



# US Supreme Court Rewrites Standard For Claim Indefiniteness Analysis

- *Journal of Intellectual Property Law & Practice* (2014) doi: 10.1093/jiplp/jpu152

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*Nautilus, Inc v Biosig Instruments, Inc, No 13-369, 574 US \_\_\_, 2 June 2014*

## Abstract

On 2 June 2014, the US Supreme Court unanimously overturned the long-standing jurisprudence of the US Court of Appeals for the Federal Circuit regarding the standard for evaluating a patent claim's definiteness under 35 USC §112, ¶2, and established a new 'reasonable certainty' standard that patent claims must satisfy.

## Legal Context

35 USC § 112(2), requires a patent specification to 'conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as [the] invention'.

Before the Supreme Court's decision in *Nautilus*, the Federal Circuit applied an 'insolubly ambiguous' standard of review for determining whether a claim was indefinite under 35 USC § 112, ¶2: '[i]f a claim is insolubly ambiguous, and no narrowing construction can properly be adopted', then the district court should find the claim to be indefinite. However, '[i]f the meaning of the claim is discernible, even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree', the claim should be held to be 'sufficiently clear to avoid invalidity on indefiniteness grounds'. *Exxon Research & Eng'g Co v United States*, 265 F3d 1371, 1375 (Fed Cir 2001). Thus *Exxon Research* made clear that claims should be construed to preserve validity, and that as long as the claims are 'amenable to construction', they should be deemed definite in a patent invalidity determination.

In *Nautilus*, the Supreme Court considered and rejected this rule.



## Facts

In 2004, Biosig filed suit against Nautilus in the US District Court for the Southern District of New York. Biosig sought judgment against Nautilus for infringing Biosig's US Patent No 5,337,753 (the '753 patent'). Nautilus moved for summary judgment, arguing that the claim limitation, 'spaced relationship', was indefinite under § 112, ¶2. The district court found that claim limitation to be indefinite.

The Federal Circuit reversed the district court's decision. The Federal Circuit applied the 'insolubly ambiguous' standard as crafted in *Exxon Research*, and found the claim limitation to be definite and 'amendable to construction'.

The Supreme Court granted certiorari.

## Analysis

Justice Ginsburg delivered the unanimous opinion of the Supreme Court in *Nautilus*, which held that the Federal Circuit's 'insoluble ambiguity' test 'breed[s] lower court confusion'. The court reasoned that '[t]o tolerate imprecision just short of that rendering a claim "insolubly ambiguous" would diminish the definiteness requirement's public-notice function and foster the innovation-discouraging "zone of uncertainty"'.

In place of the 'insolubly ambiguous' standard, the court clarified 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 (ibid, 1).

The court reasoned that § 112 'entails a delicate balance' between the ambiguity of the 'inherent limitations of language' and the 'zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims'. In assessing these 'concerns that tug in opposite directions', the court expressed the principle that '[t]he definiteness requirement, so understood, mandates clarity'. Moreover, '[i]t cannot be sufficient that a court can ascribe some meaning to a patent's claims; the definiteness inquiry trains on the understanding of a skilled artisan at the time of the patent application, not that of a court viewing matters post hoc'.

Thus *Nautilus* reversed the Federal Circuit's 'insolubly ambiguous' standard to determine whether a claim is definite under § 112, ¶2 in favour of a 'reasonable certainty' analysis. Under the new analysis, a patent claim is indefinite if it does not inform those skilled in the art of the field of the invention with 'reasonable certainty'. The court further clarified that the evaluation should entail 'the necessarily sophisticated analysis of the whole document'.



In addition to establishing a new standard for claim definiteness evaluation, the court in *Nautilus* noted that two issues ‘subsidiary to the ultimate issue of definiteness’ remain: (1) ‘whether factual findings ... trigger the clear-and-convincing evidence standard’; and (2) ‘whether deference is due to the PTO’s resolution of disputed issues of fact’. These issues have been left for another day.

## Practical Significance

*Nautilus*, at least arguably, lowers the requirement to establish indefiniteness of a patent claim under 35 USC § 112, ¶2 by replacing the Federal Circuit ‘insolubly ambiguous’ standard with a ‘reasonable certainty’ test. Shortly after *Nautilus* issued, numerous courts reopened briefing on questions regarding claim definiteness in view of the new test. Whether *Nautilus* results in more claims being found indefinite, only time will tell.

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