



## ARE Patent Law Alert: Supreme Court Rejects “Insolubly Ambiguous” Standard For Claim Indefiniteness Analysis

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On June 2, 2014, the U.S. Supreme Court unanimously rejected the Federal Circuit’s “insolubly ambiguous” standard in evaluating a patent claim’s definiteness under 35 U.S.C. § 112, ¶ 2. *Nautilus, Inc. v. Biosig Instruments, Inc.*, No. 13-369, 574 U.S. \_\_\_ (June 2, 2014). The Supreme Court criticized this formulation because it “can breed lower court confusion”. *Nautilus*, slip op. at 11. In its place, the Supreme Court established a “reasonable certainty” standard that patent claims must satisfy.

### Factual Background

The dispute originated in the 1990s when StairMaster Sports Medical Products, Inc. allegedly sold exercise machines containing patented technology concerning a heart-rate monitor used with exercise equipment that was assigned to Biosig Instruments, Inc. Nautilus, Inc., after acquiring StairMaster, continued to allegedly infringe Biosig’s patented technology.

In 2004, Biosig brought a patent infringement suit against Nautilus in in the Southern District of New York. Nautilus moved for summary judgment and argued that the term-at-issue, “spaced relationship,” did not satisfy the definiteness requirement under section 112, ¶ 2, which 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.”

The district court granted the motion, and concluded that the term was indefinite because no information was provided to define the term.

The Federal Circuit reversed the district court’s decision. It stated that “[a] claim is indefinite only when it is ‘not amenable to construction’ or ‘insolubly ambiguous.’” *Biosig Instruments, Inc. v. Nautilus, Inc.*, 715 F.3d 891, 898 (Fed. Cir. 2013) (internal citation omitted).

The Federal Circuit looked at the intrinsic evidence surrounding the claim limitation and determined that, since there were inherent parameters which allowed a skilled artisan to understand the bounds of the “spaced relationship,” the claim was definite.



## The Supreme Court Decision

The Supreme Court, in an opinion penned by Justice Ginsberg, held that the Federal Circuit’s “insolubly ambiguous” standard does not satisfy the section 112, ¶ 2 definiteness requirement. The Supreme Court reasoned that the statutory requirement involves a “delicate balance” between accepting indefiniteness as an inherent limitation of language, and requiring precision in describing a patent’s boundaries. *Nautilus*, slip op. at 9. According to the Supreme Court, the Federal Circuit had set an impermissibly high bar for evaluating indefiniteness because under the Federal Circuit standard a claim is indefinite only when it is “insolubly ambiguous” and has no ascribable meaning. *Id.* at 12. The application of this standard “would diminish the definiteness requirement’s public-notice function and foster the innovation-discouraging ‘zone of uncertainty’”. *Id.* (internal citation omitted).

In place of the “insolubly ambiguous” standard, the Supreme Court clarified that:

“a patent is invalid for indefiniteness 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.”

*Id.* at 1 (emphasis added). Under this new requirement, a claim is vague if it does not inform those skilled in the art of the scope of the invention with “reasonable certainty.”

The Supreme Court remanded the case to the Federal Circuit for further proceedings consistent with this decision.

## Conclusion

This case is a significant development in the assessment of claim validity in patent cases. The decision, at least arguably, lowers the requirement to establish indefiniteness of a patent claim under 35 U.S.C. § 112, ¶ 2 by replacing the Federal Circuit “insolubly ambiguous” standard with a “reasonable certainty” test.

We will continue to follow this development.

In the meantime, please feel free to [contact](#) our attorneys regarding issues raised by this case.

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