When are Method/Device Hybrid Claims Indefinite?

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Possible Image (taken from Fed. Circ. opinion):

The Federal Circuit’s recent decision in UltimatePointer v. Nintendo (Fed. Cir. Mar. 1, 2016) provides a reminder of the need to use caution when drafting a claim that could be read to cover both a device and a method of use.

UltimatePointer is the assignee of U.S. Patent No. 8,049,729 (“the ‘729 patent”) which is generally directed to a handheld pointing device that can be used to control the cursor on a projected computer screen, thereby improving a presenter’s ability to control the cursor while making a presentation to an audience. UltimatePointer asserted several claims of the ‘729 patent against Nintendo, with Nintendo’s Wii remote being the accused product. A key issue in the litigation was whether the asserted claims were invalid for impermissibly reciting both a device and a method in the same claim.

Claim 1 of the ‘729 patent, which was considered by the court to be representative of the asserted claims, reads as follows:

1. An apparatus for controlling a feature on a computer generated image, the apparatus comprising:
   a handheld device including:
   an image sensor, said image sensor generating data related to the distance between a first point and a second point, the first point having a predetermined relation to the computer generated image and the second point having a predetermined relation to a handheld enclosure; and
   a processor coupled to said handheld device to receive said generated data related to the distance between a first point and a second point and programmed to use the distance between the first point and the second point to control the feature on the image.
In the lower court proceedings, the U.S. District Court for the Western District of Washington granted summary judgment of invalidity based on indefiniteness under 35 U.S.C. §112. In particular, the district court held that the claim limitation “a handheld device including: an image sensor, said image sensor generating data . . .” rendered the claim indefinite, as it was not clear whether the claim was infringed when the apparatus was created, or when the apparatus was put to the specified use. In other words, the district court found the claim to run afoul of IPXL Holdings v. Amazon (Fed. Cir. 2005), in which the Federal Circuit held that “a single claim covering both an apparatus and a method of use of that apparatus” fails to meet the requirements of §112.

UltimatePointer appealed the district court’s finding of indefiniteness to the Federal Circuit, which reversed. The Federal Circuit explained that, in these types of cases, the key distinction is whether the claim recites a capability of the claimed structure (in which case the claim is not indefinite) or instead recites the activities of a user (in which case the claim is indefinite). The court’s opinion analyzes several of the pertinent cases: In IPXL Holdings v. Amazon (Fed. Cir. 2005), the indefinite claim was a system claim which recited that “the user uses the input means.” Similarly, in In re Katz (Fed. Cir. 2011), the indefinite claim was a system claim which recited that “callers digitally enter data.” Thus, in both of these cases, the invalid claims required some user action. On the other hand, in MEC v. Texas Instruments (Fed. Cir. 2008), a claim directed to a processor that recited “performing a Boolean algebraic evaluation” was not indefinite, because the “performing” recitation was merely a capability of the processor, not an activity performed by a user. Because UltimatePointer’s claim only indicates that the claimed structure has a particular capability (i.e., that the image sensor can generate data), and does not require that any data be actually generated by a user, the court held that the claim is not indefinite.

Even though UltimatePointer’s claims ultimately survived an indefiniteness challenge, this case provides an important reminder of the need to take care when drafting claims to avoid reciting user actions in a system or apparatus claim. This case is also a reminder to those challenging or evaluating the validity of a claim that the possibility exists for an indefiniteness position based on impermissible method/device hybrid claiming.