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Federal Circuit Patent Updates - October 2007

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Osram GMBH, et al. v. International Trade Commission **(No. 06-1282) (Newman, Rader, Dyk)**

October 31, 2007 3:10 PM

(Newman) Reversing claim construction and no violation of Section 337 with respect to patent directed to a wave-length converting composition. Dyk dissented.

A full version of the claim is available **here**.

Biomedical Patent Management Corporation v. State of California, Dept. of Health Services **(No. 06-1515) (Rader, Gajarsa, O'Malley)**

October 23, 2007 3:15 PM

(O'Malley) State that had intervened in an earlier, related action that was dismissed for improper venue did not waive sovereign immunity under the Eleventh Amendment in later related action.

A full version the decision is available **here**.

Paice, LLC v. Toyota Motor Corporation, et al. **(No. 2006-1610) (Lourie, Rader, Prost)**

October 18, 2007 10:08 AM

(Prost) Affirming jury verdict of infringement under the doctrine of equivalents but no literal infringement, but vacating order imposing ongoing royalty payment (after denial of a permanent injunction) for the limited purpose of reevaluating the amount of the royalty. "Under some circumstances, awarding an ongoing royalty for patent infringement in lieu of an injunction may be appropriate." However, "[i]n most cases, where the district court determines that a permanent injunction is not warranted, the district court may wish to allow the parties to negotiate a license among themselves regarding future use of a patented invention before imposing an ongoing royalty. Should the parties fail to come to an agreement, the district court could step in to assess a reasonable royalty in light of the ongoing infringement." Imposing an ongoing royalty did not violate

the parties' Seventh Amendment rights. Rader concurs, but says that the district court should be required to allow the parties to try to negotiate a future royalty rate before imposing one itself.

A full version of the decision is available **here**.

International Gamco, Inc., et al. v. Multimedia Games, Inc. **(No. 2007-1034) (Rader, Friedman, Moore)**

October 15, 2007 10:01 AM

(Rader) Exclusive field of use or enterprise licensees do not have standing to sue for infringement in their own names without joining the patentee. Friedman, S.J., dubitante.

A full version of the opinion is available **here**.

In re Translogic Technology, Inc. **(No. 2006-1192) (Mayer, Rader, Prost)**

October 12, 2007 9:47 AM

(Rader) Affirming rejection of claims in reexamination as obvious. The claim term "coupled to receive" meant "capable of receiving." "Obvious variants of prior art references are themselves part of the public domain."

A full version of the order is available **here**.

Schwarz Pharma, Inc., et al v. Paddock Laboratories, Inc. **(No. 2007-1074) (Michel, Lourie, Moore)**

October 12, 2007 9:43 AM

(Lourie) Affirming summary judgment of noninfringement. "[W]hen a patentee joins an exclusive licensee in bringing an infringement suit in a district court, the licensee does not lose standing to appeal even though the patentee does not join in the appeal." Prosecution history estoppel barred application of the doctrine of equivalents.

A full version of the summary judgment is available **here**.

Allvoice Computing PLC v. Nuance Communications, Inc. **(formerly known as ScanSoft, Inc.) (No. 2006-1440) (Newman, Rader, Gajarsa)**

October 12, 2007 9:37 AM

(Rader) Reversing summary judgment of invalidity based on alleged indefiniteness and best mode violation. There was sufficient structure described in the specification to correspond to a means-plus-function limitation, and the asserted undisclosed best mode did not relate to the claims at issue.

A full version of the summary judgment is available **here**.

***Abbott Laboratories v. Torpharm, Inc., et al.* (No. 2007-1019) (Michel, Dyk, Otero [of the C.D. Cal., sitting by designation])**

October 11, 2007 9:32 AM

(Michel) Reversing holding of contempt of injunction. Although the filing of a duplicative ANDA by or on behalf of the enjoined defendant was an act of infringement and the district court had discretion to make that determination in the context of a contempt proceeding, the injunction against the defendant did not clearly prohibit the infringing conduct at issue. Dyk concurs in part and dissents in part.

A full version of the opinion is available here.

***Nilssen, et al. v. Osram Sylvania, Inc., et al.* (2006-1550) (Mayer, Lourie, Linares [of the District of New Jersey, sitting by designation])**

October 10, 2007 9:29 AM

(Lourie) Affirming judgment of unenforceability of fifteen patents due to inequitable conduct. The inequitable conduct included submitting affidavits that failed to disclose the affiant's relationship with the inventor; making false priority claims; failing to disclose to the patent office litigation of patents pertaining to the same general subject matter of applications then being prosecuted; failing to disclose prior art; and improperly paying small entity instead of large entity maintenance fees.

A full version of the judgment is available **here**.

***Baum Research and Development Company, Inc., et al. v. University of Massachusetts at Lowell* (2006-1330) (Newman, Friedman, Moore)**

October 10, 2007 9:25 AM

(Newman) Affirming, on interlocutory review, ruling that state university waived its Eleventh Amendment immunity.

A full version of the decision is available here.

***Somerset Pharmaceuticals v. Dudas* (2007-1447) (Michel, Prost, Moore)**

October 4, 2007 9:19 AM

(Moore) Affirming denial of preliminary injunction. Patentee sought injunctive relief compelling the Director to grant a request for interim extension of the patent. Since the Director subsequently denied the patentee's request for extension, the Director has no statutory authority to issue the requested interim extension.

A full version of the decision is available **here**.

***Monsanto Co. v. Syngenta Seeds* (2006-1472) (Rader, Gajarsa, O'Malley [of the N.D. of Ohio, sitting by designation])**

October 4, 2007 9:16 AM

(Rader) Affirming summary judgment of non-infringement of two patents and finding of invalidity, due to lack of enablement, of a third patent relating to transgenic corn. Dependent claims were not infringed because the independent claim from which they depended was not infringed. Claim directed to gene "in plant cell" covered the gene in any plant cell, including monocots (plants in which initial development produces one leaf) and dicots (plants in which initial development produces two leaves). However, patent was filed before transformation of monocot cells was possible, those skilled in the art could not transform a monocot plant cell as of the filing date, and the claim was therefore not enabled.

A full version of the summary judgment is available **here**.