

## Fed. Circ. Affirms Drywall Patent Is Indefinite

By Britain Eakin

*Law360 (July 1, 2020, 6:11 PM EDT)* -- Pacific Coast Building Products Inc. has lost a bid to reverse a California federal judge's decision that one claim in a drywall patent it asserted against CertainTeed Gypsum in a 2018 suit is indefinite, with a Federal Circuit panel agreeing a key claim term's ambiguity renders it invalid.

Tuesday's nonprecedential decision rejected Pacific Coast's argument that the patent meets the definiteness requirement to inform a skilled artisan of the scope of the invention with reasonable certainty, saying that a skilled artisan would be lost when attempting to calculate a single value for the claim term at issue — "scored flexural strength."

The panel held that the inventors coined the term themselves and that the patent's written description and the claim language failed to provide the required guidance a skilled artisan would need to measure the term — which is not used by industry — with reasonable certainty.

"While the claims recite a particular value for 'scored flexural strength' ... the claims and specification fail to explain what the value represents or how to consistently and reproducibly measure this new characteristic," the decision said.

The patent pertains to a method allowing drywall for soundproofing, which is stronger than regular drywall, to be more easily broken into smaller pieces. The district court found — and the Federal Circuit panel agreed — that the patent's lack of clarity about which of four measurement methods to use to score a drywall's flexural strength doomed it.

"We agree with the district court that there are multiple ways to measure 'scored flexural strength' and that the specification's lack of guidance for choosing which measurement to use renders claim 21 indefinite," the decision said.

The panel said the district court's decision was supported by testimony from CertainTeed's expert, who provided three bases for indefiniteness that Pacific Coast did not rebut. The panel concluded the circumstances of this case mirrored those in its 2015 decision in *Teva Pharmaceuticals USA Inc. v. Sandoz Inc.*, which held that a patent was indefinite because its written description didn't specify which of three molecular weight measurement methods to use.

The panel said it could find no clear error in the district court's reasoning.

Counsel for the parties did not immediately respond to requests for comment.

The patent-in-suit is U.S. Patent No. 9,388,568.

U.S. Circuit Judges Jimmie V. Reyna, Raymond T. Chen and Todd M. Hughes sat on the panel for the Federal Circuit.

Pacific Coast is represented by Jason E. Mueller, Galyn Gafford and Matthew G. Halgren of Sheppard Mullin Richter & Hampton LLP and W. Scott Hastings of Locke Lord LLP.

CertainTeed Gypsum is represented by Matthew J. Moore, Richard G. Frenkel, Adam M. Greenfield, Gabriel Bell, Rebecca Rabenstein, and Diane Ghrist, of Latham & Watkins LLP.

The case is Pacific Coast Building v. CertainTeed Gypsum Inc., case number 19-1524, in the U.S. Court of Appeals for the Federal Circuit.

--Editing by Daniel King.