

Last month at

The Federal Circuit

Month at a Glance



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Applicant Not Required to Tell PTO of Same Prior Art Twice

James T. Wilson
Aryn Davis

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

In *Fiskars, Inc. v. Hunt Manufacturing Co.*, No. 98-1560 (Fed. Cir. July 24, 2000), the Federal Circuit affirmed the judgment of the district court entered upon a jury verdict that Hunt Manufacturing Co.'s ("Hunt") paper trimmer infringed Fiskars, Inc.'s ("Fiskars") U.S. Patent No. 5,322,001 ("the '001 patent") entitled "Paper Cutter with Circular Blades" under the doctrine of equivalents ("DOE").

The '001 patent pertains to a paper cutter with a circular blade comprising a flat cutting board, a rail upon which a carriage assembly, including a rotary cutting blade, slides, and a spring assembly for biasing the carriage assembly upward to an inoperative position. Hunt's paper cutter differs in that it includes a single biasing coil which biases only the blade, not the entire carriage assembly. The jury found these differences to be insubstantial and found infringement under the DOE.

Hunt argued on appeal that, in order to assert that Hunt's device infringed under the DOE, Fiskars had to show that Hunt's device was not in the prior art. The Federal Circuit ruled to the contrary, however, concluding that it is an affirmative defense of the accused infringer to allege and to show that it is practicing the prior art. Since Hunt had neither alleged nor offered any evidence that its device is in the prior art or that a hypothetical claim covering its device would be unpatentable, Fiskars had nothing to rebut.

Hunt also claimed that Fiskars should be precluded from arguing equivalency of the carriage assembly because Hunt had specifically substituted the term "carriage assembly" for "cutting blade" in certain claims during the prosecution to overcome prior art. Rejecting Hunt's argument, the Federal Circuit concluded that the amendment was made to broaden the claims to cover other types of blades such as perforating and scoring blades, not for the purpose of patentability.

Hunt also asserted that the '001 patent was unenforceable because Fiskars had allegedly withheld from the U.S. Patent and Trademark Office ("PTO") evidence of three prior art paper cutters and a patent. In particular, Hunt argued that although Fiskars had submitted a brochure describing one particular prior art paper cutter to the PTO, the Examiner had indicated that the reference was not considered. The Federal Circuit ruled, however, that an applicant cannot be guilty of inequitable conduct if a reference was cited to the examiner, regardless of whether it was a ground of rejection by the examiner.

Moreover, the Court concluded, an applicant is not required to tell the PTO twice about the same

prior art. Finally, the Court found no clear error in the district court's determination that Hunt had presented no evidence of intent to deceive. Since both the materiality and intent portions of Hunt's affirmative defense were absent, the Federal Circuit found no abuse of the trial judge's discretion in imposing sanctions on Hunt's counsel under 28 U.S.C. § 1927, because Hunt's inequitable conduct defense was so baseless that it served merely to waste the time and resources of the litigants.

Hunt also appealed the jury's award of damages for lost profits, past price erosion, and future price erosion, claiming they were speculative and contradictory. The Federal Circuit made note of conflicting testimony as to the amount of damages but concluded that there was sufficient evidence to permit a reasonable jury to have reached the damages verdicts in this case.

Inventor's Testimony on Scope of Invention Not Enough to Invalidate Patent Under 35 U.S.C. Section 112 or 102(f)

Michael J. McCabe

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

In *Solomon v. Kimberly-Clark Corp.*, No. 00-1033 (Fed. Cir. June 30, 2000), the Federal Circuit reversed the district court's holding that Sandra Solomon's ("Solomon") patent claims were invalid under 35 U.S.C. § 112, ¶ 2, ruling that the inventor's testimony could not be used to invalidate the claims. The Court also rejected Kimberly-Clark Corp.'s ("Kimberly-Clark") argument for invalidity under 35 U.S.C. § 102(f) because Kimberly-Clark had failed to introduce clear and convincing evidence that someone else was the true inventor.

Solomon, who owns U.S. Patent No. 4,560,381 ("the '381 patent") entitled "Disposable Panty for Menstrual Wear," sued Kimberly-Clark alleging that its Personal® panty infringed all fifty-nine claims of the '381 patent. During depositions, Solomon gave testimony about the invention that contradicted the claim language. Based on this discrepancy, Kimberly-Clark moved for summary judgment ("SJ"), alleging that the patent was invalid under section 102(f) because Solomon was not the true inventor of the claimed invention, or alternatively under 35 U.S.C. § 112, ¶ 2, because Solomon had failed to claim the subject matter that she regarded as her invention.

The district court had dismissed the section 102(f) argument, stating that Kimberly-Clark had not proven by clear and convincing evidence that Solomon was not the true inventor of the patent. In allowing SJ on section 112, ¶ 2, however, the lower court had concluded that, based on Solomon's deposition testimony, the '381 patent did not accurately depict Solomon's invention.

On appeal, in addressing the section 112 argument, the Federal Circuit drew a sharp distinction between the use of inventor testimony during prosecution for clarity and definiteness purposes and after issuance as a basis for invalidity. The Court noted that during prosecution an inventor's statements explaining the invention are helpful in determining the scope of the invention and the definiteness of the patent claims. Since, during prosecution, claims can be freely amended, the U.S. Patent and Trademark Office ("PTO") should use many sources of evidence, including inventor testimony, to generate claims that are unambiguous and accurately reflect the subject matter of the invention.

In contrast, the Court concluded, the evidence considered in evaluating whether issued claims comply with section 112, ¶ 2, should be more limited. The Court reasoned that "a more limited range of evidence should be considered in evaluating validity as opposed to patentability under either portion of section 112 because the language of issued claims is generally fixed . . . , the claims are no longer construed as broadly as is reasonably possible, and what the patentee subjectively intended his claims to mean is largely irrelevant to the claim's objective meaning and scope." *Solomon*, slip op. at 12 (citations omitted).

The Court stated that claims should be viewed objectively once the patent has issued, without the influence of the subjective intent of the inventor. Since courts, not patent holders, should construe claims, trial courts should not consider the inventor's description of his patent when determining the scope and meaning of the patent claim. Accordingly, the Court reversed the district court's finding of invalidity based on Solomon's deposition testimony.

The Federal Circuit then considered Kimberly-Clark's invalidity argument under section 102(f), which requires that the named inventor must have actually invented the subject matter to be patented. Kimberly-Clark maintained that someone other than Solomon must have conceived the invention claimed by the '381 patent because Solomon's testimony regarding the subject matter of the invention differed from the claims. In upholding the district court's decision of no invalidity under section 102(f), the Court faulted Kimberly-Clark for relying solely on Solomon's lack of precision in defining her invention during depositions instead of presenting clear evidence that someone else had actually invented the claimed material.

The Court dismissed the suggestion by Kimberly-Clark that Solomon's patent attorney may have been the proper inventor as misguided. Recognizing that the purpose of the patent attorney is to obtain "a valid patent with maximum coverage," the Federal Circuit found it unreasonable to pitch the attorney against the client by allowing an assertion of inventorship as a result of representing the client.

Federal Circuit "Steps on" Shoe Patent

Timothy J. May

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

In *Hockerson-Halberstadt, Inc. v. Avia Group International, Inc.*, No. 99-1505 (Fed. Cir. July 27, 2000), the Federal Circuit affirmed the district court's interpretation of claims directed to the heel portion of an athletic shoe. The parties had stipulated to a final judgment of noninfringement based on the district court's claim construction.

Hockerson-Halberstadt, Inc. ("HHI") charged Avia Group International, Inc. ("Avia") with infringing U.S. Patent No. 4,259,792 ("the '792 patent"), which relates to the field of footwear, particularly athletic shoes, having a heel that is bisected by a central groove creating two peripheral fins. The central groove and double fin structure provides the user with a cushioning effect by distributing the downward force of footfall over a wide area of the heel. The sole claim limitation at issue on appeal reads: "a central longitudinal groove in the underside of the heel part extending forwardly through the heel part into the underside of the sole part to divide the lower surface of the heel part into a pair of fins."

The district court had construed the term "central longitudinal groove" as being a relatively long and narrow structure that extends longitudinally or lengthwise completely through the center so as to divide the heel part into a pair of fins, and concluded that the width of the central longitudinal groove must be less than the combined width of the two fins.

The Federal Circuit agreed with the district court's claim construction. As an initial matter, the Federal Circuit observed that the district court had correctly interpreted the term "groove" as meaning a "relatively long and narrow structure." The Court noted that this construction is consistent with the ordinary meaning of the term "groove," and consistent with the purpose of the invention, *i.e.*, providing a large surface area at the heel to improve shock absorption.

Upon review of the prosecution history, however, the Federal Circuit found that the inventor had disclaimed a particular interpretation of "groove," thereby modifying its ordinary meaning. During prosecution, the inventor had submitted drawings comparing the features of the claimed invention to a hypothetical combination of the prior art. According to the inventor, the claimed invention provided a much narrower groove for a totally different purpose, namely, to involve as much of the underneath surface of the footwear as possible in a cushioning and supporting function.

The Court found that by making this statement, the inventor had disavowed footwear having a groove width greater than that disclosed by the prior art,

which taught a groove width greater than the combined width of the two fins. Thus, the inventor had defined the central longitudinal groove as requiring a width that must be less than the combined width of the two fins.

HHI asserted on appeal that the district court had incorrectly analyzed the prosecution history, arguing that the inventor's "much narrower groove" statement was an erroneous statement rather than a disavowal of a particular width relationship because the statement was made in reference to drawings submitted during prosecution and the specification contains figures depicting a groove that is wider than the fins.

The Federal Circuit dismissed this argument. First, the Court noted that patent drawings do not define the precise proportions of structural elements and may not be relied on to show particular sizes if the specification is completely silent on the issue. Second, the Court found HHI's argument to be inimical to the public notice function provided by the prosecution history. The prosecution history constitutes the public record of the patentee's representations concerning the scope of the claims, and competitors are entitled to rely on those representations, the Court stated.

The Court also rejected HHI's reliance on *Intervet America, Inc. v. Kee-Vet Laboratories, Inc.*, 887 F.2d 1050 (Fed. Cir. 1989) for the proposition that erroneous statements made during prosecution do not affect claim construction analysis. The Court stated that in HHI's case, the inventor's statements apply with equal force to all of the claims since each includes the term "central longitudinal groove." Thus, the Court found that a competitor would have no reason to believe that a mistake was made or that the inventor meant anything more than what he said. Also, the '792 patent issued immediately after the inventor's particular arguments; thus, the Examiner continued to understand that the claimed groove was narrower than that of the prior art.

Court "Bags" Infringement Claim on Food Packaging Patent

Aaron M. Raphael

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

In *Ishida Co. v. Taylor*, No. 99-1537 (Fed. Cir. July 20, 2000), the Federal Circuit affirmed a district court's decision granting summary judgment ("SJ") of noninfringement in favor of Ishida Co., Ltd. ("Ishida").

U.S. Patent No. 4,663,917 ("the '917 patent") claims a machine for packaging food products such as potato chips. The machine seals the bottom end of a tube of plastic bag material, feeds an appropriate amount of product into the bag through the open end, and seals and strips the bag.

The specification of the '917 patent illustrates two embodiments of the invention. In one embodiment, a

stripping and sealing apparatus is mounted on a carriage that follows a cam track. In the other embodiment, a cam track is not used.

The district court had interpreted the stripping and sealing means limitation pursuant to 35 U.S.C. § 112, ¶ 6.

Ishida's accused device performs the same stripping and sealing functions as does the device of the '917 patent. However, Ishida's device controls certain operations with a computer, which allows Ishida's device to follow various trajectories that the '917 patent's mechanical configurations cannot follow.

On SJ, the district court had held that the accused machine does not infringe the '917 patent, concluding that no reasonable trier of fact could find the difference between the claims and the structure disclosed in the specification to be insubstantial.

On appeal, the patentee argued that the district court had incorrectly included structural elements from the specification that were unnecessary to perform the claimed function in its interpretation of the stripping and sealing means limitation. Taylor argued that the district court should have instead crafted a single claim construction that encompassed all the embodiments disclosed in the specification.

The Federal Circuit disagreed with Taylor, noting that the embodiments were structurally very different, one embodiment having a cam track that the other does not. The Court found that requiring the district court to formulate a single claim interpretation in this case would defeat the notice function of claims since someone trying to design around the '917 patent would not know whether a single claim interpretation encompassing both embodiments included cam tracks or not. In other words, the claims would give no notice of their limits.

Upon examining the means of operation of both the accused and patented devices the Federal Circuit held that Ishida's machine achieves the stripping and sealing function in a substantially different manner than do the structures in the '917 patent since Ishida's machine has a greater variability of movement and uses a different structure and process to seal and strip the bag material. Thus, the Court affirmed the SJ of noninfringement.

Court Rejects Collateral Attack Based upon Patent and Trade-Secret Misuse

Lawrence F. Galvin

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

In *Glitsch, Inc. v. Koch Engineering Co.*, No. 99-1377 (Fed. Cir. June 30, 2000), the Federal Circuit affirmed a district court's order dismissing a declaratory judgment ("DJ") action based upon a theory of patent and trade-secret misuse.

In 1982, Koch Engineering Co., Inc., and Sulzer Brothers Ltd. (collectively “Koch”) sued Glitsch, Inc. (“Glitsch”) for patent infringement and trade-secret misappropriation in the United States District Court for the Northern District of Texas (“*Case I*”). In 1992, the district court had found Glitsch liable on both counts. Before the district court had addressed damages, Glitsch moved to amend its answer to raise the affirmative defenses of patent and trade-secret misuse. However, the district court had denied Glitsch’s motion as untimely.

In response, Glitsch filed a separate DJ action (“*Case II*”) alleging patent and trade-secret misuse by Koch. *Case II* was assigned to the *Case I* judge, who granted Koch’s motion for summary judgment (“SI”) in *Case II*, reasoning that Glitsch had already waived its right to litigate the affirmative defenses of patent and trade-secret misuse in *Case I*. Glitsch appealed the SI.

On appeal, Glitsch relied on *Mercoind Corp. v. Mid-Continent Investment Co.*, 320 U.S. 661 (1944). In *Mercoind*, a nonparty corporation provided a defense in a first infringement action, but did not raise a patent-misuse defense. In a second infringement action seeking an injunction against that same corporation, the Supreme Court held that the corporation could raise the patent-misuse defense because the public policy of preventing patent misuse outweighed the public policy underlying the doctrine of *res judicata*, at least where the corporation had no other means of raising the patent-misuse defense in the second action.

The Federal Circuit distinguished *Mercoind*, which involved two successive coercive actions where *Mercoind* had no other means of raising its patent misuse defense when the second action was filed against it. The Federal Circuit held that Glitsch could still raise the defense of patent misuse (and, in all likelihood, trade-secret misuse) in a potential appeal of *Case I*. Thus, the Court found that strong policies of federal procedure preventing parties from collaterally attacking orders in one case by filing multiple actions dealing with the same matter overrode any patent-misuse concerns.

Therefore, the Federal Circuit affirmed the district court’s order dismissing *Case II*, but on the ground that Glitsch was not entitled to file *Case II* as a collateral attack on the district court’s order in *Case I*. The Federal Circuit did not reach the merits of whether Glitsch had waived its patent-misuse defense, which the Court stated could presumably be raised on any appeal in *Case I*.

Lack of Obviousness In PTO’s Reexamination Decision

Lori-Ann Johnson

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

In *In re Kotzab*, No 99-1231 (Fed. Cir. June 30, 2000), the Federal Circuit reversed the final reexamination decision by the United States Patent and

Trademark Office (“PTO”) Board of Patent Appeals and Interferences (“Board”) holding that claims 1-10 of U.S. Patent No. 5,427,720 (“the ‘720 patent”) were obvious under 35 U.S.C. § 103. The Federal Circuit, in reversing the Board’s decision, concluded that the Board had engaged in hindsight and did not have substantial evidence to reject the claims as obvious as a matter of law.

The ‘720 patent, held by Werner Kotzab, describes an injection molding method for the formation of plastic articles. Kotzab sought to meet two main goals with his injection molding method: (1) optimal temperature control, resulting in higher product quality, and (2) short molding cycle times. Claim 1 of the ‘720 patent embodies Kotzab’s goals and forms the basis for the Examiner’s, and subsequently the Board’s, rejection of the ‘720 patent upon reexamination.

Claim 1 describes a method for controlling the temperature of a mold by adding a temperature control medium through a plurality of flow control valves regulated by a single sensor. Claim 3, dependent upon claim 1, further requires a flow measuring turbine associated with each flow valve to facilitate the injection of the temperature control medium. Claim 10, dependent upon claim 3, provides that rotation of the turbines translates to pulses, which can fix the nominal flow of the temperature controlling medium by the presetting of a corresponding number of pulses.

During a third party reexamination, the Examiner concluded, and the Board affirmed, that WO 92/08598 (“*Evans*”) discloses a method of controlling an injection mold’s temperature by use of a sensor that controls the injection of temperature controlling media through the mold, thereby rendering all claims obvious. A statement in *Evans* that “one system constructed and operated according to the invention may be used to control a number of valves” was considered an explicit teaching of the use of one sensor to control multiple valves. The Federal Circuit ruled, however, that the Board had failed to provide reference to any evidence that the “one sensor” described by Kotzab is equivalent to the “one system” in the *Evans* application.

In finding obviousness, the Examiner and the Board had relied upon two independent statements within the *Evans* reference: that “one system” can be used to operate a number of valves; and that a “single sensor” may be used to take temperature measurements at a selected part of the machine. The Federal Circuit concluded, however, that the two statements from *Evans* could not be taken in the abstract. Instead, the Board should have set forth the reasons why an individual skilled in the art, and having no knowledge of the claimed invention, would relate the two teachings of the *Evans* reference. As opposed to the Board’s findings, the Federal Circuit saw no possible foundation for the assumption that because *Evans* uses a single temperature measurement to control several zones, it necessarily controls multiple valves.

Accordingly, the Federal Circuit ruled that the prior art showed no sufficient evidence that an individ-

ual reasonably skilled in the art, in the course of solving a problem like Kotzab's, would have been motivated by the teachings in Evans to produce an invention equal to the '720 patent.

Claims to Evaporation-Free Coating Compositions "Evaporate"

Jeremy M. Stipkala

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

In *UV Coatings, Ltd. v. SICO, Inc.*, No. 99-1336 (Fed. Cir. July 18, 2000) (nonprecedential decision), the Federal Circuit affirmed a district court's summary judgment ("SJ") that U.S. Patent No. 5,453,451 ("the '451 patent") is invalid because its claims are anticipated and obvious.

Claim 1 of the '451 patent recites a sprayable, one-part, substantially solvent-free coating composition that consists essentially of a mixture of acrylates and an organic photoinitiator, wherein the composition has a viscosity ranging from 2 to 300 centipoises at 25 degrees C. The claim also states that the composition is curable upon exposure to ultraviolet light without requiring evaporation of a volatile solvent.

UV Coatings, Ltd. ("UVC"), owner of the '451 patent, brought an infringement action alleging that SICO, Inc. ("SICO") manufactured infringing coating formulations. In defense, SICO presented four U.S. patents as anticipating claims 1-4 and contended that one of the four also anticipates claim 7. Moreover, SICO argued, these four prior art patents rendered all claims of the '451 patent obvious. The district court agreed and granted SJ in favor of SICO. UVC appealed.

The Federal Circuit found that claims 1-4 and 7 of the '451 patent were anticipated by U.S. Patent No. 4,319,811 to Tu et al. ("Tu"). Tu discloses solvent-free, radiation curable coatings, at least some of which can be sprayed. SICO's expert witnesses confirmed by experimentation that one of Tu's compositions can be sprayed. UVC challenged the allegation of anticipation by offering an alternative claim construction based on the terms "sprayable" and "one-part." UVC asserted that "one-part" modifies "sprayable" in claim 1, which requires claimed compositions to be homogenous and to exhibit no separation of the composition components. UVC further argued that Tu does not teach homogenous compositions. The Court rejected these arguments first by assigning "sprayable" its ordinary meaning. Since there was no evidence in the patent nor the record to support a contrary interpretation, the Federal Circuit concluded that the ordinary meaning of "sprayable" does not require homogeneity.

The Court also rejected UVC's assertion that the claim term "one-part" requires homogeneity. During prosecution of the '451 patent, the inventor had distinguished the prior art by arguing that the claimed compositions could be mixed before application whereas the prior art compositions required addition of a component just before use. Thus, the Federal Circuit held that "one-part" means the claimed compositions could be mixed before use without triggering unwanted side reactions, and the mixture did not require homogeneity. Accordingly, the Federal Circuit affirmed the district court's conclusion of anticipation on claims 1-4 and 7.

UVC attacked the holding of obviousness on the ground that the district court had failed to specify which of the prior art rendered the invention obvious. Also, UVC asserted that the district court had not expressly applied a proper obviousness analysis. The Federal Circuit, however, found no fault with the district court's analysis, which had invoked two affidavits submitted by SICO's expert witnesses. Those affidavits provided a careful obviousness analysis and found each limitation of claims 5-6 and 8 of the '451 patent to be obvious to one of ordinary skill in the art at the time of the purported invention. This showing, with the rule that anticipated claims are obvious, supported the district court's holding that all claims of the '451 patent are obvious.

UVC asserted that an affidavit submitted by the inventor of the '451 patent to the district court raised a genuine issue of material fact vis-à-vis the SICO affidavits and their conclusion of obviousness. The Federal Circuit rejected this argument because the inventor's affidavit addressed only the sprayability of the compositions tested by SICO, and did not mention obviousness.

Court "Dissects" Judgment of Willful Infringement

William L. Strauss

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

In *General Surgical Innovations, Inc. v. Origin Medsystems, Inc.*, No. 99-1382 (Fed. Cir. July 10, 2000) (nonprecedential decision), the Federal Circuit reversed a grant of summary judgment ("SJ") that Origin Medsystems, Inc. ("Origin") had induced infringement of claims 1 and 2 of U.S. Patent No. 5,514,153 ("the '153 patent").

General Surgical Innovations, Inc. ("GSI") owns the '153 patent, which claims a method for using inflatable balloon catheters to create a space in which surgery is to be performed. Origin manufactures and sells a variety of devices that use balloon inflation to

create the space in which a surgical procedure is performed.

Independent claim 1 of the '153 patent requires that inflation of the balloon creates an "open space . . . adjacent to the distal end of the cannula." After a *Markman* hearing, the district court concluded that an "open space" is a "space for the performance of a surgical procedure, which is not occupied by a bladder or other device, or by tissue." The district court had construed "adjacent to the distal end of the cannula" to require that the open space be "next to, but not occupied by, the expanded portion of the cannula."

Both parties moved for SJ based on the district court's construction of claim 1. GSI argued that Origin's literature showed that the use of Origin's products results in the creation of open space in addition to that occupied by the inflated balloon. GSI also introduced the testimony of one expert that some open space was created when the Origin products were used. In response, Origin presented the testimony of four witnesses to support its argument that no additional space beyond that occupied by the balloon is created by its accused devices. Origin's witnesses also testified that the diagrams in the Origin product literature, which GSI had relied on, were schematic and did not exactly reproduce the anatomy created when Origin's devices were used during surgery.

The district court had found that Origin's literature "clearly claims that there is space created outside the balloon after it is inflated," and dismissed the testimony of Origin's witnesses as either inconsistent or lacking evidentiary support. The district court then granted GSI's motion for SJ that use of the Origin products infringed claim 1 and dependent claim 2 of the '153 patent.

A jury then found that Origin's infringement had been willful and awarded damages to GSI.

On appeal, neither party challenged the district court's construction of claim 1. Origin, however, argued that the "open space" recited by claim 1 must be adjacent to the inflated balloon, while GSI asserted that the "open space" need not be adjacent to the inflated balloon, but instead could include the space once occupied by the inflated balloon, which had been removed. The Federal Circuit agreed with Origin, reasoning that GSI's interpretation read out of the claim the requirement that the open space be adjacent to the expanded portion of the cannula, *i.e.*, adjacent to the expanded balloon.

The Federal Circuit also concluded that the district court had erred in granting GSI's motion for SJ. First, the Federal Circuit found that the testimony of Origin's witnesses created genuine issues of material fact regarding whether Origin's devices create an open space. Second, the Federal Circuit concluded that an issue of material fact also remained as to whether, if the Origin devices do create an open space, that open space is sufficient for performing a surgical procedure.

The Federal Circuit vacated both the district court's grant of SJ that Origin induced infringement of claims 1 and 2 of the '153 patent and the jury's verdict that Origin's infringement was willful, and remanded to the district court for further proceedings.

High-Tech Boat Design Satisfies "Raft" Limitation

Michele C. Bosch

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

In *Snuba International, Inc., v. Dolphin World, Inc.*, No. 99-1357 (Fed. Cir. July 11, 2000) (nonprecedential decision), the Federal Circuit reversed and remanded a district court's ruling of noninfringement of claim 1 of U.S. Patent No. 4,919,631 ("the '631 patent") for a determination of damages, finding the jury's verdict not supported by substantial evidence.

Snuba International, Inc.'s ("Snuba") patented product is an underwater diving system comprising compressed air tanks situated on a raft that is towed by an underwater diver. Dolphin World, Inc. ("Dolphin World") manufactured, promoted and sold a competing product, the "Free Diver," which is a diving system that includes a floating "pod" for carrying compressed air tanks. Snuba sued Dolphin World for patent infringement, alleging literal, induced, and contributory infringement. Infringement under the doctrine of equivalents ("DOE") was not asserted.

Prior to the jury trial, the undisputed claim construction resulting from a *Markman* hearing had defined two terms: "raft," which was defined as "a platform that floats on the water" and "harness means," which was defined as "a device which dissipates force when towing."

With respect to literal infringement, the Federal Circuit, after considering testimonial evidence and Dolphin World's promotional literature, concluded that Dolphin World's pod was a "raft" and contained a "harness means," as these terms were broadly defined by the district court. The Court concluded that no reasonable jury could have found otherwise.

Having found the two disputed claim elements present in Dolphin World's product, the Court turned to an evaluation of whether there was substantial evidence that Dolphin World ever made, used, or sold the combination of the elements in claim 1. In its evaluation, the Court relied upon the available circumstantial evidence, *e.g.*, Dolphin World's promotional literature, and concluded that Dolphin World had provided photographs and written instructions on how its Free Diver system was designed and intended to be used in the combination recited in claim 1 of the '631 patent. The Court thus concluded that no reasonable jury could have found that Dolphin World did not use the combination of elements set forth in claim 1.

As for induced and contributory infringement, the Federal Circuit found that the circumstantial evidence submitted by Snuba, *e.g.*, the sales information and promotional materials, demonstrated Dolphin World's sales of elements of the claimed combination and directions for use thereof in an infringing manner. Since Dolphin World offered no evidence to contradict the only reasonable conclusion to be drawn from the circumstantial evidence submitted, the Court found that no reasonable jury could have concluded that Snuba failed to prove induced or contributory infringement of claim 1 by a preponderance of the evidence. The Court found that Dolphin World had knowledge of the '631 patent and that the Dolphin diver pod was not a staple article.

Description of Claimed "Urging Means" "Urges" Noninfringement

Virginia L. Carron

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

In *Sammon v. National Hand Tool Division, Stanley Works, Inc.*, No. 99-1459 (Fed. Cir. July 14, 2000) (non-precedential decision), the Federal Circuit affirmed the district court's determination that National Hand Tool Division, Stanley Works, Inc., and Sears Roebuck & Co.'s (collectively "NHT") device neither literally infringes U.S. Patent No. 4,614,457 ("the '457 patent") nor infringes under the doctrine of equivalents ("DOE").

The '457 patent claims a mechanism for coupling a socket with a socket wrench extender. The United States District Court for the Northern District of Ohio had granted NHT's motion for summary judgment ("SJ") of noninfringement.

Claim 1 of the '457 patent recites a coupling mechanism consisting of a detent ball, a horizontal pin, and a vertical pin. These components are all within the interior of a socket wrench extender. In a locked position, part of the vertical pin protrudes from the surface of the extender forming a button. The detent ball also protrudes from the surface of the extender near its end. The protruding detent ball fits into a small groove on the inner surface of a socket thereby locking the socket in place. When a user applies pressure to the button, cams transmit the pressure on the vertical pin to the horizontal pin. The horizontal pin moves to the left against the resistance of a spring. The detent ball thus falls into the pocket on the horizontal pin, releasing the lock that held the socket in place.

When the user releases pressure on the button, the spring forces the horizontal pin into its original position. As the horizontal pin slides back, it forces the ball back out by means of a ramp on the face of the horizontal pin. In a locked position, the spring exerts force on the

horizontal pin. The ramp on the face of the horizontal pin causes this force to be transmitted to the detent ball. Thus, the spring acts indirectly on the detent ball, forcing it out.

The parties disagreed on whether the claim language requires constant outward pressure on the detent ball. The key limitation in claim 1 reads: "urging means acting through said linkage means on said detent member." The Federal Circuit found that the district court had correctly interpreted this claim limitation as a means-plus-function element under 35 U.S.C. § 112, ¶ 6 because the word "means" within a patent claim creates a presumption that section 112, ¶ 6 applies and the language of claim 1 does not recite sufficient structure to rebut this presumption.

The Federal Circuit determined that the claimed function "acting" is ambiguous and thus looked to the specification to help determine its meaning. The '457 patent drawings show a ramped structure that transmits the spring's force to the detent ball with the mechanism in the locked position. In addition, the written description explains that the detent member is urged laterally outward. Thus, reading the claim language in light of the illustrations and written description, the Federal Circuit determined that the district court had not erred when it construed "acting" to require constant outward force while in the locked position.

Because literal infringement of a section 112, ¶ 6 limitation requires that the structure in the accused mechanism perform the identical function recited in the claim with identical or equivalent structure to that disclosed, and because the district court had found that the structure of NHT's mechanism precluded outward force on the detent ball in the locked position, the Federal Circuit found that the accused device could not literally infringe under section 112, ¶ 6 and affirmed the district court's grant of SJ precluding literal infringement. The Court also affirmed the district court's entry of SJ under the DOE because one element of claim 1 of the '457 patent was missing from NHT's mechanism and there was no equivalent element.

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