
Federal Circuit Patent Updates - November 2006

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Amgen Inc. v. Hoechst Marion Roussel, Inc. (now known as Aventis Pharmaceuticals Inc.)
[order] (No. 05-1157)

November 22, 2006 8:41 AM

Order denying rehearing and rehearing en banc. Michel, Rader, Newman, and Moore dissent. Lourie, Gajarsa, Linn, and Dyk concur. Several judges say the Court should reconsider its rule of de novo review of claim construction.

Highway Equipment Company, Inc. v. Feco, LTD, et al. (No. 05-1547) (Schall, Linn, Dyk)

November 21, 2006 8:39 AM

(Linn) Affirming determination of no inequitable conduct and no litigation misconduct, vacating judgment of state law claim, and remanding with instructions to dismiss state law claim for lack of jurisdiction. Filing a covenant not to sue on the eve of trial did not preclude the district court from hearing defendant's request for attorney fees under 35 U.S.C. §285.

Impax Laboratories, Inc. v. Aventis Pharmaceuticals, Inc. (No. 05-1313) (Rader, Schall, Prost)

November 20, 2006 8:36 AM

(Schall) Affirming decision of no inequitable conduct for patent directed to method of treating ALS, vacating decision of no anticipation, and remanding. Selective citation of test results to the PTO did not evidence intent to deceive. Proof "of efficacy is not required for a prior art reference to be enabling for purposes of anticipation."

Depuy Spine, Inc. (formerly known as Depuy Acromed, Inc.), et al. v. Medtronic Sofamor Danek, Inc. (formerly known as Sofamor Danek Group, Inc.), et al. (No. 05-1311) (Newman, Linn, Prost)

November 20, 2006 8:31 AM

(Linn) Reversing summary judgment of non-infringement for some products, affirming summary judgments of infringement and non-infringement for other products, and affirming denial of JMOL regarding lost profit damages award for patent directed to devices used in spinal surgery. The claim term "compression member" was not a means-plus-function limitation. The district court "erred in concluding that no reasonable jury could find the conically-shaped portion to be an equivalent to the 'spherically-shaped' limitation." The Court's decision in *Tronzo v. Biomet, Inc.*, "does not stand for the proposition that a claim limitation describing a specific shape of a claimed structure cannot be infringed under the doctrine of equivalents by a differently shaped structure." The "pressed against the hollow spherically-shaped portion" claim limitation was satisfied by a screw head pressing "against all or any part of that portion - including the edge."

***PHG Technologies, LLC v. St. John Companies, Inc.* (No. 06-1169) (Michel, Dyk, Prost)**

November 17, 2006 8:28 AM

(Prost) Vacating preliminary injunction because of substantial questions as to invalidity of design patents directed to medical label sheet. Patentee did not meet its burden for showing likelihood of success on the merits. Defendant raised substantial question as to whether patented design was primarily ornamental.

***Optivus Technology, Inc., et al. v. Ion Beam Applications S.A.* (No. 05-1518) (Bryson, Archer, Linn)**

November 16, 2006 8:27 AM

(Linn) Affirming summary judgment of invalidity and non-infringement of patents directed to use of proton beams in cancer therapy. Also, reversing summary judgment of Lanham Act claim, reversing dismissal of state law claim, and affirming summary judgment of other state law claims.

***Abraxis Bioscience v. Mayne Pharma* (No. 06-1118) (Lourie, Plager, Rader)**

November 15, 2006 8:25 AM

(Lourie) Affirming judgment of infringement under the doctrine of equivalents but reversing judgment of literal infringement of patent directed to anesthetic formulation. The patent defined the claim term "edetate" stating, "By the term 'edetate', we mean [EDTA] and derivatives thereof . . ." However, the further statement in the patent that "edetate, which is not regarded as a broad spectrum antimicrobial agent was the only agent that would meet our requirements" indicated that the term "derivatives" was not intended to extend broadly. District court's construction of "edetate" erroneously included structural analogs of EDTA.

***02 Micro International v. Monolithic Power Systems* (No. 06-1064) (Michel, Dyk, Prost)**

November 15, 2006 8:24 AM

(Dyk) Affirming summary judgment of non-infringement. Establishing "good cause" for amending final infringement contentions per the Northern District of California's local rules for patent cases requires a showing of diligence. Patentee who did not file amended infringement contentions until

almost three months after discovering relevant information failed to establish the required diligence.

Abbott Laboratories, et al. v. Baxter Pharmaceutical Products, Inc., et al. (No. 06-1021) (Bryson, Archer, Gajarsa)

November 9, 2006 8:20 AM

(Gajarsa) Reversing judgment after bench trial and finding claims directing to anesthetic anticipated. The prior art inherently had the characteristics of the claimed invention and anticipated even though the art was unaware of the beneficial properties of the invention.