

1 identify the pleadings, depositions, affidavits, or other evidence that it “believes demonstrates the
2 absence of a genuine issue of material fact.” *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). If
3 the moving party satisfies this initial burden, then the burden shifts to the opposing party to show that
4 summary judgment is not appropriate. *Id.* at 324. The opposing party’s evidence is to be believed,
5 and all justifiable inferences are to be drawn in its favor. *Anderson v. Liberty Lobby, Inc.*, 477 U.S.
6 242, 255 (1986). *See also IPXL*, 430 F.3d at 1380 (quoting *Chiuminatta Concrete Concepts, Inc. v.*
7 *Cardinal Indus.*, 145 F.3d 1303, 1307 (Fed. Cir. 1998)) (stating ““evidence must be viewed in the light
8 most favorable to the party opposing the motion, with doubts resolved in favor of the opponent.””)
9 However, to avoid summary judgment, the opposing party cannot rest solely on conclusory
10 allegations. *Berg v. Kincheloe*, 794 F.2d 457, 459 (9th Cir. 1986). Instead, it must designate specific
11 facts showing there is a genuine issue for trial. *Id.* More than a “metaphysical doubt” is required to
12 establish a genuine issue of material fact.” *Matsushita Elec. Indus. Co., Ltd. v. Zenith Radio Corp.*,
13 475 U.S. 574, 586 (1986).

14 To prevail on a motion for summary judgment alleging patent invalidity, the moving party
15 must overcome the statutory presumption that the patent is valid. *See* 35 U.S.C. § 282; *IPXL*, 430 F.3d
16 at 1381. This is not an easy task. Indeed, the moving party can only overcome the presumption with
17 “clear and convincing evidence” of patent invalidity. *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d
18 1276, 1281 (Fed. Cir. 2005) (internal citation omitted). Consistent with the burden-shifting procedure
19 for summary judgment, if the moving party, or challenger,

20 provides evidence sufficient to establish a prima facie showing on an issue, the burden
21 of production of evidence shifts to the patent owner. If the patent owner provides
22 some contradictory evidence, then the trier of fact must resolve the conflict with the
challenger, as noted, bearing the burden of persuasion by clear and convincing
evidence.

23 1 Donald S. Chisum, *Chisum on Patents* § 3.04[1][b][v] (2005).

24 Here, Defendant argues the asserted claims of the ‘713 Patent are invalid as indefinite. Title
25 35 United States Code § 112 provides the basis for the definiteness requirement of United States
26 patents. The second paragraph of this statute states: “The specification shall conclude with one or
27 more claims particularly pointing out and distinctly claiming the subject matter which the applicant
28 regards as his invention.” 35 U.S.C. § 112, ¶ 2. The purpose of this requirement is “to inform the

1 public of the bounds of the protected invention, *i.e.*, what subject matter is covered by the exclusive
2 rights of the patent.” *Halliburton Energy Services, Inc. v. M-I LLC*, 514 F.3d 1244, 1249 (Fed. Cir.
3 2008). Absent this information, “competitors cannot avoid infringement, defeating the public notice
4 function of patent claims.” *Id.* (citing *Athletic Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573,
5 1581 (Fed. Cir. 1996)). “The definiteness requirement, however, does not compel absolute clarity.
6 Only claims ‘not amenable to construction’ or ‘insolubly ambiguous’ are indefinite.” *Datamize, LLC*
7 *v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed. Cir. 2005).

8 ““A determination of claim indefiniteness is a legal conclusion that is drawn from the court’s
9 performance of its duty as the construer of patent claims.”” *Id.* (quoting *Personalized Media*
10 *Communications, L.L.C. v. Int’l Trade Comm’n*, 161 F.3d 696, 705 (Fed. Cir. 1998)). In accordance
11 with this duty, general principles of claim construction apply. *Id.* at 1348. These principles require
12 the court to consider: (1) the ordinary meaning of the disputed claim term, (2) the intrinsic evidence,
13 and (3) the extrinsic evidence. *Id.* As with other challenges to patent validity, indefiniteness must be
14 shown by clear and convincing evidence. *Id.*

15 Signet argues five terms and phrases in the ‘713 Patent are indefinite: (1) “matching,” (2) “a
16 few different radii,” (3) “dioptric prescription values,” (4) “individually optimized,” and (5) “without
17 point [and/or] axial symmetry.” The Zeiss parties assert Signet failed to raise indefiniteness with
18 respect to “a few different radii” and “dioptric prescription values” in its Final Invalidity Contentions,
19 therefore the Court should not consider those arguments here. The Court agrees with the Zeiss parties,
20 and therefore does not consider those arguments. As for the remaining terms, there is a genuine issue
21 of material fact as to whether they are indefinite. Accordingly, Signet’s motion for summary judgment
22 of invalidity based on indefiniteness is denied.

23 **IT IS SO ORDERED.**

24 DATED: March 9, 2010

25 
26 _____
27 HON. DANA M. SABRAW
28 United States District Judge