

**Keywords:** indefiniteness; 35 U.S.C. § 112, ¶ 2; insolubly ambiguous; amendable to construction; reasonable certainty; skilled in the relevant art

**General:** A patent claim is indefinite if, read in light of the specification and the prosecution history, fails to inform those skilled in the art about the scope of the invention with reasonable certainty.

*Nautilus, Inc. v. Biosig Instruments, Inc.*  
U.S. Supreme Court  
Decided June 2, 2014

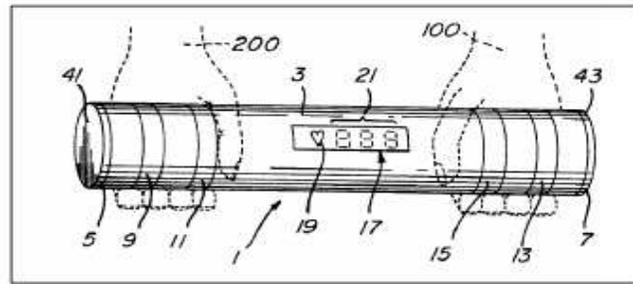
## **I. Relevant Procedural History**

The disputed patent, U.S. Patent No. 5,337,753 (“the ‘753 patent”), concerns a heart-rate monitor for use during exercise. An independent claim, which is also presented below for the purpose of context, recites “a live electrode and a common electrode mounted in *spaced relationship* with each other.” The district court found that the term “spaced relationship” is indefinite under 35 U.S.C. § 112, ¶ 2 because it does not supply any parameters for determining the appropriate spacing. The Federal Circuit reversed and remanded, holding that a claim is indefinite when it is not “*amenable to construction*” or is “*insolubly ambiguous*.” The Federal Circuit found that the claims of the ‘753 patent satisfied the aforementioned test, and thus concluded that the claims are sufficiently definite.

## **II. Facts**

Biosig is the assignee of the ‘753 patent. During the process of detecting a user’s heart rate, the invention reduces electromyogram (EMG) noise signals given off by skeletal muscles. The specification of the ‘753 patent describes that EMG signals can mask electrocardiograph (ECG) signals because they are of the same frequency, which makes it difficult to determine someone’s heart rate. The heart rate monitor proposed in the ‘753 patent functions by a user’s left and right hands each contacting both a live electrode and a common electrode on a cylindrical member. The distance between the two electrodes is not quantified in the claims or the specification. Indeed, the claims simply recite that the two electrodes are in a “spaced relationship” with each other. The relevant recitations of independent claim 1 and a representative figure are reproduced below:

1. A heart rate monitor for use by a user in association with exercise apparatus and/or exercise procedures, comprising, *inter alia*,  
a first live electrode (9) and a first common electrode (11) mounted on said first half in *spaced relationship* with each other;  
a second live electrode (13) and a second common electrode (15) mounted on said second half in *spaced relationship* with each other. (Emphases added.)



Patent No. 5,337,753, Figure 1

Biosig filed an infringement action against Nautilus in 2004. During that time, Nautilus sought reexamination of the '753 patent twice from the PTO. The PTO consolidated the reexaminations and concluded the patent was valid without amendment. During the reexamination proceeding, the parties voluntarily dismissed the 2004 case without prejudice. However, upon conclusion of the reexamination, Biosig reasserted its patent against Nautilus. Nautilus filed a motion for summary judgment that the '753 patent was invalid for indefiniteness, and the district court granted the motion. As noted above, the district court found that the term "spaced relationship" is indefinite under § 112, ¶ 2 because it does not supply any parameters for determining the appropriate spacing. The Federal Circuit reversed and remanded, holding that a claim is indefinite when it is not "amenable to construction" or is "insolubly ambiguous." The Federal Circuit found that the claims of the '753 patent satisfied the aforementioned test, and thus concluded that the claims are sufficiently definite. The Supreme Court granted certiorari on this issue.

### III. Issue

Did the Federal Circuit court err in holding that the standard for determining definiteness under 35 U.S.C. § 112, ¶ 2 is whether a claim is "amenable to construction" or is "insoluble ambiguous?"

### IV. Discussion

Yes. In a 9-0 decision, the Supreme Court overturned the Federal Circuit's test of determining definiteness under § 112, ¶ 2 based on whether a claim is "amenable to construction" or is "insolubly ambiguous." Specifically, the Court stated that the Federal Circuit's formulation, which tolerates some ambiguous claims but not others, does not satisfy the statute's definiteness requirement. Thus, in lieu of the "insolubly ambiguous" test, the Court held that a patent is invalid for indefiniteness if its claims, read in light of the specification and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.

In promulgating the correct test for definiteness under § 112, ¶ 2, the Court was cautious in attempting to reconcile the competing concerns of promoting innovation while simultaneously ensuring that the public has clear notice of the scope of an invention. Specifically, the Court cited *Festo v. Shoketsu*, which held that the definite requirement must take into account the limitation of language, and that some modicum of uncertainty is the price of ensuring the appropriate incentives for innovation. At the same time, citing *Markman v. Westview Instruments* and *United Carbon v. Binny & Smith*, the Court noted that a patent must be precise enough to afford clear notice of what is claimed, and thereby apprise the public of what is still open to them in a manner that avoids a zone of uncertainty for enterprise and experimentation. Thus, cognizant of these competing concerns, the Court concluded that the definiteness requirement that a claim—in view of the specification and prosecution history—inform those skilled in the art with only *reasonable certainty* of the scope mandates clarity while simultaneously recognizing that absolute precision is unattainable.

In its discussion of the deficiencies of the Federal Circuit's "amenable to construction" or "insolubly ambiguous" test, the Court stated that these formulations lack the precision § 112, ¶ 2 demands, and could breed lower court confusion. Specifically, the Court noted that the definiteness inquiry turns on

the understanding of a skilled artisan at the time of the patent application, and not that of a court viewing matters *post hoc*. Therefore, to tolerate imprecision just short of that rendering a claim “insolubly ambiguous” would diminish the definiteness requirement’s public-notice function and foster the innovation-discouraging zone of uncertainty warned against by the *United Carbon* Court. Furthermore, while the Court was careful to note that it does not micromanage the Federal Circuit’s particular word choice in applying patent-law doctrines, the Court stated that the Federal Circuit’s test did not meet the requisite standard of “probative of the essential inquiry,” and further characterized the expressions “insolubly ambiguous” and “amenable to construction” as having the potential to leave courts and the patent bar “at sea without a reliable compass.”

However, while the Court overturned the Federal Circuit’s test and promulgated a new standard by which to determine definiteness under § 112, ¶ 2, the Court declined to apply the promulgated standard to the disputed claims of the ‘753 patent—noting that the Supreme is a court of review as opposed to one of first review. Accordingly, the Court reversed and remanded the judgment of the Federal Circuit with instructions to decide the indefiniteness issue according to the new standard.

## **V. Conclusion**

The Supreme Court overruled the Federal Circuit’s test of determining definiteness under 35 U.S.C. § 112, ¶ 2 based on whether a claim is “amenable to construction” or is “insolubly ambiguous,” and promulgated the standard that the a patent claim is indefinite if, read in light of the specification and the prosecution history, fails to inform those skilled in the art about the scope of the invention with reasonably certainty.