

ALERT

## Federal Circuit Patent Bulletin: *Biosig Instruments, Inc. v. Nautilus, Inc.*

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April 27, 2015

*"The [U.S. Supreme Court] modified the standard by which lower courts examine allegedly ambiguous claims; we may now steer by the bright star of 'reasonable certainty,' rather than the unreliable compass of 'insoluble ambiguity.'"*

On April 27, 2015, in *Biosig Instruments, Inc. v. Nautilus, Inc.*, the U.S. Court of Appeals for the Federal Circuit (Newman, Schall, Wallach\*), on remand from the Supreme Court of the United States, again reversed and remanded the district court's summary judgment that U.S. Patent No. 5,337,753, which related to a heart rate monitor associated with an exercise apparatus and/or exercise procedures, was invalid for indefiniteness. The Federal Circuit stated:

A patent must "conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as [the] invention." A claim is invalid for indefiniteness if its language, when read in light of the specification and the prosecution history, "fail[s] to inform, with reasonable certainty, those skilled in the art about the scope of the invention." We review the district court's indefiniteness determination de novo. A patent is presumed valid under 35 U.S.C. § 282 and, "consistent with that principle, a [fact finder is] instructed to evaluate . . . whether an invalidity defense has been proved by clear and convincing evidence."

"In the face of an allegation of indefiniteness, general principles of claim construction apply." "In that regard, claim construction involves consideration of primarily the intrinsic evidence, viz., the claim language, the specification, and the prosecution history." Though the ultimate construction of a claim term is a legal question reviewed de novo, underlying factual determinations made by the district court based on extrinsic evidence are reviewed for clear error. In contrast, "when the district court reviews only evidence intrinsic to the patent (the patent claims and specifications, along with the patent's prosecution history), the judge's determination will amount solely to a determination of law, and the Court of Appeals will review that construction de novo."

When a "word of degree" is used, the court must determine whether the patent provides "some standard for measuring that degree." [W]e do not hold today, that terms of degree are inherently indefinite. Claim language employing terms of degree has long been found definite where it provided enough certainty to one of skill in the art when read in the context of the invention." Moreover, when a claim limitation is defined in "purely functional terms," a determination of whether the limitation is sufficiently definite is "highly dependent on context (e.g., the disclosure in the specification and the knowledge of a person of ordinary skill in the relevant art area)." . . .

On remand from the Supreme Court, the sole issue presented to this court is whether the district court erred in holding the '753 patent invalid for indefiniteness. In particular, the district court held that "spaced relationship" as recited in claim 1, and referring to the spacing between the common and live electrodes, was not distinctly pointed out and particularly claimed in the patent in violation of 35 U.S.C. § 112, ¶ 2. . . .

Reasonableness is the core of much of the common law, and "reasonable certainty" has been defined in broad spectra of the law. The Supreme Court has articulated a spectrum for interpretation of the phrase "reasonable certainty." [W]e conclude that Biosig's claims inform those skilled in the art with reasonable certainty about the scope of the invention. "The degree of precision necessary for adequate claims is a function of the nature of the subject matter." On certiorari, the Supreme Court "express[ed] no opinion on the validity of the patent-in-suit" but rather instructed this court "to decide the case employing the standard we have prescribed." . . .

Our prior analysis primarily relied on intrinsic evidence and we found the "extrinsic evidence underscores the intrinsic evidence." We revisit the intrinsic evidence here to make clear that a skilled artisan would understand with reasonable certainty the scope of the invention. In relevant part, we noted an ordinarily skilled artisan would be able to determine this language requires the spaced relationship to be neither infinitesimally small nor greater than the width of a user's hands. . . .

The prosecution history further illustrates that the term is not indefinite. [T]he function of substantially removing EMG signals that necessarily follows from the previously-recited structure consisting of the elongate member, the live electrode, and the common electrode [according to] the PTO examiner [was] "crucial" as a reason for overcoming the cited prior art and confirming the patentability of the asserted claims upon reexamination. Thus, the recitation of this function in claim 1 is highly relevant to ascertaining the proper bounds of the "spaced relationship" between the live and common electrodes. Not only is the recitation of this function in claim 1 "highly relevant" to ascertaining the boundaries of the "spaced relationship" between the live and

common electrodes, it shows a skilled artisan could apply a test and determine the "spaced relationship" as pertaining to the function of substantially removing EMG signals. Indeed, the test would have included a standard oscilloscope connected to both the inputs and outputs of the differential amplifier to view the signal wave forms and to measure signal characteristics. With this test, configurations could have been determined by analyzing the differential amplifier input and output signals for detecting EMG and ECG signals and observing the substantial removal of EMG signals from ECG signals while simulating an exercise. . . . [D]uring prosecution, Biosig also presented evidence in the form of a declaration by the inventor, Mr. Gregory Lekhtman. Mr. Lekhtman argued that when "configuring the claimed heart rate monitor, skilled artisans can determine the 'spaced relationship' between live and common electrodes by calculating the point in which EMG signals are substantially removed." . . .

In this case, a skilled artisan would understand the inherent parameters of the invention as provided in the intrinsic evidence. The term "spaced relationship" does not run afoul of "the innovation-discouraging 'zone of uncertainty' against which [the Supreme Court] has warned," and to the contrary, informs a skilled artisan with reasonable certainty of the scope of the claim. We conclude the "spaced relationship" phrase "inform[s] those skilled in the art about the scope of the invention with reasonable certainty." The claims that include that phrase comply with Section 112 ¶2.