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The Scope of Definiteness Required in Patent Claims after *Nautilus v. Biosig*

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In today's decision, the U.S. Supreme Court in *Nautilus, Inc. v. Biosig Instruments, Inc.* clarified the scope of definiteness required to fulfill the requirement that the patent claims particularly point out and distinctly claim the subject matter which the applicant regards as the invention. In *Nautilus*, the U.S. Supreme Court unanimously rejected the "insolubly ambiguous" standard previously set out by the Federal Circuit:

It 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*. To tolerate imprecision just short of that rendering a claim "insolubly ambiguous" would diminish the definiteness requirement's public-notice function and foster the innovation-discouraging "zone of uncertainty," against which this Court has warned.

No. 13-369, slip op. at 12 (June 2, 2014) (Citation omitted).

Instead, the Supreme Court held that the standard for indefiniteness requires "reasonable certainty," stating that "a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention." *Id.* at 1.

In describing this standard, the Court noted that "a patent must be precise enough to afford clear notice of what is claimed, thereby apprising the public of what is still open to them." *Id.* at 10 (Citations and quotations omitted). The Court acknowledged the opposing considerations, stating that "[t]he definiteness requirement, so understood, mandates clarity, while recognizing that absolute precision is unattainable." *Id.* at 11. The Court viewed its holding as achieving the correct balance between these considerations.

The Court briefly addressed the shifting nature of the claims over time and discussed the facts of the case. However, the primary focus was on the standard to be imposed and, indeed, the Court remanded the definiteness decision to the Federal Circuit to make the determination under the facts of the case.

This is yet another instance of the Supreme Court riding herd on the Federal Circuit, and defining limits on the scope of patent protection. Note that in this instance the Supreme Court also overrode the views of the Solicitor General, who had argued in favor of maintaining the Federal Circuit's standard by seeking to "require only that the patent provide reasonable notice of the scope of the claimed invention."

No. 13–369. Argued April 28, 2014—Decided June 2, 2014

The opinion can be found at http://www.supremecourt.gov/opinions/13pdf/13-369_k53m.pdf.

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