

---

## Federal Circuit Patent Updates - December 2008

DECEMBER 31, 2008

[View previous month...](#)

***Accumed v. Stryker* (No. 08-1124) (Mayer, Lourie, Gajarsa)**

December 30, 2008 10:19 AM

(Lourie) Affirming grant of permanent injunction. The district court did not abuse its discretion in entering an injunction notwithstanding prior licenses by the patentee. Balancing of hardships "is only between a plaintiff and a defendant, and thus the effect on customers and patients . . . is irrelevant under this prong."

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

***In re TS Tech USA* (No. 09-M888) (Michel, Prost, Rader)**

December 29, 2008 10:22 AM

(Rader) Applying the Fifth Circuit's opinion in *In re Volkswagen* to grant a petition for a writ of mandamus and ordering the Eastern District of Texas to transfer a patent case where there was no contact with the forum other than the sale of "several cars" incorporating the alleged infringing products.

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

***Sundance, Inc. v. Demonte Fabricating, Ltd.* (No. 08-1068) (Dyk, Prost, Moore)**

December 24, 2008 10:29 AM

(Moore) Reversing District Court's JMOL decision that claims directed to "covering system" for containers were nonobvious as a matter of law. The district court abused its discretion in allowing a lawyer-expert who was not skilled in the art to testify about infringement and validity issues. "We hold that it is an abuse of discretion to permit a witness to testify as an expert on the issue of infringement or invalidity unless that witness is qualified as an expert in the pertinent art." However, although excluding the witnesses' testimony meant there was no expert testimony supporting a

holding of obviousness, none was necessary because there were no underlying factual issues in dispute and the technology was simple.

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

***Ricoh Company, Ltd. v. Quanta Computer Inc. (No. 07-1567) (Gajarsa, Linn, Dyk)***

December 23, 2008 2:49 PM

(Per Curiam) Affirming and reversing various rulings on patents directed to optical disk drive technology. An obviousness ruling was affirmed after rejecting arguments that the prior art taught away. With respect to claims of direct infringement, the sale of software to practice a patented method did not constitute an act of direct infringement of that method. However, even though the accused optical devices had non-infringing uses, they contributorily infringed the method patents because they included "separate hardware and embedded software modules to perform the patented process and . . . those components had no non-infringing use." Further, inducement of infringement was shown by the requisite affirmative acts, even if there was no evidence that the seller explicitly communicated information regarding the patented method. Gajarsa, J. dissented on the issue of contributory infringement.

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

***Hyatt v. Director, Patent and Trademark Office [corrected] (No. 07-1050C) (Newman, Gajarsa, Ward)***

December 23, 2008 11:18 AM

(Gajarsa) In a decision affirming the rejection of claims directed to approximately 2,400 claims in twelve related patents, the Court ruled on two issues: "The first issue is the extent to which 37 C.F.R. § 1.192(c)(7) (2000) allows the Board to affirm the rejections of groups of patent claims based upon its consideration of certain representative claims. In particular, the PTO challenges the district court's holding that the Board misinterpreted the meaning of "ground of rejection" in section 1.192(c)(7) and, as a result, improperly selected certain claims to be representative of groups of claims that were rejected on different grounds. The second issue is whether the district court's remand order requires the Board to consider arguments that Hyatt allegedly waived by failing to raise them before the Board in his initial appeals. Because we conclude, first, that the district court correctly interpreted section 1.192(c)(7) and, second, that the district court's remand order does not require the Board to consider arguments waived by Hyatt, we affirm."

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

***In Re Wheeler (No. 08-1215) (Rader, Schall, Prost)***

December 19, 2008 3:08 PM

(Rader) Affirming summary of judgment of non-infringement of claims directed to pin clamps

where district court correctly interpreted "mechanism for rotating/moving . . ." as means-plus-function limitations.

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

***Rentrop v. The Spectranetics Corp.* (No. 07-1560) (Michel, Friedman, Walker)**

December 18, 2008 2:59 PM

(Walker) Affirming jury verdict of infringement of patent directed to catheters. The defendant waived its arguments based on KSR, but the instructions were, in any event, not clearly wrong. Claim interpretation and findings of no inequitable conduct also upheld.

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

***Avocent Huntsville Corp. v. Aten International Co., Ltd.* (No. 07-1553) (Newman, Schall, Linn)**

December 16, 2008 3:04 PM

(Linn) Affirming dismissal of declaratory judgment case for lack of personal jurisdiction where there was no allegation that Taiwanese patentee purposefully directed any activities beyond merely sending notice letters to residents of the forum. Newman dissented.

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

***Sanofi-Synthelabo v. Apotex Inc.* (No. 2007-1438)(Newman, Lourie, Bryson)**

December 12, 2008 9:51 AM

(Newman) Affirming holding validity of patent on a dextrorotatory isomer in view of its known racemate described in earlier patents. Anticipation "requires the specific description as well as enablement of the subject matter at issue." Any presumption of enablement of prior art does not exclude consideration of whether undue experimentation would be required to achieve enablement."

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

***iLor, LLC v. Google, Inc.* (No. 2008-1178)(Mayer, Linn, Moore)**

December 11, 2008 9:36 AM

(Linn) Affirming denial of preliminary injunction. The district court properly construed the claims, and under that construction, there was no infringement.

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

***Netcraft Corp. v. Ebay, Inc.* (No. 2008-1263)(Bryson, Linn, Prost)**

December 9, 2008 9:19 AM

(Prost) Affirming summary judgment of noninfringement. The claim phrase "providing a communications link through equipment of the third party" was construed to require providing customers with internet access.

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

***Takeda Chemical Industries Ltd. v. Mylan Laboratories Inc. (No. 2007-1269)***(Lourie, Rader, Bryson)

December 8, 2008 9:17 AM

(Lourie) Affirming exceptional case finding and award of attorney fees against the accused infringer as supported by baseless Paragraph IV ANDA certification letters and litigation misconduct. Bryson concurs in part.

***The Procter and Gamble Co. v. Kraft Foods Global, Inc. (No. 2008-1105)***(Bryson, Gajarsa, Dyk)

December 5, 2008 8:25 AM

(Gajarsa) Vacating a stay of litigation pending reexamination and remanding for reconsideration of a preliminary injunction motion that had been effectively denied. Litigation could be stayed pending an inter partes reexamination at the request of the accused infringer. "Both a preliminary injunction and a stay ordinarily should not be granted at the same time."

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

***Qualcomm Inc. v. Broadcom Corp. (No. 2007-1545, 2008-1162)*** (Mayer, Lourie, Prost)

December 1, 2008 10:12 AM

(Prost)Affirming award of attorney fees and determination that plaintiff breached its duty to disclose patents to a video compression standards-setting organization ("SSO"). Also remanding with instructions to hold patents unenforceable against products that comply with the standard. "[W]e conclude that a district court may in appropriate circumstances order patents unenforceable as a result of silence in the face of an SSO disclosure duty, as long as the scope of the district court's unenforceability remedy is properly limited in relation to the underlying breach." Jury's finding of non-infringement does not refute the conclusion that the patents "reasonably might be necessary" to practice the standard and should have been disclosed to the SSO. Plaintiff's breach of its duty to the SSO and its litigation misconduct "were proper bases for the court's exceptional case determination." WilmerHale represented the defendant-appellee, Broadcom Corporation.

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