

Inconsistent Prosecution Statements Can Render Claims Indefinite

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Infinity Computer Products v. Oki Data Americas, Inc., No. 20-1189 (Fed. Cir. Feb. 10, 2021)

In *Infinity*, the Federal Circuit affirmed the district court's final judgment that the claims were invalid for indefiniteness based on the patentee's inconsistent prosecution statements.

During prosecution, the patentee amended the claims to require a "passive link" to overcome the examiner's rejection. In particular, the patentee distinguished the prior art on the basis of the "passive link" term and argued that support for "passive link" could be found in Figures 2F-H of the specification. Notably, the term "passive link" does not appear in the patent specification and Figures 2F-H were not disclosed in the priority patent. In subsequent reexamination proceedings, the patentee sought to antedate additional prior art, and successfully relied on disclosures in the priority patent to support the "passive link" term. This time—given the absence of Figures 2F-H in the priority patent—the patentee argued that support for "passive link" could be found in Figures 2B-D, which disclosed a different configuration.

In claim construction proceedings in the instant infringement case, the district court determined that the patentee had taken materially inconsistent positions regarding the meaning of "passive link." The district court held that the patentee's inconsistent positions left the claims indefinite and entered a final judgment of invalidity.

On de novo review, the Federal Circuit held that the patentee's prosecution statements contradicted one another and rendered the claims indefinite. The Federal Circuit explained that patentees must be held to what they argue during prosecution, but doing so here was not possible in view of the patentee's inconsistent statements during prosecution and reexamination. Because the claims and specification left uncertainty regarding the meaning of "passive link," the Federal Circuit held that the intrinsic record failed to leave an ordinarily skilled artisan with reasonable certainty as to meaning of "passive link," leaving the claims indefinite.

Read the Federal Circuit's opinion [here](#).

1 Min Read

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