

Supreme Court Decision Invites More Challenges to Patent Claims as Indefinite

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On Monday, in *Nautilus Inc. v. Biosig Instruments*, the United States Supreme Court unanimously set aside the Federal Circuit's indefiniteness standard, potentially easing the way for defendants to invalidate ambiguous patent claims. This case has important implications for both accused infringers and patent prosecutors.

Under § 112 of the Patent Act, a patent specification must "conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as [the] invention." 35 U. S. C. § 112, ¶ 2. For years, the Federal Circuit has held that a claim is indefinite only when it is not "amenable to construction" or it is "insolubly ambiguous." In Monday's ruling, the Supreme Court held that the Federal Circuit's standard does not satisfy the definiteness requirement of § 112 because it "tolerates some ambiguous claims but not others."

The patent at issue in *Biosig*, U.S. Patent No. 5,337,753 is directed to a heart rate monitor in exercise equipment. Claim 1 requires a cylindrical bar with a "live" electrode and a "common" electrode "mounted . . . in spaced relationship with each other." In the proceedings below, the district court had determined that the term "spaced relationship" in the patent was indefinite because "spaced relationship" did not convey "what precisely the space should be." The Federal Circuit reversed, holding that the term was amenable to construction and was not "insolubly ambiguous."

In its opinion, the Supreme Court expressed concern that the Federal Circuit's standard creates confusion for lower courts and fails to put the public on notice of a patentee's claims. The Supreme 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" (emphases added). The Court explained, "the definiteness requirement, so understood, mandates clarity, while recognizing that absolute precision is unattainable."

This standard adopts a middle ground between the Federal Circuit's standard and the standard that the petitioner and some amici had urged the Court to adopt, which would have invalidated claims if there were two reasonable competing interpretations of the claim's meaning. The "reasonable certainty" middle ground approach was similar to the standards advocated in amicus briefs authored by the Solicitor General and the American Intellectual Property Law Association ("AIPLA"), each of which criticized the use of the insolubly ambiguous standard.

The Supreme Court remanded to allow the Federal Circuit to decide the validity of the asserted claims applying the new standard. Because the Court declined to analyze the claims at issue, there remains considerable uncertainty as to how the new "reasonable certainty" standard will apply in practice, and whether it will change the way that district courts analyze indefiniteness.

Implications for Patent Litigation

The *Biosig* decision means that vague or ambiguous claims will be more likely to be held indefinite, and that accused infringers will have stronger grounds to challenge such claims. We can expect to see this defense raised more frequently and applied to claims, such as in the mechanical and electrical arts, that had not previously been challenged on § 112 grounds to the same extent as claims in the life sciences. The defense will also provide a new tool for defendants to attack vague claims asserted by so-called patent trolls.

The decision may also heighten interest in the use of post-grant review proceedings to challenge issued patents. The America Invents Act created these new proceedings as less time-consuming alternatives to evaluate patent validity, including on § 112 grounds. As more

patents eligible for post-grant review are issued, the new indefiniteness standard will make post-grant review proceedings an attractive venue.

Implications for Patent Prosecution

The *Biosig* decision also heightens the importance of precise claim drafting during patent prosecution, particularly for claim elements where broad scope is desired. Patent attorneys should be careful to include clear claim term definitions in patent applications and provide sufficient intrinsic support both in patent applications and during prosecution to avoid indefiniteness challenges down the road. Patent practitioners should also consider drafting alternative claims with varied formulations in order to insulate the patent from future indefiniteness challenges. This is also another reason to maintain pending continuation applications, in which unforeseen ambiguities in issued claims can be remedied.

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