

When Can Errors in Patent Claims be Corrected by District Courts?

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In *CBT Flint Partners, LLC v. Return Path, Inc.*, 2011 LEXIS 16499 (Fed. Circ. 2011), CBT Flint Partners, LLC (“CBT”) appealed from a final judgment where the district court granted summary judgment of invalidity of claim 13 of U.S. patent 6,587,550 (“the ‘550 patent”), holding it indefinite under 35 U.S.C. § 112, ¶ 2. The district court granted summary judgment of invalidity on the basis that claim 13 contained a “drafting error” and that there were at least three reasonable and possible corrections to rectify that drafting error. The court held that on consideration of the claim language and specification, the appropriate correction was subject to reasonable debate. Thus, the district court concluded that it was not authorized to correct the so-called drafting error in claim 13, thereby rendering it invalid for indefiniteness.

The Federal Circuit, in its decision, reversed the district court and found that claim 13 of the ‘550 patent was not indefinite due to an obvious and correctable error in the claim. The Federal Circuit held that the district court could have and should have corrected the obvious error, indicating that in a patent infringement suit, a district court may correct an obvious error in a patent claim 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. In deciding whether the district court had authority or not to correct the patent claim, the Federal Circuit stated that a district court must consider any proposed correction from the point of view of one skilled in the art, which the Federal Circuit found the district court did not do.

Specifically, the Federal Circuit concluded that the district court failed to recognize that the claim contained an obvious error and that a person of skill in the art would find the claim to have the same scope and meaning under each of the three possible meanings advanced by the parties. Because the Federal Circuit also concluded that the specification of the ‘550 patent supported the scope and meaning of the obvious correction, the unanimous 3-judge panel found that the district court, therefore, had the requisite authority to make a correction and should have done so. Accordingly, the Federal Circuit reversed the district court's summary judgment of invalidity of claim 13 of the ‘550 patent and remanded to the district court for further proceedings consistent with its opinion.

CBT clearly encourages accused infringers to argue varied scope and meaning of possible corrections to claims containing errors, as doing so successfully results in the golden ticket of patent invalidity for any such claim under 35 U.S.C. § 112, ¶ 2. For patentees whose patents unfortunately contain drafting errors, *CBT* suggests that a potentially invalid patent claim due to a drafting error can be rescued by successfully asserting that each proposed correction has the same scope and meaning within the affected claim. Clearly, expert testimony regarding how one of ordinary skill in the art may or may not view a drafting error and the scope and meaning of possible corrections will likely be instrumental in either rescuing or in attempting to invalidate the claim.

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