

Keyword(s): definiteness, descriptive words, intrinsic evidence

General: A claim of a patent is definite if there is intrinsic or related extrinsic evidence to give an objective bound to descriptive language in the claim sufficient to inform a person of ordinary skill in the art as to the scope of the invention.

Niazi Licensing Corporation v, St. Jude Medical S.C., Inc.

United States Court of Appeals for the Federal Circuit

No. 2021-1864

Decided: April 11, 2022

I. Facts

Niazi Licensing Corporation (“Niazi”) owns U.S. Patent No. 6,638,268, which is directed to a double catheter for cannulating the coronary sinus of the heart. The ‘268 patent published on October 28, 2003 from an application filed on April 6, 2001. The ‘268 patent claims the benefit of U.S. Provisional Application 60/195,701 filed on April 7, 2000.

Niazi sued St. Jude Medical S.C., Inc. (“St. Jude”) for patent infringement. Among other things, the district court held that the terms “resilient” and “pliable” used to describe the outer and inner catheters of a double catheter in the independent claims 1, 13, 18, and 24 of the ‘268 patent rendered those claims and their dependent claims indefinite. In making this determination, the District Court focused on a sentence in the specification stating that both the inner and outer catheters “preferably have a predetermined shape and a certain degree of stiff[n]ess to maintain such shape during manipulation in the heart, but still flexible enough to bend when required.” Niazi appealed, challenging, among other things, the District Court’s determination that the independent claims 1, 13, 18, and 24 were invalid as indefinite.

II. Issues

Did the District Court err in finding the claim language indefinite in view of the intrinsic and extrinsic evidence?

III. Discussion

Yes. The court examined the claims under 35 U.S.C. §112 to determine whether the claims were definite. §112 clarifies that a patent’s specification must “conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” The court clarified that a claim is indefinite only if, when read in light of the specification and prosecution history, it fails to inform, with reasonable certainty, those skilled in the art about the scope of the invention.

The court explained that a reasonable certainty standard exists to strike a delicate balance between giving clear notice of what is claimed, while also recognizing the inherent limitations of language. The balance is significant, because without giving clear notice, there would be a zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims. Indeed, an important public notice function of the definiteness requirement demands that a patentee apprise the public of what is still open to them. However, the court recognized that the definite requirement, while mandating clarity, still recognizes that absolute precision is unattainable. For example, the court recognized that claim language employing terms of degree has long been found definite where it provided enough certainty to one of skill in the art when read in context of the invention.

The court indicated that the issue is not so much the potential breadth of a claim, but whether the use of descriptive phrasing in the claim results in a claim that fails to inform, with reasonable certainty, those skilled in the art about the scope of the invention. Phrasing that is “purely subjective” is not definite. A classic example is the term “aesthetically pleasing,” which was used in the case *Datamize, LLC v. Plumtree Software, Inc.* to describe the “look and feel” of an interface screen. There, the court found that the phrase was entirely subjective, and that there was nothing supplied in the specification to give a standard for measuring the scope of the phrase. The court clarified that a claim term, to be definite, requires an objective anchor. The court identified intrinsic evidence (e.g., the claims, written description, and prosecution history) as well as relevant extrinsic evidence as potential sources for providing the necessary objective boundaries for claim scope.

The court found that terms “pliable” and “resilient” used in the independent claims to describe the inner and outer catheters of a double catheter were definite, because the intrinsic record and extrinsic evidence informed a skilled artisan, with reasonable certainty, of the meaning of the terms. Although broad, they were found to be described with adequate clarity. Specifically, the court pointed to the claims as giving objective measures for the term “resilient.” For example, claim one recites “an outer, resilient catheter having shape memory.” The court found the phrase “shape memory” helpful, and the written description clarifies that the outer catheter has “sufficient shape memory to return to its original shape when undistorted.” Further, the written description mentions that the resilience provides for torque control and stiffness, and that the outer catheter may be made out of a braided silastic to provide the resiliency. The court found that a person of ordinary skill in the art would be well informed how to make a resilient outer catheter, i.e., one that has shape memory and stiffness such that it can return to its original shape.”

Concerning the term “pliable,” the court identified several portions in the written description that give objective measures for the term. For example, the written description explains that relative to the resilient outer catheter, the inner catheter is constructed of a more pliable, soft material, such as silicone. Further, the written description explains that the inner catheter has no longitudinal braiding, which makes it extremely flexible and able to conform to various shapes. Taken as a whole, the court concluded that the intrinsic record was sufficient to dispose of the indefiniteness issues as to the terms “resilient” and pliable.” Further, the court noted that the dictionary definitions for the terms “resilient” and “pliable” provided by Niazi were supportive extrinsic evidence of their finding.

The court disagreed with the district court's finding because the district court focused largely on a single sentence in the written description in support of their conclusion. The sentence states that both the inner and outer catheters "preferably have a predetermined shape and a certain degree of stiffness to maintain such shape during manipulation in the heart, but still flexible enough to bend when required." The court found that the degree of stiffness and flexibility for the inner and outer catheters was relative: the outer catheter has a greater degree of stiffness and less flexibility compared to the inner catheter. The court stated that a skilled artisan, viewing the written description as a whole, could readily differentiate between a resilient outer catheter and a pliable inner catheter. Accordingly, the terms were found to be definite, and the district court's findings regarding the invalidity of the claims 1, 10, 13-15, 18-19, and 23-27 was reversed.

IV. Conclusion

For a claim to be definite, there must be intrinsic evidence or extrinsic evidence to give an objective anchor to the claim language, such that a person of ordinary skill in the art could reasonably be informed about the scope of the language of the claim.