

Patent Law 2003-04: Federal Circuit Case Studies



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Novelty and the Loss of Rights to a Patent - § 102



- Watch for
 - Increased emphasis on claim construction

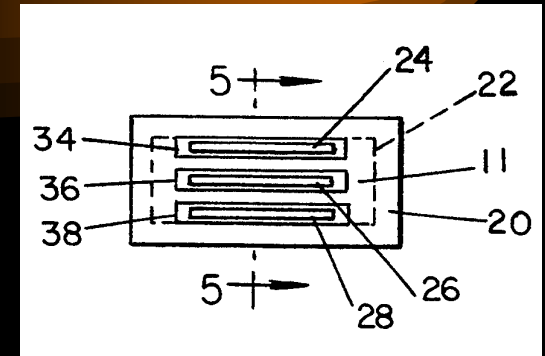
Novelty and the Loss of Rights to a Patent - § 102



- 35 USC§ 102
 - To anticipate, every claim and limitation of the claimed invention must be found in a single emphasis on claim construction
 - Requires claim construction

Claim Construction Anticipation

- *Hewlett-Packard v. Mustek Systems, Inc.*, 340 F.3d 1314 (Fed. Cir. 2003)



- “performing a final scan of a portion of the picture which corresponds to the portion of the preview scan to produce a final scan image”
- HP – ordinary meaning – only “selected portion” scanned on final scan
- Fed Cir – Disagreed – entire picture is scanned
- Anticipated

Inherency



- **Key Points**

- Relying on similar p/a structure is not enough
- Division among CAFC – whether one of ordinary skill in the art must have recognized the inherency
- Inherency must be supported by competent proof

Inherency

- Generally
 - A prior art reference that does not explicitly disclose or teach a particular claim element may nevertheless anticipate a claim containing such an element if the prior art inherently discloses the element
 - In order to establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill.”
 - *Continental Can Co. USA v. Monsanto Co.* (1991) – J. Newman

Anticipation ~ Shown Through Inherency

- Must one of ordinary skill in the art recognize what was asserted to be inherent?

Continental Can 1991 = Yes
Atlas Powder 1999 = No

MEHL/Biophile 1999 = No
EMI Group 2001 = No

Elan Pharms, Inc. v. Mayo Bd. For Med. Res., 304 F.3d 1221

(Fed. Cir. 2002) – VACATED (*en banc*) – **Alzheimer** – Yes – (J. Newman – JJ. Gajarsa & Dyk)

- Majority (Newman) = one of ordinary skill in the art would not have recognized the asserted inherency

- Dissent (Dyk) = “it matters not that those of ordinary skill heretofore may not have recognized these inherent characteristics.”

- “Replacement” Opinion - ___ F.3d ___ (Fed. Cir. 2003) – Remanded to determine whether p/a was enabling

Anticipation ~ Shown Through Inherency

- *Schering Corp. v. Geneva Pharma.*, 339 F.3d 1373 (Fed. Cir. 2003)(J. Rader – SCJ Plager & J. Bryson)
 - (1) An inherent feature of a p/a reference need not be perceived as such by a person of ordinary skill in the art before the critical date
 - (2) A p/a reference may inherently anticipate the entire claimed subject matter – even though not mentioned
 - Patent # 1 – Loratadine – CLARITIN™
 - Patent # 2 – Metabolite of loratadine - DCL
 - Patent # 1 p/a to Patent # 2
 - DCL formed when patient ingested loratadine
 - “this court’s precedent does not require a skilled artisan to recognize the inherent characteristic in the p/a that anticipates the claimed invention.”

Anticipation ~ Shown Through Inherency

- *Schering Corp. v. Geneva Pharma.*, 348 F.3d 992 (Fed. Cir. 2003)
 - October 28, 2003 – pet. for panel reh’g – denied
 - Pet. for reh’g *en banc* - denied
 - Dissents - Judges Newman and Lourie
 - Judge Gajarsa - would rehear *en banc*
 - Judge Schall - did not participate in the vote

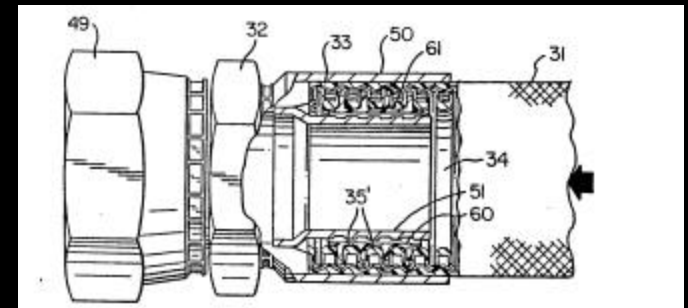
Anticipation ~ Shown Through Inherency

- *Toro Co. v. Deere & Co.*, ___ F.3d ___ (Fed. Cir. 2004)(JJ. Michel, Lourie & Linn)
 - *Schering* is the law
 - Lawn tool – plurality of nozzles on movable frame injecting high pressure water into soil to stimulate turf growth.
 - “moving said source of incompressible liquid over the surface of said turf in a pattern such that the lateral dispersion from adjacent jets coact with one another to lift and fracture the soil ***.”
 - Deere – invalid – Deere patent expressly discloses all claim limitations except above – inherently anticipated – jets mounted using overlapping parameters to those in spec.
 - Fed Cir – no sufficient showing – not all parameters overlap
 - BUT D Ct didn’t do claim construction – remand.

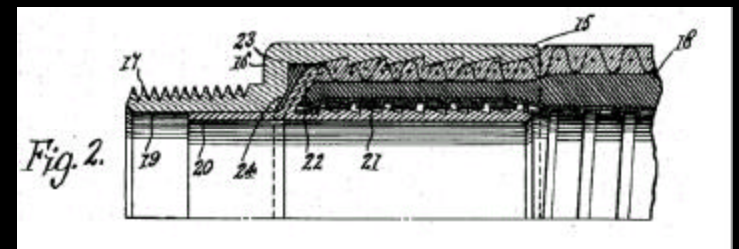
Anticipation ~ Shown Through Inherency

- Assertions of Inherency Must Be Supported By Competent Proof
 - *Dayco Products, Inc. v. Total Containment (Dayco II)* – 2003
 - No competent proof
 - “polymeric hose”

Invention



Prior Art



Oral Testimony re Lack of Novelty

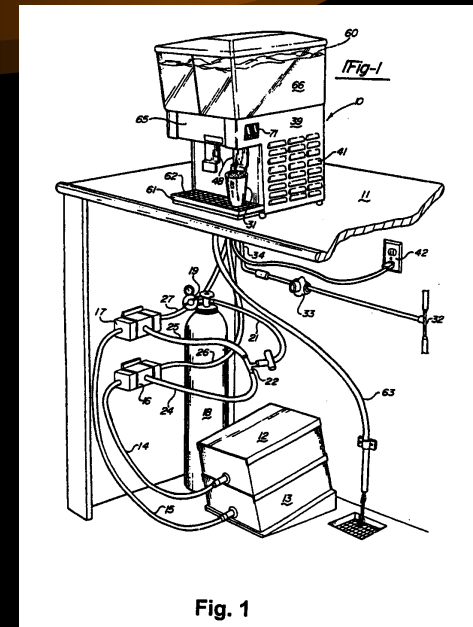
- Background
 - **Conflict in the cases beginning in 1997 whether uncorroborated testimony of prior knowledge or use can not provide clear and convincing evidence of invalidity**

Oral Testimony Re Lack of Novelty

- The Oral Evidence Conflict Resolved: The Reuter Factors Apply
 - *Juicy Whip, Inc. v. Orange Bang, Inc.*, 292 F.3d 728 (Fed. Cir. 2002)

- 1) the delay between event and trial,
- 2) interest of witness,
- 3) contradiction or impeachment,
- 4) corroboration,
- 5) witnesses' familiarity with details of alleged prior structure,
- 6) improbability of prior use considering state of the art,
- 7) impact of the invention on the industry, and
- 8) relationship between witness and alleged prior uses.

- In court demonstration – insufficient
- Dissent – Chief Judge Mayer – in court demonstration should have been sufficient



Oral Testimony Re Lack of Novelty

- *Hewlett-Packard v. Mustek*, 340 F.3d 1314 (Fed. Cir. 2003)
Mustek scanner demonstrated during trial
 - Mustek – demonstration itself provided corroboration
 - Fed Cir “We conclude that the testimonial evidence here was sufficiently corroborated by the operation of the device itself * * *” citing *Juicy Whip*.

Loss of Rights to a Patent

- **WATCH FOR**
 - Changes in Burden of Proof
 - Continuing struggle with *Pfaff* “on sale” requirements
 - Commercial sale/offer for sale – Increasing emphasis on “commercial” and “offer” must create a contract if accepted
 - “Ready for Patenting” – Standards approaching actual reduction to practice, although that requirement rejected in *Pfaff*

Loss of Rights to a Patent

- In An Infringement Context, References Are Presumed To Be Enabling For All That They Disclose, Including Claimed and Unclaimed Subject Matter: The Burden Falls On The Patentee To Prove That A Reference Is Non-Enabling
 - *In re Sasse*, 629 F.2d 675, 681 (CCPA 1980) – burden is on the applicant to show reference is non-enabling – PTO may “presume” reference is enabling
 - *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313 (Fed. Cir. 2003)
 - D Ct erred in placing burden of showing enablement on patent challenger relying on *Sasse*
 - “we hold a presumption arises that both the claimed and unclaimed disclosures in a prior art patent are enabled.”

Loss of Rights to a Patent

- A License May Place an Invention “On Sale”
 - *Minton v. Nat’l Assoc. of Securities Dealers*, 336 F.3d 1614 (Fed. Cir. 2003)(JJ. Lourie, Linn – concurring opinion J. Gajarsa)
 - Computerized securities trading system
 - Minton had leased TEXCEN, a computer program & communications network to brokerage firm < 1 yr before f/d.
 - Urged under *Kollar* not “on sale”
 - Fed Cir. – *Kollar* involved agreement to transfer technical info.
 - “a commercial transaction arranged as a ‘license’ or a ‘lease’ of a product or device *** may be tantamount to a sale ***.”

Loss of Rights to a Patent

- (1) “Offer for Sale” Means a Formal Offer For Sale in the Contract Sense and (2) Will Be Decided as a Matter of Federal Circuit Law
 - *Group One, Ltd. v. Hallmark Cards, Inc.* 254 F.3d 1041 (Fed. Cir. 2001)
 - CAFC will develop its own law re “offer for sale”
 - Offer must meet contract law definition
 - Prior contrary holding in *RCA* 1989 = dicta
 - *Linear Tech. v. Micrel*, 275 F.3d 1040 (Fed. Cir. 2001)
 - “the body of case law from which we must draw guidance * * * is that of the state and federal courts interpreting their individual versions of the UCC.”

Loss of Rights to a Patent

- Whether Activity Amounts to an “Offer for Sale” May Depend on Industry Practice
 - *Lacks Indus. v. McKechnie Vehicle Components*, 322 F.3d 1335 (Fed. Cir. 2003)
 - Cladded wheels – “on sale” issue
 - U.C.C. § 1-205 – custom & usage in the trade
 - Remanded w/ suggestion that d ct “may need to take add’l evidence on the practice in the industry * * *.”
 - J. Newman – dissent – “Determination of whether there has been an offer of sale * * * requires objective application of uniform contract law * * * [not local custom].”

Obviousness/Non-Obviousness

- Presumption of Validity Applies Even Though Examination Was Flawed
 - *TorPharm v. Ranbaxy Pharma.*, 336 F.3d 1322 (Fed. Cir. 2003)
 - Process for making rantidine – antihistime that inhibits stomach acid secretion
 - Prosecution – urged process was patentable b/c product was novel
 - Product later proved not novel in unrelated litigation
 - Question remains whether process would have been obvious given that product was p/a

Double Patenting & Restriction Requirements

- 35 U.S.C. § 121:
 - “ *** A patent issuing on an application with respect to which a requirement under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the [PTO] or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.”

Double Patenting & Restriction Requirements

- *Geneva Pharm. v. GlaxoSmithKline*, 349 F.3d 1373 (Fed. Cir. 2003)(JJ. Rader & Bryson, CJ Mayer)
 - Antibiotic
 - Original 1975 patent ('007) – 8 way restriction – no method of use claims.
 - Resulted in 3 1985 patents & 4 2000/01 patents
 - Fed. Cir. – 2000/01 patents invalid – contained method of use claims – not in '007 – strongly suggests that § 121 doesn't apply if claims aren't actually restricted
 - Fed. Cir. – 1979 Examiner Interview Summary form refers to “Agreed that *** method of use claims would go in a *** Divisional.” – Held not an actual restriction requirement – Despite PTO having so held in reexam

Double Patenting & Restriction Requirements

- *Bristol-Myers Squibb v. Pharmachemie BV*, ___ F.3d ___ (Fed. Cir. 2004)(JJ. Bryson & Michel, dissent by J. Newman)
 - Claimed (1) methods for treating tumors with platinum cmpds & (2) compositions containing cmpds
 - 1972 application – 1st restriction (1973) between (1) cmpd claims, and (2) method of treatment & composition claims – 2nd restriction (1974 – diff ex'r) between 4 diff cmpd groups
 - 1977 continuation – abnd 1972 application – new ex'r – 3rd restriction (1977) – differed from '73 & '74 – groupings included methods of use, cmpds & compositions – elected 4 claims – issued as '707 patent
 - Filed div appl. w/ all non-elected claims – 4th restriction PLUS add'l restriction that included 1977 restriction
 - 1983 filed another div appl. – diff ex'r – 5th restriction 2-way – issued as '927 patent
 - D Ct. - § 121 requirement met – 1973 requirement continued
 - Fed Cir – NO – 1977 application was new application

Enablement-Written Description-Best Mode

- **WATCH FOR**
 - **Changes in the test for compliance with the written description requirement**
 - **Scope of claims limited to scope of enablement**
 - **Best mode analysis tied to claimed invention**

Written Description

- Test for Compliance
 - *Vas-Cath, Inc. v. Mahurkar* (1991)
 - “Although the applicant does not have to describe exactly the subject matter claimed, the description must clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed. The test for sufficiency of support * * * is whether the disclosure of the application reasonably conveys to the artisan that the inventor had possession at that time of the later claimed matter.”
 - “Possession of the invention” currently under attack.

Written Description

- Test for Compliance
 - *Regents v. Eli Lilly* (1997)(J. Lourie – JJ. Newman & Bryson)
 - Gene material identified only by a statement of function or result did not adequately describe the claimed invention
 - Written description of genetic material “requires a precise definition, such as by structure, formula, chemical name, or physical properties.”

Written Description

- *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 296 F.3d 1316 (Fed. Cir. 2002)(J. Lourie, joined by JJ. Dyk and Prost)
 - “that portion of * * * *Vas-Cath*, merely states a purpose for the written description requirement * * *. It does not state that possession alone is always sufficient to meet the requirement.”
 - But “[a] showing of ‘possession’ is ancillary to the statutory mandate that ‘[t]he specification shall contain a written description of the invention,’ and that requirement is not met if, despite a showing of possession, the specification does not adequately describe the claimed invention.”

Written Description

- *Enzo Biochem, Inc. v. Gen-Probe Inc.*, Cont'd
 - Panel grants pet. for reh'g – changes its mind
 - Adopts PTO § 112(1) Disclosure Guidelines
 - Deposit w/ ATCC may satisfy written description requirement (after initially holding otherwise)
 - Pet. for *en banc* reh'g denied
 - Dissents – Rader, Gajarsa, Linn - § 112(1) has a written description requirement, but satisfied if teaches how to make & use
 - Concurring – Lourie, Newman, Dyk, - § 112(1) has separate written description requirement

Written Description

- *Amgen, Inc. v. Hoechst*, 314 F.3d 1313 (Fed. Cir. 2003)(Michel, Schall, dissent by Clevenger, JJ)
 - “Traditional” view – generic claims to production of EPO
 - “Section 112 of the patent statute describes what must be contained in the patent specification. * * * Thus, this statutory language mandates satisfaction of two separate and independent requirements: an applicant must both describe the claimed invention adequately and enable its reproduction and use. * * *.”
 - “The purpose of the written description requirement is to prevent an applicant from later asserting that he invented that which he did not; * * *”
 - Disclosure of species sufficient to support claims to genus.
 - Dissent – Clevenger - the “central issue in this case is * * * whether Amgen’s disclosure of one means of producing synthetic EPO in mammalian cells, namely exogenous DNA expression, entitles it to claim all EPO produced by mammalian cells in culture, or all cultured vertebrate cells that produce EPO.”
 - D Ct did not follow *Eli Lilly*.

Written Description

- *Moba, B.V. v. Diamond Automation*, 325 F.3d 1306 (Fed. Cir. 2003)(per curiam)(Rader, Schall & Bryson, JJ)(Concurring opinions by Rader & Bryson)
 - Egg processing machine
 - Claim – “lifting said eggs * * *”
 - No disclosure of such a conveyor mechanism
 - Fed Cir = Not invalid
 - One of ordinary skill could determine inventor possessed invention
- Rader – Concurring – “[a]ny disclosure that enables one to make and use the invention also, by definition, shows that the inventor was in possession of that full invention.”
 - *Ruschig* was wrong – no separate written description
- Bryson – Concurring – was on panel in *Eli Lilly*
 - Whether or not *Ruschig* was wrong, it’s the law.

Written Description

- ***Chen v. Bouchard***, 347 F.3d 1299 (Fed. Cir. 2003) – (J. Lourie – J. Schall, dissenting-in-part opinion by Circuit Judge Newman) – Interference – TAXOL derivatives
 - **Chen – Appl. A – described method – produced certain cmpds – allowed – w/drew from issue b/c discovered method produced different cmpds**
 - **Chen – Appl. B – continuation + App. C – CIP – CIP issued as patent in interference**
 - **Chen – Can rely on Appls. A & B b/c method inherently produces product w/in scope of counts**
 - **Fed. Cir. – NO – no written description of products (J. Newman agrees – dissented on evidence issue)**

Written Description

- *U. of Rochester v. G.D. Searle*, ___ F.3d ___ (Fed. Cir. 2004) – (JJ. Lourie, Bryson & Dyk)
 - COX-1 – cyclooxygenase – provides protection for stomach lining
 - COX-2 – expressed in response to inflammatory stimuli
 - Normal non-steroidal anti-inflammatory drugs (aspirin etc.) inhibit both COX-1 & COX-2
 - Patent – method for selectively inhibiting COX-2
 - Didn't disclose such a compd or how such a compd could be made.
 - Aff'd INVALID – lack of written description
 - Rochester & amici argued – no separate written desc. requirement.
 - Soundly rejected – “our precedent clearly recognizes a separate written description requirement.”

- “Pioneering” Status of Invention Does Not Lower Standard of Enablement

Plant Genetic Sys. NV v. DeKalb Genetics Corp.,
315 F.3d 1335 (Fed. Cir. 2003)

- Herbicide resistant plants
- Flowering plants – monocots (1 leaf) and dicots (2 leaves)
- Accused plants = monocots
- Claims drawn to a “plant cell,” i.e., literally covers both
- All examples in spec = dicots
- Science could not transform monocots until dicots transformed
- D Ct – transforming dicots would have involved “undue experimentation” as of f/d – claims ltd to dicots.
- Aff’d – a “pioneering” patent is not entitled to a lower standard of enablement
- *Hogan* does not alter rule requiring correlation between claim scope and scope of enablement

Enablement

- Claim Construction May Result in a Finding of Lack of Enablement: When An Object of the Preposition “up to” Is Nonnumeric, the Natural Meaning is to Exclude Object – But When the Object is Numeric, the Normal Meaning is to Include the Upper Limit: When a Range is Claimed, the Specification Must be Enabling for Entire Range

AK Steel v. Sollac, 344 F.3d 1234 (Fed. Cir. 2003)

- Hot-dip aluminum-coated stainless steel
- Patent A: “the coating metal consisting essentially of aluminum”
- Spec – “Most hot dip * * * coatings contain about 10% by wt. silicon. * * * We have discovered this type * * * does not wet well * * * Accordingly, silicon contents in the coating metal should not exceed about 0.5% by weight.
- Sollac – mft’d using 8.0%-8.5% silicon
 - Fed Cir – DCt correct in limiting claims to “about 0.5” silicon.”
- Patent B: “up to about 10%”
 - Fed Cir – No enablement

- *CFMT v. YieldUp*, 349 F.3d 1333 (Fed. Cir. 2003) – the claims set the scope of the required enablement
 - Wafer cleaning system
 - Installed system for TI – didn't meet TI standards
 - Add'l efforts to meet standards resulted in patent in suit
 - Claims didn't call for any particular cleaning standard
 - Disclosure sufficient for scope of the claims

Particularly Point Out and Distinctly Claim What the Applicant Regards as His Invention

- Claims That Require a Test or Analysis to Determine Infringement Are Indefinite If The Test or Analysis is Uncertain
 - *Amgen v. Hoechst*, 314 F.3d 1313 (Fed. Cir. 2003)
 - Claims – “A non-naturally occurring [EPO] product * * * having glycosylation which differs from that of human urinary [EPO] * * *.”
 - In 1984, there were available tests for glycosylation
 - But, results differed depending on purification techniques
 - Patent failed to ID single standard for measuring “difference.”
 - Invalid - indefinite

Particularly Point Out and Distinctly Claim What the Applicant Regards as His Invention

- Specification Failing to Describe How to Measure Claim Parameter Leads to Invalidity
 - *Honeywell v. ITC*, 341 F.3d 1332 (Fed. Cir. 2003)
 - Process – production of polyethylene terephthalate (PET) yarn - tires
 - Claims referred to “melting point elevation (MPE)”
 - Spec – one example using specific instrument, but did not explain how to prepare sample
 - Art recognized (1) “coil method,” (2) “cut method,” (3) “restrained method,” (4) “ball method” – Honeywell proprietary, but known in the art.
 - ITC – invalid § 112(2)
 - Fed Cir – Agreed
 - Could be construed “all method” or “any one method”
 - Insolubly ambiguous.

Particularly Point Out and Distinctly Claim What the Applicant Regards as His Invention

- When Indefiniteness is Raised, The Question Becomes Whether One of Ordinary Skill in the Art Would Understand What is Claimed When the Claim is Read in Light of the Specification
 - *B.J. Services v. Halliburton*, 338 F.3d 1368 (Fed. Cir. 2003)
 - Fracturing using viscous fluid
 - Claims – “blending together an aqueous fluid and a hydratable polymer to form a base fluid, wherein the hydratable polymer is a guar polymer having * * * and a C* value * * *.”
 - Halliburton – spec did not disclose how to measure C*
 - Fed Cir – evid that C* could be calculated theoretically or experimentally
 - Fed Cir – accepted BJ Services’ expert testimony

Particularly Point Out and Distinctly Claim What the Applicant Regards as His Invention

- *Bancorp v. Hartford Life*, ___ F.3d ___ (Fed. Cir. 2004)(JJ. Bryson, Rader & Prost)
 - System for tracking value of life insurance policies in separate accounts
 - “surrender value protected investment credits” – not defined in patent & not a term of art
 - D Ct – invalid – indefinite
 - Fed. Cir. – REV’D – “components of the term have well-recognized meanings, which allow the reader to infer the meaning of the entire phrase with reasonable confidence.”

Inequitable Conduct

- WATCH OUT FOR
 - Changing standard of materiality
 - Declarations/Affidavits
 - Naming Inventors

Inequitable Conduct



- The Elements
 - *Materiality*
 - *Intent*

Inequitable Conduct

- **Materiality – Evolving Standard**
 - Pre-1977 – '74 OG Guidelines – Rule 56 (appl. stricken if “fraud”) – Case law (generally related to patentability)
 - 1977 – “reasonable examiner” standard paraphrased from SEC disclosure standard for unsophisticated investors
 - 1982 – Claims may be rejected – appeal to Brd
 - 1983 – Renamed “P/A Statement” to “IDS”
 - 1987 – AIPLA “Blue Ribbon” Committee
 - 1988 – PTO Proposed Rule 57 – “but for” standard
 - 1988 – *Kingsdown & Harita* – PTO disbands “fraud squad” – will not investigate or reject
 - 1989 – Revised Rule 57 proposed – Comm’r Quigg resigns
 - 1990 – Comm’r Manbeck formally w/draws Rule 57
 - 1991 – Draft “new” Rule 56 announced
 - 1992 – “New” Rule 56 eff. March 16, 1992
 - 2000 – Duty to disclose “new” art in CIP

Inequitable Conduct

- “New” Rule 56
 - Applies to applications & reexams pending & filed aft. 3/16/92
 - Duty of disclosure applies to pending claims
 - Duty satisfied if material art is cited by PTO or submitted to PTO
 - Materiality
 - Cumulative art not material
 - *Prima Facie* Standard
 - Claim not patentable
 - Refutes/inconsistent w/ argument or position
 - Preponderance of the evidence standard
 - Terms given broadest reasonable construction
 - Before considering contrary evidence
- CAFC has not expressly adopted/rejected “new” Rule 56
 - D Cts have almost uniformly adopted
 - CAFC recently “strongly suggested” materiality standard of “new” Rule 56 does not apply to IE

Inequitable Conduct ~ Which Standard Controls?

- Only CAFC knows – and they haven't said
 - *Hoffman-La Roche v. Promega*, 323 F.3d 1354 (Fed. Cir. 2003)(J Bryson, SJ Archer, Dissent by J Newman)
 - **Footnote: “new” Rule 56(a) “was not intended to constitute a significant substantive break in the previous standard.”**

Inequitable Conduct ~ Which Standard Controls?

- *Dayco Products v. Total Containment (Dayco II)*, 329 F.3d 1358 (Fed. Cir. 2003)(JJ Dyk, Michel, CJ Mayer)
 - (1) “[t]he new rule reiterated the preexisting ‘duty of candor and good faith,’ but more narrowly defined materiality, providing for disclosure where the information establishes either ‘a prima facie case of unpatentability’ or ‘refutes, or is inconsistent with a position the applicant takes,’ ”
 - (2) “[i]n promulgating the new regulation, the Patent Office noted that: ‘Section 1.56 has been amended to present a clearer and more objective definition of what information the Office considers material to patentability. The rules do not define fraud or inequitable conduct which have elements both of materiality and of intent.’ Duty of Disclosure, 57 Fed. Reg. 2021, 2024 (Jan. 17, 1992),” and

Inequitable Conduct ~ Which Standard Controls?

- *Dayco Products v. Total Containment (Dayco II)*,
Cont'd

- (3) “In response to a comment suggesting that courts might interpret the duty of ‘candor and good faith’ to require more than Patent Office rules require, the Patent Office stated that the rule was ‘modified to emphasize that there is a duty of candor and good faith which is broader than the duty to disclose material information.’”
- “Thus, the extent, if any, to which the Patent Office rulemaking was intended to provide guidance to the courts concerning the duty of disclosure in the context of inequitable conduct determinations is not clear.”
- Footnote: The court’s authority to render a patent unenforceable for inequitable conduct is founded in the equitable principle that “he who comes into equity must come with clean hands.” *Precision Instrument Mfg. and United States v. Am. Bell Tel. Co.*

Inequitable Conduct ~ Which Standard Controls?

- **In Summary:**

- (1) the court’s authority for rendering a patent unenforceable comes from SCt precedent, not PTO rules,
- (2) “new” Rule 56(a) reiterated a “preexisting” (presumably referring to the same SCt precedent) “duty of candor and good faith,”
- (3) “new” Rule 56(a) defines “materiality” narrower than the scope of such “preexisting” duty,
- (4) “new” Rule 56(a) did not, and was not intended to, define “fraud or inequitable conduct,” and
- (5) the PTO acknowledged in adopting “new” Rule 56 that there was a “duty of candor and good faith” that was broader than the duty imposed by “new” Rule 56 to disclose material information, as defined by the Rule.

Legal Ethics & Inequitable Conduct

- “The New Plague” – Truthful Statements Can Nevertheless Lead to Inequitable Conduct
 - *Hoffman-La Roche v. Pro Omega*, 323 F.3d 1354 (Fed. Cir. 2003)(Bryson & SCJ Archer)
 - J. Newman dissent:
 - THE NEW PLAGUE
 - “Of course patent applicants must conduct themselves with honesty and integrity. However, unwarranted charges of inequitable conduct can infect the entire body of invention and inventors. As illustrated in this case, every experiment done and not done, every scientific inference, every judgment or belief, is fair game for opportunistic attack. Such attacks feed upon the complexities of science and technology, and it is rare indeed that some flaw cannot be found. In this case, straightforward scientific and patent activity were distorted until judicial suspicions were raised, despite the absence of any significant error or misstatement. The actions challenged herein, even if viewed in their worst light (whatever that might be) do not establish material misrepresentation and intent to deceive. The need for attention to the burden of proof and its requirement of clear and convincing evidence of both material misrepresentation and deceptive intent, is forcefully illustrated.”

Legal Ethics & Inequitable Conduct

- “The New Plague” – Truthful Statements Can Nevertheless Lead to Inequitable Conduct
 - *Hoffman-La Roche v. Promega*, 323 F.3d 1354 (Fed. Cir. 2003)(J Bryson & SJ Archer)
 - (1) phrasing an example in the specification in the past tense, even though the example performed as described, constituted inequitable conduct, and
 - (2) asserting superiority over the prior art, even if true based on available data, may constitute inequitable conduct.

Legal Ethics & Inequitable Conduct

- Drawing An Application Broadly Can Constitute Inequitable Conduct
 - *Bristol-Myers v. Rhone-Poulenc*, 326 F.3d 1226 (Fed. Cir. 2003)(JJ Prost, Clevenger & Schall)
 - D Ct “Mr. Pilard [a French patent agent working for RPR, as explained further below] intentionally drew the 011 patent more broadly than warranted by the information in his possession; * * * and none of his attempted justifications for not disclosing the JACS article are grounds for not supplying the JACS article to the examiner nor were they credible. The only conclusion that can be drawn is, and the Court finds by clear and convincing evidence that, Mr. Pilard intentionally withheld the JACS article from [U.S. counsel] and the U.S. Patent and Trademark Office in an attempt to mislead the patent examiner.”
 - CAFC – Aff’d

Legal Ethics & Inequitable Conduct

- Drawing An Application Broadly Can Constitute Inequitable Conduct (Cont'd)

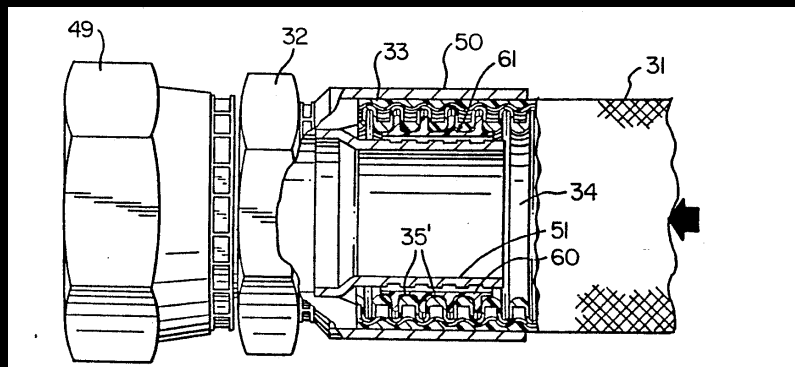
- *Bristol-Myers v. Rhone-Poulenc – Cont'd*

- Original & Reissue patents – synthesis of Taxol – cancer drug
- Inventors – draft JACS article to Pilard (RPR Fr patent agent) – recommends French app.
- Two footnotes – problems with two cmpds – MOM & TMS
- French App & U.S. App – Disclosure includes MOM and TMS w/in groups – does not specifically exclude
- U.S. Claims – broad claims – generic (MOM & TMS and other cmpds)
- Dependent claims – specific cmps – includes MOM & TMS
- JACS article not disclosed until reissue
- CAFC – material b/c bears on enablement
- BUT – even broad claims held enabled – no undue experimentation

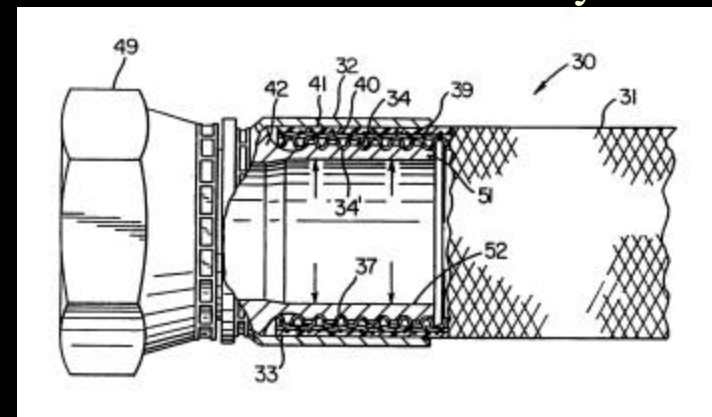
Legal Ethics & Inequitable Conduct

- (1) Information Concerning Co-Pending Applications Having Similar Subject Matter and Patentably Indistinct Claims is Material Information
- (2) Rejection of “Substantially Similar” Claim is “Material” Information
 - *Dayco Products v. Total Containment (Dayco II)*
 - Two “families” of applications:

Patent in Suit



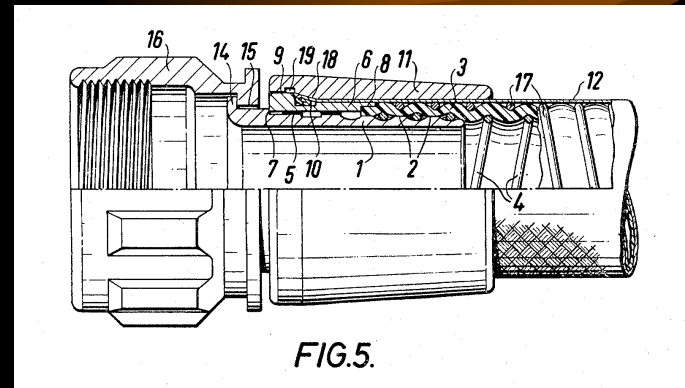
'196 Family



Legal Ethics & Inequitable Conduct

Wilson

- *Dayco Products v. Total Containment (Dayco II)*
 - (1) Failure to disclose pending similar application – material – double patenting – but here no showing of intent
 - (2) Failure to disclose Wilson – might be material – d ct hadn't evaluated
 - (3) Rejection of “substantially similar” claims – material, but d ct hadn't evaluated intent



“Although examiners are not bound to follow other examiners’ interpretations, knowledge of a potentially different interpretation is clearly information that an ex’r could consider important when examining an application.”

Legal Ethics & Inequitable Conduct

- *Phonometrics v. Economy Inns of America*, 349 F.3d 1356 (Fed. Cir. 2003)(JJ. Michel & Rader, dissent by J. Newman)
 - Attorney sanctioned for continuing to press infringement litigation after losing claim construction ruling in earlier case.

Claim Construction

- **WATCH FOR**

- Increased emphasis on art recognized “ordinary meaning” of claim terms
 - Increased reliance on dictionaries/treatises for “ordinary meaning”
- Refusal to limit claims to disclosed embodiment(s), unless clear statements that invention is so limited.
- May be ltd to spec when claim is “ambiguous”
- BUT some judges rebelling – claims should be ltd to actual invention

Claim Construction

- *Johnson Worldwide v. Zebco* 1999
- *Renishaw v. Marposs* 1998
 - Focus on “ordinary meaning” of the claims
- **Trend – 1997 – most of 2001 – limit claims b/c of written description**
 - *Wang Labs. v. AOL*
 - *SciMed v. Advanced Cardiovascular Systems*
 - *Netword v. Centraal Corp.*
 - *Toro v. White Consolidated*
 - *Bell Atlantic v. Conrad*
- **Trend – 2002-2003?**
 - *CCS Fitness, Inc. v. Brunswick Corp.*
 - *Teleflex, Inc. v. Ficosa North America Corp.*
 - *Texas Digital v. Telegenix*
 - **Refocus on “ordinary” meaning**

Claim Construction

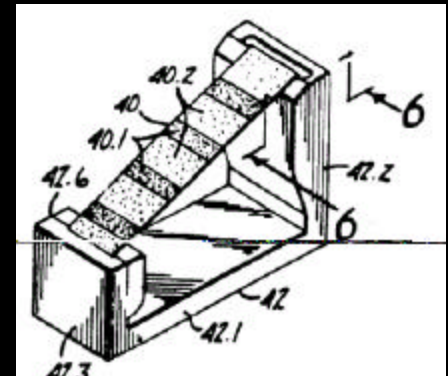
- *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359 (Fed. Cir. 2002)(Michel, Mayer, Lourie, JJ.)
 - Claim term will be given its ordinary meaning unless:
 - The patentee acted as his own lexicographer,
 - Intrinsic evidence shows that patentee expressly disclaimed subject matter, or
 - The term chosen by the patentee so deprives the claim of clarity that resort to other intrinsic evidence is required.

Claim Construction

Dictionary Definitions Control Meaning of “Non-Diffusively Bound” & “Non-Diffusively Immobilized”

Abbott Labs. v. Syntron, 334 F.3d 1343 (Fed. Cir. 2003)

- Claims – non-diffusively immobilized reactant in each reaction zone.
- DCT – “only if it is bound in such a manner that a sufficient and reproducible amount of reactant remains bound in the reaction zone to conduct quantitative and qualitative assays.”
- Fed Cir – Rev’d – relying on dictionary definitions – “a chemical or physical combination of the reagent and the medium such that the reagent does not dissolve and move within the liquid * * *.”



Claim Construction

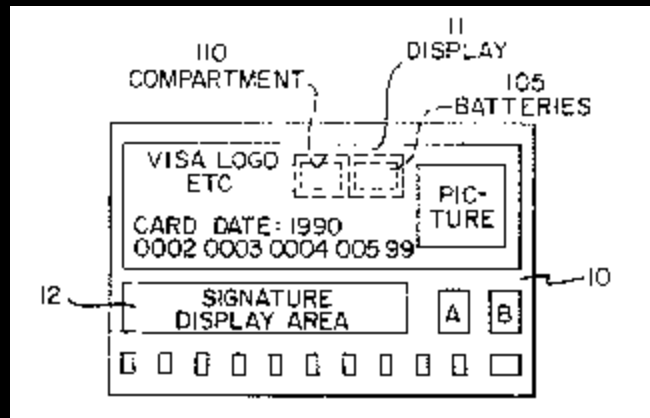
- *Arlington Indus., Inc. v. Bridgeport Fittings, Inc.*, ___ F.3d. ____ (Fed. Cir. 2003)(J. Linn & SCJ Archer – concurring-in-part & dissenting-in-part J. Dyk
 - Electrical box extenders
 - Wings on the box claimed as “capable of flexing”
 - Bridgeport – claims should be ltd to “cantilever flexing”
 - Fed Cir = dictionary definition of “flex” means “to bend.”

Claim Construction



- In Determining Whether a Statement in the Specification is Lexicographic, Must Determine Whether Intended to Define Invention

Claim Construction



The multi-function card is an electronic card or computer card which contains, in electronically stored form, not only the data of one card, but rather data sets of all cards held and used by a given person, it being possible without any problem, by simple external manipulations, to convert the multi-function card into a specific card virtually at the moment when the latter is needed.

E-Pass v. 3Com, 343 F.3d 1364 (Fed. Cir. 2003) – JJ. Dyke, Cleverger & Linn

“an electronic multi-function card”

Spec – “[p]articular advantages are provided by the simple form of the electronic multi-function card which has the outer dimensions of usual credit or check cards.”

DCt ltd claims to credit card dimensions

Fed Cir – error – statements in specification only preferred embodiment.

Claim Construction

- *Kumar v. Ovonic Battery Co.*, 351 F.3d 1364 (Fed. Cir. 2003)
 - *Definition of term in highly pertinent p/a patent discussed during prosecution may trump dictionary definition term*
 - “amorphous rare earth-transition metal alloy” used to store hydrogen in nickel metal hydride batteries
 - Ovonic – “amorphous” – means completely uncrystallized
 - Polk patent – “amorphous” – includes partially crystalline alloys
 - Polk patent definition should control unless spec or prosecution history indicates otherwise.

Claim Construction

- *Ferguson Beauregard/Logic Controls v. Mega Sys., LLC*, 350 F.3d 1327 (Fed. Cir. 2003)(JJ. Linn & Dyk – concurring opinion by J. Rader)
 - “normal plunger performance”
 - Applied dictionary definition of “normal” – “standard or regular and not in need of correction”
 - J. Rader
 - *Focusing on customary w/ less emphasis on ordinary*
 - *Customary meaning links the inquiry to one of ordinary skill in the art*
 - *Combined Systems v. Defense Tech.* (2003) J. Michel – emphasized that “ordinary meaning” was shorthand for connotation to a person of ordinary skill in the art

Claim Construction

- Claims Not Limited By “Objects” in the Specification
 - *SunRace v. SRAM*, 336 F.3d 1298 (Fed. Cir. 2003)
 - Bicycle “twist shifters”
 - Apparatus claims limited to “cams”
 - Method claims not so limited
 - DCt ltd claims to using “cams.”
 - Fed Cir – Rev’d – Specification simply a description of a preferred embodiment.
 - *Resonate, Inc. v. Alteon Websystems*, 338 F.3d 1360 (Fed. Cir. 2003)– “load balancing” on servers
 - Same

Claim Construction

- Canon That Claims Should Be Construed To Preserve Validity Applies Only If Scope Is Ambiguous
 - *Liebel-Farsheim v. Medrad*, ___ F.3d ___ (Fed. Cir. 2004)(JJ Bryson, Lourie & Dyk)
 - Powered fluid injectors – inject fluids (contrast fluids) into patients
 - Specification – pressure jacket around injectors
 - During prosecution – removed pressure jacket limitation from some claims – knew of Medrad devices
 - D Ct – read pressure jacket limitation into claims based on spec.
 - Fed Cir – rev'd – spec does not say pressure jacket is req'd component
 - Ct has rejected contention that claims ltd to single embodiment
 - Claims not ambiguous – issue of validity must be addressed head-on.

Claim Construction

- Canon That Claims Should Be Construed To Preserve Validity Applies Only If Scope Is Ambiguous
 - *Chef America v. Lamb-Weston*, ___ F.3d ___ (Fed. Cir. 2004)(SCJ Friedman, JJ. Rader & Schall)
 - “heating the resulting batter-coated dough to a temperature in the range of about 400 F to 850 F.”
 - ? Dough heated to that temp OR temp of the oven
 - Spec – oven temp 400-850 F – dough in for 10 sec. to 5 min.
 - Object – flaky texture
 - Dough at that temp would be charcoal briquet
 - CA – claim should be read “at” rather than “to”
 - Fed Cir – NO – “courts may not redraft claims, whether to make them operable or to sustain their validity.”

Claim Construction

- Antecedent Basis May Impose Limitations
 - *Warner v. Ford*, 331 F.3d 851 (Fed. Cir. 2003)(Senior Judge Archer, joined by JJ. Newman and Michel)
 - Fender liner
 - Claims called for “an elongated flat panel * * * with an inboard side flange, said flat panel * * * suited to be installed.”
 - Infringement turned on whether panel had to have flange before installation.
 - Fed Cir – Yes – “said flat panel” referred to “an elongated flat panel” which was recited as having a flange.

Claim Construction

- Claim Terms Must Be Read in Context of Surrounding Language
- Dictionary Definitions Alone Not Decisive
 - *Brookhill-Wilk v. Intuitive Surgical*, 334 F.3d 1294 (Fed. Cir. 2003)
 - Surgical robots – “remote location”
 - “While certain terms may be at the center of the claim construction debate, the context of the surrounding words of the claim also must be considered in determining the ordinary and customary meaning of those terms.”
 - “Our precedent referencing the use of dictionaries should not be read to suggest that abstract dictionary definitions are alone determinative. In construing claim terms, the general meanings gleaned from reference sources, such as dictionaries, must always be compared against the use of the terms in context, and the intrinsic record must always be consulted to identify which of the different possible dictionary meanings is most consistent with the use of the words by the inventor.”

Claim Construction

- *Glaxo Wellcome, Inc. v. Andrx Pharms., Inc.*, 344 F.3d 1226 (Fed. Cir. 2003)(J. Newman, Bryson, CJ Mayer)
 - *When claim terms has accepted scientific meaning, that meaning is generally not subject to restriction to the specific examples in the specification*
 - Controlled release agent – hydroxypropyl methylcellulose – HPMC
 - Spec disclosed specific HPMC from Dow Chemical
 - Andrx expert – one of ordinary skill would understand that HPMC must be high-viscosity and hydrogel-forming.
 - Fed Cir – HPMC not ltd to any grade or molecular weight

Claim Construction

- Statements in “Request for Comments” by Standards Setting Organization That Do Not Reflect Common Usage, But Rather Assign Language to Facilitate Further Conversation Are Not Authoritative
 - *ACTV, Inc. v. Walt Disney Co.* – 2003 – J. Linn - SCJJ. Friedman & Plager
 - Integrating Internet content w/ TVs
 - Claims referred to URLs - ? Whether “absolute” or “relative” URL
 - “Absolute” –
<<http://www.fedcir.gov/november/cases/disney.html>>
 - “Relative” – <disney.html>
 - ACTC – W3C RPC 1808 – discusses both types of URLs
 - Disney – W3C RPC 1738 – only “absolute” URL

Claim Construction

ACTV, Inc. v. Walt Disney Co. – Cont'd

- “The purpose of the RFCs is thus to collect commentary and to select language to facilitate a common understanding, or to select a standard, from a variety of competing technologies and vocabularies and from a variety of potentially competing interests. * * * This purpose is in sharp contrast to the role of dictionaries and treatises, which aim not to select or give meaning to a word or phrase, but to report the meaning already established and commonly understood by those skilled in the art.”

Claim Construction

- *Merck & Co. v. Teva Pharms., Inc.*, 347 F.3d 1367 (Fed. Cir. 2003)(JJ Newman, Prost, dissent by CJ Mayer)
 - *Patents are not written for laymen, but for and by persons experienced in the field of invention*
 - Method of treating osteoporosis by administering alendronic acid
 - Claims called for alendronic acid
 - Teva – ANDA – no inf – use salt form
 - Spec referred to both acid form and salt form
 - Claims construed to cover both
 - CJ Mayer – dissent – “acid” does not mean “salt”

Claim Construction – Lt'd by Spec

- Where the Specification Makes Clear That the Claimed Invention is Narrower Than the Claim Language Might Imply, It is Permissible and Proper to Limit the Claims

– *Alloc v. ITC*, 342 F.3d 1361 (Fed. Cir. 2003)(J. Rader, joined by J. Michel, dissent by J. Schall)

- Method of joining floor panels
- Claims called for “locking element.”
- None of the claims called for “play”
 - Panel majority – read in light of the specification, proper to read “play” into the claims
- Dissent – majority violated rule against reading limitations into the claims.

Claim Construction – Lt'd by Spec

- *Combined Sys., Inc. v. Defense Tech Corp. of Am.*, 350 F.3d 1207 (Fed. Cir. 2003)(J. Michel – CJ Mayer & J. Bryson)
 - Low lethality shotgun projectiles
 - “forming folds in said tubular sock-like projectile body”
 - Required deliberate formation of folds
 - Not satisfied if folds simply occur when placed in shell

Claim Construction – Lt'd by Spec

- *Microsoft v. Multi-Tech Sys.* ___ F.3d ___ (Fed. Cir. 2004)(JJ. Lourie & Bryson – dissent by J. Rader)
 - J. Lourie and Bryson on panel in *Liebel-Farsheim v. Medrad*
 - Systems for sending voice and data from PC
 - ? “sending” “transmitting” “receiving” ltd to POTS or whether includes packet switched network
 - Majority – ltd to POTS
 - Claims not so ltd BUT
 - Spec refers to communication “over” telephone lines
 - Prosecution – argued that “invention” uses POTS
 - J. Rader – Claims do not rule out Internet/Spec doesn't either/No “disclaimer” during prosecution.

Claim Construction – Split Among Court

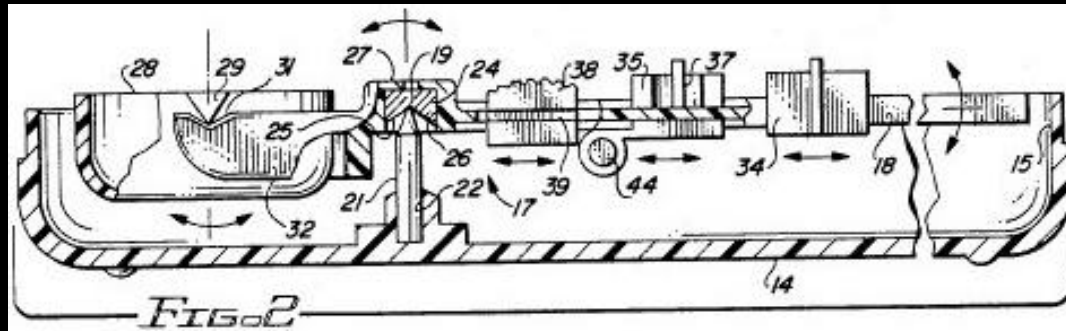
- Split Among Court – Literal Meaning v. Meaning in Light of Spec & Knowledge of Artisan
 - *Superguide Corp. v. DirecTV*, ___ F.3d ___ (Fed. Cir. 2004)(J. Prost & CJ Mayer – dissent by J. Michel)
 - Interactive program guides
 - “regularly received television signal”
 - f/d 1985 – issued 1988 – TV’s analog
 - *Kopykake v. Lucks* (2001) – “conventional screen printing” – inkjet not “conventional” for cakes
 - Artisan’s aware of digital data even though TVs were analog
 - Plain claim language not ltd to analog
 - J. Michel – dissent – “Despite *** references to the “plain” *** meaning *** our precedent requires that the correct meaning of claim terms is that determined from the standpoint of a person of ordinary skill in the relevant art and at the time of the patent.”

Claim Construction

- Where Reasons for Allowance Repeat Applicant's Arguments – May Limit Claims
 - *Bell Atlantic v. Covad* (2001) - no obligation to respond to an examiner's Reasons for Allowance, thus does not necessarily limit claims
 - *ACCO Brands, Inc. v. Micro Security Devices* – 2003 – J. Newman – JJ. Rader & Dyk)
 - PC lock
 - “a pin * * * for extending into said security slot * * * when said slot engagement member is in said locked position * * *”
 - ? – extended before or after moved to locked position
 - DCt – after – Fed Cir – AGREES
 - Reasons for Allowance - claims req'd pin be extended after slot engagement member was in locked position.
 - Fed Cir – no reason to respond BUT here repeated arguments.

Claim Construction – Claims Ltd by Spec

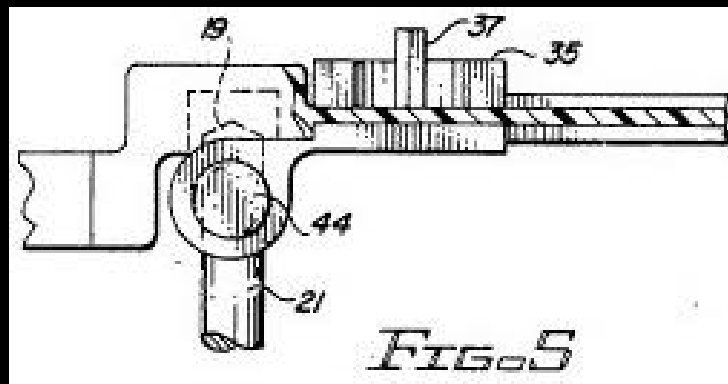
- When A Term [“Substantially”] Has Multiple “Ordinary” Meanings, It Is Proper To Resort To Intrinsic Record
 - *Deering Precision Instruments v. Vector Distribution* – 2003 – J. Gajarsa JJ. Bryson & Prost
 - Pocket scale - up to 10 g.



Claim Construction – Claims Ltd by Spec

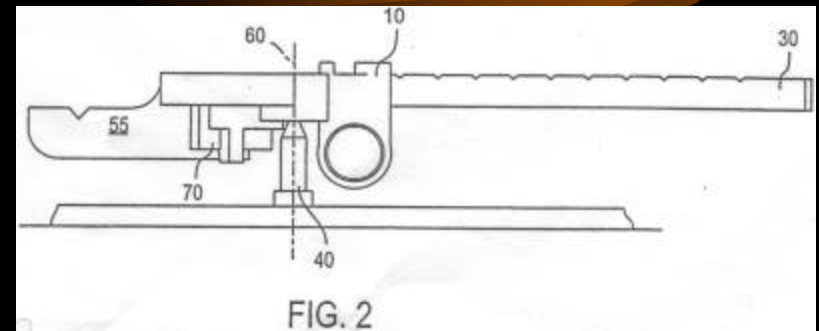
– Deering Precision Instruments v. Vector Distribution – Cont'd

- Weight 35 minimized weight of scale – moved center of mass to plane created by fulcrums
- Metallic insert 44 offset from pointer 37 - disposed “substantially in the plane” of fulcrum 19 when in zero position



Claim Construction – Claims Ltd by Spec

- *Deering Precision Instruments v. Vector Distribution* – Cont'd
 - Accused device
 - Metallic insert not offset



Deering “substantially in an imaginary plane” meant “at or near the imaginary plane.”

Fed Cir – “substantially” – (1) approximate, or (2) magnitude

Specification – used to connote magnitude

No infringement

Claim Construction – Claims Ltd by Spec

- If a Claim Term is Deemed Ambiguous, Term May be Limited by the Specification
 - *Genzyme Corp. v. Transkaryotic Therapies* – 2003 – J. Rader – J. Schall – Dissent-in-part – J. Linn
 - Method of producing human α -galactosidase A (α -Gal A) - used in enzyme therapy
 - “chromosomally integrated” – DCt – Lt’d to exogenous sequences
 - TKT – used gene promoter – endogenous
 - J. Rader – “integrated” could be either – ambiguous
 - Spec – always exogenous – claims so limited
 - J. Linn – “integrated” not ambiguous – simply covers both

Claim Construction

- In Cases Involving Unpredictable Technology, More Likely Claims Will Be Restricted by Specification
 - *Biogen v. Berlex Labs.*, 318 F.3d 1132 (Fed. Cir. 2003)
 - Recombinant DNA technology for producing human interferon
 - Claims were not per se limited to using a single DNA construct to introduce both a marker gene and a human interferon gene
 - CAFC – claims so limited b/c of examples given in specification.

Claim Construction

- If Claim Term Has No Meaning, Then Term is Limited By Intrinsic Record
 - *Altiris v. Symantec*, 318 F.3d 1363 (Fed. Cir. 2003)(J. Michel, joined by JJ. Lourie and Linn)
 - Method of intercepting and controlling boot process.
 - Claims – “automation code”
 - Dictionary definitions of “automation” and “code” – so broad as to lack meaning
 - “here the patentee chose a phrase that ‘so deprives the claim of clarity as to require resort to the other intrinsic evidence for a definite meaning.’”
 - Claim properly limited to preferred embodiment.

Claim Construction



- **Prosecution History**
 - “Prosecution Disclaimer” Added to Lexicon
 - Erroneous arguments may not limit the claims

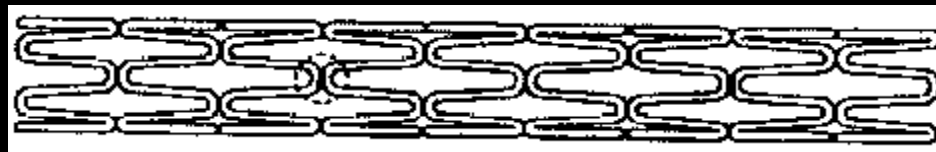
Claim Construction – Prosecution History

- “Prosecution Disclaimer” Added to Lexicon
 - *Omega Eng. v. Raytek*, 334 F.3d 1314 (Fed Cir. 2003)
 - Precludes patentee from recapturing through claim interpretation specific meanings disclaimed during prosecution.
 - Laser sighting for infrared thermometers
 - Prosecution – argued over p/a that invention did not add appreciable heat to center of energy zone.
 - Claims so limited.

Claim Construction – Prosecution History

- “Prosecution Disclaimer” Requires Clear Surrender
 - *Cordis v. Medtronic*, 339 F.3d 1352 (Fed Cir. 2003)
 - Stent – “plurality of slots formed therein”
 - Prosecution: “[in the p/a] there is no wall surface having a plurality of slots * * *”
 - Fed Cir – Cannot be read to disclaim any device not having pre-existing wall

Accused Device



Claim Construction – Prosecution History

- Erroneous Arguments – Limiting?
 - *Biotech Biologische v. Biocorp*, 249 F.3d 134 (Fed. Cir. 2002)
 - If error apparent to the reader, then not limiting
 - *Rambus v. Infineon*, 318 F.3d 1081 (Fed. Cir. 2003) – Incorrect statement does not govern meaning of the claims
 - *Storage Tech. v. Cisco*, 329 F.3d 832 (Fed. Cir. 2003) – “Inaccurate” statement cannot override the claim language
 - *Springs Window v. Novo Indus*, 323 F.3d 989 (Fed. Cir. 2003)
 - If error not apparent, then limiting

Claim Construction – Prosecution History

- **Correcting Errors in Claims**

- *Novo Indus. v. Micro Molds*, 350 F.3d 1348 (Fed. Cir. 2003)(JJ. Dyk, Clevenger & Gajarsa)

- Carrier assembly for window blinds
- “stop means formed on a rotatable with said support finger”
- D Ct – “stop means formed on and is rotatable ***.”
- Fed. Cir. – a D Ct has no authority to correct a claim unless “(1) the correction is not subject to reasonable debate ***, and (2) the prosecution history does not suggest a different interpretation ***.”
- Here – Novo had suggested 2 diff interpretations – thus D Ct erred in “correcting.”

Construction of Means- and Step-Plus-Function Limitations



- **WATCH OUT FOR**
 - “means plus function” and “step plus function”
 - Generally, but not always, construed narrower
 - May be used to avoid dedication issue
 - If used, check for spec support

Construction of Means- and Step-Plus-Function Limitations

- *Northrop Grumman v. Intel*, 325 F.3d 1346 (Fed. Cir. 2003)
 - Structure is “corresponding” structure only if it is clearly linked or associated with the function recited in the claims
 - “Corresponding structure” must actually perform the recited function, not merely enable pertinent structure to perform the recited function

Construction of Means- and Step-Plus-Function Limitations

- When Disclosed Structure is a General Purpose Computer, The “Structure” Is Not The Computer, But a Computer Programmed to Perform the Disclosed Algorithm
 - *Tehrani v. Hamilton Med.*, 331 F.3d 1355 (Fed. Cir. 2003)
 - Apparatus and method for controlling respirator.
 - “means for processing * * *.”
 - Remanded to determine what algorithm was being performed.
 - *WMS Gaming v. Int’l Game Tech.*, 184 F.3d 1339 (Fed. Cir. 1999)

Construction of Means- and Step-Plus-Function Limitations

- District Court Erred in Including S/W Within “Corresponding Structure” When Specification Did Not Clearly Link Software to Claimed Function
 - *Med. Instr. & Diagnostics v. Elekta AB*, 344 F.3d 1205 (Fed. Cir. 2003)(J. Clevenger, joined by Judge Schall, dissent by J. Newman)
 - System for planning brain surgery
 - “means for converting said plurality of images into a selected format” + “means for storing” etc.
 - Majority – not clear that s/w was part of “structure.”
 - J. Newman – whole system was computer based – spec included microfiche with programs.
 - Claim 8 “The invention of claim 1 wherein all said means are software programmable.”

Construction of Means- and Step-Plus-Function Limitations

Written Description and Definiteness Issues - §112(1), (2)

- Failure to Disclose Structure for Performing the Claimed Function Leads to Invalidity Under §112(2)
 - *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106 (Fed. Cir. 2002) Two functions - “for monitoring” and “for charging.”
 - Spec: “for monitoring” = physician
 - Physician not a “structure”
 - *Creo Prods., Inc. v. Presstek, Inc.*, 305 F.3d 1337 (Fed. Cir. 2002)
 - Knowledge of one of ordinary skill in the art may be relied upon to provide an understanding of what “structure” was disclosed.
 - Expands *Budde v. Harley-Davidson, Inc.*, *S3 Inc. v. nVIDIA Corp. & Atmel Corp. v. Info. Storage Devices, Inc.*
 - *Intel v. VIA Techs.*, 319 F.3d 1357 (Fed. Cir. 2003)
 - Claims are not indefinite because no specific circuitry or no specific device is disclosed – specific structure may be left to one of ordinary skill in the art.



Infringement

- **WATCH OUT FOR**
 - **Implied Licenses**

Infringement – Implied License

- The Unrestricted Sale of Component “A”, Not Separately Patented, Having No Substantial Non-Infringing Uses Other Than in Combination With Component “B” Grants an Implied License to The Combination
 - *Anton/Bauer v. PAG*, 329 F.3d 1343 (Fed. Cir. 2003)
 - Batteries for video cameras
 - Claims covered both male and female plates
 - Anton/Bauer sold female plates to Sony et al.
 - Accused device had male plate
 - Fed Cir - “[t]he sale of the unpatented female plate by Anton/Bauer is a complete transfer of the ownership of the plate. In effect, the sale extinguishes Anton/Bauer’s right to control the use of the plate, because the plate can only be used in the patented combination and the combination must be completed by the purchaser.”
 - “by the unrestricted sale of the female plate, Anton/Bauer grants an implied license to its customers to employ the combination claimed in the ‘204 patent. Accordingly, there is no direct infringement to support a claim of either inducement of infringement or contributory infringement.”

Infringement Under Doctrine of Equivalents

- The “All Elements” Rule May Result in a Limitation Having No Equivalents
 - *Lockheed v. Space Systems*, 324 F.3d 1308 (Fed. Cir. 2003)
 - Limitation [b] - “means for rotating said wheel in accordance with a predetermined rate schedule which varies sinusoidally over the orbit at the orbital frequency of the satellite * * *.”
 - The structure corresponding to that “means” - sine generator and certain wheel electronics.
 - Construction - “wheel” must slow to zero, stop, and then reverse direction.
 - The accused system did not do so.
 - No infringement under the “all elements” rule.
 - “In the absence of an element that performs the properly construed functions, a finding of infringement under the doctrine of equivalents would entirely vitiate the limitations of limitation [b]. Consequently, limitation [b] or its equivalent is simply not present in the accused device. Accordingly, there can be no infringement under the doctrine of equivalents.”

Prosecution History Estoppel

- *Warner-Jenkinson* Presumption
 - If no explanation is given for claim amendment, the court should presume that the PTO had a substantial reason related to patentability for requiring amendment and therefore estoppel should apply.

Prosecution History Estoppel

- Amending a Claim Through Inadvertence is No Excuse
 - *Pioneer Magnetics v. Micro Linear*, 330 F.3d 1352 (Fed. Cir. 2003)
 - Fed Cir –
 - First step – determine whether amendment narrowed literal scope of the claim
 - Second step – determine why applicant narrowed claim
 - Burden is on applicant
 - If no reason, *Warner-Jenkinson* presumption applies
 - Declaration by prosecuting attorney – irrelevant
 - “only the public record of the patent prosecution * * * can be the basis for such reason.”

Prosecution History Estoppel

- *Festo VIII* – SCt

- Estoppel arises from amendments that narrow claim scope to satisfy any requirement of the patent statute.
- Narrowing amendment creates a rebuttable presumption of estoppel
- Rebuttal if -
 - ✓ [1] equivalent was unforeseeable
 - ✓ [2] amendment has only tangential relationship to equivalent
 - ✓ [3] some other reason why patentee could not have been reasonably expected to cover equivalent literally

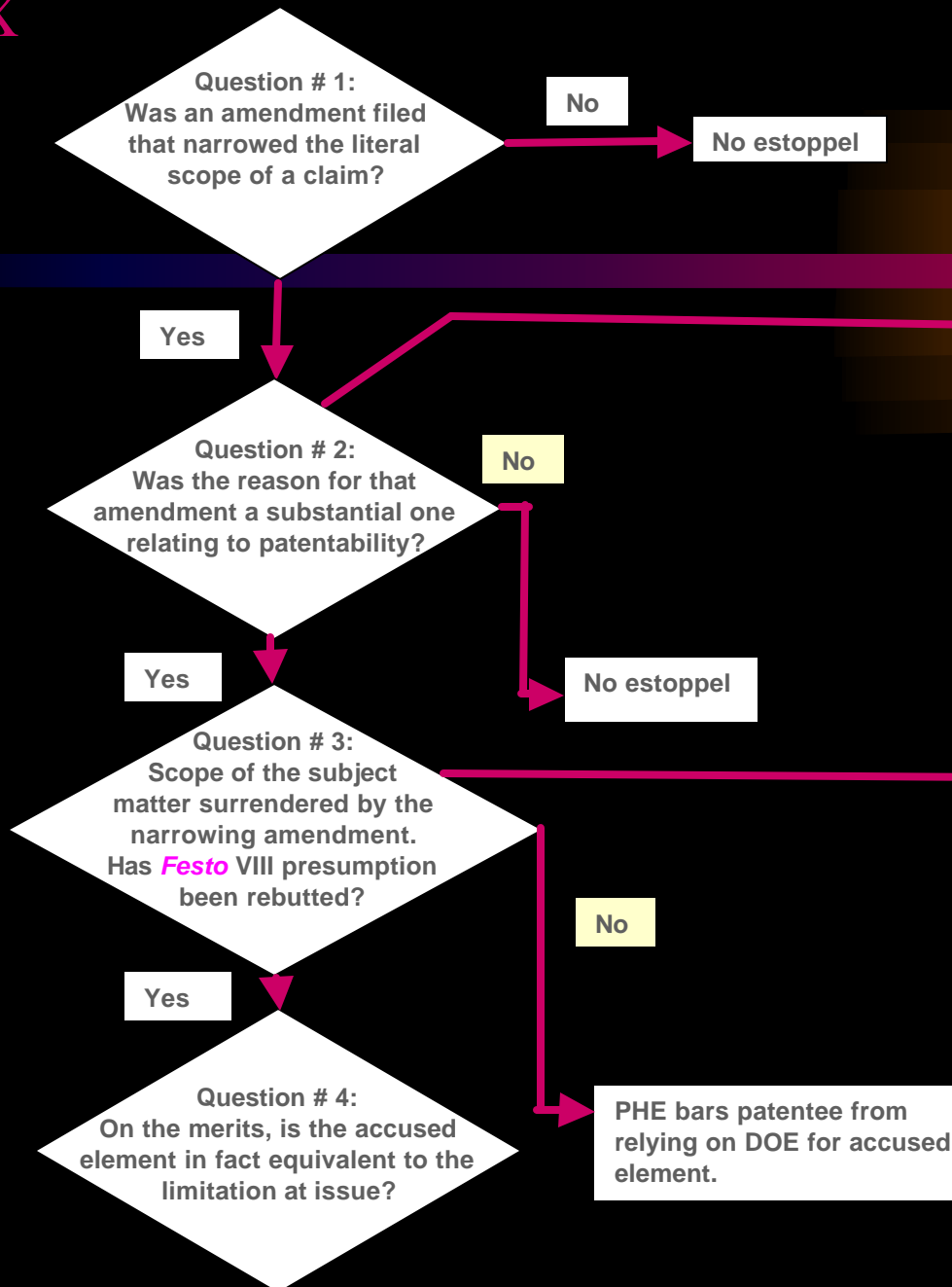
Prosecution History Estoppel

- *Festo IX* – Fed Cir
 - Asked parties to brief:
 - Whether rebuttal of the presumption of surrender, including issues of foreseeability, tangentialness, or reasonable expectations of those skilled in the art, is a question of law or one of fact; and what role a jury should play in determining whether a patent owner can rebut the presumption.
 - What factors are encompassed by the criteria set forth by the Supreme Court.
 - 2 other questions specific to the case.

Prosecution History Estoppel

- *Festo* IX – Fed Cir - Restated holdings unaffected by *Festo* VIII:
 - Narrowing amdt to comply w/ any provision of Patent Act (i.e, § 112) may create estoppel.
 - “Voluntary” amdt may create estoppel.
 - *Warner-Jenkinson* presumption continues.
 - Failure to overcome *WJ* presumption leads to new *Festo* presumption.
 - Presumption - scope between original and amd’d limitation has been surrendered – rebuttable presumption

Festo IX



1. When the prosecution history record reveals no reason for the narrowing amendment, *Warner-Jenkinson* presumes that the patentee had a substantial reason relating to patentability; consequently, the patentee must show that the reason for the amendment was not one relating to patentability if it is to rebut that presumption.

2. A patentee's rebuttal of the *Warner-Jenkinson* presumption is restricted to the evidence in the prosecution history record.

1. *Festo VIII* imposes the presumption that the patentee has surrendered all territory between the original claim limitation and the amended claim limitation.

2. The patentee may rebut that presumption of total surrender by demonstrating that it did not surrender the particular equivalent in question.

Prosecution History Estoppel

- *Festo* IX – Fed Cir – Answers to Questions
 - Whether rebuttal of the presumption of surrender, including issues of foreseeability, tangentialness, or reasonable expectations of those skilled in the art, is a question of law or one of fact; and what role a jury should play in determining whether a patent owner can rebut the presumption.
 - ✓ **ANSWER:** “rebuttal of the presumption of surrender is a question of law to be determined by the court, not a jury.”
 - What factors are encompassed by the criteria set forth by the SCt?
 - ✓ **ANSWER:** The SCt identified three ways in which the patentee may overcome the presumption - (a) foreseeability, (b) tangentialness, and (c) “some other reason.”

Prosecution History Estoppel

- *Festo* IX – Fed Cir – Guidelines
 - **Foreseeability**
 - (1) it is an objective enquiry, *i.e.*, whether the inventor or the prosecuting attorney was aware of the alleged equivalent is not decisive;
 - (2) later-developed technology will “usually” be deemed not foreseeable;
 - (3) “old” technology will “more likely” be deemed foreseeable, and “certainly should have been foreseeable” if the alleged equivalent was known in the prior art in the field of the invention; and
 - (4) because the issue is factual, the district court may hear expert testimony and may consider extrinsic evidence.

Prosecution History Estoppel

- *Festo* IX – Fed Cir – Guidelines
 - Tangentialness – Basically (1) Done Objectively, and (2) If to avoid p/a, then almost certainly not “tangential.”
 - (1) “an amendment made to avoid prior art that contains the equivalent in question is not tangential; it is central to allowance of the claim,”
 - (2) “much like the inquiry into whether a patentee can rebut the *Warner-Jenkinson* presumption that a narrowing amendment was made for a reason of patentability, the inquiry into whether a patentee can rebut the *Festo* presumption under the ‘tangential’ criterion focuses on the patentee’s objectively apparent reason for the narrowing amendment,”
 - (3) “that reason should be discernible from the prosecution history record, if the public notice function of a patent and its prosecution history is to have significance,” and
 - (4) “whether an amendment was merely tangential to an alleged equivalent necessarily requires focus on the context in which the amendment was made; hence the resort to the prosecution history”

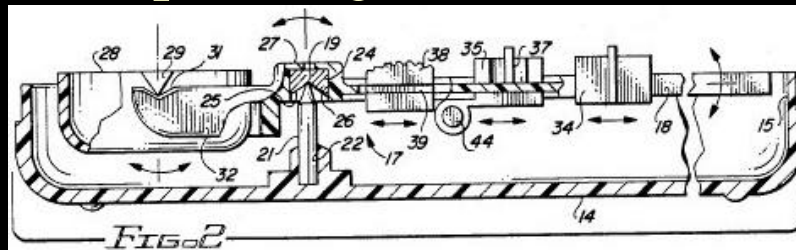
Prosecution History Estoppel



- *Festo* IX – Fed Cir – Guidelines
 - Some Other Reason
 - Narrow
 - Available just to not foreclose other reasons

Prosecution History Estoppel – Post Festo IX

- (1) Presenting a New Independent Claim Resulting From Rewriting a Dependent Claim as an Independent Claim Results in a Narrowing Amendment Even Though the Scope of the Dependent Claim Was Not Changed, (2) Prosecution History Estoppel and the *Festo* VIII Presumption Applies, and (3) Unamended Claims Containing The Same Limitation as the Dependent Claim Are Subject to the Same Estoppel and Presumption
 - *Deering Precision Instruments v. Vector Distribution* – 347 F.3d 1314 (Fed. Cir. 2003) – J. Gajarsa JJ. Bryson & Prost
 - Pocket scale - up to 10 g.



Prosecution History Estoppel – Post Festo IX

- *Deering v. Vector Distribution* – Cont'd
 - Claim 11 narrower than claim 1 – Festo IX applies
 - Claim 9 – Festo IX applies b/c same limitation – *Builder's Concrete*
 - “Deering's addition of independent claim 11, coupled with the clear surrender of the broader subject matter of the deleted original independent claim presumptively bars Deering from arguing infringement under the doctrine of equivalents. * * * Here, the patentees clearly disclaimed the territory between the original claim 1 and new claim 1 as issued.”

Orig. Appl.

Claim 1 - No Zero Position Limitation

Claim 3 – Dep from cl. 1 – Zero Position Limitation

Claim 9 – Zero Position Limitation

Rej. – Claims 1 & 9
Obj. – Claim 3

Amdt

Claim 11 (Claim 1 + Claim 3) = Patent Claim 1

Claim 9 = Patent Claim 4

Prosecution History Estoppel – Post Festo IX

- *Deering v. Vector Distribution* – Cont'd
 - “While Deering argues that it merely rewrote an allowable original claim 3 in independent form, there is no question that the claim was narrowed by the deletion of a broad original claim in favor of a claim that contained the Zero Position Limitation. Because the amendment in this case is not ‘truly cosmetic,’ estoppel presumptively applies.”
 - Re claim 9 – “Additionally, this presumption applies to all claims containing the Zero Position Limitation, regardless of whether the claim was, or was not, amended during prosecution. * * * Here, as in *Builders Concrete*, independent claim 4 contained the disputed limitation and was never amended during prosecution. Nevertheless, it is clear from the prosecution history that the allowance of claim 1, the broadest claim, depended on the amendment narrowing the Zero Position Limitation to that of a dependent claim. Since independent claim 4 and dependent claim 5 contain the Zero Position Limitation, prosecution history estoppel presumptively applies equally to those claims. ‘To hold otherwise would be to exalt form over substance and distort the logic of this jurisprudence, which serves as an effective and useful guide to the understanding of patent claims.’ ”

Prosecution History Estoppel – Post Festo IX

- *Ranbaxy Pharm. v. Apotex*, 350 F.3d 1235 (Fed. Cir. 2003)(CJ Mayer, JJ. Clevenger & Bryson)
 - Presenting a new independent claim resulting from rewriting a dependent claim as a independent claim results in a narrowing amendment
 - Even though the scope of the claim was not narrowed at all
 - Simply wrong

Prosecution History Estoppel – Post Festo IX

- **Where Disclaimer is Clear on Record, No Need to Remand**
 - *Talbert Fuel Systems v. Unocal, (Talbert III)* – 347 F.3d 1355 – J. Newman JJ. Michel & Rader – on GVR from SCt
 - Claims - gasoline boiling point range of 121°F-345°F
 - Accused - boiling range endpoints from 373.8°F to 472.9°F
 - Talbert - 345°F - nothing more than a recognition that the highest boiling C10 hydrocarbon must be present in the claimed composition - claims did not exclude presence of higher boilers in relatively small amounts
 - Fed Cir – Claims limited – no literal infringement

Prosecution History Estoppel – Post Festo IX

- **Where Disclaimer is Clear on Record, No Need to Remand**
 - *Talbert Fuel Systems v. Unocal, (Talbert III)* – Cont'd
 - Narrowed to avoid “Hamilton reference” - 390°F – 420°F.
 - Fed Cir - “the amendment * * * to a boiling point upper limit of 345°F, in light of the Hamilton reference * * * is a presumptive surrender of gasolines boiling in the range between Talbert's amended endpoint of 345°F and Hamilton's endpoints.”
 - “[w]hen the prior art embraces the alleged equivalent, and a narrowing amendment was made to avoid that equivalent, that subject matter cannot be found to have been unforeseeable at the time of the amendment.”
 - No need to remand.

Prosecution History Estoppel – Post Festo IX

- **Forseeability**

- *SmithKline Beecham v. Excel Pharm.*, ___ F.3d ___ (Fed. Cir. 2004)(JJ. Rader & Gajarsa, SCJ Plager)
 - Sustained release tablet of bupropion used to treat depression & inebriation
 - Key ingredient HPMC
 - Original claims rej'd – lack of enablement – HPMC only disclosed sustained release agent
 - Amd'd to add HPMC
 - Excel used PVA – no literal infringement
 - SKB – doctrine of equivalents – not barred – no support for claiming other than HPMC – would have been new matter
 - Fed Cir – NO – *Festo* VII cannot be avoided by asserting new matter
 - BUT record did not reveal whether PVA was foreseeable

Prosecution History Estoppel – Post Festo IX

- **Forseeability**

- *Glaxo Wellcome v. Impax*, ___ F.3d ___ (Fed. Cir. 2004)(JJ. Rader & Gajarsa, SCJ Plager)

- Sustained release tablet of bupropion used to treat depression & inebriation
- Key ingredient HPMC – same patent as in *SKB v. Excel*
- Original claims rej'd – lack of enablement – HPMC only disclosed sustained release agent
- Amd'd to add HPMC
- Impax used HPC – no literal infringement
- SKB – doctrine of equivalents – not barred – no support for claiming other than HPMC – would have been new matter
- Fed Cir – NO – *Festo* VII cannot be avoided by asserting new matter
- HERE record showed that both HPC and HPMC were known sustained release agents.
- Estoppel applies to claim 1 even though had HPMC originally b/c broader construction would lead to inconsistency in the claims