

Fax Error: Connection Failed

Infinity Computer Prods., Inc. v. Oki Data Americas, Inc., No. 2020-1189, 2021 WL 476067 (Fed. Cir. Feb. 10, 2021)

By: Ifiti Zaim & Ted Mahan | February 22, 2021

The Court of Appeals for the Federal Circuit (“CAFC”) [affirmed](#) a final judgment ruling that Infinity’s four patents—involving using a fax machine as a printer or scanner for a personal computer—are invalid as indefinite because the patent applicant had asserted conflicting definitions of the claim term “*passive link*” during prosecution and reexamination of one of the patents. *Infinity* underscores the hazards of leveraging vague distinctions during prosecution to avoid prior art, as any reprieve may be short-lived.

Infinity sued Oki Data for infringing a family of patents directed to connecting a fax machine directly to a computer so it could be used as a printer or scanner. All of these patents, including the earliest asserted patent, No. 6,894,811 (“the ’811 Patent”) claimed priority to U.S. Patent App. Ser. No. 08/226,278. Critically, all of the asserted claims required that image data be exchanged “via a passive link between the facsimile machine and the computer,” yet the specification contained no explanation of what a “passive link” meant. The “passive link” limitation was only introduced during prosecution of the ’811 Patent to avoid a potentially anticipatory prior art reference, Perkins, which disclosed a fax modem device for achieving that same functionality. The applicant argued its invention differed from Perkins by connecting the fax machine to the computer via a “passive link,” thus directly connecting the fax machine transceiver to the computer’s I/O bus without any intervening circuitry. Supporting this new limitation, the applicant submitted additional figures depicting a fax machine connected directly to a computer that lacked an internal fax modem. However, this maneuver created problems later: in reexamination, the applicant faced another prior art reference, Kenmochi, that disclosed and predated the figures introduced to support the “passive link” limitation. To antedate Kenmochi, the applicant claimed priority to the earlier ’278 Application, successfully arguing that the “passive link” was disclosed in its original figures depicting a fax machine connected to a fax modem installed on board a computer.

Returning to the present case: Oki Data, argued during claim construction that the applicant had taken inconsistent positions to overcome Perkins and antedate Kenmochi, rendering the claim terms indefinite. The district court agreed, finding that the applicant’s contradictory statements precluded a person of ordinary skill from understanding with reasonable certainty where the “passive link” ends and the “computer” begins—whether at the I/O bus or the data port of an on-board modem. The CAFC affirmed, agreeing that “holding Infinity to both positions results in a flat contradiction” that violates the public-notice function of patent claims. Although the patent applicant’s aggressive maneuvering around the prior art staved off invalidity for a time, it ultimately forced the applicant to advance inconsistent constructions and an untenable priority claim, trapping the claims between the written description requirement and the prior art.