Federal Circuit Patent Updates - August 2008

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800 Adept, Inc. v. Murex Securities, Ltd. **(No. 2007-1272, -1356) (Gajarsa, Plager, Dyk)**

August 29, 2008 10:46 AM

(Plager) Reversing judgment of infringement of plaintiff's patents in case relating to routing of "1-800" telephone calls. Also, reversing judgment for plaintiff on tortious interference with business relationships and vacating plaintiff's damages award, permanent injunction, and the judgment with respect to willfulness, enhanced damages, and attorney fees. Also vacating judgment of invalidity of some of defendant's patent claims, remanding for a new trial on two of those claims and affirming judgment of invalidity of other of defendant's claims. Plaintiff's claims, which require an "assignment" to be made before a call is placed, were not infringed by defendant's products, which perform the assignment "on the fly" during a call. "Even if [some unasserted] claims are rendered inoperative by a proper claim construction, preserving the validity of unasserted claims is an insufficient reason to ignore the meaning of the claims actually asserted in the case." Defendant's unasserted patent claims were not placed at issue in the trial and "[w]e therefore reverse the trial court's judgment of invalidity with respect to the unasserted claims." "[Plaintiff's] argument that it was unnecessary for its validity expert to put forth a claim-by-claim analysis of the unasserted claims is simply incorrect." Dyk concurred. WilmerHale represented the defendants-appellants, Murex.

A full version of the opinion is available **here**.

Proveris Scientific Corp. v. InnovaSystems Inc. **(No. 2007-1428)(Schall, Bryson, Gajarsa)**

August 5, 2008 2:46 PM

(Schall) Affirming judgment of infringement and holding that defendant was not entitled to the safe harbor provision of the Hatch-Waxman Act in 35 USC 271(e)(1). The accused device was not itself subject to FDA approval but was used by third parties for the development and submission of information to the FDA about their products. The safe harbor provision was not intended to protect such devices.

A full version of

In Re Omeprazole Patent Litigation **(Lourie, Bryson, Gajarsa)**

August 1, 2008 3:19 PM

(Bryson) Affirming judgment of infringement in Hatch-Waxman case of drug formulation patents. The case did not become moot upon patent expiration because of additional period of exclusivity afforded by pediatric testing. The claims were not invalid based on a prior public use because the invention was not ready for patenting at that time.

A full version of the order is available **here**.

DSW Inc. v. Shoe Pavilion Inc. **(Mayer, Schall, Linn)**

August 1, 2008 3:14 PM

(Mayer) Reversing claim construction where district court improperly read limitations into the claims from the specification. Damages are available immediately after notice of infringement is received under the marking statute.

A full version of the decision is available **here**.

Cooper Technologies Co. v. Director U.S. Patent and Trademark Office **(Michel, Lourie, Linn)**

August 1, 2008 3:10 PM

(Linn) Affirming and affording Chevron deference to PTO rule determining that inter partes reexamination was available for patent based on continuation application filed after effective date of Act but claiming priority to application filed before effective date of Act.

A full version of the order is available **here**.

In Re Cygnus Telecommunications Tech., LLC. **(Newman, Bronson, Pogue)**

August 1, 2008 3:07 PM

(Bryson) Affirming summary judgment that claims were invalid under an on-sale bar and not infringed.

A full version of the decision is available **here**.

Voda v. Cordis Corp. **(Mayer, Bryson, Gajarsa)**

August 1, 2008 3:02 PM

(Gajarsa) In catheter case, affirming claim construction, patent validity (anticipation and obviousness) and the denial of a permanent injunction but reversing in part a judgment of

infringement based on prosecution history estoppel and remanding a finding of willfulness because the jury was not properly instructed on the new standard of Seagate. The patentee was not entitled to a permanent injunction based on irreparable harm to its licensee.

A full version of the decision is available **here**.

Prasco v. Medicis Pharmaceutical Corp. **(Gajarsa, Clevenger, Moore)**

August 1, 2008 2:59 PM

(Gajarsa) Affirming dismissal of declaratory judgment action for failure to present a case or controversy. Marking of product by patentee and suit against another company on an unrelated patent did not confer jurisdiction over case seeking declaration that a product in development did not infringe. After the case was commenced, the patentee refused to sign a covenant not to sue, and a second complaint was filed, but this failure was also insufficient to confer jurisdiction.

A full version of the order is available here.

Aspex Eyewear Inc. v. Altair Eyewear Inc. **(No. 2007-1380)(Michel, Linn, Zagel [of the N.D. Ill., sitting by designation])**

August 1, 2008 2:55 PM

(Michel) Reversing summary judgment because of erroneous claim construction as to one patent but affirming summary judgment of noninfringement as to other patents and determination of disputed issues of fact as to standing. "[R]etaining mechanisms for ..." was a means-plus-function limitation. An "oral or implied exclusive license" could confer standing.

A full version of the opinion is available here.

Research Corp. Technologies Inc. v. Microsoft Corp. **(No. 2006-1275)(Newman, Friedman, Rader)**

August 1, 2008 2:42 PM

(Rader) Reversing holding of inequitable conduct and grants of summary judgment of noninfringement and invalidity and grants of motions in limine and remanding to a different trial judge. The inventors had no duty to disclose post-filing test results to the PTO. "Publication is an act inconsistent with an intent to conceal data from the USPTO." Suggesting that experts could testify as to materiality. "An inventor's motives in applying for a patent or his views on the purposes of the patent system are generally irrelevant to a proper determination of inequitable conduct."

A full version of the opinion is available **here**.

Star Scientific Inc. v. R.J. Reynolds Tobacco Co. **(Michel, Schall, Dyk)**

August 1, 2008 8:30 AM

(Dyk) Reversing judgment that patent was unenforceable due to inequitable conduct and that claims were indefinite. With respect to inequitable conduct, "[i]f a threshold level of intent to deceive or materiality is not established by clear and convincing evidence, the district court does not have any discretion to exercise and cannot hold the patent unenforceable regardless of the relative equities or how it might balance them.… [The defendant] cannot carry its burden simply because [the patentee] failed to prove a credible alternate explanation. … The patentee need not offer any good faith explanation unless the accused infringer first carried his burden to prove a threshold level of intent to deceive by clear and convincing evidence." With respect to indefiniteness, the district court erred in believing that claim definiteness requires that a potential infringer be able to determine if a process infringes before practicing the claimed process.

A full version of the opinion is available **here**.

Leggett & Platt Inc. v. Vutek, Inc. **(Bryson, Archer, Prost)**

August 1, 2008 8:23 AM

(Prost) Affirming summary judgment that patent to printers was invalid as anticipated, applying inherency doctrine.

A full version of the opinion is available **here**.