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PATENTS

The author reviews several Federal Circuit rulings to illustrate the importance of careful patent claim drafting.

Proofread Your Company's Patents Just as You Would Any Other Important Contract



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There are hundreds of thousands of patent applications being filed with the Patent and Trademark Office each year.¹ With so many applications, it is not surprising that many patents are issued with drafting errors. Some errors are minor and some are not.

¹ Patent and Trademark Office, Table of U.S. Patent Activity.

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Drafting errors can usually be corrected throughout the patent application process. However, once the patent issues, the laws provide for limited opportunities to correct errors. See 35 U.S.C. §§ 251-256.² And, once a patent has been asserted in litigation, the court's authority to make corrections to drafting errors, no matter how obvious those errors might be, is severely limited. A simple drafting mistake could end up being detrimental to a company in the long run.

The purpose of this article is to discuss the courts' limited ability to eradicate errors in patents and to demonstrate that certain errors can be avoided simply by reading the patent for proper grammar and context before the patent is issued. Many companies do not have in-house attorneys who are familiar with the nuances of

² This article does not address the rules and restrictions for correcting drafting errors in patents through the PTO. However, if you find drafting errors in your company's patents after the patent issues, you should seek to correct those errors through the PTO as soon as possible.

patent law or the technologies at issue in their company's patents. Therefore, in-house attorneys heavily rely on the expertise of the individual(s) who are preparing the patent application.

Nevertheless, in-house attorneys should still read the patent with a critical eye, just as they would any other important contract. Even if in-house attorneys do not understand the technology being addressed in the patent or the intricacies of patent law, they should still carefully read the patent and check it for proper grammar and context. Catching drafting errors during the application process is key.

Of course, most drafting errors in patents are never discovered because most patents do not become the subject of litigation. But if your company decides to enforce its patents against a competitor, which is a trend many companies in all industries are currently following, any drafting errors will likely be exposed during litigation and could end up being detrimental to your company's case.

Judicial Power to Correct Is Limited. Now, are all drafting errors fatal to the patent once litigation ensues? No, but the U.S. Court of Appeals for the Federal Circuit has established precedent which greatly limits a district court's ability to correct errors in patent claims during litigation.

The Federal Circuit addressed in detail the type and scope of errors that district courts may correct in *Novo Industries L.P. v. Micro Molds Corp.*, 350 F.3d 1348, 69 USPQ2d 1128 (Fed. Cir. 2003) (67 PTCJ 120, 12/12/03). In *Novo*, the patent was directed to vertical blinds. In particular, *Novo* allegedly invented a mechanism that would realign the vertical blinds when one of the blind slats became misaligned. The *Novo* patent referred to this mechanism as a "stop means" that would prevent the misaligned slat from rotating until it was back in line with the other slats of the vertical blind.

Originally, in the application draft Claim 16 read in relevant part: "An assembly as in claim 15 further comprising *stop means formed on said support finger* and extending outwardly therefrom into engaging relation with one of two spaced apart members formed on said frame." Even without knowing what Claim 15 said, and having little or no knowledge of what a "stop means" and/or a "support finger" are, the reader can at least see that the words of the claim limitation are in the proper order and context.

During the application process, Claim 16 was cancelled and added to Claim 19. However, when the claim limitation was added to claim 19, the words "*a rotatable with*" were mistakenly added to the claim limitation.

Hence the claim read: ". . . stop means formed on a *rotatable with* said support finger and extending outwardly therefrom into engaging relation with one of two spaced apart . . ." Again, irrespective of whether one understands the technical terms and aspects of this claim limitation, had someone read this claim with a critical eye towards fundamental grammar, they would have realized that "*a rotatable with*" did not make sense in the claim. Unfortunately, for the patent owner, nobody caught the error until litigation ensued.

In *Novo*, the plaintiff recognized this error (albeit too late) and offered two possible corrections: (1) deleting the three superfluous words "a rotatable with" from the claim; or (2) deleting "with said" from the claim. According to the plaintiffs, the relevant portion of the

claim should have read either: (a) "stop means formed on said support finger and extending outwardly therefrom into engaging relation with one of two spaced apart stop members form on said frame . . ."; or (b) "stop means formed on a *rotatable* support finger and extending outwardly therefrom into engaging relation with one of two spaced apart stop members form on said frame . . ."

The defendants offered yet a different construction and the district court ultimately disagreed with both parties and held that "*a rotatable with*" really meant "*and rotatable with*"—so, according to the district court, the claim read in relevant part: ". . . stop means formed on *and rotatable with* said support finger and extending outwardly . . ."

Moreover, the Federal Circuit disagreed with all of the parties and the district court. After reviewing the respective designated powers of the PTO and the district courts to correct patent claims, the Federal Circuit held that district courts may *only* correct "minor typographical and clerical errors in patents." *Id.* at 1357.

The Federal Circuit further held that such errors may *only* be corrected by district courts: "if (1) the correction is not subject to reasonable debate based on consideration of the claim language and the specification and (2) the prosecution history does not suggest a different interpretation of the claims." *Id.* Ultimately, the court concluded that there were multiple solutions that could correct the drafting error in the patent in the *Novo* case, as two solutions were offered by plaintiffs, another solution by defendants, and a fourth ultimately by the district court. In other words, the correction was subject to "*reasonable debate*."

Therefore, the Federal Circuit held that this error could not be corrected by the district court and the asserted claim was held to be invalid for indefiniteness. *Id.* at 1358.

Similarly, in *Allen Engineering Corp. v. Bartell Industries Inc.*, 299 F.3d 1336, 63 USPQ2d 1769 (Fed. Cir. 2002) (64 PTCJ 369, 8/16/02), the court refused to correct an obvious mistake in several of the patent claims at issue. The patent in *Allen Engineering* related to concrete riding trowels—machines used to smooth the surface of freshly poured concrete.

The specification described two pivot steering boxes for the machine and expressly stated that the steering boxes could *not pivot in a plane perpendicular the biaxial plane*. However, asserted Claims 1-4 and 13 of the patent claimed that the steering box of the riding trowel pivoted *only in a plane perpendicular to the biaxial plane*.

Allen argued that one of skill in the art would understand that the term perpendicular really meant parallel. *Allen Engineering*, 299 F.3d at 1349. The Federal Circuit disagreed and those claims were held invalid. *Id.* Although the court acknowledged that the error was obvious, it reiterated: "It is not our function to rewrite claims to preserve their validity." *Id.*

Here again, even if in-house counsel was not familiar with the technology and did not even understand what the biaxial plane was, careful reading would have revealed the issue of "*perpendicular versus parallel*" and the issue could have been entirely avoided.

Yet another example of an obvious error that could have been easily caught and corrected is demonstrated in *Chef America Inc. v. Lamb-Weston Inc.*, 358 F.3d 1371, 69 USPQ2d 1857 (Fed. Cir. 2004) (67 PTCJ 367,

2/27/04). The patent in *Chef America* related to a process for producing dough products with a light, flaky, crispy texture.

The examples set forth in the specification clearly stated that the dough was to be heated “at temperatures” or “at a temperature” of 400 to 850 degrees Fahrenheit. However, Claims 1 and 8 of the patent at issue both claimed “heating the resulting batter-coated dough to a temperature of about 400° F to 850° F.”

Chef America urged the court to construe the claim to read heating the dough at a temperature of about 400 to 850 F because that was consistent with the invention and heating the dough itself to those temperatures would result in a product that was burnt to a crisp – a “charcoal briquette.” The court noted, however, that the term “heating the dough to” a certain temperature was in the claims as originally filed. *Id.* at 1374.

Other changes had been made to the claims during the application process, but the word “to” had not been changed. The Federal Circuit affirmed the district court’s construction that the claim limitation referred to the temperature of the dough and not the temperature of the oven.

Therefore, the court agreed that Lamb-Weston did not infringe the claims because Lamb-Weston did not heat its dough to such temperatures. The court again held: “This court, however, repeatedly and consistently has recognized that courts may not redraft claims, whether to make them operable or to sustain their validity.” *Id.*

On Aug. 10, 2011, the Federal Circuit was again faced with the question of whether and to what extent district courts may correct errors in a patent. In *CBT Flint Partners LLC v. Return Path Inc.*, 99 USPQ2d 1610 (Fed. Cir. 2011) (82 PTCJ 536, 8/19/11), the Federal Circuit overturned the decision of the U.S. District Court for the Northern District of Georgia, where the district court held that it could not correct the error in a plaintiff’s patent, and thus held the patent invalid.

In *CBT Flint*, the patent related to a method and system for charging a fee for sending “spam” email. If the sender of the spam email was authorized, the internet

service provider would forward the spam email to the targeted recipient.

The relevant portion of the claim at issue read: “a computer in communication with a network being programmed to *detect analyze* the electronic mail communication” The district court held that there were at least three possible ways to correct the claim: (1) delete the word *detect*; (2) delete the word *analyze*; or (3) add the word “and” between *detect analyze*. Therefore, the district court held, the corrections to this error were debatable and held the claim invalid according to the Federal Circuit’s *Novo* holding.

However, the Federal Circuit disagreed, distinguishing the *CBT Flint* case from *Novo*. The Federal Circuit held that even though there were three possible ways to correct the error in the claim, there was “an obvious and correctable error in the claim.” (*Id.* slip. op. at 8.)

The court held that the district court failed to recognize that a person of skill in the art would find that the claim had the same scope and meaning under each of the three possible corrections offered. (*Id.* at 10.) Therefore, the court held, the district court had the authority to correct the claim. (*Id.*)

Even though the plaintiff’s patent was eventually preserved in the most recent Federal Circuit decision, think of the time, fees, and costs that could have been avoided.

Each of these cases provide excellent examples of how easily some errors in patents could have been corrected simply by reading the patent for drafting errors during the application process, regardless of whether the person reading the patent was experienced in patent law or educated in the technology at issue.

So, take the time to read your company’s patent applications during the application process. Even if you are not familiar with the nuances of patent law or the technology at issue in the patent, simply reading the patent application for proper grammar and context could mean the difference between winning and losing a patent infringement case, should your company choose to assert its patent in a patent litigation battle.