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## 2002 Patent Law Decisions of The Federal Circuit

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## 2002 Patent Law Decisions of The Federal Circuit

## AREA SUMMARIES

# 2002 PATENT LAW DECISIONS OF THE FEDERAL CIRCUIT

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### TABLE OF CONTENTS

Introduction.....	893
I. Procedural Aspects.....	893
A. Appellate Jurisdiction.....	893
B. Subject Matter Jurisdiction of the U.S. District Courts.....	895
C. Personal Jurisdiction.....	898
D. Standing.....	900
E. Collateral Estoppel.....	901
F. Trial Procedures.....	904
G. USPTO Procedures.....	905
H. Deference Owed to the USPTO.....	906
I. Miscellaneous Procedural Issues.....	907
II. Patentability and Validity.....	908
A. 35 U.S.C. § 102.....	909
1. Anticipation.....	909
2. On-sale bar and public use.....	912
B. 35 U.S.C. § 103—Obviousness.....	917
C. 35 U.S.C. § 112.....	919

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1. Written description.....	920
2. Enablement.....	921
3. Best mode.....	923
4. Indefiniteness.....	925
D. Reexamination.....	927
E. Reissue.....	927
F. Design Patent.....	928
G. Interference and Priority of Invention .....	929
H. Patent Term.....	935
I. Inventorship.....	935
J. Prosecution History Laches .....	938
III. Infringement .....	939
A. Claim Construction .....	940
1. Interpreting the plain and ordinary meaning of claims.....	941
2. The use of the specification and prosecution history in interpreting claims .....	948
3. The role of the preamble in interpreting claims .....	955
4. Miscellaneous claim interpretation issues .....	958
B. Means-Plus-Function Claims .....	959
C. Literal Infringement.....	962
D. Infringement under the Doctrine of Equivalents.....	964
E. Prosecution History Estoppel .....	971
F. Inducement of Infringement.....	975
G. Infringement Under the Hatch-Waxman Act.....	976
H. Design Patent Infringement .....	979
I. Willful Infringement .....	981
J. Repair and Reconstruction .....	982
K. Bona Fide Purchaser Doctrine.....	983
IV. Inequitable Conduct and Other Defenses .....	985
A. Prosecution Laches .....	985
B. Inequitable Conduct .....	987
C. Use of the Invention by the United States Government ..	988
D. Estoppel .....	989
V. Remedies.....	990
A. Preliminary Injunction .....	990
B. Damages.....	991
1. Other than reasonable royalty.....	991
2. Reasonable royalty .....	992
3. Attorney fees and costs .....	993
C. Attorney Conduct.....	994
1. Contempt .....	994
2. Pre-filing investigation under Rule 11 .....	995
3. Attorney statements .....	996
Conclusion .....	996

## INTRODUCTION

The year 2002 brought some significant changes to the Federal Circuit: the addition of a new judge, Sharon Prost,<sup>1</sup> and the issuance of two decisions by the U.S. Supreme Court reversing the Federal Circuit's decisions. These decisions have had an impact on the Federal Circuit—*Holmes Group, Inc. v. Vornado Air Circulation Systems, Inc.*<sup>2</sup> limited the Federal Circuit's patent jurisdiction and *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushki Co.*<sup>3</sup> criticized the Federal Circuit in its application of the controversial doctrine of equivalents. The Federal Circuit's docket continues to grow with the increased importance placed on intellectual property, as evidenced by the breadth and number of patent law decisions published by the Federal Circuit in 2002. The 2002 opinions are summarized here by subject matter.

## I. PROCEDURAL ASPECTS

The Federal Circuit addressed numerous procedural issues in its decisions, including the subject matter jurisdiction of the district courts, personal jurisdiction in patent cases, standing, collateral estoppel, various trial procedures, and the procedures of the United States Patent and Trademark Office ("USPTO"). The most notable decision on a procedural issue did not come from the Federal Circuit, but concerned the Supreme Court's view of the Federal Circuit's exclusive appellate jurisdiction in patent cases.

## A. Appellate Jurisdiction

In general, the Federal Circuit has exclusive appellate jurisdiction over any case where the subject matter jurisdiction of the district court is based, in whole or in part, on a dispute arising under the patent laws of the United States.<sup>4</sup> However, in 2002, the Supreme Court determined that the exclusive appellate jurisdiction of the Federal Circuit did not extend to every case in which a patent dispute arises.<sup>5</sup>

In *Holmes Group, Inc. v. Vornado Air Circulation Systems, Inc.*,<sup>6</sup> the Supreme Court held that the Federal Circuit does not have

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1. Nominated to be Circuit Judge by President George W. Bush on May 22, 2001, confirmed by the U.S. Senate September 21, 2001, and assumed duties of the office on October 3, 2001. Judge Prost sat on a panel for the first time in January 2002.

2. 535 U.S. 826, 62 U.S.P.Q.2d (BNA) 1801 (2002).

3. 535 U.S. 722, 62 U.S.P.Q.2d (BNA) 1705 (2002).

4. 28 U.S.C. § 1295(a)(1) (2000).

5. *Holmes*, 535 U.S. at 834, 62 U.S.P.Q.2d (BNA) at 1805.

6. *Id.* at 826, 62 U.S.P.Q.2d (BNA) at 1801.

jurisdiction based on a patent infringement counterclaim; rather, the Federal Circuit's jurisdiction is fixed with reference to that of the district court.<sup>7</sup> Under 28 U.S.C. § 1338, a district court has subject matter jurisdiction of cases "arising under" the patent laws.<sup>8</sup> In *Holmes*, the Supreme Court determined that the well-pleaded complaint rule governs resolution of whether the district court has jurisdiction under § 1338, and that the rule does not allow for a counterclaim to serve as the basis for the district court's "arising under" jurisdiction.<sup>9</sup> The Justices did not accept that the phrase "arising under" should be interpreted differently in assessing the Federal Circuit's jurisdiction in order to effectuate the congressional goal of ensuring patent-law uniformity.<sup>10</sup> As a result, the Supreme Court stated that the exclusive appellate jurisdiction of the Federal Circuit is limited to cases in which the patent dispute is apparent on the face of the complaint alone.<sup>11</sup>

Consistent with the decision in *Holmes*, the Federal Circuit held in *Telcomm Technical Services, Inc. v. Sieman's Rolm Communications, Inc.*<sup>12</sup> that it did not have jurisdiction to entertain an appeal solely predicated on the existence of a patent infringement counterclaim.<sup>13</sup> In this case, the plaintiff appealed the district court's grant of summary judgment on plaintiff's allegations of monopolization and attempted monopolization under the Sherman Antitrust Act.<sup>14</sup> The complaint did not allege a cause of action arising under the patent laws; rather, only the defendant raised a patent issue in the case.<sup>15</sup> As a result, the Federal Circuit transferred the case to the U.S. Court of Appeals for the Eleventh Circuit.<sup>16</sup>

In *Golan v. Pingel Enterprise, Inc.*,<sup>17</sup> the Federal Circuit again explored the boundaries of its exclusive appellate jurisdiction and addressed whether it had jurisdiction over an appeal based on the Declaratory Judgment Act for non-infringement of a patent.<sup>18</sup> Consistent with the Supreme Court's decision in *Holmes*, the Federal Circuit looked to whether the declaratory judgment complaint

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7. *Id.* at 834, 62 U.S.P.Q.2d (BNA) at 1805.

8. 28 U.S.C. § 1338(a) (2000).

9. *Holmes*, 535 U.S. at 831, 62 U.S.P.Q.2d (BNA) at 1803-04.

10. *Id.* at 833-34, 62 U.S.P.Q.2d (BNA) at 1804.

11. *Id.* at 834, 62 U.S.P.Q.2d (BNA) at 1805.

12. 295 F.3d 1249, 63 U.S.P.Q.2d (BNA) 1606 (Fed. Cir. 2002).

13. *Id.* at 1252, 63 U.S.P.Q.2d (BNA) at 1608.

14. *Id.* at 1250-51, 63 U.S.P.Q.2d (BNA) at 1607.

15. *Id.* at 1251, 63 U.S.P.Q.2d (BNA) at 1607.

16. *Id.* at 1252, 63 U.S.P.Q.2d (BNA) at 1608.

17. 310 F.3d 1360, 64 U.S.P.Q.2d (BNA) 1911 (Fed. Cir. 2002).

18. *Id.* at 1366-67, 64 U.S.P.Q.2d (BNA) at 1914-15.

alleged an action arising under the patent laws.<sup>19</sup> The Federal Circuit indicated that in the context of declaratory judgments, “the plaintiff’s complaint arises under federal law if the cause of action that the declaratory defendant threatens to assert arises (or would arise) under federal law.”<sup>20</sup> The Federal Circuit explained that in the case of a complaint seeking a declaration of non-infringement, the action threatened by the declaratory defendant would be a patent infringement action and would clearly arise under patent law.<sup>21</sup> Consequently, the Federal Circuit found that Golan’s declaratory judgment allegations in his complaint for non-infringement of a patent conferred jurisdiction on the court and noted that Pingel’s patent infringement counterclaims were irrelevant when determining whether the Federal Circuit had jurisdiction in this case.<sup>22</sup>

*B. Subject Matter Jurisdiction of the U.S. District Courts*

United States district courts have limited subject matter jurisdiction.<sup>23</sup> They may hear cases where there is a federal question,<sup>24</sup> such as a dispute arising under the patent laws,<sup>25</sup> or controversies among parties having a diversity of citizenship.<sup>26</sup>

During the past year, the Federal Circuit addressed several aspects of district court subject matter jurisdiction, including how a case is determined to “arise under” the patent laws, whether a case should be brought in the Court of Federal Claims, and whether a case is properly brought under the Declaratory Judgments Act.

In *Pixton v. B&B Plastics, Inc.*,<sup>27</sup> the Federal Circuit considered whether a district court had subject matter jurisdiction over Pixton’s patent infringement action.<sup>28</sup> As discussed above, under the relevant jurisdictional statute, a district court has subject matter jurisdiction of cases arising under the patent laws.<sup>29</sup> In this case, Pixton assigned his patent for plastic fishing lures to the defendant, B&B Plastics.<sup>30</sup> Subsequently, Pixton alleged that B&B breached the agreement and

19. *Id.*, 64 U.S.P.Q.2d (BNA) at 1914-15.

20. *Id.* at 1367, 64 U.S.P.Q.2d (BNA) at 1915 (citing Franchise Tax Bd. of State of Cal. v. Constr. Laborers Vacation Trust for S. Cal., 463 U.S. 1, 18 (1983)).

21. *Id.*, 64 U.S.P.Q.2d (BNA) at 1915.

22. *Id.*, 64 U.S.P.Q.2d (BNA) at 1915.

23. U.S. CONST. art. III, § 2, cl. 1.

24. 28 U.S.C. § 1331 (2000).

25. *Id.* § 1338(a).

26. *Id.* § 1332(a).

27. 291 F.3d 1324, 62 U.S.P.Q.2d (BNA) 1944 (Fed. Cir. 2002).

28. *Id.* at 1325-26, 62 U.S.P.Q.2d (BNA) at 1945.

29. 28 U.S.C. § 1338(a).

30. *Pixton*, 291 F.3d at 1326, 62 U.S.P.Q.2d (BNA) at 1945.

sued B&B for infringement.<sup>31</sup> The district court concluded that it lacked subject matter jurisdiction because the underlying action sounded entirely in contract principles.<sup>32</sup> On appeal, the Federal Circuit stated that a court must consider “whether the plaintiff has stated, in a well-pleaded complaint, a claim arising under the patent laws” to determine whether § 1338 jurisdiction attaches.<sup>33</sup> The Federal Circuit explained that this must be determined from the plaintiff’s statement of his claim.<sup>34</sup> The Federal Circuit then indicated that Pixton’s complaint was well-pleaded and clearly set out an action for patent infringement.<sup>35</sup> The Court explained further that federal jurisdiction “is not lost simply because the most efficient approach at trial may be to address the license defense first.”<sup>36</sup> As a result, the Federal Circuit vacated the decision and remanded the case back to the district court for trial.<sup>37</sup>

In *Toxgon Corp. v. BNFL, Inc.*,<sup>38</sup> the Federal Circuit considered whether a district court had subject matter jurisdiction over a case where the alleged infringement resulted from activities authorized by the United States for its sole benefit.<sup>39</sup> In response to the filing of a patent infringement suit by the plaintiff, the defendants moved to dismiss under Rule 12(b)(1) of the Federal Rules of Civil Procedure asserting that the infringement occurred “under the authority of and for the sole benefit of the United States.”<sup>40</sup> Defendants argued that the plaintiff’s claims must be brought in the Court of Federal Claims under 28 U.S.C. § 1498(a), a law that restricts the remedy for infringement by the United States to monetary compensation.<sup>41</sup> Among other things, the statute also relieves a federal contractor of liability where the contractor uses or manufactures an infringing invention for the United States.<sup>42</sup> The Federal Circuit held that § 1498(a) provides an affirmative defense in a suit between private litigants, rather than a jurisdictional bar, and that it would therefore

31. *Id.*, 62 U.S.P.Q.2d (BNA) at 1945.

32. *Id.*, 62 U.S.P.Q.2d (BNA) at 1945.

33. *Id.*, 62 U.S.P.Q.2d (BNA) at 1945 (quoting *Jim Arnold v. Hydrotech Sys., Inc.*, F.3d 1567, 1576, 42 U.S.P.Q.2d (BNA) 1119, 1127) (citations omitted).

34. *Id.*, 62 U.S.P.Q.2d (BNA) at 1945 (quoting *Jim Arnold v. Hydrotech Sys., Inc.*, F.3d 1567, 1576, 42 U.S.P.Q.2d (BNA) 1119, 1127) (citations omitted).

35. *Id.* at 1327, 62 U.S.P.Q.2d (BNA) at 1946.

36. *Id.*, 62 U.S.P.Q.2d (BNA) at 1946 (citations omitted).

37. *Id.*, 62 U.S.P.Q.2d (BNA) at 1946.

38. 312 F.3d 1379, 65 U.S.P.Q.2d (BNA) 1146 (Fed. Cir. 2002).

39. *Id.* at 1380, 62 U.S.P.Q.2d (BNA) at 1147 (citations omitted in original).

40. *Id.*, 62 U.S.P.Q.2d (BNA) at 1147; *see* FED. R. CIV. P. 12(b)(1) (allowing a motion for judgment for lack of jurisdiction over the subject matter).

41. *Toxgon Corp.*, 312 F.3d at 1380, 65 U.S.P.Q.2d (BNA) at 1147-48 (Fed. Cir. 2002); 28 U.S.C. § 1498(a) (2000).

42. 28 U.S.C. § 1498(a) (2000).



be inappropriate to dismiss this action under Rule 12(b)(1).<sup>43</sup> Instead, the Federal Circuit stated that where appropriate, a defense arising under § 1498(a) should be resolved by summary judgment under Rule 56 of the Federal Rules of Civil Procedure.<sup>44</sup>

The Federal Circuit faced a similar issue in *Madey v. Duke University*.<sup>45</sup> The district court dismissed a portion of Madey's claim for lack of jurisdiction on the grounds that Duke University's use of Madey's patents arose under the authority of a government research grant and the case should have been brought in the Court of Federal Claims.<sup>46</sup> The Federal Circuit reversed the case, determining that the district court erred in not applying Federal Circuit law and by providing no findings or analysis upon which to base a review of the decision.<sup>47</sup>

In *Vanguard Research, Inc. v. PEAT, Inc.*,<sup>48</sup> the Federal Circuit reversed the district court's determination that there was not a case or controversy sufficient for jurisdiction under the Declaratory Judgment Act.<sup>49</sup> In so doing, the Federal Circuit stated that "a patentee's present intentions do not control whether a case or controversy exists," even though a party may indicate that it never expressly authorized, nor intended to authorize, a suit for patent infringement.<sup>50</sup> Instead, the proper question is whether the plaintiff seeking a declaratory judgment "had a reasonable apprehension" that the patentee would sue for patent infringement at some future date.<sup>51</sup> In this case, by filing an earlier suit in state court over the same technology and indicating to the plaintiff's customers that the plaintiff was using a patented technology without a license, the defendant demonstrated a "willingness to protect that technology."<sup>52</sup> Thus, the Federal Circuit explained that the filing of a patent

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43. *Toxgon*, 312 F.3d at 1382, 65 U.S.P.Q.2d (BNA) at 1149.

44. *Id.*, 65 U.S.P.Q.2d (BNA) at 1149; *see* FED. R. CIV. P. 56 (providing for summary judgment).

45. 307 F.3d 1351, 64 U.S.P.Q.2d (BNA) 1737 (Fed. Cir. 2002).

46. *Id.* at 1353-54, 64 U.S.P.Q.2d (BNA) at 1739-40.

47. *Id.* at 1359-60, 64 U.S.P.Q.2d (BNA) at 1744-45.

48. 304 F.3d 1249, 64 U.S.P.Q.2d (BNA) 1370 (Fed. Cir. 2002).

49. *Id.* at 1250, 64 U.S.P.Q.2d (BNA) at 1370; *see* 28 U.S.C. § 2201 (2000) (allowing a court to declare the rights or legal relations of any interested party, whether or not further relief is or could be sought, in a case of actual controversy within its jurisdiction).

50. *Vanguard Research*, 304 F.3d at 1255, 64 U.S.P.Q.2d (BNA) at 1374 (citing *Goodyear Tire & Rubber Co. v. Releasomers, Inc.*, 824 F.2d 953, 956, 3 U.S.P.Q.2d (BNA) 1310, 1312 (Fed. Cir. 1987)).

51. *Id.*, 64 U.S.P.Q.2d (BNA) at 1374.

52. *Id.*, 64 U.S.P.Q.2d (BNA) at 1374 (citing *Goodyear Tire & Rubber Co. v. Releasomers, Inc.*, 824 F.2d 953, 956, 3 U.S.P.Q.2d (BNA) 1310, 1312 (Fed. Cir. 1987)).

infringement claim would be “another logical step in its quest to protect its technology.”<sup>53</sup>

### C. Personal Jurisdiction

A district court must have jurisdiction over the parties to a case in order to properly adjudicate their claims.<sup>54</sup> A court may exercise its power over a defendant if the defendant is present in the forum state or if the defendant has sufficient minimum contacts with the forum state to the extent that the assertion of power will not “offend traditional notions of fair play and substantial justice.”<sup>55</sup>

In assessing the authority of the district courts over the parties to an action, the Federal Circuit issued opinions concerning the effect of a forum selection clause in a technology agreement, the effect of negotiating a license in a state, the effect of a waiver of personal jurisdiction, and what factors satisfy the minimum contacts test of personal jurisdiction.

In *Monsanto Co. v. McFarling*,<sup>56</sup> the Federal Circuit had the opportunity to address the effects of a forum selection clause in a technology agreement on personal jurisdiction.<sup>57</sup> The district court granted a preliminary injunction to Monsanto prohibiting McFarling from using plant genes and seed obtained from crops grown from Monsanto’s patented soybean seed.<sup>58</sup> McFarling tried to use plant genes and seed obtained from crops grown from Monsanto’s patented herbicide-resistant Roundup Ready® soybean seed the previous year.<sup>59</sup> Monsanto required their seed distributors to have purchasers sign a technology agreement saying that they will not save any seeds for the next season.<sup>60</sup> Monsanto brought suit in U.S. District Court for the Eastern District of Missouri pursuant to the forum selection clause in that agreement.<sup>61</sup> Based on that clause, the Federal Circuit determined that jurisdiction in Missouri was proper because of “contractual consent”.<sup>62</sup> The Federal Circuit explained that McFarling’s voluntary failure to read the back of the contract,

53. *Id.*, 64 U.S.P.Q.2d (BNA) at 1374.

54. *See Int’l Shoe Co. v. Washington*, 326 U.S. 310, 316 (1945) (stating that the Due Process Clause does not contemplate state power to make a binding judgment against an individual or corporation with which the state has no contacts, ties, or relations).

55. *Id.*

56. 302 F.3d 1291, 64 U.S.P.Q.2d (BNA) 1161 (Fed. Cir. 2002).

57. *Id.* at 1294, 64 U.S.P.Q.2d (BNA) at 1163.

58. *Id.* at 1293, 64 U.S.P.Q.2d (BNA) at 1162.

59. *Id.*, 64 U.S.P.Q.2d (BNA) at 1162.

60. *Id.*, 64 U.S.P.Q.2d (BNA) at 1162.

61. *Id.*, 64 U.S.P.Q.2d (BNA) at 1162.

62. *Id.* at 1295, 64 U.S.P.Q.2d (BNA) at 1163-64.

which contained the forum selection clause, did not entitle him to an exemption from the effects of the clause.<sup>63</sup>

In *Depreynyl Animal Health, Inc. v. University of Toronto Innovations Foundation*,<sup>64</sup> the Federal Circuit reversed and remanded a decision by the district court not to exercise personal jurisdiction over the defendant.<sup>65</sup> The Federal Circuit explained that its law governs the issue of personal jurisdiction in patent-related cases, but regional circuit law governs the determination of whether non-infringement and invalidity claims fall within the scope of an arbitration clause of a license agreement between the parties.<sup>66</sup> The Federal Circuit stated that the negotiation of a patent license agreement of a U.S. patent in Kansas, albeit with a choice of law clause selecting Canadian law, satisfied the minimum contacts requirement and constituted sufficient purposeful availment of the U.S. patent law to make jurisdiction in Kansas proper.<sup>67</sup> The Federal Circuit also held that, in view of international comity, the Kansas district court should stay the proceedings pending the outcome of the ongoing Canadian arbitration.<sup>68</sup>

In *Frank's Casing Crew & Rental Tools, Inc. v. PMR Technologies, Ltd.*,<sup>69</sup> the Federal Circuit affirmed the district court's holding that PMR waived its personal jurisdiction defense by filing claims against new defendants.<sup>70</sup> The Federal Circuit based its determination on the fact that, in filing its Answer, Class-Action Counter-Claim, and First Amended Complaint, PMR asserted infringement claims against six counter-claim defendants that previously were not involved in any infringement suit related to the patent at issue.<sup>71</sup> The Federal Circuit reasoned that, because the new claims did not arise out of the same transaction or occurrence (even though they were based on infringement of the same patent), and because such action was not authorized by the joinder rules, the attempted joinder constituted a waiver of the opportunity to challenge personal jurisdiction relating

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63. *Id.* at 1295-96, 64 U.S.P.Q.2d (BNA) at 1164. In the dissent, Judge Cleverger noted that the technology agreement (which contained the forum selection clause) was a contract of adhesion. *Id.* at 1300, 64 U.S.P.Q.2d (BNA) at 1167 (Cleverger, J., dissenting). Judge Cleverger stated that the terms of an adhesion contract should not be permitted to overcome the constitutional right to due process that underlies the personal jurisdiction requirement. *Id.* at 1301-02, 64 U.S.P.Q.2d (BNA) at 1168.

64. 297 F.3d 1343, 63 U.S.P.Q.2d (BNA) 1705 (Fed. Cir. 2002).

65. *Id.* at 1346, 63 U.S.P.Q.2d (BNA) at 1706.

66. *Id.* at 1348-49, 63 U.S.P.Q.2d (BNA) at 1708.

67. *Id.* at 1354, 63 U.S.P.Q.2d (BNA) at 1712.

68. *Id.* at 1358, 63 U.S.P.Q.2d (BNA) at 1715.

69. 292 F.3d 1363, 63 U.S.P.Q.2d (BNA) 1065 (Fed. Cir. 2002).

70. *Id.* at 1366, 63 U.S.P.Q.2d (BNA) at 1066.

71. *Id.* at 1371-72, 63 U.S.P.Q.2d (BNA) at 1071.

to the pending claims in the action against the party seeking to add additional claims.<sup>72</sup>

In *Hildebrand v. Steck Manufacturing Co.*,<sup>73</sup> the Federal Circuit reversed and remanded a declaratory judgment of non-infringement, invalidity, and tortious interference because the trial court erred in concluding that it had personal jurisdiction over Hildebrand.<sup>74</sup> The Federal Circuit applied Federal Circuit law in analyzing the lower court exercise of personal jurisdiction over an out-of-state defendant in a patent infringement case.<sup>75</sup> The Federal Circuit indicated such jurisdiction over a non-consenting party outside the forum state is proper if that party is “amenable to service of process under the appropriate long-arm statute [and] the culmination of the party’s activities within the forum state satisfies the minimum contact requirement of the due process clause.”<sup>76</sup> The Federal Circuit determined that Hildebrand’s offers to do business and warning letters, coupled with offers to negotiate with plaintiffs, rose only to the level of soliciting business.<sup>77</sup> According to Ohio law, mere solicitation of business by a foreign person does not constitute transacting business in the state.<sup>78</sup>

Accordingly, the Federal Circuit held that Hildebrand did not satisfy the first prong of the personal jurisdiction test.<sup>79</sup> The Federal Circuit also concluded that the second prong of the personal jurisdiction test was not satisfied because Hildebrand’s contacts with the forum were minimal.<sup>80</sup> The Federal Circuit explained that “[f]airness and reasonableness demand that a patentee be free to inform a party who happens to be located in a particular forum of suspected infringement without risk of being subjected to a lawsuit in that forum.”<sup>81</sup>

#### D. Standing

Federal courts may only decide actual cases or controversies.<sup>82</sup> Accordingly, the courts have imposed standing requirements in order

72. *Id.* at 1372, 63 U.S.P.Q.2d (BNA) at 1071.

73. 279 F.3d 1351, 61 U.S.P.Q.2d (BNA) 1696 (Fed. Cir. 2002).

74. *Id.* at 1353, 61 U.S.P.Q.2d (BNA) at 1697.

75. *Id.* at 1354, 61 U.S.P.Q.2d (BNA) at 1698.

76. *Id.*, 61 U.S.P.Q.2d (BNA) at 1698.

77. *Id.* at 1355, 61 U.S.P.Q.2d (BNA) at 1698.

78. *Id.* at 1354, 61 U.S.P.Q.2d (BNA) at 1698.

79. *Id.*, 61 U.S.P.Q.2d (BNA) at 1698.

80. *Id.* at 1355-56, 61 U.S.P.Q.2d (BNA) at 1699-1700.

81. *Id.*, 61 U.S.P.Q.2d (BNA) at 1699 (citing *Red Wing Shoe Co. v. Hockerson-Halberstadt, Inc.*, 148 F.3d 1355, 1361, 47 U.S.P.Q.2d (BNA) 1192, 1197 (Fed. Cir. 1998)).

82. U.S. CONST. art. III, § 2.

to ensure that only actual cases or controversies are litigated.<sup>83</sup> In its only case addressing standing during this past year, the Federal Circuit determined that the plaintiff's lack of standing to sue did not affect the defendant's right to bring counterclaims related to unfair competition, tortious interference, and attorney fees.

In *H.R. Technologies, Inc. v. Astechologies, Inc.*,<sup>84</sup> the district court determined that the plaintiff lacked standing to sue for patent infringement because it did not own the relevant patent, and therefore granted the plaintiff's motion to dismiss the entire case without prejudice, including the defendant's counterclaims.<sup>85</sup> After determining that the district court's decision was an appealable final order, the Federal Circuit held that the district court properly dismissed the plaintiff's infringement action without prejudice because the plaintiff could simply execute a valid assignment to show ownership of the patent in question.<sup>86</sup> The Federal Circuit also affirmed the dismissal of the defendant's counterclaim for non-infringement because it also turned on the question of ownership.<sup>87</sup> However, the Federal Circuit determined that the district court improperly dismissed the defendant's counterclaims that were not affected by the standing defect because those claims did not depend upon ownership of the patent.<sup>88</sup> As a result, the Federal Circuit affirmed-in-part, vacated-in-part, and remanded the district court's decision.<sup>89</sup>

#### *E. Collateral Estoppel*

Collateral estoppel, or issue preclusion, prevents parties from litigating an issue of fact or law that was decided in a prior suit.<sup>90</sup>

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83. See, e.g., *Lujan v. Defenders of Wildlife*, 504 U.S. 555, 560 (1992) (“[T]he core component of standing is an essential and unchanging part of the case-or-controversy requirement of Article III.”).

84. 275 F.3d 1378, 61 U.S.P.Q.2d (BNA) 1271 (Fed. Cir. 2002).

85. *Id.* at 1381, 61 U.S.P.Q.2d (BNA) at 1272-73.

86. *Id.* at 1383-84, 61 U.S.P.Q.2d (BNA) at 1275.

87. *Id.* at 1386, 61 U.S.P.Q.2d (BNA) at 1276.

88. *Id.*, 61 U.S.P.Q.2d (BNA) at 1276.

89. *Id.*, 61 U.S.P.Q.2d (BNA) at 1277.

90. See *Adair v. Sherman*, 230 F.3d 890, 893 (7th Cir. 2000) (noting that “under the doctrine of issue preclusion, an issue may not be litigated if . . . : (1) the issue is the same as that involved in a prior action; (2) the issue was actually litigated; (3) the determination of the issue was essential to the final judgment; and (4) the party against whom estoppel is invoked was represented in the prior action.”); *Grosz v. City of Miami Beach*, 82 F.3d 1005, 1006 (11th Cir. 1996) (stating that collateral estoppel can foreclose relitigation of an issue of fact or law where that issue was fully litigated and decided in a prior suit).

Issue preclusion is not intended to “create vested rights in decisions that have become obsolete or erroneous over time”.<sup>91</sup>

In *Vardon Golf Co. v. Karsten Manufacturing Corp.*,<sup>92</sup> the Federal Circuit held that a non-final judgment could not be given preclusive effect even when Vardon had not exhausted its appellate remedies, including moving for certification of interlocutory appeal under Rule 54(b) of the Federal Rules of Civil Procedure, substituting the reissue patent at an appropriate time, or suspending the reissue proceedings before the USPTO.<sup>93</sup> Earlier, the district court granted partial summary judgment on the grounds that Karsten did not infringe certain claims of Vardon’s ‘941 patent.<sup>94</sup> Two months after the court granted partial summary judgment in Karsten’s favor, the ‘950 reissue patent was issued. Vardon surrendered the ‘941 patent in order to obtain the ‘950 reissue patent, thereby mooting the summary judgment on the ‘941 patent and extinguishing Vardon’s right to appeal.<sup>95</sup> Subsequently, the district court held that Vardon was collaterally estopped from asserting the reissue patent ‘950 against Karsten because Vardon failed to preserve its right to appeal the partial summary judgment.<sup>96</sup> The Federal Circuit explained that the decision with respect to the ‘941 patent claim was not final because it was not immune to reversal or modification.<sup>97</sup> Consequently, the Federal Circuit reversed the district court’s dismissal of Vardon’s complaint.<sup>98</sup>

Similarly, in *Bayer AG v. Biovail Corp.*,<sup>99</sup> the Federal Circuit held that Bayer was not collaterally estopped from suing Biovail.<sup>100</sup> In the prior action, the district court construed the claim in light of an Abbreviated New Drug Application (“ANDA”), whereas in the later action, information regarding actual products manufactured in accordance with the ANDA was submitted.<sup>101</sup> The Federal Circuit determined that the district court was required to construe the claim with respect to measurement of manufactured products as opposed to the specification contained in the ANDA that was the subject of the

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91. *Comm’r v. Sunnen*, 333 U.S. 591, 599 (1948).

92. 294 F.3d 1330, 63 U.S.P.Q.2d (BNA) 1468 (Fed. Cir. 2002).

93. *Id.* at 1334, 63 U.S.P.Q.2d (BNA) at 1471.

94. *Id.* at 1332, 63 U.S.P.Q.2d (BNA) at 1469.

95. *Id.*, 63 U.S.P.Q.2d (BNA) at 1469.

96. *Id.*, 63 U.S.P.Q.2d (BNA) at 1470.

97. *Id.* at 1334, 63 U.S.P.Q.2d (BNA) at 1471.

98. *Id.* at 1335, 63 U.S.P.Q.2d (BNA) at 1472.

99. 279 F.3d 1340, 61 U.S.P.Q.2d (BNA) 1675 (Fed. Cir. 2002).

100. *Id.* at 1342, 61 U.S.P.Q.2d (BNA) at 1676.

101. *Id.* at 1343, 61 U.S.P.Q.2d (BNA) at 1677-78.

prior action.<sup>102</sup> Further, with respect to manufactured products made in accordance with the ANDA specification of the prior action, the Federal Circuit held that “infringement under 35 U.S.C. § 271(e)(2)(A)<sup>103</sup> by submission of an ANDA is not synonymous with infringement under 35 U.S.C. § 271(a)<sup>104</sup> by a commercial product [and, therefore, the patentee should] have a full and fair opportunity to litigate the issue of infringement by the commercial product” despite a finding of non-infringement under § 271(e)(2)(A).<sup>105</sup> Specifically, the Federal Circuit determined that the district court’s prior construction of the claims of the patent at issue did not address the issues presented in the later case.<sup>106</sup> As a result, the Federal Circuit vacated the district court’s grant of summary judgment.<sup>107</sup>

The Federal Circuit addressed a related issue in *Ecolab Inc. v. Paraclypse, Inc.*<sup>108</sup> In that case, the Federal Circuit stated that a consent judgment between parties as to a certain product did not preclude the defendant from challenging the validity of the patent in a subsequent action alleging infringement by a new and different product.<sup>109</sup> The Federal Circuit indicated that the provisions of a consent judgment are to be construed narrowly and a party does not waive its right to challenge the validity of a patent as to future accused products absent clear intent to do so.<sup>110</sup> In that case, the language of the consent judgment was not clear because the defendant merely agreed that the patent in suit was valid.<sup>111</sup> Further, the record in the case showed that the accused devices at issue were not “essentially the same” in the prior case and the later suit.<sup>112</sup> As a result, the Federal Circuit remanded the case for a new trial where the defendant was entitled to challenge the validity of the patent.<sup>113</sup>

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102. *Id.* at 1349, 61 U.S.P.Q.2d (BNA) at 1682.

103. 35 U.S.C. § 271(e)(2)(A) (2000) (stating that it is an act of infringement to submit an application for a patent for a drug already claimed or the use of which is already claimed in a patent).

104. *Id.* § 271(a) (stating that whoever without the proper authority makes, uses, offers to sell, or sells any patented invention is infringing that patent).

105. *Bayer AG*, 279 F.3d at 1350, 61 U.S.P.Q.2d (BNA) at 1683.

106. *Id.* at 1349-50, 61 U.S.P.Q.2d (BNA) at 1682-83.

107. *Id.* at 1350, 61 U.S.P.Q.2d (BNA) at 1683.

108. 285 F.3d 1362, 62 U.S.P.Q.2d (BNA) 1349 (Fed. Cir. 2002).

109. *Id.* at 1377, 62 U.S.P.Q.2d (BNA) at 1359-60.

110. *Id.* at 1376, 62 U.S.P.Q.2d (BNA) at 1359 (quoting *Diversey Lever, Inc. v. Ecolab, Inc.*, 191 F.3d 1350, 1352, 52 U.S.P.Q.2d (BNA) 1062, 1064 (Fed. Cir. 1999)).

111. *Id.* at 1377, 62 U.S.P.Q.2d (BNA) at 1359.

112. *Id.*, 62 U.S.P.Q.2d (BNA) at 1359 (citation omitted in original).

113. *Id.* at 1378, 62 U.S.P.Q.2d (BNA) at 1360.

*F. Trial Procedures*

The Federal Circuit addressed various trial and post-trial procedural issues during the 2002 calendar year, including the appropriate timing of a motion for a judgment as a matter of law, the effect of erroneous jury instructions on claim construction, and the appropriate timing of a motion for relief from judgment.

In *Union Carbide Chemicals & Plastics Technology Corp. v. Shell Oil Co.*,<sup>114</sup> the Federal Circuit ruled that the district court erred in converting its grant of a new trial to a judgment as matter of law (“JMOL”) because the plaintiffs did not move for a JMOL before the case was submitted to the jury.<sup>115</sup> Thus, plaintiffs were not entitled to move for JMOL after the jury returned its verdict.<sup>116</sup>

In *Ecolab, Inc. v. Paraclipse, Inc.*,<sup>117</sup> the Federal Circuit held that the district court erred by erroneously instructing the jury in a patent infringement trial regarding issues of claim construction.<sup>118</sup> Particularly, the Federal Circuit noted that the claim for a lighted insect trap requires only that a housing “contain” a surface that reflects light, and because the ordinary meaning of “contain” is “to have within,” it was error to instruct the jury that the reflecting surfaces required by the claim were limited to surfaces located on the inside wall of the trap’s housing cover.<sup>119</sup> The Federal Circuit stated that because there was sufficient evidence to support a jury verdict of infringement under a correct interpretation of the claim, the plaintiff suffered prejudice from the district court’s error, and thus was entitled to a new trial.<sup>120</sup>

In *Fiskars Inc. v. Hunt Manufacturing Co.*,<sup>121</sup> the Federal Circuit concluded that a request for relief from judgment twenty-one months after entry of that judgment should be denied.<sup>122</sup> There, Hunt filed a motion for relief of judgment pursuant to Rules 60(b)(5) or (6) of the Federal Rules of Civil Procedure,<sup>123</sup> seeking to vacate the damages awarded based on new evidence allegedly showing that Fiskars was

114. 308 F.3d 1167, 64 U.S.P.Q.2d (BNA) 1545 (Fed. Cir. 2002).

115. *Id.* at 1187, 64 U.S.P.Q.2d (BNA) at 1559.

116. *Id.*, 64 U.S.P.Q.2d (BNA) at 1559.

117. 285 F.3d 1362, 62 U.S.P.Q.2d (BNA) 1349 (Fed. Cir. 2002).

118. *Id.* at 1365, 62 U.S.P.Q.2d (BNA) at 1350.

119. *Id.* at 1374, 62 U.S.P.Q.2d (BNA) at 1357.

120. *Id.* at 1376, 62 U.S.P.Q.2d (BNA) at 1358.

121. 279 F.3d 1378, 61 U.S.P.Q.2d (BNA) 1851 (Fed. Cir. 2002).

122. *Id.* at 1379, 61 U.S.P.Q.2d (BNA) at 1852.

123. FED. R. CIV. P. 60(b)(5) (providing relief when “it is no longer equitable that the judgment should have prospective application”); *id.* 60(b)(6) (providing relief from a final judgment “for any other reason justifying relief from the operation of the judgment”).



not entitled to lost profits.<sup>124</sup> The Federal Circuit held that Rule 60(b)(6) was available only in extraordinary circumstances, which were not present in the immediate case.<sup>125</sup> The Federal Circuit also rejected Hunt's argument that the damages for lost profits should be reassessed after the trial "if market data probative of acceptability becomes available once a non-infringing alternative replaces the infringing product in the marketplace."<sup>126</sup> As a result, the Federal Circuit agreed with the district court that evidence arising nearly two years after trial does not create the level of extraordinary circumstance necessary to invoke Rule 60(b)(6).<sup>127</sup> The Federal Circuit affirmed the district court's denial of the defendant's motion to reopen the case and vacate a damages judgment nearly two years after entry of that judgment.<sup>128</sup>

### G. USPTO Procedures

The Federal Circuit had occasion to address certain USPTO procedures in *Blacklight Power, Inc. v. Rogan*.<sup>129</sup> In that case, the Federal Circuit affirmed a decision by the U.S. District Court for the District of Columbia, finding that the Director of the USPTO had the authority to withdraw Blacklight's patent application from issue, following Notice of Allowance, payment of the issue fee, and notification of the issue date.<sup>130</sup> The USPTO withdrew Blacklight's application because there was concern that the patent application set forth a proposition contrary to the known laws of physics and chemistry, thus raising serious patentability problems.<sup>131</sup>

On appeal, Blacklight argued that 35 U.S.C. § 151 compelled issuance of the patent because it states that a patent should be issued when the fee is paid.<sup>132</sup> Moreover, Blacklight argued that 37 C.F.R. § 1.313, the regulation that the USPTO relied on to withdraw the application, contravenes the language of § 151.<sup>133</sup> The USPTO responded that its actions were proper because § 151 begins with the

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124. *Fiskars*, 279 F.3d at 1380, 61 U.S.P.Q.2d (BNA) at 1852-53.

125. *Id.* at 1382, 61 U.S.P.Q.2d (BNA) at 1854.

126. *Id.* at 1383, 61 U.S.P.Q.2d (BNA) at 1855.

127. *Id.*, 61 U.S.P.Q.2d (BNA) at 1855.

128. *Id.*, 61 U.S.P.Q.2d (BNA) at 1855.

129. 295 F.3d 1269, 63 U.S.P.Q.2d (BNA) 1534 (Fed. Cir. 2002).

130. *Id.* at 1270-71, 63 U.S.P.Q.2d (BNA) at 1535.

131. *Id.* at 1272, 63 U.S.P.Q.2d (BNA) at 1536.

132. *Id.* at 1273, 63 U.S.P.Q.2d (BNA) at 1537; 35 U.S.C. § 151 (2000).

133. *Blacklight Power*, 295 F.3d at 1272, 63 U.S.P.Q.2d (BNA) at 1536; see Rules of Practice in Patent Cases, 37 C.F.R. § 1.313(b) (2002) (explaining that once the issue fee is paid, the USPTO will not withdraw an application from issue for any reason unless: (1) there is a mistake by the USPTO; (2) there is an illegality in the application; (3) one or more claims are not patentable; or (4) there is interference).

conditional clause: "If it appears that applicant is entitled to a patent under the law"; however, here, Blacklight was not entitled to a patent under the law.<sup>134</sup> The Federal Circuit agreed with the USPTO, holding that, while the words "shall issue" impose a duty, the preface of § 151 makes that duty conditional.<sup>135</sup> Section 151 does not bar the USPTO from interrupting the sequence of action if it reasonably believes that this condition in the opening clause is not met, and thus, § 151 does not prohibit the USPTO from withdrawing a patent application after the issue fee is paid.<sup>136</sup> Blacklight argued that the USPTO did not make a final determination of unpatentability when it withdrew the application.<sup>137</sup> The USPTO stated that, although it could not make a final determination because the application was in Pennsylvania being prepared for patent printing, a related patent was reviewed and found to be unpatentable.<sup>138</sup> The district court found that at the time the patent was withdrawn regulation § 1.313(b)(3) did not require a final pronouncement.<sup>139</sup> The Federal Circuit agreed, holding that when there is a time restraint, the USPTO does not have to conclusively determine the outcome of a patent application because of the complexity of the examination process and the potential for human error.<sup>140</sup>

#### H. Deference Owed to the USPTO

In denying a petition for rehearing en banc in *Dethmers Manufacturing Co. v. Automatic Equipment Manufacturing Co.*,<sup>141</sup> the dissenting judges remarked upon the deference owed to the USPTO in its administration of its own procedural rules and the impact of that deference on the presumption that a patent is valid.<sup>142</sup> In the underlying case, the panel decision invalidated certain reissue claims based on a USPTO procedural rule that specified the content of a reissue oath or declaration.<sup>143</sup> One dissenting opinion argued that "once a patent issues, non-compliance with a procedural rule

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134. 35 U.S.C. § 151; *Blacklight Power*, 295 F.3d at 1273, 63 U.S.P.Q.2d (BNA) at 1537.

135. *Blacklight Power*, 295 F.3d at 1273, 63 U.S.P.Q.2d (BNA) at 1537.

136. *Id.*, 63 U.S.P.Q.2d (BNA) at 1537.

137. *Id.*, 63 U.S.P.Q.2d (BNA) at 1537.

138. *Id.* at 1271-72, 63 U.S.P.Q.2d (BNA) at 1536.

139. *Id.* at 1273, 63 U.S.P.Q.2d (BNA) at 1537.

140. *Id.* at 1273, 63 U.S.P.Q.2d (BNA) at 1537.

141. 293 F.3d 1364, 1365, 63 U.S.P.Q.2d (BNA) 1317-18 (Fed. Cir. 2002). There was a six-six split amongst the judges. Judges Newman, Lourie, Gajarsa, Dyk, Prost, and Linn chose to hear the case en banc. Judges Mayer, Michel, Rader, Clevenger, Schall, and Bryson declined to hear the case en banc. *Id.*

142. *Id.*, 63 U.S.P.Q.2d (BNA) at 1318 (Linn, J., dissenting).

143. *Id.*, 63 U.S.P.Q.2d (BNA) at 1318.

administered by [the USPTO] within the agency's statutory authority and found, by virtue of the grant of the patent, to have been satisfied during prosecution," is irrelevant.<sup>144</sup> The dissent further indicated that, as the result of the holding in the case, an examiner's misapplication of a USPTO procedural rule may invalidated a patent, contrary to the proposition of deference toward patent issues and supported by "a ground of invalidity not included in the exclusive list of grounds set forth in 35 U.S.C. § 282."<sup>145</sup> Accordingly, the dissent concluded that the holding failed to recognize the statutory presumption of validity to which every issued U.S. patent is entitled.<sup>146</sup> A second dissent argued that the USPTO should be afforded more deference in this particular area because a reviewing court is "ill-equipped to determine whether the USPTO received the information that it deems necessary for an examination."<sup>147</sup>

### I. Miscellaneous Procedural Issues

In *Genetech, Inc. v. Amgen, Inc.*,<sup>148</sup> the Federal Circuit reversed the district court's grant of summary judgment for non-infringement based on an erroneous claim construction.<sup>149</sup> However, the Federal Circuit affirmed the district court's order barring Genetech from proceeding on a theory of infringement under the doctrine of equivalents because Genetech failed to allege such theories in its claim charts as required under the Local Rules for the Northern District of California.<sup>150</sup> Specifically, the Federal Circuit noted that the philosophy behind amending claim charts is decidedly conservative and designed to prevent the "shifting sands" approach to claim construction.<sup>151</sup> Thus, despite Genetech's argument that it interpreted the local rule as requiring a claim chart listing whether the claimed infringement is literal *or* under the doctrine of equivalents, and that Amgen had prior notice of equivalence arguments and therefore was not prejudiced, the Federal Circuit

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144. *Id.* at 1366, 63 U.S.P.Q.2d (BNA) at 1318.

145. *Id.* at 1366, 63 U.S.P.Q.2d (BNA) at 1318; 35 U.S.C. § 282 (2000) (establishing four defenses for an action involving the validity or infringement of a patent).

146. *Dethmers Mfg.*, 293 F.3d at 1366, 63 U.S.P.Q.2d (BNA) at 1318 (Linn, J., dissenting).

147. *Id.* at 1367, 63 U.S.P.Q.2d (BNA) at 1319 (Dyk, J., dissenting).

148. 289 F.3d 761, 62 U.S.P.Q.2d (BNA) 1640 (Fed. Cir. 2002).

149. *Id.* at 764, 62 U.S.P.Q.2d (BNA) 1642.

150. *Id.*, 62 U.S.P.Q.2d (BNA) at 1642.

151. *Id.* at 774, 62 U.S.P.Q.2d (BNA) at 1649 (quoting *Amtel Corp. v. Info Storage Devices, Inc.*, 1998 WL 775115 at 2 (N.D. Cal. Nov. 5, 1998)) (quotation omitted).

upheld the order because there were no allegations of legal or factual error, and the district court's ruling was not clearly erroneous.<sup>152</sup>

In *TechSearch L.L.C. v. Intel Corp.*,<sup>153</sup> the Federal Circuit found that the district court did not abuse its discretion in its appointment and use of a technical advisor.<sup>154</sup> Predicting how the regional circuit would decide this issue of first impression, the Federal Circuit outlined the parameters for the use of a technical advisor.<sup>155</sup> The Federal Circuit explained that the district court must: "[1] use a fair and open procedure for appointing a technical advisor and address any allegations of bias, partiality, or lack of qualifications in the candidates; [2] clearly define and limit the technical advisor's duties, presumably in a writing made known to all parties; [3] guard against extra-record information; and [4] make explicit []the nature and content of the technical advisor's tutelage concerning the technology."<sup>156</sup> In reaching its decision, the Federal Circuit noted that the district court established sufficient protective measures to ensure that the advisor did not improperly influence the district court's consideration of the evidence.<sup>157</sup> The district court's failure to subject the technical advisor to cross-examination by the parties did not constitute reversible error because the advisor, unlike an expert witness for the parties, may not be relied upon as source of evidence.<sup>158</sup> Furthermore, the record did not suggest that the advisor conducted independent experiments or research that could have been used to resolve disputed issues of fact.<sup>159</sup>

## II. PATENTABILITY AND VALIDITY

In 2002, the Federal Circuit continued to address several important issues relating to patentability and validity. For example, on a few occasions the Federal Circuit confirmed the existence of "prosecution history laches," holding that unreasonable and unexplained delay in prosecution may be applied to bar enforcement of patent claims.<sup>160</sup> The Federal Circuit also rejected attempts to expand the applicability

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152. *Id.*, 62 U.S.P.Q.2d (BNA) at 1649.

153. 286 F.3d 1360, 62 U.S.P.Q.2d (BNA) 1449 (Fed. Cir. 2002).

154. *Id.* at 1379, 62 U.S.P.Q.2d (BNA) at 1462.

155. *Id.* at 1378, 62 U.S.P.Q.2d (BNA) at 1461.

156. *Id.* at 1379, 62 U.S.P.Q.2d (BNA) at 1461-62 (quoting *Ass'n of Mexican Am. Educators v. California*, 231 F.3d 572, 611 (9th Cir. 2000)).

157. *Id.*, 62 U.S.P.Q.2d (BNA) at 1462-63.

158. *Id.* at 1380, 62 U.S.P.Q.2d (BNA) at 1463.

159. *Id.*, 62 U.S.P.Q.2d (BNA) at 1463.

160. *See, e.g., In re Bogese II*, 303 F.3d 1362, 1367, 64 U.S.P.Q.2d (BNA) 1448, 1452 (Fed. Cir. 2002); *Symbol Tech., Inc. v. Lemelson Med., Educ. & Research Found.*, 277 F.3d 1361, 1364-68, 61 U.S.P.Q.2d (BNA) 1515, 1517-20 (Fed. Cir. 2002).

of inherent anticipation, noting that inherent anticipation is not a substitute for a well-reasoned obviousness analysis.<sup>161</sup> The following section presents a general overview of some of the more important cases from 2002 addressing issues relating to patentability and validity.

A. 35 U.S.C. § 102<sup>162</sup>

1. *Anticipation*

“Invalidity based on ‘anticipation’ requires that the invention is not in fact new.”<sup>163</sup> Anticipation may be supported by a single reference describing the claimed invention with enough detailed precision to establish the subject matter as existing in the prior art.<sup>164</sup>

In *Verve L.L.C. v. Crane Cams, Inc.*, the patent in suit related to improved push rods for internal combustion engines.<sup>165</sup> The Federal Circuit held that the district court erred in refusing to consider extrinsic evidence in construing the phrase “substantially constant wall thickness” and in determining that the phrase was indefinite.<sup>166</sup> The Federal Circuit also reversed the district court’s holding on summary judgment that the patent in suit was invalid based on anticipation, holding that the plaintiff’s Japanese patents on their face did not show the push rods of the patent in suit.<sup>167</sup> In particular, unlike the patent in suit, the Japanese push rods were not wider at the mid-portion but were of a uniform lengthwise diameter.<sup>168</sup> Accordingly, on these undisputed facts, the Federal Circuit held that “no reasonable trier of fact could find that [the patent was] anticipated by the Japanese references.”<sup>169</sup>

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161. See, e.g., *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1297, 63 U.S.P.Q.2d (BNA) 1597, 1600-01 (Fed. Cir. 2002).

162. 35 U.S.C. § 102 (2000) (describing the conditions for patentability). A person is entitled to a patent unless: (a) the invention is used or patented already; (b) the invention was in public use or for sale more than one year prior to the date of application; (c) the invention is abandoned; (d) the invention was patented in another country prior to the date of application in the United States; (e) the invention was described in another patent application; (f) the subject matter was not in fact invented by the applicant; or (g) the invention was first the work product of another person. *Id.*

163. *Verve L.L.C. v. Crane Cams, Inc.*, 311 F.3d 1116, 1120, 65 U.S.P.Q.2d (BNA) 1051, 1054 (Fed. Cir. 2002) (quoting *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302, 36 U.S.P.Q.2d (BNA) 1101, 1103 (Fed. Cir. 1995)).

164. *Id.*, 65 U.S.P.Q.2d (BNA) at 1054.

165. *Id.* at 1117, 65 U.S.P.Q.2d (BNA) at 1052.

166. *Id.* at 1120, 65 U.S.P.Q.2d (BNA) at 1054.

167. *Id.* at 1120-21, 65 U.S.P.Q.2d (BNA) at 1054-55.

168. *Id.* at 1121, 65 U.S.P.Q.2d (BNA) at 1054-55.

169. *Id.*, 65 U.S.P.Q.2d (BNA) at 1055.

The Federal Circuit addressed the issue of inherent anticipation on several occasions in 2002. Under the doctrine of inherency, even though an element is not expressly disclosed in a prior art reference, the reference is still “deemed to anticipate a subsequent claim if the missing element ‘is necessarily present in the thing described in the reference, and if it would be so recognized by persons of ordinary skill.’”<sup>170</sup> Inherent anticipation requires that the missing descriptive material is “necessarily present” in the prior art, not merely probably or possibly present.<sup>171</sup>

In *Rosco, Inc. v. Mirror Lite Co.*,<sup>172</sup> the two parties were competitors in the school bus mirror market. Each owned a patent and each claimed that the other infringed its patent. In particular, Rosco’s design patent related to an oval, highly convex, cross-view mirror with a black, flat metal backing. Mirror Lite’s utility patent related to an oval cross-view mirror with a varying radius of curvature along the major axis of the convex ellipsoid mirror lens. In a bench trial, the district court found, inter alia, Rosco’s design patent was invalid as functional and obvious, and Mirror Lite’s utility patent was invalid as anticipated under 35 U.S.C. §§ 102(e) and 102(g).<sup>173</sup> With respect to Mirror Lite’s utility patent, the district court found the claims invalid under § 102(e) based on anticipation by an earlier-filed U.S. application and under § 102(g) based on prior invention “‘by another.’”<sup>174</sup>

On appeal, the Federal Circuit noted that when determining the invalidity of patent claims, each claim must be considered separately.<sup>175</sup> In particular, each claim of a patent shall be presumed valid independently of the validity of the other claims.<sup>176</sup> Here, the Federal Circuit held that the lower court erred by failing to explicitly address and analyze each claim.<sup>177</sup>

The district court also found that the design patent inherently disclosed the invention of the utility patent under § 102(e), allowing one skilled in the art to read the design patent as disclosing a mirror with a varying radius of curvature based on the inherent nature of those characteristics.<sup>178</sup> The district court concluded that “‘one skilled

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170. *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1380, 64 U.S.P.Q.2d (BNA) 1676, 1680 (Fed. Cir. 2002) (quoting *Cont’l Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d (BNA) 1746, 1749 (Fed. Cir. 1991)).

171. *Id.*, 64 U.S.P.Q.2d (BNA) at 1680.

172. 304 F.3d 1373, 64 U.S.P.Q.2d (BNA) 1676 (Fed. Cir. 2002).

173. *Id.* at 1376, 64 U.S.P.Q.2d (BNA) at 1677.

174. *Id.* at 1381, 64 U.S.P.Q.2d (BNA) at 1681 (quoting U.S.C. § 102 (g) (2) (2000)).

175. *Id.* at 1379, 64 U.S.P.Q.2d (BNA) at 1680.

176. *Id.* at 1380, 64 U.S.P.Q.2d (BNA) at 1680 (quoting U.S.C. § 102 (g) (2) (2000)).

177. *Id.*, 64 U.S.P.Q.2d (BNA) at 1680.

178. *Id.*, 64 U.S.P.Q.2d (BNA) at 1680 (quoting *Rosco, Inc. v. Mirror Lite Co.*, 139 F.

in the art could produce the results claimed in the [utility patent] simply by practicing the [design patent], *i.e.*, the result flows naturally from the express disclosure of the design patent whether or not others are aware of it.”<sup>179</sup> The Federal Circuit held that the district court erred because no evidence was presented suggesting that the design patent inherently discloses to one of ordinary skill a mirror with a varying radius of curvature along the major axis.<sup>180</sup>

The district court also found certain claims of the utility patent were invalid under § 102(g)<sup>181</sup> in view of Rosco’s pre-1992 products, thus concluding that Rosco made the invention of the utility patent before the critical date.<sup>182</sup> In reversing the district court, the Federal Circuit held that uncorroborated testimony of prior inventorship is insufficient to constitute clear and convincing evidence of conception of the invention prior to the critical date.<sup>183</sup>

In *Trintec Industries, Inc. v. Top-U.S.A. Corp.*,<sup>184</sup> the Federal Circuit vacated and remanded the district court’s grant of summary judgment that the patent at issue was invalid as inherently anticipated.<sup>185</sup> The Federal Circuit determined that a prior art catalogue that taught the use of a color printer did not inherently anticipate a claim that recited a color photocopier.<sup>186</sup> Although the Federal Circuit conceded that the difference may be “minimal and obvious,” it noted that “obviousness is not inherent anticipation.”<sup>187</sup> With respect to another asserted claim, the Federal Circuit determined that the prior art catalog did not inherently teach the required claim element of creating artwork on a computer.<sup>188</sup> The Federal Circuit remanded the case noting that because obviousness seemed to be the actual question at issue, it could only be properly addressed with a fully developed record.<sup>189</sup>

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Supp. 2d 287, 301 (E.D.N.Y. 2001).

179. *Id.*, 64 U.S.P.Q.2d (BNA) at 1680 (quoting *Rosco, Inc.*, 139 F. Supp. 2d at 300).

180. *Id.* at 1381, 64 U.S.P.Q.2d (BNA) at 1680-81.

181. *Id.*, 64 U.S.P.Q.2d (BNA) at 1681. A patent is invalid if “before [the applicant’s] invention thereof, the invention was made in this country by another who had not abandoned, suppressed or concealed it.” 35 U.S.C. § 102(g)(2) (2000).

182. *Rosco*, 304 F.3d at 1381, 64 U.S.P.Q.2d (BNA) at 1681.

183. *Id.* at 1382, 64 U.S.P.Q.2d (BNA) at 1681.

184. 295 F.3d 1292, 63 U.S.P.Q.2d (BNA) 1597 (Fed. Cir. 2002).

185. *Id.* at 1297, 63 U.S.P.Q.2d (BNA) at 1601.

186. *Id.* at 1296, 63 U.S.P.Q.2d (BNA) at 1600.

187. *Id.*, 63 U.S.P.Q.2d (BNA) at 1600 (citing *Jones v. Hardy*, 727 F.2d 1524, 1529, 220 U.S.P.Q. (BNA) 1021, 1025 (Fed. Cir. 1984)).

188. *Id.* at 1297, 63 U.S.P.Q.2d (BNA) at 1600-01.

189. *Id.*, 63 U.S.P.Q.2d (BNA) at 1601.

## 2. *On-sale bar and public use*

An inventor is entitled to a patent unless the invention was in public use or on sale in this country more than one year prior to the date of application for the patent in the United States.<sup>190</sup>

In *Allen Engineering Corp. v. Bartell Industries, Inc.*,<sup>191</sup> Allen Engineering and Bartell both produced concrete riding trowels used to smooth the surface of new concrete.<sup>192</sup> The Federal Circuit held in this case that the district court failed to properly construe claim limitations and failed to make adequate findings on infringement.<sup>193</sup> In addition, the Federal Circuit held that the district court failed to apply the proper legal test in considering whether Allen's sales of the Red Rider trowel more than one year prior to the filing date of the patent in suit constituted an on-sale bar to the patenting of the invention.<sup>194</sup> Thus, the Federal Circuit vacated the district court's finding that the patent in suit was not invalid based on an on-sale bar.<sup>195</sup>

With respect to on-sale bar, the Court noted that "to establish an on-sale bar, it must be shown that the device that was 'sold fully anticipated the claimed invention or would have rendered the claimed invention obvious by its addition to the prior art.'"<sup>196</sup> Allen argued that the Red Rider was sold only for experimental reasons and that it was not ready for patenting.<sup>197</sup> In determining whether or not Allen's sales were experimental or sufficient to constitute an on-sale bar, the Federal Circuit evaluated the record under the well-established two-prong test set forth in *Pfaff v. Wells Electronics Inc.*<sup>198</sup>

Under the "*Pfaff* test," to constitute an on-sale bar, it must be shown that the subject product was both (1) the subject of a commercial offer for sale not primarily for purposes of experimentation, and (2) ready for patenting.<sup>199</sup> The first prong of this test "involves a determination of whether a commercial offer for sale occurred, applying traditional contract law principles."<sup>200</sup> It also involves an assessment of whether the circumstances surrounding the transaction show that the transaction

190. 35 U.S.C. § 102(b) (2000).

191. 299 F.3d 1336, 63 U.S.P.Q.2d (BNA) at 1769 (Fed. Cir. 2002).

192. *Id.* at 1342, 63 U.S.P.Q.2d (BNA) at 1770.

193. *Id.*, 63 U.S.P.Q.2d (BNA) at 1770.

194. *Id.*, 63 U.S.P.Q.2d (BNA) at 1770.

195. *Id.*, 63 U.S.P.Q.2d (BNA) at 1770.

196. *Id.* at 1352, 63 U.S.P.Q.2d (BNA) at 1778 (quoting *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1358, 52 U.S.P.Q.2d (BNA) at 1294, 1296-97 (Fed. Cir. 1999) (quotation omitted)).

197. *Id.*, 63 U.S.P.Q.2d (BNA) at 1778.

198. 525 U.S. 55, 48 U.S.P.Q.2d (BNA) 1641 (Fed. Cir. 1998).

199. *Id.* at 67, 48 U.S.P.Q.2d (BNA) at 1646-47.

200. *Allen Eng'g*, 299 F.3d at 1352, 63 U.S.P.Q.2d (BNA) at 1778.



was not primarily for purposes of experimentation.<sup>201</sup> This prong is satisfied “by proof of reduction to practice before the critical date; or by proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention.”<sup>202</sup> The on-sale bar is evaluated claim-by-claim, barring some claims but not others.<sup>203</sup>

The Federal Circuit held that the district court erred in concluding that Red Rider sales did not trigger an on-sale bar solely because the Red Rider was in an experimental stage.<sup>204</sup> As the Federal Circuit noted, this conclusion alone is insufficient, stating “What is important to an assessment of the commercial versus experimental significance of a sale is not necessarily the posture of the invention’s overall development, but the nature or purpose of the particular use to which the invention that is the subject of that sale is to be put.”<sup>205</sup> The proper question posed by the experimental use doctrine, using the first prong of the *Pfaff* on-sale bar test, does not ask whether the invention was in a developmental or experimental stage when the sale allegedly took place; but whether the purpose of the inventor at the time of that sale, “as determined from an objective evaluation of the facts surrounding the transaction,” was to further development or experimentation.<sup>206</sup> If there is sufficient evidence that a device was sold for experimentation purposes, the first prong of *Pfaff* would not be satisfied and there would be no need to consider “whether the device was an embodiment of the claimed invention or whether the invention was ready for patenting at the time of the sales.”<sup>207</sup> In vacating the district court’s decision, the Federal Circuit instructed the lower court to assess whether the surrounding circumstances show that the transaction was not primarily for purposes of experimentation.<sup>208</sup> In so doing, the district court should consider the principles enumerated in *EZ Dock v. Schafer Systems, Inc.* and in the present case.<sup>209</sup>

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201. *Id.* at 1352-53, 63 U.S.P.Q.2d (BNA) at 1779.

202. *Id.* at 1353, 63 U.S.P.Q.2d (BNA) at 1779 (quoting *Pfaff*, 525 U.S. 55, 48 U.S.P.Q.2d (BNA) 1641).

203. *Id.*, 63 U.S.P.Q.2d (BNA) at 1779.

204. *Id.*, 63 U.S.P.Q.2d (BNA) at 1779.

205. *Id.* at 1354, 63 U.S.P.Q.2d (BNA) at 1779.

206. *Id.*, 63 U.S.P.Q.2d (BNA) at 1780 (quoting *Scaltech, Inc. v. Retec/Tetra, L.L.C.*, 178 F.3d 1378, 1384 n.1, 51 U.S.P.Q.2d (BNA) 1055, 1059 n.1 (Fed. Cir. 1999)).

207. *Id.* at 1353, 63 U.S.P.Q.2d (BNA) at 1779.

208. *Id.* at 1354, 63 U.S.P.Q.2d (BNA) at 1780.

209. *Id.* at 1353, 63 U.S.P.Q.2d (BNA) at 1778-79 (citing *EZ Dock*, 276 F.3d 1347, 1357, 61 U.S.P.Q.2d (BNA) 1289, 1296 (Fed. Cir. 2002)); see *infra* notes 236-39 and accompanying text (describing the holding of *EZ Dock* that evidence of experimental use operates to negate application of the statutory on-sale bar).

In *Netscape Communications Corp. v. Konrad*,<sup>210</sup> the Federal Circuit affirmed the district court's grant of summary judgment on the claim of invalidity of Konrad's patents under the public use and on-sale bars of 35 U.S.C. § 102(b).<sup>211</sup> In so doing, the Federal Circuit determined that Konrad made no discernable effort to maintain the confidentiality of his inventions after showing them to others prior to the critical date.<sup>212</sup> The Federal Circuit further found that Konrad presented no objective evidence to support an argument for experimental use.<sup>213</sup> With respect to the on-sale bar, the Federal Circuit concluded that Konrad's purchase order constituted a commercial offer for sale because the one party to the purchase order did not so control the other party as to keep the invention out of the public's hands.<sup>214</sup>

In *In re Kollar*,<sup>215</sup> the Federal Circuit reversed the USPTO Board of Patent Appeals and Interferences (Board) determination that Kollar's patent application was barred under 35 U.S.C. § 102(b).<sup>216</sup> Kollar's patent application was directed to a process for preparing a dialkyl peroxide by reacting one or more alcohols and/or an olefin with a monoalkyl hydroperoxide in the presence of an acidic catalyst.<sup>217</sup> The Board sustained a rejection of the claims under § 102(b) based on a sale of the technology by Redox Technologies, a company owned by Kollar, to Celanese Corporation.<sup>218</sup> The Federal Circuit upheld the Board's determination that the claimed invention was ready to patent under *Pfaff* because of Kollar's reduction to practice.<sup>219</sup>

The Federal Circuit determined that the Board erred in finding that the invention was the subject of a commercial offer for sale under the first prong of *Pfaff*.<sup>220</sup> Specifically, the Federal Circuit found that under the Celanese contract, Redox agreed to share technical information regarding the claimed process during the "R&D Phase" in exchange for annual royalty payments.<sup>221</sup> The Federal Circuit said that although the Celanese agreement "specifically contemplates that 'resultant products' manufactured using the claimed process could potentially be sold," the agreement does not indicate that a product derived from the

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210. 295 F.3d 1315, 63 U.S.P.Q.2d (BNA) 1580 (Fed. Cir. 2002).

211. *Id.* at 1318, 63 U.S.P.Q.2d (BNA) at 1581-82.

212. *Id.* at 1321, 63 U.S.P.Q.2d (BNA) at 1584.

213. *Id.*, 63 U.S.P.Q.2d (BNA) at 1584.

214. *Id.* at 1324, 63 U.S.P.Q.2d (BNA) at 1586.

215. 286 F.3d 1326, 62 U.S.P.Q.2d (BNA) 1425 (Fed. Cir. 2002).

216. *Id.* at 1328, 62 U.S.P.Q.2d (BNA) at 1426.

217. *Id.*, 62 U.S.P.Q.2d (BNA) at 1426.

218. *Id.* at 1328-29, 62 U.S.P.Q.2d (BNA) at 1426-27.

219. *Id.* at 1330, 62 U.S.P.Q.2d (BNA) at 1428 (citation omitted in original).

220. *Id.*, 62 U.S.P.Q.2d (BNA) at 1428.

221. *Id.*, 62 U.S.P.Q.2d (BNA) at 1428 (citation omitted in original).

process was in fact offered for sale.<sup>222</sup> Rather, the court reasoned that the agreement was a license to Celanese under all future patents concerning Kollar's invention and that granting a license to an invention does not alone trigger the on-sale bar of § 102(b).<sup>223</sup> The Federal Circuit held that "the right to commercialize" the invention granted to Celanese in the form of a license pursuant to the agreement was insufficient" to bar Kollar's patent application claims under § 102(b).<sup>224</sup>

Additionally, the Federal Circuit noted the Board's failure to distinguish between a claim to a tangible item—a product, device, or apparatus—and a claim to a process—a series of acts or steps, and held that the Board erred in failing to recognize that a process is not sold in the same sense as a tangible item.<sup>225</sup> The Federal Circuit found that the know-how describing the process may be sold, i.e., giving a buyer the freedom to carry out the process pursuant to the terms of an agreement. However, this does not constitute a sale of the invention under § 102(b) because the process has not used as a result of the transaction.<sup>226</sup> Thus, the Federal Circuit reversed the Board conclusion that the license to a process under a future patent, along with a description of the process, constitutes a sale of the subject matter of the patents.<sup>227</sup>

In *Juicy Whip, Inc. v. Orange Bang, Inc.*,<sup>228</sup> the Federal Circuit reversed and remanded a district court ruling in favor of the defendants that the patent at issue was invalid on the basis of prior use and unenforceability.<sup>229</sup> The Federal Circuit found that there was no substantial evidence to support the jury's verdict that the claims at issue were invalid because of prior use, as the record was devoid of evidence proving that the apparatus satisfied every limitation of the claimed invention.<sup>230</sup> The Federal Circuit also held that uncorroborated oral testimony presented to show prior public use did not rise to the level of "clear and convincing evidence necessary to invalidate the patent for prior public knowledge."<sup>231</sup>

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222. *Id.*, 62 U.S.P.Q.2d (BNA) at 1428 (citation omitted in original).

223. *Id.* at 1330-31, 62 U.S.P.Q.2d (BNA) at 1428.

224. *Id.* at 1331, 62 U.S.P.Q.2d (BNA) at 1428 (citation omitted in original).

225. *Id.* at 1332, 62 U.S.P.Q.2d (BNA) at 1429.

226. *Id.*, 62 U.S.P.Q.2d (BNA) at 1429.

227. *Id.*, 62 U.S.P.Q.2d (BNA) at 1429.

228. 292 F.3d 728, 63 U.S.P.Q.2d (BNA) 1251 (Fed. Cir. 2002).

229. *Id.* at 731, 63 U.S.P.Q.2d (BNA) at 1252.

230. *Id.* at 738, 63 U.S.P.Q.2d (BNA) at 1257-58.

231. *Id.* at 743, 63 U.S.P.Q.2d (BNA) at 1262.

In *Dana Corp. v. American Axle & Manufacturing, Inc.*,<sup>232</sup> the Federal Circuit vacated the district court's grant of summary judgment on the claim of patent invalidity under 35 U.S.C. § 102(b).<sup>233</sup> In vacating the grant of summary judgment, the Federal Circuit stressed that the trial court "should determine 'whether the subject of the barring activity met each of the limitations of the claim, and thus was an embodiment of the claimed invention'" as required by § 102(b).<sup>234</sup> Further, the Federal Circuit reiterated that dependant claims "cannot be invalidated in a wholesale fashion," but must be individually presumed valid and independently evaluated, because "dependent claims necessarily add limitations to claims from which they depend and may therefore not be subject to the same asserted grounds of invalidity."<sup>235</sup>

As previously noted, the Federal Circuit in *EZ Dock, Inc. v. Schafer Systems Inc.*,<sup>236</sup> also addressed the on-sale bar rule. In this case, the district court granted the defendant's motion for summary judgment declaring EZ Dock's patent relating to a floating dock invalid because the dock in question was on sale in this country more than one year before the filing date.<sup>237</sup> On appeal, the Federal Circuit vacated and remanded the case, holding that a reasonable jury could find that the on-sale bar was inapplicable insofar as the sale was for an experimental use.<sup>238</sup> In finding that the sale could have been for experimental and not commercial use, the court noted that the single sale at issue was made without advertisement, the buyer paid less than full price, and the inventors visited the site location where the device was installed.<sup>239</sup>

In *New Railhead Manufacturing Co. v. Vermeer Manufacturing Co.*,<sup>240</sup> the Federal Circuit affirmed a decision by the U.S. District Court for the Northern District of Texas that invalidated New Railhead's patents on a drill bit and a method of horizontal drilling under 35 U.S.C. § 102(b).<sup>241</sup> With regard to the patent for a horizontal drilling method, the district court found that a third party, Mr. Freeman, was permitted to use the method more than a year prior to patent application.<sup>242</sup> Though New Railhead argued that Mr. Freeman's use was

232. 279 F.3d 1372, 61 U.S.P.Q.2d (BNA) 1609 (Fed. Cir. 2002).

233. *Id.* at 1374, 61 U.S.P.Q.2d (BNA) at 1609.

234. *Id.* at 1375-76, 61 U.S.P.Q.2d (BNA) at 1611 (quoting *Scaltech, Inc. v. Retec/Tetra, L.L.C.*, 178 F.3d 1378, 1383, 51 U.S.P.Q.2d (BNA) 1055, 1058 (Fed. Cir. 1999)).

235. *Id.* at 1376, 61 U.S.P.Q.2d (BNA) at 1611-12.

236. 276 F.3d 1347, 61 U.S.P.Q.2d (BNA) 1289 (Fed. Cir. 2002).

237. *Id.* at 1350, 61 U.S.P.Q.2d (BNA) at 1291.

238. *Id.* at 1353-54, 61 U.S.P.Q.2d (BNA) at 1293.

239. *Id.* at 1352-53, 61 U.S.P.Q.2d (BNA) at 1292-93.

240. 298 F.3d 1290, 63 U.S.P.Q.2d (BNA) 1843 (Fed. Cir. 2002).

241. *Id.* at 1292, 63 U.S.P.Q.2d (BNA) at 1844.

242. *Id.* at 1297-98, 63 U.S.P.Q.2d (BNA) at 1848-49.

experimental, the Federal Circuit found that his use of the patented method was public because the drilling was at a commercial jobsite on public land next to an interstate highway.<sup>243</sup> Despite the fact that the inventor continued to modify the drill bit itself, Mr. Freeman's use of the patented method met every claim limitation of the method patent.<sup>244</sup> Therefore, the Federal Circuit held that the drilling method was in public use and the patent was invalid under section 102(b).<sup>245</sup>

Judge Dyk, dissenting-in-part, stated that the drill bit was inextricably intertwined with the method of drilling so that experimental use of the bit constituted experimental use of the method.<sup>246</sup> He went on to say that the use of the method was not public because it was confidential.<sup>247</sup> The test for secret public use is whether the inventor (as opposed to a third party) makes a profit from the use, and in this case there was no such profit.<sup>248</sup>

*B. 35 U.S.C. § 103—Obviousness*<sup>249</sup>

Obviousness is a legal conclusion based on underlying facts of four general types, all of which must be considered by the trier of fact: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) any objective indicia of non-obviousness.<sup>250</sup> "Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention."<sup>251</sup> In addition, the motivation to follow particular sources and select and combine particular elements must be taught or suggested by the prior art, the nature of the problem to be solved, or the general knowledge one ordinarily skilled in the field.<sup>252</sup>

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243. *Id.* at 1298, 63 U.S.P.Q.2d (BNA) at 1849.

244. *Id.* at 1299, 63 U.S.P.Q.2d (BNA) at 1850.

245. *Id.*, 63 U.S.P.Q.2d (BNA) at 1850.

246. *Id.* at 1301, 63 U.S.P.Q.2d (BNA) at 1852 (Dyk, J., concurring in part and dissenting in part).

247. *Id.* at 1300, 63 U.S.P.Q.2d (BNA) at 1850-51.

248. *Id.* at 1301, 63 U.S.P.Q.2d (BNA) at 1851.

249. 35 U.S.C. § 103 (2000) (establishing conditions on patentability for non-obvious subject matter). A patent cannot be obtained if the differences between the subject matter to be patented and the prior art are so minimal that the subject matter, as a whole, would have been obvious to a person of normal skill in the art. *Id.*

250. *See* *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 U.S.P.Q. (BNA) 459, 467 (1966).

251. *Crown Operations Int'l, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 1376, 62 U.S.P.Q.2d (BNA) 1917, 1922 (Fed. Cir. 2002) (quoting *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 U.S.P.Q.2d (BNA) 1321, 1329 (Fed. Cir. 1998)).

252. *Id.*, 62 U.S.P.Q.2d (BNA) at 1922

In *Novo Nordisk A/S v. Becton Dickinson & Co.*,<sup>253</sup> the Federal Circuit affirmed a Southern District of New York jury verdict that Novo Nordisk's patents for a pen-shaped insulin delivery system for diabetics were invalid as obvious.<sup>254</sup> The diameter of the needle used in the system was central to the case. The claims-at-issue were directed to an insulin-delivery pen with a needle that was thinner than twenty-nine gauge (the higher gauge, the thinner the needle).<sup>255</sup> The prior art included pen systems with lower gauge needles and systems not involving pens but with higher gauge needles.<sup>256</sup> The Federal Circuit found that there was a motivation to combine technologies and create a pen with a thinner needle to reduce pain.<sup>257</sup> The Federal Circuit also stated that Becton's arguments about patent monopolies and overworked, inexperienced, and error-prone patent examiners did not warrant a new trial, because Novo Nordisk failed to object at trial or raise these issues by post-trial motion.<sup>258</sup>

In *In re Sastry*,<sup>259</sup> the Federal Circuit affirmed the Board's determination that Sastry's claimed invention was obvious.<sup>260</sup> The invention was a method for treating and preventing the Human Immunodeficiency Virus (HIV).<sup>261</sup> The invention required two peptides, the first being a cytotoxic T lymphocyte ("CTL")-inducing peptide and the second being selected from a group of peptides that assist the immune response elicited by the first peptide by ensuring that the body maintains a large population of uninfected T helper cells.<sup>262</sup>

The Board sustained a rejection of all of Sastry's claims as being obvious over Arlinghaus (which teaches the first peptide) in conjunction with references that teach the second peptide.<sup>263</sup> On appeal, Sastry conceded that the first and second peptides were taught by the prior art, but argued that there was no motivation to combine the references.<sup>264</sup> The Federal Circuit held that Arlinghaus provided a roadmap for combining the peptides by disclosing two peptide-based compositions that have CTL-inducing properties and that contain

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253. 304 F.3d 1216, 64 U.S.P.Q.2d (BNA) 1524 (Fed. Cir. 2002).

254. *Id.* at 1218, 64 U.S.P.Q.2d (BNA) at 1525.

255. *Id.*, 64 U.S.P.Q.2d (BNA) at 1525.

256. *Id.* at 1218-19, 64 U.S.P.Q.2d (BNA) at 1525-26.

257. *Id.* at 1219, 64 U.S.P.Q.2d (BNA) at 1526.

258. *Id.* at 1220, 64 U.S.P.Q.2d (BNA) at 1526-27.

259. 285 F.3d 1378, 62 U.S.P.Q.2d (BNA) 1436 (Fed. Cir. 2002).

260. *Id.* at 1379, 62 U.S.P.Q.2d (BNA) at 1436.

261. *Id.*, 62 U.S.P.Q.2d (BNA) at 1436.

262. *Id.* at 1380, 62 U.S.P.Q.2d (BNA) at 1437.

263. *Id.*, 62 U.S.P.Q.2d (BNA) at 1437-38.

264. *Id.* at 1381, 62 U.S.P.Q.2d (BNA) at 1438.

peptides that satisfy the requirements of Sastry's second peptide, including eliciting a low-level antibody-mediated response.<sup>265</sup> The Federal Circuit concluded that Arlinghaus could have been used as an anticipatory reference but because it disclosed two compositions that induce CTL activation and included specific peptides within the scope of the second peptide of Sastry's claim, Arlinghaus could be viewed as providing the necessary motivation to combine the peptides of the other references as well.<sup>266</sup>

In *In re Lee*,<sup>267</sup> the USPTO combined two references in a 35 U.S.C. § 103 rejection, while discounting the need for "any specific hint or suggestion in a particular reference" to support the combination.<sup>268</sup> On appeal, the Federal Circuit vacated and remanded the Board decision, noting that the "common knowledge and common sense" that the Board relied on to reject the application is not the type of "specialized knowledge and expertise contemplated by the Administrative Procedure Act."<sup>269</sup>

In *Teleflex, Inc. v. Ficosa North America Corp.*,<sup>270</sup> Ficosa appealed the denial of its motion for judgment as a matter of law for non-infringement, the grant of summary judgment for a best mode violation, and the denial of its JMOL motions on the invalidity of the two patents at issue.<sup>271</sup> With regard to obviousness, the Federal Circuit determined that Ficosa did not present evidence in support of its belief that the nature of the problem itself supplied the necessary motivation to combine.<sup>272</sup> Accordingly, the Federal Circuit determined that the evidence was insufficient to support a finding of invalidity.<sup>273</sup> With respect to anticipation, the Federal Circuit affirmed the lower court's decision, explaining that anticipation does not permit an additional reference to supply the missing claim limitation.<sup>274</sup>

### C. 35 U.S.C. § 112

The patent laws require that the patent specification contain a written description of the invention and of the manner and process

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265. *Id.* at 1382, 62 U.S.P.Q.2d (BNA) at 1439.

266. *Id.* at 1383, 62 U.S.P.Q.2d (BNA) at 1439-40.

267. 277 F.3d 1338, 61 U.S.P.Q.2d (BNA) 1430 (Fed. Cir. 2002).

268. *Id.* at 1343-44, 61 U.S.P.Q.2d (BNA) at 1434 (citation omitted in original).

269. *Id.* at 1344, 61 U.S.P.Q.2d (BNA) at 1435 (citation omitted in original); *see* Administrative Procedure Act, 5 U.S.C. § 557 (2000) (outlining the requirements for initial decisions and agency review).

270. 299 F.3d 1313, 63 U.S.P.Q.2d (BNA) 1374 (Fed. Cir. 2002).

271. *Id.* at 1318, 63 U.S.P.Q.2d (BNA) at 1375.

272. *Id.* at 1334, 63 U.S.P.Q.2d (BNA) at 1387.

273. *Id.*, 63 U.S.P.Q.2d (BNA) at 1387.

274. *Id.* at 1335, 63 U.S.P.Q.2d (BNA) at 1388.

of making and using it, in such a manner as to enable any person skilled in the art to make and use the invention, and must set forth the best mode contemplated by the inventor for carrying out his invention.<sup>275</sup> The specification must conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.<sup>276</sup> If a patent does not satisfy the written description, enablement, best mode or definiteness requirements, the patent is invalid under 35 U.S.C. § 112.

1. *Written description*

In *New Railhead Manufacturing L.L.C. v. Vermeer Manufacturing Co.*,<sup>277</sup> the Federal Circuit affirmed a district court decision to invalidate New Railhead's patents on a drill bit and a method of horizontal drilling under 35 U.S.C. § 102(b).<sup>278</sup> With regard to the drill bit patent, the Federal Circuit found that the related provisional application failed to provide a written description, as required by 35 U.S.C. § 119(e)(1), for the claimed angled relationship between the drill bit and its housing.<sup>279</sup> Accordingly, the Federal Circuit held that New Railhead's commercial sales constituted a § 102(b) bar because the drill bit patent is not entitled to claim the priority filing date of the provisional application.<sup>280</sup>

In *Enzo Biochem, Inc. v. Gen-Probe Inc.*,<sup>281</sup> the Federal Circuit granted a petition for rehearing and reversed its prior decision, which held that a deposit of biological materials in a public depository will not satisfy the written description requirement.<sup>282</sup> The Federal Circuit held, as a matter of first impression, that a reference to a deposit of genetic material in a patent specification may be sufficient to describe the material in accordance with 35 U.S.C. § 112.<sup>283</sup>

In doing so, the Federal Circuit relied on USPTO Guidelines stating that the written description requirement can be met where disclosed functional characteristics are coupled "with a known or disclosed

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275. See 35 U.S.C. § 112, ¶ 1 (2000) (stating the written description, enablement and best mode requirements).

276. See *id.* (stating the definiteness requirement).

277. 298 F.3d 1290, 63 U.S.P.Q.2d (BNA) 1843 (Fed. Cir. 2002).

278. *Id.* at 1292, 63 U.S.P.Q.2d (BNA) at 1844.

279. *Id.* at 1294-95, 63 U.S.P.Q.2d (BNA) at 1846.

280. *Id.* at 1297, 63 U.S.P.Q.2d (BNA) at 1848.

281. 296 F.3d 1316, 63 U.S.P.Q.2d (BNA) 1609 (Fed. Cir. 2002).

282. See *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 285 F.3d 1013, 62 U.S.P.Q.2d (BNA) 1289 (Fed. Cir. 2002), *vacated*, 296 F.3d 1316, 63 U.S.P.Q.2d (BNA) 1609 (Fed. Cir. 2002).

283. *Enzo Biochem*, 296 F.3d at 1330, 63 U.S.P.Q.2d (BNA) at 1617-18; see 35 U.S.C. § 112 (2000) (requiring a written description of the invention).



correlation between function and structure.”<sup>284</sup> The Federal Circuit remanded the case back to the district court to determine “whether a person of skill in the art would glean from the written description, including information obtainable from the deposits of the claimed sequences, subsequences, mutated variants, and mixtures sufficient to demonstrate possession of the generic scope of the claims.”<sup>285</sup> The Federal Circuit also remanded the factual determination of whether the disclosure provided by the three deposits would sufficiently describe the asserted claims to a person knowledgeable in the art.<sup>286</sup>

In *Cooper Cameron Corp. v. Kvaerner Oilfield Products, Inc.*,<sup>287</sup> the Federal Circuit affirmed the district court’s grant of summary judgment that Cameron’s ‘707 patent was not infringed under the doctrine of equivalents<sup>288</sup> and reversed the district court’s grant of summary judgment that the ‘119 patent was invalid for failing to meet the written description requirements of 35 U.S.C. § 112, ¶ 1.<sup>289</sup> The patents in question involved equipment used on sub-sea wellheads.<sup>290</sup>

With regard to the invalidity claim, the district court held that the ‘119 patent lacked sufficient written description to support a particular aspect of the invention because it was not described in the specification.<sup>291</sup> The Federal Circuit reversed the lower court, determining that inventors are entitled to claim their inventions in more than one way.<sup>292</sup> The ‘119 patent’s drawings disclosed the disputed embodiment sufficiently to support the written description requirement, because “drawings constitute an adequate description if they describe what is claimed and convey to those of skill in the art that the patentee actually invented what is claimed.”<sup>293</sup>

## 2. Enablement

In *Union Carbide Chemicals & Plastics Technology Corp. v. Shell Oil Co.*,<sup>294</sup> the Federal Circuit affirmed in part, reversed in part, and remanded a decision of the District Court of Delaware, finding non-infringement of

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284. *Enzo Biochem*, 296 F.3d at 1324, 63 U.S.P.Q.2d (BNA) at 1613 (quoting Guidelines for Examination of Patent Applications Under the U.S.C. 112, P1, “Written Description” Requirement, 66 Fed. Reg. 1099, 1106 (Jan. 5, 2001)).

285. *Id.* at 1327, 63 U.S.P.Q.2d (BNA) at 1615.

286. *Id.* at 1327-28, 63 U.S.P.Q.2d (BNA) at 1615.

287. 291 F.3d 1317, 62 U.S.P.Q.2d (BNA) 1846 (Fed. Cir. 2002).

288. *Id.* at 1321, 62 U.S.P.Q.2d (BNA) at 1849.

289. *Id.* at 1322, 62 U.S.P.Q.2d (BNA) at 1850.

290. *Id.* at 1318, 62 U.S.P.Q.2d (BNA) at 1847.

291. *Id.* at 1320, 62 U.S.P.Q.2d (BNA) at 1848.

292. *Id.* at 1322-23, 62 U.S.P.Q.2d (BNA) at 1849.

293. *Id.*, 62 U.S.P.Q.2d (BNA) at 1850-51.

294. 308 F.3d 1167, 64 U.S.P.Q.2d (BNA) 1545 (Fed. Cir. 2002).

Union Carbide's patents.<sup>295</sup> With respect to an invalidity claim based on non-enablement, the Federal Circuit concluded that in view of the presumption that a patent is valid, Shell's evidence that Union Carbide failed to reduce to practice a slightly different catalyst was not relevant to the question of whether the particular catalyst in the claims was enabled.<sup>296</sup> Consequently, the Federal Circuit held that the district court properly overturned the jury's verdict of non-enablement by granting a new trial.<sup>297</sup>

Chief Judge Mayer, dissenting on the enablement issue, argued that Union Carbide's records, which listed hundreds of ineffective catalysts, showed that to generate an "efficiency enhancing" catalyst as claimed would require "undue experimentation".<sup>298</sup> In arguing to uphold the jury's verdict that the claims were not enabled, Chief Judge Mayer relied on *Durel Corp. v. Osram Sylvania, Inc.*<sup>299</sup> and *Atlas Powder Co. v. E.I. DuPont de Nemours & Co.*,<sup>300</sup> which indicate that if a significant number of combinations covered by a claim are inoperative, then the claim might be invalid.<sup>301</sup>

In *Crown Operations International, Ltd. v. Solutia Inc.*,<sup>302</sup> the Federal Circuit affirmed the district court's grant of summary judgment that Solutia's '511 patent was not anticipated and vacated the court's grant of summary judgment that Solutia's '258 patent was not invalid for lack of enablement and written description.<sup>303</sup> In affirming the district court, the Federal Circuit rejected Crown's argument that if a prior art reference disclosed the same structure as claimed by a patent, a property resulting from that structure should be assumed.<sup>304</sup> The Federal Circuit reasoned that for a limitation to be inherently disclosed, "it must necessarily be present and a person of ordinary skill in the art would recognize its presence."<sup>305</sup> However, the presence of the property cannot be shown by probabilities and possibilities.<sup>306</sup>

The district court held that Solutia's '258 patent was enabled, but the Federal Circuit found that the district court failed to consider

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295. *Id.* at 1171, 64 U.S.P.Q.2d (BNA) at 1547.

296. *Id.* at 1186, 64 U.S.P.Q.2d (BNA) at 1558.

297. *Id.*, 64 U.S.P.Q.2d (BNA) at 1558-59.

298. *Id.* at 1193, 64 U.S.P.Q.2d (BNA) at 1563 (Mayer, J., dissenting).

299. 256 F.3d 1298, 59 U.S.P.Q.2d (BNA) 1238 (Fed. Cir. 2001).

300. 750 F.2d 1569, 244 U.S.P.Q. (BNA) 409 (Fed. Cir. 1984).

301. *Union Carbide*, 308 F.3d at 1192-93, 64 U.S.P.Q.2d (BNA) at 1563 (citing *Durel*, 256 F.3d at 1306-07, 59 U.S.P.Q.2d (BNA) at 1244; *Atlas*, 750 F.2d at 1576-77, 24 U.S.P.Q. (BNA) at 414).

302. 289 F.3d 1367, 62 U.S.P.Q.2d (BNA) 1917 (Fed. Cir. 2002).

303. *Id.* at 1370, 62 U.S.P.Q.2d (BNA) at 1918.

304. *Id.* at 1377, 62 U.S.P.Q.2d (BNA) at 1922.

305. *Id.*, 62 U.S.P.Q.2d (BNA) at 1922-23.

306. *Id.*, 62 U.S.P.Q.2d (BNA) at 1923.

Crown's evidence that the '258 patent contained ambiguities that raised a genuine issue of material fact about whether the invention could be practiced without undue experimentation.<sup>307</sup> Further, the Federal Circuit felt that inoperative embodiments resulting from the ambiguities were further evidence that there was a genuine issue of material fact with respect to the enablement claim.<sup>308</sup>

### 3. *Best mode*

In *Bayer AG v. Schein Pharmaceuticals, Inc.*,<sup>309</sup> the Federal Circuit affirmed a decision by the U.S. District Court for the District of New Jersey concerning a 35 U.S.C. § 271(e)(2) patent lawsuit based on Schein Pharmaceutical's filing an ANDA for generic Ciprofloxacin ("Cipro").<sup>310</sup> Bayer AG filed a series of applications also claiming Cipro.<sup>311</sup> As to the patent at issue, Schein argued that Bayer could not claim priority stemming back to an earlier application because that application failed to meet the best mode requirement.<sup>312</sup>

The Federal Circuit analyzed all seven cases where it held claims invalid for failure to satisfy the best mode requirement and found the cases all involved a "failure to disclose a preferred embodiment" or a "failure to disclose a preference that materially affected making or using the invention."<sup>313</sup> The Federal Circuit found that the inventor's preferred way of making an intermediate compound had no material effect on the properties of the end product and failure to disclose that method was not a best mode violation.<sup>314</sup> In doing so, the Federal Circuit rejected appellants' argument (based on a misinterpretation of *Eli Lilly & Co. v. Barr Laboratories, Inc.*<sup>315</sup>), that the best mode of obtaining novel subject matter necessary to practice the invention must be disclosed.<sup>316</sup>

In a concurring opinion, Judge Rader stated that he would simply affirm the district court decision because "the best mode requirement 'does not compel disclosure of an unclaimed method.'"<sup>317</sup> Judge Rader would not widen the "best mode net," as did the majority, to capture

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307. *Id.* at 1379, 62 U.S.P.Q.2d (BNA) at 1924.

308. *Id.* at 1380-81, 62 U.S.P.Q.2d (BNA) at 1925-26.

309. 301 F.3d 1306, 64 U.S.P.Q.2d (BNA) 1001 (Fed. Cir. 2002).

310. *Id.* at 1308, 1311, 64 U.S.P.Q.2d (BNA) at 1002, 1004.

311. *Id.* at 1310-11, 64 U.S.P.Q.2d (BNA) at 1003-04.

312. *Id.* at 1313, 64 U.S.P.Q.2d (BNA) at 1006.

313. *Id.* at 1316, 64 U.S.P.Q.2d (BNA) at 1008.

314. *Id.* at 1321-22, 64 U.S.P.Q.2d (BNA) at 1012.

315. 251 F.3d 955, 58 U.S.P.Q.2d (BNA) 1869 (Fed. Cir. 2001).

316. *Bayer*, 301 F.3d at 1322, 64 U.S.P.Q.2d (BNA) at 1013.

317. *Id.* at 1323, 64 U.S.P.Q.2d (BNA) at 1013 (Rader, J., concurring) (quoting *Bayer AG & Bayer Corp. v. Schein Pharm.*, 129 F. Supp. 2d. 705, 721 (D.N.J. 2001)).

the properties of the claimed invention and any material effect or impact on those properties.<sup>318</sup> He explained that the best mode requirement is self-enforcing; failure to meet its requirements creates the risk that someone will discover and patent a best mode, thereby obtaining a blocking patent.<sup>319</sup> Judge Rader would limit the best mode requirement to the “scope of the claimed invention” per the provisions of 35 U.S.C. § 112, because the current requirement is at best a “trap for the uninformed applicant.”<sup>320</sup>

In *Teleflex, Inc. v. Ficosa North America Corp.*,<sup>321</sup> the Federal Circuit addressed the best mode requirements of 35 U.S.C. § 112, ¶ 1. In this case, Ficosa appealed, inter alia, the district court’s grant of summary judgment finding there was no best mode violation of a patent directed to a serviceable clip core coupling used as a component of a two-piece shift cable in certain GM vehicles.<sup>322</sup>

On appeal, Ficosa argued that the inventor knew of a “best way” of practicing the invention with a particular thickness and hardness of the clip, but failed to disclose it.<sup>323</sup> Teleflex argued that the thickness and hardness of the materials of the clip are specific to the particular commercial embodiment, e.g., GM requirements.<sup>324</sup> The Federal Circuit noted that compliance with the best mode requirement is a question of fact requiring a two-pronged inquiry.<sup>325</sup> The subjective first prong focuses on the inventor’s state of mind when filing the patent application, and is directed to whether the inventor considered one mode of practicing the invention to be superior to all other modes at that time.<sup>326</sup> The objective second prong asks if the inventor adequately disclosed the mode considered to be superior.<sup>327</sup> With respect to this two-prong test, “the best mode inquiry is directed to what the applicant regards as the invention, which in turn is measured by the claims.”<sup>328</sup>

The Federal Circuit, noting that the best mode requirement does not extend to production details or customer requirements,

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318. *Id.* at 1324, 64 U.S.P.Q.2d (BNA) at 1014.

319. *Id.* at 1325, 64 U.S.P.Q.2d (BNA) at 1014-15.

320. *Id.*, 64 U.S.P.Q.2d (BNA) at 1015.

321. 299 F.3d 1313, 63 U.S.P.Q.2d (BNA) 1374.

322. *See supra* notes 270-74 and accompanying text (describing the *Teleflex* holding).

323. *Teleflex*, 299 F.3d at 1329, 63 U.S.P.Q.2d (BNA) at 1383 (citation omitted in original).

324. *Id.*, 63 U.S.P.Q.2d (BNA) at 1383.

325. *Id.* at 1330, 63 U.S.P.Q.2d (BNA) at 1384.

326. *Id.*, 63 U.S.P.Q.2d (BNA) at 1384.

327. *Id.*, 63 U.S.P.Q.2d (BNA) at 1384-85.

328. *Id.*, 63 U.S.P.Q.2d (BNA) at 1383 (quoting *Engel Indus., Inc. v. Lockformer Co.*, 946 F.2d 1528, 1531, 20 U.S.P.Q.2d (BNA) 100, 1302 (Fed. Cir. 1991)).

determined that the alleged best mode information relating to hardness of the clip involved unclaimed subject matter relating to production details dictated by customer requirements.<sup>329</sup> Accordingly, the Federal Circuit held that the district court did not err in concluding that the alleged best mode related to customer requirements and was therefore not a best mode violation.<sup>330</sup> As a result, the Federal Circuit affirmed the lower court's decision to grant summary judgment.<sup>331</sup>

#### 4. *Indefiniteness*

In *Verve L.L.C. v. Crane Cams, Inc.*,<sup>332</sup> with respect to indefiniteness, the Federal Circuit determined that the claims on appeal were directed to push rods for engines with a wall thickness that is substantially constant.<sup>333</sup> According to the district court, the specification and prosecution history did not support the term "substantially" and was not adequately defined.<sup>334</sup> The Federal Circuit disagreed, holding that the lower court erred in ruling that the intrinsic evidence of the specification and prosecution history are the sole sources of meaning for words when used in a technologic context.<sup>335</sup> Specifically, the Federal Circuit held that:

It is well established that when the term "substantially" serves reasonably to describe the subject matter so that persons in the field of the invention would understand its scope, and to distinguish the claimed subject matter from the prior art, it is not indefinite. Understanding of this scope may be derived from extrinsic evidence without rendering the claim invalid. The summary judgment record offered no basis for departing from these general rules.<sup>336</sup>

In *All Dental Prodx v. Advantage Dental Products*, the Federal Circuit affirmed in part and reversed in part a summary judgment decision, finding that Advantage's patent for a method for making a custom dental impression complied with 35 U.S.C. § 112 ¶¶ 1-2.<sup>337</sup> The claim language in dispute was "original unidentified mass."<sup>338</sup> All Dental sold tablets that were oval-shaped and flat and could be molded onto a

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329. *Id.*, 63 U.S.P.Q.2d (BNA) at 1384.

330. *Id.*, 63 U.S.P.Q.2d (BNA) at 1384.

331. *Id.*, 63 U.S.P.Q.2d (BNA) at 1384.

332. 311 F.3d 1116, 65 U.S.P.Q.2d (BNA) 1051 (Fed. Cir. 2002).

333. *Id.* at 1119, 65 U.S.P.Q.2d (BNA) at 1053.

334. *Id.*, 65 U.S.P.Q.2d (BNA) at 1053.

335. *Id.*, 65 U.S.P.Q.2d (BNA) at 1053.

336. *Id.* at 1120, 65 U.S.P.Q.2d (BNA) at 1054.

337. 309 F.3d 774, 776-77 64 U.S.P.Q.2d (BNA) 1945, 1946-47 (Fed. Cir. 2002).

338. *Id.* at 779-80, 64 U.S.P.Q.2d (BNA) at 1948-49.

tooth to take an impression.<sup>339</sup> The Federal Circuit stated that while the disputed language may not be a “model of clarity,” it is easily understood when put in the context of the specification.<sup>340</sup> The Federal Circuit noted that the specification does not need to describe the subject matter in the exact terms used in the claims, it must simply indicate to persons skilled in the art that, as of the filing date, the applicant invented what is now being claimed.<sup>341</sup>

With respect to definiteness, the Federal Circuit held that the prosecution history aided in clarifying the meaning of “original unidentified mass” because Advantage twice distinguished their invention over the prior art based on that limitation.<sup>342</sup> The Federal Circuit concluded that the prosecution history made it clear that “original unidentified mass” meant that the object lacked any specific form and thus the claims were not indefinite.<sup>343</sup> As a result, the Federal Circuit held that All Dental did not infringe Advantage’s patent because All Dental’s tablets had a specific form and shape.<sup>344</sup>

In *Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*, the Federal Circuit affirmed the district court’s holding that Cardiac Pacemaker’s patent was invalid for indefiniteness under 35 U.S.C. § 112.<sup>345</sup> The Federal Circuit agreed with the district court’s finding that the patent did not disclose the corresponding structure to a recited third means for performing the dual functions of monitoring the ECG signal and activating the charging means.<sup>346</sup> In so doing, the Federal Circuit rejected the argument that the physician could be the corresponding structure or that the physician connected multiple structures that performed the claimed functions because, among other things, the claim language did not permit separate structures to perform the functions with a physician’s input.<sup>347</sup> Indeed, the Federal Circuit noted that the intrinsic evidence required the undisclosed corresponding structure to perform both dual functions recited.<sup>348</sup>

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339. *Id.* at 777, 64 U.S.P.Q.2d (BNA) at 1946-47.

340. *Id.* at 779, 64 U.S.P.Q.2d (BNA) at 1948.

341. *Id.*, 64 U.S.P.Q.2d (BNA) at 1948 (quoting *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 U.S.P.Q.2d (BNA) 1467, 1470 (Fed. Cir. 1995) (citations omitted)).

342. *Id.* at 780, 64 U.S.P.Q.2d (BNA) at 1949.

343. *Id.*, 64 U.S.P.Q.2d (BNA) at 1949.

344. *Id.*, 64 U.S.P.Q.2d (BNA) at 1949.

345. 296 F.3d 1106, 1107 63 U.S.P.Q.2d (BNA) 1725, 1726 (Fed. Cir. 2002).

346. *Id.* at 1114, 63 U.S.P.Q.2d (BNA) at 1730-31.

347. *Id.* at 1116-18, 63 U.S.P.Q.2d (BNA) at 1732-34.

348. *Id.* at 1116, 63 U.S.P.Q.2d (BNA) at 1732.

#### D. Reexamination

In *In re Bass*,<sup>349</sup> the Federal Circuit held that the USPTO was permitted to consider references identified and discussed in a first reexamination proceeding in other reexamination proceedings, even though the patentee received a Notice of Intent to Issue Reexamination Certificate (“Notice”) in the first proceeding.<sup>350</sup> Under 35 U.S.C. § 303(a), the Federal Circuit held that “previously considered prior art from a prior proceeding could not raise a substantial new question of patentability.”<sup>351</sup> As such, the patentee argued that the examiner’s obviousness rejection based on such references in a second reexamination proceeding was improper.<sup>352</sup> The Federal Circuit, however, held that the USPTO can reconsider an earlier action until a matter is completed.<sup>353</sup> The Notice did not preclude the USPTO from further reconsideration and review of the matter, including basing a rejection on references identified in the first reexamination proceeding, because a reexamination is complete only upon the statutorily mandated issuance of a reexamination certificate.<sup>354</sup>

#### E. Reissue

In *In re Doyle*,<sup>355</sup> the Federal Circuit reversed and remanded a decision by the Board, finding that the Board erroneously rejected the pending claims in Doyle’s reissue application by extending the *Orita* doctrine.<sup>356</sup> In the initial prosecution, Doyle’s application was subject to a nine-way restriction requirement.<sup>357</sup> After the prosecution and issuance of the elected claims, but before the two-year statutory limit, Doyle applied for a broadening reissue patent.<sup>358</sup> During reissue prosecution, Doyle conceded that the reissue genus claims read on,

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349. 314 F.3d 575, 65 U.S.P.Q.2d (BNA) 1156 (Fed. Cir. 2002).

350. *Id.* at 576, 65 U.S.P.Q.2d (BNA) at 1157.

351. *Id.* at 577, 65 U.S.P.Q.2d (BNA) at 1157 (citing *In re Portola Packaging*, 110 F.3d 786, 791, 42 U.S.P.Q.2d (BNA) 1295, 1300 (Fed. Cir. 1997); see 35 U.S.C. § 303(a) (2000) (allowing the Director to determine whether there is a substantial new question of patentability within three months following the filing of a request for reexamination)).

352. *Id.*, 65 U.S.P.Q.2d (BNA) at 1157.

353. *Id.*, 65 U.S.P.Q.2d (BNA) at 1157.

354. *Id.*, 65 U.S.P.Q.2d (BNA) at 1157.

355. 293 F.3d 1355, 63 U.S.P.Q.2d (BNA) 1161 (Fed. Cir. 2002).

356. *Id.* at 1356, 63 U.S.P.Q.2d (BNA) at 1162; see *In re Orita*, 550 F.2d 1277, 1280 n.7, 193 U.S.P.Q. (BNA) 145, 148 n.7 (C.C.P.A. 1977) (holding that the applicant did not demonstrate an error justifying the reissuance of a patent solely because the patent examiner was authorized to cancel non-existent claims).

357. *In re Doyle*, 293 F.3d at 1356, 63 U.S.P.Q.2d (BNA) at 1162.

358. *Id.* at 1356-57, 63 U.S.P.Q.2d (BNA) at 1162.

but were broader than the non-elected claims of the original prosecution.<sup>359</sup> The Board affirmed the examiner's rejection of the reissue claims based on a failure to specify an error correctable by reissue under the *Orita* doctrine.<sup>360</sup>

The issue before the Federal Circuit was whether failure to present a "claim broad enough to read on, or link, two or more groups of claims subject to a restriction requirement, is an error correctable by reissue."<sup>361</sup> The Federal Circuit found that such an error was correctable by reissue.<sup>362</sup> *Orita* prevents reissue applicants from "obtaining substantially identical claims to those of non-elected groups identified in a restriction requirement" if the claims could not have been prosecuted in the application from which they were restricted.<sup>363</sup> The Federal Circuit held that *Orita* was inapplicable to the case at bar because Doyle's new claims were not identical or substantially similar to the non-elected claims.<sup>364</sup> As a result, the Federal Circuit concluded that since Doyle could have prosecuted his claims with the elected group without conflicting with the restriction requirement—due to the fact that they are linking claims—the Board erred in not allowing him to do so.<sup>365</sup>

#### F. Design Patent

In *Rosco, Inc. v. Mirror Lite Co.*,<sup>366</sup> both Rosco and Mirror Lite asserted their patents against each other. Rosco owned a design patent, while Mirror Lite owned a utility patent. The Federal Circuit reversed the lower court with respect to the utility patent holding that the design patent did not inherently anticipate the utility patent. With respect to the design patent, the district court held that the design patent was functional and obvious, and therefore invalid.<sup>367</sup> The Federal Circuit, reminding the lower court of its obligations to establish a record with findings of fact and separate conclusions of law, reversed in part, vacated in part, and remanded the case to the district court to address various fact-finding issues.<sup>368</sup>

In reversing, the Federal Circuit noted that Mirror Lite did not show by clear and convincing evidence that there were no designs that had

359. *Id.* at 1357, 63 U.S.P.Q.2d (BNA) at 1162.

360. *Id.* at 1358, 63 U.S.P.Q.2d (BNA) at 1163.

361. *Id.*, 63 U.S.P.Q.2d (BNA) at 1163.

362. *Id.* at 1361, 63 U.S.P.Q.2d (BNA) at 1165.

363. *Id.* at 1359, 63 U.S.P.Q.2d (BNA) at 1164.

364. *Id.* at 1360, 63 U.S.P.Q.2d (BNA) at 1165.

365. *Id.*, 63 U.S.P.Q.2d (BNA) at 1165.

366. 304 F.3d 1373, 64 U.S.P.Q.2d (BNA) 1676 (Fed. Cir. 2002).

367. *Id.* at 1377, 64 U.S.P.Q.2d (BNA) at 1678.

368. *Id.* at 1376, 64 U.S.P.Q.2d (BNA) at 1677.



the same functional capabilities as Rosco's design.<sup>369</sup> In evaluating a design patent, the Court applied a stringent standard for invalidating a design patent on grounds of functionality: the design of a useful article is deemed functional where "the appearance of the claimed design is 'dictated by' the use or purpose of the article."<sup>370</sup> "When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose."<sup>371</sup> In this case, the Federal Circuit determined that the mere fact that the mirror claimed in the design patent exhibited a superior field of view over a single predecessor mirror "does not establish that the design was 'dictated by' functional considerations, as required by *L.A. Gear*."<sup>372</sup> Accordingly, the Federal Circuit held that Mirror Lite had not shown by clear and convincing evidence that there were no designs, other than the one shown in Rosco's patent, that have the same functional capabilities as Rosco's oval mirror.<sup>373</sup> Thus, it could not be said that the design patent was dictated by functional considerations. The Federal Circuit reversed the district court and held that the patent in suit was not shown to be invalid on functionality grounds.<sup>374</sup>

#### G. Interference and Priority of Invention

In *Slip Track Systems, Inc. v. Metal-Lite, Inc.*,<sup>375</sup> the Federal Circuit vacated and remanded the district court's grant of summary judgment of priority.<sup>376</sup> The Federal Circuit also reversed the dismissal of the cross-complaint and affirmed the denial of leave to amend the complaint.<sup>377</sup> As a preliminary matter, the Federal Circuit noted that, while the district courts handling interfering patent suits under 35 U.S.C. § 291 do not have to define the interfering subject matter in a way similar to a count defined by the USPTO under 35 U.S.C. § 135, the courts are required to define the bounds of the interfering subject matter in a single description.<sup>378</sup>

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369. *Id.* at 1378-79, 64 U.S.P.Q.2d (BNA) at 1679.

370. *Id.* at 1378, 64 U.S.P.Q.2d (BNA) at 1679 (quoting *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123, 25 U.S.P.Q.2d (BNA) 1913, 1917 (Fed. Cir. 1993)) (citation and quotation omitted).

371. *Id.*, 64 U.S.P.Q.2d (BNA) at 1679 (quoting *L.A. Gear, Inc.*, 988 F.2d at 1123, 25 U.S.P.Q.2d (BNA) at 1917 (Fed. Cir. 1993)) (citation omitted in original).

372. *Id.*, 64 U.S.P.Q.2d (BNA) at 1679.

373. *Id.* at 1378-79, 64 U.S.P.Q.2d (BNA) at 1679.

374. *Id.* at 1379, 64 U.S.P.Q.2d (BNA) at 1679.

375. 304 F.3d 1256, 64 U.S.P.Q.2d (BNA) 1423 (Fed. Cir. 2002).

376. *Id.* at 1260, 64 U.S.P.Q.2d (BNA) at 1425.

377. *Id.*, 64 U.S.P.Q.2d (BNA) at 1425.

378. *Id.* at 1264, 64 U.S.P.Q.2d (BNA) at 1428; *see* 35 U.S.C. § 291 (2000) (allowing an owner of an interfering patent relief against the owner of another patent); *id.* § 135

The Federal Circuit reversed the district court's determination of priority, finding that the lower court erroneously used the clear and convincing standard.<sup>379</sup> Using the correct preponderance of the evidence standard, the Federal Circuit reasoned that in a case where the necessity of testing is more uncertain and where there is other uncontroverted evidence that the inventor knew that the invention would work for its intended purpose, it is inappropriate to grant summary judgment based on the lack of testing alone.<sup>380</sup> The Federal Circuit noted that while testing is not itself a requisite for reduction to practice, it may be required to show that a prototype demonstrates that an invention suits its intended purpose.<sup>381</sup> In this case, the specific question remanded to the district court was whether an "embodiment made of different materials demonstrates that the invention would work for its intended purpose."<sup>382</sup>

In *Manning v. Paradis*,<sup>383</sup> the Federal Circuit affirmed the USPTO Board's decision awarding judgment to the senior party, Paradis, in an interference.<sup>384</sup> The sole issue considered was whether the junior party, Manning, reduced to practice the subject matter of the count before the filing date of the senior party.<sup>385</sup> The Federal Circuit noted the well-settled rule that "[i]n order to establish an actual reduction to practice, the inventor must prove that (1) he constructed an embodiment or performed a process that met all the limitations of the interference count; and (2) he determined that the invention would work for its intended purpose."<sup>386</sup> After construing the count to include a limitation of the intended purpose stated in the preamble, the Federal Circuit determined that Manning did not know that the invention would work for its intended purpose at the time of his alleged reduction to practice.<sup>387</sup> The Federal Circuit based its decision on his counsel's virtual concession on the issue at oral argument and the Federal Circuit's review of a journal article authored by Manning and relied upon to establish his priority date, which showed that at that

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(outlining the procedures for an infringement action).

379. *Slip Track Sys.*, 304 F.3d at 1261, 64 U.S.P.Q.2d (BNA) at 1426.

380. *Id.* at 1267, 64 U.S.P.Q.2d (BNA) at 1430-31.

381. *Id.*, 64 U.S.P.Q.2d (BNA) at 1431.

382. *Id.* at 1268, 64 U.S.P.Q.2d (BNA) at 1431.

383. 296 F.3d 1098, 63 U.S.P.Q.2d (BNA) 1681 (Fed. Cir. 2002).

384. *Id.* at 1099, 63 U.S.P.Q.2d (BNA) at 1682.

385. *Id.* at 1100, 63 U.S.P.Q.2d (BNA) at 1682.

386. *Id.* at 1102, 63 U.S.P.Q.2d (BNA) at 1684 (quoting *Cooper v. Goldfarb*, 154 F.3d 1321, 1327, 47 U.S.P.Q.2d (BNA) 1896, 1901 (Fed. Cir. 1998)).

387. *Id.* at 1103-05, 63 U.S.P.Q.2d (BNA) at 1685-86.

time he did not know the invention would work for its intended purpose.<sup>388</sup>

In *Berman v. Housey*,<sup>389</sup> the Federal Circuit affirmed the USPTO Board's interference decision entering judgment in favor of Housey and dismissing Berman's unpatentability motion as moot.<sup>390</sup> First, the Federal Circuit addressed whether the Board properly dismissed Berman's unpatentability motion. Berman argued that the Board improperly decided Housey's preliminary motion of lack of interfering subject matter before its unpatentability motion.<sup>391</sup> The Federal Circuit held that 35 U.S.C. § 135(b) is a threshold issue best addressed by the Board at the preliminary stage of an interference before proceeding on the merits.<sup>392</sup> Accordingly, the Board properly refused to consider Berman's unpatentability motion once it determined that § 135(b) barred its proffered interfering claim.<sup>393</sup> The Federal Circuit rejected Berman's argument that the Board was required to address the unpatentability motion because of 35 U.S.C. § 6, which provides in relevant part that "[t]he [Board] . . . shall determine priority and patentability of invention."<sup>394</sup> The Federal Circuit found that the legislative histories of §§ 6 and 135(a) indicates that those provisions address only what the Board is empowered to consider, without establishing an affirmative obligation to perform.<sup>395</sup>

With respect to the second issue addressed by the Federal Circuit—the termination of the interference under § 135(b) due to the failure to declare such interference within a year of the issuance of the allegedly interfering patent—the Federal Circuit barred Berman's claim.<sup>396</sup> The Federal Circuit found that Berman waived its right to contend, on appeal, that claim sixty-four was not barred.<sup>397</sup> At the Board level, Berman did not contest the fact that claim sixty-four was directed to the same or substantially the same subject matter as Housey's patents that issued more than a year before claim sixty-four was proffered for interference.<sup>398</sup> Instead, Berman only argued that its claim twenty-seven (which was filed within the one year time period)

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388. *Id.* at 1105, 63 U.S.P.Q.2d (BNA) at 1686.

389. 291 F.3d 1345, 63 U.S.P.Q.2d (BNA) 1023 (Fed. Cir. 2002).

390. *Id.* at 1347, 63 U.S.P.Q.2d (BNA) at 1024.

391. *Id.* at 1350-51, 63 U.S.P.Q.2d (BNA) at 1026-27.

392. *Id.* at 1351, 63 U.S.P.Q.2d (BNA) at 1027.

393. *Id.*, 63 U.S.P.Q.2d (BNA) at 1027.

394. *Id.* at 1353, 63 U.S.P.Q.2d (BNA) at 1029, *see* 35 U.S.C. § 6(b) (2000) .

395. *Id.* at 1353-54, 63 U.S.P.Q.2d (BNA) at 1029.

396. *Id.* at 1354-55, 63 U.S.P.Q.2d (BNA) at 1030.

397. *Id.* at 1354, 63 U.S.P.Q.2d (BNA) at 1030.

398. *Id.* at 1354-55, 63 U.S.P.Q.2d (BNA) at 1030.

was the same or substantially the same as its claim sixty-four.<sup>399</sup> Therefore, the Federal Circuit held that because Berman never argued at the Board that claim sixty-four is not directed to the same or substantially the same subject matter as the relevant claims in Housey's patents, Berman waived that argument and could not raise it on appeal.<sup>400</sup>

Finally, the Federal Circuit rejected Berman's contention that because it filed claim sixty-four within one year of the later Housey patent ("Housey III"), an interference should be declared with that patent.<sup>401</sup> The Federal Circuit held that Housey's earlier patent claims "constitute a proper basis for barring claim sixty-four under § 135(b), and the subsequent issuance of Housey III cannot revive claim sixty-four once it lost its right to patentability" with respect to the earlier Housey patents.<sup>402</sup>

In *Adang v. Fischhoff*,<sup>403</sup> the Federal Circuit affirmed-in-part, reversed-in-part, and remanded the USPTO Board's decision against Adang, the senior party in the interference.<sup>404</sup> The Board found the application to be non-enabling and that actual reduction to practice was not proven before Fischhoff's priority date.<sup>405</sup> The invention involved genetically modifying tomato plants to protect against certain types of insects.<sup>406</sup> The Federal Circuit held that the Board erred in its count construction, noting that "[i]t is too great a leap to mandate that, in order to come within the scope of the count, expression of a gene 'capable of encoding' a protein must be shown to produce only that protein."<sup>407</sup> Further, the Board's construction was too narrow, resulting in neither Fischhoff nor Adang presenting an example sufficient to satisfy the limitations of the count.<sup>408</sup> However, the Board's decision of non-enablement was supported by substantial evidence. The Board determined that a person skilled in the art would not expect success in transferring the technique to a different tomato plant without undue experimentation.<sup>409</sup> Thus, the Federal Circuit reversed the Board's claim construction,<sup>410</sup> affirmed the decision of non-enablement with

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399. *Id.* at 1355, 63 U.S.P.Q.2d (BNA) at 1030.

400. *Id.* at 1355, 63 U.S.P.Q.2d (BNA) at 1030.

401. *Id.*, 63 U.S.P.Q.2d (BNA) at 1030.

402. *Id.*, 63 U.S.P.Q.2d (BNA) at 1030.

403. 286 F.3d 1346, 62 U.S.P.Q.2d (BNA) 1504 (Fed. Cir. 2002).

404. *Id.* at 1347, 62 U.S.P.Q.2d (BNA) at 1505.

405. *Id.*, 62 U.S.P.Q.2d (BNA) at 1505.

406. *Id.* at 1347-48, 62 U.S.P.Q.2d (BNA) at 1505-06.

407. *Id.* at 1354, 62 U.S.P.Q.2d (BNA) at 1510 (citation omitted in original).

408. *Id.*, 62 U.S.P.Q.2d (BNA) at 1510.

409. *Id.* at 1355-56, 62 U.S.P.Q.2d (BNA) at 1511.

410. *Id.* at 1359, 62 U.S.P.Q.2d (BNA) at 1514.

regard to one of Adang's CIP applications,<sup>411</sup> and remanded to determine whether Adang could establish entitlement to a priority date based on another CIP application at issue.<sup>412</sup>

In *Griffin v. Bertina*,<sup>413</sup> the Federal Circuit affirmed the Board's decision awarding priority to the senior party, Bertina.<sup>414</sup> The invention at issue was a method for diagnosing thrombosis by obtaining a nucleic acid containing the codon for human Factor V from a test subject and assaying for the presence of a point mutation that indicates an increased risk for thrombosis.<sup>415</sup> Griffin attempted to establish an actual reduction to practice prior to Bertina's accorded date.<sup>416</sup> On appeal, Griffin argued that the count should be construed as limited only to its manipulative steps.<sup>417</sup> Therefore, Griffin asserted that he completed those manipulative steps, thus reducing the count to practice prior to Bertina's priority date.<sup>418</sup> The Federal Circuit disagreed, stating that the count is limited by the preamble because it gives "meaning and purpose" to the manipulative steps.<sup>419</sup> For example, the Federal Circuit pointed out that, while the first step stated that the test nucleic acid should be obtained from a "test subject," without the preamble's stated objective of diagnose thrombosis, the term "test subject" was meaningless.<sup>420</sup> The Federal Circuit also found that a party attempting to prove that it need not be required to establish reduction to practice of every characteristic listed in the count due to their alleged inherency must prove that such inherent qualities add nothing to the count beyond the other cited limitations.<sup>421</sup> Therefore, the Federal Circuit stated that Griffin's argument regarding performing the steps inherently diagnosing thrombosis fails.<sup>422</sup> The Federal Circuit held that the relationship between the point mutation and an increased risk of thrombosis is material to the patentability of the count because it indicates the purpose of the method.<sup>423</sup> Thus, because Griffin lacked appreciation for the utility of the point mutation as actually correlating with an

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411. *Id.* at 1360, 62 U.S.P.Q.2d (BNA) at 1514.

412. *Id.*, 62 U.S.P.Q.2d (BNA) at 1514.

413. 285 F.3d 1029, 62 U.S.P.Q.2d (BNA) 1431 (Fed. Cir. 2002).

414. *Id.* at 1030, 62 U.S.P.Q.2d (BNA) at 1432.

415. *Id.* at 1030-31, 62 U.S.P.Q.2d (BNA) at 1432.

416. *Id.* at 1031, 62 U.S.P.Q.2d (BNA) at 1432.

417. *Id.* at 1032, 62 U.S.P.Q.2d (BNA) at 1433.

418. *Id.* at 1032-33, 62 U.S.P.Q.2d (BNA) at 1433.

419. *Id.* at 1033, 62 U.S.P.Q.2d (BNA) at 1434.

420. *Id.*, 62 U.S.P.Q.2d (BNA) at 1434 (citation omitted in original).

421. *Id.* at 1034, 62 U.S.P.Q.2d (BNA) at 1434.

422. *Id.* at 1034-35, 62 U.S.P.Q.2d (BNA) at 1434-35.

423. *Id.* at 1034, 62 U.S.P.Q.2d (BNA) at 1434-35.

heightened risk of thrombosis, it failed to prove a successful reduction to practice.<sup>424</sup>

In *Scott v. Koyama*,<sup>425</sup> the junior party, Scott, sought to establish a priority date in the United States by proving that he was in possession of the invention of the count in the United States before Koyama's Japanese filing date.<sup>426</sup> Scott presented evidence of a conception date, diligence, and actual reduction to practice.<sup>427</sup> In particular, Scott offered evidence of daily activity over a period of seventeen days involving planning construction of a manufacturing facility to practice the process of the count.<sup>428</sup> As the Federal Circuit noted, an interference proceeding commences with a determination of the parties' effective filing dates.<sup>429</sup> The "senior party," the party with the earlier effective filing date, will prevail unless the junior party establishes entitlement to an earlier date.<sup>430</sup> The Board found Scott's evidence insufficient to establish actual reduction to practice.<sup>431</sup> The Federal Circuit agreed that this evidence did not establish actual reduction to practice, but, in reversing the Board decision, held that this evidence should have been considered as evidence of reduction to practice.<sup>432</sup>

In *Brown v. Barbacid*,<sup>433</sup> the Federal Circuit vacated and remanded the Board's decision in this interference case, holding that: (1) the ultimate burden of proof with respect to priority always remains on the junior party;<sup>434</sup> (2) the Board, with respect to authentication, must weigh evidence from the vantage point of one skilled in the art;<sup>435</sup> (3) independent evidence must corroborate the inventor's testimony of conception or actual reduction to practice and this evidence is reviewed by the Federal Circuit under "rule of reason" analysis to determine sufficient corroboration;<sup>436</sup> (4) an inventor does not establish a conception date if the physical and testimonial evidence relating to that date does not include an element of the count;<sup>437</sup> (5) in

424. *Id.*, 62 U.S.P.Q.2d (BNA) at 1435.

425. 281 F.3d 1243, 61 U.S.P.Q.2d (BNA) 1856 (Fed. Cir. 2002).

426. *Id.* at 1246, 61 U.S.P.Q.2d (BNA) at 1858.

427. *Id.* at 1246-48, 61 U.S.P.Q.2d (BNA) at 1858-59.

428. *Id.* at 1247, 61 U.S.P.Q.2d (BNA) at 1858-59.

429. *Id.* at 1246, 61 U.S.P.Q.2d (BNA) at 1858.

430. *Id.*, 61 U.S.P.Q.2d (BNA) at 1858.

431. *Id.* at 1247-48, 61 U.S.P.Q.2d (BNA) at 1859.

432. *Id.* at 1248-49, 61 U.S.P.Q.2d (BNA) at 1858-59.

433. 276 F.3d 1327, 61 U.S.P.Q.2d (BNA) 1236 (Fed. Cir. 2002).

434. *Id.* at 1332-33, 61 U.S.P.Q.2d (BNA) at 1238-39. *But see id.* at 1340, 61 U.S.P.Q.2d (BNA) at 1243 ("[T]he junior party bears no burden of proof as to the senior party's dates of conception and reduction to practice.").

435. *Id.* at 1333-34, 61 U.S.P.Q.2d (BNA) at 1239-40.

436. *Id.* at 1334-35, 61 U.S.P.Q.2d (BNA) at 1240.

437. *Id.* at 1335-36, 61 U.S.P.Q.2d (BNA) at 1240-41.

determining the date of conception, physical evidence containing all elements of the count requires no further corroboration to demonstrate the content of the physical evidence itself—the Board must then consider evidence relating to reasonable diligence in reduction to practice;<sup>438</sup> and (6) where the senior party's brief did not rely on testimonial evidence, the Board is correct in declining to consider the testimony with respect to the party's conception and reduction to practice.<sup>439</sup>

#### H. Patent Term

In *Bayer AG v. Carlsbad Technology, Inc.*,<sup>440</sup> the Federal Circuit affirmed the district court's grant of summary judgment in favor of the plaintiff, holding that the patent at issue was valid until December 3, 2003 as a result of the Uruguay Rounds Agreements Act ("URAA").<sup>441</sup> In April 2001, Carlsbad notified Bayer that it submitted an ANDA on ciprofloxacin.<sup>442</sup> Bayer filed suit against Carlsbad, asserting that the patent at issue was valid until December 9, 2003.<sup>443</sup> Carlsbad counterclaimed that the patent was valid only until October 1, 2002 because of a terminal disclaimer that Bayer filed before passage of the URAA.<sup>444</sup> The Federal Circuit determined that the URAA amendment automatically changed the expiration date of the earlier patent on which the terminal disclaimer was based.<sup>445</sup> As a result, the patent at issue was entitled to the later date.<sup>446</sup>

#### I. Inventorship

In *Trovan Ltd. v. Sokmat SA., Irori*,<sup>447</sup> the Federal Circuit vacated and remanded a decision by U.S. District Court for the Central District of California, holding the district court did not properly construe the claims at issue, thereby necessitating resolution of factual questions regarding inventorship.<sup>448</sup> In this case, Trovan and Sokymat agreed to work together to optimize production of Trovan's transponders.<sup>449</sup> The Federal Circuit first reiterated that when a patent either includes

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438. *Id.* at 1336-37, 61 U.S.P.Q.2d (BNA) at 1241-42.

439. *Id.*, 61 U.S.P.Q.2d (BNA) at 1242.

440. 298 F.3d 1377, 64 U.S.P.Q.2d (BNA) 1045 (Fed. Cir. 2002).

441. *Id.* at 1378, 64 U.S.P.Q.2d (BNA) at 1046.

442. *Id.* at 1379, 64 U.S.P.Q.2d (BNA) at 1047.

443. *Id.*, 64 U.S.P.Q.2d (BNA) at 1047.

444. *Id.*, 64 U.S.P.Q.2d (BNA) at 1047.

445. *Id.* at 1382-83, 64 U.S.P.Q.2d (BNA) at 1049-50.

446. *Id.* at 1378, 64 U.S.P.Q.2d (BNA) at 1049-50.

447. 299 F.3d 1292, 63 U.S.P.Q.2d (BNA) 1865 (Fed. Cir. 2002).

448. *Id.* at 1294, 63 U.S.P.Q.2d (BNA) at 1865.

449. *Id.* at 1298, 63 U.S.P.Q.2d (BNA) at 1867.

names other than the true inventors or omits names of the true inventors, it is rendered invalid.<sup>450</sup> However, the presumed validity of a patent creates a presumption that the named inventors are the only inventors.<sup>451</sup> As a result of this presumption, correcting the misjoinder or nonjoinder of inventors requires clear and convincing evidence.<sup>452</sup> Here, the district court found Gustafson (Sokymat) to be the inventor of the '410 patent because Trovan could not prove by clear and convincing evidence that Hadden and Zirbes, Trovan employees, were co-inventors.<sup>453</sup> However, the Federal Circuit stated that the fact that the '410 patent contained claims that overlapped those of the '855 patent, which issued to Hadden and Zirbes, did not mean that Gustafson was a co-inventor of the '855 patent.<sup>454</sup> The Federal Circuit then interpreted the claims regarding inventorship of the '855 patent and determined that the factual record was incomplete.<sup>455</sup> Consequently, the Federal Circuit remanded the case for the district court to determine proper inventorship by determining each party's contributions to the invention.<sup>456</sup> Judge Michel dissented, stating that although the district court may have erred in its claim construction, it amounted only to harmless error.<sup>457</sup>

In *University of West Virginia v. VanVoorhies*,<sup>458</sup> the Federal Circuit affirmed the district court's grant of summary judgment on the plaintiff University's claim that a co-inventor to certain patent applications breached his duty to assign inventions developed when he was a graduate student at the University.<sup>459</sup> In its opinion, the Federal Circuit first acknowledged that while contract law questions are matters of state law, the problem of whether a patent application is a continuation-in-part of an earlier-filed patent application (thus covered by a previously executed assignment) is a matter for federal patent law.<sup>460</sup> Moreover, the Federal Circuit held that under the University's patent policy, the defendant was obligated to assign a patent application to the University even in the absence of a contract expressly requiring such assignment.<sup>461</sup> In affirming the district

450. *Id.* at 1301, 63 U.S.P.Q.2d (BNA) at 1870.

451. *Id.*, 63 U.S.P.Q.2d (BNA) at 1870.

452. *Id.*, 63 U.S.P.Q.2d (BNA) at 1870 (citing *Hess v. Advanced Cardiovascular Sys., Inc.*, 105 F.3d 976, 979-80, 41 U.S.P.Q.2d (BNA) 1782, 1785-86 (Fed. Cir. 1997)).

453. *Id.* at 1303, 63 U.S.P.Q.2d (BNA) at 1871-72.

454. *Id.*, 63 U.S.P.Q.2d (BNA) at 1871-72.

455. *Id.* at 1304-10, 63 U.S.P.Q.2d (BNA) at 1872-77.

456. *Id.* at 1310, 63 U.S.P.Q.2d (BNA) at 1877.

457. *Id.* at 1310, 63 U.S.P.Q.2d (BNA) at 1877 (Michel, J., dissenting).

458. 278 F.3d 1288, 61 U.S.P.Q.2d (BNA) 1449 (Fed. Cir. 2002).

459. *Id.* at 1291-92, 61 U.S.P.Q.2d (BNA) at 1450.

460. *Id.* at 1296-97, 61 U.S.P.Q.2d (BNA) at 1454.

461. *Id.* at 1298, 61 U.S.P.Q.2d (BNA) at 1456.



court's rejection of the defendant's argument that a previously executed assignment was invalid, the Federal Circuit clarified that although the doctrine of assignor estoppel precludes challenges to the validity of a patent itself, it does not bar challenges to the legality of a contract assigning the patent.<sup>462</sup> Finally, the Federal Circuit held that an inventor's act of providing technical information to the University's patent counsel and executing documents for a patent application prosecution did not give rise to an attorney-client relationship. Thus, the Federal Circuit deemed disqualification unnecessary when the University and the defendant investor's interest became adverse.<sup>463</sup>

In *Thompson v. Haynes*,<sup>464</sup> the Federal Circuit affirmed the district court's holding denying each party's claim for correction of inventorship to remove the other party's employee as a co-inventor.<sup>465</sup> Thompson entered into an agreement with Fluid Controls to develop a fluid conducting swivel concept.<sup>466</sup> Fluid Controls was issued a patent on this concept, and for a period of time, Thompson served as a distributor for the patented fluid conducting swivels.<sup>467</sup> Subsequently, Thompson ended the distributor relationship and began manufacturing his own swivels, and upon threat of suit by Fluid Controls, Thompson filed suit for a declaratory judgment of non-infringement.<sup>468</sup> Fluid Controls counterclaimed alleging infringement, violation of the Lanham Act,<sup>469</sup> and violation of state unfair competition law.<sup>470</sup> The district court found Thompson guilty of violating the Lanham Act and state deceptive trade practices act and awarded Fluid Controls injunctive relief, costs, attorneys' fees, and damages consisting of lost sales and Thompson's profits, both trebled.<sup>471</sup> On appeal, the Federal Circuit determined that "the burden on each party was to show facts supported by clear and convincing evidence that the other person listed as an inventor had not in fact contributed to the conception of the invention."<sup>472</sup> Thus, each party's clear and convincing evidence that its employee

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462. *Id.* at 1301, 61 U.S.P.Q.2d (BNA) at 1457.

463. *Id.* at 1303-04, 61 U.S.P.Q.2d (BNA) at 1459.

464. 305 F.3d 1369, 64 U.S.P.Q.2d (BNA) 1650 (Fed. Cir. 2002).

465. *Id.* at 1372, 64 U.S.P.Q.2d (BNA) at 1651.

466. *Id.*, 64 U.S.P.Q.2d (BNA) at 1652.

467. *Id.* at 1372-73, 64 U.S.P.Q.2d (BNA) at 1652.

468. *Id.* at 1373, 64 U.S.P.Q.2d (BNA) at 1652.

469. 15 U.S.C. § 1051 (2000).

470. *Thompson*, 305 F.3d at 1373, 64 U.S.P.Q.2d (BNA) at 1652.

471. *Id.* at 1373-74, 64 U.S.P.Q.2d (BNA) at 1652-53.

472. *Id.* at 1384, 64 U.S.P.Q.2d (BNA) at 1661.

contributed to the invention misapprehended the burden on it.<sup>473</sup> As a result, the district court properly found that neither party presented clear and convincing evidence that the other party's employee should be removed as inventor and thus properly refused to correct the inventorship to the patent in suit.<sup>474</sup>

*J. Prosecution History Laches*

In *Symbol Technology, Inc. v. Lemelson Medical, Education & Research Foundation*,<sup>475</sup> the Federal Circuit reversed the district court's holding that, as a matter of law, the defense of prosecution laches was not available.<sup>476</sup> The Federal Circuit held that "the equitable doctrine of laches may be applied to bar enforcement of patent claims that are issued after an unreasonable and unexplained delay in prosecution even though the applicant complied with pertinent statutes and rules."<sup>477</sup> In so doing, the Federal Circuit rejected the arguments that (1) the doctrine was limited to interference actions under the *Webster Electric Co. v. Splittdorf Electrical Co.*,<sup>478</sup> and its progeny;<sup>479</sup> (2) that the Patent Act of 1952 forecloses the application of prosecution laches;<sup>480</sup> and (3) that two of the Federal Circuit's non-precedential opinions rejecting prosecution laches defense should be binding on the Federal Circuit.<sup>481</sup>

In *In re Bogese II*,<sup>482</sup> the Federal Circuit affirmed a decision by the USPTO Board finding that Bogese surrendered his right to a patent due to prosecution history laches.<sup>483</sup> The Federal Circuit found that the USPTO is authorized to reject a patent application when the applicant fails to advance prosecution of his application for an unreasonably long period of time, provided the USPTO gives notice of the potential consequence of failure.<sup>484</sup> Here, the Federal Circuit quoted approvingly the Board's finding that the appellant's conduct in

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473. *Id.* at 1384, 64 U.S.P.Q.2d (BNA) at 1661.

474. *Id.* at 1384, 64 U.S.P.Q.2d (BNA) at 1661.

475. 277 F.3d 1361, 61 U.S.P.Q.2d (BNA) 1515 (Fed. Cir. 2000).

476. *Id.* at 1363, 61 U.S.P.Q.2d (BNA) at 1516.

477. *Id.*, 61 U.S.P.Q.2d (BNA) at 1516.

478. 264 U.S. 463 (1924).

479. *See Symbol Tech.*, 277 F.3d at 1365, 61 U.S.P.Q.2d (BNA) at 1518 (stating that in *Webster*, the Court based their decision on the reasonableness of the prosecution's delay, not on whether there was interference).

480. *See id.* at 1365-66, 61 U.S.P.Q.2d (BNA) at 1518-19 (explaining that the legislative history suggests that the drafters did not intend the Patent Act of 1952 to preclude the defense of prosecution laches).

481. *Id.* at 1368, 61 U.S.P.Q.2d (BNA) at 1520.

482. 303 F.3d 1362, 64 U.S.P.Q.2d (BNA) 1448 (Fed. Cir. 2002).

483. *Id.* at 1363, 64 U.S.P.Q.2d (BNA) at 1449.

484. *Id.* at 1367-68, 64 U.S.P.Q.2d (BNA) at 1452-53.

delaying issuance of his patent, thereby extending its term, was “so egregious in defeating the policy of the patent laws of promoting science and the useful arts as to be presumed unreasonable.”<sup>485</sup> Similarly, the Federal Circuit approved the Board’s holding that forfeiture of a patent is appropriate when someone, “intentionally or by reason of culpable neglect, is guilty of action which unduly postpones the time the public would be entitled to the free use of the invention.”<sup>486</sup> In fact, the Federal Circuit viewed the USPTO authority to punish undue delay as “even broader than the authority of a district court to hold a patent unenforceable.”<sup>487</sup>

In dissent, consistent with her opinion in *Symbol Technologies, Inc. v. Lemelson Medical, Education & Research Foundation*.<sup>488</sup> Judge Newman stated that the court has given patent examiners “a new power to deny a patent on the ground that the applicant dawdled too long in prosecution.”<sup>489</sup> Judge Newman found this holding inconsistent with *In re Henriksen*,<sup>490</sup> where the Court of Customs and Patents Appeals said that there is no statutory basis for fixing an arbitrary limit on the number of prior applications in a chain of co-pending applications for purposes of claiming priority.<sup>491</sup> Judge Newman saw the USPTO’s equitable power as limited to relieving distress, not causing it.<sup>492</sup> Interestingly, she explained that fixing that limit to twenty years from filing will make persistent filing rarer, but simultaneously contended that the USPTO’s new power will increase the burden on all applicants in order to punish a rare transgressor.<sup>493</sup>

### III. INFRINGEMENT

In 2002, the Federal Circuit considered numerous appeals concerning patent infringement. Central to its infringement decisions was often construing a claim. For the most part, the court followed the basic tenets of claim construction and relied on the

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485. *Id.* at 1366, 64 U.S.P.Q.2d (BNA) at 1451 (quoting *Ex parte Bogese II*, slip op. at 33-34, No. 86-1699, 818 F.2d 877 (Fed. Cir. Mar. 16, 1987)).

486. *Id.* at 1366, 64 U.S.P.Q.2d (BNA) at 1451 (quoting *Ex parte Bogese II*, slip op. at 35-36, No. 86-1699, 818 F.2d 877 (Fed. Cir. Mar. 16, 1987)).

487. *Id.* at 1367-68 & n.5, 64 U.S.P.Q.2d (BNA) at 1452-53 & n.5.

488. 277 F.3d 1361, 61 U.S.P.Q.2d (BNA) 1515 (Fed. Cir. 2002).

489. *In re Bogese II*, 303 F.3d at 1370, 64 U.S.P.Q.2d (BNA) at 1454 (Newman, J., dissenting).

490. 399 F.2d 253, 158 U.S.P.Q. (BNA) 224 (C.C.P.A. 1968).

491. *Id.* at 254, 158 U.S.P.Q. (BNA) at 225.

492. *In re Bogese II*, 303 F.3d at 1371, 64 U.S.P.Q.2d (BNA) at 1455 (Newman, J., dissenting).

493. *Id.* at 1372-73, 64 U.S.P.Q.2d (BNA) at 1456.

ordinary meaning of a claim term or intrinsic evidence to determine the meaning of a claim.

Ironically, it was the Supreme Court, not the Federal Circuit, that handed down the most important decision concerning infringement this year, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*<sup>494</sup> In this case, the Court considered the scope of the doctrine of equivalents as limited by the prosecution history of a patent in suit. The Court reversed the Federal Circuit and held that any amendment could narrow the scope of equivalents, but that truly cosmetic amendments would not create such a narrow scope.

In addition to claim construction and the doctrine of equivalents, the Federal Circuit had occasion to address the issues of literal infringement, inducement of infringement, and design patent infringement. What follows is an overview of some of the infringement cases that the court decided in 2002.

#### A. Claim Construction

Construing the claims at issue is the first step in an infringement analysis.<sup>495</sup> As a general rule, terms in a patent claim receive their plain, ordinary, and accepted meaning within the community of those of ordinary skill in the relevant art.<sup>496</sup> There is a “heavy presumption” that favors the use of this accepted meaning.<sup>497</sup> However, if the patentee chooses to use terms in some other manner, this presumption may be overcome and the Federal Circuit may depart from this customary meaning.<sup>498</sup> Accordingly, it is necessary to review the specification to determine whether the patentee assigned any special meaning to claim terms.<sup>499</sup> The specification is the best source to determine the meaning of a disputed term.<sup>500</sup> However, in consulting the specification, the interpretative process may not

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494. 535 U.S. 722, 62 U.S.P.Q.2d (BNA) 1705 (2002).

495. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976, 34 U.S.P.Q.2d (BNA) 1321, 1326 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370, 384 (1996); *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1344, 63 U.S.P.Q.2d (BNA) 1769, 1772 (Fed. Cir. 2002).

496. *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299, 53 U.S.P.Q.2d (BNA) 1065, 1067 (Fed. Cir. 1999).

497. *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 989, 50 U.S.P.Q.2d (BNA) 1607, 1610 (Fed. Cir. 1999).

498. *Ecolab, Inc. v. Envirochem, Inc.*, 264 F.3d 1358, 1366, 60 U.S.P.Q.2d (BNA) 1173, 1179 (Fed. Cir. 2001); *Hoechst Celanese Corp. v. BP Chems. Ltd.*, 78 F.3d 1575, 1578, 38 U.S.P.Q.2d (BNA) 1126, 1129 (Fed. Cir. 1996).

499. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 U.S.P.Q.2d (BNA) 1573, 1577 (Fed. Cir. 1996); *Teleflex, Inc. v. Ficoso N. Am. Corp.*, 299 F.3d 1313, 1325, 63 U.S.P.Q.2d (BNA) 1374, 1380 (Fed. Cir. 2002).

500. *Vitronics*, 90 F.3d at 1582, 39 U.S.P.Q.2d (BNA) at 1577; *Teleflex*, 299 F.3d at 1325, 63 U.S.P.Q.2d (BNA) at 1380.

import limitations from the specification into the defining language of the claims.<sup>501</sup> Additionally, if in evidence, the Federal Circuit may consider the prosecution history, which is often of critical importance in determining the meaning of a claim.<sup>502</sup>

1. *Interpreting the plain and ordinary meaning of claims*

In two related cases, *Inverness Medical Switzerland GmbH v. Warner Lambert Co.*<sup>503</sup> (“*Inverness I*”) and *Inverness Medical Switzerland GmbH v. Princeton Biomeditech Corp.*<sup>504</sup> (“*Inverness II*”), the Federal Circuit vacated the district court’s grant of summary judgment of non-infringement on the grounds of an erroneous claim construction.<sup>505</sup> The patents-at-issue in both cases involved a pregnancy-testing device.<sup>506</sup> In *Inverness I*, the Federal Circuit indicated that the construction of the phrase “mobility . . . is facilitated” from *Inverness II* also applied in this case.<sup>507</sup> In *Inverness II*, the Federal Circuit noted that the district court construed the phrase to mean that a “sugar, or a material that includes sugar as an ingredient . . . must help or improve the release of the labeled reagent from the test strip.”<sup>508</sup> The Federal Circuit, in *Inverness II*, disagreed with this interpretation and concluded that the claim phrase must be given its ordinary meaning of “capacity to make movement easier.”<sup>509</sup> The Federal Circuit started its construction with the use of dictionaries to determine the ordinary meaning of the claim terms.<sup>510</sup> The Federal Circuit relied on standard English-language dictionaries rather than specialized, technical dictionaries because the parties did not argue that the term had an established specialized meaning.<sup>511</sup> Further, the Federal Circuit indicated that it looked to dictionary definitions that were applicable

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501. *Intervet Am., Inc. v. Kee-Vet Labs., Inc.*, 887 F.2d 1050, 1053, 12 U.S.P.Q.2d (BNA) 1474, 1476 (Fed. Cir. 1989).

502. *Id.* at 1053, 12 U.S.P.Q.2d (BNA) at 1476; *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980, 34 U.S.P.Q.2d (BNA) 1321, 1330 (Fed. Cir. 1995) (en banc), *aff’d*, 517 U.S. 370, 384 (1996); *Vitronics*, 90 F.3d at 1582, 39 U.S.P.Q.2d (BNA) at 1577.

503. 309 F.3d 1373, 64 U.S.P.Q.2d (BNA) 1933 (Fed. Cir. 2002).

504. 309 F.3d 1365, 64 U.S.P.Q.2d (BNA) 1926 (Fed. Cir. 2002).

505. *Inverness II*, 309 F.3d at 1366, 64 U.S.P.Q.2d (BNA) at 1927; *Inverness I*, 309 F.3d at 1374-75, 64 U.S.P.Q.2d (BNA) at 1933.

506. *Inverness II*, 309 F.3d at 1366, 64 U.S.P.Q.2d (BNA) at 1927; *Inverness I*, 309 F.3d at 1375, 64 U.S.P.Q.2d (BNA) at 1934.

507. *Inverness I*, 309 F.3d at 1377, 64 U.S.P.Q.2d (BNA) at 1935-36.

508. *Inverness II*, 309 F.3d at 1368, 64 U.S.P.Q.2d (BNA) at 1929 (emphasis removed) (quoting *Conopco, Inc. v. Princeton Biomeditech Corp.*, No. 97-6254 at 8 (D.N.J. Sept. 28, 2000)).

509. *Id.* at 1370, 64 U.S.P.Q.2d (BNA) at 1930.

510. *Id.* at 1369-70, 64 U.S.P.Q.2d (BNA) at 1930.

511. *Id.* at 1369, 64 U.S.P.Q.2d (BNA) at 1930.

on the date the patents were issued in construing the claim.<sup>512</sup> In choosing between multiple definitions, the Federal Circuit relied on the patent disclosure to differentiate between proper and improper meanings.<sup>513</sup> The Federal Circuit further indicated that when a claim term is used in more than one claim, it should be construed consistently.<sup>514</sup> In assessing the prosecution history, the Federal Circuit did not find “a clear and unambiguous disclaimer of a claim scope” that required deviation from the ordinary meaning of the claim term.<sup>515</sup>

Additionally, in *Inverness I*, the Federal Circuit discussed the construction of the words “on” and “onto.”<sup>516</sup> The district court construed those words as requiring surface disposition.<sup>517</sup> The Federal Circuit concluded that those words encompass both surface and internal positioning and therefore vacated the district court’s judgment.<sup>518</sup> Applying the same process as used in *Inverness II*, the Federal Circuit concluded that there are two pertinent definitions and that the words may be interpreted to include both alternatives.<sup>519</sup> Interestingly, the Federal Circuit allowed the appellants to raise an argument for the first time on appeal because it provided additional support for the claim construction the appellants previously argued.<sup>520</sup> Finally, the Federal Circuit determined that the prosecution history did not preclude the use of more expansive dictionary definitions encompassing surface and internal positioning.<sup>521</sup>

In *Texas Digital Systems, Inc. v. Telegenix, Inc.*,<sup>522</sup> the Federal Circuit affirmed-in-part, reversed-in-part, and remanded the district court’s construction of various terms.<sup>523</sup> In doing so, the Federal Circuit reinforced the propriety of courts using dictionaries, encyclopedias and treatises to determine the ordinary and customary meaning of claim terms.<sup>524</sup> The Federal Circuit went on to say that:

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512. *Id.* at 1370, 64 U.S.P.Q.2d (BNA) at 1930.

513. *Id.*, 64 U.S.P.Q.2d (BNA) at 1930 (quoting *Renishaw PLC v. Marposs Societa per Azioni*, 158 F.3d 1243, 1250, 48 U.S.P.Q.2d (BNA) at 1117, 1122 (Fed. Cir. 1998)).

514. *Id.* at 1371, 64 U.S.P.Q.2d (BNA) at 1931.

515. *Id.* at 1372, 64 U.S.P.Q.2d (BNA) at 1932.

516. *Inverness I*, 309 F.3d 1373, 1377-78, 64 U.S.P.Q.2d (BNA) 1933, 1936-37 (Fed. Cir. 2002).

517. *Id.* at 1377, 64 U.S.P.Q.2d (BNA) at 1935.

518. *Id.* at 1382, 64 U.S.P.Q.2d (BNA) at 1939.

519. *Id.* at 1378-79, 64 U.S.P.Q.2d (BNA) at 1936-37.

520. *Id.* at 1380-81, 64 U.S.P.Q.2d (BNA) at 1938.

521. *Id.* at 1382, 64 U.S.P.Q.2d (BNA) at 1939.

522. 308 F.3d 1193, 64 U.S.P.Q.2d (BNA) 1812 (Fed. Cir. 2002).

523. *Id.* at 1197, 64 U.S.P.Q.2d (BNA) at 1815.

524. *Id.* at 1202, 64 U.S.P.Q.2d (BNA) at 1818.

Dictionaries are always available to the court to aid in the task of determining meanings that would have been attributed by those of skill in the relevant art to any disputed terms used by the inventor in the claims . . . . Indeed, these materials may be the most meaningful sources of information to aid judges in better understanding both the technology and the terminology used by those skilled in the art to describe the technology.<sup>525</sup>

In *Electro Scientific Industries, Inc. v. Dynamic Details, Inc.*,<sup>526</sup> the Federal Circuit vacated the district court's summary judgment of non-infringement based on claim construction.<sup>527</sup> The patent at issue was for an accurate method of high-speed drilling of small holes in circuit boards.<sup>528</sup> The district court construed the term "circuit boards" to "require multiple, separated workpieces, [but] not a system for processing a single workpiece."<sup>529</sup> Based on the language of the claim, the specification, and the prosecution history, the Federal Circuit determined that the term "circuit boards" does not require separated workpieces.<sup>530</sup> Despite a depiction in the specification of an embodiment that processes physically separate pieces, the Federal Circuit did not believe the specification restricted the claim language to require separate circuit boards or workpieces.<sup>531</sup> Interestingly, the Federal Circuit relied on a dictionary to determine that the word "multiple" does not require separateness.<sup>532</sup>

In *Union Carbide Chemicals & Plastics Technology Corp. v. Shell Oil Co.*,<sup>533</sup> the Federal Circuit affirmed-in-part, reversed-in-part, and remanded the District Court of Delaware's finding of non-infringement of Union Carbide's patents.<sup>534</sup> Union Carbide's patents contained efficiency equations for ethylene-oxide silver catalysts.<sup>535</sup> With respect to the claim construction of one patent, the district court interpreted the claims as requiring the infringing party to actually use the equation in creating its catalyst, rather than simply requiring that the party's catalyst be used to satisfy the equation.<sup>536</sup>

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525. *Id.*, 64 U.S.P.Q.2d (BNA) at 1818.

526. 307 F.3d 1343, 64 U.S.P.Q.2d (BNA) 1781 (Fed. Cir. 2002).

527. *Id.* at 1345, 64 U.S.P.Q.2d (BNA) at 1781.

528. *Id.*, 64 U.S.P.Q.2d (BNA) at 1781.

529. *Id.* at 1348, 64 U.S.P.Q.2d (BNA) at 1783 (citation omitted in original).

530. *Id.* at 1348-50, 64 U.S.P.Q.2d (BNA) at 1783-85.

531. *Id.* at 1349, 64 U.S.P.Q.2d (BNA) at 1784.

532. *Id.* at 1350, 64 U.S.P.Q.2d (BNA) at 1785.

533. 308 F.3d 1167, 64 U.S.P.Q.2d (BNA) 1545 (Fed. Cir. 2002).

534. *Id.* at 1171, 64 U.S.P.Q.2d (BNA) at 1547.

535. *Id.* at 1171-73, 64 U.S.P.Q.2d (BNA) at 1547-49.

536. *Id.* at 1174, 64 U.S.P.Q.2d (BNA) at 1549.

Consequently, the district court construed “characterizable by” to mean “determined from.”<sup>537</sup>

In its analysis, the Federal Circuit noted that the general rule creates a presumption that claim terms mean what they say and courts should construe them according to their ordinary and accustomed meaning.<sup>538</sup> However, the Federal Circuit explained that the “heavy presumption” favoring ordinary meaning can be overcome if a different meaning is clearly and deliberately put forth in intrinsic evidence.<sup>539</sup> Relying on a dictionary, the Federal Circuit found that the definition of “characterizable” is “capable of being characterized” and “characterize” is defined as “to describe the essential character or quality of . . . to be a distinguishing characteristic of.”<sup>540</sup> From this, the Federal Circuit deduced that the ordinary meaning of “characterizable by an efficiency equation” was “capable of being described by an efficiency equation.”<sup>541</sup> This would be the accepted meaning “unless the intrinsic evidence clearly redefines the claim term to put one reasonably skilled in the relevant art on notice that Union Carbide intended to assign the term a different meaning.”<sup>542</sup> After examining the prosecution history and specification, the Federal Circuit held that there was no justification to depart from “the ordinary meaning of the claim language.”<sup>543</sup> With respect to the claim term “an efficiency-enhancing amount . . . of a mixture of [salts],” the Federal Circuit agreed with the district court that this meant that the “salts themselves must increase the efficiency of the catalyst.”<sup>544</sup> Because the Federal Circuit interpreted some of the claims differently from the district court, the Federal Circuit remanded the cases to determine infringement according to the proper claim construction.<sup>545</sup>

In *CCS Fitness, Inc. v. Brunswick Corp.*,<sup>546</sup> the Federal Circuit vacated the district court’s grant of summary judgment of non-infringement

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537. *Id.*, 64 U.S.P.Q.2d (BNA) at 1549.

538. *Id.* at 1177, 64 U.S.P.Q.2d (BNA) 1551.

539. *Id.*, 64 U.S.P.Q.2d (BNA) 1551.

540. *Id.*, 64 U.S.P.Q.2d (BNA) 1552.

541. *Id.*, 64 U.S.P.Q.2d (BNA) at 1552.

542. *Id.* at 1177-78, 64 U.S.P.Q.2d (BNA) at 1552 (“We have previously held that, in redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must ‘clearly set forth’ or ‘clearly redefine’ a claim term so as to put one reasonably skilled in the art on notice that the patentee intended to so redefine the claim term.” (citing *Bell Atl. Network Servs.*, 262 F.3d 1258, 1268, 59 U.S.P.Q.2d (BNA) 1865, 1870 (Fed. Cir. 2001)).

543. *Id.* at 1177-78, 64 U.S.P.Q.2d (BNA) at 1552.

544. *Id.* at 1180, 64 U.S.P.Q.2d (BNA) at 1554.

545. *Id.* at 1190, 64 U.S.P.Q.2d (BNA) at 1561-62.

546. 288 F.3d 1359, 62 U.S.P.Q.2d (BNA) 1658 (Fed. Cir. 2002).



based on the district court's erroneous claim construction of the term "reciprocating member" as limited to a single-component straight bar in the plaintiff's patent for an elliptical trainer.<sup>547</sup> In reaching its decision, the Federal Circuit reiterated that there is a strong presumption that a claim term carries its ordinary and customary meaning.<sup>548</sup> The Federal Circuit stated that generally it will interpret a term to cover all known structural variation "if an apparatus claim recites a general structure without limiting that structure to a specific subset of structures."<sup>549</sup> The Federal Circuit noted that its precedents show that dictionary definitions may establish a claim term's ordinary meaning.<sup>550</sup>

The Federal Circuit further held that a party accused of infringement may overcome the presumption of ordinary meaning and narrow a claim term.<sup>551</sup> However, it is not enough for the accused party to simply indicate a preferred embodiment because a patentee is not required to describe every possible embodiment of the invention in the specification.<sup>552</sup> A narrowing of claims may be achieved in several ways: (1) where the patentee acts as his own lexicographer; (2) where the patentee distinguishes the term from the prior art in the specification, drawings, or prosecution history; (3) where the patentee's chosen term "so deprives the claim of clarity" that resorting to intrinsic evidence is necessary for a definite meaning; and (4) where a claim term invokes a means-plus-function analysis under 35 U.S.C. § 112, ¶ 6.<sup>553</sup> None of the narrowing methods was applicable here.<sup>554</sup> Instead, the Federal Circuit looked

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547. *Id.* at 1362, 62 U.S.P.Q.2d (BNA) at 1659.

548. *Id.* at 1366, 62 U.S.P.Q.2d (BNA) at 1662 (citations omitted).

549. *Id.*, 62 U.S.P.Q.2d (BNA) at 1662 (quoting *Renishaw PLC v. Marposs Societa per Azioni*, 158 F.3d 1234, 1250, 48 U.S.P.Q.2d (BNA) at 1117, 1122 (Fed. Cir. 1999)).

550. *Id.*, 62 U.S.P.Q.2d (BNA) at 1662 (citing *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1344, 60 U.S.P.Q.2d (BNA) 1851, 1855 (Fed. Cir. 2001) (defining the ordinary meaning of "portion" as encompassing both a one-piece and a two-piece structure using *Random House Unabridged Dictionary*)); *see also Renishaw*, 158 F.3d at 1250, 48 U.S.P.Q.2d (BNA) at 1122 (holding that a term's meaning may come from a "relevant dictionary" as long as the definition does not contradict the plain meaning of the patent disclosure); *Kegel Co. v. AMF Bowling, Inc.*, 127 F.3d 1420, 1427, 44 U.S.P.Q.2d (BNA) 1123, 1127 (Fed. Cir. 1997) (citing *Webster's Third New International Dictionary* to define "assembly"); *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1584 n.6, 39 U.S.P.Q.2d (BNA) 1573, 1580 n.6 (Fed. Cir. 1996) (explaining that technical treatises and dictionaries, though extrinsic to integrated patent documents, are legitimate resources which help judges to better understand underlying technology and interpret claim terms, so long as such definitions do not contradict definitions ascertained by reading patent documents).

551. *CCS Fitness*, 288 F.3d at 1366, 62 U.S.P.Q.2d (BNA) at 1662 (citations omitted).

552. *Id.*, 62 U.S.P.Q.2d (BNA) at 1662.

553. *Id.* at 1366-67, 62 U.S.P.Q.2d (BNA) at 1662-63 (citations omitted).

554. *Id.*, 62 U.S.P.Q.2d (BNA) at 1662-63.

to the ordinary meaning of “reciprocating member” based on a dictionary definition to determine the scope of the claims.<sup>555</sup> The Federal Circuit reversed the district court’s decision because the district court imported limitations from the specifications into the claims in its claim construction.<sup>556</sup>

*Teleflex, Inc. v. Ficos North America Corp.*<sup>557</sup> concerned a patent for shift cable components used in motor vehicles.<sup>558</sup> At issue was the term “clip” as used in the claims.<sup>559</sup> The judge adopted a narrow construction of “clip” but the jury found the claims to be infringed.<sup>560</sup> Ficos appealed the denial of its motion for judgment as a matter of law on the non-infringement issue and the Federal Circuit affirmed the district court’s decision.<sup>561</sup> The Federal Circuit first stated that the claim’s words are interpreted “in light of the intrinsic evidence from the record, including the written description, the drawings, and the prosecution history, if in evidence.”<sup>562</sup> Intrinsic evidence may offer context and clarification regarding the meaning of claim terms and is an important source for the legally operative meaning of language in dispute.<sup>563</sup>

However, in assessing claim construction, the Federal Circuit stated that the number of embodiments disclosed in the specification cannot be determined by the meaning of disputed terms.<sup>564</sup> As the Federal Circuit explained in *CCS Fitness*, the party accused of infringement cannot overcome the presumptive deference to a term’s ordinary meaning simply by referencing the preferred embodiment, structures, or steps disclosed in the specification or prosecution history.<sup>565</sup> As a result, the Federal Circuit determined that the claim at issue was not limited to the preferred embodiment disclosed in the specification.<sup>566</sup> The Federal Circuit held that claim terms assume “ordinary and accustomed” meanings unless the claimant showed an intention to employ a modified definition in the intrinsic record “using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope.”<sup>567</sup>

555. *Id.* at 1367, 62 U.S.P.Q.2d (BNA) at 1663.

556. *Id.* at 1370, 62 U.S.P.Q.2d (BNA) at 1665.

557. 299 F.3d 1313, 63 U.S.P.Q.2d (BNA) 1374 (Fed. Cir. 2002).

558. *Id.* at 1318, 63 U.S.P.Q.2d (BNA) at 1376.

559. *Id.* at 1319, 63 U.S.P.Q.2d (BNA) at 1376.

560. *Id.*, 63 U.S.P.Q.2d (BNA) at 1376.

561. *Id.* at 1318, 63 U.S.P.Q.2d (BNA) at 1375.

562. *Id.* at 1324-25, 63 U.S.P.Q.2d (BNA) at 1380.

563. *Id.* at 1325, 63 U.S.P.Q.2d (BNA) at 1380.

564. *Id.* at 1327, 63 U.S.P.Q.2d (BNA) at 1382.

565. *Id.*, 63 U.S.P.Q.2d (BNA) at 1382.

566. *Id.*, 63 U.S.P.Q.2d (BNA) at 1382.

567. *Id.*, 63 U.S.P.Q.2d (BNA) at 1382.

Although the Federal Circuit determined that the district court erred in its claim construction, it found the error harmless on the issue of infringement because the claim included a broader scope of subject matter than the jury construction.<sup>568</sup> Thus, if Ficosa infringed the district court's narrowly construed claim, it also infringed the Federal Circuit's broader claim.<sup>569</sup>

In *Neomagic Corp. v. Trident Microsystems, Inc.*,<sup>570</sup> the Federal Circuit affirmed-in-part, vacated-in-part, and remanded the district court's entry of summary judgment of non-infringement of Neomagic's '955 and '806 patents.<sup>571</sup> The Federal Circuit affirmed the trial court's construction of the term "coupling" in the '955 patent to require that the voltage applied to the substrate be different from that applied to the logic circuit.<sup>572</sup> The Federal Circuit used a technical dictionary definition of "coupling" to demonstrate the ordinary meaning of the term.<sup>573</sup> Because the accused devices tap both the substrate and logic circuit at the same voltage, the Federal Circuit found that they did not infringe the '955 patent as a matter of law.<sup>574</sup>

With regard to the '806 patent, the Federal Circuit vacated and remanded the district court's construction of "power supply" because the district court improperly relied upon the accused device to arrive at that definition.<sup>575</sup> The Federal Circuit noted that "it is well-settled that claims may not be construed by reference to the accused device."<sup>576</sup> Finally, the Federal Circuit reversed the district court's construction of "negative voltage with respect to" as referring to absolute voltage.<sup>577</sup> The Federal Circuit interpreted the term to refer to relative voltage based on the plain meaning of the claim, which it viewed as being consistent with the specification.<sup>578</sup>

In *Middleton, Inc. v. Minnesota Mining & Manufacturing Co.*,<sup>579</sup> the Federal Circuit reversed the district court's summary judgment of non-infringement because the district court applied an erroneous

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568. *Id.* at 1328-29, 63 U.S.P.Q.2d (BNA) at 1383.

569. *Id.*, 63 U.S.P.Q.2d (BNA) at 1383.

570. 287 F.3d 1062, 62 U.S.P.Q.2d (BNA) 1482 (Fed. Cir. 2002).

571. *Id.* at 1075-76, 62 U.S.P.Q.2d (BNA) at 1491.

572. *Id.* at 1072, 62 U.S.P.Q.2d (BNA) at 1489.

573. *Id.* at 1071, 62 U.S.P.Q.2d (BNA) at 1488.

574. *Id.* at 1072-73, 62 U.S.P.Q.2d (BNA) at 1489.

575. *Id.* at 1073-74, 62 U.S.P.Q.2d (BNA) at 1489-90.

576. *Id.* at 1074, 62 U.S.P.Q.2d (BNA) at 1490 (quoting *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1118, 227 U.S.P.Q. 577, 583 (Fed. Cir. 1985) (en banc)).

577. *Id.* at 1075, 62 U.S.P.Q.2d (BNA) at 1490-91.

578. *Id.*, 62 U.S.P.Q.2d (BNA) at 1491.

579. 311 F.3d 1384, 65 U.S.P.Q.2d (BNA) 1138 (Fed. Cir. 2002).

claim interpretation based on the meaning of “uniform.”<sup>580</sup> The claimed invention was a floor finishing material including a “uniform” film of clear plastic material.<sup>581</sup> The Federal Circuit noted that the term “uniform flexible film” apparently did carry any special technical meanings and the accepted meaning of “uniform” is “having always the same form.”<sup>582</sup> The Federal Circuit looked to the specification and found that it defines “flexible” as “bendability of the sheet but [] not . . . stretchability.”<sup>583</sup> Furthermore, the Federal Circuit stated that “film” obviously means the clear plastic material referred to in the patent disclosure.<sup>584</sup> Finally, the Federal Circuit acknowledged that usage and context within the claim itself were the most important indicators of the meaning of a term.<sup>585</sup> “Uniform” could thus mean “uniform in irregularity” as well as “uniform in thickness.”<sup>586</sup> As a result, a textured surface that was non-uniform in thickness could infringe the patent provided that the irregularities are uniform.<sup>587</sup>

2. *The use of the specification and prosecution history in interpreting claims*

In *All Dental Prodx v. Advantage Dental Products*, the Federal Circuit affirmed-in-part and reversed-in-part a summary judgment decision of the U.S. District Court for the Eastern District of New York.<sup>588</sup> The claim language in dispute was “original unidentified mass.”<sup>589</sup> All Dental sold tablets that were oval-shaped and flat and could be molded onto a tooth to take an impression.<sup>590</sup> The Federal Circuit stated that while the disputed language “was not a model of clarity,” it was easily understood when put in the context of the specification.<sup>591</sup> The Federal Circuit noted that the specification did not need to describe the subject matter in the exact terms used in the claims, but simply needed to indicate to persons skilled in the art that, as of the filing date, the applicant invented what was now being claimed.<sup>592</sup>

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580. *Id.* at 1385-86, 65 U.S.P.Q.2d (BNA) at 113839.

581. *Id.* at 1385, 65 U.S.P.Q.2d (BNA) at 1139.

582. *Id.* at 1387, 65 U.S.P.Q.2d (BNA) at 1140 (citing WEBSTER'S NINTH NEW COLLEGIATE DICTIONARY 1290 (1985)).

583. *Id.*, 65 U.S.P.Q.2d (BNA) at 1140.

584. *Id.*, 65 U.S.P.Q.2d (BNA) at 1140.

585. *Id.*, 65 U.S.P.Q.2d (BNA) at 1140.

586. *Id.* at 1389, 65 U.S.P.Q.2d (BNA) at 1142.

587. *Id.*, 65 U.S.P.Q.2d (BNA) at 1142.

588. 309 F.3d 774, 776, 64 U.S.P.Q.2d (BNA) 1945, 1946 (Fed. Cir. 2002).

589. *Id.* at 778-79, 64 U.S.P.Q.2d (BNA) at 1948-49.

590. *Id.* at 777, 64 U.S.P.Q.2d (BNA) at 1947.

591. *Id.* at 779, 64 U.S.P.Q.2d (BNA) at 1948.

592. *Id.*, 64 U.S.P.Q.2d (BNA) at 1948 (quoting *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 U.S.P.Q.2d (BNA) 1467, 1470 (Fed. Cir. 1995)).

In *Jack Guttman, Inc. v. Kopykake Enterprises, Inc.*,<sup>593</sup> the Federal Circuit vacated and remanded the decision by the U.S. District Court for the Southern District of Ohio denying Guttman's motion for a preliminary injunction because the district court based its decision on an erroneous claim construction.<sup>594</sup> The patent at issue involved the use of an inkjet copy machine to make edible copies of photographs to put on cakes.<sup>595</sup> Guttman claimed that the novelty of the patent stemmed from the conventional wisdom that edible sheets were too delicate to go through hot and tortuous path of an inkjet copier and that the inventor fashioned the idea to adhere the edible sheet to a carrier sheet, and then send it through the manual feed path of a conventional inkjet copier with the heaters removed or disabled.<sup>596</sup> The Federal Circuit construed "photocopy machine," finding that insofar as the specification explicitly contemplated that a "photocopy machine" could have scanning and reproduction components in separate housings, the district court erred in limiting the claims to "conventional" photocopy machines.<sup>597</sup> As a result, a scanner combined with an inkjet printer could be a "photocopy machine" under the Federal Circuit's interpretation.<sup>598</sup> Because the intrinsic evidence made the claims unambiguous, the district court erred by failing to construe the terms in dispute in accordance with that evidence.<sup>599</sup> The Federal Circuit remanded the case to the district court for further proceedings based upon the proper claim construction.<sup>600</sup>

In *Bowers v. Baystate Technologies, Inc.*,<sup>601</sup> the Federal Circuit reversed the district court's patent infringement award, holding that no reasonable jury could find that Baystate infringed a properly construed claim of Bowers' patent.<sup>602</sup> Here, Bowers developed and received a patent for a template that works in conjunction with a computer aided design program named CADKEY, made by Cadkey, Inc.<sup>603</sup> Subsequently, Bowers took a license for a copyrighted product called Geodraft and packaged the two products in a "Designer's

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593. 302 F.3d 1352, 64 U.S.P.Q.2d (BNA) 1302 (Fed. Cir. 2002).

594. *Id.* at 1354, 64 U.S.P.Q.2d (BNA) at 1303.

595. *Id.* at 1354-55, 64 U.S.P.Q.2d (BNA) at 1303.

596. *Id.*, 64 U.S.P.Q.2d (BNA) at 1303.

597. *Id.* at 1359-61, 64 U.S.P.Q.2d (BNA) at 1307-09.

598. *Id.*, 64 U.S.P.Q.2d (BNA) at 1307-08.

599. *Id.* at 1362, 64 U.S.P.Q.2d (BNA) at 1308-09.

600. *Id.* at 1363, 64 U.S.P.Q.2d (BNA) at 1310.

601. 302 F.3d 1334, 64 U.S.P.Q.2d (BNA) 1065 (Fed. Cir. 2002).

602. *Id.* at 1338, 64 U.S.P.Q.2d (BNA) at 1065-66.

603. *Id.* at 1338-39, 64 U.S.P.Q.2d (BNA) at 1066-67.

Toolkit” that was released in 1990 with a shrink wrap license.<sup>604</sup> Bowers presented the product to Baystate and offered to establish a business relationship, but Baystate rejected Bowers’ offer and developed a product with similar features as Bowers’ Designer’s Toolkit.<sup>605</sup> Baystate subsequently purchased Cadkey, Inc., effectively eliminating the market for Bowers’ Designer’s Toolkit.<sup>606</sup>

The Federal Circuit held, inter alia, that the district court erred in its claim construction and reversed the jury verdict of patent infringement.<sup>607</sup> Relying on the specification and reexamination history, the Federal Circuit construed the limitation to mean securing said templates in a fixed orientation to said tablet whereby said pointing device can select a working function in a single movement of the said button<sup>608</sup> to mean that “each of the indicia associated with the sub-menu of a main-menu group must represent a working function accessible with a single movement of the pointer button (e.g., as opposed to access through a further selection via a drop-down menu).”<sup>609</sup> Applying this construction to the “undisputed” evidence that the accused product utilized drop-down menus, the Federal Circuit held that the record showed that the patent in suit was not literally infringed.<sup>610</sup> The Federal Circuit noted that, because the patentee did not assert infringement under the doctrine of equivalents, it would not consider it on appeal.<sup>611</sup>

In *Bionx Implants, Inc. v. Linvatec Corp.*,<sup>612</sup> the Federal Circuit affirmed the claim construction decision by the U.S. District Court for the Southern District of New York, but vacated that court’s order entering summary judgment and remanded the case for further proceedings.<sup>613</sup> The patent-at-issue related to a surgical fastener that is particularly adapted to repairing tears in the meniscus of the knee.<sup>614</sup> On appeal, Bionx argued that the district court adopted too restrictive a construction of the term “rigid,” which is used in each of the asserted claims.<sup>615</sup> The district court’s construction required that the claimed suture be “sufficiently rigid to push through meniscus

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604. *Id.* at 1339, 64 U.S.P.Q.2d (BNA) at 1066.

605. *Id.*, 64 U.S.P.Q.2d (BNA) at 1066.

606. *Id.*, 64 U.S.P.Q.2d (BNA) at 1067.

607. *Id.* at 1338, 64 U.S.P.Q.2d (BNA) at 1066.

608. *Id.* at 1347, 64 U.S.P.Q.2d (BNA) at 1071.

609. *Id.* at 1349, 64 U.S.P.Q.2d (BNA) at 1073.

610. *Id.* at 1351, 64 U.S.P.Q.2d (BNA) at 1075.

611. *Id.*, 64 U.S.P.Q.2d (BNA) at 1075.

612. 299 F.3d 1378, 64 U.S.P.Q.2d (BNA) 1145 (Fed. Cir. 2002).

613. *Id.* at 1379, 64 U.S.P.Q.2d (BNA) at 1145-46.

614. *Id.*, 64 U.S.P.Q.2d (BNA) at 1146.

615. *Id.* at 1380, 64 U.S.P.Q.2d (BNA) at 1146.

tissue without a pre-cut channel for the suture to follow.”<sup>616</sup> Bionx disagreed, arguing that “rigid” should apply to “any shaft that is capable of being pushed through tissue, regardless of whether the tissue is pre-channeled.”<sup>617</sup> The Federal Circuit construed “rigid,” in the context of a surgical fastener designed to repair tears in the knee, to mean “rigid enough to be pushed directly through the semi-hard cartilage of a meniscus [a part of the knee] without any precutting [i.e. a precut channel through the tissue].”<sup>618</sup> The Federal Circuit based its interpretation on the prosecution history in which the patentee distinguished a flexible suture on the basis that it could not be “pushed into body tissue without the use of a needle.”<sup>619</sup>

With respect to the issue of infringement, the Federal Circuit found that videotaped evidence showing use of the device with a cannula (where a cannula is not normally used with the accused infringer’s device, but where use of a cannula was within the context of use contemplated by the patent) could constitute evidence relevant to the question of whether the accused device was rigid.<sup>620</sup> Therefore, the Federal Circuit reversed the district court’s grant of summary judgment and remanded the case for further proceedings.<sup>621</sup>

In *Honeywell Inc. v. Victor Co. of Japan, Ltd.*,<sup>622</sup> the Federal Circuit reversed the district court’s summary judgment ruling that the accused products did not infringe the patent claims.<sup>623</sup> However, the Federal Circuit affirmed the district court’s ruling that some of the accused products were the subjects of a license agreement.<sup>624</sup> In deciding the infringement issue, the Federal Circuit relied heavily on the definition of the claim term “contiguous” that the inventor offered during prosecution of the case before the USPTO.<sup>625</sup> The Federal Circuit determined that the district court erred by not according enough weight to the inventor’s own definition, stating that “[i]t is well settled that a patentee may define a claim term either in the written description of the patent, or, as in the present case, in the prosecution history.”<sup>626</sup> A definition is often offered during

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616. *Id.* at 1381, 64 U.S.P.Q.2d (BNA) at 1146-47.

617. *Id.*, 64 U.S.P.Q.2d (BNA) at 1147.

618. *Id.* at 1380-82, 64 U.S.P.Q.2d (BNA) at 1146-48.

619. *Id.* at 1381-82, 64 U.S.P.Q.2d (BNA) at 1148 (citation omitted in original).

620. *Id.* at 1382-83, 64 U.S.P.Q.2d (BNA) at 1148-49.

621. *Id.* at 1383, 64 U.S.P.Q.2d (BNA) at 1149.

622. 298 F.3d 1317, 63 U.S.P.Q.2d (BNA) 1904 (Fed. Cir. 2002).

623. *Id.* at 1328, 63 U.S.P.Q.2d (BNA) at 1912.

624. *Id.* at 1329, 63 U.S.P.Q.2d (BNA) at 1913.

625. *Id.* at 1323-24, 63 U.S.P.Q.2d (BNA) at 1908-09.

626. *Id.* at 1323, 63 U.S.P.Q.2d (BNA) at 1908 (citing *Mycogen Plant Sci. v.*

prosecution as a response to a rejection and is entered along with a narrowing amendment.<sup>627</sup> Such a definition limits the claim's scope and prevents a patentee from subsequently recapturing what had been surrendered.<sup>628</sup> While an inventor's definition has no narrowing effect, it is relevant to the inventor's interpretation of a term.<sup>629</sup> However, the Federal Circuit rejected the broadest implication of Honeywell's claim construction arguments as contrary to the most expansive dictionary definition of the term "contiguous."<sup>630</sup> The Federal Circuit also reviewed the specification and prosecution history to assist in determining the meaning of the claim limitations.<sup>631</sup> It concluded that nothing in the specification or prosecution history warranted a narrow reading of the claims-at-issue.<sup>632</sup>

In *Fantasy Sports Properties, Inc. v. Sportline.com, Inc.*,<sup>633</sup> the Federal Circuit affirmed-in-part and vacated-in-part the summary judgment of non-infringement decision by the U.S. District Court for the Eastern District of Virginia.<sup>634</sup> The claims on appeal involve a method and apparatus for playing a "fantasy" football computer game.<sup>635</sup> The claim limitation in dispute was "wherein said players in said first and second groups receive bonus points."<sup>636</sup> The Federal Circuit construed the term "bonus points" to mean "additional points awarded beyond those given in an actual football game for unusual scoring plays, such as when a player scores in a manner not typically associated with his position."<sup>637</sup> The Federal Circuit noted that in conjunction with the ordinary meaning of the claim term, the

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Monsanto Co., 243 F.3d 1316, 1327, 58 U.S.P.Q.2d (BNA) 1030, 1039 (Fed. Cir. 2001)).

627. *Id.* at 1323-24, 63 U.S.P.Q.2d (BNA) at 1908 (citing as an example, *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576, 34 U.S.P.Q.2d (BNA) 1673, 1677 (Fed. Cir. 1995)).

628. *Id.* at 1324, 63 U.S.P.Q.2d (BNA) at 1908.

629. *Id.*, 63 U.S.P.Q.2d (BNA) at 1908 (citing *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 U.S.P.Q.2d (BNA) 1573, 1577 (Fed. Cir. 1996) (indicating that the record is often critical to determining a claim's meaning); *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1438, 7 U.S.P.Q.2d (BNA) 1129, 1135 (Fed. Cir. 1988) (stating that the prosecution history "must be examined to ascertain the true meaning of what the inventor intended to convey in the claims")).

630. *Id.*, 63 U.S.P.Q.2d (BNA) at 1908.

631. *Id.* at 1325-26, 63 U.S.P.Q.2d (BNA) at 1909-10.

632. *Id.*, 63 U.S.P.Q.2d (BNA) at 1909-10.

633. 287 F.3d 1108, 62 U.S.P.Q.2d (BNA) 1564 (Fed. Cir. 2002).

634. *Id.* at 1111, 62 U.S.P.Q.2d (BNA) at 1566.

635. *Id.*, 62 U.S.P.Q.2d (BNA) at 1566.

636. *Id.*, 62 U.S.P.Q.2d (BNA) at 1567.

637. *Id.* at 1114, 62 U.S.P.Q.2d (BNA) at 1568.



specification also supported the district court's definition.<sup>638</sup> The specification stated that "[c]omputerized football points are awarded for touchdowns, field goals, and points after touchdowns. *Bonus* points were *also* awarded based upon the difficulty of the play."<sup>639</sup> As a result, "bonus points" was interpreted as points awarded for a scoring play above the points such a scoring play would earn in an actual football game.<sup>640</sup>

In its infringement analysis, the Federal Circuit concluded that Yahoo! did not infringe the patent because the term "miscellaneous points" indicated only an unusual play, with no additional points awarded beyond those given for such a play in a real football game.<sup>641</sup> The Federal Circuit also concluded that ESPN did not infringe the patent because their game awarded no additional points beyond those awarded in a real football game.<sup>642</sup> Furthermore, the Federal Circuit acknowledged that ESPN's fantasy football game awarded a points depending on the type of scoring play, the game did not award points based upon the position of the scoring player.<sup>643</sup>

With respect to SportsLine's game, the Federal Circuit concluded that the district court erred in granting summary judgment because under the proper infringement analysis, there existed a genuine issue of material fact.<sup>644</sup> The Federal Circuit held that in order to infringe Fantasy's patent, the software code underlying the accused game must be written in such a way as to allow a user to utilize the function of awarding bonus points for unusual plays without having to modify the code.<sup>645</sup> The SportsLine game allowed for position-specific scoring by creating different scoring configurations for each position.<sup>646</sup> As a result, the Federal Circuit determined that the SportsLine game directly infringed the "computer playing football" limitation of Fantasy's patent.<sup>647</sup> The Federal Circuit also determined that it was unclear whether kickers could be awarded points for an out-of-position score.<sup>648</sup> Thus, the Federal Circuit remanded the case

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638. *Id.*, 62 U.S.P.Q.2d (BNA) at 1568.

639. *Id.*, 62 U.S.P.Q.2d (BNA) at 1568.

640. *Id.*, 62 U.S.P.Q.2d (BNA) at 1568.

641. *Id.* at 1116, 62 U.S.P.Q.2d (BNA) at 1570.

642. *Id.* at 1116-17, 62 U.S.P.Q.2d (BNA) at 1570.

643. *Id.* at 1117, 62 U.S.P.Q.2d (BNA) at 1570.

644. *Id.*, 62 U.S.P.Q.2d (BNA) at 1571.

645. *Id.* at 1118, 62 U.S.P.Q.2d (BNA) at 1572.

646. *Id.* at 1119, 62 U.S.P.Q.2d (BNA) at 1572.

647. *Id.*, 62 U.S.P.Q.2d (BNA) at 1572.

648. *Id.*, 62 U.S.P.Q.2d (BNA) at 1573.

to the district court to determine whether the SportsLine product supports awarding bonus points to kickers in a second group.<sup>649</sup>

In *Pickholtz v. Rainbow Technologies, Inc.*,<sup>650</sup> the Federal Circuit reversed the district court's grant of summary judgment of non-infringement, but affirmed the district court's denial of Pickholtz's motion for infringement.<sup>651</sup> In so doing, the Federal Circuit held that the district court erred when it construed the term "computer" to exclude peripherals.<sup>652</sup> The Federal Circuit determined that Pickholtz used the terms "computer" and "computer system" in the specification synonymously and that nothing in the patent itself explained their relationship or indicated any difference in meaning.<sup>653</sup> Accordingly, the Federal Circuit found that the lower court in error in concluding that the "intrinsic evidence unambiguously imparted different meanings to the terms."<sup>654</sup> Since "computer" can be defined through intrinsic evidence alone, the Federal Circuit found no need to rely on extrinsic evidence,<sup>655</sup> which, would not have been conclusive in any event.<sup>656</sup> Interestingly, the Federal Circuit determined that nothing in the prosecution history indicated that the terms have different meanings, although a prior art patent used the terms differently.<sup>657</sup> The Federal Circuit did not discuss whether the prior art patent should be treated according to how a person of ordinary skill would understand the terms.<sup>658</sup>

In *Tate Access Floors, Inc. v. Interface Architectural Resources, Inc.*,<sup>659</sup> the Federal Circuit affirmed the lower court's preliminary injunction against Interface to prevent Interface from infringing Tate's patent claims to raised access flooring panels.<sup>660</sup> Interface appealed only the lower court's conclusion regarding the likelihood of success based on the merits of Tate's infringement claim.<sup>661</sup> The Federal Circuit rejected Interface's argument that the lower court's interpretation of the term "border," which "encompass[es] the simple beveled edges in the accused floor panels" was an erroneous construction.<sup>662</sup> In doing

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649. *Id.*, 62 U.S.P.Q.2d (BNA) at 1573.

650. 284 F.3d 1365, 62 U.S.P.Q.2d (BNA) 1340 (Fed. Cir. 2002).

651. *Id.* at 1367-68, 62 U.S.P.Q.2d (BNA) at 1341.

652. *Id.* at 1373-74, 62 U.S.P.Q.2d (BNA) at 1345-46.

653. *Id.* at 1373, 62 U.S.P.Q.2d (BNA) at 1345.

654. *Id.*, 62 U.S.P.Q.2d (BNA) at 1345.

655. *Id.*, 62 U.S.P.Q.2d (BNA) at 1345.

656. *Id.*, 62 U.S.P.Q.2d (BNA) at 1345.

657. *Id.*, 62 U.S.P.Q.2d (BNA) at 1345.

658. *Id.*, 62 U.S.P.Q.2d (BNA) at 1345.

659. 279 F.3d 1357, 61 U.S.P.Q.2d (BNA) 1647 (Fed. Cir. 2002).

660. *Id.* at 1360, 61 U.S.P.Q.2d (BNA) at 1648.

661. *Id.* at 1364, 61 U.S.P.Q.2d (BNA) at 1652.

662. *Id.* at 1370-72, 61 U.S.P.Q.2d (BNA) 1656-58.

so, the Federal Circuit found that a person possessing ordinary skill in the art of raised access floor panels would know that the term “border” referred to “the area or zone forming an edge or trim framing the decorative surface of the panel.”<sup>663</sup> Moreover, in reviewing the patent, the Federal Circuit found that the specification or claims did not require that the “border” be or single layered.<sup>664</sup> The Federal Circuit reiterated that it would not read in limitations from elsewhere in the specification when the original claim terms were clear, as in the case at issue.<sup>665</sup> Thus, the Federal Circuit held that Interface’s panels infringed Tate’s patent and Tate therefore met the likelihood of success on the merits portion of the preliminary injunction test.<sup>666</sup>

### 3. *The role of the preamble in interpreting claims*

The claims at issue in *Epcon Gas Systems, Inc. v. Bauer Compressors, Inc.*<sup>667</sup> related to a method and apparatus for providing gas assistance to an injection molding process.<sup>668</sup> The Federal Circuit first rejected Bauer’s argument that the preamble limits the scope of the claims.<sup>669</sup> The Federal Circuit found that Epcon’s claims were in Jepson form, which allows a patentee to use the preamble to recite “elements or steps of the claimed invention which are conventional or known.”<sup>670</sup> In *Rowe v. Dror*,<sup>671</sup> the Federal Circuit found that “[w]hen this form is employed, the claim preamble defines not only the context of the claimed invention, but also its scope.”<sup>672</sup> Following *Rowe* a patentee choosing the Jepson form of the claim supports an intention “to use the preamble to define, in part, the structural elements of his claimed invention.”<sup>673</sup> Thus, the Federal Circuit concluded that the preamble served as a limitation since the patentee used a Jepson-type claim.<sup>674</sup>

663. *Id.* at 1370, 61 U.S.P.Q.2d (BNA) at 1656.

664. *Id.*, 61 U.S.P.Q.2d (BNA) at 1657.

665. *Id.* at 1371, 61 U.S.P.Q.2d (BNA) at 1657 (citations omitted).

666. *Id.* at 1372, 61 U.S.P.Q.2d (BNA) at 1658.

667. 279 F.3d 1022, 61 U.S.P.Q.2d (BNA) 1470 (Fed. Cir. 2002).

668. *Id.* at 1025, 61 U.S.P.Q.2d (BNA) at 1472.

669. *Id.* at 1029, 61 U.S.P.Q.2d (BNA) at 1475 (citing *Applied Materials, Inc. v. Advanced Semiconductor Materials Am., Inc.*, 98 F.3d 1563, 1572-73, 40 U.S.P.Q.2d (BNA) 1481, 1488 (Fed. Cir. 1996); *Kropa v. Robie*, 187 F.2d 150, 152, 88 U.S.P.Q. 478, 481 (C.C.P.A. 1951)).

670. *Id.*, 61 U.S.P.Q.2d (BNA) at 1475 (quoting *Kegel Co. v. AMF Bowling, Inc.*, 127 F.3d 1420, 1426, 44 U.S.P.Q.2d (BNA) 1123, 1127 (Fed. Cir. 1997)) (quotation omitted).

671. 112 F.3d 473, 479, 42 U.S.P.Q.2d (BNA) 1550, 1553 (Fed. Cir. 1997).

672. *Epcon*, 279 F.3d at 1029, 61 U.S.P.Q.2d (BNA) at 1475 (citing *Rowe*, 112 F.3d at 479, 42 U.S.P.Q.2d (BNA) at 1553).

673. *Id.*, 61 U.S.P.Q.2d (BNA) at 1475 (quoting *Kegel Co.*, 127 F.3d at 1426, 44 U.S.P.Q.2d (BNA) at 1127).

674. *Id.*, 61 U.S.P.Q.2d (BNA) at 1475 (citation omitted).

The Federal Circuit also used a technical dictionary to help formulate the proper construction of the terms “supply of stored gas,” “substantially,” and “venting.”<sup>675</sup> The Federal Circuit garnered further support for its construction by reviewing the specification and finding it to be consistent with its interpretation.<sup>676</sup>

The Federal Circuit stated that the term “substantially” was used in two of Epcon’s patent claims in slightly different contexts, i.e., “substantially below,” and “substantially constant.”<sup>677</sup> The Federal Circuit noted that “the same term or phrase should be interpreted consistently where it appears in claims of common ancestry.”<sup>678</sup> However, it found that Epcon’s claims implicated a more precise statement of the axiom—“[a] word or phrase used consistently throughout a claim should be interpreted consistently.”<sup>679</sup> The Federal Circuit concluded that there was a “subtle but significant difference” in the two uses of the term “substantially.”<sup>680</sup> The phrase “substantially constant” denoted language of approximation, while the phrase “substantially below” signified language of magnitude.<sup>681</sup> Due to the differing uses of the term, the Federal Circuit held that “substantially” might have differing constructions in the two phrases.<sup>682</sup>

In *Allen Engineering Corp. v. Bartell Industries, Inc.*,<sup>683</sup> the Federal Circuit remanded the district court decision for failure to construe the claim limitations and make adequate findings on infringement.<sup>684</sup> The Federal Circuit provided the district court with guidance on claim construction on remand.<sup>685</sup> In particular, the Federal Circuit focused on the preamble of the claims-in-suit.<sup>686</sup> It noted that each of the claims began with the same preamble, namely “[a] self-propelled, fast steering motorized riding trowel for finishing a concrete

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675. *Id.* at 1029-32, 61 U.S.P.Q.2d (BNA) at 1475-77.

676. *Id.*, 61 U.S.P.Q.2d (BNA) at 1475-77.

677. *Id.* at 1030-31, 61 U.S.P.Q.2d (BNA) at 1476.

678. *Id.* at 1030, 61 U.S.P.Q.2d (BNA) at 1476 (citing *Elkay Mfg. Co. v. Ebco Mfg. Co.*, 192 F.3d 973, 980, 52 U.S.P.Q.2d (BNA) 1109, 1114 (Fed. Cir. 1999); *Abtox, Inc. v. Exitron Corp.*, 131 F.3d 1009, 1010, 46 U.S.P.Q.2d (BNA) at 1735, 1735-36 (Fed. Cir. 1997); *Fonar Corp. v. Johnson & Johnson*, 821 F.2d 627, 632, 3 U.S.P.Q.2d (BNA) 1109, 1113 (Fed. Cir. 1987)).

679. *Id.* at 1030-31, 61 U.S.P.Q.2d (BNA) at 1476 (citing *Phonometrics, Inc. v. N. Telecom Inc.*, 133 F.3d 1459, 1465, 45 U.S.P.Q.2d (BNA) 1421, 1426 (Fed. Cir. 1998)).

680. *Id.* at 1031, 61 U.S.P.Q.2d (BNA) at 1476.

681. *Id.*, 61 U.S.P.Q.2d (BNA) at 1476.

682. *Id.*, 61 U.S.P.Q.2d (BNA) 1476.

683. 299 F.3d 1336, 63 U.S.P.Q.2d (BNA) 1769 (Fed. Cir. 2002).

684. *Id.* at 1346, 63 U.S.P.Q.2d (BNA) at 1773.

685. *Id.*, 63 U.S.P.Q.2d (BNA) at 1773.

686. *Id.*, 63 U.S.P.Q.2d (BNA) at 1774.

surface.”<sup>687</sup> The Federal Circuit noted that claims are not normally limited by the preamble,<sup>688</sup> but may be “when the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention.”<sup>689</sup> The claim preamble should be construed as limiting if it is “necessary to give life, meaning and vitality” to the claim.<sup>690</sup> The Federal Circuit instructed that this construction be made on a case-by-case basis, in light of the overall claim.<sup>691</sup>

Allen Engineering interpreted the term “fast steering” to be a claim limitation.<sup>692</sup> Bartell Industries asserted that the term was laudatory and only set forth the purpose of the claimed invention.<sup>693</sup> The Federal Circuit held that “fast steering” was a relative term unaccompanied by any interpretive reference in either the claims or the specification.<sup>694</sup> Lacking a frame of reference, the indicated that a person of skill in the relevant art would not understand “fast steering” meant in this context.<sup>695</sup> The Court held that “fast steering” “failed to give life, meaning and vitality to the claimed structure” and could not be construed as a claim limit.<sup>696</sup> The Federal Circuit held that the expression should be used only to construe the intended purpose of the claimed combination without creating a limitation of the meaning.<sup>697</sup>

In *Catalina Marketing International v. Coolsavings.com*,<sup>698</sup> the Federal Circuit affirmed-in-part, reversed-in-part, vacated-in-part, and remanded the district court’s grant of summary judgment of non-infringement of Catalina’s patent directed to a system for dispensing

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687. *Id.* at 1346, 63 U.S.P.Q.2d (BNA) at 1774.

688. *Id.*, 63 U.S.P.Q.2d (BNA) at 1774 (citing *DeGeorge v. Bernier*, 768 F.2d 1318, 1322 n.3, 226 U.S.P.Q. 758, 764 n.3 (Fed. Cir. 1985)).

689. *Id.*, 63 U.S.P.Q.2d (BNA) at 1774 (quoting *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 U.S.P.Q.2d (BNA) 1816, 1820 (Fed. Cir. 1995)).

690. *Id.*, 63 U.S.P.Q.2d (BNA) at 1774 (quoting *Kropa v. Robie*, 187 F.2d 150, 152, 88 U.S.P.Q. 478, 480-81 (C.C.P.A. 1951)).

691. *Id.*, 63 U.S.P.Q.2d (BNA) at 1774 (quoting *In re Stencel*, 828 F.2d 751, 754, 4 U.S.P.Q.2d (BNA) 1071, 1073 (Fed. Cir. 1987)); *see also* *Applied Materials, Inc. v. Advanced Semiconductor Materials Am., Inc.*, 98 F.3d 1563, 1572-73, 40 U.S.P.Q.2d (BNA) 1481, 1488 (Fed. Cir. 1996) (“Whether a preamble stating the purpose and context of the invention constitutes a limitation . . . is determined on the facts of each case in light of the overall form of the claim, and the invention as described in the specification and illuminated in the prosecution history.”).

692. *Allen Eng’g*, 299 F.3d at 1346, 63 U.S.P.Q.2d (BNA) at 1774.

693. *Id.* at 1347, 63 U.S.P.Q.2d (BNA) at 1774.

694. *Id.*, 63 U.S.P.Q.2d (BNA) at 1774.

695. *Id.*, 63 U.S.P.Q.2d (BNA) at 1774.

696. *Id.*, 63 U.S.P.Q.2d (BNA) at 1774 (quoting *Kropa*, 187 F.2d at 152, 88 U.S.P.Q. at 480-81).

697. *Id.*, 63 U.S.P.Q.2d (BNA) at 1774.

698. 289 F.3d 801, 62 U.S.P.Q.2d (BNA) 1781 (Fed. Cir. 2002).

coupons to consumers at remote terminals connected to a host computer system.<sup>699</sup> The Federal Circuit held that the district court improperly treated the preamble as a limitation to the asserted claim.<sup>700</sup> In so doing, the Court held that the phrase “located at predesignated sites such as consumer stores” is not a limitation because the patentee did not rely on the phrase in defining the invention or understanding terms or limitations in body of the claim.<sup>701</sup> The Federal Circuit further held that the applicant’s statements during prosecution that its invention involved terminals “located in stores” for the distribution of coupons “on site,” did not suggest a clear reliance on the preamble to distinguish the prior art and, therefore, did not constitute a limitation.<sup>702</sup> In addition, the phrase merely suggested the use of the apparatus without affecting the structure or operation of the claim itself.<sup>703</sup> In contrast, the inclusion of the same phrase in the body of another claim necessarily limited that claim.<sup>704</sup>

#### 4. *Miscellaneous claim interpretation issues*

In *Beckson Marine, Inc. v. NFM, Inc.*,<sup>705</sup> the Federal Circuit vacated and remanded a summary judgment decision by the U.S. District Court for the Western District of Washington based on the Federal Circuit’s finding that the district court’s claim interpretation was not supported by the record.<sup>706</sup> Beckson’s patent was directed to a portlight window for a boat.<sup>707</sup> The district court’s non-infringement holding was based on its construction of the term “sloping drain groove,” as “a highly specific U-shaped drain channel of constant diameter/width.”<sup>708</sup> The Federal Circuit held that the district court improperly narrowed the scope of claim on one of the patents in suit by importing limitations from the specification and from dependent claims.<sup>709</sup> The Federal Circuit held that the term “sloping drain groove” only required a sloping artificial channel to carry water, which is not limited to long, narrow U-shaped entities.<sup>710</sup> Because

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699. *Id.* at 804-05, 62 U.S.P.Q.2d (BNA) at 1782.

700. *Id.* at 810, 62 U.S.P.Q.2d (BNA) at 1786-87.

701. *Id.*, 62 U.S.P.Q.2d (BNA) at 1786.

702. *Id.*, 62 U.S.P.Q.2d (BNA) at 1786.

703. *Id.*, 62 U.S.P.Q.2d (BNA) at 1786.

704. *Id.* at 810-11, 62 U.S.P.Q.2d (BNA) at 1787.

705. 292 F.3d 718, 63 U.S.P.Q.2d (BNA) 1031 (Fed. Cir. 2002).

706. *Id.* at 720, 63 U.S.P.Q.2d (BNA) at 1031-32.

707. *Id.* at 720-21, 63 U.S.P.Q.2d (BNA) at 1032.

708. *Id.* at 723, 63 U.S.P.Q.2d (BNA) at 1034.

709. *Id.*, 63 U.S.P.Q.2d (BNA) at 1034.

710. *Id.* at 723-24, 63 U.S.P.Q.2d (BNA) at 1034.

infringement is a question of fact, the Federal Circuit stated that an appellate court cannot generally determine infringement and must instead remand the case to the district court, with the new claim construction, for such an infringement determination.<sup>711</sup>

In *Ecolab Inc. v. Paraclipse, Inc.*,<sup>712</sup> the Federal Circuit affirmed the trial court's denial of judgment as a matter of law regarding the jury verdict of non-infringement of one claim.<sup>713</sup> The Federal Circuit also vacated the trial court's denial of judgment as a matter of law with respect to the verdict of non-infringement of a second claim, thus remanding that claim for a new trial.<sup>714</sup> The patent at issue covered a type of insect trap.<sup>715</sup> The Federal Circuit noted that an erroneous jury instruction regarding claim interpretation that impacts a jury's infringement decision is grounds for a new trial,<sup>716</sup> but a party must show that the erroneous jury instruction was prejudicial.<sup>717</sup> When an error in a jury instruction could not have altered the outcome, the error is harmless.<sup>718</sup> Here, the Federal Circuit determined that the instruction with respect to the meaning of the word "contain" was prejudicial because there was sufficient evidence adduced at trial such that a correct instruction could have supported a finding of infringement.<sup>719</sup>

#### B. Means-Plus-Function Claims

A claim limitation may be expressed in means-plus-function format in accordance with 35 U.S.C. § 112, ¶ 6, which reads as follows:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure,

711. *Id.* at 724-25, 63 U.S.P.Q.2d (BNA) at 1035.

712. 285 F.3d 1362, 62 U.S.P.Q.2d (BNA) 1349 (Fed. Cir. 2002).

713. *Id.* at 1365, 62 U.S.P.Q.2d (BNA) 1350.

714. *Id.* at 1365, 62 U.S.P.Q.2d (BNA) at 1350-51.

715. *Id.* at 1365-66, 62 U.S.P.Q.2d (BNA) at 1351.

716. *Id.* at 1373, 62 U.S.P.Q.2d (BNA) at 1356 (citing *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1281, 54 U.S.P.Q.2d (BNA) 1673, 1679 (Fed. Cir. 2000)).

717. *Id.* at 1374, 62 U.S.P.Q.2d (BNA) at 1357.

718. *Id.*, 62 U.S.P.Q.2d (BNA) at 1357 (citing *Environ Prods., Inc. v. Furon Co.*, 215 F.3d 1261, 1266-67, 55 U.S.P.Q.2d (BNA) 1038, 1043 (Fed. Cir. 2000); *Weinar v. Rollform Inc.*, 744 F.2d 797, 808, 223 U.S.P.Q. (BNA) 369, 376 (Fed. Cir. 1984) ("[A] reversal . . . is not available to an appellant who merely establishes error in instructions. . . . Where the procedural error was 'harmless,' *i.e.*, where the evidence in support of the verdict was so overwhelming that the same verdict would necessarily be reached absent the error, or the error was cured by an instruction, a new trial would be mere waste and affirmance of the judgment is required."), *cert. denied*, 470 U.S. 1084 (1985)).

719. *Id.* at 1374-75, 62 U.S.P.Q.2d (BNA) at 1357-58.

material, or acts described in the specification and equivalents thereof.<sup>720</sup>

The use of the term “means” creates a presumption that the inventor intentionally invoked § 112, ¶ 6.<sup>721</sup> This presumption may be overcome where a claim element uses “means” and does not recite a corresponding function.<sup>722</sup> Section 112, ¶ 6 also can be avoided even where a claim element uses “means” and describes a function, so long as it also includes “sufficient structure or material for performing that function.”<sup>723</sup> A claim term recites sufficient structure if it has a “reasonably well understood” meaning in the field.<sup>724</sup> However, the mere use of the word “means” after a limitation does not make that limitation a means-plus-function limitation.<sup>725</sup>

In *BBA Nonwovens Simpsonville, Inc. v. Superior Nonwovens, L.L.C.*,<sup>726</sup> where the technology at issue related to the manufacture of spunbond nonwoven fabric, the Federal Circuit found that the claims were properly interpreted to be means-plus-function claims.<sup>727</sup> The Federal Circuit upheld the district court’s interpretation of “corona means” as subject to § 112, ¶ 6, and rejected the defendant’s argument that the “means” was limited to a specific location on the claimed device.<sup>728</sup> The Federal Circuit affirmed the district court’s identification of the recited function, finding that the function corresponding to the “means” in claim one stemmed from the word “corona,” and that proper reading of the claim was “means for forming a corona.”<sup>729</sup> The district court had observed that Superior Nonwoven’s proposed construction ignored the word “positioned” in claim one, and the Federal Circuit here stated that the expression following the word “positioned” described where the corona means was located, constituting a separate limitation not subject to § 112,

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720. 35 U.S.C. § 112, ¶ 6 (2000).

721. *York Prods., Inc. v. Cent. Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1574, 40 U.S.P.Q.2d (BNA) 1619, 1623 (Fed. Cir. 1996).

722. *Rodime P.L.C. v. Seagate Tech., Inc.*, 174 F.3d 1294, 1302, 50 U.S.P.Q.2d (BNA) 1429, 1434 (Fed. Cir. 1999).

723. *Id.*, 50 U.S.P.Q.2d (BNA) at 1434. *But see* *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 531, 41 U.S.P.Q.2d (BNA) 1001, 1006 (Fed. Cir. 1996) (“To invoke [§ 112, ¶ 6], the alleged means-plus-function claim element must not recite a definite structure which performs the described function.”).

724. *Watts v. XL Sys., Inc.*, 232 F.3d 877, 880-81, 56 U.S.P.Q.2d (BNA) 1836, 1838 (Fed. Cir. 2000) (quoting *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583, 39 U.S.P.Q.2d (BNA) 1783, 1786 (Fed. Cir. 1996)).

725. *Cole*, 102 F.3d at 531, 41 U.S.P.Q.2d (BNA) at 1006.

726. 303 F.3d 1332, 64 U.S.P.Q.2d (BNA) 1257 (Fed. Cir. 2002).

727. *Id.* at 1335, 1343, 64 U.S.P.Q.2d (BNA) at 1260, 1266.

728. *Id.* at 1343-44, 64 U.S.P.Q.2d (BNA) at 1266.

729. *Id.* at 1344, 64 U.S.P.Q.2d (BNA) at 1266.



¶ 6.<sup>730</sup> The Federal Circuit noted the difference between the “corona means” itself and its location, and ultimately found Superior Interwoven’s argument—that the “corona means” must be “within” the slot draw attenuator—was misplaced.<sup>731</sup>

The Federal Circuit held that § 112, ¶ 6 was inapplicable in *Epcon Gas Systems, Inc. v. Bauer Compressors, Inc.*,<sup>732</sup> finding that the district court erred in construing a process claim to be subject to § 112, ¶ 6.<sup>733</sup> In so doing, the Federal Circuit pointed out that the claim included no language indicating a “step plus function” form, and that the claim should not be interpreted as subject to § 112, ¶ 6 simply because a similar apparatus claim was subject to § 112, ¶ 6.<sup>734</sup> In determining that § 112, ¶ 6 was not applicable, the Federal Circuit noted that the claim recited a series of steps without reciting a function.<sup>735</sup> After finding the district court’s use of the claim preamble as a source for a function to be misplaced,<sup>736</sup> the Federal Circuit determined that a preamble statement of purpose does not necessarily supply a function for a “step plus function” form.<sup>737</sup> Thus, the Federal Circuit held that the claim was merely a “garden-variety process claim.”<sup>738</sup> By construing the claim outside of § 112, ¶ 6, the Federal Circuit found that there was a genuine issue of material fact regarding the direct infringement of the claimed method, thereby reversing the district court’s summary judgment.<sup>739</sup>

In *Allen Engineering Corp. v. Bartell Industries, Inc.*,<sup>740</sup> the Federal Circuit found that the district court improperly applied § 112, ¶ 6, vacating the district court’s judgment holding that Bartell Industries infringed Allen Engineering’s patent related to riding trowels.<sup>741</sup> The Federal Circuit found that the district court failed to construe the claim limitations at issue and conduct a limitation-by-limitation comparison.<sup>742</sup> In doing so, the Federal Circuit distinguished when § 112, ¶ 6 is applicable by relying on *Cole v. Kimberly-Clark Corp.*,<sup>743</sup> and

730. *Id.*, 64 U.S.P.Q.2d (BNA) at 1266.

731. *Id.*, 64 U.S.P.Q.2d (BNA) at 1266.

732. 279 F.3d 1022, 1028, 61 U.S.P.Q.2d (BNA) 1470, 1475 (Fed. Cir. 2002).

733. *Id.*, 61 U.S.P.Q.2d (BNA) at 1475.

734. *Id.*, 61 U.S.P.Q.2d (BNA) at 1475.

735. *Id.*, 61 U.S.P.Q.2d (BNA) at 1475.

736. *Id.*, 61 U.S.P.Q.2d (BNA) at 1475.

737. *Id.*, 61 U.S.P.Q.2d (BNA) at 1475 (citing *O.I. Corp. v. Tekmar Co.*, 115 F.3d 1576, 1583, 42 U.S.P.Q.2d (BNA) 1777, 1782 (Fed. Cir. 1997)).

738. *Id.*, 61 U.S.P.Q.2d (BNA) at 1475.

739. *Id.* at 1034, 61 U.S.P.Q.2d (BNA) at 1479.

740. 299 F.3d 1336, 63 U.S.P.Q.2d (BNA) 1769 (Fed. Cir. 2002).

741. *Id.* at 1342, 63 U.S.P.Q.2d (BNA) at 1770.

742. *Id.*, 63 U.S.P.Q.2d (BNA) at 1770.

743. *Cole v. Kimberly-Clark Corp.*, 102 F.3d 531, 41 U.S.P.Q.2d (BNA) 1001 (Fed. Cir. 1996).

noting that when a claim describes elements with detailed recitations of structure, as opposed to function, it cannot be construed as a means-plus-function claim.<sup>744</sup> In contrast, the Federal Circuit found that where a claim recites merely a function such as “closure means . . . for controlling access,” it is properly construed as a means-plus-function limitation.<sup>745</sup> Using this analysis, the Federal Circuit concluded that although the patent at issue used “means” in its claims, the detailed recitation of structure clearly removed the claims from the ambit of § 112, ¶ 6.<sup>746</sup>

### C. *Literal Infringement*

Literal infringement of a claim occurs when a claim limitation reads on (is found in) the device at issue.<sup>747</sup>

In *Tate Access Floors, Inc. v. Interface Architectural Resources, Inc.*,<sup>748</sup> the Federal Circuit affirmed the district court’s order granting Tate’s motion to enjoin Interface from infringing claims of Tate’s patent for raised access flooring panels.<sup>749</sup> On appeal, Interface challenged only the district court’s determination regarding likelihood of success on the merits of Tate’s infringement claim.<sup>750</sup> First, the Federal Circuit held that there was no “practicing the prior art” defense to literal infringement.<sup>751</sup> The Federal Circuit also found that Interface’s asserted defense—that its accused device was an adoption of the teachings of the prior art—was an improper interpretation of the law.<sup>752</sup> Under the proper test, literal infringement is not determined by comparing the alleged infringement device to the prior art, but by construing the claims and comparing them to the accused device.<sup>753</sup>

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744. *Allen Eng’g*, 299 F.3d at 1347, 63 U.S.P.Q.2d (BNA) at 1775 (quoting *Cole*, 102 F.3d at 531, 41 U.S.P.Q.2d (BNA) at 1006).

745. *Id.* at 1347-48, 63 U.S.P.Q.2d (BNA) at 1775 (quoting *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1428, 44 U.S.P.Q.2d (BNA) 1103, 1110 (Fed. Cir. 1997)). This is because “a function was recited for the means and the claim did not ‘explicitly recite[] the structure, material, or acts needed to perform [the function].’” *Id.*, 63 U.S.P.Q.2d (BNA) at 1775 ((quoting *Sage Prods., Inc.* 126 F.3d at 1428, 44 U.S.P.Q.2d (BNA) at 1110)).

746. *Id.* at 1348, 63 U.S.P.Q.2d (BNA) at 1775.

747. *Baxter Healthcare Corp. v. Spectramed, Inc.*, 49 F.3d 1575, 1583, 34 U.S.P.Q.2d (BNA) 1120, 1126 (Fed. Cir. 1995); *Amhil Enters., Ltd. v. Wawa, Inc.*, 81 F.3d 1554, 1562, 38 U.S.P.Q.2d (BNA) 1471, 1476 (Fed. Cir. 1996).

748. 279 F.3d 1357, 61 U.S.P.Q.2d (BNA) 1647 (Fed. Cir. 2002).

749. *Id.* at 1360, 61 U.S.P.Q.2d (BNA) at 1648.

750. *Id.* at 1364, 61 U.S.P.Q.2d (BNA) at 1652.

751. *Id.* at 1365, 61 U.S.P.Q.2d (BNA) at 1653 (citing *Baxter*, 49 F.3d at 1583, 34 U.S.P.Q.2d (BNA) at 1126).

752. *Id.* at 1365-66, 61 U.S.P.Q.2d (BNA) at 1653 (stating that the holding in *Baxter* expressly forecloses any such defense).

753. *Id.* at 1366, 61 U.S.P.Q.2d (BNA) at 1653 (citing *Baxter*, 49 F.3d at 1583, 34 U.S.P.Q.2d (BNA) at 1126 (“There is no requirement that the accused device be

The Federal Circuit asserted that, just as the doctrine of equivalents could not extend so widely as to encompass prior art, claim language must be construed in a manner that preserves validity.<sup>754</sup> Prior art is relevant to literal infringement when it affects the construction of ambiguous claims, except where the interpretation is clear in light of the specification and is properly supported by the patent's disclosure.<sup>755</sup> The Federal Circuit also rejected Interface's attempt to prove non-infringement by the reverse doctrine of equivalents.<sup>756</sup>

In *Riles v. Shell Exploration & Production Co.*,<sup>757</sup> the Federal Circuit required the patentee to show that the accused device contained every limitation in the asserted claims; if even one limitation was missing from the accused device, or not met as claimed, there would be no literal infringement.<sup>758</sup> The U.S. District Court for the Southern District of Texas had affirmed as a matter of law a jury verdict of infringement, which included damages.<sup>759</sup> Shell Exploration appealed that decision and Riles cross-appealed because the district court vacated the jury's finding of literal infringement.<sup>760</sup> The Federal Circuit held that the evidence was insufficient to support the jury's finding of literal infringement.<sup>761</sup>

The Federal Circuit noted that there were three limitations of Riles's patent claim in dispute and that only the "Depending Support Leg" limitation was literally met by Shell's oil drilling platform.<sup>762</sup> The district court construed "stabbing connection" to mean an end-to-end joining of two metal tubes by the insertion of an extension attached to the end of one of the tubes into the end of the other.<sup>763</sup> The

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nonobvious in light of the prior art, or otherwise be itself patentable.")).

754. *Id.* at 1367, 61 U.S.P.Q.2d (BNA) at 1654 (citing *Whittaker Corp. v. UNR Indus., Inc.*, 911 F.2d 709, 712, 15 U.S.P.Q.2d (BNA) 1742, 1744 (Fed. Cir. 1990)).

755. *Id.*, 61 U.S.P.Q.2d (BNA) at 1654. The courts generally give patentees the full benefit of clear claim language and so bind the patentees in accordance with the principles of fairness and the public-notice function of patent law. *Id.*, 61 U.S.P.Q.2d (BNA) at 1654.

756. *Id.* at 1368, 61 U.S.P.Q.2d (BNA) at 1655 (noting that the Federal Circuit has never affirmed a finding of non-infringement based on the reverse doctrine of equivalents). The reverse doctrine of equivalents is "where a device is so far changed in principle from a patent article that it performs the same or similar function in a substantially different way, but nevertheless falls within the literal words of the claim." *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 609, 85 U.S.P.Q. (BNA) 328, 330 (1950).

757. 298 F.3d 1302, 63 U.S.P.Q.2d (BNA) 1819 (Fed. Cir. 2002).

758. *Id.* at 1308, 63 U.S.P.Q.2d (BNA) at 1823 (quoting *Mas-Hamilton Group v. LaGard, Inc.*, 156 F.3d 1206, 1211, 48 U.S.P.Q.2d (BNA) 1010, 1014-15 (Fed. Cir. 1998)).

759. *Id.* at 1305, 63 U.S.P.Q.2d (BNA) at 1821.

760. *Id.*, 63 U.S.P.Q.2d (BNA) at 1821.

761. *Id.*, 63 U.S.P.Q.2d (BNA) at 1821.

762. *Id.* at 1308-09, 63 U.S.P.Q.2d (BNA) at 1823-24.

763. *Id.* at 1308, 63 U.S.P.Q.2d (BNA) at 1823.

district court also found that neither Shell's leveling porch nor its leveling piling had an extension, and that the Shell process did not insert either one into the other.<sup>764</sup> The Federal Circuit held that the district court did not err in finding insufficient evidence in the record to support the jury's finding—that Shell's process literally met the "stabbing connection" limitation.<sup>765</sup>

In examining another limitation, the district court construed "metal-to-metal bearing contact" to mean "a weight bearing contact between two metal surfaces."<sup>766</sup> The Shell process guided the piling through the sleeve, resting it on the layer of wooden timbers, rather than directly on the metal plate of the leveling porch.<sup>767</sup> Ultimately, the Federal Circuit found that the district court did not err with respect to the jury's finding that Shell's process met the "metal-to-metal bearing contact" limitation literally,<sup>768</sup> and found that the district court properly granted a judgment as a matter of law with regard to literal infringement.<sup>769</sup>

#### *D. Infringement under the Doctrine of Equivalents*

If one or more of the claim limitations are not literally present in the accused device, thus precluding a finding of literal infringement, the claim may still be considered infringed if equivalents of those limitations are present.<sup>770</sup> These equivalents are assessed on a limitation-by-limitation basis; this focus on individual limitations, rather than on the accused device as a whole, enhances a court's vigilance against allowing the concept of equivalence to eliminate any claim limitations completely.<sup>771</sup> Equivalence may be established by showing, by preponderant evidence, that an element of an accused device "does substantially the same thing in substantially the same way to get substantially the same result" as the claim limitation.<sup>772</sup> The

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764. *Id.*, 63 U.S.P.Q.2d (BNA) at 1823. Moreover, the district court held that Shell's process merely "guides the leveling piling through the guide sleeve to rest on the leveling porch." *Id.*, 63 U.S.P.Q.2d (BNA) at 1823.

765. *Id.* at 1308-09, 63 U.S.P.Q.2d (BNA) at 1823.

766. *Id.* at 1309, 63 U.S.P.Q.2d (BNA) at 1823 (citation omitted in original).

767. *Id.*, 63 U.S.P.Q.2d (BNA) at 1823.

768. *Id.*, 63 U.S.P.Q.2d (BNA) at 1823.

769. *Id.*, 63 U.S.P.Q.2d (BNA) at 1823.

770. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 25, 41 U.S.P.Q.2d (BNA) 1865, 1869 (1997).

771. *Id.* at 40, 41 U.S.P.Q.2d (BNA) at 1875.

772. *Toro Co. v. White Consol. Indus., Inc.*, 266 F.3d 1367, 1370, 60 U.S.P.Q.2d (BNA) 1437, 1439 (Fed. Cir. 2001) (quoting *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1260, 9 U.S.P.Q.2d (BNA) 1962, 1969 (Fed. Cir. 1989)); see also *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608, 85 U.S.P.Q. (BNA) 328, 330 (1950).

courts also consider claim elements as equivalently present if only “insubstantial differences” distinguish the two elements.<sup>773</sup>

In 2002, the Supreme Court heard the case of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*,<sup>774</sup> which addressed infringement under the doctrine of equivalents. This decision, on the permissible scope of equivalents, seriously departed from the Federal Circuit’s previous practice, and thus became a seminal decision in this area of law.<sup>775</sup>

The Festo Corporation owned two patents for an industrial device.<sup>776</sup> After the patent examiner rejected the initial application for the first patent, due to defects in its description, the application was amended to add the new limitations.<sup>777</sup> The defendant, the alleged infringer, marketed a device that contained a structure substantially the same as Festo’s, but different with regard to the structure of the amended limitation.<sup>778</sup> The district court determined that Festo’s patents covered the defendant’s device under the doctrine of equivalents, but the Federal Circuit disagreed by determining that a limitation amendment that narrowed the claim was an absolute bar to arguing equivalence under the doctrine of equivalents.<sup>779</sup> Thus, the Supreme Court was faced with two issues: (1) can prosecution history estoppel arise from any narrowing amendment that occurs during prosecution?; and (2) when prosecution history estoppel arises, does it bar suit against every equivalent to the amended claim element?<sup>780</sup>

The Supreme Court held primarily that any amendment could narrow the scope of possible equivalents, but if the amendment was truly insignificant, then it would not narrow the scope of the patent or prevent its enforcement.<sup>781</sup> Thus, any amendment made in response to a statutory rejection (for example, a rejection under 35 U.S.C. § 112)—and not only those amendments made in response to rejections based on prior art—may give rise to prosecution history estoppel.<sup>782</sup> In this regard, the Court fully adopted the view of the Federal Circuit majority. The Court also found that the “absolute

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773. *Leggett & Platt, Inc. v. Hickory Springs Mfg. Co.*, 285 F.3d 1353, 1359, 62 U.S.P.Q.2d (BNA) 1266, 1270 (Fed. Cir. 2002) (quoting *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1423, 44 U.S.P.Q.2d (BNA) 1103, 1106 (Fed. Cir. 1997)).

774. 535 U.S. 722, 62 U.S.P.Q.2d (BNA) 1705 (2002).

775. *Id.*, 62 U.S.P.Q.2d (BNA) 1705.

776. *Id.* at 728, 62 U.S.P.Q.2d (BNA) at 1708.

777. *Id.*, 62 U.S.P.Q.2d (BNA) at 1708.

778. *Id.* at 729, 62 U.S.P.Q.2d (BNA) at 1708-09.

779. *Id.* at 729-30, 63 U.S.P.Q.2d (BNA) at 1709.

780. *Id.* at 726-27, 62 U.S.P.Q.2d (BNA) at 1708.

781. *Id.* at 734, 62 U.S.P.Q.2d (BNA) at 1712.

782. *Id.* at 735, 62 U.S.P.Q.2d (BNA) at 1712.

bar” rule adopted by the Federal Circuit was erroneous.<sup>783</sup> Instead, the Court articulated a presumption, created by the act of an amendment, that an alleged equivalent has been disclaimed.<sup>784</sup> The burden of the presumption falls on the patent holder to demonstrate that the embodiment in question is an infringing equivalent that was not disclaimed.<sup>785</sup>

Citing *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*,<sup>786</sup> the Court criticized the Federal Circuit for not following its previous cautions to courts adopting changes that upset the “settled expectations of the inventing community.”<sup>787</sup> The Court held, much as it did in *Warner-Jenkinson*, that a patentee bears the burden of proving that an amendment was not made for a reason that would give rise to estoppel and does not surrender the particular equivalent in question.<sup>788</sup> According to the Court, although prosecution history estoppel can bar challenges to many equivalents, this action requires an inquiry into the subject matter surrendered by the narrowing amendment.<sup>789</sup> While a complete bar was simpler, the Court found that it was inconsistent with the initial purpose of applying the estoppel—to tie the inventor to the contentions made during the application process and any resulting reasonable inferences.<sup>790</sup> Thus, the Court required a more thorough and searching inquiry than the Federal Circuit’s position.<sup>791</sup>

Moreover, the Supreme Court pointed out that a narrowing amendment need not: (1) “relinquish equivalents unforeseeable at the time of the amendment”; (2) “relinquish equivalents beyond a fair interpretation of what was surrendered”; or (3) “foreclose claims of equivalence for aspects of the invention that have only a peripheral relation to the reason the amendment was submitted.”<sup>792</sup> Finally, in requiring the patentee to bear the burden of showing that an

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783. *Id.* at 737, 62 U.S.P.Q.2d (BNA) at 1712.

784. *Id.* at 737-38, 62 U.S.P.Q.2d (BNA) at 1713.

785. *Id.* at 741, 62 U.S.P.Q.2d (BNA) at 1713-14.

786. 520 U.S. 17, 41 U.S.P.Q.2d (BNA) 1865 (1997).

787. *Festo*, 535 U.S. at 739, 62 U.S.P.Q.2d (BNA) at 1713.

788. *Id.*, 62 U.S.P.Q.2d (BNA) at 1713. The standard announced by the Court was that:

Th[e] presumption [that prosecution history bars an equivalence] is not, then, just the complete bar by another name . . . . The patentee must show that at the time of the amendment one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent.

*Id.* at 741, 62 U.S.P.Q.2d (BNA) at 1713.

789. *Id.* at 737, 62 U.S.P.Q.2d (BNA) at 1712.

790. *Id.* at 737-38, 62 U.S.P.Q.2d (BNA) at 1712.

791. *Id.* at 738, 62 U.S.P.Q.2d (BNA) at 1712.

792. *Id.* at 738, 62 U.S.P.Q.2d (BNA) at 1712.

amendment does not surrender the particular equivalent in question, the Court demanded a factual inquiry, which suggests that summary judgment on this issue might be difficult.<sup>793</sup>

Before *Festo* was decided, the Federal Circuit sat en banc in *Johnson & Johnston Associates Inc. v. R.E. Service Co.*<sup>794</sup> to determine whether Johnson & Johnston was entitled to a finding of infringement under the doctrine of equivalents.<sup>795</sup> A severely split Federal Circuit reversed the district court's finding of infringement on the issues of the doctrine of equivalents, willfulness, damages, attorneys' fees, and expenses.<sup>796</sup> In reversing the trial court's finding of infringement under the doctrine of equivalents, the Federal Circuit, as a matter of law, held that when a patent drafter discloses but does not claim subject matter, the drafter effectively releases the unclaimed subject matter into the world for public consumption.<sup>797</sup> The Federal Circuit reasoned that otherwise, the primacy of the claims in defining the scope of the patentee's exclusive rights would be undermined.<sup>798</sup> Further, the Federal Circuit reasoned that if the patentee were allowed undefined and unrecaptured subject matter, then patentees would narrow claims as a means of avoiding USPTO prosecution, and would use the doctrine of equivalents as a basis for post-issue infringement, citing the specification's broad disclosure.<sup>799</sup> Finally, the Federal Circuit noted that there are two remedies for patentees to recapture subject matter that was disclosed and inadvertently left unclaimed.<sup>800</sup> First, within two years of an original patent grant, under 35 U.S.C. § 251, a patentee may file a reissue application to enlarge the scope of the original claims.<sup>801</sup> Second, a patentee can file a separate continuation application under § 120 to claim disclosed but previously unclaimed subject matter.<sup>802</sup>

In another pre-*Festo* case, *Leggett & Platt, Inc. v. Hickory Springs Manufacturing Co.*,<sup>803</sup> the Federal Circuit reversed the district court's grant of summary judgment of non-infringement under the doctrine

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793. *Id.* at 740, 62 U.S.P.Q.2d (BNA) at 1713.

794. 285 F.3d 1046, 62 U.S.P.Q.2d (BNA) 1225 (Fed. Cir. 2002) (en banc).

795. *Id.* at 1048, 62 U.S.P.Q.2d (BNA) at 1226.

796. *Id.* at 1055-72, 62 U.S.P.Q.2d (BNA) at 1231-43. Judges Clevenger, Rader, Dyk, and Lourie filed separate concurring opinions, while Judge Newman filed a dissenting opinion.

797. *Id.* at 1054, 62 U.S.P.Q.2d (BNA) at 1230.

798. *Id.*, 62 U.S.P.Q.2d (BNA) at 1230.

799. *Id.* at 1054-55, 62 U.S.P.Q.2d (BNA) at 1230.

800. *Id.* at 1055, 62 U.S.P.Q.2d (BNA) at 1231.

801. *Id.*, 62 U.S.P.Q.2d (BNA) at 1231; see 35 U.S.C. § 251 (2000).

802. *Johnson & Johnston*, 285 F.3d at 1055, 62 U.S.P.Q.2d (BNA) at 1231; see 35 U.S.C. § 120 (2000).

803. 285 F.3d 1353, 62 U.S.P.Q.2d (BNA) 1266 (Fed. Cir. 2002).

of equivalents, because the Federal Circuit found that genuine issues of material fact existed.<sup>804</sup> Here, infringement pivoted on one limitation, “support wires,” in the claims for a box spring.<sup>805</sup> In this instance the prosecution history was unhelpful in assessing equivalency because the patent had issued without any amendments.<sup>806</sup> Although the alleged infringer contended that its product met the function and result prongs of the function-way-result test, the accused admitted that its product differed in its result.<sup>807</sup> The Federal Circuit noted that whether the support cups served a substantially identical function to that of the “support wires” described in the patent at issue was primarily a matter of fact.<sup>808</sup> The Federal Circuit found that the district court erred in granting summary judgment because the evidence was not such that no reasonable jury could determine whether the two elements were equivalent, and that the competing affidavits in the case created a genuine issue of material fact.<sup>809</sup> The Federal Circuit thus remanded the case to the district court.<sup>810</sup>

In *Schwing GmbH v. Putzmeister Aktiengesellschaft*,<sup>811</sup> which was decided after *Festo*, the Federal Circuit affirmed-in-part and vacated-in-part the district court’s grant of summary judgment of non-infringement of two accused devices.<sup>812</sup> The district court granted summary judgment—that Putzmeister’s Bastardring II concrete pump did not infringe Schwing’s patent under the doctrine of equivalents—because the prosecution history of the patent in suit barred the application of the doctrine.<sup>813</sup> The Federal Circuit disagreed with the district court’s application of the doctrine of equivalents, determining that the applicant’s remarks to the USPTO did not preclude the application of the doctrine of equivalents to the accused concrete pumps—the Bastardring II and the modified Bastardring II.<sup>814</sup> The Federal Circuit explained how *Festo* modified the doctrine of equivalents application from its application in the district court’s decision, stating that the Supreme Court had rejected a “complete bar,” instead requiring “an examination of subject

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804. *Id.* at 1355, 62 U.S.P.Q.2d (BNA) at 1267.

805. *Id.* at 1357, 62 U.S.P.Q.2d (BNA) at 1269.

806. *Id.* at 1358, 62 U.S.P.Q.2d (BNA) at 1270.

807. *Id.* at 1359, 62 U.S.P.Q.2d (BNA) at 1270.

808. *Id.*, 62 U.S.P.Q.2d (BNA) at 1270.

809. *Id.* at 1360, 62 U.S.P.Q.2d (BNA) at 1271.

810. *Id.* at 1362, 62 U.S.P.Q.2d (BNA) at 1272.

811. 305 F.3d 1318, 64 U.S.P.Q.2d (BNA) 1641 (Fed. Cir. 2002).

812. *Id.*, 64 U.S.P.Q.2d (BNA) at 1641.

813. *Id.* at 1326, 64 U.S.P.Q.2d (BNA) at 1647.

814. *Id.* at 1327, 64 U.S.P.Q.2d (BNA) at 1647.



matter surrendered by the narrowing amendment.”<sup>815</sup> The Federal Circuit cited the Supreme Court finding that it was possible for the patentee to overcome the rebuttable presumption that a narrowing amendment surrendered the equivalent at issue.<sup>816</sup> Specifically, the The Federal Circuit noted the Supreme Court holding that a patentee could “overcome the presumption that prosecution history estoppel bars a finding of equivalence” by illustrating: the unforeseeability of the equivalent; the tangential relationship between the rationale of the amendment and the equivalent; or that it was unreasonable to expect the patentee to describe the substitute at issue.<sup>817</sup> Given the change in the law of equivalency, the Federal Circuit agreed that the case should be remanded to the district court to determine whether Schwing could rebut the *Festo* presumption that the applicant’s narrowing amendment precluded the application of the doctrine of equivalents to the modified Bastardring II.<sup>818</sup> Finally, the Federal Circuit determined that statements in Schwing’s specification precluded the application of the doctrine of equivalents to the Bastardring II pump.<sup>819</sup>

In another post-*Festo* case, *Eagle Comtronics, Inc. v. Arrow Communication Laboratories, Inc.*,<sup>820</sup> the Federal Circuit vacated a summary judgment decision by the district court that there was no infringement, and remanded the case for trial.<sup>821</sup> The Federal Circuit noted that there are two limits to the application of the doctrine of equivalents.<sup>822</sup> First, prosecution history estoppel can prevent use of the doctrine when patentees relinquish subject matter, by amendment or argument, while prosecuting the patent.<sup>823</sup> Second, the all-limitations rule,<sup>824</sup> which renders the question of insubstantiality of the differences inapplicable if a claim limitation is missing from an accused device, also limits the application of the

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815. *Id.* at 1329, 64 U.S.P.Q.2d (BNA) at 1648-49 (citing *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 62 U.S.P.Q.2d (BNA) 1705 (2002)).

816. *Id.*, 64 U.S.P.Q.2d (BNA) at 1648.

817. *Id.*, 64 U.S.P.Q.2d (BNA) at 1649.

818. *Id.* at 1329, 64 U.S.P.Q.2d (BNA) at 1649.

819. *Id.*, 64 U.S.P.Q.2d (BNA) at 1649.

820. 305 F.3d 1303, 64 U.S.P.Q.2d (BNA) 1481 (Fed. Cir. 2002).

821. *Id.* at 1306, 64 U.S.P.Q.2d (BNA) at 1482.

822. *Id.* at 1315, 64 U.S.P.Q.2d (BNA) at 1488-89.

823. *Id.*, 64 U.S.P.Q.2d (BNA) at 1488 (citing *Pharmacia & Upjohn Co. v. Mylan Pharm., Inc.*, 170 F.3d 1373, 1376-77, 50 U.S.P.Q.2d (BNA) 1033, 1036 (Fed. Cir. 1999)).

824. *Id.*, 64 U.S.P.Q.2d (BNA) at 1489 (“No claimed [limitation], or an equivalent thereof, can be absent if the doctrine of equivalents is invoked.”) (quoting *Kustom Signals Inc. v. Applied Concepts, Inc.*, 264 F.3d 1326, 1333, 60 U.S.P.Q.2d (BNA) 1135 (Fed. Cir. 2001))).

doctrine of equivalents.<sup>825</sup> In light of these limits, the Federal Circuit reviewed the prosecution history and determined that nothing in the history gave rise to prosecution history estoppel.<sup>826</sup> The Federal Circuit concluded that although the all-limitations rule states that a claim limitation cannot be missing from the accused device for a finding of equivalents, that rule can be satisfied if one element in the device corresponds to several claim limitations.<sup>827</sup>

Similarly, the Federal Circuit found no prosecution history estoppel bar to the doctrine of equivalents in *Riles v. Shell Exploration & Production Co.*,<sup>828</sup> where Shell attempted to evade a finding of infringement by arguing that the “metal-to-metal bearing contact” limitation was not entitled to a scope of equivalents encompassing its offshore oil platform.<sup>829</sup> Here, the Federal Circuit found that the district court correctly did not interpret this claim term to require direct metal on metal contact, instead requiring “a weight bearing contact.”<sup>830</sup> Accordingly, the Federal Circuit noted that even without a direct metal-to-metal contact, a reasonable jury could have found Shell’s platform used the equivalent of “metal-to-metal bearing contact.”<sup>831</sup> Further, the Federal Circuit stated that the doctrine of prosecution history estoppel did not preclude Riles’ employment of the doctrine of equivalents on this claim element.<sup>832</sup> During prosecution of his patent, Riles attempted to distinguish the patent by stating “Graham does not describe a metal-to-metal bearing contact for transferring loads to the legs of the platforms.”<sup>833</sup> In context, the Federal Circuit found this statement was not an unmistakable surrender of subject matter of the claim coverage beyond the direct metal-on-metal contact.<sup>834</sup> The Federal Circuit also noted that Riles’s prosecution statement neither suggested a preference for weight bearing contacts, such as metal-on-metal, metal-on-wood, or metal-on-concrete, nor mentioned the directness of the contact for the weight transfer.<sup>835</sup> Instead, the Federal Circuit found that the core of the

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825. *Id.*, 64 U.S.P.Q.2d (BNA) at 1488-89 (citing *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 33-34 (1997); *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 934-35, 939 4 U.S.P.Q.2d (BNA) 1737, 1739-40 (Fed. Cir. 1987) (en banc)).

826. *Id.* at 1316, 64 U.S.P.Q.2d (BNA) at 1489.

827. *Id.* at 1317, 64 U.S.P.Q.2d (BNA) at 1490.

828. 298 F.3d 1302, 63 U.S.P.Q.2d (BNA) 1819 (Fed. Cir. 2002).

829. *Id.* at 1310, 63 U.S.P.Q.2d (BNA) at 1824-25.

830. *Id.*, 63 U.S.P.Q.2d (BNA) at 1824.

831. *Id.* at 1310, 63 U.S.P.Q.2d (BNA) at 1824-25.

832. *Id.* at 1310, 63 U.S.P.Q.2d (BNA) at 1825.

833. *Id.*, 63 U.S.P.Q.2d (BNA) at 1825 (citation omitted in original).

834. *Id.*, 63 U.S.P.Q.2d (BNA) at 1825.

835. *Id.*, 63 U.S.P.Q.2d (BNA) at 1825.

statement expressed the transfer of compressive load.<sup>836</sup> Graham involved a semi-submersible platform tied to a structure attached to the sea floor by tension tie rods, and did not transfer compressive load to the anchored structure.<sup>837</sup> Accordingly, the Federal Circuit held that Riles only explained that his invention transfers load onto an anchored structure, and that Riles's statements did not equal a surrender of claimed subject matter, or an unmistakable surrender.<sup>838</sup>

#### *E. Prosecution History Estoppel*

Prosecution history estoppel can restrict the availability of the doctrine of equivalents.<sup>839</sup> This doctrine bars a patentee from asserting, as an equivalent, subject matter surrendered during prosecution of the patent application.<sup>840</sup> The arguments and amendments contained in the prosecution history must be examined to determine the meaning of terms in the claims,<sup>841</sup> thus excluding interpretations that were disclaimed during prosecution of the patent.<sup>842</sup> In addition, arguments attempting to overcome prior art may lead to narrow claim interpretations because the public can rely on these statements.<sup>843</sup>

For example, estoppel may result from amendments that narrow the scope of a claim to satisfy requirements of the Patent Act.<sup>844</sup> In *Festo*, the Supreme Court found that narrowing amendments create a rebuttable presumption of estoppel,<sup>845</sup> with its scope dependent on

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836. *Id.*, 63 U.S.P.Q.2d (BNA) at 1825.

837. *Id.*, 63 U.S.P.Q.2d (BNA) at 1825.

838. *Id.*, 63 U.S.P.Q.2d (BNA) at 1825.

839. See *Pharmacia & Upjohn Co. v. Mylan Pharms., Inc.*, 170 F.3d 1373, 1376, 50 U.S.P.Q.2d (BNA) 1033, 1036 (Fed. Cir. 1999) (stating that a patentee may not use the doctrine of equivalents if that patentee had surrendered the subject matter at issue in a prior prosecution).

840. *Am. Permehedge, Inc. v. Barcana, Inc.*, 105 F.3d 1441, 1445-46, 41 U.S.P.Q.2d (BNA) 1614, 1618 (Fed. Cir. 1997).

841. *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576, 34 U.S.P.Q.2d (BNA) 1673, 1676 (Fed. Cir. 1995).

842. *Id.*, 34 U.S.P.Q.2d (BNA) at 1676-77 (citations omitted); see also *Spectrum Int'l, Inc. v. Sterilite Corp.*, 164 F.3d 1372, 1378, 49 U.S.P.Q.2d (BNA) 1065, 1068-69 (Fed. Cir. 1998) (stating that a patentee's explicit arguments to overcome prior art during application prosecution may narrow the scope of a claim); *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 452, 227 U.S.P.Q. (BNA) 293, 296 (Fed. Cir. 1985) (noting that prosecution history prevents a court from permitting an interpretation of a claim that the patentee surrendered during the patent application prosecution).

843. *Digital Biometrics, Inc. v. Identix, Inc.*, 149 F.3d 1335, 1347, 47 U.S.P.Q.2d (BNA) 1418, 1427 (Fed. Cir. 1998).

844. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 736, 62 U.S.P.Q.2d (BNA) 1705, 1711-12 (2002).

845. *Id.* at 740, 62 U.S.P.Q.2d (BNA) at 1713 (citing *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 33, 41 U.S.P.Q.2d (BNA) 1865, 1873 (1997)).

reasonable inferences from the amendment.<sup>846</sup> However, a patentee is not barred from asserting “equivalents unforeseeable at the time of the amendment and beyond a fair interpretation of what was surrendered,” or those that “have only a peripheral relation to the reason the amendment was submitted.”<sup>847</sup> Nor is recourse to the doctrine of equivalents foreclosed where there is a reason that suggests that the patentee could not reasonably have been expected to have explained the alternative in question.<sup>848</sup> The patentee bears the burden of overcoming this presumption by illustrating that the amendment does not surrender the equivalent at issue.<sup>849</sup> An estoppel also may be found on the basis of arguments made during prosecution of the application to secure the allowance of claims.<sup>850</sup>

In *Abbott Laboratories v. Dey, L.P.*, the Federal Circuit outlined the standards of prosecution history estoppel.<sup>851</sup> First, a court must identify which claim limitations are allegedly met by equivalents, then it must determine if such limitations were amended during patent prosecution.<sup>852</sup> If there are no such amendments, then the doctrine of equivalents will not be barred by amendment-based estoppel,<sup>853</sup> but the doctrine may be barred by argument-based estoppel depending on the statements made by the applicant during prosecution.<sup>854</sup>

In *Abbott Laboratories*, a “phospholipid” limitation in the patent in suit was at issue.<sup>855</sup> The Federal Circuit found that the limitation was not amended during prosecution, and therefore, no amendment estoppel and no argument-based estoppel existed.<sup>856</sup> In the decision below, the district court found prosecution history estoppel based on the prosecution of a related application.<sup>857</sup> The Federal Circuit

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846. *Id.* at 737-38, 62 U.S.P.Q.2d (BNA) at 1712.

847. *Id.* at 738, 62 U.S.P.Q.2d (BNA) at 1712.

848. *Id.* at 740-41, 62 U.S.P.Q.2d (BNA) at 1713-14.

849. *Id.* at 739, 62 U.S.P.Q.2d (BNA) at 1713.

850. See *Elkay Mfg. Co. v. Ebco Mfg. Co.*, 192 F.3d 973, 979, 52 U.S.P.Q.2d (BNA) 1109, 1113 (Fed. Cir. 1999) (holding that the scope of coverage of the claims may change if a patentee has relinquished a possible claim construction in an amendment or argument to overcome or distinguish a reference); *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1583-84, 34 U.S.P.Q.2d (BNA) 1673, 1683 (Fed. Cir. 1995) (holding that once a term is interpreted in one claim, the patentee is estopped from using the doctrine of equivalents to allow the claim if that term is included in a later claim).

851. 287 F.3d 1097, 1103, 62 U.S.P.Q.2d (BNA) 1545, 1549 (Fed. Cir. 2002).

852. *Id.*, 62 U.S.P.Q.2d (BNA) at 1549.

853. *Id.*, 62 U.S.P.Q.2d (BNA) at 1549.

854. *Id.*, 62 U.S.P.Q.2d (BNA) at 1549 (citing *Elkay Mfg.*, 192 F.3d at 979, 52 U.S.P.Q.2d (BNA) at 1113; *Pharmacia & Upjohn Co. v. Mylan Pharms., Inc.*, 170 F.3d 1373, 1376-77, 50 U.S.P.Q.2d (BNA) 1033, 1036 (Fed. Cir. 1999)).

855. *Id.* at 1103-04, 62 U.S.P.Q.2d (BNA) at 1549-50.

856. *Id.* at 1104-05, 62 U.S.P.Q.2d (BNA) at 1549-50.

857. *Id.* at 1104, 62 U.S.P.Q.2d (BNA) at 1549-50.

vacated the district court's finding of non-infringement under the doctrine of equivalents,<sup>858</sup> holding that there was no basis for the conclusion that statements made about the characteristics of one patent should be attributed to another because the two patents have a common assignee and inventor, as well as a similar subject matter.<sup>859</sup> Therefore, statements made during the prosecution of the first patent did not create an estoppel with respect to the second patent.<sup>860</sup> The Federal Circuit further held that the prior art first patent did not limit the scope of equivalence in the second patent's claims because the first patent disclosed a limitation argued to be equivalent to the second patent's claimed subject matter.<sup>861</sup> The Federal Circuit based its holding on the fact that the claims of the second patent contained limitations not found in the prior art and, on that basis, an examiner could have found such differences to be non-obvious during a hypothetical examination of such a claim.<sup>862</sup>

The Federal Circuit addressed the issue of whether the prosecution history of a related application can be used in limiting the scope of the claims of the patent in suit in *Middleton, Inc. v. Minnesota Mining & Manufacturing Co.*<sup>863</sup> The Federal Circuit reversed the district court's summary judgment of non-infringement based on the district court's erroneous claim interpretation based on meaning of "uniform."<sup>864</sup> The district court relied on the prosecution history of a related application to determine the meaning of uniform.<sup>865</sup> In reviewing the use of the disputed term in a related application, the Federal Circuit found that the prosecution history of a parent application that included claims directed to bowling alley surfaces did not limit the definition of "uniform" for the CIP application.<sup>866</sup> Thus, the Federal Circuit remanded the case for proper application of the doctrine of equivalents based on its new claim construction and the intervening *Festo* case.<sup>867</sup>

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858. *Id.* at 1108, 62 U.S.P.Q.2d (BNA) at 1553.

859. *Id.* at 1105, 62 U.S.P.Q.2d (BNA) at 1550.

860. *Id.*, 62 U.S.P.Q.2d (BNA) at 1550.

861. *Id.* at 1106, 62 U.S.P.Q.2d (BNA) at 1551.

862. *Id.*, 62 U.S.P.Q.2d (BNA) at 1551.

863. 311 F.3d 1384, 65 U.S.P.Q.2d (BNA) 1138 (Fed. Cir. 2002).

864. *Id.* at 1387-89, 65 U.S.P.Q.2d (BNA) at 1140-42.

865. *Id.* at 1388, 65 U.S.P.Q.2d (BNA) at 1141.

866. *Id.* at 1388-89, 65 U.S.P.Q.2d (BNA) at 1141 ("The broader continuation applications claimed floor surfaces in general, not just smooth sporting surfaces. Therefore, the prosecution history in the context of varnishes for smooth bowling alleys does not limit the broader claims to other flooring surfaces.")

867. *Id.* at 1389-90, 65 U.S.P.Q.2d (BNA) at 1142. The district court previously applied the Federal Circuit's *Festo* holding and found a complete bar based on the addition of the term "uniform" during prosecution, and which the district court had erroneously construed. *Id.* at 1386, 65 U.S.P.Q.2d (BNA) at 1139-40.

In *Schwing GmbH v. Putzmeister Aktiengesellschaft*,<sup>868</sup> the Federal Circuit affirmed-in-part and vacated-in-part the district court grant of summary judgment of non-infringement of two accused devices: Putzmeister's Bastardring II concrete pump, which was held not to infringe Schwing's patent under the doctrine of equivalents, and the modified Bastardring II pump, which did not infringe either literally or under the doctrine of equivalents.<sup>869</sup> In assessing claim construction, the Federal Circuit determined that the district court erred in interpreting the claims to include a functional requirement that was not found in the language of the claim itself.<sup>870</sup> The Federal Circuit noted that the prosecution history cannot limit a claim's scope unless the patentee's remarks before the USPTO would cause a competitor to believe that the patentee had disavowed the concerned subject matter.<sup>871</sup> In addition, the Federal Circuit affirmed the district court's finding that Schwing had not demonstrated a genuine issue of material fact as to whether the modified Bastardring II pump literally infringed, despite the Federal Circuit's disagreement with the district court's claim construction.<sup>872</sup>

With respect to infringement under the doctrine of equivalents, the Federal Circuit determined that the applicant's remarks to the USPTO were "equivocal at best" and did not preclude the doctrine's application to either the Bastardring II or the modified Bastardring II.<sup>873</sup> However, the Federal Circuit agreed that the case should be remanded to the district court to determine whether Schwing can rebut the *Festo* presumption that the applicant's narrowing amendment precluded the application of the doctrine of equivalents to the modified Bastardring II.<sup>874</sup>

Prosecution history estoppel precluded the patentee in *Rheox, Inc. v. Entact, Inc.*<sup>875</sup> from claiming that Entact infringed its patent under the doctrine of equivalents. Rheox owned a patent to a method of remediating lead from contaminated soil by applying calcium orthophosphate.<sup>876</sup> The district court limited the term "calcium orthophosphate" to "tricalcium orthophosphate" and found that Rheox disclaimed monocalcium orthophosphate and triple super

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868. 305 F.3d 1318, 1319, 64 U.S.P.Q.2d (BNA) 1641, 1642 (Fed. Cir. 2002).

869. *Id.* at 1323, 64 U.S.P.Q.2d (BNA) at 1644.

870. *Id.* at 1323-24, 64 U.S.P.Q.2d (BNA) at 1644-45.

871. *Id.* at 1324, 64 U.S.P.Q.2d (BNA) at 1645.

872. *Id.* at 1325-26, 64 U.S.P.Q.2d (BNA) at 1646-47.

873. *Id.* at 1327, 64 U.S.P.Q.2d (BNA) at 1647.

874. *Id.* at 1329, 64 U.S.P.Q.2d (BNA) at 1649.

875. 276 F.3d 1319, 1320, 61 U.S.P.Q.2d (BNA) 1368, 1369 (Fed. Cir. 2002).

876. *Id.*, 61 U.S.P.Q.2d (BNA) at 1369.

phosphate (“TSP”).<sup>877</sup> On appeal the Federal Circuit noted that when assessing whether a patentee relinquishes a claim, it considers the totality of the prosecution history, including arguments or amendments.<sup>878</sup> In affirming the non-infringement holding of the district court, the Federal Circuit found that the patentee had disclaimed claims to TSP—a necessary element to any finding of infringement.<sup>879</sup>

In *Talbert Fuel Systems Patents Co. v. Unocal Corp.*,<sup>880</sup> the Federal Circuit applied prosecution history estoppel, thus eliminating the possibility of the application of the doctrine of equivalents as a basis for infringement. The Federal Circuit agreed with the district court’s claim construction, where the prosecution history reflected that the patentee, in attempting to distinguish his invention from the prior art, disclaimed the plaintiff’s asserted claim construction.<sup>881</sup> The limitation at issue was a boiling point range limitation of 121-345°F.<sup>882</sup> The district court construed the claim as limited to gasoline with a final boiling point of 345°F, and excluded gasoline with a higher final boiling point.<sup>883</sup> The Federal Circuit reviewed the prosecution history and found that Talbert relied on 345°F as the final boiling point in overcoming § 112 rejections and in distinguishing the prior art.<sup>884</sup> In affirming a finding of non-infringement based on prosecution history estoppel, the Federal Circuit rejected Talbert’s argument that the narrow claim construction excluded the preferred embodiment because the nature of the subject matter and the arguments made in the prosecution history warranted the narrow claim construction, and precluded the application of the doctrine of equivalents such that Unocal’s product would be found to be infringing.<sup>885</sup>

#### F. Inducement of Infringement

Inducement of infringement is defined by 35 U.S.C. § 271(b), which provides that “whosoever actively induces infringement of a patent shall be liable as an infringer.”<sup>886</sup> In order to succeed on a claim of inducement, the patentee must show; first, that there has

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877. *Id.* at 1324, 61 U.S.P.Q.2d (BNA) at 1371-72.

878. *Id.* at 1326, 61 U.S.P.Q.2d (BNA) at 1373.

879. *Id.* at 1326-27, 61 U.S.P.Q.2d (BNA) at 1373-74.

880. 275 F.3d 1371, 61 U.S.P.Q.2d (BNA) 1363 (Fed. Cir. 2002).

881. *Id.* at 1376, 61 U.S.P.Q.2d (BNA) at 1367.

882. *Id.* at 1374, 61 U.S.P.Q.2d (BNA) at 1365.

883. *Id.* at 1375, 61 U.S.P.Q.2d (BNA) at 1365.

884. *Id.* at 1375-76, 61 U.S.P.Q.2d (BNA) at 1365-66.

885. *Id.* at 1376-77, 61 U.S.P.Q.2d (BNA) at 1367.

886. 35 U.S.C. § 271(b) (2000).

been direct infringement,<sup>887</sup> and second, that the alleged infringer knowingly induced infringement and possessed specific intent to encourage another's infringement.<sup>888</sup> In other words, the plaintiff must show that the infringer's actions caused the infringing acts, and that the infringer knew, or should have known, these actions would induce infringements.<sup>889</sup>

In *Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*,<sup>890</sup> the Federal Circuit reversed the district court's holding that Chemque did not induce infringement.<sup>891</sup> On appeal, Chemque alleged that there was no inducement because there was no literal infringement.<sup>892</sup> The Federal Circuit disagreed, determining that there was indeed literal infringement,<sup>893</sup> and therefore, the Federal Circuit held that substantial evidence supported the jury's verdict of infringement by inducement.<sup>894</sup> According to the Federal Circuit, Chemque knew about the 3M patents and even gave customers instructions on how to use the infringing product.<sup>895</sup> The fact that this would lead to infringement was evidence of inducement.<sup>896</sup>

### G. Infringement Under the Hatch-Waxman Act

The Hatch-Waxman Act provided a new means by which a patentee can sue for infringement.<sup>897</sup> With the enactment of the Hatch-Waxman Act, Congress sought to strike a balance between two competing policy interests.<sup>898</sup> The first interest was encouraging the research and development of new drugs, and the second interest was to allow competition in the form of low-cost, generic pharmaceutical alternatives.<sup>899</sup> Under the Act, pharmaceutical manufacturers may

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887. *Epcon Gas Sys., Inc. v. Bauer Compressors, Inc.*, 279 F.3d 1022, 1033, 61 U.S.P.Q.2d (BNA) 1470, 1478 (Fed. Cir. 2002).

888. *Manville Sales Corp. v. Paramount Sys., Inc.*, 917 F.2d 544, 553, 16 U.S.P.Q.2d (BNA) 1587, 1594 (Fed. Cir. 1990). *But see* *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 U.S.P.Q.2d (BNA) 1525, 1529 (Fed. Cir. 1990) ("[P]roof of actual intent to cause the acts which constitute the infringement is a necessary prerequisite to finding active inducement.") (footnote omitted).

889. *Manville*, 917 F.2d at 553, 16 U.S.P.Q.2d (BNA) at 1594.

890. 303 F.3d 1294, 64 U.S.P.Q.2d (BNA) 1270 (Fed. Cir. 2002).

891. *Id.* at 1298, 64 U.S.P.Q.2d (BNA) at 1271.

892. *Id.* at 1305, 64 U.S.P.Q.2d (BNA) at 1277.

893. *Id.*, 64 U.S.P.Q.2d (BNA) at 1277.

894. *Id.*, 64 U.S.P.Q.2d (BNA) at 1277.

895. *Id.*, 64 U.S.P.Q.2d (BNA) at 1277.

896. *Id.*, 64 U.S.P.Q.2d (BNA) at 1277.

897. Drug Price Competition and Patent Term Restoration Act of 1984, Pub. L. No. 98-417, 98 Stat. 1585, codified at 21 U.S.C. §§ 355, 360cc & 35 U.S.C. §§ 156, 271 (2000).

898. *Andryx Pharm. v. Biovail Corp.*, 276 F.3d 1368, 1370, 61 U.S.P.Q.2d (BNA) 1414, 1415 (Fed. Cir. 2002).

899. *Id.*, 61 U.S.P.Q.2d (BNA) at 1415.



submit an ANDA to seek expedited approval from the Food and Drug Administration (FDA) of a generic version of a previously approved drug.<sup>900</sup> In the course of submitting an ANDA, the generic drug manufacturer must certify, inter alia, that the previously approved drug's patent is no longer valid, or will not be infringed by the manufacture, use, or sale of the generic drug disclosed in the ANDA.<sup>901</sup> Congress has deemed that this paragraph IV certification is itself an act of infringement, and thus, upon receiving notice of the ANDA, the patent holder may sue the ANDA filer for infringement.<sup>902</sup>

In *Abbott Laboratories v. TorPharm, Inc.*,<sup>903</sup> the Federal Circuit examined whether the generic drug product was covered by Abbott Laboratories' patent. Specifically, the Federal Circuit reviewed TorPharm's attempt to introduce a generic version of Depakok, an anticonvulsant medication approved for the treatment of epilepsy and manufactured by Abbott Laboratories.<sup>904</sup> Abbott Laboratories listed two patents in the "Orange Book" as corresponding to the epilepsy medication, and sued TorPharm after TorPharm filed an ANDA with the FDA.<sup>905</sup> The district court granted summary judgment of infringement against TorPharm based on TorPharm's product description in its package insert and based on Abbott Laboratories' test data indicating that TorPharm's biobatch material had a high molecular weight—similar to material prepared according the two Abbott Laboratories patents.<sup>906</sup> On appeal, the Federal Circuit found no error with the lower court's claim construction.<sup>907</sup> However, the Federal Circuit held that the lower court erred in finding no issue of material fact with respect to the oligomeric structure of TorPharm's product.<sup>908</sup> In particular, TorPharm's expert provided an alternative analysis of the identification of the mass spectrum of TorPharm's product corresponding to species with molecular weights claimed by the Abbott Laboratories patents.<sup>909</sup> Therefore, the Federal Circuit remanded the case for consideration of the alternative analysis.<sup>910</sup>

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900. 21 U.S.C. § 355(j).

901. *Id.* § 355(j) (2) (A) (vii) (IV).

902. *Andrx Pharm.*, 276 F.3d at 1371, 61 U.S.P.Q.2d (BNA) at 1415; 35 U.S.C. § 271(e)(2)(A) (2000).

903. 300 F.3d 1367, 1370, 63 U.S.P.Q.2d (BNA) 1929, 1930 (Fed. Cir. 2002).

904. *Id.* at 1370, 63 U.S.P.Q.2d (BNA) at 1930.

905. *Id.* at 1370-71, 63 U.S.P.Q.2d (BNA) at 1930-31.

906. *Id.*, 63 U.S.P.Q.2d (BNA) at 1930-31.

907. *Id.* at 1372, 63 U.S.P.Q.2d (BNA) at 1931.

908. *Id.* at 1380-81, 63 U.S.P.Q.2d (BNA) at 1937-38.

909. *Id.* at 1376-77, 63 U.S.P.Q.2d (BNA) at 1934-36.

910. *Id.* at 1381, 63 U.S.P.Q.2d at 1938.

In *Bayer AG v. Biovail Corp.*,<sup>911</sup> Bayer brought two infringement actions: (1) asserting that the defendant infringed its high blood pressure drug (Adalat) patent by seeking ANDA approval of a 60mg generic version of the drug; and (2) by marketing a 30mg generic version.<sup>912</sup> The district court granted summary judgment to Biovail holding that Bayer was collaterally estopped on both claims based on a previous finding of non-infringement by the Federal Circuit in a similar 30mg Adalat ANDA infringement case.<sup>913</sup> The Federal Circuit vacated the district court's grant of summary judgment of collateral estoppel because the district court's prior construction of the claims of the patent in suit did not address all of the issues contained in the present suits.<sup>914</sup> In the prior cases, the district court construed claims in light of an ANDA specification.<sup>915</sup> In the present actions, information regarding actual products manufactured in accordance with the ANDA was submitted.<sup>916</sup> As such, the Federal Circuit held that the district court was required to construe the claim with respect to measurement of the manufactured products.<sup>917</sup> Further, with respect to manufactured products made in accordance with the ANDA specification of the prior action, the Federal Circuit held that "infringement under § 271(e)(2)(A),<sup>918</sup> by submission of an ANDA, is not synonymous with infringement under § 271(a) by a commercial product" and, therefore, the patentee should have "a full and fair opportunity to litigate the issue of infringement by the commercial tablets" despite a finding of non-infringement under § 271(e)(2)(A).<sup>919</sup>

In *Andrx Pharmaceuticals Inc. v. Biovail Corp.*,<sup>920</sup> the Federal Circuit again considered infringement in the context of the filing of an ANDA. Andrx, a generic drug manufacturer, had previously been awarded a judgment of non-infringement of Biovail's diltiazem patent.<sup>921</sup> Prior to the final resolution of the first suit, Biovail had acquired an exclusive license for a patent on an extended release version of diltiazem, and was successful at getting this drug listed in

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911. 279 F.3d 1340, 61 U.S.P.Q.2d (BNA) 1675 (Fed. Cir. 2002).

912. *Id.* at 1342, 61 U.S.P.Q.2d (BNA) at 1676.

913. *Id.*, 61 U.S.P.Q.2d (BNA) at 1676.

914. *Id.* at 1349-50, 61 U.S.P.Q.2d (BNA) at 1682-83.

915. *Id.* at 1344, 61 U.S.P.Q.2d (BNA) at 1678.

916. *Id.* at 1346-47, 61 U.S.P.Q.2d (BNA) at 1679-80.

917. *Id.*, 61 U.S.P.Q.2d (BNA) at 1679-80.

918. 35 U.S.C. § 271(e)(2)(A) (2000).

919. *Bayer*, 279 F.3d at 1350, 61 U.S.P.Q.2d (BNA) at 1683.

920. 276 F.3d 1368, 61 U.S.P.Q.2d (BNA) 1414 (Fed. Cir. 2002).

921. *Id.* at 1372, 61 U.S.P.Q.2d (BNA) at 1416.

the Orange Book.<sup>922</sup> Andrx protested the listing of this new patent, but was unsuccessful in its request to have the drug delisted.<sup>923</sup> Andrx sued Biovail in a second infringement action seeking an adjudication of non-infringement of the extended release patent.<sup>924</sup> Andrx also sued the FDA for improper handling of its ANDA and refusal to delist the extended release patent.<sup>925</sup> In the second suit at the district court, Andrx received a judgment shortening the statutory stay from ANDA approval from thirty months to five months.<sup>926</sup> Biovail appealed, and the Federal Circuit vacated the district court's order, finding that the lower court exceeded its authority in: (1) shortening the statutory thirty-month delay of approval of Andrx's pending ANDA by the FDA, and (2) ordering that the ANDA be granted approval by the FDA.<sup>927</sup> The Federal Circuit held that the district court exceeded its authority in shortening the thirty-month stay because there was little evidence that the parties were not complying with statutory requirements to cooperate in expediting the case.<sup>928</sup> Further, the Federal Circuit noted that although claims may be brought under the APA to compel the FDA to act in accordance with the Hatch-Waxman Amendments, the complaint in this instance, failed to assert jurisdiction under the APA.<sup>929</sup>

#### H. Design Patent Infringement

Under 35 U.S.C. § 171, design patents may be obtained by the inventor of any "new, original and ornamental design for an article of manufacture."<sup>930</sup> The determination of design patent infringement requires a court to engage in: (1) construction of the patent claim, and (2) a comparison of the construed claim to the accused product.<sup>931</sup> In construing a design patent claim, the scope of the claimed design encompasses the patent's visual appearance as a whole and the visual impression it creates.<sup>932</sup> Design patent infringement may be found even where the accused design and the

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922. *Id.* at 1372-73, 61 U.S.P.Q.2d (BNA) at 1416-17.

923. *Id.*, 61 U.S.P.Q.2d (BNA) at 1417.

924. *Id.* at 1373, 61 U.S.P.Q.2d (BNA) at 1417.

925. *Id.*, 61 U.S.P.Q.2d (BNA) at 1417.

926. *Id.* at 1374, 61 U.S.P.Q.2d (BNA) at 1418.

927. *Id.* at 1375, 1380, 61 U.S.P.Q.2d (BNA) at 1418, 1422.

928. *Id.* at 1376, 61 U.S.P.Q.2d (BNA) at 1419.

929. *Id.* at 1380, 61 U.S.P.Q.2d (BNA) at 1422.

930. 35 U.S.C. § 171 (2000).

931. *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577, 36 U.S.P.Q.2d (BNA) 1417, 1420 (Fed. Cir. 1995).

932. *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 104-05, 40 U.S.P.Q.2d (BNA) 1788, 1791 (Fed. Cir. 1996).

patented design are not identical.<sup>933</sup> In fact, the courts more heavily weigh the appearance of the design as a whole as compared to the accused product.<sup>934</sup>

At issue in *Hoop v. Hoop*<sup>935</sup> was a motorcycle windshield design consisting of a pair of eagle-shaped motorcycle fairing guards, which were created by brothers Jeffrey and Stephen Hoop.<sup>936</sup> The Hoops hired Lisa and Mark Hoop to create drawings and models of the designs.<sup>937</sup> Both sets of parties applied for, and received, a design patent.<sup>938</sup> In subsequent litigation, the district court found that the Hoop brothers were the true inventors and granted them a preliminary injunction.<sup>939</sup> On appeal, the Federal Circuit affirmed the district court's preliminary injunction enjoining the plaintiffs from acts constituting infringement of the Hoop brother's patent.<sup>940</sup> The Federal Circuit stated that design patents and utility patents must meet the same standard of inventorship, i.e. the person who conceived the patented invention is the true inventor.<sup>941</sup> The Federal Circuit noted that the inventor retains his or her rights to the patent even where the patentee uses the services, ideas, and aid of others in the process of realizing the invention.<sup>942</sup> Accordingly, the Federal Circuit found that, in addition to the undisputed facts that the Hoop brothers conceived of the eagle-shaped fairing guards and enlisted the assistance of Mark and Lisa Hoop, the accused patent lacked the requisite inventive quality and the Hoop brothers therefore remained the true inventors.<sup>943</sup> Upon review of the accused patent, the Federal Circuit agreed with the lower court's determination that the design was only a refined variation of the first design, thus rejecting the contention that the accused patentees were the true inventors because of additional detailed three-dimensional molds outlined in

933. *Braun Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 820, 24 U.S.P.Q.2d (BNA) 1121, 1125 (Fed. Cir. 1992).

934. *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405, 43 U.S.P.Q.2d (BNA) 1641, 1647 (Fed. Cir. 1997).

935. 279 F.3d 1004, 61 U.S.P.Q.2d (BNA) 1442 (Fed. Cir. 2002).

936. *Id.* at 1005, 61 U.S.P.Q.2d (BNA) at 1443.

937. *Id.*, 61 U.S.P.Q.2d (BNA) at 1443.

938. *Id.* at 1006, 61 U.S.P.Q.2d (BNA) at 1443.

939. *Id.*, 61 U.S.P.Q.2d (BNA) at 1443.

940. *Id.* at 1008, 61 U.S.P.Q.2d (BNA) at 1444.

941. *Id.* at 1007, 61 U.S.P.Q.2d (BNA) at 1443-44 (citing *In re Rousso*, 222 F.2d 729, 731, 106 U.S.P.Q. 99, 101 (CCPA 1955) (rejecting the assertion that a lesser standard of invention applies to design patents than to mechanical patents); *C.R. Bard, Inc. v. M3 Sys.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d (BNA) 1225, 1232 (Fed. Cir. 1998)).

942. *Id.*, 61 U.S.P.Q.2d (BNA) at 1444 (quoting *Ethicon, Inc. v. United States Surgical Corp.*, 135 F.3d 1456, 1460, 45 U.S.P.Q.2d (BNA) 1545, 1548 (Fed. Cir. 1998)).

943. *Id.* at 1008, 61 U.S.P.Q.2d (BNA) at 1444.

the accused patent.<sup>944</sup> Finally, the Federal Circuit held that the creators of the original design, the Hoop brothers, were the true inventors because they conceived of the invention and the accused design lacked the requisite inventive quality.<sup>945</sup>

In another design patent case, *Contessa Food Products, Inc. v. Conagra, Inc.*,<sup>946</sup> the district court found, on summary judgment, that Conagra infringed Contessa's design patent on a serving tray for shrimp party platters.<sup>947</sup> The Federal Circuit vacated and remanded the district court's decision, finding that the district court erred in limiting its infringement analysis to "features visible at the point of sale," during which the underside of the tray—illustrated in the patent drawings—was not visible.<sup>948</sup> The Federal Circuit stated that in determining design patent infringement, the "ordinary observer" analysis must consider features beyond just one phase or part of the useful life of the accused design.<sup>949</sup> The Federal Circuit held that the features of the accused products must be examined individually and compared overall with the patented design as a whole, as depicted in all figures, to determine design patent infringement.<sup>950</sup> Thus, all of the ornamental features illustrated in the figures must be considered in evaluating design patent infringement.<sup>951</sup> On remand, the Federal Circuit directed the district court to apply the "ordinary observer" test where the hypothetical purchasing decision made by such an observer included all ornamental features visible at any time during the normal use of the product.<sup>952</sup>

### I. Willful Infringement

In *Transclean Corp. v. Bridgewood Services, Inc.*,<sup>953</sup> Transclean sued Bridgewood for patent infringement and a jury found that Bridgewood willfully infringed the patent and engaged in false advertising.<sup>954</sup> The district court granted Transclean's motion for summary judgment and held that Bridgewood infringed Transclean's patent as a sanction for Bridgewood's failure to answer an

944. *Id.* at 1007-08, 61 U.S.P.Q.2d (BNA) at 1444.

945. *Id.* at 1007, 61 U.S.P.Q.2d (BNA) at 1444.

946. 282 F.3d 1370, 62 U.S.P.Q.2d (BNA) 1065 (Fed. Cir. 2002).

947. *Id.* at 1375-76, 62 U.S.P.Q.2d (BNA) at 1066-67.

948. *Id.* at 1378-79, 62 U.S.P.Q.2d (BNA) at 1069.

949. *Id.* at 1380, 62 U.S.P.Q.2d (BNA) at 1070 (citing *KeyStone Retaining Wall Sys., Inc. v. Westrock, Inc.*, 997 F.2d 1444, 1450-51, 27 U.S.P.Q.2d (BNA) 1297, 1302 (Fed. Cir. 1993)).

950. *Id.* at 1381, 62 U.S.P.Q.2d (BNA) at 1071.

951. *Id.*, 62 U.S.P.Q.2d (BNA) at 1071.

952. *Id.*, 62 U.S.P.Q.2d (BNA) at 1071.

953. 290 F.3d 1364, 62 U.S.P.Q.2d (BNA) 1865 (Fed. Cir. 2002).

954. *Id.* at 1369, 62 U.S.P.Q.2d (BNA) at 1868.

interrogatory about Bridgewood's ground for its defense of non-infringement.<sup>955</sup> However, the district court overturned a portion of the jury's damages award and denied Transclean's motion for enhanced damages based on the principle of willful infringement.<sup>956</sup> Applying regional circuit law, the Federal Circuit held that the district court did not abuse its discretion by imposing the sanction.<sup>957</sup> The Federal Circuit found that Transclean was entitled to a reply to its interrogatory concerning grounds for its defense of non-infringement.<sup>958</sup> The district court was within its discretion to impose a sanction because Transclean was clearly prejudiced by its inability to conduct discovery on the infringement issues.<sup>959</sup> The Federal Circuit concluded by refusing to find that the district court abused its discretion because this would impair the district court's ability to police its own proceedings, which ensures transparency and predictability, and would impair the court's ability to discourage mischievous conduct by parties.<sup>960</sup>

#### *J. Repair and Reconstruction*

The Supreme Court and the Federal Circuit have through the years grappled with the distinction between repair of a patented item and reconstruction.<sup>961</sup> In *Husky Injection Molding Systems Ltd. v. R&D Tool & Engineering Co.*,<sup>962</sup> the Federal Circuit determined that there are at least three types of repair and reconstruction circumstances. First, there is the instance where the patented item is spent, or expired, and the accused infringer reconstructs the item, thus making the patented item usable again but also infringing on the original patent.<sup>963</sup> A second, and non-infringing scenario, is where only part of the spent patented item is replaced.<sup>964</sup> A third permissible situation is where part of the patented item, although not spent, is

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955. *Id.*, 62 U.S.P.Q.2d (BNA) at 1868.

956. *Id.*, 62 U.S.P.Q.2d (BNA) at 1868.

957. *Id.* at 1373, 62 U.S.P.Q.2d (BNA) at 1871.

958. *Id.*, 62 U.S.P.Q.2d (BNA) at 1872.

959. *Id.* at 1373-74, 62 U.S.P.Q.2d (BNA) at 1872.

960. *Id.* at 1374, 62 U.S.P.Q.2d (BNA) at 1872.

961. *Husky Injection Molding Sys. Ltd. v. R&D Tool & Eng'g Co.*, 291 F.3d 780, 784-85, 62 U.S.P.Q.2d (BNA) 1834, 1837 (Fed. Cir. 2002); DONALD S. CHISUM, 5 CHISUM ON PATENTS § 16.03[3], at 16-159 (1997).

962. 291 F.3d 780, 62 U.S.P.Q.2d (BNA) 1834 (Fed. Cir. 2002).

963. *Id.* at 785, 62 U.S.P.Q.2d (BNA) at 1837 (citing *Cotton-Tie Co. v. Simmons*, 106 U.S. 89 (1882)).

964. *Id.* at 785-86, 62 U.S.P.Q.2d (BNA) at 1837-38 (citing *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336 (1961)).

replaced, thus enabling the object of the patent to perform a different function.<sup>965</sup>

The Federal Circuit affirmed the district court's grant of summary judgment of non-infringement, holding that R&D's replacement of parts in the patented system were appropriately considered permissible repair, rather than reconstruction, of the patented system.<sup>966</sup> Husky asserted its patent against R&D for contributory infringement; Husky's patent covered a device for producing hollow injection-molded plastic articles used in conjunction with a "carrier plate."<sup>967</sup> Neither the molds nor the carrier plates were separately patented.<sup>968</sup> Customers who used Husky's patented machine regularly switched molds and carrier plates when their manufacturing needs changed, and R&D manufactured and replaced molds and carrier plates which could be used in Husky's machine.<sup>969</sup> The Federal Circuit considered the parts in question to be readily replaceable, primarily because Husky's machine design allowed the carrier plates and molds to be replaced.<sup>970</sup> In accordance with substantial precedent, the Federal Circuit held that there was no infringement because the parts were readily replaceable, and that marketing replacement parts did not support Husky's claim of contributory infringement.<sup>971</sup> Further, the Federal Circuit rejected Husky's argument that the replaceable parts were essential to the invention, finding such argument irrelevant.<sup>972</sup> Finally, the Federal Circuit stated that the purchasers of the machines were within their rights to replace the carrier plates and molds, thus precluding claims of contributory infringement, which is itself based on direct infringement.<sup>973</sup>

#### K. *Bona Fide Purchaser Doctrine*

In an unusual case, *Rhone-Poulenc Agro, S.A. v. DeKalb Genetics Corp.*,<sup>974</sup> the Federal Circuit granted a petition for rehearing en banc to decide whether its decision in *Heidelberg Harris, Inc. v. Loebach*<sup>975</sup> was

965. *Id.* at 786, 62 U.S.P.Q.2d (BNA) at 1838 (citing *Surfco Haw. v. Fin Control Sys. Pty. Ltd.*, 264 F.3d 1062, 1065, 60 U.S.P.Q.2d (BNA) 1056, 1058 (Fed. Cir. 2001)).

966. *Id.* at 782, 62 U.S.P.Q.2d (BNA) at 1834.

967. *Id.* at 782-83, 62 U.S.P.Q.2d (BNA) at 1835.

968. *Id.* at 782, 62 U.S.P.Q.2d (BNA) at 1835.

969. *Id.* at 783, 62 U.S.P.Q.2d (BNA) at 1835.

970. *Id.* at 788, 62 U.S.P.Q.2d (BNA) at 1840.

971. *Id.* at 789, 62 U.S.P.Q.2d (BNA) at 1840.

972. *Id.* at 788, 62 U.S.P.Q.2d (BNA) at 1839.

973. *Id.*, 62 U.S.P.Q.2d (BNA) at 1839.

974. 284 F.3d 1323, 62 U.S.P.Q.2d (BNA) 1187 (Fed. Cir. 2002).

975. 145 F.3d 1454, 46 U.S.P.Q.2d (BNA) 1948 (Fed. Cir. 1998).

binding authority on the issue of whether the bona fide purchaser doctrine applies to patent licenses.<sup>976</sup> In *Rhone-Poulenc*, the Federal Circuit decided that *Heidelberg* was not binding and vacated the previous panel decision, while issuing a new decision.<sup>977</sup> Previously, Rhone-Poulenc Agro (RPA) and DeKalb jointly developed biotechnology related to specific genetic materials.<sup>978</sup> During that period, an RPA scientist developed, and patented, an optimized transit peptide that helps herbicide-resistant corn grow.<sup>979</sup> DeKalb was given a license to use the patented technology with the right to sublicense, which it did to Monsanto.<sup>980</sup> RPA sued DeKalb and Monsanto alleging that DeKalb procured the license by fraud, and Monsanto defended on the grounds that it held a valid (sub)license from DeKalb.<sup>981</sup> The district court found that Monsanto, as a sublicensee, “could be considered a bona fide purchaser because it had paid value for the right to use the technology without knowledge of any wrongdoing by DeKalb.”<sup>982</sup> The Federal Circuit defines “bona fide purchaser” as one who in good faith obtains legal title to property in exchange for valuable consideration, free from notice of any other claim of interest in the property.<sup>983</sup> The Federal Circuit here relied on 35 U.S.C. § 271 to determine the meaning of “without authority” to make, use, offer to sell, or sell the patented invention.<sup>984</sup> In examining the statute, the Federal Circuit departed from precedent and determined that § 261 reflects a Congressional finding that as a matter of law, only an assignee of all substantial rights can benefit from protection of the statute for a bona fide purchaser.<sup>985</sup> Finally, the Federal Circuit held that there was no available bona fide purchaser defense because Monsanto’s license was not exclusive, and

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976. *Rhone-Poulenc*, 284 F.3d at 1325, 62 U.S.P.Q.2d (BNA) at 1188. The Federal Circuit has noted that “a bona fide purchaser is one who purchases legal title to property in good faith for valuable consideration without notice of any other claim of the interest in the property.” *Id.* at 1329, 62 U.S.P.Q.2d (BNA) at 1191 (citing *Realty Portfolio, Inc. v. Hamilton*, 125 F.3d 292, 298 (5th Cir. 1997)); see also RESTATEMENT OF RESTITUTION § 172 (1937).

977. *Rhone-Poulenc*, 284 F.3d at 1325, 62 U.S.P.Q.2d (BNA) at 1188-89.

978. *Id.*, 62 U.S.P.Q.2d (BNA) at 1189.

979. *Id.*, 62 U.S.P.Q.2d (BNA) at 1189.

980. *Id.*, 62 U.S.P.Q.2d (BNA) at 1189.

981. *Id.* at 1326, 62 U.S.P.Q.2d (BNA) at 1189.

982. *Id.*, 62 U.S.P.Q.2d (BNA) at 1189 (quoting *Rhone-Poulenc Agro, S.A. v. Monsanto Co. and DeKalb Genetics Corp.*, No. 1:97CV1138, slip op. At 56 (M.D.N.C. Feb. 8, 2000)).

983. *Id.* at 1329, 62 U.S.P.Q.2d (BNA) at 1191 (citing *Realty Portfolio, Inc. v. Hamilton*, 125 F.3d 292 (5th Cir. 1997)); RESTATEMENT OF RESTITUTION, *supra* note 976, § 172.

984. *Rhone-Poulenc*, 284 F.3d at 1327, 62 U.S.P.Q.2d (BNA) at 1190; 35 U.S.C. § 271 (2000).

985. *Id.* at 1333, 62 U.S.P.Q.2d (BNA) at 1195; 35 U.S.C. § 261 (2000)



there was no argument from the parties that the license agreement transferred all substantial rights.<sup>986</sup>

#### IV. INEQUITABLE CONDUCT AND OTHER DEFENSES

##### A. Prosecution Laches

Prosecution laches is a defense to an infringement action involving new claims stemming from ongoing applications that might prejudice intervening adverse public rights.<sup>987</sup> If an intervening patent is issued more than two years before the filing of a divisional application, the burden is imposed upon the divisional applicant or patentees to show circumstances justifying the delay. This rule is applicable to any statutory bar; for example, a public use or sale.<sup>988</sup> In the absence of intervening rights, no excuse must be shown for a lapse of more than two years in presenting the divisional application.<sup>989</sup>

In *Symbol Technologies, Inc. v. Lemelson Medical, Education & Research Foundation LP*,<sup>990</sup> the Federal Circuit reversed the district court's holding that prosecution laches was unavailable as a matter of law.<sup>991</sup> The Federal Circuit held that "the equitable doctrine of laches could be applied to bar the enforcement of patent claims that issued after an unreasonable and unexplained delay in prosecution, despite the applicant's statutory and regulatory compliance."<sup>992</sup> In so doing, the Federal Circuit rejected the argument that (1) the doctrine was limited to interference actions under *Webster Electric Co. v. Splitdorf Electrical Co.*,<sup>993</sup> and its progeny; (2) the Patent Act of 1952 foreclosed the application of prosecution laches; and (3) two of the Federal Circuit's non-precedential opinions rejecting prosecution laches defenses should, in fact, bind the court.<sup>994</sup> Beyond affirming the viability of this defense, the Federal Circuit did not elaborate regarding how it should be applied.<sup>995</sup>

986. *Id.* at 1334, 62 U.S.P.Q.2d (BNA) at 1195.

987. *Symbol Tech., Inc. v. Lemelson Med., Educ. & Research Found.*, 277 F.3d 1361, 1364, 61 U.S.P.Q.2d (BNA) 1515, 1517 (Fed. Cir. 2002).

988. *Westinghouse Elec. & Mfg. Co. v. Jeffrey-DeWitt Insulator Co.*, 22 F.2d 277, 279 (2d Cir. 1927).

989. *Crown Cork & Seal Co. v. Ferdinand Gutmann Co.*, 304 U.S. 159, 167-68 (1938).

990. 277 F.3d 1361, 61 U.S.P.Q.2d (BNA) 1515 (Fed. Cir. 2002).

991. *Id.* at 1363, 61 U.S.P.Q.2d (BNA) at 1516. *See also supra* notes 475-81 (discussing the concept of prosecution laches).

992. *Symbol Technologies*, 277 F.3d at 1368, 61 U.S.P.Q.2d (BNA) at 1520.

993. 264 U.S. 463 (1924) (holding that an unreasonable eight-year delay rendered the claims unenforceable).

994. *Symbol Technologies*, 277 F.3d at 1365-68, 61 U.S.P.Q.2d (BNA) at 1518-20.

995. *Id.* at 1363-68, 61 U.S.P.Q.2d (BNA) at 1517-20.

In *In re Bogese II*,<sup>996</sup> the Federal Circuit applied the prosecution laches doctrine in the context of delayed patent prosecution. The court affirmed a decision by the USPTO Board finding that Bogese forfeited his right to a patent. In doing so, the Federal Circuit held that the USPTO could reject a patent application where the applicant failed to advance prosecution for an unreasonably long period, provided the USPTO gave notice of this consequence.<sup>997</sup> In approving the Board's findings, the Federal Circuit found that the patentee's intentional or negligent conduct of delaying the patent's issuance, hereby extending its term, was presumptively unreasonable because it eroded patent law policy of promoting science and the useful arts.<sup>998</sup> The Federal Circuit also affirmed the Board's holding that forfeiture of a patent was appropriate when a patentee either intentionally or negligently acted in a manner that unnecessarily postponed the date that the public could rightfully and freely use the invention.<sup>999</sup> This holding effectively made USPTO power to punish undue delay even broader than district court power to hold a patent unenforceable.<sup>1000</sup>

In her dissent, Judge Newman stated that the majority had effectively given patent examiners additional powers to deny patents on the basis that the applicant was not timely in prosecution.<sup>1001</sup> The Judge found this reason inconsistent with *In re Henriksen*,<sup>1002</sup> where the Court of Customs and Patent Appeals stated that "there was no statutory basis for fixing an arbitrary limit to the number of prior applications [in] a chain of co-pending applications."<sup>1003</sup> Judge Newman noted the USPTO's equitable power was limited to relieving distress, not causing it.<sup>1004</sup> Although the GATT change to a twenty years from filing standard would make these situations more rare, Judge Newman added that USPTO's new power would impose a great burden on all applicants while only occasionally punishing a transgressor.<sup>1005</sup>

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996. 303 F.3d 1362, 64 U.S.P.Q.2d 1448 (Fed. Cir. 2002).

997. *Id.* at 1367-68, 64 U.S.P.Q.2d (BNA) at 1452-53.

998. *Id.* at 1366, 64 U.S.P.Q.2d (BNA) at 1451.

999. *Id.*, 64 U.S.P.Q.2d (BNA) at 1451 (citing *Ex parte Bogese II*, slip op. at 35-36, No. 86-1699, 818 F.2d 877 (Fed. Cir. Mar. 16, 1987)).

1000. *Id.* at 1367, 64 U.S.P.Q.2d (BNA) at 1452.

1001. *Id.* at 1370, 64 U.S.P.Q.2d (BNA) at 1454 (Newman, J., dissenting).

1002. 399 F.2d 253 (C.C.P.A. 1968).

1003. *Bogese II*, 303 F.3d at 1370, 64 U.S.P.Q.2d (BNA) at 1454 (quoting *In re Henriksen*, 399 F.2d at 254).

1004. *Id.* at 1370-71, 64 U.S.P.Q.2d (BNA) at 1454-55.

1005. *Id.* at 1373, 64 U.S.P.Q.2d (BNA) at 1456.

*B. Inequitable Conduct*

In *Frank's Casing Crew & Rental Tools, Inc. v. Vincent*,<sup>1006</sup> the Federal Circuit affirmed the district court's holding that the patent in suit was unenforceable because of the patentee's inequitable conduct before the USPTO. In affirming the conduct ruling, the Federal Circuit rejected the argument that the patent should be enforced on behalf of the innocent inventor because the inequitable conduct was not by the true inventor.<sup>1007</sup> The Federal Circuit reiterated the long held rule that "one bad apple spoils the entire barrel," even as to otherwise innocent individuals, confirming that the patent in suit "may not be enforced by innocent co-inventors."<sup>1008</sup> Moreover, the Federal Circuit noted that the wrongdoers (as opposed to the innocent inventor) prosecuted the patent in suit, thereby making the patent unenforceable.<sup>1009</sup>

In *Juicy Whip, Inc. v. Orange Bang, Inc.*,<sup>1010</sup> the Federal Circuit reversed and remanded the district court's ruling, in favor of Orange Bang, that the patent at issue was invalid on the basis of prior use and was unenforceable due to inequitable conduct. The Federal Circuit held that the record was devoid of substantial evidence to support the jury's verdict because there was no evidence showing that the prior use device satisfied every limitation of the claimed invention.<sup>1011</sup> The Federal Circuit also held that the uncorroborated oral testimony presented to show prior public use failed to constitute the "clear and convincing evidence necessary to invalidate the patent for prior public knowledge."<sup>1012</sup> With respect to the first of two declarations of misconduct submitted to the USPTO, the Federal Circuit stated that every statement of the declaration relating to the invention was true and therefore did not constitute inequitable conduct.<sup>1013</sup> With respect to the second declaration, the Federal Circuit stated that the accused infringer did not identify specific statements that Juicy Whip knew were false.<sup>1014</sup> Accordingly, the Federal Circuit determined that the evidence of materiality and intent to deceive was lacking.<sup>1015</sup>

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1006. 292 F.3d 1363, 63 U.S.P.Q.2d (BNA) 1065 (Fed. Cir. 2002).

1007. *Id.* at 1377, 63 U.S.P.Q.2d (BNA) at 1075.

1008. *Id.*, 63 U.S.P.Q.2d (BNA) at 1075.

1009. *Id.*, 63 U.S.P.Q.2d (BNA) at 1075.

1010. 292 F.3d 728, 63 U.S.P.Q.2d (BNA) 1251 (Fed. Cir. 2002).

1011. *Id.* at 738, 63 U.S.P.Q.2d (BNA) at 1257-58.

1012. *Id.* at 743, 63 U.S.P.Q.2d (BNA) at 1262.

1013. *Id.* at 744, 63 U.S.P.Q.2d (BNA) at 1262.

1014. *Id.* at 745, 63 U.S.P.Q.2d (BNA) at 1263.

1015. *Id.* at 744-45, 63 U.S.P.Q.2d (BNA) at 1262-63.

C. *Use of the Invention by the United States Government*

In *Madey v. Duke University*,<sup>1016</sup> the Federal Circuit reversed the district court's partial dismissal, reversed the district court's summary judgment which applied the experimental use defense to Duke University's use of Madey's patented technology, and affirmed the district court's summary judgment that Duke University did not infringe the patents because it did not own or control the accused infringing equipment.<sup>1017</sup> Previously, the district court dismissed several of Madey's claims on the grounds that Duke University's use of the patents was under the authority of a government research grant and that the case should be brought in the Court of Federal Claims under 28 U.S.C. § 1498(a).<sup>1018</sup> Thus, the district court determined that it did not have jurisdiction over those claims.<sup>1019</sup> In reversing this partial dismissal, the Federal Circuit determined that the district court erred by failing to apply Federal Circuit law and by providing no findings or analysis upon which to base a review of the decision.<sup>1020</sup>

In granting summary judgment to Duke University, the district court determined that Madey failed to create a genuine issue of material fact that Duke University was engaged in a commercial enterprise.<sup>1021</sup> Upon reversal, the Federal Circuit concluded that the district court had used an overly broad formulation of the experimental use doctrine, which is typically "very narrow and strictly limited."<sup>1022</sup> The Federal Circuit indicated that the correct focus of the experimental use defense should be on whether Duke University's use was for legitimate non-commercial purposes, rather than examining Duke University's non-profit status.<sup>1023</sup> Further, the Federal Circuit noted that Duke University aggressively pursued a patent licensing program, from which it derived a substantial revenue stream.<sup>1024</sup>

In *Toxgon Corp. v. BNFL, Inc.*,<sup>1025</sup> the Federal Circuit vacated and remanded the district court's determination that it lacked subject matter jurisdiction in an infringement action.<sup>1026</sup> The patentee filed

1016. 307 F.3d 1351, 64 U.S.P.Q.2d 1737 (BNA) 1737 (Fed. Cir. 2002).

1017. *Id.* at 1352, 64 U.S.P.Q.2d (BNA) at 1737-38.

1018. *Id.* at 1358-60, 64 U.S.P.Q.2d (BNA) at 1744; 28 U.S.C. § 1498(a) (2000).

1019. *Id.*, 64 U.S.P.Q.2d (BNA) at 1740.

1020. *Id.* at 1359-60, 64 U.S.P.Q.2d (BNA) at 1744.

1021. *Id.* at 1355-57, 64 U.S.P.Q.2d (BNA) at 1740-42.

1022. *Id.* at 1361-62, 64 U.S.P.Q.2d (BNA) at 1746.

1023. *Id.* at 1362-63, 64 U.S.P.Q.2d (BNA) at 1747.

1024. *Id.* at 1363 n.7, 64 U.S.P.Q.2d (BNA) at 1747 n.7.

1025. 312 F.3d 1379, 65 U.S.P.Q.2d (BNA) 1146 (Fed. Cir. 2002).

1026. *Id.* at 1380, 65 U.S.P.Q.2d at 1147.

suit, alleging infringement by BNFL's process for treating and removing radioactive material using a pilot melter, described as a single-chamber vitrification system that converts nuclear waste into glass.<sup>1027</sup> In response, the accused infringer asserted, under Rule 12(b)(1) of the Federal Rules of Civil Procedure, that the infringement occurred under the authority of and for the sole benefit of the United States, thus requiring the claims to be heard in the Court of Federal Claims under 28 U.S.C. § 1498(a).<sup>1028</sup> Section 1498(a) restricts suits against the United States to monetary compensation for infringement and also relieves federal contractors of liability where the contractor uses or manufactures an infringing invention for the United States.<sup>1029</sup> Consistent with Supreme Court precedent, the Federal Circuit long has held that § 1498(a) is not a jurisdictional bar but can be used as an affirmative defense in a suit between private litigants.<sup>1030</sup> As such, the Federal Circuit found that the district court inappropriately dismissed the infringement suit under Rule 12(b)(1).<sup>1031</sup> According to the Federal Circuit, a more appropriate remedy for defenses arising under § 1498(a) should be addressed by summary judgment under Rule 56.<sup>1032</sup>

#### D. Estoppel

In *University of West Virginia v. VanVoorhies*,<sup>1033</sup> the Federal Circuit affirmed the district court's grant of summary judgment of the University's claim that a co-inventor of a patent breached his duty to assign inventions developed during the course of the co-inventor's graduate studies at the University.<sup>1034</sup> First, the Federal Circuit acknowledged that while questions of contract law are matters of state law, the question of whether a patent application was a continuation-in-part of an earlier filed patent application, and thus covered by a previously executed assignment, was a question of patent law as interpreted under federal law.<sup>1035</sup> Moreover, the Federal Circuit held that under the University's patent policy, the defendant was obligated to assign patent applications to the University even without a signed contract requiring such an assignment.<sup>1036</sup>

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1027. *Id.*, 65 U.S.P.Q.2d (BNA) at 1147.

1028. *Id.*, 65 U.S.P.Q.2d (BNA) at 1147-48; 28 U.S.C. § 1498(a) (2000).

1029. 28 U.S.C. § 1498(a).

1030. *Toxgon*, 312 F.3d at 1381, 65 U.S.P.Q.2d (BNA) at 1148.

1031. *Id.* at 1382, 65 U.S.P.Q.2d (BNA) at 1149.

1032. *Id.* at 1382-83, 65 U.S.P.Q.2d (BNA) at 1149.

1033. 278 F.3d 1288, 61 U.S.P.Q.2d (BNA) 1449 (Fed. Cir. 2002).

1034. *Id.* at 1299, 61 U.S.P.Q.2d (BNA) at 1455.

1035. *Id.* at 1296-97, 61 U.S.P.Q.2d (BNA) at 1454.

1036. *Id.* at 1298, 61 U.S.P.Q.2d (BNA) at 1455.

In affirming the district court's rejection of the defendant's argument that a previously executed assignment was invalid, the Federal Circuit clarified that "while the doctrine of assignor estoppel precluded challenges to the validity of a patent itself, it did not preclude challenges to the validity of a contract assigning the patent."<sup>1037</sup> Finally, the Federal Circuit held that an inventor's act of providing technical information to the University's patent counsel and executing the necessary documents for prosecuting a patent application did not give rise to an attorney-client relationship between the University's counsel and the defendant inventor, nor did these circumstances require disqualification when the University and the inventor's interests became adverse.<sup>1038</sup>

## V. REMEDIES

### A. Preliminary Injunction

In *Tate Access Floors, Inc. v. Interface Architectural Resources, Inc.*,<sup>1039</sup> the Federal Circuit affirmed the district court's preliminary injunction enjoining Interface from infringing claims of its patent for raised access flooring panels.<sup>1040</sup> Interface appealed only the lower court's conclusion regarding the likelihood of success based on the merits of Tate's infringement claim.<sup>1041</sup> The Federal Circuit first held that there was no practicing prior art defense to literal infringement.<sup>1042</sup> Next, the Federal Circuit rejected Interface's argument that the lower court's interpretation of the term "border," which "encompass[es] the simple beveled edges in the accused floor panels" was an erroneous construction.<sup>1043</sup> The Federal Circuit found that a person of ordinary skill in the art of raised access floor panels would know

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1037. *Id.* at 1301-02, 61 U.S.P.Q.2d (BNA) at 1457-58; *see also* *Diamond Sci. Co. v. Ambico, Inc.*, 848 F.2d 1220, 6 U.S.P.Q.2d (BNA) 2028 (Fed. Cir. 1988). The court in *Diamond Scientific* held:

Assignor estoppel is an equitable doctrine that prevents one who has assigned the rights to a patent (or patent application) from later contending that what was assigned is a nullity. The estoppel also operates to bar other parties in privity with the assignor, such as a corporation founded by the assignor. The estoppel historically has applied to invalidity challenges based on "novelty, utility, patentable invention, anticipatory matter, and the state of the art.

*Id.* at 1224, 6 U.S.P.Q.2d (BNA) at 2031 (citation omitted).

1038. *Van Voorhies*, 278 F.3d at 1303-04, 61 U.S.P.Q.2d (BNA) at 1459.

1039. 279 F.3d 1357, 61 U.S.P.Q.2d (BNA) 1647 (Fed. Cir. 2002).

1040. *Id.* at 1360, 61 U.S.P.Q.2d (BNA) at 1648.

1041. *Id.*, 61 U.S.P.Q.2d (BNA) at 1648.

1042. *Id.* at 1369, 61 U.S.P.Q.2d (BNA) at 1656.

1043. *Id.* at 1370, 61 U.S.P.Q.2d (BNA) at 1656.

that the term “border” referred to “the area or zone forming an edge or trim framing the decorative surface of the panel.”<sup>1044</sup> In reviewing the patent, the Federal Circuit found no requirements in the specification or claims that “the ‘border’ be horizontal or formed of a single layer.”<sup>1045</sup> Ultimately, the Federal Circuit held that the accused’s panels infringed the patentee’s panels and that Tate met the “likelihood of success on the merits” prong of the preliminary injunction test.<sup>1046</sup>

### B. Damages

#### 1. Other than reasonable royalty

In *Vulcan Engineering Co. v. FATA Aluminum, Inc.*,<sup>1047</sup> the Federal Circuit affirmed the district court’s finding of patent validity, infringement, and a damages award of lost profits, but remanded to determine whether the patentee was entitled to additional price erosion damages.<sup>1048</sup> The Federal Circuit also affirmed the district court’s denial of damages as to other infringing processes, attorney fees, enhanced damages, and a new trial.<sup>1049</sup> In denying damages for other infringing processes, the Federal Circuit held that the patentee’s grant of an express license to a third party user of the patented process was inconsistent with an assertion of damages for infringement against the defendant.<sup>1050</sup> After determining that the patentee reserved only the right to damages for failing to obtain the business of providing the infringing process, the district court did not award damages because the patentee failed to prove the amount of the relevant damages with certainty.<sup>1051</sup>

In *Fiskars, Inc. v. Hunt Manufacturing Co.*,<sup>1052</sup> the Federal Circuit affirmed the district court’s determination that a defendant’s motion to reopen and vacate a damages judgment, two years after entry of that judgment, should be denied.<sup>1053</sup> Hunt filed a motion for relief of judgment based on Rules 60(b)(5) or 60(b)(6) of the Federal Rules of Civil Procedure, seeking vacatur of the damages award based on new evidence allegedly showing that Fiskars was not entitled to lost

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1044. *Id.* at 1370, 61 U.S.P.Q.2d (BNA) at 1656.

1045. *Id.*, 61 U.S.P.Q.2d (BNA) at 1657.

1046. *Id.* at 1372, 61 U.S.P.Q.2d (BNA) at 1658.

1047. 278 F.3d 1366, 61 U.S.P.Q.2d (BNA) 1545 (Fed. Cir. 2002).

1048. *Id.* at 1380, 61 U.S.P.Q.2d (BNA) at 1554.

1049. *Id.* at 1378-80, 61 U.S.P.Q.2d (BNA) at 1552-54.

1050. *Id.* at 1378, 61 U.S.P.Q.2d (BNA) at 1552.

1051. *Id.*, 61 U.S.P.Q.2d (BNA) at 1552.

1052. 279 F.3d 1378, 61 U.S.P.Q.2d (BNA) 1851 (Fed. Cir. 2002).

1053. *Id.* at 1379, 61 U.S.P.Q.2d (BNA) at 1852.

profits.<sup>1054</sup> The Federal Circuit first found that Federal Circuit law applied in this case, and that Rule 60(b)(6) was available only in extraordinary circumstances, which were not present here.<sup>1055</sup> The Federal Circuit also rejected Hunt's contention argument that damages for lost profits should be reexamined post-trial where probative market data about acceptability becomes available—after “a non-infringing alternative replaces the infringing product in the marketplace.”<sup>1056</sup> Ultimately, the Federal Circuit also agreed with the district court's finding that the evidence, which arose nearly two years after trial, did not create such extraordinary circumstances as to invoke Rule 60(b)(6).<sup>1057</sup>

## 2. Reasonable royalty

In *Riles v. Shell Exploration & Production Co.*,<sup>1058</sup> the district court refused to grant a motion for judgment as a matter of law which would overturn a jury verdict of infringement and award of damages. The Federal Circuit agreed that “substantial evidence supported the jury's finding of infringement,” but that the damages were “excessive and unsupported by evidence.”<sup>1059</sup> With respect to damages, Riles's damages theory was that if Shell had a patented method of construction on the platform, it could result in an injunction on the use of the entire platform.<sup>1060</sup> Such an injunction would force Shell to either abandon its \$84 million platform or to pay Riles a percentage royalty.<sup>1061</sup> The Federal Circuit found this theory to be legally incorrect, because Shell could lawfully use its platform without infringing Riles's patent, and the Federal Circuit therefore found that the record did not support a percentage royalty based on the cost of the entire platform.<sup>1062</sup>

Moreover, the Federal Circuit found that Riles's damages model was incorrect because it did not pair the proposed royalty with the value of the patented method—but rather with the unrelated cost of the entire Shell platform—which included costs outside of the costs of anchoring without mud mats.<sup>1063</sup> In remanding the case for a re-

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1054. *Id.* at 1380, 61 U.S.P.Q.2d (BNA) at 1853.

1055. *Id.* at 1382, 61 U.S.P.Q.2d (BNA) at 1854 (citing *Marquip, Inc. v. Fosber Am. Inc.*, 198 F.3d 1363, 1370, 53 U.S.P.Q.2d (BNA) 1015, 1020 (Fed. Cir. 1999)).

1056. *Id.* at 1383, 61 U.S.P.Q.2d (BNA) at 1855.

1057. *Id.* at 1381-83, 61 U.S.P.Q.2d (BNA) at 1855.

1058. 298 F.3d 1302, 63 U.S.P.Q.2d (BNA) 1819 (Fed. Cir. 2002).

1059. *Id.* at 1305, 63 U.S.P.Q.2d (BNA) at 1821.

1060. *Id.* at 1311, 63 U.S.P.Q.2d (BNA) at 1825.

1061. *Id.*, 63 U.S.P.Q.2d (BNA) at 1825.

1062. *Id.* at 1311-12, 63 U.S.P.Q.2d (BNA) at 1826.

1063. *Id.*, 63 U.S.P.Q.2d (BNA) at 1826.



determination of damages, the Federal Circuit held that the market would not award Riles a royalty for his method that was separated from relations to potential non-infringing alternative methods.<sup>1064</sup>

In *Transclean Corp. v. Bridgewood Services, Inc.*,<sup>1065</sup> a jury found that Bridgewood willfully infringed the patent and engaged in false advertising. Transclean subsequently appealed the district court's reversal of part of the jury's damages award and its denial of Transclean's motion for enhanced damages based on willful infringement; in turn, Bridgewood cross-appealed the findings of validity and infringement.<sup>1066</sup> The Federal Circuit affirmed the lower court's finding of patent validity.<sup>1067</sup> With regard to damages, the district court disallowed the allocation of a percentage of the sale of Bridgewood's business to Transclean as a reasonable royalty.<sup>1068</sup> The Federal Circuit affirmed this decision, stating that for purposes of calculating a base from which to determine reasonable royalties, there was no concrete relation between the value of a business's goodwill at sale and the sales from infringing goods.<sup>1069</sup> Further, with regard to the denial of enhanced damages, the Federal Circuit found that the district court did not abuse its discretion.<sup>1070</sup>

### 3. Attorney fees and costs

In *Pickholtz v. Rainbow Technologies, Inc.*,<sup>1071</sup> the Federal Circuit reversed the district court's grant of summary judgment of non-infringement, but affirmed the district court's denial of Pickholtz's motion for infringement.<sup>1072</sup> In so ruling, the Federal Circuit vacated the district court's refusal to award attorney fees to Pickholtz, finding that the language of Rule 37 of the Federal Rules of Civil Procedure did not allow pro se lawyers to receive fees for their own time.<sup>1073</sup> Upon remanding the case, the Federal Circuit noted, however, that the court's inherent power could be invoked, even where a procedural rule exists that sanctions the same conduct, to determine

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1064. *Id.* at 1312, 63 U.S.P.Q.2d (BNA) at 1826.

1065. 290 F.3d 1364, 62 U.S.P.Q.2d (BNA) 1865 (Fed. Cir. 2002).

1066. *Id.* at 1367, 62 U.S.P.Q.2d (BNA) at 1866-67.

1067. *Id.* at 1373, 62 U.S.P.Q.2d (BNA) at 1871.

1068. *Id.* at 1375, 62 U.S.P.Q.2d (BNA) at 1873 (citing *Transclean Corp. v. Bridgewood Serv., Inc.*, No. 97-2298, slip op. at 3 (D. Minn. Jan. 8, 2001)).

1069. *Id.* at 1376-77, 62 U.S.P.Q.2d (BNA) at 1874.

1070. *Id.* at 1377, 62 U.S.P.Q.2d (BNA) at 1875.

1071. 284 F.3d 1365, 62 U.S.P.Q.2d (BNA) 1340 (Fed. Cir. 2002).

1072. *Id.* at 1367-68, 62 U.S.P.Q.2d (BNA) at 1341.

1073. *Id.* at 1376-78, 62 U.S.P.Q.2d (BNA) at 1347-49; FED. R. CIV. P. 37.

whether Pickholtz was entitled to attorney's fees pursuant to this power.<sup>1074</sup>

In *Kohus v. Cosco, Inc.*,<sup>1075</sup> Kohus's patent infringement suit had failed and Cosco sought to recover litigation costs from Kohus.<sup>1076</sup> The district court awarded Cosco \$975.90 for deposition costs and \$12,950.00 for exhibit expenses.<sup>1077</sup> The Federal Circuit reversed these awards, finding that 28 U.S.C. § 1920 provided the only remedy for awarding costs.<sup>1078</sup> The Federal Circuit held that the video was neither an exemplification nor a copy of a paper, and the district court had no statutory authority to award costs to the defendants for the video.<sup>1079</sup> In doing so, the Federal Circuit considered a Sixth Circuit decision, *Swan Carburetor Co. v. Chrysler Corp.*,<sup>1080</sup> to determine whether the video could be considered "drawings, charts, or physical models." The court in *Swan* allowed costs to be awarded for drawings and charts, but not for physical models.<sup>1081</sup> In applying *Swan* and denying cost recovery of the video, the Federal Circuit held that the defendant's video was a physical model, because it was a substitute for a physical model and was created to assist counsel's arguments and expert witness' explanations.<sup>1082</sup> Judge Dyk dissented, stating that, in fact, a video should be included in the costs covered by 28 U.S.C. § 1920(4).<sup>1083</sup> Judge Dyk also stated that the language of the statute could be construed to include "after-invented technology."<sup>1084</sup>

### C. Attorney Conduct

#### 1. Contempt

In *Eagle Comtronics, Inc. v. Arrow Communication Laboratories, Inc.*,<sup>1085</sup> the Federal Circuit reversed the decision of the district court, which held that there was no violation of a protective order. The Federal Circuit also vacated a summary judgment decision by the district court that there was no infringement and remanded the case for

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1074. *Pickholtz*, 284 F.3d at 1376-78, 62 U.S.P.Q.2d (BNA) at 1348-49.

1075. 282 F.3d 1355, 62 U.S.P.Q.2d (BNA) 1145 (Fed. Cir. 2002).

1076. *Id.* at 1356, 62 U.S.P.Q.2d (BNA) at 1146 (citing *Kohus v. Cosco, Inc.*, 250 F.3d 758 (Fed. Cir. 2000) (per curiam)).

1077. *Id.*, 62 U.S.P.Q.2d (BNA) at 1146.

1078. *Id.* at 1359, 62 U.S.P.Q.2d (BNA) at 1148-49; 28 U.S.C. § 1920 (2000).

1079. *Kohus*, 282 F.3d at 1359, 62 U.S.P.Q.2d at 1148-49.

1080. 149 F.2d 476, 65 U.S.P.Q. 386 (6th Cir. 1945).

1081. *Id.* at 477, 65 U.S.P.Q. at 387.

1082. *Kohus*, 282 F.3d at 1360-61, 62 U.S.P.Q.2d (BNA) at 1149-50.

1083. *Id.* at 1361, 62 U.S.P.Q.2d (BNA) at 1150 (Dyk, J., dissenting); 28 U.S.C. § 1920(4).

1084. *Kohus*, 282 F.3d at 1361, 62 U.S.P.Q.2d (BNA) at 1150.

1085. 305 F.3d 1303, 64 U.S.P.Q.2d (BNA) 1481 (Fed. Cir. 2002).

trial.<sup>1086</sup> During discovery and under a protective order, Arrow (Arcom) produced a confidential and pending patent application to Eagle.<sup>1087</sup> Under the belief that Eagle had rights to the subject matter in the application, Eagle's attorney made copies of the patent application and filed the copies as two separate applications with the USPTO.<sup>1088</sup> In a letter to Arcom nine days later, Eagle's attorney explained that he was seeking to preserve Eagle's rights.<sup>1089</sup> When Arcom petitioned the district court to hold Eagle's attorney in contempt, Eagle argued, and the district court agreed, that the attorney's actions did not violate the protective order because the disclosure was to the USPTO, which already possessed the pending patent application.<sup>1090</sup>

The Federal Circuit reversed the district court's decision, finding that the conduct of Eagle's attorney was "egregious" and that the district court's failure to find a violation of the protective order was most certainly an abuse of discretion."<sup>1091</sup>

## 2. *Pre-filing investigation under Rule 11*

In *Antonious v. Spalding & Evenflo Companies, Inc.*<sup>1092</sup> the Federal Circuit vacated and remanded the district court decision to determine whether counsel for Antonious failed to conduct reasonable pre-filing factual investigations.<sup>1093</sup> The Federal Circuit held that plaintiff's attorneys could be sanctioned under Rule 11(b)(2) of the Federal Rules of Civil Procedure if a reasonable attorney would have found the claim construction frivolous.<sup>1094</sup> In finding the claim construction was not frivolous, the Federal Circuit remanded for a determination as to whether plaintiff's counsel's investigation was thorough enough to satisfy the Rule 11(b)(3) pre-filing investigation requirement.<sup>1095</sup>

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1086. *Id.* at 1306, 64 U.S.P.Q.2d (BNA) at 1482.

1087. *Id.* at 1311, 64 U.S.P.Q.2d (BNA) at 1485.

1088. *Id.* at 1311-12, 64 U.S.P.Q.2d (BNA) at 1486. One patent application identified only an Eagle employee as inventor; the other identified Eagle and Arcom employees as joint inventors. *Id.*, 64 U.S.P.Q.2d (BNA) at 1486.

1089. *Id.* at 1312, 64 U.S.P.Q.2d (BNA) at 1486.

1090. *Id.*, 64 U.S.P.Q.2d (BNA) at 1486.

1091. *Id.* at 1314, 64 U.S.P.Q.2d (BNA) at 1487-88 ("[C]opying a competitor's patent application obtained through discovery and submitting it as your own—for whatever reason—is not using the material for purposes of litigation.").

1092. 275 F.3d 1066, 61 U.S.P.Q.2d (BNA) 1245 (Fed. Cir. 2002).

1093. *Id.* at 1068-69, 61 U.S.P.Q.2d (BNA) at 1246.

1094. *Id.* at 1072, 61 U.S.P.Q.2d (BNA) at 1249.

1095. *Id.* at 1077, 61 U.S.P.Q.2d at 1252.

In *Fantasy Sports Properties, Inc. v. Sportsline.com, Inc.*,<sup>1096</sup> the Federal Circuit affirmed-in-part and vacated-in-part the summary judgment of non-infringement of the district court.<sup>1097</sup> The claims on appeal related to a method and apparatus for playing a “fantasy” football computer game.<sup>1098</sup> Following an infringement analysis, the Federal Circuit denied Yahoo!’s motion for attorney fees and costs because Fantasy had conducted a proper pre-filing investigation, which included setting forth a reasonable claim construction under which the defendants literally infringed.<sup>1099</sup>

### 3. Attorney statements

In *Union Carbide Chemicals & Plastics Technology Corp. v. Shell Oil Co.*,<sup>1100</sup> the Federal Circuit affirmed-in-part, reversed-in-part, and remanded a decision of the district court finding non-infringement of Union Carbide’s patents.<sup>1101</sup> Union Carbide patents covered ethylene oxide silver catalysts with improved efficiency, and the claims contained an “efficiency equation.”<sup>1102</sup> Among other things, Union Carbide argued that it was entitled to a new trial because of improper statements made by Shell’s counsel about Union Carbide’s past copying of Shell patents, which allegedly tainted the jury, thus precluding a fair verdict.<sup>1103</sup> The district court found the statements “improper,” but concluded that they had not influenced the jury verdict.<sup>1104</sup> In noting the lower court’s need to monitor attorneys appearing before it, the Federal Circuit found the statements “unacceptable,” but ruled that the district court did not abuse its discretion; the statements went more to invalidity—which was ultimately not a jury question—than to infringement.<sup>1105</sup>

## CONCLUSION

In 2002, the Federal Circuit continued to play a major role in the field of patent law, securing its position as one of the most important courts in the United States. It was an unusual year for the court as it saw two of its cases taken up by the Supreme Court, *Holmes Group, Inc.*

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1096. 287 F.3d 1108, 62 U.S.P.Q.2d (BNA) 1564 (Fed. Cir. 2002).

1097. *Id.* at 1111, 62 U.S.P.Q.2d (BNA) at 1566.

1098. *Id.*, 62 U.S.P.Q.2d (BNA) at 1566.

1099. *Id.* at 1120, 62 U.S.P.Q.2d (BNA) at 1573.

1100. 308 F.3d 1167, 64 U.S.P.Q.2d (BNA) 1545 (Fed. Cir. 2002).

1101. *Id.* at 1171, 64 U.S.P.Q.2d (BNA) at 1547.

1102. *Id.* at 1171-72, 64 U.S.P.Q.2d (BNA) at 1547-48.

1103. *Id.* at 1180, 64 U.S.P.Q.2d (BNA) at 1555.

1104. *Id.* at 1183, 64 U.S.P.Q.2d (BNA) at 1556.

1105. *Id.* at 1183-84, 64 U.S.P.Q.2d (BNA) at 1556.

*v. Vornado Air Circulation Systems, Inc.*<sup>1106</sup> and *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushki Co., Ltd.*,<sup>1107</sup> both resulting in reversals.

The Federal Circuit also issued two en banc decisions. In *Johnson & Johnston Associates Inc. v. R.E. Service Co., Inc.*,<sup>1108</sup> the court clarified the law on the doctrine of equivalents post-*Festo*. And, in *Rhone-Poulenc Agro, S.A. v. DeKalb Genetics Corp.*,<sup>1109</sup> the court decided that the previous decision in *Heidelberg Harris, Inc. v. Loebach*<sup>1110</sup> was not binding authority on the issue of whether the bona fide purchaser doctrine applies to patent licenses.

Nevertheless, for the most part, the Federal Circuit continued to play its important role of ensuring that the patent laws are applied in a uniform manner.

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1106. 535 U.S. 826, 62 U.S.P.Q.2d (BNA) 1801 (2002).

1107. 535 U.S. 722, 62 U.S.P.Q.2d (BNA) 1705 (2002).

1108. 285 F.3d 1046, 62 U.S.P.Q.2d (BNA) 1225 (Fed. Cir. 2002).

1109. 284 F.3d 1323, 62 U.S.P.Q.2d (BNA) 1187 (Fed. Cir. 2002).

1110. 145 F.3d 1454, 46 U.S.P.Q.2d (BNA) 1948 (Fed. Cir. 1998).