

Obvious Claim Error Does Not Excuse Willful Infringement

Pavo Sols. LLC v. Kingston Tech. Co., Inc., 2022 WL 1815050 (Fed. Cir. June 3, 2022)

By: Joseph Saltiel & Nick Wheeler | June 10, 2022

On June 3, 2022, the CAFC held that reliance on an “obvious minor clerical error” within a claim is not a defense to willful infringement. CATR Co. sued Kingston Technology Co. (“Kingston”) for infringement of U.S. Patent No. 6,926,544 (“the ’544 Patent”) in the Central District of California (“the District Court”). The District Court found that the use of the term “case” in the ’544 Patent was a clerical error. Thus, the District Court replaced the term “case” with the term “cover” within the phrase “pivoting the case with respect to the flash memory main body.” The District Court explained that this error was evident from the “face of the patent,” not subject to reasonable debate, and was consistent with the prosecution history. With this correction, the jury found Kingston willfully infringed the ’544 Patent. Kingston appealed arguing that: (1) the District Court should not have replaced the term “case” as the use of that term was not an error, and if there was an error, the error was neither minor nor obvious; and (2) Kingston could not have formed the requisite intent to willfully infringe because Kingston reasonably relied on the fact that it did not infringe the ’544 Patent as originally written.

On appeal, the CAFC explained that a correction is appropriate “only if (1) the correction is not subject to reasonable debate based on consideration of the claim language and the specification and (2) the prosecution history does not suggest a different interpretation of the claims.” Additionally, an error must be “evident from the face of the patent” and must be made from the standpoint of a person skilled in the art. The CAFC found that based on the full context of the claims, there was an obvious minor clerical error in the patent claims. While Kingston tried to argue that it was improper for the District Court to alter the structure of the claimed invention and broaden the claims, the CAFC explained there was no case law that precluded a court from correcting an obvious minor error that alters a claimed structure and that the other claim elements required that the structure be the “cover” instead of the “case.” Next, the CAFC held that the correction was not subject to a reasonable debate because Kingston’s proposed claim construction resulted in the same claim scope as the District Court’s correction. Furthermore, the CAFC held that the prosecution history did not suggest a different interpretation of the claims and therefore, affirmed the District Court’s correction. Next, the CAFC rejected Kingston’s argument that it did not have the requisite intent for willful infringement because it did not infringe the claims as originally written and could not have anticipated that a court would correct the claims. The CAFC held that reliance on an obvious minor clerical error is not a defense to willful infringement. According to the CAFC, the District Court did not change the “metes and bounds” of the ’544 Patent as judicial correction did not re-make the claim; it merely “gave effect to its obvious meaning.” Kingston also tried to rely on the Patent Trial and Appeal Board’s (“the PTAB”) rejection of the patentee’s claim correction request during a parallel IPR proceeding. The CAFC rejected this argument because the PTAB did not consider the substance of the correction request and that the correction request was irrelevant as culpability for willful infringement is measured against the knowledge of the actor at the time of the alleged conduct. Therefore, the CAFC affirmed the District Court’s judgment that Kingston willfully infringed the ’544 Patent.

When considering infringement and willfulness, parties cannot simply rely on the claims as written but must also consider whether the claims contain a non-obvious error, which can include more than typographical errors, such as the error here that changed the structure of the claim.