

# Seyfarth PTAB Blog



## A legal look at Patent Trial and Appeal Board decisions and trends

### Construction of a Claim Term by the PTAB Does Not Negate Indefiniteness

By Patrick T. Muffo

The doctrine of definiteness requires a patent to clearly state what the inventor considers to be their invention. Of course, the PTAB interprets various claim terms when determining whether a prior art reference anticipates or renders obvious a particular claim. So what happens when an accused infringer challenges a claim before the PTAB, and after a PTAB claim interpretation, then challenges the definiteness of that same claim term in district court?

The case of *Depomed, Inc. v. Purdue Pharma, L.P.*, Civil Action No. 13-571 (MLC) (D. NJ) considered this very issue. Depomed sought to preclude Purdue Pharma from amending their invalidity contentions to assert indefiniteness after the 2014 Supreme Court *Nautilus* decision changed the standard for definiteness. Among other things, Depomed argued the PTAB had already construed the term “substantially all of said drug” so any such assertion of indefiniteness would have been futile.

The court disagreed, first noting that indefiniteness is not a basis for arguing invalidity before the PTAB. Indefiniteness is often challenged during claim construction in district courts, but Purdue Pharma could not have raised this issue before the PTAB when construing the terms of the relevant claims because indefiniteness is not an available argument before the PTAB.

Depomed also argued the challenge was futile because courts in the same district had construed the term at issue. The court also rejected this argument because those constructions were pre-*Nautilus* and therefore under a different standard for indefiniteness.

### Takeaway:

Indefiniteness is a popular invalidity argument post-*Nautilus* with what many believe to be a lower standard for invalidating a confusing or otherwise indefinite claim. Defendants often litigate and file PTAB proceedings in parallel, and this decision suggests defendants can seek construction of confusing terms before the PTAB without fearing the preclusion of a district court indefiniteness argument.

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