

Patent Law and the Supreme Court: Patent Certiorari Petitions Denied in 2009

DECEMBER 31, 2009

WilmerHale compiles lists of certiorari petitions that raise patent-law issues. This page contains a consolidated list of denied petitions for this year, organized in reverse chronological order by date of certiorari petition.

[Recently pending, granted and denied certiorari petitions](#)

Boston Scientific Corporation and Scimed Life Systems, Inc. v. Cordis Corporation, No. 09-362.

Questions Presented:

1. Where the phrase "printed publication" has been continuously used in patent statutes since 1836, does the Federal Circuit's abandonment of the original construction of that phrase, refusal to apply any other plain-language construction, and substitution of its own policy goal of protecting inventors to the exclusion of Congress' goal of encouraging competition improperly alter the scope of the "loss of right to patent" provision of 35 U.S.C. § 102(b)?
2. Does the Federal Circuit's case-by-case analysis of "printed publications"—described by commentators as "a muddled mess" with "many irreconcilable conflicts"—improperly lead to an inconsistent and unpredictable scope of the "loss of right to patent" provision and frustrate Congress' policy goal of providing a bright-line on which inventors and the public can rely?
3. Does an inventor's dissemination of a printed description of his invention to commercial companies and individuals skilled and interested in the art without a legal obligation of confidentiality—for five years in an attempt to exploit his invention—bar his later attempt to file a patent application and thereby unilaterally extend the duration of his statutory monopoly and withdraw from the public domain the subject matter he had spent five years disclosing?

Cert. petition filed 9/28/09.

Conference 11/24/09. **Petition denied.**

Astellas Pharma, Inc v. Lupin Limited and Lupin Pharmaceuticals, Inc., No. 09-335

Question Presented:

Whether the United States Court of Appeals for the Federal Circuit erred in ignoring the Court's binding precedent and finding product-by-process claims are not infringed by an identical product made by a different process?

Cert. petition filed 9/16/09.

Conference of 1/8/10. **Petition denied.**

Robert Chapman, Lonn S. Rider, Qi Hong, Donald Kyle and Robert Kupper v. Michael Lawrence Casner, Jen-Sen Dung, Erno M. Keskeny and Jin Luo, No. 09-320

Questions Presented:

1. How is the principle in *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 68 (1923), that a claim may be non-obvious when the inventor discovers a "source [of trouble or a problem] not before known" and then claims the resulting "application of the remedy," applied in light of *KSR International Co. v. Teleflex*, 550 U.S. 398 (2007)?
2. Does Eibel require recitation of the newly discovered source of the problem as claim limitations?

Cert. petition filed 9/10/09.

Conference 10/30/09. **Petition denied.**

Medela AG and Medela, Inc., v. Kinetic Concepts, Inc., KCI Licensing, Inc., KCI USA, Inc., and Wake Forest University Health Sciences, No. 09-198

Question Presented:

Whether a person accused of patent infringement has a right to independent judicial, as distinct from lay jury, determination of whether an asserted patent claim satisfies the "non-obvious subject matter" condition for patentability?

Cert. petition filed 8/11/09.

Conference 11/13/09. **Petition denied.**

Apotex, Inc. and Apotex Corp., v. Sanofi-Synthelabo, Sanofi-Synthelabo Inc., and Bristol-Myers Squibb Sanofi Pharmaceuticals Holding Partnership, No. 09-117

Question Presented:

Whether, if an experiment was "obvious to try," a prima facie case of obviousness is automatically rebutted by a showing that the outcome of the experiment was not entirely predictable?

Cert. petition filed 7/24/09.

Conference 10/30/09. **Petition denied.**

Steven D. Richie and H. David Reynard (as Trustee for the Harlie David Reynard, Jr. Revocable Trust), v. Vast Resources, Inc., (doing business as Topco Sales), No. 09-97

Questions Presented:

1. Did the Federal Circuit Panel err in not considering all relevant evidence of non-obviousness in reaching its decision of invalidity based on obviousness.?
2. Must the Federal Circuit Court of Appeals Panel explicitly address, and carefully attend to all relevant evidence of non obviousness, such as secondary consideration in reaching a judgement of obviousness?
3. Whether the Supreme Court will address the inconsistencies within the opinions of the Federal Circuit and inconsistencies with Supreme Court Case law, where the Federal Circuit found error when the District Court below failed?

(a) to give due weight to the nature of the problem to be solved and common sense as required in *Andersen Corp. v. Pella Corp.*, 300 Fed.Appx. 893, 895, C.A.Fed. (Minn. 2008); see also *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*,

(b) to make mention or discuss relevant evidence of the secondary considerations as required and, set forth in *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 667, C.A.Fed. (Mo. 2000);

(c) to focus on the indications of non obviousness, as required by *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 14 (1966); and

*ii (d) to explain the rationale for finding the patent obvious absent any evidence of any rational. underpinning which would support the legal conclusion of obviousness, as required by the Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741.

Cert. petition filed 7/22/09.

Conference 9/29/09. **Petition denied.**

Boston Scientific Scimed Inc. and Boston Scientific Corporation, v. Cordis Corporation and Johnson & Johnson, Inc., No. 09-103

Questions Presented:

1. Whether the Federal Circuit's "de novo" review methodology for jury verdicts rendered on the issue of obviousness under [35 U.S.C. § 103\(a\)](#) has become so inconsistent and unpredictable that this Court's guidance is required?
2. Whether the Federal Circuit's "de novo" review methodology for the ultimate legal conclusion under [§ 103](#) entitles it to substitute its own findings for a jury's implicit findings on the underlying Graham factors, including the secondary considerations of nonobviousness?
3. Whether the Federal Circuit may disregard the jury's findings that there was a long-felt but unfulfilled need, a widespread failure of others, and significant commercial success directly resulting from the claimed invention, and then negate their effect by recasting them as "weak" by adopting the rejected factual assertions of the verdict loser?

Cert. petition filed 7/22/09.

Conference 9/29/09. **Petition denied.**

Line Rothman and Glamourmom LLC, v. Target Group et al., No. 09-304

Questions Presented:

1. Whether an invention which was not obvious to conceive can satisfy the "nonobvious subject matter" patentability requirement, even if the invention becomes obvious to reduce to practice once conceived?
2. Whether denying patentability on an invention that was not obvious to conceive violates §103(a) of the Patent Act, which provides that "Patentability shall not be negated by the manner in which the invention was made"?
3. Whether denying patentability on an invention that was not obvious to conceive violates this Court's holding in *KSR v. Teleflex* that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently known in the prior art"?

Cert. petition filed 7/7/09.

Conference 11/13/09. **Petition denied.**

Lewis Ferguson, et al. v. Director of the The United States Patent and Trademark Office, No. 08-1501

Questions Presented:

1. Are claims that recite business methods unpatentable per se when they are not tied to a machine and do not preempt any mathematical algorithm?
2. Is a claim properly unpatentable under [35 U.S.C. §101](#) as being an abstract idea only because it does not come within the test of "machine or transformation" set forth by *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008)?

Cert. petition filed 6/2/09.

Conference 9/29/09. **Petition denied.**

Alphapharm Pty., Ltd. and Genpharm Inc., v. Takeda Chemical Industries, Ltd. and Takeda Pharmaceuticals North America, Inc., No. 08-1463

Question Presented:

1. This Court has long held that a party cannot be punished for what it was lawfully entitled to do. In spite of this fundamental rule-of-law, that is precisely what happened here. The district court punished Alphapharm for what it was lawfully entitled to do, and in the process may have gutted the underlying purpose of the Hatch-Waxman Act. In *BMW of North America Inc. v. Gore*, 517 U.S. 559, 573-74 (1996), this Court held that a fact finder (in that case, an Alabama state jury) has no power to punish a litigant for conduct that is lawful in that or other jurisdictions. The jury there had awarded \$4 million in punitive damages against the automobile company BMW for repairing and repainting minimally damaged cars without notice to prospective buyers. But BMW could have no reason to believe that its conduct would subject it to sanctions in either Alabama or any of the other 49 states. Finding that the Alabama award constituted a due process violation, this Court reversed and remanded.
2. Here the Court faces a closely analogous set of facts. Alphapharm Pty., Ltd. and Genpharm Inc. (collectively "Alphapharm") challenged U.S. Patent No. 4,687,777 ("the '777 patent") under the Hatch-Waxman Amendments ("Hatch-Waxman") to the Food, Drug, and Cosmetic Act by certifying to the FDA that the compounds claimed in that patent were obvious. Hatch-Waxman allows such challenges if the patentee is provided notice of the challenge with a detailed statement of the legal and factual bases in support. Alphapharm provided that notice by pre-suit letter ("Notice Letter"), and explained that the ' 777 patent*ii was obvious over two particular prior-art references. Following trial, the district court rejected the challenge and ruled the ' 777 patent nonobvious. But the district court went further, finding that the challenge was in bad faith under the patent act's exceptional-case provision. The district court's principal basis for this finding was Alphapharm's reliance on additional prior-art references it adduced during pre-trial discovery. This was **standard** litigation conduct in a patent case - indeed in any case. Alphapharm had no cause to believe using information obtained through discovery at trial would subject it to sanctions. Just as in *Gore*, Alphapharm was punished for lawful conduct. Does the court's award of \$5.4 million against Alphapharm penalize it for engaging in standard litigation conduct, and thus deprive Alphapharm of due process of law?

Cert. petition filed 5/26/09.

Conference 9/29/09. **Petition denied.**

Mylan Laboratories, inc., Mylan Pharmaceuticals, Inc., & UDL Laboratories,

Inc., v. Takeda Chemical Industries, Ltd. & Takeda Pharmaceuticals North America, Inc., No. 08-1461

Question Presented:

Does 35 U.S.C. § 285 permit the imposition of a ten-million-dollar attorney-fee award based substantially on (i) a generic drug maker's challenge to a patent's validity on different grounds than those stated in its pre-suit notice to the brand company, and (ii) the trial court's post-trial determination that the drug maker's initial (and ultimately unlitigated) theory lacked merit?

Cert. petition filed 5/26/09.

Conference 9/29/09. **Petition denied.**

CHF Industries, Inc. v. Park B. Smith, Inc., No. 08-1378

Question Presented:

Whether the Federal Circuit erred in holding that Fed. R. App. P. 4(a)(2) permits a premature notice of appeal filed from an interlocutory order (that did not decide or dispose of all claims in the case) to operate as a notice of appeal from a subsequently—entered final order?

Cert. petition filed 5/6/09.

Conference 9/29/09. **Petition denied.**

In Re DBC , No. 08-1284

Questions Presented:

1. Whether the PTO has jurisdiction to pass on the constitutionality of its own federal statutes or whether such constitutional issues should be heard in the first instance by the Federal Circuit as an Article III Court?
2. Whether 35 U.S.C. § 6 as amended in the Act of Aug. 12, 2008, Pub. L. No. 110-313, 122 Stat. 3014, violates the Appointments Clause of the United States Constitution?
3. Whether Congress exceeded its power by authorizing retroactive appointments in Congress's amendment to 35 U.S.C. § 6 in the Act of Aug. 12, 2008, Pub. L. No. 110- 313, 122 Stat. 3014?

Cert. petition filed 4/15/09.

Conference 9/29/09. **Petition denied.**

Patent certiorari petitions denied this year

Patent certiorari petitions denied in: [2015](#), [2014](#), [2013](#), [2012](#), [2011](#), [2010](#), 2009

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