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New Supreme Court Ruling Kills Vague Patents

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On June 2, 2014, the United States Supreme Court made it more difficult for plaintiffs with poorly written or vague patents to win patent infringement suits. This is a victory for defendants faced with the challenge and litigation costs of defending patent infringement suits. Because defendants have a stronger hand defending patent infringement suits, innovative companies must take more care in drafting their patents.

In *Nautilus, Inc. v. Biosig Instruments, Inc.* (*Nautilus*), the Supreme Court expanded the ability of district courts to invalidate patents for being unclear or vague. The Supreme Court replaced the previous "insolubly ambiguous" standard with a new standard. The *Nautilus* decision held that a patent is invalid for indefiniteness if the claims, read in light of the description and the prosecution history, fail to inform those skilled in the art with reasonable certainty about the scope of the invention. The U.S. Patent and Trademark Office (USPTO) is adopting this standard as part of the examination process. Therefore, we should see an increase in the rejection of claims in pending patent applications due to indefiniteness.

What is a Vague Patent?

A vague patent is one that includes claims that are unclear to a person working in the technology of the claimed invention. The claims of a patent define the invention. Therefore, the claims must be clear enough to allow a person skilled in the same field of technology as the patent to determine what the language of the claims mean. Courts generally look to the specification and the drawings of a patent as well as its prosecution history to determine whether the claims are sufficiently clear. The requirement that claims must be clear or definite is articulated in 35 U.S.C. § 112(b), which states that "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

The claim at issue in *Nautilus* was directed to an invention that measures a user's heart rate on exercise equipment. The invention included a pair of electrodes (sensors) placed on a handlebar of exercise equipment (such as a treadmill). The sensors were to be placed such that each of the sensors was in contact with a portion of the user's hand when using the equipment. In describing the spacing of the sensors, the patent claim used the terminology "spaced relationship." The Court of Appeals (Federal Circuit) held that those words were not vague. The Court inferred from the patent that the spacing of the sensors was at most the distance from one end of a user's hand to the other. Using this inference, the Court decided that the "spaced relationship" language was clear or definite enough for those persons skilled in the field of designing heart-monitoring sensors to understand the meaning of this term.

The Supreme Court did not agree. In a unanimous decision, the Supreme Court overturned the "insolubly ambiguous" standard previously used by the Federal Circuit. The Supreme Court reasoned that use of this lower standard allowed patents to be granted containing claims a knowledgeable person in the art could not understand to determine the scope of the invention. The Supreme Court reasoned that vague patents discourage innovation by creating anxiety in designers and developers that their products would infringe vaguely defined patents interpreted in an overly broad manner.

The Supreme Court introduced a new higher standard for indefiniteness to remedy this perceived problem. After *Nautilus*, a patent is invalid if it fails to inform, with reasonable certainty, those skilled in the art about the scope of the invention. It will take some time to understand how district courts are going to apply this new indefiniteness standard. However, we are fairly certain that district court judges will require better written and clearer patent claims with more detailed support in the specification. For example, if the specification of the patent at issue in *Nautilus* had defined an optimal spacing distance, a range of optimal spacing distances or even a method for determining the optimal spacing distance, then the claim limitation "spaced relationship" probably would not have been considered too vague. If a specification fails to provide any guidance as to the scope of a claimed feature, a district court may likely find that the specification, drawings and claims do not inform, with reasonable certainty, one skilled in the art about the scope of the claimed feature and hold that the patent is invalid.

What Does This Case Mean for Your Business?

The ruling in the *Nautilus* case should prompt a review of your patent portfolio to make sure your patents are not vague and unclear. If you think you have some vague patents, you may want to institute a reexamination proceeding on the patent at issue in order to correct or clarify the patent. We recommend that you take action quickly if you determine that you have a vague patent; time limits do exist for instituting certain types of proceedings.

Alternatively, if any continuation applications exist or can still be filed, you may

want to rewrite the claims or draft new claims in the continuation application to better define the scope of the invention. Other strategies can also be implemented to protect your patents and minimize the risk of having your patents ruled invalid.

How Do You Minimize Your Risk of Producing Vague Patents?

To reduce the risk of producing vague patents, companies should consider having a skilled patent attorney perform a thorough review of all of your patents and patent applications to ensure that the claim language is clear and supported by the specification. If the patent attorney determines that a potential problem may exist, several procedures may be available to correct the unclear patent application or granted patent.

For a patent application, amendments to the claims and/or the specification are available to clarify the scope of the patent application. This is a fairly easy solution to remedy an indefinite claim feature. For example, if alternate clearer terminology is present in specification, the claims can be amended to clarify and better define the scope of the claims.

For a granted patent, the process is more complicated and expensive. One way to correct the language in a granted patent is to start a reissue proceeding. A risk of a reissue proceeding is that the original granted patent must be surrendered and a new examination process started. If filed within two (2) years, the reissue proceeding may allow the claims to be broadened, resulting in claims that are broader and clearer.

If the original application or patent is not properly written or detailed enough to produce a clearly drafted claim, a continuation-in-part application (CIP) may be an option. A CIP allows for the addition of information not contained in the original pending application. The CIP can add sufficient detail to the specification to explain or describe the previously submitted indefinite claim language. One drawback of filing a CIP is that the priority date of the claims including the additional information will be the filing date of the CIP, not the filing date of the original pending application. However, the priority date of the claims that do not include the additional information will maintain the filing date of the original pending application.

Conclusion

The higher standard for indefiniteness articulated in *Nautilus* will significantly impact both pending patent applications and granted patents. Moving forward, it is very important to ensure that pending patent applications and granted patents are well drafted so that the claims are sufficiently clear and all the claim elements have sufficient support in the specification.

If you are responsible for the patent portfolio at your company, you should ensure that your company's patents are drafted with claims that are clear enough to avoid being deemed indefinite. In patent litigation, both plaintiff's and defendant's counsel should carefully study the patent at issue and determine whether the claims of the patent are vague or unclear to better advise their respective clients.

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