WILMERHALE

Federal Circuit Patent Updates - March 2007

MARCH 31, 2007

View previous month...

Teva Pharmaceuticals USA, Inc. v. Novartis Pharmaceuticals Corporation, et al. **(No. 06-1181) (Mayer, Friedman, Gajarsa)**

March 30, 2007 1:22 PM

(Gajarsa) In ANDA case, reversing dismissal of declaratory judgment action for lack of subject matter jurisdiction. Jurisdiction existed over patents listed in the Orange Book on which the patentee did not sue during the 45 days after the filing of a Paragraph IV certification when it did sue on one listed patent.

Merck & Co., Inc. v. HI-TECH Pharmacal Co., Inc. **(No. 06-1401) (Linn, Friedman, Plager)**

March 29, 2007 1:17 PM

(Linn) "This case presents the question of whether a patent term extension under the Hatch-Waxman Act, 35 U.S.C. § 156, may be applied to a patent subject to a terminal disclaimer under 35 U.S.C. § 253, filed to overcome an obviousness-type double patenting rejection. Because the language of § 156 is unambiguous and fulfills a purpose unrelated to and not in conflict with that of § 253, we hold that a Hatch-Waxman term extension may be so applied."

Sandisk Corp. v. Stmicroelectronics, Inc., et al. **(No. 05-1300) (Bryson, Linn, Dyk)**

March 26, 2007 12:52 PM

(Linn) Reversing dismissal for lack of subject matter jurisdiction over declaratory judgment action. "Reasonable apprehension" of suit is not required to maintain jurisdiction. "In the context of conduct prior to the existence of a license, declaratory judgment jurisdiction generally will not arise merely on the basis that a party learns of the existence of a patent owned by another or even perceives such a patent to pose a risk of infringement, without some affirmative act by the patentee. But Article III jurisdiction may be met where the patentee takes a position that puts the declaratory judgment plaintiff in the position of either pursuing arguably illegal behavior or abandoning that which he claims a right to do. We need not define the outer boundaries of

declaratory judgment jurisdiction, which will depend on the application of the principles of declaratory judgment jurisdiction to the facts and circumstances of each case." Bryson dissented.

Pfizer, Inc. v. Apotex, Inc. **(formerly known as TorPharm, Inc.) (No. 06-1261) (Michel, Mayer, Linn)**

March 22, 2007 12:47 PM

(Michel) In ANDA case, reversing district court judgment that claims directed to particular salt form or previously patented compound were valid. Motivation to combine "gleaned not only from the prior art as a whole . . . but also from the nature of the problems encountered" with prior art formulations. "Undue dependence on mechanical application of a few maxims of law, such as "obvious to try," that have no bearing on the facts certainly invites error as decisions on obviousness must be narrowly tailored to the facts of each individual case." All "prima facia obviousness" "means is that even though a patentee never must submit evidence to support a conclusion by a judge or jury that a patent remains valid, once a challenger introduces evidence that might lead to a conclusion of invalidity-what we call a prima facie case-the patentee "would be well advised to introduce evidence sufficient to rebut that of the challenger." Also holding that claim of inequitable conduct did not need to be addressed in light of holding of obviousness.

Liebel-Flarsheim Company, et al. v. Medrad, Inc. **(No. 06-1156) (Lourie, Rader, Bryson)**

March 22, 2007 12:44 PM

(Lourie) Affirming summary judgment that patents directed to syringe were invalid as not enabled and anticipated. Although the asserted claims did not include a "pressure jacket" limitation, the specification did not enable the use of a syringe without a pressure jacket and therefore the full scope of the claims was not enabled. Also affirming dismissal of inequitable conduct counterclaim as moot where appellee admitted at oral argument that relief of unenforceability was "not meaningful" at this time and that, although it planned to file an application for attorneys fees based on inequitable conduct, it had not yet done so.

eSpeed, Inc., et al. v. Brokertec USA, L.L.C., et al. **(No. 2006-1385) (Linn, Dyk, Moore)**

March 20, 2007 12:41 PM

(Moore) Affirming judgment of unenforceability because of inequitable conduct. Belated disclosure of a previously withheld prior art device in a "blizzard of paper" together with a declaration falsely describing the device was inequitable conduct.

Cross Medical Products, Inc. v. Medtronic Sofamor Danek, Inc., et al. **(No. 05-1415) (Rader, Schall, Prost)**

March 20, 2007 11:27 AM

(Per Curiam) Reversing and vacating summary judgment of infringement. The doctrine of equivalents was not available because of prosecution history estoppel. "[T]he tangential relation criterion for overcoming the Festo presumption is very narrow ...." Rader concurs.

Cellco Partnership (doing business as Verizon Wireless) v. Broadcom Corp. **(No. 2006-1514) (Mayer, Plager, Prost)**

March 19, 2007 1:33 PM

(Per Curiam) Affirming dismissal of a declaratory judgment action. Although the district court erred in light of MedImmune in relying upon no reasonable apprehension of suit in finding no actual controversy, the district court had "substantial" discretion not to hear the case over which it had jurisdiction.

In *re Arnold B. Serenkin* (No. 06-1242) (Lourie, Schall, Gajarsa)

March 6, 2007 11:12 AM

(Lourie) Affirming rejection of reissue application. An 'error" of choosing a later filing date during prosecution of the PCT application in exchange for inclusion of missing drawings is not correctable in a 35 USC 251 reissue proceeding.

Sawgrass Technologies, Inc. v. Texas Original Graphics, Inc., et al. **(No. 06-1190) (Rader, Archer, Prost)**

March 2, 2007 1:30 PM

(Rader) Dismissing appeal because the CAFC does not have jurisdiction to review an interlocutory order transferring venue (not entered to cure jurisdiction) before a final judgment.

Walter Kidde Portable Equipment, Inc. v. Universal Security Instruments, Inc. **(No. 2006-1420) (Gajarsa, Moore, Jordan)**

March 2, 2007 11:10 AM

(Jordan) Affirming dismissal of complaint without prejudice and without conditions over the defendant's objections. Although dismissal of the defendant's counterclaims at the same time was error, that error was harmless where the defendant could assert the counterclaims in another pending suit.

In *re Princo Corporation, et al.* (Misc. No. 841) (Bryson, Linn, Dyk)

March 1, 2007 11:02 AM

(Dyk) Granting writ of mandamus staying district court action until related proceedings before the US International Trade Commission, including all appeals, become final (meaning "no longer subject to judicial review").