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Federal Circuit Patent Bulletin: *Interval Licensing, LLC v. AOL, Inc.*

September 10, 2014

"[A] patent does not satisfy the definiteness requirement of § 112 merely because 'a court can ascribe some meaning to a patent's claims.' The claims, when read in light of the specification and the prosecution history, must provide objective boundaries for those of skill in the art."

On September 10, 2014, in *Interval Licensing, LLC v. AOL, Inc.*, the U.S. Court of Appeals for the Federal Circuit (Taranto, Chen*) affirmed-in-part, vacated-in-part, and remanded the district court's judgment, inter alia, that certain claims of U.S. Patents No. 6,034,652 and No. 6,788,314, which related to an attention manager for occupying the peripheral attention of a person in the vicinity of a display device, were invalid for indefiniteness and that AOL did not infringe the '652 patent. The Federal Circuit stated:

A patent must "conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as [the] invention." A claim fails to satisfy this statutory requirement and is thus invalid for indefiniteness if its language, when read in light of the specification and the prosecution history, "fail[s] to inform, with reasonable certainty, those skilled in the art about the scope of the invention." [T]he statute's definiteness requirement calls for a "delicate balance." The definiteness standard "must allow for a modicum of uncertainty" to provide incentives for innovation, but must also require "clear notice of what is claimed, thereby appris[ing] the public of what is still open to them." . . .

The key claim language at issue in this appeal includes a term of degree ("unobtrusive manner"). [W]e do not hold today, that terms of degree are inherently indefinite. Claim language employing terms of degree has long been found definite where it provided enough certainty to one of skill in the art when read in the context of the invention. . . . "[A]bsolute precision" in claim language is "unattainable." Although absolute or mathematical precision is not required, it is not enough, as some of the language in our prior cases may have suggested, to identify "some standard for measuring the scope of the phrase." [A] patent does not satisfy the definiteness requirement of § 112 merely because "a court can ascribe some meaning to a patent's claims." The claims, when read in light of the specification and the prosecution history, must provide objective

boundaries for those of skill in the art.

The patents' "unobtrusive manner" phrase is highly subjective and, on its face, provides little guidance to one of skill in the art. Although the patented invention is a system that displays content, the claim language offers no objective indication of the manner in which content images are to be displayed to the user. As the district court observed, "whether something distracts a user from his primary interaction depends on the preferences of the particular user and the circumstances under which any single user interacts with the display." The lack of objective boundaries in the claim language is particularly troubling in light of the patents' command to read "the term 'image' . . . broadly to mean any sensory stimulus that is produced from the set of content data," including sounds and video. The patents contemplate a variety of stimuli that could impact different users in different ways. As we have explained, a term of degree fails to provide sufficient notice of its scope if it depends "on the unpredictable vagaries of any one person's opinion." Where, as here, we are faced with a "purely subjective" claim phrase, we must look to the written description for guidance. We find, however, that sufficient guidance is lacking in the written description of the asserted patents. . . .

We do not agree with Interval that it is reasonably clear that the "unobtrusive manner" language is tied to a specific type of display. Although Interval identifies portions of the specification that appear to use the "unobtrusive manner" phrase in conjunction with the wallpaper embodiment, other portions of the specification suggest that the phrase may also be tied to the screen saver embodiment. [W]e find that the specification is at best muddled, leaving one unsure of whether the "unobtrusive manner" phrase has temporal dimensions as well as spatial dimensions. The hazy relationship between the claims and the written description fails to provide the clarity that the subjective claim language needs. The prosecution history further illustrates the difficulty in pinning down the relationship between the written description and the "in an unobtrusive manner that does not distract the user" claim phrase. . . .

We recognize that a patent which defines a claim phrase through examples may satisfy the definiteness requirement. In this case, however, we decline to cull out a single "e.g." phrase from a lengthy written description to serve as the exclusive definition of a facially subjective claim term. Had the phrase been cast as a definition instead of as an example—if the phrase had been preceded by "i.e." instead of "e.g."—then it would help provide the clarity that the specification lacks. But as the specification is written, we agree with the district court that a person of ordinary skill in the art would not understand the "e.g." phrase to constitute an exclusive definition of "unobtrusive manner that does not distract a user." With this lone example, a skilled artisan is still left to wonder what other forms of display are unobtrusive and non-distracting. What if a displayed image takes up 20% of the screen space occupied by the primary application with which the user is interacting? Is the image unobtrusive? The specification offers no indication, thus leaving the skilled artisan to

consult the "unpredictable vagaries of any one person's opinion." Such ambiguity falls within "the innovation-discouraging 'zone of uncertainty' against which [the Supreme Court] has warned."