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Federal Circuit Patent Updates - October 2005

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Sorensen, et al. v. International Trade Commission, et al. **(No. 05-1020)(Michel, Rader, Linn)**

October 31, 2005 3:14 PM

(Rader) Vacating finding of noninfringement. The Commission construed a claim limitation too narrowly, erroneously concluding that the prosecution history disavowed broad claim language.

Callicrate v. Wadsworth Manufacturing, Inc. **(No. 04-1597) (Newman, Rader, Prost)**

October 31, 2005 3:12 PM

(Rader) Reversing jury verdict of noninfringement, anticipation, and obviousness. There was no basis for the jury to find noninfringement where the defendant admitted infringement (even in light of the district court's errors in claim construction). When the patent in suit was given the correct priority date, the art found to anticipate and render obvious was not prior art. "[A] patent specification may sufficiently enable a feature under section 112, paragraph 1, even if only the background section provides the enabling disclosure. ...[D]isparaging remarks in a background section or remarks characterizing the prior art as less effective do not remove those disclosures as enabling references."

Sicom Systems LTD. v. Agilent Technologies, Inc., et al. **(No. 05-1066) (Mayer, Rader, Prost)**

October 18, 2005 3:10 PM

(Prost) Affirming dismissal of infringement claim because the plaintiff-licensee lacked all substantial rights in the patent, and therefore had no standing to sue. Even where the licensee had the exclusive right to sue for "commercial" infringement, the licensee lacked standing to sue where the patent owner retained other substantial rights.

Medimmune, Inc. v. Genentech, Inc., et al. **(No. 04-1300) (Newman, Mayer, Clevenger)**

October 18, 2005 3:07 PM

(Newman) Affirming dismissal of declaratory judgment suit by licensee against patentee and summary judgment dismissing the licensee's antitrust and unfair competition claims arising out of an interference settlement and patent prosecution. Because the licensee continued to comply fully with the license terms, there was no case of actual controversy to support declaratory judgment jurisdiction. Clevenger, dissents in part, saying the the appeal of the antitrust and unfair competition claims should have been transferred to the regional circuit.

Invitrogen Corp. v. Biocrest Manufacturing, L.P., et al. **(No. 04-1273) (Rader, Dyk, Prost)**

October 5, 2005 3:05 PM

(Rader) Affirming summary judgment that claims to method of transforming E. coli was infringed and that the claims were not invalid, while reversing judgment that claims were invalid under 35 U.S.C. 102(b). "The proper test for the public use prong of the § 102(b) statutory bar is whether the purported use: (1) was accessible to the public; or (2) was commercially exploited." Secret use of cells did not satisfy public use requirement.

Novo Nordisk Pharmaceuticals, Inc., et al. v. Bio-Technology General Corp., et al. **(No. 04-1581) (Schall, Archer, Bryson)**

October 5, 2005 3:02 PM

(Schall) Affirming judgment that claim directed to human growth hormone was invalid as anticipated and that patent was unenforceable. Inequitable conduct was committed in course of convincing Examiner that patent was entitled to filing date of an earlier PCT application which enabled claimed invention where earlier application described prophetic example in past tense and patentee had not been able to make hormone using method in the example.

Lizardtech, Inc., et al. v. Earth Resource Mapping, Inc., et al. **(No. 05-1062) (Lourie, Schall, Bryson)**

October 4, 2005 3:00 PM

(Bryson) Affirming summary of judgment of non-infringement and invalidity of patents directed to compression of digital images. Generic claim invalidated as overbroad under enablement and written description requirement where only one way of performing claimed creation of "seamless array of DWT coefficients" was disclosed. Note that the challenged claim was in the original disclosure.

Union Carbide v. Shell Oil **(No. 04-1475) (Mayer, Rader, Prost)**

October 3, 2005 2:58 PM

(Rader) Affirming jury verdict of infringement of clams directed to catalyst while reversing refusal to include products made for export in damages base. Section 271(f) applies to method claims, i.e., sale of products for export which can be used to practice a claimed method can constitute an act of infringement. The infringement issue turned on whether an expert's testing was consistent with the patent's teachings.

***JVW Enterprises v. Interact Accessories* (No. 04-1410) (Michel, Schall, Prost)**

October 3, 2005 2:56 PM

(Prost) Affirming in part and reversing in part judgment that video game players infringed claims having §112,¶6 limitations. District court identified the incorrect function of one claim element. Another claim element was not satisfied equivalently by the accused device.