

**bskb** Birch Stewart Kolasch Birch LLP

**In re Thomas G. Packard  
(Fed. Cir. May 6, 2014)**

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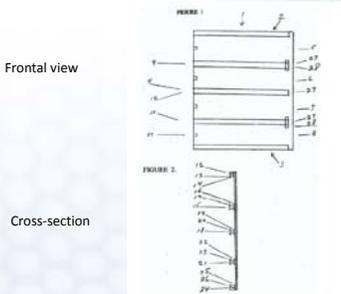


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**Background**

- Packard is a pro se applicant prosecuting Application No. 12/004,324.
- The application covers a coin change holder that is a thin plastic card with four different channels on its front surface for storing different types of coins.

**Background**



Frontal view

Cross-section

**Claim 28**

- I claim a small, thin, **flat plane**, rectangular change holding card and wallet/billfold or purse construction with the **front top side** of the card comprising three raised, straight, parallel, double flanged separators and two raised, straight, parallel, double flanged side edges and a **raised side edge end** thereby forming four parallel, side by side, flanged coin holding channels or rows of the same length and of different widths, one for quarters, one for dimes, one for nickels, and one for pennies, ...

**Claim 28**

- ... that are similarly blocked at **one side edge** by **the raised side end edge** with the other side of the channel/rows open except for small, fixed, flexible, partially movable, rubber or plastic retainers that are attached to the topside and ends of the double flanged separators such that coins can be retained on the card and yet slide freely above **the surface of the card** and obliquely overlap as necessary within the channel/rows between the separators while the bottom, back side of the card is constructed with a wallet, billfold or purse extending from it.

### Claim 29

- The change holding card wallet, billfold, purse of claim 28, wherein the change holding card is constructed as part of the wallet, billfold, or purse and affixed to a surface and contained within the wallet, billfold or purse.

### Claim 34

- I claim a small thin uniformly **flat plane** rectangular coin holding card comprising side edge retainers, a closed side retainer, small inclined/sloped end protrusions, multiple raised parallel, straight and double flanged channel/row separators, all of which are arranged on the upper surface of the card such that a various denomination of coins can be held and retained on the card within a respective channel/row and can slide freely within the double flanges and slightly above the flat surface of the card and can also be stored obliquely partially overlapping.

### USPTO

- The Examiner finally rejected the claims for lack of written description, for indefiniteness, and for obviousness.
- For the indefiniteness rejections, the Examiner rejected the claims for lack of antecedent basis or were otherwise unclear.

### Patent Trial and Appeal Board

- Packard appealed to the Board.
- The Board affirmed the written description and indefiniteness rejections and reversed the obviousness rejection.
- For the indefiniteness rejection, the Board applied the MPEP standard that a "claim is indefinite when it contains words or phrases whose meaning is unclear."

### Rehearing

- Packard requested a rehearing.
- The Board did not modify its decision.

### Federal Circuit

- Packard appealed the Board's decision to the Federal Circuit (now represented by Wilmer Cutler Pickering Hale and Dorr).

### Issue

- “This case raises an important question...”
- What standard for indefiniteness should the USPTO apply to pre-issuance claims?
- The parties did not provide any cases that have previously addressed this question.

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### 35 U.S.C. § 112, second paragraph

- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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### Packard's Arguments

- Packard argues that the Board misapplied the standard of indefiniteness by finding his claims indefinite on grounds that they contain words or phrases whose meaning is unclear.
- He argues that the claims would not have been held indefinite if the Board applied an “insolubly ambiguous” standard to the claims.
- As such, a claim is not indefinite if a court can give any meaning to the disputed term in the context of the claim.

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### Packard's Arguments

- Packard contends that the “insolubly ambiguous” standard for indefiniteness is mandated for post-issuance cases and pre-issuance cases.

### Federal Circuit

- Per Curiam opinion states that “we believe that the case before us can be resolved without addressing the broad issues raised by Mr. Packard.”
- This statement is the basis for the concurring opinion, which will be discussed later.

### Holding

- “We conclude that, when the USPTO has initially issued a well-grounded rejection that identifies ways in which language in a claim is ambiguous, vague, incoherent, opaque, or otherwise unclear in describing and defining the claimed invention, and thereafter the applicant **fails to provide a satisfactory response**, the USPTO can properly reject the claim as failing to meet the statutory requirements of § 112(b).”

### Holding

- “The satisfactory response by the applicant can take the form of a modification of the language identified as unclear, a separate definition of the unclear language, or, in an appropriate case, a persuasive explanation for the record of why the language at issue is not actually unclear. On the facts before us, this holding suffices to uphold the rejection that occurred here.”

### Federal Circuit Rationale

- “The USPTO must be able to make the congressionally created examination process work so that it fulfills its purpose of producing patents whose claims meet the statutory standards. We earlier approved a procedural mechanism for the USPTO to use in doing this, which we refer to as the ‘prima facie case.’ See *In re Piasecki*, 745 F.2d 1468 (Fed. Cir. 1984). ‘In the prosecution of a patent, the initial burden falls on the PTO [examiner] to set forth the basis for any rejection.’ *Hyatt v. Dudas*, 492 F.3d 1365, 1369-70 (Fed. Cir. 2007).”

### Federal Circuit Rationale

- “The USPTO thus meets its obligation to explain adequately the shortcomings it perceives so that the applicant is properly notified and able to respond. ‘Once the applicant is so notified, the burden shifts to the applicant to rebut the prima facie case with evidence and/or argument.’ *Id.*”
- “The same approach to making the examination process work is an appropriate one for addressing the question of indefiniteness.”

### Federal Circuit Rationale

- “We have elsewhere noted that indefiniteness rejections by the USPTO arise in a different posture from that of indefiniteness challenges to an issued patent.... It makes good sense, for definiteness and clarity as for other validity requirements, for the USPTO initially to reject claims based on a well-founded prima facie case of lack of clarity (in its several forms) based on the perspective of one of ordinary skill in the art in view of the entire written description and developing prosecution history.”

### Federal Circuit Rationale

- “Then, if the applicant does not adequately respond to that prima facie case, to confirm that rejection on the substantive basis of having failed to meet the requirements of § 112(b).”

### Federal Circuit Rationale

- Thus, the Federal Circuit was able to decide the case without determining the appropriate standard for indefiniteness, which is currently under review by the Supreme Court (*Nautilus, Inc. v. Biosig Instruments, Inc.*).

### Federal Circuit Rationale

- As the statutory language of particularity and distinctness indicates, claims are required to be cast in clear terms. It is the claims that notify the public of what is within the protections of the patent and what is not.

### *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1255 (Fed. Cir. 2008)

- “We note that the patent drafter is in the best position to resolve the ambiguity in the patent claims, and it is highly desirable that patent examiners demand that applicants do so in appropriate circumstances so that the patent can be amended during prosecution rather than attempting to resolve the ambiguity in litigation.”

### Federal Circuit

- Given the role of the applicant in the process, it is a reasonable implementation of the examination responsibility for the USPTO to demand persuasive responses after providing a well-grounded identification of clarity problems.
- Packard did not provide a satisfactory response.

### Federal Circuit

- Rather, Packard ignored some rejections entirely and only offered brief explanations of what the written description showed.
- Packard did not fix or amend the claims or traverse the rejections based on the claim language.

### PTAB

- Federal Circuit affirmed the Board based on the Board’s reasoning that Packard’s arguments focus on what is contained in the disclosure rather than the language of the claims.

### Federal Circuit

- “In some cases it is difficult enough for courts to construe claims when the draftsman has made every effort to be clear and concise, let alone when the claims have readily observable ambiguities or incoherencies within them. **Because Mr. Packard had an opportunity to bring clarity to his claim language, we affirm the Board’s finding as to indefiniteness under the MPEP standard properly applied by the USPTO, the standard which we have here approved.**”

### Concurring Opinion by Judge Plager

- “I join the *per curiam* opinion of the court, and fully support the conclusion stated therein. While the *per curiam* opinion reaches the right result and, as far as it goes, for the right reasons, it decides the case on grounds not argued by either party.”

### Concurring Opinion

- “I write separately because I am of the view that a petitioner to this court seeking reversal of a decision is entitled to an explanation of why the arguments on which he relied for his appeal did not prevail. I also believe that the significant issues raised by Mr. Packard deserve to be addressed directly.”

### Concurring Opinion

- Plager goes through a lot of the history on the law of indefiniteness.
- Plager agrees with Packard that the test proposed by the Board for pre-issuance claims differs materially from the standard for post-issuance claims.

### Concurring Opinion

- It is within the authority of the USPTO to interpret the applicable standard, and the Federal Circuit should support the USPTO.

### Concurring Opinion

- “In short, there are no legal obstacles to the USPTO’s proposed interpretation, and there are compelling reasons why, as a policy matter, this court should not preclude or otherwise interfere with the USPTO carrying out its full responsibilities under the Patent Act.”

### Hal Wegner

- “The recent decision in *In re Packard* continues to be controversial. A principal failure of the Board in reaching a conclusion of indefiniteness...was its failure to construe the claims in light of the specification.”
- “*Phillips* makes it clear that the specification is a mandatory tool for claim construction. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315-16 (Fed. Circ. 2005)(en banc).”

## Hal Wegner

- *Packard* sets forth a two-part test of:
  - (a) a prima facie case of indefiniteness by the Examiner without consideration of the specification; and
  - (b) applicant's rebuttal.

## Hal Wegner

- “Historically, patent Examiners are required to perform a complete examination on the merits which includes a study of all available evidence – for and against the patent applicant – to determine whether the statutory predicates for grant of a patent under Title 35 are met.”
- “The Patent Examiner is thus more of a ‘judge’ and clearly not an *advocate* against the patent applicant. Yet, the regime proposed in the *per curiam* opinion turns the examination process upside down into what amounts to an adversarial system....”

## Courtenay Brinckerhoff on PharmaPatents Blog

- “[T]he Federal Circuit decision does not appear to break much new ground, because the burden-shifting framework it supports is common to every issue that examiners raise.”

## Indefiniteness Issues in Other Cases

- *Nassau v. Acushnet*
  - The court held that the phrase “a location not used during ball-striking service” is broad and encompasses any location on the golf club head that is actually used to strike a golf ball. “The use of words such as ‘typical’ or ‘normally’ logically narrows the meaning to the phrase .... However, those words are not found in Claim 1 and therefore do not limit its terms.”
- Would this suggestion really work?

## MPEP 2173.05(b) – Relative Terms

- About
- Essentially
- Similar
- Substantially
- Type
- Relatively
- Aesthetically Pleasing

## Open-Ended Numerical Ranges

- 1. A composition, comprising:
  - at least 20% A; and
  - at least 70% B.
- 2. The composition of claim 1, further comprising:
  - at least 20% C.

### Exemplary Claim Language

- For example
- Such as

### Practice Points

- The USPTO has a lower standard for indefiniteness rejections, so the rejection needs to be addressed in some way.
- Hire a patent attorney or agent to prosecute your application.

Questions?  
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