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IP: Supreme Court to redefine patent law's definiteness standard

A patent is not addressed to lawyers, judges, or even the public generally, but to those experienced in the sciences of the invention. And, in the language of the sciences, any description that is sufficient to apprise those so experienced of the definite features of the invention, and to serve as a warning to others of what the patent's claims cover, is sufficiently definite to sustain the patent. The Supreme Court said so over 100 years ago. But recently, those accused of infringing a patent are more frequently defending their actions by relying on the patent law statute requiring that patent claims be "definite" and pleading that the patent does not properly define the bounds of what actions constitute infringement. There may be instances where the defense has merit if only because the issue of infringement turns on the clarity of those bounds. But where that is arguably not the case, the defense is often colored with hyperbole about the poor quality of the Patent Office's examination of the application and the Federal Circuit's omniscient comprehension of the issued patent's scope. It's no surprise, therefore, that the Supreme Court will soon attempt to *redefine* "definiteness" in *Nautilus v. Biosig*.

The *Nautilus* dispute has a long history dating to 2004, when Biosig sued Nautilus for patent infringement. In turn, Nautilus twice successfully requested the Patent Office to reexamine Biosig's patent. The original lawsuit was dismissed to permit the Patent Office's reexaminations. Eventually, the Patent Office confirmed the propriety of Biosig's patent. Accordingly, Biosig sued again. Following the district court's *Markman* decision construing the asserted patent claims, Nautilus again requested the Patent Office to reexamine the patent. But the Patent Office denied that request because Nautilus raised no question of patentability the Office had not already considered. Against that history, the district judge summarily concluded the term "spaced relationship" (among two electrodes on the claimed heart rate monitor) had *no* meaning to him or anyone. The summary judgment is shocking if only because the Patent Office – on *four* separate occasions – did not contend that the patent claims were indefinite for reciting that term. The Federal Circuit reversed, recognizing the record evidence established that ordinarily-skilled scientists could readily understand the bounds of the "spaced relationship" through

conventional tests using standard equipment in existence long before the patent.

Often coloring the indefiniteness issue is the complaint that a patent claim incomprehensible to the public must be invalid. Statements in court decisions sympathetic to this complaint are dicta if not regrettable. Claim definiteness is properly considered only from the standpoint of a person having ordinary skill in the science of the invention and, accordingly, a patent need not describe fundamental principles of that science. Among a jury, a judge, and a patent examiner, often only the latter is readily capable of satisfactorily considering this legal concept based on a patent's intrinsic record and without the aid of expert testimony. And based on a presumably-efficient market of having people competent in the science prepare and prosecute the patent, those people – patent attorneys – are satisfactorily positioned to write a patent that complies with the Patent Act's requirement for clear and definite claims. Accordingly, it is wrong to complain that the *ills* of the patent system arise from patent claims whose scope cannot be readily envisaged by people

unskilled in the science of the invention.

In its 2002 *Festo* decision, the Supreme Court acknowledged that the “nature of language makes it impossible to capture the essence of a thing in a patent application.” The (litigation) expense in determining claim scope is one component of the resources needed to educate those lacking the ordinary skill to properly decide validity and infringement. Even the Supreme Court has acknowledged that conservation of judicial resources, however, is not of paramount concern in interpreting the scope of a patent claim because the scope “is not limited to its literal terms but instead embraces all equivalents to the claims described.” Thus, the Court itself has foreclosed any argument that patent claims must precisely mark the boundaries of the invention. And, in *Nautilus*, the Federal Circuit reiterated that a claim is sufficiently clear to avoid invalidity on indefiniteness grounds if “the meaning of the claim is discernible, even though the [discerning] task may be formidable and the conclusion may be one over which reasonable persons will disagree.”

As with any other legal document, patents and the terms used in them

must be interpreted. But they are not invalid for indefiniteness simply because a competitor can concoct reasonable conflicting interpretations. We don’t forfeit the entirety of our real property rights to our neighbors simply because a fence defining its boundaries was arguably an inch off the correct mark. And, in such instances, the law has no sympathy for the trespassing neighbor squatting in the middle of that property. But accused patent infringers often plead for that sympathy, arguing that ambiguities permitted at the boundaries will encourage the pursuit of ambiguous patents. Not only is the plea absurd, but so too is the argument. Patent owners no more seek to *litigate* to enforce their patent rights than accused infringers choose to mount a litigation defense – the expenses and uncertainties drain the resources of both.

Courts have repeatedly counseled businesses to read patents from the vantage point of a person having ordinary skill in the science of the invention. Ostensibly, if not always actually, that is how the Patent Office examines patent applications. And, not surprisingly, that is how millions of applications have been drafted. Thus, a business concerned about its competitor’s

patent can easily undertake this reading by engaging an objective, yet ordinarily-skilled scientist, or it can stick its head in the sand and wait to litigate the issue to the same inevitable (but now more-costly) conclusion. Here, *Nautilus* never submitted test results, expert or fact witness testimony, or any other evidence from an ordinarily-skilled scientist that the patent was indefinite, yet received a favorable summary judgment that was reversed on appeal. No matter, with hyperbole in hand, the Supreme Court is poised, yet again, to decide an issue hardly requiring its review and one that Congress did not even consider in its recent wholesale revisions to the patent laws.

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