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## Federal Circuit Patent Updates - March 2009

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***Cordis v. Boston Scientific* (2008-1003, -1072) (Mayer, Dyk, Huff [of the S.D. of California, sitting by designation])**

March 31, 2009 8:42 AM

(Dyk) Affirming judgment of infringement of patents relating to intravascular stents. Also reversing dismissal of certain claims without prejudice and remanding with instructions to dismiss those claims with prejudice. Monographs distributed to colleagues and to two companies “while attempting to commercialize” the technology did not qualify as prior art. “The mere fact that there was no legal obligation of confidentiality - all that was shown here - is not in and of itself sufficient to show that [the inventor’s] expectation of confidentiality was not reasonable.” Also, the Court rejected an argument by plaintiff-appellant that a claim construction urged by defendants-cross appellants in another case involving the same patent should be adopted. “Raising this argument for the first time in a motion for judgment as a matter of law more than a year after the jury’s infringement verdict was too late.”

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

***In Re Gleave* (2008-1453) (Michel, Prost, Moore)**

March 26, 2009 8:36 AM

(Prost) Affirming rejection of claims directed to antisense oligodeoxynucleotides. Prior art reference that disclosed the claimed sequences among a list of over 1400 sequences anticipated. That the reference “provides ‘no understanding of which of the targets would be useful’ is of no import, because [the applicant] admits that it is well within the skill of an ordinary person in the art to make any oligodeoxynucleotide sequence.” For claims directed to compositions of matter, a reference satisfies “the enablement requirement of §102(b) by showing that one of skill in the art would know how to make the relevant sequences. . .” The standard for enablement of a prior art reference for purposes of anticipation differs from the enablement standard under §112.

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

***Clock Spring, L.P. v. Wrapmaster, Inc.* (2008-1332) (Bryson, Dyk, Patel [of the N.D. of California, sitting by designation])**

March 25, 2009 8:32 AM

(Dyk) Affirming summary judgment of invalidity of patent relating to repairing damaged high-pressure gas pipes. Also affirming summary judgment determination that false advertising claim was without merit. Although the district court's summary judgment decision was based on obviousness, the Court's affirmation relied on prior public use by the inventor. By filing a patent application, "the inventors represented that the invention was then ready for patenting, and studies done thereafter cannot justify an earlier delay in filing the application under the rubric of experimental use."

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

***E-Pass Technologies, Inc. v. 3Com Corp.* (2008-1144, -1145, -1146, -1470, -1471, -1472) (Bryson, Linn, Prost)**

March 24, 2009 8:25 AM

(Linn) Granting motion that appeal was frivolous and awarding attorneys fees. Bryson dissented.

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

***ClearValue, Inc. v. Pearl River Polymers, Inc.* (2007-1487, 2008-1176) (Newman, Schall, Dyk)**

March 24, 2009 8:12 AM

(Schall) Affirming finding of sanctionable conduct and award of attorneys fees under Rules 26 and 37 relating to plaintiff's failure to produce test results showing non-infringement of accused products. Also reversing order striking plaintiff's pleadings and entering judgment in favor of defendant and reversing other sanctions. "A district court should only use its inherent powers when 'neither the statute nor the Rules are up to the task.'" Newman concurred in part and dissented in part.

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

***E-Pass Technologies, Inc. v. 3Com Corp.* (No. 2008-1144)(Bryson, Linn, Prost)**

March 20, 2009 2:40 PM

(Linn) Granting motion that appeal was frivolous and awarding attorneys fees.

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

***Tafas v. Doll* (No. 2008-1352) (Prost, Bryson, Radar)**

March 20, 2009 2:30 PM

(Prost) Affirming in part and vacating part district court's ruling that PTO rules exceeded its authority. The Court affirmed the grant of summary judgment that Final Rule 78 (limiting the number of continuations) is invalid, vacated the grant of summary judgment with respect to Final Rules 75 (limiting the number of requests for continued examination), 114 (relating to examination support documents), and 265 (relating to examination support documents), and remanded the case for further proceedings. Bryson concurred. Rader concurred-in-part and dissented-in-part.

***Henkel Corp. v. The Proctor & Gamble Co.* (No. 08-1447) (Linn, Prost, Moore)**

March 18, 2009 2:27 PM

(Linn) Affirming Board's decision awarding priority to P&G to detergent invention as supported by substantial evidence.

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

***Larson Manufacturing Co. of South Dakota, Inc. v. Aluminart Products, Ltd.* (No. 2008-1096) (Schall, Clevenger, Linn)**

March 18, 2009 2:14 PM

(Schall) In inequitable conduct case, reversing district court's finding that three pieces of prior art not disclosed to the patent office were not cumulative and were material, but agreeing that two undisclosed office actions were material. The case was then remanded for a new evaluation of whether there was an intent to mislead. Linn concurred and urged en banc review of the issue of intent.

***Crown Packaging Technology, Inc. v. Rexam Beverage Can Co.* (No. 2008-1284) (Bryson, Gajarsa, Moore)**

March 17, 2009 2:02 PM

(Moore) Remanding summary judgment of non-infringement based on existence of a material issue of fact as to the issue of infringement under the doctrine of equivalents. "Additionally, because we are bound by our holding in *Hanson v. Alpine Valley Ski Area, Inc.*, 718 F.2d 1075 (Fed. Cir. 1983)—that the marking requirement of 35 U.S.C. § 287(a) does not apply when only method claims are asserted—we reverse the district court's grant of summary judgment dismissing Rexam's counterclaim based on a failure to mark.

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

***ICU Medical, Inc. v. Alaris Medical Systems, Inc.* (No. 2008-1077) (Michel, Prost, Moore)**

March 13, 2009 1:50 PM

(Moore) Affirming summary judgment of invalidity for failure to comply with the written description requirement where specification only disclosed medical devices that included a spike, but claims broadly covered spikeless devices. Also affirming award of attorneys fees under Rule 11.

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

***Mars, Inc. v. Coin Acceptors, Inc.* [order](No. 2007-1409) (Linn, Clevenger, Prost)**

March 9, 2009 11:42 AM

(Linn) Precedential Order recalling mandate and instructing the district court to award post-judgment interest, where the appellant was held on appeal entitled to lesser damages than the district court awarded.

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

***Cardiac Pacemakers v. St. Jude Medical* [order] (No. 2007-1296)**

March 6, 2009 11:59 AM

(Per Curiam) Order granting petition for rehearing en banc to address the question of whether 35 USC 271(f) applies to method claims as well as product claims.

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

***In Re Ferguson* (No. 2007-1232) (Newman, Mayer, Gajarsa)**

March 6, 2009 11:38 AM

(Gajarsa) Affirming rejection of claims to a "A method of marketing a product" and "A paradigm of marketing software" as not covering patent-eligible subject matter under 35 USC 101, particularly in light of *In re Bilski*. "[A] marketing force is not a machine or apparatus" to support method claims, and a "paradigm" is not a process, machine, manufacture, or composition of matter as required by Section 101. Newman concurs.

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

***Nartron Corp. v. Schukra U.S.A., Inc.* (No. 2008-1363) (Lourie, Dyk, Prost)**

March 5, 2009 10:49 AM

(Lourie) Reversing dismissal of patent infringement complaint because of failure to join an alleged co-inventor as a plaintiff. The alleged co-inventor's contribution to one claim of the patent "was insignificant and therefore prevents [him] from attaining the status as co-inventor." The contribution was in the prior art and "including it as part of the claimed invention was merely the basic exercise of ordinary skill in the art." The alleged co-inventor was also "not entitled to co-inventorship by simply posing the result to [the patentee] and leaving it it [the patentee] to figure it out how to accomplish it."

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

***Monolithic Power Systems, Inc. v. O2 Micro International Ltd.* (No. 2008-1128) (Rader, Plager, Gajarsa)**

March 5, 2009 9:45 AM

(Rader) Affirming jury verdict of obviousness and the district court's appointment of an technical expert who testified at trial (and whose opinion on obviousness the jury followed), although "[t]he predicaments inherent in court appointment of an independent expert and revelations to the jury about the expert's neutral status trouble this court to some extent." "Section 103 of Title 35 requires this court to inquire 'whether the improvement [in a claimed invention] is more than the predictable use of prior-art elements according to their established functions'"(quoting *KSR*).

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