

## Are all pending claims now indefinite?

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The Board of Patent Appeals and Interferences has recently instituted a major shift in United States Patent and Trademark Office (USPTO) policy regarding the interpretation of 35 U.S.C. § 112, second paragraph. **Ex parte Miyazaki**, Appeal No. 2007-3300 (BPAI 2008), decided Nov. 19, 2008, is a rare precedential opinion signed by a five member expanded panel of administrative patent judges (APJ), including the Chief APJ and the Vice Chief APJ. In the decision, the Board announced that the USPTO will use a lower standard of review than the federal courts for finding claims indefinite.

The claims at issued in the Miyazaki application are directed to a large printer that employs roll paper and the indefiniteness issue relates to the limitation of the height of the paper feeding unit. Claim 1 of the application recites in part:

the paper feeding unit being located at a height that enables a user, who is approximately 170 cm tall, standing in front of the printer to execute the paper feeding process.

Independent claims 16 and 18 recite a similar height limitation for the sheet feeding area but indicate that the printer is placed substantially at ground level. Independent claim 13 provides even more detail on the relationship between the printer and the user, reciting in part:

a sheet feeding area positioned at a height at which a user, who is approximately 170 cm tall, can set up a printing medium without having to bend substantially at the waist when the user is standing erect in front of the printer and standing substantially at ground level, wherein the sheet feeding area is positioned at the height when the printer is placed substantially at the ground level.

The Board states that it is appropriate for the USPTO to use a different standard of review for indefiniteness for pre-issuance pending claims than is used by the courts for post-issuance patented claims. The Federal Circuit has found that the definiteness requirement “does not compel absolute clarity” and “[o]nly claims ‘not amendable to construction’ or ‘insolubly ambiguous’ are indefinite.” **Datamize, LLC v. Plumtree Software, Inc.**, 417 F.3d 1342, 1347 (Fed. Cir. 2005) (citations omitted). This high

standard of ambiguity for finding indefiniteness is due to the statutory presumption of patent validity. **Exxon Research & Eng'g Co. v. United States**, 265 F.3d 1371, 1375 (Fed. Cir. 2001 (“By finding claims indefinite only if reasonable efforts at claim construction prove futile, we accord respect to the statutory presumption of patent validity.”) The Federal Circuit has further said that claims amenable to more than one interpretation should be interpreted narrowly in order to preserve validity. *See Modine Mfg. Co. v. U.S. Int’l Trade Comm’n*, 75 F.3d 1545, 1557 (Fed. Cir. 1996); **Athletic Alternatives, Inc. v. Prince Mfg., Inc.**, 73 F.3d 1573, 1581 (Fed. Cir. 1996).

In contrast, the USPTO is required to give pending claims “their broadest reasonable interpretation consistent with the specification.” **In re Am. Acad. Of Sci. Tech. Ctr.**, 367 F.3d 1359, 1364 (Fed. Cir. 2004). (It is noted, however, that this standard has previously been applied only for prior art purposes under 35 U.S.C. §§ 102 and 103.) Based on this different interpretation standard for pending claims, the Board held that:

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.

**Miyazaki**, slip op. at 11-12. The Board further stated that:

[t]he 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.

*Id.*, slip op. at 12.

Applying this new lower standard to the Miyazaki claims, the Board found that the limitation to the height of the paper feeding unit in claim 1 was indefinite because it did not specify a positional relationship of the user and the printer to each other. They stated that an infinite number of combinations of printer and user positions could be envisioned (*e.g.*, on the floor, on a table, on a step stool) such that the recited language

does not impose a structural limitation. The Board further found that claims 16 and 18, which recite that the printer is placed substantially at ground level, are still not sufficient to provide definiteness because they impose no restriction on where the user is standing. According to the Board, only claim 13 cures this problem as it recites the position of both the printer and the user.

Miyazaki argued that the height limitation at issue in claim 1 was analogous to the limitation at issue in **Orthokinetics, Inc. v. Safety Travel Chairs, Inc.**, 806 F.2d 1565, 1568 (Fed. Cir. 1986) (the front leg of the wheelchair “is so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats thereof.”) The Federal Circuit held that the limitation was definite, noting that “one desiring to build and use a travel chair must measure the space between the selected automobile’s doorframe and its seat and then dimension the front legs of the travel chair so they will fit in that particular space in that particular automobile” and the fact that “a particular chair on which the claims read may fit within some automobiles and not others is of no moment.” *Id.* at 1576. The Board distinguished **Orthokinetics**, stating that:

[t]he difference between the claim in *Orthokinetics* and the claims before us is that the claim in *Orthokinetics* defined the dimension of the front leg of the wheel chair by reference to a well defined reference area (*i.e.*, the space between the doorframe and seat of an automobile). In the present claims, 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.

**Miyazaki**, slip op. at 15-16.

In addition to upholding the Examiner’s indefiniteness rejection, the Board further applied the new lower standard to Miyazaki’s claims by entering a new ground of rejection under 35 U.S.C. § 112, second paragraph. The Board found that the phrase “sheet feeding area” was amenable to two plausible definitions, one based on the description provide in the specification and one based on the ordinary meaning of the words in the phrase and that neither definition made sense in view of the remainder of the claims. The specification defined the phrase “sheet feeding area” to comprise the accommodation space in which the paper roll is loaded as well as the cover member above the accommodation space. However, the claims were directed to a printer

comprising in part a sheet feeding area and a cover member. Thus, the claim language raised questions about the definition of “sheet feeding area” and it was unclear what was intended to be covered with the claim language.

The present decision of the Board -- that a standard set by the Federal Circuit for enforcement in the courts does not apply to prosecution in the USPTO -- goes against congressional intent in establishing the Federal Circuit in order to achieve doctrinal stability in patent law. *See Federal Courts Improvement Act of 1982*, Pub.L.No.97-164, 96 Stat. 25; **Cable Electric Products, Inc. v. Genmark, Inc.**, 770 F.2d 1015 (Fed. Cir. 1985). Further, it sets up an untenable dichotomy in which the federal courts must give deference to Board decisions but the Board is not required to follow federal court decisions. Indeed, this ruling promotes potential conflicts such as a federal court finding claims of an issued patent to be valid while the same claims on reissue are found by the USPTO to be invalid.

Perhaps the present decision is an attempt by the Board to make their own job and the job of examiners easier by providing a simple way to reject claims in the absence of relevant prior art. It is noted that a similar position of the Board -- that a standard set by the Federal Circuit for enforcement in the courts does not apply to prosecution in the USPTO -- had been put forward previously by the Board with respect to the “means-plus-function” language of 35 U.S.C. § 112, sixth paragraph. However, the Federal Circuit emphatically laid the idea to rest in **In re Donaldson Co.**, 16 F.3d 1189 (Fed. Cir. 1994), where it held:

[t]he fact that paragraph 6 does not specifically state that it applies during prosecution in the PTO does not mean that paragraph six is ambiguous in this respect. Quite the contrary, we interpret the fact that paragraph six fails to distinguish between prosecution in the PTO and enforcement in the courts as indicating that Congress did not intend to create any such distinction.

**Donaldson** at 1194. The same should be found true for the Board’s new interpretation of 35 U.S.C. § 112, second paragraph, in the present decision.

If the present decision is followed by the examining corp, one problem is that the new standard will be difficult to interpret and will be frequently misapplied. Examiners often confuse claim breadth with indefiniteness. In other words, a claim limitation that is

not restricted to a particular embodiment is often rejected as indefinite when in fact the claim is intended to encompass all embodiments of that limitation and should be examined for the full breadth of the claim. The present decision is likely to greatly increase the incidence of such inappropriate indefiniteness rejections.

In fact, the present decision appears to be a misapplication of the Board's own standard. The issue with the height of the sheet feeder does not relate to "two or more plausible claim constructions." As the Board stated in the decision, the limitation in claim 1 regarding the height of the sheet feeder did not add any structural limitations to the claim because the relative positions of the printer and the user were not provided by the claim. This is a claim breadth issue, not an indefiniteness issue. There is nothing indefinite about the fact that the sheet feeder can be at any height and it does not lead to multiple plausible claim constructions. The phrase is merely a non-limiting recitation. An examiner faced with this claim could apply prior art teaching sheet feeders at any height as it would be encompassed by the scope of claim 1. It is the application of prior art in this manner that should force applicants to narrow the claims appropriately, not the application of trumped up indefiniteness rejections.

Another problem raised by the present decision is that it will result in extended and inefficient prosecution if examiners rely on indefiniteness rejections in early office actions without initially raising all possible art rejections based on the apparent scope of the claims. If the examining corp relies on the Board's holding and follows the example in this decision, applicants will likely be flooded with inappropriate indefiniteness rejections.

Finally, the dual standards sets up a client counseling nightmare. Attorneys will now have to provide two different sets of advice to clients depending on whether claims are on appeal to the Board or on appeal to the Federal Circuit. And, the authority on which counsel can rely to advise clients will now be split in half, depending on whether the claims are pending or issued. Freedom-to-operate and patentability analyses based on both issued patents and published applications similarly become more difficult. All in all, the present decision, if followed, is likely to place a tremendous burden on patent practitioners and applicants.

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