



Intellectual Property Law Section

State Bar of Texas

Spring 2015

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Update From The Chair

By Kristin Jordan Harkins

I am pleased to welcome you to this edition of the IP Law Section newsletter which is also my last as your Chair. I am honored to have served as your chair and to now reflect upon the many accomplishments of the IP Section this past bar year. And I am confident that the Section will continue to be strong and vibrant under my successor Steve Koch's leadership.



The IP Section has continued its tradition of offering the finest IP CLEs, beginning with the Advanced Patent Litigation CLE in July 17-18, 2014 in San Antonio, followed with the 28th Annual Advanced Intellectual Property Law Course in Houston in March 2015. The CLE year culminated with the Annual Meeting CLE in San Antonio on June 18 – 19, 2015. The Course Directors, Scott Breedlove, Hope Shimabuku and Steve Koch worked tirelessly to put together these quality programs. And Paul Morico, the Section's immediate past chair, has

organized the 2015 Advanced Patent Litigation CLE which will focus on the anatomy of a patent case. Please plan to attend this CLE at the Four Seasons in Las Colinas on July 23-24.

During this year's Annual Meeting, the Section hosted its business meeting luncheon where it recognized and honored the Section's award recipients, including the Tom Arnold Lifetime Achievement Recipient, the Inventor of the Year, and the Women and Minority Scholarship Recipients.

With respect to other accomplishments during this past bar year, in October 2014, the IP Section filed an Amicus Brief with the U.S. Supreme Court in the trademark case, *B&B Hardware, Inc. v. Hargis Industries, Inc.* Many thanks to the trademark law experts in the Section which supported this effort, and a very special acknowledgement and thank you to Richard Stanley and to Jack Goldstein who tirelessly drafted and filed the Amicus Brief on behalf of the Section.

I hope you have taken advantage of the Section's new website which has been revamped under the very capable leadership

of Nicole Sallie Franklin. Many thanks also to the Council, Officers, Committee Chairs and other section members who contributed their time in reviewing and commenting on the organization of the new website. Committee pages are also being added to assist in furthering the committee work and communications.

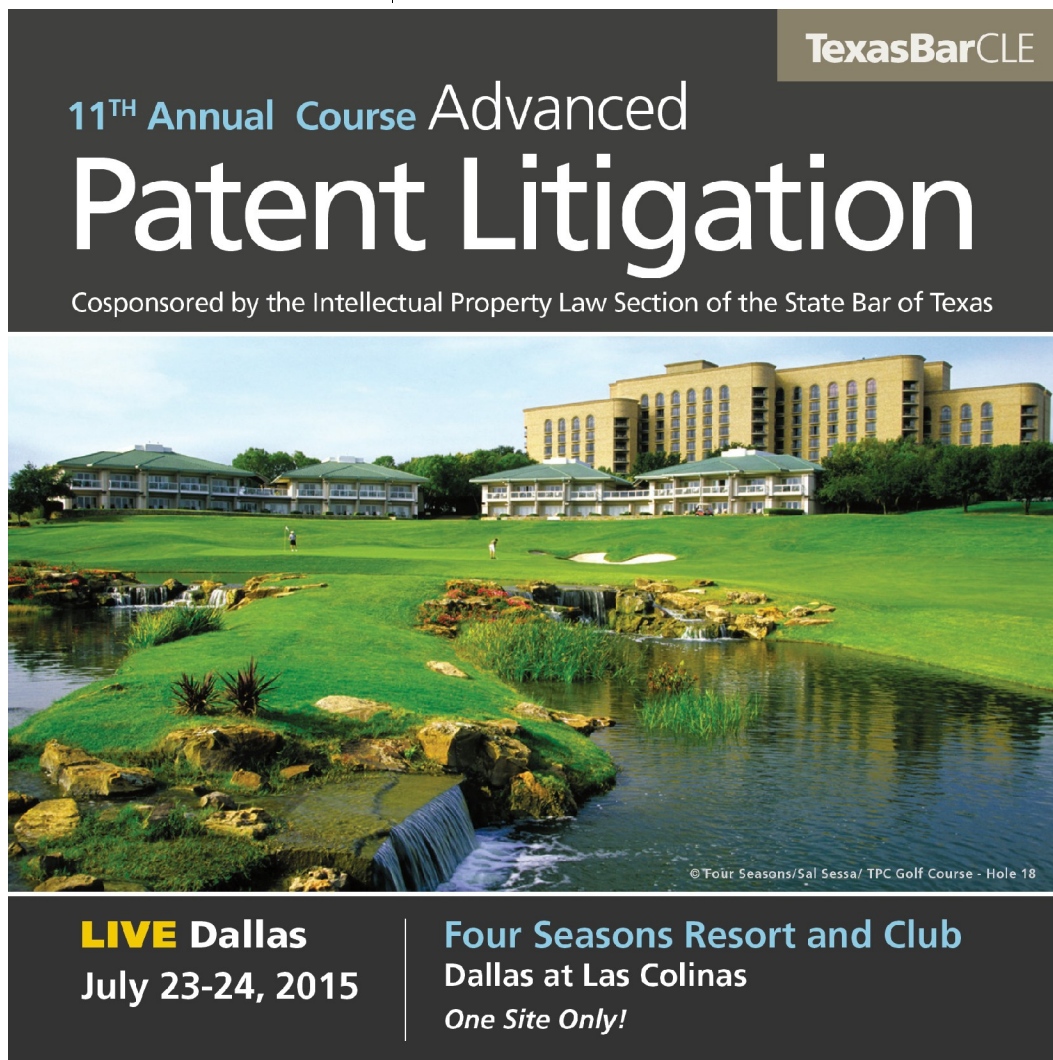
The standing substantive law committees which were reduced last year to four -patent, trademark, trade secrets and copyright- have encouraged more active member involvement by having these broader-based committees.

The newly added member services committee, the New Lawyers Committee, has hosted networking events in Houston and Dallas, and has plans to hold similar events in Austin and San Antonio. And the Women in IP Law Committee continues the tradition of hosting its breakfast during the Advanced IP CLE and this year's speaker provided great encouragement for women in Science and Engineering.

Last month, our Section's leadership participated in our second annual retreat, this year held at Travaasa in Austin on May 1 - 2. Almost all of the Section Officers, Council and

Committee Chairs participated in the two half-day retreat where the Section's recent past initiatives were evaluated and plans were made for this next bar year.

I would like to take this final opportunity to thank all of the Officers, Council, Committee Chairs and members that contributed to the Section's achievements this year. Much was accomplished and the relevance of the IP Section to its members continues.



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Mark Your Calendar

On June 29, Baker Botts will sponsor a **Young Lawyers Reception** at the JW Marriot (Austin) on behalf of the New Lawyers Committee of the SBOT IP Section, the Austin Local Networking Subcommittee of the AIPLA New Lawyers Committee, and the Austin IP Law Association. For details, visit <https://www.facebook.com/events/101793116824037>. To RSVP, email jennifer.nall@bakerbotts.com.

On September 24-26, the **Houston Intellectual Property Law Association** will hold its annual IP Institute at the Moody Gardens Hotel in Galveston. For more information, go to www.hipla.org.



In The Section

New Lawyers Committee Kick-Off Event

The New Lawyers Committee had its kick-off event on March 18, 2015 at MKT Bar in Houston. About 40 attendees, including law students, young lawyers, and experienced practitioners from around the state attended the event. Steve Koch, Chair Elect of the

SBOT IP Law Section, gave the opening remarks. The attendees were asked to wear a color-coded sticker to signify the number of years of legal experience they had as an ice breaker exercise. Thanks to all who attended. If you're interested in serving in a leadership role for the New Lawyers Committee, please contact [Priya Prasad](#) or [Bhaveeni Parmar](#).



Kristin Jordan Harkins, Chair of the SBOT IP Section, and Sarah Harris, General Counsel of the USPTO, also attended the New Lawyers kick-off.



Attendees at the New Lawyers Committee kick-off event.

Section Member Profiles

The following section members were asked to answer questions about their professional and personal life. These questions were:

- Where do you work?
- Describe your legal practice?
- If I weren't an attorney, I would be...
- My favorite (or dream) vacation is...
- In my spare time, I enjoy...
- The best dessert in the world is...
- My favorite movie is...
- If I won the lottery, I would...
- I recommend reading...
- Most SBOT IP Section members probably don't know that...
- You forgot to ask me about...

Adam Davenport

Work? Slater & Matsil, L.L.P.
in Dallas

Legal practice? I am a patent attorney that practices in patent prosecution, litigation, licensing, and opinion work, usually in high technology areas.



If I weren't an attorney, I would be... A rancher.

My favorite (or dream) vacation is... anywhere that I can be out in a wide open space with little to do but enjoy a slower pace.

In my spare time, I enjoy... spending time with my son and wife, usually at the park.

The best dessert in the world is... red velvet cake.

My favorite movie is... *Monty Python and the Holy Grail*.

If I won the lottery, I would... invest the money.

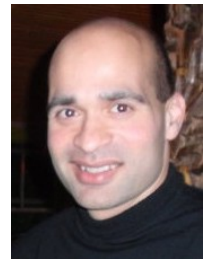
I recommend reading... *Things that Matter* by Charles Krauthammer.

Most SBOT IP Section members probably don't know that... I grew up on a dairy in North Texas. It was great experience for me to learn the value of hard work and discipline, but also great motivation for me to get my electrical engineering and law degrees.

You forgot to ask me about... my second favorite thing to do in my spare time. I can be fairly handy around the house. I still refuse to hire anyone to mow my lawn (unless I am away for an extended period), and I did a significant amount of the demolition and remodeling work when my wife and I recently re-modeled our house.

Charles Kulkarni

Work? The University of Texas M. D. Anderson Cancer Center.



Legal practice? I support the negotiation of research contracts at MD Anderson. Because MD Anderson Cancer Center is one of the leading cancer treatment centers in the world, many organizations and companies are interested in sponsoring cancer research here. MD Anderson has over 2,000 research faculty here engaged in some really innovative and cutting edge research, so naturally, we have quite a sizeable legal group here that supports that effort.

If I weren't an attorney, I would be... a chemical engi-nerd, my prior career before jumping into law.

My favorite (or dream) vacation is... travelling to visit friends in faraway countries. Visiting faraway places is always more fun when you have a local guide to show you around.

In my spare time, I enjoy... jogging and learning languages.

The best dessert in the world is... a freshly baked waffle, sprinkled with powdered sugar, topped with a scoop of ice cream, and garnished with a strawberry – shared with a friend of course! Simple, yet ever so tasty!

My favorite movie is... *La Grande Séduction*. It's a wonderfully charming movie about a tiny fishing village in Canada that pulls out all of the stops to lure a doctor to take up full-time residency on their island so that the island can qualify as a site for a much-needed new factory to restore employment to the area. Interestingly, this Canadian film turned out to be a well-known smash-hit in the province of Quebec where it was produced, but received little press here in the States. I have yet to meet anyone who has been disappointed by this film.

If I won the lottery, I would... travel the world and enjoy learning new languages.

I recommend reading... For sheer enjoyment value, anything by Douglas Adams. On the legal side of things, my two favorite contracting books are *Negotiating and Drafting Commercial Boilerplate* by Tina L. Stark (one of my legal heroes) and *Getting to Yes: Negotiating an Agreement Without Giving In*.

Most SBOT IP Section members probably don't know that... I came to the States when I was adopted from Canada at the early age of six. My interest in languages is partially inspired by my homeland having two national languages, English and French. As a French speaker, I happen to organize weekly conversation dinner meetups

opportunities in the Houston area. My group has grown to over 1,700 French speakers. If you happen to speak somewhat passable French, feel free to come out and join us anytime (<http://goo.gl/5P6jp5>). For the past three years, I've been slowly learning German, but I'm finding that to be a slow process as German is proving a lot tougher than French for me.

You forgot to ask me about... some of the things I find interesting about working for MD Anderson Cancer Center.

MD Anderson Cancer Center is actually part of The University of Texas System, which is actually a Texas government agency. Because of this, MD Anderson is subject to all sorts of interesting special statutes and other limitations based on its status as a part of the State of Texas. From a legal standpoint, I find government contracting absolutely fascinating due to the numerous "gotchas" that simply aren't present in the more typical private contracting arena (e.g. sovereign immunity, government agency limitations, etc). Plus, working at MD Anderson affords me the opportunity to learn about healthcare industry which is quite different from my prior experience in the oil and gas industry.

The State Bar of Texas Intellectual Property Law Section has over 2000 members and the Newsletter Committee is eager to get to know each of you! To this end, each newsletter will publish the profiles of one or two members providing information on where the member works, their practice area, interests and other fun facts! If you are interested in being profiled, send an email to the Newsletter Committee at texasbaripsection.newsletter@gmail.com and we will email you a questionnaire.

Call for Submissions

The IP Section Newsletter is a great way to get published! The Newsletter Committee welcomes the submission of articles for potential publication in upcoming editions of the IP Law Section Newsletter, as well as any information regarding IP-related meetings and CLE events. If you are interested in submitting an article to be considered for publication or add an event to the calendar, please email your submission to texasbaripsection.newsletter@gmail.com.

Article Submission Guidelines:

STYLE: Journalistic, such as a magazine article, in contrast to scholarly, such as a law review article. We want articles that are current, interesting, enjoyable to read, and based on your opinion or analysis.

LENGTH: 1-5 pages, single spaced.

FOOTNOTES AND ENDNOTES: Please refrain! If you must point the reader to a particular case, proposed legislation, Internet site, or credit another author, please use internal citations.

PERSONAL INFO: Please provide a one-paragraph bio and a photograph, or approval to use a photo from your company or firm website.

If you are interested in submitting an article for publication or to calendar an event, please email your submission to texasbaripsection.newsletter@gmail.com.



Practice Points

What is the “Job” of a Lawyer?

By Stephen Koch

The question on its face was simple and straightforward: “What should I be thinking about as I start my new in-house position?”

I am sure my initial response was unintelligible - after all we were at a State Bar IP Section social event and at such times serious questions do not usually accompany our liquid refreshments. But while stumbling around for an answer that sounded like the wise counsel derived from years of experience the questioner hoped to hear, two important thoughts did come to mind. The answer was in fact simple and straightforward, but the question was neither what the new in-house attorney intended to ask, nor was the question’s answer the information she really needed to hear.

As with any attorney starting a new position, in-house or with a firm, experienced or new-to-the-profession, the thought process for starting a new position is not complicated – learn the job, learn the clients, learn your management, get to work. With time and with experience, the subtleties of the law and the profession will become second nature to the attorney wanting to develop into a dedicated professional.

But what really is the role of an attorney? What really is the job that should be first and foremost in the mind of any attorney, experienced or not?

I remembered back to words I heard long ago from one of my first mentors, words that he had heard long before from his mentors. The role of an attorney – the foremost job of an attorney – has three parts: Ensure that the client’s business is fully consistent with the law; Ensure that the client’s business is fully consistent with his organization’s policies and procedures; Ensure that the business decisions the client makes stand up to a legal “Does this make sense for the business” analysis.

Each of these phrases also sound simple and straightforward, but they all require that we think in a different way than we do when we carry out the routine daily aspects of our jobs. These phrases require us to apply the broader facets of the legal education we have received to the higher level at which we are trained and intended to be thinking.

Keeping the client’s business consistent with the law – or, more bluntly stated, keeping our client out of jail – has the usual, fairly obvious, aspects. How do antitrust and competition law considerations impact, or potentially impact, business decisionmaking? What regulatory processes need to be considered and/or reflected in business strategies? How do labor and employment laws and regulations apply to the client’s business?

But those are, as stated, the fairly obvious aspects of client counseling. We also need to ensure our clients are up-to-date on changes in the law. In the IP business, the passage of the AIA required many of us to re-educate our clients on patent processes under US law. That re-education will need to continue for quite a number of years as the new post-issuance proceedings become more common, and more mature, processes in IP practice in the United States.

It is not only laws that come to us from

Washington D.C. that we need to educate our clients on. Texas enacted a new trade secrets statute two years ago – have you briefed your clients on what it contains, what it might mean to their business? Should you?

Our clients can also run afoul of their own organization’s policies, procedures, and guidelines. Keeping clients on the straight and narrow with their internal “statutes and regulations” is just as important as keeping them on the straight and narrow with federal and state strictures (In this arena they may not go to jail, but the client could get fired – perhaps just as bad from his perspective). In the international marketplace companies are today faced with an ever-changing set of export and sanctioned party rules deriving from all sorts of international challenges. Do our clients understand those changes? Have their corrupt practices guidelines and customer interaction requirements been reviewed in the context of those changes?

Keeping the client’s business consistent with the law – or, more bluntly stated, keeping our client out of jail – has the usual, fairly obvious, aspects.

The changing set of rules also impact financial transactions and parties involved in the financial and banking businesses - have internal procedures been updated with that focus in mind? Do our clients understand the implications to the financial aspects of their businesses?

The final aspect of an attorney’s job is one that can only be developed with time and experience. Attorneys need to learn how and when to “stick their nose into their client’s business,” and tell them that a decision needs to be reconsidered. Not all clients will like their attorney doing so; some clients will really, really not like it. Attorneys need to learn the difference between when a business decision is merely a bad decision – which clients are allowed to make – and when a business decision potentially risks the business – which perhaps clients are also

allowed to make but which attorneys should challenge more vociferously. New attorneys will have difficulty with this aspect of client counselling, which requires time and experience to do well. But with that time and experience, an attorney's development of a sixth-sense skill of business counselling will become a valuable resource for his own development and for support of his client.

What I could have said to my questioner at the IP Section Social event was that there are three simple things to keep in mind: Will what the client wants to do: 1) get him sent to jail? 2) get him fired? or 3) risk the business?

At the most basic level that is what we should be doing every day we are in our offices. That's what I will say next time.

The above article expresses the view of the author and not necessarily that of the State Bar of Texas IP Law Section.



Stephen Koch will retire in July 2015 after 34 years with Exxon Mobil Corporation, the last twenty-two of which were with the Exxon Mobil Law Department. Steve specialized in international transactions, in both the Upstream Oil and Gas arena, and in Intellectual Property Licensing. His most recent assignment was as General Counsel of Univation Technologies, LLC. He will miss many aspects of corporate legal life, but in particular the opportunity he has had to mentor young attorneys.

(Re)defining Indefiniteness

By Brandy S. Nolan

Under 35 U.S.C. § 112(b), a patent must “conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.” This is known as the definiteness requirement. The primary purpose is to ensure that the claims, read in light of the specification by a person having ordinary

skill in the art, “adequately perform their function of notifying the public of the scope of the patentee’s right to exclude.” *Hearing Components, Inc. v. Shure Inc.*, 600 F.3d 1357, 1367 (Fed. Cir. 2010). The definiteness requirement also facilitates a potential competitor’s determination of whether or not a course of action would infringe a patent and “guard[s] against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their respective rights.” *Exxon Research & Engineering Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001); *Athletic Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1581 (Fed. Cir. 1996).

Until recently, a claim would have failed to meet the definiteness requirement, and therefore could have been found invalid during litigation, if its terms were “not amenable to construction” or “insolubly ambiguous.” E.g., *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed. Cir. 2005). This formulation of the definiteness inquiry focused on whether the terms of a claim could be given “any reasonable meaning,” no matter how formidable the task. *Id.* at 1347. If some “narrowing construction” could be adopted, though it may be one over which reasonable persons could disagree, a claim could potentially pass the threshold of definiteness. *Exxon*, 265 F.3d at 1375. Courts were of the mindset that limiting declarations of indefiniteness to those circumstances in which claim construction proves futile accorded respect to the statutory presumption of a patent’s validity, protected the inventive contribution of patentees when drafting has been less than ideal, and aligned with the requirement that clear and convincing evidence be shown to invalidate a patent. *Datamize*, 417 F.3d at 1347–48.

Last year, in *Nautilus, Inc. v. Biosig*

Instruments, Inc., the Supreme Court criticized the Federal Circuit’s “insolubly ambiguous” standard as being too amorphous and falling short of the demands of §112. 134 S. Ct. 2120, 2131 (2014). “To tolerate imprecision just short of that rendering a claim ‘insolubly ambiguous,’” according to the Supreme Court, “would diminish the definiteness requirement’s public-notice function and foster the innovation-discouraging ‘zone of uncertainty’ against which this Court has warned.” *Id.* at 2130.

In support of this conclusion, the Supreme Court cited, for example, three Federal Circuit decisions analyzing the definiteness of terms of degree. *Id.* at 2130 n.9. One case was *Datamize, LLC v. Plumtree Software, Inc.*, in which the Federal Circuit considered the specification, prosecution history, and extrinsic evidence, and then affirmed the district court’s holding that the phrase “aesthetically pleasing” was indefinite. 417 F.3d at 1352–56. Although “aesthetically pleasing” had an ordinary meaning that could be understood (e.g., “beautiful”), there was no “objective anchor” that would allow the public to determine the scope of the claimed invention. *Id.* at 1348, 1350. Another case was *Hearing Components, Inc. v. Shure Inc.*, in which the Federal Circuit relied upon the analytical framework set out in *Datamize* and examples in the written description to reverse a district court’s holding that the phrase “said wax guard being readily installed and replaced by a user” was indefinite. 600 F.3d at 1367–68. This is because “[t]he specification clearly supplie[d] some standard for measuring the scope of the phrase.” *Id.* at 1368. The third case was *Exxon Research & Engineering Co. v. United States*, where the Federal Circuit looked to intrinsic evidence from the

perspective of one skilled in the art to, for example, reverse the district court’s indefiniteness holding concerning the phrase “for a period sufficient.” 265 F.3d at 1378–80. According to the Federal Circuit, although “some degree of experimentation” might be necessary to determine the boundaries of the disputed phrase, such phrase was still “reasonably precise in light of the subject matter.” *Id.* at 1379–80.

The Supreme Court looked at the Federal Circuit’s recent decisions and concluded that a definiteness analysis demands a more “reliable compass,” a test more “probative of the essential inquiry.” *Nautilus*, 134 S. Ct. at 2130. The answer: “reasonable certainty.” According to the Supreme Court’s *Nautilus* decision:

Does “reasonable certainty” demand a substantive change in how definiteness is analyzed, or is it simply better nomenclature for a deeper inquiry already used by federal courts?

[A] patent is invalid for indefiniteness if its claims, read in light of the specification delineating

the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.

Id. at 2124. Further, courts were guided to read the claims in light of the patent’s specification and prosecution history measured from the viewpoint of a person skilled in the art at the time the patent was filed. *Id.* at 2128.

This raises a logical question: Does “reasonable certainty” demand a substantive change in how definiteness is analyzed, or is it simply better nomenclature for a deeper inquiry already used by federal courts? Federal Circuit definiteness decisions before and after the *Nautilus* decision offer some insight.

Immediately prior to the *Nautilus* decision, the Federal Circuit issued an order using

foretelling language in *Ancora Technologies, Inc. v. Apple, Inc.*, 744 F.3d 732 (Fed. Cir. 2014). In *Ancora*, the Federal Circuit decided it could reject the defendant's indefiniteness challenge without waiting for the then pending *Nautilus* decision, reasoning that "the claim language and prosecution history leave [an ordinary skilled artisan] no reasonable uncertainty about the boundaries of the terms at issue." *Id.* at 737. Likewise, well before the Supreme Court's *Nautilus* decision, the Federal Circuit explained, in *Halliburton Energy Services, Inc. v. M-I LLC*, "[t]he fact that [a party] can articulate a definition supported by the specification [] does not end the inquiry. Even if a claim term's definition can be reduced to words, the claim is still indefinite if a person of ordinary skill in the art cannot translate the definition into meaningfully precise claim scope." 514 F.3d 1244, 1251 (Fed. Cir. 2008). Hence, as the Supreme Court recognized in *Nautilus*, "[t]he Federal Circuit's fuller explications of the term 'insolubly ambiguous' . . . may come closer to tracking the statutory prescription" than the label "insolubly ambiguous" might otherwise suggest. *Nautilus*, 134 S. Ct. at 2130.

Some post-*Nautilus* Federal Circuit decisions are also instructive. In *Interval Licensing LLC v. AOL, Inc.*, for example, the Federal Circuit followed a *Datamize* analytical framework, involving an evaluation of the claim language at issue ("unobtrusive manner that does not distract a user") in view of the specification and prosecution history. 766 F.3d 1364, 1371–73 (Fed. Cir. 2014). It then concluded that the "facially subjective claim language" was "without an objective boundary" and, therefore, indefinite. *Id.* at 1373–74. The plaintiff urged the Federal Circuit to at least adopt a "narrow example from the specification." *Id.*

at 1373. The Court refused. Post-*Nautilus*, post hoc efforts to simply ascribe some meaning are disfavored. *Id.* "The claims, when read in light of the specification and the prosecution history, must provide objective boundaries for those of skill in the art." *Id.* at 1370–71. In *Interval Licensing*, that mandate translated to faulting the patentee for casting the disputed phrase in the specification as an "e.g." (as merely one example in a lengthy written description), instead of as an "i.e." (as a clear definition). *Id.* at 1373–74.

The price of less precision in drafting could be a patent that is held invalid during litigation.

The Federal Circuit's decision on remand one year following the Supreme Court's decision in *Nautilus* is even more revealing. *Biosig Instruments, Inc. v. Nautilus, Inc.*, No. 2012-1289, 2015 U.S. App. LEXIS 6851 (Fed. Cir. 2015). The patent at issue in *Nautilus* concerned a heart rate monitor for use during

exercise. *Nautilus*, 134 S. Ct. at 2125; U.S. Patent No. 5,337,753 (filed Jun. 9, 1992). Claim 1 recited, *inter alia*, "an elongate member" (cylindrical bar) held by a user. *Id.* at 2126. On each of side of the bar was a live and a common electrode "mounted . . . in spaced relationship with each other." *Id.* Claim 1 further recited that, when held, each hand contacted both the live and common electrodes on each side of the bar. *Id.* *Nautilus* moved for summary judgment seeking, in relevant part, to have the patent held invalid for indefiniteness based on the term "spaced relationship." *Biosig Instruments, Inc. v. Nautilus, Inc.*, 715 F.3d 891, 893 (Fed. Cir. 2013). The district court granted the motion because, although the term was amenable to construction, the specification failed to provide parameters for the claimed spacing. *Id.* at 898–901. *Biosig* appealed and the Federal Circuit reversed and remanded, holding that the claim language, the specification, and the figures were sufficiently clear that the spacing could

not be infinitesimally small nor greater than the width of a user's hand. *Id.* In other words, "spaced relationship" was sufficiently definite. Then, Nautilus petitioned for certiorari. The Supreme Court vacated and remanded to the Federal Circuit with instruction to apply the "reasonable certainty" standard for definiteness without opining on the definiteness of the disputed claim terms. *Nautilus*, 134 S. Ct. at 2131.

Back at the Federal Circuit, Nautilus and Biosig disputed whether the Supreme Court had articulated a substantively different, stricter, standard for definiteness. *Biosig*, 2015 U.S. App. LEXIS 6851, at *9. The Federal Circuit's analysis suggests it believes the answer is no. According to the Federal Circuit, "reasonable certainty" is a "familiar standard." *Id.* at *10. "Reasonableness is the core of much of the common law, and 'reasonable certainty' has been defined in broad spectra of the law." *Id.* at *10-11 & n.2. Thus, federal courts "have had no problem operating under the reasonable certainty standard." *Id.* at *10-11 & n.2. As an example, the Federal Circuit cited *Freeny v. Apple Inc.*, in which an Eastern District of Texas court explained the effect of *Nautilus*:

Indefiniteness is a legal determination; if the court concludes that a person of ordinary skill in the art, with the aid of the specification, would understand what is claimed, the claim is not indefinite. . . .

Contrary to the defendant's suggestion, [the *Nautilus*] standard does not render all of the prior Federal Circuit and district court cases inapplicable, nor does it require that the claim language in this case be held indefinite. The Supreme Court recognized that 'some modicum of uncertainty' is the 'price of ensuring the appropriate incentives for innovation' and that because patents are directed to persons of skill in the art, all that is

required is that the patent apprise such persons of the scope of the invention.

No. 2:13-CV-00361-WCB, 2014 U.S. Dist. LEXIS 120446, at *14-17 (E.D. Tex. Aug. 28, 2014) (citation omitted). Given that introduction, it is unsurprising that the Federal Circuit concluded, as it had before the Supreme Court's *Nautilus* decision, the term "spaced relationship" was not indefinite.

Therefore, practitioners are left with an uncertain continuum for definiteness analysis. At one end is the Supreme Court, whose opinion in *Nautilus* arguably signaled a desire to shift toward a greater degree of precision in patent drafting. At the other end is the Federal Circuit, which has arguably held steadfast to its pre-*Nautilus* methodology. It will be interesting to see how their positions are reconciled in the future. Until then, their decisions serve as a reminder to patent prosecutors that the price of less precision in drafting could be a patent that is held invalid during litigation. As the boundaries for 35 U.S.C. § 112(b) continue to be refined, litigators are also on notice to consider the full range of definiteness analysis that could be applied to any claims in a dispute.

The above article expresses the view of the author and not necessarily that of the State Bar of Texas IP Law Section.



Brandy S. Nolan is a Senior Associate in the Dallas, Texas office of Norton Rose Fulbright US LLP. Brandy's practice focuses on intellectual property matters, including patent litigation. She has a degree in Chemical Engineering from The University of Oklahoma and attended The University of

Texas School of Law.