

## Plausible Indefiniteness: High Time for More Definite Patent Claims?

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Recently, the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences (“Board”) rendered a rare precedential opinion which appears to have lowered the threshold in determining whether the claims of a patent are invalid.<sup>2</sup> Specifically, the Board held that claims were invalid for being indefinite because claim terms were viewed as being ambiguous and having two or more plausible claim constructions. This article provides a discussion on the legal background of this Board decision, the decision itself, and a brief discussion on the decision’s potential impact for those applying for patents at the U.S. Patent and Trademark Office (“PTO”) and for those challenging the validity of issued patents.

Patent laws in the U.S. require that the claims of a patent “particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention.”<sup>3</sup> This requirement is viewed by the PTO as having two separate requirements: (i) the claims must set forth the subject matter that applicants regard as their invention; and (ii) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.<sup>4</sup>

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<sup>2</sup> *Ex Parte Miyazaki*, 89 U.S.P.Q.2D (BNA) 1207. Authors of the present article are attorneys at Sughrue Mion, P.L.L.C., the law firm which represented the appellants in *Ex Parte Miyazaki*.

<sup>3</sup> 35 U.S.C. § 112, second paragraph.

<sup>4</sup> Manual of Patent Examining Procedure at §2171-§2174, Eighth Edition, R. 7.

The PTO views “[t]he second requirement [as] an objective one because it is not dependent on the views of applicant or any particular individual, but is evaluated in the context of whether the claim is definite.”<sup>5</sup> This definiteness requirement serves to ensure that the scope of the claims is clear so the public is informed of the boundaries of the patent and to provide a clear measure of what the applicants regard as the invention.<sup>6</sup>

The application of the definiteness requirement is particularly difficult for claims which include elements entirely defined in functional terms, i.e., without any structural terms. In *Halliburton Energy Services, Inc. v. M-I LLC*, The Court of Appeals for the Federal Circuit held that:

When a claim limitation is defined in purely functional terms, the task of determining whether that limitation is sufficiently definite is a difficult one that is highly dependent on context (e.g., the disclosure in the specification and the knowledge of a person of ordinary skill in the relevant art area). **We note that the patent drafter is in the best position to resolve the ambiguity in the patent claims, and it is highly desirable that patent examiners demand that applicants do so in appropriate circumstances so that the patent can be amended during prosecution rather than attempting to resolve the ambiguity in litigation.**<sup>7</sup>

Several months after the *Haliburton* decision, the PTO issued an internal memorandum to clarify indefiniteness rejections. The memorandum stated that “inconsistency between a claim term and the specification disclosure may make an otherwise definite claim term take on an

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<sup>5</sup> *Id.* at §2171.

<sup>6</sup> *Id.* at §2173.

<sup>7</sup> 514 F.3d 1244 (Fed. Cir. 2008), (bolded emphasis added).

unreasonable degree of uncertainty.”<sup>8</sup> Although an applicant can define a claim term in the specification, the claim term can still be viewed as being indefinite if “the definition is not clear and precise and one of ordinary skill in the art would consider the claim term indefinite (e.g., the definition’s broadest reasonable interpretation results in more than one meaning and/or interpretation).”<sup>9</sup> “If a claim term is not used or defined in the specification and the meaning of the claim term is not discernable,” indefiniteness rejections can still apply.<sup>10</sup>

At the heels of the PTO memorandum, the Board presented a new interpretation of the definiteness requirement in *Ex Parte Miyazaki*.<sup>11</sup> The patent application involved in the appeal related to a printer with a sheet feeding area. The applicant appealed the rejections of several claims including claim 13 which recites:

A large printer comprising:

a sheet feeding area positioned at a height at which a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist when the user is standing erect in front of the printer and standing substantially at ground level,

wherein the sheet feeding area is positioned at the height when the printer is placed substantially at the ground level.

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<sup>8</sup> *Memorandum of John Love, Deputy Commissioner of Patent Examination Policy, U.S.P.T.O., Indefiniteness Rejections under 35 U.S.C. § 112, second paragraph, September 2, 2008, available at [www.uspto.gov/web/offices/pac/dapp/opla/preognotice/section\\_112\\_2nd\\_09\\_02\\_2008.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/section_112_2nd_09_02_2008.pdf).*

<sup>9</sup> *Id.*

<sup>10</sup> *Id.*

<sup>11</sup> *See* 89 U.S.P.Q.2D (BNA) 1207.

In construing the claim, the Board understood “sheet feeding area” to refer to two areas of the printer:

Based on the description provided in the Specification, ‘sheet feeding area’ could be interpreted to mean the accommodation space in which the paper roll is loaded and the cover member above the accommodation space on which the stiff carton and sheets of paper rest for feeding into the printer.<sup>12</sup>

According to the Board, such an understanding of claim 13, however, would contradict claim 15 which separately recites a sheet feeding area and a cover member.<sup>13</sup>

As for the ordinary meaning of “sheet feeding area,” Board added that “‘sheet feeding area’ could be interpreted to mean the part of the printer set aside for feeding sheets of paper into the printer, i.e., the cover member.”<sup>14</sup>

In the opinion of the Board, “[n]either of these definitions makes sense in view of the remainder of the claims,” which separately recite sheet feeding area and cover member as separate claim elements.<sup>15</sup> The Board asserts that the term “sheet feeding area” in claim 13 can be interpreted as an accommodation space and the cover member, or be interpreted as the part of the printer where sheets are fed, i.e., the cover member.<sup>16</sup> Because of this ambiguity, the Board held that claim 13 to be indefinite. Specifically, the Board held that “if a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to

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<sup>12</sup> *Id.* at 18-19.

<sup>13</sup> *Id.* at 17.

<sup>14</sup> *Id.* at 18-19.

<sup>15</sup> *Id.* at 20.

<sup>16</sup> *Id.* at 21.

more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph as indefinite.”<sup>17</sup>

Policy-wise, the Board justified its decision by stating that since the USPTO is the sole agency with the authority to grant exclusionary rights for inventions, it has a duty to prevent ambiguous and vague patents from “exact[ing] a cost on society ... that is not commensurate with the benefit that the public gains.”<sup>18</sup>

In view of the Federal Circuit’s *Haliburton* decision, the PTO memorandum and the Board’s precedential decision in *Ex Parte Miyazaki*, the PTO appears to be taking on the Federal Circuit’s thinly-veiled suggestion for more definite claims and for reducing inconsistencies in claim language and the specification in an effort to better inform the public of what constitutes infringement of a specific patent. At the least, it would appear that Examiners now have more guidance in determining whether claims are indefinite. In practice, however, it remains to be seen as to whether Applicants will face greater number of indefiniteness claim rejections.

When appealing an examiners’ rejection of claims as being indefinite at the Board, however, Applicant must be thoroughly familiar with the holdings of *Ex Parte Miyazaki*. Applicant must be cognizant of any inconsistencies between the claims and the specification that may give rise to multiple plausible claim constructions and a subsequent holding of indefiniteness.

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<sup>17</sup> *Id.* at 11.

<sup>18</sup> *Id.* at 12.

Ambiguities or inconsistencies or both, in the specification and the claims, coupled with multiple plausible claim constructions likely provide sufficient basis for the Board to hold a claim to be indefinite.

One possible strategy to stave off such a holding of indefiniteness would be to have claim terms which closely track the language used in the detailed description of the invention, especially specification language that is explicitly tied in with the structural details of the invention. Even if the same claim terms are correspondingly used in multiple embodiments, it would appear that a claim including such claims terms would not be held to be indefinite, per *Ex Parte Miyazaki*, as long as the matching descriptions in the specification are themselves unambiguous and not inconsistent with how the claim term is used in other claims.

Another strategy would be to provide a definition of claim terms in the specification to lessen the chance that the claim recitations are deemed to be ambiguous. Claim terms with corresponding definitions in the specification, however, may still be viewed by the PTO as being indefinite if the definition is not “clear and precise” and “one of ordinary skill in the art would consider the term indefinite (e.g., the definition’s broadest interpretation results in more than one meaning and/or interpretation).”<sup>19</sup>

In the context of invalidating a patent or upholding the validity of the claims of an issued patent, *Ex Parte Miyazaki* will likely have minimal impact because of the differing standards of review at the PTO and the courts. Before a patent is issued, claims in a patent application are given their broadest reasonable interpretation by an examiner at the PTO. The courts, however,

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<sup>19</sup> Memorandum of John Love.

view issued patents under a presumption of validity and typically apply a threshold test for indefiniteness that is higher than that formulated in *Ex Parte Miyazaki*.

Although the stated goal of this decision is that the public be given a clearer understanding of the status of technology, and the boundaries of what constitutes infringement, it may inadvertently result in more confusion than clarification. This is especially so if the decision is simplistically viewed as a green light to an examiner to reject claims covering multiple embodiments as being indefinite. The prospects of overturning the holdings of *Ex Parte Miyazaki*, however, appear to be slim, given the alignment of the policy goals of the Federal Circuit and the U.S.P.T.O. for more definite claims. Therefore, applicants are well advised to have new patent applications prepared and pending applications prosecuted in view of these recent clarifications in the requirements for claim definiteness.