

# Client Alert

January 13, 2014

## Supreme Court to Evaluate Federal Circuit's Approach to Definiteness

By Richard S.J. Hung and Kirk Allen Sigmon

### INTRODUCTION

On January 10, 2014, the Supreme Court granted certiorari on two questions relating to the “definiteness” requirement under 35 U.S.C. § 112(b). Specifically, the Supreme Court will consider (1) whether the Federal Circuit’s acceptance of ambiguous patent claims with multiple reasonable interpretations – so long as the ambiguity is not “insoluble” by a court – defeats the statutory requirement of particular and distinct patent claiming, and (2) whether the presumption of validity dilutes the requirement of particular and distinct patent claiming. *Nautilus, Inc. v. Biosig Instruments, Inc.*, No. 13-369 (Jan. 10, 2014) (“*Nautilus*”).

### BACKGROUND

Under Section 112(b), the specification of a patent must “conclude with one or more claims that particularly point[] out and distinctly claim[] the subject matter which the inventor or joint inventor regards as the invention.”<sup>1</sup> A claim that fails to satisfy this requirement may be held to be invalid as indefinite.

If an ambiguous claim is susceptible to multiple interpretations, the Federal Circuit has held that a claim is indefinite “only when it is ‘not amenable to construction’ or ‘insolubly ambiguous’”<sup>2</sup> – *i.e.*, where “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.”<sup>3</sup> The Federal Circuit has explained that this high bar “accord[s] respect to the statutory presumption of patent validity” as mandated by 35 U.S.C. § 282(a).<sup>4</sup>

In *Biosig Instruments, Inc. v. Nautilus, Inc.*,<sup>5</sup> plaintiff Biosig alleged that defendant Nautilus infringed a patent relating to a heart rate monitor apparatus. The district court granted summary judgment invalidating the asserted claim because the claim requirement of a “spaced relationship” was indefinite. On appeal, the Federal Circuit reversed, holding that the ‘753 patent was sufficiently definite because it disclosed the “inherent parameters of the claimed apparatus, which to a skilled artisan may be sufficient to understand the metes and bounds of ‘spaced relationship.’”<sup>6</sup>

<sup>1</sup> 35 U.S.C. § 112(b).

<sup>2</sup> *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1371 (Fed. Cir. 2008) (quoting *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed. Cir. 2005)).

<sup>3</sup> *Biosig Instruments, Inc. v. Nautilus, Inc.*, 715 F.3d 891, 898 (Fed. Cir. 2013).

<sup>4</sup> *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001); *see also* 35 U.S.C. § 282(a).

<sup>5</sup> No. 1:10-CV-07722 (S.D.N.Y. Feb. 23, 2012).

<sup>6</sup> *Biosig Instruments, Inc. v. Nautilus, Inc.*, 715 F.3d 891, 899 (Fed. Cir. 2013).

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## NAUTILUS'S PETITION FOR CERTIORARI

Nautilus filed a petition for certiorari on September 19, 2013,<sup>7</sup> and numerous parties subsequently filed amicus curiae briefs in support of Nautilus's petition. A collection of technology companies such as Amazon.com and Google argued that the Federal Circuit's approach to definiteness "undermines the notice function of patents – distorting incentives for inventors, taxing future innovation, and creating a host of other social costs[.]"<sup>8</sup> Two non-profit organizations, Public Knowledge and the Electronic Frontier Foundation, also filed a supporting amicus brief that argued that the Federal Circuit's approach "abrogates the public notice function, permits the proliferation of indeterminate claims, invites abuse by clever patent drafters, and contributes to a general and widespread sense that patents are unclear and uninformative documents."<sup>9</sup>

The Court granted Nautilus's petition on January 10, 2014 to address the two issues raised by Nautilus's petition. The first is whether the Federal Circuit's acceptance of ambiguous patent claims with multiple reasonable interpretations – so long as the ambiguity is not "insoluble" by a court – defeats the statutory requirement of particular and distinct patent claiming. The second is whether the presumption of validity dilutes the requirement of particular and distinct patent claiming.

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<sup>7</sup> Petition for a Writ of Certiorari, *Nautilus, Inc. v. Biosig Instruments, Inc.*, No. 13-369 (Jan. 10, 2014), available at <http://sblog.s3.amazonaws.com/wp-content/uploads/2013/12/13-PETITION-FOR-A-WRIT-OF-CERTIORARI.pdf>.

<sup>8</sup> Brief of Amazon.com, Inc., et al. as Amici Curiae, p. 1, *Nautilus, Inc. v. Biosig Instruments, Inc.*, No. 13-369 (Jan. 10, 2014), available at <http://sblog.s3.amazonaws.com/wp-content/uploads/2013/12/131023Nautilus-amicus-brief.pdf>.

<sup>9</sup> Brief of Public Knowledge and the Electronic Frontier Foundation as Amici Curiae, p. 3, *Nautilus, Inc. v. Biosig Instruments, Inc.*, No. 13-369 (Jan. 10, 2014), available at <http://sblog.s3.amazonaws.com/wp-content/uploads/2013/12/13-369-BRIEF-OF-EFF-AND-PK-IN-NAUTILUS-v-BIOSIG.pdf>.