

**ALERTS****Intellectual Property Law Alert - Supreme Court Re-Formulates Definiteness Requirement For Patent Claims**

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The Supreme Court held yesterday in *Nautilus Inc. v. Biosig Instruments Inc.* (No. 13-369) that the prevailing test used by the Court of Appeals for the Federal Circuit to determine whether a patent claim is invalid as indefinite does not meet the requirements of Section 112, paragraph 2 of the 1952 Patent Act.

Section 112, second paragraph requires that the patent specification “shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”

The patent-in-suit, U.S. Patent No. 5,337,753, relates to a heart rate monitor for use in connection with an exercise apparatus. Claim one of the ‘753 patent describes the invention as including, on each half of a cylindrical bar, a live electrode and a common electrode “mounted ...in spaced relationship with each other.” The case concerns the question of whether the “mounted ... in spaced relationship with each other” language is so ambiguous as to render the claim invalid as indefinite. (See Slip Op. at 6).

The ‘753 patent survived a Patent Office re-examination, but was struck down on summary judgment by the District Court. Applying its “not amenable to construction” or “insolubly ambiguous” standard, the Federal Circuit found that the ‘753 patent claims passed the indefiniteness review. In doing so, the Federal Circuit relied on “intrinsic evidence,” including other functional limitations of the claim and the re-examination record, which included a declaration by the inventor as to how a skilled person could determine the proper spacing. (See Slip Op. at 5-8).

Writing for a unanimous court, Justice Ginsburg explained the Federal Circuit’s test could not stand because it “tolerates some ambiguous claims but not others,” and thus invokes “a standard more amorphous than the statutory definiteness requirement allows,” thereby leaving “courts and the patent bar at sea without a reliable compass.” (Slip Op. at 1, 14-15).

In contrast, the newly articulated definiteness test “mandates clarity, while recognizing that absolute precision is unattainable,” according to the court (Slip Op. at 11). To determine whether a patent claim meets the new “reasonable certainty” standard, the patent claim must be considered (i) from the point of view of a person skilled in the art, (ii) as of the time the patent application was filed, and (iii) in light of the patent specification and prosecution history. (See Slip Op. at 1).

The court suggested that language used by the Federal Circuit in the

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case below (“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”) “may come closer to tracking the statutory prescription.” (Slip Op. at 12). Thus, the court appears to allow for the possibility that definiteness issues may be resolved through “reasonable efforts” at claim construction.

The court also stated that “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.” *Id.* Thus, testimony of a “skilled artisan” as to the level of clarity provided by intrinsic evidence may be useful in countering indefiniteness challenges.

The Supreme Court expressed no opinion on the validity of the claims of the ‘753 patent, but instructed the Federal Circuit to apply the new definiteness standard articulated in this opinion. Thus, patent drafters, applicants and patentees may still hold hope that language such as “mounted ...in spaced relationship with each other” may survive the new definiteness standard. On the other hand, defendants in patent litigation likely have another tool at their disposal for challenging patents that are asserted against them.

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