

NIAZI LICENSING CORP. v. ST. JUDE MEDICAL S.C., INC., Appeal No. 2021-1864 (Fed. Cir. April 11, 2022). Before Taranto, Bryson, and Stoll. Appealed from D. Minn. (Judge Wright).

Background:

In a patent infringement case, the alleged infringer (defendant) argued that the asserted claims were invalid as being indefinite. The independent claim recited:

- A double catheter, comprising:
 an outer, *resilient* catheter having shape memory . . . ;
 an inner, *pliable* catheter slidably disposed in the outer catheter

The defendant argued that the terms "resilient" and "pliable" were subjective terms that rendered the claims indefinite. The district court agreed, and held that the claims were invalid.

Issue/Holding:

Did the district court err in finding that the terms "resilient" and "pliable" rendered the claims indefinite? Yes, reversed and remanded.

Discussion:

In analyzing whether the claims were indefinite, the Federal Circuit reviewed the standard for indefiniteness.

As explained in *Nautilus*, a claim is indefinite if it "fail[s] to inform, with reasonable certainty, those skilled in the art about the scope of the invention." *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014). Although this requirement mandates clarity, it does not require absolute precision; the goal is to provide clarity such that a person of ordinary skill in the art could determine whether an accused product infringes the claim. *Geneva Pharms., Inc. v. GlaxoSmithKline PLC*, 349 F.3d 1373, 1384 (Fed. Cir. 2003).

Here, the claims recited terms of degree. Such terms rendered the claims broad, but "a claim is not indefinite just because it is broad." The question is whether the claims "provide objective boundaries for those of skill in the art in the context of the invention." The court considered the intrinsic and extrinsic records and concluded that those objective boundaries had been established:

	claim language	specification	prosecution history	dictionary definition
<i>resilient</i>	outer catheter has "shape memory" (independent claim) and "sufficient stiffness" (dependent claim)	<ul style="list-style-type: none"> "braided design" exemplified materials has "sufficient shape memory to return to its original shape when undistorted" resilience provides for "torque control and stiffness" 	examiner understood this phrase throughout prosecution	"returning to the original form or position after being bent, compressed, or stretched"
<i>pliable</i>		<ul style="list-style-type: none"> "constructed of a more pliable, soft material such as silicone" "has no longitudinal braiding, which makes it extremely flexible and able to conform to various shapes" 	examiner understood this phrase throughout prosecution	"easily bent, flexible; supple"