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Lawman Armor Corp. v. Winner International, LLC, et al. **(05-1253) (Michel, Friedman, Dyk)**

May 31, 2006 9:54 AM

(Friedman) Denying petition for panel rehearing and rehearing en banc, but the panel issued a Supplemental Opinion saying that "[i]n our [original] decision, we did not intend to cast any doubt upon our prior decisions indicating that in appropriate circumstances a combination of design elements itself may constitute a 'point of novelty' " in a design patent, but that "appearance of a design cannot itself be a point of novelty." Rehearing en banc was denied in a separate order Lawman Armor Corp. v. Winner International, LLC, et al., from which Newman, joined by Rader and Gajarsa, dissented.

Falko-Gunter Falkner, et al. v. Inglis, et al. **(No. 05-1324) (Gajarsa, Archer, Dyk)**

May 26, 2006 9:52 AM

(Gajarsa) Affirming judgment in an interference. To meet the written description and enablement requirements, examples, actual reduction to practice, and recitation of know structure were not required.

Applied Medical Resources v. United States Surgical **(No. 05-1314) (Gajarsa, Dyk, Prost)**

May 15, 2006 9:47 AM

(Prost) Vacating summary judgment of noninfringement. "A court errs when it improperly imports unclaimed functions into a means-plus-function limitation. First, this can occur during claim construction by defining a claimed function to require more than is actually claimed. Second, the error can occur during infringement analysis if the court improperly determines the way in which the disclosed structure performs the previously-defined function. In this step, the inquiry should be restricted to the way the structure performs the properly-defined function and should not be influenced by the manner in which the structure performs other, extraneous functions." (citation omitted) Expert testimony on structural equivalents created a genuine issue of material fact. Dyk

dissents.

Inpro II Licensing, S.A.R.L. v. T-Mobile USA, et al. **(No. 05-1233) (Newman, Dyk, Prost)**

May 11, 2006 9:31 AM

(Newman) Affirming summary judgment of noninfringement. The district court correctly construed a claim term narrowly in light of the patent specification that, among other things, referred to "a very important feature" of the invention. Also upholding the district court's exclusion of expert testimony on the issue of claim construction. Newman also wrote to express additional views.

eBay Inc. v. MercExchange, L. L. C.

May 11, 2006 9:24 AM

(Thomas) The Court vacated and remanded, holding that the traditional "four factor" test for permanent injunctions applied in patent cases and that neither the district court nor the Court of Appeals applied the test correctly. The Court took no view on whether an injunction should enter in the case. Chief Justice Roberts, joined by Justice Scalia and Justice Ginsburg, concurred in a separate opinion. Justice Kennedy, joined by Justices Stevens, Souter and Breyer, also concurred separately. WilmerHale represented the Respondent MercExchange.

In *re EchoStar Communications Corporation* [Order] (Schall, Gajarsa, Prost)

May 11, 2006 9:22 AM

(Gajarsa) Petition for mandamus granted concerning the scope of a waiver of the attorney-client privilege in defense to a claim of willfulness (applying Federal Circuit law). Production of in-house counsel's opinion was a waiver of privilege and not simply reliance on an "in-house investigation supervised by in-house counsel." Scope of waiver extended to work product of outside counsel to the extent it included (i) "documents that embody a communication between the attorney and client concerning the subject matter of the case, such as a traditional opinion letter" or (ii) "documents that discuss a communication between attorney and client concerning the subject matter of the case but are not themselves communications to or from the client." However, waiver did not extend to "documents analyzing the law, facts, trial strategy, and so forth that reflect the attorneys mental impressions but were not given to the client." Waiver extends to time period after litigation commences. "[W]hen an alleged infringer asserts its advice-of-counsel defense regarding willful infringement of a particular patent, it waives its immunity for any document or opinion that embodies or discusses a communication to or from it concerning whether that patent is valid, enforceable, and infringed by the accused."