

INTERVAL LICENSING LLC v. AOL, INC., Appeal Nos. 2013-1282, -1283, -1284, and - 1285 (Fed. Cir. September 10, 2014). Before Taranto and Chen. Appealed from W.D. Wash. (Judge Pechman).

Background:

Interval sued Defendants for infringement of patents it owned directed to "an attention manager." At trial, the district court found that (i) a specific claim limitation, "unobtrusive manner," rendered asserted claims indefinite and (ii) the Defendant's devices did not infringe other valid asserted claims based on an adopted claim construction. Interval appealed.

Issues/Holdings:

- (i) Did the district court err in its finding of indefiniteness? No, affirmed.
- (ii) Did the district court err in its claim construction? Yes, vacated and remanded.

Discussion:

Definiteness under 35 U.S.C. §112, second paragraph, requires that claim terms inform an artisan of ordinary skill of their scope with "reasonable certainty" when viewed in light of the specification and prosecution history. *See Nautilus*. Further, claim limitations of degree are sufficiently clear when they provide "enough certainty" of their scope to a skilled artisan.

With respect to definiteness, Interval argued that the limitation, "unobtrusive manner," is tied to a specific embodiment of the specification clarifying the scope of limitation. In response, the Federal Circuit explained that portions of the specification indicate this limitation may have also been used in connection with a second embodiment in which the scope is unclear. Indeed, the Federal Circuit found that the specification is at best "muddled" as to whether this limitation applied to only one or both of these embodiments. Further, the Federal Circuit noted that, during prosecution, Interval argued that this limitation applied to the second embodiment. The Federal Circuit thus held that the limitation in question possesses an uncertain relationship with the embodiments of the specification leaving the limitation "without an objective boundary."

Interval alternatively argued that a narrow example from the specification clarifies the limitation. Particularly, Interval pointed to a specific "e.g." phrase from the written description. However, the Federal Circuit explained that it would be improper to define a facially subjective claim term based on only a single "e.g." phrase. The court further explained that this result might have been different had it been an "i.e." phrase instead. As such, the Federal Circuit held that claims containing the above limitation are invalid for indefiniteness.

Regarding claim construction, the Federal Circuit agreed with Interval that the district court improperly limited the scope of a claim term by interpreting embodiments too narrowly and agreed with Interval that, in view of an extrinsic source, the district court improperly adopted an overly narrow interpretation of a different claim term.

Accordingly, the Federal Circuit affirmed the judgment of invalidity, vacated the judgment of non-infringement, and remanded for further proceedings.