



PTAB: Patent Drawings Without Precise Measurements May Be Relied Upon as Prior Art, but Only for What They Clearly Show

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By: Matt Lin, Jason Weil, Rubén H. Muñoz

The Patent Trial and Appeal Board denied institution of an *inter partes* review petition because a prior art patent figure did not provide exact dimensions, and therefore could not meet the relevant claim limitation. On review from the denied institution, the Director explained that a drawing may be relied upon for what it clearly shows, vacating and remanding for a determination of whether the reference is clear on its face or reasonably would have suggested the limitation in view of the supporting expert testimony.

The challenged patent claims require that a certain component of a motor vehicle radiator is placed within 10 inches of an inlet. Petitioner relied on expert testimony explaining that a prior art patent drawing depicted an edge of such a component lining the inlet's internal wall to be "explicitly shown at the inlet." Petitioner argued that a person of ordinary skill would thus have understood this placement to be necessarily within 10 inches of the inlet. The board disagreed, holding that patent drawings cannot be relied upon to show particular sizes if the specification is silent on the issue. Here, petitioner's expert admitted the reference did not provide exact dimensions, and thus the petitioner could not show that the component was within 10 inches of the inlet, as claimed. Petitioner requested Director Review arguing that the drawing's placement of the device "at" the inlet necessarily meets the requirement that it be placed within 10 inches of the inlet, as its expert explained.

The Director granted review and explained that a patent drawing may be relied on for what it clearly shows. Here, the board erred by failing to address petitioner's argument that the figure was clear on its face and shows the component "at" the inlet. The Director vacated and

remanded to the board for further determination as to whether the figure is clear on its face or reasonably suggests the placement of the component within 10 inches of the inlet, and whether the expert testimony provides sufficient explanation as to why the feature was disclosed or obvious based on the disclosure.

On remand the board denied institution again. Adopting petitioner’s construction of “inlet” to mean “*the center axis of [an] . . . inlet,*” the board concluded that the prior art patent drawing did not clearly show, or reasonably suggest, that the component’s placement met the 10-inch limitation because it provided no dimensions. Additionally, petitioner’s expert testimony did not show that the depicted inlet necessarily had a radius less than 10 inches. Petitioner ultimately could not show a reasonable likelihood of prevailing on at least one of the challenged claims.

Practice Tip: Patent drawings without precise measurements may be relied upon for what they clearly show. Petitioners relying on such drawings should support their argument with expert testimony explaining why the figure clearly shows the feature in question. And patent owners facing such a challenge should be ready to explain why the contested limitation is not clear from the figure, especially where the disclosure does not provide precise dimensions.

MAHLE Behr Charleston Inc. v. Frank Amidio Catalano, IPR2023-00861, Papers 15, 18, and 20 (PTAB July 26, 2024)

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