

Keywords: Prosecution laches; claim construction; enablement

General: Declaratory defendant's asserted patent claims are unenforceable under doctrine of prosecution laches, since defendant, through sequential filing of applications, delayed from 18 to 39 years in filing and prosecuting claims, and since such delay was unreasonable and unjustified.

Symbol Technologies Inc. v. Lemelson Medical, Education & Research Foundation LP
69 U.S.P.Q.2d 1738 (D. Nev. 2004)
Decided January 23, 2004

I. Facts

Lemelson claims to be the assignee of approximately 185 unexpired patents and many pending patent applications generally directed to machine vision and automatic identification bar code technology. Lemelson maintains that these patents and applications are entitled to the benefit of two Lemelson patent applications filed in 1954 and 1956.

Plaintiffs, Symbol and Cognex, manufacture and sell bar code scanners and machine vision products. In and prior to 1998, customers of Symbol and Cognex began receiving letters from Lemelson stating that the use of Symbol and Cognex products infringed various Lemelson patents. Because Symbol and Cognex would be subject to indemnification of any customers found to infringe the Lemelson patents, Symbol and Cognex brought a declaratory judgment action against Lemelson seeking judgment asserting that the patents are invalid under 35 U.S.C. §101 for lack of utility, 35 U.S.C. §102 for anticipation, 35 U.S.C §103 for obviousness, 35 U.S.C. §112 for failure to comply with the written description, enablement and definiteness requirements, and for double patenting. Additionally, Plaintiffs seek judgment that the patents-in-suit are unenforceable due to prosecution laches and due to inequitable conduct in securing those patents.

II. Issues

- A. Whether prosecution laches applies to the patents-in-suit, thus barring enforcement of the patents based on an unreasonable and unexplained delay in prosecution.
- B. Whether the asserted patent claims as construed by the Court are infringed by Symbol or Cognex.
- C. Whether the claims of the Lemelson patents-in-suit are invalid.

III. Discussion

A. Yes. The Court found that Lemelson's 18-39 year delay in filing and prosecuting the asserted claims of the 14 patents-in-suit after they were first purportedly disclosed in the 1954 and 1956 applications, was unreasonable and unjustified and that the doctrine of prosecution laches renders the asserted claims unenforceable against Symbol and Cognex.

In 2002, the Federal Circuit held that the doctrine of prosecution laches may be applied in the present case, if warranted, to bar enforcement of patent claims that issued after an unreasonable

and unexplained delay in prosecution, even though the prosecution of the patents-in-suit complied with pertinent statutes and rules. The District Court cited the Supreme Court in explaining prosecution laches as an equitable doctrine that must be evaluated on a case-by-case basis. In accordance with the doctrine, a person “may forfeit his rights as an inventor by willful or negligent postponement of his claims, or by an attempt to withhold the benefit of his improvement from the public until a similar or the same improvement should have been made and introduced to others.” The District Court further surmised that the fact that the patent office ultimately issued patents to Lemelson cannot foreclose the inquiry regarding the application of prosecution laches, nor can the overall pendency of presentation of the asserted claims be ignored in assessing whether the delay in this case was unreasonable.

The District Court found the following circumstances persuasive in warranting application of prosecution laches in the present case: (1) Lemelson’s original disclosures were made public in the 1960’s and those patents expired by the early 1980’s; (2) Before the asserted claims were filed, numerous articles and patents describing machine vision and bar code scanning were published and commercial products were developed and marketed; (3) Lemelson was aware of the developments in the machine vision and bar code fields, but still waited in filing his continuations; (4) Lemelson systematically extended the pendency of his applications by sitting on his rights and sequentially filing one application at a time so that he could maintain co-pendency while waiting for viable commercial systems to be developed and marketed; and (5) Lemelson then drafted and prosecuted hundreds of new claims in the late 1980’s and 1990’s specifically written to cover those commercial systems.

In finding that Lemelson’s delay in securing the asserted claims was unexplained and unreasonable, and that the public and private injury resulting from such delay is apparent, the Court noted that Lemelson had a duty to claim his invention promptly. Further, the Court opined that Lemelson’s intent (i.e. whether he intentionally delayed in securing the patents in issue), is not required to support the defense of prosecution laches. The Court concluded by stating that “[i]f the defense of prosecution laches does not apply under the totality of circumstances presented here, the Court can envision very few circumstances under which it would. To conclude otherwise would remove from the public domain subject matter arguably disclosed in Lemelson’s applications, but not timely claimed in a patent, and by any meaningful standard would unreasonably delay the time the public would be free to use Lemelson’s claimed inventions.”

B. No. In a poorly written analysis of the claim construction and requirements for finding infringement, the District Court held that “Lemelson’s patented system could not be used to read a bar code, nor does the Lemelson specification reveal any teaching or suggestion of catching information or identifying an article by the decoding of encoded information.” It appears that while the District Court did correctly state that a determination of infringement involves (1) claim construction to determine the scope and meaning of the claims; and (2) the determination of whether the properly construed claims encompass the accused method, that the opinion seems to focus more on the specification than the claims of the Lemelson patents. However, the Court did appear to use the specification in defining a number of claim terms and is probably correct in its opinion that such terms, when properly construed in light of the specification, cannot possibly encompass the accused devices/methods.

C. Yes. Finally, the Court also held that the claims at issue are invalid due at least to a lack of enablement under 35 U.S.C §112.