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## Federal Circuit Patent Updates - June 2005

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***Seachange International, Inc. v. C-Cor, Inc. (No. 04-1375) (Bryson, Gajarsa, Linn)***

June 29, 2005 11:27 AM

(Linn) Affirming in part and reversing in part judgment based on jury verdict in light of incorrect claim interpretation of patent directed to storing data. Infringement under the doctrine of equivalents was not possible in light of the all elements rule. A remand was required to address the prior art in light of claim construction holding.

***Northpoint Technology, LTD v. MDS America, Inc., et al. (No. 04-1249) (Schall, Bryson, Dyk)***

June 28, 2005 11:25 AM

(Bryson) Affirming judgment based on jury verdict that patents directed to satellite transmissions were invalid as anticipated. The anticipating prior art references were enabled. Patentee was not entitled to a new trial based on the theory that if alternative theories of liability are asserted together in one jury instruction a new trial was required if any of them were unsupported by substantial evidence. The anticipation defense was a single theory notwithstanding its reliance on different pieces of prior art. Dyk dissented on whether the prior art anticipated.

***Rasmusson, et al. v. Smithkline Beecham Corporation (No. 04-1191) (Bryson, Plager, Prost)***

June 27, 2005 11:22 AM

(Bryson) In interference involving inventions for treating prostate cancer, affirming Board decision that patents of one of the parties was not entitled to a priority date based on earlier filed applications but reversing Board's decision that patents were not anticipated because prior art was not enabling. The earlier applications were not entitled to be the priority date because a person skilled in the art would not recognize from them that the compound at issue was effective for treating prostate cancer and hence were not enabled. However, with respect to the validity of the claims, "the standard for what constitutes proper enablement of a prior art reference for purposes of anticipation under § 102, ... differs from the enablement standard under § 112."

***Fort James Corporation v. Solo Cup Company* (No. 04-1365) (Rader, Schall, Gajarsa)**

June 22, 2005 11:20 AM

(Gajarsa) Reversing district court's dismissal for lack of jurisdiction of counterclaim of unenforceability based on inequitable conduct. The district court bifurcated the issues of infringement and validity from the issue of inequitable conduct. After a defendant's verdict, the plaintiff filed a covenant not to sue. Notwithstanding the covenant not to sue, a case or controversy sufficient to sustain declaratory judgment jurisdiction existed. The Court also ruled that the disclosure of a document directed to whether an on-sale bar existed acted as a waiver of the attorney-client privilege with respect to a document concerning the conception and reduction to practice of the claimed invention. Finally, the Court ruled that the notice of appeal was timely under Seventh Circuit law because of the timely filing of a JMOL motion within 10 days from the entry of judgment. Schall dissented on the issue of jurisdiction.

***Prima Tek II, L.L.C., et al. v. Polypap, et al.* (No. 04-1411) (Gajarsa, Plager, Dyk)**

June 22, 2005 11:19 AM

(Dyk) Reversing judgment of infringement of patent directed to floral arrangements based on anticipation by prior art which was before the Patent Office. All of the claim limitations were expressly or inherently in the prior art.

***Checkpoint Systems, Inc. v. All-Tag Security S.A., et al.* (No.04-1395)(Michel, Schall, Dyk)**

June 20, 2005 1:42 PM

(Schall) Reversing summary judgment of invalidity for improper inventorship. Because the alleged true inventors submitted declarations to the PTO during prosecution saying that only one of them was the sole inventor, declarations submitted to the court in litigation saying that they were all joint inventors did not establish improper inventorship but an issue of fact as to whether they "lied to the PTO in 1988 or whether they are lying to the courts now."

***Upsher-Smith Laboratories v. PamLab* (No. 04-1505)(Michel, Rader, Schall)**

June 17, 2005 1:40 PM

(Rader) Affirming summary judgment of invalidity for anticipation and obviousness. "[A] prior art composition that 'optionally includes' an ingredient anticipates a claim for the same composition that expressly excludes that ingredient." A patent "cannot withdraw ... compositions from the public domain by explaining or purporting to claim the scientific underpinnings of their operation."

***Default Proof Credit Card System v. Home Depot* (No. 05-1069) (Michel, Lourie, Bryson)**

June 16, 2005 1:39 PM

(Michel) Affirming summary judgment of invalidity for indefiniteness, where the specification disclosed no structure corresponding to a means plus function limitation (despite expert testimony

to the contrary). A human being, and material incorporated by reference, cannot constitute such structure.

***Ultra-Precision Manufacturing v. Ford Motor Co. (No. 04-1329)(Mayer, Clevenger, Linn)***

June 15, 2005 1:36 PM

(Linn) Affirming summary judgment dismissing claim of joint inventorship and state law claim of unjust enrichment as preempted by federal patent law. "[F]ederal patent law generally precludes a plaintiff from recovering a royalty-like award premised on defendant's making, using, offering to sell, or selling an unpatented discovery after plaintiff makes the discovery available to the public," at least where the plaintiff did not give the defendant a benefit over and above the benefit received by the general public.

***Princeton Biochemicals, Inc. v. Beckman Coulter, Inc. (No. 04-1493) (Rader, Schall, Gajarsa)***

June 9, 2005 1:32 PM

(Rader) Affirming JMOL of invalidity for obviousness reversing a jury verdict. A motivation to combine references was found in the knowledge of those skilled in the art, based on the unrebutted opinion of an expert witness.

***Boss Control, Inc., et al. v. Bombardier, Inc., et al. (No. 04-1437) (Schall, Gajarsa, Prost)***

June 8, 2005 1:25 PM

(Prost) Affirming summary judgment of noninfringement. Because the specification "made clear" that a claim term had a "special definition," the patentee was bound by that narrower definition even though extrinsic evidence like a dictionary might support a broader definition. A party could not raise the doctrine of equivalents on appeal where it had not presented substantive arguments on the issue to the district court.

***Air Turbine Technology, Inc. v. Atlas Copco AB, et al. (No. 04-1387) (Lourie, Schall, Prost)***

June 7, 2005 1:24 PM

(Schall) Affirming judgment against patent infringement and state law claims and denial of new trial on the patent claim. The district court did not abuse its discretion in excluding testimony of a named inventor of the asserted patent about the accused products as "improper expert testimony."

***Purdue Pharma L.P., et al. v. Endo Pharmaceuticals, Inc., et al. (No. 04-1189) (Gajarsa, Plager, Linn)***

June 7, 2005 1:22 PM

(Plager) Affirming judgment of patent unenforceability because of inequitable conduct. It was inequitable conduct to represent to the PTO in support of patentability that it was "surprisingly discovered" that the "results" of the claimed composition and method were improved over the prior art without telling the PTO that the "discovery" and "results" (even if true) were the product of the

inventor's "insight" and not actual clinical results. The patentee's "arguments to the PTO provide enough of a suggestion that clinical trials had been performed that failure to tell the PTO the discovery was based on [the inventor's] insight and not scientific proof was a failure to disclose material information."

***Medimmune, Inc. v. Centocor, Inc., et al.* (No. 04-1499) (Schall, Bryson, Gajarsa)**

June 1, 2005 1:17 PM

(Schall) Reaffirming Gen-Probe Inc., v. Vysis, Inc., holding that a licensee who continues to pay royalties and otherwise perform under its license cannot sue the patentee for a declaratory judgment that the patent is not infringed or invalid.