

## Raghav Bajaj in Law360: Ignore Broader Claim Constructions At Your Own Risk

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**PRACTICES** Intellectual Property, Patents, Patent Prosecution and Counseling

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In *Owens Corning v. Fast Felt Corp.*, No. 2016-2613, 2017 U.S. App. LEXIS 19827 (Fed. Cir. Oct. 11, 2017), the Federal Circuit reversed the Patent Trial and Appeal Board's final written decision in IPR2015-00650. While the PTAB found that the petitioner had failed to show obviousness of any challenged claim, the Federal Circuit disagreed, finding that under a proper broadest reasonable interpretation of the claims, the "record conclusively establishe[d] obviousness."<sup>[1]</sup> The Federal Circuit therefore reversed the PTAB's final written decision without remand, finding the challenged claims unpatentable as obvious. ...

The ruling has many implications for practitioners:

1. Practitioners should be sure to develop a complete record at the PTAB, including evidence and arguments to support patentability/unpatentability contentions under alternative claim constructions, to ensure that the Federal Circuit's disagreement with the PTAB's reasoning does not result in a reversal without remand. In particular, expert declarants should consider alternative theories and not unduly limit their analysis.

2. Additionally, on appeal, practitioners should pay close attention to the relief sought by the appellant. Here, the appellant's opening brief sought reversal of the PTAB's decision from the Federal Circuit, but the appellee neglected to request remand in its responsive brief, and the Federal Circuit ultimately found no basis for remand. It is possible that the reversal could have been avoided by the appellee simply making the argument that a change in claim construction requires further factual findings before the PTAB, which could have provided the appellee another opportunity in this case. ...

Excerpted from *Law360*. To read the full article, click [here](#) (Subscription required).