
Federal Circuit Patent Updates - August 2010

AUGUST 31, 2010

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***Desenberg v. Google, Inc.* (No. 2010-1212, 8/31/10)(Newman, Mayer, Prost)**

August 31, 2010 1:37 PM

(Newman) Affirming dismissal of an infringement complaint for failure to state a claim upon which relief may be granted, where the asserted method claim required multiple steps and the plaintiff did not allege that the defendant performed, or directed or controlled the performance of, all the steps of the claimed method.

A full version of the text is available [here](#).

***Stauffer v. Brooks Brothers, Inc.* (No. 2009-1428, 8/31/10)(Rader, Lourie, Moore)**

August 31, 2010 9:25 AM

(Lourie) Reversing dismissal of false marking qui tam action under 35 U.S.C. 292 on grounds of lack of standing and the denial of the U.S. Government's motion to intervene. "[Plaintiff's] standing arises from his status as 'any person', and he need not allege more for jurisdictional purposes."

A full version of the text is available [here](#).

***Princo Corp. v. International Trade Commission* (No. 2007-1386, 8/30/10)(en banc)**

August 30, 2010 9:20 AM

(Bryson) Affirming ITC decision that the doctrine of patent misuse does not bar Philips from enforcing its patent rights. "Because patent misuse is a judge-made doctrine that is in derogation of statutory patent rights against infringement, this court has not applied the doctrine of patent misuse expansively. In this case, we adhere to that approach" Extensive discussion of the history, purpose, and scope of the doctrine of patent misuse. "What patent misuse is about, in short, is 'patent leverage', i.e., the use of the patent power to impose overbroad conditions on the use of the patent in suit that are 'not within the reach of the monopoly granted by the Government'." Prost and Mayer, Gajarsa, concurred. Dyk and Gajarsa, dissented.

WilmerHale represented the intervenor U.S. Philips Corporation.

A full version of the text is available [here](#).

General Protecht Group, Inc. v. International Trade Commission (Newman, Dyk, Prost)

August 27, 2010 11:37 AM

(Dyk) Reversing Commission's findings of infringement of claims directed to circuit interrupters. Newman, dissented: Unlike the deferential review evidence in the companion case (above), "This court now finds its own facts, applies theories that were not raised by any party, uses incorrect standards of review, and creates its own electrical technology contrary to the uniform and unchallenged expert testimony."

A full version of the text is available [here](#).

Pass & Seymour, Inc. v. International Trade Commission (Newman, Dyk, Prost)

August 27, 2010 10:48 AM

(Prost) Affirming Commission's claim construction and finding of no-infringement of patents related to circuit interrupters.

A full version of the text is available [here](#).

Geo M. Martin Co. v. Alliance Machine Systems International LLC (Rader, Archer, Prost)

August 20, 2010 10:09 AM

(Rader) Affirming judgment of obviousness as a matter of law after hung jury. The patent was a mechanical invention directed to separating "bundled" boards. Secondary considerations were not sufficient to show non-obviousness where the difference between the prior art and the claimed invention was minimal.

A full version of the text is available [here](#).

Transocean Offshore Deepwater Drilling v. Maersk Contractors USA (Gajarsa, Mayer, Moore)

August 18, 2010 9:21 AM

(Moore) Reversing the district court's summary judgment holding of invalidity (for both obviousness and lack of enablement) of patents relating to off-shore drilling. Secondary considerations of non-obviousness required a trial on the issue of obviousness. Whether or not one skilled in the art could practice the invention without undue experimentation presented factual issues that should be considered at trial. Regarding non-infringement, although an offer was made in Norway, the contract constituted an offer by U.S. company to a U.S. company for the delivery and use of a drilling rig within the U.S. Further, the district court failed to consider whether what was sold was infringing even though what was delivered had been modified to avoid a prior infringement ruling. However,

the patentee was estopped from asserting that the modified rig infringed based on the prior ruling. Finally, the Court affirmed a summary judgment of non-willfulness based on the modification, which was intended to avoid infringement.

A full version of the text is available [here](#).

Baran v. Medical Device Technologies (Bryson, Gajarsa, Prost)

August 12, 2010 9:15 AM

(Bryson) Affirming district court's claim construction and summary judgment of no infringement under the doctrine of equivalents of patents related to biopsy device. With respect to the doctrine of equivalents, the accused device worked in a manner opposite to what the invention claimed. The Court also affirmed the district court's decision striking an inventor's declaration where he had failed to file an expert report, although he had not been "retained or specially employed to provide expert testimony" as set forth in Fed. R. Civ. P. 26.

A full version of the text is available [here](#).

Golden Hour Data Systems, Inc. v. Emscharts, Inc. (2009-1306, -1396, 8/9/10) (Newman, Friedman, Dyk)

August 9, 2010 2:05 PM

(Dyk) Affirming JMOL of no joint infringement of claims related to information management in connection with emergency medical services, vacating inequitable conduct determination and remanding. Failure to disclose to the PTO an undated brochure obtained a few weeks after filing the patent application was a material omission. "[O]ur prior cases make clear that information may be material even if it does not qualify as prior art." Regarding intent to deceive, on remand "the district court must determine, in the first instance, whether [patentee or prosecution counsel] in fact read the brochure and deliberately decided to withhold damaging information from the PTO." Regarding infringement, the patentee accused two defendants, who had "formed a strategic partnership, enabled their two programs to work together, and collaborated to sell the two programs as a unit" of jointly infringing but failed to establish the requisite control or direction. "Where the combined actions of multiple parties are alleged to infringe process claims, the patent holder must prove that one party exercised 'control or direction' over the entire process such that all steps of the process can be attributed to the controlling party, i.e., the 'mastermind.'" Newman dissented.

A full version of the text is available [here](#).

Ring Plus, Inc. v. Cingular Wireless Corp. (2009-1537, 8/6/10) (Lourie, Gajarsa, Moore)

August 6, 2010 1:59 PM

(Moore) Reversing judgment of unenforceability, affirming summary judgment of non-infringement, and affirming denial of motion to disqualify counsel. Although the district court did not clearly err in finding that a description of prior art references in the Background section of the patent was a

material misrepresentation to the PTO, the district court did clearly err in finding that defendant introduced clear and convincing evidence of deceptive intent. “The court premised its finding of intent almost entirely on its view that the references unambiguously disclose software. ... Although the references disclose isolated components that tend to be associated with computer operation, the references do not unambiguously disclose software ...”

A full version of the text is available [here](#).

***Adams Respiratory Therapeutics, Inc. v. Perrigo co.* (2010-1246, 8/5/10) (Linn, Moore, Friedman)**

August 5, 2010 1:42 PM

(Moore) Vacating summary judgment of non-infringement of patent related to extended release formulation of guaifenesin, an expectorant, and remanding. The Court construed the claim term “equivalent” to require “a Cmax that is 80% to 125% of the value to which it is being compared.” Patentee’s comparison of the accused product to a commercial embodiment of the invention was sufficient for a fact finder to reasonably conclude that the “equivalent” limitation was met, and thus to preclude summary judgment of non-infringement. “Our case law does not contain a blanket prohibition against comparing the accused product to a commercial embodiment. ...[W]hen a commercial product meets all of the claim limitations, then a comparison to that product may support a finding of infringement.”

A full version of text is available [here](#).

***Intervert Inc. v. Merial Ltd.* (2009-1568, 8/4/10) (Bryson, Dyk, Prost)**

August 4, 2010 1:37 PM

(Prost) Reversing claim construction for patent relating to porcine circovirus, vacating judgment of non-infringement and remanding. The district court erred by construing the term “porcine circovirus type II” to be limited to the sequences deposited by the patentee with the PTO. “Here, the deposited strains are representative species of the larger ‘type II’ genus, where the genus is identified and claimed as the invention.” Prosecution history estoppel did totally bar equivalents because the claim amendment bore only a tangential relation to the equivalent in question. Dyk concurred-in-part and dissented-in-part.

A full version of the text is available [here](#).

***Kimberly-Clark v. First Quality Baby [order]* (2010-1382, 8/2/10) (Rader, Bryson, Moore)**

August 2, 2010 2:29 PM

(Rader) Denying petition for stay of a preliminary injunction.

A full version of text is available [here](#).

***In Re Echostar [Order]* (Miscellaneous Docket No. 933, 8/2/10) (Rader, Bryson, Moore)**

August 2, 2010 2:11 PM

(Rader) Denying petition for writ of mandamus seeking to transfer case from the Eastern District of Texas to the District of Delaware.

A full version of the text is available [here](#).

King Pharmaceuticals, inc. v. Eon Labs, Inc. (2009-1437,-1438, 8/2/10) (Bryson, Gajarsa, Prost)

August 2, 2010 1:32 PM

(Gajarsa) Affirming summary judgment of invalidity of claims related to methods of using metaxalone, a prior art muscle relaxant. Claims directed to administering metaxalone with food to increase “the bioavailability of metaxalone” were inherently anticipated by prior art that taught administering metaxalone with food for a different purpose, i.e., for reducing gastric discomfort. Other claims relating to “informing the patient” that taking metaxalone with food increases its bioavailability were also anticipated. “The specific question before us is whether an otherwise anticipated method claim becomes patentable because it includes a step of ‘informing’ someone about the existence of an inherent property of that method. We hold it does not. The ‘informing’ limitation adds no novelty to the method, which is otherwise anticipated by the prior art.” The district court had found the “informing the patient” claims invalid under 35 U.S.C. § 101. The Court noted that the district court’s § 101 analysis was improper because it “ignored the claim as a whole and improperly focused on one limitation, the ‘informing’ limitation.” The Court did not itself analyze the “informing the patient” claims under § 101, instead finding them anticipated. “The present case, however, does not present the proper vehicle for determining whether claims covering medical treatment methods are eligible for patenting under § 101 because even if [the claim] recites patent eligible subject matter, that subject matter is anticipated . . .”

A full version of the text is available [here](#).