

Keywords: indefiniteness; unanswered questions; Examiner deference; indefiniteness subsequent to Examiner’s amendment

General: Establishing indefiniteness requires more than identifying “unanswered questions” based on the claim language, standing alone and actions by PTO Examiners are entitled to appropriate deference as official agency actions.

Nature Simulation Systems Inc. v. Autodesk, Inc.

United States Court of Appeals for the Federal Circuit

No. 2020-2257

Decided: January 27, 2022

I. Facts

Appellant Nature Simulation Systems, Inc (“NSS”) owns U.S. Patent No. 10,120,961 (“the ‘961 patent”) and No. 10, 109,105 (“the ‘105 patent”), both entitled “Methods for Immediate Boolean Operations Using Geometric Facets.” The patents relate to methods for packaging computer-aided data for three-dimensional objects. NSS sued Autodesk, Inc. for infringement in the United States District Court for the Northern District of California. At issue are claims 1 and 8 of the ‘961 patent and claim 1 of the ‘105 patent.

The ‘961 and ‘105 patents are directed to methods for packaging computer-aided data for three-dimensional objects using a technique termed a “Boolean operation.” According to the patents, the claimed methods are improvements on a known Boolean operation (“the Watson method”) published in 1981 for analyzing and representing three-dimensional geometric shapes. Following a *Markman* hearing that included technology tutorials from the named inventor and Autodesk’s expert, the district court considered whether two terms were indefinite: “searching neighboring triangles of the last triangle pair that holds the last intersection point” and “modified Watson method.” The district court did not define the two terms; instead the court held that a claim term is indefinite if there are any “unanswered questions” about the term.

The district court acknowledged that, during prosecution, the Examiner initially rejected the claims containing the terms at issue. However, Autodesk asserted that that a person having ordinary skill in the art would not understand the terms. More particularly, for the “searching” term, the district court noted that there were three unanswered questions raised: (1) whether the phrase requires searching repeatedly, iteratively, or merely once; (2) what a “last triangle pair” or “last intersection point” is; (3) how can one “extend an intersection line” when, as Autodesk’s expert proposed, in some cases it is not possible. Likewise, for the “modified Watson method” term, the district court found four unanswered questions as being raised: (1) what is a neighboring point of intersection; (2) what is the meaning of an “identical” point of intersection; (3) what is the

meaning of removing a point of intersection; and (4) from what is the point of intersection being removed.

The district court further stated that even if the questions are answered in the specification, the definiteness requirement is not met if the questions are not answered in the claims. Thus, the district court ruled claims 1 and 8 of the '961 patent and claim 1 of the '105 patent invalid on the ground of claim indefiniteness under 35 U.S.C. § 112(b). NSS argued that all of the questions were answered in the specification, but the district court maintained that “the claim language, standing alone” did not answer those questions. NSS appealed.

II. Issue

Did the district court err in holding that the terms “searching neighboring triangles of the last triangle pair that holds the last intersection point” and “modified Watson method” in the '961 and '105 patents were indefinite under 35 U.S.C. § 112(b)?

III. Discussion

Yes, the district court erred in holding that the terms at issue were indefinite. The court held that the district court applied the incorrect analysis by holding that a claim term is indefinite, as a matter of law, if there are any “unanswered questions” regarding the term and by analyzing the “claim language, standing alone.”

The court confirmed that the test for indefiniteness involves analyzing whether the claims provide reasonable certainty when viewed in light of the specification and prosecution history from the perspective of the person of ordinary skill in the art. The court reaffirmed that the function of the claims is to “define the patent right, and perform the ‘notice’ function of legal documents,” citing *Ariad Pharms., Inc. v. Eli Lilly & Co.*, “Claims define and circumscribe, the written description discloses and teaches.” 598 F.3d 1336 (Fed. Cir. 2010).

The court further held that “[c]laim language, standing alone’ is not the correct standard of law, and is contrary to uniform precedent. Patent claims are viewed and understood in light of the specification, the prosecution history, and other relevant evidence,” as would allow a skilled artisan to know the scope of the claimed invention with reasonable certainty. The court criticized the district court for failing to apply the standard protocol for analyzing claim definiteness and for not construing the claims. Analyzing the specification, the court observed that the figures and text of the specifications of the '961 and '105 patents described the searching and intersection point process and the prior art Watson method. The court noted that the district court, incorrectly, “declined to consider information in the specification that was not included in the claims.”

In reviewing the prosecution history, the court noted that both of the terms at issue had been rejected during prosecution on the ground of indefiniteness, but that the Examiner withdrew both rejections after the applicant amended the claims (in consultation with the Examiner) to include certain technological limitations as well as after an Examiner’s amendment to the claims. However, the district court rejected the Examiner’s conclusion as to indefiniteness, stating that the amendment did not answer the questions raised by Autodesk. The court criticized the district court for giving “no weight to the prosecution history showing the resolution of indefiniteness by adding the designated technologic limitations to the claims.” The court reasoned that “actions by PTO

examiners are entitled to appropriate deference as official agency actions, for the examiners are deemed to be experienced in the relevant technology as well as the statutory requirements for patentability.”

IV. Conclusion

The court overturned the district court's decision. The court rejected the district court's holding that a claim term is indefinite as a matter of law if there are any “unanswered questions” regarding the term after analyzing the “claim language, standing alone.” In reversing the district court's decision, the court held that “[w]hen the meaning or scope of a patent claim is disputed by litigants, the judicial role is to construe the claim as a matter of law, on review of appropriate sources of relevant information,” including the text and figures of the specification and the prosecution history, among other sources. Additionally, the court reaffirmed the significance that deference to the decision of the Examiner, since the Examiner is deemed to be experienced in the relevant technology as well as the statutory requirements for patentability.