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Federal Circuit Patent Updates - October 2006

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Go Medical Industries PTY, LTD, et al. v. Inmed Corporation **(doing business as Rusch), et al. (No. 05-1241)(Michel, Archer, Linn)**

October 27, 2006 12:56 PM

(Michel) Affirming judgments of patent invalidity and on various non-patent claims but vacating reduced damages award for breach of contract. Patent was not entitled to an earlier priority application date because of a best mode violation and was, therefore, anticipated by intervening prior art.

Qualcomm Incorporated, et al. v. Nokia Corporation, et al. **(No. 2006-1317)(Newman, Schall, Prost)**

October 20, 2006 12:53 PM

(Prost) Vacating order denying motion to stay litigation pending arbitration in light of arbitration clause language in agreement.

Medrad, Inc. v. Tyco Healthcare Group LP, et al. **(No. 06-1082)(Michel, Archer, Linn)**

October 16, 2006 12:51 PM

(Linn) Reversing summary judgment of invalidity of reissue patent. The reissue statue, 35 USC 251, extends to reissues based on defects in inventor declarations.

Medtronic, Inc. v. Guidant Corporation, et al. **(No. 05-1515) (Michel, Schall, Dyk)**

October 12, 2006 12:49 PM

(Schall) Affirming judgment that reissue claims were not invalid for an improper recapture of surrendered subject matter. Although claims had been narrowed to exclude an embodiment originally covered in the original prosecution, this was not done deliberately; therefore, there was no surrender. There also was no surrender by argument. Dyk concurs in part and dissents in part.

Figueroa v. U.S. **(No. 05-5144) (Newman, Dyk, Prost)**

October 11, 2006 11:27 AM

(Dyk) Affirming summary judgment and dismissal of claims to recover fees paid to the PTO. The fees imposed by the PTO are not unconstitutional and are not an impermissible direct tax. Newman concurs.

DyStar Textilfarben GMBH & Co Deutschland KG v. C.H. Patrick, Co., et al. **(No. 06-1088) (Michel, Rader, Schall)**

October 3, 2006 11:24 AM

(Michel) Reversing judgment no invalidity and finding claims directed to dyeing textile materials obvious as a matter of law. Opinion discusses commentary related to the motivation to combine test and the KSR Int'l Co. v. Teleflex, Inc. case, now on appeal to the Supreme Court, and states "Indeed, we have repeatedly held that an implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the 'improvement' is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient." Asserted claims held obvious in view of combination of 80 years old references. Schall concurs.

AERO Products International, Inc., et al. v. INTEX Recreation Corp., et al. **(No. 05-1283) (Rader, Schall, Dyk)**

October 2, 2006 11:20 AM

(Schall) Affirming judgment of infringement and non-invalidity of patent directed to inflatable support systems, but vacating trademark infringement damages. Patent and trademark damages flowed from the same operative facts, sales of mattresses, and the award of trademark damages was impermissible double recovery. Dyk concurs.

SRAM Corp. v. AD-II Engineering, Inc. **(No. 05-1365) (Rader, Bryson, Linn)**

October 2, 2006 11:14 AM

(Linn) Vacating and remanding judgments of liability and no invalidity due to faulty claim construction of patent directed to bicycle gear shifter.