

Ex parte Miyazaki: Definite Difficulty With BPAI's New Standard for Indefiniteness

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Introduction

“The specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy.”²

Drafting claims just became more difficult. In a rare precedential opinion, the Board of Patent Appeals and Interferences (“BPAI”) adopted a new standard of indefiniteness under 35 U.S.C. 112, second paragraph in *Ex parte Miyazaki*:³

[I]f a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite.”⁴

Consider the difficulty in writing *anything* that is not subject to multiple *plausible* constructions, let alone the difficulty in writing claims meant to capture the full breadth of an invention in a way such that each claim is subject to a single *plausible* construction. This decision has the potential to make indefiniteness rejections a persistent concern for all patent practitioners.

Whenever claims are submitted to the United States Patent and Trademark Office (“USPTO”) for examination, an examiner is presumed to have reviewed them to ensure that they “particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.”⁵ The claim language must be clear for many reasons. An

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² *Topliff v. Topliff*, 145 U.S. 156, 171 (1892).

³ 89 U.S.P.Q.2d (BNA) 1207 (BPAI Nov. 19, 2008).

⁴ *Ex parte Miyazaki*, 89 U.S.P.Q.2d (BNA) 1207, 1211 (BPAI Nov. 19, 2008).

⁵ See USPTO, MANUAL OF PATENT EXAMINING PROCEDURE § 2171 (8th ed., rev. 7 2008) [hereinafter MPEP], available at <http://www.uspto.gov/web/offices/pac/mpep/mpep.htm> (describing one of the requirements of 35 U.S.C. 112, second paragraph).

examiner must be able to determine the periphery of the applicant's invention in order to determine whether the prior art precludes the coverage sought by the applicant. As a public policy justification, the claim language must be clear so as to put the public on notice of what activity will infringe an applicant's patent.⁶ Thus, if the claims submitted for examination are so unclear as to render the claims indefinite, an examiner should issue a rejection under 35 U.S.C. 112, second paragraph to force the applicant to more clearly define the outer boundaries of the claims.⁷

The USPTO uses the "broadest reasonable interpretation" standard ("BRI") when examining claims.⁸ This standard requires the USPTO to apply "the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account...the written description contained in the applicant's specification."⁹ One reason the USPTO uses the BRI standard is to ensure that an applicant does not receive more than he is entitled to because the examiner searched a narrower swath of prior art based on an unnecessarily narrow interpretation of the scope of a claim. Additionally, during prosecution, an applicant can always narrow a claim if its broadest reasonable interpretation reads on prior art found by the examiner.

When the words in a claim are given their broadest reasonable interpretation, what determines if the claim as a whole is indefinite? Traditionally, claims were indefinite only if they were not amenable to construction.¹⁰ That is, if a claim is amenable to two constructions, one of which makes sense to a person of skill in the art while the other does not, the claim is interpreted in the way that makes sense and it is not indefinite. The *Miyazaki* standard, however, renders a claim indefinite for having two *plausible* constructions. This new standard and the exacting perfection in language that it seemingly requires would have a negative overall effect on a practitioner's ability to have definite claims which protect the full breadth of a patentee's invention.

Further Implications

Consider claim 1 of the appellants' application analyzed in *Miyazaki*. The claim was to a large printer comprising a paper feeding unit "being located at a height that enables a user, who is approximately 170 cm tall, standing in front of the printer to execute the paper feeding process."¹¹ Is the claimed height of the paper feeding unit indefinite? The BPAI found this height limitation indefinite because it failed "to specify...a positional relationship of the user and

⁶ See MPEP at § 2173.

⁷ See MPEP at § 2171.

⁸ See MPEP at § 2111.

⁹ *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). For a more recent enunciation of the BRI standard, see *In re Am. Acad. Of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

¹⁰ See, e.g., *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001).

¹¹ *Id.* at 1208.

the printer to each other.”¹² For instance, both the user and the printer could be resting on the ground, and we would have one range of heights “X” for the paper feed unit. However, if the user is on the ground while the printer is resting on an elevated table, the paper feeding unit would be at another range of heights “Y”. The BPAI stated that “[a]n infinite number of combinations of printer and user positions could be envisioned such that the above-recited language of claim 1 does not, in fact, impose a structural limitation on the height of the paper feeding unit of the claimed printer.”¹³

Under the traditional indefiniteness analysis, the claims would not be rejected as indefinite if they could be interpreted in a way that made sense to a person of skill in the art. If a person of skill in the art would understand the claim to recite that the user and printer are both at ground level because that is where they are oriented in relation to each other when a user ordinarily uses a printer, then the claim would not be rejected as indefinite. According to the holding of *Miyazaki*, the person of skill in the art appears irrelevant; as long as *any* person can come up with more than one *plausible* construction of a claim, even if one of these constructions would be ridiculous when considered by a person of skill in the art, then the claim can be rejected as indefinite.

To realize how difficult it is to write *any* sentence that is not subject to more than one construction, consider again the very sentence outlining the holding of *Miyazaki*:

“[I]f a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite.”¹⁴

This was a sentence meant to provide guidance to everyone concerned with patent practice, including all examiners, agents, attorneys, etc. Yet, is there a single understanding of the meaning of the word “plausible” such that we know clearly what is meant by a “plausible claim construction”? Plausible could mean any claim construction that was logically possible, regardless of whether the construction makes sense to those persons skilled in the art.

If one consults a dictionary, the word “plausible” has multiple definitions. One definition is “having an appearance of truth or reason...credible; believable.”¹⁵ This definition tracks “plausible” in the sense that something plausible is reasonably credible. For example, assume a suspect’s alibi for 7:00 p.m. on Tuesday night is that he was seeing a specific movie at a specific theater. The suspect’s alibi is “plausible” according to this first definition if the suspect produces a ticket stub for the specific movie at the specific theater at the given date and time. The alibi may not be airtight, but it is reasonably credible. Another definition of “plausible” is

¹² *Id.* at 1212.

¹³ *Id.*

¹⁴ *Id.* at 1211.

¹⁵ WEBSTER’S ENCYCLOPEDIA UNABRIDGED DICTIONARY OF THE ENGLISH LANGUAGE 1104 (1989).

“specious...[;] that which has the appearance of truth but might be deceptive.”¹⁶ This definition tracks “plausible” in the sense that something plausible is logically possible, but not reasonably credible. For example, a student’s “dog ate my homework” excuse is plausible if the student has a dog that is physically capable of eating his homework. Despite this, the student’s teacher is likely to be skeptical and not accept this excuse as the true reason the student does not have his homework.

The BPAI holding in *Miyazaki* is more than just fodder for a class in linguistics. Claim drafting requires using a carefully calculated balance of language that is broad enough to encompass the entirety of the patentee’s invention and narrow enough to differentiate the encompassed subject matter over the prior art. If examiners are instructed to consider every logically possible construction of a claim, no matter how specious or incredible the construction may be, the examiner would have the ability to repeatedly issue indefinite rejections. In turn, patent practitioners who have to be concerned with every logically possible construction of the claims they draft would face a nearly impossible task of drafting valid and effective claims which are each subject to only one logically possible construction. In practice, an endless cycle of narrowing limitations and amendments could be required if the examiner truly is seeking claims with only a single logically possible construction. And the more limitations added to claims during prosecution, the narrower the scope of the claims due to file wrapper estoppel and preemption of the doctrine of equivalents. Overall, these endlessly narrowed claims would be nearly worthless against potential infringers.

Additionally, the decision in *Miyazaki* also adds further confusion to the breadth versus indefiniteness argument. Examiners are specifically instructed not to confuse breadth for indefiniteness.¹⁷ The confusion may arise when a claim is written broadly to cover multiple possible combinations of claim elements. For example, in *Orthokinetics v. Safety Travel Chairs*,¹⁸ a claim for a wheelchair included the following limitation: “wherein said front leg portion is so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats thereof.”¹⁹ Why was the claim written this way? In order to cover the use of the inventive wheelchair with various types of automobiles, the applicants could not provide specific dimensions for the front leg portion. Such specific dimensions included in the claim would mean that the applicants would only have claim coverage, and thus patent protection, for wheelchairs compatible with one automobile model’s specific dimensions. Competitors would be free to make and sell the inventive wheelchair for other automobile models having different specific dimensions. In *Orthokinetics*, the Court of Appeals for the Federal Circuit (“CAFC”) found that definiteness required only that “those of ordinary skill in the art realize[] that the dimensions could be easily obtained.”²⁰ In other words, for a given automobile, those skilled in the art would be able to determine whether a given wheelchair’s front leg portion would read on the claim limitation.

¹⁶ *Id.*

¹⁷ *See* MPEP at § 2173.04.

¹⁸ 806 F.2d 1565 (Fed. Cir. 1986).

¹⁹ *See id.* at 1575.

²⁰ *Id.* at 1576.

Would the limitation survive the new standard for indefiniteness under *Miyazaki*? The appellants in *Miyazaki* compared their height limitation in claim 1 to the front leg portion limitation in *Orthokinetics*.²¹ The BPAI refused to accept the comparison, explaining that the *Orthokinetics* limitation references “a well defined reference area (i.e., the space between the doorframe and seat of an automobile).”²² The height limitation in claim 1, however, references an area (the relative position of the user and the printer) which is “not well defined.”²³ The relative position of the user and the printer is not well defined in claim 1 because “an infinite number of combinations of printer and user positions could be envisioned.”²⁴

The BPAI’s distinction between claim 1 in *Miyazaki* and the claims in *Orthokinetics* is problematic. One could reasonably argue that the size of the space between the doorframe and the seat of an automobile is as infinitely variable as the combinations of printer and user positions. For example, the space between the doorframe and seat of an automobile will vary depending on whether the automobile is a Hummer or a Volkswagen Beetle and every car in between. The CAFC in *Orthokinetics* noted that “[t]he patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims.”²⁵ Claim 1 in *Miyazaki* similarly attempted to capture the full breadth of the invention by covering multiple height ranges for the printer feed unit without having to list the specific combinations in the patent, let alone the claims. The BPAI’s refusal to accept claim 1 appears irreconcilable with the CAFC’s holding in *Orthokinetics*.

Going Forward

The decision in *Miyazaki* gives examiners broad latitude to issue more indefiniteness rejections. When faced with claim rejections based on multiple plausible constructions under *Miyazaki*, the first thing to check is whether the examiner provided a clear basis for the rejection. When an examiner rejects a claim for indefiniteness, the MPEP requires examiners to provide “an analysis as to why the phrase(s) used in the claim is “vague and indefinite.””²⁶ If the examiner states that there is more than one plausible construction of the claim, check whether the examiner has explained what part of the claim is subject to more than one construction and whether the examiner defined what these plausible constructions are.

Next, consider the multiple constructions of the phrase in the claim. Would the allegedly ambiguous phrase cause a person of ordinary skill in the art to have trouble understanding what the phrase means? It may be useful to explain why an allegedly ill-defined

²¹ *Ex parte Miyazaki*, 89 U.S.P.Q.2d (BNA) 1207, 1213 (BPAI Nov. 19, 2008).

²² *Id.*

²³ *Id.*

²⁴ *Id.* at 1212.

²⁵ *Orthokinetics*, 806 F.2d at 1576.

²⁶ MPEP at § 2173.02.

phrase would be understood by those skilled in the art to exclude certain “plausible” constructions which are logically possible, but not reasonable. If it is a close case, it may be wise to err on the side of clarifying the language. For example, in *Exxon Research & Eng’g Co. v. United States*,²⁷ the CAFC considered whether the term “U_L” referred to interstitial velocity or superficial velocity of a liquid. There was evidence in the claims and the specification that supported both interpretations of the disputed term.²⁸ The court held that the term was not insolubly ambiguous because one interpretation was “more reasonable” than the other, and thus, a person of ordinary skill in the art would understand which velocity “U_L” referred to.²⁹ However, the court advised that “[i]f this case were before an examiner, the examiner might well be justified in demanding that the applicant more clearly define U_L, and thereby remove any degree of ambiguity.”³⁰ Thus, there is Federal Circuit support for *Miyazaki* so far as the standard is construed to mean that an indefiniteness rejection may be issued when there is more than one construction of a claim, and each construction is reasonable to a person of ordinary skill in the art. In this case, it would have been easy for the applicant to state during prosecution which value U_L referred to.

The more difficult case would occur if an examiner rejects a claim for indefiniteness because it has multiple constructions, and one of the constructions, though logically possible, is completely unreasonable to a person of ordinary skill in the art. In defending the rejection, the examiner could cite to the holding in *Miyazaki*, which does not explicitly require that the multiple constructions be credible to a person of ordinary skill in the art. If one wants to traverse the rejection, there is some language in the MPEP to try and force the examiner to rely on constructions which would be reasonable to a person of ordinary skill in the art. For example, the MPEP instructs that examiners “should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness.”³¹ The MPEP also states that “[d]efiniteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.”³²

Finally, it is also questionable whether the Federal Circuit would uphold the holding in *Miyazaki*. The *Miyazaki* holding states that claims with more than one plausible construction can be rejected at the PTO for indefiniteness. Assume it is possible for a claim to have just one plausible construction and the PTO does a thorough job so as to issue only claims which are definite under this standard. This would revolutionize patent litigation. Currently, the central issue in most patent litigation is claim construction, which is done in a Markman hearing. Since

²⁷ 265 F.3d 1371 (Fed. Cir. 2001).

²⁸ *Id.* at 1383.

²⁹ *Id.*

³⁰ *Id.* at 1384.

³¹ MPEP at § 2173.02.

³² *Id.*

Markman v. Westview Instruments,³³ a judge must interpret any disputed terms of a claim.³⁴ If the issued claims have only one plausible construction, there is no reason for a judge to interpret the claims. From April 1996 through June 2007, there were 952 CAFC cases in which the parties disputed a district court judge's construction of a claim limitation.³⁵ Claim construction issues are a substantial portion of the CAFC's cases. It seems unlikely the BPAI could obviate such a vital component of CAFC cases and patent litigation generally.

The decision in *Miyazaki* imposes a new standard for examination of claims under 35 U.S.C. 112, second paragraph. The holding allows examiners to issue indefiniteness rejections for any claim that has multiple *plausible* constructions. Because the term "plausible" itself has multiple definitions, the holding in *Miyazaki* may support rejecting a claim that has only one construction reasonable to those skilled in the art and multiple unreasonable constructions that are nevertheless logically possible. Practitioners should be ready to explain how their claims have only one reasonably credible construction to those skilled in the art. The decision in *Miyazaki* also may require practitioners to be prepared to explain how a given set of claims is broad rather than indefinite.

³³ 517 U.S. 370 (1996).

³⁴ *Id.* at 388-91.

³⁵ David L. Schwartz, *Practice Makes Perfect? An Empirical Study of Claim Construction Reversal Rates in Patent Cases*, 107 MICH. L. REV. 223, 238-39 (2008).