

No. 21-413

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IN THE  
**Supreme Court of the United States**

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INFINITY COMPUTER PRODUCTS, INC.,  
*Petitioner,*

v.

OKI DATA AMERICAS, INC.,  
*Respondent.*

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

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**REPLY BRIEF**

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ANDREW G. DI NOVO  
NICOLE E. GLAUSER  
DI NOVO PRICE LLP  
7000 N. MoPac  
Expressway, Suite 350  
Austin, TX 78731  
(512) 539-2626

CARTER G. PHILLIPS\*  
RYAN C. MORRIS  
SIDLEY AUSTIN LLP  
1501 K Street, N.W.  
Washington, D.C. 20005  
(202) 736-8000  
cphillips@sidley.com

*Counsel for Petitioner*

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\* Counsel of Record

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## REPLY BRIEF

Respondent's Brief in Opposition ("Opp.") attempts to confuse issues and muddy the waters, but it offers nothing to diminish the need for this Court's review of the decision below.

In *Nautilus, Inc. v. Biosig Instruments, Inc.*, the Court rehabilitated the indefiniteness doctrine in 35 U.S.C. § 112, articulating a test that preserves the "delicate balance" in § 112. 572 U.S. 898, 909 (2014) (quoting *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002)). That test requires courts to evaluate whether patent claims are sufficiently definite "from the perspective of someone skilled in the relevant art." *Id.* at 908.

Overreacting to this Court's correction, the Federal Circuit has now shunted away the core of *Nautilus*. According to the decision below, courts can ignore the perspective of someone skilled in the art to find patent claims indefinite as a matter of law if there is any imagined inconsistency in the patent's prosecution history. See Pet. 12–14. This holding not only upsets the Court's delicate balance for indefiniteness, but it erects a rule that is ripe for abuse. See *id.* at 16.

Respondent does not dispute that the Federal Circuit ruled solely on the basis of the patent's prosecution history, or that it did so purely as a matter of law. See Opp. 15–16 & n.3, 22. Instead, respondent says this case is a poor vehicle because it is fact bound. But indefiniteness will always arise "in the context of [particular patent] claims." *Id.* at 14 (quoting Pet. App. 18a). That does not make the case a bad vehicle. At bottom, the courts below held that common terms such as "computer" and "passive link" invalidate a patent when the record is clear that everyone skilled in the

art knew and knows what they mean. The lower courts simply ignored the sole evidence of one skilled in the art based on their own reading of the prosecution history.

Respondent also argues that the Federal Circuit justifiably ignored the only evidence of someone skilled in the art because that evidence did not address where the “passive link” ends and the computer begins in the invention. This is a strawman.

The patent specification explicitly defines the “computer” and indicates that the passive link ends at the computer’s port. The only remaining question concerned the meaning of “passive link.” On that, the sole evidence came from Infinity’s expert, who explained that the term was well-understood by skilled artisans. The Federal Circuit’s only basis for ignoring that evidence was its view that a supposed isolated inconsistency in the prosecution history overrode any other consideration as a matter of law. Such a view stands in stark contrast to the Court’s approach in cases such as *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228 (1942)—a case respondent fails even to address.

Ultimately, the Federal Circuit’s rule that courts can ignore the views of a skilled artisan if there is a supposed inconsistency in the prosecution history is inconsistent with this Court’s precedent. It also produces absurd results. The Patent Trial and Appeal Board (“PTAB”) evaluated the same expert testimony at issue here and had no trouble understanding the scope of the invention with reasonable certainty. Yet, the Federal Circuit’s new indefiniteness rule allows courts to disregard that history and the views of skilled artisans to reach its own legal conclusion.

This is a particularly compelling case for certiorari because it would allow the Court to address questions

previously left open in *Nautilus*—namely, whether indefiniteness rests on factual issues and whether those issues must be proven by clear-and-convincing evidence. Respondent argues that this case is a poor vehicle to resolve those issues because they were supposedly not raised or presented. But these issues are antecedent issues to the question presented. And contrary to respondent’s contention, Infinity did not concede that the indefiniteness inquiry is a purely legal one. Respondent quotes Infinity’s articulation of the standard for *claim construction*, not indefiniteness. Infinity made clear below that respondent had the “heavy burden to show by clear and convincing evidence that all of the patent claims are indefinite.” CAFC Opening Br. 26.

The Court should grant the petition.

**I. THE FEDERAL CIRCUIT’S DECISION  
ERECTS A NEW RULE THAT IS INCON-  
SISTENT WITH THIS COURT’S PRECE-  
DENTS.**

Certiorari is warranted because the decision below establishes a new methodology for determining indefiniteness under § 112 that is inconsistent with this Court’s precedents. Pet. 12–14. According to this new approach, courts can disregard “the perspective of someone skilled in the relevant art,” *Nautilus*, 572 U.S. at 908, to declare patent claims indefinite as a matter of law if there is an arguable inconsistency in the prosecution history. Pet. 13. The refusal to consider the only evidence in this case on the views of a skilled artisan not only contravenes this Court’s instructions in *Nautilus*, but also it stands in stark contrast to the Court’s approach in cases like *United Carbon*, 317 U.S. 228. Pet. 13–14. Moreover, making any ambiguity in a decades-long prosecution history a legal trump card is especially pernicious because it turns

patent litigation into a game of “gotcha.” *Id.* at 16. Respondent’s counterarguments are unavailing.

Respondent suggests that the Federal Circuit did not establish a new approach in this case and that the case is “uniquely fact bound.” Opp. 14; *id.* at 1. But indefiniteness always arises “in the context of [certain patent] claims,” *id.* at 1, 14 (quoting Pet. App. 18a); that does not make it uniquely fact bound. Nor does the particular nature of the indefiniteness issue here alter the fact that the Federal Circuit held courts could ignore the only views of skilled artisans if there is an imagined inconsistency in the prosecution history. Pet. 13.

Respondent asserts repeatedly that the indefiniteness question here turns on where the passive link ends and computer begins, and that this somehow makes the case unique. See Opp. 14–15; *id.* at 1–2, 9, 12–13, 18–19. This is a strawman. The ’811 patent explicitly defines the computer as “any type of computer (including but not limited to an Apple Macintosh, IBM PC, PCAT or PCXT),” CAFC JA85, and consistently teaches that the connection between the facsimile and computer extends to the computer’s port—that is, terminates at the computer’s port.<sup>1</sup> Because the patent does not explicitly define the term “passive link,” the only open question concerned the meaning of that term, which the sole expert evidence established was a term “well understood by those skilled in the art as a connection which is not active.” CAFC JA2975. Accordingly, to one skilled in the art, the passive link—

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<sup>1</sup> See CAFC JA88 (“connected to an appropriate receiving port of a computer”); *id.* (“using a [computer’s] digital connector port”); *id.* (“connector ports to interface”); CAFC JA89 (“passive link between ... facsimile machine and [computer’s] digital connector port”); see CAFC JA87 (describing RS 232 “interconnect port” at the computer).

an inactive connection—terminates at the computer port. See CAFC JA2976 (“modulation procedure within the PC ... does not” change meaning of “passive link”).

Respondent, the district court, and the Federal Circuit bypassed the patent claims, specification, and “perspective of someone skilled in the relevant art,” *Nautilus*, 572 U.S. at 908, solely by concluding that a supposed inconsistency in the prosecution history overrode any other consideration as a matter of law. See Pet. App. 13a–14a, 20a–22a, 34a–35a, 39a. In other words, they began by reaching a conclusion about the prosecution history and then viewed all else through the prism of that conclusion. And it is respondent’s view of the prosecution history—not any acknowledgment from Infinity—that supposedly creates a question about where the passive link ends and computer begins. Infinity’s counsel agreed that a skilled artisan would need to know where the passive link ends and computer begins, see Opp. 1, 14–15, because those are components in the claims. That, however, did not mean a skilled artisan would not know those limits with reasonable certainty. Quite the contrary. See *supra*, 4–5. Indeed, the PTAB, which accepted the meaning of “passive link” from Infinity’s expert, had no trouble ascertaining the boundaries of the invention with reasonable certainty. See CAFC JA2686–93.

For similar reasons, respondent’s effort to excuse the fact that the Federal Circuit ignored un rebutted expert evidence fails. Respondent contends that the Federal Circuit could ignore Infinity’s expert testimony because that testimony did not explicitly address “where the passive link ends and the computer begins.” Opp. 18–20. As explained, however, the declaration of Infinity’s expert bore directly upon whether a skilled artisan would know what the term “passive



link” means, the patent claims and specification explained where the passive link ends, and so a skilled artisan would know where that link ends and the computer begins. See *supra*, 4–5.

Moreover, that expert declaration explained why there is in fact no conflict in the prosecution history and respondent’s view is wrong “from the perspective of someone skilled in the relevant art.” *Nautilus*, 572 U.S. at 908. The declaration makes clear that, in distinguishing *Perkins*, Infinity did *not* suggest that the passive link extends to the I/O bus in the computer; rather, the *data*—not the link—passes directly to the I/O bus. See Pet. 14–15. Respondent has no rebuttal. This and the Federal Circuit’s decision to ignore the views of someone of ordinary skill in the art is inconsistent with this Court’s approach in *United Carbon*, 317 U.S. 228. See Pet. 13–14. Respondent has no response to *United Carbon*, failing to discuss it at all and referencing it only in a parenthetical. See Opp. 14.

Respondent says the Federal Circuit justifiably ignored the only views of a skilled artisan because “definiteness is to be measured as of the time of the patent application” and “the expert declaration offered by Infinity *was not* directed to ‘the time the patent was filed.’” Opp. 18. Respondent is flatly wrong. Infinity’s expert based his opinions on “the level of ordinary skill in this art *at the time of filing* of the claims of the ... ’811 patent family.” CAFC JA2965 (emphasis added); see CAFC JA2964 (same). The declaration is plainly “relevant under *Nautilus*.” Opp. 18. And in adopting respondent’s view that its own reading of the prosecution history could establish indefiniteness as a matter

of law, the Federal Circuit contravened this Court’s precedents. Pet. 12–14.<sup>2</sup>

According to respondent, the Federal Circuit did nothing wrong because the Court in *Nautilus* said that the claims may be “read in light of the patent’s ... prosecution history,” Opp. 18, and because the Court has approved the use of prosecution in a variety of contexts, *id.* at 17. However, it is one thing to consult the prosecution history, in connection with the claims and specification, as part of an inquiry into whether a skilled artisan would understand the claims with reasonable certainty, and it is something else entirely to hold, as the Federal Circuit did, that the prosecution history alone can render claims indefinite as a matter of law. Pet. 13. Nothing in *Nautilus* suggests that the prosecution history can be used as a legal ace in the hole. Rather, the Court emphasized that “definiteness is to be evaluated from the perspective of someone skilled in the relevant art.” *Nautilus*, 572 U.S. at 908. Nor do respondent’s other cases suggest that the prosecution history is legally dispositive, regardless of other considerations. See *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 33 (1966); *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 227 (1880).

As the petition demonstrated, moreover, not even prosecution history estoppel—perhaps the strongest use of prosecution history—is absolute. Pet. 15. As this Court explained in *Festo Corp.*, 535 U.S. 722, prosecution history estoppel merely establishes a presumption

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<sup>2</sup> Respondent argues that the Federal Circuit did not ignore all evidence, because the court did consider the “intrinsic” evidence, namely the prosecution history. Opp. 19–20. But the only evidence concerning “the perspective of someone skilled in the relevant art,” *Nautilus*, 572 U.S. at 908, was Infinity’s expert declaration. Intrinsic evidence does not necessarily reveal the views of a skilled artisan.

that is rebuttable with evidence from “one skilled in the art.” *Id.* at 741. The Court in *Nautilus* referenced *Festo* in approving the use of prosecution history, and this confirms the Federal Circuit’s elevation of prosecution history as legally conclusive for indefiniteness is inconsistent with this Court’s precedents. Pet. 15–16. Respondent has no response.

If the Federal Circuit’s new rule in this case is allowed to stand, it will surely turn patent litigation into a game of “gotcha.” Pet. 16; contra Opp. 16, 17. The Court’s perspective-of-a-skilled-artisan standard offers some objective measure by which patent holders and the public may understand the boundaries of an invention. But giving alleged infringers a means to have a patent declared indefinite as a matter of law based on imagined inconsistencies in the prosecution history offers no meaningful measure—only the ingenuity of the alleged infringer and the vagaries of what it may find. Pet. 16.<sup>3</sup>

## **II. THIS CASE WILL ALLOW THE COURT TO ADDRESS A QUESTION LEFT OPEN BY NAUTILUS.**

Certiorari is particularly warranted in this case because it will give the Court an opportunity to resolve whether indefiniteness under § 112 rests on factual issues and whether those issues must be proven by clear-and-convincing evidence. Pet. 17. In *Nautilus*, this Court left those questions “for another day,” 572 U.S. at 912 n.10, and this case heralds that day. A core inquiry in assessing indefiniteness under *Nautilus* is

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<sup>3</sup> Respondent says it is incumbent on patent holders to avoid creating vagaries in the prosecution history. Opp. 17. But language is “inherent[ly] limit[ed],” and there will always be “[s]ome modicum of uncertainty.” *Nautilus*, 572 U.S. at 909. That is true of the prosecution history as much as the claims.

a factual one, and this Court has made clear that such factual issues must be established by clear-and-convincing evidence to find patent claims invalid. Pet. 17–18. However, the Federal Circuit in the decision below treated the inquiry as a purely legal one, refusing to consider the only views of a person of ordinary skill in the art and failing to hold respondent to its clear-and-convincing burden. *Id.* at 18. Respondent contends that this case is an inappropriate vehicle to answer the questions left open in *Nautilus*, but it is wrong.

Respondent suggests that the Court should decline to address this issue because it was not raised below or decided by the court of appeals. Opp. 21. But whether a factual issue underlies indefiniteness and what the burden of proof is are issues “antecedent” to the question presented, precisely the kind of issues this Court has addressed in the past whether raised below or not. *U.S. Nat’l Bank of Or. v. Indep. Ins. Agents of Am., Inc.*, 508 U.S. 439, 447 (1993); see *Arctadia v. Ohio Power Co.*, 498 U.S. 73, 77 (1990) (addressing antecedent question).

Respondent also argues that Infinity should not be allowed to question whether the issue is a purely legal one because Infinity’s appellate brief below indicated that the question was purely one of law. Opp. 21–22; *id.* at 10–11. But this argument rests on a lengthy quotation of the standard of review for claim construction, not indefiniteness. Infinity’s Federal Circuit brief stated explicitly that respondent has the “heavy burden to show by clear and convincing evidence that all of the patent claims are indefinite.” CAFC Opening Br. 26. Infinity also argued that the district court erred by, among other things, “disregarding the only expert testimony of record.” *Id.* Infinity has not “oscillat[ed].” Opp. 22.

According to respondent, treating indefiniteness as a purely legal issue was appropriate because the Federal Circuit merely followed this Court’s guidance in *Teva* that construing the “intrinsic evidence is ‘solely a determination of law.’” Opp. 22 (quoting *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318, 320 (2015)). Once again, respondent confuses claim construction and indefiniteness. In *Teva*, the Court explained that when construing a claim term, “the judge’s determination will amount solely to a determination of law” “when the district court reviews only evidence intrinsic to the patent (the patent claims and specifications, along with the patent’s prosecution history).” 574 U.S. at 331. But *Teva* did not purport to announce an overarching principle for all uses of prosecution history. Rather, it concerned the principles applicable when a court is construing a particular patent claim—that is, “a district court’s interpretation of a written instrument” to arrive at the authoritative meaning of that term. *Id.* While claim construction often influences indefiniteness, this Court has made clear that indefiniteness is not about trying to derive the authoritative construction of a term. It is about whether patent claims “inform those skilled in the art about the scope of the invention with reasonable certainty,” *Nautilus*, 572 U.S. at 910, and must be “measured from the viewpoint of a person skilled in [the] art *at the time the patent was filed*,” *id.* at 908 (alteration in original). This inquiry is rife with factual questions. Even for claim construction, “the meaning of a term in the relevant art during the relevant time period” is a factual question. *Teva*, 574 U.S. at 331; Pet. 18. But even if there is an open question on this, that is a reason to grant certiorari, not deny it.

Finally, respondent argues that, in any event, it is clear the lower courts “applied the clear-and-convincing evidentiary burden.” Opp. 23. Except they did not. As respondent has confirmed, the lower courts made a purely legal determination based on a supposed conflict in the prosecution history. They eschewed any factual inquiry. They may have paid lip service to the evidentiary burden, but they did not apply it.

### CONCLUSION

For these reasons, and those in the petition, the Court should grant the petition for a writ of certiorari.

Respectfully submitted,

ANDREW G. DI NOVO  
NICOLE E. GLAUSER  
DI NOVO PRICE LLP  
7000 N. MoPac  
Expressway, Suite 350  
Austin, TX 78731  
(512) 539-2626

CARTER G. PHILLIPS\*  
RYAN C. MORRIS  
SIDLEY AUSTIN LLP  
1501 K Street, N.W.  
Washington, D.C. 20005  
(202) 736-8000  
cphillips@sidley.com

*Counsel for Petitioner*

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\* Counsel of Record