

**Keywords:** Indefiniteness; continuation-in-part; prosecution history; public-notice function

**General:** Claims are indefinite if, read in light of the specification and the prosecution history, the claims fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention. Use claim terms that are defined in the specification. Further, ensure that arguments during prosecution are not contradictory

*Infinity Computer Products, Inc. v. Oki Data Americas, Inc.*

United States Court of Appeals for the Federal Circuit

No. 2020-1189

Decided February 10, 2021

**I. Facts**

Infinity Computer Products, Inc. (“Infinity”) owns U.S. Patent No. 6,894,811 (“the ‘811 patent”), directed toward interfacing a fax machine with a personal computer and using the fax machine as a printer or a scanner for the personal computer. The ‘811 patent is a continuation-in-part from U.S. Patent App. No. 08/226,278 (“the ‘278 application”). Oki Data Americas, Inc. (“Oki”) manufactures and sells personal computer peripheral equipment, including printers, media, and spare parts. Infinity sued Oki in the U.S. District Court for the District of Delaware for infringement of the ‘811 patent.

Claim 1 of the ‘811 patent is representative of the asserted claims. Claim 1 recites a passive link between a fax machine and a computer, where the passive link enables data transmission between the fax machine and the computer. The term “passive link” does not appear in the specification of the ‘811 patent, and was introduced by Infinity during prosecution in an effort to distinguish from an anticipating reference (“Perkins”). In claiming the passive link, Infinity sought to exclude methods employing an intervening circuit between the computer and the fax machine, including a method disclosed in Perkins that employs a card inserted into the computer. To gain allowance of the ‘811 patent, Infinity argued that the card in Perkins processes data signals before transmission to an I/O bus of the computer, and that the computer begins with the I/O bus, not the card. Thus, according to Infinity, the card is intervening circuitry between the computer and the fax machine, which is not analogous to the claimed passive link. Infinity also alleged that the characterization of “passive link” during prosecution was supported by FIGS. 2f-h of the ‘811 patent (note: FIGS. 2f-h were not present in the parent ‘278 application). As illustrated below, FIG. 2f of the ‘811 patent depicts an example in which an RS-232 cable directly connects a fax machine and a computer, without an intervening card or any other intervening circuitry between the fax machine and the computer:

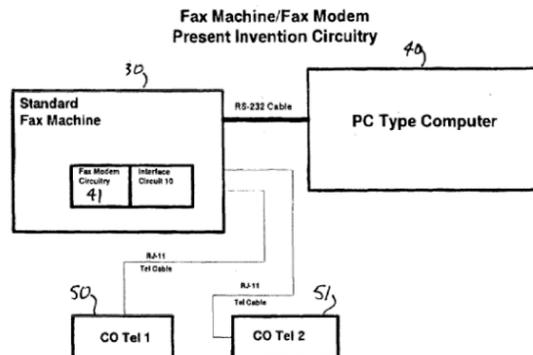


Fig. 2f

The '811 patent was later subject to an ex parte reexamination, during which Infinity sought to antedate another reference (“Kenmochi”) by arguing that claim 1 is entitled to the priority date of the '278 application. While FIG. 2f of the '811 patent, for example, illustrates a fax machine, a computer, and an RS-232 cable extending between the fax machine and the computer without intervening circuitry, FIG. 2f was not included in the '278 application. Accordingly, Infinity argued that the '278 application includes other drawings (e.g., FIG. 2b) depicting an RJ-11 telephone cable connecting a fax machine and a computer, and that the RJ-11 telephone cable meets the criteria of the passive link recited in claim 1. Infinity advanced these arguments despite the drawings from the '278 application depicting the RJ-11 telephone cable extending to interfacing circuitry 10 and fax modem circuitry 41, which is described in the '278 application as being inserted in a slot of a computer 40 and receiving signals from the RJ-11 cable prior to the signals being processed and relayed to a computer bus:

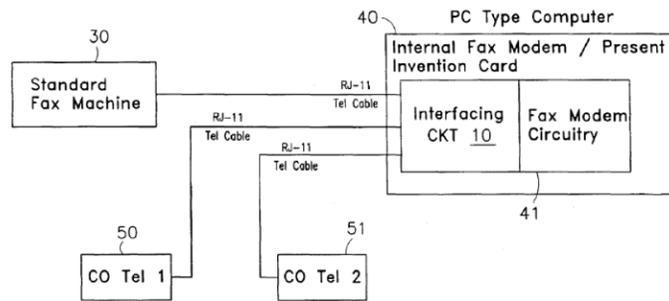


Fig. 2b

Infinity’s earlier arguments over Perkins were not expressly addressed in the ex parte reexamination. Infinity prevailed and a reexamination certificate was issued noting the patentability of the claims.

Oki argued before the district court that the claim terms “passive link” and “computer” are indefinite because Infinity took conflicting positions during prosecution as to the endpoint of the passive link and beginning point of the computer. That is, Oki argued that the embodiments in the '278 application relied upon by Infinity in an effort to antedate Kenmochi include the same or similar features as Perkins, and that Infinity earlier argued that Perkins does not disclose the claimed passive link. Oki argued that, based on Infinity’s contradictory remarks during prosecution and failure to explicitly define “passive link” in the specification, those skilled in the art would not be reasonably certain as to where the passive link ends and the computer begins. The district court agreed with Oki and entered a final judgement of invalidity on the grounds that the asserted claims are indefinite. Infinity appealed.

**II. Issue**

Did the district court err in its determination that the claims asserted by Infinity are indefinite?

**III. Discussion**

No. In the decision, the Court pointed to *Nautlius, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014), in which the Supreme Court held that “[a] patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” (Emphasis added.) Further, the Court relied on *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 789 F.3d 1335, 1341 (Fed. Cir. 2015), in which the claim term “molecular weight” was found to be indefinite. In *Teva*, the parties agreed that the claim term “molecular weight” could refer to any of three different measures that are calculated in different ways and that yield materially different results. The term “molecular weight” was found to be indefinite because neither the specification nor the prosecution history provided reasonable

certainty as to which of the three different measures and corresponding calculations the “molecular weight” element referred.

Here, the Court found that “passive link” and “computer” are indefinite because the passive link was not included in the specification of the ‘811 patent, and because Infinity’s conflicting positions during prosecution as to where the passive link ends and the computer begins created uncertainty regarding the scope of the claim terms. The Court also referenced the public-notice function of a patent and its prosecution history, which requires that patentees are held to what they declare during prosecution. Finally, the Court disagreed with Infinity’s argument that “computer” is a familiar term with a well-understood and ordinary meaning, at least because the indefiniteness issue does not reside in the term “passive link” or “computer” alone, but rather in the relationship between the passive link and the computer. Thus, the Court found that both “passive link” and “computer” are indefinite, and the claims at issue are invalid.

#### **IV. Conclusion**

If the specification and the prosecution history fail to inform, with reasonable certainty, those skilled in the art regarding the scope of the claim, then the claim is indefinite. An applicant’s contradicting positions during prosecution regarding the meaning of a claim term may create uncertainty regarding the scope of the claim term, rendering the claim term indefinite.

#### **V. Practice Tips**

When drafting an application, ensure that inventive features are described in a variety of ways to improve amendment and argument flexibility during prosecution. Further, be cognizant of the prosecution history, especially with respect to previous remarks characterizing claim features. Treat prosecution as a continuum.