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Federal Circuit Patent Updates - September 2007

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In *Re AD-II Engineering, Inc.* [order] (Rader, Bryson, Linn)

September 28, 2007 10:19 AM

(Linn) Refusing to issue mandamus. Per an order from the district court, the patentee may assert a claim of the patent that was not asserted until after a remand from the Federal Circuit.

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

***IpVenture, Inc. v. ProStar Computer, Inc., et al.* (06-1012, -1081) (Newman, Lourie, Bryson)**

September 28, 2007 8:53 AM

(Newman) Vacating dismissal because inventor's prior employer did not have an ownership interest in the asserted patent and was not an indispensable party.

A full version of the opinion is available here.

In *Re David Buszard, et al.* (2006-1489) (Newman, Friedman, Prost)

September 27, 2007 8:30 AM

(Newman) Reversing Board decision on anticipation and remanding for completion of examination. Claim directed to a flame retardant that includes "a flexible polyurethane foam reaction mixture" is not anticipated by a reference that teaches a rigid foam and further teaches crushing the rigid foam to produce a flexible foam. Prost dissents.

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

***CIAS, Inc. v. Alliance Gaming Corporation, et al.* (2006-1342) (Newman, Schall, Moore)**

September 27, 2007 8:27 AM

(Newman) Affirming summary judgment of non-infringement of patent directed to detecting counterfeit objects.

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

Verizon Services Corp., et al. v. Vonage Holdings Corp., et al. **(2007-1240, -1251, -1274) (Michel, Gajarsa, Dyk)**

September 26, 2007 8:22 AM

(Dyk) Affirming judgments of infringement and non-obviousness and an injunction related to two patents, vacating judgment of infringement and an injunction related to a third patent, and vacating damage award in case relating to Voice over IP ("VoIP") technology. The court ordered a new trial regarding infringement of the third patent and, because the jury had failed to allocate damages between the three patents, also remanded for further consideration of damages. The court further held that any alleged error in the jury instructions, which required the jury to find a motivation to combine in order to find claims obvious, was harmless because the testimony regarding obviousness centered on a single reference. Also, although not at issue in this case, the Court noted that whether defendant should be allowed time to implement a "workaround that would avoid continued infringement" is a factor that should be considered in an injunction analysis. Michel dissenting in part would have found the jury instruction on obviousness to be correct and would have affirmed the damage award. Gajarsa concurs in part and dissents in part.

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

Maurice Mitchell Innovations, L.P. v. Intel Corporation **(2007-1108) (Rader, Moore, Yeakel [of the W.D. of Texas, sitting by designation])**

September 24, 2007 10:13 AM

(Rader) Affirming summary judgment of indefiniteness because the specification did not contain any corresponding structure for a means-plus-function claim limitation.

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

In Re Gabapentin Patent Litigation, et al. **(No. 06-1572) (Lourie, Linn, Moore)**

September 21, 2007 12:59 PM

(Lourie) Reversing summary judgment of non-infringement in ANDA case, while affirming claim construction. The claims were directed to an epilepsy drug "substantially from a lactam contaminant." The dispute of fact concerned the reliability of test methods for determining whether there was infringement where the tests had a margin of error and the claims were drafted in quantitative terms.

In Re Stephen W. Comiskey **(No. 06-1286) (Michel, Dyk, Prost)**

September 20, 2007 1:29 PM

(Dyk) Holding certain claims unpatentable under 35 U.S.C. 101 as directed to "mental processes" and remanding other claims to determine whether the addition of a general purpose computer or modern communication device to an otherwise unpatentable mental process would have been obvious. The opinion also includes a discussion of when a board decision can be affirmed on grounds not considered or relied on by the board.

BMC Resources, Inc. v. Paymentech, L.P. **(No. 06-1503) (Rader, Gajarsa, Prost)**

September 20, 2007 1:27 PM

(Rader) Affirming summary judgment of non-infringement of method claims for processing debit transactions. The steps for performing the claimed method were performed by different entities. In order to infringe such claims, the party accused of direct infringement must control or direct the actions of all of the parties performing the different steps of the claims.

In Re Petrus A.C.M. Nuijten **(No. 06-1371) (Gajarsa, Linn, Moore)**

September 20, 2007 1:18 PM

(Gajarsa) Claims direct to a "signal" that has been encoded in a particular manner are not patentable subject matter under 35 U.S.C. 101 because a signal is not a "process, machine, manufacture , or composition of matter." Linn dissented.

GP Industries, Inc., et al. v. Eran Industries, Inc., et al. **(No. 07-1087) (Newman, Lourie, Prost)**

September 20, 2007 1:03 PM

(Lourie) Reversing preliminary injunction enjoining patentee from communicating with defendant's customers regarding its patents claims.

Morrow, et al. v. Microsoft Corporation **(06-1512) (Prost, Plager, Moore)**

September 19, 2007 1:42 PM

(Moore) Reversing determination that plaintiff had standing to sue where the right to sue for infringement was separated from title to the patent in a bankruptcy proceeding. Prost dissented.

Adenta GMBH, et al. v. Orthoarm, Inc., et al. **(06-1571) (Michel, Lourie, Roberston)**

September 19, 2007 1:34 PM

(Lourie) Affirming jury verdict of on-sale bar of claim directed to orthodontic devices. The evidence of invalidity was sufficiently corroborated. Also affirming a judgment of no inequitable conduct.

McZeal, Jr. (doing business as International Walkie Talkie) v. Sprint Nextel Corporation, et al. **(06-1548) (Michel, Dyk, Archer)**

September 14, 2007 1:44 PM

(Archer) Reversing dismissal of pro se plaintiff's complaint for failure to state a claim although plaintiff had admitted at argument that he didn't know how the accused device worked. Dyk dissented.

L.B. Plastics, Inc. v. Amerimax Home Products, Inc. (doing business as Gutter World), et al. **(No. 06-1465) (Newman, Rader, Dyk)**

September 12, 2007 2:03 PM

(Dyk) Affirming summary judgment of non-infringement of claims directed to gutter guards. The plaintiff could not invoke the doctrine of equivalents where the specification of the patent criticized alleged equivalent.

Arminak and Associates, Inc., et al. v. Saint-Gobain Calmar, Inc. **(now known as MeadWestvaco Calmar, Inc.) (No. 06-1561) (Michel, Gajarsa, Holderman)**

September 12, 2007 1:55 PM

(Holderman) Affirming summary judgment that design patents were not infringed. The opinion includes a lengthy discussion of issues relevant to infringement of design patents.

Acco Brands, Inc. (doing business as Kensington Technology Group) v. ABA Locks Manufacturer Co, LTD, et al. **(No. 06-1570) (Lourie, Schall, Prost)**

September 12, 2007 1:52 PM

(Lourie) Reversing jury verdict of direct infringement of claims to a computer lock. "To prove direct infringement, a patentee must either point to specific acts of direct infringement or show that the accused device necessarily infringes the patent in suit. "

Daiichi Sankyo Co., LTD (formerly known as Daiichi Pharmaceutical Co., Ltd), et al. v. Apotex, Inc., et al. **[reissued as a precedential opinion] (No. 06-1564) (Michel, Archer, Dyk)**

September 12, 2007 1:47 PM

(Archer, Dyk) Reversing district court in ANDA case and finding claim to method for treating ear infections obvious. The district court erred in its determination of the level or ordinary skill in the art as being that of a general practitioner.

Aventis Pharma Deutschland GMBH, et al. v. Lupin, LTD., et al. **(No. 06-1530) (Mayer, Linn, Robertson)**

September 11, 2007 2:07 PM

(Linn) In ANDA case, reversing district court and finding compound "substantially free of other isomers" obvious.

Toshiba Corporation v. Juniper Networks, Inc. **(No. 2006-1612)(Mayer, Prost, Linares [of the District of New Jersey, sitting by designation)**

September 6, 2007 2:34 PM

(Prost) Affirming judgment of noninfringement. Without providing facts regarding how the district court's claim construction affects the infringement analysis, a judgment of noninfringement of a claim based on a stipulation of noninfringement under that construction will be affirmed if any appealed term in a claim was correctly construed.

Data Encryption Corporation v. Microsoft Corporation, et al. **(No. 2006-1603)(Rader, Bryson, Prost)**

September 6, 2007 2:26 PM

(Prost) Affirming summary judgment of noninfringement. A statement in the patent specification that "All data subject to encryption by operation of the present invention is maintained" in a certain way constituted a disavowal of claim scope.

Gillespie v. DYWIDAG Systems International, USA **(No. 2006-1382)(Newman, Schall, Bryson)**

September 6, 2007 2:19 PM

(Newman) Reversing judgment of infringement because of erroneously broad claim construction. "The patentee is held to what he declares during prosecution of his patent."

Automotive Technologies International, Inc. v. BMW of North America, Inc., et al. **(No. 2006-1013)(Lourie, Rader, Prost)**

September 6, 2007 2:16 PM

(Lourie) Affirming summary judgment of invalidity for lack of enablement of the full scope of claims to side impact crash sensors. The claims covered both mechanical and electronic sensors, but only mechanical sensors were enabled by the specification.

Forest Laboratories, Inc., et al. v. Ivax Pharmaceuticals, Inc., et al. **(No. 2007-1059)(Lourie, Friedman, Schall)**

September 5, 2007 2:24 PM

(Lourie) Affirming judgment of validity but modifying injunction. The correction of a typographical error in claims during reissue did not broaden the claims. A permanent injunction that extended to all products that infringe the patent and not merely those that were adjudicated to infringe was overly broad. Schall dissents in part.

Mitutoyo Corporation, et al. v. Central Purchasing, LLC **(No. 2006-1312)(Mayer, Rader, Moore)**

September 5, 2007 2:14 PM

(Mayer) Affirming summary judgment of infringement but reversing calculation of damages and dismissal of willful infringement claim.