35 U.S.C. § 112(b): Reasonably Certain Patent Claims

Nature Simulation Sys. Inc. v. Autodesk, Inc., No. 2020-2257, 2022 WL 244065 (Fed. Cir. Jan. 27, 2022)

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The instant case highlights a disagreement between the Federal Circuit Judges Newman and Dyk regarding whether deference should be applied to an examiner's amendment entered in order to overcome an indefiniteness rejection under 35 U.S.C. § 112(b). Judge Newman, writing for the majority, found that deference should be applied to an examiner's amendment and reversed the District Court's ruling of indefiniteness. Judge Dyk dissented and stated that the test for definiteness is whether the claims "inform those skilled in the art about the scope of the invention with reasonable certainty,"[1] not "whether the claim language was added by a patent examiner or was not indefinite to the examiner." Opinion at 10.

The patents at issue were U.S. Pat. Nos. 10,120,961 (the "'961 Patent") and 10,109,105 (the "'105 Patent"). The '961 and '105 patents claimed a computer-implemented method for building three-dimensional objects via a "Boolean operation" computation. The two terms at issue were: (1) "searching neighboring triangles of the last triangle pair that holds the last intersection point" and (2) "modified Watson method."

The prosecution history for both patents involved rejections for indefiniteness and examiner-guided amendments of the claims that added the terms at issue to overcome these rejections. After the Applicant accepted the Examiner's amendments, the examiner withdrew the rejections and allowed the claims. The District Court gave no deference to the Examiner's allowance based on the amendments and found the claims invalid on the ground of claim indefiniteness under 35 U.S.C. § 112(b).

The majority reversed the District Court's finding of indefiniteness because, among other reasons, no deference was given to the examiner-guided amendments. "Actions by PTO examiners are entitled to appropriate deference as official agency actions, for the examiners are deemed to be experienced in the relevant technology as well as the statutory requirements for patentability." Opinion at 8.

Judge Dyk dissented, stating that it is irrelevant whether the indefinite language was introduced by the examiner. Further, Judge Dyk noted that the term "modified Watson method" did not have an ordinary and customary meaning to a person of ordinary skill in the art. Finally, Judge Dyk stated that the test for definiteness is whether the claims "inform those skilled in the art about the scope of the invention with reasonable certainty,"[2] not "whether the claim language was added by a patent examiner or was not indefinite to the examiner." Opinion at 10.

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[1] *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 910 (2014).
[2] *Nautilus*, 572 U.S. at 910.