

SONIX TECHNOLOGY CO., LTD. v. PUBLICATIONS INTERNATIONAL, LTD., Appeal No. 2016-1449 (Fed. Cir. January 5, 2017). Before Lourie, O'Malley, and Taranto. Appealed from N.D. Ill. (Judge St. Eve).

Background:

Sonix sued Publications International and several other defendants for infringement of U.S. Patent No. 7,328,845 (the '845 patent). The '845 patent is directed to a system and method of using a "visually negligible" graphical indicator, similar to an invisible barcode, on surfaces such as pages of children's books. In examples given in the '845 patent, the reader can scan the graphical indicators with a device that gives additional audiovisual information, and the graphical indicator itself is not visible to the reader.

The defendants moved for a summary judgment for invalidity of the asserted claims of the '845 patent, on the basis that the phrase "visually negligible" was indefinite under Pre-AIA §112, ¶2. The District Court granted the motion, and Sonix appealed.

Issues/Holdings:

Did the District Court err in holding that the phrase "visually negligible" in the '845 patent claims was indefinite? Yes, remanded.

Discussion:

The Federal Circuit first articulated that terms of degree, such as "negligible" in the asserted claims, are not inherently indefinite. However, there must be enough certainty of scope for those terms when read in the context of the invention. The Federal Circuit repeatedly compared the '845 patent to the patent in *Enzo Biochem v. Applera*, where they had held that the phrase "not interfering substantially" was definite when read in view of the intrinsic evidence. The Federal Circuit reasoned that like in *Enzo*, the '845 patent's written description provided a sufficient level of detail to enable one having ordinary skill to ascertain the scope of "visually negligible." The Federal Circuit listed the following information from the '845 patent written description to support its holding: (i) an exemplary design for a visually negligible indicator, (ii) requirements for the graphical indicators being negligible to human eyes, and (iii) two examples of visually-negligible indicators. Based on these examples, the Federal Circuit held that the written description enabled one having ordinary skill to ascertain the scope of "visually negligible."

The Federal Circuit also supported its decision by citing the litigation history of the '845 patent. The Federal Circuit noted that the '845 patent had been through two *ex parte* reexaminations and a substantial period of the District Court litigation (including claim construction) in which the phrase "visually negligible" had been at issue. During these proceedings, the definiteness of the phrase "visually negligible" had not been questioned by any of the experts or examiners. The Federal Circuit found that these instances of skilled artisans recognizing the meaning of the phrase "visually negligible" were meaningful evidence of definiteness.