



Zone of uncertainty

Richard Stark of Cravath, Swaine & Moore talks about how the recent Supreme Court ruling in *Biosig v Nautilus* will affect patent holders and inventors

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What happened in *Biosig v Nautilus*?

This case addresses the standard for judging whether patent claims meet the so-called 'definiteness' requirement. The US Patent Act requires that a patent conclude with "one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor regards as the invention". Each claim is essentially a paragraph that defines the metes and bounds of the protected intellectual property. Ideally a patent claim should be precise and definite, so that mem-

bers of the public can know whether they are infringing or not. In reality, it is very hard to achieve that kind of precision.

Of course, as with every litigation issue, there are opposing interests. On the one hand, inventors and patent holders would like to describe and claim their inventions in a way that is somewhat generic or conceptual. If you have invented a machine, you don't want your patent claim to be limited to the specific dimensions and blueprint of the machine you built.

Rather, you want your patent claims to describe the machine in a way that is general enough to encompass the idea of it. The claims have to be broad enough so that if someone builds a machine that incorporates your idea but isn't exactly the same as the embodiment you built on your workbench, it would still be infringing.

On the other hand, potential infringers want the claims to be as specific and as narrow as possible. So, claims that the patent holder may see as justifiably broad, potential

infringers may see as impermissibly indefinite. In *Nautilus v Biosig Instruments*, the US Supreme Court took up the question: what is the appropriate standard for evaluating a patent claim for indefiniteness?

The Court of Appeals for the Federal Circuit, for a number of years, maintained that a claim is indefinite if it was “insolubly ambiguous”. Put another way, if a claim could be construed using the usual tools of claim construction, it was deemed to be definite. But if there was an ambiguity that couldn’t be resolved by those tools then the claim would be deemed indefinite. The Federal Circuit standard was generally seen as favourable to patent holders, in that it made it difficult to find patent claims invalid for indefiniteness.

In *Biosig*, the district court held the claims in question to be indefinite. The Federal Circuit reversed the decision and ruled that the claims were not indefinite. *Nautilus* asked the Supreme Court to review the standard of indefiniteness applied by the Federal Circuit.

The Supreme Court ultimately decided that the Federal Circuit’s “insolubly ambiguous” standard was not consistent with the statute. The court reasoned that the Federal Circuit’s standard permitted ambiguous claims, as long as a court could construe those claims, leaving a “zone of uncertainty” and potentially creating an incentive for patent drafters to be vague.

To “eliminat[e] that temptation”, the court announced a new standard. Rather than focusing on whether a court, at the time of litigation, can construe a patent claim, the new test asks whether patent claims “inform those skilled in the art about the scope of the invention with reasonable certainty” as of the time of the patent application.

How will the new test affect future patent cases?

What this new standard means in practice is very much up in the air. The Supreme Court has told us that the new test should eliminate that “zone of uncertainty”. We can safely say this means that it should be easier to find patent claims invalid for indefiniteness. But, frankly, it is hard to know whether there is a case that would turn out differently under the new “reasonable certainty” test than under the Federal Circuit’s “insolubly ambiguous” test. Standards such as this can really only be understood as they are applied in particular cases.

How was the new test applied in the *Biosig* case?

This particular case concerns a device for monitoring a person’s heart rate, which can be mounted on exercise equipment. The claims in question deal, in part, with the placement of electrodes on a handle bar,

two electrodes for each hand, spread apart in what the claims refer to as a “spaced relationship”. The case turns on the meaning of that term, “spaced relationship”, and whether it is definite or indefinite.

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The Supreme Court opted not to decide how its new rule applies in this instance. Instead, it remanded the case to the Federal Circuit for consideration of whether the claims in question meet the new standard. So, we will have to wait and see.

When the Federal Circuit decided the case the first time around, all three judges on the panel found the claims to be sufficiently definite, though the majority and the concurrence took slightly different views. Given that, my guess is that on its second try, the Federal Circuit will reach the same conclusion, which may well be the right conclusion for this particular case.

The patent claims at issue describe an apparatus in which the electrodes have a space

between them. The Federal Circuit may conclude that this limitation is understandable to those skilled in the art and apprises them as to the scope of the claim with “reasonable certainty”. Arguments about how large of a space the “spaced relationship” limitation covers may be seen as going to the breadth of the claim, not to ambiguity.

Why did the Supreme Court issue this new rule?

There was a fairly widely held view among practitioners that the Federal Circuit’s “insolubly ambiguous” standard was overly favourable to patent holders. Many thought that this standard tolerated too many ambiguous patents. Before the Supreme Court, both parties, as well as the solicitor general and a number of amici, shared that view. Indeed, at one point in the oral argument, counsel for *Biosig* (who was the patent holder and presumably wanted to defend the Federal Circuit’s ruling) conceded that the standard needed to be changed.

How will the new rule affect NPEs?

To the extent that the Supreme Court’s decision has created an easier standard for finding a patent claim invalid for indefiniteness, it should be helpful for potential infringers of patents and therefore somewhat of a negative development for non-practicing entities (NPEs), or ‘patent trolls’.

It would be hard to say at this point that the new decision is a game changer. Oftentimes when defendants assert indefiniteness, they are really complaining that the claim is broad, not that it is ambiguous. Going forward, a defendant who hopes to win on indefiniteness will still want to show how a term in a patent claim has multiple possible meanings, all supported by what was known to those skilled in the art at the time of the patent application, but all mutually incompatible. A court presented with such a well-supported demonstration of ambiguity should find a claim invalid for indefiniteness. **IPPro**



Richard Stark
Partner
Cravath, Swaine & Moore LLP