ONE-E-WAY, INC. v. INTERNATIONAL TRADE COMMISSION, Appeal No. 16-2105 (Fed. Cir. June 12, 2017). Before Prost, Wallach and Stoll. Appealed from the International Trade Commission.

Background:

One-E-Way filed a complaint with the International Trade Commission (ITC) alleging that Sony Corporation and various other respondents infringed claims of two of its patents. The patents are directed to a wireless digital audio system, which allows multiple users within the same space to use wireless headphones without interference. More specifically, the use of the wireless headphones is "virtually free from interference from device transmitted signals operating in the [wireless digital audio system] spectrum," as recited in the claims.

Respondents filed a motion for summary determination that the term "virtually free from interference" is indefinite. The administrative law judge (ALJ) granted the motion, and upon consideration of the claims, found that the term was indefinite. One-E-Way petitioned the ITC for review, and the ITC affirmed the ALJ's finding of indefiniteness. One-E-Way appealed to the Federal Circuit.

Issue/Holding:

Did the ITC err in holding that the term "virtually free from interference" rendered One-E-Way's claims indefinite? Yes, reversed.

Discussion:

The Supreme Court's *Nautilus* test for indefiniteness requires that claims, when viewed in light of the specification and prosecution history, inform those skilled in the art of the scope of the invention with reasonable certainty. As asserted by the Federal Circuit, as long as the claims meet this test, terms of degree and relative terms recited in the claims do not render the claims invalid.

In applying the *Nautilus* test, the Federal Circuit found that the specification discloses "a system that enables wireless headphone users to enjoy their audio privately, without interference." In addition, the Federal Circuit found that the specification repeatedly states that this private-listening feature is "without interference." Accordingly, the Federal Circuit indicated that the specification makes clear that the private-listening feature, as required by the claims, is the intended meaning of "without interference" from other users.

The Federal Circuit also considered a statement made by the applicant during the prosecution of the related parent patent. The statement indicated that a prior art reference does not disclose or suggest "a relationship where interference is virtually eliminated (e.g., where eavesdropping cannot occur)." The Federal Circuit considered this statement as confirmation of One-E-Way's interpretation of "virtually free from interference."

Although respondents argued that the term "virtually free from interference" does not inform one skilled in the art as to the degree of interference required, the Federal Circuit held that the lack of a technical measure of the amount of interference does not render the claims indefinite. Instead, the Federal Circuit found that the specification and prosecution history sufficiently used the term "interference" in a non-technical manner to merely indicate that eavesdropping cannot occur. Thus, the Federal Circuit held that one skilled in the art would be sufficiently informed of the scope of the invention with reasonable certainty.

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