

## “Reasonably Certain” is Definite Enough

Patents are required to be written in a way that puts the public on notice of the boundaries of the claimed invention. More specifically, the patent claims must “particularly point out and distinctly claim the subject matter which the applicant regards as the invention.” This is known as the definiteness standard. If a patent does not meet this standard, then it is invalid for indefiniteness and cannot be enforced.

Recently, in *Nautilus, Inc. v. Biosig Instruments, Inc.* the Supreme Court of the United States held that the Court of Appeals for the Federal Circuit (“CAFC”), which hears all appeals related to the enforcement of a patent, set too low of a bar when it comes to the definiteness standard. 572 U.S. \_\_\_\_ (2014). The CAFC required only that the claims were “amenable to... [being defined] and were not “insolubly ambiguous”. The Supreme Court found that some claims that met the CAFC definiteness standard could still be ambiguous enough that the interested public would not be on notice of what the patent actually protected. To remedy the situation, the Supreme Court set forth a new standard which states that a “[p]atent is invalid for indefiniteness if its claims...fail to inform, with *reasonable certainty*, those skilled in the art about the scope of the invention.”

Despite the Supreme Court’s best efforts to set a decisive definiteness standard, the phrase “reasonable certainty” is open to interpretation. What this phrase actually means will be decided in the federal trial courts and the CAFC. The first step in determining the meaning of this phrase was taken in the case *Interval Licensing LLC v. AOL, Inc.* Nos. 13-1282, -1283, -1284, -1285, (Fed. Cir. Sep. 10, 2014).

Interval Licensing (“Interval”) had two patents directed to using the display space of an internet connected device, such as a computer, tablet or phone, to display advertising content. The claims stated that the ads are to be displayed in an “unobtrusive manner that does not distract a user of the [device] from [its] primary [use].” The CAFC explained that “unobtrusive manner” was a term of degree, and under the new definiteness standard, it must set an objective boundary that a person having ordinary skill in the art (“PHOSITA”) would understand. First, the CAFC found that the claim language itself was highly subjective because it depended on the opinion of each individual user. Second, the CAFC found that the written description did not provide an objective boundary because it used the term to describe both the wallpaper version and the screensaver version of the invention. The wallpaper version was based on using parts of the display not taken up by the user’s primary use of the display, and the screensaver version was based on using the display when the user was not using it for its primary use. The CAFC found that the former set an objective boundary but the latter was too subjective for a PHOSITA to determine when the ads would be displayed. Lastly, the CAFC found that the prosecution of the patent at the patent office did not provide an objective boundary because Interval had argued that “unobtrusive manner” applied to both the wallpaper and the screensaver versions.

In conclusion, the CAFC held that the new definiteness standard does not require the claim to state boundaries with mathematical precision and that a term of degree can be “reasonably certain”. However, a term of degree must set an objective boundary that would

allow a PHOSITA to determine what would and would not be covered by the patent. This is in contrast to past cases which found that just some discernible boundary would be sufficient.

In drafting patent claims, we at Wood Phillips stay abreast of the current law to ensure that our clients' rights are protected. If you have questions about the scope of the rights available to protect your invention please contact an attorney at Wood Phillips.