



## TECHNOLOGY LAW UPDATE

***Symbol Techs., Inc.***  
**v.**  
***Lemelson Med.,  
Educ. & Research  
Found.***

No. 04-1451

Federal Circuit  
Sept. 9, 2005

*Taken singly, the delay in the prosecution on any one particular application will surely not appear to merit relief by the courts in equity. On the other hand, an examination of the totality of the circumstances, including the prosecution history of all of a series of related patents and overall delay in issuing claims, may trigger laches.*

**Schwartz  
Sung &  
Webster**

*an intellectual property  
law firm*

On September 9, 2005, the Federal Circuit affirmed the district court’s judgment, *inter alia*, that U.S. Patents No. 4,338,626, No. 4,511,918, No. 4,969,038, No. 4,979,029, No. 4,984,073, No. 5,023,714, No. 5,067,012, No. 5,119,190, No. 5,119,205, No. 5,128,753, No. 5,144,421, No. 5,249,045, No. 5,283,641, and No. 5,351,078, which related to bar code technology asserted to be entitled to the benefit of the filing date of two Lemelson patent applications filed in 1954 and 1956, were unenforceable for prosecution laches. The Federal Circuit stated:

We agree with Symbol that the court did not abuse its discretion in holding that Lemelson’s patents are unenforceable under the doctrine of prosecution laches. The doctrine of prosecution laches is an equitable defense. [T]here are no strict time limitations for determining whether continued refiling of patent applications is a legitimate utilization of statutory provisions or an abuse of those provisions. The matter is to be decided as a matter of equity, subject to the discretion of a district court before which the issue is raised.

There are legitimate grounds for refiling a patent application which should not normally be grounds for a holding of laches, and the doctrine should be used sparingly lest statutory provisions be unjustifiably vitiated. The doctrine should be applied only in egregious cases of misuse of the statutory patent system. . . .

However, refiling an application solely containing previously-allowed claims for the business purpose of delaying their issuance can be considered an abuse of the patent system. In particular, multiple examples of repetitive refilings that demonstrate a pattern of unjustifiably delayed prosecution may be held to constitute laches. Taken singly, the delay in the prosecution on any one particular application will surely not appear to merit relief by the courts in equity. On the other hand, an examination of the totality of the circumstances, including the prosecution history of all of a series of related patents and overall delay in issuing claims, may trigger laches.

The district court here heard considerable evidence that that was what occurred in this case. The court found that an 18- to 39-year time period had elapsed between the filing and issuance of the patents in suit. That period of time is not what is contemplated by the patent statute when it provides for continuation and continuation-in-part applications. Patent applications should normally be permitted to issue when they have been allowed and the statutory requirements complied with. The court also found that Lemelson had engaged in “culpable neglect” during the prosecution of these applications and it recognized the adverse effect on businesses that were unable to determine what was patented from what was not patented. It noted that the Lemelson patents occupied the “top thirteen positions” for the longest prosecutions from 1914 to 2001. The court also cited the existence of “intervening private and public rights.” It concluded that “[i]f the defense of prosecution laches does not apply under the totality of circumstances here, the Court can envision very few circumstances under which it would.” Under those circumstances, we can hardly conclude that the court abused its discretion in holding the involved patents unenforceable on this ground. The court thoroughly examined the facts and the equities, and it exercised its discretion reasonably. We therefore affirm the district court’s holding of unenforceability.