

Did Teva Alter the Standard for Invalidating a Patent for Indefiniteness?

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As discussed in the concurrent article, prior to the Supreme Court's decision in *Teva Pharmaceuticals v. Sandoz, Inc.*, 574 U.S. ___, No. 13-854, slip op. (2015), the Court of Appeals for the Federal Circuit ("Federal Circuit") declined to give deference to district court judges' findings of subsidiary facts made during claim construction, as required by Federal Rule of Civil Procedure § 52(a)(6). Although the parties' dispute in *Teva* was whether the claims in *Teva's* patent were indefinite under 35 U.S.C. § 112, second paragraph^[i], the question before the Court was whether the Federal Circuit employed the proper standard of review of a district court's factual findings during claim construction^[ii]. The Court did not consider the underlying issue of indefiniteness, but rather it vacated the Federal Circuit's decision and remanded with explicit instructions on how to apply the appropriate standard of review.

In its last term, however, the Supreme Court specifically addressed the issue of indefiniteness. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 572 U.S. ___, 189 L. Ed. 2d 37(2014). In *Nautilus*, the parties disagreed over the meaning of the claim term "spaced relationship" used to describe the location of electrodes employed in an exercise apparatus. The accused infringer, *Nautilus*, argued that the term was indefinite when read in light of the specification and its accompanying drawings. The District Court agreed with *Nautilus* and concluded that the claim terms failed to inform one skilled in the art what the appropriate spacing was or how it should be determined. *Nautilus*, slip op. at 6-7.

On appeal, the Federal Circuit reviewed the district court's claim construction de novo^[iii]. The panel majority considered the intrinsic evidence and found that there were "certain inherent parameters of the claimed apparatus, which to a skilled artisan may be sufficient to understand the metes and bounds of 'spaced relationship.'" *Biosig Instruments, Inc. v. Nautilus, Inc.*, 715 F.3d 891, 897 (Fed. Cir. 2013). The majority also considered the extrinsic evidence of record and found that it supported the intrinsic evidence.^[iv] Accordingly, the Federal Circuit reversed and remanded with instruction that the claims were not indefinite if they were "amenable to construction" and not "insolubly ambiguous." *Nautilus* petitioned for certiorari.

The Supreme Court agreed to review the case and found that the Federal Circuit's aforementioned standards were imprecise and diminished "the definiteness requirement's public-notice function and foster[ed] the innovation-discouraging 'zone of uncertainty'." *Nautilus*, 572 U.S. slip op. at 12. The

Court unanimously held that “[a] patent is invalid for indefiniteness if the patent’s specification and prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention [emphasis added].” *Nautilus*, 572 slip op. at 1. In reaching its conclusion, the Court acknowledged that the limitations of claim language must be balanced with the need to provide incentives for innovation and the ability of applicants to claim the full scope of their inventions. However, the Court also recognized that a check on indefiniteness was needed to counter any temptation a patent applicant might have “to inject ambiguity into their claims” and later impermissibly broaden their claims,” *Nautilus*, slip op. at 10. Specifically, the Court stated that “[e]liminating that temptation is in order, and ‘the patent drafter is in the best position to resolve the ambiguity in...patent claims.’” *Nautilus*, slip op. at 10-11, quoting *Halliburton Energy Servs., Inc. v. M-I LLC*, 524 F.3d 1244, 1255 (Fed. Cir. 2008).

The Court vacated the Federal Circuit’s decision and remanded for determination of the claims indefiniteness under the new standard.

The Supreme Court’s holding that the claims, in combination with the intrinsic evidence, must inform the artisan of the scope of the invention with “reasonable certainty,” lowered the bar for invalidating a patent for indefiniteness. Thus, after *Nautilus*, it seemed as though patent practitioners were well advised to take care to draft both applications and claims with clear and precise language in order to preserve their patents’ validity.

In *Nautilus*, the Court emphasized the crucial role of intrinsic evidence; i.e., the words of the claims, the specification, and the prosecution history, in determining whether claims satisfy the requirements of § 112, second paragraph, and focused on the need to reduce the temptation of patent drafters to inject ambiguity into the claims.^[v] The Court made no mention of the role extrinsic evidence plays in determining whether claims are indefinite.

In *Teva* however, the Court appears to sanction the introduction of extrinsic evidence to resolve ambiguous claim language. That is, rather than finding conflicting expert testimony on the meaning of the terms in the claims at issue to be indicative of indefiniteness, the Court held that a district court judge’s use of extrinsic evidence during claim construction is to be given deference on appeal and only reviewed for clear error (Fed. R. Civ. Proc. 52(a)(6)). Thus, under *Teva*, it is not imperative that all claim terms be defined in the specification. Instead, experts can be employed to define terms in a manner that supports a party’s prosecution or litigation strategy.

Granted, the Supreme Court stated that “subsidiary fact finding is unlikely to loom large in the universe of litigated claim construction.” *Teva*, slip op. at 10. To that end, the court envisions the use of extrinsic evidence to be limited to background scientific information and the explanation of technical terms. *Teva*, slip op. at 12. However, the *Teva* opinion invites courtroom behavior to the contrary. That is, after *Teva*, litigants are more likely to use expert testimony to challenge the definiteness of even the simplest claim terms if they can obtain a claim construction that is favorable to their client. And, district court judges wanting to ensure that their claim construction is not reversed on appeal, will now be motivated to permit entry of such testimony during Markman (claim construction) hearings. However, the more a district court finds it necessary to rely on extrinsic evidence to construe claims, the less likely it is that a patent’s specification and prosecution history inform, with reasonable certainty, those skilled in the art about the scope of the invention. See *Nautilus*, slip op. at 1. Should the *Teva* decision lead district courts to permit the entry of more extrinsic evidence in claim construction, then perhaps the Federal Circuit’s original test of indefiniteness (i.e., “amenable to construction” or not “insolubly ambiguous”) was more judicious than the Supreme Court recognized.

[i] 35 U.S.C. § 112, second paragraph, requires that the claims particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

[ii] The issue before the Supreme Court in *Teva* was: Whether a district court's factual finding in support of its construction of a patent claim term may be reviewed de novo as the Federal Circuit requires (and as the panel explicitly did in this case) or only for clear error, as Rule 52(a) requires?

[iii] The District Court held a Markman hearing and construed the Biosig patent claims. Following the claim construction, Nautilus filed a motion for summary judgment arguing that based on the district court's construction of "spaced relationship," the claims were indefinite. The District Court agreed

and granted the motion. Biosig appealed. The issue before the Federal Circuit was whether the District Court erred in holding the patent invalid for

indefiniteness and, consequently, in granting the motion for summary judgment. *Biosig Instruments, Inc. v. Nautilus, Inc.*, 715 F.3d 891, 897 (Fed. Cir.

2013).

[iv] The extrinsic evidence of record included a declaration (1) submitted by the inventor (Mr. Lekhtman) during a reexamination proceeding before the USPTO describing some of his own tests as well as tests performed by another laboratory (Dr. Galiana) and; (2) to support the opposition to the motion

for summary judgment (Dr. Yanulis) which supported Mr. Lekhtman's and Dr. Galiana's test results and reports.

[v] The Supreme Court also acknowledged that another relevant inquiry was the perspective or understanding of the claims by one skilled in the art at the time the patent application was filed.

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