

Conflicting Prosecution Statements Can Render Claims Indefinite

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In *Infinity Comput. Prods. v. Oki Data Ams., Inc.*, No. 2020-1189 (Fed. Cir. Feb. 10, 2021), the Federal Circuit affirmed the District of Delaware’s finding that claims of U.S. Patent Nos. 6,894,811, 7,489,423, 8,040,574, and 8,294,915 were invalid as indefinite. The patents claimed the use of a fax machine as a printer or scanner for a personal computer. Neither the specification nor the original claims included the disputed term “passive link,” but the patentee added it during prosecution to distinguish an anticipatory reference. In a subsequent *ex parte* reexamination, the patentee asserted an inconsistent definition of the term to antedate a different reference. The district court held that because of the inconsistent positions in the intrinsic record, the claims reciting this term were indefinite.

On appeal, the Federal Circuit affirmed. The Court rejected Infinity’s arguments, including that the court should have interpreted the term in a way other than how Infinity defined it during prosecution and that indefiniteness cannot be based on a “single statement” in the file history. The Court emphasized that the term on its own is not necessarily indefinite but was rendered so based on Infinity’s own conflicting statements in the intrinsic record.

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