

Kyocera Senco Indus. Tools v. Int’l Trade Comm’n, 22 F.4th 1369 (Fed. Cir. 2022) (Moore, Dyk, Cunningham)

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The patent holder, Kyocera, filed a complaint in the International Trade Commission against Koki in *Certain Gas Spring Nailer Prods. & Components Thereof*, Inv. No. 337-TA-1082, 2020 WL 2093834 (Apr. 28, 2020). Kyocera’s asserted patents related to gas-spring nailers, like compressed-air power staple and nail guns. Some asserted claims included a limitation reciting “a prime mover that moves a lifter member which moves a driver member away from an exit end of the mechanism.” The parties disputed the construction of the term “lifter member,” with Koki arguing that “member” was a nonce word akin to “means.” The Federal Circuit agreed, finding that “lifter member” did not connote sufficient structure on its own and thus overcame the presumption against 35 U.S.C. § 112 ¶ 6. The court also found that the surrounding claim language did not provide the needed structural recitation for the lifter member.

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The court thus confirmed the precedent in *Mas-Hamilton Grp. v. LaGard, Inc.*, 156 F.3d 1206 (Fed Cir. 1998), by holding that the word “member,” like “means,” will generally be given means-plus-function treatment. This is a departure from the more recent decision in *CCS Fitness, Inc. v. Brunswick Corp.*, which held the opposite. 288 F.3d 1359, 1367 (Fed. Cir. 2002) (“‘member,’ as defined by common and technical dictionaries, refers to a ‘structural unit such as a...beam or tie, or a combination of these’”). In sum, patentees cannot rely on any generic words to be *per se* structural.

The court also noted that, under § 112 ¶ 6, the claimed structure included “the structure, materials, or acts

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described in the specification as corresponding to the claimed function and equivalents thereof.” But the statutory equivalents encompassed in this standard is not necessarily the same as the judicial doctrine of equivalents for infringement. Despite briefing the judicial doctrine of equivalents in the context of infringement, the parties had not thoroughly briefed what structures described in the specification correspond to the lifter member or the scope of “equivalents thereof” in the claim construction context. The Federal Circuit thus remanded to the ITC to adjudicate infringement under the proper claim construction.

The court also addressed the exclusion of Kyocera’s expert testimony as unqualified for not satisfying the level of ordinary skill in the art. At trial, Koki advanced, Kyocera did not specifically contest, and the Administrative Law Judge (ALJ) adopted a definition of the level of ordinary skill as requiring two years’ experience in designing power nailers. Kyocera’s technical expert on claim construction, invalidity, and infringement had advanced degrees in engineering and extensive experience in the design and manufacture of fastener driving tools—but did not have experience in power nailer design, specifically. The ALJ thus concluded that he did not satisfy the definition of an ordinarily skilled artisan. The ALJ accordingly allowed the expert to testify as to his opinions on literal infringement but excluded all other testimony (claim construction, invalidity, and doctrine of equivalents) as unqualified.

The Federal Circuit held that it was an abuse of discretion for the ALJ to allow an expert to testify on literal infringement if the expert was unqualified to testify as to the perspective of a skilled artisan. The court

explained that an expert must have at least ordinary skill in the pertinent art for his testimony to be relevant and reliable. There is nothing about literal infringement that would make an unqualified witness's testimony more relevant or reliable than, for example, infringement under the doctrine of equivalents.

It is rare for an expert to be excluded for lacking the minimum level of experience to qualify as an ordinarily skilled artisan. Following the opinion in this case, parties should take care to ensure that the definition of the skilled artisan fits the experience of their experts. Moreover, this decision creates particular uncertainty in cases where a cross-disciplinary invention implicates a hypothetical "person" who represents a team of collaborators. Such cases often arise in, for example, computer-assisted life-science applications, where joint inventors might include a person holding a Ph.D. in biochemistry, a practicing physician, and an experienced software engineer. Rarely would one expert be a person of ordinary skill in more than one of those arts.

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