

International reports

'Visually negligible' is definite enough

[Baker Donelson - USA](#)

[W Edward Ramage](#)

18 Jan 2017

On January 5 2017 the Federal Circuit in *Sonix Technology v Publications International* determined that the patent claim term 'visually negligible' was definite enough to meet the definiteness requirement under the Patent Act. In reversing the district court, which had held that the term rendered the asserted patent claims indefinite, and thus invalid, the Federal Circuit held that 'visually negligible' was not purely subjective.

The Sonix patent was directed to a system for using a "graphical indicator" consisting of a matrix of small dots to encode information on the surface of an objects. An optical device was used to capture an image that included the graphical indicator, retrieve the indicator from the image and output additional information (eg, audio information). While the prior art clearly included recording information on the surface of objects, the patent purported to improve on conventional methods by rendering the graphical indicator "visually negligible".

Sonix asserted that Publications International, SD-X Interactive, Encyclopedia Britannica and Herff Jones had infringed the assert claims. The alleged infringers asserted that the term 'visually negligible' was indefinite under Section 112(2) of the Patent Act. The district court ultimately granted summary judgment for the defendants, holding that "visually negligible" was "purely subjective".

Section 112 requires that patent claims particularly point out and distinctly claim the subject matter regarded as the invention. The Supreme Court has held that this requires that "a patent's claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty". The courts have recognised that "absolute precision is unattainable".

The Federal Circuit started with the language of the claims. While agreeing with the district court that the claim language itself did not make unmistakably clear the scope of 'visually negligible', it found that the term was not "purely subjective". It held that the question of whether something was "visually negligible" and did not interfere with a user's perception involved what could be seen by the average human eye. This provided an objective baseline through which the claims could be interpreted. This baseline, in turn, was supported by considerable detail in the patent specification, which provided guidance on how to create visually negligible indicators. The court also noted that the prosecution history supported this conclusion: neither the patent examiner nor anyone involved during two subsequent re-examinations had any apparent difficulty in determining the scope of this phrase.

The court noted that the existence of examples in the written description would not necessarily render a claim definite or that listing requirements always would provide sufficient certainty. This case serves as a reminder that sufficient detail and material should be included in the written description to support all claim terms, especially those that arguably may include some subjective element.

For further information please contact:

W Edward Ramage
Baker Donelson
www.bakerdonelson.com
Email: eramage@bakerdonelson.com
Tel: +1 615 726 5600



**W Edward
Ramage**

**BAKER
DONELSON**

IAM (www.IAM-media.com) reports on intellectual property as a business asset. The primary focus is on looking at how intellectual property can be best managed and exploited in order to increase company profits, drive shareholder value and obtain increased leverage in the capital markets. Its core readership primarily comprises senior executives in IP-owning companies, corporate counsel, private practice lawyers and attorneys, licensing and technology transfer managers, and investors and analysts.