

CLIENT ALERT

The Facts on Fax Machines: They're Not Dead, They're Indefinite

Feb.16.2021

The Federal Circuit affirmed a finding of indefiniteness based on a patent owner's materially conflicting positions adopted during prosecution on the scope of its claims.

Infinity Computer Products sued Oki Data in 2012 alleging infringement of four of its patents involving the use of a fax machine as a printer or scanner for a personal computer. The indefiniteness issues relate to the connection between the fax machine and the computer, termed a "passive link."

Oki Data argued that the terms "passive link" and "computer" are indefinite because Infinity took materially conflicting positions on the endpoint of the "passive link" during prosecution. The Federal Circuit agreed, concluding, based on Infinity's contradictory positions, that a person of ordinary skill would not be able to determine where the claimed passive link ends and the computer begins. That is, the public was not properly put on notice of "what is still open to them."

Infinity first introduced the term "passive link" during prosecution of one of its patents to distinguish a prior-art reference that similarly disclosed using a fax machine as a scanner or printer for a computer. Infinity argued that the reference was distinguishable because it required intervening circuitry, like a fax modem, between the fax machine and computer. Infinity contended that its claimed "passive link" in contrast does not end at a computer's port, but rather conveys data from the fax machine directly to a computer's I/O (input/output) bus. During a later reexamination of the patent, however, Infinity completely changed course in order to distinguish another prior art reference, arguing that the passive link does in fact end at the computer's port.

On appeal from the district court's final judgment of invalidity, Infinity contended that "computer" was not indefinite because it's a familiar word with a well-understood ordinary meaning. The Court, recognizing that "in a vacuum, it might seem odd to hold 'computer' indefinite," explained that "the indefiniteness here does not reside in the term 'passive link' or 'computer' on its own but rather in the relationship between the two in the context of these claims." The Court concluded that "any resulting strangeness stems from Infinity's own statements."

The Court rejected Infinity's remaining arguments, including that the district court should not have held the patent claims indefinite based on a "single statement" in the prosecution history. To that point, the Federal Circuit emphasized that a court could appropriately rely on a single contradictory statement to find a claim indefinite (citing *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 789 F.3d 1335 (Fed. Cir. 2015)), but regardless, disagreed that the district court did so.

The full decision can be found here: [*Infinity Computer Products Inc. v. Oki Data Americas Inc.* No. 20-1189 \(Fed. Cir. 2021\)](#).

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