
Federal Circuit Patent Updates - February 2008

FEBRUARY 29, 2008

[View previous month...](#)

Micron Tech. v. MOSAID Tech. (07-1080) (Newman, Rader, Dyk)

February 29, 2008 11:20 AM

(Rader) Reversing dismissal of declaratory judgment complaint for lack of subject matter jurisdiction. Because it is easier to achieve declaratory judgment jurisdiction after the Supreme Court's decision in *Medimmune*, in declaratory judgment cases involving competing forums, the district court should consider the "convenience factors" under 28 USC 1404(a). The district therefore also erred in exercising its discretion to dismiss the suit in favor of a later-filed action in the Eastern District of Texas. WilmerHale represented the Appellant Micron.

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

Regents of the U. of California v. Dakocytomation California (No. 2006-1334, -1452) (Mayer, Lourie, Prost)

February 28, 2008 11:14 AM

(Lourie) Remanding denial of preliminary injunction and partial grant of summary judgment of non-infringement based on faulty claim construction of patent directed to identifying and classifying chromosomes. The plaintiff met its burden of overcoming the presumption of prosecution history estoppel by showing that the amendment was tangential to patentability. Prost dissented on the prosecution history estoppel holding.

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

Amado v. Microsoft Corp. (No. 07-1236) (Bryson, Clevenger, Linn)

February 26, 2008 11:09 AM

(Linn) Remanding for further procedures with respect to post-verdict injunction and royalty payments. The district court assessed a royalty for infringing units while an injunction was stayed

during a prior appeal. The Federal Circuit remanded that portion of the court's opinion for a further explanation of the basis for the amount of the award. The district court's extension of the prior-granted stay did not violate the mandate rule, and its dissolution of the injunction in light of eBay was within its discretion.

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

Aristocrat Tech. Australia Pty Ltd. v. Multimedia Games Inc. (No. 2007-1375)(Lourie, Schall, Bryson)

February 22, 2008 11:19 AM

(Lourie) Reversing summary judgment of invalidity for indefiniteness based on alleged lack of structure in the specification to perform the function of a means-plus-function (MPF) limitation. There were "genuine issues of material fact ... whether one skilled in the art of computer programming would identify structure in the specification associated with the various asserted claim limitations." "Subsidiary" MPF limitations might be able to define sufficient structure to rebut the presumption of MPF treatment of a "parent" MPF clause. "The law does not require that the structure be explicitly identified as long as a person of ordinary skill in the art would understand what structure is identified in the specification." WMS Gaming (dealing with use of a general purpose computer or microprocessor to correspond to a MPF limitation) "does not require that a particular algorithm be identified if the selection of the algorithm or group of algorithms needed to perform the function would be readily apparent to a person of skill in the art."

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

Atlanta Attachment Co. v. Leggett and Platt Inc. (No. 2007-1188) (Mayer, Dyk, Prost)

February 21, 2008 10:37 AM

(Mayer) Reversing judgment that patent was not invalid because of an on sale bar. Extensive discussion of the "experimental use" exception to the on sale bar. "[O]nce there has been a commercial offer, there can be no experimental use exception." Prost, J., concurs, joined by Dyk.

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

Chamberlain Group v. Lear Corp. (No. 2007-1314) (Rader, Clevenger, Dyk)

February 19, 2008 10:28 AM

(Rader) Vacating preliminary injunction because of an erroneous claim construction.

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

Erico International Corp. v. Vutec Corp. (No. 2007-1168) (Newman, Rader, Dyk)

February 19, 2008 10:17 AM

(Rader) Vacating a preliminary injunction because the defendant raised a substantial question of invalidity. There was an "implicit motivation" to combine prior art references that created a substantial question of obviousness. Newman dissents.

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

***In Re Bilski* (No. 2007-1130)**

February 15, 2008 11:14 AM

Per curiam. Order granting rehearing en banc to consider questions concerning 35 USC 101, including "What standard should govern in determining whether a process is patent-eligible subject matter under section 101?" and whether State Street Bank "should be overruled in any respect?".

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

***DDB Tech. v. MLB Advanced Media* (No. 2007-1211) (Newman, Clevenger, Dyk)**

February 13, 2008 10:13 AM

(Dyk) Affirming in part dismissal of suit for lack of subject matter jurisdiction but reversing denial of request for jurisdictional discovery, in a case where the accused infringer, after suit was filed, obtained a retroactive license from the alleged true owner of the asserted patents. The plaintiff was not entitled to jury trial on the issue of whether it had standing, even though the issue of standing was somewhat intertwined with substantive issues in the case. Newman concurred in part and dissented in part.

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

***In Re Petrus A.C.M. Nuijten* (No. 2006-1371) (Linn, Newman, and Rader)**

February 11, 2008 10:10 AM

(Per curiam) Precedential order denying petition for rehearing en banc. Linn, Newman, and Rader dissent.

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

***International Rectifier v. IXYS* (No. 2007-1063) (Linn, Dyk, Prost)**

February 11, 2008 10:07 AM

(Linn) Reversing jury verdict of infringement because of prosecution history estoppel and the Court's mandate in a prior appeal. Prosecution history applied where the claim limitation at issue

was narrowed by amendment even though the amendment also broadened the claim in other respects.

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

International Rectifier v. IXYS (2007-1063, -1141, -1165) (Linn, Dyk, Prost)

February 11, 2008 10:03 AM

(Linn) Reversing judgment of infringement and vacating damages award and permanent injunction. Also dismissing cross-appeal as moot because the purported error "does not affect the final judgment of non-infringement that our decision today requires." Although an amendment broadened the claim in some respects, it also narrowed the claim by adding a limitation and prosecution history estoppel precluded infringement of that limitation by equivalents.

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

In Re Petrus A.C.M. Nuijten [order] (2006-1371)(Linn, Newman and Rader)

February 11, 2008 9:49 AM

Order denying petition for rehearing and rehearing en banc. Linn, Newman and Rader dissent.

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

Rocky Mountain Technology Engineering v. Hutchens Industries (2007-1473) (Gajarsa, Linn, Dyk)

February 8, 2008 11:10 AM

(Dyk) Affirming dismissal for failure to prosecute.

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

Miken Composites v. Wilson Sporting Goods (2006-1628) (Newman, Schall, Linn)

February 6, 2008 9:38 AM

(Linn) Affirming summary judgment of non-infringement of patent relating to a baseball bat. District court's construction of "insert" as "something inserted or intended for insertion" was not erroneous and patentee's attempt to challenge the construction because it imported "a process limitation into claims directed to a product" failed.

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

Monsanto v. David (2007-1104) (Lourie, Bryson, Moore)

February 5, 2008 9:28 AM

(Lourie) Affirming judgment of infringement of patent relating to genetically modified crops. Also affirming award of attorney fees, costs, enhanced damages, and prejudgment interest and affirming the district court's reasonable royalty calculation. Vacating and remanding for new determination relating to the planting density of the infringing seeds. The patent, which covers a gene sequence, was "infringed by planting a seed containing the gene sequence because the seed contains the gene. The gene itself is being used in the planting, an infringing act." Also, the testimony of patentee's expert was admissible even though it was based on tests that were not conducted by the expert himself. WilmerHale represented the plaintiff-appellee, Monsanto Technology LLC.

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

In Re Roche Molecular Systems, Inc., Roche Diagnostics Corporation, and Roche Diagnostics Operations, Inc. [order] (Miscellaneous Docket No. 854) (Newman, Friedman, Mayer)

February 1, 2008 9:24 AM

Order denying petition for writ of mandamus. Petitioner "has not shown that it cannot obtain the relief it seeks by review after final judgment."

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