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## Federal Circuit Patent Updates - April 2010

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***Verizon Services Corp. v. Cox Fibernet Virginia, Inc.* (Mayer, Linn, Prost)**

April 20, 2010 1:54 PM

(Linn, J.) Affirming JMOL and new trial decisions of district court in case involving six patents to packet-switched telephony. The district court did not err under O2 Micro in failing to interpret the claims. There was substantial evidence that a prior art reference was enabling. Given evidence before the jury, argument that the accused device was the same as the prior art was not an improper "practicing the prior art" defense.

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

***In Re Suitco Surface, Inc.* (Rader, Prost, Moore)**

April 20, 2010 1:49 PM

(Rader, J.) Reversing Board's finding of anticipation where it was based on an unreasonable construction of the claim.

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

***Novo Nordisk A/S v. Caraco Pharmaceutical Laboratories, Ltd.* (Rader, Clevenger, Dyk)**

April 20, 2010 1:48 PM

(Rader, J.) Dissolving for lack of standing injunction directing Novo to change the Orange Book patent use code for listed patent, and thereby "correct the patent information" for the '358 patent. Clevenger, J. concurred. Dyk, J. dissented.

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

***Anascape v. Nintendo* (Newman, Gajarsa, Dyk)**

April 20, 2010 1:46 PM

(Newman, J.) Reversing judgment and finding claims invalid for failure of priority application to comply with the written description requirement. Gajarsa, J. concurred in the judgment.

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

***SiRF Technology v. ITC* (Michel, Clevenger, Dyk)**

April 20, 2010 1:19 PM

(Dyk, J.) Affirming ITC finding of violation of Section 337 with respect to patents relating to GPS technology. There was not a failure to join an alleged co-owner of the patent because of an automatic assignment of the inventor's interest in the patent. The claims covered patentable subject matter because they recited a GPS receiver as an integral part of the claims.

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

***MBO Laboratories v. Becton, Dickinson & Co.* (Gajarsa, Clevenger, Dyk)**

April 20, 2010 11:12 AM

(Gajarsa, J.) Affirming summary judgment that reissue claims to retracting syringe were invalid under the recapture rule.

WilmerHale represented the defendant Becton Dickinson.

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

***Bid for Position, LLC v. AOL* (Newman, Bryson, Moore)**

April 20, 2010 11:05 AM

(Bryson, J.) Affirming summary judgment of non-infringement of methods of conducting an online auction including judgment of no infringement under the doctrine of equivalents where a reasonable juror could not conclude that differences were insubstantial.

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

***Yorkey v. Diab* (Michel, Gajarsa, Kendall)**

April 20, 2010 11:02 AM

(Michel, J.) In interference, affirming Board's denial of motion that application did not comply with written description requirement and denial of motion that there was no interference-in-fact.

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

***Yorkey v. Diab* (Michel, Gajarsa, Kendall)**

April 20, 2010 10:06 AM

(Michel, J.) In interference, affirming finding of compliance with written description requirement, but reversing finding that there was no actual reduction to practice. Reduction to practice of a claim directed to measuring the concentration of blood in oxygen was met by two computer programs.

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

***Vanderbilt Univ. v. Icos Corp.* (Michel, Clevenger, Dyk)**

April 20, 2010 10:03 AM

(Clevenger, J.) Affirming district court's judgment that scientists were not joint inventors of compounds and methods to treat erectile dysfunction. Dyk, J. dissented.

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

***Hearing Components, Inc. v. Shure, Inc.* (Lourie, Rader, Schall)**

April 6, 2010 8:17 AM

(Lourie, J.) reversing findings of indefiniteness and noninfringement by some devices but affirming findings of infringement by other devices, nonobviousness, and no laches.

The claim term "readily installed" in a preamble was a limitation and not indefinite.

With respect to means-plus-function equivalence, "[defendant] attempts to convert known interchangeability into a factor weighing against equivalence by stating that the inventors were aware of alternatives to the disclosed structures but chose not to disclose them. However, that is necessarily the case with known interchangeability, which nevertheless can support a finding of equivalence."

Regarding laches:

--Where the defendant "had relied on noninfringement opinions of counsel, such that it would not have acted differently if it had been sued earlier", it did not prove prejudice from delay in suit;

--"[C]apital investment is not required to show economic prejudice," but "our cases have required at least increased expenditure by the defendant in reliance on the delay.";

--"It is not economic prejudice to pay damages from infringing sales of products generating a profit over a longer period of time resulting from delay."

--"[E]videntiary prejudice must consist of some separate disadvantage from the delay, such as loss of records, unavailability of evidence, etc., that prevents a party from proving a separate claim or defense."

***Innovative Therapies, Inc. v. Kinetic Concepts, Ltd.* (Michel, Newman, Prost)**

April 6, 2010 8:16 AM

(Newman, J.) Affirming dismissal of declaratory judgment action for lack of an actual controversy.

The patentee's knowledge of the device at issue, "impromptu responses" by employees of the

patentee in telephone calls that were "not an assertion of patent rights" (but rather were elicited by "a ploy to attempt to generate jurisdiction through informal phone calls to past colleagues"), and the patentee's "history of litigation to enforce its patents" were not sufficient to create declaratory judgment jurisdiction. This was true even though the patentee later sued the declaratory judgment plaintiff for infringement, because "these acts after the filing of [the] original complaint did not establish that an actual controversy existed at that earlier time." "[U]nless there was jurisdiction at the filing of the original complaint, jurisdiction could not be carried back to the date of the original pleading."

***HIF Bio, Inc. v. Yung Shin Pharmaceuticals Industrial Co., Ltd.* (Michel, Gajarsa, Holderman [of the N.D. Ill., sitting by designation])**

April 6, 2010 8:14 AM

(Gajarsa, J.) Upon remand from the Supreme Court, reversing the district court's remand of a complaint to state court because two of the remanded causes of action "arise under" 28 U.S.C. § 1338(a), "but the district court should have dismissed these purported causes of action for failure to state a claim for which relief can be granted." "[W]e expressly hold that [35 U.S.C.] § 116 does not provide a private right of action to challenge inventorship of a pending patent application. Once a patent issues, however, 35 U.S.C. § 256 provides a private right of action to challenge inventorship ...." Section "116 precludes the district court from determining the true inventor of an invention disclosed in a pending patent application."

***Power-One, Inc. v. Artesyn Technologies, Inc.* (Michel, Gajarsa, Kendall [of the N.D. Ill., sitting by designation])**

April 6, 2010 8:12 AM

(Kendall, J.) Affirming jury verdict of infringement and validity. Affirming district court's construction of claim term as adequately precise and not indefinite. Affirming jury verdict of nonobviousness. "The jury heard conflicting testimony of whether the ... patent was obvious in light of the prior art. In evaluating the evidence, the jury was free to disbelieve [defendant's] expert ...and credit [plaintiff's] expert ...." "[Defendant's] position that [plaintiff's] invention was obvious is inconsistent with its position that its own infringing product was an advancement in the industry."

***Enzo Biochem, Inc. v. Applera Corp.* (Michel, Plager, Linn)**

April 6, 2010 8:10 AM

(Linn, J.) Reversing summary judgment of indefiniteness of three patents but affirming judgments of anticipation of one of those patents and noninfringement of a fourth patent, relating to labeling and detecting nucleic acids. "[A] claim cannot be both indefinite and anticipated. ...If a claim is indefinite, the claim, by definition, cannot be construed."

***Pressure Products Medical Supplies, Inc. v. Greatbatch Ltd.* (Newman, Lourie, Rader, Gajarsa, Moore)**

April 6, 2010 8:07 AM

(Rader, J.) Vacating finding of infringement because of improper claim construction and affirming denial of motion to leave amend answer to assert inequitable conduct. The district court did not err in adjusting or supplementing its construction of a claim term during a jury trial. "As this court has recognized, 'district courts may engage in a a rolling claim construction ....'" But the district court did err in expanding the definition of a means-plus-function limitation to include structures not disclosed in the specification. "Trial courts cannot look to the prior art, identified by nothing more than its title and citation in a patent, to provide corresponding structure for a means-plus-function limitation. ...Simply mentioning prior art references in a patent does not suffice as a specification description to give the patentee outright claim to all of the structures disclosed in those references." Regarding inequitable conduct, "this court has issued significant opinions requiring specific and demanding showings of evidence before a party may assert the defense of inequitable conduct." Newman, J., concurs in part and dissents in part.