FEDERAL CIRCUIT PATENT LAW CASE UPDATE

Energizer Holdings, Inc. v. Int'l Trade Comm'n, 05-1018 (Fed. Cir. Jan. 25, 2006) (Newman, J.)

The court reversed the International Trade Commission's determination that all claims of Energizer's battery patent were invalid under § 112 ¶2 as indefinite. The claims to a zero-mercury-added battery were not insolubly ambiguous because the phrase "said zinc anode" implicitly had antecedent basis in the claims under a reasonable approach to construing and understanding the claims.

Energizer owns U.S. Pat. No. 5,464,709.

> The '709 patent is for an electrolytic alkaline battery cell that is substantially free of mercury. . . . The '709 patent describes the discovery that a cause of gas-producing corrosion is the presence of trace impurities in the zinc used in the anode, and that upon identification and elimination of these impurities, the addition of mercury can be eliminated or substantially reduced. The electrolytic cells at issue are described as "zero-mercury-added" batteries.

Contrary to the Administrative Law Judge's determination, the Commission "held all of the claims invalid for indefiniteness under 35 U.S.C. §112 ¶2, on the ground that the claim term 'said zinc anode' lacks antecedent basis in the claim, and that the claims are unclear or ambiguous." Claim 1 is as follows.

> 1. An electrochemical cell comprising an alkaline electrolyte, a cathode comprising manganese dioxide as an active cathode component, and an anode gel comprised of zinc as the active anode component, wherein the cell contains less than 50 parts of mercury per million parts by weight of the cell and said zinc anode has a gel expansion of less than 25% after being discharged for 161 minutes to 15% depth of discharge at 2.88A.

The Commission did not tie the term "said zinc anode" to the following language found earlier in the claim: "anode gel comprised of zinc as the active anode component," in part because it read the test-characteristic limitation later in the claim to require every anode to be actually discharged according to the test parameters.

The court found the Commission's approach in error.

> Whether this claim, despite lack of explicit antecedent basis for "said zinc anode," nonetheless has a reasonably ascertainable meaning must be decided in context. In prosecuting the '709 patent, the examiner made several objections to the claims, but the claims were not rejected or objected to on the ground of lack of antecedent basis.

The court did not find the claim insolubly ambiguous.

> The Commission erred in holding that the need to construe a claim, or the proffer of alternative constructions, renders the claim indefinite. A claim that is amenable to construction is not invalid on the ground of indefiniteness. . . . Here, it is apparent that the claim can be construed. In that regard, we conclude that "anode gel" is by implication the antecedent basis for "said zinc anode."

Moreover, the test-characteristics were better viewed as a description of the properties of the zinc anode gel.