

# Klarquist

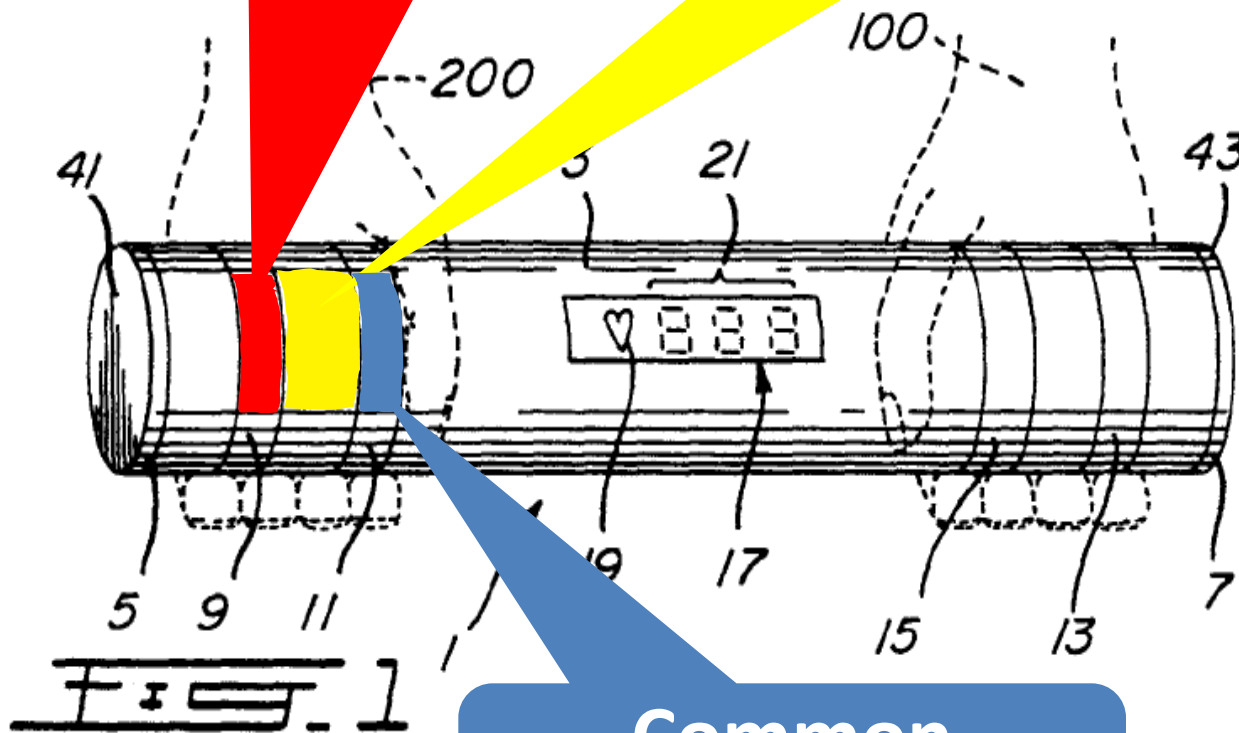
## *Nautilus:* Definiteness and Functional Claiming

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# Nautilus: Old Design ... Better Result?

Live electrode

“Spaced  
Relationship”



Common  
electrode

# Nautilus: Is “Spaced Relationship” “Functional”?

1. A heart rate monitor for use by a user in association with exercise apparatus and/or exercise procedures, comprising;

an elongate member;

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a first live electrode and a first common electrode mounted on said first half in spaced relationship with each other;

a second live electrode and a second common electrode mounted on said second half in spaced relationship with each other;

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whereby, a first electromyogram signal will be detected between said first live electrode and said first common electrode, and a second electromyogram signal, of substantially equal magnitude and phase to said first electromyogram signal will be detected between said second live electrode and said second common electrode;

# Nautilus: Zone of Uncertainty

- If “spaced relationship” is itself functional, then:
  - ❑ Artisans could safely explore different techniques (e.g., new materials) for achieving claimed result with this old design.
- But if “spaced relationship” is not functional, then:
  - ❑ No way of achieving claimed result with this old design would be safe.



# Nautilus: Impact?

- Court's Phrasing: “clarity and precision demand;” “clear notice;” “reasonable certainty”
- Not *Post Hoc*: Rejects *post hoc*, claim-construction-first, hindsight approach
  - ❑ Do not first construe claim and then ask whether crystal ball showing that construction would have provided sufficient notice to artisan.
- How Precise?: Not “absolute precision.” But, must claim be as precise as the subject matter permits?



# Nautilus: Prohibits Ambiguous Claims

- Court: “the Federal Circuit’s formulation, which tolerates some ambiguous claims but not others, does not satisfy the statute’s definiteness requirement.”
- Court: “[A]bsent a meaningful definiteness check, we are told, patent applicants face powerful incentives to inject ambiguity into their claims. Eliminating that temptation is in order.” (Citations omitted).
- ❑ Claims are indefinite when “‘might mean several different things’” and “‘no informed and confident choice is available among the contending definitions.’” *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364 (Fed. Cir. 2014).

# Nautilus: Supports *In re Packard*

- “when the USPTO has initially issued a well-grounded rejection that identifies ways in which language in a claim is ambiguous, vague, incoherent, opaque, or otherwise unclear in describing and defining the claimed invention, and thereafter the applicant fails to provide a satisfactory response, the USPTO can properly reject the claim as failing to meet the statutory requirements of § 112(b).” *In re Packard*, 751 F.3d 1307 (Fed. Cir. 2014).

# Nautilus: Supports *In re Miyazaki*

- Prohibits Ambiguity: “we hold that if a claim is amenable to two or more plausible claim constructions, the USPTO is justified in” rejecting the claim as indefinite. *In re Miyazaki*, 89 USPQ2d 1207 (BPAI 2008) (precedential).



# Recommendation 1

- **Challenge common sources of ambiguity:**
  - ☐ Preambles that maybe are limitations
  - ☐ Language that maybe triggers Sec. 112(6/f)
  - ☐ Terms that maybe are functional

# Recommendation 2

- **Argue that purely functional element invalidates a claim:**
  - ❑ A claim may not contain a “purely functional claim element with no limitation of structure” in the claim (expressly or under Sec. 112, ¶ 6), whether or not at the point of novelty. *In re Miyazaki*, 89 USPQ2d 1207 (BPAI 2008) (precedential) (“the claimed ‘sheet feeding area operable to feed ...’ is a purely functional recitation with no limitation of structure” and thus unpatentable for lack of definiteness and lack of enablement).

# Recommendation 3

- **Argue that post-issuance events (e.g., reexam) cannot cure lack of clarity:**
  - ❑ Argue that post-issuance disclosures and prosecution history cannot cure lack of clarity in claims. Seems to follow from Court's admonition that clarity is measured from viewpoint of person of skill in the art "at the time the patent was filed," "not that of a court viewing matters post hoc." *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120 (2014).

# Recommendation 4

- **Challenge attempts to treat a result as a function:**
  - ❑ Sec. 112(f): “a means or step for performing a specified function”
  - ❑ Doctrine of Equivalents: “if it performs substantially the same function in substantially the same way to obtain the same result.”