

Last month at

The Federal Circuit



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COURT CONSTRUES 35 U.S.C. § 272 FOR THE FIRST TIME

Section 272 provides that the use of certain foreign-owned means of transit or transport entering into the jurisdiction of the U.S. temporarily or accidentally is not an infringing use, provided a host of conditions are satisfied. "Temporarily" means for a limited period of time for the sole purpose of engaging in international commerce. *Nat'l Steel Car, Ltd. v. Can. Pac. Ry., Ltd.*, No. 03-1256 (Fed. Cir. Jan. 29, 2004)1

MOTIVATION TO COMBINE REFERENCES MAY BE FOUND IN THE NATURE OF THE PROBLEM TO BE SOLVED

A finding of obviousness does not require that an express, written motivation to combine appear in the prior art references to be combined; the motivation to combine may be found in the nature of the problem to be solved. *Ruiz v. A.B. Chance Co.*, No. 03-1333 (Fed. Cir. Jan. 29, 2004)2

THE DOE COMPENSATES FOR THE PATENTEE'S INABILITY TO CLAIM UNFORESEEABLE NEW MATTER

Court remands SJ of noninfringement for determination of whether PVA time-release agent was foreseeable alternative for HPMC agent. *SmithKline Beecham Corp. v. Excel Pharms., Inc.*, No. 02-1581 (Fed. Cir. Jan. 29, 2004)3

FORESEEABLE EQUIVALENT CANNOT BE REACHED BY DOE

Evidence shows that accused equivalent HPC time-release agent was foreseeable at time of filing and amending claims for HPMC agent. *Glaxo Wellcome, Inc. v. Impax Labs., Inc.*, No. 03-1013 (Fed. Cir. Jan. 29, 2004)4

RETAILER'S FAILURE TO TAKE APPROPRIATE ACTION LEADS TO WILLFUL INFRINGEMENT

Letter to retailer from manufacturer assuring that its products do not infringe was rejected by district court as "crudely drafted" and "cursory." *Golight, Inc. v. Wal-Mart Stores, Inc.*, No. 02-1608 (Fed. Cir. Jan. 20, 2004) . . .5

COURT CLARIFIES DISCLOSURE-DEDICATION RULE

The disclosure-dedication rule requires an inventor who discloses specific matter to claim it and to submit the broader claim for examination. Otherwise, that matter is dedicated to the public and may not be recaptured under the DOE. *PSC Computer Prods., Inc. v. Foxconn Int'l, Inc.*, No. 03-1089 (Fed. Cir. Jan. 20, 2004)6

DISTRICT COURT ERRED IN ITS INHERENT ANTICIPATION ANALYSIS

The fact that a characteristic is a necessary feature or result of a prior art embodiment (that is itself sufficiently described and enabled) is enough for inherent anticipation, even if that fact was unknown at the time of the prior invention. *Toro Co. v. Deere & Co.*, No. 03-1160 (Fed. Cir. Jan. 20, 2004)7

CIP APPLICATION CLAIMING GENUS IS DENIED BENEFIT OF EARLIER FILING DATE OF APPLICATION DISCLOSING SPECIES

Claims to a genus are not supported by an earlier disclosure of a species when the disclosure unequivocally identifies the species as unique. *In re Curtis*, No. 03-1215 (Fed. Cir. Jan. 6, 2004)8

COURT AFFIRMS REJECTION OF CLAIMS, EVEN THOUGH BOARD APPLIED NEW COMBINATION OF PRIOR ART

Appellants failed to show that Board's failure to explicitly rely on prior art reference for certain claims was harmful, and no remand was required. *In re Watts, Jr.*, No. 03-1121 (Fed. Cir. Jan. 15, 2004)10

Court Construes 35 U.S.C. § 272 for the First Time

Jay A. Stelacone

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

In *National Steel Car, Ltd. v. Canadian Pacific Railway, Ltd.*, No. 03-1256 (Fed. Cir. Jan. 29, 2004), the Federal Circuit reversed a district court's preliminary injunction in favor of National Steel Car, Ltd. ("NSC") against Canadian Pacific Railway, Ltd. ("CPR").

NSC owns the patent-in-suit, U.S. Patent No. 4,951,575 ("the '575 patent"), which is directed to a depressed center-beam flat railway car used to haul lumber. CPR is a Canadian railroad company that owns rail lines in the United States and Canada, and intended to use depressed center-beam flat cars to carry lumber shipments from Canada to the United States. For destinations beyond CPR-owned rail lines in the United States, CPR's flat cars are switched to trains powered by U.S.-owned locomotives. CPR's flat cars would spend over half of their time in the United States before returning to Canada.

NSC initiated the instant suit and moved for a preliminary injunction. The district court determined that NSC demonstrated a likelihood of success on the merits, and that CPR's defense to infringement under 35 U.S.C. § 272 and its invalidity defense lacked substantial merit.

Under § 272, the use of certain foreign-owned means of transit or transport for "temporarily" entering into the jurisdiction of the United States is not an infringing use under certain conditions. In rejecting CPR's defense under the statute, the district court considered the means of

transport to be the entire train, which would occasionally include U.S.-owned locomotives. Further, the district court found that CPR's flat cars were not "temporarily" present in the United States because they spend a majority of their time delivering lumber to United States destinations and because CPR would derive significant benefits from using the accused rail car in the United States. The Federal Circuit rejected these two findings and instead determined that the accused flat car is a "vehicle" within the meaning of the statute. Further, the Court defined a vehicle entering the United States "temporarily" as a vehicle entering the United States for a limited period of time for the sole purpose of engaging in international commerce.

Having construed the language of § 272, the Federal Circuit concluded that NSC had not demonstrated that CPR's defense based on § 272 lacked substantial merit at this preliminary injunction stage.

In support of its invalidity defense, CPR argued that the invention of the '575 patent was obvious in view of two U.S. patents issued many years earlier. The district court concluded that at the time the '575 patent was invented, there was no suggestion, teaching, or motivation to combine these two patents. The district court rejected CPR's use of two sources—one being a technical drawing, the other being testimony about an oral technical disclosure—predating the application for the '575 patent to demonstrate the requisite motivation to combine, concluding that these sources had not been disseminated so as to gain prior art status.

Noting that motivation can be found in the knowledge generally available to one of ordinary skill in the art, the Federal Circuit found the prior art status of the two sources irrelevant. Instead, the Court

ruled that the two sources are relevant to determining what was implicit in the knowledge of one of ordinary skill in the art at the time of invention of the '575 patent, and concluded that the two sources suggest that one of ordinary skill in the art would have been motivated to combine the two prior art patents. The Federal Circuit, therefore, held that the district court abused its discretion in granting the preliminary injunction because CPR's defenses have substantial merit.

Motivation to Combine References May Be Found in the Nature of the Problem to Be Solved

Edward Naidich

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

In *Ruiz v. A.B. Chance Co.*, No. 03-1333 (Fed. Cir. Jan. 29, 2004), the Federal Circuit affirmed a district court's finding, following a bench trial, that the patents-in-suit were invalid for obviousness over a combination of prior-art references.

The two patents-in-suit relate to a screw anchor with an earth-boring (screw) tip and a metal bracket used for underpinning a building foundation to support and stabilize the building. The prior art Fuller-Rupiper method uses a screw anchor with a concrete haunch instead of a metal bracket for supporting a building. The prior art Gregory patents are directed to an apparatus for underpinning structural foundations using a push pier (nonscrew) and a metal bracket. Following a bench trial, the district court found the patents-in-suit to be obvious under 35 U.S.C. § 103 over a combination of the teachings

of the Gregory patents and the Fuller-Rupiper method.

The Federal Circuit affirmed the district court's finding of obviousness. The Court began by explaining that section 103 requires consideration of the claimed invention as a whole. This requires a showing that an artisan of ordinary skill in the art at the time of the invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would select the various elements from the prior art and combine them in the claimed manner. In other words, the Examiner or court must show some suggestion or motivation, before the invention itself, to make the new combination.

The Court rejected the patent owner's argument that the district court had clearly erred in finding a motivation to combine the teachings in the Gregory patents with the Fuller-Rupiper method. The Court explained that a finding of obviousness does not require the prior art references to contain an express, written motivation to combine; instead, a motivation to combine prior art references may be found in the nature of the problem to be solved. The Court noted that the Gregory patents and the Fuller-Rupiper method address precisely the same problem as the patents-in-suit. The Court observed that this form of motivation to combine is particularly relevant with simpler mechanical technologies. Agreeing that the record did contain some evidence weighing against the district court's finding, the Court nevertheless found that it did not approach the level of evidence necessary to leave it with a firm conviction that the district court had committed clear error in its factual finding of a motivation to combine.

The Federal Circuit also rejected the patent owner's argument that the district

court had committed clear error in discounting its evidence of commercial success. The Court found that the record supported the district court's finding that any commercial success was not due to the patented combination, but rather due to the patent owner's experience with screw anchors combined with being the first large screw-anchor manufacturer to enter the underpinning market. Accordingly, the Court affirmed the judgment of the district court.

The DOE Compensates for the Patentee's Inability to Claim Unforeseeable New Matter

Robert W. Mann

[Judges: Rader (author), Plager, and Gajarsa]

In *SmithKline Beecham Corp. v. Excel Pharmaceuticals, Inc.*, No. 02-1581 (Fed. Cir. Jan. 29, 2004), the Federal Circuit vacated a district court's SJ of noninfringement because, under the DOE, questions of fact remained concerning the foreseeability of certain time-release agents alleged to be equivalent to a claimed time-release agent when the claims were amended.

SmithKline Beecham Corporation, doing business as GlaxoSmithKline ("GSK"), owns U.S. Patent No. 5,427,798 ("the '798 patent") directed to controlled sustained-release tablets containing bupropion hydrochloride. Bupropion is used to treat depression and addiction, and is marketed for the treatment of depression as Wellbutrin®SR, and as Zyban® for smoking cessation. The '798 patent is directed to a sustained-release composition containing hydrogels that

swell upon ingestion. The hydrogel described by the '798 patent is hydroxypropyl methylcellulose (HPMC).

Many of the original claims of the '798 patent did not recite HPMC as a limitation. During prosecution, the Examiner rejected the claims that did not recite HPMC for lack of enablement under 35 U.S.C. § 112, ¶ 1. GSK then amended those claims to overcome the rejection and to recite HPMC.

In response to an ANDA filing, GSK filed suit against Excel Pharmaceuticals, Inc. ("Excel") for infringement of the '798 patent. In Excel's ANDA filings before the FDA, Excel claimed that the proposed generic substitutes did not infringe the '798 patent because the proposed sustained-release compositions contained polyvinyl alcohol (PVA), a hydrogel-forming polymer, and did not contain HPMC.

The district court found that there was no literal infringement. Further, citing *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002) ("*Festo VIII*"), the district court found that, because the claims had been narrowed in order to comply with § 112, GSK was estopped from asserting infringement under the DOE, and the court granted SJ of noninfringement.

In reviewing the case, the Federal Circuit noted that, according to *Festo VIII*, not all narrowing amendments surrender subject matter that the DOE cannot later recapture. GSK noted that PVA could not have been added in an amendment at the pertinent time without drawing a new matter rejection, as GSK had not recited any controlled-release agents other than HPMC. Accordingly, it reasoned the *Festo* presumption was rebutted, and the DOE was justifiably invoked. The Federal Circuit rejected GSK's arguments, noting

that the *Festo* ruling was meant to reflect whether the applicant would have been expected to know of, and thus properly claim, the proposed equivalent at the time of the amendment.

The record contained some evidence showing that at the time the amendment was made, there were no known hydrogels other than HPMC that had been tested with bupropion to achieve sustained release. Thus, the record suggested that PVA was not a known sustained-release agent, with respect to bupropion, but the record on this issue was not fully developed for SJ purposes. Accordingly, the Court vacated the SJ and remanded.

Foreseeable Equivalent Cannot Be Reached by DOE

Kevin W. McCabe

[Judges: Rader (author), Gajarsa, and Plager]

The Federal Circuit also considered the '798 patent and estoppel issues in *Glaxo Wellcome, Inc. v. Impax Laboratories, Inc.*, No. 03-1013 (Fed. Cir. Jan. 29, 2004). In *Glaxo*, the Federal Circuit affirmed the district court's determination on SJ that Impax Laboratories, Inc. ("Impax") could not infringe the asserted claims under the DOE.

Impax, a manufacturer of generic pharmaceuticals, filed two ANDAs with the FDA, one for a generic version of Wellbutrin®SR, and the other for a generic version of Zyban®. In both ANDAs, Impax made a paragraph IV certification that its generic sustained-release bupropion hydrochloride tablets do not infringe Glaxo's '798 patent. The sustained-release

agent in Impax's proposed composition is hydroxypropyl cellulose (HPC). Upon receiving notice of Impax's ANDA filings, Glaxo filed suit against Impax alleging infringement of the '798 patent.

Arguing prosecution history estoppel, Impax moved for SJ of noninfringement. The trial court granted Impax's motion, noting in the process that the claim amendments indisputably narrowed the patent with respect to sustained release.

On appeal, Glaxo argued that the district court had erred in granting SJ because HPC is equivalent to HPMC. Glaxo further contended that it had not surrendered HPMC equivalents during prosecution of the '798 patent.

As it did in the *SmithKline* decision discussed above, the Federal Circuit found that Glaxo had narrowed the claims during prosecution and, in so doing, had presumptively surrendered the territory that embraced Impax's sustained-release agent. During prosecution, the Examiner had rejected the claims for lack of enablement. The Examiner considered the recitation of HPMC, the only disclosed sustained-release mechanism, "critical" for the controlled or sustained-release aspect of the claims. The Examiner also noted that the application's disclosure of a single species, HPMC, did not support claims to a generic concept. To overcome that rejection, Glaxo amended the claims to define HPMC.

Glaxo argued that because it could not have added HPC to its claims at the time of the amendment without drawing a new matter rejection, the presumption of claim surrender should not apply. The Federal Circuit rejected this argument, noting that the quintessential example of an enforceable equivalent—after-arising technology—would always be unclaimable new matter.

Contrary to the evidence in the *SmithKline* case concerning the foreseeability of PVA, the evidence in this case suggested that HPC was a foreseeable time-release agent at the time of filing and amendment. Accordingly, the Court found that Glaxo had not rebutted the presumption that prosecution history estoppel bars a finding of infringement under the DOE.

Not all of the claims were amended during prosecution. Rather, claim 1 originally recited HPMC as the sustained-release agent for bupropion. Because Glaxo did not amend this claim during prosecution, it argued that the presumption of claim surrender did not operate to divest that claim of its equivalents armor. The Federal Circuit ruled against Glaxo, however, based on the concept of “infectious estoppel.” To find otherwise, the Court concluded, would create inconsistency within the patent.

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Retailer’s Failure to Take Appropriate Action Leads to Willful Infringement

Kenneth M. Lesch

[Judges: Prost (author), Schall, and Archer (dissenting-in-part)]

In *Golight, Inc. v. Wal-Mart Stores, Inc.*, No. 02-1608 (Fed. Cir. Jan. 20, 2004), the Federal Circuit affirmed a judgment against Wal-Mart Stores, Inc. (“Wal-Mart”) that it infringed U.S. Patent No. 5,673,989 (“the ‘989 patent”) owned by Golight, Inc. (“Golight”) after finding no error in the district court’s claim construction.

The ‘989 patent is for a wireless, remote-controlled, portable search light. The only claim-construction dispute involved the claim limitation “horizontal

drive means for rotating said lamp unit in a horizontal direction.” The infringement question turned on whether this limitation requires that the search light be capable of rotating through 360°, because the accused product was not.

Wal-Mart argued that the patentees acted as their own lexicographers, giving the term “rotating” a special definition during prosecution. Wal-Mart relied on a statement in the prosecution history to overcome the prior art that “the claims in issue have been amended to recite rotation through at least 360°.” Wal-Mart argued that by repeatedly stating that the invention was different from the prior art because it rotated through 360°, the patentees unequivocally disavowed any other meaning of “rotate.” The Federal Circuit reasoned that these statements could be understood as applying only to claims that explicitly recited rotation “through greater than 360°” but not to the claim in question. Thus, the prosecution history does not provide a clear and unmistakable departure from the ordinary meaning of “rotating” or a clear disavowal of claim scope.

Wal-Mart also argued that the only “horizontal drive means” disclosed by the ‘989 patent, under a 35 U.S.C. § 112, ¶ 6 analysis, is one that rotates through 360°. The Federal Circuit determined that while the only embodiment in the ‘989 patent is capable of rotating through 360°, there is nothing in the written description that compels limiting the function to rotation through any particular angle. Moreover, the Court reasoned, to the extent the patent contains structures for permitting rotation through 360°, these structures are superfluous because they are not required for performing the claimed “rotate” function.

As a result, the Federal Circuit gave “rotating” its ordinary meaning and included in the corresponding structure

only the structure necessary to cause rotation, but not through any particular angle. Wal-Mart did not dispute that it infringed claim 11 under this claim construction and, therefore, the Federal Circuit affirmed the district court's holding of infringement.

Wal-Mart next argued that the combination of three prior-art references and obviousness-type double patenting—two arguments already considered by the Examiner during prosecution—invalidated the '989 patent. Wal-Mart failed, in the Federal Circuit's opinion, to provide evidence of any motivation to combine the three references. Further, during prosecution, the patentees filed a terminal disclaimer to overcome the same obviousness-type double-patenting issue in view of an earlier patent. Because the earlier patent is not prior art and because the Federal Circuit refused to infer from the terminal disclaimer that the patentees conceded that they could not obtain any new claim unless it contained a 360° limitation, the Court rejected Wal-Mart's arguments. Thus, the Federal Circuit affirmed the district court's decision that the '989 patent was not invalid.

Concerning damages, Wal-Mart argued that the royalty determined by the district court was unreasonable as a matter of law because it would have left Wal-Mart selling the accused product below cost. No rule states that a royalty be less than the infringer's net profit margin, the Federal Circuit reasoned, and Wal-Mart presented no evidence suggesting that the royalty determined was clearly erroneous. Thus, the Federal Circuit affirmed the district court's reasonable royalty findings.

The district court determined that Wal-Mart willfully infringed because it failed to take any action after receiving a cease and desist letter. Wal-Mart argued that it

obtained a letter from the manufacturer assuring that its products did not infringe. This letter was not admitted into evidence at trial, however, and the district court found that it was "crudely drafted" and "cursory." The Federal Circuit determined that, based on the evidence before the district court, it was not clearly erroneous for the district court to have found willful infringement. The Federal Circuit further affirmed the district court's award of attorney's fees because willfulness is a sufficient basis for finding a case exceptional and awarding attorney's fees.

Judge Archer dissented, arguing that the specification only describes a single structure, one that shows rotation only through 360°. Further, Judge Archer argued that the prosecution history and other statements in the specification fully support requiring rotation through 360°. Thus, he would have reversed the finding of infringement.

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Court Clarifies Disclosure-Dedication Rule

Roland G. McAndrews

[Judges: Gajarsa (author), Mayer, and Clevenger]

In *PSC Computer Products, Inc. v. Foxconn International, Inc.*, No. 03-1089 (Fed. Cir. Jan. 20, 2004), the Federal Circuit affirmed a SJ of noninfringement because the patentee had dedicated plastic clips to the public by disclosing that prior art clips were made of plastic, but explicitly claiming only clips made of metal.

PSC Computer Products, Inc. ("PSC") owns U.S. Patent No. 6,061,239 ("the '239 patent") directed to a retainer clip

for securing a heat-sink component to a microchip. The written description of the '239 patent describes the clip as including a component "made of a resilient metal such as stainless steel although other resilient materials may be suitable." The written description also states that "other prior art devices use molded plastic and/or metal parts that must be cast or forged which again are more expensive metal forming operations." The patent claim at issue recites a clip including a "resilient metal strap."

Foxconn International, Inc. ("Foxconn") sells plastic retainer clips for securing a heat-sink component to a microchip. PSC filed suit against Foxconn alleging that Foxconn's clip infringed the '239 patent under the DOE. Foxconn argued that PSC had dedicated clips with plastic parts to the public. The district court agreed with Foxconn and granted SJ of noninfringement.

In affirming the SJ, the Federal Circuit addressed two issues concerning what it coined as the "disclosure-dedication" rule. Namely, the Federal Circuit discussed (1) how specific a disclosure in a written description must be to dedicate matter to the public; and (2) whether the written description of the '239 patent was sufficiently specific to dedicate plastic parts to the public. With respect to the first issue, the Federal Circuit held that while the disclosure-dedication rule does not mean that any generic reference in a written specification dedicates all members of that particular genus to the public, if one of ordinary skill in the art can understand the unclaimed disclosed teaching upon reading the written description, such unclaimed disclosed matter has been dedicated to the public.

Regarding the second issue, the Federal Circuit found that one of ordinary skill in the art reading the specific disclosure in the '239 patent relating to prior

art devices using molded plastic parts could reasonably conclude that plastic clip parts could be substituted for metal clip parts. Accordingly, the Court concluded, PSC was obliged to either submit a broader claim covering both metal and plastic clips, or dedicate the use of plastic clips to the public. PSC chose the latter, thus putting the public on notice that clips made of metal parts would infringe and those made of plastic would not.

District Court Erred in its Inherent Anticipation Analysis

John Y. Pfeifer

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

In *Toro Co. v. Deere & Co.*, No. 03-1160 (Fed. Cir. Jan. 20, 2004), the Federal Circuit vacated the district court's holding and stipulated final judgment of validity regarding U.S. Patent No. 5,207,168 ("the '168 patent"); affirmed the district court's denial of SJ of invalidity for anticipation and its grant of SJ of infringement of the '168 patent; affirmed the district court's SJ of noninfringement of U.S. Patent Nos. 5,199,744 ("the '744 patent") and 5,101,745 ("the '745 patent"); and remanded the case for further proceedings on claim construction, anticipation, and other invalidity defenses regarding the '168 patent.

The three patents-in-suit, which share a common written description, relate to technology for lifting and fracturing soil to decrease subsurface soil density and thereby encourage turf growth. The technology involves using an apparatus with a row of adjacent nozzles that sporadically shoot concentrated jets of pressurized liquid into the turf and topsoil. Toro Company ("Toro") sued Deere & Company

("Deere") for infringement based on Deere's RZ1 700 machine. Deere countered with various defenses, including that the '168 patent was invalid as anticipated by U.S. Patent No. 4,907,516 ("the '516 patent") to Ramon Rogers, the eventual designer of Deere's RZ1 700 machine.

Claim 1 of the '168 patent recites a turf-treating method comprising three steps. On appeal, Toro argued that the '516 patent expressly disclosed two of the three steps and inherently disclosed the third step: "moving said source of incompressible liquid over the surface of said turf in a pattern such that the lateral dispersion from adjacent jets coact with another to lift and fracture the soil and reduce the general soil density."

The Federal Circuit ruled that the district court had erred in failing to construe this limitation. This lack of claim construction left unclear the precise scope of the limitation and made it impossible to know exactly what the prior art '516 patent must disclose if it were to inherently anticipate. Accordingly, the Federal Circuit remanded to the district court for further claim construction.

The Federal Circuit also disagreed with the district court's statement of the law governing inherent anticipation and, citing its recent decision in *Schering Corp. v. Geneva Pharmaceuticals, Inc.*, 339 F.3d 1373 (Fed. Cir. 2003), reiterated that the fact that a characteristic is a necessary feature or result of a prior art embodiment suffices for anticipation, even if that fact was unknown at the time of the prior invention. The Court went on to hold that, to properly show inherent anticipation, the prior art reference must have sufficiently described and enabled at least one embodiment that necessarily featured or resulted in the subject matter at issue, but neither description nor contemporaneous recognition of these necessary features or results was required. Accordingly,

the Federal Circuit affirmed the district court's denial of SJ of invalidity based on anticipation, but vacated the court's holding that the '168 patent was valid and remanded for further analysis of anticipation in accordance with its opinion.

Turning to the '744 and '745 patents, the Federal Circuit agreed with the district court's interpretation that claim 1 of both the '744 and '745 patents recites means-plus-function language and, thus, triggers § 112, ¶ 6 analysis. However, it disagreed with the district court's finding that claim 17 of the '744 patent is not written in means-plus-function format. Instead, the Federal Circuit found that claim 17 was subject to § 112, ¶ 6 and, therefore, limited to a structure that includes a mechanical cam system as disclosed and its equivalents. Deere used an electrically controlled solenoid system to periodically release pressurized liquid. The Court compared this structure to Toro's mechanical cam system and concluded that the electrically controlled solenoid system performs the claimed function in a substantially different way than the mechanical cam system. Accordingly, the Court affirmed the district court's grant of SJ of noninfringement of the '744 and '745 patents.

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CIP Application Claiming Genus Is Denied Benefit of Earlier Filing Date of Application Disclosing Species

Steven J. Scott

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

In *In re Curtis*, No. 03-1215 (Fed. Cir. Jan. 6, 2004), the Federal Circuit affirmed a decision of the Board that certain claims of U.S. Patent No. 5,209,251 ("the '251

patent”) in a merged reissue and reexamination proceeding lacked novelty.

The ‘251 patent is directed to dental floss made of polytetrafluoroethylene (“PTFE”) filaments covered with friction-enhancing coatings. The coatings provide the floss with a coefficient of friction (“COF”) of at least 0.08. This value falls within the “sweet spot” that makes floss not too sticky in the teeth and not too slippery in the hands.

The inventors, John P. Curtis et al. (collectively “Curtis”), received the ‘251 patent at the end of a series of CIP applications, the last being filed on July 11, 1991. Curtis then filed a reissue application adding claims to dental floss unrestricted by any COF value. W.L. Gore & Associates, Inc. (“Gore”) soon after requested reexamination of the claims of the ‘251 patent. The PTO merged the two proceedings.

The Examiner and Board handed Curtis a novelty rejection in view of one of his own related European patent applications that was published on October 4, 1989, more than one year before the July 1991 filing date of the application that led to the ‘251 patent. The European counterpart discloses PTFE filaments coated with microcrystalline wax and having the desired COF value. To sidestep this publication, Curtis sought priority to an earlier U.S. Application No. 07/282,962 (“the ‘962 application”), filed on December 2, 1988. As with the European case, the ‘962 application discloses PTFE filaments coated with microcrystalline wax. The Examiner and Board rejected Curtis’s request for priority, concluding that the disclosure of “microcrystalline wax” (a species) in the ‘962 application does not provide written-description support for “friction enhancing coatings” (a genus) used in the ‘251 patent claims.

Curtis argued that the ‘962 application disclosure of a microcrystalline wax coating conveyed to one skilled in the art a PTFE dental floss having a “friction enhancing coating.” The reason that the ‘962 application only disclosed microcrystalline wax in particular, Curtis argued, was that it was the most commonly used and cheapest dental-floss coating at the time of filing. Curtis believed that the decision of *In re Smythe*, 480 F.2d 1376 (C.C.P.A. 1973), squarely applied to his situation. In *Smythe*, the applicants sought, and were granted, priority benefit for the genus of “inert fluid” (encompassing both an inert gas and an inert liquid) in view of an earlier disclosure of only an “inert gas.”

The Board disagreed. Nowhere in the ‘962 application did Curtis name a suitable friction-enhancing coating for a PTFE dental floss other than microcrystalline wax. The ‘962 application itself expressed the “surprise” of the inventors to find that microcrystalline wax in particular, and from among different waxes, adheres to PTFE filaments, unexpectedly resulting in important benefits. In responding to an obviousness rejection, Curtis argued that “[t]he only wax that will effectively bind to PTFE is microcrystalline wax,” and “[w]hat can be adhered to PTFE surfaces can be determined only by trial and error There are no expectations of what will work. There is no obvious solution.”

The Federal Circuit concluded that the record contained considerable evidence demonstrating that microcrystalline wax was in fact the only friction-enhancing coating conveyed in the ‘962 application. The unpredictability in performance of friction-enhancing coatings, argued by Curtis to distinguish the prior art, undermined any reliance on *In re Smythe*. In the case of the Curtis invention, the

Federal Circuit concluded that almost all the evidence points to the conclusion that a person of ordinary skill would be hard-pressed to instantly recall any other species of friction-enhancing coatings that would adhere to PTFE. Even if a skilled person could do so, the written-description problem would remain because the '962 specification unequivocally identifies microcrystalline wax as unique and different in its ability to bind to PTFE. By definition, such a disclosure does not convey the knowledge that the overall genus of "friction enhancing coatings" has the same qualities. The Federal Circuit, therefore, denied Curtis the benefit of the '962 application filing date and affirmed the rejection of the claims.

Court Affirms Rejection of Claims, Even Though Board Applied New Combination of Prior Art

Frank A. Italiano

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

In *In re Watts, Jr.*, No. 03-1121 (Fed. Cir. Jan. 15, 2004), the Federal Circuit affirmed a decision by the Board that upheld a rejection of many claims of U.S. Patent Application No. 08/568,904 ("the '904 application") as being obvious. Although the Court found error in the Board's sustaining the rejection of claims 21 and 23, it found the error to be harmless and affirmed the Board's decision on a new ground of rejection.

The '904 application is directed to real-time thermal management for computers. The claimed system selectively

stops clock signals from being sent to a central processing unit ("CPU") in a computer when the computer reaches a certain temperature, thereby slowing down portions of the CPU and reducing heat production.

The Examiner rejected many of the claims as being obvious over U.S. Patent No. 5,590,061 ("Hollowell") in view of U.S. Patent Nos. 5,502,838 ("Kikinis") and 5,493,684 ("Gephardt"). The Examiner determined that the only claim element missing from Hollowell and Kikinis was stopping clock signals "to the CPU only when the CPU is not processing critical I/O." To cure the deficiency of Hollowell and Kikinis, the Examiner applied Gephardt.

The Examiner rejected other claims as being obvious over Hollowell in view of Kikinis and U.S. Patent No. 5,422,806 ("Chen"), but the Examiner did not specify whether the combination of Hollowell, Kikinis, and Chen disclosed the critical I/O function and did not rely on Gephardt as teaching this functionality.

Appellant, LaVaughn F. Watts, Jr., appealed the rejection to the Board, arguing that Gephardt does not teach the critical I/O element because it did not disclose detecting critical I/O activities. According to Watts, the activities mentioned in Gephardt were inconsistent with the claimed critical I/O activities. Watts also argued that Gephardt failed to teach slowing clock speed based on CPU activity and temperature. Watts also disputed the rejection of claims based on Hollowell, Kikinis, and Chen, submitting that the combination failed to teach or suggest the critical I/O element. The Board affirmed.

Watts argued, on appeal, that Gephardt does not teach or suggest stopping clock signals during noncritical information processing but not during critical

I/O processing. The Federal Circuit declined to consider the Appellant's argument regarding Gephardt, however, because the argument was raised for the first time on appeal.

Claims 21 and 23 were grouped with several other claims that were rejected as obvious over Hollowell, Kikinis, and Chen. The Board did so, contending that Watts had not articulated why these claims were separately patentable. The Federal Circuit concluded that the Board had erred in grouping the claims together because Watts had sufficiently argued them to be separately patentable. However, the Court found the error to be harmless, because it did not affect the Board's decision. Specifically, the Federal Circuit ruled that claims 21 and 23 could be grouped with the other claims that had been rejected based on Gephardt because Watts had made the exact same argu-

ments regarding Gephardt for claims 21 and 23 as he had for the other claims that were properly rejected based on Gephardt. The Court found that Watts even appeared to assume that the Board actually intended to rely on Gephardt in rejecting claims 21 and 23.

Accordingly, the Court found that Watts failed to show that the Board's failure to rely on Gephardt with respect to claims 21 and 23 was harmful error and, therefore, affirmed the Board's decision without remand.

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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