



UNIVERSITY OF  
MARYLAND  
SCHOOL OF LAW

**PATENT LAW  
UPDATE**

***Honeywell Int'l  
Corp.  
v.  
Int'l Trade  
Comm'n***

Nos. 02-1393,  
-1448  
Federal Circuit  
Aug. 26, 2003

***"If the court  
determines that  
a claim is not  
'amenable to  
construction,'  
then the claim  
is invalid as  
indefinite under  
35 U.S.C.  
§ 112, ¶ 2."***

On August 26, 2003, the Federal Circuit affirmed the determination of the ITC that U.S. Patent No. 5,630,976 was invalid as indefinite under 35 U.S.C. § 112, ¶ 2 and that Hyosung did not infringe the '976 patent, which related to a process for production of a particular multifilament polyester product called polyethylene terephthalate (PET) yarn. The Federal Circuit stated:

"In construing claims, the analytical focus must begin and remain centered on the language of the claims themselves, for it is that language that the patentee chose to use to 'particularly point[ ] out and distinctly claim[ ] the subject matter which the patentee regards as his invention.'" The terms used in the claims bear a presumption that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art. Moreover, unless compelled otherwise, a court will give a claim term the full range of its ordinary meaning as understood by persons skilled in the relevant art.

If the court determines that a claim is not "amenable to construction," then the claim is invalid as indefinite under 35 U.S.C. § 112, ¶ 2. The definiteness requirement of § 112, ¶ 2 "focuses on whether the claims, as interpreted in view of the written description, adequately perform their function of notifying the public of the [scope of the] patentee's right to exclude." It requires "that the claims be amenable to construction, however difficult that task may be." Because a claim is presumed valid, a claim is indefinite only if the "claim is insolubly ambiguous, and no narrowing construction can properly be adopted." . . .

The claim construction dispute focuses on the claim term "melting point elevation" or MPE [and specifically] on whether the claims require any particular sample preparation method when determining the MPE. [N]either the claims, the written description, nor the prosecution history reference any of the four sample preparation methods that can be used to measure the MPE. . . . Without any reference to a sample preparation method, there are at least two possible constructions of the term—the "any one method" construction and the "all methods" construction. . . .

After reviewing the entire record regarding claim construction, we agree with the Commission and hold that the claims are insolubly ambiguous, and hence indefinite, with respect to a required sample preparation method. As we discuss below with respect to each proffered construction, the claims, the written description, and the prosecution history fail to give us, as the interpreter of the claim term, any guidance as to what one of ordinary skill in the art would interpret the claim to require. [B]ecause the sample preparation method is critical to discerning whether a PET yarn has been produced by the claimed process, knowing the proper sample preparation method is necessary to practice the invention. . . . Without knowing which sample preparation method to use, one cannot discern whether a yarn was produced using the claimed process. Under the "any one method" construction, the testing results will necessarily fall within or outside the claim scope depending on the sample preparation method chosen. Competitors trying to practice the invention or to design around it would be unable to discern the bounds of the invention.