

No. 13-369

IN THE
Supreme Court of the United States

NAUTILUS, INC.,

Petitioner,

v.

BIOSIG INSTRUMENTS, INC.,

Respondent.

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

**BRIEF OF PUBLIC KNOWLEDGE AND THE
ELECTRONIC FRONTIER FOUNDATION AS
AMICI CURIAE IN SUPPORT OF PETITIONER**

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INTEREST OF *AMICI CURIAE*

The Electronic Frontier Foundation (“EFF”)¹ is a non-profit civil liberties organization that has worked for more than 20 years to protect consumer interests, innovation, and free expression in the digital world. EFF and its 24,000 active members have a strong interest in helping the courts and policy-makers in striking the appropriate balance between intellectual property and the public interest.

Public Knowledge is a non-profit organization that is dedicated to preserving the openness of the Internet and the public’s access to knowledge; promoting creativity through balanced intellectual property rights; and upholding and protecting the rights of consumers to use innovative technology lawfully. As part of this mission, Public Knowledge advocates on behalf of the public interest for a balanced patent system, particularly with respect to new and emerging technologies.

Both EFF and Public Knowledge have previously served as *amici* in key patent cases. *E.g.*, *Microsoft Corp. v. i4i Ltd. P’ship*, 131 S. Ct. 2238 (2011); *Bilski v. Kappos*, 130 S. Ct. 3218 (2010); *Quanta Computer, Inc. v. LG Elecs. Corp.*, 553 U.S. 617 (2008).

¹No counsel for a party authored this brief in whole or in part, and no such counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than *amici curiae*, or their counsel, made a monetary contribution intended to fund its preparation or submission. Pursuant to Supreme Court Rule 37.2(a), *amici* provided at least ten days’ notice of its intent to file this brief, to counsel of record for all parties. The parties have consented to the filing of this brief and such consents are being submitted.

SUMMARY OF ARGUMENT

A developer wishes to build a hotel by a highway, and is searching the records of deeds for a prospective plot of land. The search reveals a recordation of an easement stating in part, “*the western boundary is in a spaced relationship with the highway.*”

What can the developer do? “Spaced relationship” could mean a foot from the highway, or a yard, or a mile. The developer could guess at the meaning, but a wrong guess could render the entire investment in building the hotel a waste. Should the case be brought to court, different judges or juries could reasonably disagree on the meaning. Worse yet, when the easement owner sues the developer, the owner will have the benefit of hindsight in making his argument for interpreting the property claim, but the developer has no such benefit when choosing where to build the hotel. The cards are stacked against the developer, a deadweight loss for the hotel business and for the economy at large.

Beyond creating this uncertainty for developers, allowing ambiguous words in property claims would encourage owners of real property to exploit such ambiguities, so that they might later alter or stretch the grant. Rather than providing adequate notice to the public, such deeds would deter the public from improving land for fear of the breadth of such vaguely worded instruments.

Such ambiguous descriptions of the metes and bounds of real property would never be tolerated, but for years the Federal Circuit has tolerated equally ambiguous descriptions of the metes and bounds of patents. Indeed, the term “spaced relationship,” so

clearly improper in the hypothetical example above, is the exact term held “definite” by that court in the present case for petition.

Certainly patents differ in many respects from real property, but clarity in the boundaries should not be one such difference. The claims of a patent serve a public notice function, informing others of what may and may not be done. But the Federal Circuit’s “insolubly ambiguous” test for indefiniteness of patent claims abrogates this public notice function, permits the proliferation of indeterminate claims, invites abuse by clever patent drafters, and contributes to a general and widespread sense that patents are unclear and uninformative documents. The test thus fails to serve the constitutional mandate that patents “promote the Progress of Science and the useful Arts.” U.S. Const. art. 1, § 8, cl. 8.

To reverse these problematic trends, the Court should disapprove the Federal Circuit’s “insolubly ambiguous” test and restore a proper interpretation of indefiniteness of patent claims. To do so, it must review the present case. The Federal Circuit’s test for indefiniteness is so monumentally difficult to satisfy that appealing a case on this issue is almost certainly futile and almost never done. Should the present case not be reviewed, another appropriate vehicle for review may not arise.

Because the Federal Circuit’s standard for claim indefiniteness conflicts with both the plain language of the Patent Act and decisions of this Court, because the “insolubly ambiguous” standard encourages patentees to craft vague claims and creates uncertainty for the public, and because this case cleanly presents the issue for review, this Court should grant certiorari.

ARGUMENT

I. The Federal Circuit’s Overly Strict Test for Indefiniteness of Patent Claims Invites Abuse and Impedes Innovation

The Patent Act requires that a patent must conclude with “one or more claims *particularly pointing out and distinctly claiming* the subject matter which the inventor or a joint inventor regards as the invention.” 35 U.S.C. § 112, ¶ 2 (2011) (emphasis added). This provision establishes a key requirement of the patent system: patents must inform potential infringers, in advance, of what the claims cover and what they do not cover. As this Court has explained, a patent claim secures “all to which [the patentee] is entitled” while “appris[ing] the public of what is still open to them.” *McClain v. Ortmyer*, 141 U.S. 419, 424 (1891). Ambiguous patent claims create a “zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims” and thereby “discourage invention only a little less than unequivocal foreclosure of the field.” *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942).

The Federal Circuit takes a different approach. It holds that a patent claim is definite unless it is “insolubly ambiguous.” *Exxon Research & Eng’g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001) (*Exxon Research*). Under this test, a patent claim is valid “if the meaning of the claim is discernible, even though...the conclusion may be one over which reasonable persons will disagree.” *Id.*

This “insolubly ambiguous” test is improper for at least three reasons explained below. First, the test conflicts with this Court’s long-established precedent

on indefiniteness of patent claims under § 112, ¶ 2. Second, the test creates an untenable dilemma for patent defendants, effectively preventing them from fully arguing their cases. Third, the test encourages the drafting of unclear and ambiguous patent claims. These factors all contribute to a widespread and well-known problem of unclarity in patents. By granting certiorari in this case, the Court can take a first step in correcting these problematic trends.

A. The Federal Circuit’s Test Conflicts with This Court’s Precedents

Patent “boundaries should be clear. This clarity is essential to promote progress, because it enables efficient investment in innovation.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002). The purpose of a patent claim is to define the scope of the patentee’s right. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996). A clear definition of patent scope serves multiple purposes: the “limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others, and the assurance that the subject of the patent will be dedicated ultimately to the public.” *Gen. Elec. Corp. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938).

As this Court explained over 100 years ago, “[t]he claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is.” *White v. Dunbar*, 119 U.S. 47, 52 (1886). The Federal Circuit ignores this. Instead of requiring that claims precisely define the invention, the Federal Circuit requires only that, years later, they be “amenable to construction” by a

court, “*however difficult* that task may be.” *Exxon Research*, 265 F.3d at 1375 (emphasis added). In effect, the Federal Circuit’s “insolubly ambiguous” standard has repealed the Patent Act’s requirement that applicants “distinctly claim[] the subject matter” of their inventions. § 112, ¶ 2.

By expressly tolerating ambiguity in patent claims, the Federal Circuit has removed an essential plank of a well-functioning patent system. The court’s error can be traced to a misapplication of the evidentiary burden applied in patent cases. The Federal Circuit has reasoned that indefiniteness “requires such an exacting standard” because an accused infringer must “show[] by clear and convincing evidence that a skilled artisan could not discern the boundaries of the claim.” *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1249 (Fed. Cir. 2008).

It is true that invalidity defenses must be proved by clear and convincing evidence. *Microsoft Corp. v. i4i Ltd. P’ship*, 131 S. Ct. 2238, 2242 (2011). But, as a claim construction issue, the “determination of claim indefiniteness is a legal conclusion.” *Personalized Media Communications, LLC v. Int’l Trade Comm’n*, 161 F.3d 696, 705 (Fed. Cir. 1998); *see also Atmel Corp. v. Info. Storage Devices, Inc.*, 198 F.3d 1374, 1378 (Fed. Cir. 1999). There is no reason to apply an evidentiary burden when developing the legal standard for indefiniteness.

In sum, the Federal Circuit’s “insolubly ambiguous” test directly conflicts with this Court’s principles and precedents on indefiniteness of patent claims.

B. The Misapplication of Indefiniteness Creates an Imbalance in Justice

The Federal Circuit's erroneous standard creates unfairness for defendants, who "disproportionately" bear the "risks and harms resulting from ambiguous patents." Phil Goldberg, Progressive Policy Inst., *Stumping Patent Trolls on the Bridge to Innovation* 4 (2013). This occurs specifically in at least two ways. First, the benefit of hindsight favors those who assert patents. Those who make products, as well as their investors, must guess at the meaning of patent claims, and a wrong guess puts their investment at risk. But once an investment is made, the patentee has the benefit of hindsight and will argue for an interpretation that covers the accused product. Thus, the legal doctrines "give the patentee the benefit of later information, which creates a patentee preference for vagueness." Tun-Jen Chiang, *Fixing Patent Boundaries*, 108 Mich. L. Rev. 523, 573 (2010).

Second, the "insolubly ambiguous" standard unfairly prevents parties from fully presenting their cases in litigation, by forcing them to choose between offering and arguing for a favorable claim construction on the one hand, and alleging the indefiniteness of the claim on the other. Under the Federal Circuit standard, a claim is indefinite only when it is "not amenable to construction," *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed. Cir. 2005), the proposal of a construction for that claim entirely undermines the argument for indefiniteness. *Cf. Lazare Kaplan Int'l, Inc. v. Photocopy Techs., Inc.*, 628 F.3d 1359, 1376 (Fed. Cir. 2010) (holding that failure to raise a claim construction argument waives that argument on appeal).

This forced choice between arguments conflicts with the general policy favoring alternative pleadings. It has long been the law that “[a]lternative and inconsistent defenses may be pleaded.” *Elec. Storage Battery Co. v. Shimadzu*, 307 U.S. 5, 16 (1939); see also Fed. R. Civ. P. 8(d)(2) (“A party may set out 2 or more statements of a claim or defense alternatively or hypothetically. . .”). By preventing defending parties from arguing for both indefiniteness and favorable claim constructions, the “insolubly ambiguous” test blocks those parties from fully presenting their cases and thus creates an imbalance in justice disfavoring them.

For these reasons, the Federal Circuit’s standard for indefiniteness is not only substantively erroneous, but also unfair to litigants.

C. Sanctioned Vagueness Has Led to Abusive Business Practices of Asserting Patents

The “insolubly ambiguous” test has fostered business practices that abuse the patent system by exploiting this sanctioned vagueness in patent claims. One economist traced how patents with “fuzzy boundaries” have created “a business opportunity based on acquiring patents that can be read to cover existing technologies and asserting those patents.” James Bessen et al., *The Private and Social Costs of Patent Trolls*, Regulation, Winter 2011–2012, at 26, 34. Similarly, stakeholders reported to the Federal Trade Commission that the patent system “generally creates ‘an incentive to be as vague and ambiguous as you can with your claims’ and to ‘defer clarity at all costs.’” Fed. Trade Comm’n, *The Evolving IP*

Marketplace: Aligning Patent Notice and Remedies with Competition 85 (2011).²

In this way, ambiguous patents—mostly relating to software—have fed the recent explosion in litigation by non-practicing entities (also known as patent trolls). By revitalizing the law of indefiniteness, this Court could improve patent quality and reduce opportunistic patent litigation.

D. The Lack of Clarity in Patents Has Caused Widespread, Well-Known Harm

The Federal Circuit’s laxity in policing vagueness and ambiguity in patents has led to a popular view that patents are unintelligible documents with little value to the scientific or engineering communities. This is the manifestation of the “zone of uncertainty” that this Court presciently feared would result from indefinite claims, *United Carbon Co.*, 317 U.S. at 236, and it is an unfortunate development given the constitutional mandate that patents “promote the Progress of Science and the useful Arts,” U.S. Const. art. 1, § 8, cl. 8.

One survey of researchers in the nanotechnology field found found numerous complaints on the

²See also Goldberg, *supra*, at 3 (citing “vague or expansive terms” in patents as one of “three cross winds” creating a flood of patent litigation); David Segal, *Has Patent, Will Sue: An Alert to Corporate America*, New York Times, July 14, 2013, at BU1 (“But as long as the [patent] system exists, [noted patent assertor Erich] Spangenberg is going to exploit its ambiguities and pokiness for all it’s worth.”); James Bessen & Michael J. Meurer, *Patent Failure: How Judges, Bureaucrats, and Lawyers Put Innovators at Risk* 164 (2008) (“The evidence suggests . . . that the deterioration of the notice function might be the central factor fueling the growth in patent litigation”).

usefulness of patents as technical disclosures. Lisa Larrimore Ouellette, *Do Patents Disclose Useful Information?*, 25 Harv. J.L. & Tech. 545 (2012). Among the surveyed researchers, 36% never read patents, many of them complaining about “the style in which patents are written—patents were called ‘vague,’ ‘legal jargon,’ ‘incomprehensible,’ and lacking ‘technical detail.’” *Id.* at 571. Those who had read patents had similar complaints: “To a scientist,” an academic chemist wrote, “the patent literature looks like an invention of lawyers for the benefit of other patent lawyers.” *Id.* at 576. Only 38% of surveyed researchers believed that one could reproduce an invention from the patent specification—a clear indication that disclosure and dissemination of knowledge, the cornerstone goals of the patent system, are not being served. *Id.*

This unclarity in patent drafting has been specifically tied to Federal Circuit law. As one commentator observed, “the Federal Circuit has permitted a number of vague general disclosures that don’t actually communicate very much to anyone, and patent lawyers often have incentives to write such vague disclosures.” Mark A. Lemley, *The Myth of the Sole Inventor*, 110 Mich. L. Rev. 709, 745 (2012). Another has said on the increasing use of the “insolubly ambiguous” standard, “[i]f the Federal Circuit does not correct this trend soon, a competitor’s ability to accurately determine the metes and bounds of current patents might deteriorate further.” Christa J. Laser, *A Definite Claim On Claim Indefiniteness*, 10 Chi.-Kent J. Intell. Prop. 25, 27 (2010).

Indefiniteness of claims is a substantial offender within this general discontent over vagueness. The

Federal Circuit’s “insolubly ambiguous” test holds claims to be definite even if the definition is “one over which reasonable persons will disagree.” *Datamize, LLC*, 417 F.3d at 1437. One patent attorney bemoaned, “if reasonable people can disagree about the definition of the claim terms, how does this notify the public of the patentee’s right to exclude?” Kirk M. Hartung, *Claim Construction: Another Matter of Chance and Confusion*, 88 J. Pat. & Trademark Off. Soc’y 831, 844 (2006). By validating claims whose meanings are up for debate, Federal Circuit’s test contravenes the clarity of patent boundaries “essential to promote progress,” *Festo Corp.*, 535 U.S. at 731, and undermines the public notice function that patent claims should serve.

Those outside of academic circles have expressed the most concern about the difficulty of understanding patents and particularly patent claims. One author, in describing how to read patent claims, laments that they are “a dense form of legal English,” further explaining that the “drafting of patent claims is a black art” because claims are “full of magic words.” Rob Weir, *How Not to Read a Patent* (Aug. 13, 2009), <http://www.robweir.com/blog/2009/08/how-not-to-read-patent.html>. “Patents are so vague,” one attorney said, that “[i]f someone claims infringement, the only way to resolve it is through litigating.” Rich Steeves, *New Report Examines the Economic Cost of Patent Trolls* (Oct. 11, 2013), <http://www.insidecounsel.com/2013/10/11/new-report-examines-the-economic-cost-of-patent-tr>. Where litigation is “the only way” to assess the meaning of a patent, that patent has failed to serve its public notice function.

These examples demonstrate that vagueness and

lack of clarity is a substantial problem for patent policy. By granting certiorari in this case and reviewing the standard for indefiniteness of claims, the Court can take a first step toward restoring the original intention of patents as disclosures of information that promote progress and innovation.

II. This Case Presents a Rare and Ideal Vehicle for Assessing the Standard of Indefiniteness

The Court should use the present case as the vehicle to review the Federal Circuit's standard for indefiniteness under § 112, ¶ 2, for two reasons. First, because the "insolubly ambiguous" test is practically impossible to meet, few cases challenging that test are brought on appeal, so the pool of opportunities for reviewing this error is diminishing rapidly. Second, the present case presents a clear and straightforward issue of law, not complicated by questions of fact, making it an ideal candidate for review.

A. The Current Rule on Indefiniteness Has Resulted in a Minuscule Pool of Cases on this Issue

The present case is likely to be the only appropriate opportunity for the Court to address the proper standard for indefiniteness under § 112, ¶ 2. This is because, due to the Federal Circuit's "insolubly ambiguous" test being overly strict, almost no cases presenting the issue of indefiniteness are presented on appeal.

Between 2010 and 2013, there were only thirteen published Federal Circuit decisions that considered

indefiniteness under § 112, ¶ 2.³ Of those thirteen cases, the Federal Circuit found the claims definite in all but two cases: in *Haemonetics Corp. v. Baxter Healthcare Corp.* the court remanded the issue of indefiniteness to the district court due to a reversal of the underlying claim construction, 607 F.3d 776, 784 (Fed. Cir. 2010), and in *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.* the court found some claims indefinite only because the applicant had actually made contradictory statements in the prosecution history, 723 F.3d 1363, 1369 (Fed. Cir. 2013). In the vast majority of cases, the Federal Circuit has rejected arguments of indefiniteness.⁴

Given the futility of arguing indefiniteness before the Federal Circuit, it is unsurprising that the

³There were additional cases that considered indefiniteness of means-plus-function claims under 35 U.S.C. § 112, ¶ 6 (2011), but those cases apply different law. Additionally, there were several cases involving typographical or drafting errors, making them unsuitable for certiorari. See *Funai Elec. Co. v. Daiwoo Elecs. Corp.*, 616 F.3d 1357 (Fed. Cir. 2010) (confusing grammar); *Rembrandt Data Techs., LP v. AOL, LLC*, 641 F.3d 1331 (Fed. Cir. 2011) (mixed apparatus/method); *CBT Flint Partners, LLC v. Return Path, Inc.*, 654 F.3d 1353 (Fed. Cir. 2011) (missing word “and” in claim); *HTC Corp. v. IPCOM GmbH & Co., KG*, 667 F.3d 1270 (Fed. Cir. 2012) (mixed apparatus/method).

⁴See *Trading Techs. Int’l, Inc. v. eSpeed, Inc.*, 595 F.3d 1340 (Fed. Cir. 2010); *Honeywell Int’l, Inc. v. United States*, 596 F.3d 800 (Fed. Cir. 2010); *Enzo Biochem, Inc. v. Applera Corp.*, 599 F.3d 1325 (Fed. Cir. 2010); *Power-One, Inc. v. Artesyn Techs., Inc.*, 599 F.3d 1343 (Fed. Cir. 2010); *Hearing Components, Inc. v. Shure Inc.*, 600 F.3d 1357 (Fed. Cir. 2010); *Spansion, Inc. v. Int’l Trade Comm’n*, 629 F.3d 1331 (Fed. Cir. 2010); *Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355 (Fed. Cir. 2011); *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 655 F.3d 1364 (Fed. Cir. 2011); *IGT v. Bally Gaming Int’l, Inc.*, 659 F.3d 1109 (2011); *Deere & Co. v. Bush Hog, LLC*, 703 F.3d 1349 (Fed. Cir. 2012). The remaining case is the present one.

Figure 1: Published Federal Circuit opinions deciding indefiniteness under § 112 ¶ 2.

Year	Number of cases
2010	7
2011	3
2012	1
2013	2
	1 3 5 7

issue is being appealed less and less often. As shown in Figure 1, the number of cases considering indefiniteness has dropped precipitously between 2010 and today. Only three opinions on indefiniteness have issued since 2012. Of those three cases, two of them involved contradictory statements in the patent prosecution histories, making them unsuitable vehicles for evaluating the pure legal question of the “insolubly ambiguous” standard. *See Deere & Co. v. Bush Hog, LLC*, 703 F.3d 1349, 1359 (Fed. Cir. 2012); *Teva Pharmaceuticals USA, Inc.*, 723 F.3d at 1369. The third is the present case.

This small number of cases should not be taken to diminish the importance of this issue. As explained previously, the problem of vagueness and indefiniteness in patents is serious and widespread. The dearth of decisions on indefiniteness should rather be seen as an indication of the undue strictures of the Federal Circuit’s “insolubly ambiguous” test, one that is so difficult to meet that it is, under the current law, fruitless to even argue on appeal.

The Federal Circuit’s test for indefiniteness is thus

not only contrary to this Court's precedent, but also constructed to evade judicial review by this Court. Accordingly, the Court should accept this opportunity, which will likely not arise again, to correct this error.

B. The Claim Term in this Case Cleanly Presents the Issue of Indefiniteness

Unlike other indefiniteness cases that have reached this Court, this case cleanly and straightforwardly presents the important question of whether patent claims must be unambiguous when issued. In another recent indefiniteness case, this Court invited the views of the Solicitor General, who recommended against granting certiorari. See Brief for the United States as Amicus Curiae, *Applera Corp. v. Enzo Biochem, Inc.*, 131 S. Ct. 847 (2011) (No. 10-426) (Mem.). The Solicitor General noted that *Applera* was a poor vehicle for review because it raised complex factual issues and because “the court of appeals did not use either the phrase ‘insolubly ambiguous’ or the phrase ‘capable of construction’ in its opinion below.” *Id.* at 15.

In contrast, the Federal Circuit's decision in this case expressly invoked and relied upon the “insolubly ambiguous” standard. See *Biosig Instruments, Inc. v. Nautilus, Inc.*, 715 F.3d 891, 898, 903 (Fed. Cir. 2013). Further, this case does not require the Court to engage in highly technical analysis. The disputed term—“spaced relationship”—is a term of degree. The District Court correctly concluded that the patent did not tell “anyone what precisely the space should be.” *Id.* at 899 (citing the transcript of the summary judgment hearing). Even the Federal Circuit conceded that “that the specification of the ’753 patent does not specifically define ‘spaced relationship’ with actual

parameters.” *Id.* Quite simply, the patent provided no advance notice as to what “spaced relationship” meant.

If it grants certiorari, this Court’s task will be simple. The Court should reject the Federal Circuit’s “insolubly ambiguous” test and replace it with the correct standard: patent claims must allow a person of ordinary skill in the art to read and understand both what is claimed and what is not claimed. Applied to the facts of this case, this standard requires that the judgment of the Federal Circuit be reversed.

CONCLUSION

For the foregoing reasons, *amici* respectfully submit that the Court should grant certiorari.

Respectfully submitted,

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