

## Indefinite Claims With Definite Alternative Forms Can Be Reviewed for Patentability in IPR Proceedings

MAY 15, 2020

*Cochlear Bone Anchored Solutions AB v. Oticon Medical AB*, No. 2019-1105 (Fed. Cir. May 15, 2020)

Petitioner sought *inter partes* review of a patent that claimed a bone-anchored hearing aid that transmits soundwaves transcranially from a patient's deaf ear to the patient's non-deaf ear. The Patent and Trademark Office's Patent Trial and Appeal Board (PTAB) concluded that all but four of the patent's claims were unpatentable. With respect to those four claims, the PTAB concluded that—because each contained a means-plus-function limitation without disclosing a corresponding structure in the specification—it “could not construe the claims in order to compare the claim requirements with the prior art” in order to come to a conclusion about patentability. Although the Federal Circuit affirmed most of the PTAB's findings, it vacated the PTAB's decision as to one of the four means-plus-function claims.

35 U.S.C. § 112 permits a claim to recite, as a required element, a means for performing a function without reciting a corresponding structure for performing that function. The scope of such claims is determined by what corresponding structures the specification describes for performing the function. If the specification wholly fails to recite any such structure, the claim will be indefinite—it has what amounts to an “inkblot” as a required element. According to the Federal Circuit, such claims “cannot be compared to prior art, because an essential claim element has no discernable meaning.” Because the PTAB is not permitted in *inter partes* reviews to hold that a challenged patent claim is “indefinite,” the proper conclusion in such circumstances is that no decision can be reached with respect to the unpatentability of the claim at issue under 35 U.S.C. § 102 or 35 U.S.C. § 103.

In this case, the Federal Circuit affirmed the PTAB's conclusion that “unpatentability could not be shown” as to three of the four indefinite means-plus-function claims at issue. However, because the last claim recited a “directivity means comprising at least one directivity dependent microphone and/or signal processing means in the electronic circuitry,” the court concluded that one subset of claim coverage—*i.e.*, directivity means comprising just one directivity dependent microphone—had a discernable meaning and could be compared to the prior art. Based on this “stand-alone alternative to the signal processing means,” the Federal Circuit held that the PTAB should have conducted a prior-art analysis to determine whether that stand-alone alternative was unpatentable and remanded for further proceedings on that claim.

A copy of the opinion can be found [here](#).

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