

## Terms of Degree Not Always Indefinite

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The US Court of Appeals for the Federal Circuit overturned a district court determination that the claim terms “resilient” and “pliable” were indefinite. The Federal Circuit found that the claims, while broad, were sufficiently definite in view of both intrinsic and extrinsic evidence. The Federal Circuit also upheld the district court’s findings of no induced infringement, finding zero evidence of predicate direct infringement of the properly construed method claims. *Niazi Licensing Corp. v. St. Jude Medical S.C., Inc.*, Case No. 21-1864 (Fed. Cir. Apr. 11, 2022) (Taranto, Bryson, **Stoll**, JJ.) The Federal Circuit also affirmed entry of sanctions excluding portions of the plaintiff’s technical and damages expert reports for failing to disclose predicate facts during discovery and also affirmed exclusion of portions of plaintiff’s damages expert report as unreliable for being conclusory and legally insufficient.

In reaching its decision on indefiniteness, the Federal Circuit focused on the terms “resilient” and “pliable” as used in a claim directed to a double catheter structure. Citing the 2014 Supreme Court decision in *Nautilus v. Biosig Instruments*, the Federal Circuit explained that language has “inherent limitations,” and stated that a “delicate balance” must be struck to provide “clear notice of what is claimed” and avoid the “zone of uncertainty” relating to infringement. The Court noted that under *Nautilus*, claims must provide “objective boundaries,” but the Court distinguished the present case from those in which “subjective boundaries” created uncertainty and rendered the claim indefinite. The Court pointed to its 2005 decision in *Datamize v. Plumtree Software* as a “classic example” of subjectivity where the term “aesthetically pleasing” was deemed indefinite because the patent provided no way to provide “some standard for measuring the scope of the phrase.” The Court also noted that a patent’s claims, written description and prosecution history—along with any relevant extrinsic evidence—can provide or help identify the necessary objective boundaries for claim scope

The Federal Circuit concluded that there was sufficient support in the intrinsic evidence, both in the claims themselves and the written description, to allow a skilled artisan to determine the scope of the claims with reasonable certainty. The Court explained that the claim at issue recited “an outer, *resilient* catheter having shape memory” that “itself provides guidance on what this term means—the outer catheter must have ‘shape memory,’ and ‘sufficient stiffness.’” The Court also cited to “[n]umerous dependent claims [that] further inform the meaning of this term by providing exemplary resilient materials of which the outer catheter could be made. . . . The written description provides similar guidance . . . . Thus, a person of ordinary skill reading the claims and written description would know of exemplary materials that can be used to make a resilient outer

catheter, *i.e.*, one that has shape memory and stiffness such that it can return to its original shape.”

The Federal Circuit distinguished this case from *Datamize*, where the claim scope depended on the eye of each observer, finding it more akin to its 2017 decision in *Sonix Technologies*. In that case, the Court found that the claim term “visually negligible,” while a term of degree, was, in the context of the claim provided, “an objective baseline through which to interpret the claims”—*i.e.*, whether it could be seen by the normal human eye.

**Practice Note:** When analyzing claims for definiteness, practitioners should focus on how a term of degree affects the objective and subjective nature of the claim scope to determine whether there is an objective way a skilled artisan can determine the scope of the claim.

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