

PRESENTED AT
20th ANNUAL
ADVANCED PATENT LAW INSTITUTE

November 5–6, 2015
Austin, Texas

Definiteness and Induced Infringement

Kevin S. Kudlac
Rene A. Treviño

Kevin S. Kudlac
Greenberg Traurig, LLP
300 West Sixth Street, Suite 2050
Austin, Texas 78701

KudlacK@gtlaw.com
(512) 320-7200

Rene A. Treviño
Greenberg Traurig, LLP
1000 Louisiana Street, Suite 1700
Houston, Texas 77002

TrevinoR@gtlaw.com
(713) 374-3500

Definiteness and Induced Infringement

By Kevin Kudlac and Rene Treviño

Over the past few years, the Supreme Court has been active in the area of patent law, specifically in the areas of definiteness and induced infringement. This article discusses the Supreme Court's recent decisions in *Nautilus, Inc. v. Biosig Instruments, Inc.*; *Commil USA v. Cisco Systems*; and the Federal Circuit's *en banc* decision in *Akamai Techs. v. Limelight Networks*.

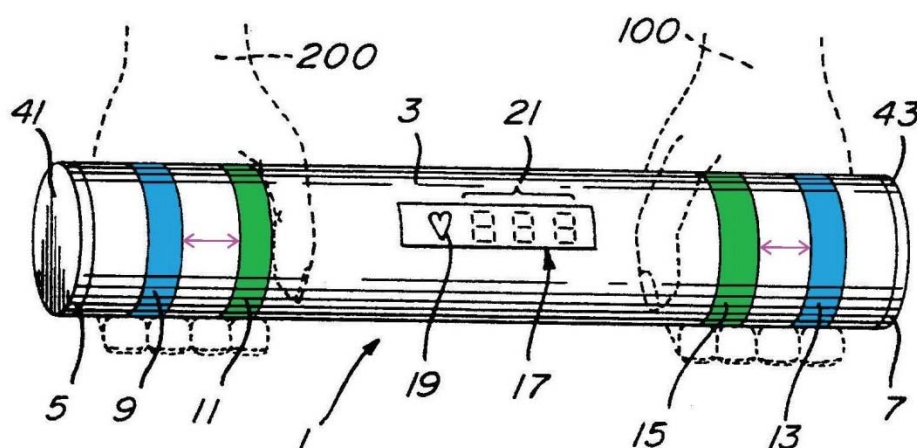
I. DEFINITENESS

The patent system is meant to foster inventions and spread knowledge. With this goal in mind, the patent laws require a patent's claim to be described clearly. The term for such clarity is "definiteness," which is codified in 35 U.S.C. § 112(b). The purpose for requiring a claim to be definite is clear: to give the public notice of what is and is not within the boundaries of the patent's claims and to clearly describe the invention for, among other things, improvement by others. For over a century, the United States Supreme Court has stressed the importance of public knowledge of a patent's scope. For example, in *Merrill v. Yeomans*, the Supreme Court stated that the "public should not be deprived of rights ... without being clearly told what it is that limits these rights." 94 U.S. 868, 573 (1876). The Supreme Court further held that "making improvements in existing patents ... should not be restrained by vague and indefinite descriptions of claims" *Id.* (emphasis added). In *White v. Dunbar*, decided in 1886, the Supreme Court gave one of its most memorable statements regarding definiteness, stating that a patent claim is not "a nose of wax, which may be turned and twisted in any direction." 119 U.S. 47, 51-52 (1886). Early in the twentieth century, the Supreme Court reiterated the need for patent clarity to best serve the public interest. See *General Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938) (patent limits "must be known for the protection of the patentees, the encouragement of the inventive genius of others"); see also *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 232 (1942) (definiteness "seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights.").

According to recent precedent of the United States Court of Appeals for the Federal Circuit a patent claim was definite so long as the claim was "amenable to construction," and the claim, as construed, was not "insolubly ambiguous." The Supreme Court, however, in *Nautilus, Inc. v. Biosig Instruments, Inc.*, disagreed with the Federal Circuit's standard for determining when a claim is indefinite. 134 S. Ct. 2120, 2129 (2014). The Supreme Court articulated a new standard that requires claims to inform those skilled in the art about the scope of the invention with "reasonable certainty." *Id.*

A. *Nautilus* – the Lower Courts

In *Nautilus*, the district court was presented with a patent that utilized metal electrodes for measuring heart rates, such as the ones commonly found on treadmills. The electrodes, when grasped by a person's hand, complete a circuit to measure the person's heart rate.



The patent's claims specified that the electrodes are placed in a "spaced relationship with each other." The district court granted summary judgment on the ground that the term "spaced relationship" was indefinite, finding that the term "did not tell [the district court] or anyone what precisely the space would be," or "even supply 'any parameters' for determining the appropriate spacing." The Federal Circuit reversed and remanded the case based on the reasoning that a claim is indefinite "only when it is not amenable to construction or insolubly ambiguous." *Nautilus, Inc. v. BioSig Instruments, Inc.*, 715 F.3d 891, 898 (Fed. Cir. 2013) (citations omitted). The Federal Circuit, in light of the intrinsic evidence, concluded that the claim contained "certain inherent parameters of the claimed apparatus, which to a skilled artisan may be sufficient to understand the metes and bounds of 'spaced relationship.'" *Id.* at 899. Interestingly, however, the Federal Circuit stated that even when the task of construction "may be formidable and the conclusion may be one over which reasonable persons will disagree," the claim may still be definite. As expected, the ruling was appealed to the Supreme Court.

B. The Supreme Court Rejected the Insolubly Ambiguous Standard

The Supreme Court, unanimously, held that the Federal Circuit's test for indefiniteness did not satisfy the precision that § 112 requires. *Nautilus*, 134 S. Ct. at 2129. Rather, the Court read § 112(b) "to require that a patent's claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty." *Id.* (emphasis added). Definiteness is to be evaluated from the perspective of someone skilled in the art, in light of the

Find the full text of this and thousands of other resources from leading experts in dozens of legal practice areas in the [UT Law CLE eLibrary \(utcle.org/elibrary\)](http://utcle.org/elibrary)

Title search: Definiteness and Induced Infringement

Also available as part of the eCourse

[Patent Litigation: Recent Developments](#)

First appeared as part of the conference materials for the
20th Annual Advanced Patent Law Institute session

"Definiteness and Induced Infringement"