

3 Infringement Defenses To Consider 10 Years Post-Nutilus

By **John Vandenberg** (June 3, 2024)

The U.S. Supreme Court issued its decision in *Nautilus Inc. v. Biosig Instruments Inc.* just over 10 years ago, on June 2, 2014.

The ruling rejected the U.S. Court of Appeals for the Federal Circuit's then 13-year-old test for satisfying the Patent Act's requirement that a patent application concludes its specification "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".[1]



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Under that test, a patent claim needed only be "amenable to construction" and not "insolubly ambiguous." *Nautilus* rejected that interpretation of the statute, with several justices dismissing it out of hand at the argument.[2]

Chief Justice John Roberts's take on the existing test was succinct: "Nobody agrees with that formulation; right?"[3]

Justice Antonin Scalia noted that the court took the case because of the Federal Circuit's "really extravagant language." [4] Justice Ruth Bader Ginsburg's unanimous opinion less colorfully concluded that the Federal Circuit's test was not "probative of the essential inquiry." [5]

In its place, *Nautilus* prohibited genuine ambiguity in patent claims and mandated instead reasonable certainty, albeit not absolute precision, in claim scope:

We conclude that the Federal Circuit's formulation, which tolerates some ambiguous claims but not others, does not satisfy the statute's definiteness requirement. In place of the "insolubly ambiguous" standard, we hold that a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.[6][7][8][9]

Yet, the spirit of the rejected "amenable to construction" test persists with many patent litigators and judges. Many attorneys say, despite *Nautilus*, that one cannot — or should not — argue for a claim construction of a claim term while also arguing that the term is indefinite.

Thus, defendants who argue in *Markman* proceedings that a claim term is indefinite rarely also seek a construction for the term, or do in the alternative, as if being amenable to construction means that a claim term satisfies the "particularly pointing out and distinctly claiming" mandate.

Similarly, some judges have rejected indefiniteness arguments in part on the ground that the court's claim construction is not indefinite.[10]

When I see or hear this, I think back to Justice Scalia at the argument belittling that very concept.

As he pointed out with his trademark flair, there's always a correct claim construction, yet, of course, that does not mean there was not genuine ambiguity, i.e., multiple reasonable constructions after application of the applicable interpretive tools:

There's never more than one correct construction. Even when there is, there isn't. I mean, we always have to come up with an answer. And the patent office has to come up with an answer. It means this or it doesn't mean this. Have you ever heard of a court that says, well, you know, it could mean either one of these? It's a tie. So then you win all the time. There is no such thing as ambiguity, because there is always a right answer.[11]

Just because a court must instruct the jury on a precise claim scope, that does not mean that the skilled artisan seeking to innovate just outside the patent's boundary, long before any court construes the claims, would have had reasonable certainty as to the location of that boundary line.

A judge does not need reasonable certainty to decide what language means. But the would-be next inventor about to mortgage her home to invest in her idea, absolutely needs reasonable certainty about the claim's scope, or else she might just give up innovating and go to law school.

Fear, uncertainty and doubt like this undermine our patent system as an engine of innovation. Patent claim ambiguity chills innovation today whether or not a judge years from now gives the ambiguous claim an unambiguous construction.

Justice Ginsburg's opinion made this point as follows:

It cannot be sufficient that a court can ascribe some meaning to a patent's claims; the definiteness inquiry turns on the understanding of a skilled artisan at the time of the patent application, not that of a court viewing matters post hoc.[12]

Below, I recommend three arguments patent infringement defense counsel should always consider.

A construed term also may be ambiguous.

If after applying the applicable interpretative tools from the perspective of a person having ordinary skill in the art, or POSITA, as of the effective filing date, there are multiple reasonable interpretations of claim scope, the claim is genuinely ambiguous and fails the "particularly pointing out and distinctly claiming" mandate.

This is so even if one of those interpretations is adopted by the court post hoc as the correct claim construction. Thus, arguments both for a construction and for indefiniteness of the same claim term are not arguments in the alternative.

It is not a problem for a claim term to be ambiguous on its face if application of the standard interpretive tools removes that ambiguity.

But if those tools leave multiple reasonable interpretations of varying claim scope, then there is genuine ambiguity, violating the "particularly pointing out and distinctly claiming" mandate.[13] Some Federal Circuit panels have recognized this.[14][15]

The ambiguity may relate to application of Section 112(f).

These same principles apply to genuine claim-scope ambiguities caused by uncertain application of Section 112(f).

There is no reason to tolerate innovation-chilling genuine ambiguity in patent claim scope just because that ambiguity is caused by uncertainty in application of Section 112(f) rather than some other claim-construction principle.

A court analyzing a claim term must choose yes or no: Yes, the term triggers Section 112(f) or no, it does not. There are no ties.

But that does not mean that the other answer would have been unreasonable to a POSITA on the effective filing date. The same goes for identifying the structures, materials or acts incorporated into the claim by virtue of Section 112(f).

That a court can identify those structures, etc., does not mean a POSITA would have had reasonable certainty identifying them. That the claim is to be construed according to one set of interpretive tools, Williamson, versus another, standard Phillips, is of no concern to the skilled artisan who needs to know the claim's scope.

If parties and courts ignore genuine ambiguities caused by patents being drafted — intentionally or not — to make application of Section 112(f) uncertain, they allow an innovation-discouraging zone of uncertainty.

A purely functional claim term fails Section 112(b) if it is not saved by Section 112(f).

Claim-scope ambiguity is not the only way to violate the "particularly pointing out and distinctly claiming" mandate of Section 112(b).

For example, if a claim term recites a function without sufficient structures, materials or acts for performing the function, and it is not saved by application of Section 112(f), then the claim fails the "particularly pointing out and distinctly claiming" mandate. This is because the claim scope is not limited to a particular set of structures, materials and acts.

But few patent-litigation defendants assert this defense. They join the battle on whether the functional claim term triggers Section 112(f) and stop there.[16]

In the 1930s and 1940s, the Supreme Court rejected, as a matter of law, functional patent claims reciting a function to be performed without also reciting particular structures, materials or acts sufficient to perform the function.[17][18]

In direct response, Congress in the Patent Act codified this case law, but with a twist.[19][20] Section 112(f) is a limited and provisional safe harbor against invalidation of purely functional claims for indefiniteness.[21]

If the patent specification fails to describe — and link to the function — the required structures, materials or acts for performing the claim-recited function, the claim remains a naked functional claim and is invalid for impermissible pure functional claiming.[22]

Yes, there's always a right answer. No, that does not mean the claim satisfies Nautilus.

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Disclosure: Vandenberg argued for Nautilus before the U.S. Supreme Court in 2014.

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[1] *Nautilus Inc. v. Biosig Instruments Inc.*, 572 U.S. 898 (2014).

[2] Oral Argument Audio, *Nautilus Inc. v. Biosig Instruments Inc.*, 572 U.S. 898 (2014) (No. 13-369).

[3] Transcript of Oral Argument at 24:25–25:1, *Nautilus Inc. v. Biosig Instruments Inc.*, 572 U.S. 898 (2014) (No. 13-369).

[4] *Supra*[3] at 24:3–5.

[5] *Supra*[1] at 912–13.

[6] *Supra*[1] at 901.

[7] See *Dow Chem. Co. v. Nova Chem. Corp.*, 803 F.3d 620, 630 (Fed. Cir. 2015) ("[T]here can be no serious question that Nautilus changed the law of indefiniteness. This was indeed the very purpose of the Nautilus decision.").

[8] *HZNP Meds. LLC v. Actavis Labs UT Inc.*, 940 F.3d 680, 694 (Fed. Cir. 2019) ("The Supreme Court has repeatedly emphasized why the definiteness requirement demands clear notice of what is being claimed.").

[9] *Eon Corp. IP Holdings LLC v. AT&T Mobility LLC*, 785 F.3d 616, 623 (Fed. Cir. 2015) (Nautilus "warned against 'diminish[ing] the definiteness requirement's public-notice function and foster[ing] the innovation-discouraging zone of uncertainty against which this Court has warned.'").

[10] See, e.g., *Nanoco Techs. Ltd. v. Samsung Elecs. Co.*, No. 2:20-CV-00038-JRG, 2021 WL 1890453, at *8 (E.D. Tex. May 10, 2021) ("[T]he Court's construction is substantially like that proposed by the Defendant — a construction which it does not argue is indefinite.").

[11] *Supra*[3] at 39:19-40:13.

[12] *Supra*[1] at 911.

[13] Cf. *Teva Pharms. USA Inc. v. Sandoz Inc.*, 789 F.3d 1335, 1342 (Fed. Cir. 2015) (remand from S. Ct.) (explaining that facts found by trial court "do not resolve the ambiguity in the Group I claim about the intended molecular weight measure").

[14] See, e.g., *Bombardier Recreational Prods. Inc. v. Arctic Cat Inc.*, 785 F. App'x 858, 866-68. (Fed. Cir. 2019) (non-precedential) (affirming jury verdict of indefiniteness where

both parties accepted district court's claim construction and indefiniteness was based on terms used in that claim construction).

[15] *GE Lighting Sols. LLC v. Lights of Am. Inc.*, 663 F. App'x 938, 940 (Fed. Cir. 2016) (non-precedential) (affirming that term "elongated" (in a thermally conductive elongated core having a first end in thermal communication with the conductive spreader), construed to mean "extending in length," was indefinite, as there were no "objective boundaries" for this term of degree; where applicant in prosecution distinguished some prior art as not "elongated," and provided no dimensions in the specification).

[16] *Markman v. Westview Instruments Inc.*, 517 U.S. 370, 373 (1996) (citation omitted) ("A claim covers and secures a process, a machine, a manufacture, a composition of matter, or a design, but never the function or result of either.").

[17] *Gen. Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364 (1938) (cited in *Nautilus*).

[18] *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1, 3-7 (1946).

[19] 35 U.S.C. § 112, ¶ 6. This provision allows "[a]n element in a claim for a combination" to be "expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof." But it instructs that "such[a] claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

[20] See *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 27–28 (1997) ("Congress enacted § 112, ¶ 6, in response to[*Halliburton Oil*].").

[21] *In re Hyatt*, 708 F.2d 712, 715 (Fed. Cir. 1983) ("The final paragraph of § 112 saves combination claims drafted using means-plus-function format from this problem[of non-enablement] by providing a construction of that format narrow enough to avoid the problem of undue breadth as forbidden by the first paragraph.").

[22] See, e.g., *Ergo Licensing LLC v. CareFusion 303 Inc.*, 673 F.3d 1361, 1363 (Fed. Cir. 2012) ("Failure to specify the corresponding structure in the specification amounts to impermissible pure functional claiming If an applicant does not disclose structure for a means-plus-function term, the claim is indefinite.").