

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF HAWAII

WILLIAM R. KOWALSKI,	)	Civ. No. 04-00055 BMK
	)	
Plaintiff,	)	
vs.	)	ORDER DENYING
	)	DEFENDANT’S MOTION FOR
OCEAN DUKE CORPORATION,	)	ENTRY OF JUDGMENT OF
	)	PATENT INVALIDITY ON
Defendant.	)	GROUND OF INDEFINITENESS
_____	)	

ORDER DENYING DEFENDANT’S MOTION FOR ENTRY OF JUDGMENT  
OF PATENT INVALIDITY ON GROUND OF INDEFINITENESS

Plaintiff William R. Kowalski (“Kowalski”) obtained a jury verdict against Defendant Ocean Duke Corporation (“Ocean Duke”) on December 13, 2007, for infringement of Kowalski’s U.S. Patent 5,972,401 (“the Kowalski Patent”). Ocean Duke has now filed a “Motion for Entry of Judgment, Based on Patent Invalidity on Grounds of Indefiniteness.” The Court deems this motion appropriate for consideration without further hearing, and after careful review of the motion and the supporting and opposing memoranda, Ocean Duke’s motion is hereby DENIED.

## DISCUSSION

### I. TIMELINESS OF THE MOTION

Notwithstanding the jury verdict in this case, Ocean Duke has moved for judgment in its favor on the grounds that the claims of the Kowalski patent are invalid as a matter of law. A party may move for judgment notwithstanding the verdict only by renewing a motion for judgment as a matter of law already made during the course of the trial. Fed. R. Civ. P. 50(b). Rule 50 provides that the underlying motion for judgment as a matter of law “may be made at any time before the case is submitted to the jury.” Fed. R. Civ. P. 50(a). The renewal of such a motion may only be based on arguments raised in the underlying motion. Freund v. Nycomend Amersham, 347 F.3d 752, 761 (9th Cir. 2003) (stating that “[a] party cannot raise argument in its post-trial motion for judgment as a matter of law under Rule 50(b) that it did not raise in its pre-verdict Rule 50(a) motion”).

Here, Ocean Duke did make a Rule 50 motion for judgment as a matter of law on the issue of patent invalidity at the close of Kowalski’s case. The only invalidity ground that Ocean Duke asserted in this motion, however, was invalidity on the basis of failure to meet the written description requirement. Nowhere in this motion did Ocean Duke argue or even allude to indefiniteness. These are very different defenses. The written description defense involves issues

of fact, and is grounded in the first paragraph of 35 U.S.C. § 112. Cordis Corp. v. Medtronic Ave., Inc., 339 F.3d 1352, 1363 (Fed. Cir. 2003). The indefiniteness defense, on the other hand, is a matter of law, and is grounded in the second paragraph of § 112. Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576 (Fed. Cir. 1986). Because of these differences, Ocean Duke's present motion for judgment on the grounds of indefiniteness fails to renew its earlier Rule 50(a) motion for a finding of invalidity based on the written description defense.

Moreover, it is now too late for Ocean Duke to bring an independent Rule 50(a) motion, since it has not been brought "before the case is submitted to the jury," Fed. R. Civ. P. 50(a). The fact that Ocean Duke pled the indefiniteness defense in its answer does not provide it with a free pass to ignore the requirements of Rule 50. See, e.g. Bradford-White Corp. v. Ernst & Whitney, 872 F.3d 1153, 1161 (3d. Cir. 1989) (finding that an affirmative defense pled in the answer had been waived where it had not been pursued before or at trial because "it would be grossly unfair to allow a plaintiff to go to the expense of trying a case only to be met by a new defense after trial"). Ocean Duke did not raise indefiniteness during summary judgment proceedings, did not raise it as a possible defense in its pre-trial statement or its trial brief, and did not raise it at trial. Ocean

Duke cannot be allowed to raise this defense now, at this very late stage in the proceedings.

Accordingly, Ocean Duke's motion for judgment on the basis of indefiniteness is hereby DENIED for being untimely under Rule 50(a), and for failing to meet the renewal requirement of Rule 50(b).

## II. MERITS OF THE MOTION

Even if Ocean Duke's motion were timely filed at an appropriate stage of the litigation, it would fail on the merits. A patent is invalid for indefiniteness where there is no objective standard allowing the public to determine the scope of the claimed invention. See Datamize LLC v. Plumtree Software, Inc., 417 F.3d 1342, 1347 (Fed. Cir. 2005). Here, Ocean Duke asserts that the Kowalski Patent's claims of "reduc[ing] taste imparting components below thresholds for imparting smoke odor and taste" (Kowalski Patent, Col. 23, at 1-4) is entirely subjective, and hence, invalid.

Kowalski responds that the Kowalski Patent's claims, unlike those in Datamize, are capable of a reasonable and definite construction. Unlike the claim of "aesthetically pleasing" at issue in Datamize, which is not susceptible to any objective criteria, there is no doubt what it means for something to be "tasteless," or how that criteria can be met. Moreover, the Court was in fact able to construe

this language in its claims construction order, and so the claim language is not “insolubly ambiguous,” nor did “reasonable efforts at claim construction prove futile,” Datamize, 417 F.3d at 1347 (stating that “only claims ‘not amenable to construction’ or ‘insolubly ambiguous’ are indefinite).

CONCLUSION

For the foregoing reasons, Ocean Duke’s motion for an entry of judgment on the grounds of patent invalidity is hereby DENIED.

IT IS SO ORDERED.



/s/ Barry M. Kurren  
United States Magistrate Judge  
Dated: March 31, 2008

Kowalski v. Ocean Duke; Civ. No. 04-00055 BMK; ORDER DENYING DEFENDANT’S MOTION FOR ENTRY OF JUDGMENT OF PATENT INVALIDITY ON GROUND OF INDEFINITENESS.