

**Keywords:** indefiniteness; insolubly ambiguous; plausible indefiniteness; 35 U.S.C. §112, second paragraph

**General:** The Board redefined the standard for indefiniteness during prosecution as “plausible indefiniteness.”

*Ex parte Miyazaki*

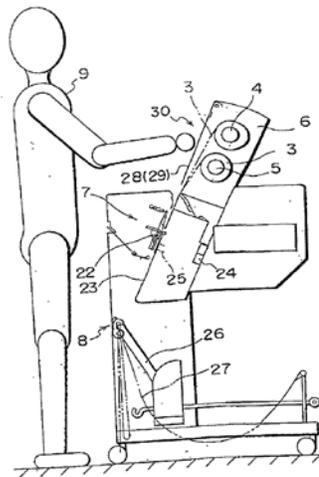
No. 2007-3300 (B.P.A.I. Nov. 19, 2008)

Application No. 09/386,000

**I. Facts**

In an unusual precedential opinion, the Board of Patent Appeals and Interferences redefined the standard for indefiniteness during prosecution.

Appellants filed a patent application (the ‘000 application) directed to a large printer that can be loaded with roll paper while a user is standing.



During prosecution, the Examiner rejected claims 1-6, 13, and 16-18 as indefinite under 35 U.S.C. § 112, second paragraph. The relevant, representative language from claim 1 states: "the paper feeding unit being located at a height that enables a user, who is approximately 170 cm tall, standing in front of the printer to execute the paper feeding process including replacement of the roll paper and setting at least one of the sheet of paper and the stiff carton." According to the Examiner, the height of the paper feeding unit in relation to the user's height is ambiguous. Appellants appealed the final rejection to the Board.

Additionally, claim 13 was directed to "a sheet feeding area positioned at a height which a user, who is approximately 170 cm tall, can set up a printing medium . . . ." Claims 15 and 26 were directed to a large printer with "a sheet feeding area operable to feed" rolls of paper. During the appeal, the Board raised two new grounds of rejection relating to the recitation of the "sheet feeding area."

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## II. Issues

- A. Did the Examiner err in concluding that the language of claims 1-6, 13, and 16-18 was indefinite?
- B. Is the recitation of a “sheet feeding area” in claims 13, 15, 16, 18, and 26 indefinite?
- C. Is the recitation of a “sheet feeding area operable to feed . . .” in claims 15 and 26 a purely functional recitation with no structural limitation?

## III. Discussion

- A. No. In upholding the Examiner’s rejection, the Board defined a new standard for pre-issuance indefiniteness. During prosecution, a claim may be found to be indefinite if the claim is “amenable to two or more plausible claim constructions.” *Ex parte Miyazaki*, at 11. The new standard applies a lower threshold for indefiniteness than the standard defined by the Federal Circuit. Under the Federal Circuit standard, claims may be indefinite if they are “not amenable to construction” or are “insolubly ambiguous.” *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed. Cir. 2005) (citations omitted). In creating the lower threshold for indefiniteness, the Board focused on the differences between pending applications and issued patents. First, the Board reasoned that the Federal Circuit’s “high standard of ambiguity” was based on the statutory presumption of patent validity that applies to issued patents. The Board then noted that during prosecution, pending claims are given their “broadest reasonable interpretation consistent with the specification,” largely because applicants have an opportunity to amend the claims. *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The Board then further expounded on the USPTO’s duty to guard the public against ambiguous patents. The Board summarized its justification as follows:

The USPTO is justified in using a lower threshold showing of ambiguity to support a finding of indefiniteness under 35 U.S.C. § 112, second paragraph, because the applicant has an opportunity and a duty to amend the claims during prosecution to more clearly and precisely define the metes and bounds of the claimed invention and to more clearly and precisely put the public on notice of the scope of the patent.

*Ex parte Miyazaki*, at 12. As further support, the Board cited to a recent Federal Circuit case noting that ambiguity could more easily be resolved during prosecution by the drafter. *Halliburton Energy Servs. v. M-ILLC*, 514 F.3d 1244, 1255 (Fed. Cir. 2008). The Board also cited to another case noting that due to the presumption of validity, in certain cases, an examiner may demand claims be more clearly defined while the Federal Circuit may not. *Exxon Research and Engineering Co. v. United States*, 265 F.3d 1371.

In applying the new “plausible indefiniteness” standard, the Board noted that claim 1 failed to specify a positional relationship between the user and the printer. The Board reviewed the specification and found that it also did not clearly impose a structural limitation on the height of the paper feeding unit. The Board noted that although figure 1 showed a user and printer at ground level, figure 1 was described as a “preferred embodiment,” implying that other positional relationships between the printer and the user were possible. The Board then reasoned that claim 1 could cover situations where the printer was located on a table or where the user was standing on a step stool. Because an “infinite number of combinations of printer and user positions” could be covered by claim 1, the Board found the claim indefinite under

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the new standard. *Ex parte Miyazaki*, at 14. However, this rationale appears to suggest that the claim is too broad, instead of indefinite.

- B. Yes. The Board found that the specification could not be resolved with the claims. The specification defines the sheet feeding area as including both an accommodation space for loading the paper and a cover member that covers the accommodation space. However, claim 15 claims both a sheet feeding area and a cover member. Based on the definition in the specification, the recitation of a cover area in claim 15 is redundant. To resolve the redundancy, the court looked to the ordinary meaning of the phrase “sheet feeding area” and determined that the area meant the part of the printer set aside for feeding paper into the cover member. However, neither the ordinary meaning nor the specification allows a cover member to exist separately from the sheet feeding area.
- C. Yes. The claim does not recite the “means-plus-function” language required to invoke a means plus function interpretation under 35 U.S.C. § 112 ¶6. A claim that does not use the term “means” triggers a rebuttable presumption that § 112 ¶6 does not apply. However, the presumption is not easily overcome. The Board chose not to rebut the presumption because during prosecution, the Appellant can amend the claims to use the “means-plus-function” language, which provides notice to the public.

#### **IV. Conclusion**

The USPTO has rejected the Federal Circuit’s “insolubly ambiguous” standard for indefiniteness, and has instead created a lower threshold of “plausible indefiniteness.” Under the new pre-issuance standard, a claim may be found indefinite if the claim is amenable to two or more plausible claim constructions.