

## Supreme Court Decides *Nautilus v. BioSig* and Unanimously Eliminates Federal Circuit’s “Insolubly Ambiguous” Standard for Indefiniteness

On June 2, 2014, the Supreme Court in *Nautilus, Inc. v. BioSig Instruments, Inc.*, No. 13-369, ruled 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.” In doing so, the Supreme Court rejected the Federal Circuit’s standard that a patent claim satisfies 35 U.S.C. § 112, ¶ 2, if it is “amenable to construction” and, once construed, found not to be “insolubly ambiguous.”

BioSig Instruments, Inc. (“BioSig”) manufactures and sells fitness electronics, and is the assignee of the asserted patent, U.S. Patent No. 5,337,753, which generally concerns heart rate monitors used in connection with exercise equipment. Nautilus, Inc. (“Nautilus”) manufactures and sells exercise equipment. This dispute arose when BioSig allegedly disclosed the patented technology to Nautilus’s predecessor company, StairMaster Sports Medical Products, Inc. (“StairMaster”). During negotiations, StairMaster purportedly began using BioSig’s patented heart rate monitor technology in its equipment without permission, thereby prompting BioSig’s patent infringement suit against Nautilus in 2004.

During a *Markman* hearing, the district court construed the term “in spaced relationship with each other” to mean “there is a defined relationship between the live electrode and the common electrode on one side of the cylindrical bar and the same or a different defined relationship between the live electrode and the common electrode on the other side of the cylindrical bar,” but did not refer to the width of the electrode as Biosig had during reexamination. Subsequently, the district court granted Nautilus’s motion for summary judgment of invalidity for indefiniteness. The district court found that the words “spaced relationship did not tell [the court] or anyone what precisely the space should be” or provide “any parameters” to define the spacing. *BioSig Instruments, Inc. v. Nautilus, Inc.*, 715 F.3d 891, 899 (Fed. Cir. 2013) (citation and internal quotation omitted).

On appeal, the Federal Circuit reversed, finding the claims not invalid for indefiniteness. *Id.* at 893. The majority opined that intrinsic evidence indicated the boundaries of the term, since the distance between the heart rate monitor’s electrodes had to be less than the width of a user’s hands, but also not infinitesimally small because the electrodes needed to remain separate so there are two detection points. *Id.* at 898-903. Moreover, the majority concluded that a skilled artisan would be able to conduct a test to determine what constitutes a “spaced relationship” in connection with the recited function of substantial removal of electromyogram signals. *Id.* Concurring Judge Schall wrote that “spaced relationship” means any “fixed spatial relationship” between the electrodes. *Id.* at 905.

The Supreme Court overruled the Federal Circuit, unanimously eliminating the Federal Circuit’s test that “a patent claim passes the §112, ¶2 threshold so long as the claim is ‘amenable to construction,’ and the claim, as construed, is not ‘insolubly ambiguous.’” *Nautilus, Inc.*, No. 13-369, slip. op. at 1 (citation omitted). The Court stated, “Section 112 ... entails a ‘delicate balance’” between the “inherent limitations of language” and the precision necessary “to afford clear notice of what is claimed.” *Id.* at 9-10. “[R]econcil[ing] [those] concerns that tug in opposite directions,” the Court interpreted Section 112, ¶ 2, “to require that a patent’s claims, viewed in the light of the specification and prosecution history, inform those skilled in the art about

the scope of the invention with reasonable certainty.” *Id.* at 11. This standard, the Court stated, “mandates clarity, while recognizing that absolute precision is unattainable” and “accords with opinions of this Court stating that ‘the certainty which the law requires in patents is not greater than is reasonable, having regard to their subject-matter.’” *Id.* (citation omitted). The Court did not opine on the validity of the ’753 patent, and remanded the issue to the Federal Circuit for reconsideration under this new standard. *Id.* at 14.

To find out how the Supreme decision in *Nautilus* affects your interest, please contact your usual Ropes & Gray attorney or one of the Ropes & Gray attorneys listed below.

[Gene W. Lee](#)

[Adrienne Proverb Hale](#)

[Diana Santos](#)