

Patents Have Mistakes; You Should Fix Them At The PTO

Canatex Completion Sol. Inc. vs. Wellmatics LLC, et al., Case No. 4:22-cv-03306, Dkt. No. 100
(S.D. Tex. Dec. 14, 2023)

By: Robyn Bowland & Nick Wheeler | December 28, 2023

Found a mistake in your patent? You might want to get it fixed at the U.S. Patent and Trademark Office (“PTO”). If the mistake is not corrected by the PTO, your patent may be found invalid in court. On December 14, 2023, the Southern District of Texas (“the court”) held all patent claims invalid because a claimed phrase contained an error that rendered the claims indefinite.

Canatex Completions Solutions, Inc. (“Canatex”) brought a patent infringement suit against Wellmatics, LLC (“Wellmatics”) asserting several claims from U.S. Patent No. 10,794,122 (“the ’122 Patent”). The claims of the ’122 patent generally relate to a “releasable connection for a downhole tool string” that is used in oil wells. The parties disputed five different claim phrases. In its December 14, 2023 claim construction order, the court analyzed the claim phrase “a release position that permits the releasable engagement profile to expand radially to release the connection profile of the second part.” Canatex stated this phrase contained an error but asked the court to fix it. Wellmatics argued the error was not evident on the face of the patent and asserted all of the claims were indefinite.



All of the independent claims in the ’122 patent included the phrase “the connection profile of the second part.” Notably, there was no antecedent basis for the “second part,” although there was an antecedent basis for the term “first part.” Canatex argued this was a clear clerical error. First, Canatex argued the use of the definite article “the” meant the phrase was referring back to the connection profile of the first part previously identified in the claim. Thus, a person of ordinary skill in the art (“POSITA”) would understand based on all the other references to a “connection profile” that the claims contained an error and that the drafters meant the connection profile of the first part. Second, Canatex argued that the specification’s use of the error indicated the drafter merely duplicated the error from the specification into the claims. In response, Wellmatics argued there was no antecedent basis for the connection profile of the second part, and that the error was not obvious because the patent describes both a first and second part, both of which have connection profiles. Therefore, Wellmatics argued a POSITA could not discern with reasonable certainty whether the claims referred to two connection profiles or only one. Additionally, Wellmatics argued because the specification used the same error, a POSITA would infer the phrase was intentional. The Court held the error was not evident from the face of the patent, and therefore the court could not “correct” the claim. Thus, all of the independent claims of the patent were invalid as indefinite. The fact that the error was found in the claims and specification suggested it was intentional. Additionally, the use of “the” instead of an “a” in the phrase suggested there could be multiple interpretations.

The court also rejected Canatex’s argument that the court should fix the error because the PTO would take too long to correct the error. The court again explained that while the PTO can correct non-obvious errors, courts can only correct mistakes that are evident on the face of the patent. Further, the court stated there was no case law that supported correcting an error in court when the PTO would take too long.

Patent owners should be careful when launching infringement suits if they think their claims may contain an error. If there is any uncertainty as to whether the error is evident from the face of the patent, the patent should be corrected through the PTO, even though it may take a long time. Otherwise, attempting to fix your claims through the court system runs the risk your claims may be found invalid as indefinite.