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**COURT URGED TO CLARIFY “DEFINITENESS”
REQUIREMENT FOR PATENTS
(*R.J. Reynolds Tobacco Co. v. Star Scientific, Inc.*)
U.S. Supreme Court**

The Washington Legal Foundation (WLF) this week urged the U.S. Supreme Court to clarify the statutory “definiteness” requirement that directs every patent applicant to “particularly point out” and “distinctly claim” the subject matter which the applicant claims as the invention.

In a brief filed in *R.J. Reynolds Tobacco Co. v. Star Scientific, Inc.*, WLF argued that the “definiteness” requirement contained in 35 U.S.C. § 112, ¶2 not only requires the patentee to distinguish the invention from prior art, but it also requires the patent’s claims to sufficiently clarify the invention’s boundaries for future inventors desiring to avoid infringement. WLF argued that the Federal Circuit’s recent “insolubly ambiguous” test for patent definiteness fails to adequately put the world on notice of the patent’s true reach.

Beginning in 2001, the Federal Circuit articulated a new standard for “definiteness” that holds a patent claim indefinite only if it is “insolubly ambiguous” or otherwise incapable of being construed. Since that time, the proper scope of § 112’s “definiteness” requirement has been a question that has continued to divide both the patent bar and judges on the Federal Circuit. As a result, R.J. Reynolds is asking the Supreme Court to agree to hear the case for the purpose of deciding the issue once and for all.

The case arises from a dispute over a patented process for curing tobacco. Because freshly harvested tobacco leaves are unsuitable for human consumption, tobacco must be properly “cured” before it can be used to manufacture cigarettes and other tobacco products. Star Scientific, Inc. sued R.J. Reynolds alleging infringement of patents that claim a method for drying tobacco in a “controlled environment” to achieve certain favorable conditions of humidity, temperature, and airflow. Although the district court found the patent invalid for indefiniteness, the Federal Circuit reversed that finding under its “insolubly ambiguous” test.

In its brief urging discretionary review, WLF argued that the Supreme Court has long held that the proper standard for judging the statutory “definiteness” requirement

derives from the very purpose of that requirement—putting the public on notice by fully and clearly disclosing the scope of the patented invention in order to allow other inventors to continue to innovate while avoiding infringement. WLF argued that the Federal Circuit has abandoned this important public-notice function and is severely undermining that requirement such that a patent’s claims no longer must fully and clearly disclose the scope of the patented invention in order to be valid.

By abandoning the important public-notice function of patent claims, WLF stated, the Federal Circuit has created perverse incentives that actually stifle rather than foster important innovation. Given the imprecise boundaries made possible by ambiguous claims, WLF is concerned that patentees are increasingly free to file suit against products they never invented. Patentees seeking to stretch their claims beyond the intended bounds of the patent are too easily able to avoid the indefiniteness defense, thereby increasing a defendant’s costs to defend the suit. As a result, WLF’s brief noted, innovative competitors and those desiring to avoid infringement liability can no longer rely on the words of the patent claims themselves, but must incur the risks and high costs of litigation to learn whether there is some “soluble” meaning, no matter how elusive, that some court somewhere can construe for the claim at issue.

WLF is a public interest law and policy center with supporters in all 50 States. WLF devotes a substantial portion of its resources to litigating cases raising patent law and other intellectual property issues.

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For further information, contact WLF Senior Litigation Counsel Cory Andrews, (202) 588-0302. A copy of WLF’s brief is posted on its web site, www.wlf.org.