



The Revival of the Prosecution Laches Defense Against Patent Infringement: *Symbol Technologies, Inc. v. Lemelson Medical, Education & Research Foundation, L.P.*

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Introduction

The Patent Act allows a patent applicant, having filed a patent application covering his invention (the original application), to file one or more continuing applications related to that invention.² The three main types of continuing applications are continuation applications, continuation-in-part applications, and divisional applications.³ Patents that issue from those continuing applications (the continuing patents) differ from the patent that issues from the original application (the original patent) in at least two important ways.

First, continuing patents have different scopes from the original patent. Continuing patents must repeat at least a substantial portion of the original patent but include different claims from the original patent.⁴ Claims define the scope of a patent.⁵ Thus, continuing patents have different scopes from the original patent.

Second, continuing patents typically have shorter patent terms than the original patent. The original patent has a patent term of twenty years from its filing date.⁶ In contrast, a continuing patent filed on or after June 8, 1995 (a post-GATT⁷ patent) has a patent term of twenty years from the original patent's filing date.⁸ A continuing patent filed before June 8, 1995 (a pre-GATT patent) has, however, a patent term of the longer of twenty years from the original application's filing date or seventeen years from the continuing patent's issue date.⁹

A patent applicant may file continuing applications for several reasons. For example, the patent applicant may file a continuing application to pursue broader claims or to pursue claims that cover different aspects of the invention not sufficiently covered by the original patent. A patent applicant also may file a continuing application to

defer responding to the U.S. Patent and Trademark Office (USPTO) regarding the original application.¹⁰ Additionally, a patent applicant may file a continuing application to keep an application pending in the USPTO. That pending application allows the patent applicant to draft claims that cover competitors' products that are introduced in the marketplace after the original patent's issue date. Therefore, with all the benefits of continuing applications, are there any reasons why a patent applicant should not file one continuing application after another?¹¹

This article reviews the United States Court of Appeals for the Federal Circuit's revival of the prosecution laches defense in *Symbol Technologies, Inc. v. Lemelson Medical, Education & Research Foundation, L.P.*¹² Part I reviews that case and its history. Part II discusses the prosecution laches defense against patent infringement. Finally, this Article concludes in Part III with what patent applicants and their patent attorneys, particularly those applicants and attorneys who file multiple continuing applications, may do to reduce the risk of a court finding their patents unenforceable for prosecution laches.

I. *Symbol Technologies, Inc. v. Lemelson Medical, Education & Research Foundation, L.P.*

In *Symbol IV*, the United States Court of Appeals for the Federal Circuit affirmed that Lemelson's asserted continuing patents were unenforceable under the doctrine of prosecution laches.¹³

A. The Dispute

Lemelson is the assignee of fourteen patents covering machine vision and automatic identification bar code technology.¹⁴ Those patents resulted from the filing of continuation-in-part applications over several decades that date back to original patent applications filed in 1954 and 1956.¹⁵ *Symbol* and its co-plaintiffs design, manufacture, and sell bar code scanners and other machine vision products.¹⁶



In 1998, Lemelson sent letters to Symbol's customers stating that their use of Symbol's products infringed various Lemelson patents.¹⁷ In response, Symbol filed a declaratory judgment action against Lemelson in the United States District Court for the District of Nevada.¹⁸ That action sought judgment that the asserted patents¹⁹ were, among other things, unenforceable for prosecution laches.²⁰

B. The Motion to Dismiss

Lemelson moved to dismiss, transfer, or stay proceedings.²¹ In its motion, Lemelson argued that there was no case or controversy between the parties and that Symbol's count of prosecution laches failed to state a claim upon which relief can be granted.²² The district court found that Symbol met the case or controversy requirement.²³ The district court, however, dismissed the prosecution laches claim finding improper the introduction of "the equitable doctrine of laches into the statutory scheme of continuation practice."²⁴

C. The Interlocutory Appeal

Symbol filed an interlocutory appeal with the Federal Circuit, which agreed to consider whether the equitable doctrine of laches can "ever apply to bar enforcement of patent claims which were first presented to the Patent Office for examination after an unreasonable and unexplained delay that causes injury to an alleged infringer and others?"²⁵

The Federal Circuit, in reversing the district court, held that Symbol's defense of prosecution laches was legally available where the asserted patent issued "only after an unreasonable and unexplained delay in prosecution"²⁶ and remanded the case to the district court for further proceedings.²⁷ In arriving at its holding, the Federal Circuit rejected Lemelson's arguments that prosecution laches were limited to interference actions and that the Patent Act of 1952, which provided for the filing of continuing applications, eliminated the prosecution laches defense.²⁸

D. The Remand

The district court found Lemelson's asserted patents unenforceable due to prosecution laches.²⁹ In arriving at its holding, the court concluded that Lemelson's eighteen to thirty-nine year delay in filing and prosecuting the asserted patents,³⁰ which allegedly covered inventions disclosed in the 1954 and 1956 applications, was "unreasonable and unjustified" for at least three

reasons. First, "unreasonable delay alone [was] sufficient to apply prosecution laches without the requirement that Lemelson intended to gain some advantage by the delay."³¹ Second, Lemelson's delay amounted to "culpable neglect" for ignoring the "duty to claim his invention promptly."³² That neglect had a prejudicial effect on Symbol and other parties because they could not determine what Lemelson's patents covered and what those patents did not cover.³³ Finally, Symbol provided strong evidence of "intervening private and public rights."³⁴ That evidence included the public's use of Symbol bar code scanners and other machine vision products, as well as the public's use of similar third-party products.³⁵

E. The Appeal

The Federal Circuit affirmed that Lemelson's asserted patents were unenforceable under the doctrine of prosecution laches.³⁶ In affirming the district court's judgment, the Federal Circuit stated that there 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."³⁷ The court also noted that the determination is a "matter of equity, subject to the discretion of a district court before which the issue is raised" and should apply "only in egregious cases of misuse of the statutory patent system."³⁸ Additionally, the Federal Circuit stated that a court should examine the "totality of the circumstances, including the prosecution history of all of a series of related patents and overall delay in issuing claims."³⁹

Applying the principles above, the Federal Circuit concluded that the district court reasonably exercised its discretion based on its findings of Lemelson's eighteen to thirty-nine year delay in prosecution, Lemelson's culpable neglect during prosecution, the adverse effect on business unable to determine what Lemelson's patents covered, and the existence of intervening private and public rights.⁴⁰

II. The Prosecution Laches Defense⁴¹

Symbol successfully asserted the prosecution laches defense against Lemelson's patent infringement claims. This section discusses the details of the prosecution laches defense.

A. Availability

The defense may be available in patent infringement suits where the asserted patents have filing and prosecution delays that are much



shorter than Lemelson's eighteen to thirty-nine year delay.⁴² Additionally, the defense may be available regardless of whether the asserted patents are pre-GATT or post-GATT.⁴³ Moreover, the defense may be available despite the patent applicant's filing of terminal disclaimers for the asserted patents. A terminal disclaimer limits the patent term of a patent to the patent term of an earlier issued patent.⁴⁴ The defense is not, however, available when the patent applicant filed one or more divisional applications in response to a restriction requirement⁴⁵ from the USPTO, even when the patent applicant waited until just before the original patent's issuance to file the divisional application.⁴⁶

B. Elements

The Federal Circuit did not define the elements required for asserting the prosecution laches defense.⁴⁷ Thus, courts have applied one of four standards.⁴⁸ The first standard requires only an "unreasonable and unexplained delay in prosecution."⁴⁹ The second standard requires (1) an "unreasonable and unexplained delay in prosecution" and (2) that the circumstances of the case are sufficiently egregious to warrant the use of the equitable defense.⁵⁰ The third standard requires (1) an "unreasonable and unexplained delay in prosecuting the patent claim" and (2) the "alleged infringer has suffered prejudice as a result."⁵¹ Finally, the fourth standard requires (1) that the claims at issue were "presented more than two years after the existence of an intervening adverse right" and (2) an insufficient excuse for the delay of presenting the claims at issue.⁵²

C. Burden of Proof

The Federal Circuit did not establish the burden of proof to prove prosecution laches.⁵³ Some courts require clear and convincing evidence because prosecution laches renders a patent unenforceable.⁵⁴ Other courts require a preponderance of evidence because equitable laches and estoppel cases require the same burden of proof.⁵⁵

D. Result

Prosecution laches renders an issued patent unenforceable even though the patent applicant complied with all applicable statutes in filing and prosecuting that patent.⁵⁶

III. Reducing the Risk of Prosecution Laches

Patent applicants and their patent attorneys, particularly those who file multiple continuing applications, may adopt certain practices to reduce the risk of a court finding their patents unenforceable due to prosecution laches.

A. Actively Prosecute Applications

Courts have been less lenient with patent applicants who had a pattern of repeated filing of continuing applications without advancing prosecution or allowing issuance.⁵⁷ Even when the USPTO is primarily at fault in causing the delay, such as failing to issue a patent or misplacing a patent application, courts have not looked favorably at patent applicants who failed to follow-up within a reasonable time with the USPTO.⁵⁸ In contrast, many courts have been more lenient with patent applicants who did more than the minimum to advance prosecution, even when the prosecution involved substantial delays.⁵⁹

B. Timely Present Claims that Cover Competitor's Products

The Federal Circuit has approved the filing of a patent application to "exclude a known competitor's product from the market."⁶⁰ Long delays in filing patent applications or presenting claims that cover the competitor's products may, however, trigger prosecution laches.⁶¹ Particularly at risk are those patent applicants who could have presented claims that covered the competitor's product in earlier continuing applications.⁶² One court even has set a two-year limit for the patent applicant to present claims that cover the competitor's products, after which the "patentee must demonstrate sufficient excuse for the delay."⁶³

C. Direct Claims of Continuing Applications Towards Different or New Aspects of the Invention

Legitimate reasons to file one or more continuing applications include (1) covering new developments as the invention progresses, (2) covering aspects of the invention disclosed, but not claimed, in the original application, and (3) presenting new evidence of "unexpected advantages of an invention."⁶⁴

IV. Conclusion

The smoke has not cleared from the Federal Circuit's decisions in the *Symbol* cases as the dis-



strict courts still are sorting out the details of the prosecution laches defense. Patent applicants and their patent attorneys may, however, want to start reducing the risk of a court finding their patents unenforceable due to prosecution laches.

Endnotes

1. The author thanks Professor Joseph Scott Miller of Lewis and Clark Law School for recommending this topic. Additionally, the author dedicates this Article to his sister, Maryanne, his brother-in-law, Christopher, and his niece and goddaughter, Nicole. The views expressed in this Article are those of the author and not necessarily those of Kolisch Hartwell, P.C.
2. See 35 U.S.C. §§ 120, 121 (2004); U.S. DEP'T OF COMMERCE, UNITED STATES PATENT & TRADE MARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE §§ 201.06, 201.07, 201.08 (8th ed., rev. 1 Feb. 2003) [hereinafter MPEP].
3. STEPHEN A. BECKER, PATENT APPLICATIONS HANDBOOK § 5:2 (2003 ed.). A continuation application is a later filed application covering the same invention. MPEP, supra note 1, § 201.07. A continuation-in-part application is a later filed application repeating at least a substantial portion of the original application and adding new information not disclosed in the original application. *Id.* at § 201.08. A divisional application is a later filed application for a distinct invention that is "carved out" of an original application. *Id.* at § 201.06.
4. See MPEP, supra note 2, § 201.07.
5. See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 1000 (Fed. Cir. 1995) (en banc), aff'd, 116 S. Ct. 1384 (1996) (stating that the "legal effect of a patent claim is to establish the metes and bounds of the patent right to exclude").
6. 35 U.S.C. § 154(a)(2) (2004).
7. GATT is the General Agreement on Tariffs and Trade Uruguay Round Agreement Act (GATT), which was enacted in the current 35 U.S.C. § 154.
8. See 35 U.S.C. § 154(a)(2) (2004).
9. See 35 U.S.C. § 154(c)(1) (2004).
10. The patent applicant's failure to respond to the USPTO may lead to abandonment of the original application. See 37 C.F.R. § 1.135; MPEP, supra note 2, § 711. If the original application becomes abandoned, then the patent applicant may continue prosecution via the continuing application.
11. For a discussion of how patent applicants may abuse continuation applications, see Mark A. Lemley & Kimberly A. Moore, *Ending Abuse of Patent Continuations*, 84 B.U.L.REV. 63 (2004).
12. 2005 U.S. App. LEXIS 19439 (Fed. Cir. 2005) [hereinafter Symbol IV].
13. *Id.* at *22.
14. *Id.* at *3-*4.
15. See *id.* The asserted patents were all based on continuation-in-part applications filed before June 8, 1995 and thus had patent terms of the longer of twenty years from the earliest application (which presumably was the 1954 application) or seventeen years from the date of issue of the patent. See 35 U.S.C. § 154(c)(1) (2004).
16. *Symbol IV* at *5 (citing *Symbol Techs., Inc. v. Lemelson Med., Educ. & Research Found., L.P.*, 301 F. Supp. 2d 1147, 1150 (D. Nev. 2004)).
17. *Id.*
18. *Id.*
19. U.S. Patent Nos. 4,338,626; 4,511,918; 4,969,038; 4,979,029; 4,984,073; 5,023,714; 5,067,012; 5,119,190; 5,119,205; 5,128,753; 5,144,421; 5,249,045; 5,283,641; and 5,351,078. *Id.* at *6.
20. See *id.* at *5. The declaratory judgment action also sought judgment that "the patents [were] invalid under 35 U.S.C. § 101 for lack of utility; § 102 for anticipation; § 103 for obviousness; § 112 for failure to comply with the written description, enablement, and definiteness requirements." *Id.* Additionally, *Symbol* asserted that the patents were unenforceable for inequitable conduct before the U.S. Patent and Trademark Office. *Id.* (citing *Symbol Techs., Inc. v. Lemelson Med., Educ. & Research Found., L.P.*, 301 F. Supp. 2d 1147, 1151 (D. Nev. 2004)).
21. *Symbol Techs., Inc. v. Lemelson Med. Educ. & Research Found., L.P.*, 2000 U.S. Dist. LEXIS 21863, *1 (D. Nev. 2000), rev'd, 277 F.3d 1361 (Fed. Cir. 2002) [hereinafter Symbol I].
22. See *id.*
23. See *id.* at *19.
24. See *id.* at *18-*19 (citing *Ford Motor Co. v. Lemelson*, 42 U.S.P.Q.2d 1706, 1709 (D. Nev. 1997)).
25. *Symbol Techs., Inc. v. Lemelson Med., Educ. & Research Found., L.P.*, 2000 U.S. App. LEXIS 23529, *2 (Fed. Cir. 2000)).
26. *Symbol IV* at *17 (citing *Symbol Techs., Inc. v. Lemelson Med., Educ. & Research Found., L.P.*, 277 F.3d 1361, 1368 (Fed. Cir. 2002), cert. denied, 537 U.S. 825 (2002)).
27. *Symbol Techs., Inc. v. Lemelson Med., Educ. & Research Found., L.P.*, 277 F.3d 1361, 1368 (Fed. Cir. 2002), cert. denied, 537 U.S. 825 (2002) [hereinafter Symbol II].
28. See *id.* at 1365-66.
29. *Symbol Techs., Inc. v. Lemelson Med., Educ. & Research Found., L.P.*, 301 F.Supp.2d 1147, 1157 (D. Nev. 2004) [hereinafter Symbol III]. The district court also found Lemelson's asserted patents not infringed and invalid for lack of written description and enablement under 35 U.S.C. § 112. *Id.* at 1167.
30. The court appears to have measured the delay from the filing date of the original applications



- (1954 and 1956) to the filing date of the asserted continuing patents. *Symbol III*, 301 F.Supp.2d at 1155.
31. *Id.* at 1156 (citing *In re Bogese*, 303 F.3d 1362, 1369 (Fed. Cir. 2002)).
 32. *Id.* at 1156.
 33. *Id.*
 34. *Id.* at 1157 (citing *Symbol II* at 1364; *Webster Electric Co. v. Splitdorf Electrical Co.*, 264 U.S. 463, 471 (1924)).
 35. *See id.*
 36. *Symbol IV* at *22.
 37. *Id.* at *17-*18.
 38. *Id.* at *18.
 39. *Id.* at *20.
 40. *Id.* at *20-*21.
 41. For a historical perspective of the prosecution laches defense, see Joseph Scott Miller, *The Historical Roots of Patent Prosecution Laches*, 3 *OR. INTELLECTUAL PROP. NEWSLETTER* (Lewis & Clark Law Sch., Portland, Or.), Spring 2002, at 8.
 42. *See, e.g., Cummins-Allison Corp. v. Glory, Ltd.*, 2003 U.S. Dist. LEXIS 16812, *51-*52 (N.D. Ill. 2003) (stating that there remains an issue of fact whether patent applicant's delay of eight years to add claims potentially covering the alleged infringer's products was "unreasonable and inexcusable"); *Mosaid Techs. Inc. v. Samsung Elecs. Co.*, 362 F.Supp.2d 526, 553 (finding that the issuance of the asserted continuing patents over thirteen years after the priority date of those patents raises "some serious questions as to the reasonableness" of the delay). *But see Reiffin v. Microsoft Corp.*, 270 F. Supp. 2d 1132, 1156-7 (finding genuine issues of material fact that patent applicant's delay of more than eleven years to add claims potentially covering the alleged infringer's products was reasonable).
 43. *Symbol IV* at 22; *Cummins-Allison Corp.*, 2003 U.S. Dist. LEXIS 16812 at *51-*52 (concluding that "post-GATT patents and continuation patents may still be subject to prosecution laches" despite the patent term limitations inherent in those patents). *See also Anchor Wall Sys., Inc. v. Rockwood Retaining Walls, Inc.*, 2004 U.S. Dist. LEXIS 18458, *58 (D. Minn. 2004) (stating that GATT limitations on the patent term of continuation applications are not determinative on the issue of prosecution laches).
 44. *See Mosaid Techs. Inc. v. Samsung Elecs. Co.*, 362 F. Supp. 2d 526, 553 n.34 (D.N.J. 2005); (noting that a terminal disclaimer does not "preclude a finding that the delay in prosecution was unreasonable"); *Chiron Corp. v. Genentech, Inc.*, 268 F. Supp. 2d 1139, 1142-43 (E.D. Cal. 2002) (stating that "there is no suggestion in the case law that the filing of a terminal disclaimer necessarily and in every case disposes of the defense").
 45. If the USPTO determines that the patent applicant is attempting to claim two or more "independent and distinct" inventions, then it issues a restriction requirement requiring that applicant to select claims to only one of those inventions. *See* 35 U.S.C. § 121; 37 C.F.R. § 1.141 and 1.142; MPEP, supra note 2, § 800.
 46. *See Symbol IV* at *18-*19.
 47. *Reiffin*, 270 F. Supp. 2d at 1149; *See Symbol II* and *Symbol IV*.
 48. *See also Reiffin*, 270 F. Supp. 2d at 1151 (reviewing three prosecution laches standards).
 49. *See Mosaid*, 362 F. Supp. 2d at 551; *Biogen Idec MA Inc. v. The Trustees of Columbia Univ. in the City of N.Y.*, 332 F. Supp. 2d 286, 297-298 (D. Mass. 2004); *Reiffin*, 270 F.Supp.2d at 1153, 1155 (concluding that based on a review of pertinent cases only one element is required). The *Reiffin* court also provided a list of relevant considerations in determining whether there was an unreasonable delay, which included: "(1) the prosecution history of plaintiff's patents was typical of patents in that field or patents generally; (2) any unexplained gaps exist in the prosecution history; (3) plaintiff took any unusual steps to speed or delay the application process; (4) the PTO or other reviewing body took any unusual steps to speed or delay the application process; (5) plaintiff took any steps to limit public awareness of his pending applications or the inventions he sought to patent over the course of the prosecution; (6) any changes in plaintiff's prosecution of the application coincide with or directly follow evolutions in the field that relate to the claimed invention; and (7) legitimate grounds can be identified for abandonment of prior applications.
 50. *See Anchor Wall Sys., Inc. v. Rockwood Retaining Walls, Inc.*, 2004 U.S. Dist. LEXIS 18458 *55 (D. Minn. 2004); *Novo Nordisk Pharms., Inc. v. Bio-Technology Gen. Corp.*, 2004 U.S. Dist. LEXIS 14960, *100 (D. Del. 2004); *Stambler v. RSA Security, Inc.*, 243 F. Supp. 2d 74, 76 (D. Del. 2003); *Intuitive Surgical, Inc. v. Int'l Bus. Machs. Corp.*, 2002 U.S. Dist. LEXIS 24808, *9-*10 (D. Del. 2002).
 51. *See A&E Prods. Group, L.P. v. Mainetti USA Inc.*, 2004 U.S. Dist. LEXIS 2904, *5 (S.D.N.Y. 2004); *Cummins-Allison Corp. v. Glory, Ltd.*, 2003 U.S. Dist. LEXIS 2151, *127-*128 (N.D. Ill. 2003); *Gen-Probe Inc. v. Vysis, Inc.*, 2002 U.S. Dist. LEXIS 25020, * 119 (S.D. Cal. 2002); *Chiron Corp. v. Genentech, Inc.*, 268 F. Supp. 2d 1139, 1141 (E.D. Cal. 2002) (using the elements required for the traditional laches defense pending "further elaboration by the Federal Circuit").
 52. *Verizon Cal. Inc. v. Ronald A. Katz Tech. Licensing, L.P.*, 2003 U.S. Dist. LEXIS 23553, *61-*63 (C.D. Cal. 2003). *But see Digital Control Inc. v. McLaughlin Mfg. Co.*, 225 F. Supp. 2d 1224, 1229 (W.D. Wa. 2002) (stating that it is "not convinced that an examination of intervening adverse rights is a useful concept in prosecution laches").



53. *Reiffin*, 270 F. Supp. 2d at 1149; *See Symbol II* and *Symbol IV*.
54. *See, e.g., Novo Nordisk Pharms., Inc.*, 2004 U.S. Dist. LEXIS at *99; *Gen-Probe Inc. v. Vysis, Inc.*, 2002 U.S. Dist. LEXIS 25020, *113, *119 (S.D. Cal. 2002) (citing *Li Second Family Lt. Partnership v. Toshiba Corp.*, 231 F.3d 1373, 1378 (Fed. Cir. 2000)).
55. *See, e.g., Cummins-Allison Corp. v. Glory, Ltd.*, 2003 U.S. Dist. LEXIS 16812, *50 (N.D. Ill. 2003) (citing *A.C. Aukerman Co. v. R.L. Chaides Constr. Co.*, 960 F.2d 1020, 1045 (Fed Cir. 1992)); *Reiffin*, 270 F. Supp. 2d at 1155; *Intuitive Surgical, Inc.*, 2002 U.S. Dist. LEXIS at n.4 (adopting the preponderance of evidence burden of proof to be consistent with equitable laches and estoppel cases).
56. *See Symbol II* and *Symbol IV*.
57. *See In re Bogese II*, 303 F.3d 1362 (Fed. Cir. 2002) (holding that the U.S. Patent and Trademark Office did not err in rejecting Bogese's claims under the "equitable doctrine of laches"); *Reiffin*, 270 F. Supp. 2d 1132 at 1156 (stating that the textbook case of prosecution laches, "if one exists, involves a patent application filed and then followed by a lengthy period of unexplained inactivity") (internal quotations omitted). But see *Gen-Probe Inc.*, 2002 U.S. Dist. LEXIS at *120-*122 (finding patent applicant's repeated filing of continuation applications without advancing prosecution acceptable because of the patent attorney's lack of intent to delay prosecution, personnel changes within patent applicant, and the "extraordinary volume of work assigned" to the patent attorney).
58. *See Woodbridge v. U.S.*, 263 U.S. 50 (1923) (holding that patent applicant's nine-year delay in contacting the USPTO to follow-up on the issuance of his patent as rendering the patent unenforceable); *Intuitive Surgical, Inc. v. Int'l Bus. Machs. Corp.*, 2002 U.S. Dist. LEXIS 24808, *13-*16 (D. Del. 2002) (finding a four year and four month delay in contacting the USPTO to follow-up on a missing official filing receipt to be unreasonable but not egregious).
59. *See Reiffin*, 270 F. Supp. 2d at 1158-59 (finding that an eleven year delay was not unreasonable and unexplained because that plaintiff made "substantive changes to the applications or by properly appealing those decisions," raised a "number of substantive issues" on appeal, filed a "petition to make special", and did not "take frequent advantage of potential extensions of the period of time he was given to respond to office actions of the examiner") (internal quotations omitted).
60. *See Chiron Corp. v. Genentech, Inc.*, 268 F. Supp. 2d 1139, 1143 (E.D. Cal. 2002) (citing *Kingsdown Med. Consultants v. Hollister, Inc.*, 863 F.2d 867, 874 (Fed. Cir. 1988)) (internal quotations omitted).
61. *See id.*
62. *See Cummins-Allison Corp. v. Glory Ltd.*, 2003 U.S. Dist. LEXIS 2151, *132-*136 (N.D. Ill. 2003) (finding relevant to the issue of prosecution laches that the patent applicant could have added claims to cover the competitor's product in the prosecution of three earlier patents); *Symbol III*, at 1156 (stating that patent applicant's delay ignored the "duty to claim his invention promptly"). *But see Novo Nordisk Pharms., Inc. v. Bio-Technology Gen. Corp.*, 2004 U.S. Dist. LEXIS 14960, *101-*102 (D. Del. 2004) (stating that the relevant inquiry is "not whether the patentee unreasonably delayed in filing specific claims in a patent application . . . [r]ather, it is whether the patentee unreasonably delayed in prosecuting those claims once filed").
63. *Verizon Cal. Inc. v. Ronald A. Katz Tech. Licensing, L.P.*, 2003 U.S. Dist. LEXIS 23553, *63 (C.D. Cal. 2003) (citing *Crown Cork & Seal Co. v. Ferdinand Gutmann Co.*, 304 U.S. 159 (1938)).
64. *Symbol IV* at *19; *See Verizon Cal. Inc.*, 2003 U.S. Dist. LEXIS 23553 at *69-*70 (stating the need to distinguish between patent applicant's "legitimate attempt to extract from the original patent applications all claimable subject matter disclosed in these applications, or an impermissible, calculated attempt to extend its exclusivity right by presenting application claims having no meaningful difference in scope from previously issued claims").

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9. *Id.* at 640.
10. *Id.* at 640-641.
11. 17 U.S.C. § 1201(a)(2) (2000) provides: No person shall manufacture...any technology... that...is primarily designed or produced for the purpose of circumventing a technological measure that effectively controls access to a work protected under this title;...has only limited commercially significant purpose or use other than to circumvent a technological measure that effectively controls access to a work protected under this title; or...is marketed...for use in circumventing a technological measure that effectively controls access to a work protected under this title.
12. *Davidson*, 422 F.3d at 641.
13. *Id.* at 642.