

Supreme Court Chooses Middle Ground in Formulating A Standard for
Patent Claim Definiteness
by David R. Todd

On June 2, 2014, the U.S. Supreme Court issued a unanimous opinion in *Nautilus v. Biosig Instruments, Inc.* At issue was the language of 35 U.S.C. § 112, 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 his invention.” This requirement is commonly referred to as the requirement for “definiteness.”

In this case, the district court granted summary judgment that the claim term “spaced relationship” was too ambiguous and that the patent claim at issue was therefore invalid for indefiniteness. The Federal Circuit reversed, relying on a test used in many of its opinions, namely that an ambiguous claim term renders a claim invalid for indefiniteness only if the term is not “amenable to construction” or if the term is “insolubly ambiguous.” *Nautilus* then petitioned for certiorari, arguing to the Supreme Court that the Federal Circuit’s test is incorrect. *Nautilus* proposed that if a term in a patent claim has more than one reasonable interpretation, then the patent claim should be held invalid for indefiniteness.

The Supreme Court chose a middle ground, rejecting both the Federal Circuit’s test and the test proposed by *Nautilus*. Instead, the Supreme Court adopted the following standard: The statute requires “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.”

Several principles informed the Supreme Court’s decision. First, the Court explained that the parties were in agreement on several aspects of the definiteness inquiry. Specifically, the parties agreed that “definiteness is to be evaluated from the perspective of someone skilled in the relevant art,” that “in assessing definiteness, claims are to be read in light of the patent’s specification and prosecution history,” and that definiteness is measured “from the viewpoint of a person skilled in [the] art at the time the patent was filed.” The Court observed that the real dispute between the parties was in their articulation of “how much imprecision” the statute tolerates. In answering that question, the Court noted that section 112 entails a “delicate balance.” “On one hand, the definiteness requirement must take into account the inherent limitations of language,” and “[s]ome modicum of uncertainty...is the

Supreme Court Chooses Middle Ground in Formulating A Standard for
Patent Claim Definiteness
by David R. Todd

‘price of ensuring the appropriate incentives for innovation.’” “At the same time, a patent must be precise enough to afford clear notice of what is claimed, thereby apprising the public of what is still open to them.” In other words, “[t]he definiteness requirement...mandates clarity, while recognizing that absolute precision is unattainable.” The Court concluded that its formulation was the best way to reconcile these competing concerns. Its “reasonable certainty” formulation in this case is consistent with statements of the Court in previous cases. See *Minerals Separation Ltd. v. Hyde*, 242 U.S. 261, 270 (1916) (“[T]he certainty which the law requires in patents is not greater than is reasonable, having regard to their subject-matter.”); *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942) (“claims must be reasonably clear-cut”).

After providing its standard, however, the Court declined to apply it to the particular dispute in this case. Instead, it vacated the Federal Circuit’s decision and remanded for the lower courts to make that determination in the first instance. The Court did observe that the Federal Circuit’s “fuller explications,” even when using the “insolubly ambiguous” standard, “may come close[] to tracking the statutory prescription.” Thus, it remains to be seen just how much the Supreme Court’s standard will change the outcome in this particular case and in other cases in which the issue of definiteness is raised.