

4 Annotated Patent Digest § 23:25.120

Annotated Patent Digest (Matthews) | May 2026 Update
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Chapter 23. Sufficiency of Claiming—§ 112, ¶ 2

I. Particularly Point Out and Distinctly Claim the Invention

C. Procedural Aspects of an Invalidity Challenge for Indefiniteness

§ 23:25.120. No waiver of indefiniteness for not raising it on claim construction

[Correlation Table](#) | [References](#)

Although it may be possible in some cases to resolve an indefiniteness challenge as part of construing a claim, courts generally will not find a waiver of an indefiniteness challenge simply because an accused infringer did not raise the challenge as part of its claim construction arguments.

[Daedalus Blue, LLC v. MicroStrategy Incorporated](#), 2023 WL 5941736, *12–*14 (E.D. Va. 2023) (rejecting argument that accused infringer forfeited an indefiniteness defense by not raising the issue during claim construction, the court finding that the accused infringer's indefiniteness did not arise from claim construction, but “instead arises from an ‘ambiguity that became relevant based on the infringement theory in Plaintiff's expert report, raised after claim construction and fact discovery,’” therefor. “[f]inding waiver under such circumstances would essentially amount to punishing Defendant for circumstances outside of its control”—“The first issue here concerns when an indefiniteness defense may be raised. While not directly on point, binding precedent appears to exist, inasmuch as various courts facing this issue have found that ‘[n]othing in the law confines a party's indefiniteness argument to the claim construction stage of the litigation.’ *Versata Software, Inc. v. Zoho Corp.*, 213 F. Supp. 829, 834 (W.D. Tex. 2016) (citing [Conoco, Inc. v. Energy Env't, Int'l, L.C.](#), 460 F.3d 1349, 1359 (Fed. Cir. 2006); [Apple, Inc. v. Samsung Elecs. Co.](#), 932 F. Supp. 2d 1076, 1079 (N.D. Cal. 2013); [Indus. Tech. Rsch. Inst. V. LG Elecs. Inc.](#), 2014 WL 6907449, at *2 (S.D. Cal. Dec. 8, 2014)). The Federal Circuit has also made clear that, while parties may not raise new claim construction arguments on appeal, [Conoco, Inc.](#), 460 F.3d at 1358–59, no such restriction exists before a final lower court decision: ‘district courts may engage in ‘rolling claim construction, in which the court revisits and alters its interpretation of the claim terms as its understanding of the technology evolves.’” *13 To the extent a party *can* be deemed to have waived indefiniteness or claim construction-related concerns, courts have discretion regarding whether to find a party waived their opportunity to raise such concerns. *See, e.g., Cioffi v. Google, Inc.*, 2017 WL 275386, at *5 n.2 (E.D. Tex. Jan. 9, 2017) (‘The court has ample grounds to find that Google waived its claim construction arguments ... but the [c]ourt declines to find waiver at this stage.’) Indeed, ‘courts generally will not find a waiver of an indefiniteness challenge simply because an accused infringer did not raise the challenge as part of its claim construction arguments.’ 4 ANNOTATED PATENT DIGEST § 23:25.120 (collecting cases). Plaintiff cites several cases ostensibly holding the contrary position. One such case, *Central Admixture Pharmacy Services*, appears to support a finding of waiver under certain circumstances: ‘[Defendant] argues that the district court erred by failing to construe the term ‘maintaining’ in Claims 7–12. The district court found that ACS waived any argument with respect to this term by failing to raise it during the claim construction phase. We agree.’ [Cent. Admixture Pharmacy Servs., Inc. v. Advanced Cardiac Solutions, P.C.](#), 482 F.3d 1347, 1356 (Fed. Cir. 2007). And in fact, courts do occasionally find waiver when a party fails to timely and adequately challenge or assert particular claim constructions. *See id.*; [Norix Group v. Corr. Techs., Inc.](#), 2020 WL 6153266, at *2 (N.D. Ill. June 24, 2020); [Finalrod IP, LLC v. John Crane, Inc.](#), 2019 WL 4061703, at *2 (W.D. Tex. May 30, 2019); [Gammino v. Sprint Comm'ncs Co., L.P.](#), 2014 WL 3973503, at *8 (Fed. Cir. 2014); 1 ANNOTATED PATENT DIGEST § 3:9 (collecting cases). However, a thorough review of Federal Circuit precedent indicates that waiver generally arises where (1) a party fails to object to jury instructions using a certain claim construction, (2) engages in clear conduct showing acquiescence to a particular claim construction (e.g., withdrawing prior

objections before later attempting to re-assert them), or (3) fails to preserve the issue at the district court level altogether. See, e.g., *Solvay S.A. v. Honeywell Int'l Inc.*, 742 F.3d 998, 1003–04 (Fed. Cir. 2014); *Power Mosfet Techs., L.L.C. v. Siemens AG*, 378 F.3d 1396, 1408 (Fed. Cir. 2004); *Versata Software, Inc. v. SAP Am., Inc.*, 717 F.3d 1255, 1262 (Fed. Cir. 2013); *Cordis Corp. v. Boston Sci. Corp.*, 561 F.3d 1319, 1331 (Fed. Cir. 2009); *Broadcom Corp. v. Qualcomm Inc.*, 543 F.3d 683, 694 (Fed. Cir. 2008); 1 ANN. PAT. DIG. § 3:9 (collecting cases). Piecing together the caselaw, there are several main takeaways. First, claim construction continues until a final judgment is rendered. See *Conoco, Inc.*, 460 F.3d at 1358–59 (allowing rolling claim construction but noting that a party may not introduce new claim construction arguments on appeal). Similarly, a party need not raise a specific indefiniteness defense at the claim construction phase in order to be able to raise that defense later. See, e.g., *Versata Software, Inc. v. Zoho Corp.*, 213 F. Supp. 829, 834 (W.D. Tex. 2016), *aff'd in part, vacated and remanded in part on other grounds*, 717 F.3d 1255, 1258, 1269 (Fed. Cir. 2013). Additionally, courts are permitted to find a party waived claim construction or indefiniteness challenges, but typically only do so under a narrow set of circumstances. See, e.g., *id.*; *Solvay S.A. v. Honeywell Int'l Inc.*, 742 F.3d 998, 1003–04 (Fed. Cir. 2014); *Power Mosfet Techs., L.L.C. v. Siemens AG*, 378 F.3d 1396, 1408 (Fed. Cir. 2004). Finally, courts have discretion in deciding whether to find a party waived a particular claim construction or indefiniteness challenge. See, e.g., *Cioffi*, 2017 WL 275386 at * 6 n.2 (citing *Cent. Admixture Pharmacy Servs., Inc.*, 482 F.3d at 1356). *14 In turn, this Court finds that Defendant is not foreclosed from bringing this indefiniteness defense as the result of ‘waiver.’ The circumstances here do not map on to the standard waiver situations outlined above (e.g., clear conduct showing acquiescence to a particular claim construction). Instead, Defendant has largely maintained its position that the phrase in question is ambiguous. Moreover, as Defendant notes, its argument could not have been raised at any earlier stage regardless. Defendant’s argument instead arises from an ‘ambiguity that became relevant based on the infringement theory in Plaintiff’s expert report, raised after claim construction and fact discovery.’ *Id.* Finding waiver under such circumstances would essentially amount to punishing Defendant for circumstances outside of its control. Defendant should therefore be permitted to pursue the merits of its indefiniteness claim, contrary to the Special Master’s recommendation.”)

Science Applications International Corp. v. United States, __ Fed. Cl. __, 2022 WL 17485581, *16–*17 (Ct. Fed. Cl. 2022) (refusing to strike intervening accused infringer’s indefiniteness theories for not having been raised during claim construction, the court instructing that its “ability to construe terms does not end there [at the claim construction hearing]; courts generally may opt to construe terms a party later argues are indefinite, even after a *Markman* hearing and issuance of a claim construction opinion,” and further noting that the “introduction of new indefiniteness theories at this juncture is, therefore, the exact situation anticipated and welcomed by the Court during the August 27, 2020 hearing”—“Plaintiff moves to strike ‘Microsoft’s new indefiniteness theories articulated in Section V(A) of Defendants’ Final Invalidity Contentions.’ Specifically, Plaintiff takes issue with Microsoft interposing new indefiniteness theories based upon terms Microsoft alleges are newly-relevant considering the Court’s Claim Construction Opinion, Plaintiff’s subsequent narrowing of claims, and advancements to Microsoft’s prototype. Microsoft contends that its newly-asserted indefiniteness theories are timely, as they: (i) ‘involve underlying issues of fact that Microsoft anticipated would be—and have now in fact been—informed by discovery’; and (ii) were provided as part of a supplement to Microsoft’s invalidity contentions. *17 Claim construction is, and was in this case, primarily accomplished via a *Markman* hearing and subsequent issuance of a Claim Construction Opinion. The Court addressed questions of indefiniteness at the *Markman* Hearing and in its Claim Construction Opinion. However, the Court’s ability to construe terms does not end there; courts generally may opt to construe terms a party later argues are indefinite, even after a *Markman* hearing and issuance of a claim construction opinion. See 4 Robert A. Matthews, Jr., *Annotated Patent Digest* § 23:25.120 (2022) (‘No waiver of indefiniteness for not raising it on claim construction Although it may be possible in some cases to resolve an indefiniteness challenge as part of construing a claim, courts generally will not find a waiver of an indefiniteness challenge simply because an accused infringer did not raise the challenge as part of its claim construction arguments.’); *Berkheimer v. HP Inc.*, 2022 WL 910580, at *5 (N.D. Ill. Mar. 29, 2022) (‘That claim construction must accompany an indefiniteness analysis does not mean that indefiniteness must be decided, once and for all, at the *Markman* hearing.’). This is especially true in this action, which involves a [Redacted]. Indeed, prior to the December 15, 2020 *Markman* hearing, this Court anticipated further claim construction could be necessary ‘[Redacted] if, in fact, SAIC is accusing that product of infringement,’ and that the Court would potentially undertake ‘supplemental claim construction with regard to a couple of terms’ at that point. Microsoft’s introduction of new indefiniteness theories at this juncture is,

therefore, the exact situation anticipated and welcomed by the Court during the August 27, 2020 hearing. ... Accordingly, the Court denies Plaintiff's Motion to Strike Microsoft's newly asserted indefiniteness theories on this basis.”)

[Berkheimer v. HP Inc.](#), 2022 WL 910580, *4–*6 (N.D. Ill. 2022) (rejecting argument that the accused infringer forfeited an indefiniteness challenging by not raising it during claim construction, but only raising it at summary judgment, that court instructing that “[t]hat claim construction must accompany an indefiniteness analysis does not mean that indefiniteness must be decided, once and for all, at the *Markman* hearing,” also noting that the scheduling order did not preclude the accused infringer from raising the defense with a summary judgment motion—“First, Berkheimer urges that HP has waived its indefiniteness argument by making it for the first time at summary judgment. While Berkheimer is correct that indefiniteness is generally decided at claim construction, ‘a district court may engage in claim construction during various phases of litigation, not just in a *Markman* order.’ [Conoco, Inc. v. Energy & Env’tl, Int’l](#), 460 F.3d 1349, 1359 (Fed. Cir. 2006). And at least one district court has explicitly held that ‘[f]ailure to seek construction of a term during claim construction does not constitute waiver of an indefiniteness argument.’ [Apple, Inc. v. Samsung Elecs. Co.](#), 932 F. Supp. 2d 1076, 1079 (N.D. Cal. 2013) (Koh, J.). *5 Berkheimer relies on the Federal Circuit's opinion in *Eidos Display, LLC v. AU Optonics Corp.*, where the court noted ‘[t]he indefiniteness inquiry ... is intertwined with claim construction.’ 779 F.3d 1360, 1364 (Fed. Cir. 2015) (citing [Atmel Corp. v. Info. Storage Devices, Inc.](#), 198 F.3d 1374, 1379 (Fed. Cir. 1999)). But this does not imply that indefiniteness must be decided during claim construction. n.3: District courts have consistently rejected the idea that indefiniteness can only be raised during claim construction. See, e.g., [Versata Software, Inc. v. Zoho Corp.](#), 213 F. Supp. 3d 829, 834 (W.D. Tex. 2016) (finding ‘[n]othing in the law confines a party's indefiniteness argument to the claim construction stage of the litigation.’) (citing cases); [DataTern, Inc. v. MicroStrategy, Inc.](#), 2017 WL 1147441, at *5 (D. Mass. Mar. 27, 2017); [Takeda Pharm. Co. v. Handa Pharms., LLC](#), 2012 WL 1243109, at *16 (N.D. Cal. Apr. 11, 2012); [ASM Am., Inc. v. Genus, Inc.](#), 2002 WL 1892200, at *15 (N.D. Cal. Aug. 15, 2002). And the Federal Circuit has at least acquiesced to, if not endorsed, consideration of indefiniteness on summary judgment by routinely affirming summary judgment on indefiniteness grounds. See, e.g., [EON Corp. IP Holdings LLC v. AT&T Mobility LLC](#), 785 F.3d 616, 619 (Fed. Cir. 2015); [H–W Tech. L.C. v. Overstock.com, Inc.](#), 758 F.3d 1329, 1330 (Fed. Cir. 2014); [Halliburton Energy Servs., Inc. v. M-I LLC](#), 514 F.3d 1244, 1246 (Fed. Cir. 2008); [S3 Inc. v. NVIDIA Corp.](#), 259 F.3d 1364, 1367 (Fed. Cir. 2001).] It only means that the ‘Court must attempt to determine what a claim means before it can determine whether the claim is invalid for indefiniteness.’ [Indus. Tech. Rsch. Inst. v. LG Elecs. Inc.](#), 2014 WL 6907449, at *2 (S.D. Cal. Dec. 8, 2014) (quoting [Atmel](#), 198 F.3d at 1379). That claim construction must accompany an indefiniteness analysis does not mean that indefiniteness must be decided, once and for all, at the *Markman* hearing. See [Conoco](#), 460 F.3d at 1359. Berkheimer also relies on two district court cases to support his waiver argument. But those cases deal with litigants' failures to follow the district court's claim construction procedures during claim construction, not the timeliness of indefiniteness challenges. See [Protegrity USA, Inc. v. Netskope, Inc.](#), 2015 WL 6126599, at *3 (N.D. Cal. Oct. 19, 2015) (rejecting an untimely claim construction argument and noting ‘that plaintiffs' failure to include the additional proposed construction in their opposition brief was a calculated attempt to prevent defendant from providing a fulsome response’); [Finjan, Inc. v. Sophos, Inc.](#), 2015 WL 890621, at *8 (N.D. Cal. Mar. 2, 2015) (finding that arguments raised for the first time at a *Markman* hearing, but not included in briefing, were waived). Therefore, they fail to support Berkheimer's argument. ... Second, Berkheimer contends that raising an indefiniteness argument at this stage violates the Court's scheduling order, LPR 4, and [Federal Rule of Civil Procedure 16\(b\)\(4\)](#) (which concerns scheduling orders). This too is unpersuasive. As one court has held, ‘[n]either the docket control order nor any local rule or court directive provides a deadline for filing an indefiniteness motion in response to a claim construction order, where it [is] the Court's new claim construction that g[ives] rise to the indefiniteness challenge.’ [Erfindergemeinschaft UroPep GbR v. Eli Lilly & Co.](#), 240 F. Supp. 3d 605, 626 (E.D. Tex. 2017). *6 Like Berkheimer, the plaintiff in *Eli Lilly* argued that ‘because [defendant] did not make its indefiniteness argument at the time the parties briefed the issue of claim construction, it has waived its right to argue indefiniteness now.’ *Id.* at 625. The court concluded that, while it would have entertained a motion raising the indefiniteness issue immediately after the claim construction order, ‘there was no scheduling directive that obligated [defendant] to file its challenge at that time.’ *Id.* at 626. Similarly, nothing in this Court's scheduling order required HP to raise indefiniteness at an earlier time. Neither party asked the Court to interpret ‘without substantial redundancy’ at the claim construction stage, and the construction of ‘without substantial redundancy’ only became relevant after the Federal Circuit held that the synonymous term ‘minimal redundancy’ was invalid. [n.4: While HP might reasonably have raised the argument that claim 4 and its

dependents are indefinite at claim construction, the Court will not fault HP for failing to do so. The local rules limit claim construction to ten terms, *see* LPR 4.1(b), and Berkheimer asserted nearly twenty claims against HP. *See Apple*, 932 F. Supp. 2d at 1079 (because local rule limited claim construction to ten terms, ‘failure to include a term at that stage [could not] reasonably constitute a waiver’ of indefiniteness argument).] Because nothing in the Court’s scheduling order precludes HP from raising indefiniteness at this stage, Rule 16’s requirement that ‘a schedule may be modified only for good cause and with the [court’s] consent’ is inapplicable. Nor does Local Patent Rule 4 (which governs claim construction) require indefiniteness to be raised at claim construction. *See generally* LPR 4. HP has not forfeited its indefiniteness defense.”—some citations omitted)

3rd Eye Surveillance, LLC v. United States, __ Fed. Cl. __, 2022 WL 123130, *4–*5 (Ct. Fed. Cl. 2022) (rejecting patentee’s argument that the accused infringer waived any indefiniteness challenge by not raising that issue during claim construction, the court ruling that while indefiniteness may have a link to claim construction, it is a separate issue and does not have to be raised and determined at claim construction, also noting that the court had scheduling orders that “explicitly [required] separate indefiniteness contentions from claim construction,” further ruling that the accused infringer’s challenge that several computer-related claim limitations were indefinite for failing to provide corresponding structure raised “factual issues can only be resolved after further discovery and submissions by the parties, either on motion or at trial”—“Plaintiffs’ principal contention is that defendants’ assertion of an affirmative defense based on indefiniteness is untimely, and thus waived, because it should have been asserted at or prior to claim construction. In support of that contention, plaintiffs rely on the Federal Circuit’s decision in *Noah Sys., Inc. v. Intuit, Inc.*, 675 F.3d 1302, 1311 (Fed. Cir. 2012). In *Noah Systems*, the court of appeals stated that ‘[w]hether a claim complies with the definiteness requirement of 35 U.S.C. § 112 ¶ 2 is a matter of claim construction, which we review de novo.’ *Noah Systems*, 675 F.3d at 1311. The government responds in opposition, contending (1) that the law does not require that indefiniteness challenges be resolved during claim construction, (2) that the government in all events raised the indefiniteness defense prior to claim construction, and (3) its invalidity arguments will in due course be supported by expert discovery and testimony, which is yet to be had.’ Federal district courts have addressed contentions based on *Noah Systems* and have consistently rejected them. Indefiniteness challenges are indeed linked to claim construction because a ‘[c]ourt must attempt to determine what a claim means before it can determine whether the claim is invalid for indefiniteness, and not that the [c]ourt must determine indefiniteness during the claim construction proceedings.’ *ASM Am., Inc. v. Genus, Inc.*, 2002 WL 1892200, at *15 (N.D. Cal. Aug. 15, 2001), *amended in other respects*, 2003 WL 21033555 (N.D. Cal. Jan. 10, 2003), *aff’d*, 401 F.3d 1340 (Fed. Cir. 2005); *see also DataTern, Inc. v. MicroStrategy, Inc.*, 2017 WL 1147441, at *5 (D. Mass. Mar. 27, 2017) (‘[A]n indefiniteness claim ‘is not waived’ merely because the defendant ‘did not seek claim construction of the [pertinent] term.’ (quoting *Apple, Inc. v. Samsung Elecs. Co.*, 932 F. Supp.2d 1076, 1079 (N.D. Cal. 2013))). Rather than reaching a question of indefiniteness during claim construction, courts have opined that an indefiniteness question ‘is more suitable for resolution on summary judgment.’ *Leines v. Homeland Vinyl Prods., Inc.*, 2020 WL 406769, at *6 (E.D. Cal. Jan. 24, 2020); *see also Takeda Pharm. Co. v. Handa Pharms., LLC*, 2012 WL 1243109, at *16 (N.D. Cal. Apr. 11, 2012) (‘Due to the largely factual nature of [the indefiniteness] inquiry, the [c]ourt concludes that [the] question is more suitable for determination on summary judgment than at the claim construction phase of the case.’). *5 The court’s patent rules also explicitly separate indefiniteness contentions from claim construction. Patent Rule 16 requires parties to have mandatory settlement discussions at three different progressive stages of a case: ‘(a) within 7 days after entry of the court’s Claim Construction Opinion and Order; (b) within 7 days after entry of the court’s Validity or Indefiniteness Opinion and Order, if the case is not dismissed; and (c) within 7 days after the conclusion of trial.’ The pertinent discovery orders in this case also required defendants to set forth their invalidity contentions *after* plaintiffs disclosed their infringement contentions. This staging makes sense. Invalidity, including indefiniteness, contentions are informed by and responsive to infringement claims. Plaintiffs also ignore that defendants filed Preliminary Invalidity Contentions that included indefiniteness arguments on December 18, 2017, notably before claim construction, which occurred on September 25, 2018. Defendants thus gave appropriate notice of their contentions. That defendants also raised indefiniteness invalidity arguments on August 5, 2021, when they responded to plaintiffs’ infringement contentions, in effect confirming their prior actions. That subsequent confirmation is not significant insofar as timing is concerned. As to the merits, defendants aver that plaintiffs’ ‘[a]sserted [c]laims are invalid as indefinite because the claims contain computer implemented functional limitations, yet the respective specifications failed to provide the necessary structure,’ to apprise those skilled in the art of the patent claims’

scope. Nonetheless, defendants concede that a ‘question about the state of the knowledge of a skilled artisan is a question of fact.’ *Id.* at 25 (quoting *Dow Chem. Co.*, 809 F.3d at 1225). The relevant factual issues can only be resolved after further discovery and submissions by the parties, either on motion or at trial.”)

TQ Delta, LLC v. 2Wire, Inc., 2019 WL 1553805, *9 (D. Del. 2019) (accused infringer did not waive its indefiniteness defense by not raising it during claim construction, nonetheless rejecting the defense on the merits and granting the patentee summary judgment—“First, Defendant has not waived its indefiniteness defense. There is no requirement that indefiniteness be raised at claim construction. Moreover, case law in this district supports Defendant's position ‘that the submission of a proposed construction for a claim term does not amount to a waiver of a later indefiniteness challenge,’ and thus the failure to raise indefiniteness at claim construction is not a waiver. *Leader Techs. Inc. v. Facebook, Inc.*, 770 F. Supp. 2d 686, 708 (D. Del. 2011). Therefore, I determine that Defendant has not waived its indefiniteness defense.”)

Erfindergemeinschaft UroPep GbR v. Eli Lilly and Company, 2017 Markman 841147, 2017 WL 841147, *16-*17 (E.D. Tex. 2017) (Bryson, J., sitting by designation) (for claims directed to a method of treating BPH problems by administering to a person in need thereof an effective amount of an inhibitor of phosphodiesterase (PDE) V, while ruling that the accused infringer had not waived an indefiniteness challenge by not raising the issue during claim construction, nonetheless denying summary judgment on the merits since the court found that the specification provided sufficient objective guidance to know when a “2-fold” potency standard was met, the court accepting the contention that the particular indefiniteness issue was not readily evident during claim construction—“UroPep points to the original docket control order in this case, which provided that ‘[i]n lieu of early motions for summary judgment, the parties are directed to include any arguments related to the issue of indefiniteness in the *Markman* briefing, subject to the local rules’ normal page limits.’ Each docket control order issued in this case since that time has contained the same language. UroPep argues that because Lilly did not make its indefiniteness argument at the time the parties briefed the issue of claim construction, it has waived its right to argue indefiniteness now. Lilly responds that the issue of indefiniteness did not become ripe until the Court’s October 21, 2016, order in which it construed the term ‘inhibitor of phosphodiesterase (PDE) V’ to mean a selective inhibitor that satisfied the 20-fold test. Because it did not have reason to file its indefiniteness motion any earlier than that, Lilly argues that it cannot fairly be deemed to have waived the motion. The Court agrees with Lilly. In its original claim construction brief, Lilly presented arguments as to the indefiniteness of the ‘124 patent claims, but not the same arguments that it now presses. That is because at that time neither party was advocating the construction that the Court ultimately adopted. Even in the briefing leading up to the Court’s October 21, 2016, order, while UroPep urged the Court to adopt a requirement of selectivity, it did not advocate the 20-fold test that the Court ultimately adopted. For that reason, it was reasonable for Lilly not to make an indefiniteness argument at that time. Although UroPep argues that Lilly should have raised its indefiniteness argument when UroPep argued in favor of a ‘selectivity’ construction of the claims, Lilly’s indefiniteness argument is directed not just to the selectivity requirement, but also to the 20-fold test that the Court adopted. Because UroPep did not argue in favor of that test, it would have been unreasonable to expect Lilly to anticipate the Court’s claim construction and argue that the construction that the Court ultimately adopted would render the claims indefinite. UroPep argues, with some plausibility, that the indefiniteness issue was even more clearly presented by UroPep’s initial argument that the claims required selective inhibition but did not require a particular degree of selectivity. For that reason, UroPep contends that Lilly cannot point to the Court’s construction as an excuse for not raising the indefiniteness issue at the time the parties first briefed issues of claim construction. But even if Lilly had challenged UroPep’s initial claim construction argument on indefiniteness grounds, the nature of the argument changed substantially when the Court imposed the 20-fold potency requirement, and Lilly would have been entitled to recast its indefiniteness argument at that time. That being the case, the Court discerns no waiver by Lilly in failing to raise at an earlier time an argument that would have been rendered largely moot when the Court entered its ‘20-fold’ claim construction order. UroPep next argues that even if Lilly is right that it should not have been expected to raise its indefiniteness argument prior to the Court’s October 21, 2016, order that included the 20-fold selectivity construction, Lilly should have raised the indefiniteness argument shortly thereafter, and its failure to do so until the summary judgment motions were filed constitutes a waiver of Lilly’s indefiniteness challenge. Again, the Court disagrees with UroPep. Neither the docket control order nor any local rule or court directive provides a deadline for filing an indefiniteness motion in response to a claim construction order, where it was the Court’s new claim construction that gave rise to the indefiniteness challenge. While the Court would

have entertained a motion from Lilly raising the indefiniteness issue immediately after the Court's claim construction order, there was no scheduling directive that obligated Lilly to file its challenge at that time. To be sure, it may have simplified matters if Lilly had raised the indefiniteness issue shortly after the October 21, 2016, order, since that presumably would have precipitated an earlier resolution of the claim construction issue that the parties have now raised in their infringement summary judgment motions. But the same could be said of UroPep's motion to clarify the Court's claim construction; an earlier motion for clarification would have been more efficient than having the Court address the new claim construction issue along with all of the other summary judgment motions and forcing the parties to argue their summary judgment motions without being certain how the Court would ultimately rule on the open claim construction issue. But UroPep was not legally obligated to file its motion at that time, and neither was Lilly. Thus, the Court concludes that it was permissible for Lilly to raise the issue of indefiniteness when it filed its summary judgment motions. The Court therefore rejects UroPep's waiver argument and holds that Lilly has preserved its indefiniteness argument.”—citations omitted)

[Versata Software, Inc. v. Zoho Corporation](#), __ F. Supp. 3d __, 2016 WL 5793778, *3 (W.D. Tex. 2016) (rejecting contention that accused infringer's failure to raise indefiniteness during claim construction precluded the accused infringer from raising it on summary judgment—“Nothing in the law confines a party's indefiniteness argument to the claim construction stage of the litigation. See, e.g., [Conoco, Inc. v. Energy & Envtl. Int'l, L.C.](#), 460 F.3d 1349, 1359 (Fed. Cir. 2006) (‘[A] district court may engage in claim construction during various phases of litigation, not just in a *Markman* order. We have recognized that district courts may engage in rolling claim construction, in which the court revisits and alters its interpretation of the claim terms as its understanding of the technology evolves.’) (internal quotation marks omitted); [Apple, Inc. v. Samsung Elecs. Co.](#), 932 F. Supp. 2d 1076, 1079 (N.D. Cal. 2013) (‘[F]ailure to seek construction of a term during claim construction does not constitute waiver of an indefiniteness argument.’); [Indus. Tech. Research Inst. v. LG Elecs. Inc.](#), No. 3:13-CV-2016-GPC-WVG, 2014 WL 6907449, at *2 (S.D. Cal. Dec. 8, 2014) (‘[T]he Federal Circuit's statements that indefiniteness is intertwined with claim construction mean only that the Court must attempt to determine what a claim means before it can determine whether the claim is invalid for indefiniteness, and not that the Court must determine indefiniteness during the claim construction proceedings.’). Indeed, case law reveals courts often address indefiniteness at the summary judgment stage. In light of the foregoing, the Court finds it is both appropriate and necessary to address Zoho's indefiniteness argument on summary judgment.”—some citations omitted—granting summary judgment that term "space-constrained display" was indefinite where the intrinsic evidence, while providing an example of something that could meet the "space-constrained display" limitation failed to provide information as to when something would not meet the limitation)

See also

[ECOSERVICES, LLC, Plaintiff, v. CERTIFIED AVIATION SERVICES, LLC, Defendant](#), 2018 WL 5629301, *7-*8 (C.D. Cal. 2018), *related appeal*, No. 2019-1602, __ Fed. Appx. __, 2020 WL 5949809, *12-*13 (Fed. Cir. Oct. 8, 2020) (*nonprecedential*) (rejecting contention that an indefiniteness challenge to a claim term, whose construction the parties stipulated to, was waived where the accused infringer only raised the defense to the court in its post-trial motions, the court finding it was proper to raise the issue in a post-trial motion as it was a question of law, that stipulating to a construction of claim term does not automatically waive an indefiniteness challenge to that term, there was no waiver by not bringing a summary judgment motion on the issue where the accused infringer had challenged indefiniteness for other claim terms on summary judgment, since the accused infringer relied on trial testimony for the underlying facts asserted as part of its indefiniteness challenge, and there was no surprise to the patentee as the accused infringer had provided an expert report that raised the argument that the claim term was indefinite, however, rejecting the defense on the substantive merits—“Plaintiff argues as an initial matter that Defendant waived its indefiniteness argument for various reasons, including that Defendant failed to raise it during claim construction, on summary judgment, in its jury instructions, or as part of a Rule 50(a) motion. With regard to the claim construction phase, the parties agreed that the claim term 'a liquid particle size in the range of 250-120 μ m' did not require construction. Plaintiff argues Defendant cannot now contest the indefiniteness of this claim term. However, stipulating to a certain claim construction term does not automatically become an admission that the claim term is not indefinite. [MeadWestVaco Corp. v. Rexam Beauty and Closures, Inc.](#), 731 F.3d 1258, 1270 n.8 (Fed Cir. 2013). Nor is the indefiniteness argument waived for this reason. [Apple v. Samsung](#), 932 F. Supp. 2d 1076, 1079 (N.D. Cal. 2013) (‘[F]ailure

to seek construction of a term during claim construction does not constitute waiver of an indefiniteness argument.’). *See also Versata v. Zoho*, 213 F. Supp. 3d 829, 934 (W.D. Tex. 2016) (‘Nothing in the law confines a party’s indefiniteness argument to the claim construction stage of litigation.’); *Havco Wood Prods v. Industrial Hardwood Prods.*, No. 10-cv-566-wme, 2013 WL 1497429, at *1-2 (W.D. Wis. Apr. 11, 2013) (rejecting plaintiff’s argument that defendant had waived its indefiniteness defense and allowing it as a post trial motion). *8 As to summary judgment, Plaintiff is correct that Defendant did not raise the indefiniteness issue for this claim term, as it only raised indefiniteness for the different claim term ‘small quantities’ in the ‘860 Patent. While an indefiniteness determination is an issue of law, it can involve underlying questions of fact. *E.g.*, *UltimatePointer, LLC v. Nintendo Co.*, 816 F.3d 816, 826 (Fed. Cir. 2016). Here, because Defendants rely on trial testimony and issues of fact resolved by the jury in its Motion,⁶ its indefiniteness challenge would not have been appropriately resolved on summary judgment. *See e.g.*, *Presidio Components, Inc. v. Am. Tech. Ceramics Corp.*, 2008 WL 3925723, at *3 (S.D. Cal. Aug. 25, 2008). Central to the issue of waiver is whether Plaintiff had been on notice of Defendant’s indefiniteness claim. Defendant has consistently maintained its indefiniteness claim throughout this litigation. *Compare Apple*, 932 F. Supp. 2d at 1079 (finding plaintiff on notice because defendant continued to raise its invalidity issue in its invalidity contentions and jury instructions, and the court specifically included the issue as a topic defendant could address in a non-jury brief) with *BioCell Tech. LLC v. Arthro-7*, 2013 WL 12131282, at *10 (C.D. Cal. Apr. 16, 2016) (finding unfair surprise where defendants did not even mention the term it argued as indefinite prior in the litigation). Defendant first raised indefiniteness of the particle size limitation in its preliminary invalidity contentions. Defendant’s expert, Dr. Micklow, stated in his invalidity report that the particle size limitation rendered the ‘860 Patent indefinite. Defendant’s Memoranda of Contentions of Fact and Law identified indefiniteness as an issue of law triable to the Court. This Court identified indefiniteness of the ‘860 Patent as an issue for trial in its Final Pretrial Conference Order (‘FPTC Order’). Finally, the parties and this Court agreed during trial that indefiniteness of the ‘860 Patent was a remaining issue to be briefed for the Court to decide after trial. While Plaintiff is correct that Defendant did not bring a Rule 50(a) motion, the indefiniteness claim was separate from the jury’s determination of infringement and identified prior to trial as a remaining issue of law, of which the Court agreed to take post-trial. *See Havco*, 2012 WL 1497429, at *3 (‘[I]t is not unusual for the court to consider [indefiniteness] independent of the jury and render an opinion after the jury verdict.’) Given that Plaintiff has been on notice of Defendant’s indefiniteness, the Court finds it appropriate for Defendant to raise the issue now.”)

But cf.

Finalrod IP, LLC v. John Crane, Inc., 2019 WL 4061703, *2-*3 (W.D. Tex. 2019) (accused infringer waived its indefiniteness challenge when, after having identified the specific indefiniteness issue in the parties’ joint claim construction statement, it withdrew that contention of indefiniteness and did not pursue it during the claim construction hearing and did not reassert it any time thereafter until it filed its summary judgment motion on the issue, the court ruling that “Defendants waived their indefiniteness argument regarding ‘compressive force’ limitations because they failed to raise it during the claim construction phase”—“On September 29, 2017, the Parties provided their proposed construction for the claim terms that are in dispute for the ‘951 Patent, ‘757 Patent, and ‘431 Patent. In the Joint Claim Construction and Prehearing Statement, Defendants asserted that the ‘compressive force’ limitations were indefinite. On December 8, 2017, the Parties filed a Supplemental Joint Claim Construction and Prehearing Statement, which limited the number of disputed terms. In this Statement, Defendants withdrew their contention that the ‘compressive force’ limitations were indefinite. Defendants did not assert that the ‘compressive force’ limitations were indefinite at any point after December 8, 2017 until they filed this Motion for Summary Judgment on April 4, 2019. This is made evident from Defendants’ claim construction briefs, which make no mention that ‘compressive force’ limitations in either the ‘951 Patent or ‘757 Patent were indefinite. Notwithstanding the foregoing, Defendants claim in their Motion for Summary Judgment that the asserted claims of the ‘951 Patent and the ‘757 Patent are invalid for indefiniteness. Specifically, Defendants claim that ‘Plaintiffs’ patents provide no information about how to identify and measure [] “compressive forces” to ascertain where they are greatest.’ ... The Court finds that Defendants’ Motion should be denied because they waived their argument that the ‘compressive force’ limitations were indefinite by failing to raise this issue during the case’s claim construction phase. The Federal Circuit holds that an accused infringer waives any argument with respect to the construction of a claim term when they fail to raise that issue during the claim construction phase of a patent infringement action. *Cent. Admixture Pharmacy Servs., Inc. v. Advanced Cardiac Sols., P.C.*, 482 F.3d 1347, 1356

([Fed. Cir. 2007](#)) ('The district court found that [the defendant] waived any argument with respect to this term by *failing to raise it* during the claim construction phase. We agree.') (emphasis added). Here, Defendants withdrew their contention that the 'compressive force' limitations were indefinite on December 8, 2017. Furthermore, Defendants failed to assert that this claim term was indefinite at any point after December 8, 2017 until they filed this Motion on April 4, 2019. Thus, like *Admixture Pharmacy*, Defendants waived their indefiniteness argument regarding 'compressive force' limitations because they failed to raise it during the claim construction phase. As such, for the reasons stated above, Defendants' Motion for Summary Judgment should be and hereby is DENIED.")

Additionally, as many courts limit the number of claim terms the parties may present for construction, these courts, generally, will not find that by failing to present an allegedly indefinite claim term for claim construction, the accused infringer waives the right to later raise its indefiniteness challenge for the unrepresented claim term.

[DataTern, Inc. v. MicroStrategy, Inc., 2017 WL 1147441, *3-*5 \(D. Mass. 2017\)](#) (rejecting contention that a *per se* rule applies that timely-filed indefiniteness contentions with respect to terms that an accused infringer did not nominate for claim construction are waived, the court noting that indefiniteness does not always have to be resolved on claim construction, and denying motion to strike accused infringer's amended invalidity contentions that challenged several claim terms for being indefinite since the court found that the amended contentions were timely under the scheduling order even though the court had already held its claim construction hearing—"DataTern contends that MicroStrategy has waived the indefiniteness contentions with respect to all three terms by failing to nominate, propose constructions for, or brief those terms as candidates for claim construction. In support of its waiver argument, DataTern has pointed to decisions from other districts preventing parties from amending indefiniteness claims when the timing of the filing prevented the court from considering indefiniteness at a *Markman* hearing. However, unlike in the present case, in the cases cited, the parties were required to show good cause for amending the contentions. Here, the Court has deemed MicroStrategy's amendments to have been filed in a timely manner, so it need not show good cause. DataTern further contends that the indefiniteness contentions were waived, notwithstanding their timeliness, because a *Markman* hearing construing the disputed terms is a necessary prerequisite to determining whether a claim is invalid for indefiniteness. It has pointed to a number of cases suggesting that claim construction and indefiniteness analysis are inextricably intertwined. ('Whether a claim complies with the definiteness requirement of [35 U.S.C. § 112](#) ... is a matter of claim construction.'). It argues that if MicroStrategy were permitted to assert indefiniteness claims with respect to terms that were not construed, the Court would have to re-open the *Markman* hearing, at considerable cost and delay. Many courts have considered the question of whether 'a finding of indefiniteness should occur during claim construction, or whether it should occur at a later step.' Some courts have held that while the reasons for indefiniteness claims are 'sometimes very closely intertwined' with claim construction, at other times those reasons 'may not be so intertwined,' and therefore courts should determine on a claim-by-claim basis whether to analyze indefiniteness contentions as a part of claim construction or at a later point. In any event, the question posed by DataTern is slightly different than the one addressed by those cases. Here, the issue is whether a party *per se* waives timely-filed indefiniteness contentions with respect to terms that it did not nominate for claim construction. DataTern's argument relies on the premise that parties have only one bite at the claim-construction apple. However, courts have recognized that 'district courts may engage in 'rolling claim construction, in which the court revisits and alters its interpretation of the claim terms as its understanding of the technology evolves.' ... see also [Versata Software, Inc. v. Zoho Corporation, 2016 WL 5793778, at 3 \(W.D. Tex. Oct. 3, 2016\)](#) ('Nothing in the law confines a party's indefiniteness argument to the claim construction stage of the litigation.'); [Industrial Tech. Research Inst. v. LG Elecs. Inc., 2014 WL 6907449, at *2 \(S.D. Cal. Dec. 8, 2014\)](#) ('[T]he Federal Circuit's statements that indefiniteness is intertwined with claim construction mean only that the Court must attempt to determine what a claim means before it can determine whether the claim is invalid for indefiniteness, and not that the Court must determine indefiniteness during the claim construction proceedings.'). Furthermore, DataTern has not identified a single case that states such a *per se* rule. At least one district court has plainly stated the opposite, holding that an indefiniteness claim 'is not waived' merely because the defendant 'did not seek claim construction of the [disputed] term.' [Apple, Inc. v. Samsung Electronics Co., Ltd., 932 F. Supp. 2d 1076, 1079 \(2013\)](#) ('[F]ailure to seek construction of a term during claim construction does not constitute waiver of an indefiniteness argument.'). The *Apple* court determined that because the court's local rules only permitted the parties to propose ten terms for construction at the *Markman* hearing, the court could not reasonably find that the defendant had waived a timely-filed

indefiniteness contention for failure to propose that term for construction. To be sure, the present state of affairs, in which the Court apparently will be required to undertake, in substance, a new round of claim construction, does not appear to be efficient or even entirely sensible. The Court might well be persuaded in future cases that it should issue a scheduling order that prohibits more than one round of claim construction. However, the Court has been shown no authority that would permit the finding that a party has *per se* waived its indefiniteness contentions as to certain terms simply by failing to propose those terms for claim construction. Accordingly, the motion will be denied with respect to the indefiniteness contentions concerning the terms 'with the object oriented application,' 'detecting a need,' and 'code generator.'”—some citations omitted)

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