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Federal Circuit Patent Bulletin: *Cisco Sys., Inc. v. Cirrex Sys., Inc.*

May 15, 2017

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On May 10, 2017, in *Cisco Sys., Inc. v. Cirrex Sys., Inc.*, the U.S. Court of Appeals for the Federal Circuit (Prost, Wallach, Chen*) affirmed-in-part and reversed-in-part the U.S. Patent & Trademark Office Patent Trial and Appeal Board inter partes reexamination decision that upheld the examiner's rejection of claims of U.S. Patent No. 6,415,082, which related to fiber optic communication signals, for lack of written description. The Federal Circuit stated:

[W]e correct the Board's construction of equalization to clarify that the individual wavelengths of light energy inside the [planar lightguide circuit (PLC)] must be equalized with respect to other wavelengths of light energy while those wavelengths are traveling inside the PLC. We also correct the Board's construction of discrete attenuation to clarify that discrete attenuation does not encompass using the same attenuation element inside the PLC to attenuate all wavelengths of light in the same way.

Turning next to the Board's finding of patentability of the equalization and discrete attenuation claims over Cisco's objection for lack of written description support, we note first that the '082 patent issued with original claims 1–34, and Cirrex later added claims 35–124 during reexamination, of which claims 56, 57, 76, 102, and 103 were found patentable. . . .

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Practice Areas

Intellectual Property

The written description requirement provides that a patentee must "clearly allow persons of ordinary skill in the art to recognize that [he] invented what is claimed." "[T]he test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." "[T]he level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology."

[I]n asserting written description support for its equalization and discrete attenuation claims, Cirrex argued a modified version of Figure 10, illustrating a possible location of the attenuation material inside the PLC to the Board . . . . The Board agreed with Cirrex, finding that the claimed equalization function encompassed the equalization of .1, .2, and .4 against .3', even though .3' was not inside the PLC. The Board also found that placing an attenuation element inside the PLC could support the discrete attenuation claims because even though all the wavelengths of light .1–.4 inside the PLC were collectively attenuated, the addition of an unattenuated wavelength of light .3' from outside the PLC meant that some wavelengths of light were attenuated and other wavelengths were not attenuated.

We disagree. Under the correct claim construction, as explained earlier, the claimed functionality of equalization and discrete attenuation must occur inside the PLC with respect to the wavelengths "traveling in the [PLC]," not to wavelengths outside of the PLC. This construction does not encompass the equalization of wavelengths .1, .2, and .4 already inside the PLC with a wavelength .3' coming from outside the PLC. Similarly, placing an attenuation element inside the PLC will not result in discrete attenuation because the attenuation element attenuates all the wavelengths of light inside the PLC. The fact that an additional wavelength .3' may be later introduced into the PLC to replace an original wavelength .3 does not transform a collective attenuation into discrete attenuation.

We also agree with Cisco that the claims are directed to subject matter that is indisputably missing from the'082 specification, i.e., the claims "cover a mechanism for acting on individual channels of light within the PLC to discretely attenuate one of several channels" or "a mechanism for acting on individual channels of light within the PLC to make their several intensities equal." The '082 specification does not meet the quid pro quo required by the written description requirement for the disputed claims because demultiplexing light to manipulate separately the intensities of individual wavelengths of light while the light is still inside the PLC is a technically difficult solution that the '082 specification does not solve, let alone contemplate or suggest as a goal or desired result. Nothing in the '082 specification explains how individual wavelengths of light are separately manipulated while those wavelengths are still inside the PLC. Nor is there anything in the specification that suggests that the inventor contemplated that approach. To the contrary, the '082 specification expressly describes using the PLC to separate wavelengths of light to allow the manipulation of each individual wavelength—outside the PLC—before it is rerouted back into the PLC for remultiplexing.

Under the correct claim construction for the equalization and discrete attenuation claims, there is no substantial evidence in the record to support the Board's finding that claims 56, 57, 76, 102, and 103 of the '082 patent have sufficient written description support. Thus, we reverse the Board's findings of patentability for these claims.