

No. 24-2335

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IN THE  
**United States Court of Appeals**  
FOR THE FEDERAL CIRCUIT

FMC CORPORATION,

*Plaintiff-Appellee,*

v.

SHARDA USA, LLC,

*Defendant-Appellant.*

On Appeal from the United States District Court  
for the Eastern District of Pennsylvania  
No. 2:24-cv-02419, Hon. Mia R. Perez

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**PETITION FOR PANEL REHEARING AND REHEARING EN BANC  
FOR PLAINTIFF-APPELLEE FMC CORPORATION**

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Benoit Quarmby  
MOLOLAMKEN LLP  
430 Park Avenue  
New York, NY 10022  
(212) 607-8160

Jeffrey A. Lamken  
Lucas M. Walker  
Jennifer Elizabeth Fischell  
Walter H Hawes IV  
Kayvon Ghayoumi  
MOLOLAMKEN LLP  
The Watergate, Suite 500  
600 New Hampshire Avenue, N.W.  
Washington, D.C. 20037  
(202) 556-2000  
jlamken@mololamken.com

*Counsel for Plaintiff-Appellee FMC Corporation*

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**UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT**

**CERTIFICATE OF INTEREST**

**Case Number** 24-2335

**Short Case Caption** FMC Corporation v. Sharda USA, LLC

**Filing Party/Entity** FMC Corporation

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Date: 09/16/2025

Signature: /s/ Jeffrey A. Lamken

Name: Jeffrey A. Lamken

<p><b>1. Represented Entities.</b> Fed. Cir. R. 47.4(a)(1).</p>	<p><b>2. Real Party in Interest.</b> Fed. Cir. R. 47.4(a)(2).</p>	<p><b>3. Parent Corporations and Stockholders.</b> Fed. Cir. R. 47.4(a)(3).</p>
<p>Provide the full names of all entities represented by undersigned counsel in this case.</p>	<p>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.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p>	<p>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.</p> <p><input type="checkbox"/> None/Not Applicable</p>
<p>FMC Corporation</p>		<p>BlackRock, Inc.</p>

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Michael L. Burns DLA Piper LLP (US)	Gregory J. Ferroni DLA Piper LLP (US)	Lesley McCall Grossberg Ice Miller LLP
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**STATEMENT OF COUNSEL CONCERNING REHEARING EN BANC**

This Court’s jurisprudence on when preambles are limiting has been characterized by commentators and Judges of this Court as an “incoherent mess,” Mark A. Lemley, *Without Preamble*, 100 B.U.L. Rev. 357, 388 (2020), or “nonsense,” Oral Argument at 6:29-6:35, *In re: Xencor, Inc.*, No. 24-1870 (Fed. Cir. Dec. 4, 2024) (Hughes, J.). This case presents an opportunity to revisit and reform that jurisprudence. Based on my professional judgment, I believe this appeal requires an answer to the following precedent-setting question of exceptional importance: Do ordinary claim-construction principles control whether a preamble is limiting, or are preambles subject to special, categorical rules applicable to no other part of the claim?

Based on my professional judgment, I also believe the panel decision is contrary to the following decision(s) of the Supreme Court of the United States or the precedent(s) of this court: *Bell Commc’ns Rsch., Inc. v. Vitalink Commc’ns Corp.*, 55 F.3d 615 (Fed. Cir. 1995); *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

/s/ Jeffrey A. Lamken

Jeffrey A. Lamken  
Counsel for Plaintiff-Appellee  
FMC Corporation

**POINTS OF LAW OR FACT OVERLOOKED OR MISAPPREHENDED**

The decision below also warrants panel rehearing because the panel decision (1) misapprehended that ordinary claim-construction principles apply when determining whether a preamble is limiting; (2) misapprehended *DDR Holdings, LLC v. Priceline.com LLC*, 122 F.4th 911 (Fed. Cir. 2024); and (3) overlooked, in construing the claim term “composition,” that skilled artisans understood that the claimed compositions’ superior insecticidal activity requires stability.

## **INTRODUCTION**

This Court’s jurisprudence on when preambles limit the scope of patent claims has long been characterized as an “incoherent mess.” Mark A. Lemley, *Without Preamble*, 100 B.U.L. Rev. 357, 388 (2020). The panel’s decision reinforces that disarray. It does not merely presume that preambles are non-limiting. It categorically rules that preambles describing a “use” are non-limiting, even if ordinary claim-construction principles prove otherwise. That defies precedent on an important, frequently case-dispositive issue. En banc review is warranted.

Panel rehearing is independently warranted—for that reason and others. The decision misapprehends and fails to address FMC’s arguments about a key precedent, *DDR Holdings, LLC v. Priceline.com LLC*, 122 F.4th 911 (Fed. Cir. 2024), and about how skilled artisans would understand the word “composition” in light of the specification, claims, and prosecution history.

## **BACKGROUND**

### **I. FMC’S INVENTION**

FMC patented and commercialized novel, premixed compositions for killing insects and mites that prey on crops. The patented compositions combine two active ingredients—bifenthrin and zeta-cypermethrin. Since the 1980s, bifenthrin products and zeta-cypermethrin products have been marketed under the names Capture® and Mustang®, respectively. Appx712(¶6). Farmers had tried mixing those products in tanks in the field, hoping to “broaden the spectrum” of controlled pests. Appx870;

Appx27(1:17-40); Appx37(1:17-42). But those “tank mixtures” were notoriously unstable: A known “problem in the art of formulating bifenthrin and zeta-cypermethrin” was achieving the mixture’s “physical stability.” Appx870; *see* Appx819-37.

FMC developed a new, premixed pesticide product—HERO®—containing both bifenthrin and zeta-cypermethrin. That product overcame the stability problems that rudimentary tank mixes suffered. Appx6; Appx16; Appx737-38(¶¶59-62); Appx2143-44(¶¶17-19).

Claim 2 of the ’416 patent, read together with claim 1 from which it depends, recites:

A miticidal composition comprising bifenthrin and [zeta-cypermethrin], wherein the weight ratio of bifenthrin to [zeta-cypermethrin] is from 10:1-1:30.

Appx33(14:42-49). Claim 1’s “miticidal” limitation arose during prosecution. Claim 1 previously recited “insecticidal or miticidal composition[s],” but the inventors deleted “insecticidal or,” thereby “limit[ing] [it] to miticidal compositions.” Appx1101; Appx1104. Other claims, however, still recite “insecticidal *or* miticidal composition[s].” Appx34(15:9-14) (emphasis added).

The asserted patents claim priority to a provisional application (“the ’979 provisional”). The ’979 provisional explained that “a problem in the art” had been “successfully achieving physical[ly] stab[le]”—and thus effective—“mixture[s]” of

“bifenthrin and zeta-cypermethrin.” Appx870. “Physical stability” was “most important” to ensure “the insecticides are fully effective.” Appx870. The provisional described “the present invention” as novel compositions of bifenthrin and zeta-cypermethrin with “significantly improve[d] physical stability.” Appx871. Because of that stability, the compositions “exhibit[ed]” unexpected “increase[s] in insecticidal activity” (*i.e.*, effectiveness). Appx871. An unasserted patent, the ’145 patent, claims priority to the ’979 provisional and includes the provisional’s emphasis on stability. Appx861 (1:26-45). Like the asserted patents, it claims “composition[s].” Appx864(8:53).

The asserted patents’ common specification omits stability-related disclosures from the provisional and ’145 patent. Like the provisional, however, the specification stresses the claimed compositions’ “unexpected insecticidal activity.” Appx27(1:10-13, 1:65-2:14); Appx37(1:10-13, 2:1-17). During prosecution of the asserted patents, the inventors overcame prior art by emphasizing “extensive data” showing the claimed compositions “produce[d] unexpected results”—namely, “unexpectedly desirable control” of insects and mites. Appx1616-18; *see* Appx1359-60.

## II. PROCEDURAL HISTORY

### A. District Court Proceedings

When Sharda started selling “WINNER,” a generic version of FMC’s HERO, FMC sued and moved for a preliminary injunction.

Sharda did not dispute infringement. It argued there was a substantial question as to whether the claims were invalid as anticipated by “McKenzie,” a study by a former FMC biologist. Appx311. In response, FMC urged that the claimed “composition[s]” were limited to *stable* compositions; at most, McKenzie disclosed unstable, ineffective prior-art tank mixes the inventors had disclaimed. Appx702-05. FMC also argued that some claims specify that the compositions are “*miticidal*,” but McKenzie nowhere disclosed “miticidal” compositions. Appx705-06. Sharda urged the court to construe “composition” to include unstable, ineffective tank mixes. Appx2072.

The district court rejected Sharda’s arguments and granted the injunction. Appx7-11. The court construed the claimed “composition[s]” to “cover only stable compositions.” Appx21-22. It held that the prosecution history showed the claims do not encompass unstable and ineffective “tank mixtures” the inventors had disclaimed. Appx21-22. Because McKenzie at most disclosed tank mixtures of Capture and Mustang—the very mixtures the inventors distinguished—McKenzie could not anticipate. Appx7-8; *see* Appx311-18; Appx724-25(¶¶37-38). Having

thus rejected Sharda’s anticipation theory, the district court did not address FMC’s argument that McKenzie also failed to disclose “miticidal” compositions. The district court also found (and Sharda did not contest on appeal) that the other relevant factors (likelihood of infringement, irreparable harm, equities) favored injunctive relief. Appx6-7; Appx11-13.

### **B. The Panel Decision**

The panel disagreed with the district court’s construction of the term “composition,” concluding that the term “includes ‘tank mixtures.’” Op.11 & n.4. The panel thus vacated and remanded for a determination “under the correct claim construction.” Op.13.

1. The panel declined to read the term “composition” in light of the ’979 provisional’s and ’145 patent’s stability-related disclosures, because those disclosures did not “ma[k]e it into the asserted patents.” Op.7. “A skilled artisan, in light of such deletions,” the panel determined, “would not understand ‘composition’ . . . to cover only stable formulations.” Op.7.

The panel decision found *DDR Holdings, LLC v. Priceline.com LLC*, 122 F.4th 911 (Fed. Cir. 2024), controlling. There, “the provisional application defined ‘merchants[.]’ . . . as ‘producers, manufacturers, and select distributors of **products or services**,’ but the patent-at-issue defined ‘merchants’ as ‘the producers, distributors, or resellers of the **goods**.’” Op.7. That difference, *DDR* concluded,

“‘indicate[d] an evolution of the applicant’s intended meaning of the claim term’” to exclude “‘services.’” Op.7. The panel saw “‘little difference between this case and *DDR*[.]” Op.7.

The panel characterized FMC as having argued that *DDR* “‘applies only where the progression between a provisional application and the patent-at-issue **narrows** the meaning of a claim term,” while “‘the progression [here] . . . would **broaden** the scope of ‘composition.’” Op.8. It did not address FMC’s argument that the intent revealed by the prosecution history controls: *DDR*’s history showed the patentee “‘intended” to “‘narrow[.]” the definition of merchants; here, by contrast, “‘nothing suggests that the inventors sought to broaden the claimed insecticidal and miticidal compositions to encompass the unstable and ineffective compositions the inventors distinguished as prior art.” ECF #29 at 2 (R.28(j) letter).

2. The decision also rejected FMC’s argument that the patents’ common specification—even apart from the provisional—supported the district court’s construction of “‘composition.” The patents disclose and claim compositions possessing “‘unexpected insecticidal activity.” FMC.Br.39. And skilled artisans knew that “‘such unexpected effectiveness was possible only by overcoming stability problems that plagued prior-art tank mixtures and ‘yielded inadequate efficacy.’” *Id.* The panel deemed FMC to be arguing that stability and efficacy mean the same thing, and rejected that argument. Op.10.

3. The opinion then turned to FMC’s argument that, *even under Sharda’s construction of “composition,”* McKenzie could not anticipate claims that recite only “miticidal” compositions. Op.12. The preambles of those claims, FMC argued, limit them to “miticidal composition[s],” which McKenzie does not disclose. FMC.Br.65. The preambles of *other* claims, by contrast, covered “insecticidal *or* miticidal composition[s].” *Id.* (emphasis added). That distinction, FMC argued, “was deliberate: During prosecution . . . , FMC amended claim 1 ‘to be limited to miticidal compositions’ by *deleting* the words ‘insecticidal or’ from claim 1’s preamble.” *Id.* (quoting Appx1101; Appx1104). The panel disagreed, ruling that preambles “‘that merely state[] the purpose or intended use of an invention’” are non-limiting. Op.13. Any “linguistic differentiation” was thus irrelevant: “[V]ariations in language have no effect if said language is not controlling in the first place.” *Id.*

## ARGUMENT

### **I. THE OPINION’S TREATMENT OF PREAMBLES—EXEMPTING THEM FROM ORDINARY CLAIM-CONSTRUCTION PRINCIPLES—WARRANTS EN BANC OR PANEL REHEARING**

The panel’s construction of the “miticidal” preamble requires en banc rehearing or at least panel reconsideration. It reflects an entrenched conflict in this Court’s jurisprudence. The “law on preambles” has become “nonsense.” Oral Argument at 6:29-6:35, *In re: Xencor, Inc.*, No. 24-1870 (Fed. Cir. Dec. 4, 2024)

(Hughes, J.). And the panel decision made matters worse still. It violated clear precedent requiring courts to construe claim preambles like all other claim language. While amending the opinion could correct the outcome, “the time” has “come” for this Court to fix its “preamble limitation” doctrine. *Am. Med. Sys., Inc. v. Biolitec, Inc.*, 618 F.3d 1354, 1364 (Fed. Cir. 2010) (Dyk., J., dissenting).

**A. The Panel Decision Conflicts with Binding Precedent**

1. This Court has long held that it “construe[s] claim preambles[] like all other claim language, consistent[] with” ordinary claim-construction “principles.” *Bell Commc’ns Rsch., Inc. v. Vitalink Commc’ns Corp.*, 55 F.3d 615, 620 (Fed. Cir. 1995); *see Arctic Cat Inc. v. GEP Power Prods., Inc.*, 919 F.3d 1320, 1327 (Fed. Cir. 2019) (“the effect of preamble language [is] a claim-construction issue”). Although courts may construe preambles as not “limit[ing],” that process “presents no deeper mystery than the broader task of claim construction, of which it is but a part.” *Bell*, 55 F.3d at 620-21; *see Eli Lilly & Co. v. Teva Pharms. Int’l GmbH*, 8 F.4th 1331, 1340 (Fed. Cir. 2021) (“[T]here is no ‘litmus test’ for determining whether a preamble is limiting.”).

Applying those principles here leads to a straightforward result: The preambles of the asserted “miticidal” claims are limiting. It is axiomatic that “different claim terms are presumed to have different meanings,” *Helmsderfer v. Bobrick Washroom Equip., Inc.*, 527 F.3d 1379, 1382 (Fed. Cir. 2008), and give rise to “dif-

ferent claim scope,” *Wi-LAN USA, Inc. v. Apple Inc.*, 830 F.3d 1374, 1391 (Fed. Cir. 2016). Here, *some* asserted claims recite “insecticidal *or* miticidal composition[s],” but others recite only “*miticidal* composition[s].” Appx33(14:42-49); Appx34(15:9-14) (emphasis added). That shows a difference in scope.

Prosecution history—often “critical” in claim construction, *Univ. of Mass. v. L’Oreal S.A.*, 36 F.4th 1374, 1379 (Fed. Cir. 2022)—makes that conclusion inescapable. FMC amended claim 1 of the ’416 patent “to be *limited to* miticidal compositions” by deleting the words “insecticidal or” from the preamble. Appx1101; Appx1104 (emphasis added). Skilled artisans seeing that history and variation in language would understand “the claim drafter ch[ose] to use . . . the preamble . . . to define the subject matter of the claimed invention.” *Bell*, 55 F.3d at 620.

2. The panel opinion did not dispute that, under ordinary claim-construction principles, “miticidal” claims and “insecticidal *or* miticidal” claims have distinct scope. Rather than apply ordinary claim-construction principles, however, the panel invoked the “‘general[.]’” rule that preambles “‘stat[ing] the purpose or intended use of an invention’” are not limiting. Op.13 (quoting *Pacing Techs., LLC v. Garmin Int’l, Inc.*, 778 F.3d 1021, 1023 (Fed. Cir. 2015)). Here, the panel proclaimed, the “miticidal” language is non-limiting because it “recited” a mere “use.” *Id.* The panel rejected FMC’s “linguistic differentiation” argument

because it viewed preambles mentioning “uses” as categorically non-limiting. *Id.* Linguistic-variation arguments, the opinion declares, impermissibly “presuppose[] that the preamble limits the claim.” *Id.* Such variation had “no effect” here, the panel held, because the preamble “language is not [limiting] in the first place.” *Id.* The opinion never mentions the prosecution history, which shows that the claims were amended to effect precisely that differentiation of scope. The panel thus refused to apply claim-construction principles to determine whether the preamble was limiting “in the first place.” *Id.*

That is upside down. Courts should not wait to apply claim-construction rules until after they decide preambles are limiting. Claim-construction principles should answer whether preambles are limiting in the first place. In *Bell*, for example, this Court explained that deciding whether “claim preambles limit the scope of claims” is “part” of the “broader task of claim construction,” subject to the same “principles.” 55 F.3d at 620-21. The same idea pervades precedent: “[W]hether a preamble is limiting” is determined using a “claim construction analysis.” *Eli Lilly*, 8 F.4th at 1340-41.

As *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), made clear, all “the words of a claim” must be given the “‘ordinary and customary meaning’” they would have to skilled artisans. *Id.* at 1312-13. There is no “rigid algorithm” of *per se* rules for any particular claim part. *Id.* at 1324. And preambles

are just parts of claims; construing them “presents no deep[] mystery.” *Bell*, 55 F.3d at 621.

3. The panel decision cites *Pacing*, 778 F.3d at 1023, for the idea that preambles reciting a “‘purpose or intended use’” are necessarily non-limiting. *Op.13*. But *Pacing* reflects no categorical rule; it offers “‘general[]’” observations. *Id.* And this Court has rejected attempts to draw “binary distinction[s] between statements of mere intended purpose on the one hand and limiting preambles on the other.” *Eli Lilly*, 8 F.4th at 1340. Yet the panel decision does just that.

*Symantec Corp. v. Computer Assocs. Int’l, Inc.*, 522 F.3d 1279 (Fed. Cir. 2008), is equally unresponsive. There, the Court determined that “different language in the preamble than in the body of the claims does not suggest that the preamble imposes a limitation.” *Id.* at 1289. That makes sense: A disputed preamble will ordinarily use different language. Absent that variation, no dispute would arise because the claim body, at minimum, would supply the relevant limitation. Intentional variation from preamble to preamble is very different. It commands that the variation is there for a reason—as does the prosecution history here. *See* p. 9, *supra*.

### **B. The Law on Preamble Construction Is Rife with Inconsistency**

The “law on preambles is nonsense and all messed up.” Oral Argument at 6:29-6:35, *Xencor*, No. 24-1870 (Hughes, J.). The panel decision perpetuates that

mess. Despite repeated admonitions to avoid categorical rules when determining whether a preamble is limiting, panels keep invoking such rules. This Court’s “case law” on preambles thus “has become rife with inconsistency,” *Am. Med.*, 618 F.3d at 1363-64 (Dyk., J., dissenting)—an “incoherent mess,” Mark A. Lemley, *Without Preamble*, 100 B.U.L. Rev. 357, 388 (2020). En banc review is required to “jettison” special, categorical rules for preambles and restore coherence to this important area of law. *Alnylam Pharms., Inc. v. Pfizer, Inc.*, No. 22-cv-336, 2024 WL 3742313, at \*4 (D. Del. Aug. 9, 2024) (Connelly, C.J.).

1. The development of this Court’s preamble jurisprudence resembles the game of telephone. More than half a century ago, this Court’s predecessor “review[ed] some 37 cases” and observed that courts had denied preambles “‘the effect of a limitation’” in some situations (like when “‘the preamble merely stated a purpose’”), while granting them effect when it “‘was considered necessary to give life, meaning and vitality to the claims.’” *Bell*, 55 F.3d at 620-21 (quoting *Kropa v. Robie*, 187 F.2d 150, 152 (C.C.P.A. 1951)). *Bell* explained that those case summaries were just another way of saying that “[p]reamble construction” is part of “claim construction.” *Id.* at 621.

But what started as a summary of cases rapidly evolved (or devolved) with each telling. Courts first treated the summaries as “**general[]**” directives, as *Pacing* did: The “purpose or intended use of an invention is **generally** not . . . limiting.”

778 F.3d at 1023 (emphasis added); *see* Op.13. But those general directives have since become categorical rules. The panel decision here, for example, invoked *Pacing*'s generalization to categorically reject otherwise applicable claim-construction principles. It concluded that the “miticidal” preambles described a “use” and thus couldn’t be limiting regardless of what claim-construction principles (and prosecution history) otherwise showed. Op.13; *see* pp. 9-10, *supra*. In *Shoes by Firebug LLC v. Stride Rite Children’s Grp.*, 962 F.3d 1362 (Fed. Cir. 2020), the Court similarly found that “an intended purpose” in the preamble “does not limit the claims,” and “preamble[s] . . . cannot” limit claims when “the same element . . . is independently recited in the body of the claim.” *Id.* at 1367-68. Other cases hold “that ‘a preamble is not limiting ‘where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention.’”” *Arctic Cat*, 919 F.3d at 1329.

2. Such *per se* rules are misplaced. There are no “binary distinctions” between limiting and non-limiting preambles. *Eli Lilly*, 8 F.4th at 1340. Nor are there distinctions between preambles and other sorts of claim language: “[T]he [patent] statute” “does not mention preambles” and does not distinguish between “[t]he effect of preamble language” versus other claim language. *Arctic Cat*, 919 F.3d at 1327; *see* 35 U.S.C. § 112(b).

When deciding whether claim terms are limiting, the question should always be whether skilled artisans would understand them to be limiting—whether the terms appear in preambles or not. *Phillips*, 415 F.3d at 1312-13; *Bell*, 55 F.3d at 620-21.<sup>1</sup> The answer must always turn on skilled artisans’ views of “the words of the claims themselves, the remainder of the specification, the prosecution history,” and relevant “extrinsic evidence.” *Phillips*, 415 F.3d at 1312-13.

3. This Court’s judges, district court judges, and academics have all decried the untenable state of this Court’s law on preambles. Pp. 11-12, *supra*. “[T]he time [has] come for” the Court to clean it up. *Am. Med.*, 618 F.3d at 1364 (Dyk., J., dissenting). The issues are important and often dispositive. Where the Court deemed a preamble not limiting in *Marrin v. Griffin*, 599 F.3d 1290, 1294-95 (Fed. Cir. 2010), it affirmed an anticipation ruling. But when the Court gave a preamble weight in *In re Fought*, 941 F.3d 1175, 1179 (Fed. Cir. 2019), it reversed. So too with infringement. *E.g.*, *Data Engine Techs. LLC v. Google LLC*, 10 F.4th 1375, 1380-81 (Fed. Cir. 2021); *Am. Med.*, 618 F.3d at 1359. Patentholders and drafters need predictability; the current “mess” should not continue.

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<sup>1</sup> Disputes also arise when construing language in a claim’s body. *E.g.*, *Bristol-Myers Squibb Co. v. Ben Venue Labs, Inc.*, 246 F.3d 1368, 1374-75 (Fed. Cir. 2001) (preamble and body limitations were non-limiting); *In re Copaxone Consolidated Cases*, 906 F.3d 1013, 1023 (Fed. Cir. 2018) (body limitation “superfluous” and “non-limiting”).

## II. THE PANEL’S CONSTRUCTION OF “COMPOSITION” MISAPPREHENDED FMC’S ARGUMENTS AND OVERLOOKED MATERIAL FACTS

The panel’s construction of “composition” warrants panel rehearing. The claims recite “compositions” of bifenthrin and zeta-cypermethrin. *E.g.*, Appx33 (14:42-47); Appx33 (14:48-49); Appx43 (13:41-50). The inventors repeatedly disclaimed prior-art “tank mixture[s].” Appx870-71; Appx861 (1:26-45). Those mixtures were plagued by instability and thus poor efficacy. Appx870-71. The claimed composition[s], the inventors explained, were different: They had “significantly improve[d] physical stability,” resulting in an “increase in insecticidal activity.” Appx871.

Based on that disclaimer, the district court found that the claimed insecticidal and miticidal “composition[s]” “cover only *stable* compositions.” Appx21-22 (emphasis added). The panel’s contrary decision misapprehended FMC’s arguments and overlooked key facts.

### A. The Decision Misapprehends Material Differences Between *DDR* and this Case

No one disputes that, in the ’979 provisional application and related ’145 patent, the inventors repeatedly explained that the “present invention” was compositions with “significantly improve[d] physical stability.” Appx871. And there is no serious question that the inventors repeatedly disclaimed prior art “tank mixture[s]” as something other than their invention, because such mixtures had

known “problems with . . . physical stability” and, as a result, “application and efficacy issues.” Appx870-71. The panel nonetheless determined “that ‘composition,’ as recited in the claims, includes ‘tank mixtures’”—the same unstable and ineffective prior-art mixtures over which the inventors distinguished their invention. Op.11 & n.4. According to the panel, *DDR Holdings, LLC v. Priceline.com LLC*, 122 F.4th 911 (Fed. Cir. 2024), required that result. Under *DDR*, the opinion declared, skilled artisans would find “highly significant” the inventors’ decision to “remove[.]” stability-related disclosures “from the asserted patents.” Op.7.

The panel misapprehended *DDR* and FMC’s arguments about it. FMC had explained that, in *DDR*, the inventors had *redefined* a claim term to exclude a category. ECF #29 at 2. There, “[t]he provisional application [had] defined ‘merchants[.]’ . . . as ‘producers . . . of *products or services*,’” whereas the downstream patent “defined ‘merchants’ as ‘the producers . . . of the *goods*.’” Op.7. Here, the inventors merely chose not to carry forward into the body of the patent already clear disclaimers made during prosecution. Giving that choice dispositive weight broadened the claims so as to encompass the very prior art the inventors had emphatically distinguished from their invention. ECF #29 at 2. *DDR* does nothing similar.

The decision does not address that difference. The decision instead addressed an argument FMC never made—that *DDR* involved “*narrow[ing]*” claims, while

this case involved “*broaden[ing]*” claims. Op.8. But FMC’s argument was not merely about scope; it was about how Sharda’s construction would broaden the claims *in a manner that defies prosecution history*. The decision never responds to that argument.

Differences between later-issued patents and provisionals may “‘contribute[.]’” to skilled artisans’ understanding of later-issued patents. Op.8. But inventor statements about how their inventions differ from prior art can too. Here, the inventors repeatedly said their “present invention” was compositions with “significantly improve[d] physical stability”; and they said it *was not* prior art “tank mixture[s]” that had “problems with . . . physical stability.” Appx870-71. The inventors decided not to repeat those statements in the asserted patents themselves, focusing on the compositions’ unexpected insecticidal activity instead.

That differs from *DDR* in critical respects. A skilled artisan could certainly understand the different definitions of “merchant” to impart different meanings. But no one—neither Sharda nor the panel—has shown that skilled artisans would read the claims the way the panel did. No skilled artisan, considering the prosecution history here, would understand the asserted patents’ focus on efficacy—instead of stability—to mean that the inventors intended to broaden their claims to cover the very prior art they had clearly and unmistakably disclaimed.

**B. The Panel Decision Overlooked That Skilled Artisans Understood Superior Insecticidal Activity To Require Stability**

The decision also overlooked other disclosures showing that “composition” is limited to stable compositions. The asserted patents repeatedly emphasize that the claimed compositions “exhibit unexpected insecticidal activity.” Appx27(1:10-13, 1:65-2:14); Appx37(1:10-13, 2:1-17). During prosecution, the inventors distinguished prior art on that basis. Appx1616-18; *see* Appx1359-60. And undisputed evidence showed that skilled artisans knew superior insecticidal activity required stability. FMC.Br.40; Appx10; Appx21-22; Appx870-71; Appx2403. FMC thus argued skilled artisans would have understood from the asserted patents— notwithstanding any deletion of stability disclosures—that the claimed compositions had to be stable. FMC.Br.39-40; Op.10. The panel nonetheless concluded “that ‘composition,’ as recited in the claims, includes ‘tank mixtures’”—the unstable and ineffective prior-art tank mixtures over which the inventors distinguished their invention. Op.11 & n.4.

According to the panel, the specification and prosecution history could not have “equate[d] ‘activity’ with ‘stability’” because “‘insecticidal activity’ has a different meaning from ‘stability.’” Op.10. But that misses FMC’s point and the undisputed facts: Skilled artisans knew that unstable compositions have poor insecticidal activity. They thus also understood that compositions with superior insecticidal activity—like the claimed compositions—had to be stable. Sharda’s own

expert admitted that, to be significantly more effective than bifenthrin and zeta-cypermethrin “individually,” a “composition” with both active ingredients “would necessarily have to have been stable.” Appx2403. The provisional application confirmed that skilled artisans knew “physical [in]stability of [prior art] mixtures . . . have caused . . . efficacy issues.” Appx870-71. The district court agreed. Appx21-22 (instability of “bifenthrin . . . and zeta-cypermethrin” mixtures “led to ineffective[ness]”).

That undisputed evidence—which the panel opinion never addresses—undermines the panel’s construction of “composition.” Claims must be read from the perspective of skilled artisan “presumed” to have “[k]nowledge of the prior art.” *Storer v. Clark*, 860 F.3d 1340, 1350 (Fed. Cir. 2017). But the panel’s construction broadly covers prior-art tank mixes that skilled artisans—and the inventors—knew were unstable and thus ineffective. Op.11 & n.4. That conflicts with how skilled artisans would have understood the claimed, efficacious compositions. It cannot be right.

### **CONCLUSION**

Panel or en banc rehearing should be granted.

September 16, 2025

Benoit Quarmby  
MOLOLAMKEN LLP  
430 Park Avenue  
New York, NY 10022  
(212) 607-8160

Respectfully submitted,

/s/ Jeffrey A. Lamken

Jeffrey A. Lamken  
Lucas M. Walker  
Jennifer Elizabeth Fischell  
Walter H Hawes IV  
Kayvon Ghayoumi  
MOLOLAMKEN LLP  
The Watergate, Suite 500  
600 New Hampshire Avenue, N.W.  
Washington, D.C. 20037  
(202) 556-2000  
jlamken@mololamken.com

*Counsel for Plaintiff-Appellee FMC Corporation*

**ADDENDUM**

# United States Court of Appeals for the Federal Circuit

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**FMC CORPORATION,**  
*Plaintiff-Appellee*

v.

**SHARDA USA, LLC,**  
*Defendant-Appellant*

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2024-2335

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Appeal from the United States District Court for the Eastern District of Pennsylvania in No. 2:24-cv-02419-MRP, Judge Mia Roberts Perez.

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Decided: August 1, 2025

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LUCAS M. WALKER, MoloLamken LLP, Washington, DC, argued for plaintiff-appellee. Also represented by JENNIFER ELIZABETH FISHELL, KAYVON GHAYOUMI, WALTER H. HAWES, IV, JEFFREY A. LAMKEN; BENOIT QUARMBY, New York, NY.

MIRCEA TIPESCU, Benesch, Friedlander, Coplan & Aronoff LLP, Chicago, IL, argued for defendant-appellant. Also represented by MANISH MEHTA, TARA MYTHRI RAGHAVAN.

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Before MOORE, *Chief Judge*, CHEN, *Circuit Judge*, and  
BARNETT, *Judge*.<sup>1</sup>

CHEN, *Circuit Judge*.

Sharda USA, LLC (Sharda) appeals from a preliminary injunction order, barring it from importing, marketing, selling, or distributing its accused product. J.A. 1–2; *see FMC Corp. v. Sharda USA LLC*, No. 24-cv-02419, 2024 WL 3361604 (E.D. Pa. July 10, 2024) (*First Memorandum*); *FMC Corp. v. Sharda USA LLC*, No. 24-cv-02419, 2024 WL 3850811 (E.D. Pa. Aug. 16, 2024) (*Second Memorandum*). For the reasons explained below, we *vacate* and *remand*.

#### BACKGROUND

FMC owns U.S. Patent Nos. 9,107,416 (’416 patent) and 9,596,857 (’857 patent) (collectively, asserted patents). The asserted patents claim the benefit of U.S. Provisional Application No. 60/752,979 (’979 provisional application).

The asserted patents,<sup>2</sup> titled “Insecticidal and Miticidal Mixtures of Bifenthrin and Cyano-Pyrethroids,” relate to insecticides and miticides. ’416 patent at Abstract. They propose “novel insecticidal compositions comprising bifenthrin and a cyano-pyrethroid” that purportedly “exhibit unexpected insecticidal activity.” *Id.* col. 1 ll. 11–13. Independent claim 1, representative for the purposes of this appeal, recites:

1. A miticidal composition comprising bifenthrin and a cyano-pyrethroid selected from the group consisting of deltamethrin, cyfluthrin, alpha-cypermethrin, zeta-cypermethrin, lambda-cyhalothrin,

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<sup>1</sup> Honorable Mark A. Barnett, Chief Judge, United States Court of International Trade, sitting by designation.

<sup>2</sup> The asserted patents share a common specification. We cite to the specification of the ’416 patent as exemplary of both patents.

and esfenvalerate, wherein the weight ratio of bifenthrin to cyano-pyrethroid is from 10:1 to 1:30.

'416 patent at claim 1.

Sharda sells WINNER, an insecticide containing bifenthrin and zeta-cypermethrin (a cyano-pyrethroid). J.A. 1. FMC brought suit against Sharda for patent infringement, asserting both the '416 and '857 patents. FMC initially moved for both a temporary restraining order and a preliminary injunction, which the district court denied for reasons unrelated to this appeal. *First Memorandum*, 2024 WL 3361604, at \*1; J.A. 169–71.

But of importance, in its memorandum denying FMC's motion, the district court issued a claim construction of "composition." *First Memorandum*, 2024 WL 3361604, at \*3–4. Rather than adopting the term's plain and ordinary meaning, which Sharda argued for, the district court construed "composition" as limited to "stable compositions, rather than the well-known unstable compositions that produce ineffective results as discussed throughout the prosecution history." *Id.* at \*4.

To support this construction, the district court relied on statements about physical stability in the '979 provisional application. As the district court noted, the '979 provisional observed that "[a] problem in the art of formulating bifenthrin and zeta-cypermethrin is in successfully achieving physical stability of a water-diluted mixture of the formulation over significant periods of time," and that "[p]hysical stability is most important in this type of formulation to ensure the small amounts of the insecticides are fully effective." *Id.* (first alteration in original) (quoting J.A. 870). The district court also relied on disclosures in U.S. Patent No. 8,153,145 ('145 patent), another patent owned by FMC which also claims the benefit of the '979 provisional application. Here too, the district court relied on express disclosures about physical stability. *See, e.g., id.* ("[T]he '145 Patent explained that '[t]he novel

formulations of the present invention are superior in maintaining the physical stability of a mixture of bifenthrin and zeta-cypermethrin in dilution stability tests when compared to the control dilution stability test.” (second alteration in original) (quoting ’145 patent col. 7 ll. 29–32)). The district court, however, did not acknowledge that such disclosures about physical stability, though present in the ’979 provisional application and the ’145 patent, did not exist in the asserted patents.

Shortly thereafter, FMC renewed its motion for a temporary restraining order. The district court first rejected Sharda’s invalidity defense based on anticipation over McKenzie, a prior art reference.<sup>3</sup> *Second Memorandum*, 2024 WL 3850811, at \*3–4. According to the district court, McKenzie disclosed only *unstable* compositions, which fell outside “composition” as construed. *Id.* at \*3. The district court then rejected Sharda’s obviousness arguments “for similar reasons as the anticipation argument.” *Id.* at \*4. The district court separately noted that, during prosecution of the asserted patents, “the patented compositions overcame obviousness arguments due to their unexpected superior performance.” *Id.* And in response to Sharda’s written description and indefiniteness challenges under 35 U.S.C. § 112, the district court found that the common specification discloses “the ‘unexpected insecticidal activity’ achieved by the patented compositions,” which sufficed to provide adequate disclosure of stable compositions and reasonable certainty as to the scope of the claimed invention. *Id.* at \*5 (citations omitted).

The district court issued the temporary restraining order, which automatically converted into a preliminary injunction order after 14 days elapsed. J.A. 1–2; *see* Fed. R. Civ. P. 65(b)(2). Sharda appeals the district court’s order,

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<sup>3</sup> McKenzie, a 1996 article, discusses the performance of various pesticide mixtures. J.A. 311–18.

arguing that the district court's construction of "composition" was erroneous, and thus, so too was the district court's conclusion that Sharda had not raised a substantial invalidity challenge under anticipation or obviousness. We have jurisdiction under 28 U.S.C. § 1292(c)(1); *see also id.* § 1295(a)(1).

#### DISCUSSION

We review the grant or denial of a preliminary injunction under the law of the regional circuit, here the Third Circuit. *Natera, Inc. v. NeoGenomics Lab's, Inc.*, 106 F.4th 1369, 1374 (Fed. Cir. 2024). "However, the Federal Circuit has itself built a body of precedent applying the general preliminary injunction considerations to a large number of factually variant patent cases, and gives dominant effect to Federal Circuit precedent insofar as it reflects considerations specific to patent issues." *Id.* at 1375 (quoting *Murata Mach. USA v. Daifuku Co.*, 830 F.3d 1357, 1363 (Fed. Cir. 2016)). Both the Third Circuit and the Federal Circuit review the district court's decision to grant or deny a preliminary injunction for an abuse of discretion. *Id.*; *Ferring Pharms., Inc. v. Watson Pharms., Inc.*, 765 F.3d 205, 210 (3d Cir. 2014). An abuse of discretion may arise when the district court made a clear error of judgment in weighing relevant factors, exercised its discretion based upon an error of law, or exercised its discretion based upon clearly erroneous factual findings. *Natera*, 106 F.4th at 1375.

We begin with Sharda's challenge to the district court's construction of "composition," before turning to Sharda's invalidity defenses.

#### I. Claim Construction

"We review claim construction based on intrinsic evidence de novo and review any findings of fact regarding extrinsic evidence for clear error." *SpeedTrack, Inc. v. Amazon.com*, 998 F.3d 1373, 1378 (Fed. Cir. 2021). We

generally give claim terms their plain and ordinary meaning, which is the meaning that a skilled artisan would ascribe when reading the term in context of the claim, specification, and prosecution history. *Kyocera Senco Indus. Tools Inc. v. ITC*, 22 F.4th 1369, 1378 (Fed. Cir. 2022).

The district court construed “composition” to mean *stable* compositions only, relying primarily on disclosures stressing stability within the ’979 provisional application and the related ’145 patent. *First Memorandum*, 2024 WL 3361604, at \*4. The district court also relied on references to “unexpected insecticidal activity” in the shared specification of the asserted patents. *Id.*

Sharda contends that, although the ’979 provisional application and ’145 patent contain various teachings about stability and stable compositions, the common specification of the asserted patents omits every such disclosure. That is, the patent applications that matured into the asserted patents did not simply carry over and maintain the same specification from the earlier-filed ’979 provisional application; instead, FMC chose to alter the asserted patents’ written description by deleting every single one of the many references contained in the ’979 provisional application to stability and stable compositions. And therefore, according to Sharda, the district court impermissibly grafted a stability requirement onto “composition” as used in the claims of the asserted patents. We agree.

We begin with the ’979 provisional application. As FMC notes, it contains several references to “stability.” *See, e.g.*, J.A. 870 (“However, a problem in the art of formulating bifenthrin and zeta-cypermethrin is in successfully achieving physical stability of a water-diluted mixture of the formulation over significant periods of time.”); *id.* (“Mixtures containing two or more insecticide compositions have been practiced in the art, but problems with the physical stability of such mixtures in water have caused application and efficacy issues.”); *id.* at 873 (“An acid is used to

buffer the formulation in order to stabilize the zeta-cypermethrin from epimerizing to less active isomers.”); *id.* at 876 (“Dilution stability studies were conducted using 2.5 mL of the formulation added to 47.5 mL of water with 342 ppm hardness in a 50 mL Nessler tube.”). But none of those stability statements made it into the asserted patents; FMC culled all such references from the common specification. Neither “stable” nor “stability,” nor any variation thereof, appear anywhere in the common specification.

Under the circumstances, we see little difference between this case and *DDR Holdings, LLC v. Priceline.com LLC*, 122 F.4th 911 (Fed. Cir. 2024). In *DDR*, the provisional application defined “merchants,” in relevant part, as “producers, manufacturers, and select distributors of *products or services*.” *Id.* at 915 (citation omitted). But the patent-at-issue defined “merchants” as “the producers, distributors, or resellers of the *goods*.” *Id.* at 915–16 (citation omitted). “Notably missing from the patent’s specification, however, [was] any mention of *services* in relation to merchants.” *Id.* at 916. We found that deletion of “services” “highly significant,” explaining that a skilled artisan would understand that “progression between the provisional application and the patent specification to indicate an evolution of the applicant’s intended meaning of the claim term.” *Id.*

So too here. The ’979 provisional application contains several disclosures about stable compounds, yet none appear in the asserted patents. A skilled artisan would find that evolution meaningful: every textual reference in the provisional application that a skilled artisan might reasonably have relied upon for interpreting “composition” as covering only stable compounds was removed from the asserted patents. A skilled artisan, in light of such deletions in the prosecution history, would not understand “composition” as claimed in the asserted patents to cover only stable formulations. *See MPHJ Tech. Invs., LLC v. Ricoh Ams. Corp.*, 847 F.3d 1363, 1369 (Fed. Cir. 2017) (“In

this case, it is the deletion from the . . . [p]rovisional application that contributes understanding of the intended scope of the final application.”); *Finjan LLC v. ESET, LLC*, 51 F.4th 1377, 1383 (Fed. Cir. 2022) (“The use of a restrictive term in an earlier application does not reinstate that term in a later patent that purposely deletes the term, even if the earlier patent is incorporated by reference.”).

FMC attempts to distinguish *DDR*, arguing that it applies only where the progression between a provisional application and the patent-at-issue *narrows* the meaning of a claim term. Here, according to FMC, the progression is different because, if considered, it would *broaden* the scope of “composition” to also include unstable compositions. But our reasoning in *DDR* did not turn on whether the deletions there would narrow or broaden the claim scope. *See DDR*, 122 F.4th at 915–17. Rather, our holding turned on the existence of meaningful alterations the patent owner made between the content of the provisional application and the patent-at-issue. And here, as explained above, FMC amended the common specification of the asserted patents, deleting every reference to the terms “stable,” “stability,” and variations thereof. The ’979 provisional application, accordingly, cannot limit “composition” in the asserted patents to only stable compositions.

The district court’s reliance on the related ’145 patent suffers from a similar problem. Unlike the common specification of the asserted patents, FMC’s ’145 patent specification maintained the ’979 provisional application’s several disclosures of stable compounds. *See, e.g.*, ’145 patent col. 1 ll. 10–13 (“In particular, the invention relates to novel insecticidal compositions comprising bifenthrin and enriched cypermethrin that are physically stable when diluted with water.”); *id.* col. 1 ll. 55–58 (“The present invention is directed to novel insecticidal compositions comprising bifenthrin and enriched cypermethrin in an insecticidal formulation having significantly improved physical stability when the composition is diluted in water.”).

According to the district court, because “composition” as claimed in the ’145 patent seemed to cover only stable compositions, “composition” in the asserted patents should be similarly limited.

We disagree. It is true we typically interpret a claim term consistently across a patent family when the patents “derive from the same parent application.” *SightSound Techs., LLC v. Apple Inc.*, 809 F.3d 1307, 1316 (Fed. Cir. 2015). But that principle does not hold true when the patent owner, like FMC here, materially alters the specification of some of the members of the patent family in a manner that directs a skilled artisan to interpret the claim term differently. So even if “composition” as claimed in the ’145 patent covers only stable compositions—a premise we express no view on—the district court erred by transferring that construction to “composition” as claimed in the asserted patents.

FMC additionally contends that the asserted patents’ references to “homogeneous” compositions and “unexpected insecticidal activity” mandate a stability requirement for “composition.” We disagree.

FMC, for starters, provides no persuasive reason for why “homogeneous,” as used in the common specification of the asserted patents, means “stable.” FMC asserts that a “homogeneous” composition means one that has not physically separated. *See* Appellee’s Br. 38. But the asserted patents do not mention, let alone even discuss, physical separation.

Moreover, we find it particularly problematic to equate “homogeneous” with “stable” given the prosecution history. The ’979 provisional application expressly mentions “homogeneous” and physical “phase separation,” but in different sections corresponding to different teachings, with no suggestion that the two phrases relate to one another. *Compare* J.A. 875 (“Upon completion of the addition, the agitation was continued for 10 minutes to obtain a

yellowish homogeneous solution.”), *with* J.A. 870 (“When traditional insecticidal compositions are combined, the combined components (surfactants, viscosity modifiers, wetting agents) of both may cause accelerated physical degradation (phase separation) of the mixture when diluted in low to moderately hard water.”).

FMC’s reliance on the “unexpected insecticidal activity” fares no better. According to FMC, compositions exhibiting “unexpected insecticidal activity” means that the compositions possessed “unexpected effectiveness,” which in turn implies that the compositions were stable. Appellee’s Br. 39. FMC’s attempt to indirectly equate “activity” with “stability” runs into two problems.

First, the common specification suggests that “insecticidal activity” has a different meaning from “stability.” The asserted patents discuss insecticidal activity in context of how many total insects a composition can kill. *See, e.g.*, ’416 patent col. 6 ll. 24–27 (measuring insecticidal activity as a percentage “derived from the total number of dead insects (TD) compared to the total number of insects (TI) in the test . . .”). In contrast, although the common specification does not discuss stability, the ’979 provisional application indicates that stability refers to the ability of a composition to not physically separate into different phases over “significant periods of time.” J.A. 870. Insecticidal activity and stability, therefore, describe different properties of the claimed compositions.

Second, the prosecution history further militates against FMC’s attempt to equate “insecticidal activity” with “stability.” The ’979 provisional application itself uses “insecticidal activity” and “stability” in different contexts, suggesting that the terms carry different meanings. *Compare, e.g.*, J.A. 870 (discussing “stability” in context of phase separation), *with* J.A. 872 (discussing “insecticidal activity” in context of the kinds of insects killed). But FMC has not explained why that distinction between “stability”

and “insecticidal activity” in the ’979 provisional application no longer applies in the asserted patents.

We thus hold that the district court erred by imposing a stability requirement onto the term “composition” as recited in the claims of the asserted patents. On remand, the district court should instead give “composition” its plain and ordinary meaning.<sup>4</sup>

## II. Anticipation

With the correct claim construction in mind, we turn to Sharda’s argument that McKenzie anticipates the asserted patents.

“An accused infringer ‘need not make out a case of actual invalidity’ to avoid a preliminary injunction but need only show a substantial question of invalidity.” *Natera*, 106 F.4th at 1376 (citation omitted). If challenged, the patent owner must show “it is more likely than not to prevail over an invalidity challenge.” *Id.* at 1377.

The district court found that McKenzie did not anticipate the claims asserted by FMC, primarily because McKenzie disclosed only unstable compounds, and therefore did not disclose “composition” per the district court’s construction. *See Second Memorandum*, 2024 WL 3850811, at \*3. Since we find error in the district court’s construction of “composition,” we accordingly find error in the district court’s anticipation analysis. Separately, to the extent that the district court formally found that McKenzie did not anticipate the claims, the district court

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<sup>4</sup> We also note that “composition,” as recited in the claims, includes “tank mixtures,” a specific type of mixture which the district court seemingly excluded from the construction of “composition” only because of its purported instability. *See Second Memorandum*, 2024 WL 3850811, at \*3–4.

impermissibly elevated the standard for defeating a preliminary injunction motion. *See Natera*, 106 F.4th at 1376 (“An accused infringer ‘need not make out a case of actual invalidity’ to avoid a preliminary injunction but need only show a substantial question of invalidity.” (citation omitted)).

The district court also appeared to fault Sharda for focusing on certain, less-effective embodiments disclosed in McKenzie, to the exclusion of McKenzie’s preferred embodiments. *See, e.g., Second Memorandum*, 2024 WL 3850811, at \*3 (“Sharda cherry-picked efficacy data regarding whitefly nymphs, ignoring the less favorable data regarding whitefly eggs and whitefly adults.”). But an anticipating embodiment in a prior art reference need not be the preferred embodiment. *See Arthrocare Corp. v. Smith & Nephew, Inc.*, 406 F.3d 1365, 1372 (Fed. Cir. 2005) (finding the district court’s anticipation analysis erroneous because it “limit[ed] the disclosure of the prior art reference to a preferred embodiment”). Thus, to the extent that the district court penalized Sharda for relying on certain embodiments in its anticipation defense, we find error.

FMC contends that even if the district court’s anticipation analysis rested on an erroneous construction of “composition,” McKenzie nevertheless fails to meet the “miticidal” limitation recited in the preamble of several asserted claims. According to FMC, although McKenzie discloses usage of Capture<sup>5</sup> in various embodiments, “Capture is appropriate as a miticide only at a use rate of *at least 0.06 lbs/acre*.” Appellee’s Br. 64. And since “McKenzie does not disclose any use of Capture at the necessary [0.06

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<sup>5</sup> Capture is a class of prior art insecticide products that contains bifenthrin. *See* Appellant’s Br. 19; Appellee’s Br. 5.

lbs/acre] rate,” FMC concludes that McKenzie cannot raise a substantial question of anticipation. *Id.*

We reject this attempt to narrow the claimed scope based on a use recited in the preamble. “Preamble language that merely states the purpose or intended use of an invention is generally not treated as limiting the scope of the claim.” *Pacing Techs., LLC v. Garmin Int’l, Inc.*, 778 F.3d 1021, 1023 (Fed. Cir. 2015) (citation omitted).

FMC’s only rebuttal is that because one claim’s preamble recites “miticidal,” whereas a different claim’s preamble recites “miticidal or insecticidal,” that variation in preamble language should be given effect. But this argument based on linguistic differentiation presupposes that the preamble limits the claim—variations in language have no effect if said language is not controlling in the first place. *See Symantec Corp. v. Comput. Assocs. Int’l, Inc.*, 522 F.3d 1279, 1288–89 (Fed. Cir. 2008) (declining to find the preamble limiting, despite the fact that the preamble used different language from the claim body).

We thus find that the district court abused its discretion by relying on an erroneous claim construction and clearly erroneous factual findings in its anticipation analysis. On remand, the district court should reconsider whether, under the correct claim construction of “composition”, Sharda has raised a substantial question of anticipation by McKenzie.<sup>6</sup>

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<sup>6</sup> The district court also appeared to fault Sharda for not pointing out which specific Capture products and which specific Mustang products (a preexisting product line of pesticides using zeta-cypermethrin) were used in McKenzie. *Second Memorandum*, 2024 WL 3850811, at \*3. The representative claim, however, requires only a composition

### III. Obviousness

The district court rejected Sharda's obviousness arguments "for similar reasons as [Sharda's] anticipation argument."<sup>7</sup> *Second Memorandum*, 2024 WL 3850811, at \*4. In light of our conclusion that the district court abused its discretion in its anticipation analysis, we accordingly find the same for its obviousness analysis.

FMC objects that, to the extent the district court erroneously construed "composition," the erroneous construction did not affect its obviousness analysis. The district court, according to FMC, rested its obviousness analysis on the "unexpected superior performance" of the claimed compositions, not on the alleged "stability" of the claimed compositions. Appellee's Br. 59 (citation omitted). We disagree.

The district court's own reasoning undermines FMC's argument. The district court prefaced its obviousness discussion by stating "[t]hese arguments fail for similar reasons as the anticipation argument." *Second Memorandum*, 2024 WL 3850811, at \*4. And the district court's anticipation analysis, as noted above, turned on its erroneous construction of "composition." *See supra* Discussion Section II.

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comprising certain components within a certain weight ratio range. *See* '416 patent at claim 1. FMC and Sharda appear to agree that all Capture products contain a non-zero amount of bifenthrin, and all Mustang products contain a non-zero amount of zeta-cypermethrin. *See* Appellant's Br. 28; Appellee's Br. 2, 5, 7, 10, 12, 20.

<sup>7</sup> We reiterate that, in addressing Sharda's defenses to a temporary restraining order or preliminary injunction, the district court must determine whether Sharda has raised a "substantial question" of obviousness, not whether Sharda has made out an actual case of obviousness. *See Natera*, 106 F.4th at 1376.

Moreover, in explaining why McKenzie's compositions do not render the claims of the asserted patent obvious, the district court referenced its prior discussion of McKenzie. Yet the preceding—and only—discussion about McKenzie's formulations in the decision centered on their purported instability. *See id.* at \*3 (noting that McKenzie's compositions, among other things, suffered from “instability”). And most conspicuously, the district court concluded that, among other factors, “the well-known difficulty in achieving a stable formulation of bifenthrin and zeta-cypermethrin, establish that the asserted patents are not obvious to a person skilled in the art.” *Id.* at \*4. The district court's erroneous claim construction unequivocally influenced its obviousness analysis.

The district court also focused on the unexpected results of the claimed compositions. But the effect of unexpected results, a secondary consideration, requires considering the patent challenger's prima facie case. *See Genentech, Inc. v. Sandoz Inc.*, 55 F.4th 1368, 1378 (Fed. Cir. 2022) (“[W]eak secondary considerations generally do not overcome a strong prima facie case of obviousness.” (alteration in original) (citation omitted)). As explained above, the district court's erroneous claim construction infected its analysis of the prima facie case.

On remand, the district court should: (1) identify each distinct obviousness theory raised by Sharda; and (2) determine whether Sharda has presented a substantial question of obviousness, considering the relative strengths of the prima facie case and any rebuttal evidence of unexpected results (or other secondary indicia of non-obviousness).

#### IV. Written Description

Sharda contends that, if we uphold the district court's claim construction, the asserted patents lack adequate written description under 35 U.S.C. § 112. Because we reject the district court's claim construction and instead

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direct the district court to give “composition” its plain and ordinary meaning, we do not address Sharda’s invalidity defense based on inadequate written description.

CONCLUSION

We have considered FMC’s remaining arguments and find them unpersuasive. We therefore vacate the district court’s preliminary injunction and remand for further proceedings consistent with this opinion.

**VACATED AND REMANDED**

COSTS

Costs to Appellant.

**UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT**

**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATIONS**

**Case Number:** 24-2335

**Short Case Caption:** FMC Corporation v. Sharda USA, LLC

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Date: 09/16/2025

Signature: /s/ Jeffrey A. Lamken

Name: Jeffrey A. Lamken