

No. 22-1439

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**United States Court of Appeals  
for the Federal Circuit**

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MALVERN PANALYTICAL INC.,

*Plaintiff - Appellant*

v.

TA INSTRUMENTS-WATERS LLC, WATERS TECHNOLOGIES  
CORPORATION,

*Defendants - Appellees*

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Appeal from United States District Court for the District of Delaware,  
No. 1:19:cv-02157-RGA, Hon. Richard G. Andrews

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**APPELLEES' REQUEST FOR REHEARING EN BANC**

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1. **Represented Entities.** Provide the full names of all entities represented by undersigned counsel in this case.

TA Instruments-Waters LLC and Waters Technologies Corporation

2. **Real Party in Interest.** Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.

N/A

3. **Parent Corporations and Stockholders.** Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.

Waters Technologies Corporation, Waters Corporation

4. **Legal Representatives.** List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court.

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5. **Related Cases.** Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal.

N/A

6. **Organizational Victims and Bankruptcy Cases.** Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees).

N/A

DATED: January 2, 2024

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## STATEMENT OF COUNSEL

Based on my professional judgment, I believe this appeal requires an answer to one or more precedent-setting questions of exceptional importance:

1. What standard should courts apply when determining whether a claim term is a “coined term,” i.e., a term that has no ordinary meaning to skilled artisans as of the filing of the patent application?

Based on my professional judgment, I believe en banc consideration is necessary to secure or maintain uniformity of the court’s decisions.

*/s/ Aaron P. Bowling* \_\_\_\_\_  
Aaron P. Bowling

## REASONS FOR GRANTING THE PETITION

When construing a patent’s claim term, courts begin with one threshold question: does the claim term have an “ordinary meaning” to a skilled artisan as of the filing date? The answer to that question sends the Court down two divergent branches of analysis.

Along the first branch—where the claim term *does* have an ordinary meaning—the Court must apply the full scope of that ordinary meaning unless (i) the inventor redefined the claim term with lexicography or (ii) disclaimed some portion of the ordinary meaning. *E.g.*, *Apple Inc. v. MPH Techs. Oy*, 28 F.4th 254, 259 (Fed. Cir. 2022) (quoting *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313–14 (Fed. Cir. 2005) (en banc)). Absent a disclaimer, a claim term with an ordinary meaning **cannot** be limited to the embodiments in the specification. *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1372 (Fed. Cir. 2003) (“Merely because the specification only describes one embodiment is not a sufficient reason to limit the claims to that embodiment.”).

Along the second branch—where the claim term *does not* have an ordinary meaning (i.e., it is a “coined term”)—the term “cannot be construed broader than the disclosure in the specification.” *Indacon, Inc. v. Facebook, Inc.*, 824 F.3d 1352, 1357 (Fed. Cir. 2016). The scope of a coined term **must** be limited to the embodiments in the specification, regardless of whether lexicography or a disclaimer



exist.<sup>1</sup> *Irdeto Access, Inc. v. Echostar Satellite Corp.*, 383 F.3d 1295, 1300 (Fed. Cir. 2004) (“Absent such an accepted meaning, we construe a claim term only as broadly as provided for by the patent itself”).

But missing from the Court’s jurisprudence is the most important question: how should courts determine *if* a given claim term is a coined term? In the absence of any guidance, courts across the country have adopted different tests, applied different burdens, and considered a variety of different evidence. Along the way, they’ve reached irreconcilably inconsistent decisions about whether certain terms are coined terms. These inconsistencies reduce predictability, undermine public notice, stifle innovation, and promote gamesmanship.

The Court should rehear this case en banc to clarify the standard that courts should apply when determining whether a claim term is a coined term. Only then will “competitors be able to ascertain to a reasonable degree the scope of the patentee’s right to exclude.” *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 978–79 (Fed. Cir. 1995), *aff’d*, 517 U.S. 370 (1996).

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<sup>1</sup> Several courts have construed claim terms lacking an ordinary meaning without using the phrase “coined term.” For simplicity, this Petition refers to all of this jurisprudence collectively as “coined term” jurisprudence.

## SUMMARY OF THE APPEALED DECISION

Malvern sued Waters in the District of Delaware for infringement of two patents related to isothermal titration calorimeters (ITCs). An ITC measures the amount of energy absorbed or released during a chemical reaction. Appx66 (1:26–29). The claimed ITC contains a “pipette assembly” that can be moved to different positions, corresponding to various modes of operation. Appx69 (7:8–65). For example, the pipette assembly may be in one position while being filled with liquid, another position when performing titration experiments, and still another position when washing the assembly between experiments. *Id.* The pipette assembly is guided between those positions by a “pipette guiding mechanism.” *Id.* (7:10–11, 50–51).

During claim construction proceedings, the parties disputed the meaning of “pipette guiding mechanism.” *Malvern Panalytical, Inc. v. TA Instruments-Waters LLC*, No. 19-cv-2157, 2021 WL 965684, at \*3–\*4 (D. Del. Mar. 15, 2021). There was no evidence of an ordinary meaning for “pipette guiding mechanism,” and Malvern did not dispute that the term “pipette guiding mechanism” was used for the first time in these patents. Appx3397, ll. 13–15; Appx3403, ll. 23–Appx3404, ll. 25. Malvern also admitted that “doesn’t have a disclosure of an automatic pipette guiding mechanism.” Appx3402, ll. 24–Appx3403, ll. 3. Nonetheless, Malvern argued that the term should mean a “mechanism that guides the pipette assembly,”

including both automatic and manual embodiments. *Malvern*, 2021 WL 965684, at \*3–\*4). Waters argued that the term should mean a “mechanism that manually guides the pipette assembly,” including only a manual embodiment. *Id.* The district court agreed with Waters, determining that “pipette guiding mechanism” was a coined term. *Id.* at \*4. Because *Malvern* “has not shown that a ‘pipette guiding mechanism’ has an ‘ordinary and customary meaning,’” the court explained, “[n]o evidence has been presented that a ‘pipette guiding mechanism’ was known or readily understandable to a POSA.” *Id.* Having determined that “pipette guiding mechanism” was a coined term, the district court then limited the term to manual embodiments based on the “objective boundaries” of the intrinsic record. *Id.* at \*4 (quoting *Iridescent Networks, Inc. v. AT&T Mobility, LLC*, 933 F.3d 1345, 1353 (Fed. Cir. 2019)). *Malvern* appealed the district court’s construction.

### SUMMARY OF THE PANEL DECISION

The Panel reversed the district court’s determination that “pipette guiding mechanism” is a coined term. *Op.* at 14. The Panel instead concluded, despite *Malvern*’s admissions to the district court, that “‘pipette guiding mechanism’ has a plain and ordinary meaning—a mechanism that guides the pipette assembly.” *Id.* at 10–11. The Panel reached that conclusion simply by “looking at the individual words in the claim.” *Id.* at 11. Based on those individual words—“pipette,” “guiding,” and “mechanism”—it was “immediately apparent” to the Panel that

“pipette guiding mechanism” had an ordinary meaning to skilled artisans in 2007. *Id.* at 11.

Having determined that “pipette guiding mechanism” had an ordinary meaning, the Panel next examined the intrinsic record for lexicography or a disclaimer. *Op.* at 11–19. The Panel found no indication of a “clear intent” to redefine the term with lexicography. *Id.* at 12 (quoting *Hill-Rom Servs., Inc. v. Stryker Corp.*, 755 F.3d 1367 (Fed. Cir. 2014)). And the Panel found no “clear and unmistakable” disclaimer in either the specification or prosecution history. *Id.* at 11–19. *Id.* Absent lexicography or a disclaimer, the Panel declined to “deviate from the plain and ordinary meaning” and declined to limit “pipette guiding mechanism” to “embodiments disclosed in the specification.” *Id.* at 11–12.

## ARGUMENT

### **I. The Court’s “Coined Term” Jurisprudence is Unsettled, Inconsistent, and Problematic**

The Court construes coined terms far differently than it construes terms with an ordinary meaning. And these different analyses yield vastly different results. But this Court has never clearly explained how to determine *if* a claim term is a coined term. The dearth of guidance has bred inconsistency in this Court and district courts across the country. This inconsistency leads to uncertainty, a lack of public notice, and an opportunity for gamesmanship.

**A. Starkly Different Analyses for “Coined Terms” and Terms with an Ordinary Meaning**

1. Construction of Terms with an Ordinary Meaning

As a “general rule,” claim terms are given their “plain and ordinary meaning,” or “ordinary and customary meaning.” *Apple*, 28 F.4th at 259; *Phillips*, 415 F.3d at 1312. The “ordinary” meaning is “the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.” *Phillips* at 1313.

When an ordinary meaning exists, the Court will depart from that meaning “in only two instances: lexicography and disavowal.” *Hill-Rom*, 755 F.3d at 1371. The standards for finding lexicography and disavowal are “exacting.” *Id.* To act as its own lexicographer, a patentee must “clearly express an intent to redefine the term” as something other than its ordinary meaning. *Id.* Disavowal requires that the specification or prosecution history “make clear that the invention does *not* include a particular feature, or is clearly limited to a particular form of the invention.” *Id.*

For terms with an ordinary meaning, “the scope of the claims is not generally limited to the embodiments disclosed in the patent,” even when “the specification describes only a single embodiment.” *Hill-Rom*, 755 F.3d at 1371. A “clear ordinary meaning is not properly overcome (and a relevant reader would not reasonably think it overcome) by a few passing references that do not amount to a redefinition or disclaimer.” *Ancora Techs., Inc. v. Apple, Inc.*, 744 F.3d 732, 738 (Fed. Cir. 2014).

2. Construction of “Coined Terms”

Courts conduct a far different claim construction analysis for coined terms. Coined terms “cannot be construed broader than the disclosure in the specification.” *Indacon*, 824 F.3d at 1357. The Court “need not find disclaimer where the specification does not permit a broader interpretation of these claim terms and the terms otherwise lack an ordinary meaning in the art.” *Id.* As this Court explained in *Iridescent*:

The question here, however, is not whether *Iridescent* narrowed the scope of the disputed term during prosecution from its full ordinary and customary meaning. Rather, because the disputed term is a coined term, meaning it has no ordinary and customary meaning, the question is whether the intrinsic evidence provides objective boundaries to the scope of the term.

*Iridescent*, 933 F.3d at 1353.

Likewise, in *Irdeto*, this Court explained that—because the “disputed term has no previous meaning to those of ordinary skill in the art”—“we construe a claim term only as broadly as provided for by the patent itself.” *Irdeto*, 383 F.3d at 1300–1301. The Court thus construed the term “group key” as limited to the way the term was “repeatedly, consistently, and exclusively” used in the disclosed embodiments—even though the Court found no “explicit narrowing statements in the specification.” *Id.* at 1302. The *Irdeto* Court recognized that this coined-term analysis was far different from cases in which the Court construed a term with an

ordinary meaning. *Id.* at 1303 (“Most importantly, neither *Liebel–Flarsheim* nor *Brookhill* nor *Teleflex* involved a situation where the applicant admitted that certain claim terms lacked any agreed upon meaning in the art—i.e., ordinary meaning.”)

**B. Inconsistency in Determining *If a Claim Term is A “Coined Term”***

This Court has never provided guidance on the standard should courts apply when determining whether a claim term is a “coined term.” The law is clear that a coined term is a term that “has no ordinary and customary meaning.” *Iridescent*, 933 F.3d at 1353. But the question remains unanswered: how do courts determine that a term has *no* ordinary meaning? The absence of guidance has caused widespread inconsistency in the analyses of this court and district courts across the country. At least two important questions about the Court’s coined-term analysis remain unanswered: (1) who bears the burden of demonstrating the presence or absence of a coined term?; and (2) when does the combination of multiple words with ordinary meanings become a coined term?

1. Who Bears the Burden of Demonstrating the Presence or Absence of a Coined Term?

When determining if a disputed term is a coined term, this Court has inconsistently applied the burden of proof. In some instances, the Court requires the patentee to demonstrate the absence of a coined term, i.e., the *presence* of an ordinary meaning in the art. In other instances, the Court requires the alleged

infringer to demonstrate the presence of a coined term, i.e., the *absence* of an ordinary meaning in the art.

In *Honeywell Int'l Inc. v. Universal Avionics Sys.*, for example, this Court required the patentee to prove the absence of a coined term, i.e., the *presence* of an ordinary meaning. 488 F.3d 982, 991 (Fed. Cir. 2007). The Court held that “terrain floor boundary” was a coined term because there was “no evidence to indicate that ‘terrain floor boundary’ was a term having ordinary meaning known to one skilled in the art at the time of the filing of the patent application.” *Id.* In *Indacon*, the Court reached the same conclusion, holding that “custom link” was a coined term because the record contained no evidence of an accepted meaning. 824 F.3d at 1357–58; ECF No. 31, 2015 WL 4183261, at \*20 (arguing that the term had no ordinary meaning because “there is no evidence of an accepted meaning”). In both cases, the absence of evidence for an ordinary meaning led the Court to construe the disputed term only as broad as the embodiments of the specification. Many district courts have followed suit. *Koninklijke KPN N.V. v. Telefonaktiebolaget LM Ericsson*, No. 21-cv-113, 2022 WL 811072, at \*22 (E.D. Tex. Mar. 16, 2022) (“Plaintiff does not, however, demonstrate that the term ‘service code’ has any established meaning in the relevant art. Instead, this is a coined term in the ’235 Patent.”). That includes the district court here, which required patentee Malvern to prove the presence of an ordinary meaning. *Malvern*, 2021 WL 965684, at \*5



(observing that “[n]o evidence has been presented that a ‘pipette guiding mechanism’ was known or readily understandable to a POSA”). Because Malvern “has not shown that a ‘pipette guiding mechanism’ has an ‘ordinary and customary meaning,” the Court concluded that “‘pipette guiding mechanism’ is a coined term.” *Id.*

But in other cases—including the Panel’s decision here—the Court instead requires the accused infringer to prove the presence of a coined term, i.e., the *absence* of an ordinary meaning. The record here contained no evidence of an ordinary meaning, and yet the Panel reversed the district court’s finding of a coined term. *Op.* at 11. The Court instead concluded that “pipette guiding mechanism” had an ordinary meaning to skilled artisans in 2007—without any evidence about how, or even if, this term was used in the art. *Id.* at 11–12. Many district courts have similarly required the accused infringer to prove the *absence* of an ordinary meaning. *HID Glob. Corp. v. Vector Flow, Inc.*, No. 21-cv-1769, 2023 WL 2655117, at \*1 (D. Del. Mar. 27, 2023) (“[Defendant] Vector Flow has not carried its burden of demonstrating that ‘visual rules’ is a coined term that lacks an ordinary and customary meaning in the field.”); *Facebook, Inc. v. BlackBerry Ltd.*, No. 18-cv-05434-JSW, 2019 WL 6828359, at \*10 (N.D. Cal. Dec. 13, 2019) (“The Court finds that BlackBerry has failed to meet its burden to show ‘multimedia data delivery information’ lacks an ascertainable meaning by clear and convincing evidence.”);

*DSS Tech. Mgmt., Inc. v. Apple, Inc.*, No. 14-cv-05330-HSG, 2018 WL 6421870, at \*3 (N.D. Cal. Dec. 6, 2018).

The result of this inconsistency is significant: when evidence of an ordinary meaning is absent or in equipoise, the claim-construction analysis applied by the Court will depend entirely on which party bore the burden. As in this case, merely flipping the burden from the patentee to the accused infringer will alter the outcome of the case.

2. Inconsistency in Handling Combinations of Multiple Ordinary Words

When determining if a disputed term is a coined term, this Court has inconsistently oscillated between analyzing the term as a whole, or analyzing the term based on its individual words.

When “a phrase as a whole lacks a common meaning,” this Court sometimes identifies a phrase’s ordinary meaning by combining the “established meanings of the individual words.” *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1372 (Fed. Cir. 2003). In *Altiris*, this Court held that “boot selection flag” had an ordinary meaning because “flag” had “a common meaning in the art” and “the other words (‘boot’ and ‘selection’) quite clearly are descriptive modifiers of ‘flag.’” *Id.* (giving “boot selection flag” the full breadth of its ordinary meaning, rather than restricting the term to the embodiments in the specification). This Court has applied the same individual-word analysis in other cases. *E.g., Littelfuse, Inc. v. Mersen USA EP*

*Corp.*, 29 F.4th 1376, 1381 (Fed. Cir. 2022) (“[T]he district court was correct in seeking to give meaning to the term ‘fastening stem’ by looking to the meaning of the words ‘fastening’ and ‘stem’ as used in the patent.”); *DSW, Inc. v. Shoe Pavilion, Inc.*, 537 F.3d 1342, 1347 (Fed. Cir. 2008) (concluding that “horizontally movably positional stack divider” had an ordinary meaning based on the meaning of the individual words in the term). In this case, the Panel applied the same analysis. By looking to the individual words of the disputed phrase—“pipette,” “guiding,” and “mechanism”—“the immediately apparent meaning is that a ‘pipette guiding mechanism’ is a mechanism that guides the pipette.” *Id.*

But the Court does not consistently apply this individual-word analysis. In *Indacon*, for example, the Court held that “custom link” was a coined term that “lack[s] an ordinary meaning in the art.” 824 F.3d at 1357–58. Unlike *Altiris*, the *Indacon* Court never considered whether “link” or “custom”—as individual terms—had common meanings in the art of computing. *Id.* Nor did the Court consider whether “custom” was a “descriptive modifier” of “link.” *Cf. Altiris*, 318 F.3d at 1372. In fact, the Court never addressed or distinguished *Altiris* at all. Instead, it concluded that the phrase as a whole lacked an ordinary meaning in the art, and it “limited” “custom link” to the embodiments disclosed in the specification—without even considering whether a disclaimer existed. *Id.* The Court did the same thing in *Honeywell*, 488 F.3d 982, holding that “terrain floor boundary” is a coined term.

The Court explained that “terrain floor boundary”—as a whole—“had no ordinary meaning to a skilled artisan at the time of filing of the patent application.” *Id.* District courts have also identified coined terms after concluding that a phrase comprised of common words lacked an ordinary meaning as a whole. In *Wirtgen*, for example, the District of Delaware held that “predefined efficiency points” was a coined term, even though the term is nothing more than “common English words [] strung together”:

This term requires construction because ‘predefined efficiency points’ does not have a clear, obvious meaning. When these common English words are strung together in the claimed order, their meaning is not clear to me, nor would they be to a jury member or POSITA. Therefore, I reject Caterpillar’s proposed plain and ordinary meaning construction.

*Wirtgen Am., Inc. v. Caterpillar, Inc.*, No. 17-cv-770, 2023 WL 2456090, at \*8 (D. Del. Mar. 10, 2023). The district court in this case reached the same conclusion: “[a]lthough the individual words ‘pipette,’ ‘guiding,’ and ‘mechanism’ may be commonly understood, it does not automatically follow that ‘pipette guiding mechanism’ is commonly understood in the art.” *Malvern*, 2021 WL 965684, at \*5.

The result of this inconsistency is significant. Many claims terms involve ordinary words that, when strung together in a certain combination or order, are not commonly used in the art. Without consistency in courts’ analysis of these multi-word claim terms, claim construction will lack predictability, the public will lack

notice of the scope of the invention, and the parties will be motivated to identify disputed claim language in a way that suits their desired claim scope.

**C. The Panel’s Decision In This Case Demonstrates the Consequences of the Court’s Inconsistent “Coined Term” Jurisprudence**

When the panel in this case overturned the district court—holding that “pipette guiding mechanism” is not a coined term—it relied on *3M Innovative Props. Co. v. Tredegar Corp.*, 725 F.3d 1315, 1329 (Fed. Cir. 2013). Op. at 15. But the Court’s decision in *3M* is confusing and inconsistent with other decisions of this Court. And the Panel’s application of *3M* only further demonstrates this confusion.

In *3M*, the parties agreed at the district court that “preferential activation zone” was a coined term. *3M Innovative Props. Co. v. Tredegar Corp.*, No. 09-cv-3335, 2011 WL 6004023, at \*11 (D. Minn. Nov. 30, 2011) (“Tredegar agrees that because the term preferential activation zone is a term coined by the patentee, it is necessary to look to the specification to determine its meaning.”). On appeal, the Court acknowledged that “preferential activation zone” is a coined term. *3M*, 725 F.3d at 1328 (the term “preferential activation zone” does not have an ordinary meaning outside of the patents). But then the *3M* Court applied the *wrong* analysis. Contradicting all of the Court’s coined-term jurisprudence, the *3M* Court gave the term “the full scope of its plain and ordinary meaning” because the patentee did not “explicitly redefine[] the term or disavow[] its full scope.” *Id.* (quoting *Thorner v. Sony Computer Ent. Am. L.L.C.*, 669 F.3d 1362, 1367 (Fed. Cir. 2012)). The *3M*

Court held that it was error for the district court to narrow “preferential activation zone”—an undisputed coined term—to the embodiments in the specification. *Id.* at 1329–1330. Without any “express restrictions to limit a ‘preferential activation zone,’” the *3M* Court explained, “our cases do not support prescribing a more particularized meaning.” *Id.*

The Panel in this case relied on *3M* when it reversed the district court. *Op.* at 15. According to the Panel, the district court erred by only considering whether “pipette guiding mechanism” has a plain and ordinary meaning “broadly in the art,” rather than determining its “plain and ordinary meaning . . . in the context of a patent.” *Id.* The Panel then cited to *3M*—a case that improperly construed an undisputed coined term—as an example of what the district court *should* have done here: i.e., “evaluat[e] the plain and ordinary meaning of a patent term that does not have an ordinary meaning outside of the Asserted Patents.” *Id.* at 15. The Panel provides no explanation as to how a term with no “ordinary meaning outside of the Asserted Patents” can nonetheless have a “plain and ordinary meaning.” *See id.* Nor does the Panel indicate that it is attempting to create some sort of hybrid class of claim terms: coined terms that nonetheless have an ordinary meaning. *See id.* Instead, the Panel concludes—simply by “looking at the individual words in the claim”—that “pipette guiding mechanism” had an ordinary meaning to skilled artisans in 2007.

The Panel’s application of *3M*, and the holdings of *3M* itself, only underscore the rampant confusion and misunderstanding surrounding coined terms.

## **II. The Court Should Impart Consistency and Predictability on the Construction of “Coined Terms”**

The United States patent system hinges on a competitor’s ability “to ascertain to a reasonable degree the scope of the patentee’s right to exclude.” *Markman*, 52 F.3d at 978–79. Without “established rules of construction,” competitors cannot understand the scope of the patent owner’s rights—nor can they “rest assured, if infringement litigation occurs, that a judge, trained in the law, will similarly analyze the text of the patent.” *Id.* Clarity in the scope of a patent claim “is essential to promote progress, because it enables efficient investment in innovation.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 730–31 (2002).

To date, this Court has failed to provide “established rules of construction” for coined terms. Various legal commentators have observed the “ambiguity” and “tension” in the Court’s jurisprudence on this issue. *E.g.*, Crouch, D., *Nose of Wax: The Ongoing Ambiguity in Claim Construction Standards*, PATENTLYO, available at <https://patentlyo.com/patent/2023/11/ambiguity-construction-standards> (Nov. 2, 2023). This case presents the Court with an opportunity to “impart consistency, predictability, and guidance to patent claiming, whereby the patent-user community can rely on a technologically correct and legally consistent interpretation of patent

claims.” *Sinorgchem Co., Shandong v. Int’l Trade Comm’n*, 511 F.3d 1132, 1146 (Fed. Cir. 2007) (Newman, J.) (dissenting). The Court should take that opportunity.

### CONCLUSION

Petitioner respectfully requests that this Court grant en banc review, vacate the Panel Decision, and invite the parties and amici to provide briefing on the appropriate standard for determining whether a claim term is a “coined term.”

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Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that on January 2, 2024, a true and correct copy of the foregoing was served upon counsel of record via email through the court's CM/ECF system.

*/s/ Aaron P. Bowling* \_\_\_\_\_  
Aaron P. Bowling

**CERTIFICATE OF COMPLIANCE**

This brief complies with the type-volume limitation of Federal Circuit Rule 35(b)(2). The brief contains 3,891 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(f) and Federal Circuit Rule 32(b).

*/s/ Aaron P. Bowling*  
Aaron P. Bowling

# **ADDENDUM**

**United States Court of Appeals  
for the Federal Circuit**

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**MALVERN PANALYTICAL INC.,**  
*Plaintiff-Appellant*

v.

**TA INSTRUMENTS-WATERS LLC, WATERS  
TECHNOLOGIES CORPORATION,**  
*Defendants-Appellees*

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2022-1439

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Appeal from the United States District Court for the  
District of Delaware in No. 1:19-cv-02157-RGA, Judge  
Richard G. Andrews.

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Decided: November 1, 2023

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Before PROST, HUGHES, and CUNNINGHAM, *Circuit Judges*.

PROST, *Circuit Judge*.

Malvern Panalytical Inc. (“Malvern”) appeals a claim construction order construing the term “pipette guiding mechanism” in the patents-in-suit as a “mechanism that manually guides the pipette assembly.” *Malvern Panalytical Inc. v. TA Instruments-Waters LLC*, No. 19-cv-2157, 2021 WL 965684, at \*3–6 (D. Del. Mar. 15, 2021) (“*Decision*”). Because the district court erred in construing “pipette guiding mechanism,” we vacate the stipulated judgment of non-infringement and remand for further proceedings.

## BACKGROUND

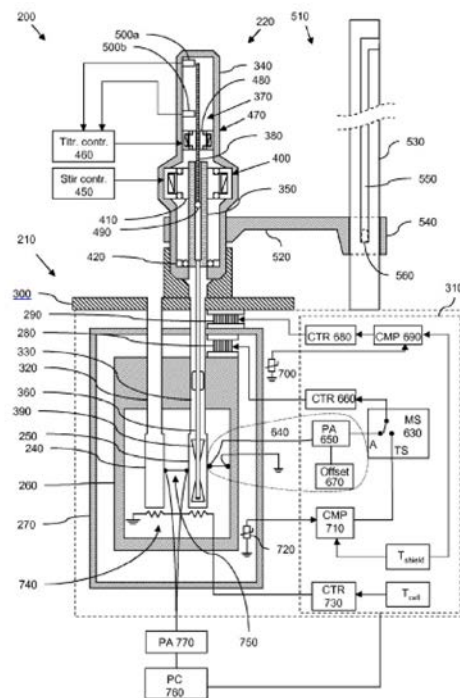
### I

Malvern sued TA Instruments-Waters LLC and Waters Technologies Corporation (together, “Waters”) in the District of Delaware for infringing various claims of, among others, U.S. Patent Nos. 8,827,549 (“the ’549 patent”) and 8,449,175 (“the ’175 patent”).<sup>1</sup> These patents both disclose microcalorimeters, which are machines that measure the amount of energy absorbed or released during a chemical reaction between two compounds. ’549 patent col. 1 ll. 26–29. The specific type of microcalorimeter described in these patents is an isothermal titration calorimeter (“ITC”). *Id.* at col. 1 ll. 37–41.

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<sup>1</sup> The ’549 patent is a continuation of the ’175 patent, and they share a substantially similar specification. For brevity, this opinion cites only the ’549 patent specification.

The ITC in the '549 and '175 patents contains several components. One component is the automatic pipette assembly. “The automatic pipette assembly [220] comprises a pipette housing 340, a syringe 350 with a titration needle 360 arranged to be inserted into the sample cell 250 for supplying titrant, and a linear activator 370 for driving a plunger 380 in the syringe 350.” *Id.* at col. 4 ll. 60–64.<sup>2</sup> Figure 2 illustrates the pipette assembly components in the context of the microcalorimeter:



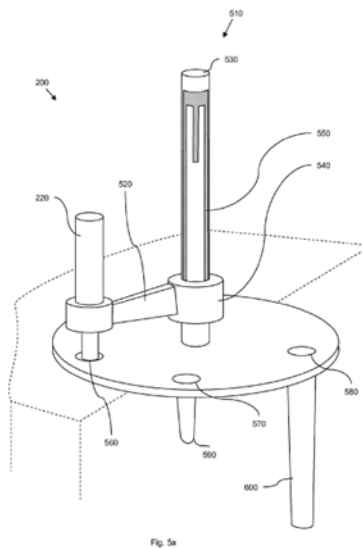
*Id.* at Fig. 2.

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<sup>2</sup> While the specification discloses an “automatic pipette assembly 210” here, we assume it meant to disclose an “automatic pipette assembly 220,” as it did earlier. '549 patent col. 3 l. 67–col. 4 l. 1.

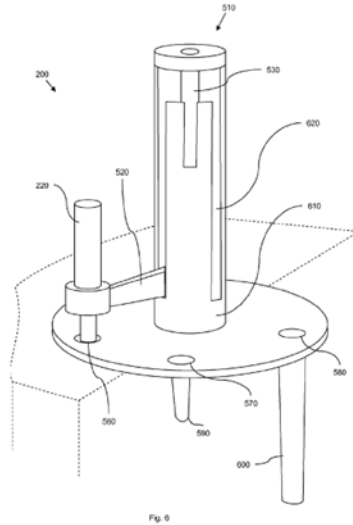
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Another component, the pipette guiding mechanism, “guide[s] the pipette assembly 220 between and into at least two positions of operation.” *Id.* at col. 7 ll. 10–11. The ’549 and ’175 patents disclose two embodiments of the pipette guiding mechanism. The first embodiment is “a pipette arm 520 that supports the pipette assembly 220, and an essentially vertical guide rod 530.” *Id.* at col. 7. ll. 18–20. “The pipette arm 520 is moveably attached by a sleeve 540 to the guide rod 530, but its motion about the guide rod is restricted by a guide groove 550 in the guide rod 530 and a guide pin 560 that protrudes from the inner surface of the sleeve 540 and which fits into the guide groove 550.” *Id.* at col. 7 ll. 20–25. With this embodiment, the “movement of the pipette assembly 220 in the vertical direction is restricted to the angular positions of the positions of operation,” *id.* at col. 7 ll. 28–30, and “rotational movement of the pipette assembly 220 between the angular positions only is permitted when the titration needle 260 is fully retracted from respective positions of operation,” *id.* at col. 7 ll. 31–34. Figure 5a illustrates the guide rod embodiment of the guiding mechanism:



*Id.* at Figure 5a.

A second embodiment of the pipette guiding mechanism, “wherein the guide groove in the guide rod 530 is replaced by a coaxial external guide sleeve 610 with corresponding guide paths 620 for the guide arm 520,” *id.* at col. 7 l. 66–col. 8 l. 2, is depicted in Figure 6:



*Id.* at Fig. 6.

Claim 1 of the '549 patent and claim 9 of the '175 patent are independent and contain the disputed term, “pipette guiding mechanism.”

Claim 1 of the '549 patent states:

1. A micro titration calorimetry system comprising:

an automatic pipette assembly comprising a titration needle arranged to be inserted into a sample cell for supplying titrant, a syringe for supplying titrant to the titration needle, a stirring paddle for stirring fluid in the sample cell, and a stirring motor for rotating the stirring paddle, and



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a *pipette guiding mechanism* arranged to restrict the movement of the pipette assembly along safe paths to ensure that the titration needle cannot be damaged during movement thereof between different positions of operation.

'549 patent claim 1 (emphasis added).

Claim 9 of the '175 patent states:

9. A micro titration calorimetry system comprising:

an automatic pipette assembly comprising a titration needle arranged to be inserted into a sample cell for supplying titrant, a syringe for supplying titrant to the titration needle, a stirring paddle for stirring fluid in the sample cell, and a stirring motor for rotating the stirring paddle, and

a *pipette guiding mechanism* arranged to guide the pipette assembly between and into at least two positions of operation, wherein a first position of operation is a pipette washing position wherein the titration needle is inserted in a washing apparatus, and a second position of operation is a titration position wherein the titration needle is inserted into the sample cell for calorimetric measurements.

'175 patent claim 9 (emphasis added).

## II

Relevant to this appeal is another patent, U.S. Patent No. 9,103,782 (“the '782 patent”). Although the '782 patent is unrelated to the '549 and '175 patents, all three patents had a common assignee and are now owned by Malvern. During prosecution of the '782 patent, the examiner rejected various claims as anticipated by U.S. Patent Application Publication No. 2010/0238968 (“the '968

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application”).<sup>3</sup> J.A. 2926. The ’782 patent describes the ’968 application as disclosing a prior art “manual ITC system,” ’782 patent col. 2 l. 62, in apparent contrast to the pipette translation unit that is a component of the ’782 patent’s automated ITC, *id.* at col. 6 ll. 24–32. Despite this characterization, the examiner rejected the ’782 patent as anticipated by the ’968 application because the examiner understood the ’968 application to disclose an automated ITC system. J.A. 2926–27. The ’782 patent applicant tried to overcome this rejection by arguing that the ’968 application contains a purely manual guiding system. J.A. 2919. The examiner again disagreed and rejected the ’782 patent as anticipated by the ’968 application. J.A. 2893, 2907. The ’782 patent applicant again argued that the pipette guiding mechanism in the ’968 application is “purely a passive guiding mechanism arranged to prevent damage of the sensitive titration needle.” J.A. 2885. The examiner once again disagreed and observed that the ’968 application teaches that “the movements of the pipette are performed using a program (such as that provided by the ITC control system).” J.A. 2872. In this same rejection, the examiner noted that because the ’968 application and the ’782 patent had a common assignee, the ’968 application might not qualify as prior art under pre-America Invents Act 35 U.S.C. § 103(c)(1). J.A. 2858. The ’782 patent applicant, seemingly taking the hint, then argued that the anticipation rejections over the ’968 application should be withdrawn because the ’968 application did not count as prior art under § 103(c)(1). J.A. 2852. The examiner withdrew the anticipation rejection on this basis. J.A. 2842.

### III

After a change in ownership by which Malvern came to own the ’549 and ’175 patents, Malvern sought supplemental examination of the ’175 patent under 35 U.S.C.

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<sup>3</sup> The ’968 application resulted in the ’175 patent.

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§ 257. J.A. 1418. As part of an information disclosure statement (“IDS”), Malvern cited 154 documents. Seven of these were the office action documents from the ’782 patent prosecution. J.A. 1488. Malvern did not describe or characterize the ’782 patent office actions in any way, and nothing in the supplemental examination shows any further discussion of the ’782 patent office actions.

During the supplemental examination, the examiner rejected claim 9 of the ’175 patent as anticipated by a Microcal iTC200 Microcalorimeter User’s Manual. J.A. 1464–66. The iTC200 manual contains several descriptions of its guiding mechanism as manually operated. J.A. 1169, 1174, 1176–77. Malvern sought to overcome this rejection by arguing that the iTC200 was the applicant’s own work. To do so, Malvern submitted declarations of co-inventor Rochalski. J.A. 1546. The first Rochalski declaration stated that the iTC200 manual “simply describes the product Valerian Plotnikov and I invented.” J.A. 1553. The second Rochalski declaration stated that “Valerian Plotnikov and I invented the features described and claimed in the ’549 and ’175 Patents” and that “[t]hese relevant features were included in the iTC200 Microcalorimeter.” J.A. 1686. The examiner thereafter withdrew the rejection of claim 9 over the iTC200 manual. J.A. 1707.

#### IV

During claim-construction proceedings before the district court in this case, Malvern argued that “pipette guiding mechanism” should mean a “mechanism that guides the pipette assembly,” while Waters argued that it should mean a “mechanism that manually guides the pipette assembly.” *Decision*, 2021 WL 965684, at \*3–4. The district court adopted Waters’s proposed construction. *Id.* at \*4. In doing so, the district court first concluded that the term “pipette guiding mechanism” was a coined term because Malvern presented “no evidence . . . that a ‘pipette guiding mechanism’ was known or readily understandable” to a

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person of ordinary skill in the art. *Id.* at \*5. The district court thus examined the intrinsic evidence for “objective boundaries to the scope of the term.” *Id.* (quoting *Iridescent Networks, Inc. v. AT&T Mobility, LLC*, 933 F.3d 1345, 1353 (Fed. Cir. 2019)).

The district court looked to the ’782 patent applicant’s statements during prosecution of the ’782 patent to ascertain the scope of the “pipette guiding mechanism,” concluding that the ’782 patent applicant limited the “pipette guiding mechanism” to only manual embodiments. *Id.* The district court attributed the statements of the ’782 patent applicant to Malvern because the ’782, ’549, and ’175 patents had a common assignee and because both parties and the district court treated the common assignee as Malvern. *Id.* at \*4 n.2. The district court considered statements made during the ’782 patent prosecution when interpreting the ’549 and ’175 patents because it concluded that Malvern agreed the statements cited in the IDS during supplemental examination were incorporated into the intrinsic record. *Id.* In part relying on this prosecution history, the district court limited “pipette guiding mechanism” to manual guiding mechanisms.

Following claim construction, the parties stipulated to non-infringement, J.A. 34–35, and the district court entered a final judgment of non-infringement, J.A. 29. Malvern timely appealed. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

#### DISCUSSION

Claim construction is a question of law this court reviews entirely de novo where, as here, the construction relies solely on the intrinsic evidence. *Baxalta Inc. v. Genentech, Inc.*, 972 F.3d 1341, 1345 (Fed. Cir. 2020).

Malvern and Waters dispute whether the term “pipette guiding mechanism” encompasses only manual guiding mechanisms (Waters’s position) or covers both manual and

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automatic guiding mechanisms (Malvern’s position). We agree with Malvern that “pipette guiding mechanism” means a mechanism that guides the pipette assembly manually or automatically.

We proceed first by analyzing the claim language, specification, and the co-inventor declarations submitted with the ’175 patent supplemental examination. We then analyze the district court’s conclusion that “pipette guiding mechanism” is a coined term. We finally analyze the impact, if any, that the ’782 patent prosecution history has on our claim construction.

## I

Claim terms are generally construed according to their ordinary meaning to a skilled artisan at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc). This meaning “provides an objective baseline from which to begin claim interpretation.” *Id.* at 1313. To that end, we consult intrinsic evidence, such as “the words of the claims themselves, the remainder of the specification, [and] the prosecution history,” and, to the extent it applies, extrinsic evidence. *Id.* at 1314. We keep in mind that a skilled artisan “is deemed to read the claim term . . . in the context of the entire patent, including the specification.” *Id.* at 1313. Additionally, “the prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution.” *Id.* at 1317. However, “because the prosecution history represents an ongoing negotiation between the [United States Patent and Trademark Office] and the applicant, rather than the final product of that negotiation, it often lacks the clarity of the specification and thus is less useful for claim construction purposes.” *Id.*

Starting with the claim language, we conclude that “pipette guiding mechanism” has a plain and ordinary

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meaning—a mechanism that guides the pipette assembly. It is appropriate to construe this term by looking to the words “pipette,” “guiding,” and “mechanism” individually. *Littelfuse, Inc. v. Mersen USA EP Corp.*, 29 F.4th 1376, 1381 (Fed. Cir. 2022) (“[T]he district court was correct in seeking to give meaning to the term ‘fastening stem’ by looking to the meaning of the words ‘fastening’ and ‘stem’ as used in the patent.”); *see also 3M Innovative Props. Co. v. Tredegar Corp.*, 725 F.3d 1315, 1329 (Fed. Cir. 2013) (“For this claim term the patentee offers an ascertainable definition in the body of the claim, and our cases do not support prescribing a more particularized meaning unless a narrower construction is required by the specification or prosecution history.”). Looking at the individual words in the claim, the immediately apparent meaning is that a “pipette guiding mechanism” is a mechanism that guides the pipette. The claim language contains no restrictions that would suggest that the “pipette guiding mechanism” is only manual. Instead, the broad claim language supports the conclusion that the “pipette guiding mechanism” encompasses both manual and automatic embodiments.

The claim term here is similar to the claim term we interpreted in *Hill-Rom Services, Inc. v. Stryker Corp.*, 755 F.3d 1367 (Fed. Cir. 2014). In *Hill-Rom*, we construed the term “datalink” to mean a link that conveys data. *Id.* at 1375. We did so over the objection of the accused infringer, who argued that we should limit the construction of datalink to the wired embodiments disclosed in the patent. *Id.* at 1373–74. In our view, the broad language of the claim supported a broad construction of the claim term. *See id.* at 1375 (“There is nothing improper about defining ‘datalink’ as a link that conveys data. If one of skill in the art at the relevant time would understand that datalinks can be both wired and wireless, then the patentee is entitled to the full range of that claim term.”). The similar breadth here compels a similarly broad result—that the “pipette

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guiding mechanism” is not limited to manual embodiments.

The remaining language in claim 1 of the ’549 patent and claim 9 of the ’175 patent supports this reading. Claim 1 specifies that the “pipette guiding mechanism” is “arranged to restrict the movement of the pipette assembly along safe paths to ensure that the titration needle cannot be damaged during movement thereof between different positions of operation,” and claim 9 specifies that the “pipette guiding mechanism” is “arranged to guide the pipette assembly between and into at least two positions of operation.” The claims clarify and restrict what the guiding mechanism does, but they provide no language suggesting the restriction to manual embodiments Waters advocates.

The specification confirms our broader understanding of the “pipette guiding mechanism.” It discloses two embodiments of the guiding mechanism. The first embodiment is a guide arm that can move only by way of a guide rod where permitted by guide grooves. ’549 patent col. 7 ll. 8–65. The second is a guide arm that can only move where permitted by a coaxial guide sleeve. *Id.* at col. 7 l. 66–col. 8 l. 2. The specification contains no language describing the invention as limited to a manual guiding mechanism, stating that “the present invention ‘is,’ ‘includes,’ or ‘refers to’” a manual guiding mechanism, or “expressing the advantages, importance, or essentiality” of a manual guiding mechanism. *Hill-Rom*, 755 F.3d at 1372. In fact, the specification states nothing about whether the guiding mechanism is manual or automatic. This absence leads us to conclude that nothing in the specification explicitly or implicitly limits the guiding mechanism to manual embodiments. *See id.* at 1373 (“There are no magic words that must be used, but to deviate from the plain and ordinary meaning of a claim term to one of skill in the art, the patentee must, with some language, indicate a clear intent to do so in the patent. And there is no such language here.”).

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Waters resists this conclusion by invoking portions of the specification that allegedly indicate that the “pipette guiding mechanism” is manual. Waters cites descriptions of “pre-set factory alignment” of the pipette assembly that “significantly improves usability and reliability of the instrument” and “makes the quality of measurements independent of the user skills.” ’549 patent col. 8 ll. 21–25. Waters also cites that the guiding mechanism “enables proper positioning of the pipette assembly.” *Id.* at col. 8 ll. 25–26. According to Waters, “these references plainly contemplate that a ‘user’ must manually move the pipette assembly into positions of operation, assisted by the pre-aligned guidance mechanism to avoid variability between experiments.” Appellee’s Br. 51. Waters’s heavy reliance on these disclosures is misplaced, however, because the benefits articulated in these disclosures are consistent with both manual and automatic embodiments of the guiding mechanism. As Malvern persuasively argues, “a guiding mechanism that restricts the movement of the pipette assembly between predetermined positions of operation improves usability and reliability and makes measurement independent of user skills—regardless [of] whether the pipette assembly is manually or automatically moved within those constraints.” Reply Br. 25. At bottom, these descriptions say nothing about whether the guiding mechanism is manually or automatically operated.

Waters further invokes the fact that the pipette assembly and stirring motor are automatic. ’549 patent col. 5 l. 1–col. 6 l. 2. According to Waters, the implication is that the “pipette guiding mechanism” is not automatic since the specification never explicitly describes the “pipette guiding mechanism” as automatic. Our conclusion from this difference, however, is that unlike the pipette assembly and the stirring motor, the specification describes the guiding mechanism broadly, without limitation to either manual or automatic embodiments. Waters does not point to portions of the specification that change our conclusion—that the



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specification neither explicitly nor implicitly limits the “pipette guiding mechanism” to manual embodiments.

Waters also argues that the prosecution history of the ’175 patent supplemental examination limits the guiding mechanism to manual embodiments. The co-inventor declarations submitted during the ’175 patent supplemental examination do not change our conclusion. During the supplemental examination, the examiner initially rejected claim 9 of the ’175 patent as anticipated by the iTC200 manual. J.A. 1464–66. Malvern overcame this anticipation rejection by submitting co-inventor declarations establishing that the iTC200 was the original applicant’s own prior art. J.A. 1553, 1686. Waters argues that these statements mean that Malvern argued the ’175 patent was co-extensive with the iTC200, which is manually operated. Appellee’s Br. 52–54. The context of Malvern’s statements during the supplemental examination, however, indicates that the co-inventor declarations do not bear on the precise scope of the ’175 patent; they establish only that the iTC200 embodied what was described and claimed in the ’549 and ’175 patents. *See Myco Indus., Inc. v. BlephEx, LLC*, 955 F.3d 1, 15 (Fed. Cir. 2020) (“[C]laim construction . . . focuses on the recited limitations of the *claims*, not the features of a commercial embodiment of the invention.”).<sup>4</sup>

In sum, the claim language and the specification indicate that the term “pipette guiding mechanism” in the ’549 and ’175 patents is used broadly. The prosecution history discussed above does not change our conclusion. Thus, the claim language and specification both support the conclusion that “pipette guiding mechanism” is a mechanism that

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<sup>4</sup> For this reason, we consider these statements “too vague or ambiguous to qualify as a disavowal of claim scope.” *Omega Eng’g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1325 (Fed. Cir. 2003).

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guides the pipette assembly either manually or automatically.

## II

The district court took a different view, concluding that “pipette guiding mechanism” is a coined term with no commonly understood meaning in the art. *Decision*, 2021 WL 965684, at \*5. On this basis, the district court concluded that “pipette guiding mechanism” “cannot be construed broader than the disclosure in the specification.” *Id.* at \*6 (quoting *Indacon, Inc. v. Facebook, Inc.*, 824 F.3d 1352, 1357–58 (Fed. Cir. 2016)).

In *Indacon*, we held that claim terms that “have no plain or established meaning to one of ordinary skill in the art” “ordinarily cannot be construed broader than the disclosure in the specification.” *Indacon*, 824 F.3d at 1357 (citing *Irdeto Access, Inc. v. Echostar Satellite Corp.*, 383 F.3d 1295, 1300 (Fed. Cir. 2004)). We have sparingly applied this principle of construction in other cases. *See, e.g., Iridescent Networks*, 933 F.3d at 1353 (considering a “coined term of degree”); *Honeywell Int’l Inc. v. Universal Avionics Sys. Corp.*, 488 F.3d 982, 991 (Fed. Cir. 2007) (citing *Irdeto*, 383 F.3d at 1300).

The district court’s analysis predominantly addressed whether “pipette guiding mechanism” has a plain and ordinary meaning broadly in the art. *Decision*, 2021 WL 965684, at \*5 (concluding that “pipette guiding mechanism” is a coined term because Malvern did not show “pipette guiding mechanism” was known in the art or readily understandable to a skilled artisan). This analysis, however, does not answer the question of what plain and ordinary meaning a term has in the context of a patent, which is the focus of our analysis. *See 3M Innovative Props.*, 725 F.3d at 1328–30 (evaluating the plain and ordinary meaning of a patent term that “does not have an ordinary meaning outside of the [asserted] Patents”). We discern plain and ordinary meaning by examining the claims

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themselves, the specification, and the prosecution history. *Phillips*, 415 F.3d at 1314. As we explained above, the plain and ordinary meaning of “pipette guiding mechanism” is a mechanism that guides a pipette, which can be either manual or automatic.

### III

A remaining question is how much weight we should give the ’782 patent prosecution history in our analysis. The district court concluded that the prosecution history of the ’782 patent was relevant to the construction of “pipette guiding mechanism.” *Decision*, 2021 WL 965684, at \*5. The district court relied heavily on the ’782 patent prosecution history to limit the guiding mechanism to manual embodiments. *Id.* at \*5–6.

We conclude that merely listing the ’782 patent office actions in the IDS of the ’175 patent supplemental examination was insufficient to inform the meaning of “pipette guiding mechanism” in the unrelated ’175 and ’549 patents. On this basis alone, we conclude that the district court erred when it used the ’782 patent prosecution history statements to limit “pipette guiding mechanism” to manual guiding mechanisms.

“In the absence of an incorporation into the intrinsic evidence, this court’s precedent takes a narrow view on when a related patent or its prosecution history is available to construe the claims of a patent at issue and draws a distinct line between patents that have a familial relationship and those that do not.” *Goldenberg v. Cytogen, Inc.*, 373 F.3d 1158, 1167 (Fed. Cir. 2004). However, even once a reference has been incorporated into the intrinsic record, such as by citation in an IDS, see *Ekchian v. Home Depot, Inc.*, 104 F.3d 1299, 1303–04 (Fed. Cir. 1997), the amount of characterization of that reference in the IDS impacts how informative we consider that reference when evaluating a patent. For example, listing of references in an IDS does no more than admit “that references in the disclosure

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may be material to prosecution of the pending claims,” but it does not admit materiality. *Abbott Labs. v. Baxter Pharm. Prods., Inc.*, 334 F.3d 1274, 1279 (Fed. Cir. 2003). Likewise, a patentee has not necessarily admitted that a listed reference’s characterization or use of a claim term bears on the proper construction of that term in the patent. *See id.*

We conclude that Malvern’s bare listing of the ’782 patent office actions in the IDS during the ’175 patent supplemental examination did not amount to an admission that the ’782 patent prosecution history is material (or controlling) in construing “pipette guiding mechanism.” The sum total of the references to the ’782 patent prosecution history is seven lines in the IDS citing office actions from the ’782 patent prosecution.<sup>5</sup> Malvern’s bare references to the ’782 patent office actions in the IDS for the ’175 patent supplemental examination are insufficient to impact our understanding of the specification and claim language. On this basis alone, the ’782 patent prosecution history statements cannot limit the scope of “pipette guiding mechanism.”

#### IV

Even if, however, the bare references to the office actions in the IDS were sufficient for us to consider the ’782 patent prosecution history in our analysis, the statements in the ’782 patent prosecution history do not clearly and

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<sup>5</sup> The IDS in the ’175 patent supplemental examination cites only the office actions from the ’782 patent prosecution, not the ’782 patent applicant’s arguments. Because we conclude the district court improperly considered the ’782 patent prosecution history, we do not address the propriety of the district court’s consideration of additional documents not cited in the IDS.

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unambiguously disclaim any scope of “pipette guiding mechanism.”

Because we concluded above that the ordinary meaning of “pipette guiding mechanism” is a mechanism that guides the pipette assembly either manually or automatically, we consider whether the ’782 patent prosecution statements could disclaim the broad scope of “pipette guiding mechanism.” The doctrine of prosecution disclaimer “preclud[es] patentees from recapturing through claim interpretation specific meanings disclaimed during prosecution.” *Omega Eng’g*, 334 F.3d at 1323. Prosecution disclaimer, which can arise from arguments made during prosecution or claim amendments, “only applies to unambiguous disavowals.” *Grober v. Mako Prods., Inc.*, 686 F.3d 1335, 1341 (Fed. Cir. 2012).

Here, although the ’782 patent applicant argued that the ’968 application discloses only a manual guiding mechanism, J.A. 2919, the examiner clearly stated its rejection of this argument several times. J.A. 2858, 2872–73, 2893, 2906–07, 2926–27. The ’782 patent applicant then abandoned this unviable argument that the ’968 application only discloses a manual guiding mechanism and instead successfully argued that the ’968 application did not qualify as prior art. J.A. 2842, 2852. A reasonable interpretation of this colloquy with the examiner is that by abandoning its argument that the ’968 application discloses only a manual guiding mechanism, the ’782 patent applicant acquiesced to the examiner’s views regarding the scope of the ’968 application.

In these circumstances, where an applicant abandons its unsuccessful argument, we conclude that the prosecution history lacks the clarity necessary to establish prosecution disclaimer. We have previously declined to find prosecution disclaimer where an applicant made an allegedly disclaiming argument to overcome prior art, the examiner disagreed, and the applicant “never repeated the

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allegedly disclaiming statements and instead offered alternative reasons to overcome” the prior art. *Ecolab, Inc. v. FMC Corp.*, 569 F.3d 1335, 1343 (Fed. Cir. 2009). The circumstances here are similar to the circumstances in *Ecolab*. By abandoning its arguments about the scope of the ’968 application, “a reasonable reader” of the ’782 patent prosecution history could conclude that the ’782 patent applicant “recognized its error and never again repeated or relied upon the erroneous rationale.” *Id.* In such circumstances, an applicant’s statements “simply are not clear and unmistakable enough to invoke the doctrine of prosecution history disclaimer.” *Id.*; see also *Mass. Inst. of Tech. v. Shire Pharms., Inc.*, 839 F.3d 1111, 1120–21 (Fed. Cir. 2016) (concluding no unambiguous prosecution disclaimer where a patent applicant attempted to add a limitation, the examiner rejected the added limitation under § 112 as new matter, and the applicant “never again sought to limit the claims” with the additional limitation).

#### CONCLUSION

We have considered the parties’ remaining arguments and find them unpersuasive. For the foregoing reasons, we conclude that the proper construction of “pipette guiding mechanism” is a mechanism that guides the pipette assembly either manually or automatically.<sup>6</sup> We thus vacate the stipulated judgment of non-infringement and remand for further proceedings consistent with this opinion.

#### VACATED AND REMANDED

#### COSTS

Costs to Malvern.

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<sup>6</sup> The district court may need to further refine this construction on remand, consistent with our holding here. *In re Papst Licensing Digital Camera Pat. Litig.*, 778 F.3d 1255, 1261 (Fed. Cir. 2015).