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DEFINING INDEFINITENESS:  
SUPREME COURT SAYS “REASONABLY CERTAIN”

The U.S. Supreme Court just made it easier to prove that a patent is indefinite and therefore invalid. The Supreme Court jettisoned the “incapable of construction” or “insolubly ambiguous” test in favor of a new “reasonable certainty” standard.

Now, a patent is considered indefinite if it doesn’t define the scope of the invention with “reasonable certainty” for those skilled in the art.<sup>1</sup> A “zone of uncertainty,” however, has descended on the law of indefiniteness, and key issues remain unresolved after *Nautilus, Inc. v. Biosig Instruments, Inc.*<sup>2</sup>

What are the parameters of “reasonable certainty?” How will the new standard be applied in practice? Will more patents be found invalid as indefinite? The recent Federal Circuit opinion in *Interval Licensing LLC v. AOL, Inc.*,<sup>3</sup> sheds some light on these questions.

Ground Rules – Indefiniteness

The Patent Act requires patent specifications to “conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”<sup>4</sup>

The “particularity” requirement is met only when claims (1) clearly distinguish what is claimed from what went before, and (2) clearly circumscribe what is foreclosed.<sup>5</sup> Thus, a patent must afford clear notice of what is claimed and tell the public what is still open.<sup>6</sup> Otherwise, a “zone of uncertainty” about possible infringement would surround competition and experimentation.<sup>7</sup>

If a patent holder is too ambiguous in her claim, a finding of indefiniteness renders the claim invalid.<sup>8</sup> Indefiniteness is a legal issue for the court and requires clear and convincing evidence.<sup>9</sup>



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1 *Nautilus, Inc. v. Biosig Instruments, Inc.*, \_\_\_ U.S. \_\_\_, 134 S. Ct. 2120, 2124, 2129 (2104) (emphasis added).

2 *Id.* at 2129.

3 *Interval Licensing v. AOL, Inc.*, Nos. 2103-1282, -1283, -1284, -1285, 2014 WL 4435871 (Fed. Cir. Sept. 10, 2014).

4 35 U.S.C. § 112, ¶ 2(b). Old paragraph 2 of 35 U.S.C. § 112 was replaced by newly designated 35 U.S.C. § 112, ¶ 2(b) when the America Invents Act took effect on September 16, 2012.

5 *United Carbon Co., v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942); *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. at 2129.

6 *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. at 2129 (citing *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996)).

7 *Nautilus, Inc.*, 134 S. Ct. at 2129 (quoting *Union Carbon Co.*, 317 U.S. at 236).

8 *Nautilus, Inc.*, 134 S. Ct. at 2124; *Interval Licensing*, 2014 WL 4435871, at \*4.

9 *Thomas Swan & Co. Ltd. v. Finisar Corp.*, No. 2:13-cv-00178-JRG, 2014 WL 2885296, at \*5 (E.D. Tex. June 25, 2014) (citing *Young v. Lumenis, Inc.*, 492 F.3d 1336, 1344, 1345 (Fed. Cir. 2007)).

Indefiniteness is determined from the perspective of a person of ordinary skill in the art at the time the patent application was filed.

The Federal Circuit used the existing two-prong rule that “a claim is indefinite only when it is ‘not amenable to construction’ or ‘insolubly ambiguous.’”

The statutory presumption of patent validity does not affect the definiteness inquiry.<sup>10</sup> Indefiniteness is determined from the perspective of a person of ordinary skill in the art at the time the patent application was filed.<sup>11</sup>

General principles of claim construction apply when determining whether a patent doesn’t meet the particularity requirement and is therefore indefinite.<sup>12</sup> A court will first consider intrinsic evidence of the claim language, the specification language and the prosecution history, followed by extrinsic evidence to decide indefiniteness.<sup>13</sup>

#### District Court Opinion in *Nautilus*

The patent in dispute in *Nautilus* concerned a heart-rate monitor for use during exercise.<sup>14</sup> Patentee Biosig sued *Nautilus* for infringement. The district court conducted a claims construction hearing and, *inter alia*, construed the term “in spaced relationship with each other” at it related to the monitor’s key parts.<sup>15</sup>

*Nautilus* moved for summary judgment, arguing that the term “spaced relationship” as construed by the court was indefinite under 35 U.S.C. §112, ¶ 2. Concluding that the term “did not tell . . . anyone what precisely the space should be” or supply “any parameters” for determining appropriate spacing, the district court found the term indefinite as a matter of law and granted the motion.<sup>16</sup>

Biosig appealed to the Federal Circuit.<sup>17</sup>

#### Federal Circuit Opinion in *Nautilus*

The Federal Circuit decided that the term “spaced relationship” was not indefinite, reversing and remanding the district court’s finding.<sup>18</sup> The Federal Circuit used the existing two-prong rule that “a claim is indefinite only when it is ‘not amenable to construction’ or ‘insolubly ambiguous.’”<sup>19</sup>

In completing its analysis, the Federal Circuit panel looked first at the intrinsic evidence.<sup>20</sup> Based on its review of the patent claim language, specification and figures illustrating the “spaced relationship,” the Federal Circuit identified “certain inherent parameters” that “may be sufficient” to allow a skilled artisan to understand the metes and bounds of the term.<sup>21</sup> The court also pointed to the functionality of the claim as “shed[ding] further light” on the term’s meaning.<sup>22</sup> A skilled artisan could conduct a test and determine the “spaced relationship” as pertaining to the functionality of the elements of the patented device.<sup>23</sup>

The Supreme Court granted *Nautilus*’s petition for *writ of certiorari*.<sup>24</sup>

<sup>10</sup> *Nautilus, Inc.*, 134 S. Ct. at 2130 n.10.

<sup>11</sup> *Id.* at 2128.

<sup>12</sup> *Nautilus, Inc. v. Biosig Instruments, Inc.*, 715 F.3d 891, 898 (Fed. Cir. 2013).

<sup>13</sup> *Nautilus, Inc.*, 134 S. Ct. at 2128.

<sup>14</sup> *Id.* at 2125.

<sup>15</sup> *Id.* at 2127; *Nautilus, Inc. v. Biosig Instruments, Inc.*, No. 10-Civ-7722-AKH, 2011 WL 11745378 (S.D.N.Y. Sept. 29, 2011).

<sup>16</sup> *Nautilus, Inc.*, 134 S. Ct. at 2127.

<sup>17</sup> *Nautilus, Inc.*, 715 F.3d at 897.

<sup>18</sup> *Id.* at 893, 905.

<sup>19</sup> *Id.* at 898 (citing *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed. Cir. 2005)).

<sup>20</sup> *Nautilus, Inc.*, 134 S. Ct. at 2127.

<sup>21</sup> *Id.*; *Nautilus, Inc.*, 715 F.3d at 899, 901.

<sup>22</sup> *Nautilus, Inc.*, 715 F.3d at 899.

<sup>23</sup> *Id.* at 901.

<sup>24</sup> *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 896 (2014).

The Supreme Court rejected the Federal Circuit's "insolubly ambiguous" test for the determination of indefiniteness . . .

The old two-prong, "amenable to construction" or "insolubly ambiguous," test could breed confusion for lower courts.

The Court read ". . . § 112, ¶ 2 to require 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."

### Supreme Court Opinion in *Nautilus*

The Supreme Court rejected the Federal Circuit's "insolubly ambiguous" test for the determination of indefiniteness, saying that it "tolerates some ambiguous claims but not others" and "does not satisfy the statute's definiteness requirement."<sup>25</sup>

In place of the "incapable of construction" and "insolubly ambiguous" standard, the Court adopted a "reasonable certainty" standard by holding, "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."<sup>26</sup>

The Court began its analysis by observing that § 112 entails a "delicate balance."<sup>27</sup> On one hand, the language has inherent limitations, while on the other, "some modicum of uncertainty, the Court has recognized, is the 'price of ensuring the appropriate incentives for innovation.'"<sup>28</sup> The patent must be precise enough to afford notice of what is claimed, "otherwise there would be a zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims."<sup>29</sup> Without a clarity check, patent applicants face a powerful incentive to inject ambiguity into their claims. That temptation must be eliminated, and the drafter of the patent is in the best position to do so.<sup>30</sup>

The old two-prong, "amenable to construction" or "insolubly ambiguous," test could breed confusion for lower courts.<sup>31</sup> The Court reasoned it "cannot be sufficient" that a court can ascribe *some* meaning to a claim—inherently a *post hoc* analysis. Rather, the definiteness inquiry focuses on the understanding of the claim by someone skilled in the art at the time of the application.<sup>32</sup> Allowing ambiguity just short of "insolubly ambiguous" fosters an innovation-discouraging "zone of uncertainty."<sup>33</sup>

To reconcile the balance between disclosure and the incentive to innovate, the Court read "§ 112, ¶ 2 to require 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."<sup>34</sup> This rule "mandates clarity, while recognizing that absolute precision is unattainable."<sup>35</sup> At the same time, the rule accords with Court precedent stating that the certainty required in patents, "is not greater than is reasonable, having regard to their subject matter."<sup>36</sup>

Declining to apply the new standard to the claims in issue, the Court vacated the Federal Circuit's judgment and remanded the case to determine whether the claims are sufficiently definite.<sup>37</sup>

<sup>25</sup> *Nautilus, Inc.*, 134 S. Ct. at 2124.

<sup>26</sup> *Id.* at 2124, 2129 (emphasis added).

<sup>27</sup> *Id.* at 2128.

<sup>28</sup> *Id.*

<sup>29</sup> *Id.* at 2129 (quoting *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942)) (internal quotation marks omitted).

<sup>30</sup> *Id.*

<sup>31</sup> *Id.* at 2130.

<sup>32</sup> *Id.*

<sup>33</sup> *Id.*

<sup>34</sup> *Id.* at 2129.

<sup>35</sup> *Id.*

<sup>36</sup> *Id.* (citing *Minerals Separation, Ltd. v. Hyde*, 242 U.S. 261, 270 (1916)).

<sup>37</sup> *Id.* at 2131.

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Open Issues

Undoubtedly, *Nautilus, Inc.* states a stricter standard for the definiteness inquiry—just how much stricter remains to be seen. Recent Federal Circuit and district court cases are beginning to define the new rule’s parameters:

- Claims requiring a mathematically impossible calculation are invalid.<sup>38</sup>
- While terms of degree (e.g., “unobtrusive manner”) are not inherently indefinite, they must provide reasonable certainty to one skilled in the art when read in the context of the invention.<sup>39</sup>
- Although absolute or mathematical precision is not required, it is no longer enough to identify “some standard” for measuring the scope of a claim. The claims, when read in light of the specification and prosecution history, “must provide objective boundaries for those of skill in the art.”<sup>40</sup>
- A highly subjective phrase (e.g., “unobtrusive manner”) that provides little guidance to one skilled in the art, offers no objective boundaries, and may affect different users in different ways, is indefinite.<sup>41</sup> Thus, claim language is indefinite if it doesn’t provide an objective standard for determining the scope of the invention and, instead, relies on the subjective opinion of the person practicing the invention.<sup>42</sup>
- A “hazy relationship between the claims and the written description” may fail to provide the new clarity that subjective claim language requires.<sup>43</sup>
- Adopting a narrow example from the specification to save an indefinite claim will not work if the language relied on is cast as an *example* rather than a *definition* of the vague claim language.<sup>44</sup> Thus, use of “i.e.” in the specification, rather than “e.g.” may make all the difference.<sup>45</sup>
- The definiteness inquiry may require expert testimony on “reasonable certainty.”<sup>46</sup>
- While the new rule may require a review of claims construction rulings handed down before *Nautilus, Inc.*, it is not an open invitation to rehash arguments already made.<sup>47</sup>

38 *Invensys Sys., Inc. v. Emerson Elec. Co.*, No. 6:12-cv-799, 2014 WL 3976371, at \*5 (E.D. Tex. Aug. 6, 2014).

39 *Interval Licensing LLC v. AOL, Inc.*, Nos. 2013-1282, -1283, -1284, -1285, 2014 WL 4435872, at \*4 (Fed. Cir. Sept. 10, 2014).

40 *Id.* at \*5.

41 *Id.*

42 *Prolifiq Software Inc. v. Veeva Sys. Inc.*, No. 3:13-cv-03644, at \*5 (N.D. Cal. Aug. 6, 2014).

43 *Interval Licensing LLC*, 2014 WL 4435872, at \*6.

44 *Id.* at \*7.

45 *Id.* at \*8.

46 *Mycone Dental Supply Co., Inc. v. Creative Nail Design, Inc.*, Civil Action No. 11-4380, 2014 WL 3362364, at \*4 (D.N.J. July 9, 2014).

47 *Id.* at \*1; *In re Maxim Integrated Prods., Inc.*, No. 12-244, 2014 WL 3696137, at \*7 (W.D. Pa. July 23, 2014).