

Lawyers Weigh In On High Court's Patent Indefiniteness Ruling

By **Julia Revzin**

Law360, New York (June 02, 2014, 7:35 PM ET) -- The U.S. Supreme Court on Monday ruled that the Federal Circuit's long-standing precedent for proving a patent indefinite allowed for too much ambiguity. Here, attorneys tell Law360 why the decision in *Nautilus Inc. v. Biosig Instruments Inc.* is significant.

Andrew C. Ryan, Cantor Colburn LLP



“The Nautilus Court rejected the Federal Circuit’s ‘insolubly ambiguous’ standard for indefiniteness and replaced it with a ‘reasonable certainty’ standard. However, the court agreed that some of the Federal Circuit’s ‘fuller explications’ of the term ‘insolubly ambiguous’ came closer to tracking the statute. Because many of the Federal Circuit’s decisions actually employ a ‘reasonable certainty’ type analysis, we do not expect the substance of the indefiniteness standard to meaningfully change.”

James Barney, Finnegan Henderson Farabow Garrett & Dunner LLP

“The impact of this decision is not limited to any particular industry or type of patent. All patents in all areas of technology could be susceptible to indefiniteness challenges depending on how the Federal Circuit applies the new Nautilus test. For instance, it will be interesting to see how this new test applies to so-called terms of degree, like ‘about’ and ‘approximately.’ These types of terms are very common in patent claim drafting, so it will probably not be long before one of them is challenged under the new Nautilus test.”

Courtenay Brinckerhoff, Foley & Lardner LLP

“Today in *Nautilus v. Biosig Instruments*, the Supreme Court rejected the Federal Circuit’s ‘insolubly ambiguous’ test for patent claim indefiniteness under 35 USC Section 112, and instead adopted a ‘reasonable certainty test.’ The court recognized that the standard for indefiniteness must balance two competing interests: permitting ‘[s]ome modicum of uncertainty’ to provide ‘appropriate incentives for innovation’ while requiring enough precision ‘to afford clear notice of what is claimed’ and disincentivize the deliberate creation of ‘zone[s] of uncertainty’ around claim scope. The court determined that these interests are best balanced when the statute is read ‘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.’ Although the court took some time to explain the questions presented by the claims at issue, it refused to apply the new ‘reasonable certainty’ test in the first instance, instead remanding to the Federal Circuit. Thus, it will be up to the Federal Circuit to determine how to assess

whether Biosig's claims define its invention with 'reasonable certainty,' and provide further insight on what this new test means in practice."

Rob Brunelli, Sheridan Ross PC

"In *Nautilus v. Biosig Instruments*, the Supreme Court, in again reversing the Federal Circuit, today held that the definiteness requirements of the patent statutes mandate clarity, while somewhat confusingly still recognizing that absolute precision in claim drafting is unattainable. The Federal Circuit's standard, which the court noted tolerated some ambiguities in claims, was too lenient, with the court remanding the case for a determination of whether the at-issue patent claims were indefinite under its more exacting standard. The court's continued attack on the patent system in general, and patentees in particular, is unfortunate, but not unexpected given other recent decisions from the court."

Monte Cooper, Orrick Herrington & Sutcliffe LLP

"The big impact of *Nautilus* likely will be a procedural one. The case, by invoking a more defense-friendly 'reasonable certainty' standard for claim meaning, will certainly invite more indefiniteness challenges. A big question is when those challenges will be allowed to occur. *Nautilus* heavily focuses upon the relationship of indefiniteness to traditional mechanics of claim construction. The court's new 'reasonable certainty' standard would seem to invite district courts to resolve indefiniteness issues at the same time they otherwise construe all of the claim terms at issue. That creates a potential tension in the fact that claim construction is a purely legal issue with no heightened burden of proof, but indefiniteness as a form of invalidity and is subject to a clear and convincing standard. District courts and the parties will need to think carefully how and when to deal with that duality, and what evidence, including expert testimony, they will need to introduce to prove a claim is, or is not, indefinite."

David K.S. Cornwell, Sterne Kessler Goldstein & Fox PLLC

"In *Nautilus v. Biosig Instruments*, the Supreme Court addressed the question of the meaning of definiteness as it applies to patent claims. The court rejected the Federal Circuit's inquiry of whether the claim is 'amenable to construction' or 'insolubly ambiguous.' The Supreme Court held that the Federal Circuit standards would diminish the definiteness requirement's public-notice function and foster the innovation-discouraging 'zone of uncertainty.' Drafting patent claims is one of the most difficult tasks that a patent attorney undertakes. It requires a patent attorney simultaneously be a technologist, a linguist and a lawyer. The decision will make the job of patent lawyers even more difficult. While the Supreme Court has raised the bar for patent lawyers, hopefully it will result in improved patents by reducing the 'zone of uncertainty.' Lawyers who purposely inject ambiguity to patent claims to provide flexibility in litigation will not be able to engage in such practices."

Patrick Doody, Pillsbury Winthrop Shaw Pittman LLP

"The Supreme Court's unanimous decision in *Nautilus* eases the burden on alleged infringers to prove invalidity under 35 USC Section 112, second paragraph, and opens the door to more indefiniteness challenges not only in district court, but in post grant proceedings. This decision continues the recent trend of the Supreme Court taking cases on appeal where it believes the Federal Circuit applies the incorrect standard."

Michael A. Erbele, Merchant & Gould PC

"The Supreme Court's holding on the indefiniteness standard in *Nautilus v. Biosig* will curb enforcement of vague patents by trolls and other entities that rely on indefinite language to support broad claim interpretations. The court rejected the Federal Circuit's 'insolubly ambiguous' test in favor of a more lenient standard, under which a patent is indefinite if it fails to state the scope of the invention 'with reasonable certainty' to a person skilled in the art. This holding will check the assertion of vague and

overly-broad patents by making it easier for defendants to prove invalidity.”

Brian Ferrall, Kecker & Van Nest LLP

“The Supreme Court’s opinion in *Nautilus* is an important, albeit small, step toward recalibrating the patent monopoly grant back to what the inventor actually invented. This is good for preserving a robust patent system, which is rightfully under attack for having granted patent rights that have little, or only vague, correlation to the inventor’s claimed improvement in the art. But the opinion leaves much to the Federal Circuit and district courts. Most important is the question of how to reconcile this definiteness requirement with the tolerance for sweeping claim constructions found in some Federal Circuit opinions. There will be much work to do at the district court and Federal Circuit to bring meaning and coherence to this new standard.”

Jack Griem, Carter Ledyard & Milburn LLP

“Accused infringers now have yet another more powerful defense to assert. With every court decision, the pendulum is swinging farther away from strong patent rights.”

David Gross, Faegre Baker Daniels

“As courts apply the new 'reasonable certainty' test, the rubber will hit the road right away. Should a court invalidate a claim on the grounds that the scope of the claim lacks 'reasonable certainty' where two sides in a case present reasonable constructions of a claim term? The first court to do so will signal a significant change in the law of indefiniteness.”

Shawn Hansen, Nixon Peabody LLP

“I anticipate that *Nautilus* will have limited impact on how future cases will be decided. The Supreme Court's new standard provides little more concrete guidance than the former Federal Circuit rule. Absent a clear new analytical framework, courts likely will analyze whether a patent claim is invalid for indefiniteness in much the same way as they did before *Nautilus*.”

Mark Harris, Proskauer Rose LLP, Counsel for Biosig

“The decision endorses our position substantively. In replacing the Federal Circuit’s test for indefiniteness, the court adopted the test that we advocated: whether the patent’s claims, viewed in light of the specification and prosecution history, inform a skilled artisan about the scope of the invention with reasonable certainty. At the same time, the court rejected *Nautilus*’ position that any ambiguity invalidates a patent.”

Barry Herman, Womble Carlyle Sandridge & Rice LLP

“In my opinion, the most significant aspect of the *Nautilus* case is that the court specifically addressed the perception that patent attorneys and applicants are gaming the system by intentionally injecting ambiguity into their claims. It specifically noted that it was ‘[e]liminating that temptation,’ in large part because the applicant is in the best position to resolve ambiguity in the claims during prosecution. The court recognized that the Federal Circuit’s actual application of the indefiniteness test is not that far afield from the court’s holding but wanted the lower courts and the patent bar to have a ‘more reliable compass.’”

Mark Janis, Center for Intellectual Property Research at the Indiana University Maurer School of Law

“The court may have felt that it was sending a strong signal to the Federal Circuit, the lower courts and the PTO to scrutinize patents more closely for indefiniteness, but I think that the test that the court adopted is itself quite indefinite. Those who were hoping for the court to make it much easier to challenge patents for indefiniteness shouldn’t be claiming victory — the Federal Circuit could use the

court's new test to reach the same result it reached under its own test."

Cynthia Kernick, Reed Smith LLP

"Congress has tried, but failed, to modify the Patent Statute to reduce the explosion of unnecessary and often frivolous suits. But today, the Supreme Court continued its successful efforts to apply the existing Patent Statute in concrete and reasonable ways to infringement claims. The impact of the Nautilus decision will be felt most strongly in cases in which vague language in a specification has been used to assert infringements never contemplated when the patent issued. The prior Federal Circuit standard was itself so ambiguous and indefinite as to not be helpful to district court judges. In deciding that the necessary purpose of the specification is to 'inform those skilled in the art about the scope of the invention with reasonable certainty,' Nautilus will be used by district judges to dispose of cases that, under the prior 'insolubly ambiguous' standard, unnecessarily would have continued through trial or summary judgment and too frequently resulted in an appearance of validity when none existed."

Stephen G. Kunin, Oblon Spivak McClelland Maier & Neustadt LLP

"The Supreme Court ruling in Nautilus v. Biosig Instruments will make it easier for parties to successfully attack the validity of issued patents. No longer will the irreconcilably insoluble standard apply. The decision lowers the standard for proving that a claim fails to particularly point out and distinctly claim an invention. It appears that so long as a person of ordinary skill in the art would sufficiently understand what it would take to avoid infringing a claim, the claim will pass muster under 35 USC Section 112(b). However, cases like the Chef America v. Lamb-Weston 2004 Federal Circuit decision will still require claim drafters to exercise due care to avoid drafting nonsensical claims."

Thomas F. Lebens, Fitch Even Tabin & Flannery LLP

"The Nautilus decision's reversal of the 'insolubly ambiguous' standard, and adoption of the 'reasonable certainty' standard, not only raises the level of particularity with which claims must be drafted, but places a premium on a sound written description and prosecution history, written with an eye toward litigation, that inform the skilled artisan with regard to the scope of the invention. The full impact of this decision will unfold over the years to come, but it seems clear going forward that the burden remains on the patent drafter to skillfully anticipate and resolve ambiguities in patents as they are prepared and argued before the United States Patent and Trademark Office."

David Levy, Morgan Lewis & Bockius LLP

"Patent claims will now be more vulnerable to attacks on their validity, because the Supreme Court has lowered the bar for proving that claim terms are 'indefinite.' The prior test for indefiniteness was whether a claim term was 'insolubly ambiguous' and not 'amenable to construction.' The question for courts will now be whether a person of ordinary skill in the art at the time of the patent application could understand the scope of the claimed invention with 'reasonable certainty.' Expect more indefiniteness arguments at the claim construction phase of cases."

Jeremy Lowe, Axinn Veltrop & Harkrider LLP

"Today's Supreme Court decision in Nautilus marks an abrupt end to imprecise claim terms and the leniency afforded to such terms by the PTO, district courts and the Federal Circuit. Patent applicants must now give extra attention to claim drafting while facing the first-to-file pressures brought about by the Leahy-Smith America Invents Act. Litigants and courts alike will also need to quickly move beyond the Federal Circuit's amorphous standard and engage in more rigorous evidentiary and legal analyses to determine whether or not a claim is sufficiently definite to meet the statutory requirements."

John Murphy, BakerHostetler

“The Supreme Court established the succinct new definiteness requirement of ‘reasonable certainty,’ but did not make a ruling on the facts, so the decision comes across as only a general nudge in the direction of being tougher on ambiguous claims. Thus, much remains to be seen about the impact of the decision, including the fate of the claim at issue, which will be in the Federal Circuit’s — or perhaps the district court’s — hands. One thing seem certain: the new standard in combination with the court’s allusions to the subject matter of the claims, expert testimony and factual findings subsidiary to the ultimate issue of definiteness all point to an uptick in detailed, evidence-heavy litigation on definiteness.”

Woodrow H. "Woody" Pollack, GrayRobinson PA

“The Supreme Court identified the delicate balance that must be struck with an indefiniteness analysis. Language, by definition, is imprecise. But a patent, by definition, must put the public on notice of what activity is in the public domain. Here, the Supreme Court seems to have followed a long line of its recent cases where it eliminates a test the Federal Circuit has developed to address patent issues. The court’s standard, by its own admission, does not appear to be substantively different from the Federal Circuit’s application of its ‘insolubly ambiguous’ test. I’d expect a lot of expert testimony battles going forward addressing whether or not the challenged patent informs, with reasonable certainty, those of skill in the art on the scope of the claimed invention. This will likely be very difficult for trial judges, as the juries will need to decide which side’s experts have the better view.”

Antony Pfeffer, Kenyon & Kenyon LLP

“Today the Supreme Court reemphasized the importance that inventors must particularly point out and distinctly claim what they want exclusivity regarding. Today’s decision should reinvigorate indefiniteness as a viable legal defense. Time will tell whether this decision will have any impact on how the Federal Circuit looks at claims, as the new standard may be the same as the standard that the Federal Circuit had previously applied — a possibility which the Supreme Court acknowledges. What is clear is that moving forward, district courts will have a more definite standard against which to measure the adequacy of patent claims.”

Joshua Rothman, Fitzpatrick Cella Harper & Scinto LLP

“With its recent ruling in *Nautilus v. Biosig Instruments*, the Supreme Court has eschewed the Federal Circuit’s ‘insolubly ambiguous’ claim definiteness standard in favor of a new standard requiring that the claims of a patent, when read in light of the patent’s specification and the prosecution history, inform with reasonable certainty those skilled in the art about the scope of the invention. The Supreme Court’s ‘reasonable certainty’ standard may result in an increasing number of validity challenges under 35 USC Section 112, as it alters the standard for proving that challenged claims fail to particularly point out and distinctly claim the subject matter regarded as the invention. In its holding today, the Supreme Court indicated that the new ‘reasonable certainty’ standard attempts to strike the right balance between the ‘modicum of uncertainty’ that is inherent in written language, and the need to avoid providing incentive for patent applicants to ‘inject ambiguity’ into claims. The ‘reasonable certainty’ standard will likely help curtail excessive ambiguity during patent prosecution, and thereby reduce the number of issued patents with uncertain claim scope.”

P. Anthony Sammi, Skadden Arps Slate Meagher & Flom LLP

"Nautilus is all about certainty. Certainty about what the standard should be, and certainty about what claim terms mean. The way the Supreme Court has handled both issues will likely tend to favor defendants, at least in the near term: by asking courts to apply a reasonableness standard over the 'insolubly ambiguous' standard, patent claims are more likely to be found invalid for indefiniteness, thus conferring an advantage on defendants."

Michael A. Sartori, Venable LLP

“In *Nautilus*, the Supreme Court casts off the ‘amenable to construction’ and ‘insolubly ambiguous’ standards for determining indefiniteness under Section 112, second paragraph. The Supreme Court is apparently concerned that the Federal Circuit’s standard can foster too much ambiguity in claims. The Supreme Court replaces the Federal Circuit’s standard with one that requires more precision in the hopes of reducing a ‘zone of uncertainty’ that can arise in claim drafting. The Supreme Court’s decision today apparently requires more precise claim drafting and may offer a greater chance of invalidating patent claims as being indefinite. However, with the Supreme Court’s decision in *Nautilus*, new jurisprudence will be required by the Federal Circuit to sort out this new standard for determining indefiniteness.”

Robert Siminski, Harness Dickey & Pierce PLC

“The decision in *Nautilus* should serve to limit patent infringement litigation cases where not a single reference is made in the specification as to the scope being considered for assertion. This will not only cause prospective litigants to take a closer look at this prior to filing suit, but will likely influence how patent applications are written going forward.”

Charlie Steenburg, Wolf Greenfield & Sacks PC

“The decision will undoubtedly change how judges structure indefiniteness opinions. However, the impact on the underlying merits may be limited. The ‘reasonable notice’ standard announced today is something that the patentee itself had proposed. The accused infringer had sought a stricter standard, under which a claim would be indefinite whenever different readers could plausibly have different understandings. On remand, the Federal Circuit will likely stress the Supreme Court’s refusal to go that far. The decision may also make trial courts more favorably disposed toward expert testimony and by extension less likely to resolve indefiniteness challenges early in cases.”

Tim Worrall, Polsinelli PC

“The Supreme Court was quite sure that the previous Federal Circuit standard — insolubly ambiguous — was incorrect. That said, there is a great deal of ambiguity in the standard proposed by the Supreme Court. Among other things, the test requires a determination of what is reasonable, to one skilled in the art, having evaluated the specification and prosecution history of the patent in question, at the time of the invention. This will be determined by courts in future cases across several technologies. As such, the practical meaning of the new standard has yet to be determined.”

--Editing by Emily Kokoll