

CLEARONE, INC. v. SHURE ACQUISITION HOLDINGS, Appeal No. 2021-1517 (Fed. Cir. June 1, 2022). Before Moore, Newman, and Hughes. Appealed from Patent Trial and Appeal Board.

Background:

Shure owns a patent directed to arrays of microphones and housings for the arrays that can be fitted into a drop ceiling grid. In an *inter partes* review (IPR) of the patent, the Board granted Shure's motion to amend the claims so as to add an independent claim reciting: "an array microphone comprising a plurality of microphones arranged in a *self-similar* configuration . . ." This limitation is supported by the specification, which states that the array microphone assembly "includes a plurality of microphone transducers selectively positioned in a *self-similar* or fractal-like configuration, or constellation." Thus, the Board concluded that the meaning of the term "self-similar" would be understood by a skilled artisan to include "fractal-like configurations or constellations," thereby finding the term "self-similar" to be definite.

ClearOne requested a rehearing on the indefiniteness issue and leave to file a motion for sanctions against Shure, alleging that Shure violated its duty of disclosure by failing to cite art that Shure deemed relevant in another proceeding. That is, ClearOne asserted, that before the Board issued its decision in the present IPR proceeding, Shure petitioned for a post-grant review of a ClearOne patent, which is also directed to drop ceiling microphone arrays. ClearOne reasoned that a rehearing and sanctions were warranted because Shure violated the duty of disclosure by failing to disclose, in the present proceeding, the art that had been asserted in the other proceeding. However, the Board concluded that Shure had not violated its duty to disclose because the art cited in the other proceeding was cumulative to references asserted by ClearOne in its IPR petition for the patent of the present proceeding. ClearOne appealed the Board's decision that the new claim was definite. ClearOne also appealed the Board's denial of its request to file a motion for sanctions against Shure.

Issues/Holdings:

Did the Board err in holding that the new claim was not indefinite? No, affirmed. Did the Board err in denying ClearOne's request to file a motion for sanctions? No, affirmed.

Discussion:

On the issue of indefiniteness, the Federal Circuit first noted that just because a term is susceptible to more than one meaning does not render it indefinite. Next, the Federal Circuit concluded that based on the intrinsic record alone, the written description provides the scope of the term self-similar, which when read in light of the specification, informs skilled artisans, with reasonable certainty, about the scope of the invention. Thus, the Federal Circuit affirmed the Board's decision on the issue of indefiniteness.

In regards to the Board's denial of ClearOne's request for a sanctions motion, the Federal Circuit concluded that the Board did not abuse its discretion. Instead, the Federal Circuit noted that after the Board held a hearing on the merits of the sanctions motion, the Board found that ClearOne's arguments were essentially the same as those asserted on the indefiniteness issue, and "amount[ed] to nothing more than a thinly veiled attempt at a second bite at the apple." Thus, the Federal Circuit affirmed the Board's decision on the issue of the sanctions motion request.