

## Federal Circuit Says Not so Fast on Priority and Indefiniteness Based Invalidity Attacks

by Andrew Crain, Thomas | Kayden, LLP\*

[andrew.crain@tkhr.com](mailto:andrew.crain@tkhr.com)

In *Star Scientific, Inc. v. R.J.Reynolds Tobacco Co.*, 2011 U.S. App. LEXIS 17826 (Fed. Cir. Aug. 26, 2011), the Federal Circuit dealt with two areas where accused infringers oftentimes seek to base an invalidity attack on a patent-in-suit. However, the Federal Circuit's *Star Scientific* decision likely makes invalidity attacks based on insufficient priority claims and indefiniteness more difficult to sustain.

Regarding priority claims to provisional applications, the Federal Circuit clarified that patent claims deserve the provisional application's earlier filing date so long as that application contains adequate written description under 35 U.S.C. § 112. Consistent with 35 U.S.C. § 112 ¶ 1, the Federal Circuit explained that the written description of the provisional application must enable one of ordinary skill in the art to practice the invention claimed in the non-provisional application.

Here, the patent-in-suit claimed an air flow of 25,000 CFM in a tobacco curing barn, but the provisional application only disclosed that the minimum air flow may be about 28,000 CFM but could also vary according to conditions that may be determined on a routine basis. Since the provisional application taught one of ordinary skill that minimum air flow "may vary," the Federal Circuit found that one of ordinary skill in the art would know that the air flow variable could be 25,000 CFM. So, the Federal Circuit concluded that the provisional application did provide an adequate written description, thereby entitling the patent-in-suit to the priority date of the provisional application and, importantly for the patentee, eliminating two of the accused infringer's invalidity arguments in the process.

The Federal Circuit also dealt with an indefiniteness challenge by the accused infringer, who argued that a particular construed claim term did not communicate to one of ordinary skill in the art how to perform the claimed method. In explaining indefiniteness, the Federal Circuit noted that indefiniteness is a purely legal issue that arises when claims are not amenable to construction or are "insolubly ambiguous." Accordingly, the court explained that a construed claim can be indefinite if the construction remains insolubly ambiguous, meaning it fails to provide sufficient clarity about the bounds of the claim to one skilled in the art. But, the Federal Circuit noted that absolute clarity is not required to find a claim term definite, as a claim term may be definite even when discerning the meaning is a "formidable task and the conclusion may be one over which reasonable persons will disagree."

The Federal Circuit found that the record, which largely consisted of text in the patent-in-suit, repeatedly established that a person of skill in the art of the patent-in-suit would possess adequate understanding to perform the claimed method argued to be indefinite. Thus, the Federal Circuit concluded that the term was not insolubly ambiguous and not, therefore, indefinite.

In *Star Scientific*, the Federal Circuit likely makes invalidity challenges based on arguably insufficient priority claims or indefiniteness of claim terms a little more difficult to assert. But, like so many areas of patent law based on what one of ordinary skill in the art would or would not know, perhaps the real winners here are the experts and the parties who get the best experts on their side.

\*Andrew Crain is a partner at Thomas, Kayden, Horstemeyer & Risley, LLP. His practice experience involves all areas of intellectual property law, including patents, trademarks, trade secrets, copyrights, and unfair competition. For more information about Andrew, go to [www.tkhr.com/patents](http://www.tkhr.com/patents)