Keywords: indefiniteness; 35 U.S.C. § 112, second paragraph

One-E-Way, Inc. v. Sony Corp. (Fed. Cir. 2017)
Decided June 12, 2017

I. Facts

One-E-Way, Inc. filed a complaint with the International Trade Commission (ITC) accusing Sony Corporation, among others (hereinafter "Respondents"), of infringing two of its related patents, U.S. Patent Nos. 7,865,258 and 8,131,391, which are directed toward a wireless digital audio system designed to let people use wireless headphones privately, even when multiple people are using wireless headphones in the same space. The specification of the '258 patent explained that previous wireless digital audio systems did not provide private listening without interference where multiple users are occupying the same space and are operating wireless transmission devices. The specification of the '258 patent claimed to solve this problem by disclosing a digital wireless audio system that ensures private listening by changing the way prior art systems sent and processed wireless signals. Specifically, the specification suggested sending a digitally encoded signal to ensure each user can independently access his or her transmission. The specification also disclosed processing the signal with a fuzzy logic detection subsystem to enhance signal clarity, so that the user could listen to music through wireless headphones without interference from any other headphones in a shared space.

At the ITC, the parties disputed whether the claim term "virtually free from interference" was indefinite, which was recited in all of the asserted claims. The Respondents asserted that "virtually free from interference" was indefinite. In response, One-E-Way asserted that the term meant "free from interference such that eavesdropping on device transmitted signals operating in the wireless digital audio system spectrum cannot occur" and that the specifications of the asserted patents provided abundant guidance to a POSITA to understand what the term meant. An Administrative Law Judge (ALJ) conducted a claim construction hearing and issued a decision finding that the term was indefinite. The ALJ explained that he found the term to be indefinite because it was not defined in the asserted patents or their history and the term did not have an understood meaning in the relevant art. Respondents then filed a motion for summary determination that the term is indefinite, which the ALJ granted. One-E-Way petitioned the ITC to review the ALJ's order, which the ITC affirmed. One-E-Way then appealed.

II. Issues

Did the ITC err in its finding that the claim term "virtually free from interference" is indefinite under 35 U.S.C. § 112, second paragraph, in light of the specification and prosecution history?

III. Discussion

Yes. Relying on *Nautilus Inc., v. Biosig Instruments*, the court noted that, all claims suffer from the "inherent limitations of language" but that the claims must "be precise enough to afford clear notice of what is claimed." Recognizing this balance, the Supreme Court in *Nautilus* articulated the test for indefiniteness as requiring that a patent's claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty. This test mandates clarity while recognizing that absolute precision is unattainable. Further relying on *Interval Licensing LLC v. AOL, Inc*., the court noted that as long as claim terms satisfy the foregoing test, relative terms and words of degree do not render patent claims invalid. Citing *Eibel Process*, the Supreme Court upheld as definite a patent for an improvement to a paper making machine, which provided that a wire be placed at a 'high' or 'substantial elevation.' The Court explained that these relative terms were sufficiently definite because readers skilled in the art of paper making and use of the machine would have no difficulty in determining the substantial elevation needed for the machine to operate as specified.

In the instant case, the court first considered the specification of the asserted patent. In its review, the court noted that the specification repeatedly highlighted the private-listening feature of the claimed invention. For example, the background of the invention emphasized that the prior art needs a system like the one disclosed in the specification that is capable of private listening without interference where multiple users are occupying the same space and operating wireless transmission devices. The detailed description provided an embodiment capable of private listening without interference from any other headphones when operated in a shared space. Together, the court found the specification made it clear that the private listening is listening without interference from other users.

The court also considered the prosecution history of the asserted patent. During prosecution, the applicant explained that the term "virtually free from interference" results in the ability to listen without eavesdropping and that the prior art of record did not teach or suggest a relationship "where interference is virtually eliminated." The Respondents disputed the relevance of this statement because it was made by the applicant regarding claims reciting the term "free from interference" rather than "virtually free from interference." In response, the court noted that the "free from interference" claims were not the only ones pending at the time the applicants filed the response. Rather there were other pending claims reciting "virtually free from interference," namely already allowed claims 12 and 16. The court concluded that a POSITA would have found this statement in the prosecution history instructive. Moreover, the very language of the prosecution history statement employed the term "virtually" and that the context of the prosecution history did not mandate a different reading.

The Respondents further argued that the term "virtually free from interference" does not inform a POSITA as to any particular level of interference or as to how much interference is permitted. The Respondents asserted that there are known ways to define levels of interference, such as signal to noise ratios, packet errors, and bit rate errors, but that the specification gave no examples or descriptions and had no relevant figures relating to levels of interference. However, the court determined that the lack of a technical definition does not render the term indefinite. The court also noted, for purposes of definiteness, the term is not required to have a technical measure of the amount of interference.

Finally, the Respondents argued that "virtually free from interference" must be indefinite because One-E-Way failed to identify how it differs in scope from claims that recited the term "free from interference." The court noted that One-E-Way did not assert claims that recite the term "free from interference" in the instant case and the asserted claims only recited "virtually free from interference." The court further noted that there is no precedent requiring that the court interpret the term "free from interference" absent any assertion of the term. Moreover, the court determined that the claims, specification, and prosecution history show that "virtually free from interference" means the ability to listen without eavesdropping such that a user is not able to listen to another user's transmissions in the wireless digital audio system spectrum. Just as audio "free from interference" will be a bit better than audio "virtually free from interference," something "free from defects" will be a bit better than something "substantially" or "virtually free from defects."

IV. Conclusion

The court held that the ITC erred in finding that the claim term "virtually free from interference" is indefinite and reversed and remanded to the ITC.

V. Dissent

In the dissenting opinion, Judge Prost noted that by relying so heavily on a cherry-picked prosecution remark, the majority's decision significantly relaxed the law on indefiniteness against the Supreme Court's recent decision in *Nautilus*. The proper application of the test in *Nautilus* renders a term definite where it is defined through specific examples in the written description or where an expert opines on the guidance of detailed embodiments provided in the written description.