June 3, 2014

June 2, 2014 – The Supreme Court issued its unanimous decision in *Nautilus, Inc. v. Biosig Instruments, Inc.*, No. 13-369, 572 U.S. ___ (2014), lowering the standard for showing a patent claim is invalid for indefiniteness. Under the previous standard articulated by the Federal Circuit more than a decade ago, a patent claim was indefinite only if it was "insolubly ambiguous," or, in other words, if the patent claim was not amenable to construction. In *Nautilus*, the Supreme Court relaxed the standard for indefiniteness, adopting a reasonableness standard based on the knowledge of a person of ordinary skill in the art of the claimed invention. Now, the question is whether a patent claim, read in light of the specification and prosecution history, informs a person of ordinary skill in the art of the scope of the invention with "reasonable certainty."

Potential impacts

Pending and future patent litigation and prosecution will be impacted by the Supreme Court's decision in *Nautilus*, in the following ways:

Litigation Strategy: The "reasonable certainty" test opens the door to broader indefiniteness challenges where patent claims are subject to more than one possible construction, which will lead to an increased number of indefiniteness challenges. Plaintiffs taking stretch positions to cover products not originally the subject of the patented invention need to carefully evaluate this strategy or risk highlighting potentially invalidating claim scope ambiguities. Conversely, defendants should carefully review claims asserted against them for plausible alternative meanings, which may give rise to new indefiniteness arguments.

Claim Construction: The "reasonable certainty" test may require expert witness involvement in the claim construction process, which often addresses the definiteness of patent claim terms. Expert witnesses will be the primary vehicles for parties to supply opinions on what a person of ordinary skill understands patent claims to mean with "reasonable certainty."

Claim Drafting: The "reasonable certainty" test requires a reevaluation of claim drafting strategies, used by some patent prosecutors, that encourage ambiguity over clarity in claim language in order to preserve or expand claim scope. Intentionally creating ambiguity in claim scope leaves patent claims vulnerable to indefiniteness attacks under the Supreme Court's new test. In fact, the Supreme Court emphasized that it articulated a new test for indefiniteness to curb the practice of ambiguous claim drafting.

Background

Biosig sued Nautilus for infringing U.S. Patent No. 5,337,753 ('753 patent) in the U.S. District Court for the Southern District of New York. *Nautilus*, 572 U.S. ___, at 5. The '753 patent relates to improved heart-rate monitors for use in connection with exercise equipment. StairMaster, and later Nautilus, through acquisition, were accused of using the patented technology in their exercise equipment. The indefiniteness dispute centered on the element of claim 1 reciting a heart rate monitor having electrodes "mounted … in a spaced relationship with each other." '753 patent, cl. 1. The Federal Circuit reversed the District Court's indefiniteness ruling, finding the claim term could be construed. The Supreme Court overturned the Federal Circuit's indefiniteness test, but declined to reach a decision on the ultimate issue of whether the '753 patent was indefinite under the new test.

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Key Contacts

Orion Armon Colorado	oarmon@cooley.com +1 720 566 4119

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