.