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Federal Circuit Patent Bulletin: *One-E-Way, Inc. v. Int'l Trade Comm'n*

June 19, 2017

"While we note that 'virtually' is a term of degree, one that slightly expands the scope of the term 'free from interference,' the inclusion of "virtually" in these claims does not render them indefinite."

On June 12, 2017, in *One-E-Way, Inc. v. Int'l Trade Comm'n*, the U.S. Court of Appeals for the Federal Circuit (Prost, Wallach, Stoll*) reversed the International Trade Commission decision that certain claims of U.S. Patents No. 7,865,258 and No. 8,131,391, which related to a wireless digital audio system designed to let people use wireless headphones privately, without interference, even when multiple people are using wireless headphones in the same space, were invalid for indefiniteness under 35 U.S.C. § 112. The Federal Circuit stated:

The Patent Act requires inventors to claim their invention in "full, clear, concise, and exact terms." This indefiniteness requirement is "part of the delicate balance the law attempts to maintain between inventors, who rely on the promise of the law to bring the invention forth, and the public, which should be encouraged to pursue innovations, creations, and new ideas beyond the inventor's exclusive rights." This balance recognizes that all claims suffer from "the inherent limitations of language," but also that claims must "be precise enough to afford clear notice of what is claimed." This balance permits "[s]ome modicum of uncertainty" to "ensur[e] the appropriate incentives for innovation," but it also provides a "meaningful definiteness check" to prevent patent applicants from "inject[ing] ambiguity into their claims." Recognizing this balance, the Supreme Court articulated the test for indefiniteness as "requir[ing] that 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."

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This test "mandates clarity, while recognizing that absolute precision is unattainable." As long as claim terms satisfy this test, relative terms and words of degree do not render patent claims invalid. To determine whether a particular term is indefinite, "[o]ne must bear in mind . . . that patents are 'not addressed to lawyers, or even to the public generally,' but rather to those skilled in the relevant art." . . .

Here, we must determine whether the term "virtually free from interference" is indefinite. The Commission determined that the term is indefinite, and both the Government and Respondents urge affirmance of that conclusion on appeal. One-E-Way proposes that the claim term, viewed in light of the specification and prosecution history, should be interpreted to mean "free from interference such that eavesdropping on device transmitted signals operating in the . . . wireless digital audio system spectrum cannot occur." Put simply, One-E-Way proposes that "virtually free from interference" prevents one user from eavesdropping on another. We agree.

First, the claims require that the system user's audio is "virtually free from interference" from signals transmitted by other users' wireless audio transmission devices. . . . The specification repeatedly highlights this private-listening feature of the claimed invention. And in each repetition, the specification states that private listening is "without interference" from other users' wireless audio transmission devices. . . . Taken together, the specification makes clear that private listening is listening without interference from other users. In other words, the interference would cause one user to hear another user's wireless transmissions, potentially interfering with the utility of a device. The patented invention sought to prevent such interference, making it possible for wireless-headphone users to listen in private. The prosecution history confirms One-E-Way's interpretation of "virtually free from interference." During prosecution of the related parent patent, the applicant explained that the term "virtually free from interference" results in the ability to listen without eavesdropping . . . .

Respondents further argue that the term "virtually free from interference" does not "inform one of ordinary skill in the art as to any particular level of interference or as to how much interference is permitted." The ALJ similarly found that the term "is indefinite . . . because one of ordinary skill in the art would not be able to discern with reasonable certainty what amount or level of interference constitutes 'virtually free from interference.'" This finding was based in part on Respondents' assertion "that there are known ways to define levels of interference in the ISM band, such as signal to noise ratios, packet errors and bit rate errors, but that the specifications give no examples or descriptions and have no relevant figures relating to levels of interference." While One-E-Way did not define the scope of the term "virtually free from interference" in a technical sense as both the ALJ and Respondents would seemingly require, the lack of a technical definition does not render the term indefinite. [T]he applicant used the term "interference" in a non-technical manner to simply mean that the wireless headphone user is able to listen without eavesdropping. This interpretation is consistent with the specification and prosecution history and provides a clear line such that it informs those skilled in the art about the scope of the invention with reasonable certainty. For the purposes of definiteness, the term is not required to have a technical measure of the amount of interference.

Finally, we consider the Government and Respondent's claim that "virtually free from interference" must be indefinite because One-E-Way fails to identify how it differs in scope from claims that recite the term "free from interference." At the outset, we note that One-E-Way has not asserted claims that recite the term "free from interference" here. The asserted claims recite only "virtually free from interference." We are aware of no precedent requiring us to construe the "free from interference" term where, as here, the term is absent from any asserted claim. Nevertheless, without deciding the meaning of the term "free from interference," an understanding of the relative meaning of these terms is readily apparent. Both terms relate, of course, to the ultimate aim of the patented invention: providing private listening without interference from signals transmitted by other users' wireless audio transmission devices. . . . It follows that one of ordinary skill might expect that because audio "virtually free from interference" is free from eavesdropping, audio "free from interference" will be, at a minimum, free from eavesdropping as well.

We conclude that a person of ordinary skill in the art, viewing the claim term "virtually free from interference" in light of the specification and prosecution history, would be informed of the scope of the invention with reasonable certainty. While we note that "virtually" is a term of degree, one that slightly expands the scope of the term "free from interference," the inclusion of "virtually" in these claims does not render them indefinite. The term "virtually" does not expand "free from interference" without end: it simply requires that the claimed invention does not allow for eavesdropping. A system that permits eavesdropping is no longer "free" or "virtually free from interference"; that system is no longer captured by the asserted patents' claims. Thus, the term "virtually free from interference" satisfies the requirements of § 112 ¶ 2.