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Federal Circuit Patent Updates - August 2007

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In *Re Trans Texas Holdings Corp.* (No. 2006-1599, -1600) (Michel, Mayer, Dyk)

August 22, 2007 3:09 PM

(Dyk) Affirming Board's obviousness rejection of reexamination claims directed to financial system. PTO was not bound by claim construction rendered by district court during litigation preceding the reexamination.

In *re Seagate Technology, LLC* (No. 830) (Newman, Mayer, Lourie, Rader, Schall, Bryson, Gajarsa, Linn, Dyk, Prost)

August 20, 2007 3:06 PM

(Mayer) Granting petition for writ of mandamus directing trial court to vacate orders compelling disclosure from trial counsel. The Court overruled the standard articulated in Underwater Devices, which failed "to comport with the general understanding of willfulness in the civil context." "[P]roof of willful infringement permitting enhanced damages requires at least a showing of objective recklessness. Because we abandon the affirmative duty of due care, we also reemphasize that there is no affirmative obligation to obtain opinion of counsel." Privilege waivers associated with raising the advice of counsel defense generally will not extend to trial counsel. However, the Court stressed that this rule is not absolute and "trial courts remain free to exercise their discretion in unique circumstances to extend waiver to trial counsel, such as if a party or counsel engages in chicanery." The Court also noted that "willful infringement in the main must find its basis in prelitigation conduct" and that opinions obtained after commencement of litigation "will likely be of little significance."

***Frazer, et al. v. Schlegel, et al.* (No. 06-1154) (Newman, Friedman, Rader)**

August 20, 2007 3:04 PM

(Newman) Reversing award of priority and concluding that junior party to interference was entitled to priority date of foreign patent application directed to human papilloma virus vaccine.

Nisus Corporation v. Perma-Chink Systems, Inc. v. Teschner **(No. 2006-1592, 2007-1142) (Rader, Bryson, Linn)**

August 13, 2007 3:02 PM

(Bryson) Dismissing appeal of inequitable conduct order and affirming denial of motion to intervene. Patent attorney who was not a party to underlying litigation, but who prosecuted patent that was found unenforceable due to inequitable conduct, sought to appeal district court's inequitable conduct order and intervene. "[A]bsent a court's invocation of its authority to punish persons before it for misconduct, actions by the court such as making adverse findings as to the credibility of a witness or including critical language in a court opinion regarding the conduct of a third party do not give nonparties the right to appeal."

Boston Scientific Scimed, Inc. (formerly known as Scimed Life Systems, Inc.) v. Medtronic Vascular, Inc. (also known as Medtronic AVE, Inc.), et al. **(No. 06-1434) (Mayer, Bryson, Prost)**

August 8, 2007 2:59 PM

(Mayer) Affirming interference decision and holding that an applicant is not entitled to benefit from a prior foreign application previously filed by an entity that was not acting on behalf of the U.S. applicant at the time of filing.

Safetcare Manufacturing, Inc. v. Tele-Made, Inc., et al. **(No. 06-1535) (Michel, Gajarsa, Robinson)**

August 3, 2007 2:54 PM

(Gajarsa) Affirming summary judgment of non-infringement of patent directed to hospital bed. The court decided the case after informing the parties at oral argument that order was not appealable, after which the district court entered a "nunc pro tunc" final judgment under Rule 54(b). On the merits, the decision turned on claim construction and a finding under the doctrine of equivalents that claim scope had been surrendered during prosecution.

Sony Electronics, Inc., et al. v. Guardian Media Technologies, LTD. **(No. 06-1363) (Newman, Friedman, Prost)**

August 3, 2007 2:52 PM

(Prost) Reversing and remanding district court's dismissal for lack of subject matter jurisdiction over declaratory judgment actions.

Biotechnology Industry Organization, et al. v. District of Columbia, et al. **(No. 06-1593) (Bryson, Plager, Gajarsa)**

August 1, 2007 2:49 PM

(Gajarsa) Holding that District of Columbia law limiting price that can be charged for patented drugs was preempted by Commerce Clause. The opinion includes a discussion of the CAFC's jurisdiction over the case. WilmerHale represented the plaintiffs-appellees.

In Re Icon Health and Fitness, Inc. **(No. 06-1573) (Mayer, Schall, Prost)**

August 1, 2007 2:48 PM

(Prost) Affirming decision on reexamination that claims directed to a treadmill were obvious. Prior art describing a folding bed was "analogous art" to treadmill invention and did not teach away from claimed invention.