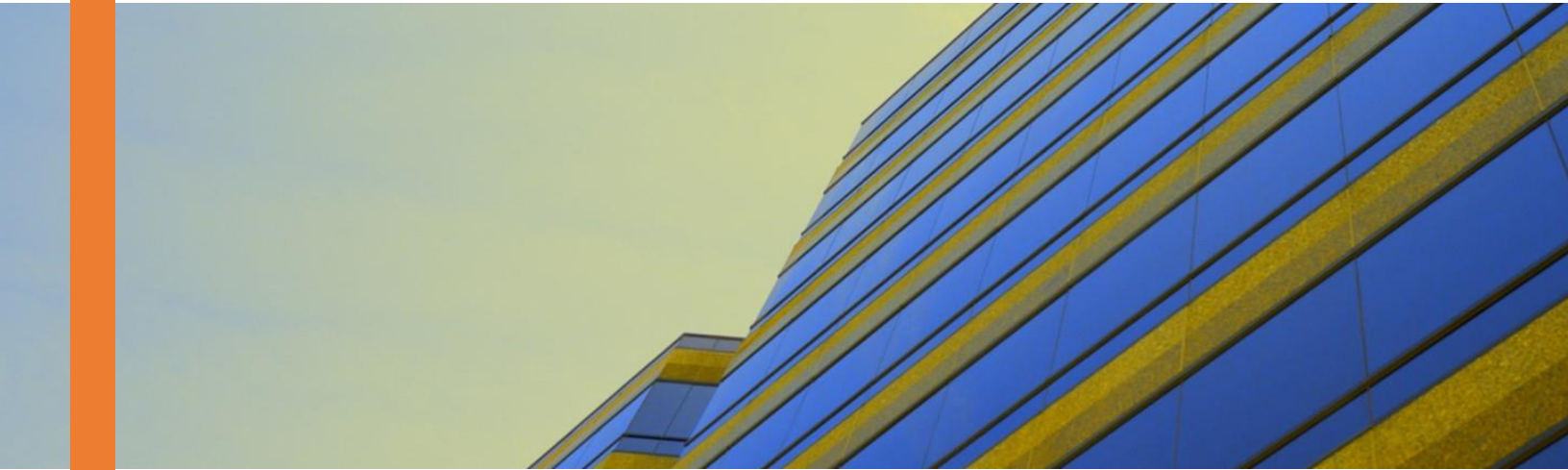


SONIX TECHNOLOGY CO., LTD., V.
PUBLICATIONS INTERNATIONAL, LTD.
2016-1449 (FED. CIR. JANUARY 5, 2017)



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Practice Insights in the Wake of *Sonix Technology Co., LTD., v. Publications International, LTD*

In *Sonix Technology Co., LTD., v. Publications International, LTD* (Fed. Cir. Jan. 5, 2017), the Federal Circuit found that the term at issue in U.S. Patent No. 7,328,845, i.e. “visually negligible,” did not render the asserted claims indefinite under 35. U.S.C. § 112, second paragraph.

The decision provides insight into how terms of degree in claims are treated and how the specification can be useful in providing an objective baseline in interpreting such terms.

The ‘845 patent of Sonix is directed to using a graphical indicator (e.g. a matrix of small dots) to encode information on the surface of an object, and an optical device that can read the graphical indicator and output additional information. An example application is a children’s book with icons, where if one scans an icon (e.g. a horse) with the optical device, the book will output a sound (e.g. pronunciation of “horse”). The patent admits that encoding graphical indicators is not new (e.g. barcode on a book cover), but the invention is an improvement over conventional methods because it renders the graphical indicators “visually negligible.”

The district court granted summary judgment against Sonix finding the patent invalid as being indefinite. Particularly, the district court found the term “visually negligible” in the claim as indefinite under 35. U.S.C. § 112, second paragraph because the term was “purely subjective” and because the claim language provides no guidance on its meaning. The court also determined that the specification does not provide a person of ordinary skill in the art “with a meaning that is reasonably certain and defines objective boundaries” of the claim scope.

On appeal, Sonix argued that the requirements and examples in the specification would have allowed a skilled artisan to know the scope of the claimed invention with reasonable certainty and establish that the term depends on human perception, not opinion. They argued that this was consistent throughout the initial examination and reexamination processes. Publications argued that there is no objective standard to determine whether something is “visually negligible” because it depends on the vagaries of a person’s opinion.

The Federal Circuit agreed with Sonix and reversed the district court, citing *Enzo Biochem, Inc. v. Applera Corp.*, 599 F. 3d 1325, 1336 (Fed. Cir. 2010), where the court found that the clause “not interfering substantially” did not render a claim indefinite because the intrinsic evidence provided examples for non-interfering structures and criteria for their selection. Thus, sufficient guidance was given to allow a skilled artisan to compare a potentially infringing product with examples from the specification to determine whether interference is “substantial.”

The court also cited *Datamize, LLC v. Plumtree Software, Inc.*, 417 F. 3d 1342, 1348-1349 (Fed. Cir. 2005), where the court found the term “aesthetically pleasing,” with respect to a look and feel for interface screens, indefinite because the specification provided no guidance to a person making aesthetic choices. Without any guidance, a determination of whether something is “aesthetically pleasing” was completely dependent on a person’s subjective opinion.

The court further cited *Interval Licensing, LLC v. AOL, Inc.*, 766 F. 3d 1364, 1368 (Fed. Cir. 2014), where the court found displaying content “in an unobtrusive manner that does not distract a user” indefinite because the single example in the specification without more information leaves the skilled artisan to wonder what other forms of display are unobtrusive and non-distracting. This leaves the skilled artisan to consult the “unpredictable vagaries of any one person’s opinion.”

Here, the Federal Circuit found that the term “visually negligible” does not depend on a person’s taste or opinion, but rather depends on whether something can be seen by the normal human eye. The court found that this provides an “objective baseline” to interpret the claim, and thus, is not “purely subjective” even though it may be a term of degree. When turning to the specification to determine whether there is some standard for measuring visual negligibility, the court found that the specification 1) has a general exemplary design for a visually-negligible indicator, 2) states “requirements for the graphical indicators [to be] negligible to human eyes”, and 3) contains two specific examples of visually negligible indicators. Thus, the court found the existence of examples in the specification distinguishes this case from *Datamize*, and the existence of an additional example and specific requirements distinguishes the case from *Interval Licensing*. The court also found the level of detail in the specification to be closer to that provided in *Enzo* because it provided guidance on how to create visually negligible indicators and specific examples that provide points of comparison for the result. Further, the court found that Publications had not provided evidence that human perception varies so significantly that reliance on it as a standard renders the claim indefinite, noting that no one involved in the first or second reexamination had any difficulty in determining the scope of the term “visually negligible.”

The Federal Circuit made one final point about how their holding in this case does not necessarily mean that “the existence of examples in the written description will always render a claim definite, or that listing requirements always provide sufficient certainty.” The court indicated that they simply held that “visually negligible” is not purely a subjective term and that the written description and prosecution history provided sufficient support to inform with reasonable certainty those skilled in the art of the scope of the invention.

Going forward, the decision provides some instruction regarding potential patent drafting strategies with regard to terms of degree. For example, the decision highlights the importance of providing sufficient requirements and examples in the written description so that sufficient guidance is provided to those skilled in the art for interpreting such terms.