

*Nautilus, Inc. v. Biosig Instr's, Inc.*, No. 13-369, June 2, 2014

The U.S. Supreme Court set aside the Federal Circuit's "insolubly ambiguous" standard for definiteness of a claim under 35 U.S.C. § 112, concluding that "the Federal Circuit's formulation, which tolerates some ambiguous claims but not others, does not satisfy the statute's definiteness requirement."

In its place, the Court held 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." This "reasonable certainty" requirement "mandates clarity, while recognizing that absolute precision is unattainable."

The question the Court tried to answer was how much imprecision § 112 tolerates. In trying to find a "delicate balance" for § 112, the Court recognized that "[s]ome modicum of uncertainty ... is the price of ensuring the appropriate incentives for innovation." However, "[a]t the same time, 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." Without enough precision, "there would be a zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims." The Court noted that a problem faced by the public is that "patent applicants face powerful incentives to inject ambiguities into their claims," and that "[e]liminating that temptation is in order."

The Court recognized that while the Federal Circuit's fuller explanation of "insolubly ambiguous" more closely follows the gist of statute, the expressions "insolubly ambiguous" and "amenable to construction" pervades recent decisions by the Federal Circuit concerning § 112, ¶2's requirement. "[S]uch terminology can leave courts and the patent bar at sea without a reliable compass."

The Court declined to apply its announced standard to the case at hand, instead vacating and remanding the case back to the Federal Circuit for reconsideration.