

Supreme Court Paves the Way for Invalidating Vague Patents

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On Monday, June 2, 2014, the United States Supreme Court lowered the threshold for invalidating patents based on ambiguous claim language. In ***Nautilus, Inc. v. Biosig Instruments***, No. 13-369, the Supreme Court rejected the long-standing test formulated by the Federal Circuit that claims are indefinite only if they are “insolubly ambiguous.” Instead, the Supreme Court held that the proper test for definiteness is whether the claims “inform those skilled in the art about the scope of the invention with reasonable certainty.” Under the Supreme Court’s new test, claims that might have passed muster under the old test are more likely to be held indefinite, rendering them invalid.

Largely unchanged for more than 150 years, the definiteness requirement of the Patent Act currently mandates that each claim “particularly point[] out and distinctly claim[] the subject matter that the applicant regards as his invention.” 37 U.S.C. § 112. Claims that fail to meet this requirement are considered indefinite. This requirement necessitates that courts confront the tension created by using an inherently imprecise tool, language, to provide clear notice to the public of the scope of an invention. Ever since *Exxon Research & Engineering v. United States*, 265 F.3d 1371 (Fed. Cir. 2001), courts have found a claim indefinite only if it was “not amenable to construction” and “insolubly ambiguous.” That test resulted in great deference to the applicant’s choice of language. In contrast, the new *Nautilus* test raises the necessary level of specificity by requiring inventors to define the bounds of each claim with “reasonable certainty.”

This new standard likely will have a dramatic impact on how patent applications are prosecuted and how patent infringement lawsuits are litigated. Patent prosecutors must be ever more mindful of how patent applications define claim terms, and patent litigators must consider whether claim terms are precise enough to survive challenge under the new standard.

Anthony Wenn also contributed to this article.

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National Law Review, Volume IV, Number 156

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