

Ex parte Miyazaki

No. 07-3300, BPAI (Fleming, MacDonald, Pate, Bahr, Horner*)

[R]ather than requiring that the claims are insolubly ambiguous, [as necessary to invalidate a patent claim post-grant,] if a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite.

On November 19, 2008, the USPTO Board of Patent Appeals and Interferences, *inter alia*, affirmed-in-part the patent examiner's rejection of certain claims of U.S. patent application Serial No. 09/386,000, which related to a large printer that employs roll paper, as indefinite under 35 U.S.C. § 112, ¶ 2. The Board stated:

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." The Federal Circuit has held in post-issuance patent infringement cases that the definiteness requirement "does not compel absolute clarity" and "[o]nly claims 'not amenable to construction' or 'insolubly ambiguous' are indefinite." The Federal Circuit has noted that such a high standard of ambiguity for finding indefiniteness is due to the statutory presumption of patent validity.

This rule of reading claims narrowly in view of ambiguity runs counter to the USPTO's broader standard for claim construction during prosecution. In particular, unlike in post-issuance claim construction, the USPTO gives pending claims "their broadest reasonable interpretation consistent with the specification" and "in light of the specification as it would be interpreted by one of ordinary skill in the art." This broader claim construction standard is justified because, during prosecution, the applicant has the opportunity to amend the claims, and the Federal Circuit has held that an applicant has the opportunity and the obligation to define his or her invention precisely during proceedings before the USPTO.

[W]e employ a lower threshold of ambiguity when reviewing a pending claim for indefiniteness than those used by post-issuance reviewing courts. In particular, rather than requiring that the claims are insolubly ambiguous, we hold that if a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite.

The USPTO, as the sole agency vested with the authority to grant exclusionary rights to inventors for patentable inventions, has a duty to guard the public against patents of ambiguous and vague scope. Such patents exact a cost on society due to their ambiguity that is not commensurate with the benefit that the public gains from disclosure of the invention. The USPTO is justified in using a lower threshold showing of ambiguity to support a finding of indefiniteness under

35 U.S.C. § 112, second paragraph, because the applicant has an opportunity and a duty to amend the claims during prosecution to more clearly and precisely define the metes and bounds of the claimed invention and to more clearly and precisely put the public on notice of the scope of the patent.

[T]he requirement that the applicant clearly and precisely set out the metes and bounds of the claimed invention prior to completion of examination of the patentability of the claims furthers the USPTO's duty to issue valid patents. A fundamental principle of patent law is that the claims measure the invention. The duty of the PTO is to issue valid claims upon whose language the public can rely.

We realize that our reviewing court has never before set forth a different standard of review for indefiniteness under 35 U.S.C. § 112, second paragraph, for pre-issuance pending claims as compared with post-issuance patented claims. The Federal Circuit has, however, noted that a different standard for indefiniteness may be appropriate during prosecution of patent claims. Accordingly, we adopt this lower threshold standard of ambiguity for indefiniteness for claims during prosecution in keeping with the USPTO's broadest reasonable interpretation standard for claim construction.

The language of claim 1 attempts to claim the height of the paper feeding unit in relation to a user of a specific height who is performing operations on the printer (Fact 1). Claim 1 fails to specify, however, a positional relationship of the user and the printer to each other. For example, claim 1 does not recite where the printer is located or where, relative to the ground, the user is standing. As such, the printer of claim 1 could be positioned on a table or a platform and/or the user could be standing on something other than the ground, such as a step stool. An infinite number of combinations of printer and user positions could be envisioned. [B]because the relative position of the user and the printer are not well-defined in the claim, the claimed height of the paper feeding unit does not present a structural limitation on the height at all. Accordingly, we agree with the Examiner that the language of claim 1 is not sufficiently definite such that those skilled in the art would understand what is being claimed when the claim is read in light of the Specification.

The previous statements are for information purposes only, and do not constitute legal advice. Questions regarding the matters discussed above, and any requests to be subscribed to the free electronic distribution of this publication, may be directed to Lawrence M. Sung, Ph.D., at +1 202.346.7850 or lsung@dl.com, or to any other Dewey & LeBoeuf LLP attorney with whom you regularly consult.

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