

DATAMIZE V. PLUMTREE SOFTWARE: CLAIM INDEFINITENESS
UNDER 35 U.S.C. §112, SECOND PARAGRAPH

In an opinion regarding the validity of a claim on indefiniteness grounds, the Court of Appeals for the Federal Circuit (“CAFC”) recently stated that the phrase “aesthetically pleasing” is indefinite as “[s]ome objective standard must be provided in order to allow the public to determine the scope of the claimed invention.” *Datamize, LLC v. Plumtree Software, Inc.*, (No. 04-1564) (Fed. Cir. 2005).

The CAFC reasoned that a purely subjective standard was insufficient to determine whether a claim term satisfied the statutory requirement of 35 U.S.C. §112, second paragraph, of adequately notifying the public of a patentee’s right to exclude. The CAFC looked to the specification, the prosecution history, and the extrinsic record in an attempt to determine an objective standard in defining the disputed claim term, but concluded that the patentee did not “suggest or provide any meaningful definition for the phrase “aesthetically pleasing” itself.”

The court concluded that “[t]he scope of the claim language cannot depend solely on the unrestrained, subjective opinion of a particular individual purportedly practicing the invention.” Therefore, in order to avoid a finding of invalidity under 35 U.S.C. §112, second paragraph, some workable objective standard must sufficiently define a claim term in the patent such that the public will be able to objectively determine the scope of the patent.

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