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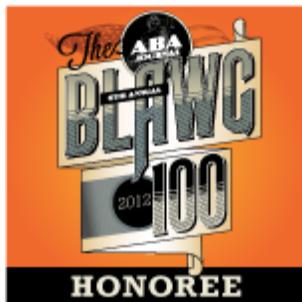
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June 03, 2014

Nautilus, Inc. v. Biosig Instruments, Inc. (2014)

By [Kevin E. Noonan](#) --

In the universe of the toxic interplay between the Federal Circuit and the Supreme Court, an affirmance or even a begrudging acknowledgement of the Federal Circuit's "special expertise" in patent law has become as rare as the apocryphal newspaper headline "Man bites dog." Once again, in an opinion rendered yesterday in *Nautilus, Inc. v. Biosig Instruments, Inc.*, the mythical patent law dog is safe: the Court predictably reversed and in doing so overruled the lower court's "insolubly ambiguous" standard for patent claim indefiniteness.



The facts are unremarkable. The claims at issue were directed towards components of exercise equipment that enabled the user to detect her heart rate during exercise using sensors placed in such a way that the signals from skeletal muscles in motion (the electromyogram signals) don't interfere with or mask the signals from the heart (the electrocardiogram or ECG). The patent-in-suit, U.S. Patent No. [5,337,753](#), disclosed methods and apparatus that take advantage of the difference in polarity between the right hand and the left hand exhibited by the ECG that is absent in the signals detected as the EMG. Accordingly, the ECG can be detected by eliminating the EMG signals based on this polarity difference. The claim term at issue related to the relative placement of electrodes, specifically that they are "mounted . . . in spaced relationship with each other." Exactly how these electrodes are so spaced was asserted by the patentee to be the result of a "trial and error" process to adapt the invention to different exercise machines having different configurations, *inter alia*, of the positions of the handgrips on the machine.

The dispute between the parties related to the proper construction of the claim term "in spaced relationship with each other." Biosig's interpretation was that the phrase meant the difference in spacing between the electrodes in each electrode pair, while Nautilus contended that the term meant a spacing "greater than the width of each electrode," based on the prosecution history of an *ex parte* re-examination provoked by Nautilus. The District Court construed the claims in the absence of any reliance on electrode width, deciding that the term meant that there was a "defined relationship" between the electrodes on the sensor for one hand that was the same as the defined relationship between the electrodes on the other hand. Based on this construction, the District Court granted Nautilus's motion for summary judgment that the claims were indefinite, finding that the term "did not tell [the court] or anyone what precisely the space should be," or "even supply 'any parameters' for determining the appropriate spacing." The Federal Circuit reversed, in a ruling that applied the "insolubly ambiguous" test first enunciated by that Court in *Datamize, LLC v. Plumtree Software, Inc.*, 417 F. 3d 1342, 1347 (Fed. Cir. 2005). As characterized in the Supreme Court's opinion, the Federal Circuit held that the intrinsic evidence surrounding the claim term contained "certain inherent parameters of the claimed apparatus, which to a skilled artisan may be sufficient to understand the metes and bounds of 'spaced relationship.'" (These properties related to the disclosure that the electrodes must detect signals from two distinct points on each hand, so that the "spaced relationship" could not be greater than the width of user's hand, nor could the distance be "infinitesimally small, effectively merging the [two] electrodes into a single electrode with one detection point.")

The Supreme Court vacated this judgment and remanded to the Federal Circuit, in a unanimous (what else?) opinion written by Justice Ginsberg. The Justice noted that the parties held several principles regarding indefiniteness in common:

- "First, definiteness is to be evaluated from the perspective of someone skilled in the relevant art," citing *General Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 371 (1938) and the words of Section 112, second paragraph of the Patent Act.
- "Second, in assessing definiteness, claims are to be read in light of the patent's specification and prosecution history," citing *United States v. Adams*, 383 U.S. 39, 48-49 (1966) (specification) and *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U. S. 722, 741 (2002) (prosecution history).
- "Third, "[d]efiniteness is measured from the viewpoint of a person skilled in [the] art *at the time the patent was filed*," citing the Respondent's Brief and E. Manzo [(ed.)], Patent Claim Construction in the Federal Circuit §0.2, p. 9 (2014).

The difference in the parties' views, according to the opinion, is in "just how much imprecision §112, ¶12 tolerates," with Nautilus espousing the view that a claim is indefinite when "readers could reasonably interpret the claim's scope differently," while Biosig (and the Solicitor General) contended that "the patent provide reasonable notice of the scope of the claimed invention" in order to satisfy the statutory standard.

The Court discerned that the statutory section "entails a 'delicate balance,'" citing *Festo*, wherein "[o]n the one hand, the definiteness requirement must take into account the inherent limitations of language," while on the other hand "a patent must be precise enough to afford clear notice of what is claimed, thereby 'appris[ing] the public of what is still open to them,'" citing *Markman v. Westview Instruments*, 517 U.S., at 373 quoting *McClain v. Ortmyer*, 141 U.S. 419, 424 (1891). The considerations involved in the "inherent limitations of language" include that there is a "modicum of uncertainty" that is necessary to encourage innovation in view of the target audience of the patent claim, which are "'not addressed to lawyers, or even to the public generally,' but rather to those skilled in the relevant art," citing *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, 437 (1902). Nevertheless, this inherent ambiguity cannot become so great that it creates a "zone of uncertainty" around the patent claims, which would discourage innovation without any benefit to the public says the Court, citing *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942). And the Court also apparently was persuaded (at least to some degree) that "patent applicants face powerful incentives to inject ambiguity into their claims" unless countervailing disincentives (in the form of being put at risk of being invalidated) are in place, citing (predictably) to Petitioner Nautilus's brief but also to a Federal Trade Commission report, [The Evolving IP Marketplace: Aligning Patent Notice and Remedies With Competition](#) 85 (2011), regarding "testimony that patent system fosters 'an incentive to be as vague and ambiguous as you can with your claims' and 'defer clarity at all costs,'" statements that even the FTC does nothing more than quote.

Being "[c]ognizant of the competing concerns," the Court announced its test for indefiniteness (citing *Minerals Separation, Ltd. v. Hyde*, 242 U.S. 261, 270 (1916)(other citations omitted)):

[W]e read §112, ¶12 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. The definiteness requirement, so understood, mandates clarity, while recognizing that absolute precision is unattainable. The standard we adopt accords with opinions of this Court stating that "the certainty which the law requires in patents is not greater than is reasonable, having regard to their subject-matter."

The Court's justification for adopting this test, over the Federal Circuit's "insolubly ambiguous" test, is that the Federal Circuit's test would "breed lower court confusion," an ironic statement from a Court whose recent patent law decisions have bred so much confusion that even the Court having "special expertise" in patent law has been seriously befuddled in attempting to apply their decisions (see the Federal Circuit's *en banc* opinion in *CLS Bank v. Alice*). Further, the Court's opinion asserts that claim terms must be unambiguous at the time the patent is granted to a person skilled in the art and "not [to] a court viewing matters *post hoc*." The Court asserts that the consequence of upholding the "insolubly ambiguous" test would be to 'diminish the definiteness requirement's public-notice function and foster the innovation-discouraging "zone of uncertainty," citing again the Court's *Union Carbide* decision.

However, while the Court evinces no (express) interest in "micromanaging" the Federal Circuit, it "must ensure that the Federal Circuit's test is at least 'probative of the essential inquiry,'" citing *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 40 (1997). Finding that the lower court's current test for indefiniteness does not meet this standard, the opinion stated that the Court "agree[s] with Nautilus and its *amici* that such terminology can leave courts and the patent bar at sea without a reliable compass" and reversed. The Court was in no mood to actually apply the "reasonable certainty" test it created, however; instead, the Court remanded the matter to the Federal Circuit to "reconsider, under the proper standard, whether the relevant claims in the '753 patent are sufficiently definite," citing *Johnson v. California*, 543 U.S. 499, 515 (2005).

This is a decision that raises the question of why the Court even bothered to make the effort, except for its apparent knee-jerk impulse to want to school the Federal Circuit once again regarding its interpretation of patent law. The patent community can take some measure of comfort that the Court recognizes the

difficulties in translating the tangible fruits of innovation into patent claims, in language reminiscent of the Court's consideration of these difficulties in *Graver Tank v. Linde Air Products*, 339 U.S. 605 (1950):

In determining whether an accused device or composition infringes a valid patent, resort must be had in the first instance to the words of the claim. If accused matter falls clearly within the claim, infringement is made out and that is the end of it.

But courts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for -- indeed encourage -- the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law. One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy. Outright and forthright duplication is a dull and very rare type of infringement.

But in other ways the Court's opinion (which does so little to define what is "reasonable certainty" in patent claim drafting under its newly enunciated test) raises tensions with other areas of patent law. For example, although the opinion emphasizes that the meaning of claim terms is directed not to judges but to the worker of ordinary skill, the Court has also mandated that courts, including the Federal Circuit, construe the meaning of claim terms as a matter of law (*Markman*). In practice, lawyers write freedom-to-operate and patentability opinions, and district court judges write their opinions, with an eye towards review by trial courts and the Federal Circuit, respectively, and thus how claim terms appear to lawyers and judges is an important consideration. Pretending does not make it so, and the Court here has raised legitimate questions regarding whether claim indefiniteness is to be determined as a matter of law by the court in construing claims, or by determining (purportedly using expert testimony) whether the skilled worker would understand the term and the claim thus "inform[s] the skilled worker with reasonable certainty" what the claim terms mean. Thus, there is now another opportunity for the Federal Circuit to "get it right" on this patent requirement, until the next time the Court decides that its test, rather than the Federal Circuit's next test, is the test that all courts must apply.

Hat tip to Greg Ahorenian regarding the tension between these two areas of the Supreme Court's jurisprudence.

[Nautilus, Inc. v. Biosig Instruments, Inc. \(2014\)](#)
Opinion of the Court by Justice Ginsburg

Posted at 11:59 PM in [Definiteness](#), [Supreme Court](#) | [Permalink](#)

Comments

I think though that the Supreme Court was correct to point out that the Federal Circuit's approach of trying to find the meaning in an unclear claim did cause a 'zone of uncertainty' which was undesirable. Applicants might then be tempted to write claims with a clear portion and an ambiguous portion.

Posted by: [Suleman](#) | [June 04, 2014 at 06:25 AM](#)

How will this decision affect, if at all, prosecution of patent applications and the standards employed by the USPTO in judging claim definiteness?

Posted by: Jim McKeown | [June 04, 2014 at 08:09 AM](#)

"Applicants might then be tempted to write claims with a clear portion and an ambiguous portion."

No doubt, but that temptation is checked by two additional considerations. (1) You still have to get it past the PTO before you can take your chances in court, and it is well settled law that the "insolubly ambiguous" standard *never* applied in ex parte prosecution before the PTO. MPEP 2173.02.I; In re Packard, slip op. at 20 (Plager J., concurring.) (2) In litigation, ambiguous claims are supposed to be construed to favor non-infringement. Athletic Alternatives, Inc. v. Prince Mfg., Inc., 73 F.3d 1573, 1581 (Fed. Cir. 1996); see also, 3M Innovative Prods. Co. v. Tredegar Corp., 107 USPQ2d 1717, 1733 (Fed. Cir. 2013) (Plager J., concurring).

In other words, existing elements of CAFC jurisprudence were easily available to deal with any of the problems that supposedly motivated the Supreme Court's decision. If they really cared about fixing the problem, they would have seized on Judge Plager's recent work and run with it. Instead, they simply slapped the CAFC, but offered almost no guidance at all to help lower courts apply 112(b).

This is why, anymore, I wince when I see the Supreme Court grant cert on a patent issue. They almost never improve matters, even when there really is a problem in the law.

Posted by: GrzeszDeL | [June 04, 2014 at 09:02 AM](#)

It seems to me that much of this is the inevitable result of the Legislature removing any teeth to the long established Best Mode requirement? While The patent-in-suit, U.S. Patent No. 5,337,753, certainly came up through the PTO in the times where such disclosure did have teeth and thus a desirability for such disclosure, never-the-less, reading the above reeks of struggling with putting other tools in place to deal with ambiguity, where if the best mode requirement had been available for exploring during litigation, a much more suitable and immediate result achieved (in this case at least).

Posted by: Christopher Wait | [June 04, 2014 at 09:54 AM](#)

Christopher Wait,

I do not think that "Best Mode" - being a subjective item in the eyes of the inventor only, never really had the teeth that you seem to think that they had.

Posted by: Skeptical | [June 04, 2014 at 11:07 AM](#)

"an ironic statement from a Court whose recent patent law decisions have bred so much confusion that even the Court having 'special expertise' in patent law has been seriously confused in attempting to apply their decisions (see the Federal Circuit's en banc opinion in CLS Bank v. Alice)."

Kevin,

Never were truer words spoken regarding Our Judicial Mount Olympus that continues to create utter chaos in our area of the law. Our Judicial Mount Olympus is also completely hypocritical and disingenuous when it continues to chastise the Federal Circuit for error when it too commits the same sin (or worse). Or as Jesus once said, "take the plank out of your own eye before asking your brother to remove the speck from his."

Posted by: EG | [June 04, 2014 at 12:06 PM](#)

The part of the Manzo-IPLAC book quoted by SCOTUS in Nautilus was from a chapter co-authored by Prof. Josh Sarnoff of DePaul U. College of Law and me. I have written to the Court asking it to amend the citation to name us both as chapter authors. I appreciate the contributions of all of the contributing authors, particularly Kevin Noonan.

Posted by: Edward Manzo | [June 05, 2014 at 08:47 PM](#)

The comments to this entry are closed.



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