

NAUTILUS, INC. v. BIOSIG INSTRUMENTS, INC., Appeal No. 13-369 (U.S. June 2, 2014).  
Delivered by Ginsburg. Appealed from Fed. Cir. (Before Newman, Schall, and Wallach).

Background:

Biosig sued Nautilus for infringement of a patent for a heart rate monitor on an exercise machine having a live electrode and a common electrode "in spaced relationship with each other." The district court entered summary judgment of invalidity, holding that the claim term "spaced relationship" was indefinite because it is unclear how the "space" is defined or what parameters should be used to determine the appropriate spacing.

The Federal Circuit reversed the district court's decision, reaffirming that a claim is indefinite only when it is "not amenable to construction" or "insolubly ambiguous." The court explained that a claim is "insolubly ambiguous" when reasonable efforts at claim construction result in a definition that does not provide sufficient clarity to inform the ordinarily skilled artisan of the bounds of the protected invention. In applying this standard, the Federal Circuit held that the term "spaced relationship" was not indefinite, and the ordinarily skilled artisan would have been able to determine sufficiently clear boundaries from the intrinsic record and "certain inherent parameters of the claimed apparatus." For example, the distance separating the electrodes cannot be wider than the width of a user's hand because the claims require the user's hand to touch both electrodes, and it cannot be so small as to merge the two electrodes into a single electrode with one detection point.

Issue/Holding:

Did the Federal Circuit apply the correct standard in evaluating indefiniteness? No, vacated and remanded.

Discussion:

As an initial matter, the Supreme Court confirmed that (1) definiteness is to be evaluated from the perspective of the ordinarily skilled artisan; (2) in assessing definiteness, the claims must be read in light of the specification and prosecution history; and (3) the relevant time frame for assessing definiteness is at the time the patent application was filed. The court also recognized the delicate balance required by §112. The Court emphasized that although some uncertainty is tolerated as "the price of ensuring the appropriate incentives for innovation," claim language must be precise enough to afford notice to persons of ordinary skill in the art as to what is claimed, and conversely, what is open to practice without risk of infringement.

The Court concluded that this notice function was not achieved with the Federal Circuit's indefiniteness standard. It declared that "[i]t cannot be sufficient that a court can ascribe *some* meaning to a patent's claims; the definiteness inquiry trains on the understanding of a skilled artisan at the time of the patent application, not that of a court viewing matters *post hoc*."

In light of these concerns, the Supreme Court articulated a new standard: a patent is invalid as indefinite if the claims fail to inform persons of ordinary skill in the art about the scope of the invention "with reasonable certainty." The new standard leaves room for some uncertainty in claim language while ensuring that any uncertainty is not greater than what is reasonable.

