

Parsing IP Indefiniteness Claims In ITC Investigations

By **Jeffrey Eichen** (May 5, 2020, 7:11 PM EDT)

With increasing frequency in Section 337 investigations, administrative law judges and the U.S. International Trade Commission itself are relying on indefiniteness as a ground for patent invalidity under Title 35 of U.S. Code Section 112.

But indefiniteness often turns on minute questions of wording and disclosures in the patent's specification, and so defining the exact circumstances where indefiniteness arises is not a simple task.

Therefore, it might be useful to consider three typical fact patterns in recent Section 337 opinions where claims of indefiniteness were decided: (1) internally inconsistent claim terms, (2) claim terms with no definition or method for measurement (or multiple definitions or methods) in the specification, and (3) qualitative claim terms.



Jeffrey Eichen

Internally Inconsistent Claim Terms

One form of indefiniteness is contradictory or logically inconsistent terms included in a patent claim. The idea behind this form of indefiniteness is that a claim cannot simultaneously require two mutually exclusive or contradictory things, such as a requirement that a device must both include and exclude instruction set architecture, or ISA, structures.[1] Logical inconsistencies of this type fail to inform those skilled in the art about the scope of the invention with reasonable certainty.[2]

In *Certain Infotainment Systems*, ALJ Sandra Lord found this form of indefiniteness in a claim that included the following element: "estimating a known value for the time tag error state within the dynamic model using the time-of-week information." As respondents argued, the words estimating and known are directly contradictory, since a known quantity, by definition, does not need to be estimated, and estimated quantities, by definition, are not known.

The patent owner responded that in fact there was no inconsistency since the time tag error is provided by an inherently imprecise nonatomic clock, and a person having ordinary skill in the art would know that, because a variable used in calculating the time tag error state is imprecise, the result is also imprecise and therefore an estimate.

Lord, however, found this argument to be a non sequitur, stating:

While a local clock with a high degree of imprecision would result in a large time tag error, the time tag error itself would not be imprecise as it is calculated by

subtracting the local time (whatever that local time is) from the time provided by the atomic clocks of the satellites.

Based on this, Lord found the claim to be internally contradictory and therefore indefinite. [3]

The logical inconsistency or contradiction in this opinion appears to arise purely from the definitions used for the words "estimate," "known," "precise" and "imprecise." These definitions led to a logical contradiction or impossibility that could not be resolved — like the requirement that a claimed device must both include and exclude "ISA structures."

While it might have been possible to avoid this result using slightly different definitions, Lord appears to have rejected any alternatives, and the commission ultimately decided not to review this portion of the ALJ's decision.[4]

No Definition or Method of Measurement (or Multiple Definitions or Methods of Measurement) in the Specification

The next form of indefiniteness is when the claim requires a particular measurement or quantity but the specification does not provide any particular definition or method (or multiple definitions or methods) for measuring this quantity.

So, for example, where there are three different methods for measuring molecular weight — peak average molecular weight (M_p), number average molecular weight (M_n) and weight average molecular weight (M_w), each giving a different result — and the specification does not say which one to use, a claim requiring measurement of molecular weight is indefinite. [5]

Indefiniteness of this type was considered by ALJ Theodore Essex in *Certain L-Tryptophan*, where an element of one claim required measurement of a K_i value, and all parties agreed that the measurement of this value was assay-dependent, that is, the result obtained depended upon which method one chose to measure it.

The patentee argued that the patent specification disclosed exemplary methods for measuring K_i , and so (1) a POSITA would know to incorporate the specification's exemplary methods into the claim language and (2) a POSITA would know how to adjust the conditions of other measurement methods to make the results consistent with the exemplary methods described in the specification.

But in the part of the specification discussing the exemplary measurement methods, Essex found a specific sentence to contradict the patentee's arguments:

The PGD activity was determined by detection of the forward or reverse reaction of the enzyme by the method of McKitrick, J. C. and Lewis J. P. ... It is likewise possible to employ any other method for measuring the PGD activity.

This sentence, according to Essex, entirely undermines the patentee's argument and leaves a POSITA in the position of having no guidance at all on which measurement method to use and thus no reasonable certainty as to which compositions might or might not fall within the scope of the claim.[6]

Chief ALJ Charles Bullock considered similar circumstances in finding indefiniteness in *Certain Dental Ceramics*, where the claim required "3-point flexure strength ... greater than about 370 MP_a" and the specification described two different methods for testing 3-point flexure strength — one using rectangular-shaped bars and another using cylindrical-shaped rods.

The patentee argued that only bars are proper since the specification also mentions an ISO standard for testing flexure strength and that standard requires bars, not rods. The patentee's expert testified that a POSITA would understand that only the International Organization for Standardization standard should be used for testing flexure strength, which means that references in the specification to testing rods can be ignored. Bullock found, however, that the patentee's reliance on expert testimony to overcome contrary statements in the specification was misplaced:

Here, the intrinsic evidence discloses two methods for measuring 3-point flexure strength — one using rectangular bars, and one using as-pressed cylindrical rods. The intrinsic evidence also discloses that these two measurement methods lead to different results. And the intrinsic evidence is silent on which of these two methods should be used to determine flexure strength with respect to the claims in which that term appears.

Given this, Bullock found the claim term "3-point flexure strength ... greater than 370 MP_a" indefinite.[7]

One final example of this form of indefiniteness appears in the commission's opinion in *Certain UV-Curable Coatings for Optical Fibers*. Just as in the U.S. Court of Appeals for the Federal Circuit case *Teva Pharmaceuticals USA v. Sandoz Inc.*, the claims in this investigation required one oligomer having a molecular weight of about 1000 or higher, and the respondent argued that molecular weight here could refer to number average molecular weight, average molecular weight or theoretical molecular weight of an individual molecule, each of which gives a different result.

In her ID granting summary determination of indefiniteness, ALJ Mary Joan McNamara agreed, finding that

If the patent claim specification, as it does here, and as the Teva court found, gives a variety of different measurement terms in the same specification without stating whether the measurement is the "average" of the oligomer or co-polymer, or the weight that is not an "average," there is uncertainty.[8]

Yet the commission reversed and remanded this decision approximately one month later, finding instead that:

The record evidence demonstrates that "molecular weight" and "average molecular weight" are used interchangeably in the context of the '659 patent specification and that a person having ordinary skill in the art would understand "molecular weight, in the context of an oligomer component of the claimed primary coating composition, to mean "average molecular weight." In addition, because the '659 patent discloses one method of measuring average molecular weight only, namely "number average molecular weight," the Commission has determined to construe the claim term "molecular weight" as "number average molecular weight." [9]

It would be difficult to come up with a single rule that consistently accounts for all of the results shown above, but at the most basic level, it is clear that intrinsic record — particularly the instructions or measurement methods given in the specification — controls the outcome of this issue.

Specifications containing unambiguous, consistent instructions for measurement of crucial values are highly likely to survive an indefiniteness challenge, while specifications containing no measurement methods (or multiple methods) and muddled instructions on what to do are likely to fail.

Qualitative Claim Terms

Finally, parties have argued indefiniteness with regard to qualitative claim terms that provide no objective method or procedure for determining when that claim term is met.

So, for example, a claim to a process to produce a precooked sliced bacon product resembling a pan-fried bacon product is indefinite where the specification identifies several criteria of pan-fried bacon (texture, mouth feel, bite, appearance and color) but otherwise gives no guidance or objective standard for deciding when the pan-fried quality has been achieved.[10]

In Section 337 investigations, this form of indefiniteness has been considered in several recent opinions, but with mixed results. In *Certain Gas Spring Nailer Products*, Bullock considered whether claims that included a requirement for a driving piston to move toward a ready position (defined in the specification as "at or proximal to the uppermost travel position") were indefinite.

According to the respondent, a POSITA would find no objective guidance or method for determining when the piston has returned to a position proximal to the uppermost travel position, and even the patentee's own expert described this ready position variously as near the top, almost at the top and a small amount away from the top, none of which include any objective standard for deciding what is or is not proximal.

Bullock, however, rejected this indefiniteness argument entirely. He first noted that the U.S. Supreme Court's indefiniteness standard requires reasonable certainty, not absolute, mathematical precision.

Bullock further noted that the claims do not require the piston to be at a ready position; instead, the claims require the piston to move toward a ready position, and so there is no need for a POSITA to understand exactly where the ready position begins or ends, so long as one can determine that the piston is moving toward it. Given these facts, Bullock found that the claims are not invalid for indefiniteness.[11]

Similarly, in *Certain Electrical Connectors*, Bullock considered whether the terms end regions, proximate to two opposite ends and a center region between the two end regions are indefinite. The patent claim in this investigation required first holes located in the end regions and second holes located in the center region, so being able to determine the boundaries of these end and center regions is essential to deciding whether a particular article falls within or outside the scope of the claim.

But after examining both the intrinsic evidence and various experts' testimony on a POSITA's understanding of the terms, Bullock found no guidance at all on the location of a boundary between end regions and a center region and therefore held the claim indefinite. [12] The commission, however, rejected Bullock's insistence on defining a particular boundary between the end and center regions.

Instead, the commission found definitions for these regions in the plain language of the specification:

- End region: "the areas located at the two opposite ends of the tine plate in the substantially longitudinal direction."

- Center region: "the region between the two opposite end regions of the tine plate with respect to the longitudinal direction of the plate."

And as for a boundary between the two regions, this issue is not addressed in the commission's opinion at all.[13]

So how does one determine the bounds of a patent claim defined by qualitative terms? There appears to be considerable disagreement, even within the ITC, on how to approach this question. From the decisions above, one could conclude that basic positional or geographic terms like ready position, end region and center region are at least sufficiently well-defined to meet the Nautilus reasonable certainty test for indefiniteness.

Other qualitative terms requiring more subjective or personal judgment, such as resembling pan-fried bacon, probably would not meet the ITC's standards. And the exact border between these examples, like so many other things in patent law, remains undefined for now.

Jeffrey Eichen is a partner at Faegre Drinker Biddle & Reath LLP.

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[1] [Competitive Techs., Inc. v. Fujitsu Ltd.](#) , 185 Fed. Appx. 958, 965-66 (Fed. Cir. 2016).

[2] [Nautilus, Inc. v. Biosig Instruments, Inc.](#) , 572 U.S. 898, 910, 134 S. Ct. 2120, 2129 (2014)).

[3] Certain Infotainment Systems, Components Thereof, and Automobiles Containing the Same, Inv. No. 337-TA-1119, Initial Determination on Violation of Section 337 and Recommended Determination on Remedy and Bonding, ALJ Lord, November 13, 2019, at 208-10 (citing [Competitive Techs.](#), supra).

[4] Certain Infotainment Systems, et al., Inv. No. 337-TA-1119, Notice of a Commission Determination to Review in Part a Final Initial Determination Finding No Violation of Section 337, February 26, 2020, at 3.

[5] [Teva Pharms. USA, Inc. v. Sandoz, Inc.](#) , 789 F.3d 1335, 1341-43 (Fed. Cir. 2015).

[6] Certain L-Tryptophan, L-Tryptophan Products and their Methods of Production, Inv. No. 337-TA-1005, Initial Determination on Violation of Section 337 and Recommended Determination on Remedy and Bond, ALJ Essex, August 11, 2017, at 49-52.

[7] Certain Dental Ceramics, Products Thereof, and Methods for Making the Same, Inv. No. 337-TA-1050, Initial Determination on Violation of Section 337 and Recommended Determination on Remedy and Bond, Chief ALJ Bullock, July 23, 2018, at 58-65 (citing [Dow Chem. Co. v. Nova Chemicals Corp. \(Canada\)](#) , 803 F.3d 620, 634 (Fed. Cir. 2015)).

[8] Certain UV-Curable Coatings for Optical Fibers, Coated Optical Fibers and Products Containing the Same, Inv. No. 337-TA-1031, Initial Determination Granting MUV's Motion for Summary Determination, July 6, 2017, at 7-9 (citing Teva Pharms., supra).

[9] Certain UV-Curable Coatings, et al., Inv. No. 337-TA-1031, Commission Opinion, August 11, 2017, at 9-10.

[10] **HIP, Inc. v. Hormel Foods Corp.**, et al., 2019 WL 2579266, at *6 (D. Del. June 24, 2019), aff'd ___ Fed. Appx. ___, 2020 WL 1081706 (Fed. Cir. March 6, 2020)

[11] Certain Gas Spring Nailer Products and Components Thereof, Inv. No. 337-TA-1082, Initial Determination on Violation of Section 337 and Recommended Determination on Remedy and Bond, June 7, 2019, at 47-51.

[12] Certain Electrical Connectors, Components Thereof, and Products Containing the Same, Inv. No. 337-TA-1043, Order 23: Construing the Terms of the Asserted Claims of the Patent at Issue and Staying the Procedural Schedule, September 28, 2017, at 7-15.

[13] Certain Electrical Connectors, et al., Inv. No. 337-TA-1043, Reversal of Initial Determination and Remand of the Investigation, March 26, 2018, at 2-4.