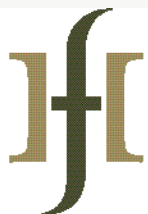


Last  
month at

# The Federal Circuit

Month at a Glance



**FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP**

Washington, DC  
202-408-4000

Palo Alto  
650-849-6600

Atlanta  
404-653-6400

Tokyo  
011-813-3431-6943

Brussels  
011-322-646-0353

## ON "INSUBSTANTIAL DIFFERENCES" TEST, "MAY THE BEST LAWYER WIN"

This case "provides a textbook example of the insubstantial nature of the 'insubstantial differences' test, and its marginally legitimate child, 'substantially the same way to achieve substantially the same result.'" *Caterpillar, Inc. v. Deere & Co.*, No. 99-1593 (Fed. Cir. Sep. 15, 2000) . . . . .1

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EDITED BY VINCE KOVALICK

## On “Insubstantial Differences” Test, “May the Best Lawyer Win”

D. Brian Kacedon

**[Judges: Mayer (author), Plager (concurring), and Lourie (dissenting)]**

In *Caterpillar, Inc. v. Deere & Co.*, No. 99-1593 (Fed. Cir. Sep. 15, 2000), the Federal Circuit vacated a district court’s grant of SJ of noninfringement and remanded the case for a jury determination of the issue.

Caterpillar Inc. (“Caterpillar”) filed suit in the Northern District of Illinois against Deere & Company (“Deere”), asserting that certain Deere tractors infringed U.S. Patent No. 5,279,378 (“the ‘378 patent”). Caterpillar’s ‘378 patent concerns a “frictionally driven belted work vehicle.” The claim limitations at issue were directed to a “tensioning means” for the belt of the vehicle. The parties agreed that the claim limitations were in means-plus-function form and required a means for making the belt taut around the wheels of a tractor and a means for longitudinally separating the front and rear wheels. The parties also agreed that the corresponding structure to perform these functions includes a movable front axle and a pair of hydraulic cylinders connected to that axle by angled struts. The hydraulic cylinders move the angled struts, which in turn move the front axle, thereby adjusting the tension in the belt.

Deere’s accused products are belt-driven tractors that utilize a different mechanism to tension the belt. The Deere tractors do not contain a front axle. Rather, each of the front wheels is connected to the frame independently by a device called a “swing link.” Each swing link also attaches to a hydraulic cylinder. The hydraulic cylinders can be used to move the front wheels in and out, thereby adjusting the tension in the belt.

The district court had found that no reasonable jury could find that the accused structure infringed the ‘378 patent. First, the accused device lacked a front axle and angled struts. Second, the two structures differed in the number and size of parts involved. Finally, the absence of a front axle in Deere’s design resulted in improved operator visibility.

On appeal, the Federal Circuit agreed that the district court had properly framed the analysis under 35 U.S.C. § 112, ¶ 6. Because the parties agreed that the two structures performed the same function, the only issue was whether there were substantial differences in the way they performed that function and in the result they achieved. The Federal Circuit applied the “insubstantial differences” test to determine if the tensioning means used by Deere was equivalent to that used in Caterpillar’s patent.

The Federal Circuit concluded that the district court had improperly conducted a component-by-component analysis in determining that substantial differences existed between the claimed and accused structures. The individual components of an overall structure that corresponds to a claimed function are not claim limitations, according to the Court. Rather, the claim limitation is the overall structure corresponding to the claim func-

tion. The district court had also erred in considering the improved visibility offered by Deere’s design. The Court ruled that this potential advantage did not relate to the disputed function and therefore should not have been considered. The Federal Circuit noted that Caterpillar presented considerable evidence, including expert affidavits and depositions, showing that the accused structure was equivalent. Caterpillar had also provided evidence that the accused mechanism was a known alternative that had in fact been substituted by Caterpillar themselves in their products. This was sufficient to create an issue of material fact as to whether the differences were substantial. Therefore, the grant of SJ was improper.

Judge Plager joined in the majority opinion and also filed a concurring opinion in which he expressed his displeasure with the “insubstantial nature of the insubstantial differences test.” *Caterpillar*, slip op., concurring opinion. Judge Plager’s final thought: “[M]ay the best lawyer win.” *Id.*

Judge Lourie dissented, finding such structural and operational differences that no reasonable jury could have found them to be equivalent.

## Not All Claim Limitations Are Entitled to Equal Scope of Equivalents

Stacy D. Lewis

**[Judges: Michel (author), Newman, and Clevenger]**

In *Moore U.S.A., Inc. v. Standard Register Co.*, No. 98-1386 (Fed. Cir. Sep. 22, 2000), the Federal Circuit affirmed a SJ of no infringement to Standard Register Corporation (“SRC”) with respect to three Moore U.S.A., Inc. (“Moore”) patents relating to business forms: U.S. Patent Nos. 5,201,464 (“the ‘464 patent”); 5,253,798 (“the ‘798 patent”); and 5,314,110 (“the ‘110 patent”).

Claim 1 of Moore’s ‘464 patent recites strips of adhesive “extending the majority of the lengths of said [first and second] longitudinal marginal portions.” In claim 9, the limitation requires, “the means defining a transverse line of weakness [be] adjacent said transverse strip in said third section, on the opposite side thereof from said second section.”

In the accused SRC form, the first and second longitudinal strips of adhesive extend approximately 47.8% of the total margin length. Moore did not dispute that the accused SRC form did not literally satisfy the claim limitations of the ‘464 patent, but argued equivalents. The district court granted SJ of no infringement under the DOE, because to do otherwise would have removed entirely the “majority of the lengths” limitation of Claim 1.

On appeal, Moore argued that the written description unequivocally teaches such equivalence, because it states that adhesive “may only be necessary . . . to extend about half of the length.” The Federal Circuit concluded, however, that allowing a minority (*i.e.*, 47.8%) to be equivalent to a “majority” would vitiate

the claim limitation. “[I]t would defy logic to conclude that a minority—the very antithesis of a majority—could be insubstantially different from a claim limitation requiring a majority, and no reasonable juror could find otherwise.” *Moore*, slip op. at 24-25. Citing *YBM Magnex, Inc. v. ITC*, 145 F.3d 1317 (Fed. Cir. 1998), the Court concluded that Moore, having disclosed two district embodiments, one in which the first and second longitudinal strips extend a majority of the length of the longitudinal marginal portions, and one in which they do not, was not entitled to enforce the unclaimed embodiment as an equivalent of the claimed embodiment.

With respect to claim 9, the Federal Circuit found that the accused SRC form undisputedly has a transverse line of weakness adjacent the transverse strip in its second section on the same side as the third section. Therefore, the line in the third section cannot be on the “opposite side thereof from said second section,” as claimed.

Moore’s ‘798 patent is directed to solving the problem of adhesive interfering with the printer rollers. The limitation at issue in claim 1 recites that the adhesive must be a “distance sufficient” from the edge so as to not interfere with the printer rollers. Other claims of the patent specifically require a distance of 5/16 inch.

The accused SRC form has adhesive strips located approximately 1/16 inch from the leading and trailing edges that do not interfere with the printer rollers. The district court had concluded that the “distance sufficient” limitation in claim 1 is in reference to only an IBM 3800 printer, because the specification and title refer only to this model. Because the IBM 3800 makes a 1/4-inch-wide impression on each side of the perforation line during printing, the district court construed the “distance sufficient” limitation as “more than 1/4 inch.” Having done so, the district court had found no infringement.

The Federal Circuit disagreed that the “distance sufficient” limitation was limited to the particular specifications of the IBM 3800 printer. The plain language of claim 1 recites a “printer” generally and nowhere mentions the IBM 3800 printer. The written description discloses that a form for use on an IBM 3800 printer is only the preferred embodiment. That the title also refers to an IBM 3800 printer does not change the analysis, the Court ruled, since the bar on importing limitations from the written description into the claims applies no less forcefully to a title.

The Federal Circuit found the district court’s claim construction error harmless, however, because Moore had failed to provide any evidence demonstrating or even suggesting SRC’s use of any form with adhesive at least 5/16 of an inch away from the transverse edges to avoid interference with the printer rollers. 5/16 is greater than the distance of the adhesive from the transverse edges of the SRC products. Therefore, SRC could not infringe claims 1, 2, 4, and 10, as a matter of law. Nor could SRC literally infringe claims 3, 5-9, and 11-16, because each of these claims expressly requires that the

adhesive strip be located 5/16 inch away from the transverse edge.

Moore’s ‘110 patent claims a mailer-type business form “wherein said sheet is devoid of adhesive extending along said end edges of said sheet between said longitudinal lines of weakness.” The “between said longitudinal lines of weakness” phrase was added to overcome an Examiner’s rejection over prior art (“the Conti patent”), which disclosed adhesive covering roughly 75% of the area between the longitudinal perforation lines. In the accused SRC form, the patches of adhesive cover no more than 25% of the linear distance between the two longitudinal lines of weakness.

The Federal Circuit found nothing in the plain language of the claims or the written description that would limit the reference to “said end edges” in the “devoid of adhesive” limitation to only some, but not all, of the end edges, as Moore had suggested. All of the figures disclosed depict a form with no adhesive along any of the four end edges between the longitudinal lines of weakness.

The Federal Circuit affirmed the grant of SJ that SRC did not literally satisfy the “devoid of adhesive” limitation. The Federal Circuit also held Moore estopped from asserting infringement under the DOE due to the Application’s prosecution history, which makes clear that the absence of any adhesive, not some adhesive, was necessary to secure allowance of the claims.

Judge Newman dissented in part, believing that the issue of equivalency with respect to the ‘464 claims should not have been determined on SJ, but required a full analysis.

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## Corporation’s Conduct Raises Inference That Implied-in-Fact Contract to Assign Inventive Rights Was Not Formed

Patricia Ann Shatynski

[Judges: Mayer (author), Friedman, and Schall]

In *Banks v. Unisys Corp.*, No. 00-1030 (Fed. Cir. Sep. 28, 2000), the Federal Circuit overturned a SJ against Gerald Banks that an implied-in-fact contract existed and required him to assign all his inventive rights to Unisys Corporation (“Unisys”). The Court held that Banks’s failure to execute assignments to Unisys, coupled with Unisys’ failure to further pursue the signing of these agreements, supports a reasonable inference that Unisys acquiesced to Banks’s refusal to transfer his inventive rights, making SJ inappropriate.

In 1987, Banks, an expert in optical engineering, began working for Burroughs Corporation (now Unisys). At this time, Unisys asked Banks to sign an agreement (“the Agreement”) to effectively assign his inventive rights to Unisys. Banks did not sign the Agreement.

During the course of his employment by Unisys, Banks joined a project team chartered to develop an image camera used in conjunction with a high-speed document sorter. Based on the results of tests conducted on his own time and initiative, Banks recommended a redesign of the camera's optics. In 1988, the modifications developed by Banks were incorporated into the high-speed document sorter. In 1989, Unisys filed six patent applications related to the sorter. Unknown to Banks, he was listed on three of the applications. When Unisys asked Banks to sign the patent application papers, Unisys indicated that Banks would be paid for each patent. Bank signed the papers for each of the three applications. Later, Unisys informed Banks that he would not be paid.

Banks brought suit against Unisys, alleging that Unisys' misrepresentations induced him to assign his patent rights. Banks also claimed that Unisys had failed to name Banks as a coinventor on other patents and asked the district court to correct the patents. Unisys moved for SJ, arguing that the "employed to invent" rule does not require an express agreement of assignment. As such, Banks's refusal to assign his inventive rights to Unisys has no legal significance. Unisys argued that Banks's job was to specifically create and develop various design improvements for the image camera system. Unisys asserted that Banks is barred from claiming a right to the inventions since he has already been compensated for his work. Banks countered that his refusal to assign his patent rights indicated that an implied-in-fact contract was not formed. The district court granted SJ for Unisys.

In vacating the SJ, the Federal Circuit stated that application of the "employed to invent" rule includes consideration of the employment relationship at the time of the inventive work to establish whether the parties had entered into an implied-in-fact contract to assign patent rights.

The Court concluded that the district court had failed to address the impact of Banks's failure to sign Unisys' standard assignment form and his refusal to sign other agreements he believed would assign his inventive rights to Unisys. This, coupled with Unisys' failure to further pursue the signing of these agreements, supported a reasonable inference that Unisys had acquiesced to Banks's refusal to transfer his inventive rights. As such, SJ against Banks was inappropriate.

## PTO's Error Costs Plaintiff

A. J. Moss

[Judges: Schall (author), Michel, and Skelton]

In *Southwest Software, Inc. v. Harlequin Inc.*, No. 99-1213 (Fed. Cir. Sep. 18, 2000), the Federal Circuit vacated the judgment for Southwest Software, Inc. ("Southwest") based on a jury verdict that Harlequin

Inc. ("Harlequin") infringed claim 1 of U.S. Patent No. 5,170,257 ("the '257 patent"), and remanded to the district court to determine whether the '257 patent is valid without the benefit of a certificate of correction issued after the suit had been filed.

The technology of the '257 patent is used in an imagesetter, a device that receives data and instructions from a computer and prints an output image. Printed output images from conventional imagesetters typically include darker shades of gray than desired. The '257 patent addresses this problem by programming an imagesetter to automatically calibrate its output to produce the desired shades of gray.

In the district court, Southwest had sued Harlequin alleging infringement of the '257 patent by an image-processing software product that automatically calibrates an imagesetter. Harlequin responded by altering its product to inhibit the automatic calibration feature, replacing it with a user-selected calibration technique. Additionally, Harlequin discovered that the certified copy of the '257 patent was missing a program printout appendix. And, noting that the '257 patent states that the appendix provides source code to enable calibration according to the invention, Harlequin moved for SJ of invalidity, arguing that the specification failed to meet the enablement and best mode requirements of 35 U.S.C. § 112.

As a result, Southwest requested the PTO to issue a certificate of correction under 35 U.S.C. § 254 to add the appendix to the '257 patent, arguing that the omission resulted from a printing oversight by the PTO. The PTO agreed and issued the certificate. Harlequin then moved for SJ that the certificate of correction was invalid, asserting that the record demonstrated that the omission of the appendix was Southwest's fault, not the PTO's. Alternatively, Harlequin argued that the certificate, if valid, was not effective for purposes of the suit. The district court had denied Harlequin's motions for SJ, without prejudice to their refiling as a motion for JMOL at trial.

At a pretrial hearing, the parties had agreed to proceed through trial without challenging before the jury the validity or effect of the certificate of correction, in essence assuming a valid and effective incorporation of the appendix into the '257 patent. At trial, the jury returned a verdict of infringement of the '257 patent by Harlequin's original product, and noninfringement by its redesigned product. In a postverdict motion for JMOL, Harlequin again argued that the certificate of correction was invalid, or ineffective for purposes of the suit. In either event, Harlequin asserted that the appendix was not part of the '257 patent, thereby invalidating the patent for failure to comply with the best mode and enablement requirements of 35 U.S.C. § 112. The district court denied Harlequin's motion.

On appeal, the Federal Circuit concluded that there was no clear error in the district court's determination that the appendix had been omitted by fault of the PTO. Consequently, the Court affirmed the district



court's ruling that the certificate had not been issued in violation of 35 U.S.C. § 254. The Court noted, however, that the district court had not considered the effective date of the certificate of correction, or the consequences if it was not effective for the suit. Southwest argued that the certificate of correction, once granted, became effective as of the issue date of the '257 patent, while Harlequin contended that the language of 35 U.S.C. § 254 states that a certificate of correction only becomes effective for causes of action arising after it is issued.

Examining the statutory language of section 254, the Court concluded that it requires a certificate of correction to be considered part of the original patent for causes of action arising after the certificate is issued. Alternatively, for causes of action arising before a certificate's issuance, the Court concluded, the certificate would be ineffective. Here, Southwest obtained its certificate after it had filed suit. Thus, the certificate is ineffective for purposes of the suit, and therefore, the appendix is not part of the '257 patent for the suit. And, in remanding the case to the district court to determine whether the '257 patent is invalid without the appendix, the Court clarified that if the patent is so invalid, this basis for invalidity ended on the date that the certificate of correction issued, but only for actions arising thereafter.

## Claim Construction "Undermines" Infringement Finding Against Government on Mine-filling Patent

*Lawrence F. Galvin*

**[Judges: Archer (author), Gajarsa, and Rich]**

In *Dow Chemical Co. v. United States*, No. 97-5035 (Fed. Cir. Sep. 6, 2000), the Federal Circuit affirmed-in-part, reversed-in-part, vacated-in-part, and remanded a lower court decision concerning a statute of limitations, patent validity, infringement, breach of contract, and damages.

In the early 1970s, Dow Chemical Company ("Dow") invented an improved method for filling abandoned mines to prevent collapse of the overlying land and filed an associated patent application. In 1972, Dow licensed the Federal Government ("Government") under the patent application and any patents issuing thereon, including subsequently issued U.S. Patent No. 3,817,039 ("the '039 patent"). After signing the license, the Government undertook an extensive program of mine-backfilling projects. As a result, in 1975, Dow requested an accounting from the Government for royalties due under the license. In a 1976 reply, the Government refused to pay any royalties, indicating that it had not practiced the invention of the '039 patent. After reconsidering its position in 1978, the Government affirmed that no royalty payments would be made. After a reissue of the '039 patent, Dow sued the

Government in 1983. And in 1985, Dow notified the Government that it was terminating the license.

The Court of Federal Claims held that Dow's infringement claim was not barred by the applicable statute of limitations; found that the '039 patent was not invalid, but was infringed; held the license void ab initio due to the Government's material breach and repudiation of the license; and awarded damages based on the value of the benefit conferred during unlicensed infringement.

On appeal, the Federal Circuit affirmed that Dow's infringement claim was not barred by the statute of limitations. However, the Court found reversible error in the lower court's reliance during claim interpretation on extrinsic evidence of interested witnesses over intrinsic evidence in the claims, specification, and prosecution history. Thus, the Federal Circuit vacated and remanded to determine whether the Government infringed the '039 patent under the Court's claim construction.

Additionally, although the Federal Circuit agreed that the Government had materially breached and repudiated the license, the Court reversed the lower court's determination that the license was void ab initio, in part because in this case money damages for breach of contract could adequately compensate Dow. The Court also found that Dow's 1985 letter had terminated the license upon receipt of the letter by the Government.

Finally, the Federal Circuit found the lower court's method for calculating damages too speculative and remanded for a recalculation of damages if, on remand, the lower court determined that the Government infringed the '039 patent. The Court directed two such damages recalculations: prior to termination of the license, breach of contract damages based upon terms in the license, and after termination of the license, royalty damages based upon the Government's costs.

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## Improved Excipient Patent Not Infringed, Not Invalid

*Eric W. Adcock*

**[Judges: Newman (author), Skelton, and Archer]**

In *Upjohn Co. v. MOVA Pharmaceutical Corp.*, No. 99-1092 (Fed. Cir. Sep. 11, 2000), The Upjohn Company ("Upjohn") appealed an adverse decision regarding its U.S. Patent No. 4,916,163 ("the '163 patent"). The Federal Circuit affirmed the district court's judgment of noninfringement based on a jury verdict, but reversed the lower court's invalidity and unenforceability judgments.

The dispute between Upjohn and MOVA Pharmaceutical Corporation ("MOVA") arose after MOVA filed an Abbreviated New Drug Application for a bioequivalent form of Upjohn's antidiabetic drug glyburide. The '163 patent claims an improved micronized glyburide excipient: spray-dried lactose in such an amount that it represents about 70% or more by weight

of the total pharmaceutical composition. The accused MOVA product contains micronized glyburide, but only 49% by weight of spray-dried lactose and about 46-49% Starch 1500. The district court had granted MOVA's SJ motion in part, ruling that there was no literal infringement, but the issue of infringement under the DOE was tried to a jury. The jury rendered a verdict of noninfringement, and the district court entered judgment on this verdict, denying Upjohn's JMOL.

The Federal Circuit considered Upjohn's argument that MOVA's excipient is substantially the same as one containing 70% spray-dried lactose. MOVA argued that substantial evidence showed sufficient differences between Starch 1500 and spray-dried lactose to support the jury's verdict. MOVA also pointed out that the disclosure of the '163 patent specification states that use of spray-dried lactose as the "preponderant" component is "critical to the success of the present composition." The Court affirmed the noninfringement verdict, stating that the different ways in which spray-dried lactose and Starch 1500 deliver glyburide could have led a reasonable jury to find a lack of equivalence.

The jury had also found the '163 patent invalid for obviousness, but the Federal Circuit reversed this verdict. At trial, MOVA's expert witness, Dr. Rodriguez, had offered an opinion that one of the prior art references taught the 70% weight limitation. The limitation could only be obtained from the prior art reference by reducing the amount of active ingredient in a particular example without reducing the amounts of the other ingredients. The Federal Circuit found no factual support for Dr. Rodriguez's conclusion that the reference taught such a reduction, even though lower dosages of the active ingredient were mentioned in the same prior art reference. The Court also found two other references insufficient to support an obviousness holding because they did not disclose micronized compounds. Dr. Rodriguez's assertion that it was "widely known" that micronized drugs could be blended successfully with spray-dried lactose was considered nonprobative by the Court for lack of documentary evidence.

The Federal Circuit then considered the unenforceability judgment. MOVA had presented three bases of inequitable conduct at trial. First, MOVA argued that Upjohn had submitted photographs that labeled a comparative testing ingredient as glyburide when it was really a placebo. Second, Upjohn had failed to disclose earlier adverse comparative tests. Third, Upjohn had failed to ask newly named inventors whether they were aware of material prior art, and the inventors had knowledge of known properties of spray-dried lactose that should have been disclosed to the PTO.

The Federal Circuit concluded that this evidence was not sufficient to support a finding of inequitable conduct. Regarding the photographs, Upjohn had submitted a second declaration stating that a placebo was used, and had argued that glyburide was not required in the demonstrations, which focused on flow behavior based on particle sizes. Upjohn's failure to disclose earlier adverse test results did not show intent to deceive because those tests involved a glyburide dosage level

that had since been abandoned. Finally, concerning the knowledge of the newly named inventors, the Federal Circuit concluded that the information was already in the specification and stated that inventors are only required to reveal prior art to the PTO, not their entire personal knowledge of the subject matter.

## Single Reference Renders Claims Obvious

Jason R. Buratti

[Judges Gajarsa (author), Mayer, and Michel]

The Federal Circuit reversed a district court's denial of JMOL in *Sibia Neurosciences, Inc. v. Cadus Pharmaceutical Corp.*, No. 99-1381 (Fed. Cir. Sep. 6, 2000), finding that a jury's factual finding of nonobviousness was not supported by substantial evidence. The Court ruled that Sibia Neurosciences, Inc.'s ("Sibia") U.S. Patent No. 5,401,629 ("the '629 patent") was obvious in light of a single prior art reference.

The '629 patent is directed to a method for screening cells for surface proteins that induced agonistic stimulating or antagonistic suppressant reactions within the cell to identify potentially therapeutic drug substances. A cell's surface proteins are responsible for initiating intracellular signal transduction pathways, which are intracellular chain reactions leading to specific intracellular functions, such as the transcription of DNA, or genes, into messenger RNA, which would then be translated into proteins. By identifying compounds that trigger or stop the pathway, a scientist could reliably screen large numbers of compounds for therapeutically effective agonistic or antagonistic effects on the internal signal transduction pathways.

To achieve this goal, the invention provides for the creation of a recombinant cell and the use of that cell in two sets of assays. The goal of the assays is to identify desired binding activities between the compound and the surface protein by observing the activity of a reporter gene construct (a mechanism in the recombinant cell that produces an identifiable reporter gene product when the signal transduction pathway is stimulated by extracellular stimuli). The first assay set compares cells exposed to compound and cells not exposed to compound to test the effectiveness of the compound. The second assay set compares cells with the surface protein to cells without the surface protein (called "cells with heterologous surface proteins") to detect whether binding occurred. After running the two sets of assay, a scientist would know whether the compound was effective for triggering or stopping the pathway associated with the surface protein, and was thus a potentially effective drug.

Accepting the trial court's claim construction, the Federal Circuit considered Cadus Pharmaceutical Corporation's ("Cadus") arguments that the '629 patent would have been obvious in view of a prior art single reference. This reference ("Stumpo") teaches the use of

a recombinant cell identical to that disclosed in the '629 patent in a transcription-based assay to detect cell surface receptor activation, an agonistic response. Notably, Stumpo's teachings use the compound insulin and seek to characterize certain aspects of the recombinant cell's genetic material, rather than to provide drug screening. Consequently, the only difference between Stumpo and claim 1 of the '629 patent is that the compounds in Stumpo were known to interact with the cell surface proteins, while those in claim 1 were not.

Based on this difference, the Federal Circuit presumed that the jury determined that there was no motivation to modify the Stumpo reference for use with compounds of unknown interaction properties. The Court reasoned that the jury, by returning a verdict in favor of Sibia, must have resolved the factual dispute of motivation to modify Stumpo in Sibia's favor.

The Court looked to other prior art references including a review article and two patents, to determine whether the motivation existed to modify Stumpo to use compounds of unknown interaction to screen for drugs. Two of the prior art references teach the use of cells with heterologous surface proteins to screen for drugs, and thus teach exactly the same uses as those disclosed in the '629 patent. Because Stumpo teaches the identical recombinant cells, the Federal Circuit found that these two references teachings provided sufficient motivation to modify Stumpo.

The Federal Circuit rejected Sibia's argument that none of the prior art references disclose the reporter gene construct for drug screening, because Sibia had failed to present evidence that the use of the reporter made a cell attractive as drug screening candidate. In fact, one prior art reference actually discloses that such a cell would be useful for this purpose. The Court also rejected Sibia's arguments concerning secondary considerations, namely, three license agreements that it had entered, because Sibia failed to establish a nexus between the licenses and the merits of the claimed method.

Judge Mayer dissented, concluding that the majority had substituted itself for the jury, and reweighed the evidence, stringing together a series of references to invalidate a nonobvious patent.

## Finding of No Infringement Leaves Patentee with "Bitter Taste"

*Timothy B. Donaldson*

**[Judges: Newman (author), Freidman, and Rader]**

In *Cultor Corp. v. A.E. Staley Manufacturing Co.*, No. 99-1232 (Fed. Cir. Sep. 21, 2000), the Federal Circuit affirmed a district court's decision granting SJ of noninfringement in favor of A.E. Staley Manufacturing Company ("Staley").

Cultor Corporation ("Cultor") sued Staley alleging infringement of certain claims of U.S. Patent No. 5,667,593 ("the '593 patent") and claim 24 of U.S. Patent No. 5,645,647 ("the '647 patent"). The claims

of the '593 patent are directed to polydextrose compositions that are substantially free of bitter-tasting residual compounds. Claim 24 of the '647 patent is directed to a method of purifying polydextrose and includes a step of passing a polydextrose solution through an ion-exchange column.

Polydextrose is a low-calorie replacement for flour and sugar that is often used to replace the bulk that is lost when sugar is replaced by artificial sweeteners, for instance in baked goods. As explained in the specification, polydextrose is traditionally made by the Rennhard process, which includes a step of heating dextrose in a catalytic amount of citric acid. The polydextrose made by the Rennhard process has a slightly bitter taste. The inventors of the '593 and '647 patents discovered that the bitter taste could be removed by passing the polydextrose solution through an ion-exchange column to remove any residual citric acid.

The accused process also includes steps of heating polydextrose in the presence of an acid catalyst and passing the final polydextrose solution through an ion-exchange column. However, Staley's process uses phosphoric acid as a catalyst instead of citric acid. In response to Cultor's charge of infringement, Staley argued that, as interpreted in light of the specification, Cultor's claims were limited to polydextrose produced using citric acid. Specifically, the specification explains that the expression "water-soluble polydextrose" (also known as polyglucose or poly-D-glucose) specifically refers to the water-soluble polydextrose prepared by melting and heating dextrose (also known as glucose or D-glucose), preferably with about 5-15% by weight of sorbitol present, in the presence of a catalytic amount (about 0.5 to 3.0 mol %) of citric acid.

The district court agreed with Staley and granted SJ of noninfringement, ruling that as defined in the specification, the claims were limited to polydextrose produced with citric acid as a catalyst.

Cultor also asserted infringement under the DOE, arguing that citric acid and phosphoric acid were interchangeable and both were removed from polydextrose using an ion-exchange resin. The district court found, however, that Cultor had repeatedly distinguished the invention from the prior art by emphasizing their discovery that citric acid caused the bitterness of polydextrose made by the Rennhard process and that the bitterness could be removed by passing the polydextrose through an ion-exchange resin to remove any bound citric acid.

On appeal, Cultor argued that the Rennhard process is not limited to a citric acid catalyst. Cultor cited the Rennhard patent, which lists ten possible acid catalysts. The Federal Circuit, however, looked to the '593 and '647 patents, which teach how to overcome the problem of the Rennhard process by a specific method of removing citric acid. Furthermore, the Court found no error in the district court's construction of the claims. Having narrowly defined the term "water-soluble polydextrose" in the specification as limited to that prepared with citric acid, Cultor had effectively disclaimed other prior art acids.

Cultor argued that no prosecution history estoppel existed to limit the DOE because none of the asserted

claims had been amended to distinguish prior art, and the inventors had made no arguments to distinguish the prior art on the basis of citric acid. The Court noted, however, that Cultor had made no amendments or arguments because the claims were copied for interference purposes. Since the purpose of the invention was the removal of bitter taste caused by citric acid, the Court declined to use the DOE to enlarge the scope of the claims to encompass other acids when no bitter taste or citric acid was present.

The Federal Circuit also rejected Cultor's argument that the asserted claims should be given the broad interpretation they had received in a prior interference. According to Cultor, since the claims had been copied to provoke an interference, they should be construed as they would be in the patent from which they had been copied. The Court disagreed, explaining that a copied claim does not acquire the benefit of the descriptive text of the copied patent. Rather, the claims must be construed in light of their own specification.

## Evidence Does Not Support Inequitable Conduct

Rebecca D. Hess

[Judges: Gajarsa (author), Michel, and Bryson]

In *Life Technologies, Inc. v. Clontech Laboratories, Inc.*, No. 99-1550 (Fed. Cir. Sep. 21, 2000), the Federal Circuit reversed a district court decision that held two Life Technologies, Inc. ("Life Technologies") patents unenforceable because of inequitable conduct before the PTO. The Federal Circuit determined that the three findings of fact on which the district court had based its inequitable conduct finding were clearly erroneous and/or a misapprehension of legal standards.

The two asserted patents pertain to a genetically engineered reverse transcriptase enzyme that promotes DNA polymerase activity, but does not exhibit any of the usual RNase H activity. The Life Technologies inventors had spent years trying to locate and delete the RNase H activity from the reverse transcriptase ("RT") enzyme when another scientist published an article ("the Johnson article") indirectly suggesting the location of the elusive RNase H activity. The inventors were skeptical of the author's results, since the article taught away from prior art in the field. To exclude the possibility that Johnson was correct, the inventors conducted further experiments and, contrary to expectations, successfully created the mutant RT enzyme that later became the subject matter of their patents. A few months after confirming their discovery, they learned that a third researcher ("Goff") was also working to develop an engineered RT enzyme with properties similar to the inventors' enzyme. The inventors learned that Goff had given a presentation at Stanford University about his work, but they did not attend this presentation and knew nothing else of Goff's work. During prosecution of Life Technologies' application(s), the inventors disclosed the Johnson article, but not their knowledge of Goff's research or presentation.

The district court had based its inequitable conduct ruling on three findings of fact; three Applicants: (1)

withheld information regarding their "reliance" on the Johnson article, (2) made material misrepresentations regarding the article, and (3) withheld information regarding Goff's work. The Federal Circuit held that all three findings were clearly erroneous and could not support a finding of inequitable conduct.

First, the Federal Circuit held that in this situation disclosure of the Johnson article to the PTO was sufficient to satisfy the Applicants' duty of disclosure. The Applicants were not required to mention their reliance on the article or how it motivated them to conduct the experiments leading to their invention. The Federal Circuit emphasized that the manner in which the inventors had used a disclosed prior art reference is not material information because a reasonable Examiner would not have considered the information important in deciding patentability of the invention.

Next, the Federal Circuit ruled that the Applicants did not make misrepresentations regarding the Johnson article when they had argued to the Examiner (to overcome an obviousness rejection) that there was no reasonable expectation of success in applying the Johnson article's teachings. Because the Johnson article was contrary to established teachings and was based on a relatively new technique, the inventors had argued that a reasonable expectation of success was lacking. This argument was not a misrepresentation, the Court concluded, pointing out that the Applicants' argument was simply an interpretation of the Johnson teachings, which the Examiner was free to reject.

Lastly, the Federal Circuit held that the Applicants did not withhold material knowledge from the PTO regarding Goff's work or his presentation. The inventors were in possession of only very limited information regarding Goff's work, and the information they did have lacked the specificity and definiteness required for a section 102(g) rejection. The Applicants did not know when or how Goff's results were achieved, or even how similar Goff's work was to their discovery. Knowledge of those details required for the Examiner to consider whether Goff was a prior inventor, and the knowledge that Applicants *did* have would not have been material to a reasonable examiner. When the Examiner did find out about Goff's work prior to issuance, the Examiner wrote that the information had no bearing on the patents issued or the instant application. The Federal Circuit took such a statement as further evidence that the Applicants' limited knowledge about Goff's work and presentation was immaterial to the prosecution of the application and thus did not support a finding of inequitable conduct.

## Statements from Trademark Registration Process Do Not Create Judicial Estoppel

Steven J. Scott

[Judges: Bryson (author), Mayer, and Rader]

In *Lampi Corp. v. American Power Products, Inc.*, No. 00-1011 (Fed. Cir. Sep. 28, 2000), the Federal Circuit affirmed portions of a judgment of noninfringement, but



remanded for reconsideration of other portions based on a revised claim construction. The Federal Circuit also instructed the district court to consider an obviousness defense in light of the revised claim construction.

Lampi Corporation ("Lampi") owns U.S. Patent No. 5,169,227 ("the '227 patent"), which is directed to a miniature fluorescent lamp comprising a fluorescent tube, electrical means for operating the fluorescent tube, and a self-supporting housing. The lamp can be used, for example, as a night-light. American Power Products, Inc. ("APP") sells lamp models 5544 and 7744, which prompted Lampi's suit for infringement of claims 1 and 11 of the '227 patent. Claim 1, recites a "support means" for supporting the fluorescent tube, and the parties disputed what structure performs the claimed support function. Lampi argued that a curved section of the housing perform the function, while APP argued that two parallel plates within the housing, referred to as "front sides," perform the function.

Noting that the patent's disclosure of the structure was "sparse at best," the Federal Circuit turned to a statement in the specification that the fluorescent tube was "held without slack," and concluded that the front sides were the only disclosed structure that could achieve that restriction in movement. Against this construction, the Federal Circuit agreed with the district court's finding of no infringement under the DOE, since the corresponding structures in the accused devices allowed for lateral movement of the tube.

Lampi also argued that the district court had erred in finding that the 7744 model, having a translucent cover, did not meet a claim limitation calling for a "first interior channel." Lampi's arguments before the PTO during prosecution of the patent, however, undermined its position, and the Court concluded that the 7744 model could not meet the first interior channel limitation either literally or under the DOE.

Turning to the accused APP 5544 model, Lampi challenged the district court's determination that the limitation "housing having two half-shells" in claim 11 was restricted by the term "having" to preclude other elements. In other words, the model 5544 could avoid infringement by containing additional unclaimed elements. Rather than allowing the term "having" a fixed breadth, the Court referred to the patent specification and applied principles of claim differentiation to conclude that the patentee had intended the term "having" as open, not closed. The specification stated that the housing "preferably consists of" two separate half shells, indicating that the disclosure as a whole communicated the potential for additional elements. Dependant claim 8 uses the transition term "comprises" rather than "having," and the Court concluded that these terms should be interpreted the same way.

The Court then addressed APP's challenges to the validity of the '227 patent under 35 U.S.C. §§ 102(b), 112, and 103. For the section 102(b) issue, the Court concluded that the district court had been justified in not applying judicial estoppel to Lampi's statements made during prosecution of a trademark application, that the invention had been "used in commerce" before the patent's critical date. The Court also rejected APP's

argument that the patent claims, covering both identical and nonidentical "half-shells" in the housing, lacked written description support in the parent specification that allegedly only disclosed identical half shells. Without benefit of the parent application filing date, APP argued, intervening art between the filings of the parent and application leading to the '227 patent invalidated the '227 patent claims. The Court dismissed APP's argument, however, on the basis that identical half shells were only a disclosed preferred embodiment and the parent application as a whole described both identical and nonidentical half shells. Finally, the Court remanded the issue of obviousness of the claims in light of its construction of the transition term "having."

## Federal Circuit "Clears Up" Dispute Over Water Purification Patent

Gregory A. Chopskie

[Judges: Michel (author), Cleverger, and Rader]

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In *Ecolochem, Inc. v. Southern California Edison Co.*, No. 99-1043 (Fed. Cir. Sep. 7, 2000), the Federal Circuit affirmed the district court's holding of invalidity on one asserted claim but reversed on the remaining asserted claims.

Ecolochem, Inc. ("Ecolochem") charged Southern California Edison Company ("Edison") with willful infringement of its U.S. Patent No. 4,818,411 ("the '411 patent"), and Edison counterclaimed that the asserted claims were invalid as anticipated and obvious in view of the prior art and asserted other equitable defenses. The '411 patent claims a process for removing dissolved oxygen from liquid ("deoxygenation") that is useful for deoxygenating water for use in nuclear power plants. Generally, the claimed process calls first for contacting the liquid with hydrazine over a bed of activated carbon to catalyze the reaction followed by a second step of removing the dissolved contaminants by passing the liquid through cation and anion resins. The district court had held that although Edison willfully infringed the asserted claims, some of those claims were invalid as anticipated and all of those claims were invalid for obviousness. Ecolochem appealed the holding of invalidity.

The Federal Circuit reversed the district court's finding of anticipation of all of the claims except claim 20, ruling that the published literature asserted by the Defendant was limited to deoxygenation of water for use in a nuclear power plant by using hydrogen rather than hydrazine. Accordingly, the published references did not contain all of the limitations of the asserted claims. The Federal Circuit also concluded that a presentation by the author of these references addressed only the removal of dissolved contaminants, such as carbon, which did not anticipate independent claims 1 and 15, but did anticipate claim 20.

Turning to obviousness, the Federal Circuit again reversed the district court with regard to all of the

asserted claims except claim 20. The Court concluded that the district court had failed to identify any evidence of motivation to combine the relevant prior art references. Moreover, according to the Federal Circuit, the prior art references taught away from the use of deoxygenation with hydrazine over a carbon catalyst by suggesting that the claimed process was too costly and would release impurities into the liquid. With regard to claim 20, which Ecolochem had admitted was *prima facie* obvious, the Federal Circuit considered *de novo* the district court's analysis of the objective indicia of nonobviousness and found that the district court had committed clear error in not finding commercial success, teaching away, and evidence of copying. Nevertheless, the Federal Circuit held that those factors did not outweigh the case of *prima facie* obviousness.

## Accused Infringer "Pressed" by Preamble and Procedure

Lara C. Kelley

[Judges: Michel (author), Newman, and Rader]

In *Heidelberg Harris, Inc. v. Mitsubishi Heavy Industries, Ltd.*, No. 99-1100 (Fed. Cir. Sep. 18, 2000) (nonprecedential decision), the Federal Circuit affirmed the district court's discretionary extension of appeal deadline, affirmed the judgment of literal infringement of Heidelberg Harris, Inc.'s ("Heidelberg") U.S. Patent No. 5,440,981 ("the '981 patent"), and affirmed the judgment of no invalidity for obviousness of the '981 patent and Heidelberg's U.S. Patent No. 5,429,048 ("the '048 patent"). The Federal Circuit reversed the district court's decision of infringement of the '048 patent, but this reversal did not require remand for further proceedings.

The '981 and '048 patents are directed to offset lithographic printing presses, whereby an inked image on a printing plate carried on a plate cylinder is transferred onto a printing blanket carried on a blanket cylinder, which, in turn, transfers its inked image onto paper. The dispute on appeal focused on the phrase "for reducing vibrations and slippage" that occurs in the preambles of the independent claims in the '981 and '048 patents, as well as on the phrase "at the same speed" that occurs in the claims of the '048 patent in reference to the rotation of the plate and blanket cylinders.

Mitsubishi Heavy Industries, Ltd. ("Mitsubishi") alleged that its presses were designed to promote, rather than reduce slippage as a result of an increased surface speed differential between the printing plate and printing blanket.

Before the case went to trial, the district court had denied both parties' motions for SJ and held that the "reducing vibrations and slippage" language in the preambles of the '981 and '048 patent claims was not a claim limitation. After the close of evidence, the district court granted Heidelberg's motion for JMOL that Mitsubishi's accused presses satisfied the "at the same speed" limitation in the '048 patent claims. The case

was submitted to a jury, who concluded that all of the asserted claims of the '981 and '048 patents were literally infringed and not invalid as obvious.

Almost two months after judgment on the jury verdict had been entered, while the district court was still considering an untimely (and ultimately unsuccessful) motion for JMOL and new trial, Mitsubishi filed a contingent motion under Federal Rule of Appellate Procedure 4(a)(5) that the deadline for filing a notice of appeal be extended for "excusable neglect." The district court had granted Mitsubishi's Rule 4(a)(5) motion, thus allowing Mitsubishi to appeal the entry of judgment to the Federal Circuit. Heidelberg cross-appealed the extension of the appeal deadline, contending that the Federal Circuit lacked jurisdiction over the appeal.

In considering Heidelberg's cross-appeal, the Federal Circuit found that the district court had not abused its discretion in granting the extension of appeal deadline under the excusable neglect standard. The Court noted that while misinterpretation of a procedural rule does not normally constitute excusable neglect, in this case there was sufficient evidence of good faith effort to comply with post-trial deadlines, as well as other equitable considerations, that weighed in favor of the district court's decision.

Turning to the merits of Mitsubishi's appeal, the Federal Circuit agreed with the district court's decision that the intended purpose recited in the preambles of the claims of the '981 and '048 patents was not a claim limitation. The Court pointed out that although the phrase "for reducing vibrations and slippage" was originally added to the body of certain claims as part of means-plus-function language, these claims were cancelled in favor of new claims that included the intended function as part of the preamble. Additionally, since the phrase in the preambles was not necessary to the meaning of the claims, did not provide antecedent basis for claim terms, or distinguish over the prior art, it did not serve as a claim limitation.

The Federal Circuit did not agree, however, with the district court's construction of the phrase "at the same speed" in the '048 patent claims. In particular, the Federal Circuit rejected the lower court's analysis and Heidelberg's argument that this phrase be interpreted to include different linear speeds as long as the intended effect of avoiding image migration is present. Considering that the plain language of the claim, the written description, and the prosecution history did not support such a broad construction, the Court found that Mitsubishi's presses with plate and blanket cylinders running at different speeds did not literally infringe the '048 patent claims.

Turning to the validity of the '048 and '981 patents, the Federal Circuit noted that it was constrained by Mitsubishi's failure to timely move for JMOL. Thus, the only inquiry was whether Heidelberg's evidence at trial supported the legal conclusion of nonobviousness. Accepting Heidelberg's characterizations of the prior art, as well as the lack of evidence to combine references and strong evidence of secondary considerations, the Federal Circuit held that there was no error in the district court's judgment of no invalidity for obviousness.

## Court “Filters Out” Infringement of Water Filter Patent

Michael V. O’Shaughnessy

**[Judges: Gajarsa (author), Plager, and Clevenger]**

In *Brita Wasser-Filter-Systeme, GmbH v. Recovery Engineering, Inc.*, No. 99-1322 (Fed. Cir. Sep. 21, 2000) (nonprecedential decision), the Federal Circuit affirmed a district court’s grant of SJ holding that neither Recovery Engineering, Inc. (“Recovery”); Signature Brands, Inc. (“Signature”); nor Culligan International Co. (“Culligan”) infringed U.S. Patent No. 4,969,996 (“the ‘996 patent”), either literally or under the DOE.

The ‘996 patent, owned by Brita Wasser-Filter-Systeme, GmbH (“Brita”), describes a water filtration pitcher with filter cartridge inserts. The claimed invention reduces the presence of air bubbles generally yielded by chemical reactions within the filtering process when combined with a rising water level. This reduction of air bubbles is accomplished by integrating an “air collecting space” with a filter insert and sleeve design that is capable of exhausting air bubbles from the sleeve. The exhaustion of air bubbles improves the flow of water through the filter cartridges.

Recovery, Signature, and Culligan all manufacture water filtration systems that exhaust air bubbles. Brita asserted claim 1 of the ‘996 patent in an infringement action against all three companies. After a *Markman* hearing, the district court concluded that the ‘996 claim language must be read as a means-plus-function claim governed by 35 U.S.C. § 112, ¶ 6. Claim 1 was therefore read as having the function of gathering and removing bubbles from the filter bottom. This function, according to claim 1, was performed by the corresponding structure of a space in the filter having a vertical and horizontal component as described in the specification. Additionally, the district court had read the “sleeve” as a single continuous structure with two open ends.

The Federal Circuit rejected the district court’s conclusion that the language “means defining an air collecting space” denotes a means-plus-function claim. The Court stated that although the presumption of a means-plus-function claim arose from the mere use of the “means for” language, this presumption was rebutted by the sufficiently definite structural parameters found in the claim regarding the air-collecting space. In particular, the claim language describes the “air collecting space” as a void that is structurally defined as part of the insert, formed at the bottom of the insert and extending upwardly along the sidewalls and to the opening of the sleeve. This element is further defined in the written description as half-tubes and tunnels formed in the bottom and sidewalls of the insert. The Court further rejected Brita’s contention that the air-collecting space includes all air space between the insert and sleeve, including any “ambient” air.

Brita also challenged the construction of the term “sleeve,” arguing that a sleeve could be a structure

made up of two parts. The Federal Circuit concluded, however, that the ordinary meaning of the term “sleeve” means a continuous structure that fits over and around another structure.

Finally, Brita took issue with the district court’s conclusion that the language “extending upwardly at least partially towards the side wall, and to the opening in the sleeve” meant that the air-collecting space must fully extend to the opening of the sleeve. This conclusion, however, is reinforced by the prosecution history. Originally, Brita did not include the language regarding the extension of the air-collecting space to the sleeve opening. When amending the claims to include the language, Brita stressed that the air-collecting space must extend to the level of the opening. Therefore, Brita had locked itself into this claim construction.

Against this construction, the Federal Circuit considered the appropriateness of the grant of SJ. The Court found no literal infringement and ruled that the DOE must be limited by prosecution history estoppel. Because Brita argued during prosecution that the air-collecting space must extend to the sleeve opening, Brita is now estopped from claiming that an air-collecting space that does not extend to the opening is equivalent. Thus, the SJ of noninfringement was affirmed.

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## Court “Tracks” Inventorship of Transponder Patents

Charles D. Niebylski

**[Judges: Michel (author), Clevenger, and Bryson]**

In *Trovan, Ltd. v. Sokymat SA*, No. 99-1474 (Fed. Cir. Sep. 8, 2000) (nonprecedential decision), the Federal Circuit affirmed a grant of JMOL that Ake Gustafson was the sole owner of U.S. Patent No. 5,572,410 (“the ‘410 patent”), and reversed a grant of SJ that Gustafson was not a coinventor of U.S. Patent No. 5,281,855 (“the ‘855 patent”) and remanded for trial.

Trovan, Ltd. (“Trovan”) is in the business of designing and distributing miniature passive transponders comprising an integrated circuit, an antenna, and a means for connecting the two. These transponders may be used to identify or track animals. In 1988, Trovan approached Sokymat SA (“Sokymat”), a coil-winding company headed by Gustafson, to develop an automated means of winding wire to make antenna coils so that miniature transponders could be mass produced. Sokymat and Trovan entered into a Nondisclosure Agreement (“NDA”) in October 1989, covering Trovan transponder technology. Subsequently, Gustafson worked with others on the “Trovan Project” to develop new transponder technology.

Trovan was granted the ‘855 patent on January 25, 1994, which claimed transponder technology developed in the Trovan Project. The Trovan Application named Messrs. Hadden and Zirbes, but not Gustafson, as coin-

ventors. Gustafson separately filed a Swiss Application for a means for connecting the integrated circuit and antenna similar to a connection claimed in the '855 patent. He did not list the other members of his team as coinventors, nor did he inform them of his application. Gustafson was granted the '410 patent on November 5, 1996, which claimed priority to the Swiss Application.

In district court, Trovan asserted ownership of the '410 and '855 patents and contended that Sokymat had infringed these patents. Sokymat counterclaimed to correct inventorship on the Trovan '855 patent to add Gustafson, and counterclaimed on the '410 patent for DJ that Gustafson is sole inventor. The parties reached and filed a settlement agreement contingent upon the outcome of this appeal.

The district court ruled that Gustafson was not a coinventor of the '855 patent because no reasonable jury could have found that he had exercised more than the normal skill expected of one skilled in the art.

The Federal Circuit vacated the district court's SJ that Gustafson was not a coinventor of the '855 patent because evidence of whether Gustafson's contribution was unambiguously communicated to the other team members is undeniably a dispute of material facts. Also, the Federal Circuit found that a genuine issue of fact exists as to whether Gustafson's thermal compression bonding means, which was known and used in circuit boards but not in chips to attach antennae, could be considered a significant inventive contribution. SJ was therefore inappropriate.

Upon remand, the Federal Circuit instructed the district court to try both issues of whether Gustafson was erroneously not named in an issued patent and

whether such error arose without any deceptive intention. According to the Court, if both are found, then Trovan should be ordered to file a certificate of correction and Sokymat found not liable for infringement. If deceptive intent is found, then the district court should invalidate the patent. If Gustafson is found to have been correctly not listed as an inventor on the '855 patent, then the patent is valid and infringement by Sokymat as conceded.

The Federal Circuit also affirmed the district court's JMOL that Gustafson was the sole inventor of the '410 patent because there was no evidence that the invention disclosed and claimed in the '410 patent was subject to the provisions of the NDA. The NDA was written to protect existing intellectual property, and not to protect future inventions, and the '410 patent did not exist at the time the NDA was signed. Since no other proof of assignment had been made, the Federal Circuit denied the cross-appeal and affirmed the grant of JMOL that Gustafson is the sole owner of the '410 patent.

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**In Last Month at the Federal Circuit**, certain terms, titles, and names of federal agencies that are frequently referred to, appear in abbreviated forms or as acronyms. These abbreviated forms and acronyms are listed below.

ALJ	Administrative Law Judge
APJ	Administrative Patent Judge
Board	Board of Patent Appeals and Interferences
Commissioner	Commissioner of Patents and Trademarks
DJ	Declaratory Judgment
DOE	Doctrine of Equivalents
JMOL	Judgment as a Matter of Law
MPEP	Manual of Patent Examining Procedure
PCT	Patent Cooperation Treaty
PTO	United States Patent and Trademark Office
SM	Special Master
SJ	Summary Judgment