

Post-Nautilus

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Biosig v. Nautilus, 715 F.3d 891 (CAFC 2013)

U.S. Pat. No. 5,337,753

- A “live” electrode and a “common” electrode “mounted . . . in a spaced relationship with each other”
- “Indefiniteness here would require a showing that a person of ordinary skill would find “spaced relationship” to be insolubly ambiguous—that it fails to provide sufficient clarity delineating the bounds of the claim to one skilled in the art.”
- Holding: Valid

Nautilus v. Biosig, 134 S. Ct. 2120 (2014)

- A heart rate monitor used for exercise (no decision on “spaced relation”, just overturned law and remanded)
 - “A patent is invalid for indefiniteness if its claims, read in light of the patent’s specification and prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.”
 - Overturns CAFC’s lenient “amenable to construction” and “insolubly ambiguous” tests
 - “Such formulations lack the precision that 112, ¶ 2 demands”
 - » “To tolerate imprecision just short of that rendering a claim ‘insolubly ambiguous’ would diminish the definiteness requirement’s public-notice function and foster the innovation-discouraging “zone of uncertainty”
 - » Remanded to lower courts

Biosig v. Nautilus, 785 F.3d 1374 (CAFC 2015)

U.S. Pat. No. 5,337,753

- A “live” electrode and a “common” electrode “mounted . . . in a spaced relationship with each other”
- “The 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”
- Holding: Still Valid

Types of Indefiniteness

1. Multiple interpretations
2. Antecedent basis
3. Means-plus-function
4. Term of degree
5. USPTO PTAB and others

Teva v Sandoz, 789 F.3d 1335 (CAFC 2015)

Multiple interpretations - U.S. 5,800,808

- “a method of manufacturing copolymer-1 . . . to result in copolymer-1 having a molecular weight of about 5 to 9 kilodaltons”
- “the claim term is indefinite if it ‘leaves the skilled artisan to consult the ‘unpredictable vagaries of any one person’s opinion’”
 - there was no express definition of the term molecular weight
 - each method of calculation was different and yielded a different result
- Holding: Invalid

Dow Chem. Co v Nova, 803 F.3d 620 (CAFC 2015)

Multiple interpretations - U.S. 5,847,053 & 6,111,023

- An ethylene polymer composition ... having: “A slope of strain hardening coefficient greater than or equal to 1.3”
- Applied Nautilus & Teva. The claim term is indefinite if it “leave[s] the skilled artisan to consult the ‘unpredictable vagaries of any one person’s opinion”
 - Different methods to determine the slope yield different results
 - There is no discussion on what method should be used to calculate the slope
- Holding: Invalid under Nautilus

Ethicon Surgery v Covidien (CAFC 2015)

Multiple interpretations - U.S. 5,847,053 & 6,111,023

- Claim 17 – An ultrasonic surgical shears comprising:
 - an ultrasonic blade;
 - a clamping arm operable to open and close the blade;
 - a tissue pad attached to the clamping arm, wherein the blade and tissue pad define the clamping surface area so that the applied clamp force does not exceed **a clamping pressure of 210 psi at the clamping surface area**; and
 - means for limiting a user applied clamping force on the clamping arm creating an average predetermined clamping pressure between and including 60 psi and 210 psi on tissue disposed between the tissue pad and the blade.
- Although district court found no method of consistently measuring as per different tissue types/conditions, a skilled artisan reading specification would know that it is the average force at the arm midpoint as DISCLOSED IN SPECIFICATION.
- Holding: Valid under Nautilus

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Adaptix v. AT&T (E.D. Tex. Mar. 24, 2014)

Antecedent basis - U.S. 6,947,748 & 7,454,212

- Claim 8 - “A method for subcarrier selection for a system employing orthogonal frequency division multiple access (OFDMA) comprising:

- a subscriber measuring channel and interference information for a plurality of subcarriers based on pilot symbols received from a base station;

- the subscriber selecting a set of candidate subcarriers;

- the subscriber providing feedback information on the set of candidate subcarriers to the base station;

- the subscriber sending an indication of coding and modulation rates that the subscriber desires to employ for **each cluster**; and

- the subscriber receiving an indication of subcarriers of the set of subcarriers selected by the base station for use by the subscriber.

- Narrowing construction to preserve validity applied to “each cluster”

- Holding: Valid under pre-Nautilus “amendable to construction” standard

Adaptix v. Huawei (E.D. Tex. Nov. 20, 2014)

Antecedent basis - U.S. 6,947,748 & 7,454,212

- Respective claim 8 and 9 - “the subscriber desires to employ for **each cluster**”
- *Nautilus* seems to prohibit the use of a “narrowing construction” to avoid a finding of indefiniteness (in tension with claim construction case law, which appears to be overturned)
- A lack of a clear antecedent basis for “each cluster” renders the claims indefinite
- Holding: Invalid under *Nautilus*

Types of Indefiniteness

1. Multiple interpretations
2. Antecedent basis
3. Means-plus-function
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Eon Corp. v AT&T (CAFC 2015)

Means-plus-function - U.S. 6,034,652 & 6,788,314

- The claimed invention was directed to software embodied in a “local subscriber data processing station”.
- The claims contained 8 terms at issue, which included, *e.g.*:
 - “means under control of said replaceable software means”
 - “means controlled by replaceable software means
 - “means responsive to said self contained software”
 - “means establishing a first menu”
- The parties agreed that the terms were “means-plus-function terms”
- The parties also agreed that all functions are performed by computer software

Eon Corp. v AT&T (CAFC 2015)

Means-plus-function - U.S. 6,034,652 & 6,788,314

- The patent contained no algorithms with the only disclosed structure in the specification being a microprocessor.
- Eon relied on *In re Katz Interactive Call Processing Patent Litigation*, 639 F.3d 1303 (CAFC 2011), which held “a standard microprocessor can serve as sufficient structure for ‘functions [that] can be achieved by any general purpose computer without special programming.’”
- Eon argued that the recited functions in the claims do not require “special programming” and thus the Katz exception applies.
- CAFC said that “special programming is any functionality that is not co-extensive with a microprocessor.
- Holding: Invalid under *Nautilus* and as before

Types of Indefiniteness

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Interval Licen. v AOL, 766 F.3d 1364 (CAFC 2014)

Term of degree - U.S. 6,034,652 & 6,788,314

- “selectively display, in an unobtrusive manner that does not distract a user of the display device”
- “A claim fails ... 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”
 - “The phrase ‘unobtrusive manner’ is highly subjective and . . . provides little guidance”
 - “The lack of objective boundaries in the claim language is particularly troubling in light of broad definition of image to mean any set of sensory stimulus produced from the set of content data”
- Holding: Invalid under Nautilus

DDR Holdings 773 F.3d 1245 (CAFC 2014)

Term of degree - U.S. 6,993,572

- “a data store including a look and feel description associated with a host web page”
- “A patent must, when “viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty”
 - evidence demonstrates that "look and feel" had an established, sufficiently objective meaning in the art
 - specification defined look and feel as “including logos, colors, page layout, navigation systems, frames, 'mouse-over' effects, or other elements consistent throughout host website”
- Remanded

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In re Packard, 751 F.3d 1307 (CAFC 2014)

PTAB - U.S. App. Ser. No. 12/004,324

- Coin change holder with many ambiguities
 - (“examiner here, having ample grounds, set forth a variety of ways in which he found the claims imprecise or confusing, sometimes not even understandable, considering them in light of the written description”)
- “well-founded prima facie case of lack of clarity (in its several forms)”
 - *e.g.*, M.P.E.P. § 2173.05(e) “a claim is indefinite when it contains words or phrase whose meaning is unclear”
 - M.P.E.P. § 2173.02(l) “in deciding whether a pending claim [is definite], a lower threshold of ambiguity is applied during prosecution”
- Holding: Not patentable

SAP v Lakshmi (PTAB 2014)

PTAB - U.S. 8,037,158

- “routed transactional data structure” not clear
 - data structure per se as term of art is ambiguous b/c too little context, no clear use of phrase in spec, or discussion of what/how exactly is routed, no object type disclosed
 - user routing versus data structure routing (e.g. “object routing”) but proprietary protocol not disclosed.
- “requires that [claims], viewed in light of the specification and prosecution history, inform those of skill in the art about the scope of the invention with reasonable certainty.”
- Determination is a subset of claim construction
- Holding: Invalid upon CBM USPTO post-issuance review

Ex Parte Breed 2012-003990 (PTAB 2014)

PTAB - U.S. 5,337,753

Functional language such as “can be” and “capable of” now scrutinized heavily or not patentable. See *Ex Parte Breed* Appeal No. 2012-003990 (PTAB 2014)

- Other functional language will suffer the same fate increasingly.

Facebook v TLI Com. 2014-00566 (PTAB 2014)

- PTAB – Refusing to institute IPR because “amenable to two or more plausible claim constructions” *Ex Parte Miyazaki* (B.P.A.I. 2008)
- Issues non-final indefiniteness determination
 - Mainly focusing on means-plus-function limitations
- Pending but stayed, or newly filed, district court finds indefinite because PTAB says so. (~80% of IPRs have concurrent district court proceedings).
- Holding: Invalid because of parallel proceedings and objectively expert opinion of PTAB “witness”.
- *See also* Ericson v. Intellectual Ventures 2014-011170, Microsoft v. Enfish 2013-00559, *etc.*

Regeneron v. Merus B.V. (S.D.N.Y. Nov. 21, 2014)

- Judge Forrest noted that “[t]he **specification never uses the term ‘endogenous mouse immunoglobulin locus’ and never informs the reader how to find the immunoglobulin locus.**” As such, “[o]ne would have had to guess and be lucky to get it right,” and thus “the ‘reasonable certainty’ required by the Supreme Court [in *Nautilus*] is lacking.” *Regeneron Pharm., Inc. v. Merus B.V.*, No. 14 1650 (KBF), 2014 BL 329370, at 17-19 (S.D.N.Y. Nov. 21, 2014) (*citing Nautilus*, 134 S.Ct. at 2124).

Types of Indefiniteness

1. Multiple interpretations CHANGED
2. Antecedent basis CHANGED
3. Means-plus-function LIKELY CHANGED
(ambiguity of whether 112f invoked)
4. Term of degree CHANGED (at least at PTAB)
5. USPTO PTAB and others CHANGED (at PTAB
and practically speaking, in district court)

Thanks for your attention. Questions?



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