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# Recent(ish) Developments in Indefiniteness

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# Indefiniteness Issues

- What's the standard?
- What types of terms are susceptible to indefiniteness?
- What evidence is considered?
- Can experts play a role?

# Old Federal Circuit Standard

- Prior to 2014, a claim was indefinite if it was “not amenable to construction” or “insolubly ambiguous.”

# Current “Reasonable Certainty” Standard

- Supreme Court rearticulated standard in *Nautilus v. Biosig* (2014):
  - The old standard is, itself, indefinite:
    - “can breed lower court confusion;”
    - “such terminology can leave courts and the patent bar at sea without a reliable compass.”
  - **New standard:** A claim is indefinite when “read in light of the specification . . . , and the prosecution history, [it] fail[s] to inform, with reasonable certainty, those skilled in the art about the scope of the invention.”

# What Types of Terms Are Susceptible

- Terms of degree / subjective terms.
- Terms of measurement / variable parameters.
- Odds and ends: missing words, point of novelty, antecedent basis, design patents.
- Functional claiming under §112(f).

# Terms Of Degree / Subjective Terms

- Terms of degree are problematic if the baseline is unclear.
- It is not enough to simply identify some standard for measuring the scope.
- Terms of degree are definite when the intrinsic record (spec, file wrapper) provides objective boundaries for the POSITA.

# Example Terms Of Degree / Subjective Terms

## ***Interval Licensing v. AOL (Fed. Cir. 2014)***

- Content to be displayed “in an unobtrusive manner that does not distract a user ... from a primary interaction.”
- **Indefinite:**
  - Highly subjective on its face – depends on user’s focus;
  - Written description is “muddled” and provides “hazy relationship” between term and description;
  - Single “e.g.” in lengthy description not enough - “(e.g., the information is presented in areas of a display screen that are not used by displayed information associated with the primary interaction with the apparatus).” “E.g.” does not mean “i.e.” Single example leaves POSITA to wonder what else qualifies;
  - Prosecution revealed different interpretations by patentee and examiners.

# Example Terms Of Degree / Subjective Terms

## ***Icon Health & Fitness v. Polar Elec. (Fed. Cir. 2016)***

- Claims related to networked exercise equipment.
- Claimed “in-band” and “out-of-band” communication, where “out-of-band communication has a relationship to said in-band communication.”\*
- **Indefinite:**
  - Intrinsic record did not explain the difference or relationship between these types of communications;
  - Expert at claim construction established that the terms are relative to each other and have meaning in a given context with a defined frame of reference (e.g., a frequency, time slot) – But, here, there was no reference;
  - FC found no clear error in the factual determination and no legal error in the conclusion that the claims were indefinite.



# Example Terms Of Degree / Subjective Terms

## ***GE Lighting Sol'n v. Lights of America* (Fed. Cir. 2016)**

- “elongated” thermally conductive core **indefinite**:
  - Term not in spec and dimensions not described in text or illustrated in drawings;
  - During prosecution, applicant distinguished prior art by saying that certain plates and disks were not elongated;
  - No objective means to determine what makes a core elongated or not.
- “to heat sink” **definite**:
  - The claims, spec and prosecution history make clear it means to transfer *any amount* of heat;
  - No “zone of uncertainty;” something either transfers heat, or it does not.

# Example Terms Of Degree / Subjective Terms

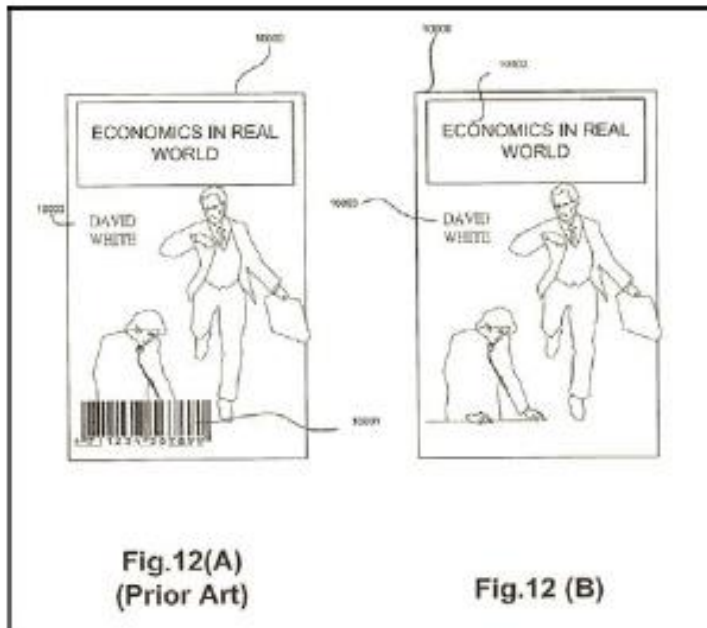
## ***DDR Holdings v. Hotel.com* (Fed. Cir. 2014)**

- Term “visually perceptible elements” for web page construed as “look and feel’ elements that can be seen.”
- **Definite:**
  - “look and feel” not defined in specification;
  - However, evidence at trial showed that “look and feel” had a well understood and objective meaning in the art – i.e., not subjective;
  - Spec used term in a manner consistent with that understanding.

# Example Terms Of Degree / Subjective Terms

## *Sonix Tech. v. Publications Int'l* (Fed. Cir. 2017)

- “visually negligible” encoding **definite**:
  - Term is not purely subjective;
  - Spec disclosed (1) a generally exemplary design, (2) requirements for graphical indicators being negligible to human eyes, and (3) two specific examples;
  - This was guidance and points of comparison for how to create visually negligible encoding;
  - No evidence that human perception varies enough to render term imprecise;
  - Parties and PTO could distinguish prior art during prosecution/reexamination;
  - FC noted, however, that merely providing examples does not necessarily save claims – always determined on case-by-case basis.



# Example Terms Of Degree / Subjective Terms

- **“Block-like” indefinite:**

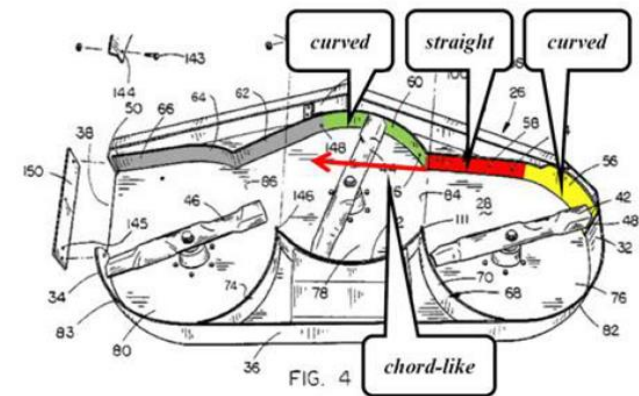
Intrinsic record lacked objective boundaries for determining what shapes were/weren't sufficiently like a block. The spec said the invention could be fabricated in any shape, and the prosecution history used the term “block-like” inconsistently. *In re Walter* (Fed. Cir. 2017).

- **“[An archive of documents that] exhibits minimal redundancy” indefinite:**

Claim didn't define “minimal redundancy,” the spec was inconsistent in describing the level of redundancy, prosecution history was no help, unrebutted expert testimony that a POSITA wouldn't have known meaning. *Berkheimer v. HP, Inc.* (Fed. Cir. 2018).

- **“Elongated and substantially straight” definite:**

Remember in GE Lighting, “elongated” was found indefinite. Here, spec showed the relevant portion had to be long enough to connect two curved portions, and relatively straight compared to the curved portions. Did not require numerically precise straightness value, just a standard for measuring the term of degree. *Exmark Manufacturing Co. v. Briggs & Stratton Power Products Group LLC* (Fed. Cir. 2018) .



# Terms Of Measuring / Testing

- If claim recites feature or value that needs to be measured or is variable, there is a risk of indefiniteness.
- These types of claims more common in chem / pharma.
- Issues:
  - How much specificity is required to perform the measuring?
  - If multiple known ways to measure, is there guidance as to which is required by the claim?
- To prove indefiniteness, a challenger may need to prove that multiple measurement techniques exist, they yield differing results, and a POSITA would not know how to choose amongst them.

# Example Terms Of Measuring / Testing

## ***Teva v. Sandoz* (Fed. Cir. 2015)**

- Copolymer-1 “molecular weight.”
- **Indefinite**
  - No meaning for “molecular weight” in the spec;
  - No presumed meaning in the art;
  - There are multiple ways to measure molecular weight, and they each require different parameters and define distinct properties of a compound
  - Applicant took different positions during prosecution of continuations;
- Court also held that “[d]etermining the meaning or significance to ascribe to . . . the intrinsic record is legal analysis” – i.e., subject to de novo review – factual determinations are entitled to clear error standard.

# Example Terms Of Measuring / Testing

## ***Dow v. NOVA* (Fed. Cir. 2015)**

- Patent relates to a plastic.
- Claim required “a slope of strain hardening coefficient greater than or equal to 1.3.”
- The patent did not provide guidance to measure the slope.
- At trial, evidence showed there were 3 known methods, and Dow’s expert concocted a 4th for litigation – all yielding different results.
- **Indefinite**
  - No guidance in intrinsic record for which method to use, leaving POSITA “to consult the unpredictable vagaries of any one person’s opinion;”
  - Note, prior to *Nautilus*, these same claims were found to be definite.

# Example Terms Of Measuring / Testing

## ***Ethicon v. Covidien (Fed. Cir. 2015)***

- Directed to ultrasonic surgical shears to cut and seal tissue and blood vessels.
- Claims required a numerical range for “clamping pressure.”
- **Definite**
  - In light of the spec, POSITA would understand how to measure – the clamping pressure was an average.
  - Although there were 4 known methods for calculating “clamping pressure,” the results of these methods are all “quite similar.”



# Example Terms Of Measuring / Testing

## ***Akzo Nobel Coatings v. Dow (Fed. Cir. 2016)***

- Claim directed to a process for generating a polymer.
- Polymer having “an aqueous dispersion with a viscosity below 10 Pa.s.”
- **Definite**
  - Spec did not say what temperature to measure the viscosity;
  - Yet, turning to extrinsic evidence, it was known to perform such measurements at room temperature;
  - Applying *Teva*, FC found no clear error and affirmed because the extrinsic evidence did not conflict with the specification.

# Example Terms Of Measuring / Testing

## ***Capital Security Systems, Inc. v. NCR Corp. (Fed. Cir. 2018)***

- Term: “Ascertaining an apparent signature.”
- **Definite**
  - Claim language as a whole suggests term means determining the presence of a signature;
  - Spec supported that by describing a machine that determines whether there is a signature on the signature line.

# Odds And Ends: Point of Novelty

## ***Cox Comm'ns v. Sprint (Fed. Cir. 2016)***

- “processing system”
- **Definite**
  - FC concluded that “processing system” did not provide novelty, but was “merely the locus at which the steps are being performed.”
  - “If ‘processing system’ does not discernably alter the scope of the claims, it is difficult to see how this term would prevent the claims . . . from serving their notice function under § 112.”
  - This opinion emphasizes that the focus of indefiniteness is on the claim, not on individual terms in the claim.

1. A communication method for a call comprising:  
receiving set-up signaling associated with the call into a *processing system*;  
processing the set-up signaling in the *processing system* to select a DS0 connection;  
generating a message identifying the DS0 connection;  
transmitting the message from the *processing system*;  
receiving the message and an asynchronous communication associated with the call into an interworking unit;  
in the interworking unit, converting the asynchronous communication into a user communication; and  
transferring the user communication from the interworking unit to the DS0 connection in response to the message.

# Odds And Ends: Missing Words

## *Trusted Knight Corp. v. IBM Corp.* (Fed. Cir. 2017)

- “a process of passing the encrypted data to a 3-ring level where a hook inserted by a hook-based key logger.”
- **Indefinite**
  - Everybody agreed that this term was missing a verb between “hook” and “inserted;”
  - Courts can correct claims only when the correction is not reasonably debatable;
  - Here, plaintiff proposed to insert “is” or “could be.” Both are supported by spec, but result in different scope;
  - Does not provide reasonable certainty as to its bounds.



# Odds And Ends: No Antecedent Basis

## ***Bushnell Hawthorne, LLC v. Cisco Systems, Inc.* (Fed. Cir. 2020)**

- “said different IP Address.”
- Remember, lack of antecedent basis isn’t fatal if a POSITA can ascertain the meaning.
- **Indefinite**
  - No antecedent basis;
  - Claim recites three types of IP addresses, each of which are presumably different.

a fifth processor that

a) supplies one or more **IP Addresses** for the information requested if one or more of the pre-defined bit strings or character sets are not encountered,

b) supplies one or more **second IP Addresses** for the information requested if one or more different bit strings or character sets are encountered,

c) supplies one or more **third IP Addresses** if one or more of the pre-defined bit strings or character sets are encountered and a higher level protocol can be inferred, and/or

d) allows the traffic to flow thru unmodified; and

a sixth processor that analyzes a request submitted to **said different IP Address** for one or more alternative bit strings or character sets,

# Odds And Ends: Consisting Essentially Of

## ***HZNP Medicines LLC v. Actavis Laboratories UT, Inc. (Fed. Cir. 2020)***

- Remember, “consisting essentially of” signals that claim includes the listed ingredients as well as “unlisted ingredients that do not materially affect the basic and novel properties of the invention.”
- To construe, need to determine what the “basic and novel properties” are.
- Here, the specification indicated that one of those properties was “better drying time.”
- FC determined that “better drying time” was indefinite, so claim is indefinite.

# Odds And Ends: Design Patents

## ***In re Maatita* (Fed. Cir. 2019)**

- Ordinary observer standard: "So long as the scope of the invention is clear with reasonable certainty to an ordinary observer, a design patent can disclose multiple embodiments within its single claim and can use multiple drawings to do so."
- Here, FC concluded that 2D drawing supported 3D design and was definite.

# Tidbits and Takeaways

- Terms of degree, subjective terms, measuring terms and functional claiming are susceptible to indefiniteness challenges.
- Definiteness is determined on a case-by-case basis.
- The intrinsic record is often critical, although extrinsic evidence may be consulted in some cases.
- Patent drafters, when reciting measurements, especially if there is more than one way to determine, should specify the method for determining the measurement in the specification.



# Tidbits and Takeaways

- Fed. Cir. reviews D. Ct's legal conclusions regarding indefiniteness *de novo*, but reviews underlying factual issues for clear error.
- Any fact critical to a holding on indefiniteness must be proven by the challenger by clear and convincing evidence.
- Experts may be used to establish what POSITA would understand, particularly where specification is silent as to scope of term.
- Expert report submitted during prosecution is considered intrinsic evidence.

# Tidbits and Takeaways

- *Citrix + Aristocrat* = risk for computer-implemented claims.
  - Patent drafters take care not to draft accidental means+function claims—add sufficient structure to claims and disclose algorithms for computer implemented functions;
  - Litigators keep an eye out for purely functional computer-implemented claim language.
- In practice, choose your claim terms carefully and be sensitive to terms that may not convey scope with reasonable certainty.

# Questions?