



Supreme Court Focuses Indefiniteness Inquiry on “Reasonable Certainty”

BY [ELIZABETH L. BRANN](#), [ERICKA J. SCHULZ](#) & [BOB B. CHEN](#)

On June 2, 2014, the Supreme Court unanimously rejected the Federal Circuit’s test for indefiniteness under 35 U.S.C. § 112, ¶ 2. *Nautilus, Inc. v. Biosig Instruments, Inc.*, No. 13–369 (S. Ct. June 2, 2014). The Court rejected the Federal Circuit’s standard that a patent was definite if it were “amenable to construction” and not “insolubly ambiguous,” and found that a patent is indefinite “if its claims, read in light of the patent’s specification and prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Slip op.* at 1-2.

It remains to be seen how the “reasonable certainty” test will be applied because the Court remanded the case to the Federal Circuit to apply the test to the relevant claims. Under this decision, however, the indefiniteness inquiry likely will focus on the perspective of one skilled in the relevant art trying to determine the metes and bounds of a claim to avoid infringement.

Background of Proceedings

BioSig’s U.S. Patent No. 5,337,753 (“the ‘753 Patent”) claims a heart rate monitor for use during exercise. The ‘753 Patent claims a cylindrical bar with handlebars containing a live electrode and a common electrode that are grasped by a user’s hands. The user’s hands complete an electrical circuit and enable the monitor to measure the user’s heart rate. Key to the case was claim 1, requiring the two electrodes to be “mounted . . . in [a] spaced relationship with each other.” The parties disputed the construction of the term “spaced relationship.”

During *Markman*, the District Court construed the term “spaced relationship” to mean that “there is a defined relationship between the live electrode and the common electrode on one side of the cylindrical bar and the same or a different defined relationship between the live electrode and the common electrode on the other side of the cylindrical bar.” *Id.* at 6. *Nautilus* argued that the limitation “spaced relationship” as construed rendered the asserted claims indefinite and moved for summary judgment. The District Court granted the motion, holding that the definition “[spaced relationship] did not tell [the court] or anyone what precisely the space should be” or provide “any parameters” to define the spacing. *Id.* at 6-7.

On appeal the Federal Circuit reversed and remanded. Under the “amenable to construction/insolubly ambiguous” standard, the court determined that the ‘753 Patent was definite because the meaning of “spaced relationship” could be determined by “certain inherent parameters of the claimed apparatus” based on the specification and prosecution history of the patent. *Id.* at 7.

The Supreme Court Decision

The Supreme Court overruled the Federal Circuit's decision, unanimously eliminating the Federal Circuit's "amenable to construction/insolubly ambiguous" test and replacing it with a new test. Under the new test, 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." *Id.* at 1. The Court expressed no opinion on the validity of the asserted patent in *Nautilus*, and instead remanded the case to the Federal Circuit for further proceedings under the new standard.

The Court noted that section 112, ¶ 2 demands a "delicate balance" between taking "into account the inherent limitations of language" and being "precise enough to afford clear notice of what is claimed thereby apprising the public of what is still open to them." *Id.* at 9-10. The Court noted that the Federal Circuit's old test lacked "the precision §112, ¶2 demands" because it was not sufficient "that a court can ascribe *some* meaning to a patent's claims[.]" The Court stressed that the definiteness inquiry should focus on "the understanding of a skilled artisan at the time of the patent application" and not that "of a court viewing matters *post hoc*." *Id.* at 12. In so doing, the Court viewed the claims from the perspective of those skilled in the relevant art who might read a patent and consider the technology they can practice without risking an infringement claim. *Id.* at 10.

Conclusion

Nautilus re-focuses the indefiniteness inquiry on the perspective of one skilled in the relevant art trying to determine the scope of patent claims. Although the decision appears to lower the bar for invalidating patents as indefinite, it remains to be seen how the test will be applied in practice.

A copy of the decision is available at: http://www.supremecourt.gov/opinions/13pdf/13-369_k53m.pdf.

◇ ◇ ◇

If you have any questions concerning these developing issues, please do not hesitate to contact any of the following Paul Hastings San Diego lawyers:

Elizabeth L. Brann
1.858.458.3014
elizabethbrann@paulhastings.com

Ericka J. Schulz
1.858.458.3025
erickajschulz@paulhastings.com

Bob B. Chen
1.858.458.3023
bobchen@paulhastings.com

Paul Hastings LLP

StayCurrent is published solely for the interests of friends and clients of Paul Hastings LLP and should in no way be relied upon or construed as legal advice. The views expressed in this publication reflect those of the authors and not necessarily the views of Paul Hastings. For specific information on recent developments or particular factual situations, the opinion of legal counsel should be sought. These materials may be considered ATTORNEY ADVERTISING in some jurisdictions. Paul Hastings is a limited liability partnership. Copyright © 2014 Paul Hastings LLP.

IRS Circular 230 Disclosure: As required by U.S. Treasury Regulations governing tax practice, you are hereby advised that any written tax advice contained herein or attached was not written or intended to be used (and cannot be used) by any taxpayer for the purpose of avoiding penalties that may be imposed under the U.S. Internal Revenue Code.