

INTELLECTUAL PROPERTY LITIGATION

Expert Analysis

## Indefiniteness of Claim Terms Reciting a Term of Degree After ‘One-E-Way’ and ‘Sonix’

Some patents define the boundaries of their inventions using qualitative terms of degree, rather than quantitative measures. Patents must, however, reasonably inform skilled readers about what is within and what is outside the scope of their claims, and terms of degree can be subjective. In *Sonix Technology v. Publications International*, the Federal Circuit found that the claim term “visually negligible” was not “purely subjective,” and thus was not indefinite, 844 F.3d 1370 (Fed. Cir. 2017). Likewise, in *One-E-Way v. International Trade Commission*, the Federal Circuit held that the claim term “virtually free from interference,” viewed in light of the specification and prosecution

LEWIS R. CLAYTON and ERIC ALAN STONE are litigation partners at Paul, Weiss, Rifkind, Wharton & Garrison. MICHAEL F. MILEA, an associate at the firm, and JOHN W. BODKIN, a summer associate at the firm, assisted in the preparation of this column.



By  
**Lewis R.  
Clayton**



And  
**Eric Alan  
Stone**

history, was not indefinite, 859 F.3d 1059 (Fed. Cir. 2017).

We report here on the impact of these cases on the interpretation of terms of degree in patent claims, providing guidance for practitioners.

A patent must ‘conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the inventor or joint inventor regards as the invention.’

### The Definiteness Requirement

A patent must “conclude with one or more claims particularly pointing out and distinctly claiming the

subject matter that the inventor or joint inventor regards as the invention,” 35 U.S.C. Section 112(b). The claims define the invention, and serve a notice function as well: When “viewed in light of the specification and prosecution history,” the patent’s claims must “inform those skilled in the art about the scope of the invention with reasonable certainty,” as in *Nautilus v. Biosig Instruments*, 134 S. Ct. 2120, 2129 (2014). A claim that violates this definiteness requirement is invalid.

Terms of degree, while posing a risk of indefiniteness, are not inherently indefinite: “Claim language employing terms of degree has long been found definite where it provided enough certainty to one of skill in the art when read in the context of the invention,” see *Interval Licensing v. AOL*, 766 F.3d 1364, 1370 (Fed. Cir. 2014).

### Sonix and One-E-Way

In *Sonix*, the district court held that the term “visually negligible”

was purely subjective, and thus indefinite, in a patent claiming a system and method for using a “graphical indicator” to encode information on the surface of an object. The Federal Circuit reversed. While the court agreed that “visually negligible” is a term of degree, it held that the term is not “purely subjective” because “what can be seen by the normal human eye”—implicated by the word “visually”—“provides an objective baseline through which to interpret the claims.”

In so holding, the court relied on the intrinsic and extrinsic evidence to find that “there is some standard in the written description for measuring visual negligibility.” First, the court found that the patent itself provided “guidance on how to create visually-negligible indicators,” such as differentiability, brightness, and homogeneity requirements, and further disclosed “specific examples that provide points of comparison for the result.” The court also relied on the prosecution history, in which “No one involved in either the first or second reexamination had any apparent difficulty in determining the scope of” visually negligible.

The court also relied on the extrinsic evidence that in the first years of the litigation, the parties challenging the patent never questioned the clarity of the term “visually negligible” and

instead offered constructions of that term. Likewise, the parties’ experts both “repeatedly applied the term to the references and the accused products” prior to any assertion that the term was indefinite.

The court limited its holding to the specific facts, however: “Our holding in this case does not mean that the existence of examples in the written description will always render a claim definite, or that listing requirements always provide sufficient certainty.”

Following *Sonix*, in *One-E-Way* the Federal Circuit reversed the International Trade Commission’s conclusion that the term “virtually free from interference” was indefinite as used in patents disclosing a wireless digital audio system designed to allow the use of wireless headphones privately and without interference. The Federal Circuit held that in those patents “virtually free from interference” simply “prevents one user from eavesdropping on another,” such that the term does not “expand ‘free from interference’ without end.”

As in *Sonix*, the court relied on both intrinsic and extrinsic evidence. For example, the claim itself “names of the source of the interference” and the specification “repeatedly highlights [the] private listening feature of the claimed invention.” Notably, because the

term “interference” was used in a “nontechnical manner,” the court did not require the patent holder to define the term in the “technical sense” even though “there are known ways to define levels of interferences.”

### Subsequent Federal Circuit And District Court Decisions

Courts have relied on *Sonix* and *One-E-Way* to hold that claims containing terms of degree are not indefinite where the patent specification includes specific examples that embody the claim term and provide a necessary “objective baseline through which one can interpret the claims.”

One emerging theme in the cases is the use of examples to provide context. In *Integra Life-sciences v. Hyperbranch Medical Technology*, No. 15-819-LPS-CJB, 2017 WL 3336274, at \*17–18 (D. Del. July 27, 2017), the court held that the term “observable change” was not indefinite as used in patents relating to certain polymers. Analogizing to *Sonix*, the court found that the dependent claims and the specification listed specific examples of an “observable change,” including examples of how application of the invention renders features less clear or even invisible. Likewise, in *Mentor Graphics v. EVE-USA*, 851 F.3d 1275, 1292–1293 (Fed. Cir. 2017), the

Federal Circuit held that the term “visually near” was not indefinite where the specification provided two examples that would allow a skilled artisan to “readily understand” the claim scope.

At least one court has also looked to the parties’ prior litigation conduct as extrinsic evidence, as the Federal Circuit did in *Sonix*. In *Dexcwin Global v. Ari-bex*, No. CV 16-143-GW, 2017 WL 3477748, at \*5–6 (C.D. Cal. June 7, 2017), the court held that the term “high voltage” was not indefinite as used in a patent directed to a portable X-ray machine, because a “reading of the specification discloses that the inventors intended this term to be a general term, which only meant that the voltage was sufficiently high to drive the desired x-ray tube.” The court relied on positions taken by the patent challenger in a prior challenge to the same patent, where the challenger had not asserted that the term “high voltage” was indefinite.

Courts have also relied on *Sonix* and *One-E-Way* to hold that terms like “generally” or “substantially” are not indefinite. For example, in *Edgewell Personal Care Brands v. Albaad Massuot Yitzhak*, No. 15-1188-RGA, 2017 WL 1900736, at \*3–4 (D. Del. May 9, 2017), the court held that the terms “generally tapered” and “generally elliptical” were not indefinite as used

in a patent directed to a tampon assembly, and—citing *Sonix*—noted that “after *Nautilus*, the Federal Circuit has continued to uphold terms of degree,” accord *Tinnus Enterprises v. Telebrands*, No. 2017-1726, 2018 WL 2434504, at \*6 (Fed. Cir. May 30, 2018) (citing *One-E-Way*, holding “substantially filled” was not indefinite in patent directed to apparatus that fills balloons with fluids).

---

Courts have also relied on ‘*Sonix*’ and ‘*One-E-Way*’ to hold that terms like ‘generally’ or ‘substantially’ are not indefinite.

On the other hand, courts have held that claims are indefinite where the patent provides no point of reference from which a person of ordinary skill could understand the claim scope. Thus, the court in *Rovi Guides v. Comcast*, No. 16-CV-9278, 2017 WL 3447989, at \*13–14 (S.D.N.Y. Aug. 10, 2017), held that the term “relatively large,” while not “purely subjective,” was nevertheless indefinite. The examples in the patent did “not give meaning to the phrase” and provided no reference point of comparison. The court stated: “to determine if a database is ‘relatively large,’ all one needs is a reference point to compare to. Jupiter is relatively large compared to Earth but relatively small compared to the Sun.” So too

in *Berkheimer v. HP*, 881 F.3d 1360, 1364 (Fed. Cir. 2018), where the Federal Circuit found the term “minimal redundancy” indefinite because the “specification contains no point of comparison for skilled artisans to determine an objective boundary of ‘minimal’ when the archive includes *some* redundancies.”

### Guidance for Practitioners

Indefiniteness remains a case-by-case analysis, viewing claim terms in the context of the intrinsic and extrinsic evidence. Patent prosecutors will likely note the importance of examples, both in dependent claims and in the specification, as a means of giving context to terms of degree. Litigators should also note these courts’ reliance on the parties’ litigation positions, both with regard to indefiniteness challenges that were not advanced when they could have been, and with regard to proffered claim constructions later undercutting a claim of indefiniteness.