

ANNOTATED PATENT DIGEST

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CHAPTER 23

SUFFICIENCY OF CLAIMING – § 112, ¶ 2

I. PARTICULARLY POINT OUT AND DISTINCTLY CLAIM THE INVENTION

A. Statutory Requirement for Definiteness in Claims

- § 23:1 Indefinite Claims – In General
- § 23:2 Separate from Other Validity Requirements
- § 23:3 Intended to Give Notice of the Extent of the Exclusionary Rights

B. Standards for Determining Indefiniteness

- § 23:4 Basic Test
- § 23:5 Impossibility, Not Difficulty, in Claim Construction Required
- § 23:6 Need Not Provide Precise Guidance on What Does Not Infringe
- § 23:7 Form of Disclosure Irrelevant
- § 23:8 Claim Need Not Teach the Technology
- § 23:9 Not Indefinite if Term Defined in Written Description
- § 23:10 No Requirement that Claim Term Must be Expressly Defined in the Written Description
- § 23:11 Numerical Precision Not Necessarily Required
- § 23:12 — Use of Qualifiers
- § 23:13 Functional Limitations
- § 23:13.50 Simultaneously Claiming an Apparatus and Method of Using the Apparatus
- § 23:14 Negative Limitations
- § 23:14.50 Subjective Terms May be Indefinite
- § 23:15 Failing to Disclose Corresponding Structure of a Means-Plus-Function Limitation
- § 23:16 — Clear and Convincing Evidence Required
- § 23:17 — Judged From Perspective of One of Ordinary Skill in the Art
- § 23:18 Claims Broader than Enabling Disclosure

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- § 23:19 Claiming Less than What is Needed to Practice the Invention
- § 23:20 Undue Multiplicity in the Number of Claims Presented for Examination

C. Procedural Aspects of an Invalidity Challenge for Indefiniteness

- § 23:21 Question of Law
- § 23:22 Clear and Convincing Evidence Required
- § 23:23 Resolving Indefiniteness Doubts for Issued Patents
- § 23:24 Use of Drawings
- § 23:25 Use of Extrinsic Evidence
- § 23:26 Use of Prosecution History
- § 23:27 Use of Post-Filing Publications
- § 23:28 Cannot Make Infringement Determinations

D. Case Examples on Claim Indefiniteness

- § 23:29 Cases Finding Claim Indefinite
- § 23:30 Cases Finding Claim Sufficiently Definite

II. CLAIMING THE SUBJECT MATTER APPLICANT REGARDS AS ITS INVENTION

- § 23:31 Statutory Requirement
- § 23:32 Standard
- § 23:33 Question of Law
- § 23:34 Limitations on Using Inventor Deposition Testimony
- § 23:35 The Invention can be Changed by Amendments or Continuation Practice
- § 23:36 Cases Finding Inventor did Not Claim What the Applicant Regarded as its Invention
- § 23:37 Cases Finding Inventor did Claim What the Applicant Regarded as its Invention