

No. 13-369

IN THE
Supreme Court of the United States

NAUTILUS, INC.,

Petitioner,

v.

BIOSIG INSTRUMENTS, INC.,

Respondent.

**On Writ of Certiorari to the United States
Court of Appeals for the Federal Circuit**

**BRIEF OF THE INTELLECTUAL PROPERTY LAW
ASSOCIATION OF CHICAGO AS AMICUS CURIAE
IN SUPPORT OF NEITHER PARTY**

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TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES	II
INTEREST OF AMICUS CURIAE	1
SUMMARY OF THE ARGUMENT	2
I. ARGUMENT	6
A. THE PATENT STATUTE CALLS FOR CLARITY	6
B. THE SUPREME COURT ALSO DEMANDS CLARITY.....	9
C. THE RECENT FEDERAL CIRCUIT VIEW RUNS COUNTER TO THE CLARITY DEMANDED BY THE PATENT STATUTE AND THIS COURT	13
D. A SINGLE STANDARD IS REQUIRED TO ENABLE A CONSCIENTIOUS PATENT LAWYER TO DETERMINE INDEFINITENESS	16
E. THE FEDERAL CIRCUIT HAS INCONSISTENTLY ARTICULATED WHETHER INDEFINITENESS DETERMINATIONS UNDER 35 U.S.C. § 112, ¶ 2, ARE WHOLLY A QUESTION OF LAW OR A MIXED QUESTION OF LAW AND FACT	19
CONCLUSION.....	23

TABLE OF AUTHORITIES

Cases

<i>Biosig Instruments, Inc. v. Nautilus, Inc.</i> , 715 F.3d 891 (Fed. Cir. 2013) cert. granted, 134 S. Ct. 896 (2014).....	18
<i>BJ Servs. Co. v. Halliburton Energy Servs., Inc.</i> , 338 F.3d 1368 (Fed. Cir. 2003).....	21
<i>Carnegie Steel Co. v. Cambria Iron Co.</i> , 185 U.S. 403 (1902).....	11
<i>Cybor Corp. v. FAS Techs., Inc.</i> , 138 F.3d 1448 (Fed. Cir. 1998) (<i>en banc</i>)	20
<i>Datamize, LLC v. Plumtree Software, Inc.</i> , 417 F.3d 1342 (Fed. Cir. 2005)	4, 13, 16, 19
<i>Diamond v. Diehr</i> , 450 U.S. 175 (1981).....	17
<i>Dow Chem. Co. v. NOVA Chemicals Corp. (Canada)</i> , 629 F. Supp. 2d 397 (D. Del. 2009).....	21
<i>Energizer Holdings, Inc. v. Int’l Trade Com’n</i> , 435 F.3d 1366 (Fed. Cir. 2006).....	16
<i>Enzo Biochem, Inc. v. Applera Corp.</i> , 599 F.3d 1325 (Fed. Cir. 2010)	16
<i>Enzo Biochem, Inc. v. Applera Corp.</i> , 605 F.3d 1347 (Fed. Cir. 2010)	13, 14, 15, 22, 23
<i>Ernie Ball, Inc. v. Earvana, LLC</i> , 502 Fed. Appx. 971 (Fed. Cir. 2013).....	5
<i>Evans v. Eaton</i> , 20 U.S. (7 Wheat.) 356 (1822).....	7

<i>Ex parte Miyazaki</i> , 89 U.S.P.Q.2d 1207 (Bd. Pat. App. & Interf., Nov. 19, 2008)	15
<i>Exxon Research & Eng'g Co. v. United States</i> , 265 F.3d 1371 (Fed. Cir. 2001)	4, 13, 16
<i>Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.</i> , 535 U.S. 722 (2002)	4, 9, 11, 17, 22
<i>Green Edge Enterprises, LLC v. Rubber Mulch Etc., LLC</i> , 620 F.3d 1287 (Fed. Cir. 2010)	21
<i>Halliburton Energy Servs. Inc. v. M-I LLC</i> , 514 F.3d 1244 (Fed. Cir. 2008)	16
<i>Keystone Bridge Co. v. Phoenix Iron Co.</i> , 95 U.S. 274 (1877)	8
<i>Lighting Ballast Control LLC v. Philips Electronics N. Am. Corp.</i> , No. 2012-1014, 2014 WL 667499 (Fed. Cir. Feb. 21, 2014) (<i>en banc</i>)	5, 19, 20
<i>Markman v. Westview Instruments, Inc.</i> , 517 U.S. 370 (1996)	3, 7, 11
<i>Markman v. Westview Instruments, Inc.</i> , 52 F.3d 967 (Fed. Cir. 1995) (<i>en banc</i>), <i>aff'd</i> , 517 U.S. 370 (1996)	9, 20
<i>Merrill v. Yeomans</i> , 94 U.S. 568 (1876)	4, 7
<i>Microsoft Corp. v. i4i Ltd. P'ship</i> , 131 S. Ct. 2238 (2011)	20
<i>Minerals Separation, Ltd. v. Hyde</i> , 242 U.S. 261 (1916)	10

<i>Morton Int'l, Inc. v. Cardinal Chem. Co.</i> , 5 F.3d 1464 (Fed. Cir. 1993)	6, 18, 24
<i>Motion Picture Patents Co. v. Universal Film Mfg. Co.</i> , 243 U.S. 502 (1917)	6
<i>Noah Systems, Inc. v. Intuit Inc.</i> , 675 F.3d 1302 (Fed. Cir. 2012)	16
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005) (<i>en banc</i>)	20
<i>Providence Rubber Co. v. Goodyear</i> , 76 U.S. (9 Wall.) 788 (1869)	10
<i>Pullman-Standard v. Swint</i> , 456 U.S. 273 (1982)	19
<i>Retractable Techs., Inc. v. Becton, Dickinson & Co.</i> , 659 F.3d 1369 (Fed. Cir. 2011)	20
<i>Sys. Mgmt. Arts Inc. v. Avesta Technologies, Inc.</i> , 137 F. Supp. 2d 382 (S.D.N.Y. 2001)	21
<i>United Carbon Co. v. Binney & Smith Co.</i> , 317 U.S. 228 (1942)	3, 7
<i>United States v. U.S. Gypsum Co.</i> , 333 U.S. 364 (1948)	19
<i>Young v. Lumenis, Inc.</i> , 492 F.3d 1336 (Fed. Cir. 2007)	19, 21
Statutes	
35 U.S.C. § 112	2, 3, 6, 7, 9, 15, 17, 18, 20, 22, 23
35 U.S.C. § 154	6
35 U.S.C. § 282(a)	4, 13, 17, 18, 20, 24

Other Authorities

Edward D. Manzo, PATENT CLAIM CONSTRUCTION IN
THE FEDERAL CIRCUIT (2013)2, 4

Edward D. Manzo, PATENT CLAIM CONSTRUCTION IN
THE FEDERAL CIRCUIT, (forthcoming 2014)
(manuscript at 12) (on file with Thomson Reuters
Westlaw).....12

*Supplementary Examination Guidelines for
Determining Compliance With 35 U.S.C. 112 and
for Treatment of Related Issues in Patent
Applications*, 76 Fed. Reg. 7162 (2011).....15

Rules

Fed. R. Civ. P. 52(a)(6)19

Constitutions

U.S. Const., Art. I, § 8, cl. 88

INTEREST OF AMICUS CURIAE

The Intellectual Property Law Association of Chicago (“IPLAC”) submits this brief as amicus curiae in support of neither party on the ultimate merits of the case.^{1,2,3}

Founded in 1884, the Intellectual Property Law Association of Chicago is a voluntary bar association of over 1,000 members who practice in the areas of patents, trademarks, copyrights, trade secrets. IPLAC is the country’s oldest bar association devoted exclusively to intellectual property matters. In litigation, IPLAC’s members are split about equally between plaintiffs and

¹ Pursuant to Supreme Court Rule 37.6, no counsel for a party authored this brief in whole or in any part, no such counsel or a party made a monetary contribution intended to fund the preparation or submission of the brief, and no person other than the amicus curiae, its members, or its counsel, made such a monetary contribution.

² In addition to the required statement of footnote 1, IPLAC adds that after reasonable investigation, IPLAC believes that (a) no member of its Board or Amicus Committee who voted to prepare this brief, or any attorney in the law firm or corporation of such a member, represents a party to this litigation in this matter, (b) no representative of any party to this litigation participated in the authorship of this brief, and (c) no one other than IPLAC, or its members who authored this brief and their law firms or employers, made a monetary contribution to the preparation or submission of this brief.

³ Pursuant to Supreme Court Rule 37.2, counsel of record received timely notice of the intent to file this brief under the Rule and consent was granted.

defendants. Its members include attorneys in private and corporate practices before federal bars throughout the United States, and the U.S. Patent and Trademark Office (“USPTO” or “Patent Office”), and the U.S. Copyright Office. As part of its central objectives, IPLAC is dedicated to aiding the development of intellectual property law, especially in the federal courts.⁴

IPLAC is the source of Manzo, ed., *Patent Claim Construction in the Federal Circuit*, published in annual editions by Thomson Reuters Westlaw, including the current 2013 edition. This book of the IPLAC Litigation Committee reviews the law of precedential and non-precedential Federal Circuit claim interpretation cases each (calendar) year.

SUMMARY OF THE ARGUMENT

The state of the patent law on definiteness too often leaves lawyers and patent owners unable to tell with any degree of certitude what the standard is to determine whether a given patent claim (in an issued patent) is compliant with 35 U.S.C. § 112, ¶ 2.⁵ Articulations by the Federal Circuit of the standard have varied and appear to be inconsistent

⁴ While over 30 federal judges are honorary members of IPLAC, none of them was consulted or participated in any way regarding this brief.

⁵ Paragraph 2 of 35 U.S.C. § 112 was replaced with the redesignated § 112(b) by the Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 4(c), 125 Stat. 284, 296 (2011). Cites in this brief are to the pre-AIA version of the provision that was applied below.

with the standard announced by this Court. The Federal Circuit has repeatedly asserted a *de novo* standard of review although indefiniteness, while ultimately an issue of law, is predicated on factual underpinnings which, IPLAC respectfully submits, should be reviewed under the “clearly erroneous” standard.

The patent statute dictates that a patent “specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112, ¶ 2. (35 U.S.C. § 112 (b)). The statute does not dictate *how* the inventor must claim, and it leaves considerable discretion to the inventor. The Patent Office has prescribed various regulations that concern the form of patent claims, such as the requirement that each claim be restricted to a single sentence, but inventors and their counsel are left to draft patent claims in various unrestricted ways. Regardless how the claim is written, this statutory requirement must be followed.

This Court’s jurisprudence recognizes that “[i]t has long been understood that a patent must describe the exact scope of an invention.” *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996). Well before *Markman*, the definiteness requirement was interpreted as met “only when [patent claims] clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise.” *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942). “The patent law, and . . . the principles which govern the exclusive rights

conferred by it, leave no excuse for ambiguous language or vague descriptions.” See *Merrill v. Yeomans*, 94 U.S. 568, 573 (1876). However, in patent litigation, this Court acknowledges the limitations of language and that “the nature of language makes it impossible to capture the essence of a thing in a patent application.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 731 (2002).

At least since 2001, under the rubric of the presumption of validity found in the Patent Act, as codified in U.S.C. § 282(a), the Federal Circuit has moved away from the above standard. Instead, the Federal Circuit has held that “only claims ‘not amenable to construction’ or ‘insolubly ambiguous’ are indefinite.” *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed. Cir. 2005). The Federal Circuit takes the position that “the definiteness of claim terms depends on whether those terms can be given *any reasonable meaning*,” *Id.* at 1347 (emphasis added), “even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree.” *Exxon Research & Eng’g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001). Various other articulations of the standard being applied by the Federal Circuit are reviewed in the opinion below. For further review see Edward D. Manzo, PATENT CLAIM CONSTRUCTION IN THE FEDERAL CIRCUIT §4:1 (2013). The multiple standards leave district courts, the members of our bar association, patent holders, and the public at large adrift in trying to determine whether patent claims pass muster under the statutory definiteness requirement.

The Federal Circuit also has conflated claim construction, which it views as a pure matter of law, with validity of a claim under section 112, ¶ 2, and it has taken it upon itself to determine questions both of claim construction and indefiniteness *de novo*. See, e.g., *Lighting Ballast Control LLC v. Philips Electronics N. Am. Corp.*, No. 2012-1014, 2014 WL 667499, at *1, *9 (Fed. Cir. Feb. 21, 2014) (*en banc*).

The current approaches of the Federal Circuit are incompatible with the precepts this Court set forth. The Federal Circuit has improperly equated claim construction with indefiniteness. IPLAC respectfully submits that to be sufficiently definite within the meaning of the statute, a claim must be construable. The converse is *not* true, however. Some claims are construable but still indefinite, as the Federal Circuit itself recently ruled.⁶ While claims that are not construable are indefinite, construability is a necessary *but not sufficient* condition for meeting the definiteness requirement. IPLAC respectfully requests that this Court articulate a consistent indefiniteness standard for assessing the validity of an issued patent claim under section 112.

IPLAC further requests the Court to clarify the standard for review – whether *de novo* by the appellate court or with appropriate deference to the trier of fact. An appropriate standard would require adherence to the dictates of 35 U.S.C. § 112, ¶ 2, *i.e.*,

⁶ See *Ernie Ball, Inc. v. Earvana, LLC*, 502 Fed. Appx. 971 (Fed. Cir. 2013) (nonprecedential).

less tolerant of claim ambiguity, while considering the presumption of validity found in section 282(a), *e.g.*, a standard used in *Morton Int'l, Inc. v. Cardinal Chem. Co.* In *Morton*, the Federal Circuit held that claims must be clear enough that “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” 5 F.3d 1464, 1470 (Fed. Cir. 1993).

On appeal, from our members’ point of view, the appropriate weight to be given to determinations of indefiniteness should be that factual findings made by a district court in interpreting patent claims and assessing validity under section 112 should be reviewed under the clearly erroneous standard of review, but that the import of the facts and the ultimate interpretation should be reviewed *de novo*.

I. ARGUMENT

A. THE PATENT STATUTE CALLS FOR CLARITY

Similar to a deed to a parcel of land, a patent’s claims define the metes and bounds of the patentee’s rights. *See Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 510 (1917) (“[Claims] so mark where the progress claimed by the patent begins and where it ends that they have been aptly likened to the description in a deed, which sets the bounds to the grant which it contains.”). These rights include “the right to exclude others from making, using, offering for sale, or selling the claimed invention.” 35 U.S.C. § 154(a)(1). To protect the public interest, this Court finds “no excuse for ambiguous language or vague descriptions. The public should not be deprived of rights supposed to

belong to it, without being clearly told what it is that limits these rights.” *Merrill*, 94 U.S. at 573; *see also Evans v. Eaton*, 20 U.S. (7 Wheat.) 356, 434 (1822) (a patent must give “warning”: “to put the public in possession of what the [patentee] claims as his own invention, so as . . . to guard against prejudice or injury from the use of an invention which the party may otherwise innocently suppose not to be patented,” and “at the same time . . . taking from the inventor the means of [practicing] upon the credulity or the fears of other persons, by pretending that his invention is more than what it really is.”).

The “definiteness” requirement is a validity requirement demanding that the “specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112, ¶ 2. This Court’s jurisprudence recognizes that “[i]t has long been understood that a patent must describe the exact scope of an invention.” *Markman*, 517 U.S. at 373. This “definiteness” requirement “is met only when [patent claims] clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise.” *United Carbon*, 317 U.S. at 236. A lack of clarity creates a “zone of uncertainty [in] which enterprise and experimentation may enter only at the risk of infringement claims [and] would discourage invention.” *Id.* The Patent Office’s role is to foster public disclosure of an invention in exchange for a right to exclude:

Since the act of 1836, the patent laws require that an applicant for a patent shall

not only, by a specification in writing, fully explain his invention, but that he “shall particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery.” This provision was inserted in the law for the purpose of relieving the courts from the duty of ascertaining the exact invention of the patentee by inference and conjecture, derived from a laborious examination of previous inventions, and a comparison thereof with that claimed by him. This duty is now cast upon the Patent Office. There his claim is, or is supposed to be, examined, scrutinized, limited, and made to conform to what he is entitled to. If the office refuses to allow him all that he asks, he has an appeal. But the courts have no right to enlarge a patent beyond the scope of its claim as allowed by the Patent Office, or the appellate tribunal to which contested applications are referred. When the terms of a claim in a patent are clear and distinct (as they always should be), the patentee, in a suit brought upon the patent, is bound by it.

Keystone Bridge Co. v. Phoenix Iron Co., 95 U.S. 274, 278 (1877). In 2002, this Court confirmed the patent applicant’s duty to claim the invention properly, finding that:

The patent laws “promote the Progress of Science and useful Arts” by rewarding innovation with a temporary monopoly. U.S. Const., Art. I, § 8, cl. 8. The monopoly is a property right; and like any property

right, its boundaries should be clear. *This clarity is essential to promote progress, because it enables efficient investment in innovation. A patent holder should know what he owns, and the public should know what he does not.* For this reason, the patent laws require inventors to describe their work in “full, clear, concise, and exact terms,” 35 U. S. C. § 112, as part of the delicate balance the law attempts to maintain between inventors, who rely on the promise of the law to bring the invention forth, and the public, which should be encouraged to pursue innovations, creations, and new ideas beyond the inventor’s exclusive rights.

Festo, 535 U.S. at 730-31 (emphasis added). The patent laws demand a balance between the rights of the inventor and the public, and this balance must be maintained.

B. THE SUPREME COURT ALSO DEMANDS CLARITY

In patent litigation, courts construe claims in light of the patent specification, the prosecution history, other patent claims, and the prior art (in the intrinsic record). *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (*en banc*), *aff’d*, 517 U.S. 370 (1996). Issued patent claims (as distinguished from pending application claims) are construed liberally to preserve validity:

A patent should be construed in a liberal spirit, to sustain the just claims of the inventor. This principle is not to be carried

so far as to exclude what is in it, or to interpolate anything which it does not contain. But liberality, rather than strictness, should prevail where the fate of the patent is involved, and the question to be decided is whether the inventor shall hold or lose the fruits of his genius and his labors.

Providence Rubber Co. v. Goodyear, 76 U.S. (9 Wall.) 788, 795-96 (1869).

This Court took a tempered view of claim definiteness when it declared “the certainty which the law requires in patents is not greater than is reasonable, having regard to their subject matter.” *Minerals Separation, Ltd. v. Hyde*, 242 U.S. 261, 270 (1916). The Court will remember that by the time a patent reaches a definiteness challenge in litigation, the inventor has already made the full and complete disclosure of the new technical subject matter that Congress bargained for and the claim was scrutinized by an expert examiner before the USPTO granted the letters patent to the inventor or assignee. This means that the USPTO has already considered claim definiteness and examined the claimed subject matter, according to the broadest reasonable interpretation in light of the patent specification, for patentability over the art. The inventor has already performed his part of the social contract between the inventor and the public by forgoing other forms of protection. The issue at bar is whether such a claim should now be declared invalid because of its lack of precision.

Over history, the English language has accomplished great things using only twenty-six letters, but it has its limitations. This Court has explained that “the nature of language makes it impossible to capture the essence of a thing in a patent application.” *Festo*, 535 U.S. at 731.

Patent claims define the patentee’s legal right. See *Markman*, 517 U.S. at 388. This Court noted in *Markman* that claim construction is “a mongrel practice” of law and fact with “evidentiary underpinnings.” *Id.* at 378, 390. Patent claims are construed referring to the hypothetical Person of Ordinary Skill In The Art (“POSITA”). See *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, 437 (1902). (“The specification of the patent is not addressed to lawyers, or even to the public generally, but to the manufacturers of steel . . .”). A POSITA should be able to understand and construe patent claims:

Because claims are to be understood objectively, using objective evidence of meaning to the POSITA, patent claim construction is an exercise of democratic governance in which all persons may engage. It is a practice that all persons may perform with equal hope of being objectively “correct,” even if doing so may be difficult and even if predictions about how PTO officials and federal judges may construe claims may turn out to be wrong. Many more private entities evaluate patent claims and their validity and scope than do administrative officials and judges in the context of patent prosecution and litigation.

For example, lawyers must be able to provide advice about the scope of patent rights that can be obtained and whether patent claims obtained are in fact valid; patent owners and buyers must be able to determine the value and consequences for businesses and individuals of owning or selling patent rights; and patent licensors and licensees must be able to reach agreement regarding what specific patent rights are worth. The ability of private parties to make such determinations predictably and on their own without going to court depends on claim construction being an objective exercise based on evidence that is accessible to all.

Excerpt from Joshua D. Sarnoff and Edward D. Manzo, “An Introduction to, Premises of, and Problems with Patent Claim Construction,” to be published in Manzo, *PATENT CLAIM CONSTRUCTION IN THE FEDERAL CIRCUIT*, *supra*, 2014 edition.⁷ The current disagreement between the “definiteness” standard of the Patent Statute and this Court’s precedents and the “insolubly ambiguous” standard of the Federal Circuit renders it impossible for our members and their clients to determine with any accuracy whether a court will find a claim indefinite.

⁷ Publication forthcoming in April 2014; on file with Thomson Reuters Westlaw. IPLAC will provide copies to this Court shortly after publication.

**C. THE RECENT FEDERAL CIRCUIT
VIEW RUNS COUNTER TO THE
CLARITY DEMANDED BY THE
PATENT STATUTE AND THIS
COURT**

At least since 2001, under the rubric of the presumption of validity found in section 282(a) of the Patent Act, the Federal Circuit has moved away from the standard set out in section 112 of the Patent Statute and the precedents of this Court. *See Exxon Research*, 265 F.3d at 1375. Instead, the Federal Circuit has held that “only claims ‘not amenable to construction’ or ‘insolubly ambiguous’ are indefinite.” *Datamize*, 417 F.3d at 1347. This is wrong. The Federal Circuit posits that “the definiteness of claim terms depends on whether those terms can be given *any reasonable meaning*,” *Id.* (emphasis added), “even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree.” *Exxon Research*, 265 F.3d at 1375. The result is that the Federal Circuit has announced that patent claims that are open to multiple reasonable interpretations will not be found indefinite.

The Federal Circuit’s disparate views on indefiniteness have been recognized by individual Federal Circuit judges. In *Enzo Biochem, Inc. v. Applera Corp.*, Judge Plager explained that the Federal Circuit’s “indefiniteness” jurisprudence “seems to be this: if a person of ordinary skill in the art can come up with a plausible meaning for a disputed claim term in a patent, that term, and therefore the claim, is not indefinite.” 605 F.3d 1347, 1348 (Fed. Cir. 2010) (Plager J., dissenting from

panel rehearing). Judge Plager further noted that “the Board [in *Ex Parte Miyazaki*] concluded that the Federal Circuit’s reading of the indefiniteness requirement was counter to the PTO’s broader standard for claim construction during prosecution.” *Id.* at 1349 (citing *Ex parte Miyazaki*, 89 U.S.P.Q.2d at 1211). Judge Plager recognized that a difference of standard was permissible since the “Board is clearly right in recognizing that the circumstances are different between pre-issuance and post-issuance application of the definiteness standard with regard to claim terms.” *Enzo Biochem*, 605 F.3d at 1349. Judge Plager, however, commented that the Federal Circuit’s “definiteness doctrine could go considerably further in promoting [the public notice function of the patent law] than it currently does, with the not inconsequential benefit of shifting the focus from litigation over claim construction to clarity in claim drafting.” *Id.* Finally, Judge Plager offered, but was denied, what the Supreme Court did in granting certiorari in this case, namely:

To begin the discussion of how this court could move in that direction, I would grant the petition for panel rehearing. The court now spends a substantial amount of judicial resources trying to make sense of unclear, overbroad, and sometimes incoherent claim terms. It is time for us to move beyond sticking our fingers in the neverending leaks in the dike that supposedly defines and figuratively surrounds a claimed invention. Instead, we might spend some time figuring out how to support the PTO in requiring that the walls surrounding the claimed

invention be made of something other than quicksand.

Id.

The Federal Circuit's disparate views on indefiniteness have also been recognized by the USPTO. In a precedential opinion issued by the Board of Patent Appeals and Interferences ("Board"), the Board announced that:

Rather than requiring that the claims are insolubly ambiguous, we hold that if a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite.

Ex parte Miyazaki, 89 U.S.P.Q.2d 1207, 1211 (Bd. Pat. App. & Inter., Nov. 19, 2008). The Board in *Miyazaki* reinforced the Patent Office Rule that states that if a person of ordinary skill in the relevant art would read a claim with more than one reasonable interpretation, then a rejection under section 112, ¶ 2, is appropriate. See *Supplementary Examination Guidelines for Determining Compliance With 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications*, 76 Fed. Reg. 7162, 7164 (2011).

**D. A SINGLE STANDARD IS
REQUIRED TO ENABLE A
CONSCIENTIOUS PATENT
LAWYER TO DETERMINE
INDEFINITENESS**

The Federal Circuit views the indefiniteness analysis as “inextricably intertwined with claim construction.” *Energizer Holdings, Inc. v. Int’l Trade Com’n*, 435 F.3d 1366, 1368 (Fed. Cir. 2006); *see also Noah Systems, Inc. v. Intuit Inc.*, 675 F.3d 1302, 1311 (Fed. Cir. 2012) (“Whether a claim complies with the definiteness requirement of 35 U.S.C. § 112 ¶ 2, is a matter of claim construction . . .”); *Datamize*, 417 F.3d at 1348 (“In the face of an allegation of indefiniteness, general principles of claim construction apply.”). Claims are not indefinite if they are “amenable to construction, however difficult that task may be.” *Exxon Research*, 265 F.3d at 1375. *See, e.g., Halliburton Energy Servs. Inc. v. M-I LLC*, 514 F.3d 1244, 1249-1250 (Fed. Cir. 2008). The Federal Circuit seemingly contradicts that position though when it declares that “[i]f a claim is indefinite, the claim, by definition, cannot be construed.” *Enzo Biochem, Inc. v. Applera Corp.*, 599 F.3d 1325, 1332 (Fed. Cir. 2010).

IPLAC’s members include attorneys in private and corporate practices before federal bars throughout the United States, and the U.S. Patent and Trademark Office. In our roles as advocates of and advisors to our clients, it falls on us to tell our clients what a patent, whether a competitor’s or their own, covers. Our clients seek our knowledge at all stages, from patent procurement, product development, valuation, licensing, possible

infringement or non-infringement, to litigation at the district court level all the way to appeals to the Supreme Court. Our clients demand what this Court has also demanded, mainly that a patent's "boundaries be clear." *Festo*, 535 U.S. at 731 ("This clarity is essential to promote progress, because it enables efficient investment in innovation."). With the differing standards, determining questions of indefiniteness with a fair degree of accuracy is nearly impossible. Our clients struggle every day with the vagueness and fuzzy boundaries of some of today's patent claims. These clients look to the judiciary to "establish rules that enable a conscientious patent lawyer to determine with a fair degree of accuracy [patent-eligibility questions]" especially with a congress that seems incapable of agreement on any issue. *Diamond v. Diehr*, 450 U.S. 175, 219 (1981) (Stevens, J., dissenting) (citing cases). IPLAC respectfully requests that this Court articulate a consistent indefiniteness standard for post-grant litigation.

An appropriate standard would require adherence to the dictates of 35 U.S.C. § 112, ¶ 2, *i.e.*, less tolerant of claim ambiguity, while considering the presumption of validity found in section 282(a), understanding that "the nature of language makes it impossible to capture the essence of a thing in a patent application." *Festo*, 535 U.S. at 731. That standard cannot arise by the removal of "insolubly" from the "insolubly ambiguous" standard. Invalidating a claim because it is "ambiguous" goes too far. Neither can the standard be so lax as to invalidate every patent because experts often disagree as to the meaning of a claim term. One possible standard is found in an earlier Federal

Circuit decision, *Morton Int'l*, where the Federal Circuit held that claims must be clear enough that “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” 5 F.3d at 1470.

For instance, in the present case, the question before the district court and on appeal centered on the construction of the term “spaced relationship.” *Biosig Instruments, Inc. v. Nautilus, Inc.*, 715 F.3d 891 (Fed. Cir. 2013) cert. granted, 134 S. Ct. 896 (2014). The trial court construed the term “spaced relationship” and then found the claim, so construed, indefinite. The Federal Circuit majority, using a “pertaining to the function” interpretation of the claim, held the claim to be definite. *Id.* at 901-902. The Federal Circuit concurrence also construed the term “spaced relationship” and then found the claim met the requirements of 35 U.S.C. § 112, ¶ 2. *Id.* at 905 (Schall, J., concurring). The term, “spaced relationship,” is not new. A search of the USPTO Full-Text and Image Database found on the USPTO web site (www.uspto.gov) for the term “spaced relationship” in the claims of granted patents (Term 1: “spaced relationship” in Field 1: Claim(s)) reveals this term has been used in the claims of over 22,000 granted patents since 1976. The present case is not before this Court because of the lack of understanding of the term “spaced relationship,” but rather because of the dispute between the parties regarding the prior art and the validity of the claim using the term according to section 282(a). *See Id.* at 893-897.

**E. THE FEDERAL CIRCUIT HAS
INCONSISTENTLY ARTICULATED
WHETHER INDEFINITENESS
DETERMINATIONS UNDER 35
U.S.C. § 112, ¶ 2, ARE WHOLLY A
QUESTION OF LAW OR A MIXED
QUESTION OF LAW AND FACT**

The process that the Federal Circuit uses to determine indefiniteness “requires a determination whether those skilled in the art would understand what is claimed. To make that determination, we have explained that ‘[i]n the face of an allegation of indefiniteness, general principles of claim construction apply.’” *Young v. Lumenis, Inc.*, 492 F.3d 1336, 1346 (Fed. Cir. 2007) (quoting *Datamize*, 417 F.3d at 1348). The indefiniteness analysis is inextricably intertwined with claim construction and they both receive *de novo* review on appeal. *Id.* at 1344; see also *Lighting Ballast*, 2014 WL 667499, at *1, *9.

Federal Rule of Civil Procedure 52(a)(6) provides the standard of review for factual findings: “Findings of fact, whether based on oral or other evidence, must not be set aside unless clearly erroneous, and the reviewing court must give due regard to the trial court’s opportunity to judge the witnesses’ credibility.” Rule 52(a) applies to “all actions tried upon the facts without a jury,” *United States v. U.S. Gypsum Co.*, 333 U.S. 364, 394-95 (1948), and “does not make exceptions or purport to exclude certain categories of factual findings from the obligation of a court of appeals to accept a district court’s findings unless clearly erroneous.” *Pullman-Standard v. Swint*, 456 U.S. 273, 287 (1982).

The indefiniteness analysis is a question of a patent's validity. Under the presumption of validity in section 282(a), a patent invalidity defense, such as indefiniteness, must be proven by clear and convincing evidence. *See generally Microsoft Corp. v. i4i Ltd. P'ship*, 131 S. Ct. 2238 (2011). The presumption of validity calls for the Court to "separat[e] factual and legal aspects of an invalidity claim." *Id.* at 2253 (Breyer, J., joined by Scalia and Alito, JJ., concurring).

Ever since 1995, the Federal Circuit has treated every aspect of claim construction as a purely legal inquiry. *Markman*, 52 F.3d at 976-77, 979. An *en banc* Federal Circuit has had three opportunities since then to revisit this standard of review. *See Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1456 (Fed. Cir. 1998) (*en banc*); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1330-1333 (Fed. Cir. 2005) (*en banc*); *Lighting Ballast*, 2014 WL 667499, at *1, *9. Most recently in *Lighting Ballast*, the Federal Circuit reaffirmed that patent claim construction receives *de novo* review on appeal and is determined without deference to the ruling of the district court. *Lighting Ballast*, 2014 WL 667499, at *1, *9. The Federal Circuit reviews *de novo* even such findings as those reached after "live hearings with argument and testimony, sometimes covering several days." *Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 659 F.3d 1369, 1374 (Fed. Cir. 2011) (O'Malley, J., dissenting from denial of rehearing *en banc*).

The Federal Circuit, however, has also held that definiteness under 35 U.S.C. § 112, ¶ 2, is a question of law with underlying factual determinations. *Green Edge Enterprises, LLC v. Rubber Mulch Etc.*,

LLC, 620 F.3d 1287, 1299 (Fed. Cir. 2010). These underlying factual determinations must be given deference on appeal, and reviewed for clear error. *See id.*; *see also Young*, 492 F.3d at 1344–45 (stating that a showing of indefiniteness requires clear and convincing evidence). The Federal Circuit determined that “[l]ike enablement, definiteness, too, is amenable to resolution by the jury where the issues are factual in nature.” *BJ Servs. Co. v. Halliburton Energy Servs., Inc.*, 338 F.3d 1368, 1372 (Fed. Cir. 2003).

Some district courts have interpreted the Federal Circuit’s precedent as allowing for the submission of the matter of indefiniteness to the jury when the dispute is factual. *See Dow Chem. Co. v. NOVA Chemicals Corp. (Canada)*, 629 F. Supp. 2d 397, 403 (D. Del. 2009) (citing *BJ Servs.*, 338 F.3d at 1372-73). Other district courts have discussed the unclear nature of indefiniteness determinations. In *Sys. Mgmt. Arts Inc. v. Avesta Technologies, Inc.*, the court noted:

While the Federal Circuit has often stated that the indefiniteness inquiry is “drawn from” the district court’s role as a construer of patent claims, the circuit court has not expressly held that these inquiries are one and the same, nor that the indefiniteness inquiry can not involve underlying questions of fact. Moreover, to state that the indefiniteness inquiry is a question of law or “legal conclusion,” does not answer the question. The Federal Circuit has recognized that some questions of law involve underlying issues of fact.

137 F. Supp. 2d 382, 400 (S.D.N.Y. 2001) (internal citations omitted). Thus, the Federal Circuit precedent related to 35 U.S.C. § 112, ¶ 2, is subject to the logical interpretation that an indefiniteness determination on appeal is a legal inquiry that is informed by issues of fact that are necessary to clarify what the “essence of a thing” is. *See Festo*, 535 U.S. at 731. The factual framework relevant to an indefiniteness determination should remain undisturbed on appeal in the absence of clear error by the court of first instance.

Due to the lack of guidance concerning the standard of review, Judge Plager, in his dissent in *Enzo Biochem*, identifies the conundrum faced by the patent bar:

[I]f several persons of ordinary skill come up with competing but plausible interpretations of a disputed term – as is typically the case with competing “expert witnesses” in patent infringement litigation – the problem is not one of an inherently ambiguous and potentially indefinite claim term, but rather the problem becomes simply one of picking the “right” interpretation for that term. Since picking the “right” interpretation – claim construction – is a matter of law over which this court rules, and since the view of the trial judge hearing the case is given little weight, so that the trial judge’s view on appeal becomes just a part of the cacophony before this court, it is not until three court of appeals judges randomly selected for that purpose pick the “right” interpretation that the public, not to mention the patentee and

its competitors, know what the patent actually claims. The inefficiencies of this system, and its potential inequities, are well known in the trade.

Enzo Biochem, 605 F.3d at 1348 (Plager J., dissenting from panel rehearing) (internal footnote omitted).

This Court should identify whether indefiniteness is an issue of law, meriting *de novo* review on appeal, or for instance, a mixed question of law and fact (especially given the ever present expert testimony on patent claim validity) for which some deference must be given to the trier of fact. On appeal, the appropriate weight to be given to determinations of indefiniteness should be that factual findings made by a district court in interpreting patent claims should be reviewed under the clearly erroneous standard of review, but the import of the facts and the ultimate interpretation should be reviewed *de novo*. This is based on the Federal Circuit's much greater expertise in assessing the import of the facts of claim interpretation and the district court being in a better position to make credibility determinations.

CONCLUSION

Amicus curiae, the Intellectual Property Law Association of Chicago, urges this Court to articulate a consistent indefiniteness standard for post-grant patent litigation when assessing the validity of a patent claim under section 112. An appropriate standard would require adherence to the dictates of 35 U.S.C. § 112, ¶ 2, *i.e.*, less tolerant of claim ambiguity, while considering the presumption of

validity found in section 282(a), *e.g.*, a standard used in *Morton Int'l*, where the Federal Circuit held that claims must be clear enough that “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” 5 F.3d at 1470. On appeal, the appropriate weight to be given to determinations of indefiniteness should be that factual findings made by a district court in interpreting patent claims should be reviewed under the clearly erroneous standard of review, but the import of the facts and the ultimate interpretation should be reviewed *de novo*.

Respectfully submitted,

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