



Federal Circuit Addresses Indefiniteness and Mean-Plus-Function Claiming in *Inter Partes* Review Proceedings at the PTAB

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Prisua Engineering Corp. (“Prisua”) sued Samsung Electronics America, Inc. (“Samsung”) for patent infringement based on Samsung’s “Best Face” feature, which allows taking a burst of pictures and replacing a facial image with a better image in the burst. In response, Samsung petitioned for *inter partes* review. During review, the Board raised two indefiniteness issues *sua sponte* that, according to the Board, prevented it from assessing anticipation and obviousness. First, the claims recite “a data entry device ... operated by a user to select [] at least one pixel.” Applying *IPXL Holdings, LLC v. Amazon.com, Inc.*, 430 F.3d 1377 (Fed. Cir. 2005), the Board decided that this language was unclear as to whether it covers a device *capable of* being operated by a user or covers only the user *actually operating* the device. Second, the claims recite a “digital processing unit,” which the Board interpreted as a means-plus-function term under 35 U.S.C. § 112, ¶ 6, without corresponding structure in the specification.

On appeal, Samsung argued that the Board should have found the claims unpatentable based on indefiniteness in its final written decision. The Federal Circuit disagreed because Congress expressly limited the scope of *inter partes* review to assessing anticipation and obviousness under 35 U.S.C. §§ 102 and 103 based on patents and printed publications. The court instructed that, if the scope of the claims cannot be ascertained with reasonable certainty for purposes of assessing patentability, the Board should decline to institute the IPR, or if the indefiniteness issue affects only certain claims, the Board should conclude that it could not reach a decision on the merits for those claims. The Federal Circuit stated that, in cases where the Board cannot reach a final decision on certain claims because of indefiniteness, the

petitioner would not be estopped by 35 U.S.C. § 315(e) from challenging those claims under §§ 102 and 103 in other proceedings.

Next, the Federal Circuit found that the Board erred in construing “digital processing unit” as a means-plus-function term under 35 U.S.C. § 112, ¶ 6. Because the term does not contain the word “means,” there is a rebuttal presumption that § 112, ¶ 6 does not apply. That presumption may be overcome only if the challenger demonstrates that the claim term fails to “recite sufficiently definite structure” or else recites “function without reciting sufficient structure for performing that function.” The Board, however, pointed to no evidence that a person of skill in the art would regard the term as purely functional. Prisua’s technical expert testified that the term “digital processing unit” is an image processing device that people in the art would be familiar with. Also, the Board treated the term differently in other claims by equating a “digital process unit” to a class of known structures—central processing units. The Federal Circuit found that, as used in the claims, a person of skill would understand the term “digital processing unit” to serve as a stand-in for a general purpose computer or central processing unit, thus a reference to structure. Because the Board erred in applying § 112, ¶ 6, the court rejected the Board’s finding that it could not analyze the claims for anticipation or obviousness.

Lastly, the Federal Circuit addressed the Board’s conclusion that the claims were indefinite under *IPXL* for reciting both an apparatus and a method of using that apparatus. In light of its decision on the “digital processing unit,” the court decided that the Board ended its analysis with respect to *IPXL* prematurely. On remand, the Federal Circuit instructed the Board to address Samsung’s argument that the Board may analyze patentability of a claim, even if the claim is indefinite under the reasoning of *IPXL*. The court limited its decision to only *IPXL*-type indefiniteness and in forums not authorized to consider indefiniteness as a basis for invalidity, i.e., IPR.

PRACTICE TIP

The Board may not cancel claims for indefiniteness in an IPR. Where claims may be subject to *IPXL*-type indefiniteness, petitioners should show why they are anticipated or obvious under either interpretation. Also, when seeking to overcome the presumption against applying pre-AIA § 112, ¶ 6 (or AIA § 112(f)) to claim terms that do not recite “means,” challengers should present evidence sufficient to demonstrate that the term fails to “recite sufficiently definite

structure” or else recites “function without reciting sufficient structure for performing that function.”

Samsung Electronics America, Inc. v. Prisia Engineering Corp., No. 2019-1169, -1260 (Fed. Cir. Feb. 4, 2020).

Categories

Federal Circuit

Patent Trial & Appeal Board

35 U.S.C § 112 ¶ 6

35 U.S.C. § 315(e)(2) estoppel

America Invents Act

Inter Partes Review

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