

Last month at

# The Federal Circuit



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**PLAINTIFF REBUTS *FESTO* PRESUMPTION AGAINST DOE**

Prosecution history establishes that the rationale underlying amendments narrowing the scope of claims bears no more than a tangential relation to the equivalent in question. *Insituform Techs., Inc. v. Cat Contracting, Inc.*, No. 99-1584 (Fed. Cir. Oct. 4, 2004) . . . . .1

**DICTIONARY DEFINITION DOES NOT TRUMP INTRINSIC RECORD FOR CLAIM CONSTRUCTION**

Despite contentions to the contrary, cases such as *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed. Cir. 2002), do not require, or even allow, the Court to disregard the intrinsic record. *C.R. Bard, Inc. v. U.S. Surgical Corp.*, No. 04-1135 (Fed. Cir. Oct. 29, 2004) . . . . .1

**DJ SUIT SHOULD NOT HAVE BEEN DISMISSED**

Threats of patent infringement were not aimed at negotiation but at impeding a competitor's commercial activity. *Capo, Inc. v. Dioptics Med. Prods., Inc.*, No. 04-1045 (Fed. Cir. Oct. 25, 2004) . . . . .2

**DISCLOSURE IN PATENTS PREVENTS MISAPPROPRIATION OF TRADE-SECRET CLAIM**

Although party later utilized technology disclosed under confidential agreement, it did not do so until after that technology was disclosed in issued patents. *On-Line Techs., Inc. v. Bodenseewerk Perkin-Elmer GmbH*, No. 04-1291 (Fed. Cir. Oct. 13, 2004) . . . . .2

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The district court failed to analyze the "public nature" of premarket activities and exhibition by furniture company as invalidating public use. *Bernhardt L.L.C. v. Collezione Europa USA, Inc.*, No. 04-1024 (Fed. Cir. Oct. 20, 2004) . . . . .3

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**GOVERNMENT CONTRACTOR FORFEITS PATENT FOR FAILURE TO DISCLOSE INVENTION TO ARMY**

Government contract requiring contractor to identify inventions on DD Form 882 must be strictly enforced to permit government to properly identify inventions. *Campbell Plastics Eng'g & Mfg., Inc. v. Brownlee*, No. 03-1512 (Fed. Cir. Nov. 10, 2004) . . . . .6

EDITED BY | VINCE KOVALICK

This publication brings you a synopsis of patent cases decided over the last months by the United States Court of Appeals for the Federal Circuit based on slip opinions received from the court. Given the small number of precedential cases in Nov. 2004, we combined them with the Oct. 2004 cases. You can review and download the full text of each opinion by visiting our website at [www.finnegan.com](http://www.finnegan.com)

## Plaintiff Rebutts *Festo* Presumption Against DOE

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

In *Insituform Technologies, Inc. v. Cat Contracting, Inc.*, No. 99-1584 (Fed. Cir. Oct. 4, 2004), the Federal Circuit affirmed a judgment of infringement with respect to the Defendants, vacated a finding of willful infringement and remanded for further proceedings on that issue with respect to certain Defendants, and vacated the district court's damages award and remanded for further proceedings on that issue.

This case has a lengthy procedural history concerning a complex series of trials and appeals spanning nearly fourteen years. *Insituform Technologies, Inc.* and other related parties (collectively "*Insituform*") sued *Cat Contracting, Inc.* and others (collectively "*Cat*") for infringement of U.S. Patent No. 4,366,012 ("the '012 patent"), which is directed to a process for rehabilitating underground pipe without digging it up. Specifically, the claim at issue of the '012 patent claims a process for impregnating a flexible tube liner with resin prior to insertion of the liner into a damaged pipe.

The infringement question was one of equivalency and required a determination of whether the Plaintiffs were barred by prosecution history estoppel from asserting the DOE. The Federal Circuit ruled that the rationale underlying amendments made during the prosecution history bore no more than a tangential relation to the equivalent in question and, therefore, rebutted the *Festo* presumption that a narrowing amendment made for a reason of patentability surrenders the entire territory between the original claim limitation and the amended limitation. Specifically, the Court ruled that an amendment limiting the literal scope of claim 1 to a "single cup process" bore only a tangential relation to the equivalent in question, i.e., a process using "multiple cups." The patentee had merely argued that the amended claim did not have the disadvantage of a large compressor at the end of the liner as in that prior art. There simply was no relationship between the narrowing amendment and a multiple-cup process, according to the Federal Circuit.

The damages trial had been bifurcated from the infringement issues and was conducted under the assumption that two different processes infringe the '012 patent. The Federal Circuit had previously determined, however, that only one of those processes infringed. Based on testimony from two previous trials and new evidence, on this appeal,

the Court amended its damages ruling. *Cat* argued that the district court had erroneously ruled on damages based on deposition and affidavit testimony without the opportunity to observe and assess the credibility of the new witnesses. The Federal Circuit agreed that the procedure chosen by the district court was tantamount to a trial by affidavit. The deposition testimony of the two additional witnesses combined with inconsistent testimony from witnesses at two different trials created a disputed issue of material fact upon which the quantum of damages turned. Accordingly, the Federal Circuit vacated and remanded the damages issue.

Concerning willfulness, *Cat* had failed to obtain an opinion of counsel, and the district court found willful infringement. The Federal Circuit vacated this decision, concluding that its elimination of the adverse inference arising from failure to obtain an opinion of counsel is a material change requiring a fresh weighing of the evidence in this case.

The district court had also found that *Cat* and another Defendant were liable for induced infringement because they had taught their licensees to use an infringing process. Concerning intent, *Cat*'s and the other Defendant's licensing activities had occurred after the first trial with full knowledge that the process had been accused of infringing. Thus, the Federal Circuit concluded that the evidence of record supported the finding of induced infringement.

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## Dictionary Definition Does Not Trump Intrinsic Record for Claim Construction

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

In *C.R. Bard, Inc. v. United States Surgical Corp.*, No. 04-1135 (Fed. Cir. Oct. 29, 2004), the Federal Circuit affirmed the district court's claim construction and judgment of noninfringement.

*C.R. Bard, Inc.* and its subsidiary (collectively "*Bard*") asserted U.S. Patent No. 4,356,432 ("the '432 patent") against *United States Surgical Corporation* ("*U.S. Surgical*"). The '432 patent relates to an implantable prosthesis for repairing a tissue or muscle wall, typically a hernia defect.

The infringement dispute centered around the proper claim construction of a claimed hollow plug. *U.S. Surgical* argued that the hollow plug implant must include a pleated surface. Because its accused implants did not include any pleated surfaces, *U.S. Surgical* reasoned, its implants did not infringe. The district court agreed.

On appeal, the Federal Circuit rejected Bard's arguments that standard dictionary definitions should trump the intrinsic evidence. The Court observed that the Summary of the Invention and the Abstract of the Invention in the '432 patent both require the implant to include a pleated surface. Moreover, each embodiment in the specification referred to a pleated plug. Accordingly, although the term "pleated" did not occur in the claims, the Court concluded that properly construed, the claim should include pleats. The Court also observed that during reexamination of the patent, Bard stated that "the surface of the inventive plug is pleated," which constituted a clear disclaimer of scope.

### DJ Suit Should Not Have Been Dismissed

[Judges: Newman (author), Lourie, and Dyk]

In *Capo, Inc. v. Dioptics Medical Products, Inc.*, No. 04-1045 (Fed. Cir. Oct. 25, 2004), the Federal Circuit ruled that a district court exceeded its discretionary authority in dismissing a DJ action. Dioptics Medical Products, Inc. ("Dioptics") produces "wear-over" sunglasses adapted to fit over or clip onto eyeglasses. Capo, Inc. ("Capo") is a wholesale marketer of sunglasses and has been a customer and reseller of Dioptics's products since 1988. In 2000, Capo developed its own wear-over sunglasses and was preparing to market the product. When Dioptics learned of Capo's intentions, it informed Capo that it had several patents and would vigorously enforce its patents against infringers, but that it wished to avoid a legal dispute with a valued customer. The presidents of the two companies had several other exchanges, and Dioptics indicated that it would have no choice but to defend its patents against infringement.

Capo then filed its DJ complaint, seeking a declaration of noninfringement of fourteen Dioptics design patents. Dioptics moved to dismiss the DJ action, contending that it could not have threatened suit for infringement because Dioptics had not seen Capo's product and no one had analyzed it for infringement of any Dioptics patents. Capo contended that it had definite conviction that Dioptics would sue it for patent infringement unless it withdrew its product from the marketplace. The district court found that the dispute was not sufficiently crystallized for a DJ action.

The Federal Circuit concluded that Dioptics's threats were not aimed at negotiation but at impeding a competitor's commercial activity. Its

threats created the reasonable apprehension of suit in Capo. The Court rejected Dioptics's argument that it had not adequately investigated Capo's infringement, and concluded that Capo was not required to verify the extent to which the accuser had studied the accused product before acting to declare its commercial rights. Accordingly, the Federal Circuit ruled that the district court had erred in declining to find that Capo had a reasonable apprehension of suit.

### Disclosure in Patents Prevents Misappropriation of Trade-Secret Claim

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

In *On-Line Technologies, Inc. v. Bodenseewerk Perkin-Elmer GmbH*, No. 04-1291 (Fed. Cir. Oct. 13, 2004), the Federal Circuit vacated a grant of SJ of noninfringement and remanded that issue. The Court also affirmed the grant of SJ with respect to several state-law claims and procedural issues.

On-Line Technologies, Inc. ("On-Line") obtained U.S. Patent No. 5,440,143 ("the '143 patent") directed to a method for increasing the length of a light path in a gas cell while correcting for astigmatism. Such devices are used in an infrared spectrometer to determine the composition of gases. On-Line sued Bodenseewerk Perkin-Elmer GmbH and several related companies (collectively "Perkin-Elmer") for patent infringement and several state-law claims, including misappropriation of trade secrets, violation of the state law of unfair competition, breach of contract, and fraud. On-Line alleged that pursuant to a Nondisclosure Agreement, it had revealed its gas-cell design to Perkin-Elmer scientists in anticipation of a possible business arrangement. Perkin-Elmer then allegedly copied what it had learned from On-Line. The district court granted SJ in favor of Perkin-Elmer on all of On-Line's state-law claims and granted SJ of noninfringement.

On appeal, the infringement issue turned on the claim limitation that called for mirrors to have "substantially spherical concave reflective surfaces," and "at least one of the objective surfaces having a cylindrical component added thereto." Perkin-Elmer argued that its objective mirrors had toroidal surfaces and, therefore, did not infringe.

The patent specification describes the contour of the spherical objective mirrors as "approaching toroidal." The district court reasoned that mirrors that "approach toroidal" cannot actually be

toroidal. Thus, the district court construed the claims to exclude toroidal mirrored surfaces. The district court also concluded that because toroidal surfaces were disclosed but not claimed, the patentee was barred from applying the DOE. The Federal Circuit rejected the district court's reasoning and concluded just the opposite. According to the Court, the specification makes clear that the claim language referring to spherical surfaces with cylindrical components does include toroidal surfaces.

Concerning the trade-secret claim, the evidence showed that Perkin-Elmer did not begin to incorporate the features of On-Line's gas cell into its own product until after the '143 patent had issued. The Court noted that information contained in a patent or published materials does not qualify for protection as a trade secret. Also, other technology that Perkin-Elmer had used was disclosed in a third-party patent. Therefore, Perkin-Elmer did not misappropriate trade secrets.

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## Public Display May Not Be Public Use of Furniture Designs

[Judges: Linn (author), Mayer, and Michel]

In *Bernhardt L.L.C. v. Collezione Europa USA, Inc.*, No. 04-1024 (Fed. Cir. Oct. 20, 2004), the Federal Circuit vacated a district court's decision that six design patents were not infringed and that four of the patents were invalid for prior public use.

Bernhardt L.L.C. ("Bernhardt") owns the six design patents at issue (collectively "the patents-in-suit"). Collezione Europa USA, Inc. ("Collezione") imports and sells furniture. Bernhardt participates in the International Home Furnishing Market ("Market") held in October and April of each year in North Carolina. One month prior to the Market event, Bernhardt conducts a "Premarket" exposition ("Premarket"), at which it showcases its new designs to key customers and industry newspaper representatives. To be admitted to Premarket, an attendee must have identification, which is checked in the lobby of the exhibition building. Attendees are escorted by security personnel but are not required to sign confidentiality agreements. Attendees may not take pictures of any of the designs. Bernhardt also showcases its new designs in its showroom in the form of mock-ups, prototypes, and drawings. The designs that are subject to the patents-in-suit, with some modifications, were adopted into Bernhardt's Coronado collection, which was showcased at the September 1999 Premarket and then introduced to the public at the following Market.

Following a trial, the district court held that the designs covered by four of the patents-in-suit had been placed in public use by Bernhardt at the September 1999 Premarket exhibition, rendering them invalid. The district court also held all six patents to be noninfringed.

The district court had found that although some changes may have been made to the furniture designs exhibited at the Premarket, what was shown was not substantially different from the patented designs depicted in the Premarket patents. The Federal Circuit ruled that to invalidate a design patent based on a prior public use, the fact finder must compare the claim and the prior public use, employing both the "ordinary observer" and "point of novelty" tests. The Court concluded that it was unclear from the district court's opinion whether both of these tests were correctly applied. The Federal Circuit concluded that the district court had overlooked the evidence showing that, under the circumstances, a confidentiality agreement was not necessary. Bernhardt showed that the Premarket was not open to the public; the witnesses and attendees were identified, logged, and escorted; and they were not permitted to make notes or take photographs. Absence of a confidentiality agreement in this instance is not dispositive. Thus, the district court's analysis of the "public" nature of the exhibition was incomplete.

For these reasons, the Federal Circuit vacated the district court's finding of invalidity based on a public use and remanded on that issue.

Concerning infringement, the district court had found that Bernhardt had failed to establish that Collezione's designs appropriated the points of novelty of the furniture designs. The Court commented that it has not unequivocally spoken as to what minimum evidence the patentee must present to satisfy its burden under the point of novelty tests. Accordingly, the Court held that the patentee must introduce into evidence, at a minimum, the design patent at issue, its prosecution history, and the relevant prior art references cited in the prosecution history; and must present, in some form, its contentions as to points of novelty. In this case, Bernhardt submitted all of these requirements and its contentions as to the points of novelty contained in its proposed findings of fact and conclusions of law. Although Bernhardt did not present an expert witness, that was not necessary. Because the district court incorrectly required Bernhardt to explain its points of novelty through the testimony of a witness, the Federal Circuit vacated the district court's judgment of noninfringement and remanded on the issue.

## Court Reverses Jury Verdict Based on Biased Juror

[Judges: Prost (author), Newman, and Dyk]

In *Caterpillar, Inc. v. Sturman Industries, Inc.*, No. 03-1444 (Fed. Cir. Oct. 28, 2004), the Federal Circuit reviewed issues between the parties concerning a finding relating to trade-secret misappropriation in favor of Caterpillar, Inc. ("Caterpillar") and concerning inventorship issues on several patents.

Oded Sturman had worked with Caterpillar employees for several years to develop a fuel injector valve using residual magnetic latching. The parties signed a Joint Development Agreement ("JDA"). During a "brain-storming" session between Mr. Sturman and Caterpillar engineers, Mr. Sturman sketched an idea for a specific integrated spool valve using a particular grade of steel for residual magnetic latching. Although Caterpillar rejected the idea, Caterpillar engineers recognized that the design had potential and began exploring ideas of using an integrated spool valve for a hydraulically actuated, electronically controlled unit injector ("HEUI"). Caterpillar never informed Mr. Sturman about its work using an integrated spool valve for a HEUI. Later, Caterpillar offered Mr. Sturman a lump sum and, in exchange, sought a release of any claims involving the JDA. The parties exchanged correspondence concerning the scope of what was being released and what intellectual property arose under the JDA. Thereafter, Mr. Sturman began working on other projects as a consultant and focused on an integrated spool valve design for other clients. He then filed two patent applications claiming this technology. The first issued as U.S. Patent No. 5,640,987 ("the '987 patent") and the second as U.S. Patent No. 5,460,329 ("the '329 patent").

Meanwhile, Caterpillar continued with its own designs for use in an HEUI and filed its own patent application covering this technology, naming Mr. Sturman as a coinventor. Mr. Sturman refused, however, to assign the application or assign his rights to Caterpillar. Accordingly, that application was abandoned. However, Caterpillar filed a separate application that did not name Mr. Sturman as an inventor and that ultimately issued as U.S. Patent No. 5,479,901 ("the '901 patent").

At trial, Mr. Sturman had generally thought to strike for cause any potential jurors with close ties to Caterpillar. However, one particular juror, juror no. 3, the spouse of a current Caterpillar employee, ultimately sat on the jury. The Federal Circuit ruled that Mr. Sturman had properly objected to juror no. 3 and, therefore, the district court had erred in sit-

ting her. The Court concluded that this juror was impliedly biased and had a financial interest in the case because her husband worked for Caterpillar at the time of trial. Accordingly, the Court vacated the jury's verdict in favor of Caterpillar on its claims of trade-secret misappropriation, breach of contract, and conversion, and ordered a new trial on those issues.

The district court also granted SJ to Caterpillar, ruling that Caterpillar had not fraudulently induced Mr. Sturman into signing an amendment to the JDA. The Federal Circuit concluded, however, that a genuine issue still existed as to whether, during the negotiations of the terms of the amendment, Caterpillar knowingly and falsely created the impression that it considered only two inventions to have been developed under the JDA, and that the integrated spool valve design was not one of them. Thus, this issue was remanded for trial.

As to the inventorship issues, the Federal Circuit agreed with the district court's finding that Caterpillar's engineers were not coinventors of the '329 and '987 patents. Although Caterpillar engineers may have identified a specific type of steel for the claimed integrated spool valve, the Court found that this particular type of steel was an insignificant contribution whose magnetic properties were publicized and known.

As to Caterpillar's '901 patent, the district court had concluded that Mr. Sturman was the sole inventor of the '901 patent. The Federal Circuit, however, concluded that although Mr. Sturman had conceived of the two-way integrated spool valve, the '901 patent was directed to a three-way integrated spool valve that was admittedly more complex than the two-way valve. Moreover, Mr. Sturman did not present clear and convincing evidence that he had also conceived of a three-way version of the valve. Accordingly, he had failed to prove that he was the sole inventor of the '901 patent. The Court declined to address whether or not Mr. Sturman was a joint inventor of the '901 patent.

## ITC Failed to Consider Invalidity Defenses During Enforcement Proceedings for General Exclusion Order

[Judges: Linn (author), Cleverger, and Bryson]

In *Vastfame Camera, Ltd. v. International Trade Commission*, No. 03-1426 (Fed. Cir. Oct. 7, 2004), the Federal Circuit vacated a decision of the ITC concerning infringement because the ITC's decision

refused to allow Vastfame Camera, Ltd. (“Vastfame”) to present its invalidity defense.

This appeal concerns another decision by the ITC involving disposable film cameras. The ITC had previously issued a general exclusion order in June 1999. Although Vastfame was not a party to that investigation and its cameras were not at issue in that investigation, it knew that the proceedings were taking place.

After the general exclusion order issued, Vastfame obtained a ruling from the U.S. Customs Service (“Customs”) that two of its cameras did not violate the general exclusion order. Fuji Photo Film Company, Ltd. (“Fuji”) then filed a complaint with the ITC concerning whether Vastfame had violated the general exclusion order. Vastfame pled an invalidity defense, but the ALJ refused to consider invalidity, ruling that the defense could not be raised in an enforcement proceeding. The ALJ eventually ruled that Vastfame’s cameras violated the general exclusion order and could no longer be imported.

The Federal Circuit reviewed the statutory authority for the ITC and could not agree with the ITC generally that if no specific statutory authority exists to the contrary, the ITC has the authority to conduct enforcement proceedings. Nonetheless, the Federal Circuit ruled that the ITC has authority to conduct proceedings to enforce general exclusion orders under the provisions of 19 U.S.C. § 1337(b).

Moreover, 19 U.S.C. § 1337(c) specifically states that “all legal and equitable defenses may be presented in all cases.” According to the Federal Circuit, the “all cases” phrase of § 1337(c) clearly encompasses investigations under § 1337(b). As a result, the ITC erred by not allowing Vastfame to present its invalidity defense.

## Court Orders New Determinations on Infringement of Disposable Cameras

[Judges: Bryson (author), Clevenger, and Linn]

In *Fuji Photo Film Co. v. International Trade Commission*, No. 03-1016 (Fed. Cir. Oct. 7, 2004), the Federal Circuit affirmed part of the ITC’s order relating to infringement by single-use or disposable 35 mm film cameras, but vacated another part of that order and remanded for a new determination of infringement concerning one patent.

Several years ago, the ITC found that twenty-six respondents had infringed one or more patents owned by Fuji Photo Film Company, Ltd. (“Fuji”) and issued a general exclusion order concerning fif-

teen Fuji patents. The ITC also issued cease and desist orders to twenty domestic respondents who were found to have had significant amounts of inventory in this country. The Federal Circuit upheld those orders.

Later, Fuji sought modification of a general exclusion order and named twenty respondents in the new proceeding, many of which were not respondents in the earlier proceeding. The ALJ made several findings of infringement involving seven patents, several of which are the subject of this appeal.

First, Fuji argued that the ITC had erred in construing claim 1 of reissued U.S. Patent No. Re 34,168 (“the ‘168 patent”). Fuji argued for a broad construction of the term “opening,” but the Federal Circuit agreed that the claim scope and specification required a more narrow construction. Specifically, the Court agreed that the term “opening” means a hole, breach, or aperture in a cover, not a three-dimensional open space of the sort argued by Fuji.

Fuji also argued that the ITC had erred in the construction of the term “said means” in claim 1 of the ‘168 patent. Specifically, the ITC ruled that reference to “said means” included the “shutter means” and the “film transporting means” but did not include the “taking lens” recited in claim 1. Fuji argued that notwithstanding the omission of the word “means” following “taking lens,” the taking lens should still be considered as one of “said means” referred to in claim 1. The Federal Circuit rejected this argument, concluding that the plain language of the claim provided clear direction. Since the word “means” was used in reference to two of these three components but not the third (“taking lens”), this third limitation was not a means limitation.

Concerning two other patents, the claims recite a light-tight film casing that must be destroyed to open the same. The Federal Circuit agreed with the ALJ that the evidence showed that the respondent’s accused cameras did not have film casings that must be destroyed to open them. The wife of one expert witness was able to obtain through the Internet the film needed to reload one of the cameras. The casing readily snapped back in place without any apparent loss of light-tightness.

Concerning claim 1 of U.S. Patent No. 4,972,649 (“the ‘649 patent”), the ITC had required all three steps of the claim to be performed in a “dark room,” even though the words “in a dark room” were only recited for the first step of that claim. The Federal Circuit concluded, however, that the fact that this limitation was included in only one of the three steps provided strong textual support

that the claim should be construed to distinguish between the first step and the other two. Moreover, nothing in the '649 patent required that a dark room be used for all three steps. Thus, according to the Federal Circuit, the ITC had erred in ruling otherwise.

Fuji also sought a cease and desist order against companies that import infringing products but maintain no inventory in the U.S. and those that do not import products but do business through third parties. The Federal Circuit concluded, however, that Fuji had not shown that the general exclusion order would be inadequate when enforced by customs.

## No Structural Equivalence

[Judges: Rader (author), Friedman, and Dyk]

In *Frank's Casing Crew & Rental Tools, Inc. v. Weatherford International, Inc.*, No. 03-1519 (Fed. Cir. Nov. 30, 2004), the Federal Circuit affirmed a district court's decision of no infringement of U.S. Patent No. 5,049,020 ("the '020 patent"). The '020 patent concerns a system for handling sections of well casing suspended within a derrick during oil-field operations. Specifically, the '020 patent claims a system for making up a vertically extending string of interconnected casing sections comprising a derrick, bracket subassembly, and a boom and jaw subassembly. The boom and jaw subassembly includes a means for pivoting and elevating the boom.

The district court ruled that the structure corresponding to this claimed means included lift and boom plates disclosed in the specification. Plaintiff argued instead that the relevant corresponding structure is a piston and cylinder subassembly disclosed in the specification. According to the Federal Circuit, the only structure identified in the '020 patent for performing the pivoting function is the lift plate under the boom. Although the '020 patent also discloses a piston and cylinder subassembly, that subassembly, in connection with the lifting function, includes a connection to the lift plate. Moreover, according to the Federal Circuit, during prosecution history, the applicants had stated that the lifting cylinder could not be used when directly connected to the boom, underscoring the essentiality of the lift plate to the claimed function.

On the issue of infringement, the Federal Circuit concluded that although the accused product performed the same function recited in the claims, its structure for doing so was not insubstan-

tially different from that in the '020 patent. Thus, the structure did not infringe under 35 U.S.C. § 112, ¶ 6. Moreover, because the lifting mechanism without a lift plate was in use before the filing of the patent, the Court did not find it necessary to conduct a separate analysis under the DOE.

The Court affirmed the district court's decision denying attorney fees.

## Government Contractor Forfeits Patent for Failure to Disclose Invention to Army

[Judges: Clevenger (author), Michel, and Dyk]

In *Campbell Plastics Engineering & Manufacturing, Inc. v. Brownlee*, No. 03-1512 (Fed. Cir. Nov. 10, 2004), the Federal Circuit affirmed a ruling by the Armed Services Board of Contract Appeals ("Board") upholding an Administrative Contracting Officer's ("ACO") demand for title to an invention developed pursuant to a contract between Campbell Plastics Engineering & Manufacturing, Inc. ("Campbell Plastics") and the U.S. Army Chemical Research, Development, and Engineering Center ("Army").

In 1992, Campbell Plastics entered into a contract with the Army to develop certain components of an aircrew protective mask. The contract included numerous clauses from the Federal Acquisition Regulations ("FAR"), including a patent retention-rights clause from 48 C.F.R. § 52.227-11 ("FAR 52.227-11"), which requires a contractor to disclose any subject invention developed pursuant to a government contract. The contract also includes 48 C.F.R. § 252.227-7039, which requires a contractor to disclose subject inventions in interim reports. The inventions were to be disclosed on DD Form 882.

In October 1992, Mr. Richard Campbell, president of Campbell Plastics, submitted to the Army a form wherein he stated that they had no inventions. He did the same in 1993 and 1994. Thereafter, Campbell Plastics did not submit another form concerning inventions. In October 1997, Campbell Plastics filed a patent application for a sonic-welded gas mask and process, which was the subject of Campbell Plastics's contract with the Army. That application issued as U.S. Patent No. 5,895,537 ("the '537 patent") and expressly reserved for the government a paid-up license. In April 1999, Campbell Plastics notified the Army in writing of the '537 patent. After an exchange of letters between the parties, an ACO ultimately con-

cluded that Campbell Plastics had forfeited title to the patent by failing to comply with FAR 52.227-11. Campbell Plastics argued that although it did not disclose this invention in the form of DD Form 882 as required by the contract, it disclosed all technical aspects of the invention to the Army, including an enabling disclosure, by June 1997. Thus, Campbell Plastics argued that its failure to disclose using the proper forms was simply a matter of form that should not result in the forfeiture of title to the subject invention. The Board agreed that Campbell Plastics had failed to satisfy its contractual obligation to inform the Army that it considered sonic welding to be an invention.

The Federal Circuit found the language of the controlling FARs to be clear and unambiguous in requiring the use of DD Form 882 for disclosing subject inventions. The Court found the contract

requirement of a single, easily identified form on which to disclose any invention to be sound and needing strict enforcement, because, if not, the methods of disclosure would vary widely from case to case and the government could never be sure which communications were part of an overall invention disclosure.

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

ALJ	Administrative Law Judge
ANDA	Abbreviated New Drug Application
APA	Administrative Procedures Act
APJ	Administrative Patent Judge
Board	Board of Patent Appeals and Interferences
Commissioner	Commissioner of Patents and Trademarks
CIP	Continuation-in-Part
DJ	Declaratory Judgment
DOE	Doctrine of Equivalents
FDA	Food & Drug Administration
IDS	Information Disclosure Statement
IP	Intellectual Property
ITC	International Trade Commission
JMOL	Judgment as a Matter of Law
MPEP	Manual of Patent Examining Procedure
PCT	Patent Cooperation Treaty
PTO	United States Patent and Trademark Office
SEC	Securities and Exchange Commission
SJ	Summary Judgment
SM	Special Master