
Federal Circuit Patent Updates - September 2008

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***Praxair v. ATMI* (07-1483, -1509) (Lourie, Bryson, Dyk)**

September 29, 2008 1:24 PM

(Dyk) Affirming judgment that one patent was unenforceable for inequitable conduct. Reversing unenforceability judgment and claim construction ruling on second patent, but affirming finding of validity. Reversing judgment of invalidity of third patent as indefinite. The inequitable conduct judgment was based on a high level of materiality and no good faith explanation. On the issue of claim construction, the Court adopted a construction not advanced by the appellant or the district court and therefore remanded for a determination of infringement. Lourie dissented on the issue of inequitable conduct.

A full version of the decision is available [here](#).

***Lucent Tech. Inc. v. Gateway Inc.* (07-1546, -1580) (Lourie, Bryson, Prost)**

September 25, 2008 1:16 PM

(Prost) Affirming JMOL based on lack of standing to sue under one patent under a joint development agreement and non-infringement of another patent. There was no proof of indirect infringement because the plaintiff failed to prove acts of direct infringement.

A full version of the opinion is available [here](#).

***Broadcom Corp. v. Qualcomm Inc.* (08-1199, -1271, -1272) (Linn, Friedman, Prost)**

September 24, 2008 1:05 PM

(Linn) Reversing overly broad claim construction of one patent and finding it invalid, but affirming jury verdict of infringement and validity of two other patents. An induced infringement instruction was proper where it instructed the jury that it could consider whether or not the defendant obtained the advice of a competent lawyer. Intent to induce infringement need not be proven by direct

evidence. Also, affirming entry of an injunction based on indirect competition and notwithstanding a vertical license where the parties were horizontal competitors. WilmerHale represented the plaintiff Broadcom.

A full version of the opinion is available [here](#).

Egyptian Goddess v. Swisa Inc. (06-1562) (En Banc)

September 22, 2008 12:57 PM

(Bryson) Rejecting the "point of novelty" test as a requirement to prove infringement of a design patent and holding that the sole test of infringement is the "ordinary observer" test in which similarity is considered from the perspective of an ordinary observer who is familiar with the art.

A full version of the opinion is available [here](#).

Aristocrat Technologies Australia PTY Ltd. v. International Game Tech. (08-1016) (Newman, Bryson, Linn)

September 22, 2008 12:51 PM

(Linn) "The district court concluded that the U.S. Patent and Trademark Office "improperly revived" U.S. Patent No. 7,056,215 after it was abandoned during prosecution, and therefore held it (and the continuation patent that followed it) invalid on summary judgment. We conclude that "improper revival" is not a cognizable defense in an action involving the validity or infringement of a patent. Thus, we reverse the district court's grant of summary judgment."

A full version of the opinion is available [here](#).

Commonwealth Scientific and Industrial Research Org. v. Buffalo Tech. Inc. (No. 2007-1449) (Lourie, Rader, Bryson)

September 19, 2008 2:17 PM

(Bryson) Affirming summary judgment of infringement and validity on certain issues but vacating summary judgment of nonobviousness in light of KSR. Two prior art references, one citing the other, did not create a single reference for purposes of anticipation under 35 USC 102. There was no violation of the written description requirement by the alleged addition of new matter to the specification. Lourie concurs.

A full version of the opinion is available [here](#).

Broadcom Corp. v. International Trade Commission (No. 2007-1164) (Rader, Bryson, Linn)

September 19, 2008 2:09 PM

(Bryson) Affirming noninfringement determination as to one patent but vacating it in part and remanding as to another patent in a section 337 proceeding.

A full version of the decision is available [here](#).

***The Campbell Pet Co. v. Miale* (No. 2008-1109) (Bryson, Archer, Prost)**

September 18, 2008 1:59 PM

(Bryson) Reversing dismissal for lack of personal jurisdiction. The actions of the defendant-patentee in the forum state of accusing the plaintiff of infringement and threatening litigation, and in making those accusations to the plaintiff's customers and trying to have the plaintiff's products removed from a trade show, were sufficient to support specific personal jurisdiction over the defendant in a declaratory judgment case.

A full version of the decision is available [here](#).

***ExcelStor Tech. Inc. v. Papst Licensing GMBH & Co. KG* (No. 2008-1140) (Mayer, Lourie, Schall)**

September 16, 2008 1:54 PM

(Lourie) Affirming dismissal for lack of subject matter jurisdiction. "[P]atent exhaustion is a defense to patent infringement, not a cause of action." "[T]here is no federal cause of action for collecting royalties twice on the same goods. Patent exhaustion prohibits patentees from enforcing patent rights in certain circumstances, but it does not forbid multiple licenses on a single product or even multiple royalties."

A full version of the opinion is available [here](#).

***Duratech Ind. International v. Bridgeview Manufacturing Inc.* (No. 2008-1157) (Michel, Rader, Schall)**

September 12, 2008 2:22 PM

(Rader) Vacating judgment of noninfringement because of erroneous claim construction. The claim term "manipulator ... for driving ..." was not a means-plus-function limitation subject to 35 USC 112, 6.

A full version of the opinion is available [here](#).

***Medical Solutions v. C. Change Surgical* (No. 2007-1163) (Bryson, Prost, Zagel [of the N.D. III., sitting by designation])**

September 9, 2008 1:51 PM

(Zagel) Affirming dismissal for lack of personal jurisdiction. The display and demonstration of the allegedly infringing device at a trade show did not constitute a "use" of the device under the patent laws.

A full version of the opinion is available [here](#).

***Carnegie Mellon University v. Hoffmann La-Roche Inc.* (No. 2007-1266) (Lourie, Bryson, Prost)**

September 8, 2008 1:44 PM

(Lourie) Affirming summary judgment of non-infringement and invalidity of patents related to recombinant plasmids. Some claims were invalid due to lack of written description. “[W]hile the [claims] encompass a genus of recombinant plasmids that contain coding sequences of DNA polymerase . . . from any bacterial source, in contrast, the narrow specifications of the [patents] only disclose the polA gene coding sequence from one bacterial source . . . Significantly, the specification fails to disclose or describe the polA gene coding sequence for any other bacterial species.” Other claims were not infringed under the doctrine of equivalents. “[F]inding that Taq is an equivalent of E. coli would essentially render the ‘bacterial source [is] E. coli’ claim limitation meaningless, and would thus vitiate that limitation of the claims.”

A full version of the opinion is available [here](#).

***Janssen Pharmaceutica, N.V. v. Apotex, Inc.* (No. 2008-1062) (Michel, Rader, Moore)**

September 4, 2008 1:08 PM

(Moore) Affirming dismissal of declaratory judgment action. “[W]e hold that a possible delay in the future of a first Paragraph IV ANDA filer in launching its generic product does not give rise to declaratory judgment jurisdiction.”

A full version of the opinion is available [here](#).

***In Re Swanson* (No. 2007-1534) (Lourie, Bryson, Gajarsa)**

September 4, 2008 12:51 PM

(Gajarsa) Affirming Board’s rejection in a case of first impression concerning the interpretation of § 303(a) as amended in 2002. The prior art “Deutsch” reference presented a “substantial new question of patentability” sufficient to initiate a reexamination, even though that reference had been considered during the original prosecution and even though, in prior litigation, the Court had “sustained the judgment that Deutch did not anticipate the asserted claims . . .” “As properly interpreted, a ‘substantial new question of patentability’ refers to a question which has never been considered by the PTO; thus, a substantial new question can exist even if a federal court previously considered that question.”

A full version of the opinion is available [here](#).

***Howmedica Osteonics Corp. v. Wright Med. Tech. Inc.* (No. 2007-1363) (Dyk, Prost, Hochberg [of the District of N.J., sitting by designation])**

September 2, 2008 11:21 AM

(Dyk) Vacating judgment of non-infringement of patent related to artificial knee prosthesis and remanding. Also affirming summary judgment that plaintiff's infringement claim was not released as part of an earlier settlement agreement. The Court rejected defendant's argument that an inventor's testimony is relevant to claim construction if the testimony is against the inventor's interest. "We hold that inventor testimony as to the inventor's subjective intent is irrelevant to the issue of claim construction." The district court had concluded that the patent claim, which covered both bi-condylar prostheses and single-condylar prostheses, required both condyles of a bi-condylar prosthesis to meet the claim's geometric requirements. Although calling it a "close case," the Court disagreed and found that only one condyle of a bi-condylar prosthesis must meet the claim's geometric requirements. Prost dissented and would have affirmed the district court's construction requiring both condyles of a bi-condylar prosthesis to satisfy the claim's geometric limitations.

A full version of the decision is available [here](#).