

BIOSIG INSTRUMENTS, INC. v. NAUTILUS, INC., Appeal No. 2012-1289  
(Fed. Cir. April 27, 2015). Before Newman, Schall, and Wallach. On remand.

### Background:

Biosig sued Nautilus for infringement of a patent directed to a heart rate monitor. The monitor included two pairs of electrodes. Each pair included a live electrode and a common electrode "in spaced relationship with each other." The district court found that the specification did not define a particular spacing, and did not describe any parameters for determining the spacing. Thus, the court held that the term "spaced relationship" was indefinite.

On appeal, the Federal Circuit applied the "insolubly ambiguous" standard in reversing the district court's holding on indefiniteness. Under this standard, a claim is indefinite "if 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" considering the specification and the prosecution history. The Federal Circuit held that both the specification and prosecution history provided "certain inherent parameters" that would be sufficient to understand the metes and bounds of the term "spaced relationship."

The Supreme Court vacated the Federal Circuit's ruling, holding that the Federal Circuit had articulated the incorrect legal standard for indefiniteness. While recognizing that the Federal Circuit's "fuller explications" of the term "insolubly ambiguous" appeared to track the statutory language, the Court expressed concern that the expression "insolubly ambiguous" "can leave courts and the patent bar at sea without a reliable compass." The Court thus articulated a new formulation to clarify the indefiniteness standard. Under the Court's "reasonable certainty" standard, 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." The Court remanded the case to the Federal Circuit to analyze the claims under the newly articulated standard.

### Issue/Holding:

Did the District Court err in granting summary judgment of invalidity for indefiniteness as analyzed under the "reasonable certainty" standard? Yes, reversed and remanded.

### Discussion:

The Federal Circuit defined the issue before the court as whether the Supreme Court had articulated a new standard, or whether the Supreme Court was primarily clarifying the existing standard. Without directly answering the question, the Federal Circuit cited lower courts for interpreting the "reasonable certainty" standard as not rendering the Federal Circuit's prior decisions inapplicable. It also emphasized that the "reasonable certainty" standard is a familiar standard prevalent throughout Supreme Court and Federal Circuit jurisprudence.

Turning to the case at hand, the Federal Circuit revisited its prior analysis to "make clear" that the ordinarily skilled artisan would understand the scope of the invention with reasonable certainty. The Federal Circuit proceeded to quote its previous analysis, focusing again on the specification and the prosecution history. The court concluded that the term "spaced relationship" satisfies the "reasonable certainty" standard articulated by the Supreme Court for the reasons set forth in its previous opinion.

Although the Federal Circuit stood by its prior analysis, it celebrated that "we may now steer by the bright star of 'reasonable certainty,' rather than the unreliable compass of 'insoluble ambiguity.'"