

## Federal Circuit Patent Bulletin: *In re Packard*

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May 6, 2014

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On May 6, 2014, in *In re Packard*, the U.S. Court of Appeals for the Federal Circuit (O'Malley, Plager, Taranto) per curiam affirmed the Patent Trial and Appeal Board decision upholding the rejection as indefinite under 35 U.S.C. §112(b) the claims of U.S. patent application Serial No. 12/004,324, which related to a coin change holder. The Federal Circuit stated:

As the statutory language of "particular[ity]" and "distinct[ness]" indicates, claims are required to be cast in clear—as opposed to ambiguous, vague, indefinite—terms. It is the claims that notify the public of what is within the protections of the patent, and what is not. At the same time, this requirement is not a demand for unreasonable precision. The requirement, applied to the real world of modern technology, does not contemplate in every case a verbal precision of the kind found in mathematics. Nor could it do so in a patent system that actually works, in practice, to provide effective protection for modern-day inventions. Rather, how much clarity is required necessarily invokes some standard of reasonable precision in the use of language in the context of the circumstances. . . .

Given the role of the applicant in the process, it is a reasonable implementation of the examination responsibility, as applied to § 112(b), for the USPTO, upon providing the applicant a well-grounded identification of clarity problems, to demand persuasive responses on pain of rejection. That approach decides this case, because Mr. Packard did not offer a satisfactory response to well-grounded indefiniteness rejections in this case. The examiner here, having ample grounds, set forth a variety of ways in which he found the claims imprecise or confusing, sometimes not even understandable, considering them in light of the written description.

Mr. Packard did not respond adequately to this group of claim language problems. He ignored some entirely. As to others, he offered brief explanations of what he thought certain material in the written description and figures showed. But he did not focus on the claim-language difficulties, nor did he propose clarifying changes or show why, on close scrutiny, the existing claim language really was as reasonably precise as the circumstances permitted. The Board relied on this failure of response to the examiner's well-grounded rejections in affirming on the merits the examiner's final rejection. The Board reviewed and agreed with the examiner's identification of the indefiniteness problems that constituted Mr. Packard's failure to adequately comply with the statutory requirements of § 112(b), and for which there had been no satisfactory response from Mr. Packard. On reconsideration, the Board stood by its affirmance of the rejection, noting the crucial distinction between what Mr. Packard argued and what is required to address an indefiniteness problem: Mr. Packard's "arguments focus on what is contained in the disclosure, whereas the indefiniteness to which [§ 112 (b)] is applied is in the language of the claims."

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 findings as to indefiniteness under the MPEP standard properly applied by the USPTO, the standard which we have here approved.

In view of our judgment upholding the Board's determination that the applied-for patent claims are invalid for failure to comply with the requirements of § 112(b), the requirement that a claim "particularly point[ ] out and distinctly claim[ ] the subject matter . . .," we need not address the further issue of the problems with the written description under § 112(a). We affirm the Board's decision on indefiniteness and approve the Board's application of the standard on which it is based.