

Stick to the Fax: Conflicting Statements Made During Prosecution Lead to Indefiniteness

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In deciding whether use of the term “passive link” to define a connection between a computer terminal and a fax machine rendered a patent claim indefinite, the US Court of Appeals for the Federal Circuit affirmed the district court’s finding of invalidity based on conflicting statements made by the patent owner during prosecution. *Infinity Computer Products, Inc. v. Oki Data Americas, Inc.*, Case No. 20-1189 (Fed. Cir. Feb. 10, 2021) (Prost, C.J.)

Infinity owns a patent directed to providing a circuit for interfacing a personal computer with a facsimile machine to enable the facsimile to be used as a scanner or a printer for a personal computer. The patent seeks to accomplish all of the objectives of a scanner or a printer in a simple, straightforward manner through the use of a circuit of highly simplified design and low cost. The patent claims recite that this functionality is accomplished “through a bi-directional direct connection via a passive link between the facsimile machine and the computer.” Infinity asserted the patent against Oki in district court.

The term “passive link” does not appear in the patent specification. Infinity introduced this term during prosecution to overcome rejections based on a prior art patent to Perkins. During prosecution, Infinity unsuccessfully argued that unlike Perkins, the claimed invention permits uninterrupted transfer of signals between the facsimile and the computer without the use of intervening circuitry. Infinity engaged in multiple rounds of amendment and response with the examiner before finally overcoming the rejections based on Perkins by arguing that the invention “creates a passive link between the facsimile machine and the computer [and] therefore does not require any intervening apparatus as does Perkins.” Perkins used a modem, characterized by Infinity as the “intervening apparatus,” internal to the computer. Infinity argued that the modem “should be regarded as a peripheral device to the computer which processes data before it is transmitted to the I/O bus of the computer,” effectively drawing the boundary of the “passive link” at the I/O bus of the computer.

After allowance, the patent was the subject of three *ex parte* re-examination proceedings. The patent was a continuation-in-part of a parent application, and in order to overcome a prior art reference asserted in the re-examination proceeding, Infinity argued that the claimed “passive link” element was entitled to the priority date of an earlier parent application. Infinity specifically noted that the patent’s description of “the RJ11 telephone cable and use thereof in communicating data between the fax machine 30 and the PC computer 40 meets the definition of ‘passive link.’” In doing so,

Infinity pointed to certain figures in the parent application specification that disclosed fax modem circuitry internal to the computer, effectively drawing the boundary of the “passive link” at the computer’s external port—before the I/O bus.

The district court found that there was a discrepancy on the boundary of the “passive link” because during prosecution it was defined as at the I/O bus of the computer, but during the *ex parte* re-examination it was defined as at the computer’s external port, *i.e.*, circuitry upstream of the I/O bus. Based on this discrepancy, the district court entered final judgment of invalidity based on indefiniteness of the terms “passive link” and “computer,” stating that it is not reasonably certain where one ends and the other begins. Infinity appealed.

The Federal Circuit affirmed the finding of indefiniteness and analogized the case with its previous findings in [*Teva Pharms. v. Sandoz*](#). In *Teva*, the Court found that the term “molecular weight” was indefinite because the claim language and specification were silent as to which of the three different ways that “molecular weight” may be calculated. The parties agreed that the resulting molecular weight could be materially different depending on the method used. At two separate points during prosecution, the patentee defined the term using different methodologies in order to overcome two separate rejections. The Court found that the inconsistent statements made during prosecution supported its finding that the term “molecular weight” was indefinite in the *Teva* case.

The Federal Circuit found the facts of *Teva* to be similar to the present case. In both instances, the claims and specification did not clearly define the term in question. Additionally, during the prosecution history, the patentee made conflicting statements as to the definition of the term. The Court therefore affirmed the finding of indefiniteness.

Practice Note: The Federal Circuit also highlighted the importance of distinguishing the intrinsic versus extrinsic records for the purposes of indefiniteness. Infinity introduced “unrebutted expert testimony” during the district court proceeding that the term “passive link” needed no construction, or that it should be construed as “[a link where] data is transferred, with no intervening apparatus or signal interception by a processing element or any active component, along the path of an unbroken direction connection between the PC and the facsimile machine.” In addition to noting that the proposed definition “is no help,” the Court found that the district court properly discredited the expert’s testimony, because “Infinity’s contradictory positions are plain from the patent record. The district court therefore saw no need for extrinsic evidence, and neither do we.”

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