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# The Uncertain Future of Patent Indefiniteness Under Federal Circuit's Deference Standard

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In deciding whether a patent claim term is indefinite, how much weight should a court accord to the prosecution history versus the claims, specification, and the understanding of a person of ordinary skill in the art?

The U.S. Court of Appeals for the Federal Circuit's Jan. 27, 2022, decision, *Nature Simulation Sys. v. Autodesk, Inc.*, [23 F.4th 1334](#) (Fed. Cir. 2022), presents divergent views regarding the degree of deference to a patent examiner's understanding of a disputed claim term, potentially elevating the importance of prosecution history over other intrinsic, as well as extrinsic, evidence, and could even affect claim construction generally.

## Background

*Nature Simulation* offers a new wrinkle to the claim construction analysis. In its 2005 en banc decision in *Phillips v. AWH*, the Federal Circuit emphasized that "claims are of primary importance," that the specification "is the single best guide to the meaning of a disputed term," and "[u]sually, it is dispositive." In contrast, "because the prosecution history represents an ongoing negotiation between the PTO and the applicant, rather than the final product of that negotiation, it often lacks the clarity of the specification and thus is less useful for claim construction purposes." *Phillips v. AWH Corp.*, [415 F.3d 1303, 1315](#) (Fed. Cir. 2005).

In *Nature Simulation*, the parties disputed indefiniteness of the claim term "modified Watson method." Although "Watson method" was a known algorithm in the art, the parties disputed whether a person of ordinary skill in the art would understand with reasonable certainty the scope of "modified" Watson methods that would be covered by the claims. Citing a non-precedential opinion, the majority held that the term was not indefinite based on "appropriate deference" to the patent examiner's manifested understanding. *Tinnus Enters., LLC v. Telebrands, Corp.*, [733 F. App'x 1011, 1020](#) (Fed. Cir. 2018). During oral argument, Judge Pauline Newman, who authored the majority opinion, commented:

Obviously, the examiner had a different view when the examiner suggested or requested the additional information [to] be added to the claim. So now, we as judges may not be experts in Boolean mathematics. How are we to second-guess [what] the examiner plainly thought was suitable to complete the description and make the claims allowable?

Pointing to the incongruence between the amended claims and their supporting written description, the dissent criticized the majority decision as overriding the test for definiteness based on whether the claim language "was not indefinite to the examiner." *Nature Simulation Sys.*, [23 F.4th at 1344-45](#).

## Implication for Indefiniteness Inquiry

Previously, the Federal Circuit has held that an examiner's statement in prosecution history was, "at most, representative of how one of skill in the art would understand the term." *3M Innovative Properties Co. v. Tredgar Corp.*, [725 F.3d 1315, 1332](#) (Fed. Cir. 2013). In another case, the Federal Circuit noted that although a patent examiner's understanding "provide[s] evidence that a skilled artisan did understand the scope of the invention with reasonable certainty," it does not on its own establish an objective standard for definiteness. Rather, "the written description is key to determining whether a [disputed term] is indefinite," and the prosecution history merely provides "support." *Sonix Tech. Co. v. Publ'ns Int'l, Ltd.*, [844 F.3d 1370, 1380](#) (Fed. Cir. 2017); see also *Altair Eng'g v. LEDdynamics, Inc.*, [413 F. App'x 251, 255](#) (2011)

In the absence of rehearing or en banc review, *Nature Simulation* may signal a departure from previous claim construction principles. Cf. *Infinity Computer Prods., Inc. v. Oki Data Am., Inc.*, [987 F.3d 1053, 1059-60](#) (Fed. Cir. 2021); *One-E-Way, Inc. v. ITC*, [859 F.3d 1059, 1064-65](#) (Fed. Cir. 2017).

## Evolution of Claim Construction Analysis

*Nature Simulation* may potentially be another departure from the Federal Circuit's views on claim construction. In 2002, in *Texas Digital Sys., Inc. v. Telegenix, Inc.*, the court emphasized the priority of the ordinary and customary meanings of claim terms, compared to the written description and prosecution history. The dictionary definitions of terms in particular were hailed as "objective resources that serve as reliable sources on the established meanings that would have been attributed to the terms of the claims by those of skill in the art." *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1204 (Fed. Cir. 2002).

Several years later, the Federal Circuit provided clarification in the seminal decision, *Phillips v. AWH*, stating that "extrinsic evidence may be useful to the court, but it is unlikely to result in a reliable interpretation of patent claim scope unless considered in the context of the intrinsic evidence."

In that opinion, Judge William Bryson provided an extensive discussion of the relative importance of the specification and prosecution history in construing claim terms, with the prosecution history described as "less useful for claim construction purposes" despite "demonstrate[ing] how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1319 (Fed. Cir. 2005). Coincidentally, the same panel decided *Phillips* and *Nature Simulation* (Newman, Lourie, Dyk), with the same dissenting judge (Dyk).

*Phillips* established that "the written description is key to determining whether a [disputed term] is indefinite," whereas the prosecution history merely provides "support." It is not entirely clear how to square this well-established ranking of claim language and specification as the primary source for determining the meaning of claim terms with the holding of "appropriate deference" to the patent examiner in *Nature Simulation*. As such, in the absence of further guidance from rehearing or en banc review, the *Nature Simulation* decision could create tension between the importance of the claim language and written description and the prosecution history when construing claims.

## Objective vs. Subjective Test

The test for determining indefiniteness is an objective one, i.e., whether "a patent's claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty." *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 910 (2014).

In his dissent, Judge Timothy Dyk criticized the majority's opinion as applying a subjective test, i.e., "whether the claim language was added by a patent examiner or was not indefinite to the examiner." As a result, *Nature Simulation* could be viewed as elevating the significance of the examiner's understanding, deviating from the Federal Circuit's previous holding in *3M Innovative Properties Co. v. Tredegar Corp.* that "an examiner's statement [in the prosecution history] was, at most, representative of how one of skill in the art would understand the term."

## Practice Reminder

Relying on expert opinion, in *Nature Simulation Sys.*, Autodesk had argued that "modified Watson method," the claim term that was deemed indefinite by the district court, had no ordinary and customary meaning at the time of the invention, and all of the modifications recited in the claims were ambiguous. *Nature Simulation* relied solely on intrinsic evidence, including the prosecution history, in which the claims were amended to clarify the meaning of "modified Watson method," and argued that the court should give deference to the examiner's understanding. *Nature Simulation Sys. Inc. v. Autodesk, Inc.*, 2020 WL 12933852, at \*5-7 (N.D. Cal. July 31, 2020). Ideally, extrinsic support, in addition to intrinsic evidence, should be cited for claim construction and indefiniteness positions whenever possible.

Autodesk petitioned for panel and en banc rehearing on March 21, 2022. Regardless of any further review, litigants should be mindful of these developments, including the elevated attention to examiner statements in the prosecution history, not just in connection with indefiniteness challenges but in the context of claim construction generally. In particular, examiner statements may be given increased deference where they address issues similar to those raised in subsequent litigation.