

Litigation Alert

June 4, 2014

Supreme Court Strengthens the Definiteness Requirement for Patent Claims

On June 2, 2014, in *Nautilus, Inc. v. Biosig Instruments, Inc.*, No. 13-369, the Supreme Court unanimously rejected the Federal Circuit's test for determining indefiniteness of a patent claim as "lack[ing] the precision that § 112, ¶ 2 demands." The Court (Ginsburg, J.) explained that "it cannot be sufficient that a court can ascribe *some* meaning" to the disputed claim language. Rather, the definiteness inquiry "trains on the understanding of a skilled artisan at the time of the patent application"—not that of a court years later. A patent claim, when read in light of the specification and prosecution history, must inform, "with reasonable certainty," those skilled in the art about the scope of the invention.

Background

A district court found that certain patent claims to a heart rate monitor were indefinite under 35 U.S.C. 112, ¶ 2. The disputed claim language was the "spaced relationship" which the applicant used to describe the positioning of two electrodes with respect to each other in the claimed heart monitor.

The Federal Circuit reversed, holding that the term "spaced relationship" was not "insolubly ambiguous" when read in light of the intrinsic evidence and from the perspective of a person skilled in the art. Although the patent specification did not define the "spaced relationship" with specific parameters, the Federal Circuit reasoned that the patent's claim language and specification disclosed "certain inherent parameters of the claimed apparatus, which to a skilled artisan may be sufficient to understand the metes and bounds of 'spaced relationship,'" and thus provided "sufficient clarity."

The "Delicate Balance" of the Definiteness Requirement

The Supreme Court rejected the "insolubly ambiguous" test as too tilted in the patentee's favor, explaining that the definiteness requirement "entails a 'delicate balance.'" On one hand, "the definiteness requirement must take into account the inherent limitations of language" and that patents are written for "those skilled in the relevant art." On the other hand, "a patent must be precise enough to afford clear notice of what is claimed," lest there be "[a] zone of uncertainty at which enterprise and experimentation must enter only at the risk of infringement claims."

The Supreme 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. The definiteness requirement, so understood, mandates clarity, while recognizing that absolute precision is unattainable."

The Supreme Court vacated the Federal Circuit's decision and remanded the case for reconsideration of the indefiniteness issue under the new "reasonable certainty" standard.

Practice Tips

Much remains to be seen as to how the Federal Circuit actually applies the new standard for indefiniteness in practice. Although “reasonable certainty” is by no means a precise standard, the Supreme Court clearly intended to add some teeth to the definiteness requirement. Accordingly, the new standard is likely to prompt new indefiniteness challenges to patent claims in the district courts, the International Trade Commission and the United States Patent Office, and those challenges are likely to be more successful than in the past.

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