
Federal Circuit Patent Updates - December 2006

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Ventana Medical Systems, Inc. v. BioGenex Laboratories, Inc. (No. 06-1074) (Lourie, Dyk, Prost)

December 29, 2006 8:13 AM

(Prost) Vacating summary judgment of non-infringement of patents related to automated methods for staining slides. The Court's holding was based on the district court's unduly narrow claim construction of the term "dispensing". Lourie dissented.

Eli Lilly v. Zenith Goldline (No. 05-1396) (Rader, Schall, Gajarsa)

December 26, 2006 8:12 AM

(Rader) In ANDA case, affirming judgment that patent directed to compound and method of using compound to treat schizophrenia was not invalid or unenforceable. An anticipation attack under In re Petering was rejected. The claimed compound was also non-obvious. Clinical trials of the drug were an experimental, not public, use.

Plumtree Software, Inc. v. Datamize, LLC (No. 06-1017) (Newman, Friedman, Dyk)

December 18, 2006 8:09 AM

(Dyk) Affirming subject matter jurisdiction over declaratory judgment action. Reversing judgment that claimed method for creating software was invalid under the on-sale bar. The plaintiff had neither offered to perform the patented method prior to the critical date, nor had it in fact performed the method for a promise of future compensation. The alleged agreement did not unambiguously require use of the patented method.

L&W, Inc. v. Shertech, Inc., et al. (No. 06-1065) (Mayer, Clevenger, Bryson)

December 14, 2006 3:48 PM

(Bryson) Affirming and vacating various judgments of infringement and validity of patents related to heat shields for automobiles. Summary judgment of non-infringement was reversed based on a

disputed issue of fact. Appeal of a jury verdict of invalidity based on inconsistent jury verdicts was denied because it was not raised before the jury was discharged.

Planet Bingo, LLC, et al. v. GameTech International, Inc., et al. (No. 05-1476) (Newman, Mayer, Rader)

December 13, 2006 3:42 PM

(Rader) Affirming judgment of non-infringement and anticipation of patents relating to methods of playing bingo. No infringement existed under the doctrine of equivalents based on application of the all-elements rule ("after" could not be equivalent to "before" without vitiating a limitation).

DSU Medical Corporation, et al. v. JMS Co., LTD, et al. (No. 04-1620) (Rader, Schall, Linn)

December 13, 2006 3:39 PM

(Rader) Affirming various jury verdicts on patents covering safety shields for needles. A finding of no contributory infringement was sustained based on the absence of direct evidence establishing that accused devices were actually used in an infringing manner in the United States, notwithstanding holding that products had no non-infringing uses. In a portion of the opinion resolved en banc, the Court held that, to show inducement of infringement, "it must be established that the defendant possessed specific intent to encourage another's infringement and not merely that the defendant had knowledge of the acts alleged to constitute inducement. The plaintiff has the burden of showing that the alleged infringer's actions induced infringing acts and that he knew or should have known his actions would induce actual infringements." In the panel portion applying this holding, the Court affirmed the verdict of no inducement based on the intent requirement including evidence that the defendant had obtained advice of counsel that there was no infringement. The Court also affirmed exclusion of an expert opinion seeking lost profits based on the lack of "sound economic proof."

Thompson v. Microsoft Corporation (No. 06-1073)(Mayer, Bryson, Linn)

December 8, 2006 3:33 PM

(Linn) Transferring appeal because of lack of jurisdiction. An unjust enrichment claim alleging that the defendant had misappropriated and patented the plaintiff's technology did not "arise under" the patent laws, even where the defendant asserted that the claim was preempted by the patent laws.

Sanofi-Synthelabo, et al. v. Apotex, Inc., et al. (No. 06-1613)(Lourie, Clevenger, Bryson)

December 8, 2006 3:31 PM

(Lourie) Affirming grant of a preliminary injunction against sales of a generic drug. Infringement was conceded, and the invalidity and enforceability defenses were not substantial. Irreparable harm existed even though the parties had earlier reached a settlement that did not receive regulatory approval. The public interest in the enforcement of the patent system encouraging the development of new drugs outweighed the interest of the public in having generic drugs.