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CLIENT ALERT

BPAI Expands Definiteness Requirement During Patent Prosecution in Ex parte Miyazaki

Ex parte Miyazaki, Appeal No. 2007-3300 (BPAI 2008) (precedential opinion)¹

On November 19, 2008 the Board of Patent Appeals and Interferences (Board) announced in the above captioned case that “if a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite.” *Ex parte Miyazaki*, slip op. at 11-12.

This case is of interest primarily for the expansive language the Board used in determining that the claims under review were indefinite under 35 U.S.C. § 112, second paragraph. Claim 1 reads:

A large printer comprising:

a paper feeding unit operable to feed at least one roll of paper, at least one substantially flat sheet of paper and at least one stiff carton, the paper feeding unit being located at a height that enables a user, who is approximately 170 cm tall, standing in front of the printer to execute the paper feeding process including replacement of the roll paper and setting at least one of the sheet of paper and the stiff carton;

a printing unit located below the paper feeding unit,

a discharged paper stacking unit located below the printing unit; and

a paper feeding path extending in a substantially straight line from the paper feeding unit to the discharged paper stacking unit via the printing unit.

In holding claim 1 was indefinite, the Board noted:

The language of claim 1 attempts to claim the height of the paper feeding unit in relation to a user of a specific height who is performing operations on the printer []. Claim 1 fails to specify, however, a positional relationship of the user and the printer to each other. For example, claim 1 does not recite where the printer is located or where, relative to the ground, the user is standing. As such, the printer of claim 1 could be positioned on a table or a platform and/or the user could be standing on something

¹ A copy of the Board’s opinion can be found at <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd073300.pdf>.



other than the ground, such as a step stool. An infinite number of combinations of printer and user positions could be envisioned such that the above-recited language of claim 1 does not, in fact, impose a structural limitation on the height of the paper feeding unit of the claimed printer. As a result, claim 1 fails to delineate any height requirement for the paper feeding unit despite purporting to do so.

Ex parte Miyazaki, slip op. at 14. The Board also considered the specification of the application and concluded that nothing in the specification “clearly impose[s] such a positional relationship between the user and the printer to the language of claim 1.” *Id.*

The mischief created by the Board in this case is not whether the claim is or is not indefinite under the statute but, rather, it is found in the Board’s broad holding regarding the application of 35 U.S.C. § 112, second paragraph. Many claim limitations are amenable to two or more reasonable constructions as that is what gives a patent claim breadth. If the Board’s holding is taken at face value, we can expect a flood of rejections of claim terms as being indefinite under the statute.

The Board based its holding on the well established broader claim construction that patent claims receive while pending in the PTO. However, in so doing, the Board lost sight of well established precedent that holds that definiteness of claim language “must be analyzed—not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.” *In re Moore*, 439 F. 2d 1232, 1235 (CCPA 1971). The Board did not discuss the prior art and expressly declined to review the pending prior art rejections in view of their determination the claims were indefinite. Nor did the Board discuss how one of ordinary skill in the art would have viewed the questioned term.

Notably, the Board denominated the opinion as “Precedential.” According to Board Standard Operating Procedure 2 (Rev. 7) March 23, 2008, page, 3², “[t]he purpose of a Precedential opinion is to create a consistent line of authority as to a holding that is to be followed in future Board decisions.” Thus, a so-called Precedential opinion is binding on the Board but not necessarily on the Examining Corps.

If you have any questions please contact a member of Woodcock Washburn's Patent Prosecution Service Group. Further questions may also be directed to William F. Smith (wsmith@woodcock.com) or S. Maurice Valla (svalla@woodcock.com).

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² The Board’s SOP 2 is available at <http://www.uspto.gov/web/offices/dcom/bpai/sop2.pdf>.