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Supreme Court Redefines “Definiteness” Test for Patent Claims

Court Strikes Down Federal Circuit Standard for Determining Whether Patent Claim Meets Definiteness Requirement of 35 U.S.C. § 112, ¶ 2

SUMMARY

In *Nautilus, Inc. v. Biosig Instruments, Inc.*,¹ the Supreme Court rejected the long-standing Federal Circuit test for determining whether a patent claim meets the “definiteness” standard of 35 U.S.C. § 112, ¶ 2. Under the Federal Circuit test rejected by the Court, a claim was sufficiently definite to meet the statutory requirement if it was “amenable to construction” and not “insolubly ambiguous.” In *Nautilus*, the Supreme Court unanimously held that the proper test is whether the patent claims, “read in light of the specification . . . and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.”² The Court vacated the Federal Circuit’s decision and remanded for further consideration of the patent at issue under the newly defined legal standard.

BACKGROUND

By statute (35 U.S.C. § 112, ¶ 2), a patent must conclude with “one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” This requirement, known as “definiteness,” is evaluated from the perspective of one of skill in the art at the time the patent application was filed, and in light of the patent’s specification and prosecution history. For many years, the Federal Circuit has held that a patent claim is not sufficiently definite to meet the requirements of the statute, *i.e.*, the claim is indefinite, only if it is “not amenable to construction” or is “insolubly ambiguous.”³

The patent in *Nautilus* claimed a heart-rate monitor that more accurately measured the electrical signals associated with heartbeats. The claims required that the electrodes used by the monitor be in a “spaced

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relationship” with one another. After Biosig sued Nautilus for infringement, the District Court granted Nautilus’ motion for summary judgment on the ground that the term “spaced relationship” was indefinite. The Federal Circuit reversed, holding that the term was amenable to construction and not insolubly ambiguous because the patent specification disclosed “certain inherent parameters of the claimed apparatus, which to a skilled artisan may be sufficient to understand the metes and bounds of the ‘spaced relationship.’”⁴ The Supreme Court granted certiorari.

THE SUPREME COURT’S DECISION

The Supreme Court, in a unanimous decision written by Justice Ginsburg, held that the Federal Circuit had employed an incorrect legal standard to determine whether Biosig’s patent claims met the definiteness requirement of § 112, ¶ 2. The court began its analysis by noting that a patent claim is a property right and “like any property right, its boundaries should be clear.”⁵ Although recognizing that “[s]ome modicum of uncertainty . . . is ‘the price of ensuring the appropriate incentives for innovation,’” the court found that “a patent must be precise enough to afford clear notice of what is claimed.”⁶ The Court also noted that the presumption of patent validity does not alter the degree of clarity that § 112, ¶ 2 requires of patent applicants.

The Court held that the Federal Circuit’s test—whether a patent claim is not amenable to construction or is insolubly ambiguous—“lack[ed] the precision § 112, ¶ 2 demands” and fails to provide the necessary incentive to promote clarity in patent claims. First, the Court observed that to “tolerate imprecision just short of that rendering a claim ‘insolubly ambiguous’ would diminish the definiteness requirement’s public-notice function.”⁷ Second, the Court reasoned that the mere fact that a claim is not “insolubly ambiguous” because a “court can ascribe *some* meaning to [it]” is not sufficient to meet the statutory requirement, because definiteness focuses on “the understanding of a skilled artisan at the time of the patent application, not that of a court viewing matters *post hoc*.”⁸

The Court acknowledged that other formulations of the test used in the past by the Federal Circuit “may come closer to tracking the statutory prescription,” but determined that to allow the test most commonly used by Federal Circuit to stand would “leave courts and the patent bar at sea without a reliable compass.”⁹ The Court therefore 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.”¹⁰ The Court found that this standard “mandates clarity, while recognizing that absolute precision is unattainable,” and accorded with its prior opinions stating that “the certainty which the law requires in patents is not greater than is reasonable, having regard to their subject matter.”¹¹

The Court did not address whether Biosig’s patent claims were indefinite, but instead remanded to the Federal Circuit for review under the Supreme Court’s test.

IMPLICATIONS

Nautilus, Inc. v. Biosig Instruments, Inc. makes clear that the Federal Circuit’s “not amenable to construction” or “insolubly ambiguous” framework for interpreting definiteness under § 112, ¶ 2 is no longer valid. Although the two standards are clearly different as articulated, it is less certain that the Supreme Court’s “reasonable certainty” formulation will always be interpreted in ways significantly and materially different from the prior Federal Circuit test, which the lower courts had frequently applied in ways less stringent than the language of the test would suggest. It seems clear that at least in the short term indefiniteness will become a far more prominent part of patent litigation, patent prosecution and post-grant review procedures than it has been in the past as courts apply and interpret the new standard. Moreover, the Court’s redefined bar for indefiniteness may cause holders of patents with broad or vague claims to reassess the benefits of bringing suit against alleged infringers, because the Court’s newly articulated standard may be used to invalidate such claims. Finally, patent filers may have an incentive to use narrower language in their claims in order to meet the new, more precise definiteness threshold requirement.

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ENDNOTES

- 1 572 U.S. ____ (June 2, 2014).
- 2 *Id.* at 1.
- 3 *Id.* at 11.
- 4 *Id.* at 7.
- 5 *Id.* at 2 (quoting *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 730 (2002)).
- 6 *Id.* at 9-10.
- 7 *Id.* at 12.
- 8 *Id.* (emphasis in original).
- 9 *Id.* at 12-13. The Court specifically referred to the definition of “insolubly ambiguous” used by the Federal Circuit in some cases: “If reasonable efforts at claim construction result in a definition that does not provide sufficient particularity and clarity to inform skilled artisans of the bounds of the claim, the claim is insolubly ambiguous and invalid for indefiniteness.” *Id.* at 12 (quoting *Biosig Instruments, Inc. v. Nautilus, Inc.*, 715 F.3d 891, 898 (Fed. Cir. 2013)).
- 10 *Id.* at 1.
- 11 *Id.* at 11.

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CONTACTS

New York

Garrard R. Beeney	+1-212-558-3737	beeneyg@sullcrom.com
Adam R. Brebner	+1-212-558-3011	brebnera@sullcrom.com
Marc De Leeuw	+1-212-558-4219	deleeuwm@sullcrom.com
Stephen J. Elliott	+1-212-558-7446	elliotts@sullcrom.com
John Evangelakos	+1-212-558-4260	evangelakosj@sullcrom.com
James T. Williams	+1-212-558-3130	williamsj@sullcrom.com

Palo Alto

Nader A. Mousavi	+1-650-461-5660	mousavin@sullcrom.com
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Washington, D.C.

Jeffrey B. Wall	+1-202-956-7660	wallj@sullcrom.com
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