
Federal Circuit Patent Updates - December 2004

DECEMBER 31, 2004

***Matthew Stephens et al. v. Tech International, Inc. (doing business as Health Tech) et al.* (No. 04-1215) (Mayer, Rader, Schall)**

December 29, 2004 2:21 PM

(Mayer) Reversing award of attorney fees and finding of an exceptional case. Contrary to the district court's findings, the plaintiff's suit was not frivolous, and the plaintiff did not engage in litigation misconduct or vexatious behavior.

***In re Crish* (No. 04-1075) (Mayer, Lourie, Dyk)**

December 21, 2004 2:20 PM

(Lourie) Affirming rejection of claims as anticipated. A claim to a purified DNA molecule containing the promoter region of the human involucrin gene was anticipated by a prior art publication disclosing the size and location--but not the nucleotide sequence-- of that region. Even though the application at issue appeared to be the first to identify the nucleotide sequence of that region, "the identification and characterization of a prior art material ... does not make it novel."

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

December 14, 2004 2:45 PM

(Linn) The Blackberry device was found by a jury to infringe four patents. The CAFC reversed with respect to one claim element and remanded for a determination of whether the faulty claim interpretation was prejudicial with respect to those claims having the limitation and the issue of damages. Although claims were directed to systems and methods and part of the system and method was located in Canada, a finding of direct infringement was still proper where the "location of the beneficial use and function of the whole operable system assembly is the United States."

***Iron Grip Barbell Company, Inc., et al. v. USA Sports, Inc.* (No. 04-1149) (Newman, Archer, Dyk)**

December 14, 2004 2:41 PM

(Dyk) Affirming summary judgment of obviousness of claims to barbells. An invention is obvious if

it falls within a range disclosed within the prior art unless the prior art teaches away from the invention or there are new and unexpected results. This principle can also apply where the range is taught by multiple pieces of prior art rather than a single reference. Long felt need, commercial success and copying discussed as secondary considerations of non-obviousness.

***Versa Corporation v. AG-BAG International Limited*(No. 03-1445) (Newman, Rader, Dyk)**

December 14, 2004 2:29 PM

(Dyk) Reversing summary judgment of non-infringement based on faulty construction of a means-plus-function element. The court found that the specification disclosed multiple embodiments of the structure corresponding to the claimed function based on a single sentence in the specification stating the "belief" that all of the structure might not be necessary to practice the function. Newman dissented.

***Alza Corporation, et al. v. Mylan Laboratories, Inc., et al.* (No. 04-1344) (Newman, Archer, Dyk)**

December 10, 2004 2:48 PM

(Archer) Affirming summary judgment that claims directed to the transdermal administration of a narcotic were not anticipated, obvious or unenforceable. Validity turned on an affirmed narrow claim interpretation involving a disclaimer of prior art. The inequitable conduct holding was based on a lack of intent. Archer dissented in part on the inequitable conduct holding.

***Centricut, LLC, et al. v. The ESAB Group, Inc.* (No. 03-1574/1614) (Michel, Clevenger, Dyk)**

December 6, 2004 2:51 PM

(Dyk) Reversing finding of infringement of patent directed to an electrode for a plasma arc torch where there was no supporting expert testimony. Although expert testimony is not always necessary, where technology is complex, expert testimony may be essential, although this is not a per se rule.

***In Re Daniel S. Fulton and James Huang* (no. 04-1267) (Michel, Rader, Gajarsa)**

December 2, 2004 3:01 PM

(Michel) Affirming rejection of claims directed to shoe soles with increased traction where substantial evidence supported finding of a motivation to combine references.