

IP Alert: U.S. Supreme Court Clarifies Definiteness Standard

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Yesterday, the U.S. Supreme Court issued its ruling in *Nautilus, Inc. v. Biosig Instruments, Inc.* involving the definiteness requirement of 35 U.S.C. § 112 (b). The patent at issue relates to a heart rate monitor capable of measuring the heartbeat of an individual while exercising without attaching electrodes. The device compares electrical waves from an electrode gripped by the left hand to those from an electrode gripped by the right hand in order to calculate the individual's heart rate.

At issue was a claim feature that common electrodes are placed in a "spaced relationship" to live electrodes, which record the signals. The district court construed the term to mean there is a "defined relationship" between the live and common electrodes on each side of the cylindrical bar. However, the district court granted a motion for summary judgment on indefiniteness because the term "spaced relationship" did not inform "what precisely the space should be" or "whether the spaced relationship on the left side should be the same as the spaced relationship on the right side."

The Federal Circuit reversed, concluding that "the claims provide inherent parameters sufficient for a skilled artisan to understand the bounds of 'spaced relationship,'" such as the fact that the

distance separating the electrodes cannot be greater than the width of a user's hand. The majority also pointed to the fact that "a skilled artisan could apply a test and determine the 'spaced relationship' as pertaining to the function of substantially removing EMG signals." The Federal Circuit reiterated its "insolubly ambiguous" standard under which claims should not be ruled indefinite as long as they are amenable to construction. Judge Schall concurred, agreeing that the claims are not indefinite but disagreeing that the "spaced relationship" is defined by the function of removing EMG signals.

In a unanimous decision delivered by Justice Ginsburg, the Supreme Court rejected the Federal Circuit's articulation of the definiteness standard, which it said "tolerates some ambiguous claims but not others." The High Court ruled that "[i]n place of the 'insolubly ambiguous' standard, we hold that a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention."

The Court emphasized the patent law's competing concerns between encouraging innovation and providing adequate public notice of patent rights. The Court said that the newly announced "reasonable certainty" standard strikes an appropriate balance between these concerns by "mandat[ing] clarity, while recognizing that absolute precision is unattainable."

Although the Court disagreed with the Federal Circuit's articulation of the appropriate test for indefiniteness, it did not address the underlying question of whether the claims at issue are definite. The case was remanded to the Federal Circuit to consider this question in light of the Court's decision.

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