

GRACE INSTRUMENT INDUSTRIES, LLC v. CHANDLER INSTRUMENTS COMPANY, LLC, Appeal No. 2021-2370, (Fed. Cir. January 12, 2023). Before Chen, Cunningham, and Stark. Appealed from S. D. Tex. (Judge Hanen).

### Background:

Grace owns a patent directed to a viscometer for measuring a drilling fluid's viscosity. The device is used to test the viscosity of the drilling fluid before the fluid is used in oil wells to ensure that the fluid works properly under certain drilling conditions (i.e., temperature, pressure, etc.). The patented viscometer purportedly eliminates measurement errors frequently found in conventional viscometers by introducing an antechamber ("enlarged chamber") in the upstream vessel to confine the pressurization fluid within this enlarged chamber, thereby preventing the pressurization fluid from entering a measurement chamber where the viscosity of the sample fluid is being measured during elevated pressurization so that the viscosity of only the sample fluid is measured.

In 2020, Grace sued Chandler alleging that Chandler's viscometer infringed Grace's patent. After the claim construction analysis, the district court held that the term "enlarged chamber" used in the claims was indefinite because "enlarged" was a "term of degree" that necessarily called for a comparison against some baseline that was not provided in the specification. The district court entered final judgment in favor of Chandler, indicating that "enlarged chamber" must be larger than something else and concluding that the patent fails to provide such "objective boundaries." Grace appealed.

### Issue/Holding:

Did the district court err in finding that "enlarged chamber" is indefinite? Yes, vacated and remanded.

### Discussion:

The Federal Circuit overturned the indefiniteness finding for "enlarged chamber" by the district court and required further fact finding on remand for the following two reasons.

First, the Federal Circuit emphasized that the claim construction should be based on the intrinsic record (e.g., claims, specification and prosecution history) and that, if the meaning of a claim term is clear from the intrinsic record, there is no reason to resort to extrinsic evidence (e.g., dictionary definitions). In this regard, the patent's specification teaches that "chamber 45 and chamber 49 are *large enough* so that at maximum rated pressure, chamber 49 is still at least half filled with sample liquid..." Thus, the Federal Circuit found that the term was not indefinite because the intrinsic record provided sufficient guidance ("objective boundary") to the skilled artisan as to the meaning of "enlarged chamber," and as such, this objective boundary does not require a comparison to the size of prior-art chambers. The district court erred in its reliance on extrinsic evidence that contradicts the scope and meaning of "enlarged chamber" that a skilled artisan would ascertain by consulting the intrinsic record.

Second, the Federal Circuit also rejected Chandler's argument that an explicit definition of the term "enlarged chamber" is required. The Federal Circuit reasoned that the specification may define claim terms by implication such that the meaning may be found in or ascertained by a reading of the specification itself.