



## Federal Circuit Affirms Invalidity of Patent by Applying Nautilus Standard for Indefiniteness

Aug 11, 2016

Reading Time : **1 min**

By: Rubén H. Muñoz

Because the district court had relied on expert testimony (i.e., extrinsic evidence) in determining that the claims were indefinite, the Federal Circuit reviewed these factual findings for clear error under the Supreme Court's decision in *Teva Pharm. USA, Inc. v. Sandoz, Inc.* On appeal, Icon argued that its expert's position has been that "in-band" and "out-of-band" communications are different from each other, and that the fact that there is a difference is alone sufficient to render the claims definite and capable of construction. Polar's expert did not disagree that the terms are distinct, but instead argued that the patent-in-suit "does not provide one skilled in the art with sufficient information to define these terms with reasonable certainty" and that the "terms as used in the [patent-in-suit] are ambiguous" without some sort of reference to provide context. Specifically, there was no reference provided in the specification to teach a person of ordinary skill what constitutes an "in-band" communication versus an "out-of-band" communication. To support this position, Polar's expert proffered 10 prior art patents and textbooks each of which allowed the reader to differentiate in-band from out-of-band in relation to that reference.

The Federal Circuit agreed with Polar stating, "[w]e find no clear error in the district court's findings of fact, based on the extrinsic evidence presented by Polar's expert, nor do we find error in the legal conclusion it draws from this factual premise." Specifically, the Federal Circuit panel's nonprecedential opinion pointed to *Nautilus* and stated, "[b]ecause the [patent-in-suit's] claims, read in light of the specification delineating the patent, and the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 . . . we affirm the district court’s finding that the [patent-in-suit] is invalid for indefiniteness.”

*Icon Health & Fitness Inc. v. Polar Electro Oy et al.*, No. 2015-1891; *Icon Health & Fitness Inc. v. Garmin International Inc. et al.*, No. 16-1166 (Fed. Cir. August 8, 2016).

## Categories

Federal Circuit

Technology

© 2025 Akin Gump Strauss Hauer & Feld LLP. All rights reserved. Attorney advertising. This document is distributed for informational use only; it does not constitute legal advice and should not be used as such. Prior results do not guarantee a similar outcome. Akin is the practicing name of Akin Gump LLP, a New York limited liability partnership authorized and regulated by the Solicitors Regulation Authority under number 267321. A list of the partners is available for inspection at Eighth Floor, Ten Bishops Square, London E1 6EG. For more information about Akin Gump LLP, Akin Gump Strauss Hauer & Feld LLP and other associated entities under which the Akin Gump network operates worldwide, please see our Legal Notices page.