

Last month at

The Federal Circuit



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POSTER PRESENTATION CONSTITUTES A "PRINTED PUBLICATION"

Distribution and indexing are not the only factors to consider for printed publication; the key inquiry is whether the reference has been made publicly accessible. *In re Klopfenstein*, No. 03-1583 (Fed. Cir. Aug. 18, 2004)1

"DYING" PLANT APPLICATIONS RESUSCITATED

Nonenabling publication disclosing a plant variety plus foreign sales of the plant creates a bar under 35 U.S.C. § 102(b). *In re Elsner*, No. 03-1569 (Fed. Cir. Aug. 16, 2004)1

COURT REINSTATES JURY VERDICT OF VALIDITY, MODIFIES CLAIM CONSTRUCTION, AND REMANDS FOR NEW TRIAL

Recognition of a need does not render obvious the achievement that meets that need. *Cardiac Pacemakers, Inc. v. St. Jude Med. Inc.*, No. 02-1532 (Fed. Cir. Aug. 31, 2004)3

ELEVENTH AMENDMENT BARS CLAIM AGAINST STATE TO CORRECT INVENTORSHIP

State University's entrance into commercial arrangements and application for patent does not waive state's Eleventh Amendment immunity from federal suit for correction of inventorship. *Xechem Int'l, Inc. v. Univ. of Tex.*, No. 03-1406 (Fed. Cir. Aug. 31, 2004)4

PARTIAL PROTEIN SEQUENCE DOES NOT PROVIDE SUFFICIENT WRITTEN DESCRIPTION

Appellants provided no evidence that the full amino acid sequence of a protein can be deduced from a partial sequence and the limited additional physical characteristics that they identified. *In re Wallach*, No. 03-1327 (Fed. Cir. Aug. 11, 2004)5

HAIRBRUSH PRIOR ART INCLUDES TOOTHBRUSHES

Common sense must be considered in determining what prior art may be "analogous." *In re Bigio*, No. 03-1358 (Fed. Cir. Aug. 24, 2004)6

CLAIM BROADER THAN PREFERRED EMBODIMENT

Applicant's choice to disclose only a single embodiment does not mean that the patent clearly and unambiguously disavowed other embodiments. *Home Diagnostics, Inc. v. LifeScan, Inc.*, No. 03-1370 (Fed. Cir. Aug. 31, 2004)7

"OPERATIVELY CONNECTED" CONSTRUED TOO NARROWLY

Contrasting nature of the axioms that (a) a claim must be read in view of the specification and (b) a court may not read a limitation into a claim from the specification presents the long-standing difficulty in claim construction. *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, No. 04-1097 (Fed. Cir. Aug. 11, 2004)8

GENERAL AND CONCLUSORY TESTIMONY DOES NOT SUFFICE AS SUBSTANTIAL EVIDENCE OF INVALIDITY

Expert did not mention specific prior art reference after introducing it into evidence; therefore, jury's verdict of invalidity cannot be upheld. *Koito Mfg. Co. v. Turn-Key-Tech, LLC*, No. 03-1565 (Fed. Cir. Aug. 23, 2004)9

NOTHING PRECLUDES A DISTRICT COURT FROM MAKING ADJUSTMENTS TO A CLAIM CONSTRUCTION AS A TRIAL PROCEEDS

Party's failure to address ambiguity left in district court's claim construction during trial leads to affirmance of noninfringement. *Power Mosfet Techs., L.L.C. v. Siemens AG*, No. 03-1083 (Fed. Cir. Aug. 17, 2004) . . .10

Poster Presentation Constitutes a “Printed Publication”

Jeffrey C. Totten

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

In *In re Klopfenstein*, No. 03-1583 (Fed. Cir. Aug. 18, 2004), the Federal Circuit affirmed a decision of the Board, which upheld the PTO’s denial of Patent Application Serial No. 09/699,950 (“the ‘950 application”) because the applicants had described the invention in a printed publication more than one year prior to applying for a patent.

Appellants filed the ‘950 application on October 30, 2000, claiming methods of preparing foods containing extruded soy cotyledon fiber (“SCF”), which lowers serum cholesterol levels while raising HDL cholesterol levels. In particular, the ‘950 application disclosed a double-extrusion process, which enhanced SCF’s previously known lowering effect on cholesterol levels.

In October 1998, two years before applying for a patent, Appellants presented the process subsequently claimed in the ‘950 application to a meeting of the American Association of Cereal Chemists. During the meeting, Appellants displayed a copy of the presentation—which disclosed every limitation claimed in the application—on poster boards for two and one-half days. Later that same year, they displayed the same presentation, for less than a day, at an Agriculture Experiment Station at Kansas State University.

The presentation consisted of fourteen slides, including a cover page, an acknowledgement slide, and four slides presenting experimental data in graphical form. Of the eight substantive slides in the presentation, most contained information already known by persons of skill in the art. The presentation did not contain a confidential-

ity notice, or otherwise alert viewers that they could not copy or disseminate the information it contained. Appellants did not disseminate copies of the slides.

On appeal, Appellants argued that precedent required (1) distribution of copies or (2) indexing in a library or database for a reference to constitute a “printed publication.” The Federal Circuit rejected this assertion, noting that the key inquiry is whether a reference has been made “publicly accessible.” To make this assessment, the Court analyzed (1) the length of time Appellants displayed the presentation, (2) the expertise of the target audience, (3) the lack of reasonable expectation that the audience would not copy the displayed material, and (4) the relative ease of copying the displayed material. The Court stressed that Appellants displayed their presentation for three days to an audience including cereal chemists and took no measures to protect the information it contained. Moreover, the slides contained easily understood bullet points, which a person of skill in the art could easily copy or remember. Given these factors, the Court affirmed the Board’s decision.

“Dying” Plant Applications Resuscitated

Robert F. Shaffer

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

In *In re Elsner*, No. 03-1569 (Fed. Cir. Aug. 16, 2004), the Federal Circuit vacated and remanded the Board’s decision rejecting applicants’ plant applications under 35 U.S.C. § 102(b). The Board determined that Appellants’ published Plant Breeder’s Rights (“PBR”) applications anticipated their claims in view of the foreign sales of the claimed plants. The issue of first impression was whether evidence of the

foreign sale of a claimed reproducible plant variety may enable an otherwise non-enabled printed publication disclosing that plant, thereby creating a § 102(b) bar. While the Court held that the publication of the applications coupled with foreign sales of the plants may constitute a § 102(b) bar to patentability, it vacated and remanded the case because (1) the record was silent on the extent to which the foreign sales were known to the public, and (2) the Board did not adequately address the degree to which availability of the plants through foreign sales enabled the preparation of the claimed plants.

Wilhelm Elsner, a plant breeder in Germany, filed an application for a Community Plant Variety Rights (“CPVR”) Certificate, or PBR, at the Community Plant Variety Office (“CPVO”) in Europe for a type of geranium named “Pendec.” Elsner’s application was listed in the CPVO Official Gazette that was published in December 1997. That listing only disclosed the names and addresses of the breeder and its representative, a statement of botanical classification, and a provisional denomination for the plant. In July 1998, a sale of the Pendec geranium occurred in Germany. Elsner withdrew the application in May 1999, and it did not therefore mature into a CPVR certificate. In September 2000, Elsner filed a plant patent application claiming the Pendec geranium.

The Board affirmed the Examiner’s rejection of the only claim in the application as anticipated under § 102(b) on the ground that the CPVO listing disclosed the invention and that the sales placed the skilled artisan in possession of the invention more than one year before the effective filing date.

On appeal, Elsner argued that foreign activity cannot cause a non-enabled publication to constitute a statutory bar under § 102(b). Appellants further asserted that,

because foreign sales are not prior art under the patent statute, they may not be considered within the knowledge of one of skill in the art and cannot be used to enable an otherwise nonenabling publication. Accordingly, Appellants claimed that the published PBR applications are not enabled because it is impossible to recreate the claimed plants from the textual descriptions alone and, thus, are not effective as references.

Noting the difference between plants and statutorily distinct inventions, the Court disagreed. It reasoned that in the case of plant patents, the touchstone of the statutory subject matter is asexual reproduction of a unique biological organism. Thus, a statutory bar arises when a publication, which only identifies the plant that is invented, is combined with a foreign sale that puts one of ordinary skill in the art in possession of the plant itself. In coming to its conclusion, the Court cautioned that the precise focus of the analysis is not whether the foreign sales are themselves § 102(b) prior art, but whether the publication has placed the claimed invention in the possession of the public before the critical date. Thus, foreign sales of the claimed plants may be within the knowledge of the skilled artisan and may be considered to provide the public with access to Appellants’ inventions.

Even though the Court ultimately agreed with the PTO that foreign sales may enable an otherwise nonenabling publication, it found that factual issues remained. For example, with respect to the accessibility of the foreign sales of the claimed invention, the Court found that it was unclear whether a skilled artisan would have known of the sales. In comparing it to a printed publication under § 102(b), the Court stated that the sale must have been known to the public and not merely an obscure or solitary occurrence that would go unno-

ticed to those skilled in the art. Therefore, the Court remanded for further factual findings relating to the accessibility of the foreign sales and the reproducibility of the claimed plants from the plants that were sold.

Court Reinstates Jury Verdict of Validity, Modifies Claim Construction, and Remands for New Trial

Steven L. Park

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

page | 03

In *Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*, No. 02-1532 (Fed. Cir. Aug. 31, 2004), the Federal Circuit reinstated a jury verdict of no invalidity of U.S. Patent No. 4,407,288 (“the ‘288 patent”) and remanded for a new trial based on the Court’s partially modified claim construction.

At trial, Cardiac Pacemakers, Inc. (“CPI”) charged St. Jude Medical, Inc. (“St. Jude”) of infringing U.S. Patent No. 4,316,472 (“the ‘472 patent”) and the ‘288 patent, both of which relate to improved implantable cardiac defibrillators (“ICD”) for treating abnormal cardiac activity. The jury found both patents valid and found that St. Jude infringed the ‘472 patent, awarding damages of \$140 million. On post-trial motions, the district court granted JMOL in favor of St. Jude, finding both the patents invalid and not infringed. CPI only appealed the district court’s judgment of invalidity and noninfringement as to the ‘288 patent.

The ‘288 patent relates to an improved multimode ICD that treats multiple types of abnormal cardiac activity by delivering electrical shocks to the heart muscle in appropriate strengths, including a treatment known as cardioversion. Despite the

jury’s finding to the contrary, the district court found that the ‘288 patent was invalid based on obviousness and best-mode grounds.

In determining invalidity based on obviousness, the district court had found that cardioversion therapy was known, and that there was a known need to treat mixtures of arrhythmias. Thus, the court determined that it would have been obvious to combine known methods of separate treatment within a single ICD. The Federal Circuit disagreed, opining that the mere recognition of the problem of treating complex heart arrhythmias does not render obvious the eventual solution. Indeed, it was undisputed that the solution of this problem had not previously been achieved.

The Federal Circuit explained that whether the prior art provides the suggestion or motivation to combine prior knowledge in a way to produce the invention at issue is a question of fact. And these issues were extensively explored at trial, including evidence of commercial success and licensing interest. The Court concluded that the trial record contained substantial evidence, whereby a reasonable jury could have reached the verdict that it would not have been obvious to provide an ICD that includes cardioversion therapy.

In determining invalidity based on best mode, the district court had found that the inventors requested a third party to develop an improved battery for use in CPI’s ICDs. Approximately four months before the ‘288 patent application was filed, the third party published an article describing the battery that it developed. The district court held that failure to include the third-party battery in the specification invalidated the patent on best-mode grounds, because it was the best battery then known to them.

The Federal Circuit disagreed for two reasons. First, the Court noted that the battery for use in battery-powered ICDs

was not part of the claimed invention. Second, even if the battery was part of the claimed invention, a best-mode violation requires that the inventor knew of and concealed a better mode than was disclosed for making and using the claimed invention. The Federal Circuit held that there was no evidence of such concealment. Accordingly, there was substantial evidence, whereby a reasonable jury could have found that the best-mode requirement had not been violated.

The Federal Circuit also overturned the district court's claim construction that "determining a condition of the heart from among a plurality of conditions of the heart" is in the step-plus-function form of 35 U.S.C. § 112, ¶ 6. Method claims, the Court explained, necessarily recite the steps of the method, and the preamble words, "the method comprises the steps of," do not automatically convert each ensuing step into the form of § 112, ¶ 6. To the contrary, the absence of the signal "step for" creates a presumption that each ensuing step is not in step-plus-function form. The Court clarified, however, that removal of a clause from § 112, ¶ 6 does not automatically convert it into an open-ended step without limits. A claim limitation is always construed in light of the specification, regardless of the form of the claim. Accordingly, the Federal Circuit remanded the case in order to construe the "determining" step in light of the specification and the prosecution history.

Eleventh Amendment Bars Claim Against State to Correct Inventorship

Paul C. Goulet

[Judges: Newman (author), Gajarsa, and Linn]

In *Xechem International, Inc. v. University of Texas*, No. 03-1406 (Fed. Cir. Aug. 31, 2004), the Federal Circuit affirmed the trial

court's conclusion that the University of Texas, an arm of the state of Texas ("the University"), is immune from federal suit for the correction of inventorship and that the University had not waived that immunity by entering into commercial arrangements with Xechem International, Inc. ("Xechem") and by applying for and receiving patents.

Xechem and the University entered into collaborative research agreements for the purpose of developing a pharmaceutical formulation that would enhance the solubility and effectiveness of the cancer drug paclitaxel. Upon the successful development of that formulation, Xechem prepared a draft patent application naming Xechem's Dr. Pandey and the University's Dr. Andersson as joint inventors. The University objected to the designation of inventorship and filed the patent application naming the University's Dr. Andersson as the sole inventor. Xechem and the University subsequently entered into a patent and technology license agreement, and Xechem agreed to pay certain continuing sums and a royalty to the University. The patent application subsequently resulted in the issuance of U.S. Patent Nos. 5,877,205 ("the '205 patent") and 6,107,333 ("the '333 patent"). Dr. Andersson assigned the patents to the University.

Eventually, Xechem brought suit, seeking correction of inventorship of the '205 and '333 patents to include Xechem's Dr. Pandey. The University claimed immunity from suit under the Eleventh Amendment. Xechem argued that the University had waived immunity by: (1) entering into various commercial agreements with Xechem for the purpose of financial gain; (2) causing its employee, Dr. Andersson, to apply for a United States patent; and (3) accepting "gifts" from the federal government in the form of United States patents. Finally, Xechem argued that Eleventh Amendment immunity does not apply to actions for correction of inventorship. The Federal Circuit rejected each of these arguments in turn, acknowledging that Supreme Court prece-

dent controlled each of Xechem's arguments.

The Federal Circuit rejected the notion that a state's entrance into commercial arrangements can waive Eleventh Amendment immunity. Specifically, the Federal Circuit rejected Xechem's argument that by entering into a collaborative research agreement and then a license agreement with Xechem for purposes of financial gain, the University waived objection to federal court jurisdiction to secure constitutionally protected property rights (patents), and for issues that can be decided only in federal court under preemptive federal statutes (the Patent Act). The Federal Circuit highlighted Supreme Court precedent that a waiver of a state's immunity cannot be imposed or implied based on a state's entry into commerce; rather, the waiver must be founded on a clear declaration of the state's intent to submit to federal jurisdiction. The Federal Circuit found no such "clear declaration" of waiver by the University in entering into its various relationships and contracts with Xechem.

The Federal Circuit further rejected Xechem's argument that the University constructively waived immunity when it averred that Dr. Andersson was the sole inventor in its application for a United States patent and, thus, consented to correction of that erroneous averral in a federal court. The Federal Circuit noted that the Supreme Court had already rejected the argument that a state's voluntary participation in activities controlled by federal statute imposes a consent to suit arising from those activities.

Likewise, the Federal Circuit rejected Xechem's argument that the grant of a patent is a "gift" from the government, whereby acceptance of that gift is a constructive waiver of immunity. The Federal Circuit reasoned that the grant of a patent is not a disbursement of government largesse. Rather, it is the result of a carefully crafted bargain that encourages both the

creation and the public disclosure of new and useful advances in technology, in return for an exclusive monopoly for a limited period of time.

Finally, the Federal Circuit rejected Xechem's argument that because the University is not a necessary party to the action to correct inventorship, it need not consent to or participate in the hearing and, thus, the Eleventh Amendment does not bar federal suit to correct inventorship. The Federal Circuit noted, however, that without any defendant, there is no suit. The Federal Circuit further argued that, while inventorship is determined under federal law, state courts can apply federal law to issues properly before the state court. And, federal preemption of causes arising under the Patent Act does not include matters of ownership. Therefore, because Xechem is not left without a possible remedy under state law, the due-process concerns of the Fourteenth Amendment are not implicated and there is no reason to abrogate the state's Eleventh Amendment immunity.

Partial Protein Sequence Does Not Provide Sufficient Written Description

Michael V. O'Shaughnessy

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

In *In re Wallach*, No. 03-1327 (Fed. Cir. Aug. 11, 2004), the Federal Circuit affirmed a decision of the Board that upheld a rejection of several claims of U.S. Patent Application No. 08/485,129 ("the '129 application") by David Wallach et al. (collectively "Wallach") for failure to provide an adequate written description.

The '129 application is directed to two specific tumor necrosis binding proteins ("TBP-I" and "TBP-II") that inhibit the cyto-

toxic effect of tumor necrosis factor (“TNF”). Among other aspects of the invention, Wallach claimed proteins having a partial sequence, a particular molecular weight, and the ability to inhibit the cytotoxic effect of TNF. The disclosed sequence included only the partial amino acid sequence for the N-terminal portion of TBP-II. The complete DNA sequence encoding the proteins was claimed in divisional application 07/930,443 (“the ‘443 application”), which had been allowed subject to an interference proceeding.

The patent Examiner rejected the claims of the ‘129 application under 35 U.S.C. § 112 because the specification did not provide an adequate written description of the claimed invention. The Board affirmed the rejections because Wallach did not describe the invention with sufficient specificity.

Wallach appealed, contending that because the ‘443 application had been allowed, the identical specification of the ‘129 application could not be viewed as inadequate. Wallach argued that the two applications differed substantively only because the ‘129 application claimed the partial protein sequence, whereas the ‘443 application claimed the DNA sequence encoding the protein. Citing the correspondence between the amino acid sequence and encoding DNA codons, Wallach argued that the distinction was not meaningful and, in fact, the amino acid sequence of a protein automatically puts one of ordinary skill in the art in possession of all DNA sequences encoding that protein. Moreover, Wallach argued that the complete amino acid sequence is an inherent property of an isolated protein that has been fully characterized by a partial amino acid sequence and other characteristics, such as molecular weight. Therefore, according to Wallach, the ‘129 application provided sufficient description for the entire claimed genus of DNA sequences. As a final point, Wallach also argued that

the ‘129 application satisfied the written-description requirement by providing a functional description of the identified protein, namely, the ability to selectively inhibit TNF.

The Federal Circuit recognized that a complete amino acid sequence of a protein may put one in possession of the genus DNA sequence that encodes it and, therefore, may satisfy the written-description requirement. Wallach, however, did not claim the nucleic acid sequence for the protein they disclosed. Rather, Wallach claimed only a partial sequence (approximately 5%) of the disclosed protein. The Court stated that mere possession of the protein does not amount to knowledge of that protein’s sequence absent any evidence that the sequence of the full protein can be deduced from a partial sequence.

Finally, the Court rejected Wallach’s functional-description argument. Acknowledging that the written-description requirement may be met by a functional description of the genetic material, the Court explained that there must be a relationship between the chemical structure and the biological function. Finding that no correlation existed between a protein’s partial structure, biological activity, and molecular weight on the one hand and the complete structure of the DNA encoding the protein on the other, the Federal Circuit affirmed the Board’s rejection of the claims.

06 | page

Hairbrush Prior Art Includes Toothbrushes

Elizabeth M. Burke

[Judges: Rader (author), Schall, and Newman (dissenting)]

In *In re Bigio*, No. 03-1358 (Fed. Cir. Aug. 24, 2004), the Federal Circuit affirmed the Board’s claim construction and

determination that the prior art applied in a rejection of claims of U.S. Patent Application No. 09/145,747 (“the ‘747 application”) was analogous art.

The ‘747 application claims a hair-brush having an hourglass configuration for a bristle substrate and the overall bristle array. During prosecution of Alberto Lee Bigio’s ‘747 application, the Examiner rejected certain claims as being obvious in view of three toothbrush patents.

Before the Board, Bigio argued that the term “hair brush” should be narrowly construed to encompass only brushes for scalp hair. The Board rejected this interpretation, instead construing the term “hair brush” to encompass brushes that may be used for human hair on a scalp and other parts of animal bodies, e.g., human facial hair, human eyebrow hair, or pet hair.

Bigio also argued that the toothbrush patents were nonanalogous art. Under its claim construction, the Board found that the toothbrush patents relate to the same field of invention as the claimed invention, specifically to the field of hand-held brushes having a handle segment and a bristle-substrate segment. The Board therefore affirmed the Examiner’s rejection.

On appeal, the Federal Circuit first construed the term “hair brush” and then, based on that construction, determined whether the toothbrush references were analogous art. In construing the term “hair brush,” the Court reviewed the reasonableness of the Board’s construction of the disputed term. First, the Court noted that the modifier “hair” before the word “brush” was not in itself sufficient to limit the claim to brushes for scalp hair, as it did not limit the claim to any particular type of hair. The Court also noted that the Board correctly refused to import from the specification a limitation that would apply the claim only to hairbrushes for the scalp. The Court concluded that the term “hair

brush” does not in itself specify the type of hair to be groomed, and, therefore, the Board’s interpretation of the term was reasonable.

After affirming the Board’s claim construction, the Court reviewed the use of the toothbrush references as analogous art. The Court set forth the two separate tests that define the scope of analogous prior art: (1) regardless of the problem addressed by the inventor, whether the art is from the same field of endeavor, and (2) if not within the same field of endeavor, whether the reference still is reasonably pertinent to the particular problem to be solved. The Board based its determination on the first test, finding that the toothbrush patent(s) related to the same field of endeavor as Bigio’s claimed invention. The Court also stated that the reality of the circumstances, or common sense, must be considered in determining where one of ordinary skill in the art could reasonably be expected to look for a solution to the given problem. Bigio had agreed that if the prior art was analogous, then his invention was obvious.

Judge Newman dissented, arguing that the toothbrush art is about as analogous to the hairbrush art as teeth are to hair.

Claim Broader than Preferred Embodiment

Robert Pollock

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

In *Home Diagnostics, Inc. v. LifeScan, Inc.*, No. 03-1370 (Fed. Cir. Aug. 31, 2004), the Federal Circuit reversed the district court’s claim-construction order, vacated the order entering judgment in favor of Home Diagnostics, Inc. (“Home

Diagnostics”), and remanded the case for a determination of validity and infringement.

Home Diagnostics initiated the suit below by seeking a DJ that its Prestige blood-glucose meters do not infringe LifeScan, Inc.’s (“LifeScan”) U.S. Patent No. 6,268,162 (“the ‘162 patent”). LifeScan filed a counterclaim for infringement. Following a *Markman* hearing, LifeScan stipulated that it could not prove infringement given the district court’s claim construction. The district court dismissed LifeScan’s counterclaim and entered a final judgment of noninfringement in favor of Home Diagnostics.

The sole claim at issue, claim 4 of the ‘162 patent, recites a method of measuring blood glucose with a reflectance-reading device. In particular, a sample of whole blood applied to a test strip reacts with a reagent, whereupon reflectance readings are taken “at specified time intervals upon detecting a predetermined drop in reflectance.” The glucose concentration in the sample is calculated from one of the reflectance readings “upon detection of a suitably stable endpoint.”

The central dispute in this case focused on the meaning of “upon detection of a suitably stable endpoint.” The district court construed this language as limiting the claim to detection at the expiration of a predetermined time period—a construction that effectively precluded a finding of infringement against Home Diagnostics because its device did not detect reflectance readings at a predetermined time.

Rejecting the district judge’s narrow construction, the Federal Circuit found that the claim language does not explicitly require a predetermined time for the reaction, but instead measures the endpoint with reference to the stability of the reflectance. The Court pointed to the teaching of the specification as simply one

means of determining when a “suitably stable endpoint” has been reached. The ‘162 patent describes a preferred embodiment using predetermined time periods, but describes no other embodiments in detail. Nevertheless, the Court found no disavowal of alternative methodology, because an applicant’s choice to describe only a single embodiment does not mean that the patent clearly and unambiguously disavows other embodiments. Rather, the preferred embodiment is just one way of using the invention.

In addition, the Court noted that prior art identified by the ‘162 patent recites various methods of monitoring a reaction and cited these teachings as further evidence that one of ordinary skill would understand the claims as not limited to predetermined timing methods. Finally, the Court noted that during the prosecution of the family of patents including the ‘162 patent, LifeScan sought progressively broader claim language culminating in the limitation at issue in this case. The Court found that this course of prosecution showed that LifeScan purposefully sought claim scope in the ‘162 patent broader than the predetermined timing method disclosed. Thus, finding no disavowal, the Federal Circuit found that LifeScan was entitled to the full scope of its claim language and remanded for determinations on the liability issues.

08 | page

“Operatively Connected” Construed Too Narrowly

Eric P. Raciti

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

In *Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc.*, No. 04-1097 (Fed. Cir. Aug. 11, 2004), the Federal Circuit

ruled that the term “operatively connected,” describing the relationship between two recited claim elements, could not be construed to require “tenacious engagement” as required by the district court in granting SJ of noninfringement, and reversed that decision.

Innova/Pure Water, Inc. (“Innova”) is the owner of U.S. Patent No. 5,609,759 (“the ‘759 patent”), which claims a filter and cap combination for water bottles. Innova’s claimed filter and cap combination includes a filter for radial filtration of water exiting a bottle that is “operatively connected” to the cap of the bottle. Safari Water Filtration Systems, Inc. (“Safari”) argued, and the district court agreed, that because the specification only discussed preferred embodiments in which the cap and filter were integral, the term “operatively connected” must be construed to require the filter and cap to be integral, or to be in “tenacious engagement.” Safari’s filter was held in the mouth of the bottle by the cap when threaded onto the bottle neck. Because the cap and filter were not integral, or in “tenacious engagement,” the district court ruled for Safari.

Innova’s appeal focused on the proper interpretation of the disputed claim term “operatively connected.” Specifically, Innova challenged that the district court improperly read the “tenacious engagement” limitation into the claims, where the literal claim language required no such thing. The Federal Circuit agreed. First, the Court pointed out that the asserted claims do not literally require that the filter and cap form a unitary structure. The Court noted that the phrase is a frequently used functional term used across various arts. Absent any special meaning, as is the case here, the Court found that the general descriptive meaning of the term was controlling. Accordingly, the Court found that the term “operatively connected,” as used

in the claims, required only that the cap and the filter be connected in a way to perform their designated function.

Accordingly, the Court vacated the district court’s grant of SJ and remanded the case for further proceedings.

General and Conclusory Testimony Does Not Suffice as Substantial Evidence of Invalidity

Vince Kovalick

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

In *Koito Manufacturing Co. v. Turn-Key-Tech, LLC*, No. 03-1565 (Fed. Cir. Aug. 23, 2004), the Federal Circuit reversed a jury finding of invalidity based on prior art but affirmed findings that the patent is not invalid for lack of embodiment, failure of written description, and the addition of new matter. In addition, the Federal Circuit affirmed the district court’s decisions reflecting a jury’s verdict of noninfringement.

Turn-Key-Tech, LLC and Jens Ole Sorensen (collectively “Turn-Key”) own U.S. Patent No. 5,045,268 (“the ‘268 patent”), which teaches a method of strengthening injection-molded plastic. After Turn-Key asserted the ‘268 patent against several customers of Koito Manufacturing Company, Ltd. (“Koito”), Koito filed a DJ action against Turn-Key requesting that the ‘268 patent be declared invalid and not infringed.

After a trial, a jury found the ‘268 patent not infringed and invalid for lack of enablement, lack of written description, and addition of new matter through a certificate of correction. The jury also found a certain number of claims anticipated and

obvious based on prior art. The district court upheld the finding of invalidity based on prior art but granted JMOL as for the other invalidity grounds.

On appeal, Turn-Key took issue with the district court's claim construction of certain claim terms. The Federal Circuit concluded, however, that Turn-Key did not preserve its claim-construction argument at trial and did not object to the jury instructions on this claim term. If Turn-Key had wanted a different construction of that limitation, the Federal Circuit commented, it should have objected at trial. After resolving this claim-construction issue, the Federal Circuit quickly concluded that sufficient evidence supported the ruling of non-infringement.

Concerning anticipation and obviousness, the district court had focused exclusively on a Japanese Unexamined Application No. 148,082 ("JP '082"). Turn-Key argued that Koito merely submitted that reference into evidence and made no specific mention of it at trial. The Federal Circuit agreed that the evidence based on the JP '082 reference was insufficient to support the determination of anticipation and obviousness. Koito had entered the JP '082 reference into evidence but otherwise failed to provide any testimony to demonstrate how it met the limitations of the claims. Instead, Koito's expert simply made conclusory statements about JP '082 together with several other pieces of prior art. However, given that Koito had presented an array of other evidence of anticipation and obviousness at trial, the Federal Circuit vacated the district court's ruling of invalidity based on prior art and remanded for further proceedings to determine whether sufficient evidence supported the jury's findings of invalidity based on the other prior art evidence.

Koito argued that the '268 patent is invalid because a certificate of correction altered the definition of the thickness of a

flow channel described in the specification. According to Koito, this change was not supported by the specification and broadened the scope of the claims. The Federal Circuit found that the amended material was inherently contained in the original application and, therefore, was not new matter. The Court also found that certain figures demonstrated that the inventor was in possession of the patent claims at the time of filing, and, therefore, the written-description requirement was satisfied.

Nothing Precludes a District Court from Making Adjustments to a Claim Construction as a Trial Proceeds

Vince Kovalick

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

In *Power Mosfet Technologies, L.L.C. v. Siemens AG*, No. 03-1083 (Fed. Cir. Aug. 17, 2004), the Federal Circuit affirmed a finding of noninfringement. Power Mosfet Technologies, L.L.C. ("PMT") owns U.S. Patent No. 5,216,275 ("the '275 patent"), which is directed to a specific type of MOSFET semiconductor power device. PMT sued Infineon Technologies Corporation and related companies (collectively "Infineon"), STMicroelectronics, N.V. and related companies (collectively "ST"), and International Rectifier Corporation and related companies (collectively "IR").

An SM construed the claims, and the district court found no infringement. The district court also found that the '275 patent was not invalid.

The Federal Circuit engaged in a detailed analysis of specific claim limitations, only to conclude that the record

revealed both an incomplete claim construction containing a significant ambiguity and an awareness by the parties that the limited constructions that did exist were subject to further modification by the district court. In the end, the Federal Circuit affirmed the district court's claim constructions and its judgment of noninfringement.

The Federal Circuit also denied Infineon's request for attorney fees, because, according to the district court, all of the parties had conducted themselves without the decorum required when practicing before a federal court. The Federal

Circuit characterized Infineon's request for attorney fees in view of the district court's admonition as "quite bold."

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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