

No. 21-

IN THE
Supreme Court of the United States

INFINITY COMPUTER PRODUCTS, INC.,
Petitioner,

v.

OKI DATA AMERICAS, INC.,
Respondent.

**On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit**

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

The Patent Act provides that a patent “specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112, ¶ 2 (2006). A patent claim that is insufficiently “definite” under this provision is invalid. In *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014), this Court made clear that “[d]efiniteness is measured from the viewpoint of a person skilled in [the] art *at the time the patent was filed.*” *Id.* at 908 (alterations in original). Although the only evidence in this case on how those skilled in the art would understand two disputed claim terms came from the patent owner’s expert, the Federal Circuit treated the issue as a purely legal one and concluded that two supposedly inconsistent positions found in the prosecution history rendered the disputed terms indefinite, rendering the claims invalid. The question presented is:

Whether a patent claim is indefinite under § 112, ¶ 2, if conflicting positions about a claim term arise during the patent prosecution process, even if uncontradicted expert testimony established that the term has a reasonably certain meaning to those skilled in the art.

**PARTIES TO THE PROCEEDING AND RULE
29.6 STATEMENT**

Petitioner (plaintiff-appellant below) is Infinity Computer Products, Inc. Respondent (defendant-appellee below) is Oki Data Americas, Inc.

Pursuant to this Court's Rule 29.6, Petitioner Infinity Computer Products, Inc. states as follows: Infinity Computer Products, Inc. is a privately held company with no parent corporation.

RELATED PROCEEDINGS

Counsel are unaware of any proceeding that is directly related to this case within the meaning of Supreme Court Rule 14.1(b)(iii). The following cases, however, were deemed related in the lower courts:

Infinity Computer Products, Inc. v. Canon USA, Inc., No. 2:18-cv-01823 (EDNY)

Infinity Computer Products, Inc. v. Dell, Inc., No. 2:12-cv-06808 (EDPA)

Infinity Computer Products, Inc. v. Hewlett-Packard Co., No. 2:12-cv-06805 (EDPA)

Infinity Computer Products, Inc. v. Konica Minolta Business Solutions, USA, Inc., No. 2:12-cv-06802 (EDPA)

Infinity Computer Products, Inc. v. Lexmark International, Inc., No. 5:18-cv-00198 (EDKY)

Infinity Computer Products, Inc. v. Ricoh USA, Inc., No. 2:12-cv-06807 (EDPA)

Infinity Computer Products, Inc. v. Samsung Electronics America, Inc., No. 2:12-cv-06798 (EDPA)

*Infinity Computer Products, Inc. v. Toshiba America
Business Solutions, Inc.*, No. 2:12-cv-06807 (EDPA)

Infinity Computer Products, Inc. v. Xerox Corp., No.
2:12-cv-06804 (EDPA)

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PETITION FOR A WRIT OF CERTIORARI

Petitioner Infinity Computer Products, Inc. respectfully petitions for a writ of certiorari to review the decision of the U.S. Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

The Federal Circuit’s opinion is reported at 987 F.3d 1053 and is reproduced in the appendix to this petition at Pet. App. 1a–18a. The district court’s opinion is unpublished, but can be found at 2019 WL 5213250, and is reproduced at Pet. App. 25a–40a

JURISDICTION

The Federal Circuit entered judgment on February 10, 2021, Pet. App. 1a, and denied Infinity’s timely petition for rehearing and rehearing en banc on April 14, 2021, Pet. App. 44a. This Court has jurisdiction under 28 U.S.C. § 1254.

STATUTORY PROVISION INVOLVED

The statutory provision involved is 35 U.S.C. § 112, ¶ 2 (2006),¹ which provides in relevant part:

The specification shall conclude with one or more claims particularly pointing out and distinctly

¹ In the Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), Congress amended several parts of the Patent Act, including § 112, ¶ 2, which it designated § 112(b). Any modifications are not pertinent here. In any event, the pre-AIA version of § 112 applies here because the AIA amendments are “inapplicable to patent applications filed before September 16, 2012, and proceedings commenced before September 16, 2011.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 902 n.1 (2014).

claiming the subject matter which the applicant regards as his invention.

INTRODUCTION

In *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014), this Court corrected the Federal Circuit by clarifying the standards for assessing whether patent claims are sufficiently definite under 35 U.S.C. § 112. In less than ten years, however, the Federal Circuit in the decision below now threatens to upend all that this Court sought to achieve.

Section 112 requires, among other things, that a patent’s “specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112, ¶ 2 (2006). This definiteness requirement has long been a staple of patent law. In *Nautilus*, the Court held that the Federal Circuit had been employing an erroneous standard for assessing indefiniteness and explained that § 112 requires “a patent’s claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty.” 572 U.S. at 910. The Court emphasized that “definiteness is to be evaluated from the perspective of someone skilled in the relevant art.” *Id.* at 908.

In the decision below, however, the Federal Circuit struck out on its own, creating a new way in which to find patent claims indefinite. Although the sole, un rebutted evidence showed that the claim terms at issue inform those of skill in the art with reasonable certainty, the Federal Circuit held as a matter of law that the claims are indefinite. It did so by concluding that Infinity had taken inconsistent positions during the prosecution history of one of the asserted patents. The court reasoned that Infinity had taken one position in

early prosecution of the patent but, during subsequent prosecution, including a reexamination proceeding after the patent issued, had taken a contrary position. The court then held that the supposed inconsistency, by itself, meant the claims are legally indefinite, even though one of skill in the art readily understood the patent claims, and even though the claims had received a consistent construction through years of prosecution.

The Federal Circuit's decision is inconsistent with this Court's precedent. This Court has explained that "the definiteness inquiry trains on the understanding of a skilled artisan at the time of the patent application, not that of a court viewing matters *post hoc*." *Nautilus*, 572 U.S. at 911. But the Federal Circuit's decision below ignores that, focusing instead on its own views of what the prosecution history says. Such a rule—which rests on what litigants may argue and courts may find—breeds uncertainty about the meaning of patent claims. And this conflicts with the longstanding principle that the "limits of a patent must be known for the protection of the patentee, [and for] the encouragement of the inventive genius of others." *Gen. Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938). The Court should grant certiorari to once again correct the Federal Circuit's misapplication of indefiniteness.

The argument for certiorari is particularly powerful here because this case would allow the Court to answer "questions [it left] for another day." *Nautilus*, 572 U.S. at 912 n.10. The Court in *Nautilus* declined to address which aspects of the indefiniteness inquiry under § 112 are issues of fact or "whether factual findings subsidiary to the ultimate issue of definiteness trigger the clear-and-convincing-evidence standard." *Id.* Elsewhere, however, this Court has said that "the meaning

of a term in the relevant art during the relevant time period” is a question of fact, *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318, 331–32 (2015). Under that logic the decision below is clearly wrong because the sole evidence concerning the views of a skilled artisan came from Infinity, not respondent. Accordingly, respondent could not have satisfied the burden under 35 U.S.C. § 282, to prove invalidity by clear and convincing evidence. See *Microsoft Corp. v. iAi Ltd. P’ship*, 564 U.S. 91, 95 (2011). This case thus squarely presents the very questions this Court previously left unanswered. This case thus presents a compelling vehicle for deciding how to apply the standard for indefiniteness in patent law.

The Court should grant the petition.

STATEMENT OF THE CASE

I. LEGAL BACKGROUND

In the Patent Act of 1790, Congress first addressed how inventors should disclose their inventions in patent applications. It provided that the “specification shall be so particular ... as not only to distinguish the invention or discovery from other things before known and used, but also to enable a ... person skilled in the art ... to make, construct, or use the same.” Act of Apr. 10, 1790, ch. 7, § 2, 1 Stat. 109, 110. Congress adopted similar requirements in its 1793 amendments. See William Redin Woodward, *Definiteness and Particularity in Patent Claims*, 46 Mich. L. Rev. 755, 758 (1948). Under these requirements, and in response to court decisions interpreting them, there arose a practice of appending a statement of what the patent “claims” at the end of the description of the invention. *Id.* at 759. In 1836, Congress codified this practice by requiring the patent applicant to “particularly specify and point out the part, improvement, or combination,

which he claims as his own discovery.” *Id.* at 759–60 (quoting Act of July 4, 1836, ch. 357, § 6, 5 Stat. 117, 119). And in 1870, Congress amended this provision to require the applicant to “particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery.” *Id.* at 760 (quoting Act of July 8, 1870, ch. 230, § 26, 16 Stat. 198, 201).

The Court addressed this statutory requirement to “claim” an invention in *General Electric*, 304 U.S. 364. There, the Court affirmed the principle that, after 1870, “[t]he claims ‘measure the invention.’” *Id.* at 369. Moreover, the Court explained that the statutory command to distinctly claim an invention “seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights.” *Id.* In *General Electric*, the Court found the claims at issue were insufficiently definite and failed this requirement because they described the invention in functional terms using indeterminate adjectives. *Id.* at 371.

This Court also addressed indefinite claims in *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228 (1942). There, the Court emphasized that “[t]he statutory requirement of particularity and distinctness in claims is met only when they clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise.” *Id.* at 236. However, the Court recognized that “it is difficult for persons not skilled in the art to measure the inclusions or to appreciate the distinctions which may exist in the words of a claim when read in the context of the art itself.” *Id.* at 233. Accordingly, the Court examined the trial testimony of one of the inventors to obtain the “clearest exposition of the significance which the terms employed in the claims

had for those skilled in the art.” *Id.* With that expert understanding, the Court concluded that the claims were indefinite. *Id.* at 234, 237.

In the Patent Act of 1952,² Congress established the current structure of patent law and reaffirmed the definiteness requirement. It carried forward the requirement that the “specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112, ¶ 2 (2006).

Most recently, the Court in *Nautilus*, 572 U.S. at 911–12, rejected the Federal Circuit’s “insolubly ambiguous” test for assessing indefiniteness under § 112, ¶ 2. Under that test, the requirement of definiteness was essentially rendered a dead letter. All but the most poorly worded patents would survive scrutiny. This Court granted review to balance properly the interests of inventors and the public. *Id.* at 909–10.

The Court explained that the “1870 Act’s definiteness requirement survives today, largely unaltered.” *Id.* at 902. And the Court “read[s] § 112, ¶ 2 to require that a patent’s claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty.” *Id.* at 910. According to the Court, definiteness must “be evaluated from the perspective of someone skilled in the relevant art.” *Id.* at 908. Indeed, it must be “measured from the viewpoint of a person skilled in [the] art *at the time the patent was filed.*” *Id.* (alteration in original). The Court emphasized that “the definiteness inquiry trains on the understanding of a skilled artisan at the time of the patent application, not that of a court viewing matters *post hoc.*” *Id.*

² Act of July 19, 1952, Pub. L. No. 82-593, 66 Stat. 792.

at 911. The Federal Circuit’s test, according to the Court, was incompatible with these principles. *Id.* at 911–12.

After clarifying the standards for assessing indefiniteness, the Court did not apply those standards in that case; instead, it remanded the case for the Federal Circuit to apply them in the first instance. *Id.* at 913. The Court also did not address which issues in the analysis are factual or legal, and declined to address “whether factual findings subsidiary to the ultimate issue of definiteness trigger the clear-and-convincing-evidence standard.” *Id.* at 912 n.10. The Court left those questions, and any deference to factual findings, “for another day.” *Id.* That day has arrived.

II. BACKGROUND OF THE CASE

A. Factual Background

The patents at issue in this case represent a breakthrough in systems and methods for using a fax machine as a universal printer or scanner for any personal computer. Bruce Nachman, the inventor, understood the benefit of having printing and scanning devices connected to personal computers, but also recognized that having these devices increased the cost and complexity of personal computing. See CAFC JA84. Having these capabilities not only required the PC to connect to multiple devices, but each device often also required its own proprietary connections. Nachman saw a potential solution—“conventional facsimile machines may be utilized as scanners or printers for PCs,” *id.*—and he set out to find a technical method of accomplishing that extremely useful invention. The object of Nachman’s inventions was “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.” *Id.*; Pet. App. 3a.

Nachman’s initial patent application—U.S. Patent Application No. 08/226,278 (“the ’278 application”)—ultimately led to the issuance of U.S. Patent No. 5,530,558. Pet. App. 3a. The ’278 application also led to several continuation-in-part applications, which resulted in the four patents at issue in this case: 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”). *Id.* at 2a. Claim 1 of the ’811 patent is exemplary and claims a “method of creating a scanning capability from a facsimile machine to a computer.” CAFC JA88; Pet. App. 2a. In this method, the fax machine scans an image and the “scanned image digital data signals [are] transmitted through a bi-directional connection via a passive link between the facsimile machine and the computer.” CAFC JA88; Pet. App. 2a. The method comprises several steps, including bypassing or isolating the fax machine and computer from the public network, coupling the machines, conditioning the computer to receive scanned digital signals from the fax machine, and conditioning the fax machine to transmit the scanned digital signals to the computer. CAFC JA88; Pet. App. 2a–3a. The computer in the method is equipped with particular communications software for receiving the digital signals, and the “transmitted digital facsimile signals [are] received directly into the computer through the bi-directional direct connection via the passive link.” CAFC JA88; Pet. App. 3a.

B. Proceedings Below

1. Infinity sued Oki Data for infringement of numerous claims of four patents: the ’811 patent, ’423 patent, ’574 patent, and ’915 patent. Pet. App. 2a & n.1. In

response to Infinity’s lawsuit, Oki Data maintained, among other things, that two terms in claim 1 of the ’811 patent are indefinite, rendering all asserted claims entirely invalid under § 112, ¶ 2. See *id.* at 10a. Those two terms are “computer” and “passive link.” *Id.*

After briefing and argument on the appropriate construction of certain contested claim terms, the district court issued a claim construction order that concluded counterintuitively that the terms “computer” and “passive link” are indefinite. Pet. App. 33a–36a, 38a–39a. Oki Data offered no expert or other evidence on whether those terms would be definite to a person of skill in the art at the time the patent was filed. Nor did the district court make any factual assessments or findings on how one of skill in the art would view the claim terms. Rather, the court accepted Oki Data’s argument that allegedly inconsistent positions concerning the phrase “passive link” in the prosecution history of the ’811 patent were sufficient to render that phrase (and the term “computer”) indefinite. *Id.* at 36a–37a.

2. The Federal Circuit affirmed and adopted the district court’s reasoning. Pet. App. 13a–14a, 17a–18a. According to the court of appeals, the claim terms are indefinite because of supposedly conflicting positions taken by Infinity during the prosecution history of the 811’ patent.

The court explained that the term “passive link” does not appear in the initial application for or the specification of the ’811 patent. Pet. App. 5a. Rather, Infinity introduced the term while prosecuting the ’811 patent to distinguish another prior-art reference—namely, U.S. Patent No. 5,452,106 (“*Perkins*”). *Id.* The patent examiner initially rejected the ’811 patent application on the basis that *Perkins*—which discloses use of a fax machine as a scanner or printer—anticipates the application. *Id.* at 5a–6a. As the Federal Circuit

explained, Infinity overcame the rejection by adding the “passive link” language and by explaining that *Perkins* includes an intervening modem (labeled “device 3”) between the fax machine and the computer. *Id.* Unlike the modem in *Perkins*, the passive link in the ’811 patent application does not process the digital data. *Id.* at 6a. Rather, as the court of appeals noted, Infinity had explained to the examiner that the “passive link” in its application conveys data directly. The Federal Circuit focused myopically on Infinity’s statement to the examiner that, in the claimed method, when the digital data is transferred from the fax machine “through a passive link,” 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.” *Id.* at 8a (emphases omitted).

The Federal Circuit contrasted this explanation with other statements that eventually became part of the prosecution history of the ’811 patent. In particular, the court noted that, after it issued, the ’811 patent became the subject of three ex parte reexamination proceedings. Pet. App. 8a. The court of appeals stated that in those reexamination proceedings—which became part of the prosecution history—Infinity had asserted that the telephone cable shown in Figures 2b, 2c, and 2d of the ’278 application disclose the “passive link,” a reading with which the Patent Trial & Appeals Board (“PTAB”) agreed. *Id.* at 9a. The Federal Circuit concluded that these assertions were inconsistent with Infinity’s prior statements over a decade earlier concerning *Perkins* because Figures 2b–d disclose intervening circuitry. *Id.* at 13a–14a. According to the court, the supposedly inconsistent positions taken in the prosecution history meant that “one of ordinary skill cannot

determine with any reasonable certainty” where the passive link ends and the computer begins. *Id.* at 14a.

Although Infinity demonstrated that the sole evidence concerning how a skilled artisan would view the disputed terms came from Infinity’s expert—and he stated that those terms were reasonably certain to a skilled artisan—the court of appeals treated the issue as one of law. See Pet. App. 12a, 16a. The court accordingly dismissed not only the views of Infinity’s expert evidence, but also the construction of “passive link” agreed to and adopted by the PTAB during several *inter partes* review proceedings. Infinity had submitted an expert declaration that explained the appropriate construction of “passive link” is the one adopted by the PTAB, namely a link in which “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.” CAFC JA2975–76 (emphasis omitted).³ According to the Federal Circuit, this definition did not help, even though it is undeniably reasonably certain and therefore not indefinite, because it did not resolve “the extent of the ‘link’” claimed. Pet. App. 16a.

³ Infinity’s expert declaration was prepared in connection with another lawsuit, but Infinity submitted it in this case to demonstrate the views of one of ordinary skill in the art. See CAFC JA2975–79.

REASONS FOR GRANTING THE PETITION**I. CERTIORARI IS WARRANTED BECAUSE THE FEDERAL CIRCUIT'S DECISION IS INCONSISTENT WITH THIS COURT'S PRECEDENTS.**

In *Nautilus*, this Court reinvigorated the requirement of definiteness by adopting an approach that looks to what is reasonably certain to one skilled in the art. The Federal Circuit has overreacted to that decision by finding indefiniteness as a matter of law whenever there is some arguable inconsistency in the prosecution history of a patent. The actual views of those skilled in the art become irrelevant. The effect of that holding imperils the rights of many patent holders. The Court should grant the petition to restore the proper focus to this Court's indefiniteness holding, answer questions that have been previously left open by the Court, and preserve the rights of patent holders.

a. In the decision below, the Federal Circuit held that supposed inconsistencies about the meaning of a claim term in the prosecution history mean the term, and the claim as a whole, are indefinite, regardless of the fact that the only evidence of one skilled in the art established that the term did have a reasonably certain meaning. See Pet. App. 16a; CAFC JA2975–76. The court of appeals' holding is inconsistent with several aspects of this Court's prior decisions.

This Court in *Nautilus* held that § 112, ¶ 2, requires a patent claim to “inform those skilled in the art about the scope of the invention with reasonable certainty.” 572 U.S. at 910. Indeed, the Court emphasized that definiteness must “be evaluated from the perspective of someone skilled in the relevant art.” *Id.* at 908. The “definiteness inquiry trains on the understanding of a skilled artisan at the time of the patent application,

not that of a court viewing matters *post hoc*.” *Id.* at 911.

Although the Federal Circuit paid lip service to the term “ordinarily skilled artisan” in stating its conclusion, the court of appeals completely ignored the views of experts skilled in the arts. Instead, the court reached a legal determination that any arguable inconsistency in the prosecution history renders claim terms, and therefore the claims, indefinite. Pet. App. 13a–14a. Such a wooden rule erects an entirely new category of indefiniteness, one untied to how a skilled artisan would view claim terms. And it falls into the trap of resting entirely on how “a court view[s] matters *post hoc*”—the very evil this Court said the indefiniteness standard should eliminate. *Nautilus*, 572 U.S. at 911.

To be sure, this Court said in *Nautilus* that “claims are to be read in light of the patent’s specification and prosecution history,” *id.* at 908, but using prosecution history in evaluating claims is a far cry from the Federal Circuit’s new standard that the prosecution history alone—irrespective of how skilled artisans may view claim terms—can render claims indefinite as a matter of law. Moreover, the holding below ignores entirely the central inquiry for assessing definiteness, which “trains on the understanding of a skilled artisan at the time of the patent application.” *Id.* at 911. Here, the only evidence concerning the views of a skilled artisan came from Infinity in the form of an expert declaration. That expert explained that the term “passive link” had a “well understood” meaning to those skilled in the art and a reasonably certain definition. CAFC JA2975.

b. Indeed, the Federal Circuit’s failure to evaluate or consider the sole evidence concerning the views of one skilled in the art is flatly inconsistent with this Court’s

earlier precedents. In *United Carbon*, this Court addressed the indefiniteness of patent claims related to carbon black. 317 U.S. at 228–29. To find the claim indefinite, the Court explained that “it is difficult for persons not skilled in the art to measure the inclusions or to appreciate the distinctions which may exist in the words of a claim when read in the context of the art itself.” *Id.* at 233. Accordingly, the Court analyzed the “clearest exposition of the significance which the terms employed in the claims had for those skilled in the art”—namely, the testimony of one of the patentees. *Id.* The Federal Circuit’s decision to ignore the views of a skilled artisan in this case in favor of its own reading of the prosecution history stands in stark contrast to *United Carbon*.

That inconsistency with this Court’s precedent is material because the sole evidence concerning the views of a skilled artisan established that the term “passive link” had more than a reasonably certain meaning. It was well understood. Infinity’s expert explained that the term “is well understood by those skilled in the art as a connection which is not active.” CAFC JA2975. To the extent any construction of the term was necessary, he explained, the term means a link through which “data is transferred, with no intervening apparatus or signal interception by processing element or any active component, along the path of an unbroken direct connection between the PC and the facsimile machine.” CAFC JA2975–76 (emphasis omitted). He stated further that *Perkins* did not disclose a “passive link” because device 3 in *Perkins* included a microprocessor, and a “microprocessor is clearly a processing element” to one of skill in the art. CAFC JA2978. This is entirely consistent with what Infinity said during reexamination—the passive link has “no intervening apparatus or signal interception by a

processing element or any active component.” Pet. App. 9a (emphasis added). The Federal Circuit believed that, in distinguishing *Perkins*, Infinity had defined the passive link as extending to the I/O Bus. *Id.* at 8a–9a. However, the statement highlighted by the Federal Circuit described the data, not the link. It said that when data is transferred through the passive link, that “non-intercepted data enters through the RS 232 type connector port of the computer and passes directly to the I/O Bus.” *Id.* at 8a (emphasis omitted). Had the Federal Circuit followed this Court’s instructions to evaluate definiteness “from the perspective of someone skilled in the relevant art,” the conclusion would have been inescapable that the claims are indeed reasonably certain to a skilled artisan.

The court of appeals refused to address the unrebutted declaration of a skilled artisan because the court believed that evidence to be incompatible with its reading of the prosecution history. Pet. App. 16a. As explained, however, that declaration is not incompatible with the prosecution history. Nonetheless, the Federal Circuit’s approach reflects yet another way in which the decision below is inconsistent with this Court’s case law.

In *Nautilus*, the Court stated that claims should be read in light of a patent’s prosecution history, and to support that principal, the Court cited *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 741 (2002). See *Nautilus*, 572 U.S. at 908. In *Festo*, the Court addressed prosecution history estoppel, explaining that when a patentee “has chosen to narrow a claim” in the prosecution history, “courts may presume the amended text was composed with awareness of this rule” and has surrendered that territory. 535 U.S. at 741. But, the Court made clear that the rule is not absolute; it is a rebuttable presumption. The “patentee

still might rebut the presumption” with evidence from “one skilled in the art.” *Id.* In other words, the Federal Circuit’s approach of using the prosecution history to foreclose inquiry into the views of a skilled artisan is precisely backwards to the approach contemplated by the Court in *Nautilus*.

d. Ultimately, the Federal Circuit’s new approach to indefiniteness serves no good and is inconsistent with the goals of § 112’s indefiniteness requirement. Nothing beneficial comes from encouraging alleged patent infringers to devote their attention to scouring a patent’s prosecution history in search of an apparent inconsistency. This will turn patent litigation into an exercise of “gotcha,” rather than a fair assessment of whether a person of ordinary skill in the art would find the scope of the claims reasonably certain based on the claims, specification, and prosecution history. Such a rule also eliminates the notice to patent holders and the world of the scope of patent claims. Instead, patent owners will be subject to the vagaries of what an alleged infringer may find in the prosecution history, should the owner assert its intellectual property rights. Such a situation muddies the rights of patent holders, which diminishes the incentive to innovate. See *Gen. Elec. Co.*, 304 U.S. at 369; see also *Festo*, 535 U.S. at 730–32.

Certiorari is warranted to resolve the inconsistencies that decision below creates with this Court’s precedent.

II. CERTIORARI IS PARTICULARLY WARRANTED HERE TO ADDRESS THE UNANSWERED QUESTION WHETHER INDEFINITENESS RESTS ON FACTUAL ISSUES THAT MUST BE ESTABLISHED BY CLEAR AND CONVINCING EVIDENCE.

This case presents an unusually powerful case for certiorari because review of the decision below will allow the Court to resolve whether indefiniteness under § 112 rests on factual issues and whether those issues must be proven by clear-and-convincing evidence. In *Nautilus*, the Court held that definiteness under § 112 requires “a patent’s claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty.” 572 U.S. at 910. And the Court emphasized that “the definiteness inquiry trains on the understanding of a skilled artisan.” *Id.* at 911.

The Court, however, declined to address which aspects of the § 112 indefiniteness inquiry are factual or “whether factual findings subsidiary to the ultimate issue of definiteness trigger the clear-and-convincing-evidence standard.” *Id.* at 912 n.10. The Court left those “questions for another day.” *Id.* The day has come to answer these questions.

As this Court has recognized, § 282 of the Patent Act creates a presumption of validity for issued patents. 35 U.S.C. § 282. See *i4i Ltd.*, 564 U.S. at 95. This statute provides that the “burden of establishing invalidity of a patent or any claim ... shall rest on the party asserting such invalidity,” and explicitly lists invalidity under § 112 as one of the defenses subject to its dictates. 35 U.S.C. § 282(a), (b). As the Court has explained, § 282 establishes not only a burden of persuasion, but also a standard of proof—“§ 282 requires an invalidity defense to be proved by clear and convincing evidence.”

564 U.S. at 95, 102. Section 282, therefore, should answer the open questions for indefiniteness.

As the Court has explained elsewhere, “the meaning of a term in the relevant art during the relevant time period” is a question of fact. *Teva*, 574 U.S. at 331–32; see also *id.* at 333 (how a skilled artisan would read a patent figure was an issue of fact subject to clear error review). And that is precisely the central issue in the indefiniteness inquiry: “[d]efiniteness is measured from the viewpoint of a person skilled in [the] art *at the time the patent was filed.*” *Nautilus*, 572 U.S. at 908 (alterations in original). The fact that there may be a factual component that is central to the indefiniteness inquiry does not change its factual nature or the burden under § 282. As the Court has explained “in some instances, a factual finding may be close to dispositive of the ultimate legal question of the proper meaning of the term in the context of the patent.” *Teva*, 574 U.S. at 333.

In the decision below, however, the Federal Circuit treated the inquiry as a purely legal one, simply refusing to consider the only evidence concerning the views of an ordinarily skilled artisan. The Federal Circuit said simply that “[i]ndefiniteness is ultimately a question of law that [it] review[s] *de novo.*” Pet. App. 12a. And the court concluded that its reading of the prosecution history obviated any views of a skilled artisan. *Id.* at 16a. Even if the ultimate issue of indefiniteness is a legal one, this Court has made clear that it rests on particular factual issues, such as the viewpoint of a skilled artisan at the time the patent was filed. *Nautilus*, 572 U.S. at 908. Yet, neither the district court nor the court of appeals inquired into the views of a skilled artisan at the time Infinity filed its patent application. That failure reveals a further problem with the Federal Circuit’s decision—the courts failed to hold Oki

Data to its burdens under § 282. The only evidence from one skilled in the art came from Infinity, not Oki Data, and that evidence showed the disputed terms had a reasonably certain meaning. Oki Data in no way met its burden of establishing invalidity by clear-and-convincing evidence.

Certiorari should be granted because it will permit the Court to resolve the open questions concerning the factual inquiries underlying indefiniteness and the appropriate burden of proof.

CONCLUSION

For the foregoing reasons, the Court should grant the petition for a writ of certiorari.

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