
Federal Circuit Patent Updates - May 2009

MAY 31, 2009

[View previous month...](#)

Paragon Solutions, LLC. v. Timex Corp. (No. 2008-1516)(Bryson, Linn, Moore)

May 22, 2009 9:36 AM

(Linn) Vacating judgment of noninfringement in light of an erroneously narrow claim construction. A "real time" claim limitation did not require "instantaneous" action but did require no "intentional delay." "Absent an express limitation to the contrary, any use of a device that meets all the limitations of an apparatus claim written in structural terms infringes that apparatus claim. ... Construing a non-functional term in an apparatus claim in a way that makes direct infringement turn on the use to which an accused apparatus is later put ... is inconsistent with the notice function central to the patent system."

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

In Re Volkswagen of America, Inc. [order] (No. Misc. 897) (Gajarsa, Friedman, Linn)

May 22, 2009 9:32 AM

(Linn) Denying mandamus to transfer from the E.D. Tex. "In this case, the existence of multiple lawsuits involving the same issues is a paramount consideration"

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

In Re Genentech, Inc. [order] (No. Misc. 901) (Michel, Friedman, Linn)

May 22, 2009 9:26 AM

(Linn) Granting mandamus to transfer from the E.D. Tex. In denying transfer, the district court erred in evaluating the convenience to witnesses and other factors. The fact that the party moving to transfer had itself previously commenced suit in the E.D. Tex. was not relevant to the transfer inquiry.

A full version of the decision is available

[here](#).

***Epistar Corp. v. International Trade Commission* (No. 2007-1457) (Rader, Archer, Dyk)**

May 22, 2009 9:21 AM

(Rader) Affirming in part, but reversing holdings of estoppel to argue invalidity in light of a prior settlement agreement and extending a limited exclusion order to parties not named in the case. "A patentee's discussion of the shortcomings of certain techniques is not a disavowal of the use of those techniques in a manner consistent with the claimed invention."

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

***CoreBrace, LLC. v. Star Seismic LLC* (No. 2008-1502) (Lourie, Friedman, Prost)**

May 22, 2009 9:15 AM

(Lourie) Affirming dismissal of claims for breach of license agreement and infringement. In a patent license, '[t]he right to 'make, use, and sell' a product inherently includes the right to have it made by a third party, absent a clear indication of intent to the contrary."

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

***Linear Technology Corp. v. International Trade Commission* (No. 2008-1117) (Mayer, Lourie, Schall)**

May 21, 2009 9:12 AM

(Schall) Affirming-, reversing-, and vacating-in-part and remanding issues of infringement and invalidity. Claim limitations of "second circuit" and "third circuit" did "not require entirely separate and distinct circuits," and a "second control signal" did not need to "be entirely distinct" from a "first control signal."

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

***Erbe Elektromedizin GMBH v. International Trade Commission* (No. 2008-1358) (Michel, Rader, Dyk)**

May 19, 2009 9:09 AM

(Dyk) Affirming finding of no contributory or induced infringement where there was no evidence of direct infringement by third parties under the correct claim construction.

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

***Autogenomics, Inc. v. Oxford Gene Tech. Ltd.* (2008-1217) (Newman, Moore, Gettleman [of the N.D. of Illinois, sitting by designation])**

May 18, 2009 1:43 PM

(Moore) Affirming dismissal for lack of personal jurisdiction. “Our holding in *Avocent* was that only enforcement or defense efforts related to the patent rather than the patentee’s own commercialization efforts are to be considered for establishing specific personal jurisdiction in a declaratory judgment action against the patentee.” Also, the “district court did not abuse its discretion by denying jurisdictional discovery.” Newman dissented.

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

***Abbott Laboratories v. Sandoz, Inc.* (No. 2007-1400)(Rader, Plager, Bryson, and en banc in part)**

May 18, 2009 9:05 AM

(Rader) Affirming summary judgment of noninfringement and denial of a preliminary injunction. In an en banc portion of the opinion, holding that product-by-process claims are limited by their process terms. Three judges dissented.

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

***Altana Pharma Ag v. Teva Pharmaceuticals USA, Inc.*(2008-1039) (Newman, Gajarsa, Ward [of the E.D. of Texas, sitting by designation])**

May 14, 2009 1:38 PM

(Ward) Affirming denial of preliminary injunction. “An appellant carries a heavier burden when seeking to reverse the denial of a preliminary injunction than seeking to reverse the grant of a preliminary injunction.” The district court’s preliminary finding that defendants raised a substantial question of invalidity was not clearly erroneous. Newman concurred.

WilmerHale represented the plaintiff-appellants, Atlanta Pharma AG and Wyeth.

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

***The Procter & Gamble Co. v. Teva Pharmaceuticals USA, Inc.* (2008-1404, -1405, -1406) (Mayer, Dyk, Huff [of the S.D. of California, sitting by designation])**

May 13, 2009 1:33 PM

(Huff) Affirming judgment that patent directed to the active ingredient in an osteoporosis drug is not invalid. The claimed compound and a prior art compound are positional isomers, they each contain the same atoms arranged in different ways. The district court's findings indicated though "that there was no reasonable expectation in 1985 that [the claimed compound] would be a successful compound." Also, the "only direct evidence that the structural modification [required to make the claimed compound] was routine was presented by an expert witness that the district court judge discredited." The patent was also not invalid for double patenting.

WilmerHale represented the plaintiff-appellee, The Procter & Gamble Company.

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

In Re Fallaux (2008-1545) (Schall, Archer, Moore)

May 6, 2009 1:27 PM

(Moore) Affirming rejection for obviousness-type double patenting. The examiner rejected claims under the one-way test but agreed the claims would have survived under the two-way test. "[T]he applicant is entitled to the narrow exception of the two-way test when the PTO is at fault for the delay that causes the improvement patent to issue prior to the basic patent." Substantial evidence supported the Board's finding that the applicant, not the PTO, was responsible for the delay. In a footnote, the Court noted that neither party challenged the PTO rule that a reference can be used for an obviousness-type double patenting rejection even if it shares only a common inventor with the application rather than an identical inventive entity. The Court stated that the "opinion should not be read to decide or endorse the PTO's view on this issue."

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