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## Federal Circuit Patent Updates - April 2009

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***Every Penny Counts, Inc. v. American Express, Co.* (No. 2008-1434) (Michel, Bryson, Cudahy)**

April 30, 2009 9:42 AM

(Cudahy) Affirming judgment of non-infringement based on claim construction of patent directed to solving the problem of "loose change."

A full version of the judgment is available [here](#).

***Amgen, Inc. v. International Trade Commission*[reissued] (No. 2007-1014) (Newman, Lourie, Linn)**

April 30, 2009 9:38 AM

(Per Curiam) Following a request for en banc review, the Court reissued its 2008 opinion reaffirming that the safe harbor of 271(e)(1) is available in ITC cases. The Court retracted its prior opinion's discussion of whether the Commission had jurisdiction over "imminent importation" not in connection with a contract for sale, stating that it was not necessary to decide the issue in light of the allegations in the complaint.

A full version of the opinion is available [here](#).

***Revolution Eyewear, Inc. v. Aspex Eyewear, Inc.*(No. 2008-1267) (Michel, Bryson, Posner)**

April 29, 2009 9:33 AM

(Michel) Affirming judgment that eyeglass frame reissue patent was valid and infringed. The patent satisfied the written description requirement and did not violate the requirement that reissue patents claim "the same invention" as the original patent. "[W]hen the specification sets out two different problems present in the prior art, it is unnecessary for each and every claim in the patent to address both problems." The Court also rejected an invalidity attack based on the recapture rule. Summary judgment of infringement was affirmed where the accused device satisfied claim language requiring it to be "capable of" the claimed function. Also affirming the denial of a request for remittitur and a refusal to find the case exceptional.

A full version of the summary judgment is available [here](#).

***Ritchie v. Vast Resources, Inc.* (No. 2008-1528)(Michel, Bryson, Posner)**

April 24, 2009 9:29 AM

(Posner) Affirming judgment that claimed sex aids were obvious.

A full version of the judgment is available [here](#).

***Princo Corp. v. International Trade Commission*(No. 2007-1386)(Bryson, Gajarsa, Dyk)**

April 20, 2009 3:24 PM

(Dyk) Affirming in part and vacating and remanding in part Commission rejection of patent misuse arguments. Mandatory package licensing did not improperly tie the essential patents to practice a standard to an allegedly non-essential patent that "could be viewed as reasonably necessary to practice" the standard. "[P]erfect certainty is not required to avoid a charge of misuse through unlawful tying. Rather, in this context a blocking patent is one that at the time of the license an objective manufacturer would reasonably believe might be necessary to practice the technology at issue." However, an alternative patent misuse argument, that there was an alleged agreement between the licensor and a competitor to license a patent to prevent it from being a commercially viable alternative technology competitive with the standard, required further Commission proceedings. Bryson concurred in part and dissented in part. WilmerHale represented the intervenor, U.S. Philips Corp.

A full version of the argument is available [here](#).

***Synthes v. GMReis* (No. 2008-1279) (Schall, Friedman, Bryson)**

April 17, 2009 3:17 PM

Reversing dismissal for lack of personal jurisdiction. A Brazilian company was subject to specific jurisdiction under Fed. R. Civ. P. 4(k)(2), where it brought and displayed accused products at a U.S. trade show, even if doing so was not itself an act of infringement.

A full version of the dismissal is available [here](#).

***Takeda Pharmaceutical v. Doll* (No. 2008-1311) (Rader, Schall, Moore)**

April 10, 2009 3:05 PM

(Rader) Vacating summary judgment of entitlement to a reexamination certificate. Later developments in the art may inform the "patentably distinct" determination for double patenting, but only to the extent that the later developments predate the secondary application that triggers a double patenting rejection. Schall concurs in part and dissents in part.

A full version of the summary judgment is available [here](#).

***Felix v. American Honda Motor Co.* (No. 2008-1367)(Rader, Friedman, Linn)**

April 10, 2009 3:01 PM

(Linn) Affirming summary judgment of noninfringement. "It is the patentee's response to a rejection--not the examiner's ultimate allowance of a claim--that gives rise to prosecution history estoppel."

A full version of the summary judgment is available [here](#).

***TransCore, Lp. v. Electronic Transaction Consultants, Corp.* (No. 2008-1430) (Gajarsa, Dyk, Moore)**

April 8, 2009 2:58 PM

(Gajarsa) Affirming summary judgment that patent claims against a customer were barred by patent exhaustion by virtue of a covenant not to sue granted by the patentee to the seller. Evidence that the parties intended the covenant not to extend to customers was irrelevant where the covenant authorized the sales by the seller, which exhausted the patentee's rights.

A full version of the summary judgment is available [here](#).

***In Re Kubin (2008-1184) (Rader, Friedman, Linn)***

April 3, 2009 8:58 AM

(Rader) Affirming Board decision that genus claims relating to DNA sequences that encode a polypeptide with at least 80% identity to an amino acid sequence are obvious. “Insofar as Deuel implies the obviousness inquiry cannot consider that the combination of the claim’s constituent elements was ‘obvious to try,’ the Supreme Court in KSR unambiguously discredited that holding.” Discussion of *In re O’Farrel* and differences between proper and improper applications of “obvious to try.” When the prior art does not indicate which parameters are critical or which direction is likely to be successful “courts should not succumb to hindsight claims of obviousness.” But, “where a skilled artisan merely pursues ‘known options’ from a ‘finite number of identified, predictable solutions,’ obviousness under §103 arises.”

A full version of the decision is available [here](#).

***Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co. (2008-1248) (Linn, Prost, Moore)***

April 3, 2009 8:55 AM

(Moore) Reversing denial of JMOL and finding claims related to method for gene regulation invalid due to lack of written description. Also affirming ruling of no inequitable conduct. The Court rejected an argument that “because there is no term in the asserted claims that corresponds to the molecules, [the patentee] is entitled to claim the methods without describing the molecules.” To satisfy the written description requirement “the specification must demonstrate that [the patentee] possessed the claimed methods by sufficiently disclosing molecules capable of reducing NF-κB activity so as to ‘satisfy the inventor’s obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed.’” Linn concurred.

A full version of the finding is available [here](#).

***Euclid Chemical v. Vector Corrosion Technologies(2008-1170) (Newman, Lourie, Linn)***

April 1, 2009 8:46 AM

(Linn) Reversing summary judgment regarding ownership of one of the patents-in-suit, vacating and remanding. The relevant patent-in-suit was a continuation-in-part (CIP). An assignment transferring the parent patent and “any and all . . . continuations in part” was executed after grant of the CIP and the assignment did not specifically identify the CIP. “Had the assignee intended, through the assignment of ‘continuations in part’ to assign other issued U.S. patents, it would be expected that the Assignment would have said that the inventor was assigning his ‘issued US patents’ - plural - and even recited the patent number of the issued [patent-in-suit].” Also, “the district court abused its discretion by dismissing [plaintiff’s] bona fide purchaser claim on the ground that [plaintiff] had abandoned it.” Newman concurred in part and dissented in part.

A full version of the summary judgment is available [here](#).