

**Evidentiary, My Dear Watson**  
*Biosig, Instruments v. Nautilus, Inc.*

In *Biosig, Instruments v. Nautilus, Inc.*, a unanimous panel of the Federal Circuit had little trouble deducing the definiteness of the patent at issue despite a lower court finding it “insolubly ambiguous.” Using both intrinsic and extrinsic evidence, the *Biosig* court found the patent term “spaced relationship” amenable to construction – and thus an improbable suspect for summary judgment on indefiniteness grounds.

The patent at issue in *Biosig* covers a heart rate monitor used for exercise equipment. Patent holder Biosig claims for infringement date back to 2004, when it first brought an action against fitness manufacturer Nautilus. During that time, Nautilus twice sought reexamination using the exact same piece of prior art. Both times, the PTO confirmed the validity of the patent, without amendment. Biosig then refiled the case it had voluntarily dismissed without prejudice pending the first two reexams. In response, Nautilus again sought reexamination relying, once again, on the identical prior art. The PTO finally denied this third request for reexamination.

In the meantime, however, the district court granted Nautilus’ motion for summary judgment. The district court found as a matter of the law that the term “spaced relationship” in Biosig’s claim limitation rendered the patent invalid for indefiniteness because it inadequately defined the necessary placement of the key sensors the term sought to describe. Biosig appealed.

On appeal, the Federal Circuit panel held that the district court had incorrectly applied the test for determining indefiniteness under section 112. A claim is invalid for indefiniteness only when “it is not amenable to construction” or “insolubly ambiguous.” Because the district court construed the claim “spaced relationship” as meaning some defined relationship between the invention’s two key sensors it had, necessarily, found the claims amendable to construction. As a result, the conclusion of indefiniteness was wrong as a matter of law.

Furthermore, the appeals court found that the district court had failed to properly consider both intrinsic and extrinsic evidence that helps to define the disputed “spaced relationship” term. The panel found that that the patent’s

intrinsic claim language, specification and the figures illustrating the “spaced relationship” provide sufficient clarity to skilled artisans as to the bounds of that term. Additionally, the court looked to evidence developed during the reexamination history that had also become part of the intrinsic record. That evidence, which explained the specific level of understanding and skill held by an artisan skilled in the making of heart rate monitors, further helped define the “spaced relationship” term – as did similar extrinsic evidence considered by the court. Interestingly, the panel had no problem with the fact that some additional testing would be required by an artisan to determine the best location, stating “we have not insisted that claims be plain on their face in order to avoid a determination of invalidity for indefiniteness.” (But the court did, however, suggest the issues raised by Nautilus might be viewed differently in a validity challenge based on enablement.)

In *Biosig*, the curious incident of multiple reexaminations ended up providing a crucial clue in the whodunit of the district court’s (as yet) unwarranted purloining of patentability. Because it occurred during a prosecution extended by reexamination, the declaration the inventor submitted to overcome the cited prior art ended up becoming part of the intrinsic record of the patent – something that would not have held true had the same arguments been made during the litigation that had been pending when the reexamination was requested. Did the alleged infringer then end up supplying the very evidence that tipped the scales in favor of the patent holder? The answer is elementary.

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