

## Is Your Patent Definite Enough? Or Is It Fragile?



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When claiming their inventions, inventors are often loathe to use precise, numerical limitations in their patent claims, because the precise limitations make the claim appear easy to design around. Typically, the inventor would much rather have a claim requiring “a fluid having a viscosity sufficient to [perform a desired function]” than a claim requiring “a fluid having a viscosity of at least 30 centipoise.” With the latter wording, it would

seem easy for a competitor to avoid literal infringement simply by using a fluid of 29 centipoise or less. However, the former wording – which uses the desired function to describe the claim element – is at greater risk for being found indefinite and thereby invalidating the claim. The patent statute requires that each patent “conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112, 2nd ¶. This statutory provision is not satisfied if the claims are indefinite.

Patent examiners frequently reject patent claims as being indefinite, but patent applicants typically overcome such rejections by amending the claims or by explaining why the objected-to claim terminology is sufficiently definite. Indeed, the definiteness of the claim is a critical issue for the patent examiner, since the patent examiner needs to understand the scope of the claim in order to determine whether the claimed subject matter is different from the prior art and whether the patent specification fully supports the claim. The examiner cannot make such determinations if the examiner does not understand the scope of the claim.

Thus, once the patent has been allowed, patent claims are rarely invalidated for indefiniteness. Even where there is a long, drawn-out battle over claim interpretation, with expert witnesses – and sometimes even appellate judges – disagreeing over the meaning of claim terms, the claims are seldom invalidated for indefiniteness. Nevertheless, despite the patent examiner’s determination of defi-

niteness, courts sometimes do invalidate claims as being insufficiently definite. One such case, *Halliburton Energy Services, Inc. v. M-I LLC*, 514 F. 3d 1244 (Fed. Circ. 2008) was recently decided by the Federal Circuit Court of Appeals.

Beyond simply invalidating patent claims for indefiniteness, there are couple of aspects of the *Halliburton* case that are surprising. First, the claims were found to be indefinite on summary judgment, i.e., without a complete presentation of expert testimony and other evidence on whether persons of ordinary skill in the field would have understood the claim scope. Second, the patent included fifteen graphs, three tables and fourteen columns of written description describing the characteristics of the invention and comparing it to the prior art. In addition, the patent included a definition of the disputed claim term “fragile gel” of over 350 words. Thus, the patent claims were not done in by any brevity in the patent’s discussion of the invention.

Despite all the discussion in the patent describing the invention and comparing it to the prior art, the district court summarily found the asserted

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claims to be indefinite, and the Federal Circuit agreed. Why? The claim interpretation being proffered by the patentee was not “meaningfully precise” in several ways. For example, the definition of the claim term “fragile gel” required a gel that “easily transitions to liquid.” The court explained that it was far from clear how “easily” the transition had to happen in order to satisfy the definition. In other words, it was unclear how “fragile” a gel had to be in order to qualify as a “fragile gel.”

The court noted that when a claim incorporates an imprecise standard, like “easy,” the claim can fail to serve its “notice function,” *i.e.*, the claim can fail to put the public (including competitors) on notice as to exactly what falls within the scope of the claims and what falls outside the scope of the claims.

The *Halliburton* decision further explained that the patentee’s proposed claim interpretation included functional language, and that use of functional language increased the danger of a claim being found indefinite.

The court also noted that the drafter of the claim was in the best position to make the claim “meaningfully precise.” Accordingly, the claim drafter has the responsibility of making the claim definite enough to put the public on notice of the precise scope of the claim.

*Halliburton* will make patent drafters worry that, if their claims are not sufficiently definite, their patent may be fragile and could easily transition into a worthless piece of paper. How does a patent drafter avoid such a fate? Of course, making the claims as precise as possible alleviates the indefiniteness problem.<sup>1</sup>

However, as noted above, inventors will often be troubled by claims that look overly precise. Indeed, it is often very

difficult or cumbersome to set forth, in a claim, numerical limitations that cover all conditions. For example, a numerical limitation may be appropriate under one set of conditions (*e.g.*, at a temperature of 70° F and a pressure of 15 p.s.i.), but should be modified as conditions vary (*e.g.*, the numerical limitation should be higher if the temperature and pressure are lower).

**IF YOU WANT TO INCLUDE A CLAIM THAT COULD BE ATTACKED AS BEING IMPRECISE, ADD ANOTHER, MORE PRECISE CLAIM TO THE APPLICATION. THE MORE PRECISE CLAIM MAY SURVIVE AN INDEFINITENESS ATTACK EVEN IF THE LESS PRECISE CLAIM IS STRUCK DOWN.**

What to do? If you want to include a claim that could be attacked as being imprecise, add another, more precise claim to the application. The more precise claim may survive an indefiniteness attack even if the less precise claim is struck down. Also, *Halliburton* indicates that providing a sufficient number of examples in the written description can help show where the claim boundaries are.

Of course, claims do not usually require numerical limitations, and functional limitations are found to be definite in the vast majority of cases. Also, claims with means-plus-function elements language can be perfectly acceptable, as long as the specification provides structure clearly corresponding to the means-plus-function element.

In order to make it harder for others to design around your patent and to make it harder to invalidate the entire patent, include a mix of claims in your patent, *e.g.*, structural claims as well as means-plus-function claims, claims

using quantitative metrics as well as claims setting forth qualitative functional features, method claims as well as device claims, or product-by-process claims as well as straight product claims. Providing a wide variety of claims in a patent makes a patent more robust. Having many claims, however, is not enough; there must be enough diversity in the claims such that all the claims will not have the same weaknesses. (You can think of your collection of claims like an investment portfolio; if it is well-diversified, it can better handle choppy markets.)

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Currently, the USPTO has no limitations on the number of claims an applicant can pursue for an invention. The only limit is how much the applicant is willing to spend on extra claim fees. However, as Bruce Sunstein reported in the prior edition of our newsletter,<sup>2</sup> the USPTO has attempted to limit the number of claims that may be pursued in a single application and to limit the number of continuation applications, but these rules have been enjoined. Unless and until these rules go into effect, the best way of protecting an invention that is hard to claim is to claim it many different ways.

<sup>1</sup> Note that merely including numerical limitations, e.g., 30-40 centipoise, although sounding precise, may not be sufficiently definite if the method of testing and the conditions of measurement would not be clear to someone of ordinary skill in the field. *See, e.g., Honeywell Int'l, Inc. v. Int'l Trade Comm'n*, 341 F.3d 1332, 1340 (Fed. Cir. 2003). For example, there may be different ways of measuring viscosity, and a fluid's viscosity may vary with temperature. Therefore, sometimes merely giving a numerical range may not be definite enough.

<sup>2</sup> Bruce D. Sunstein, "What to Expect with the New Rules of the Patent and Trademark Office: Although on Hold for Now, Rule Changes May Yet Transform Patent Prosecution," *The Dispatch*, Winter 2008.

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