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Federal Circuit Patent Updates - June 2010

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Therasense Inc. v. Becton, Dickinson and Co. [order] (2008-1511, -1512, -1513, -1514, -1595 and 2009-1374) (6/3/10)

June 11, 2010 12:25 PM

Oral arguments en banc for Therasense Inc. v. Becton, Dickinson and Co. and TiVo Inc. v. EchoStar Corp. are scheduled for Tuesday, November 9, 2010.

In Therasense, the Court has posed the following questions regarding inequitable conduct: (1) Should the materiality-intent-balancing framework be modified or replaced? (2) If so, how? In particular, should the standard be tied directly to fraud or unclean hands? If so, what is the appropriate standard for fraud or unclean hands? (3) What is the proper standard for materiality? What role should the PTO's rules play in defining materiality? Should a finding of materiality require that but for the alleged misconduct, one or more claims would not have issued? (4) Under what circumstances is it proper to infer intent from materiality? (5) Should the balancing inquiry (balancing materiality and intent) be abandoned? (6) Whether the standards for materiality and intent in other federal agency contexts or at common law shed light on the appropriate standards to be applied in the patent context?

In TiVo, the Court has posed the following questions: a) Following a finding of infringement by an accused device at trial, under what circumstances is it proper for a district court to determine infringement by a newly accused device through contempt proceedings rather than through new infringement proceedings? What burden of proof is required to establish that a contempt proceeding is proper? b) How does "fair ground of doubt as to the wrongfulness of the defendant's conduct" compare with the "more than colorable differences" or "substantial open issues of infringement" tests in evaluating the newly accused device against the adjudged infringing device? c) Where a contempt proceeding is proper, (1) what burden of proof is on the patentee to show that the newly accused device infringes and (2) what weight should be given to the infringer's efforts to design around the patent and its reasonable and good faith belief of noninfringement by the new device, for a finding of contempt? d) Is it proper for a district court to hold an enjoined party in

contempt where there is a substantial question as to whether the injunction is ambiguous in scope?

WilmerHale represents TiVo in the appeal.

A full version of the text is available here.

Advanced Magnetic Closures v. Rome Fastener **(Rader, Archer, Gajarsa)**

June 11, 2010 12:21 PM

(Gajarsa, J.) Affirming holding of unenforceability based on inequitable conduct and award of attorney's fees and costs. Also reversing sanction against attorney under 28 U.S.C. §1927. Fabricated evidence and contradictory testimony supported finding of intent to deceive the PTO. Attorney's fee award affirmed because plaintiff failed to argue that district court's award based on litigation conduct was improper and the district court relied on litigation misconduct as an independent ground. Rader, J. concurred, stating "I write separately to express my view that, absent extreme facts such as those found in the present case, this court should refrain from resolving inequitable conduct cases until it addresses the issue en banc" in Therasense Inc. v. Becton, Dickinson and Co.

A full version of the text is available here.

TriMed, Inc. v. Stryker Corp. **(Lourie, Linn, Moore)**

June 11, 2010 11:55 AM

(Linn, J.) Reversing summary judgment of invalidity, remanding, and reassigning to a different judge. "The district court has now been reversed twice after entering summary judgment against [patentee], in both instances simply signing [defendant's] proposed statement of law and facts . . . [W]e are convinced that reassigning this matter to a different judge is necessary to preserve the appearance of justice."

A full version of the text is available here.

Silicon Graphics, Inc. v. ATI Technologies, Inc. **(Rader, Lourie, Prost)**

June 11, 2010 11:48 AM

(Rader, J.) Affirming summary judgment of non-infringement of some claims relating to computer graphics. Also vacating summary judgment of non-infringement of other claims and remanding due to the district court's incorrect claim construction and interpretation of a license. Regarding the license, the district court incorrectly concluded that the accused chips could not infringe apparatus claims unless they are used with a licensed operating system. "Even if the products cannot [perform claimed functions] absent an operating system, they may include [circuits] for doing so. If they do, they infringe separate and apart from the operating system . . ." Also affirming ruling that defendant waived or abandoned its invalidity counterclaims on any claims defendant failed to litigate through trial. "It is a claimant's burden to keep the district court clearly apprised of what

parts of its claim it wishes to pursue and which parts, if any, it wishes to reserve for another day. . . To be clear, although this court is vacating the district court's non-infringement ruling on [some claims, defendant] is nevertheless precluded from relitigating its invalidity counterclaims with respect to those claims."

A full version of the text is available here.

Haemonetics, Corp. v. Baxter Healthcare Corp. **(Lourie, Gajarsa, Moore)**

June 11, 2010 11:40 AM

(Lourie, J.) Reversing claim construction and vacating grant of JMOL that claim relating to centrifuge device for separating red blood cells is not indefinite. Also vacating verdict of no invalidity and award of remedies and remanding. "[W]e do not redraft claims to contradict their plain language in order to avoid a nonsensical result."

A full version of the text is available here.