

Indefiniteness Is Not Determined by Claim Language Standing Alone

FEBRUARY 9, 2022

Nature Simulation Systems Inc. v. Autodesk, Inc., No. 20-2257 (Fed. Cir. Jan. 27, 2022)

After a *Markman* hearing, Magistrate Judge Kim in the Northern District of California ruled that two claim terms were indefinite under 35 U.S.C. § 112(b), rendering the claims invalid. Pointing to “unanswered questions” about claim scope that were raised by the accused infringer’s expert, the district court held that definiteness requires, as a matter of law, the questions to be answered in “the claim language, standing alone.” Because the claims did not answer the questions, the district court held the claims were indefinite.

The Federal Circuit reversed, holding that the district court had “applied an incorrect standard of ‘unanswered questions’” requiring the questions to be answered in “the claim language, standing alone.” Instead, definiteness requires that the “claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty.” The district court erred by not considering “information in the specification that was not included in the claims” and by giving “no weight to the prosecution history.” During prosecution, indefiniteness rejections had been resolved by adding claim limitations, including by an examiner’s amendment, with the Federal Circuit reiterating that “[a]ctions by PTO examiners are entitled to appropriate deference.” Applying the correct standard, the Federal Circuit held the claims were not indefinite.

Judge Dyk dissented, asserting the district court had read the patent claims in light of the specification and properly determined the claim terms were indefinite. According to Judge Dyk, the specification did not explain certain limitations that the examiner suggested during prosecution, and the majority improperly relied on the fact that the examiner suggested those limitations instead of requiring that the specification explain them.

1 Min Read

Related Locations

[Charlotte](#)

[Chicago](#)

[Houston](#)

[Los Angeles](#)

[Silicon Valley](#)

[Washington, DC](#)

Related Topics

Markman/Claim Construction

Invalidity

Infringement

Related Capabilities

Patent Litigation

Intellectual Property

Related Regions

North America

Related Professionals



David Enzminger



Brian E. Ferguson



Kelly C. Hunsaker



Ivan Poullaos



Mike Rueckheim



Danielle Williams