

# The Scope Of Challenged Claims After Fed. Circ. Sivel Ruling

By **Joshua Weisenfeld** (November 13, 2023)

The U.S. Court of Appeals for the Federal Circuit's Sept. 1 Sivel International SA v. Sierra Wireless, Inc. decision addresses the validity of two patents asserted against wireless communications technologies. In particular, this case discusses claim construction and post-issuance claim amendments that broaden the scope of challenged claims.



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Sierra Wireless, along with several other defendants, filed petitions seeking inter partes review of U.S. Patent Nos. 7,433,698 and 8,364,196. The Patent Trial and Appeal Board instituted review on both patents and concluded that claims 10, 11, 13, 17 and 23 of the '698 patent and claims 1, 2, 4 and 13-18 of the '196 patent were unpatentable as anticipated and obvious in view of the prior art.

Sivel appealed both PTAB decisions, challenging the PTAB's construction of the term "connection rejection message," and challenging the PTAB's denial of Sivel's revised motion to amend the claims of the '698 patent.

## Issues

At issue were whether the claim term "connection rejection message" is limited to specific connection rejection messages issued by telecommunication networks identified in the patent's specification, and whether the PTAB erred in denying Sivel's motion to amend the claims of the '698 patent.

## Holdings

The Federal Circuit held that the PTAB properly constructed the term "connection rejection message" based on permissive language in the specification.

The Federal Circuit, applying rules set forth by the Administrative Procedure Act, held that the PTAB properly denied Sivel's motion to amend claims of the '698 patent because the proposed substitute claims, while narrower in parts, were broader than the original claims in at least two limitations of the proposed substitute independent claim.

## Reasoning

In its reasoning, the Federal Circuit first considered Sivel's contention that the PTAB erred in construing "connection rejection message." The Federal Circuit noted that they were applying the Phillips claim construction standard — whereby "[t]he words of a claim are generally given their ordinary and customary meaning as understood by a person of ordinary skill in the art when read in the context of the specification and prosecution history."

Sivel argued that, in light of the specification, the term "connection rejection message" should be construed as "a message from a [Global System for Mobile Communications or Universal Mobile Telecommunications Service] telecommunication network rejecting a connection request from a mobile station" as the specification specifically identified such

telecommunications networks as sending rejection messages.

However, the Federal Circuit reasoned that such a construction would improperly limit the claims and that "the intrinsic evidence provide[d] no persuasive basis to limit the claims to any particular cellular network."

Pointing to the specification, the Federal Circuit weighed two disclosures: first, that the specification expressly disclosed embodiments in a GSM or UMTS network, and second, that language from the specification specifically stated "[t]he invention is applicable in any such cellular telecommunication system."

The Federal Circuit favored the latter and went on to agree with the PTAB's decision stating that the cited language from the specification "clearly is permissive, not mandatory."

The Federal Circuit concluded that they have no basis, as Sisvel provided insufficient intrinsic evidence to conclude that a person of ordinary skill in the art would read the broad claim language to be limited to the GSM and UMTS networks, and affirmed the PTAB's conclusion that the challenged claim construction should be given its ordinary and customary meaning.

Second, the Federal Circuit considered Sisvel's contention that the PTAB erred by denying its motion to amend the claims of the '698 patent.

The Federal Circuit noted that "when a patent owner seeks to amend its claims during inter partes review, the amended claims 'may not enlarge the scope of the claims of the patent'" and that "[a] motion to amend may be denied where ... [t]he amendment seeks to enlarge the scope of the claims."

The Federal Circuit further noted that "[w]hile it is a petitioner's burden to show ... that any proposed substitute claims are unpatentable ... it is Sisvel's burden ... to show that the proposed amendment complies with the relevant regulatory and statutory requirements."

The Federal Circuit thus reviewed the PTAB's decision to deny the motion under the APA to determine whether the PTAB's actions were arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law.

In other words, the Federal Circuit reasoned that if the PTAB's determination that the proposed substitute claims were broader in scope than the original claims was incorrect, the PTAB would have abused their discretion.

However, the Federal Circuit, reviewing the claims de novo, agreed with the PTAB that the proposed substitute claims were broader than the original claims. In coming to this decision, the Federal Circuit looked to instances where the proposed substitute claims were broader than the original claims.

The Federal Circuit noted twice that the original claim language required that a value be set "based at least in part on information in at least one frequency parameter" of the connection rejection message and that the substitute claim language merely required the value to be set by "using the frequency parameter" of the connection rejection message.

The court agreed with the PTAB's distinction that the proposed substitute value need not be based, in whole or in part, on information in the connection rejection message, and thus was broader than the original claim 10.

The Federal Circuit rejected Sisvel's argument that "when all of the limitations are considered as a whole, the scope of [the substitute claim] is narrower than the scope of the original claim."

Looking back to the standard set in the 1999 Hockerson-Halberstadt v. Converse decision, the Federal Circuit pointed out that "if a substitute claim 'is broader in any respect [it] is considered to be broader than the original claim even though it may be narrower in other respects,'" and concluded that the substitute claim is broader than the original claim.

Therefore, the Federal Circuit concluded, the PTAB correctly determined that Sisvel failed to meet its burden to show that the scope of the substitute claims is not broader than the scope of the original claims, and held that the PTAB did not abuse its discretion in finding the same.

### **Conclusion**

The Federal Circuit affirmed the PTAB's construction of the term "connection rejection message" citing permissive, rather than mandatory, language in the specification, and against Sisvel's arguments that such rejection messages should be limited to GSM and UMTS telecommunications networks, as such networks were merely exemplary embodiments as opposed to required limitations.

Further, the Federal Circuit affirmed that the proposed claim amendments were broader than the original claims, focusing their analysis on specific limitations that were broader, as opposed to the scope of the entire claim, thus holding that the PTAB did not err or abuse its discretion.

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