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A PATENT IS INVALID FOR INDEFINITENES UNDER 35 U.S.C. §112 IF ITS CLAIMS FAIL TO INFORM A PERSON SKILLED IN THE ART "WITH REASONABLE CERTAINTY" ABOUT THE SCOPE OF THE CLAIMED INVENTION

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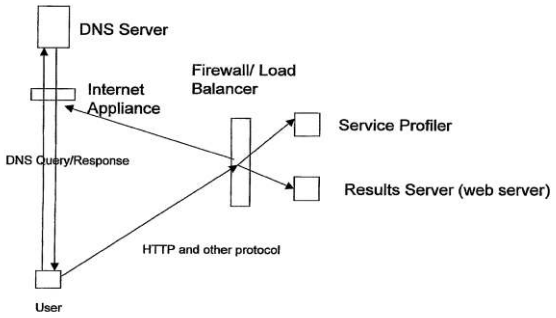
Introduction: The U.S. Supreme Court has held that "a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention." *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014).

Background: In the recent U.S. Court of Appeals for the Federal Circuit case of *Bushnell Hawthorne, LLC v. Cisco Systems, Inc.*, 2019-2191 (Fed. Cir. 2020), Bushnell appealed a decision of the district court holding that Bushnell's U.S. Patent No. 7,933,951 ("'951 patent") is invalid as indefinite pursuant to 35 U.S.C. §112(b). The Federal Circuit affirmed the district court's finding of invalidity pursuant to 35 U.S.C. §112(b).

The '951 patent is concerned with the redirecting of internet traffic for, for example, generating advertising revenue. The invention redirects only certain types of communication traffic of interest, while permitting other types of communication to pass without redirection. Figure 1, below, illustrates a block diagram of the method and system of the invention, which redirects only certain desired types of internet communication traffic.



Claim 1, the only independent claim, recites a "computer system for redirecting Internet communication." The claimed computer system is comprised of a first processor through a sixth processor. The fifth processor:

a) supplies *one or more IP Addresses* for the information requested if one or more of the predefined bit strings or character sets are not encountered,

b) supplies *one or more second IP Addresses* for the information requested if one or more different bit strings or character sets are encountered,

c) supplies *one or more third IP Addresses* if one or more of the pre-defined bit strings or character sets are encountered and a higher level protocol can be inferred, and/or

d) allows the traffic to flow thru unmodified; and

a sixth processor that analyzes a request submitted to *said different IP Address* for one or more alternative bit strings or character sets * * *, and

wherein the system further comprises maintaining a list of bit strings or character sets for which *a different IP Address* should not be supplied, wherein the list is updated one or more times after creation of the list, and wherein the list is updated based on monitoring of requests for: originating *IP Address*, requested hostname, size of a DNS query, frequency of a single hostname or domain name, port number, date, and/or time.

CAFC Decision: *First*, the CAFC stated that claim 1 calls for three classes of IP addresses; namely, "one or more IP Addresses," "one or more second IP Addresses," and "one or more third IP Addresses" supplied by the fifth processor; and thus, "[e]ach of those terms is presumed to have a separate meaning and, therefore, presumed to refer to *different* classes of IP addresses." To a person of ordinary skill in the art, it becomes difficult to discern which of the different IP addresses "said different IP Address [having a request analyzed by the sixth processor]" refers to.

Second, each of the three classes of IP addresses is recited in the "plural" form, while "said different IP Address" is recited in the "singular" form. "Where [in claim 1], a singular/plural mismatch further confuses an already confused claim, it is proper to consider the mismatch in discerning whether a [person of ordinary skill in the art] could understand the claim with reasonable certainty." With regard to this "mismatch" language in claim 1, the Federal Circuit found that a person of ordinary skill in the art could not understand the claim with "reasonable certainty."

Third, although the specification uses the term "the different IP Address" or "said different IP Address," it does not clarify the meaning of "said different IP Address." In its attempt to find the meaning of the term "said different IP Address," the Federal Circuit specifically found two conflicting meanings of "said different IP Address" in the specification. In its review of the specification, the Federal Circuit stated that:

> [a]t one point, the specification appears to indicate * * * that the "different" IP address the patent refers to is the one which was requested. *See* '951 patent, col. 13, ll. 21-22 * * *. At another, the specification provides comparing one list of request submitted to "the different IP Address" to another list of requests submitted to "the different IP Address"-reasonably indicating that those two uses of "different IP Address" are not, even in the same sentence, referring to identical data sets. *Id.* at col. 13, l. 63-col. 14, l. 1.

In citing the U.S. Supreme Court case of *Nautilus, Inc. v. Biosig Instruments, Inc.* (see above), the Federal Circuit found that, for the reasons discussed above, the meaning of "said different IP Address" is entirely unclear, and a person of ordinary skill in the art, "faced with the claims and the specification, could not, with reasonable certainty, discern the meaning of the claim term;" and thus held claim 1 and all the claims depending therefrom invalid for indefiniteness, pursuant to 35 U.S.C. §112(b).

Summary and Key Points: The finding of patent invalidity based on indefinitess, pursuant to 35 U.S.C. §112(b), can happen, as seen in the *Bushnell Hawthorne, LLC v. Cisco Systems, Inc.* case. The claim term "said different IP Address" lacked proper antecedent basis, and there was a "singular/plural mismatch" in the use of this term in comparison to other terms recited in the claim. Thus, the Federal Circuit ruled that a person of ordinary skill in the art could not, *with reasonable certainty*, discern the meaning of this claim term, and the claim and claims dependent therefrom are therefore invalid for indefiniteness under 35 U.S.C. §112(b). In its attempt to salvage the patented claims, the Federal Circuit made significant efforts in looking into the specification for clarification as to the meaning of "said different IP Address," but found that the specification was just as confusing as the claim.

It is important to remember that basic English grammar be followed when drafting patent claims. In this case, the term "said" or "the" refers to a specific or particular noun (element in a claim), and is, in English grammar, a "*definite* article," which requires that a similar noun or element in the claim precedes it. A clear description of the claimed element in the specification is also important in case clear meaning of the element cannot be discerned in the claim.

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