

Last month at

The Federal Circuit



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COURT CONTINUES DEBATE ON WRITTEN-DESCRIPTION REQUIREMENT

Based on CCPA precedent, Federal Circuit finds adequate written description, but Judges Rader and Bryson use concurring opinions to frame debate about whether the Court should reconsider its written-description precedent en banc. *Moba, B.V. v. Diamond Automation, Inc.*, No. 01-1063 (Fed. Cir. Apr. 1, 2003)1

"BITTER PILL" FOR ANDA APPLICANT DURAMED REGARDING CONTRACEPTIVE DRUG DELIVERY SYSTEM

District court had construed claims too narrowly; characterizing a particular drug delivery system as "embodying" the invention is not the same as stating that the claimed system is limited to that embodiment. *Bio-Technology Gen. Corp. v. Duramed Pharms., Inc.*, No. 02-1195 (Fed. Cir. Apr. 1, 2003)2

NO COLLATERAL ESTOPPEL ON CLAIM CONSTRUCTIONS FROM PREVIOUSLY SETTLED CASE

Claim constructions related to SJ orders in case that was settled did not invoke collateral estoppel in subsequent case, given lack of *Markman* hearing and lack of final judgment. *RF Del., Inc. v. Pacific Keystone Techs., Inc.*, No. 02-1508 (Fed. Cir. Apr. 21, 2003)3

LATE SUBMISSION OF ARTICLE RENDERS PATENT UNENFORCEABLE

Court concludes that patent agent in France should have submitted article he knew of to the PTO earlier than he did, even though the PTO found the article in a computer search, given that the Examiner did not initial his search report. *Bristol-Meyers Squibb Co. v. Rhone-Poulenc Rorer, Inc.*, No. 02-1280 (Fed. Cir. Apr. 15, 2003)4

ABSTRACT DICTIONARY DEFINITIONS ARE NOT DETERMINATIVE OF CLAIM CONSTRUCTION

The general meanings of claim terms obtained from references, such as dictionaries, must always be compared against the use of the terms in context and the intrinsic record. *Brookhill-Wilk 1, L.L.C. v. Intuitive Surgical, Inc.*, No. 02-1145 (Fed. Cir. Apr. 11, 2003)5

DISTRICT COURT IMPROPERLY INTERPRETED FUNCTIONAL CLAIM LIMITATIONS AS MEANS-PLUS-FUNCTION LIMITATIONS

Court reverses holding of noninfringement after ruling that claims are not in means-plus-function form and remands for further development of record on ordinary meaning of several claim limitations. *Apex, Inc. v. Raritan Computer, Inc.*, No. 02-1303 (Fed. Cir. Apr. 2, 2003)6

DISTRICT COURT HAS PERSONAL JURISDICTION

Letters to alleged infringers informing them of injunction issued in one state court creates basis for personal jurisdiction in another state. *Silent Drive, Inc. v. Strong Indus., Inc.*, No. 02-1329 (Fed. Cir. Apr. 16, 2003)6

EDITED BY | VINCE KOVALICK

Court Continues Debate on Written-Description Requirement

Meredith H. Schoenfeld

[Judges: Schall (per curiam), Rader (concurring), and Bryson (concurring)]

In *Moba, B.V. v. Diamond Automation, Inc.*, No. 01-1063 (Fed. Cir. Apr. 1, 2003), the Federal Circuit reversed the district court's ruling that Moba, B.V.; Staalkat, B.V.; and FPS Food Processing Systems, Inc. (collectively "FPS") did not infringe Diamond Automation's ("Diamond") U.S. Patent No. 4,519,505 ("the '505 patent"), which is directed to egg-processing machinery.

In 1995, FPS filed suit in the United States District Court for the Eastern District of Pennsylvania seeking a DJ that the '505 patent and three other patents were invalid and not infringed. Diamond counterclaimed that the patents are valid and infringed. A jury found that those patents were not invalid and not infringed. The district court then denied Diamond's JMOL motion and entered judgment in favor of Diamond on the validity issues and in favor of FPS on the infringement issues.

On appeal, the Federal Circuit held that no reasonable jury could find that machines sold by FPS and used by its customers do not infringe Diamond's '505 patent. The Court also found that the '505 patent was valid. Thus, the Federal Circuit reversed the part of the district court's decision pertaining to the '505 patent and remanded the case back to the district court for a determination of damages for infringement of that patent.

Diamond manufactures and sells high-speed egg-processing machines to sort batches of eggs into different categories by weight and quality. Diamond developed these machines with technology that significantly increased the processing speed for eggs. Diamond obtained various patents covering aspects of that technology, including United States Patent No. 4,519,494 ("the '494 patent") and the '505 patent.

The '505 patent relates generally to "front end" processing of eggs, while the '494 patent relates generally to "back end" processing of eggs. The "front end" process first washes the eggs, then introduces them into a candling station, where they are checked for defects, such as blood spots or cracks. The process then weighs the eggs and a computer stores the information for use in sorting the eggs at a later point. The "back end" process receives the eggs from the "front end" processing and transfers them into an overhead conveyor, which drops off each individual egg based on the information stored in the computer.

Moba, B.V. and Staalkat, B.V. are Dutch companies that also manufacture and sell high-speed egg-processing machines, such as the Moba Omnia and the Staalkat Selecta. FPS sells Moba's and Staalkat's machines in the United States.

The Federal Circuit determined that the district court had allowed the jury to add an additional limitation concerning the sequential performance of the claim steps by failing to instruct the jury whether sequential performance was necessary. The error was significant because the jury ultimately found no infringement. According to the Federal Circuit, there was no alternative basis upon which a reasonable jury could find no infringement. By allowing the jury to import additional limitations into the claims, the district court had fundamentally altered the verdict. Therefore, the Federal Circuit found that because no reasonable jury could find on the record evidence that the method performed by the Moba Omnia does not infringe claim 24 of the '505 patent, the district court had erred in not granting JMOL on that issue.

However, with regard to the '494 patent, the Federal Circuit found that the evidence supported the jury's verdict of noninfringement. The Court stated that the Staalkat Selecta performs a different function in a different way to obtain a different result from the language of the claim limitation, so it was not equivalent.

The Federal Circuit remanded for further inquiry on the issue of inducement to infringe, stating that the only intent necessary to meet the requirement of 35 U.S.C. § 271(b) is the intent by FPS to cause the acts that constitute infringement. Since this is a factual inquiry, the Federal Circuit declined to make a determination that no reasonable jury could conclude that FPS did not intend that its customers perform acts that constitute infringement.

The Federal Circuit also determined that the '505 patent was not invalid for lack of an adequate written description. The Court stated that FPS's contention that the '505 patent does not adequately disclose lifting eggs from a moving conveyor merely revived its noninfringement argument in the cloak of a validity challenge. In the present case, the Court found, one of skill in the art could determine from the specification that the inventor possessed the invention at the time of filing.

In his concurrence, Judge Rader voiced the opinion that the application of the written-description standard that has evolved through judge-made law is contrary to the statute and case law, since it applies the written-description doctrine beyond the purpose for which the doctrine was created, namely, priority protection.

“Bitter Pill” for ANDA Applicant Duramed Regarding Contraceptive Drug Delivery System

Rebecca D. Hess

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

In *Bio-Technology General Corp. v. Duramed Pharmaceuticals, Inc.*, No. 02-1195 (Fed. Cir. Apr. 1, 2003), the Federal Circuit rejected the district court’s claim construction and reversed the district court’s SJ of noninfringement. The Federal Circuit remanded the case with a broader claim construction and held that under this new claim construction, the Plaintiff may be able to prove infringement of its pharmaceutical patent claims.

Bio-Technology General Corporation (“BTG”) is the assignee of reissued U.S. Patent Re. 35,724 (“the ‘724 patent”), a patent covering an oral contraceptive “method of use” and “drug delivery system” in which a woman takes doses of estrogen and/or progestin at different stages of her menstrual cycle. Claim 1 of the ‘724 patent describes a daily oral contraceptive method in which the woman consumes an estrogen compound on days 3 or 4 through day 7 of her menstrual cycle, followed by a progestin-containing compound through day 28 (wherein day 1 is the onset of menses). Claim 18 of the ‘724 patent claims a “drug delivery system” of 24+ separate daily doses in which a woman takes four or five “initial dosage units” of estrogen compound, followed by twenty-one doses of progestin-containing compound.

The commercial embodiment of the ‘724 patent is marketed as Mircette®, in which a woman takes 28 pills per 28-day menstrual cycle. The Mircette® dosage package or “blister pack” is arranged such that the first twenty-one pills contain a composition of progestin and estrogen, the next two pills are placebos, and the last five pills contain only estrogen.

Duramed Pharmaceuticals, Inc. (“Duramed”) filed an ANDA and sought FDA approval for a generic version of Mircette®, which Duramed claimed was identical to Mircette® in every material respect. However, in the Duramed “drug delivery system” blister pack, the 21 progestin pills are *before* the two placebo pills and five estrogen pills (instead of *after*, as described in claim 1). Duramed certified to the FDA that neither its generic version of the drug nor Mircette® was covered by BTG’s ‘724 patent, and therefore Duramed did not infringe.

BTG sued Duramed for patent infringement under the Hatch-Waxman Act (35 U.S.C.

§ 271(e)(2)) in the District Court for the District of New Jersey, claiming that Duramed’s proposed contraceptive method infringed both the above described independent claims, as well as several dependent claims. The district court granted SJ of noninfringement because the arrangement of pills in their package by Duramed is reversed from that in the claims, as construed by the court.

The Federal Circuit disagreed, concluding that a contraceptive regimen in which a woman at any time is taking BTG’s described compounds on the prescribed days of her menstrual cycle in the order indicated (placebo, estrogen, progestin), will infringe. The Federal Circuit relied on testimony by BTG’s medical experts, as well as Duramed’s own package insert, which taught that taking the estrogen and progestin-containing pills in the order and duration prescribed in the Duramed system would cause a “menstrual shift.” Expert testimony suggested that after taking 21 days of progestin-containing product followed by placebos (as in the Duramed system), a woman would begin menses again, thereby “restarting” the woman’s menstrual cycle with “day 1.” Continuing with the regimen, the woman is instructed to take several placebo pills, followed by estrogen, followed by progestin again until day 28 of her cycle. In other words, within a short time after a woman began using Duramed’s accused product, she would end up taking the placebo and estrogen pills as recited in the claims. Hence, users of the Defendant’s product would infringe BTG’s ‘724 patent and Duramed could be liable for contributory or induced infringement.

The Federal Circuit also held that the district court’s claim construction of claim 18 was unduly restrictive. The district court had interpreted claim 18 to cover only one month’s worth of pills in a blister pack, with the pills being arranged in a specified order (4/5 estrogen-only pills before 21 progestin-containing pills). The district court ruled that Duramed could not infringe claim 18 because its blister packs had the three rows of progestin-containing pills ahead of the estrogen-only pills. However, the Federal Circuit held that the term “drug delivery system” referred more generally to any system consisting of at least 24 dosage units of the composition type specified in the claim, to be taken in the order specified in the claim. The Court stressed that there was no evidence that the patentee intended claim 18 to be limited in scope to a one-month blister pack of pills, but rather that BTG’s written description repeatedly characterized the “drug delivery system” in terms of the timing of the administration of the dosages of estrogen and progestin in reference to the different stages of the

woman's menstrual cycle (estrogen in the initial stage followed by three weeks of progestin), without limiting that contraceptive regimen to a specific ordering of pills beginning and ending within one blister pack. Given the evidence that a woman's menstrual cycle would "shift" in such a way that the contraceptive regimen would soon be administering the same type of claimed compounds in the same order claimed by BTG, the Federal Circuit ruled that SJ of noninfringement was not appropriate.

No Collateral Estoppel on Claim Constructions from Previously Settled Case

Eric J. Fues

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

In *RF Delaware, Inc. v. Pacific Keystone Technologies, Inc.*, No. 02-1508 (Fed. Cir. Apr. 21, 2003), the Federal Circuit reversed the district court's SJ rulings of noninfringement for both patents-in-suit and remanded the case for further proceedings.

RF Delaware, Inc. ("RFD") owns U.S. Patent Nos. 5,198,124 ("the '124 patent") and 5,314,630 ("the '630 patent"), which share identical written descriptions and relate to the use and washing of an "upflow filter" in combination upflow and downflow water-filtration systems. The accused infringers, Pacific Keystone Technologies, Inc.; BCA Industrial Controls Limited; Clearwater Technologies, Inc.; and Michael Morris (collectively "Pacific") make water-filtration systems.

The central issue on appeal was whether the Alabama district court properly construed the claim terms "filter bed" of claim 1 of the '124 patent and "first particulate filter media" of claim 1 of the '630 patent to require a flocculation layer and a transitional layer, in addition to a filter layer. The appeal also presented the issue of what preclusive effect, if any, should be accorded the claim-construction rulings on partial SJ of an earlier Virginia district court case that involved the same patents but ended in settlement without complete adjudication.

Pacific argued on appeal that RFD was bound by the claim-construction rulings issued by the Virginia district court on motions for partial SJ in an action that RFD had brought against another party, Infilco Degremont, Inc. ("IDI"). Applying Eleventh Circuit law to the procedural issue of collateral estoppel, the Federal Circuit held that the standard for judicial finality was not satisfied. In so ruling,

the Court noted that neither of the orders issued by the Virginia district court had been dispositive and the case was ready for trial on the issue of infringement when RFD and IDI settled that action. The Federal Circuit also observed that the Virginia district court's orders granting partial SJ were not sufficiently firm to have preclusive effect. An evidentiary hearing had not been conducted to construe the claims of the '124 and '630 patents before the orders had issued. Indeed, the Virginia district court had not even entertained oral argument on the claims of the '124 patent. Thus, the Federal Circuit found it questionable whether the parties had been fully heard before the Virginia district court rendered its claim-construction rulings. Additionally, the Virginia district court had not put the parties on notice that its orders could have a preclusive effect, nor had it entered a final order approving the proposed settlement between RFD and IDI.

Turning to the merits of the claim-construction rulings by the Alabama district court, the Federal Circuit held that the trial court had improperly construed the claim terms "filter bed" and "first particulate filter media" as requiring multiple layers. Specifically, the district court had erred by importing limitations from the specification into the claims of the '124 and '630 patents, and by importing limitations from the narrower or dependent claims of the '124 patent into a broader independent claim.

Claim 1 of the '124 patent teaches a method of washing an upflow filter that includes "a filter bed having a non-buoyant particulate filter media layer." Claim 7, another independent claim, teaches a similar method that provides a filter bed "having a non-buoyant particulate media filter layer and a particulate non-buoyant static flocculation layer." Claim 12, which depends from claim 7, also includes "a transitional layer of particulate material between the flocculation layer and the filter layer." The specification of the patent also indicates that in "the most preferred embodiment of the invention," the filter bed includes a flocculation layer, a transitional support layer, and a filter layer.

According to the Federal Circuit, the claim language "a filter bed having a non-buoyant particulate media filter layer" can be interpreted according to its plain and ordinary meaning because the claim does not refer to a flocculation layer or a transitional layer. The district court's claim construction also violated the doctrine of claim differentiation because it rendered redundant or meaningless the limitations of "a flocculation layer" in claim 7 and "a transitional layer" in claim 12.

As with the '124 patent, the Federal Circuit held that the district court had improperly import-

ed limitations from the specification into the claims of the '630 patent when it construed the "first particulate filter media" to require a multimedia, non-buoyant filter bed containing multiple layers (namely, flocculation, transitional support, and filter layers). The Federal Circuit also recognized that SJ of noninfringement had been premised on the district court's erroneous claim interpretations and, therefore, reversed that holding.

A final issue involved the question of whether Pacific, as a manufacturer and seller of water-treatment equipment, had committed any act of infringement of the claimed methods. Pacific argued that it was not a direct infringer, and that it had no knowledge of the RFD patents at the time it sold its products, so it could not be held liable for inducement of infringement or contributory infringement. Upon review of the appellate record, the Federal Circuit concluded that there were genuine issues of material fact regarding whether Pacific had tested or started up any infringing equipment, thereby committing direct acts of infringement. The Court also concluded that there were genuine issues of material fact regarding whether Pacific had sold systems knowing about the '124 and '630 patents and that its systems would infringe during operation. Hence, the Federal Circuit reversed the district court's grant of SJ of noninfringement and remanded the case for further proceedings.

Late Submission of Article Renders Patent Unenforceable

Dwight M. Benner

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

In *Bristol-Meyers Squibb Co. v. Rhone-Poulenc Rorer, Inc.*, No. 02-1280 (Fed. Cir. Apr. 15, 2003), the Federal Circuit affirmed a district court's decision holding U.S. Patent Re. 34,277 ("the '277 patent") unenforceable for inequitable conduct.

The '277 patent and its parent, U.S. Patent No. 4,924,011 ("the '011 patent"), concern a semisynthesis of taxol, a cancer chemotherapeutic agent, and are owned by Rhone-Poulenc Rorer, Inc. and its affiliated companies (collectively "RPR"). On November 3, 1987, the inventors submitted what became an article published in the *Journal of the American Chemical Society* ("the JACS article") to a patent agent employed by RPR in France. Among other things, the article stated that the synthesis of taxol could be successfully achieved only with spe-

cific protective groups and under unique reaction conditions. The agent prepared a corresponding French patent application and filed it on April 6, 1988. But, the French patent application did not specify which protective groups could be used in the synthesis. The patent agent later sent a copy of the French application to a colleague in the United States for the preparation of a U.S. application; however, he did not send the JACS article. During the prosecution of the U.S. application, the Examiner requested a computer search, which found the JACS article; however, the Examiner did not initial next to the article on the search report. On May 8, 1990, the '011 patent issued.

On November 1, 1991, RPR filed the '277 reissue patent application without discussing the JACS article. In July 1992, the patent agent in France sent a copy of the JACS article to the patent attorney prosecuting the reissue application with the comment that it, and several other references, were irrelevant. Finally, on December 15, 1992, the U.S. attorney filed an Information Disclosure Statement with the PTO disclosing the JACS article. The '277 patent issued on June 8, 1993.

The district court — relying on a SM — ruled that the JACS article was material to the examination. In particular, the district court found that a reasonable patent examiner reviewing the patent application would have expected the use of the protecting groups to yield significant amounts of taxol, but that a review of the JACS article would have raised doubts that the use of protecting groups would produce taxol in more than trace amounts. And, after a four-day hearing on the issue of intent, the district court held that RPR had committed inequitable conduct in processing the '277 patent. In upholding the district court's finding of materiality, the Federal Circuit ruled that the district court had not erred in concluding that the statements in the JACS article would have raised the question of enablement in the mind of a reasonable examiner. The Court rejected RPR's argument that the Examiner must have determined that the JACS article was immaterial because he likely considered the article during the '011 patent prosecution and still allowed the patent. Although the Examiner did not initial the search report containing the JACS article, RPR argued that this was his regular practice and did not indicate the article had not been reviewed. The Federal Circuit concluded, however, that the Examiner likely had not considered the JACS article because he did not initial the search report. Had the Examiner been performing his duties regularly, the Court reasoned, he would have initialed and dated the search report as instructed in the MPEP.

The Federal Circuit also rejected RPR's argument that the JACS article was not material because the Examiner considered the JACS article during the '277 reissue prosecution, but did not reject any claims using it. The Court found this probative, but not persuasive, because a reference is not necessarily immaterial simply because the claims were eventually deemed by an examiner to be patentable there-over.

Concerning the issue of intent, the Federal Circuit held that because the patent agent in France was intimately familiar with the JACS article — he approved the article for publication — and the article was in his possession while he was drafting the French patent application, the determination that he knew of the significance of the article, in combination with the finding that he knew of the duty to disclose, was sufficient to establish intent.

Accordingly, the Federal Circuit held that the district court did not abuse its discretion in finding the '277 patent unenforceable because RPR had obtained the '011 and '277 patents by inequitable conduct.

page | 05

Abstract Dictionary Definitions Are Not Determinative of Claim Construction

John A. Hudalla

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

In *Brookhill-Wilk 1, L.L.C. v. Intuitive Surgical, Inc.*, No. 02-1145 (Fed. Cir. Apr. 11, 2003), the Federal Circuit reversed the district court's grant of SJ of noninfringement of U.S. Patent No. 5,217,003 ("the '003 patent") and remanded the case for further proceedings.

Brookhill-Wilk 1, L.L.C. ("Brookhill") is the owner of the '003 patent, which is directed to systems and methods for performing robotic surgery that allow a surgeon to operate from a "remote location beyond a range of manual contact." This claim limitation became the focus of the appeal. Brookhill sued Intuitive Surgical, Inc. ("Intuitive"), alleging that Intuitive's *da Vinci* robotic surgical system infringed Brookhill's '003 patent. The accused *da Vinci* system was operated by a surgeon in the same operating room as the patient. Intuitive sought a construction of the term "remote location" to mean "a location outside of the operating room," while Brookhill argued that it was merely any location of the surgeon that is beyond an arm's length from the patient.

In construing the term "remote location," the district court had consulted dictionary definitions, the objects and advantages of the invention, and the embodiments disclosed in the patent. In particular, the district court had determined that the patentee's objects and advantages would not be met unless the surgeon was located beyond the room in which the patient is located. Additionally, the district court found that the written description and prosecution history of the '003 patent required the surgeon to be outside of the operating room. Having so ruled, the district court granted SJ of non-infringement in favor of Intuitive.

The Federal Circuit noted that the term "remote location" found context in the surrounding phrase "remote location beyond a range of direct manual contact." The Court also looked to dictionary definitions, which it found did not favor either party's proposed claim constructions. The Court cautioned that general meanings from dictionaries should be compared against the use of the terms in context, and instructed that the intrinsic record should be consulted to identify which dictionary meaning is most consistent with the words in the disclosure.

The Court found that while the written description of the patent sets forth no specific parameters regarding the distance between the surgeon and patient, it generally teaches that the surgeon may operate without directly touching the patient, and nothing in the patent disclosure disavows the use of the invention within an operating room. The fact that the patentee distinguished the invention from traditional surgery and touted the possibility of surgery performed at great distances from the patient did not restrict the claimed invention to embodiments where the doctor was located outside of the operating room, the Court reasoned.

The Court also noted that the prosecution history of the '003 patent supported its claim construction. The prosecution history includes statements that defined the term "remote location beyond a range of direct manual contact" to mean that the remote location is beyond an arm's reach of the patient. When reviewing amendments made during prosecution in which the claim limitation "beyond a range of direct visual contact" was changed to "beyond a range of direct manual contact," the Court found that such amendments did not attempt to capture something that was not supported by the original specification.

For these reasons, the Federal Circuit held that the district court's construction of the term "remote location" was erroneous, reversed the grant of SJ, and remanded the case for further proceedings.

District Court Improperly Interpreted Functional Claim Limitations as Means-Plus-Function Limitations

Karna J. Nisewaner

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

In *Apex, Inc. v. Raritan Computer, Inc.*, No. 02-1303 (Fed. Cir. Apr. 2, 2003), the Federal Circuit vacated the district court's judgment of non-infringement of U.S. Patent Nos. 5,884,096 ("the '096 patent"), 5,937,176 ("the '176 patent"), and 6,112,264 ("the '264 patent") (collectively "the patents"), and remanded the case for further proceedings. The Federal Circuit ruled that Defendant had not overcome the presumption that the lack of the term "means" in the asserted claims suggests that the claims are not in means-plus-function form and the claims are not limited by disclosure of a preferred embodiment.

Apex, Inc. ("Apex") is the assignee of the patents, which relate to computer-switching systems for connecting computer workstations to remote computers.

After a seven-day bench trial, the district court construed twelve of fourteen disputed claim limitations as means-plus-function limitations and found no infringement.

The Federal Circuit found that the district court had erred in its interpretation of the claims, particularly given that Raritan Computer, Inc. had not overcome the rebuttable presumption that § 112, ¶ 6 does not apply.

The Federal Circuit found enough in the record to address "first interface circuit" and "second interface circuit" limitations in the claims. Looking to dictionary definitions, it found several examples for an "interface circuit." The written description and prosecution history provided no evidence that the inventors intended the term "interface circuit" to have a meaning contrary to this ordinary meaning. Characterizing the record as poorly developed, the Federal Circuit suggested that the district court conduct a similar analysis with respect to the remaining limitations at issue.

District Court Has Personal Jurisdiction

Donald D. Min

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

In *Silent Drive, Inc. v. Strong Industries, Inc.*, No. 02-1329 (Fed. Cir. Apr. 16, 2003), the Federal

Circuit reversed the district court's dismissal of a complaint by Silent Drive, Inc. ("Silent Drive") against Strong Industries, Inc. and Brooks Strong (collectively "Strong") for lack of personal jurisdiction and remanded for further proceedings.

Silent Drive and Strong are competitors in the manufacture of trailing axles, which are suspension systems attached to the backs of trucks to increase their payload capacity. Silent Drive collaborated with F.S. New Products to create a new trailing axle named the "MAXLE."

Strong alleged that its trade secrets had been misappropriated in creating MAXLE. In addition, Strong alleged that the MAXLE infringed U.S. Patent No. 6,116,698 ("the '698 patent"), which is directed to a trailing axle in combination with a truck.

Strong sued F.S. New Products and others in a Texas state court for trade-secret misappropriation. However, Silent Drive was not named as a party in this action. The Texas state court ruled in favor of Strong and granted an injunction. Even though Silent Drive was not named as a party, the Texas court's injunction ordered Silent Drive to stop manufacturing and selling the MAXLE.

Strong then sent to Silent Drive and Silent Drive's customers letters that included a copy of the Texas injunction and the '698 patent. The letters alleged serious consequences for disobeying the injunction and infringing the '698 patent, including litigation and damages. In addition, Strong issued a news release stating that it was inconceivable for someone to attach a trailing axle to a truck without infringing one of Strong's patents.

Following these actions by Strong, Silent Drive filed a complaint against Strong in an Iowa federal district court. The first count sought declaratory relief from the Texas injunction. The second count alleged that Strong's conduct constituted tortious interference, and the third count asked for a declaration that the '698 patent was invalid and not infringed.

However, the Iowa federal district court dismissed the complaint. The Iowa district court found that Strong's activities in Iowa were too sporadic and lacked the required minimum contacts to confer personal jurisdiction. Strong Industries is a Texas corporation whose principal place of business is in Texas, and Brooks Strong, the president of Strong Industries, is a resident of Texas. Therefore, the Iowa district court dismissed the complaint for lack of personal jurisdiction over Strong.

On appeal, the Federal Circuit began its analysis with the third count of Silent Drive's complaint, which sought a DJ that Strong's '698 patent was invalid. The Federal Circuit noted that the sending of letters threatening litigation is insufficient to confer personal jurisdiction. Therefore, the Federal Circuit held that there was no personal jurisdiction

over Strong by the Iowa district court with respect to the third count.

As to the second count of the complaint — tortious interference — the Federal Circuit found that there was no independent federal subject matter jurisdiction and, therefore, it was unnecessary to reach the question of personal jurisdiction with respect to this count.

As to the first count of the complaint, which sought relief from the Texas injunction, the Federal Circuit ruled that the Iowa district court had personal jurisdiction. In particular, the Federal Circuit noted that a fair reading of the first count was that the Texas state court's exercise of jurisdiction over Silent Drive violated federal due process because Silent Drive was not a party to the Texas case. The Federal Circuit then noted that the relevant issue was whether Strong's activities to enforce the Texas injunction were sufficiently connected to the forum to confer personal jurisdiction.

The Federal Circuit found that Strong's activities to enforce the Texas injunction were "uniquely

aimed" at Iowa and that Strong was seeking to extend the injunction's effect into Iowa. Therefore, since Strong's activities were aimed at Iowa, the Federal Circuit held that the Iowa district court could exercise personal jurisdiction. Since the other two counts were related to the same facts as the first count, the Federal Circuit held that the Iowa district court had supplemental jurisdiction over these counts.

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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
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