

Fed. Circ. Patent Indefiniteness Ruling Bears Drafting Lessons

By **Keith Fredlake and Stephen Dew** (October 2, 2020)

Patent drafters are rightfully weary of preparing a patent specification that will be construed as limiting years later during litigation.

Therefore, drafters typically write in a nonlimiting way, for example, liberally using multiple embodiments, using nonlimiting examples, and employing words such as "can" and "may."

But going too far to avoid limiting the scope of the invention risks that the specification cannot provide the necessary limits on claim scope to satisfy the definiteness requirement.[1]

This interplay between a nonlimiting specification and the definiteness requirement is illustrated in the recent nonprecedential U.S. Court of Appeals for the Federal Circuit case IQASR LLC v. Wendt Corp.[2] In this scathing opinion, in attempting to determine the meaning of the claim term "magnetic fuzz," the Federal Circuit pointed out multiple inconsistencies in the patentee's specification and affirmed a finding of indefiniteness.

Indefiniteness in Patent Drafting

During prosecution, the U.S. Patent and Trademark Office evaluated applications using a lower threshold for indefiniteness because claims are evaluated under the broadest reasonable interpretation, but once the claims issued the indefiniteness standard changes.[3] Thus, patent drafters need to satisfy both standards when drafting.

In 2014, the U.S. Supreme Court rejected the "insolubly ambiguous" definiteness standard.[4] The court, in an opinion authored by late Justice Ruth Bader Ginsberg, held that a "patent is invalid for indefiniteness if its claims, read in light of the patent's specification and prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention." [5] Accordingly, for a term to be definite, it will not suffice to ascribe just some meaning to a term.

Coined Terms: No Ordinary Meaning

According to Federal Circuit jurisprudence, there exist three types of claim terms: (1) terms having well-known meanings; (2) generic structural terms ("means," "element" or "device"); and (3) coined terms ("widget" or "high speed").[6]

Patent drafters often chose to define, or coin terms.[7] Coined terms, which are the focus of this article, have no ordinary and customary meaning and can be somewhat unusual terms.[8] To challenge a coined term, the challenger must show by clear and convincing evidence that the coined term has no ordinary meaning.[9]

Open-Ended Definitions: No Reasonable Certainty

To ascertain whether a patent claim is definite, each coined term in the claim must be analyzed to determine whether the record supports a precise meaning. Definiteness applies



Keith Fredlake



Stephen Dew

principles of claim construction and relies on intrinsic evidence, which includes the specification and the prosecution history.[10] IQASR illustrates that the specification is even more important when the claims use a coined term.

In IQASR, the Federal Circuit upheld the district court's factual findings that the term "magnetic fuzz" has no ordinary meaning and rejected the post-filing evidence and rationalization presented by the patentee.

In particular, the court held that the patentee failed to provide a meaningful description and instead left the term "magnetic fuzz" decidedly unclear.[11] The court pointed out that some statements in the patent specification cut both ways, supporting some of the patentee's claim construction arguments, but also at the same time clouding these arguments.[12]

For instance, the specification included the following:

Low susceptance microparticles could be magnetic fuzz, iron oxide particles, microparticles, dust, trash, ferromagnetic particles, non- or even anti-ferromagnetic particles or the like and may even be small perhaps less than about one inch in size or the like.

Low susceptance microparticles may be magnetically active disassociated particles with low or magnetic or perhaps even low sensor susceptibility, such [as] but not limited to magnetic fuzz.

Disassociated magnetically active microparticles may be magnetic fuzz because these particles may be difficult to substantially identify.[13]

According to the Federal Circuit, these statements created a binary property which was low susceptance microparticles may be magnetic — but also, may not be magnetic. The equivocation and subjectivity in these statements "present[ed] obstacles to understanding no matter the reader's technical background." [14]

The multiple layers of definitions, the court held, are all open-ended and nonlimiting, which force the skilled artisan to "wade through a morass of uncertainty and contradiction" and made a "word salad of inconsistent indirect definitions and examples" that "flummoxed the district court." [15]

The court also pointed out that the use of term "magnetic fuzz" over 70 times in the specification is not helpful because "[a]dditional discussion of a concept may obfuscate the concept just as much as it may clarify it." [16]

The court also discussed the use of modal verbs, emphasizing precedent that a "patentee cannot simultaneously use nonmodal verbs [for example, 'may'] to avoid limiting the scope of an invention while also arguing that those same examples define the limits of the invention." The use of modal verbs to give nonlimiting examples for a claim term "does not necessarily render that term indefinite." [17]

But conversely, "such non-limiting examples do not on their own expressly define the bounds — the limits — of the claim." [18]

Practical Lessons/Tips for Patent Drafting for Definiteness

Although IQASR is a nonprecedential opinion, the decision illustrates the need to consider the definiteness standard when drafting a patent specification with coined terms to ensure that the specification provides objective boundaries for the terms.

1. Understand the technology.

Often invention disclosures are written in the language of the inventor and the patent drafter has to know the subject matter to recognize when there are coined terms, such as magnetic fuzz.

One technique is to search patent literature to determine how the term is used. If the search returned few or no results, then question whether to use the coined term or use a more widely accepted term.

Another technique is a translation check using machine translation tools. If the meaning is lost using the translation check, then this is a strong indicator of a coined term. Consideration should be given to how the coined term will be viewed in multiple language to ensure that the same meaning is maintained, even if foreign filings are not part of the patent strategy.

2. During drafting, practice defining the coined terms both as broadly as intended and as a potential infringer would define the term.

Evaluate whether both definition conforms to understood meaning and if not include a definition in the specification that provides clear unambiguous support for the patentee's definition of the coined term. This means that any definition shall not use the term "may."

3. Use examples and embodiments carefully.

In some cases, nonlimiting examples can "provide sufficient information to allow a skilled artisan to infer the bounds of a term or to eradicate any latent ambiguity in a term." [19]

But in other cases, "contradictory examples in the specification introduce ambiguity to an otherwise clear term and render it indefinite." [20] If the definition is written as a description of an embodiment, even a preferred embodiment, note the description will have limited use for a definition. Although claim interpretation will not exclude a preferred embodiment from a claim term, [21] the claim term cannot be defined by only the embodiment.

4. For some coined terms it may be helpful to use the coined term as you would with a trademark, in particular as an adjective and not a noun.

The description of the class of goods for the trademark should be considered when preparing the definition.

5. Test the binary nature of any statement involving the coined term that also uses "may" in the specification.

For example, when writing the statement "microparticles may be magnetically active," evaluate the circumstances whether the "microparticles may not be magnetically active." If those circumstances are important to the breadth or meaning of the invention then incorporate that meaning in the definition of the coined term.

In sum, drafting high-quality patent applications requires an understanding of the terms so

that the necessary scope for claim terms in an unambiguous manner is included. Among all the issues that may arise years later during litigation, definiteness is directly within the control of the patent drafter from the outset and considering these lessons will improve your patent drafting.

Keith Fredlake is a partner and Stephen Dew is an associate at Kilpatrick Townsend & Stockton LLP.

The opinions expressed are those of the author(s) and do not necessarily reflect the views of the firm, its clients, or Portfolio Media Inc., or any of its or their respective affiliates. This article is for general information purposes and is not intended to be and should not be taken as legal advice.

[1] In a patent infringement case, prior to an infringement evaluation, the claims of the asserted patent must satisfy the definiteness requirement.

[2] IQASR LLC vs. Wendt Corp. No. 2019-2227 (Fed. Cir. Sept. 15, 2020).

[3] Ex parte McAward, Appeal No. 2015-006416 (August 25, 2017) (precedential) (a claim is indefinite "when it contains words or phrases whose meaning is unclear.")

[4] *Nautilus v. Biosig*, 572 U.S. 898 (2014).

[5] *Id.* at 898-99.

[6] *Personalized Media Communications, LLC v. International Trade Com'n*, 161 F.3d 696, n. 11 (Fed. Cir. 1998).

[7] *Id.* at 704.

[8] IQASR at 9.

[9] *Id.* at 7-8.

[10] *Id.* at 9.

[11] *Id.* at 11.

[12] *Id.* at 9.

[13] *Id.* at 10-11.

[14] *Id.* at 10.

[15] *Id.* at 11.

[16] *Id.* at 13.

[17] *Id.* at 12.

[18] *Id.* (citing *Am. Med. Sys., Inc. v. Biolitec, Inc.*, 618 F.3d 1354, 1361 (Fed. Cir. 2010))

(finding that "the use of the words 'based upon,' rather than 'means' or 'is,'" to describe a term used in a claim preamble undermined the patentee's argument that the description of the term was intended to be "used as a definition" of the term)).

[19] IQASR, at 12 (citing *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1373 (Fed. Cir. 2014) ("We recognize that a patent which defines a claim phrase through examples may satisfy the definiteness requirement.")).

[20] *Id.*

[21] *MBO Labs., Inc. v. Becton, Dickinson & Co.*, 474 F.3d 1323, 1333 (Fed. Cir. 2007) ("A claim interpretation that excludes a preferred embodiment from the scope of the claim is rarely, if ever, correct." (internal citation omitted)).