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“Particularly Pointing Out And Distinctly Claiming”: What’s Next For
The Patent Act’s “Clarity And Precision Demand”
Post Nautilus And Williamson?

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“The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.” 35 U.S.C. § 112(2/b).

“An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” 35 U.S.C. § 112 (6/f).

“The monopoly is a property right; and like any property right, its boundaries should be clear. This clarity is essential to promote progress, because it enables efficient investment in innovation.” Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722, 730-31 (U.S. 2002).

1. Predictions Of What’s Next

1.1. The particular-and-distinct claiming mandate (and invalidity defense) will be untangled from claim construction.

1.1.1. Claims will have a “correct” construction and be “indefinite.”

1.1.2. In rare case where there is a genuine dispute over a material subsidiary fact for “indefiniteness,” it will go to a jury, while subsidiary fact finding for claim construction will remain with judges.

1.1.3. Summary judgments of “indefiniteness” will not be reviewed for “clear error” (because there is no fact finding on summary judgment) even though subsidiary “fact finding” on claim construction will continue to be reviewed for clear error.

1.1.4. Hindsight will be removed from the “indefiniteness” analysis but remain proper in claim construction.

1.1.4.1. “Intrinsic evidence” for “indefiniteness” will be limited to that available the day the patent issues, but not for claim construction.

1.1.4.2. For example, post-issuance PTO proceedings are not part of the “intrinsic evidence” for “indefiniteness” review of an originally issued patent claim.

1.2. “Functional” claiming again will be prohibited, especially at the point of novelty.

1.2.1. The BPAI’s oft-overlooked prohibition against “purely functional” claim elements, In re Catlin, 90 U.S.P.Q.2d 1603 (BPAI 2009) (precedential); In re Miyazaki, 89 U.S.P.Q.2d 1207 (BPAI 2008) (precedential), will prevail.

1.2.2. So will the S. Ct.’s prohibition against functional claiming at the point of novelty, Halliburton Oil Well Cementing Co. v. Walker, 329 U.S. 1 (1946) (“unless frightened from the course of experimentation by broad functional claims like these, inventive genius may evolve many more devices to accomplish the same purpose.”).

1.2.3. Patent claims will be required to recite a particular “way” not just a “function” or “result,” i.e., how the function is performed (sufficient structure or acts to perform the function) or how the result is achieved.

1.2.3.1. White v. Dunbar, 119 U.S. 47, 50 (1886) (“the object of an invention is a very different thing from the invention itself. The object may be accomplished in many ways; the invention shows one way.”)

1.3. The provisional safe harbor of Sec. 112 (6/f) will be given its plain meaning.

1.3.1. “for performing a specified function” will no longer encompass “for achieving a specified result.” Results claiming will no longer be saved by this safe harbor.

1.3.2. “a means or step” will no longer encompass abstract information. Reciting information for achieving a function will no longer be saved by this safe harbor.

1.3.2.1. Per USPTO Legal Training Module [guidance](#) (08/02/13): “Terms that represent only non-structural elements such as information, data, instructions, and software *per se* would not serve as substitutes for ‘means’, because the terms do not serve as placeholders for structure or material.”

1.3.2.2. The S. Ct. will rule at least one “computer readable medium” (CRM) claim purely functional, not saved by the Sec. 112 (6/f) safe harbor, and contrary to the Patent Act.

1.3.3. What is in the specification “corresponding” to the claim-recited “means” will no longer be limited to “structure,” but instead will include “the corresponding structure, material, or acts described in the specification and equivalents thereof.” In other words, “acts” will no longer be treated as applying solely to “step for” claim elements.

1.3.3.1. An “algorithm” will no longer be called “structure,” but rather recognized as “acts.”

2. The Patent Statute’s “Clarity And Precision Demand” Is Claim Construction’s Cousin, Not Its Twin

2.1. The Patent Act’s “clarity and precision demand” for patent claims, is a tool serving the public notice function of patent claims. It is enforced during patent prosecution and as an invalidity defense in an infringement suit. Claim construction is none of these things. Its primary purpose is to guide the trier of fact in an adjudication of infringement or validity. It is not a defense. And, it does not serve the public notice function. Yet, courts and litigants routinely conflate the patent statute’s clarity and precision demand with claim construction. That error led to the Fed. Cir.’s “amenable to construction” test rejected last term by the S. Ct. as not even being “probative of the essential inquiry.” And, this same error now seems to be the root cause of equally unsupportable developments in patent law, including some courts concluding that because post-issuance patent prosecution is fair game in a claim-construction analysis it must be equally relevant to determining compliance with the clarity and precision demand. In other words, the skilled artisan wishing to innovate around a patent the day it issues is assumed to have a crystal ball seeing changes and clarifications of the claims years in the future. This, of course, defeats the public-notice function.

2.2. Construing A Patent Claim Is Confusingly Similar To But Dramatically Different Than Enforcing “The Statute’s Clarity And Precision Demand”

2.2.1. **A Claim May Be Amenable To Construction (Or A BRI) And Still Be “Indefinite”**: Claim construction and “indefiniteness” are cousins not twins. Yet, courts and litigants often conflate claim construction with enforcing “the statute’s clarity and precision demand,” Nautilus, Inc. v. Biosig Licensing Inc., 134 S. Ct. 2120, 2124 (2014). But, Nautilus rejected the Fed. Cir.’s “amenable to construction” test for policing the public notice function of patent claims. Justice Scalia mockingly summarized the amenable-to-construction test as “There is no such thing as ambiguity, because there is always a right answer.” ([04/28/15 Nautilus Argument Transcript](#) at 40:12-13). Like any contractual or statutory provision, a patent claim may have multiple conflicting reasonable constructions (creating a zone of uncertainty for the skilled artisan) yet one of those may be the “correct” construction, or the “correct” “broadest reasonable interpretation” (BRI) in the Patent Office. Thus, courts routinely interpret contracts and statutes that have been deemed ambiguous.

2.2.2. **Nautilus Rejects The Claim-Construction-First, *Post Hoc* Approach**: The clarity and precision demand for patent claims is measured from the viewpoint of person of skill in the art “at the time the patent was filed,” “not that of a court viewing matters *post hoc*.” Nautilus, Inc. v. Biosig Instruments, Inc., 134 S. Ct. 2120, 2128, 2130 (2014); but see Biosig Instruments Inc. v. Nautilus, Inc., 783 F.3d 1374 (Fed. Cir. 2015) (on remand) (engaging in claim construction based in part on a reexamination more than 10 years after issuance, and not addressing conflicting clues in original intrinsic evidence). This rejected the Fed. Cir.’s hindsight, crystal-ball approach of first construing the claim and then asking if the claim so-construed provided sufficient notice.

2.2.3. **But Teva Pharm. Did Not Distinguish Claim Construction From “Indefiniteness”**: Some may argue that the above position distinguishing claim construction from the patent statute’s clarity and precision demand is undermined by

Teva Pharm. USA, Inc. v. Sandoz, Inc., 135 S. Ct. 831 (2015) (7-2) (overturning Fed. Cir.’s long-standing purely “de novo” review of claim constructions; in context of argument that claim language “molecular weight of 5 to 9 kilodaltons,” is “indefinite.”) But, this distinction between claim construction and “indefiniteness” was not argued or mentioned in Teva Pharm.

2.2.4. Propose Constructions For “Indefinite” Claim Language: One practical recommendation for patent challengers is to not shy away from proposing a claim construction and “indefiniteness” for the same claim language. But, be sure one’s expert understands the distinction.

2.2.5. The POSA Has No Crystal Ball: Post-Issuance Events (E.g., Reexam PH) Cannot Cure Lack Of Clarity And Precision Day Patent Issues: One specific distinction between policing the clarity and precision demand versus construing a patent claim, is the relevant evidentiary time period. Logic dictates that post-issuance disclosures and prosecution history cannot cure a lack of clarity in claims the day they issued. Although the S. Ct. did not expressly address this argument made by Nautilus, it seems to follow from Court’s admonition that clarity is measured from viewpoint of person of skill in the art “at the time the patent was filed,” “not that of a court viewing matters *post hoc*.” Nautilus, Inc. v. Biosig Instruments, Inc., 134 S. Ct. 2120, 2128, 2130 (2014).

2.2.5.1. At Nautilus argument, two Justices seemed to agree that a lack of clarity cannot be cured by post-issuance prosecution history, Nautilus argument. But see Interval Licensing LLC v. AOL, Inc., 766 F.3d 1364 (Fed. Cir. 2014) (affirming indefiniteness, relying in part on patent owner and Examiner disagreement in reexamination about claim scope); Biosig Instruments Inc. v. Nautilus, Inc., 783 F.3d 1374 (Fed. Cir. 2015) (on remand) (relying on reexamination prosecution history but without mentioning argument that this is improper.)

2.2.5.2. Possibly analogize using post-issuance prosecution to clarify claims to using reissue prosecution to reconstrue original patent’s claims, to avoid broadening, which is prohibited: “If the reissue claim itself could be used to redefine the scope of the original claim, this comparison [of the original and reissue claims] would be meaningless.” Arcelormittal France v. AK Steel Corp., Nos. 2014-1189, -1190, 2015 WL 2191218, *3 (Fed. Cir. May 12, 2015).

2.3. Enabling A Claim Does Not Make It Clear And Precise: Some Fed. Cir. panels properly distinguish whether a patent’s disclosure enables a person of skill in the art to practice inside the claim’s boundary (enablement) from the very different question of whether a patent’s claim is sufficiently clear and precise to allow a person of skill in the art to practice just outside the claim’s boundary with reasonable certainty of the claim’s boundary line; but some do not. Compare Eon Corp. IP Holdings LLC v. AT & T Mobility LLC, Nos. 2014-1392, -1393, 2015 WL 2083860 (Fed. Cir. May 6, 2015) with Biosig Instruments Inc. v. Nautilus, Inc., 783 F.3d 1374 (Fed. Cir. 2015) (on remand).

3. Apt Terminology For Enforcing The Statute’s Clarity And Precision Demand

3.1. Clear boundaries are necessary to Patent Law’s “second engine of innovation” (courtesy Jeff Dean, Amazon.com).

3.2. “Good fences make good neighbors” (courtesy Microsoft amicus brief).

3.3. Use “Clarity and Precision Demand” More Often Than Label “Indefiniteness”: The standard shorthand of “indefiniteness” may suggest that ambiguity is the only concern. It is not. E.g., a claim can lack particularity if it unambiguously recites a desired result without specifying how to achieve the result. Claims need to be both clear (distinct) and limited to a specific (particular) and precise solution. Better to refer to the claim’s failure to satisfy “the statute’s clarity and precision demand.” Nautilus, Inc. v. Biosig Instruments, Inc., 134 S. Ct. 2120, 2124 (2014).

4. Challenge Ambiguous Claims:

4.1. Nautilus indirectly but clearly prohibits ambiguous claims: “the Federal Circuit’s formulation, which tolerates some ambiguous claims but not others, does not satisfy the statute’s definiteness requirement;” “eliminating that temptation [to inject ambiguity into claims] is in order.” Nautilus, Inc. v. Biosig Instruments, Inc., 134 S. Ct. 2120, 2124 (2014).

4.1.1. Cf. In re Miyazaki, 89 U.S.P.Q.2d 1207 (BPAI 2008) (precedential) (“we hold that if a claim is amenable to two or more plausible claim constructions, the USPTO is justified in” rejecting the claim as indefinite.)

4.2. Possibly analogize to ambiguity under “step one” of Chevron U.S.A. Inc. v. Natural Res. Def. Council, Inc., 467 U.S. 837, 843 (1984) (“if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency’s answer is based on a permissible construction of the statute.”) Cf. Markman v. Westview Instruments, Inc., 52 F.3d 967, 986 (Fed. Cir. 1995) (*en banc*) (“This statutory language has as its purpose the avoidance of the kind of ambiguity that allows introduction of extrinsic evidence in the contract law analogy.”) Cf. Interval Licensing LLC v. AOL, Inc., 766 F.3d 1364, 1371 (Fed. Cir. 2014) (claims are indefinite when “‘might mean several different things’” and “‘no informed and confident choice is available among the contending definitions’”) (quoting Nautilus, Inc. v. Biosig Instruments, Inc., 134 S. Ct. 2120 (2014) quoting a trial court decision.); In re Packard, 751 F.3d 1307, 1313 (Fed. Cir. 2014) (“As the statutory language of ‘particular[ity]’ and ‘distinct[ness]’ indicates, claims are required to be cast in clear—as opposed to ambiguous, vague, indefinite—terms;” but “this requirement is not a demand for unreasonable precision.”)

5. Challenge Purely Functional Language, Especially At Point Of Novelty:

5.1. Challenge any “functional” claim language that does not comply with Sec. 112 (6/f) (see below) that is either purely “functional” (i.e., recites a “result” of overall device/method not a structure-impacting “function” of an element and not a “way” of achieving the result), or is functional at the purported point of novelty. This is an area where the Fed. Cir. deviates from the S. Ct. but USPTO follows S. Ct.

5.1.1. S. Ct.: “The vice of a functional claim exists not only when a claim is ‘wholly’ functional, if that is ever true, but also when the inventor is painstaking when he recites what has already been seen, and then uses conveniently functional language at the exact point of novelty. A limited use of terms of effect or result, which accurately define the essential qualities of a product to one skilled in the art, may in some instances be permissible and even desirable, but a characteristic essential to novelty may not be distinguished from the old art solely by its tendency to remedy the problems in the art met by the patent.” Gen. Elec. Co. v. Wabash Appliance Corp., 304 U.S. 364, 371-372 (1938) (claim recited “that the grains must be ‘of such size and contour as to prevent substantial sagging and offsetting’ during a commercially useful life for the lamp.”); United Carbon Co. v. Binney & Smith Co., 317 U.S. 228, 232 (1942) (rejecting claims describing product by its function/result, including one reciting “a pellet of approximately one-sixteenth of an inch in diameter and formed of a porous mass of substantially pure carbon black” (cited with approval in Markman v. WestView Instruments, Inc., 517 U.S. 370 (1996)); Halliburton Oil Well Cementing Co. v. Walker, 329 U.S. 1 (1946) (“unless frightened from the course of experimentation by broad functional claims like these, inventive genius may evolve many more devices to accomplish the same purpose.”) Cf. White v. Dunbar, 119 U.S. 47, 50 (1886) (“the object of an invention is a very different thing from the invention itself. The object may be accomplished in many ways; the invention shows one way.”)

5.1.2. USPTO: A claim may not contain a “purely functional claim element” with no limitation of structure, whether or not at the point of novelty, unless it triggers Sec. 112, ¶ 6. In re Miyazaki, 89 U.S.P.Q.2d 1207 (BPAI 2008) (precedential) (“the claimed ‘sheet feeding area operable to feed ...’ is a purely functional recitation with no limitation of structure” and thus unpatentable for lack of definiteness and lack of enablement); cf. In re Catlin, 90 U.S.P.Q.2d 1603 (BPAI 2009) (precedential) (if step “providing, at a merchant’s web site, means for a consumer to participate in an earning activity to earn value from a merchant” did not invoke Sec. 112 (6/f), then “the step simply recites purely functional language and would impermissibly cover every conceivable act for achieving the claimed result, and the scope of the claimed step would not be enabled.”)

5.1.3. Fed. Cir.: The Fed. Cir. takes a different view. A claim element may be defined in purely functional terms. Biosig Instruments Inc. v. Nautilus, Inc., 783 F.3d 1374 (Fed. Cir. 2015). But, a patent owner proposing construction of claim term at point of novelty (here, “fragile gel”) as covering, in effect, any and all means so long as they perform the recited functions, increases chance of indefiniteness ruling. Halliburton Energy Serv., Inc. v. M-I LLC, 514 F.3d 1244 (Fed. Cir. 2008); but see Star Sci., Inc. v. R.J. Reynolds Tobacco Co., 655 F.3d 1364 (Fed. Cir. 2011) (claim not indefinite; construed as “controlling one or more of humidity, temperature and airflow in the curing barn, in a manner different from conventional curing, in order to substantially prevent the formation of TSNAs.”).

5.1.4. TIP: Explain Clearly What Is Meant By “Functional”: Careful using this terminology. Consider characterizing the claim language per the DOE trilogy of “function” “way” and “result.” And, distinguish between functions that imply structure (“partly functional”) and those that do not (“purely functional”). The latter may include intended uses that are not inevitable.

6. Other Common Sources Of Uncertainty In Patent Claims

6.1. Uncertainty Whether Preamble Is Limitation Renders Claim Scope Uncertain: It often is disputed whether a preamble is limiting. That uncertainty often will render scope of claim uncertain.

6.2. Uncertainty Whether Claim Language Triggers Sec. 112 (6/f) Renders Claim Scope Uncertain: It often is disputed whether claim language triggers Sec. 112 (6/f). That uncertainty often renders scope of claim uncertain.

6.3. Uncertainty Whether Claim Term Itself Is “Functional” Renders Claim Scope Uncertain: Where claim recites a function or result, e.g., within a “whereby” or “wherein” clause, it often is unclear which if any structural elements in the claim are limited to structures that cause or contribute to that function. In Nautilus, for example, the claim term “spaced relationship” was ambiguous whether it included a functional requirement that caused the result recited in the claim’s whereby clause, which ambiguity caused ambiguity about the claim’s scope.

6.4. Disconnect With Disclosure: MPEP 2173.03 addresses inconsistencies in patent specification rendering patent claims indefinite. For example, specification says “may” where purpose requires “must.” See also PureChoice, Inc. v. Honeywell Int’l, Inc., 333 Fed. Appx. 544 (Fed. Cir. 2009) (non-precedential) (claim terms not used or explained in specification and appear inconsistent with embodiments in specification.)

6.5. Word Of Degree Without Sufficient Positive And Negative Examples: Word of degree “readily” in “said wax guard being readily installed and replaced by a user,” not indefinite where patent gave example of design that satisfied this claim requirement and an example that did not. Hearing Components, Inc. v. Shure Inc., 600 F.3d 1357 (Fed. Cir. 2010); Deere & Co. v. Bush Hog, LLC, 703 F.3d 1349 (Fed. Cir. 2012) (neither “substantially planar” nor “easily wash off” renders claims indefinite, in view of clarifying language in specification and prosecution history); Accentra Inc. v. Staples, Inc., 500 Fed. Appx. 922 (Fed. Cir. 2013) (non-precedential) (reversing summary judgment of invalidity; no clear and convincing evidence that “near” renders claim indefinite in claim to a stapler reciting “a pressing area near a front end of the handle.”); but see Interval Licensing LLC v. AOL, Inc., 766 F.3d 1364, 1373 (Fed. Cir. 2014) (although words of degree may be sufficiently clear, as in Eibel Process, here refusing to “post hoc” adopt a single “e.g.,” example as the “exclusive definition of a facially subjective claim term”).

6.6. Test For Compliance Unspecified In Patent: Where patent fails to specify which of available alternative tests to use for measuring compliance with a claim limitation, and different tests can have different results, the claims are indefinite. Honeywell Int’l, Inc. v. Int’l Trade Comm’n, 341 F.3d 1332 (Fed. Cir. 2003); but see Wellman, Inc. v. Eastman Chem. Co., 642 F.3d 1355 (Fed. Cir. 2011) (distinguishing Honeywell and reversing summary judgment of indefiniteness); Dow Chem. Co. v. Nova Chem. Corp., 458 Fed. Appx 910 (Fed. Cir. 2012) (non-precedential) (“slope of strain hardening coefficient” not indefinite, even though was not a term of art and drawing promised by specification to help illustrate where to measure this slope, was missing from the patent app.).

6.7. Failure To Define Clear Distinction Over Prior Art: “Whether the patent expressly or at least clearly differentiates itself from specific prior art ... is an important

consideration in the definiteness inquiry.” Halliburton Energy Serv., Inc. v. M-I LLC, 514 F.3d 1244, 1252 (Fed. Cir. 2008).

6.8. Hybrid Claim Directed To Thing And Method Of Using Thing, Is “Indefinite”: Claim is indefinite if it claims both a system and a method of using the system. IPXL Holdings, LLC v. Amazon.com, Inc., 430 F.3d 1377 (Fed. Cir. 2005) (“wherein ... the user uses”); accord H-W Tech., L.C. v. Overstock.com, Inc., 758 F.3d 1329 (Fed. Cir. 2014) (affirming summary judgment of indefiniteness of CRM claim reciting method steps “where said user ...”); In re Katz, 639 F.3d 1303, 1318 (Fed. Cir. 2011) (invalidating system claim reciting “interface means for providing automated voice messages...to certain of said individual callers, wherein said individual callers digitally enter data”); Rembrandt Data Tech., LP v. AOL, LLC, 641 F.3d 1331 (Fed. Cir. 2011) (affirming invalidity for indefiniteness of apparatus claim that recited several means elements and ended with step “transmitting the trellis encoded frames,” refusing to redraft the elements into a means element); Nassau Precision Casting Co., Inc. v. Acushnet Co., Inc., 566 Fed. Appx. 933 (Fed. Cir. 2014) (non-precedential) (dictum citing IPXL with approval); cf. Microprocessor Enhancement Corp. v. Tex. Instruments Inc., 520 F.3d 1367 (Fed. Cir. 2008) (following language is functional, not a method step invalidating the claim: “a pipeline processor for executing instructions comprising...fetching means for fetching source operands specified by said operand specifiers; operating means for performing the operation specified by said opcode....”); HTC Corp. v. IPCOM GmbH & Co., 667 F.3d 1270, 1277 (Fed. Cir. 2012) (reversing hybrid-claim indefiniteness judgment; alleged method steps merely recited environment for the claimed device; claims used “preamble-within-a-preamble” format).

6.8.1. Consider Arguing That Claim Must Be As Precise As the Subject Matter Permits: In 1980s/1990s, Fed. Cir. said that a claim needs to be (only) as precise as the subject matter permits, citing to Georgia-Pacific Corp. v. U.S. Plywood Corp., 258 F.2d 124 (2d Cir. 1958) (claim valid). Making that a necessary (but not sufficient) requirement seems consistent with Nautilus, Inc. v. Biosig Instruments, Inc., 134 S. Ct. 2120 (2014).

7. Where Does This Invalidity Ground Fit Within The Fed. R. Civ. P.?

7.1. Impact of Teva And FRCP 52 On Appellate Review Of “Indefiniteness” Summary Judgment Rulings: In questionable line of cases, Fed. Cir. has stated that trial courts find facts when deciding “indefiniteness” summary judgment motions and therefore Teva Pharm. USA, Inc. v. Sandoz, Inc., 135 S. Ct. 831 (2015) applies and “we review these subsidiary factual determinations for clear error.” Eon Corp. IP Holdings LLC v. AT & T Mobility LLC, Nos. 2014-1392, -1393, 2015 WL 2083860 (Fed. Cir. May 6, 2015) (affirming summary judgment of Sec. 112 (6/f)-based “indefiniteness;” trial court had Markman hearing; summary judgment hearing, and took expert testimony); Biosig Instruments Inc. v. Nautilus, Inc., 783 F.3d 1374 (Fed. Cir. 2015) (on remand) (but relying on only purportedly intrinsic evidence); Eidos Display, LLC v. AU Optronics Corp., 779 F.3d 1360 (Fed. Cir. 2015) (same).

7.1.1. TIP: Consider challenging this. This conflates trial court subsidiary fact finding on claim construction (which is not a jury issue) with summary judgment proceedings on a defense that can be tried to a jury, presumably. Rather than find facts, trial courts determine under Rule 56 whether there are any facts that need to be found (i.e., genuinely disputed material facts), and therefore summary judgment decisions do not

trigger Rule 52 or “clear error” review. *E.g.*, Burlington Indus., Inc. v. Dayco Corp., 849 F.2d 1418, 1420 (Fed. Cir. 1988) (“In reviewing a trial court’s grant of summary judgment, an appellate court is not bound by the ‘clearly erroneous’ rule, because proper summary judgment is not based on debatable findings of fact.”)

8. Nautilus And Its Initial Reception At the Fed. Cir.:

8.1. S. Ct. rejected the Fed. Cir.’s “amenable to construction” and “insolubly ambiguous” test (which Fed. Cir. had adopted in 2001) as not even “probative of the essential inquiry,” mandating instead a “reasonable certainty” and “clear notice” standard: “We conclude that the Federal Circuit’s formulation, which tolerates some ambiguous claims but not others, does not satisfy the statute’s definiteness requirement. In place of the ‘insolubly ambiguous’ standard, we hold that a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” Nautilus, Inc. v. Biosig Instruments, Inc., 134 S. Ct. 2120, 2124, 2129, 2130 (2014) (9-0), on remand, Biosig Instruments Inc. v. Nautilus, Inc., 783 F.3d 1374 (Fed. Cir. 2015) (again reversing summary judgment of indefiniteness). “To tolerate imprecision just short of that rendering a claim ‘insolubly ambiguous’ would diminish the definiteness requirement’s public-notice function and foster the innovation-discouraging ‘zone of uncertainty.’” *Id.* See White v. Dunbar, 119 U.S. 47, 52 (1886) (“The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is”); Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722, 730 (2002) (“clarity is essential to promote progress”).

8.1.1. Presumption of validity does not alter degree of clarity required by the statute. *Id.*

8.1.2. Question of law. *Cf.* Nautilus, Inc. v. Biosig Instruments, Inc., 134 S. Ct. 2120, 2132 n.10 (2014) (expressly not deciding “whether factual findings subsidiary to the ultimate issue of definiteness trigger the clear-and-convincing evidence standard and, relatedly, whether deference is due to the PTO’s resolution of disputed issues of fact.”)

8.2. “Clarity and Precision,” “Reasonable Certainty” And “Clear Notice” Required: “Cognizant of the competing concerns, we read § 112, ¶ 2 to require that a patent’s 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 definiteness requirement, so understood, mandates clarity, while recognizing that absolute precision is unattainable. The standard we adopt accords with opinions of this Court stating that ‘the certainty which the law requires in patents is not greater than is reasonable, having regard to their subject-matter.’ *Minerals Separation, Ltd. v. Hyde*, 242 U.S. 261, 270 (1916). See also *United Carbon*, 317 U.S., at 236 (‘claims must be reasonably clear-cut’); *Markman*, 517 U.S., at 389 (claim construction calls for ‘the necessarily sophisticated analysis of the whole document,’ and may turn on evaluations of expert testimony).” Nautilus, Inc. v. Biosig Instruments, Inc., 134 S. Ct. 2120, 2124 (2014) (referring to “the statute’s clarity and precision demand”). Permits “some modicum of uncertainty.” *Id.* “A patent must be precise enough to afford clear notice of what is claimed, thereby “‘appris[ing] the public of what is still open to them,’” in a manner that avoids “[a] zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims.” *Id.* (citations omitted); see Eon Corp. IP Holdings LLC v. AT & T Mobility LLC, Nos.

2014-1392, -1393, 2015 WL 2083860, *5 (Fed. Cir. May 6, 2015) (Nautilus “warned against ‘diminish[ing] the definiteness requirement’s public-notice function and foster[ing] the innovation-discouraging zone of uncertainty against which this Court has warned.’”); cf. Akamai Tech., Inc. v. LimeLight Networks, Inc., Nos. 2009-1372, -1417, -1380, -1416, 2015 WL 2216261, *6 (Fed. Cir. May 13, 2015) (2-1) (“the patentee specifically defines the boundaries of his or her exclusive rights in the claims appended to the patent and provides notice thereby to the public so that it can avoid infringement.”))

8.3. Finding “Indefiniteness” Post Nautilus: Teva. Pharm. USA v. Sandoz, Inc. (Fed. Cir. No. 2012-1567 June 18, 2015) (“there is not reasonable certainty that molecular weight should be measured using M_p ”); Interval Licensing LLC v. AOL, Inc., 766 F.3d 1364, 1368, 1371, 1372, 1374 (Fed. Cir. 2014) (affirming indefiniteness of display “in an unobtrusive manner that does not distract a user” as “highly subjective” and with only a “hazy relationship” with the written description; claims must provide “objective boundaries”).

8.4. Rejecting “Indefiniteness” Post Nautilus: Biosig Instruments Inc. v. Nautilus, Inc., 783 F.3d 1374, 1379 (Fed. Cir. 2015) (on remand) (copying and pasting much of its original panel opinion reversing summary judgment of indefiniteness, and seemingly mocking the S. Ct.’s “reasonable certainty” standard: “The Court has accordingly modified the standard by which lower courts examine allegedly ambiguous claims; we may now steer by the bright star of ‘reasonable certainty,’ rather than the unreliable compass of ‘insoluble ambiguity.’”); Apple Inc. v. Samsung Elec. Co., Ltd., Nos. 2014-1335, -1029, 2015 WL 2343543 (Fed. Cir. May 18, 2015) (“‘substantially centered’” on the display” sufficiently precise in view of patent owner’s expert testimony and embodiment in specification); Eidos Display, LLC v. AU Optronics Corp., 779 F.3d 1360 (Fed. Cir. 2015) (reversing summary judgment of indefiniteness: specification makes clear that “a contact hole for source wiring and gate wiring connection terminals” means a separate hole for each terminal); Warsaw Orthopedic, Inc. v. NuVasive, Inc., 778 F.3d 1365 (Fed. Cir. 2015) (claim recited implant dimensions relative to size of vertebrae; not indefinite as parties stipulated average dimensions of vertebrae well known); Lexington Luminance LLC v. Amazon.com Inc., 601 Fed. Appx. 963 (Fed. Cir. 2015) (non-precedential) (reversing R. 12(c) judgment of indefiniteness of open-ended Markush limitation (“said substrate is *selected from the group comprising* group III-V, group IV, ...”): “intrinsic record is reasonably definite in indicating what the claim covers because the specification lays out a considerable list of exemplary substrates” and thus “the reasonably ascertainable meaning of the contested claim language is that the substrate must contain one or more of the enumerated members of the claimed group”); DDR Holdings, LLC v. Hotels.com, L.P., 773 F.3d 1245 (Fed. Cir. 2014) (affirming rejection of indefiniteness defense: “‘look and feel’ is not a facially subjective term” but rather “had an established meaning in the art by the relevant timeframe” as shown by challenger’s use of the term and admissions at trial). Cf. Ancora Tech., Inc. v. Apple, Inc., 744 F.3d 732, 737 (Fed. Cir. 2014) (affirming rejection of indefiniteness defense; citing Nautilus cert. pending; “the claim language and the prosecution history leave no reasonable uncertainty about the boundaries of the terms at issue, even considering certain aspects of the specification [referring to a hard disk as an example of “volatile memory”] that could engender confusion when read in isolation.”))

8.4.1. Claims Fail To “Clearly Circumscribe” What Is Foreclosed: In addition to “reasonable certainty” and “clear notice,” urge also the “clearly circumscribe” S. Ct. standard: “The statutory requirement of particularity and distinctness in claims is met only

when they clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise. A zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field.” United Carbon Co. v. Binney & Smith Co., 317 U.S. 228, 236 (1942) (cited with approval in Markman v. WestView Instruments, Inc., 517 U.S. 370 (1996) and Nautilus, Inc. v. Biosig Instruments, Inc., 134 S. Ct. 2120, 2132 n.6 (2014).). Cf. Interval Licensing LLC v. AOL, Inc., 766 F.3d 1364, 1374 (Fed. Cir. 2014) (artisan “is still left to wonder what other forms for display are unobtrusive and non-distracting. What if a displayed image takes up 20% of the screen space occupied by the primary application with which the user is interacting? Is the image unobtrusive?”)

8.4.2. Identify Conflicting “Clues” In The Intrinsic Evidence: If it sounds like a mystery novel, it’s likely invalid. See Interval Licensing LLC v. AOL, Inc., 766 F.3d 1364, 1372 (Fed. Cir. 2014) (“the specification is at best muddled,” noting that different portions of the specification suggested different meanings of the claim language). Argue “competing plausible interpretations.”

9. The Provisional Safe Harbor For “Functional Claiming”: Sec. 112 (2/b) + Sec. 112 (6/f)

9.1. BASICS: Congress “struck a balance in allowing patentees to express a claim limitation by reciting a function to be performed rather than by reciting structure for performing that function, while placing specific constraints on how such a limitation is to be construed, namely, by restricting the scope of coverage to only the structure, materials, or acts described in the specification as corresponding to the claimed function and equivalents thereof.” Williamson v. Citrix Online LLC, No. 2013-1130, 2015 WL 3687459, *5 (Fed. Cir. June 16, 2015) (Fed. Cir. en banc part). In part, this provides a provisional safe harbor from functional-claiming “indefiniteness,” if specification satisfies its requirements. But, claims invoking this provision often are invalid for not being particular and distinct, for failure of the patent to disclose the required structure.

9.2. En Banc Fed. Cir. Expands Language Triggering Sec. 112 (6/f): Word “means” creates presumption that Sec. 112 (6/f) is triggered and absence of word “means” creates presumption that it is not. But, overruling Fed. Cir. case law since 2004, latter presumption is not “strong.” Rather, “the essential inquiry is not merely the presence or absence of the word ‘means’ but whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure” or “or else recites ‘function without reciting sufficient structure for performing that function.’” Williamson v. Citrix Online LLC, No. 2013-1130, 2015 WL 3687459, *6 (Fed. Cir. June 16, 2015) (Fed. Cir. en banc part). “We also overrule the strict requirement of ‘a showing that the limitation essentially is devoid of anything that can be construed as structure.’” Id. at *7. See Williamson, 2015 WL 3687459 at *8 (Fed. Cir. June 16, 2015) (Fed. Cir. panel part) (affirming “indefiniteness”; claim element triggers Sec. 112 (6/f): “a *distributed learning control module* for receiving communications transmitted between the presenter and the audience member computer systems and for relaying the communications to an intended receiving computer system and for coordinating the operation of the streaming data module,” because uses format of “means” element and replaces “means” with “nonce word” “module” which, like “means,” is a “generic,” “black box” “description for software or hardware

that performs” a specified function, and the written description’s description of the element “fails to impart any structural significance” to the term.”))

9.2.1. Arguing Williamson: Argue that any supposed structural element in claim which does not meaningfully limit how the recited function is achieved, triggers 112 (6/f).

9.2.2. Argue That “Information Plus Function” Does Not Trigger Sec. 112 (6/f) Safe Haven: Per USPTO Legal Training Module [guidance](#) (08/02/13): “Terms that represent only non-structural elements such as information, data, instructions, and software *per se* would not serve as substitutes for “means”, because the terms do not serve as placeholders for structure or material.”

9.2.3. Argue That A “Result” Is Not A “Specified Function” (35 USC 112(f)) And Does Not Trigger Sec. 112(f) Safe Haven: Courts generally tend to use word “function” broadly to encompass what under “equivalents” law would be considered a “result” as well as a “function.” But the statutory text uses “function” more narrowly: “for performing a specified function,” which suggests that “function” is the action the element is designed to perform, not the outcome to be achieved. Consider arguing that a “means for [result]” is not saved by Sec. 112(f), which is limited to true means for function elements. E.g., look to the specification for some intermediate action/function between the structure and the result recited in the claim, and argue that that was the “function.”

9.3. Structure Must Be Clearly Linked To The Claim-Recited Function: Specification must disclose the structure and clearly link it to the claimed function; it is not sufficient that a structure was well known in the art for performing such function. Medtronic, Inc. v. Adv. Cardiovascular Sys., Inc., 248 F.3d 1303 (Fed. Cir. 2001); MobileMedia Ideas LLC v. Apple Inc., 780 F.3d 1159 (Fed. Cir. 2015) (reversing infringement judgment based on too-broad interpretation of corresponding structure); Saffran v. Johnson & Johnson, 712 F.3d 549 (Fed. Cir. 2013) (corresponding structure limited to “hydrolyzable bonds,” not more generic “chemical bonds and linkages.”) (2-1) (reversing judgment of infringement).

9.4. Only That Portion Of Structure Necessary To The Claimed Function: The corresponding structure is only that part of the disclosed structure necessary to performing that claimed function. John Mezzalingua Assocs. v. Int’l Trade Comm’n, 437 Fed. Appx. 886 (Fed. Cir. 2010) (non-precedential); Univ. of Pitt. v. Varian Med. Sys., Inc., 561 Fed. Appx. 934 (Fed. Cir. 2014) (corresponding algorithm is only what is necessary to perform the function, here two-step algorithm described in the background, not more detailed optional implementations later in specification).

9.5. “Structure” Need Not Be Physical: “The ‘structure’ of computer software is understood through, for example, an outline of an algorithm, a flowchart, or a specific set of instructions or rules.” Apple Inc. v. Motorola, Inc., 757 F.3d 1286 (Fed. Cir. 2014) (2-1) (in context of overcoming presumption that claim element “heuristics” is not a means-plus-function element).

9.5.1. Preserve Objection To This Questionable Case Law; Argue That An Algorithm Is A Series Of Acts, Not A Structure: Following long usage in the Fed. Cir, including in Alappat, the PTO and courts refer to an algorithm practiced by a general-purpose computer as structure, or as imparting structure to the computer. Consider

contesting this characterization. E.g., saying that a computer performs a certain algorithm does not dictate any particular structure in the computer. Instead, an algorithm is a series of acts. If those acts are sufficiently particular to narrow the scope of the claim as required under Sec. 112(f), then that satisfies the statute, even without calling the algorithm a structure. That is because the statute speaks of “structure, material or acts,” and does not limit “acts” to “step for” claim elements. So, consider interpreting the claim element’s corresponding “structure material or acts” as “a general-purpose computer specially programmed/configured to perform the following acts:”

9.6. “Structure” Cannot Be Purely Functional (E.g., Any Circuit That Performs The Function): Identifying structure as “any circuit that performs the claim function” is “no more specific than defining” the means “in purely functional terms” which is “prohibited.” Tomita Tech. USA, LLC v. Nintendo Co., Ltd., 594 Fed. Appx. 657 (Fed. Cir. 2014) (non-precedential) (reversing district court claim construction).

9.7. The Opposite Of Claim Differentiation Applies: Where a dependent claim recites that the means-plus-function element comprises a particular structure that supports a construction that such structure is the “corresponding structure” for that element. Medtronic, Inc. v. Adv. Cardiovascular Sys., Inc., 248 F.3d 1303 (Fed. Cir. 2001).

9.8. Invalid If Means-Plus-Function Claim Element Without Disclosure Of Corresponding Structure: A means-plus-function element with arguably no linked and specific corresponding structure in the written description is the best candidate for invalidity for lack of particular and distinct claims. E.g., claim reciting “control means for automatically operating said valving” was invalid where only references in disclosure to “control means” were “a box labeled ‘Control’ [in drawing] and a statement that the regeneration process of the invention ‘may be controlled automatically by known differential pressure, valving and control equipment.’” “A bare statement that known techniques or methods can be used does not disclose structure.” Biomedino, LLC v. Waters Tech. Corp., 490 F.3d 946 (Fed. Cir. 2007); accord Bosch v. Snap-On Inc., 769 F.3d 1094 (Fed. Cir. 2014) (affirming invalidity for indefiniteness where “program recognition device” and “program loading device” triggered 112 (6/f) and lacked corresponding structure in specification, despite expert declaration); Triton Tech of Tex., LLC v. Nintendo of Am., Inc., 753 F.3d 1375, 1377 (Fed. Cir. 2014) (affirming summary judgment; specification stated that the claim-recited numerical integration function is performed in a “conventional manner”); Function Media, LLC v. Google Inc., 708 F.3d 1310 (Fed. Cir. 2013) (affirming summary judgment of indefiniteness; patent includes no disclosure of how the program performs the transmitting function); Ergo Licensing, LLC v. CareFusion 303, Inc., 673 F.3d 1361, 1365 (Fed. Cir. 2012) (disclosure of control device with memory insufficient structure to support claimed means for “controlling the adjusting means,” where expert showed that there were multiple different types of control devices in the art). Contra Elcommerce.com v. SAP AG, 745 F.3d 490 (Fed. Cir. 2014) (2-1) (vacating summary judgment of invalidity; specification descriptions of acts and functions performed was sufficient where uncontested that person of skill in the art would have understood how to implement without undue experimentation), vacated, 564 Fed. Appx. 599 (Fed. Cir. 2014).

9.9. Programmed Processors And Algorithms: Compare Aristocrat Tech. Austl. PTY Ltd. v. Multimedia Games, Inc., 266 Fed. Appx. 942 (Fed. Cir. 2008) (non-precedential) (reversing SJ indefiniteness; remanding for fact determinations on level of skill in art and whether sufficient corresponding structures and algorithms were disclosed to one of ordinary skill) with Aristocrat

Tech. Austl. PTY Ltd. v. Int’l Game Tech., 521 F.3d 1328, 1334 (Fed. 2008) (affirming SJ indefiniteness where sole specification disclosure of “control means” was that persons of ordinary skill would know how “to introduce the methodology on any standard microprocessor base [sic] gaming machine by means of appropriate programming.” long discussion of WMS Gaming line of case law); Encyclopaedia Britannica, Inc. v. Alpine Elec., Inc., 355 Fed. Appx. 389 (Fed. Cir. 2009) (non-precedential) (specification must disclose the algorithm that performed the recited function no matter how simple that function is); Brown v. Baylor Healthcare Sys., 381 Fed. Appx. 981 (Fed. Cir. 2010) (claim indefinite for lack of disclosed algorithm corresponding to “means for processing” even though Examiner suggested the claim language) (non-precedential); Dealertrack, Inc. v. Huber, 674 F.3d 1315, 1329 (Fed. Cir. 2012) (“the appropriate structure must include the algorithms disclosed in the specification that ‘implement[] and control[] credit application processing and routing,’” but where specification discloses alternative algorithms, only one (or its equivalent) need be met by accused structure).

9.10. Clear And Convincing Evidence: A lack of disclosure of structure adequate to perform recited function must be shown by clear and convincing evidence. Chi. Bd. Options Exch., Inc. v. Int’l Sec. Exch., LLC, 748 F.3d 1134 (Fed. Cir. 2014) (reversing summary judgment of indefiniteness, based on sufficient disclosure of algorithm for computer); TecSec, Inc. v. Int’l Business Machines Corp., 731 F.3d 1336 (Fed. Cir. 2013) (sufficient disclosure of algorithms); Creative Integrated Sys., Inc. v. Nintendo of Am., Inc., 526 Fed. Appx. 927 (Fed. Cir. 2013) (non-precedential); Aerotel, Ltd. v. Telco Group, Inc., 433 Fed. Appx. 903 (Fed. Cir. 2011) (non-precedential).

9.11. Function Performed By Computer Or Processor: Failure to disclose an algorithm (i.e., a step-by-step procedure) practiced by software renders claim indefinite. Net MoneyIn, Inc. v. Verisign, Inc., 545 F.3d 1359, 1367 (Fed. Cir. 2008) (“[A] means-plus-function claim element for which the only disclosed structure is a general purpose computer is invalid if the specification fails to disclose an algorithm for performing the claimed function.”) “Simply disclosing a black box that performs the recited function is not a sufficient explanation of the algorithm required to render the means-plus-function term definite.” Augme Tech., Inc. v. Yahoo! Inc., 755 F.3d 1326, 1328 (Fed. Cir. 2014) (disclosing inputs to and outputs from “code assembler instructions” does not disclose an algorithm for how the claimed assembly function is performed; affirming summary judgment of indefiniteness); Triton Tech of Tex., LLC v. Nintendo of Am., Inc., 753 F.3d 1375, 1377 (Fed. Cir. 2014) (affirming summary judgment of indefiniteness; multiple different algorithms were known for performing the numerical integration function, but specification disclosed no particular algorithm, instead saying function is performed in a “conventional manner”); Ibormeith IP, LLC v. Mercedes-Benz USA, LLC, 732 F.3d 1376, 1382 (Fed. Cir. 2013) (affirming summary judgment of indefiniteness: “A description of an algorithm that places no limitations on how values are calculated, combined, or weighted is insufficient to make the bounds of the claim understandable.”); HTC Corp. v. IPCom GmbH & Co., 667 F.3d 1270, 1282 (Fed. Cir. 2012) (“The necessity of an algorithm has been well established at least since WMS Gaming, a 1999 case.”); Finisar Corp. v. The DirecTV Group, Inc., 523 F.3d 1323, 1341 (Fed. Cir. 2008) (may describe the system “in any understandable terms including as a mathematical formula, in prose, or as a flow chart, or in any other manner that provides sufficient structure”); Dealertrack, Inc. v. Huber, 674 F.3d 1315 (Fed. Cir. 2012) (dependent claims that added function to be performed by the means element (“central processing means computer program ... further provides for tracking pending credit applications”), indefinite because no

algorithm disclosed for that function). A description that merely recites the function without describing how it is achieved, does not provide sufficient “structure.” Blackboard, Inc. v. Desire2Learn Inc., 574 F.3d 1371 (Fed. Cir. 2009); accord Eon Corp. IP Holdings LLC v. AT & T Mobility LLC, Nos. 2014-1392, -1393, 2015 WL 2083860 (Fed. Cir. May 6, 2015) (affirming summary judgment of invalidity; WMS Gaming correct despite reliance on since-overruled Alappat); Stamps.com, Inc. v. Endicia, Inc., 437 Fed. Appx. 897 (Fed. Cir. 2011) (non-precedential); In re Aoyama, 656 F.3d 1293, 1298 (Fed. Cir. 2011) (affirming PTO indefiniteness rejection where flowchart (and description) “fails to describe, even at a high level, how a computer could be programmed to produce the structure that provides the results described in the boxes.”); cf. Typhoon Touch Tech., Inc. v. Dell, Inc., 659 F.3d 1376, 1386 (Fed. Cir. 2011) (reversing invalidity ruling on this ground, “it suffices if the specification recites in prose the algorithm to be implemented by the programmer”); HTC Corp. v. IPCom GmbH & Co., 667 F.3d 1270, 1279 (Fed. Cir. 2012) (specification need not literally disclose the corresponding structure (here a processor and transceiver) if person skilled in the art would understand that the disclosed device “would have to contain” those structures); EPlus, Inc. v. Lawson Software, Inc., 700 F.3d 509, 519 (Fed. Cir. 2012) (“There is no instruction for using a particular piece of hardware, employing a specific source code, or following a particular algorithm. There is therefore nothing in the specification to help cabin the scope of the functional language in the means for processing element.”)

9.11.1. Processor And Transceiver = General-Purpose Computer: HTC Corp. v. IPCom GmbH & Co., 667 F.3d 1270, 1280 (Fed. Cir. 2012) (dictum; because argument waived) (“The processor and transceiver amount to nothing more than a general-purpose computer,” and thus an algorithm needed to be disclosed as well).

9.11.2. But, Basic Functions Of A General-Purpose Computer Do Not Need Disclosure Of Special Structure/Algorithm: a “means for” “processing,” or “receiving,” or “storing” in effect recites a general-purpose computer, not “specific functions” requiring “special programming,” i.e., “a particular function not disclosed simply by a reference to a general purpose computer;” WMS Gaming and Aristocrat “involved specific functions that would need to be implemented by programming a general purpose computer to convert it into a special purpose computer capable of performing those specified functions.” In re Katz, 639 F.3d 1303 (Fed. Cir. 2011) (but rejecting other claims reciting special functions, for indefiniteness); cf. Eon Corp. IP Holdings LLC v. AT & T Mobility LLC, Nos. 2014-1392, -1393, 2015 WL 2083860, *3, 5 (Fed. Cir. May 6, 2015) (affirming summary judgment of invalidity; Katz’s “narrow exception” to “the algorithm rule” does not apply to any functions other than basic functions of a computer: “‘special programming’ does not denote a level of complexity . . . ; ‘special programming’ includes any functionality that is not ‘coextensive’ with a microprocessor or general purpose computer”); Ergo Licensing, LLC v. CareFusion 303, Inc., 673 F.3d 1361, 1364 (Fed. Cir. 2012) (Katz “a narrow exception”); Noah Sys., Inc. v. Intuit Inc., 675 F.3d 1302, 1315 (Fed. Cir. 2012) (“The acts of ‘entering’ ‘deleting’ ‘reviewing’ and ‘adjusting’ financial transaction data . . . are specialized functions which cannot be accomplished absent specialized programming.”)

9.11.3. Only If Specification Discloses Some Algorithm For Performing Entire Claimed Function Need Court Consider Person Of Skill In The Art?: Court is “required to consider patentee’s argument and evidence regarding what one skilled in the art would

understand from the specification before determining whether the claim was indefinite,” only if patent discloses some algorithm for performing the entirety of the claim-recited function. Noah Sys., Inc. v. Intuit Inc., 675 F.3d 1302 (Fed. Cir. 2012) (affirming summary judgment of invalidity; algorithm disclosed was for performing only part of the function so no need to consider expert testimony); accord Eon Corp. IP Holdings LLC v. AT & T Mobility LLC, Nos. 2014-1392, -1393, 2015 WL 2083860 (Fed. Cir. May 6, 2015). Contra Elcommerce.com v. SAP AG, 745 F.3d 490 (Fed. Cir. 2014) (2-1) (vacating summary judgment of invalidity; trial court erred by not requiring expert testimony or other evidence of whether person of skill in the art would have found sufficient structure and acts in the specification), vacated, 564 Fed. Appx. 599 (Fed. Cir. 2014).