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Federal Circuit Patent Updates - April 2011

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Billups-Rothenberg, Inc. V. Associated Regional And University Pathologists, Inc. **(2010 1401) (Gajarsa, Linn, Moore)**

April 29, 2011 9:54 AM

(Gajarsa) Affirming summary judgment of invalidity of patents related to genetic test for hereditary hemochromatosis. One patent was invalid for lack of written description. Regarding that patent, the Court explained that the patent "claims a test for mutations, yet it is undisputed that the specification and originally filed claims of the [patent] disclose neither the hemochromatosis gene sequence nor any specific mutations within that gene… The [patent] merely represents [patentee's] research plan." A later filed patent was anticipated.

A full version of the text is available here.

Wellman, Inc. V. Eastman Chemical Co. **(2010 1249) (Rader, Lourie, Whyte [of the Northern District of California, sitting by designation])**

April 29, 2011 9:51 AM

(Rader) Affirming summary judgment of invalidity for failure to disclose the best mode and reversing summary judgment of indefiniteness for patents relating to polyethylene terephthalate ("PET") resins for use in plastic beverage containers. "[A]n evolving recipe potentially means that the inventors had no best mode of practicing the invention… However, even when viewed in the light most favorable to [patentee], this evidence cannot overcome the testimony of the [inventors]... Put simply, at the time of filing, an inventor believed that the 2003 recipe … was the best mode. Subtle changes in the recipe in 2004 to accommodate specific customer demands does not excuse the applicant's obligation to disclose what [the inventors] contemplated was the best mode of practicing the invention at the time of filing."

A full version of the text is available here.

Juniper Networks, Inc. V. Shipley **(2010 1327) (Rader, Newman, Linn)**

April 29, 2011 9:45 AM

(Rader) Affirming dismissal of false marking qui tam action. “[T]his court holds that websites can qualify as unpatented articles within the scope of § 292.”

A full version of the text is available here.

Radio Systems Corp. V. Accession, Inc. **(2010 1390) (Bryson, Linn, Dyk)**

April 25, 2011 9:43 AM

(Bryson) Affirming dismissal due to lack of personal jurisdiction. Defendant’s attorney contacted the patent examiner for plaintiff’s patent application, informing the examiner that defendant’s issued patent was prior art to plaintiff’s application. As a result, the patent examiner withdrew a previously issued notice of allowance for plaintiff’s application. Neither defendant’s contact with the patent examiner nor defendant’s attempt to establish a business relationship with plaintiff were sufficient to give the district court personal jurisdiction over defendant.

A full version of the text is available here.

Lexion Medical, LLC. V. Northgate Technologies, Inc. **(2009 1494) (Rader, Dyk, Prost)**

April 22, 2011 9:31 AM

(Rader) Affirming summary judgment of infringement of patent related to heating gas for laparoscopic surgical procedures. “The district court correctly interpreted ‘having a temperature within 2°C of the predetermined temperature’ not to require the claimed device to always be with 2°C of the predetermined temperature… Because the predetermined temperature is a single temperature point (even if selected from a range of possibilities), the term ‘within 2°C of the predetermined temperature’ means just that, within 2°C of the predetermined temperature, subject to minor fluctuations.”

A full version of the text is available here.

Akamai Technologies, Inc. V. Limelight Networks, Inc. **[ORDER] (2009 1372, 1380, 1416, 1417) (Rader, Newman, Lourie, Bryson, Gajarsa, Linn, Dyk, Prost, Moore, O’Malley, Reyna)**

April 21, 2011 9:58 AM

Per Curiam. Granting petition for rehearing en banc and requesting briefing on the following issue: “If separate entities each perform separate steps of a method claim, under what circumstances would that claim be directly infringed and to what extent would each of the parties be liable?”

A full version of the text is available here.

Tive Inc. V. Echostar Corp. **(2009 1374) (Rader, Newman, Mayer, Lourie, Bryson, Gajarsa, Linn, Dyk, Prost, Moore, O'Malley, Reyna)**

April 20, 2011 9:20 AM

(Lourie) Affirming district court's finding of contempt based on violation of one provision of permanent injunction and affirming related sanctions award. Also vacating district court's finding of contempt based on violation of another provision of permanent injunction and remanding. The Court set forth new standards for when contempt proceedings are appropriate for evaluating redesigned products. "We conclude that KSM's two-step inquiry has been unworkable and now overrule that holding of KSM. KSM crafted a special rule for patent infringement cases, in that it required a threshold inquiry on the propriety of initiating a contempt proceeding. We recognize now that that inquiry confuses the merits of the contempt with the propriety of initiating contempt proceedings… As a result, we will telescope the current two-fold KSM inquiry into one, eliminating the separate determination whether contempt proceedings were properly initiated. That question, we hold, is left to the broad discretion of the trial court to be answered based on the facts presented… As with appeals from findings of civil contempt in other areas of law, we will only review whether the injunction at issue is both enforceable and violated, and whether the sanctions imposed were proper. Allegations that contempt proceedings were improper in the first instance do not state a defense to contempt." Regarding the "colorably different" test, the Court stated, "Today, we reject that infringement-based understanding of the colorably different test. Instead of focusing solely on infringement, the contempt analysis must focus initially on the differences between the features relied upon to establish infringement and the modified features of the newly accused products… Where one or more of those elements previously found to infringe has been modified, or removed, the court must make an inquiry into whether that modification is significant."

Dyk, Rader, Gajarsa, Linn and Prost dissented-in-part.

WilmerHale represents the plaintiff-appellee, Tivo Inc.

A full version of the text is available here.

Rembrandt Data Technologies, LP. V. AOL, LLC **(2010 1002) (Gajarsa, Linn, Dyk)**

April 18, 2011 10:25 AM

(Gajarsa) Affirming decision that a company was licensed and the patentee could not therefore recover from the company's customers because of patent exhaustion. Also affirming summary judgment that certain claims were invalid as indefinite (because they recited both apparatus and method elements) but reversing summary judgment that other claims were indefinite because of a dispute of fact as to whether the specification disclosed algorithms for means-plus-function limitations. Certain claim limitations that contained the term "means" were not means-plus-function limitations because the limitations themselves recited adequate structure to perform the claimed functions.

A full version of the text is available here.

In Re Tanaka **(2010 1262) (Bryson, Linn, Dyk)**

April 15, 2011 10:22 AM

(Linn) Reversing Board of Patent Appeals and Interferences holding that a reissue application that retains all of the original claims and adds only narrower claims does not present the type of error correctable by reissue under 35 U.S.C. § 251. "[T]he omission of a narrower claim from a patent can render a patent partly inoperative by failing to protect the disclosed invention to the full extent allowed by law." Dyk dissents.

A full version of the text is available here.

McKesson Technologies Inc. V. Epic Systems Corp. **(2010 1292) (Newman, Bryson, Linn)**

April 12, 2011 10:17 AM

(Linn) Affirming summary judgment of noninfringement where all steps of the method claims were not performed by a single party, and the users of the defendant's products were not agents of the defendant or its customers. Bryson concurs but suggests en banc review of precedent on this issue may be warranted in an appropriate case. Newman dissents.

A full version of the text is available here.

Innovention Toys V. MGA Entertainment **(2010 1290) (Rader, Lourie, Whyte)**

April 8, 2011 9:35 AM

(Lourie) Affirming summary judgment of literal infringement, but reversing summary judgment of non-obviousness. The district court erred in viewing electronic games as non-analogous art to claims directed to a board game and erred in defining the level of skill in the art as that of a layperson.

A full version of the text is available here.

In Re Verizon Business **(Miscellaneous Docket No. 956) (Lorie, Gajarsa, Linn)**

April 8, 2011 9:14 AM

(Linn) Granting petition for mandamus and transferring patent case where the sole basis of maintaining jurisdiction was that the district court had handled an earlier lawsuit involving the same patent five years earlier.

A full version of the text is available here.

Aventis Pharma S.A. V. Hospira, Inc. **[ORDER] (2011 1018, 1047) (Prost, Mayer, Moore)**

April 8, 2011 8:43 AM

(Moore) Dismissing “protective” cross-appeal on issue of double-patenting and threatening sanctions where claims had been invalidated for other reasons.

A full version of the text is available here.

***Crown Packaging Technology, Inc. V. Ball Metal Beverage Container Corp.* (2010 1020)**
(Newman, Dyk, Whyte)

April 1, 2011 8:29 AM

(Whyte) Reversing summary judgment that claims directed to manufacture of cans were invalid under the written description requirement. Where the patent taught two independent, although related, methods of saving metal in manufacturing cans, the claims were not overly broad in not being limited to only one of those methods. Also reversing summary judgment that claims were anticipated because a disputed issue of fact existed over whether prior art reference inherently disclosed all limitations. Dyk concurred in part and dissented in part on the issue of written description with respect to the method claims.

A full version of the text is available here.