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Federal Circuit Patent Updates - August 2006

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Ormco Corporation, et al. v. Align Technology, Inc. **(No. 05-1426) (Schall, Gajarsa, Dyk)**

August 30, 2006 3:17 PM

(Dyk) Reversing summary judgment that patents directed to orthodontic devices were not invalid and finding them obvious as a matter of law. There was no nexus between the alleged secondary considerations of non-obviousness and the claimed invention.

Fuji Photo Film Co., LTD. v. Benun, et al. **(No. 05-1445) (Rader, Clevenger, Dyk)**

August 23, 2006 3:13 PM

(Rader) The district court had jurisdiction to enjoin importation of products subject to an ITC exclusion order previously issued by the ITC.

Cook Biotech Inc., et al. v. ACell, Inc., et al. **(No. 05-1458) (Newman, Lourie, Prost)**

August 18, 2006 3:11 PM

(Prost) Reversing infringement verdict based on faulty claim construction and affirming summary judgment that inventorship was correct and that state law claim of unjust enrichment should be dismissed.

Conoco v. Energy & Environmental International**(No. 05-1363) (Bryson, Archer, Gajarsa)**

August 17, 2006 3:09 PM

(Gajarsa) Affirming district court verdict finding infringement of patents directed to “drag reducing agents” used in pipelines. The transitional phrase “consisting of” did not exclude components unrelated to the invention, such as impurities. The addition by an Examiner’s amendment of a claim limitation to a particular claim that was a correction of an inadvertent omission did not create a prosecution history estoppel.

Monsanto Company v. Scruggs, et al. **(No. 04-1532) (Mayer, Bryson, Dyk)**

August 16, 2006 3:06 PM

(Mayer) Affirming summary judgment that patent directed to chimeric gene was valid and infringed and that there was no liability for antitrust violations or patent misuse. The first sale doctrine did not give farmer right to plant saved seeds in light of express restrictions on sale. The claims were not invalid under the written description and enablement requirements. No patent misuse occurred because all of the alleged wrongful acts were within the scope of the patent grant. Dyk dissented on the issue of patent misuse. WilmerHale represented the appellee Monsanto.

Tegic Communications Corp. v. Board of Regents of the University of Texas System **(No. 05-1553) (Newman, Archer, Gajarsa)**

August 10, 2006 3:05 PM

(Newman) Affirming dismissal of declaratory judgment complaint against state university on Eleventh Amendment grounds. the university's infringement suit against certain users of a device in one court did not abrogate the university's immunity from a declaratory judgment suit by the manufacturer in another court.

Serio-US Industries, Inc. v. Plastic Recovery Technologies, Corp. **(No. 05-1106) (Lourie, Rader, Linn)**

August 10, 2006 3:03 PM

(Rader) Affirming judgment of noninfringement, dismissal of Lanham Act and state law counterclaims, and denial of award of attorney fees.

Pennington Seed, Inc., et al. v. Produce Exchange No. 299, et al. **(No. 05-1440) (Rader, Schall, Gajarsa)**

August 9, 2006 3:01 PM

(Gajarsa) Affirming dismissal of complaints against university and its officials because of Eleventh Amendment immunity and lack of personal jurisdiction.

Venture Industries Corp., et al. v. Autoliv ASP, Inc. (successor to Morton International, Inc.), et al. **(No. 05-1537) (Linn, Dyk, Prost)**

August 7, 2006 2:59 PM

(Dyk) Vacating denial of relief from judgment under Fed.R.Civ.P. 60(b)(3)("fraud, misrepresentation, or other misconduct of an adverse party") because of the use by the plaintiff's damages expert of falsified information in financial statements. However, affirming denial of relief from judgment on those grounds under Rule 60(b)(3)("newly discovered evidence").

Amgen v. Hoechst Marion Roussel (now known as Aventis Pharmaceuticals) **(No. 05-1157) (Michel, Clevenger, Schall)**

August 3, 2006 2:56 PM

(Schall) Vacating judgment of validity because of erroneous claim construction and reversing judgment of infringement under doctrine of equivalents, but affirming other judgments of validity and infringement. Claim term "therapeutically effective amount" did not require the claimed compound actually to heal or cure disease but only to elicit certain biological effects. When a piece of prior art is a patent, that prior art is presumed to be enabling, but that presumption can be overcome by a preponderance of the evidence. Presumption of prosecution history estoppel was not rebutted under the "merely tangential" or "some other reason" analyses of a claim amendment. The alleged equivalent was foreseeable at the time of the amendment when the patent knew about it. Michel dissents in part.

Pfizer, Inc. v. Ranbaxy Laboratories, Limited **(No. 06-1179) (Michel, Schall, Dyk)**

August 2, 2006 2:53 PM

(Michel) Affirming judgment of infringement of one patent but reversing judgment of validity of another patent. Statements made during prosecution of a later patent or foreign counterpart patents were irrelevant to claim construction because they were made in response to unique foreign patentability requirements. Patent term extension was valid. Dependent claim that was not narrower than the independent claim was invalid under 35 USC 112, 4.