APPENDIX

APPENDIX A

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2020-1189

INFINITY COMPUTER PRODUCTS, INC.,

Plaintiff-Appellant,

v.

OKI DATA AMERICAS, INC.,

Defendant- Appellee.

Appeal from the United States District Court
for the District of Delaware in
No. 1:18-cv-00463-LPS,
Chief Judge Leonard P. Stark.

Decided: February 10, 2021

Before PROST, Chief Judge, CLEVENGER, and
TARANTO, Circuit Judges.

OPINION

PROST, Chief Judge.

Infinity Computer Products, Inc. ("Infinity") appeals the U.S. District Court for the District of Delaware's final judgment of invalidity. We agree with the district

court that the patent claims asserted by Infinity against Oki Data Americas, Inc. ("Oki Data") are indefinite. We therefore affirm.

BACKGROUND

I

Infinity sued Oki Data for infringing four related patents: U.S. Patent Nos. 6,894,811 ("the '811 patent"), 7,489,423, 8,040,574, and 8,294,915.[1] The patents share a specification and involve using a fax machine as a printer or scanner for a personal computer. The indefiniteness issues in this case revolve around the connection between the fax machine and the computer, termed a "passive link." The parties agree that claim 1 of the '811 patent is representative. That claim states:

> 1. A method of creating a scanning capability from a facsimile machine to a computer, with scanned image digital data signals transmitted through a bi-directional direct connection *via a passive link between the facsimile machine and the computer*, comprising the steps of:
>
> by-passing or isolating the facsimile machine and the computer from the public network telephone line;
>
> coupling the facsimile machine to the computer;
>
> conditioning the computer to receive digital facsimile signals representing data on a scanned document; and
>
> conditioning the facsimile machine to transmit digital signals representing data on a scanned

[1] Infinity asserted claims 1–2, 4, 6–7, and 18–20 of the '811 patent; claims 1–4 and 6 of U.S. Patent No. 7,489,423; claims 1–2, 4–5, and 7–8 of U.S. Patent No. 8,040,574; and claims 1, 6–9, and 14–15 of U.S. Patent No. 8,294,915.

> document to the computer, said computer being equipped with unmodified standard protocol send/receive driver communications software enabling the reception of scanned image signals from the facsimile machine, said transmitted digital facsimile signals being received directly into the computer through the bi-directional direct connection *via the passive link*, thereafter, said computer processing the received digital facsimile signals of the scanned document as needed.

'811 patent claim 1 (emphases added).

The '811 patent is a continuation-in-part of U.S. Patent App. No. 08/226,278 ("the '278 application"), which itself ultimately issued as U.S. Patent No. 5,530,558. The "principal object" of the claimed invention is "to provide a circuit for interfacing a PC and a facsimile to enable the facsimile to be utilized as a scanner or a printer for a PC and to accomplish all of the objectives of a scanner or a printer in a simple straightforward manner through the use of a circuit of highly simplified design and low cost." '811 patent col. 1 ll. 39–45; *see id.* Fig. 1 (circuit diagram).

Figures 2a–e of the '811 patent depict this circuit relative to a computer and a fax machine. They also depict "facsimile modem circuitry," which "may be either internal or external" to the computer. *Id.* at col. 6 ll. 3–5. Figures 2b–d, for example, depict a fax machine connected to a computer via an RJ-11 cable, with fax modem circuitry located internal to the computer.

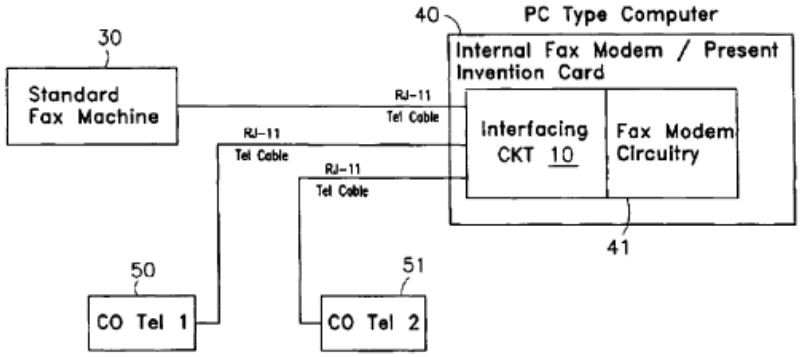

Fig. 2b

Id. Fig. 2b.

Figures 2f–h do not show fax modem circuitry interposed between the fax machine and the computer. Nor do they depict it as internal to the computer. The arrangement of Figure 2f, for example, "is used with PC's which do not have a fax modem installed." *Id.* at col. 6 ll. 62–63. This figure depicts a fax machine connected to a computer via an RS-232 cable, with both the circuit of the invention and the fax modem circuitry residing in the fax machine.

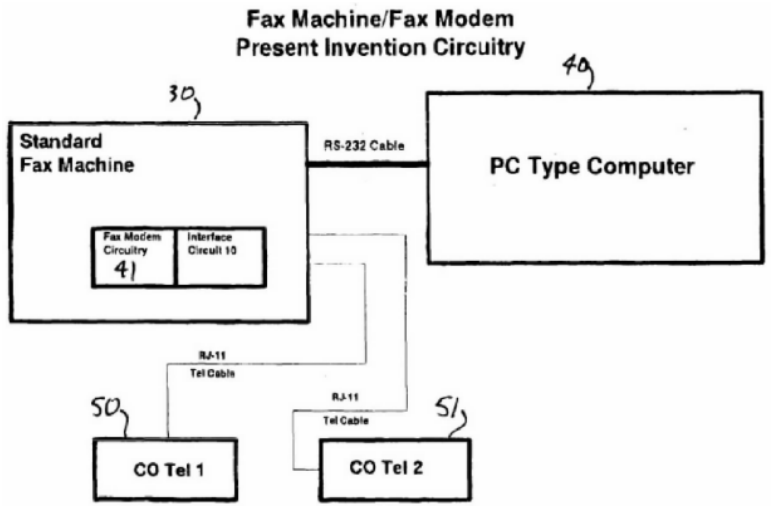

Fig. 2f.

Id. Fig. 2f. Unlike Figures 2a–e, Figures 2f–h were not disclosed in the parent '278 application.

II

The term "passive link" does not appear in the '811 patent specification. Nor does it appear in the parent '278 application. Rather, Infinity first introduced the term during prosecution of the '811 patent to distinguish an anticipating prior-art reference—U.S. Patent No. 5,452,106 ("Perkins"). This reference, the patent examiner noted, discloses using a fax machine as a scanner or printer for a computer. J.A. 2129–30.

Infinity's initial attempts at distinguishing Perkins were unsuccessful. First, Infinity amended the claim to recite (among other things) data transfer "between the facsimile machine and the computer" that occurs "without interruption." J.A. 1227. Infinity also distinguished Perkins at length in accompanying remarks, on the ground that Perkins includes an intervening component—"device 3"—between the fax

machine and the computer. J.A. 1233–36. As Infinity noted, one function of device 3 was to serve as a fax modem. J.A. 1233.

Infinity asserted that, "[u]nlike Perkins," the claimed invention permits "the uninterrupted transfer of scanning or printing signals *between* the facsimile and the computer without the use of intervening circuitry, and does not intercept the signals for demodulation as Perkins does with device 3." J.A. 1234. Later in the same response, Infinity reiterated that its invention "does not require a microprocessor or *any circuitry or software to interrupt and intercept* the signals which occur in transmissions between a fax machine and a computer." J.A. 1235.

The examiner was not persuaded. Perkins's device 3, the examiner countered, "may be provided on a card for location in the computer." J.A. 3443. This internal-card embodiment, the examiner continued, represents an "uninterrupted" connection between the fax machine and the computer that defeats Infinity's distinction. J.A. 3443.

Infinity responded with further amendments and remarks in several subsequent responses, including by repeating the "intervening circuitry" distinction. Eventually, Infinity overcame Perkins by amending the claim to require a "passive link" between the fax machine and the computer and by using this new term as a hook for its intervening-circuitry distinction:

> The Applicant *creates a passive link* between the facsimile machine and the computer in order to accommodate the signal transfer for printing or scanning. Therefore, the Applicant *does not require any intervening apparatus* as does Perkins. The applicant therefore believes[ ]

> Perkins did not anticipate the methods used by the Applicant.

J.A. 2196 (emphases added). In support, Infinity emphasized that Perkins requires an intervening modem:

> Perkins'[s] device 3 or card design requires a modem to be integrated into it in order to transfer signals for scanning or printing as part of his computer and facsimile transceiver interface. In contrast, the Applicant can transfer digital signals between the facsimile transceiver and the computer without the need for a modem at the computer interface.

J.A. 2197. In doing so, Infinity relied on its more recent Figures 2f–h, which do not depict a fax modem between the fax machine and the computer. J.A. 2198 ("[A] modem is not required at the computer in Figures 2F, 2G, and 2H.").

Infinity also reprised its argument that Perkins's device 3 is intervening circuitry between the fax machine and the computer—even when placed internally. This is so, Infinity contended, because device 3 intercepts data before it reaches the I/O bus of the computer:

> In [Perkins's] internal configuration, facsimile transmission data never enters the computer I/O Bus until after it is processed by the device 3 card circuits into digital data, thereafter, the flow of data transfers to the I/O Bus and is processed by the computer circuitry.
>
> It is therefore evident that Perkins'[s] device 3 intercepts the flow of data before it is transmitted to the computer circuits, in order to convert the analog signal into a digital signal format

> acceptable to the computer. Hence, even though circuitry of device 3 is placed in a card within the box containing the computer *it should be regarded as a peripheral device to the computer which processes data before it is transmitted to the I/O bus of the computer*.

J.A. 2201 (emphasis added).

Unlike Perkins's internal-card embodiment, Infinity argued, the claimed "passive link" conveys data directly to the I/O bus of the computer without intervening circuitry:

> Contrary to the above, when the Applicant transfers digital data from the facsimile transceiver *through a passive link* for scanning to the computer, the non-intercepted data enters through the RS 232 type connector port of the computer and *passes directly to the I/O Bus and is processed by the receiving circuits* (i.e., UART, CPU) *of the computer*, providing a true non intercepted digital signal between the facsimile transceiver and the computer.
>
> In effect, the Applicant's method does not use intermediary peripheral circuitry for signal interception, resulting in demodulation or modulation which is required by Perkins with his card or device 3.

J.A. 2201 (emphases added). This time, Infinity's argument was successful, and the '811 patent issued after further prosecution.

III

The '811 patent was later the subject of three ex parte reexaminations. In one of these, Infinity sought to antedate a reference, U.S. Patent No. 5,900,947 ("Kenmochi"), by arguing that claim 1 of the '811

patent is entitled to the priority date of the '278 application. Specifically, as Infinity recounted in summarizing an examiner interview, Infinity asserted that "the RJ-11 telephone cable shown in Figs. 2b, 2c and 2d of the ['278 application] is the 'direct' and 'passive link.' " J.A. 2500. Infinity made this argument even though each of Figures 2b–d depicts internal fax modem circuitry like Perkins's internal-card embodiment.

Likewise, in its written response to the Kenmochi rejection, Infinity argued that "the RJ 11 telephone cable and use thereof in communicating data between the fax machine 30 and the PC computer 40 meets the … definition of 'passive link.' " J.A. 2377–78. "For example, with respect to Figures 2b–2d" of the '278 application, Infinity argued, "the RJ 11 telephone cable connects the fax machine 30 to the PC computer 40 such that there is no intervening apparatus or signal interception by a processing element or any active component, along the path of an unbroken direct connection between the PC and the facsimile machine." J.A. 2378 (internal quotation marks omitted). Along the way, Infinity acknowledged that "[t]he term 'passive link' was first introduced in an amendment … to distinguish the invention of the ['811 patent] from Perkins." J.A. 2377.

Infinity also submitted an expert declaration during the reexamination. Without addressing the prior distinction of Perkins, Infinity's expert witness likewise opined that Figures 2b–d of the '278 application disclose a "passive link." J.A. 1980. He added that "the use of a modulation procedure within the PC and facsimile machine as shown in the figures does not insert an intervening apparatus or processing element along the path, e.g. on the cable between the PC's RJ-11 and the fax's RJ-11." J.A. 1980.

The examiner accepted Infinity's argument without expressly addressing Infinity's prior distinction of Perkins, J.A. 2525–29, despite recognizing in an interview summary that "the 'passive link' limitation" was a basis on which Infinity overcame "rejections based on Perkins" during prosecution. J.A. 1992. After further proceedings, including an appeal to the Patent Trial and Appeal Board ("Board"), a reexamination certificate ultimately issued noting the patentability of the claims.

IV

In this case, Oki Data argued before the district court that the terms "passive link" and "computer" are indefinite because Infinity took conflicting positions on the endpoint of the "passive link" during prosecution. In particular, Oki Data argued that Infinity took one position to overcome Perkins and a different position to antedate Kenmochi—creating uncertainty as to where the "passive link" ends and where the "computer" begins. At the *Markman* hearing, Infinity acknowledged that one of ordinary skill would need to be reasonably certain where the passive link ends and the computer begins in order for the claims to be definite. *Infinity Comput. Prods., Inc. v. Oki Data Ams., Inc.*, No. 18-463, 2019 WL 2422597, at *4 (D. Del. June 10, 2019), *reconsideration denied*, 2019 WL 5213250 (D. Del. Oct. 16, 2019).[2]

The district court agreed with Oki Data that "passive link" and "computer" are indefinite. First, the court explained that Infinity had taken materially inconsistent positions regarding the extent of the

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[2] *Markman* Tr. 61:19–22, J.A. 3855 (The Court: "In order for these claims to be definite, does one of skill in the art have to be reasonably certain where the passive link ends and the computer begins?" Mr. DiNovo: "Yes.").

claimed "passive link"—specifically, whether it ends at the I/O bus inside the computer (as argued to distinguish Perkins) or merely at the computer's port (as argued to antedate Kenmochi). *Id.* at *4–6. Therefore, the court concluded, the endpoint of "passive link" is not reasonably certain and the term is indefinite. *Id.*

Second, the court reasoned that because there is not reasonable certainty about where the "passive link" ends, there also cannot be reasonable certainty about where the "computer" begins. *Id.* at *6. "Specifically, where the passive link ends at a computer port, the computer begins at the port, and where the passive link ends at the I/O bus, the computer begins at the I/O bus." *Id.* The court denied Infinity's motion for reconsideration and entered a final judgment of invalidity. *Infinity*, 2019 WL 5213250, at *1–2; J.A. 22. This appeal followed. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

DISCUSSION

I

"The Patent Act requires that a patent specification 'conclude with one or more claims *particularly pointing out and distinctly claiming* the subject matter which the applicant regards as [the] invention.' " *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901, 134 S.Ct. 2120, 189 L.Ed.2d 37 (2014) (alteration in original) (quoting 35 U.S.C. § 112, ¶ 2 (2006)). "[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." *Id.* This standard strikes the "delicate balance" of accounting for both "the inherent limitations of language" and the need to "afford clear

notice of what is claimed, thereby apprising the public of what is still open to them." *Id.* at 909, 134 S.Ct. 2120 (cleaned up). It also serves as a "meaningful … check" against "foster[ing] [an] innovation-discouraging 'zone of uncertainty.' " *Id.* at 910–11, 134 S.Ct. 2120 (quoting *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236, 63 S.Ct. 165, 87 L.Ed. 232 (1942)).

Indefiniteness is ultimately a question of law that we review de novo. *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 789 F.3d 1335, 1341 (Fed. Cir. 2015). "[W]e look to the patent record—the claims, specification, and prosecution history—to ascertain if they convey to one of skill in the art with reasonable certainty the scope of the invention claimed." *Id.* "The prosecution history 'consists of the complete record of the proceedings before the PTO,' " including reexamination proceedings. *InTouch Techs., Inc. v. VGO Commc'ns, Inc.*, 751 F.3d 1327, 1341 (Fed. Cir. 2014) (quoting *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005) (en banc)); *see also Krippelz v. Ford Motor Co.*, 667 F.3d 1261, 1266 (Fed. Cir. 2012) ("A patentee's statements during reexamination can be considered during claim construction."). And "[a] statement made during prosecution of related patents may be properly considered in construing a term common to those patents." *Teva*, 789 F.3d at 1343.

Indefiniteness may result from inconsistent prosecution history statements where the claim language and specification on their own leave an uncertainty that, if unresolved, would produce indefiniteness. In *Teva*, for example, we concluded that the term "molecular weight" was indefinite. The parties had agreed that the term could refer to any of three different measures that are calculated in different ways and that typically yield materially different results. *Id.* at 1341. Neither the claim

language nor the specification indicated which measure the claims covered. *Id.* The prosecution history did not answer the question. To the contrary, in the prosecution histories of two continuation applications with nearly identical specifications, the patentee defined the term in two different ways—in each case to successfully overcome a rejection. *Id.* at 1343–45. On that record, we concluded that the term was indefinite. *Id.* at 1345. The record here is similar. As with the term "molecular weight" in *Teva*, the claim language and specification do not provide reasonable certainty about a crucial aspect of "passive link," namely, where it ends. And far from resolving the uncertainty during prosecution, Infinity took conflicting positions during prosecution regarding the scope of "passive link."

At first, Infinity argued that a "passive link" does not allow for intervening circuitry, like a fax modem, between the fax machine and the I/O bus of the computer. At the time, Infinity asserted that even circuitry "within the box containing the computer," like Perkins's device 3, "should be regarded as a peripheral device to the computer which processes data before it is transmitted to the I/O bus of the computer." J.A. 2201. Unlike Perkins, Infinity argued, data transmitted "through a passive link … passes directly to the I/O Bus and is processed by the receiving circuits … of the computer." J.A. 2201. On its own, this position would lead one of ordinary skill to believe a passive link does not end at the computer's port but rather reaches to the I/O bus of the computer—especially "[g]iven the role of the statement in gaining allowance of the claims," *Teva*, 789 F.3d at 1344.

Later, Infinity reversed course. During reexamination, Infinity contended that the passive

link was coextensive with the RJ-11 cable in the embodiments of Figures 2b–d—embodiments which *do* include intervening circuitry (such as fax modems) between the fax machine and the computer's I/O bus—indeed, within the "box containing the computer" like Perkins's device 3. On its own, this argument would lead one of ordinary skill to believe a "passive link" ends at the computer's port.

The public-notice function of a patent and its prosecution history requires that we hold patentees to what they declare during prosecution. *Teva*, 789 F.3d at 1344. But holding Infinity to both positions results in a flat contradiction, providing no notice to the public of "what is still open to them." *Nautilus*, 572 U.S. at 909, 134 S.Ct. 2120. Here, one of ordinary skill cannot determine with any reasonable certainty, for instance, whether or not the claims cover arrangements like the internal-card embodiment of Perkins and the internal-modem embodiments of Figures 2b–d. On the record before us, therefore, we agree with the district court that the intrinsic evidence leaves an ordinarily skilled artisan without reasonable certainty as to where the passive link ends and where the computer begins.

II

Infinity's contrary arguments are unavailing. Before the district court and on appeal, Infinity advanced its reexamination interpretation—i.e., that the passive link ends (and the computer begins) at the computer's port. But as the district court recognized, such an interpretation contradicts Infinity's distinction of Perkins—in which Infinity called Perkins's device 3 an intervening apparatus even though it was internal to the computer. *Infinity*, 2019 WL 5213250, at *1 ("Thus, if the 'passive link' ends at a computer *port* and not at the computer's I/O bus, as Infinity now suggests,

Perkins would include a 'passive link,' rendering the patentee's distinction from Perkins nugatory.").

Infinity argues that the court misinterpreted its statements distinguishing Perkins. According to Infinity, the passive link is the physical cable spanning the fax machine and the computer and Infinity's prosecution statements should be interpreted to mean that the data flowing through the passive link, rather than the passive link itself, proceeds uninterrupted to the I/O bus. But "we hold patentees to the actual arguments made, not the arguments that could have been made" during prosecution. *Tech. Props. Ltd. LLC v. Huawei Techs. Co.*, 849 F.3d 1349, 1359 (Fed. Cir. 2017). And the Supreme Court has warned us against "viewing matters *post hoc*" to "ascribe *some* meaning to a patent's claims." *Nautilus*, 572 U.S. at 911–12, 134 S.Ct. 2120. Here, Infinity stated that the passive link is the reason why its invention requires no intervening apparatus. J.A. 2196 ("The Applicant creates a passive link …. Therefore, the Applicant does not require any intervening apparatus as does Perkins."). To distinguish Perkins's internal-card embodiment, the passive link could not be merely a cable that ends at the computer's port.

Infinity has also at various points relied on an express definition of "passive link" that it presented to the Patent Office. Infinity first offered this definition in response to a rejection that came after Perkins was withdrawn, and later again through its expert witness during reexamination and before the Board.[3] The definition provides:

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[3] Infinity's appeal to the Board concerned whether the '278 application supports claims reciting digital-signal transmission. J.A. 3281. In passing, the Board described Figures 2b–d of the '811 patent as depicting a passive link—i.e., "the RJ-11 telephone cable"—based on the definition that Infinity's expert witness

> [A] "passive link" is one where the initiation of data flow is activated from a set-up procedure within the PC and/or the facsimile machine, and said data is transferred, with no intervening apparatus or signal interception by a processing element or any active component, along the path of an unbroken direct connection between the PC and the facsimile machine, for purposes of providing both scanning or printing data.

J.A. 1784. This is no help. According to this definition, a passive link is "one" characterized by the properties described. The definition, therefore, does not resolve the point in question: the extent of the "link."

Additionally, Infinity emphasizes that it submitted "unrebutted expert testimony" to the district court. Yet the testimony Infinity submitted merely states that "passive link" needs no construction and, in the alternative, that it should be construed according to the unhelpful definition above. J.A. 2975–76. And, as Oki Data notes, that testimony repeats the very same statements made during reexamination that gave rise to the inconsistency in the first place. Infinity's contradictory positions are plain from the patent record. The district court therefore saw no need for extrinsic evidence, and neither do we. *See Teva*, 789 F.3d at 1342 ("The internal coherence and context assessment of the patent, and whether it conveys claim meaning with reasonable certainty, are questions of law.").

We also reject Infinity's argument that the district court should not have held the claims indefinite based on a "single statement." *E.g.*, Appellant's Br. 50–53. As

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proffered. J.A. 3284. The Board's only mention of Perkins related to Infinity's prosecution argument that Perkins disclosed an analog-only configuration. J.A. 3287.

an initial matter, we disagree that the court did so. As discussed above, Infinity repeatedly made the distinction that was eventually successful in overcoming Perkins. Moreover, as Oki Data points out, a single contradictory statement was sufficient in *Teva*. Indeed, we noted there that we hold patentees even to erroneous prosecution statements. *Teva*, 789 F.3d at 1344.

Further, it is immaterial that Infinity also distinguished Perkins on another ground—i.e., that Perkins discloses an analog-only arrangement. *See, e.g.*, *Andersen Corp. v. Fiber Composites, LLC*, 474 F.3d 1361, 1374 (Fed. Cir. 2007) ("An applicant's invocation of multiple grounds for distinguishing a prior art reference does not immunize each of them from being used to construe the claim language."). Infinity admits that it made both distinctions during prosecution. Reply Br. 20. And, for what it's worth, Infinity commented in an interview during reexamination that "the examiner did not find the analog versus digital signal argument persuasive." Reply Br. 20; J.A. 1992.

We also disagree that the presence of the term "computer interface" in the claim at the time of the Perkins distinction somehow harmonizes Infinity's inconsistent statements. As the district court explained, the claim at the time also recited "a passive link … from the facsimile machine to the computer." *Infinity*, 2019 WL 5213250, at *2 (alteration in original). And Infinity "did not make any mention of, let alone place any material significance on, the phrase 'computer interface' in its distinction of the claimed invention's 'passive link' from the connection in Perkins." *Id.*

Last, Infinity argues that "computer" is a familiar term with a well-understood ordinary meaning. We

recognize that, in a vacuum, it might seem odd to hold "computer" indefinite. We also recognize that the specification identifies examples of commercial computers, such as an "Apple Macintosh" and an "IBM PC." '811 patent col. 4 ll. 64–66. Yet the indefiniteness here does not reside in the term "passive link" or "computer" on its own but rather in the relationship between the two in the context of these claims.[4] And any resulting strangeness stems from Infinity's own statements. *See, e.g.*, J.A. 2201 ("[E]ven though circuitry of device 3 is placed in a card within the box containing the computer[,] it should be regarded as a peripheral device to the computer."). As already noted, Infinity agrees that one of ordinary skill would need to be reasonably certain where the passive link ends and where the computer begins. There is no reasonable certainty as to that boundary. We therefore agree with the district court that both terms are indefinite.

III

We have considered Infinity's remaining arguments and find them unpersuasive. The district court correctly concluded that the asserted claims are invalid for indefiniteness. We affirm.

AFFIRMED

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[4] *See Markman* Tr. 49:19–25, J.A. 3843 (Mr. Labgold: "[W]e all know what a computer is. That is not what the issue is. It's the way that it is being used and how it has been differentiated with regard to the passive link.").

APPENDIX B

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

C.A. No. 18-463-LPS

INFINITY COMPUTER PRODUCTS, INC.,

Plaintiff,

v.

OKI DATA AMERICAS, INC.,

Defendant.

Signed 10/16/2019

MEMORANDUM ORDER

LEONARD P. STARK, UNITED STATES DISTRICT JUDGE

At Wilmington this 16th day of October, 2019:

Pending before the Court is Plaintiff Infinity Computer Products, Inc.'s ("Infinity") motion for reargument or reconsideration of the Court's holding, in its June 10, 2019 claim construction Opinion (D.I. 172) and Order (D.I. 173), that the claim terms "passive link" and "computer" are indefinite. (D.I. 177) Having reviewed the parties' submissions (D.I. 178, 184, 186-1 Ex. A), **IT IS HEREBY ORDERED** that Infinity's motion for reconsideration (D.I. 177) is **DENIED** for the following reasons:

1. Pursuant to Local Rule 7.1.5, a motion for reconsideration should be granted only "sparingly." The decision to grant such a motion lies squarely within the discretion of the district court. *See Dentsply Int'l, Inc. v. Kerr Mfg. Co.*, 42 F. Supp. 2d 385, 419 (D. Del. 1999); *Brambles USA, Inc. v. Blocker*, 735 F. Supp. 1239, 1241 (D. Del. 1990). These types of motions are granted only if the Court has patently misunderstood a party, made a decision outside the adversarial issues presented by the parties, or made an error not of reasoning but of apprehension. *See Schering Corp. v. Amgen, Inc.*, 25 F. Supp. 2d 293, 295 (D. Del. 1998); *Brambles*, 735 F. Supp. at 1241. A motion for reconsideration may be granted only if the movant can show at least one of the following: (i) there has been an intervening change in controlling law; (ii) the availability of new evidence not available when the court made its decision; or (iii) there is a need to correct a clear error of law or fact to prevent manifest injustice. *See Max's Seafood Café by Lou-Ann, Inc. v. Quinteros*, 176 F.3d 669, 677 (3d Cir. 1999). However, in no instance should reconsideration be granted if it would not result in amendment of an order. *See Schering Corp.*, 25 F. Supp. 2d at 295.

2. Here, Infinity does not contend that there has been an intervening change in law or that new evidence is available. (*See generally* D.I. 178) Therefore, Infinity has the burden to demonstrate a clear error of law or fact in the Court's reasoning. Infinity has not met its burden.

3. Infinity fails to show a clear error of law or fact with respect to its first contention: that the Court's interpretation of the patentee's September 26, 2002 Office Action Response ("Office Action Response") is incorrect. (*See id.* at 2-6) After a review of that Office Action Response, the Court concluded that the

patentee had, in distinguishing a prior art reference (U.S. Patent No. 5,452,106 to Perkins), taken the position that the patentee's claimed "passive link" was passive from a fax machine to a computer's input/output (I/O) bus. (D.I. 172 at 8-9) Infinity now argues that the Court's conclusion was in error; to Infinity, the patentee characterized the passive link as ending at a computer ***port***. (*See* D.I. 178 at 3-4) ("[T]he passive link spans the facsimile machine to the computer . . . and the computer begins at the RS 232 port . . . .") The Court is unpersuaded. For reasons explained at length in the Court's claim construction opinion (D.I. 172 at 8-11), Infinity's characterization of the patentee's argument is simply inconsistent with the Office Action Response itself, which repeatedly mentions the "I/O Bus" as the endpoint of the link between the "facsimile transceiver" and the "computer."[1] (*See* D.I. 148-29 at 15 (Infinity37915)) Moreover, Infinity's position that the "passive link" ends at a computer port would not serve to distinguish Perkins. As the patentee noted (*see id.*), Perkins discloses embodiments in which a "facsimile device 3," which sits between a fax machine and a computer I/O bus, can be placed inside a computer, such that a fax machine is connected to the device via a port on the computer. (*See* Perkins, 3:59-68, 9:24-32) Thus, if the "passive link" ends at a computer ***port*** and not at the computer's I/O bus, as Infinity now suggests, Perkins

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[1] Infinity argues that the Court "conflat[es] the discussion of ***the data flow*** which permissibly continues past the passive link connection to the I/O bus – and potentially on to the CPU – with the passive link's endpoint." (D.I. 178 at 4) (emphasis in original) To the extent that the Court does so, it is because the patentee did the same in the Office Action Response. *See Tech. Properties Ltd. LLC v. Huawei Techs. Co.*, 849 F.3d 1349, 1359 (Fed. Cir. 2017) (noting that scope of patent disclaimer is commensurate with "actual arguments made").

would include a "passive link," rendering the patentee's distinction from Perkins nugatory. *See Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1351 (Fed. Cir. 2001) ("A patent may not, like a 'nose of wax,' be twisted one way to avoid anticipation and another to find infringement.").

4. Infinity also fails to demonstrate that the Court made a clear error of law or fact with respect to Infinity's second contention: that the discussion in the Office Action Response is inapposite to the claims at issue in this case, as the Response concerned a different version of the claims.[2] (*See* D.I. 178 at 6-9) Infinity contends that claim 27, as it existed at the time of the Office Action Response, had an "additional requirement" over the current claims: "that the endpoint of the passive link lead directly to the 'computer interface.'" (*Id.* at 8) To Infinity, this requirement renders the Office Action Response's distinction from Perkins inapplicable to the interpretation of the asserted claims, which do not recite a "computer interface" but instead recite a "passive link" that extends to a "computer." (*Id.* at 8-9) Infinity's argument is unpersuasive. Although Claim 27 recites sending data through a "passive link" to a "computer interface," it also recites "a passive link . . . from the facsimile machine to the computer," which is essentially the same limitation as appears in the asserted claims. (*See* D.I. 148-29 at 20 (Infinity37920)) Moreover, the patentee in the Office Action Response did not make any mention of, let alone place any material significance on, the phrase "computer interface" in its distinction of the claimed invention's

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[2] The Court notes that Infinity did not raise this argument in its original briefing (*see generally* D.I. 149, 159), and first mentioned it during the claim construction hearing (Tr. at 63-66, 76-77). The Court will nevertheless consider the argument.

"passive link" from the connection in Perkins. (*See id.* at 15) Therefore, a person of ordinary skill would find the patentee's discussion of the endpoint of the "passive link" in the Office Action Response to indicate the endpoint of the "passive link" in the asserted claims. *See Fonar Corp. v. Johnson & Johnson*, 821 F.2d 627, 632 (Fed. Cir. 1987) (holding that meaning of claim term must be consistent throughout patent); *see also Acromed Corp. v. Sofamor Danek Grp., Inc.*, 253 F.3d 1371, 1382 (Fed. Cir. 2001); Tr. at 76-77 (Infinity agreeing that "a [POSA] can, and should, rely on" "any discussion in the prosecution" of "passive link," as long as Patent Office agrees with discussion).

5. Infinity's third and final contention – that the Court applied the wrong standard for patent disclaimer – also lacks merit. (*See* D.I. 178 at 9-10) Infinity seems to find a conflict between "the proposition that surrender can exceed that which is required by the prior art" (which Infinity contends the Court adopted) and the standard that disavowal must be "clear and unmistakable" (which Infinity contends the Court did not). (*Id.*) Contrary to Infinity's contention, these two points of law are not in conflict here; the patentee's distinction from Perkins on the basis of the claimed "passive link" was not ambiguous or "amenable to multiple reasonable interpretations." (*See id.* at 10) Instead, in the Office Action Response, the patentee took the clear and unmistakable position that the claimed "passive link" extends from a fax machine to the I/O bus of a computer. Even if the alternative distinctions from Perkins that Infinity has made in this litigation (*see id.* at 2-9) were persuasive (they are not), Infinity cannot negate the impact of the patentee's clear and unmistakable position during prosecution. *See Tech Properties Ltd. v. Huawei Techs. Co.*, 849 F.3d 1349 (Fed. Cir. 2017).

6. For these reasons, the Court denies Infinity's motion for reconsideration of the Court's holding that "passive link" and "computer"[3] are indefinite.

/s/ Leonard P. Stark
HONORABLE LEONARD P. STARK
UNITED STATES DISTRICT COURT

[3] Infinity does not provide any additional arguments with respect to the Court's finding that the term "computer" is indefinite (D.I. 178 at 10), so Infinity's motion with respect to that term fails for the reasons explained above for "passive link."

APPENDIX C

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

C.A. No. 18-463-LPS

INFINITY COMPUTER PRODUCTS, INC.,

Plaintiff,

v.

OKI DATA AMERICAS, INC.,

Defendant.

June 10, 2019
Wilmington, Delaware

MEMORANDUM OPINION

STARK, U.S. District Judge:

Plaintiff Infinity Computer Products, Inc. ("Infinity") sued Defendant Oki Data Americas, Inc. ("Oki Data"), alleging that Oki Data infringes Infinity's U.S. Patent Nos. 6,894,811 ("the '811 patent"), 7,489,423 ("the '423 patent"), 8,040,574 ("the '574 patent"), and 8,294,915 ("the '915 patent"). (D.I. 1) The asserted patents relate to systems for connecting a fax machine to a computer so that the fax machine can be used as a printer or scanner. (*See* '811 patent, Abstract) Oki Data makes devices that Infinity contends infringe the patents. (D.I. 1 ¶¶ 17-20)

Presently before the Court are the parties' disputes over the meaning of certain claim terms in the asserted claims. The parties submitted claim construction briefs. (D.I. 149, 151, 159, 162) Infinity submitted a technology tutorial (D.I. 150), to which Oki Data submitted objections (D.I. 161). The Court held a claim construction hearing on February 4, 2019. (*See* D.I. 170 ("Tr."))

I. LEGAL STANDARDS

A. Claim Construction

The ultimate question of the proper construction of a patent is a question of law. *See Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 837 (2015) (citing *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 388-91 (1996)). "It is a bedrock principle of patent law that the claims of a patent define the invention to which the patentee is entitled the right to exclude." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (citation and internal quotation marks omitted). "[T]here is no magic formula or catechism for conducting claim construction." *Id.* at 1324. Instead, the court is free to attach the appropriate weight to appropriate sources "in light of the statutes and policies that inform patent law." *Id.*

"[T]he words of a claim are generally given their ordinary and customary meaning . . . . [which is] the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* at 1312-13 (internal citations and quotation marks omitted). "[T]he ordinary meaning of a claim term is its meaning to the ordinary artisan after reading the entire patent." *Id.* at 1321 (internal quotation marks omitted). The patent "specification is always highly relevant to the claim

construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

While "the claims themselves provide substantial guidance as to the meaning of particular claim terms," the context of the surrounding words of the claim also must be considered. *Phillips*, 415 F.3d at 1314. Furthermore, "[o]ther claims of the patent in question, both asserted and unasserted, can also be valuable sources of enlightenment . . . . [b]ecause claim terms are normally used consistently throughout the patent." *Id.* (internal citation omitted).

It is likewise true that "[d]ifferences among claims can also be a useful guide . . . . For example, the presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim." *Id.* at 1314-15 (internal citation omitted). This "presumption is especially strong when the limitation in dispute is the only meaningful difference between an independent and dependent claim, and one party is urging that the limitation in the dependent claim should be read into the independent claim." *SunRace Roots Enter. Co., Ltd. v. SRAM Corp.*, 336 F.3d 1298, 1303 (Fed. Cir. 2003).

It is also possible that "the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs." *Phillips*, 415 F.3d at 1316. It bears emphasis that "[e]ven when the specification describes only a single embodiment, the claims of the patent will not be read restrictively unless the patentee has demonstrated a clear intention to limit the claim scope using words or expressions of manifest

exclusion or restriction." *Hill-Rom Servs., Inc. v. Stryker Corp.*, 755 F.3d 1367, 1372 (Fed. Cir. 2014) (quoting *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 906 (Fed. Cir. 2004)) (alteration in original) (internal quotation marks omitted).

In addition to the specification, a court "should also consider the patent's prosecution history, if it is in evidence." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996). The prosecution history, which is "intrinsic evidence," "consists of the complete record of the proceedings before the [Patent and Trademark Office] and includes the prior art cited during the examination of the patent." *Phillips*, 415 F.3d at 1317. "[T]he prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be." *Id.*

"In some cases, . . . the district court will need to look beyond the patent's intrinsic evidence and to consult extrinsic evidence in order to understand, for example, the background science or the meaning of a term in the relevant art during the relevant time period." *Teva*, 135 S. Ct. at 841. "Extrinsic evidence consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises." *Markman*, 52 F.3d at 980. For instance, technical dictionaries can assist the court in determining the meaning of a term to those of skill in the relevant art because such dictionaries "endeavor to collect the accepted meanings of terms used in various fields of science and technology." *Phillips*, 415 F.3d at 1318. In addition, expert testimony can be useful "to ensure that the

court's understanding of the technical aspects of the patent is consistent with that of a person of skill in the art, or to establish that a particular term in the patent or the prior art has a particular meaning in the pertinent field." *Id.* Nonetheless, courts must not lose sight of the fact that "expert reports and testimony [are] generated at the time of and for the purpose of litigation and thus can suffer from bias that is not present in intrinsic evidence." *Id.* Overall, while extrinsic evidence "may be useful to the court," it is "less reliable" than intrinsic evidence, and its consideration "is unlikely to result in a reliable interpretation of patent claim scope unless considered in the context of the intrinsic evidence." *Id.* at 1318-19. Where the intrinsic record unambiguously describes the scope of the patented invention, reliance on any extrinsic evidence is improper. *See Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1308 (Fed. Cir. 1999) (citing *Vitronics*, 90 F.3d at 1583).

Finally, "[t]he construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998). It follows that "a claim interpretation that would exclude the inventor's device is rarely the correct interpretation." *Osram GmbH v. Int'l Trade Comm'n*, 505 F.3d 1351, 1358 (Fed. Cir. 2007) (quoting *Modine Mfg. Co. v. U.S. Int'l Trade Comm'n*, 75 F.3d 1545, 1550 (Fed. Cir. 1996)).

B. Indefiniteness

A patent claim is indefinite if, "viewed in light of the specification and prosecution history, [it fails to] inform those skilled in the art about the scope of the invention with reasonable certainty." *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2129 (2014).

A claim may be indefinite if the patent does not convey with reasonable certainty how to measure a claimed feature. *See Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 789 F.3d 1335, 1341 (Fed. Cir. 2015). But "[i]f such an understanding of how to measure the claimed [feature] was within the scope of knowledge possessed by one of ordinary skill in the art, there is no requirement for the specification to identify a particular measurement technique." *Ethicon Endo–Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1319 (Fed. Cir. 2015).

II. CONSTRUCTION OF DISPUTED TERMS

A. "facsimile machine" and "fax machine"[1]

Infinity No construction necessary or "a device that is capable of sending and receiving a fax, including associated scan and print functionality"
Oki Data "a standard facsimile machine" or "a conventional facsimile machine"
Court "a device that is capable of sending and receiving a fax over a phone line and includes associated scan and print functionality"

The parties agree that a "fax machine" or "facsimile machine" must be capable of sending and receiving a fax over a phone line. (Tr. 11, 35 (Infinity: "in our view, I think a person of ordinary skill in the art would

[1] The terms "facsimile machine" or "fax machine" appear in claims 1, 2, 4, 6, 7, and 18-20 of the '811 patent, claims 1-4 and 6 of the '423 patent, claims 1, 2, 4, 5, 7, and 8 of the '574 patent, and claims 1, 6-9, 14, and 15 of the '915 patent.

understand that a fax machine has a phone line sending capability"); *id.* at 17 (Oki Data: "fax machine . . . would normally only communicate with the outside world through a telephone line"))

The parties' central dispute regarding this term is whether, as Oki Data contends (D.I. 151 at 10-14), the "fax machine" and "facsimile machine"[2] must be standard or conventional, or whether, as Infinity contends (D.I. 149 at 13-16), the terms may include non-standard and non-conventional machines.

The Court agrees with Infinity because the plain meaning of "fax machine" does not exclude non-standard machines, and the specification further supports this broad construction. Generally, a construction should depart from plain and ordinary meaning only when a patentee acts as its own lexicographer or disavows claim scope during prosecution. *See Poly-Am, L.P. v. API Indus., Inc.*, 839 F.3d 1131, 1136 (Fed. Cir. 2016). To narrow the scope of an otherwise broad term, the specification must demonstrate a "clear intention . . . using words or expressions of manifest exclusion or restriction." *Hill-Rom*, 755 F.3d at 1372. Here, the specification does not show any clear intention to require a fax machine to be standard or conventional. To the contrary, Figures 2c, 2f, and 2h show the inventive "interface circuit 10" inside the fax machine. A fax machine including interface circuit 10 would not be standard or conventional. Such a fax machine would also be excluded from the claims under Oki Data's construction, a result that is disfavored. *See Broadcom Corp. v. Emulex Corp.*, 732 F.3d 1325, 1333 (Fed. Cir.

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[2] The claims use "fax machine" and "facsimile machine" interchangeably. For clarity, the Court will refer to both terms as fax machines.

2013) ("[A]n interpretation which excludes a disclosed embodiment from the scope of the claim is rarely, if ever, correct.") (internal alterations and quotation marks omitted).

The specification suggests that the use of a conventional fax machine may be a preferred embodiment ('811 patent, Abstract), and that a "principal object" of the invention is to allow a conventional fax machine to be used as a scanner or printer using "a circuit of highly simplified design and low cost" (*id.*, 1:25-40). Still, nothing in the specification establishes that the fax machine used in the invention ***must*** be conventional. *See Northrop Grumman Corp. v. Intel Corp.*, 325 F.3d 1346, 1355 (Fed. Cir. 2003) (holding claims not limited to certain context even though inventor conceived that invention "would be used principally, if not exclusively," in that context, even when specification "refers repeatedly to the advantages of the invention in that context").

Oki Data contends that the patentee's arguments distinguishing U.S. Patent No. 5,598,533 to Yokota ("Yokota") limit the claims to conventional fax machines. (D.I. 151 at 12-13) However, the patentee merely argued that the claimed invention, unlike Yokota, ***could be used*** with a standard fax machine. (D.I. 148-10 Ex. 6 at 20) (distinguishing Yokota as requiring "a complex memory and interrupt service routine based interface between PC-like and Fax-like components that were integrated into a single box")

B. "passive link"[3]

Infinity No construction necessary or "a link where the initiation of data flow is activated from a setup procedure within the PC and/or the facsimile machine, and the data is transferred, with no intervening apparatus or signal interception by a processing element or any active component, along the path of an unbroken direct connection between the PC and facsimile machine, for purposes of providing scanning and/or printing data"
Oki Data Indefinite or "a link where the initiation of data flow is activated from a set-up procedure within the PC and/or the facsimile machine, and said data is transferred, with no intervening apparatus or signal interception by a processing element or any active component, along the path of an unbroken direct connection between the PC and the facsimile machine"
Court Indefinite

Each of the asserted independent claims recites connecting a fax machine to a computer "via a passive link." Oki Data contends that "passive link" is indefinite because, during prosecution of the '811 patent, the patentee took contradictory positions as to whether a passive link must extend (i) all the way to

[3] The term "passive link" appears in claims 1, 6, 7, and 18-20 of the '811 patent, claims 1, 2, and 6 of the '423 patent, claims 1, 7, and 8 of the '574 patent, and claims 1 and 9 of the '915 patent.

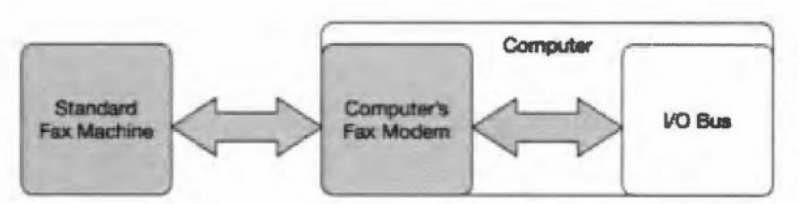
the I/O bus of a computer, or (ii) only to a port on the housing of the computer, such that an "intervening apparatus" (such as a fax modem) may be located between the passive link and the I/O bus. (D.I. 151 at 15) Infinity agrees that in order for the Court not to find "passive link" indefinite, one of skill in the art would have to be reasonably certain as to where the passive link ends and the computer begins (Tr. 61-62), and further agrees that one of skill in the art would look to the prosecution history in determining the meaning of "passive link" (*id.* at 67).

During prosecution of the '811 patent, the patentee maintained that a passive link must extend to a computer's I/O bus without any intervening devices. In response to an obviousness rejection, the patentee distinguished U.S. Patent No. 5,452,106 to Perkins ("Perkins") on the basis that Perkins did not include a passive link as recited by the claims. (D.I. 148-29 Ex. 25) Perkins discloses a system for connecting a fax machine to a computer via a "facsimile device 3" that connects to the fax machine via a phone line and to the computer via a serial cable. (Perkins 3:59-68) The facsimile device might be a standalone device or, alternatively, be located on a card inside a computer. (*Id.* 3:59-68,9:24-32) The patentee argued that Perkins lacked a passive link because, in Perkins' configuration, the "facsimile transmission ***never enters the computer I/O bus until after it is processed by device 3*** . . . . Contrary to the above, [in the claimed invention], ***the non-intercepted data enters through the [serial] type connector port of the computer and passes directly to the I/O bus*** . . . providing a true non-intercepted signal between the facsimile transceiver and the computer." (D.I. 148-29 Ex. 25 at 12) (emphasis added)

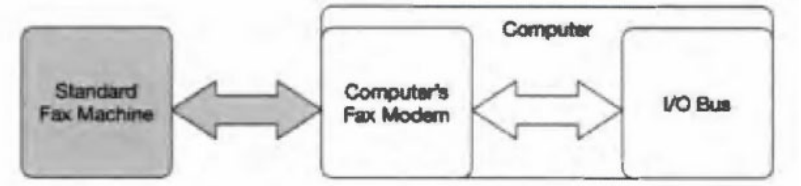
However, during a later *ex parte* reexamination of the '811 patent, the patentee argued that a passive link need only extend to a computer port without any intervening device. During reexamination, the claims were rejected as anticipated by U.S. Patent No. 5,900,947 to Kenmochi et al. ("Kenmochi"). (D.I. 151-5 Ex. 52 at 14) The patentee responded that Kenmochi was not prior art because the effective priority date of the claims was not the filing date of the '056 application, but rather the filing date of the '278 application, of which the '056 application was a continuation-in-part. (D.I. 148-18 Ex. 14 at 7) The patentee argued that written description for the "passive link" term could be found in Figures 2b, 2c, and 2d, which were present in the '278 application. (*Id.*) Specifically, the patentee argued that passive link in each of Figs. 2b-2d was the RJ-11 (phone line) cable from the fax machine to the RJ-11 port on the computer's fax modem. (*Id.*) On this understanding, a passive link need only be uninterrupted from the fax machine to a port on the computer; it may be further processed in the computer before it passes to the I/O bus. (*See id.*; U.S. Patent App. No. 90/013,208, Final Office Action dated 2/11/2015 at 20-25 (concluding, based on patentee's arguments, that "the claimed 'passive link' . . . constitutes the direct physical connection between the facsimile machine and the computer, ***regardless of whether the PC included an internal modem***") (emphasis added).

Oki Data's diagrams characterizing the prosecution history, reproduced below, accurately depict the understanding a person of ordinary skill would have when reading the prosecution history.

(D.I. 151 at 8)



Location of the passive link to the "computer" in distinguishing *Perkins*



Location of the passive link to the "computer" during re-examination

(D.I. 151 at 8)

Oki Data has met its burden to show indefiniteness by clear and convincing evidence. During prosecution, the patentee distinguished prior art references by characterizing "passive link" as requiring the link to be entirely passive from the fax machine to the computer's I/O bus (in the patentee's words, "a true non-intercepted digital signal"). (D.I. 128-29 Ex. 25 at 12) This is depicted in the first diagram above. Then, however, in order to claim the filing date of the '278 application, the patentee characterized "passive link" as only requiring the link to be passive from the fax machine to a port on the computer. (D.I. 148-18 Ex. 14 at 7) This is depicted in the second diagram above.

Under the patentee's first definition, the '278 application lacks written description for a passive link because the '278 application does not disclose a link that was passive until the computer's I/O bus. Rather,

under that definition, each embodiment disclosed in the '278 application includes an intervening apparatus – a modem – between the fax machine and the I/O bus. (*See* '811 patent, Figs. 2b-2d) Conversely, the patentee's second definition, used to overcome the written description rejection, would not distinguish the Perkins patent because Perkins teaches connecting a fax machine to a computer a via an intervening device: a "facsimile device" inside the computer. (Perkins 9:24-32) The patentee's contentions regarding "passive link" have been materially inconsistent. Hence, a person of ordinary skill in the art would not be reasonably certain as to which of the patentee's two inconsistent definitions of "passive link" is used in the claims, rendering the claims indefinite. *See Teva*, 789 F.3d at 1345 (holding claim term indefinite where patentee used two inconsistent definitions of term during prosecution).

Infinity is not correct that the PTAB's construction during reexamination is "the definitive outcome of the prosecution history." (D.I. 159 at 5) The PTAB's construction of a claim term is not binding on a district court. *See Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1359-60 (Fed. Cir. 2007). Moreover, the PTAB did not consider the argument now before this Court. (*See generally* D.I. 149-9 Ex. 3) The issue before the PTAB was whether there was written description for both analog and digital signals in the '278 patent, and the PTAB only rejected the contention that the patentee, in distinguishing Perkins, limited the claims to "***solely analog*** transmission." (D.I. 149-9 Ex. 3 at 12) (emphasis in original). The PTAB's conclusion is not relevant to the question before this Court: whether the patentee took inconsistent positions with respect to the ***endpoint*** of the passive link.

Infinity's argument that its construction does not, in fact, conflict with Perkins also misses the mark. (*See* D.I. 159 at 7-9) Infinity's post hoc distinction of Perkins does not negate the patentee's far more specific arguments during prosecution. *See Tech. Properties*, 849 F.3d at 1359 (holding that "the scope of surrender is not limited to what is absolutely necessary to avoid a prior art reference" but rather to "the actual arguments made"). Moreover, Infinity's distinction fails on its merits: Perkins contemplates the facsimile device being inside a PC and, so, envisions embodiments with a direct, passive connection between a fax machine and a PC port. (Perkins, 9:24-32)

C. "computer"[4]

Infinity No construction necessary
Oki Data Indefinite
Court Indefinite

The parties' dispute over "computer" mirrors their dispute over "passive link." Infinity contends that the term is a "straightforward word" that is "readily understood by a person of skill in the art, the Court and jury without construction." (D.I. 149 at 20) Oki Data argues that "computer" is indefinite for essentially the same reasons as it provided for "passive link." (D.I. 151 at 20)

[4] The term "computer" appears in claims 1, 2, 4, 6, 7, and 18-20 of the '811 patent, claims 1-4, and 6 of the '423 patent, claims 1, 2, 4, 5, 7, and 8 of the '574 patent, and claims 1 and 9 of the '915 patent.

The Court agrees with Oki Data for the same reasons as provided above for "passive link." Each claim that recites "passive link" states that the passive link connects a "facsimile machine" and a "computer." (*See, e.g.*, '811 patent. cl. 12) (reciting "transferring data signals . . . via a passive link between the facsimile machine and the computer")) Given that the two definitions for "passive link" vary in their end point – one connects the fax machine to a port on a computer, and another connects the fax machine to the I/O bus of the computer – it follows that the scope of "computer" changes depending on the definition. Specifically, where the passive link ends at a computer port, the computer begins at the port, and where the passive link ends at the I/O bus, the computer begins at the I/O bus. Accordingly, a person of ordinary skill in the art would not be reasonably certain as to what the claims mean by "computer." *See Teva*, 789 F.3d at 1345.

Infinity provides several arguments as to why "computer" is not indefinite, but none are persuasive. (*See* D.I. 149 at 20-21; D.I. 159 at 10) Infinity points to the statement in the specification that "[t]he PC . . . may be any type of computer (including but not limited to an Apple Macintosh, IBM PC, PCAT or PCXT)." (D.I. 149 at 20) Infinity also notes that "computer" has been construed or given its plain meaning in many unrelated patents. (*Id.*) Infinity further points out that defendants in related cases have not suggested that "computer" is indefinite. (D.I. 159 at 10) Yet neither the specification nor any case cited by Infinity resolves the ambiguity created by the prosecution history of the patents-in-suit. The fact that an indefiniteness argument was not made by defendants in other cases does not render the argument being made here less meritorious.

III. CONCLUSION

The Court will construe the disputed terms as explained above. An appropriate Order follows.

APPENDIX D

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

C.A. No. 18-463-LPS

INFINITY COMPUTER PRODUCTS, INC.,

Plaintiff,

v.

OKI DATA AMERICAS, INC.,

Defendant.

ORDER

At Wilmington, this **10th** day of **June, 2019**:

For the reasons set forth in the Memorandum Opinion issued this date,

IT IS HEREBY ORDERED that the claim terms in this case are construed as follows:

Claim Term	**Court's Construction**
"facsimile machine"	"a device that is capable of sending and receiving a fax over a phone line and includes associated scan and print functionality"
"fax machine"	"a device that is capable of sending and receiving a fax over a phone line and includes associated scan and print functionality"
"passive link"	Indefinite
"computer"	Indefinite

/s/ Leonard P. Stark
UNITED STATES DISTRICT JUDGE

APPENDIX E

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2020-1189

INFINITY COMPUTER PRODUCTS, INC.,

Plaintiff-Appellant,

v.

OKI DATA AMERICAS, INC.,

Defendant- Appellee.

Appeal from the United States District Court
for the District of Delaware in
No. 1:18-cv-00463-LPS,
Chief Judge Leonard P. Stark.

ON PETITION FOR PANEL REHEARING
AND REHEARING EN BANC

NOTE: This order is nonprecedential.

Before PROST, *Chief Judge*, NEWMAN, LOURIE, CLEVENGER*, DYK, MOORE, O'MALLEY, REYNA, WALLACH, TARANTO, CHEN, HUGHES, and STOLL, *Circuit Judges*.

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* Circuit Judge Clevenger participated only in the decision on the petition for panel rehearing.

PER CURIAM.

ORDER

Infinity Computer Products, Inc. filed a combined petition for panel rehearing and rehearing en banc. The petition was referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc was referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

The mandate of the court will issue on April 21, 2021.

FOR THE COURT

April 14, 2021
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court