
Federal Circuit Patent Updates - June 2011

JUNE 30, 2011

[View previous month...](#)

***SPECTRALYTICS, INC. V. CORDIS CORP.* (2009-1564, 2010-1004, 6/13/11) (Newman, Clevenger, Bryson)**

June 13, 2011 10:26 AM

Newman, J. Affirming award of a 5-percent royalty rate for infringement of a patent related to a laser cutting apparatus for producing coronary stents. Also vacating denial of enhanced damages and attorney fees and remanding for redetermination of those issues. Also affirming denial of a motion for JMOL for obviousness.

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

***Microsoft Corp. v. i4i Limited Partnership* (No. 10-290, 6/9/11)**

June 9, 2011 10:04 AM

Sotomayor, J., affirmed. The issue was whether the standard to prove the invalidity of a patent in litigation, under 35 U.S.C. 282, is always clear-and-convincing evidence, as the Federal Circuit has long held, or instead -- as Microsoft urged -- a preponderance of the evidence or some combination of the two standards. The case arose from i4i's infringement lawsuit against Microsoft, which resulted in a finding of willful infringement, a rejection of Microsoft's invalidity defense, and a \$290 million judgment against Microsoft. When certiorari was granted, there was widespread expectation that the Court may reverse the Federal Circuit's judgment. Instead, the Court unanimously upheld the clear-and-convincing-evidence standard. (Chief Justice Roberts was recused, and Justice Thomas concurred only in the judgment.) The Court agreed with i4i that in enacting 35 U.S.C. 282 in 1952, Congress codified pre-1952 Supreme Court decisions that had adopted the clear-and-convincing-evidence standard. The Court rejected Microsoft's narrower reading of those pre-1952 cases, as well as Microsoft's other statutory-interpretation and policy arguments.

WilmerHale represented the respondents, i4i Limited Partnership et al.

SIEMENS MEDICAL SOLUTIONS USA, INC. V. SAINT-GOBAIN CERAMICS & PLASTICS, INC.
[ORDER] (2010-1145, -1177, 6/7/11) (Rader, Lourie, Newman, Linn, Moore, O'Malley, Dyk, Gajarsa, Prost)

June 7, 2011 10:18 AM

Per Curiam. Denying petitions for rehearing and rehearing en banc. The burden of proving infringement under the doctrine of equivalents is not increased where the accused product is separately patented. Dyk, J., Gajarsa, J., and Prost, J. dissented.

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

BOSTON SCIENTIFIC CORP. V. JOHNSON & JOHNSON (2010-1230, -1231, -1233, -1234, 6/7/11)
(Bryson, Gajarsa, Moore)

June 7, 2011 10:15 AM

Moore, J. Affirming summary judgment of invalidity due to lack of written description. The claims related to use of macrocyclic lactone analogs with a drug-eluting coronary stent, but the specification did not disclose such analogs. "While a small number of such analogs were known in the prior art, the claims cover tens of thousands of possible macrocyclic lactone analogs. With no guidance at all in the specification as to how to properly identify or choose the claimed analogs, and in light of the unpredictability and nascent state of using drug-eluting stents to treat restenosis, we agree with the district court that appellants have failed to create genuine issues of material fact." The Court also stated that although "examples are not always required to satisfy the written description requirement, the lack of any disclosure of examples may be considered when determining whether the claimed invention is adequately described." Gajarsa, J. concurred-in-part.

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

IN RE KLEIN (2010-1411, 6/6/11) (Newman, Schall, Linn)

June 6, 2011 10:12 AM

Schall, J. Reversing Board decision of obviousness and remanding. The claim at issue related to a nectar mixing apparatus with a movable divider for mixing water and sugar in ratios that are selectable by the user. The prior art references relied upon by the Board were not in an analogous art. Some of the references related to containers for separating contents rather than mixing them. Other references related to containers for mixing separated substances but only in a fixed ratio and not with a movable divider.

WilmerHale represented appellant, Arnold G. Klein.

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

Board of Trustees of the Leland Stanford Junior University v. Roche Molecular Systems, Inc.

(No. 09-1159, 6/6/11)

June 6, 2011 8:38 AM

Roberts, C.J. Affirming dismissal due to lack of standing. Patentee lacked standing because defendant possessed an ownership interest in the patents-in-suit. “Since 1790, the patent law has operated on the premise that rights in an invention belong to the inventor. The question here is whether the University and Small Business Patent Procedures Act of 1980—commonly referred to as the Bayh-Dole Act—displaces that norm and automatically vests title to federally funded inventions in federal contractors. We hold that it does not.” The inventor, patentee’s employee, signed an agreement stating that he “‘agree[d] to assign’ to [patentee] his ‘right, title and interest in’ inventions resulting from his employment.” While remaining the patentee’s employee, the inventor subsequently conducted research at defendant’s predecessor and signed an agreement stating that he “‘will assign and do[es] hereby assign’ to [defendant’s predecessor] his ‘right, title and interest in each of the ideas, inventions and improvements’ made ‘as a consequence of [his] access’ to [defendant’s predecessor].” The patentee later applied for and obtained the patents-in-suit and asserted them against the defendant. The inventor’s initial agreement with patentee constituted a “mere promise to assign rights in the future.” The inventor’s subsequent agreement with defendant was an effective assignment of rights. Patentee argued that the inventor had no rights to assign to defendant’s predecessor because patentee’s research was federally funded and the Bayh-Dole Act therefore conferred ownership on the patentee. The Court disagreed stating that the “Bayh-Dole Act does not confer title to federally funded inventions on contractors or authorize contractors to unilaterally take title to those inventions; it simply assures contractors that they may keep title to whatever it is they already have.”

WilmerHale represented respondents, Roche Molecular Systems, Inc., Roche Diagnostics Corporation, and Roche Diagnostics Operations, Inc.

ADVANCED SOFTWARE DESIGN CORP. V. FISERV, INC. (2009-1585, 2010-1011, 6/2/11)
(Bryson, Dyk, Prost)

June 2, 2011 10:09 AM

Bryson, J. Reversing summary judgment of non-infringement of patent related to check-security product. Also vacating summary judgment of no inducement and reversing claim construction. All parties agreed that a claim’s preamble contained encrypting and printing steps that limited the claim. However, those limitations “limit only the claimed environment, not the claimed method or system.”

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

KIMBERLY-CLARK WORLDWIDE, INC. V. FIRST QUALITY BABY PRODUCTS, LLC. (2010-1382, 6/1/11) (Dyk, Friedman, Prost)

June 1, 2011 10:29 AM

Prost, J. Affirming decision to grant a preliminary injunction for one patent. Also vacating grant of preliminary injunction for other patents.

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