

## Eastman Says Fed. Circ. Patent Ruling Flouted Precedent

By **Ben James**

Law360, New York (November 15, 2011, 8:06 PM ET) -- Eastman Chemical Co. asked the U.S. Supreme Court Wednesday to review a Federal Circuit decision that revived a Wellman Inc. suit over patents covering a special plastic used in bottles, which Eastman said was at odds with some of the appeals court's own prior findings.

Eastman's petition for certiorari took aim at an April 29 Federal Circuit decision that held that a district court erred when it granted Eastman's motion for summary judgment that two patents covering a type of plastic that can handle high temperatures during the bottling process were invalid due to indefiniteness.

Wellman sued Eastman in September 2007, alleging that Eastman infringed its patents by manufacturing certain polyethylene terephthalate resins, which are used in the food and beverage packaging industry. Eastman won summary judgment in 2010.

But the Federal Circuit reversed and joined "one of two conflicting lines of its precedent" by holding that that the patent claims at issue were not invalid because they were amenable to construction, according to Eastman, which added that the amenable-to-construction standard was "meaningless and vague."

"The Federal Circuit's decision in this case deepens a significant split within the Federal Circuit and with several other federal appellate courts," the petition said.

In this case, the Federal Circuit opted to apply a line of decisions that have held that patent claims will survive indefiniteness challenges as long as they are amenable to construction or if reasonable efforts at construction don't prove futile, said Eastman, quoting from the court's 2001 decision in Exxon Research and Engineering Co. v. U.S.

The amenable-to-construction standard conflicts with Supreme Court precedents as well as previous Federal Circuit rulings, rulings out of other circuit courts, and the plain language of the law, Eastman argued.

The Federal Circuit has created two conflicting lines of authority on definiteness, one of which adheres to the public notice requirement of the patent statute — which requires that claims be definite enough to let the public know what the boundaries of the invention are — and the other of which focuses on whether the claim is amenable to construction, said the petition.

But in other cases — including the one at hand — the Federal Circuit upheld vague and ambiguous patent claims as long as they are amenable to some construction, even though the proper meaning of the claims cannot clearly be determined, Eastman argued.

Eastman pointed to the Federal Circuit's 2008 decision in *Halliburton Energy Services Inc. v. M-I LLC* and its 2003 ruling *Honeywell International Inc. v. U.S. International Trade Commission* in support of its argument.

The Federal Circuit should have applied *Honeywell* and *Halliburton* in this case and affirmed the trial court's finding that the Wellman patents were invalid, the petition said.

The *Honeywell* case is virtually identical to the case at hand, according to Eastman.

“We do not believe that there is a split in Federal Circuit precedent,” Edwards Wildman Palmer LLP's Scott Wofsy, an attorney for Wellman, told Law360. “We believe the decision in our case was consistent with prior decisions of the Federal Circuit for determining the definiteness of claim language.”

Wellman was recently acquired by DAK Americas LLC. A DAK Americas representative declined to comment.

The patents-in-suit are U.S. Patent Numbers 7,129,317 and 7,094,863.

Eastman is represented by Thomas Goots, Susan Gerber, Anthony Jacono and Lawrence Rosenberg of Jones Day.

Wellman is represented by Scott Wofsy and Barbara Moore of Edwards Wildman Palmer LLP.

The case is *Eastman Chemical Co. v. Wellman Inc.*, case number 11-584, in the Supreme Court of the United States.

--Additional reporting by Ryan Davis. Editing by Cara Salvatore.