

Client Advisory

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Unreasonable Delay In Pursuing Claims Puts U.S. Patents at Risk

By Timothy J. Vezeau

On January 23, 2004, the U.S. District Court for the District of Nevada in *Symbol Technologies Inc. v. Lemelson Medical, Education, and Research Foundation, L.P.*, held that 14 Lemelson patents asserted against machine vision/bar code scanning technologies were not infringed, were invalid (due to lack of written description support and lack of enablement), and were unenforceable for “prosecution laches” resulting from Lemelson’s decades-long prosecution of a string of continuing patent applications in the United States Patent and Trademark Office (USPTO).

Lemelson’s Delay Held To Be “Unreasonable and Unjustified”

In this decision, the Court held:

“...Lemelson’s 18 to 39 year delay in filing and prosecuting the asserted claims under the fourteen 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 . . . If 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 when the public would be free to use Lemelson’s claimed inventions.”

The outcome in this case may be hailed as a fitting end to what many may have considered to be a “wolf pack” submarine patent attack on companies that spent considerable efforts and large sums on the research, development and commercialization of machine vision and bar code scanning technologies developed during the many years of pendency of the string of Lemelson applications. Published estimates indicate that more than \$1 billion has already been collected from companies against which these patents were asserted.

Impact On Continuing Patent Applications In The USPTO

Continuation patent practice in the USPTO is quite routine. It is not uncommon to encounter continuing applications that claim priority dates of parent applications filed five to 10 years before the filing dates of the continuing applications. However, in view of this decision in what may be viewed as an extreme case, patent application owners should exercise caution and be as expeditious as possible in pursuing

patent claims, whether through continuation or continuation-in-part or divisional applications. Specifically, patent application owners should insert the claims they would like to obtain as soon as possible in the patent application process to minimize the expected defense of “prosecution laches,” premised upon an unreasonable delay in prosecuting the patent claims. Patent application owners should seek the advice of their patent counsel to minimize the possible impact of this defense on their valuable intellectual property assets.

We Can Help

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