



THINK FORWARD

Federal Circuit Says "Teaching Away" Must Cover the Entire Claim Scope

By Michael Spink, Mark Jenkins

October 23, 2017

In reversing the Patent Trial and Appeal Board (PTAB), the Federal Circuit recently held that certain claims of a patent granted to Fast Felt Corp. covering methods for applying nail tabs on roofing and building material were invalid. *Owens Corning v. Fast Felt Corp.* 2016-2613 (Fed. Cir. October 11, 2017). The Federal Circuit's precedential decision provides guidance regarding the "broadest reasonable interpretation" standard and its interplay with a prior art reference's ability to teach away.

Fast Felt Corp. initially sued Owens Corning for patent infringement alleging Owens Corning's SureNail® Strip™ infringed Fast Felt Corp.'s U.S. Patent No. 8,137,757 (the "'757 patent"). The '757 patent recites methods of making a roofing or building cover material. Owens Corning responded by filing a petition for *inter partes* review. While the petition was granted, the PTAB eventually determined that Owens Corning failed to show that any of the challenged claims were obvious. Particularly, the PTAB found that the closest prior art (U.S. Patent No. 6,451,409 – Lassiter) taught away from using pressure or heat to add reinforcement, since pressure and heat destabilize asphalt roof materials.

On appeal, the Federal Circuit focused on the PTAB's interpretation of the term "roofing or building cover material" recited in independent claims 1 and 7 of the '757 patent. Owens Corning argued that the PTAB's claim construction was legally incorrect under the broadest-reasonable-interpretation standard that is applicable in *inter partes* review. Particularly, Owens Corning argued that the PTAB erroneously treated "roofing or building cover material" as limited to material that either has been or would be coated or saturated with asphalt or asphalt mix. The Federal Circuit agreed. Particularly, the Federal Circuit noted that while preferred embodiments of the '757 patent focused on roofing materials that are or will be coated in asphalt or asphalt mix, the claims were not limited to such preferred embodiments and the specification was not enough to narrow the claims' scope in *inter partes* review. Thus, the Federal Circuit held that the PTAB erred in effectively construing the claims to exclude such materials.

Turning to the prior art teaching relied on by the PTAB, the Federal Circuit effectively found that while Lassiter may teach away from certain asphalt materials, Lassiter does not teach away from all embodiments encompassed by the full scope of the claims. The Federal Circuit also noted that some building materials, like Tyvek® covering, are not necessarily asphalt coated. The Federal Circuit agreed that the PTAB erred by effectively interpreting the claims to exclude those types of materials. Thus, the Federal Circuit ultimately held that a skilled artisan would have been motivated to combine the prior art references to use a layer of reinforcement material with print nail tabs on building cover materials that are not already or will be asphalt coated or saturated.

Practical considerations may be drawn from the Federal Circuit's decision. First, both petitioner and respondent in *inter partes* review must bear in mind that claim construction is based on a broadest reasonable construction *in light of the specification of the patent which it appears*. See 37 CFR

§42.100(b). A preferred embodiment in a patent's specification does not necessarily narrow claim scope in an *inter partes* review and simply informs the public as to one manner of carrying out the invention. Thus, the entire specification must be considered under a broadest reasonable construction. Secondly, the effectiveness of a reference at teaching away for purposes of obviousness in an *inter partes* review may be dependent upon the broadest reasonable construction of a claim term. That is, just because a reference may discourage taking certain steps or using certain components does not mean that such a teaching away will impact all embodiments of an invention covered by the full scope of the claims under a broadest reasonable construction standard. While it would seem that the pertinent issue is whether the prior art teaches away from combining one particular reference with another reference or teaching, established law indicates the prior art must teach away from the invention as claimed. Graduating levels of claim scope should therefore be employed and adjusted in view of the prior art cited by the USPTO.

Contact Us

If you have any questions or wish to discuss how this decision may impact your business, please contact one of our [Brinks attorneys](#).