

CASE LAW UPDATE:

Nautilus, Inc. v Biosig Instruments, Inc.

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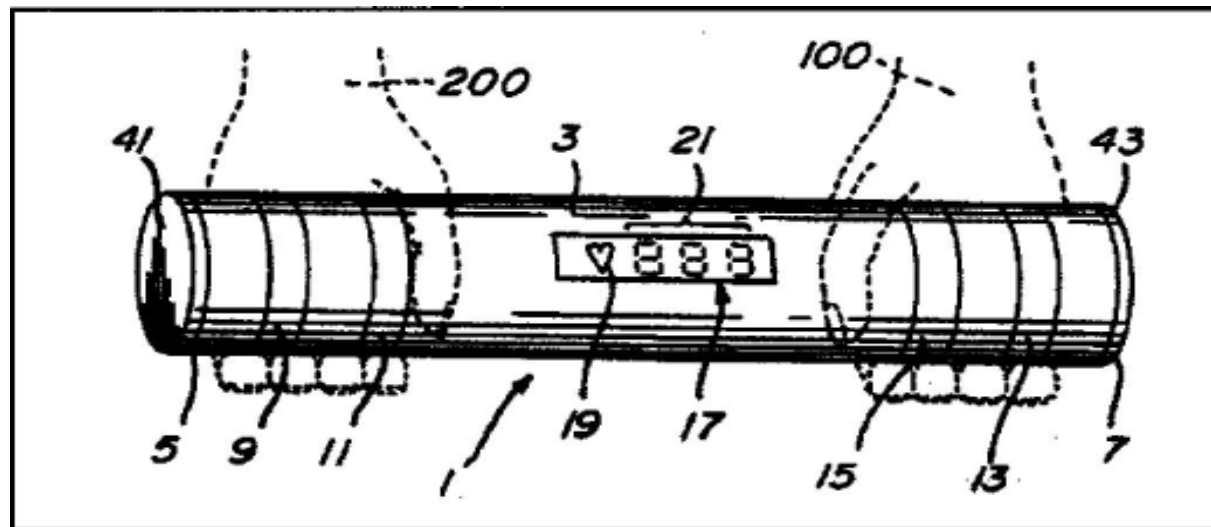
Electronics, Telecom & Software Patent Practice Update

November 6, 2014



Nautilus v. Biosig Instruments - background

- Infringement suit relating to a heart monitor used in exercise equipment, U.S. Patent No. 5,337,753.
- Monitor comprised of cylindrical bar, electronic circuitry and live and common electrodes mounted “**in spaced relationship** with each other.”



Patent No. 5,337,753, Figure 1



***Nautilus. v. Biosig Instruments* – SDNY and CAFC**

- SDNY determined that claim limitation “in spaced relationship” was indefinite under 35 USC § 112, ¶ 2.

- CAFC reversed and remanded the SDNY, concluding that a claim passes § 112, ¶ 2 muster if:
 - it is “amenable to construction” and
 - it is not “insolubly ambiguous.”



***Nautilus v. Biosig Instruments* – 134 S Ct 2120 (2014)**

- Supreme Court (J. Ginsburg) recognized “delicate balance” between
 - the “inherent limitations of language” and
 - the “clear notice” [to public] of what is claimed . . . [and] what is still open to invent.”

- But, rejected CAFC’s formulations as “breed[ing] lower court confusion;” and “ascrib[ing] *some* meaning to a patent’s claims” cannot be sufficient.



***Nautilus v. Biosig Instruments* – 134 S Ct 2120 (2014)**

- New standard: A patent is invalid for indefiniteness if its claims, read in light of the specification and the prosecution history, fail to inform a POSA with “reasonable certainty” about the scope of the invention.
- “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*.”
 - Vacated, CAFC to apply new test on remand.



Federal Circuit § 112 Decisions post-*Nautilus*

- *Nautilus* – briefing and oral argument on remand completed last week. CAFC decision to come.
- *Interval Lic'g v AOL* – no “meaningful boundaries” existed for claim limitation “in an unobtrusive manner”; need “objective boundaries.”
 - “terms of degree are not inherently indefinite.”
- *Augme Techs v Yahoo!* – limitation at issue met the new standard.



District Court § 112 Decisions post-*Nautilus*

- About 70 district court cases considered indefiniteness *post-Nautilus*.
 - roughly 25% found claim term(s) indefinite.
- District Courts are relying on various extrinsic sources to determine “reasonable certainty” of claim scope: experts; dictionaries and other treatises; and considering objective criteria of claim terms.



Post-*Nautilus* Practical Considerations

- Indefiniteness is issue of law and burden of proof is clear and convincing evidence.
 - court considers subsidiary facts.
- Expert involvement – what would POSA understand at time of patent application – considering claims, read in light of spec and prosecution history?



Post-*Nautilus* Practical Considerations, *cont'd*

- Timing of determining indefiniteness relative to claim construction.
- Differing standards between PTO and District Court:
 - “words or phrases whose meaning is unclear” vs “reasonable certainty.”
- Means plus function claims (§ 112(f)) must have recited structure.
- How much ambiguity in a claim is acceptable?
 - absolute precision is unattainable.



Questions?



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