

ARTICLES

June 26, 2014

NAUTILUS: NEW TEST, SAME APPLICATION?

In anticipation of *Nautilus v. Biosig*, many expected that the Supreme Court would relax the Federal Circuit's so-called "insolubly ambiguous" test for determining definiteness under **35 U.S.C. § 112, ¶ 2**. Under the Federal Circuit's test, patents had been notoriously difficult to invalidate under indefiniteness – even if the patent had ambiguous claims. The Supreme Court in *Nautilus* ultimately crafted a new definiteness test in place of the "insolubly ambiguous" test, which will likely make it easier to invalidate patents under indefiniteness. However, a closer look at the decision and oral argument shows that the Supreme Court's decision may have only relabeled the test while maintaining the application of the Federal Circuit's test.

At issue in *Nautilus* was which test should be used in determining definiteness under § 112, ¶ 2. While Biosig supported upholding the Federal Circuit's test that a claim is indefinite only when it is "not amenable to construction" or "insolubly ambiguous," Nautilus and the U.S. Patent & Trademark Office (PTO) proposed replacing the Federal Circuit's test with alternative tests. Nautilus argued that a claim is indefinite when it is ambiguous such that readers could reasonably interpret the scope of the claim differently. On the other hand, **the PTO argued** that a claim is indefinite when a person skilled in the relevant art would not reasonably understand what is claimed.

In attempting to adopt a definiteness test, the Justices at the oral hearing grappled with how much ambiguity is tolerated under § 112. The "insolubly ambiguous" test had a bright line of tolerated ambiguity: if the claims after construction were *insolubly* ambiguous. Nautilus's test sought to lower the standard of tolerated ambiguity: whether readers could reasonably interpret the scope of the claim differently. The PTO's test included analysis for determining improperly ambiguous claims: whether there was no front-runner construction substantially better than another construction.

In evaluating these different solutions to the amount of tolerated ambiguity, the Supreme Court did not appear to appreciate many differences between the Federal Circuit's test and the alternative proposed tests proposed by Nautilus and the PTO. Instead, the Supreme Court emphasized the common ground between the tests, that: 1) definiteness be evaluated from the perspective of one skilled in the art 2) at the time the patent application was filed, and 3) that the claims be read in light of the specification and prosecution history. In light of the Supreme Court's perceived agreement among the parties, there did not appear to be a need for the Supreme Court to deviate too far from the status quo in the first place.

To focus on the essential inquiry of definiteness, the Supreme Court replaced the "insolubly ambiguous" test with a new definiteness test that requires that those skilled in the art understand the scope of the claim with reasonable certainty in light of the specification and prosecution history. The new test acknowledges that absolute precision is unattainable under the definiteness requirement, but explains that all that is required is reasonable certainty.

However, this new test does not appear to be different from the Federal Circuit's application of its "insolubly ambiguous" test. That is, the Supreme Court acknowledged that in practice the Federal Circuit's test had been "shorthand" for a more thorough analysis. This more thorough analysis included determining whether reasonable efforts at claim construction resulted in a definition that does not provide sufficient particularity and clarity to inform skilled artisans of the bounds of the claim. In other words, the Federal Circuit's test looked at how those skilled would understand the scope of the claim in light of the specification and prosecution history (being determined by traditional claim construction tools). Thus, the Supreme Court's new test appears to include the same elements as the Federal Circuit test in practice.

At the oral argument, several justices of the unanimous panel saw no need to disrupt the Federal Circuit's application of the "insolubly ambiguous" test. For example, Chief Justice Roberts seemed unpersuaded by Nautilus's pleas to vacate the Federal Circuit's standard. "I don't see much

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disagreement among *any of you* about the standard or what's wrong with the Federal Circuit's articulation," **he stated** (emphasis added). In response to the PTO's proposed test, Chief Justice Roberts wondered whether the Federal Circuit's test had already been following the Patent Office's proposed test all along.

Hence, the Supreme Court's "new definiteness test" appears merely to replace the shorthand terms "insolubly ambiguous" and "amenable to construction" with the explicit analytical steps for which those terms stand. This new test was made to guide courts in correctly and uniformly applying the essential definiteness inquiry. The Supreme Court's new test in determining definiteness may not dramatically change the actual application of the indefiniteness analysis, at least at the Federal Circuit. That being said, time will tell how the new test will be developed.