

IN RE THOMAS G. PACKARD, Appeal No. 2013-1204 (Fed. Cir. May 6, 2014). Before O'Malley, Plager and Taranto (*per curiam*). Appealed from the Patent Trial and Appeal Board.

Background:

Packard sought a patent on a coin change holder. The examiner rejected the patent claims for indefiniteness, failing to comply with the written description requirement, and obviousness. On appeal to the PTAB, the PTAB affirmed the indefiniteness and written description rejections, while reversing the obviousness rejection. Packard appealed the PTAB's decision to the Federal Circuit arguing that the PTAB misapplied the standard of indefiniteness by finding his claims indefinite on grounds that they contain words or phrases whose meaning is unclear. Packard argued that had the PTAB applied an "insolubly ambiguous" standard to his claims, those claims would not have been held indefinite.

Issue/Holding:

Did the PTAB error in finding Packard's claims indefinite? No, affirmed.

Discussion:

This is the first time the Federal Circuit has dealt with the issue of what standard for indefiniteness the USPTO should apply to pre-issuance claims.

The USPTO argued, and the Federal Circuit agreed, that if the Federal Circuit affirmed the PTAB on the indefiniteness issue that applied to all claims, the adequacy of the written description, applicable only to some of the claims, became a moot issue. Packard principally argued that (1) the standard applied by the Federal Circuit in determining indefiniteness is "insolubly ambiguous," and (2) the "insolubly ambiguous" standard applies not only in post-issuance cases but pre-issuance cases. Packard believed that the "insolubly ambiguous" standard was more favorable to his case than the MPEP "unclear" standard applied by the USPTO.

The Federal Circuit resolved the matter without regard to the proper indefiniteness standard to be applied in post-issuance cases (that issue is currently under review by the Supreme Court in *Nautilus, Inc. v. Biosig Instruments, Inc.*). Rather, the Federal Circuit concluded that when the USPTO issues a well-grounded indefiniteness rejection based on lack of clarity, the burden is on the Applicant to provide a satisfactory response. Because Packard did not provide a satisfactory response to the USPTO's indefiniteness rejection, the Federal Circuit affirmed the PTAB.

In a concurring opinion, Judge Plager more directly addressed the issues raised by Packard, as the *per curiam* opinion decided the case on grounds not argued by either party. Judge Plager discussed the evolution of the "insolubly ambiguous" standard up through the Supreme Court's grant of *certiorari* in *Nautilus*, noting that it would have been inappropriate at this time for the Federal Circuit to address the appropriateness of the "insolubly ambiguous" standard in view of the Court's pending decision in *Nautilus*. Judge Plager concluded that while the USPTO indefiniteness standard applied to Packard's claims differed from the Federal Circuit's standard, whatever it may be, as a policy matter, it is well within the authority of the USPTO to interpret the applicable indefiniteness standard to be applied in examination of claims.