

No. 21-413

**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**

— ♦ —

**BRIEF IN OPPOSITION TO
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). In *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014), this Court made clear that “[a] patent is invalid for indefiniteness if its claims, read in light of the patent’s specification and prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Id.* at 908 (alterations in original). In *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318 (2015), this Court made clear that “[w]hen the district court reviews only evidence intrinsic to the patent, the judge’s determination is solely a determination of law, and the court of appeals will review that construction *de novo*.” *Id.* at 320. In this case, the district court relied solely upon the intrinsic evidence—which evidence on its face presented two contradictory explanations—to find the claims were invalid as indefinite as a matter of law. The Federal Circuit, following this Court’s precedent, reviewed that decision *de novo* and, relying solely upon the contradictory intrinsic evidence, found one of skill in the art could not be reasonably certain as to the scope of the invention. On that basis, the court found the claims invalid as indefinite as a matter of law. Neither court ignored any extrinsic evidence, but instead, both concluded the expert evidence presented did not address the case-specific definiteness question presented. The question presented is:

Whether this Court should grant certiorari when the Federal Circuit relied upon intrinsic

evidence to find patent claims indefinite as a matter of law, in a case where neither party offered extrinsic evidence on the case-specific definiteness issue presented.

RULE 29.6 STATEMENT

Oki Data Americas, Inc. is a wholly-owned subsidiary of Oki Electric Industry Co., Ltd. No other publicly held company owns 10% or more of the stock of Oki Data Americas, Inc.

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INTRODUCTION

The Federal Circuit correctly held Petitioner Infinity’s patent claims invalid as indefinite by applying well-established legal principles to a particularly idiosyncratic record. The decision below followed directly from the language of the Patent Act and this Court’s precedent. There is no split of authority, there was no dissent, and not a single judge voted to rehear the decision *en banc*. Further, the decision below does not “threaten[] to upend all that this Court sought to achieve.” Pet. 2. Instead, it is Infinity’s approach that, if accepted, would overturn decades of jurisprudence and introduce conflict and confusion into the law well beyond the issue of indefiniteness.

The Federal Circuit held the claim terms “passive link” and “computer” indefinite—not because the terms on their own were uncertain—but rather because of the “relationship between the two in the context of these claims.” Pet. App. 18a. This case-specific posture arose from Infinity’s unequivocal response to the district court’s question during the claim construction hearing:

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?*”

Infinity’s counsel: “Yes.”

Pet. App. 10a, n. 2, quoting J.A.3855 (emphasis added).

It is from that case-specific perspective that the Federal Circuit set out to assess whether the “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.” *Nautilus*, 572 U.S. at 910. Because the term “passive link” does not appear in the specification of the patents-in-suit, the court turned to the prosecution history in order to address the question that Infinity itself acknowledged was determinative of definiteness—*i.e.*, whether one skilled in the art could be reasonably certain where the “passive link” ends and the “computer” begins. The prosecution history revealed that Infinity had presented two contradictory explanations that made it impossible for one skilled in the art to be reasonably certain as to where the “passive link” ends and the “computer” begins. Relying solely on the intrinsic evidence, the court concluded the claims were invalid as a matter of law. *Teva*, 574 U.S. at 320.

Infinity erroneously contends that the Federal Circuit ignored Infinity’s expert declaration. The court considered the declaration but found, as is undisputed, the expert declaration does not address whether one of ordinary skill in the art could determine with reasonable certainty where the “passive link” ends and the “computer” begins. This case, therefore, is not a vehicle for answering the question presented by Petitioner. As acknowledged by Petitioner, “Infinity’s expert explained that the term [passive link] ‘is well understood by those skilled in the art *as a connection which is not active*.’” Pet. 14 (emphasis added). The expert provided testimony about how a person of skill in the art would interpret “passive link” but did not, as the court of appeals

explained, address the issue presented—*i.e.*, where the “passive link” ends and the “computer” begins. Pet. App. 16a.

Finally, Infinity’s assertion (Pet. 19) that this case “will permit the Court to resolve the open questions concerning the factual inquiries underlying indefiniteness and the appropriate burden of proof” is similarly misplaced. The burden of proof was not contested or in any way addressed at the court of appeals and, as such, the Court should decline to consider this argument now. *Sisson v. Ruby*, 497 U.S. 358, n.1 (1990).

The petition for a writ of certiorari should be denied.

COUNTERSTATEMENT OF THE CASE

A. The Purported Invention

The original patent application—U.S. Patent Application No. 08/226,278 (“the ‘278 application”)—disclosed a circuit design for simulating a phone network between a personal computer (“PC” or “computer”) and a facsimile machine on the same desk. CAFC JA3353-3401. This circuitry allowed the connected facsimile machine to function as a printer or scanner for the connected computer. *Id.* In a later filed continuation-in-part application (“the CIP application”), Infinity disclosed a new system for connecting a facsimile machine and a computer using a direct connection with no intervening circuitry. CAFC JA80-82, 86 at 6:51-67.

The CIP application led to the issuance of the four patents, each with identical specifications, that claimed this new system: U.S. Patent Nos. 6,894,811 (“the ‘811 patent”), 7,489,423, 8,040,574, and 8,294,915 (collectively, the “patents-in-suit”). The parties agreed that Claim 1 of the ‘811 patent is representative:

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 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.

Pet. App. 2a-3a (emphasis original).

Figures 2a-2e of the patents-in-suit depict the original embodiments disclosed in the '278 application, including their intervening circuitry. Pet. App. 3a. This intervening circuitry is shown, for example, as "Interfacing CKT 10" and "Fax Modem Circuitry 41" in Figure 2b of the Patents-in-Suit:

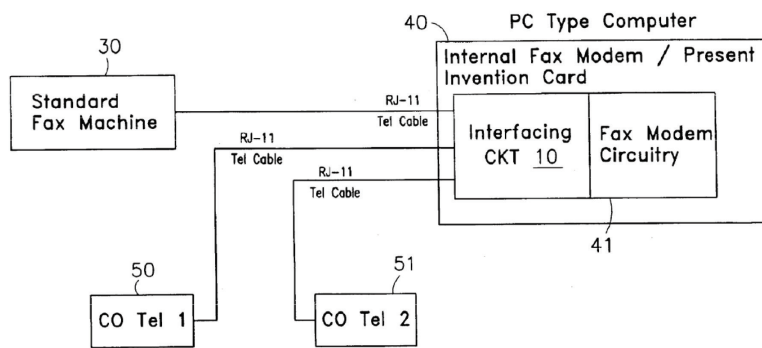


Fig. 2b

Id. at 3a-4a (quoting Fig. 2b of the '811 patent).

Figures 2f-2h of the patents-in-suit depict the new embodiments added by way of the CIP application. In contrast to the original embodiments depicted in Figures 2a-e, the new embodiments, such as that depicted in Figure 2f (below), have no intervening circuitry or apparatus between the facsimile machine and the computer (including inside the computer). *Id.* at 3a-5a; CAFC JA80-82. Instead, the interfacing

circuitry—*e.g.*, “Interfacing CKT 10” and “Fax Modem Circuitry 41”—resides within the facsimile machine. CAFC JA80-82.

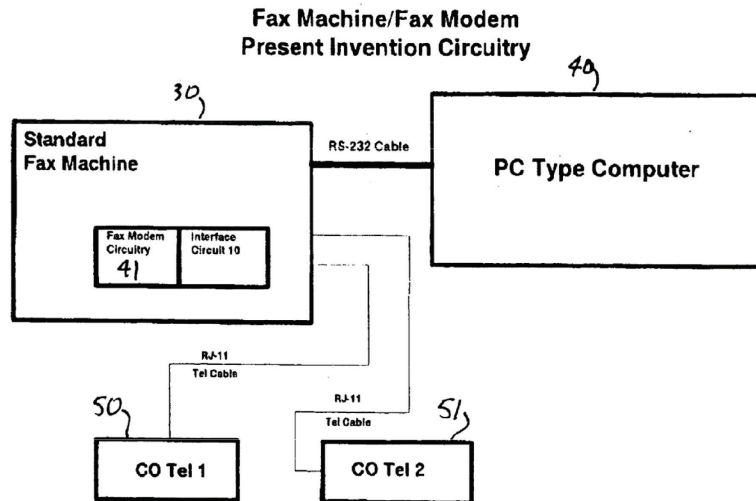


Fig. 2f

Id.; Pet. App. 5a.

B. Prosecution of the Patents-in-Suit

During prosecution, the patent examiner rejected the claim that would ultimately issue as exemplary Claim 1 of the '811 patent on the grounds that it was anticipated by a prior art reference, U.S. Patent No. 5,452,106 (“Perkins”). CAFC JA2124-2132, JA2696-2710. Perkins disclosed intervening circuitry (“device 3”) for connecting a facsimile machine to a computer to allow the facsimile machine to function as a scanner or printer for the computer. Pet. App. 5a-8a. Infinity repeatedly asserted that, unlike Perkins, its new system required no intervening

circuitry between the facsimile machine and the computer. CAFC JA2124-2132, JA2696-2710. The patent office, however, rejected that distinction, noting that Perkins disclosed that its device could be installed on a card *inside* the computer. Pet. App. 6a.

Infinity attempted multiple times to distinguish Perkins on a variety of grounds, including arguing that Perkins' device used analog instead of digital communications, and used a variety of electronic components not present in Infinity's embodiments. *Id.* at 5a-7a, 17a; CAFC JA1304-1309, JA1233-36, JA2155-2161, JA2196-2202, JA4213-4219. The patent examiner, however, maintained that such arguments failed to distinguish the claimed subject matter. *See, e.g.*, CAFC JA3440-3445; JA4195-4203; Pet. App. 6a, 17a (quoting CAFC JA1992).

To overcome the rejection, Infinity amended the claims to require a "passive link" between the computer and the facsimile machine, asserting:

When Perkins places his device 3 on a card internal to the computer, the same process noted above occurs. In this 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' device 3 intercepts the flow of data before it is transmitted to the computer circuits, in order to achieve the proper 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.

CAFC JA2201 (emphasis added); Pet. App. 7a-8a. In doing so, Infinity defined the end point of the passive link and the beginning of the computer as the computer's I/O bus. *Id.* To avoid any confusion, the applicant explained further that the so-defined "passive link" was shown in "Figures 2F, 2G, and 2H"—*i.e.*, the new embodiments added by the CIP application. CAFC JA2196-97.

During a subsequent reexamination of the '811 patent, however, Infinity took a contradictory position. In order to antedate a different prior art reference (U.S. Patent No. 5,900,947, "Kenmochi"), Infinity sought to claim the benefit of the '278 application. Pet. App. 8a-9a. To do so, Infinity asserted that an original embodiment depicted in Figure 2b of the '278 application (and reproduced in the '811 patent)—an embodiment having intervening circuitry and fax modem located between the facsimile machine and the I/O bus of the computer and installed within the box of the computer—nonetheless embodied a "passive link." *See, e.g.*, CAFC JA4721. In support of this position, Infinity submitted an expert declaration to the patent office opining that Figures 2b-2d of the original '278 application disclose a "passive link." Pet. App. 9a. The patent office did not address the conflict between Infinity's new position and the prior position distinguishing Perkins. *Id.* at 9a-10a.

C. Proceedings in the District Court

The parties did not dispute the meaning of “passive link” or “computer” in isolation. Instead, the definiteness inquiry regarding these terms was focused on the interrelationship of the “passive link” and the “computer.” During the *Markman* hearing, Infinity acknowledged that for the claims to be definite, “*one of skill in the art would need to be reasonably certain where the passive link ends and the computer begins.*” Pet. App. 10a, n. 2, quoting CAFC JA3855 (emphasis added).

Infinity submitted an expert declaration in support of its claim construction positions, which included an unsupported and conclusory opinion that the term “‘passive link’ . . . is well understood by those skilled in the art *as a connection which is not active.*”¹ Pet. 14 (emphasis added). In the alternative, the expert stated that a person of skill in the art would use the definition offered by Infinity during prosecution. Pet. App. 16a. But this definition was silent on the question that Infinity acknowledged was determinative of definiteness—*i.e.*, whether one of skill in the art could be reasonably certain *where the passive link ends and the computer begins.* *Id.*

The district court found that “Oki Data . . . met its burden to show indefiniteness by clear and convincing evidence” (Pet. App. 36a), because “a person

¹ Infinity’s expert declaration was originally drafted to respond to a declaration that was offered in a separate litigation (to which Oki Data was not a party) by an expert who never appeared in this case, and as such, Infinity’s expert declaration is primarily directed to issues that were not raised in this case. *See, e.g.*, Pet. 11, note 3; CAFC JA2957-2995.

of ordinary skill in the art would not be reasonably certain as to which of Infinity’s two inconsistent definitions of ‘passive link’ is used in the claims, rendering the claims indefinite.” Pet. App. 36a-37a. It determined that Infinity’s argument during the original prosecution of the ‘811 patent—that the Perkins device 3 located inside the computer was part of the passive link—conflicted with its later argument during reexamination that intervening circuitry and a fax modem inside the computer was not part of the passive link. *Id.* The court likewise found that “[g]iven 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.” *Id.* at 39a. The court recognized that “expert testimony can be useful ‘. . . to establish that a particular term in the patent or the prior art has a particular meaning in the pertinent field,” but also stated 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.” Pet. App. 28a-29a.

D. Proceedings in the Court of Appeals

The Federal Circuit reviewed the district court’s decision *de novo*, recognizing that the lower court’s determination was “ultimately” a question of law. *Id.* at 12a. Infinity had confirmed the proper standard of review in its opening brief, stating:

The district court’s constructions of “passive link” and “computer” are reviewed *de novo* under *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 135

S. Ct. 831, 834 (2015), because the court reviewed and cited only to evidence intrinsic to the Infinity Patents and did not make factual findings about any disputed subsidiary facts based on extrinsic evidence in construing the term. See generally Appx 28-41.

CAFC Opening Brief for Plaintiff-Appellant at 25 (underline emphasis added).

Following this Court’s decision in *Nautilus*, the court of appeals set out the proper standard for indefiniteness: “[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.” Pet. App. 11a.

The Federal Circuit confirmed the unusual nature of the claim construction issues in this case, noting that “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.” The court noted that while “in a vacuum, it might seem odd to hold ‘computer’ indefinite,” because those terms by themselves may be understood by a person of skill in the art, that “strangeness stems from Infinity’s own statements.” *Id.* Under the particular circumstances of this case, for the claims to be definite, “Infinity agrees that one of ordinary skill would need to be reasonably certain where the passive link ends and where the computer begins.” *Id.* at 18a.

The Federal Circuit found that Infinity “took conflicting positions during prosecution regarding the

scope of ‘passive link.’” *Id.* at 13a. In the first instance, to overcome the rejection over the Perkins prior art reference, 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.” *Id.* In the second instance, to antedate the Kenmochi prior art reference during reexamination, “Infinity reversed course,” arguing that the “passive link” is “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.’” *Id.* at 13a-14a.

The court considered the expert testimony proffered by Infinity, but found it unhelpful. *Id.* at 16a. The court confirmed Infinity’s alleged “unrebutted expert testimony” . . . merely states that ‘passive link’ needs no construction and, in the alternative, that it should be construed according to the unhelpful definition [offered after the patentee had distinguished Perkins].” *Id.* That “unhelpful definition” characterized the passive link by its function while failing to “resolve the point in question: the extent of the ‘link’”—*i.e.*, *where the passive link ends and the computer begins*. The court concluded:

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 1342 (“The internal coherence and context assessment of the patent, and whether it conveys claim meaning with reasonable certainty, are questions of law.”).

Id. In affirming the district court’s determination, the Federal Circuit stated: “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.*” *Id.* at 14a (emphasis added).

REASONS FOR DENYING THE PETITION

I. THE COURT OF APPEALS’ HOLDING FOLLOWS DIRECTLY FROM GOVERNING PRECEDENT

The Court should deny certiorari. The decision below follows this Court’s precedent, the petition is premised on misstatements of fact, and the particular facts of this case make it the wrong vehicle for the questions presented in the petition.

1. Section 112 of 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 his invention.” 35 U.S.C. § 112 ¶ 2 (2010).² “The patent laws have retained this requirement of definiteness” since the enactment of the first Patent Act in 1790. *Nautilus*, 572 U.S. at 901–02. This Court has recognized in an unbroken line of authority extending back more than a century that the definiteness requirement serves a critical purpose: it ensures that the patent “inform[s] the public . . . of the limits of the monopoly asserted, so that it may be known which features may

² The pre-America Invents Act statute applies to the patents at issue by virtue of their priority date. The post-AIA version of § 112 contains identical language. See 35 U.S.C. § 112(b) (AIA).

be safely used or manufactured without a license and which may not.” *Permutit Co. v. Graver Corp.*, 284 U.S. 52, 60 (1931) (citing *Merrill v. Yeomans*, 94 U.S. 568, 573 (1876)). “[A] patent must be precise enough to afford clear notice of what is claimed, thereby ‘appris[ing] the public of what is still open to them.’” *Nautilus*, 572 U.S. at 909 (quoting *Markman v. Westview Instruments*, 517 U.S. 370, 373 (1996)). If unable to discern the boundaries of the claims with reasonable certainty, the skilled artisan is faced with “a zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims.” *Nautilus*, 572 U.S. 909–10 (quoting *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942)).

The issue of indefiniteness in this case is uniquely fact bound. The Federal Circuit recognized that “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.” Pet. App. 18a. The Federal Circuit did not come to this understanding of its own accord, but rather Infinity expressly acknowledged this during the claim construction hearing before the district court:

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.”

Pet. App. 10a, n. 2, quoting J.A.3855 (emphasis added). The court’s question was clear and Infinity’s

response was unequivocal. Thus, the particular indefiniteness issue to be resolved in this case turned on whether one of skill in the art can be reasonably certain where the “passive link” ends and the “computer” begins. If not, Infinity expressly acknowledged the claims would be indefinite.

Contrary to Infinity’s assertion (*see, e.g.*, Pet. 13), the Federal Circuit did not impose a “new standard” or take a “new approach” by relying upon the prosecution history in the determination of indefiniteness. Pet. 9, 13, 15, 16. Under *Nautilus*, § 112 requires 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.” 572 U.S. at 910. “The definiteness requirement, so understood, mandates clarity, while recognizing that absolute precision is unattainable.” *Id.*

The Federal Circuit faithfully applied the legal standards this Court provided in *Nautilus* and *Teva*. Because the term “passive link” does not appear in the specification, the Federal Circuit properly turned to the prosecution history to address the question that Infinity itself acknowledged was determinative of definiteness—*i.e.*, “*where the passive link ends and the computer begins.*” Following this Court’s precedent, the Federal Circuit relied on the assertions the patent applicant made to distinguish the Perkins prior art during prosecution and secure allowance of the claims, concluding that the applicant’s “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.” Pet. App. 13a (emphasis added). The court concluded this was

particularly so “[g]iven the role of the statement in gaining allowance of the claims.” *Id.* (quoting *Teva*, 789 F.3d at 1344).³ The Court next relied on Infinity’s assertions made to antedate a second prior art reference during reexamination (Kenmochi), concluding Infinity’s “argument would lead one of ordinary skill to believe a ‘passive link’ ends at the computer’s port.” *Id.* at 14a (underline emphasis added). Applying the *Nautilus* standard, the court found “holding Infinity to both positions results in a flat contradiction, providing no notice to the public of ‘what is still open to them.’” *Id.* citing *Nautilus*, 572 U.S. at 909.

On the record before it, the Federal Circuit properly concluded that “the intrinsic evidence leaves an ordinarily skilled artisan without reasonable certainty as to where the passive link ends and the computer begins.” *Id.*

2. Infinity’s effort to immunize patent holders from what it characterizes as “the vagaries of what an alleged infringer may find in the prosecution history” (Pet. 16) would upend more than a century’s worth of

³ “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.” Pet. App. 12a. (citing *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 789 F.3d 1335 (Fed. Cir. 2015) (“*Teva II*”). In *Teva II*, on remand from this Court’s decision in *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318 (2015), the Federal Circuit held that “[a] party cannot transform into a factual matter the internal coherence and context assessment of the patent simply by having an expert offer an opinion on it. The internal coherence and context assessment of the patent, and whether it conveys claim meaning with reasonable certainty, are questions of law.” 789 F.3d at 1342. There is no intracircuit conflict on this point as Infinity has raised no conflicting decisions.

precedent from this Court. This Court has consistently heralded the importance of a patent’s prosecution history for understanding the meaning of its claims. It has done so not just in the context of indefiniteness, but also in cases spanning the full spectrum of patent law issues, including *inter alia* the doctrine of equivalents, obviousness and reissue. *See, e.g., Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 741 (2002) (“the interpretation of the patent must begin with its literal claims, and the prosecution history is relevant to construing those claims”); *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 33 (1966) (“Claims as allowed must be read and interpreted with reference to rejected ones and to the state of the prior art; and claims that have been narrowed in order to obtain the issuance of a patent by distinguishing the prior art cannot be sustained to cover that which was previously by limitation eliminated from the patent.”); *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 227 (1880) (“it is reasonable to hold that such a construction may be confirmed by what the patentee said when he was making his application.”).

Contrary to Infinity’s assertions (Pet. 16), holding patent applicants to statements made to secure allowance of claims and issuance of patents is not an exercise of “gotcha.” Patent applicants have a statutory obligation to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. 35 U.S.C. 112, ¶ 2. Those applicants have the unique position of controlling what is said to the patent examiner during prosecution. With such control, it is incumbent upon applicants to ensure that their own statements do not create “vagaries” sufficient to prevent a person of skill in the art from

understanding their patent claims with reasonable certainty.

Nothing in *Nautilus* requires the Court to overturn its long-held jurisprudence regarding the importance of the prosecution history in construing claims. To the contrary, *Nautilus* made clear that “in assessing definiteness, claims are to be read in light of the patent’s . . . prosecution history.” *Nautilus*, 572 U.S. at 908. Infinity’s effort to absolve patent applicants from contradictory statements made to achieve issuance of a patent would create exactly the kind of uncertainty this Court has sought to prevent.

3. Infinity misleadingly asserts that the Federal Circuit ignored “unrebutted expert testimony.” *See, e.g.*, Pet. 2, 15. This is not true. In reality, Infinity offered no expert testimony on the issue that Infinity itself acknowledged was determinative of definiteness—*i.e.*, whether one of skill in the art can be reasonably certain where the passive link ends and the computer begins.

Furthermore, this Court made clear that definiteness is to be measured as of the time of the patent application. *Nautilus*, 572 U.S. at 899. While Infinity complains that the Federal Circuit failed to consider evidence of “whether those terms would be definite to a person of skill in the art at the time the patent was filed” (*e.g.*, Pet. 3, 6, 9, 12, 13, 18), the expert declaration offered by Infinity *was not* directed to “the time the patent was filed.” CAFC JA2975. Thus, the declaration is not relevant under *Nautilus*.

In addition to that defect, the allegedly “unrebutted expert testimony” that Infinity relies upon—

an expert declaration from a different litigation—merely stated that the term “passive link” required “no construction as this is well understood by those skilled in the art as a connection which is not active.” Pet. 14; Pet. App. 16a; CAFC JA2975. Aside from being conclusory, Infinity’s expert declaration failed to address where the passive link ends and the computer begins, much less whether one of skill in the art could be reasonably certain where the passive link ends and the computer begins. The expert declaration stated further, in the alternative, that should the court deem that construction was required, the term “passive link” should be construed in accordance with the “unhelpful” definition provided during reexamination. Pet. App. 16a. That definition, which is quoted in the decision below (*id.*), failed to address where the passive link ends and the computer begins. As such, the Federal Circuit properly recognized that the only definition for “passive link” provided in the expert’s declaration “does not resolve the point in question: the extent of the ‘link.’” *Id.*

The Federal Circuit did not ignore any expert evidence relevant to the definiteness inquiry under *Nautilus* for the simple reason that Infinity offered no expert evidence on the question that Infinity itself acknowledged was determinative of definiteness: whether one of skill in the art can be reasonably certain where the passive link ends and the computer begins.

4. Infinity incorrectly asserts that the allegedly ignored testimony was “the sole evidence concerning the views of one skilled in the art.” *See, e.g.*, Pet. 2, 4, 11, 13, 14. This is false. Infinity’s expert declaration was the only *extrinsic* evidence offered, but as noted

above, it fails to address whether one of skill in the art can be reasonably certain where the passive link ends and the computer begins. Pet. App. 16a. The court of appeals and the district court therefore relied exclusively on the *intrinsic* evidence—*i.e.*, the prosecution history, and in particular, the contradictory positions Infinity took concerning the extent of the passive link—to resolve the issue. Those contradictory positions, on their face, made it impossible for one of skill in the art to be reasonably certain where the passive link ends and the computer begins. Thus, the indefiniteness of the claims was based exclusively upon the intrinsic evidence, rendering that decision “solely a determination of law.” *Teva*, 574 U.S. at 320.

5. Respectful of this Court’s warning in *Nautilus*, the court of appeals expressly resisted “viewing matters *post hoc*” to “ascribe some meaning” to the claims. Pet. App. 15a. Instead, the court took both of Infinity’s irreconcilably conflicting positions at face value, confirming the “contradictory positions are plain from the patent record, thereby obviating the need to resort to ‘extrinsic evidence.’” *Id.* at 16a (citing *Teva II*, 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.”)); *Teva*, 574 U.S. at 320.

Thus, the decision below follows directly from this Court’s precedent and the petition for writ of certiorari should be denied.

II. THE DECISION BELOW DOES NOT PRESENT ANY ISSUE THE *NAUTILUS* COURT LEFT UNANSWERED

Infinity argues that the Court should grant certiorari to address whether factual issues related to an indefiniteness analysis must be proven by clear and convincing evidence. Pet. 17. The unique facts and circumstances of this case, however, make it a particularly poor vehicle for resolving that question because the issue was not briefed or addressed at the Federal Circuit, the parties have previously agreed that the district court's decision did not involve such findings of fact and, regardless, the district court already required Oki Data to prove indefiniteness by clear and convincing evidence.

1. The decision below does not address the issue of the proper burden of proof, because the burden of proof, or whether Oki Data met that burden, was not addressed on appeal. The Court should decline to consider this argument “because it was not raised below.” *Sisson*, 497 U.S. at 358, n.1.

2. Nonetheless, the issue of indefiniteness in this case neither involved nor turned on fact finding by the lower courts. Infinity criticizes the Federal Circuit for treating the indefiniteness inquiry in this case “as a purely legal one.” Yet that is precisely how Infinity represented it should be treated by the Federal Circuit:

The district court's constructions of ‘passive link’ and ‘computer’ are reviewed *de novo* under *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 834 (2015), because the court reviewed

and cited only to evidence intrinsic to the Infinity Patents and did not make factual findings about any disputed subsidiary facts based on extrinsic evidence in construing the term. See generally Appx 28-41.

CAFC Opening Brief for Plaintiff-Appellant at 25 (underline emphasis added). Now, after the Federal Circuit affirmed the district court's decision, Infinity reverses course and argues that Federal Circuit erred by applying the standard of review that it requested, and that the issue of indefiniteness should have been resolved on factual grounds. Infinity should not be permitted to approbate and reprobate during the course of the same litigation. The Court should view such oscillations with skepticism.

In accord with *Nautilus*, both of the lower courts relied upon the patent applicant's statements in the prosecution history to address the question Infinity itself acknowledged was determinative of definiteness: whether one of skill in the art can be reasonably certain where the passive link ends and the computer begins. 572 U.S. at 910. The district court found that Infinity's contradictory statements rendered the claims indefinite to a person of skill in the art. The Federal Circuit performed its *de novo* review and likewise concluded "the intrinsic evidence leaves an ordinarily skilled artisan without reasonable certainty as to where the passive link ends and the computer begins." Pet. App. 14a. In accordance with this Court's holding in *Teva*, indefiniteness based only upon the intrinsic evidence is "solely a determination of law." 574 U.S. at 320.

Moreover, even if one assumes *arguendo* that the district court engaged in fact finding, despite Infinity's acknowledgement that it did not, the decisions below make clear that the district court and the court of appeals applied the clear-and-convincing evidentiary burden. The district court expressly held that "Oki Data has met its burden to show indefiniteness by clear and convincing evidence." Pet. App. 36a. The Federal Circuit affirmed the district court's decision. Pet. App. 1a-2a.

As such, this case is the wrong vehicle to address the so-called "unanswered question" of whether factual findings supporting an indefiniteness ruling must be established by clear and convincing evidence.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted,

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