
Federal Circuit Patent Updates - August 2005

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MEMC Electronic Materials v. Mitsubishi Materials Silicon Corp., et al. (04-1396) (Newman, Schall, Dyk)

August 22, 2005 11:13 AM

(Schall) Affirming summary judgment of no direct infringement where there was no offer to sell silicon wafers but merely the transmission of test data to a potential customer. Any actual sale occurred between defendant and third party in Japan. However, disputed issue of fact existed concerning whether there was inducement of infringement of U.S. customer. Also affirming denial of motion for attorneys fees.

AquaTex Industries, Inc. v. Techniche Solutions (05-1088) (Mayer, Gajarsa, Dyk)

August 19, 2005 11:10 AM

(Mayer) Affirming summary judgment of no-literal infringement but reversing summary judgment of no infringement under the doctrine of equivalents of patent related to materials for evaporative cooling garments. The claim was interpreted narrowly in light of the specification; however, the record did not support a finding of an argument-based estoppel.

Broadcast Innovation, L.L.C., et al. v. Charter Communications, et al. (05-1008) (Mayer, Rader, Dyk)

August 19, 2005 11:09 AM

(Rader) Reversing summary judgment of invalidity under 102(b) because of improper determination of priority date to which the patent in suit was entitled. Patent was entitled to date of filing of PCT application from which grandparent application was filed as the national stage application.

Tap Pharmaceutical Products (formerly known as Tap Holdings, Inc.) v. Owl Pharmaceuticals, L.L.C., et al. (03-1634) (Newman, Bryson, Gajarsa)

August 18, 2005 11:06 AM

(Bryson) Affirming summary judgment of non-infringement of three patents, summary judgment of infringement of two patents and summary judgment that two patents were not unenforceable. The patents were generally directed to materials used in pharmaceutical preparations. Infringement rulings were all based on claim construction. Inequitable conduct ruling was based on a finding of no materiality or intent.

Research Plastics, Inc. v. Federal Packaging Corp. (04-1605) (Newman, Bryson, Gajarsa)

August 18, 2005 11:04 AM

(Gajarsa) Reversing claim construction and summary judgment of non-infringement of patent related to caulking tubes. Remanding for determination of literal infringement, but also precluding finding of infringement under the doctrine of equivalents based on prosecution history estoppel.

Terlep v. The Brinkmann Corp., et al. (04-1337) (Bryson, Gajarsa, Linn)

August 16, 2005 11:02 AM

(Linn) Affirming claim interpretation and summary judgment of non-infringement of patent directed to omni-directional light emitting diode. The court rejected a broad definition of "clear" as synonymous with translucent in light of the written description. Prosecution history estoppel arose because the claim term was added by amendment and the reason for the amendment was not peripheral to the alleged equivalent.

Pause Technology, LLC v. Tivo, Inc. (No. 04-1263) (Newman, Lourie, Linn)

August 16, 2005 11:00 AM

(Linn) Affirming claim interpretation and summary judgment of non-infringement of patent directed to digital video recorders.

In Re Sujeet Kumar, et al. (04-1074) (Newman, Dyk, Archer)

August 15, 2005 10:57 AM

(Newman) Reversing Board's obviousness determination of patent directed to aluminum oxide particles. Although prima facie case of obviousness can be made where only distinction from prior art is in a difference in the range or value of a particular variable, Board introduced certain calculations for the first time in its decision. This constituted a new grounds of rejection. Further, there was issue as to whether prior art reference was enabling.

Capon, et al. v. Eshhar, et al. v. Dudas (03-1480) (Newman, Mayer, Gajarsa)

August 12, 2005 10:53 AM

(Newman) Reversing Board decision in interference finding that neither party's specification satisfied the written description requirement. Chimeric gene patents did not require disclosure of

complete nucleotide sequence.

Warner-Lambert Company v. Teva Pharmaceuticals USA (04-1506) (Schall, Linn, Prost)

August 11, 2005 10:52 AM

(Prost) Reversing summary judgment of infringement and validity in ANDA case, affirming judgment of no inequitable conduct based on lack of intent. Disputed issues of fact existed concerning infringement and whether the claims were enabled to their full breadth.

Freedman Seating Co. v. American Seating Co. (04-1216) (Mayer, Plager, Schall)

August 11, 2005 10:47 AM

(Schall) Reversing summary judgment of infringement under the doctrine of equivalents based on all elements rule and reversing summary judgment of non-obviousness because of disputed issue of fact over motivation to combine. The opinion includes an unusually lengthy discussion of the case law directed to when a claim limitation is sufficiently "vitiating" to bar the doctrine of equivalents.

Pharmacia Corp., et al. v. Par Pharmaceutical, Inc. (No. 04-1478) (Rader, Schall, Linn)

August 10, 2005 10:45 AM

(Linn) Affirming judgment of inequitable conduct in ANDA case directed to a first patent on a glaucoma medication but refusing to declare second patent unenforceable simply because a terminal disclaimer was filed to make the first patent expire with the second. The inequitable conduct judgment was based on a declaration that was inconsistent with an earlier publication of the declarant that was not submitted to the PTO.

Marley Mouldings, Ltd. v. Mikron Industries, Inc. (No. 04-1441) (Newman, Schall, Dyk)

August 8, 2005 10:43 AM

(Newman) Reversing summary judgment that claims directed to method of forming composite plastic products were indefinite. Although practice in polymer processing was to measure components by weight, claim was not indefinite for measuring components by volume.

Ericsson, Inc., et al. v. Harris Corp., et al. (No. 03-1625)(Clevenger, Gajarsa, Prost)

August 6, 2005 10:38 AM

(Prost) Vacating or reversing judgments of infringement because of erroneous claim constructions or lack of evidence. "[T]he corresponding structure for a section 1112, paragraph 6 claim for a computer-implemented function is the algorithm disclosed in the specification," not merely a "microprocessor." In the context of waiver of claim construction arguments on appeal, Federal Circuit law applies. There was no waiver of a claim construction argument on appeal where the appellant argued "the same concept" to the district court. The reasonable royalty damages rate that should apply is that which would have been in effect during the period for which damages are

available, even if infringement and the hypothetical negotiation would have occurred earlier (and before notice of the patent that would start the damages period running). Gajarsa dissents.

***Datamize, L.L.C. v. Plumtree Software, Inc.* (No. 04-1564)(Clevenger, Bryson, Prost)**

August 5, 2005 10:36 AM

(Prost) Affirming summary judgment of invalidity for indefiniteness. A limitation in a patent claim of "aesthetically pleasing" rendered the claim indefinite.

***Ericsson, Inc. v. Interdigital Communications Corporation, et al. v. Nokia Corporation* (No. 04-1484) (Rader, Schall, Bryson)**

August 4, 2005 10:33 AM

(Schall) Reversing orders allowing a non-party to intervene in a case after it had been settled and dismissed and to reinstate orders in that case that had been vacated.

***NTP, Inc. v. Research in Motion, LTD.* (No. 03-1615)(Michel, Schall, Linn)**

August 2, 2005 10:30 AM

(Linn) On rehearing pursuant to order (NTP, Inc. v. Research), withdrawing the original opinion at 392 F.3d 1336 and issuing a new opinion with revised portions concerning 35 USC 271. Domestic communications of Blackberry devices occur "within the United States" regardless of whether the communications may be transmitted outside the U.S. at some point along their wireless journey, where all but one of the components of the accused system were located within the U.S. and the control and beneficial use of the system occur within the U.S.

***James A. Frazier and Mantis Wildlife Films, PTY, Limited, et al. v. Roessel Cine Photo Tech, Inc., et al.* (NO. 04-1060)(Bryson, Linn, Dyk)**

August 2, 2005 10:26 AM

(Linn) Affirming-in-part and reversing-in-part holding of inequitable conduct. A prior art advertisement withheld during prosecution did not disclose enough to put one of ordinary skill in the art on notice of its materiality, but a video by the inventor submitted during prosecution made with something other than the claimed invention was materially misleading, even if the video could also have been made with the claimed invention. However, "[w]e do not hold that every time erroneous information is submitted to the PTO with knowledge of the error that the intent prong of the inequitable conduct inquiry is satisfied." Bryson concurs in part and dissents in part, saying the inequitable conduct holding should have been affirmed in its entirety.

***Collegenet, Inc. v. Applyyourself, Inc.* (No. 04-1202)(Lourie, Rader, Schall)**

August 2, 2005 10:24 AM

(Rader) Reversing JMOL and award of new trial and reinstating jury verdict of infringement of one patent because of an erroneous claim construction; affirming jury verdict of infringement of another

patent; and affirming the dismissal without (as opposed to with) prejudice of invalidity counterclaims that were abandoned during trial. The claim term "automatically" did not preclude human intervention to institute or interrupt the process.