
Federal Circuit Patent Updates - February 2010

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Hyatt v. Acting Director, Patent and Trademark Office

February 22, 2010 2:00 PM

(Per Curiam) Order vacating [prior opinion](#) and granting rehearing en banc to address questions including "Are there any limitations on the admissibility of evidence in [35 U.S.C.] section 145 proceedings?"

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

Alloc, Inc. v. Pergo, Inc. (Lourie, Dyk, Kendall [of the N.D. Ill., sitting by designation])

February 22, 2010 1:56 PM

(Kendall, J.) Affirming jury verdict of obviousness and trial court finding of no inequitable conduct. "The district court's submission of the claim construction to the jury, leaving the jury free to make its own determination of the meaning of the claims, was error."

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

Honeywell International, Inc. v. U.S. (Mayer, Prost, Moore)

February 22, 2010 1:48 PM

(Moore, J.) Reversing holdings of invalidity for obviousness and lack of written description and of lack of standing under the Inventions Secrecy Act. Also holding that the first sale doctrine did not apply to limit damages when the prior sale was made before the patentee acquired the patent; "the fact that Honeywell now owns the patent does not retroactively authorize the earlier sale." Mayer, J., dissents in part.

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

ABB Inc. V. Cooper Ind., LLC. (2010 1227) (Rader, Lourie, Dyke)

February 17, 2010 8:05 AM

(Dyk) Reversing district court's dismissal for lack of subject matter jurisdiction and finding that declaratory judgment action arose under the patent laws where it sought declaration that actions were authorized under a license agreement. Resolving a question left open by the Supreme Court in *Textron Lycoming Reciprocating Engine Div., AVCO Corp. v. Auto. Workers*, 523 U.S. 653, 659–60 (1998), the Court held that federal courts have jurisdiction over a declaratory judgment action where there is a federal cause of action but only a state law defense.

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

***SEB S.A. v. Montgomery Ward & Co., Inc.* (Rader, Bryson, Linn)**

February 10, 2010 9:40 AM

(Rader, J.) Affirming judgment of infringement of patent directed to a cooking appliance. “[A] claim for inducement is viable even where the patentee has not produced direct evidence that the accused infringer actually knew of the patent-in-suit. . . . The record contains adequate evidence to support a conclusion that [defendant] deliberately disregarded a known risk that [plaintiff] had a protective patent.” Defendant developed the accused product by copying the plaintiff’s product. Defendant then obtained a “right-to-use” study from an attorney but defendant did not tell the attorney that it had copied plaintiff’s product. “A failure to inform one’s counsel of copying would be highly suggestive of deliberate indifference in most circumstances.” Also, defendant’s argument that prosecution history estoppel precluded a finding of infringement under the doctrine of equivalents was not timely raised thus preventing the Court from reversing unless it detected a “manifest injustice.”

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

***Resqnet.com, Inc. v. Lansa, Inc.* (Newman, Lourie, Rader)**

February 10, 2010 9:28 AM

(Per Curiam.) Affirming rulings of infringement and validity of patent related to terminal emulation software. Also reversing a damages award, remanding for redetermination of damages and reversing a sanctions award. The district court’s damages award was “divorced from proof of economic harm linked to the claimed invention and [] inconsistent with sound damages jurisprudence” and improperly relied upon licenses unrelated to the patent. “In sum, the district court erred by considering [plaintiff’s] re-bundling licenses to significantly adjust upward the reasonable royalty without any factual findings that accounted for the technological and economic differences between those licenses and the [infringed] patent.” Also, the “district court seems to have been heavily influenced by [defendant’s] decision to offer no expert testimony to counter [plaintiff’s damages expert’s] opinion. But it was [plaintiff’s] burden, not [defendant’s], to persuade the court with legally sufficient evidence regarding an appropriate reasonable royalty.” Also, the district court did not err in concluding that user manuals did not qualify as prior art. Citation of those manuals in an information disclosure statement, and amending claims in response to a rejection based on those manuals, did not establish that the manuals qualified as prior art. Newman, J.

concurring in part and dissenting regarding damages.

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

***Therasense, Inc. v. Becton, Dickinson and Co.* (Linn, Friedman, Dyk)**

February 1, 2010 8:58 AM

(Linn, J.) Affirming jury verdict that claims were invalid and consequently dismissing cross-appeal for lack of jurisdiction with respect to finding of infringement. Although a jury instruction on anticipation was erroneous, because the issue of anticipation and obviousness were presented in the same verdict and the Court found that the claim was obvious as a matter of law, the error was harmless.

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

***Boehringer Ingelheim International GMBH v. Barr Laboratories, Inc.* (Linn, Dyk, Prost)**

February 1, 2010 8:55 AM

(Linn, J.) A defense of obviousness type double patenting can not be defeated by filing a terminal disclaimer during litigation where the term of the earlier patent had already expired, even when at the time of the disclaimer, the patent enjoyed a patent term extension under Section 156 such that the patent would have still been in force for those uses permitted by the extension. However, the district court erred in not giving the patentee the benefit of the safe harbor provisions of Section 121 for patent applications filed as a result of a restriction requirement. Dyk, J. dissented on the scope of Section 121.

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

***Therasense, Inc. v. Becton, Dickinson and Co.* (Linn, Friedman, Dyk)**

February 1, 2010 8:51 AM

(Dyk, J.) With respect to patents directed to blood glucose test strips, affirming summary judgment of non-infringement of two patents, anticipation of most of the claims of one patent, and obviousness and unenforceability of a third patent. The prior art includes the claims of a prior art patent. Where the product alleged to show commercial success is covered by more than one patent, the patentee was not entitled to a presumption of a nexus between the commercial success and the claimed invention. The finding of inequitable conduct was based on the failure to disclose statements made in the prosecution of a European counterpart that were contrary to statements made in the US prosecution. The Court rejected the district court's claim construction, but still found non-infringement. Linn, J. dissented on the issue of inequitable conduct and whether the prior art claims were relevant to obviousness.

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

Schindler Elevator Corp. v. Otis Elevator Co. (Linn, Friedman, Dyk)

February 1, 2010 8:46 AM

(Linn, J.) Reversing summary judgment of non-infringement of patent directed to elevator system based on erroneous claim construction. Dyk, J. concurred in the result, but would have interpreted the claims more narrowly based on a disclaimer in the prosecution.

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