

INFINITY COMPUTER PRODUCTS INC. v. OKI DATA AMERICAS, Appeal No. 2020-1189 (Fed. Cir. February 10, 2021). Before Prost, Clevenger, and Taranto. Appealed from D. Del. (Judge Stark).

Background:

Infinity owns several patents with a common specification that are directed to using a fax machine as a printer or scanner for a generic computer. A representative claim at issue recites "a *passive link* between the facsimile machine and the computer." Infinity advanced two separate interpretations of the claimed "passive link" during prosecution.

Firstly, in order to distinguish the Perkins reference, Infinity argued that the passive link connects the fax machine directly to the I/O bus of the computer without any intervening circuitry. On the other hand, Perkins disclosed intermediate circuitry for modulating or demodulating the signal between a fax machine and a computer. The Examiner then allowed the application based on this argument.

Secondly, one of the patents was later subject to reexamination, and Infinity sought to antedate the Kenmochi reference during the reexamination. When explaining the nature of the claimed "passive link," Infinity stated that the passive link was simply the cable connecting the fax machine to the computer. That is, Infinity did not go on to assert that the passive link goes so far as to directly connect to the I/O bus of the computer, as it did during the original prosecution. The reexamination certificate then issued affirming the patentability of the claims.

At trial, Oki Data argued that the claims were indefinite because "Infinity took one position to overcome Perkins and a different position to antedate Kenmochi creating uncertainty as to where the passive link ends and where the computer begins." The district court agreed with Oki Data and held the claims to be indefinite under 35 U.S.C. §112(b), noting that Infinity took "materially inconsistent positions" on the endpoint of the claimed "passive link."

Issue/Holding:

Did the district court err in holding that the claims of the patent in suit are invalid for indefiniteness? No, affirmed.

Discussion:

The Federal Circuit agreed with the district court and held that the claims failed to meet the reasonable certainty standard. Indefiniteness can result from prosecution history arguments that are inconsistent with each other. In the present case, Infinity first argued that the "passive link" extends from the fax machine directly to the internal I/O bus of the computer, without any intervening circuitry. Infinity later argued, during reexamination, that the "passive link" only extended as far as the receiving port on the computer. Thus, the endpoint of the "passive link" was unclear based on the prosecution history. As a result, one of ordinary skill in the art could not determine with reasonable certainty the scope of the claims.