

## “PROSECUTION LACHES” AS A BAR TO LEMELSON PATENT ENFORCEMENT

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The doctrine of “prosecution laches” has been resuscitated as a defense in lawsuits in which the Lemelson Foundation is seeking damages for infringement of its bar-code and machine-vision patents. Chief Judge Mayer of the U. S. Court of Appeals for the Federal Circuit, which hears appeals in patent cases from around the country, recently held that this equitable doctrine could be asserted by a group of manufacturers, including Accu-Sort Systems, Inc., Cognex, and Symbol Technologies, in their declaratory judgment action against the Lemelson Foundation to bar it from enforcing certain patents because of unreasonable and unexplained delays by Jerome Lemelson in prosecuting his patents, notwithstanding his compliance with pertinent patent statutes and rules.

This break-through opinion reverses the decision by a trial judge in Reno, Nevada, who had dismissed this defense of prosecution laches simply because Lemelson had complied with the U.S. Patent Act and implementing regulations, which at the time authorized “submarining” - the filing of continuing reapplications for patents under certain circumstances.<sup>1</sup> Chief Judge Mayer’s decision also parts company with an earlier holding by a federal trial judge in one of the first Lemelson patent enforcement cases – the one against Ford, General Motors, and Chrysler where the Big Three were

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<sup>1</sup> Much of the criticism of Jerome Lemelson and his patents has stemmed from the controversial, secretive methods by which he obtained some of them. Applying for many of these patents around 1960, Lemelson kept his applications alive for approximately 30 years by submitting a series of applications, and resubmissions, to the U.S. Patent Office. At that time, a patent’s life extended 17 years from the date of *issue*, not from the date of *application*, as it is today. In the United States, patent applications are kept confidential while applications are processed, rejected, and resubmitted – until finally approved. It is not until final approval that a patent application’s contents and its technology *surface* – like a *submarine*. In the meantime, the application’s contents and the technology underlying the patent could be refined as continuing applications were resubmitted, as long as refinements did not introduce new matter.

precluded from relying on this defense at trial. (That automotive case then settled without a trial, leaving the issue of prosecution laches unresolved at the Circuit level.)

The equitable doctrine of “prosecution laches” involves the issue whether these seven manufacturers of bar-code and machine-vision apparatus can fight Lemelson’s claim of patent infringement by establishing that Jerome Lemelson’s delays in prosecuting his patents constituted acquiescence in others’ use of the patent processes. If these manufacturers are able to establish the bases for “prosecution laches,” the Lemelson Foundation’s patent enforcement efforts would be substantially derailed, not only in this case pending in Reno, Nevada, but in the more than a dozen other cases pending around the country in Arizona, Nevada, Massachusetts, and elsewhere.

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