
Patent Law and the Supreme Court: Certiorari Petitions Denied in 2010

DECEMBER 31, 2010

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](#)

Benun, et al. v. FujiFilm Corp., No. 10-486

Question Presented:

Whether the authorized sale of an article that substantially embodies a patented invention exhausts the patentee's rights to use the patent law to control post sale disposition of such article, where the authorized sale occurs outside the United States.

Cert petition filed 10/8/10.

Conference 12/10/10. Petition denied **12/13/10**.

[CAFC Opinion, CAFC Argument](#)

Anascape, Ltd. v. Nintendo of America, Inc., No. 10-301

Question Presented:

In reviewing the factual sufficiency of the evidence supporting a jury verdict under Fed. R. Civ. P. 50, may an appellate court weigh expert testimony submitted to the jury, and discredit that expert testimony, when its admissibility was never challenged under Fed. R. Evid. 702?

Cert. petition filed 8/27/10.

Conference 10/29/10. **Petition denied 11/1/10.**

[CAFC Opinion, CAFC Argument](#)

WilmerHale represents respondent Nintendo of America, Inc.

Kozachuk v. Medpointe Healthcare, Inc., No 10-342

Question Presented:

Should reasonable (or at least some) indicia of informed consent, by voir dire or otherwise, be a necessary and required element of an oral settlement of a case in open court, on the record?

Cert. petition filed 7/6/10. **Petition denied 11/1/10.**

[CAFC Opinion](#)

Innovative Therapies, Inc. v. Kinetic Concepts, No. 10-287

Questions Presented:

1. Does Article III's grant of jurisdiction of "all Cases...arising under...the Laws of the United States," implemented in the "actual controversy" requirement of the Declaratory Judgment Act, 28 U.S.C. § 2201 (a), require a patentee to direct an affirmative act toward a potential infringer for declaratory judgment subject matter jurisdiction to exist?
2. Does such grant of jurisdiction require that a patentee be able to sue a potential infringer before declaratory judgment subject matter jurisdiction can exist?
3. What are the metes and bounds of a district court's discretion to dismiss a declaratory judgment complaint under the Declaratory Judgment Act, despite the existence of an actual controversy?

Cert. petition filed 8/24/10. **Petition denied 10/18/10.**

[CAFC Opinion](#), [CAFC Argument](#)

Vaidyanathan v. Kappos, No. 10-234

Questions Presented:

1. Does de novo judicial review of a legal conclusion reached by an agency adjudicatory body permit remand to the agency when there is no material question of underlying fact?
2. Does de novo judicial review of a legal conclusion reached by an agency adjudicatory body require reversal when the underlying facts as set forth by the agency adjudicatory body, and taken in a light most favorable to that body, are insufficient to reach the agency's ultimate legal conclusion?

Cert. petition filed 8/16/10. **Petition denied 10/4/10.**

[CAFC Opinion](#)

Sami Chemicals and Extracts v. United States Patent and Trademark Office, No. 10-133

Questions Presented:

1. Whether the failure of the Federal Circuit to order reopening of prosecution after the U.S.

Patent and Trademark Office Board of Appeals and Patent Inferences issued a new ground of rejection in its Decision on Appeal denied Petitioner the right to appeal decisions "adverse to the patentability of any original or proposed amended or new claim of the patent." 37 C.F.R. § 41.50(d), 35 U.S.C. § 306?

2. Whether the failure of the Federal Circuit to reverse the Decision on Appeal issued by the U.S. Patent and Trademark Office Board of Appeals and Patent Inferences was inconsistent with its own precedents, in particular: *Abbot Labs. v. Baxter Pharm. Prods., Inc.*, 334 F.3d 1274 (Fed. Cir. 2003); and *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

Cert. petition filed 7/26/10.

Conference 9/27/10. **Petition denied 10/4/10.**

[CAFC Opinion](#), [CAFC Argument](#)

***University of South Carolina v. University of Southern California*, No. 09-1270**

Questions Presented:

1. Should the likelihood-of-confusion analysis require proof that a group of relevant purchasing consumers exists who would likely be confused by competing trademarks so that trademark registration may be denied or trademark infringement be found?
2. Should the scope of protection for ornamentally used trademarks (i.e., merchandising rights), such as those used by colleges and universities to decorate products and indicate an affiliation with their school, be accorded the same scope of protection as traditional trademarks that instead identify the source of the products being sold under the trademarks?

Cert. petition filed 4/19/10. **Petition denied 10/4/10.**

***Vaidyanathan v. Kappos*, No. 10-234**

Questions Presented:

1. Does de novo judicial review of a legal conclusion reached by an agency adjudicatory body permit remand to the agency when there is no material question of underlying fact?
2. Does de novo judicial review of a legal conclusion reached by an agency adjudicatory body require reversal when the underlying facts as set forth by the agency adjudicatory body, and taken in a light most favorable to that body, are insufficient to reach the agency's ultimate legal conclusion?

Cert. petition filed 8/16/10; 2010 WL 3267816. **Petition denied.**

Sami Chemicals and Extracts v. David Kappos, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and

Trademark Office, No. 10-133

Questions Presented:

1. Whether the failure of the Federal Circuit to order reopening of prosecution after the U.S. Patent and Trademark Office Board of Appeals and Patent Interferences issued a new ground of rejection in its Decision on Appeal denied Petitioner the right to appeal decisions “adverse to the patentability of any original or proposed amended or new claim of the patent.” [under] 37 C.F.R. § 41.50(d), 35 U.S.C. § 306?
2. Whether the failure of the Federal Circuit to reverse the Decision on Appeal issued by the U.S. Patent and Trademark Office Board of Appeals and Patent Interferences was inconsistent with its own precedents, in particular:
Abbott Labs. v. Baxter Pharm. Prods., Inc., 334 F.3d 1274 (Fed. Cir. 2003); and *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

Cert. petition filed 7/26/10.

Conference 9/27/10. **Petition denied.**

Media Technologies Licensing, LLC and Adrian Gluck, v. The Upper Deck

Company LLC, Upper Deck Distribution & Sales Company, Upper Deck

Distribution & Sales Company, LLC. and Playoff Corporation, No. 10-126

Questions Presented:

1. Whether the same standard should govern the obviousness determination of patents in the non-technical arts as patents in the technical arts?
2. Whether the Federal Circuit erred by failing to apply in its obviousness analysis of a non-technical patent this Court's precedent 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.” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).
3. Whether this Court's precedent that a patent can be proved invalid as “obvious to try” when “there are a finite number of identified, predictable solutions” requires (1) merely that the number of solutions be “not infinite” (e.g. one million potential solutions) as the Federal Circuit held in this case; or alternatively, (2) that the number of solutions be relatively small or easily traversed (as the Federal Circuit has held in other cases). *KSR Int'l Co.*, 550 U.S. at 421

Cert. petition filed 7/22/10.

Conference 9/27/10. **Petition denied 10/4/10.**

[CAFC Opinion](#), [CAFC Argument](#)

Derek J. Lackey v. David J. Kappos, Under Secretary of Commerce for

Intellectual Property Director of the United States Patent and Trademark Office,

No. 10-50

Question Presented:

Whether substituting one fabrication material (metal) for another (plastic) to produce a previously unknown significant advance in the state of the art of air admittance valves is per se obvious under 35 USC 103(a), thereby foreclosing further consideration of patentability?

Cert. petition filed 6/30/10

Conference 9/27/10. **Petition denied 10/4/10.**

[CAFC Opinion](#)

***Heather A. Davis v. Brouse McDowell, L.P.A. and Daniel A. Thomson*, No. 09-1413**

Questions Presented:

1. Whether the Federal Circuit erred by relying upon a deposition answer in determining that federal patent jurisdiction extended to Plaintiff's Amended Complaint under 35 U.S.C. § 1338(a)?
2. Whether the Federal Circuit erred by asserting federal patent jurisdiction over a single state law claim of legal malpractice in which at least one theory of the claim does not rely upon a substantial question of federal patent law?

Cert. petition filed 5/19/10.

Conference 9/27/10. **Petition denied 10/4/10.**

[CAFC Opinion](#), [CAFC Argument](#)

***Ferring B.V., Ferring Pharmaceuticals, Inc., and Aventis Pharmaceuticals, Inc. v. Meijer, Inc., Meijer Distribution, Inc., Rochester Drug Co-Operative, Inc., and Louisiana Wholesale Drug Co., Inc.*, No. 09-1175**

Questions Presented:

1. The Federal Circuit has "exclusive jurisdiction" over all appeals that are based "in whole or in part" on patent issues. 28 U.S.C. § 1295(a)(1). Accordingly, courts have consistently held that a *Walker Process* claim (i.e., an antitrust claim alleging enforcement of an invalid patent that was procured through fraud) lies within the *exclusive* jurisdiction of the Federal Circuit. In this case, however, the Second Circuit held that the Federal Circuit lacks jurisdiction over a *Walker Process* claim if plaintiffs include non-patent allegations in the same count. The court reached this conclusion even though it acknowledged that the patent fraud allegations are "the linchpin" of the case and even though the non-patent allegations would *not* provide plaintiffs a basis for obtaining all the relief they seek.

2. The question presented is whether the Second Circuit's new jurisdictional standard conflicts with this Court's decision in *Christianson v. Colt Indus. Operating Corp.*, 486 U.S. 800 (1988), and with decisions of the Federal Circuit and Seventh Circuit, holding that the Federal Circuit has exclusive jurisdiction in any patent-based case in which patent issues must be resolved in order for plaintiffs to achieve the overall success of their claim and obtain all the damages (or other relief) they seek.?

Cert. petition filed 3/26/10.

Conference 6/24/10. **Petition denied.**

Bayer Schering Pharma AG and Bayer HealthCare Pharmaceuticals Inc. v. Barr Laboratories, Inc.; No. 09-1022

Questions Presented:

1. Under [35 U.S.C. § 103\(a\)](#) and this Court's precedents, a claimed invention is not patentable if it would have been "obvious" at the time it was made to a person having ordinary skill in the art. This Court has used terms like "plainly foreshadowed," "plainly indicated," "immediately recognized," and "predictable" to describe the standard.
2. Whether the Federal Circuit has deviated from the statutory text and this Court's precedents by holding that an invention is "obvious" when there were a finite number of "viable" options that provided a so-called "reasonable expectation" of success, even though it remained necessary to conduct further experimentation, the results of which were unpredictable.?

Cert. petition filed 2/23/10.

Conference 4/30/10. **Petition denied.**

Microsoft Corporation v. Lucent Technologies, No. 09-1006

In this case, the Federal Circuit affirmed a verdict of patent infringement over a challenge to the sufficiency of the evidence. After reviewing the record, the Federal Circuit pointed only to expressly speculative expert testimony and lawyer characterization of the evidence (not the evidence itself) to support the verdict. In affirming the verdict, the Federal Circuit itself characterized this speculative and argumentative "evidence" as "less than the weight of the evidence," but "just more than a mere scintilla." The questions presented are:

1. Whether a jury verdict of patent infringement can stand when it is supported only by speculative "evidence" and lawyer argument, or whether the standards for entry of judgment as a matter of law that apply in all other federal cases should apply equally in patent cases?
2. Whether a new trial is required in a patent infringement case, as in all other cases, when the verdict is found to be contrary?

Cert. petition filed 2/19/10.

Conference 5/20/10. **Petition denied.**

Fresenius USA, INC. and Fresenius Medical Care Holdings, Inc., vs. Baxter International and Baxter Healthcare Corporation, No. 09-1096

Questions Presented:

1. Does the Federal Circuit's practice of evaluating jury verdicts in patent cases by requiring a prevailing party to point to substantial evidence plus a detailed explanation by an expert witness of that evidence (a "substantial evidence plus explication" requirement) comport with this Court's precedents and the Constitution?
2. If the answer to Question 1 is yes, then in what circumstances should a requirement for substantial evidence plus explication apply?

Cert. petition filed 2/16/10.

Conference 4/16/10. **Petition denied.**

Loren David v. Monsanto Company and Monsanto Technology LL, No. 09-829

Question Presented:

Is a federal statutory award of attorney fees, expert expenses and costs in a private law action (not a civil rights action involving important civil and constitutional rights providing a broader, uncompensated benefit to the public), in the amount of \$487,000 reasonable in relation to the results achieved, a compensatory damage award of \$87,000?

Cert. petition filed 1/12/10.

Conference of 2/26/10. **Petition denied.**

Saint-Gobain v. Gemtron, No. 09-778

Question Presented:

Did the Federal Circuit impermissibly apply United States patent law on an extraterritorial basis in upholding a finding of infringement of a product claim based on a temporary characteristic of the product during its manufacture in Mexico, even though the product found to infringe no longer has this characteristic when imported into the United States?

Cert. petition filed 12/31/09.

Conference 3/5/10. **Petition denied.**

SAP AG and SAP America, Inc.v. Sky Technologies LLC, No. 09-819

Question Presented:

The Patent Act identifies only three classes of patent owners with standing to sue for infringement: "patentee[s]," "heirs," and "assigns." This Court has repeatedly held that these three classes—

unchanged since 1870—comprise the exclusive set of patent owners and that the transfer of legal title in and to a patent requires an assignment in writing. Respondent is not the original patentee, is not an heir, and has no written assignment from the original patent owner. The United States Court of Appeals for the Federal Circuit nevertheless held that Respondent had standing to sue for infringement because a non-judicial state law foreclosure "transferred" legal title to the patents-in-suit by operation of law.

1. Did the Federal Circuit err when it held that the Patent Act allows the states to create additional, non-statutory classes of patent owners—including "transfer[ee]s" who may take title without any writing at all?

Cert. petition filed 12/24/09.

Conference 2/19/10. **Petition denied.**

Acushnet Company v. Callaway Golf Company, No. 09-702

Questions Presented:

1. Whether this Court should make clear that no single finding on any of its underlying Graham factors is dispositive of the ultimate legal conclusion on invalidity, such that a court reviewing a jury's § 103 verdicts must always independently render its own legal conclusion regardless of whether one or all of the jury's underlying findings are accepted as adequately supported by the evidence?
2. Whether this Court should instruct that a jury's § 103 verdict necessarily identifies the jury's implicit findings on the disputed underlying factual issues litigated at trial, but is entirely advisory as to the ultimate legal conclusion on invalidity?

Cert. petition filed 12/11/09.

Conference 2/19/10. **Petition denied.**

Cardiac Pacemaker, Inc., and Guidant Sales Corporation and Mirowski Family Ventures, LLC and Anna Mirowski, v. St. Jude Medical Inc., and Pacesetter, Inc., No. 09-596

Questions Presented:

Should a defendant be permitted to use "the accident of a remand" to raise previously available but not previously asserted defenses?

Patent protection is important for an economy heavily based upon technology. Although this Court recently held in one context that method and product inventions should be treated similarly (*Quanta Computer, Inc. v. LG Electronics, Inc.*, 128 S.Ct. 2109 (2008)), the Federal Circuit's en banc decision in another context does not provide such similar treatment and significantly restricts protection for method inventions. Two additional questions are:

1. Where the value of a method invention is its availability for use if needed, should damages for infringement be restricted to actual use?
2. Should the maker of a product capable of performing a patented method be liable for products made here but sold abroad, i.e., does 35 U.S.C. §271(f) exclude method claims?

Cert. petition filed 11/17/09.

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

Richard P. Mettke, v. David Kappos, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, No. 09-744

Questions Presented:

1. Whether the Court of Appeals for the Federal Circuit erred by holding the United States Patent and Trademark Office's conclusion of obviousness based on the combination of Exhibit E, Exhibit F, and Shah was correct and that it was based on findings supported by substantial evidence and not rebutted by objective evidence?
2. Whether the Court of Appeals for the Federal Circuit erred in denying the appellant the right to present oral arguments in support of his appeal in contradiction to the Constitution of the United States, Fifth Amendment right to due process?

Cert. petition filed 11/16/09.

Conference 1/22/10. **Petition denied.**

Patent Enforcement Team, LLC, v. Dickson Industries, Inc., No. 09-476

Questions Presented:

1. Can a patentee be held liable for tortious interference without an appropriate finding that the patentee's pre-suit actions were objectively baseless?
2. What constitutes substantial evidence sufficient to invalidate a claim based on anticipation?

Cert. petition filed 10/20/09.

Conference 1/22/10. **Petition denied.**

SMC Corporation and SMC Corporation of America, v. Norgren, Inc, and U.S. International Trade Commission, No. 09-412

Questions Presented:

1. The claims in a patent are critical since they define the scope of the exclusionary right. Prior to *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (en banc), aff'd, 517 U.S. 370 (1996), the jury construed the claims. Although this Court in its *Markman*

decision *supra* held as a matter of policy that the claims should be construed by the district court, this Court did not hold that this construction was entitled to no deference upon appeal.

2. In *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448 (Fed. Cir. 1998) (en banc), the Federal Circuit held that a district court's claim construction was entitled to no deference upon appeal. This ruling has resulted in a highly unsatisfactory situation during the last eleven years, i.e., a claim construction reversal rate of roughly 40%, a need for many patent cases to be tried more than once, and increasing dissatisfaction by the district courts whose claim constructions are afforded no deference and are reversed almost half the time. Although some Federal Circuit judges have long recognized this problem, it appears that its correction can only come from this Court. Thus, the question presented for review is—Should the Federal Circuit accord deference to a district court's claim construction?

Cert. petition filed 10/6/09.

Conference 1/15/10. **Petition denied.**

Patent certiorari petitions denied this year

Patent certiorari petitions denied in: 2015, 2014, 2013, 2012, 2011, 2010, 2009

For more information on this or other patent appeal matters, contact:

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