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-Patent Case Law Bulletin-

Supreme Court establishes new standard for indefiniteness, raises questions about courts' application of the standard

In *Nautilus, Inc. v. Biosig Instruments, Inc.*,[1] on appeal from the Federal Circuit Court of Appeals, the Supreme Court unanimously articulated a new standard for determining whether a patent satisfies the definiteness requirement of 35 U.S.C. § 112.[2] The court held that "a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention."[3] The Court stated that the Federal Circuit had applied an incorrect indefiniteness standard to determine whether § 112 had been satisfied and declined to apply its new standard. It therefore vacated the Federal Circuit's decision and remanded the case for the Federal Circuit to apply the correct standard.[4] As discussed below, the courts may encounter difficulty as they attempt to apply the new standard.

<u>Facts, Procedural History, and Issue at Trial and on Appeal</u>

The claims of Biosig's patent at issue, U.S. Patent No. 5,337,753 ("the '753 patent"), recite a heart rate monitor that comprises "a first live electrode and a first common electrode mounted on said first half [of an elongate member] in <u>spaced relationship</u> with each other."[5] Biosig alleged that Stairmaster Sports Medical Products, Inc. sold exercise machines that included the claimed heart rate monitor, and that Nautilus, Inc. continued such sales after acquiring Stairmaster.[6] Biosig thus sued Nautilus for infringement of the '753 patent. In a reexamination proceeding that Nautilus subsequently requested, the USPTO confirmed that the patent's claims were patentable over the prior art.[7]

After a *Markman* hearing, the district court granted Nautilus' motion for summary judgment of invalidity for indefiniteness.[8] The court agreed with Nautilus that, as properly construed, the claim term "spaced relationship," describing the relative positions of paired electrodes

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[1] *Nautilus, Inc. v. Biosig Instruments, Inc.*, No. 13-369, 2014 U.S. LEXIS 3818 (June 2, 2014).
[2] The statute reads, in relevant part, as follows: "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U.S.C. § 112, ¶ 2 (pre-AIA).
[3] *Id.* at *6 (emphasis added).
[4] *See id.* at *6, *28.
[5] See '753 patent, claim 1 and its dependent claims 2-16.
[6] *See Nautilus*, 2014 U.S. LEXIS 3818, at *11-*12.
[7] See *id.* at *12-*13. The parties voluntarily dismissed the suit without prejudice pending the outcome of the reexamination. Biosig reinstituted the suit after the reexamination concluded. *See id.* at *13-*14.
[8] The Federal Circuit's decision provides additional details of the case's procedural history. *See Biosig Instruments, Inc. v. Nautilus, Inc.*, 715 F.3d 891, 895-97 (Fed. Cir. 2013).

in the monitor, was indefinite.[9] The court found that the term "'did not tell [the court] or anyone what precisely the space should be,' or even supply 'any parameters' for determining the appropriate spacing."[10]

The Federal Circuit reversed, finding that the claim term met its indefiniteness standard.[11] The court reasoned that the district court had construed "spaced relationship," so this term was amenable to construction.[12] It further reasoned that, in view of the intrinsic evidence, "a skilled artisan could apply a test and determine the 'spaced relationship.'"[13] It therefore found the term not insolubly ambiguous.[14]

The Supreme Court's Reasoning and Further Guidance Relating to the New Standard

The Supreme Court reaffirmed several axioms of the indefiniteness analysis but took issue with the Federal Circuit's application of those axioms. The Court stated that definiteness should "be evaluated from the perspective of someone skilled in the relevant art," that "claims are to be read in light of the patent's specification and prosecution history," and that "definiteness is measured from the viewpoint of a person skilled in the art at the time the patent was filed."[15]

The Court recognized the tension between the need for certainty in claims and the difficulty in providing such certainty. "[T]he definiteness requirement must take into account the inherent limitations of language." Thus, the statute permits "[s]ome modicum of uncertainty."[16] But "a patent must be precise enough to afford clear notice of what is claimed, thereby apprising the public of what is still open to them."[17]

The Court rejected the indefiniteness standard that the Federal Circuit applied, that "[a] claim is indefinite only when it is 'not amenable to construction' or 'insolubly ambiguous.'"[18] The Court considered these requirements confusing and insufficiently precise. Also, "amenable to construction" is too lax and asks whether a court can ascribe some meaning to the claims after the fact, instead of whether the person of ordinary skill in the art can

[9] '753 patent at col. 5, ll. 28-30 (emphasis added). Claim 1 also recites the term "spaced relationship" with respect to a second pair of electrodes. *Id.* col. 5, ll. 31-33.
[10] *Nautilus*, 2014 U.S. LEXIS 3818, at *14-*15.
[11] *See Biosig*, 715 F.3d at 898-903.
[12] *See id.* at 898-99.
[13] *Id.* at 901; *see also id.* at 898-901.
[14] *See id.* at 901, 903.
[15] *Id.* at *17-*18 (internal quotations omitted).
[16] *Id.* at *19.
[17] *Id.* at *20 (internal quotations omitted).
[18] *Biosig Instruments, Inc. v. Nautilus, Inc.*, 715 F.3d 891, 898 (Fed. Cir. 2013).

understand the claims at the time of the application. That a claim must not be "insolubly ambiguous" permits too much uncertainty in a claim.[19]

Comments and Questions to be Answered

The Court's decision raises several questions. One question relates to how the new standard can be satisfied. The Court established a new standard but did not apply it. Thus, practitioners await clarification of "reasonable certainty," among other things, by the courts' implementation of the decision. District courts may need to apply the new standard before the Federal Circuit decides *Nautilus* on remand.

Another question relates to whether a patent or a claim must satisfy the new standard. The Court's holding replaced an indefiniteness standard that the courts had applied to individual claims with an indefiniteness standard that, taken literally, applies to a patent as a whole. The Court noted that the Federal Circuit had applied the "amenable to construction" and "not insolubly ambiguous" standard to determine whether "a patent claim passes the §112, ¶2 threshold." In the same paragraph, the Court stated that "a patent is invalid for indefiniteness if its claims" fail to meet the new standard.[20] It is not clear why the Court did not employ parallel language and instead state that "a patent claim is invalid for indefiniteness if it" fails to meet the new standard, since the issue of validity relates to individual claims. Perhaps this is what the Court meant. The courts may interpret the new standard to apply to individual claims, despite the language of the decision, and apply it accordingly.

Another question relates to the meaning of "inform" "about the scope of the invention." The Court's new standard states that "a patent is invalid for indefiniteness if its claims" "fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention."[21] Does the Court mean that the claims must inform the person of ordinary skill in the art of "the scope of the invention?" Different claims in a patent often have different scopes; a patent often does not have a single "scope of the invention." The Court's phrasing does not seem to take this into account. A clearer articulation of what the Court may have meant is that a claim is not indefinite if a person of ordinary skill in the art can determine the scope of that claim with reasonable certainty, in view of the claims, specification, and prosecution history. As noted above, the "reasonable certainty" element of the standard awaits further elaboration.

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[19] *See Nautilus*, 2014 U.S. LEXIS 3818, at *22-*23.
[20] *See Nautilus*, 2014 U.S. LEXIS 3818, at *6.
[21] *Id.* at *6 (emphasis added).

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