

## PATENT WATCH

### Supreme Court reins in ambiguous patents

Patents that contain ambiguous or indefinite claims could now face a tougher time in court, thanks to a recent ruling by the US Supreme Court.

Under US patent law, the claims of a patent must “particularly point out” and “distinctly claim” the invention, otherwise they can be held invalid by a court owing to indefiniteness. For many years, the US appeals court that decides patent disputes (the Court of Appeals for the Federal Circuit) had applied a standard, which held that a claim was only invalid for indefiniteness if it was “insolubly ambiguous” or “not amenable to construction”. In other words, a claim was valid provided some meaning could be gleaned from the language in the claim. “Conventional wisdom had come to accept that this was a very low threshold, and that the vast majority of patent claims could satisfy this standard,” says Chris Mammen, a partner at Hogan Lovells, San Francisco, California, USA.

But now, in hearing a patent dispute, the Supreme Court has weighed in on the issue and held that this standard is too lax.

The case centred on a patent owned by Biosig Instruments (US 5337753) that claimed a heart-rate monitor that was designed to be used with exercise equipment. A key claim in the patent described electrodes of the monitor that were “in spaced relationship with each other”. Competitor Nautilus argued that this claim was indefinite; it was too imprecise to particularly point out and distinctly claim the invention, as required by US patent law, because a skilled person would not know how to configure the electrodes in order to use the equipment correctly.

So the Supreme Court had to decide how much imprecision can be tolerated by the indefiniteness statute of US patent law. It noted that there is a “delicate balance” between the need for clarity and precision to let people know what is claimed, and the inherent limitations of language that will be

used in the claims. The Court rejected the standard used by the lower court, which in its view tolerated some ambiguous claims but not others, because it did not satisfy the statute’s definiteness requirement. Indeed, the Court noted that the “insolubly ambiguous” indefinite standard could “leave courts and the patent bar at sea without a reliable compass”.

However, the Court did not decide whether the specific term in the Biosig patent was indefinite; that dispute was sent back to the lower court to decide in light of this new legal standard. But the ruling of the Supreme Court could have broad implications. “Any patent claim, regardless of the technology sector, that fails to adequately communicate its boundaries is now susceptible to increased scrutiny — and potential invalidation — under this new test, says Mammen. “This ruling is expected to produce an increase in indefiniteness challenges to patent claims,” he highlights.

**Nautilus versus Biosig:** [http://www.supremecourt.gov/opinions/13pdf/13-369\\_1idf.pdf](http://www.supremecourt.gov/opinions/13pdf/13-369_1idf.pdf)

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