



UNIVERSITY OF
MARYLAND
SCHOOL OF LAW

**PATENT LAW
UPDATE**

**Schumer
v.
Lab. Computer
Sys., Inc.**

No. 02-1100
Federal Circuit
Oct. 22, 2002

***“[T]o accept
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On October 22, 2002, the Federal Circuit vacated and remanded the district court’s summary judgment that LCS did not infringe claims 1-10 of U.S. Patent No. 5,768,492, and that claims 13 and 14 of the ‘492 patent were invalid as anticipated. With respect to the invalidity finding, the Federal Circuit stated:

“A patent shall be presumed valid.” To overcome this presumption of validity, the party challenging a patent must prove facts supporting a determination of invalidity by clear and convincing evidence. Whether a patent is anticipated under section 102(b) is a question of fact. On summary judgment, all justifiable inferences are made in favor of the nonmovant, here Schumer. LCS failed to meet its high burden of showing invalidity on summary judgment.

The recited invention of independent claim 13 requires an interface capable of multiple translation of differing command formats into a single native format for a digitizer, and sending a translated command to a digitizer. This allows multiple digitizers having different command formats to operate on a single computer by enabling multiple digitizers to communicate with a single computer. . . .

The Seiko driver reference is identified as anticipating because, LCS argues, the Seiko driver performs the steps of the method of claim 13. Evidence of invalidity must be clear as well as convincing. Typically, testimony concerning anticipation must be testimony from one skilled in the art and must identify each claim element, state the witnesses’ interpretation of the claim element, and explain in detail how each claim element is disclosed in the prior art reference. The testimony is insufficient if it is merely conclusory. And if the testimony relates to prior invention and is from an interested party, as here, it must be corroborated.

It is not our task, nor is it the task of the district court, to attempt to interpret confusing or general testimony to determine whether a case of invalidity has been made out, particularly at the summary judgment stage. Indeed, to accept confusing or generalized testimony as evidence of invalidity is improper. The risk is great that the confusion or generality is the result, not of an inarticulate witness or complex subject matter, but of a witness who is unable to provide the essential testimony. Here both of Dezmelyk’s declarations lack the requisite clarity. Dezmelyk merely sets forth his understanding of the operation and steps performed by the Seiko driver and describes what he considered to be known to one of ordinary skill prior to Schumer’s invention. He does not clearly describe the operative steps of the method recited in claim 13, nor how those operative steps are performed by the Seiko driver.

The burden of proving invalidity on summary judgment is high. We find that LCS failed to prove by clear and convincing evidence on summary judgment that the Seiko driver, even if it were prior art, disclosed “each and every limitation” of claim 13, as is required to prove anticipation.