

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

FORUM US, INC., A DELAWARE CORPORATION,
Plaintiff-Appellee

v.

**FLOW VALVE, LLC, AN OKLAHOMA LIMITED
LIABILITY COMPANY,**
Defendant-Appellant

2018-1765

Appeal from the United States District Court for the
Western District of Oklahoma in No. 5:17-cv-00495-F, Sen-
ior Judge Stephen P. Friot.

Decided: June 17, 2019

KEITH JAASMA, Ewing & Jones, PLLC, Houston, TX, ar-
gued for plaintiff-appellee. Also represented by HARVEY D.
ELLIS, JR., DAVID M. SULLIVAN, Crowe & Dunlevy, PC, Ok-
lahoma City, OK.

GARY PETERSON, Tomlinson McKinstry, PC, Oklahoma
City, OK, argued for defendant-appellant. Also repre-
sented by ROSS N. CHAFFIN, KELLY J. KRESS, ROBERT D.
TOMLINSON.

Before REYNA, SCHALL, and HUGHES, *Circuit Judges*.

REYNA, *Circuit Judge*.

Flow Valve, LLC appeals from the U.S. District Court for the Western District of Oklahoma’s grant of summary judgment of invalidity of its reissue patent. The original patent does not disclose the invention claimed in the reissue patent. The reissue claims therefore do not comply with the original patent requirement of 35 U.S.C. § 251 as a matter of law. We affirm.

BACKGROUND

I. The Patent-in-Suit

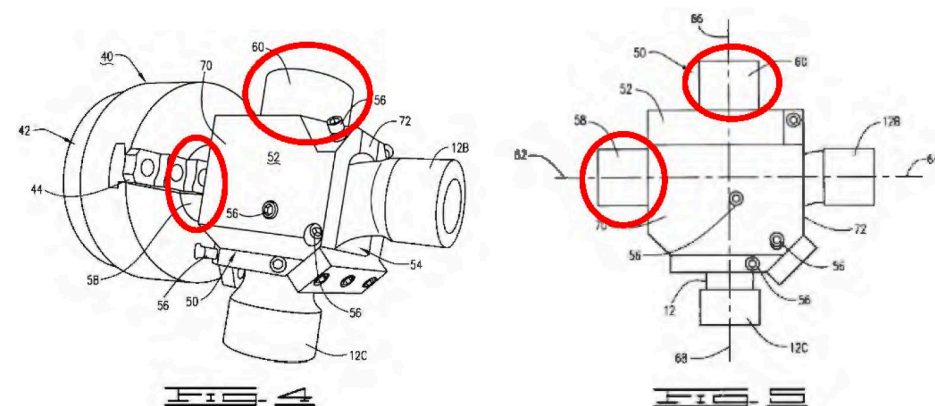
Flow Valve owns U.S. Patent No. RE45,878 (“the Reissue patent”), entitled “Workpiece Supporting Assembly.” The Reissue patent is a reissue of U.S. Patent No. 8,215,213 (“the ’213 patent”). During prosecution of the Reissue patent, the patentees added seven claims—claims 14 through 20—but made no changes to the written description or drawings of the original ’213 patent.¹

The Reissue patent relates to supporting assemblies, i.e., fixtures, for holding workpieces during machining. The workpieces disclosed in the patent are machined pipe fittings, such as those used in the oil and gas industry. Such fittings attach to other pipe sections by means of threaded connections where one or more ends of the fitting require machining on a turning machine to form threads or seat surfaces. Reissue patent col. 1 ll. 20–27. A turning machine, such as a lathe, rotates the workpiece while stationary tools perform various operations on the workpiece, such as cutting or sanding, as the workpiece rotates. *See id.* col. 1 ll. 29–37. Machinists often make and use fixtures

¹ The ’213 and Reissue patents share identical written descriptions and drawings. We therefore refer to the Reissue patent unless otherwise noted.

that utilize arbors to hold the workpiece while it rotates on the turning machine, and it is advantageous to have a multi-purpose fixture capable of holding a workpiece in multiple orientations to expedite machining by minimizing setup time. *See id.* col. 1 ll. 36–58.

The written description and drawings disclose only embodiments with arbors. The following figures illustrate the placement of arbors in a machining fixture for holding the pipe joint as disclosed in the Reissue patent.



Reissue patent Figs. 4 & 5 (annotations added by Appellee). The written description discloses a first and a second arbor as central to the fixture design:

[T]he body member 52 has a *first arbor 58* and a *second arbor 60* supported to extend from the body member 52. The *first arbor 58* is positioned so that the longitudinal axis 62 thereof is coincident with the datum or central axis 64 of the extending elbow end 12B so that, when workpiece machining implement 40 rotates the chuck 42, the *first arbor 58* is rotated about its longitudinal axis 62, the body member 52 will rotate the elbow end 12B about the datum axis 64 thereof.

In like manner, the *second arbor 60* is positioned so that the longitudinal axis 66 thereof is

coincident with the datum or central axis 68 of the extending elbow end 12C.

Reissue patent col. 3 ll. 11–22 (emphases added). The written description further explains that “the multiple arbors of the workpiece supporting assembly provides [*sic*] means for machining the ends of the unfinished elbow member 12 by a single setup and only a change from one arbor to one of the other arbors allows rapid and accurate machining of the workpiece.” *Id.* col. 3 ll. 42–46.

In the Reissue patent, the patentees broadened the claims to include embodiments of fixtures that do not use arbors by writing new claims without the arbor limitations. Claim 1 of the '213 patent is representative of the original claims:

1. A workpiece machining implement comprising:

a workpiece supporting assembly comprising:

a body member having an internal workpiece channel, the body member having a plurality of body openings communicating with the internal workpiece channel;

means supported by the body member for positioning a workpiece in the internal workpiece channel so that extending workpiece portions of the workpiece extend from selected ones of the body openings;

a *plurality of arbors* supported by the body member, *each arbor* having an axis coincident with a datum axis of one of the extending workpiece portions; and

means for rotating the workpiece supporting assembly about the axis of a selected *one of the arbors*.

'213 patent col. 3 l. 52–col. 4 l. 5 (emphases added). Claim 14 is representative of the claims added (14–20) to the Re-issue patent:

14. A workpiece supporting assembly for securing an elbow during a machining process that is performed on the elbow by operation of a workpiece machining implement, the workpiece supporting assembly comprising:

a body having an internal surface defining a channel, the internal surface sized to receive a medial portion of the elbow when the elbow is operably disposed in the channel; and

a support that is selectively positionable to secure the elbow in the workpiece supporting assembly, the body pivotable to a first pivoted position, the body sized so that a first end of the elbow extends from the channel and beyond the body so the first end of the elbow is presentable to the workpiece machining implement for performing the machining process, the body pivotable to a second position and sized so that a second end of the elbow extends from the channel beyond the body so the second end of the elbow is presentable to the workpiece machining implement for performing the machining process.

Reissue patent col. 4 l. 64–col. 5 l. 15.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.