

# FINNEGAN

## LAST MONTH AT THE FEDERAL CIRCUIT

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# SPOTLIGHT INFO:

In *In re Comiskey*, No. 06-1286 (Fed. Cir. Jan. 13, 2009), the Federal Circuit issued an order granting a petition for rehearing en banc for the limited purpose of authorizing the merits panel to revise its original opinion. In the revised opinion, No. 06-1286 (Fed. Cir. Jan. 26, 2009), the Federal Circuit affirmed the Board's decision rejecting Stephen W. Comiskey's claims to a mandatory arbitration process, but affirmed the rejections on different grounds than that considered by the Board. Although the Board affirmed the examiner's rejection based on prior art under 35 U.S.C. § 103, the Federal Circuit did not consider that reasoning and instead affirmed the rejections of the method claims on the ground that they did not recite patentable subject matter under 35 U.S.C. § 101. As for the system claims, the Court remanded the claims to the PTO for further consideration. The original decision held that Comiskey's system claims satisfied § 101, but remanded them to the PTO for consideration of whether they satisfied § 103 by adding routine electronics to an otherwise unpatentable mental process. The revised decision, however, deleted the Court's original warning that "[t]he routine addition of modern electronics to an otherwise unpatentable invention typically creates a prima facie case of obviousness," citing *Leapfrog Enters. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007). Moreover, the revised decision omitted the holding that Comiskey's system claims recite patentable subject matter and instead directed the PTO to consider whether the system claims satisfy § 101 in the first instance. See full summary below.

## Petition for Rehearing En Banc Granted for Limited Purpose of Authorizing Panel to Revise Its Opinion

Erika H. Arner

**Judges: Michel, Newman (dissenting), Mayer, Lourie (concurring), Rader, Schall, Bryson, Gajarsa, Linn, Dyk (concurring), Prost, Moore (dissenting)**

### [Appealed from Board]

In *In re Comiskey*, No. 06-1286 (Fed. Cir. Jan. 13, 2009), the Federal Circuit, sitting en banc, granted rehearing for the limited purpose of vacating the original judgment entered on September 20, 2007, reported at 499 F.3d 1365 (Fed. Cir. 2007), and allowing the merits panel to issue a revised opinion. The per curiam en banc order was accompanied by a concurrence by the original panel members, Judge Dyk (author), Chief Judge Michel, and Judge Prost; a concurrence by Judge Lourie; a dissent by Judge Moore; and a dissent by Judge Newman.

In a concurring opinion filed with the order denying further rehearing, the merits panel defended its affirmance of the PTO's rejections on alternative grounds. Judge Dyk, joined by Chief Judge Michel and Judge Prost, argued that the panel's reliance on *SEC v. Chenery Corp.*, 318 U.S. 80 (1943), was proper, citing several instances in which the Federal

Circuit and other reviewing courts had invoked the power to affirm an agency decision on alternative grounds. The concurrence maintained that the § 101 issue was fully briefed on appeal at the Court's invitation and that addressing the issue of § 101 was both desirable and appropriate.

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"Instead of addressing this clear and simple ground [of obviousness], the court elected *sua sponte* to decide one of the most far reaching and important patentability issues—the scope of patentable subject matter under § 101." Moore Dissent at 10 n.6.

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In his concurrence, Judge Lourie concurred in the Court's decision to deny the petition for further rehearing en banc. According to Judge Lourie, not only are Comiskey's method claims unpatentable under § 101, but the system claims also fail to recite statutory subject matter. Judge Lourie also concurred in the panel's decision to vacate the issued opinion and remove language that was contrary to law.

Judge Moore, joined by Judges Newman and Rader, dissented from the denial of a broader rehearing en banc, arguing that the panel erred by introducing

a new ground of rejection (§ 101) and failing to consider the only ground for rejecting the claims decided below and appealed by the parties (§ 103). Judge Moore criticized the panel's reliance on *Chenery* and maintained that the power to decide new legal issues on appeal from agency action is limited to cases in which the agency's ground was erroneous. According to Judge Moore, the panel here cannot justify its decision by arguing that it avoided a wasteful remand because it did not consider whether the PTO's § 103 rejection of the claims was erroneous. Although the PTO and the applicant spent nearly a decade fighting over the obviousness of the system claims, Judge Moore noted that the Court refused to consider whether the system claims were obvious and instead remanded for the PTO to consider whether the claims are directed to patentable subject matter. Judge Moore also found puzzling that the panel decided that the process claims are directed to unpatentable subject matter, but remanded the machine claims to the PTO to consider whether they are directed to patentable subject matter. Judge Moore noted that the Court has a long line of precedent that holds that machine claims are patent eligible subject to the Supreme Court's exceptions to patentability. Accordingly, Judge Moore stated that the Court should take *Comiskey* en banc to review its creation of broad appellate authority to decline to address the bases provided by any agency for its actions and instead decide a legal ground of its choosing.

Finally, Judge Newman filed a separate dissent from the denial of a full rehearing en banc to address the panel's perceived misinterpretation of 35 U.S.C. § 101. According to Judge Newman, the panel's rejections under § 101 perpetuate a broad and ill-defined exclusion of business method patents. Judge Newman wrote that the panel's disparate treatment of the method and system claims was unsupported by statute or policy and that the Court's holding cast a cloud over thousands of issued patents and pending patent applications. (The full text of the order is available on the Federal Circuit's website as Dkt. # 06-1286o.pdf.)

## Federal Circuit Revises Original Opinion to Remand Machine Claims to the PTO to Consider Whether Claims Recite Patentable Subject Matter

Erika H. Arner

**Judges: Michel, Dyk (author), Prost**

### [Appealed from Board]

In *In re Comiskey*, No. 06-1286 (Fed. Cir. Jan. 26, 2009), revising No. 06-1286 (Fed. Cir. Jan. 13, 2009), the Federal Circuit issued a revised opinion in which the outcome remained the same as its prior opinion: the Court affirmed the Board's decision rejecting claims to a mandatory arbitration process in U.S. Patent Application No. 09/461,742 by Stephen W. Comiskey. Although the Board had affirmed the examiner's rejections based on prior art under 35 U.S.C. § 103, the Federal Circuit did not consider that reasoning and instead affirmed the rejections of Comiskey's method claims on the ground that they did not recite patentable subject matter under 35 U.S.C. § 101. As for the machine claims, the Court remanded to the PTO to consider the § 101 question in the first instance.

Comiskey's application claimed methods and systems for performing mandatory arbitration resolution regarding one or more legal documents. The PTO examiner rejected the claims under 35 U.S.C. § 103(a) as obvious over a combination of prior art references. The rejections were affirmed by the Board, and Comiskey appealed to the Federal Circuit. During oral arguments, the Federal Circuit raised the question of whether Comiskey's claims recited patentable subject matter under 35 U.S.C. § 101 because the method claims did not require any machine or computer and the system claims were broader than any computer-implemented system. Afterwards, the Court requested supplemental briefing on the § 101 issue.

In both its original decision (now vacated) and the revised decision, the Court expressly did not reach the obviousness rejections affirmed by the Board, instead finding that many of the claims were barred by the threshold requirement of compliance with § 101.

In its discussion, largely unchanged by the revised decision, the Court began by addressing Comiskey's argument that the issue of patentable subject matter could not properly be raised by the reviewing Court. Based on the Administrative Procedure Act, Comiskey argued that the Federal Circuit's review should be limited to the record before the PTO, which did not include rejections under § 101. The Court rejected this argument and cited the Supreme Court's holding in *SEC v. Chenery Corp.*, 318 U.S. 80 (1943), that a reviewing court can and should affirm an agency decision on legal grounds not relied on by the agency when there is no issue of fact, policy, or agency expertise. Noting that whether claims recite statutory subject matter under § 101 is a question of law reviewed without deference, the Court continued to address the merits.

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“[T]he patent statute does not allow patents on particular systems that depend for their operation on human intelligence alone, a field of endeavor that both the framers and Congress intended to be beyond the reach of patentable subject matter.” Slip op. at 22.

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Beginning with the constitutional provision authorizing Congress to grant patents to promote the “useful Arts,” the Court examined the scope of subject matter that falls within the four categories set forth in the Patent Act of 1952, namely, any new and useful process, machine, manufacture, or composition of matter. The scope of patentable subject matter under the Act may be “extremely broad,” but the Court noted that not every process is patentable.

Regarding the prohibition against patenting abstract ideas, the Court noted that an abstract concept that has no claimed practical application is not patentable. Furthermore, the Court stated, “a claim reciting an algorithm or abstract idea can state statutory subject matter only if, as employed in the process, it is embodied in, operates on, transforms, or otherwise involves another class of statutory

subject matter, i.e., a machine, manufacture, or composition of matter.” Slip op. at 18.

The Court next analyzed Supreme Court cases finding a process containing an abstract idea to be patentable if the process is tied to a machine or if it acts to transform subject matter to a different state or thing. See, e.g., *Diamond v. Diehr*, 450 U.S. 175 (1981); *Tilghman v. Proctor*, 102 U.S. 707 (1880); *Cochrane v. Deener*, 94 U.S. 780 (1876). The Court also considered its earlier decisions that found processes patentable because they claimed practical applications and were tied to specific machines. See, e.g., *AT&T Corp. v. Excel Commc'ns, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999); *State St. Bank & Trust Co. v. Signature Fin. Group*, 149 F.3d 1368 (Fed. Cir. 1998); *In re Alappat*, 33 F.3d 1526 (Fed. Cir. 1994) (en banc). The Court therefore held that “a claim that involves both a mental process and one of the other categories of statutory subject matter (i.e., a machine, manufacture, or composition) may be patentable under § 101.” Slip op. at 19.

Considering the nature of business method patents, the Court noted that business methods are patentable subject to the same legal requirements for patentability as applied to any process or method. Therefore, according to the Court, “the present statute does not allow patents to be issued on particular business systems—such as a particular type of arbitration—that depend entirely on the use of mental processes.” *Id.* at 22.

Turning to Comiskey's application, the Court held that the claims reciting methods for mandatory arbitration resolution, which Comiskey admitted did not recite any computer or other apparatus, were impermissible attempts to patent the use of “human intelligence in and of itself.” *Id.* at 23. Thus, the Court affirmed the rejections of Comiskey's method claims on the ground that they recited only abstract ideas and were therefore ineligible for patenting.

Regarding Comiskey's system claims, the Court's revised decision omitted the original holding that the system claims, which did recite computer components, recited patentable subject matter under § 101. Instead, the Court noted that the system claims recited the use of a machine and remanded the case to the PTO to consider in the

first instance whether the system claims satisfy § 101. The Court reasoned that remanding the case to the PTO would afford Comiskey the opportunity to amend his claims in light of the newly applied § 101 rejections. (The full text of the original revised opinion, which issued on January 13, 2009, is available on the Federal Circuit's website as Dkt. # 06-1286.pdf, and the revision to the revised opinion, which issued on January 26, 2009, is available as Dkt. # 06-1286r.pdf.)

## Court Finds Obviousness Based on Adjacent Figures in a Single Prior Art Reference

Jim P. Kastenmayer

**Judges: Lourie (author), Rader, Prost**

**[Appealed from D. Del., Judge Robinson]**

In *Boston Scientific Scimed, Inc. v. Cordis Corp.*, No. 08-1073 (Fed. Cir. Jan. 15, 2009), the Federal Circuit affirmed the district court's construction of claim 8 of U.S. Patent No. 6,120,536 ("the '536 patent"), but reversed the district court's denial of Cordis Corporation's ("Cordis") motion for JMOL, finding that claim 8 of the '536 patent would have been obvious in view of a prior art patent showing two adjacent figures that together disclosed all the elements of that claim.

Boston Scientific Scimed, Inc. and Boston Scientific Corporation (collectively "Boston Scientific") own the '536 patent, which relates to drug-eluting expandable stents. The stents are coated with an undercoat that incorporates a biologically active material, and a topcoat comprising a nonthrombogenic material that provides "long term non-thrombogenicity . . . during and after release of the biologically active material." Slip op. at 2. Cordis makes the Cypher drug-eluting expandable stent. Boston Scientific sued Cordis, alleging that the Cypher stent infringed the '536 patent. At trial, the jury found that claim 8 of the '536 patent would not have been obvious based on, among other prior art references, U.S. Patent No. 5,545,208 ("Wolff"). The jury also found that the Cypher stent infringed that claim.

After trial, Cordis filed a renewed motion for JMOL or, in the alternative, a new trial on infringement and validity, but the district court upheld the jury's verdict. Cordis again moved for a new trial based on new FDA evidence of increased risk of thrombosis in patients treated with drug-eluting stents, arguing that the Cypher stent could not provide long term nonthrombogenicity. The district court denied the motion. Cordis timely appealed the district court's claim construction, the denial of JMOL of obviousness and noninfringement, and the denial of a new trial.

On appeal, the Federal Circuit considered whether the court properly construed the phrase "non-thrombogenic material which provides long term non-thrombogenicity to the device portion during and after release of the biologically active material" to mean "a material that does not promote thrombosis for a period of time that extends both during and after release of the biologically active material." *Id.* at 3. The district court had relied on medical dictionary definitions for the meaning of "thrombogenic," which did not appear in the patent, and "thrombolytic," which appeared in the specification but not in the claims.

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**"Combining two embodiments disclosed adjacent to each other in a prior art patent does not require a leap of inventiveness." Slip op. at 17.**

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The Federal Circuit agreed that the district court correctly construed the "non-thrombogenic limitation," and that it properly employed the analysis set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). Because the Federal Circuit found the meaning of "non-thrombogenic" unclear from the claims themselves, it turned to the specification, which described ways to modify a topcoat or surface to be more nonthrombogenic. Thus, the Court concluded that the thrombogenic activity of the claimed stents is reduced relative to stents whose topcoats have not been so modified. Accordingly, the Court rejected Cordis's argument that "non-thrombogenic" should be read to require less thrombogenicity than an uncoated metal stent.



The Court also found that the prosecution history indicated that if “non-thrombogenic” required reduced thrombogenicity over anything, it would be reduced over a coated stent, not a bare metal stent.

The Federal Circuit also held that the district court did not err by relying on a dictionary because “[c]ourts may of course ‘rely on dictionary definitions when construing claim terms, so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents.’” Slip op. at 9 (quoting *Phillips*, 415 F.3d at 1322-23). Finding that the district court’s definition accorded with the specification, prosecution history, and the dictionary definition of a related term, the Federal Circuit affirmed the district court’s definition of “non-thrombogenic.” The Federal Circuit also affirmed the district court’s construction of the “long term” aspect of the “non-thrombogenic” limitation, and did not address Cordis’s noninfringement argument based on an alternate claim construction.

Turning to validity, the Court considered Cordis’s argument that the district court erred in denying Cordis’s motion for JMOL of invalidity of the ‘536 patent on the ground of obviousness over the Wolff patent alone. Figure 3B of Wolff shows a polymer stent made of a drug-eluting polymer with a barrier topcoat. Wolff also refers to the stent and topcoat as separate layers. Figure 4 of Wolff shows a metallic stent with a drug-eluting polymer coating, and the drug-eluting polymer coating is identified with the same numeral as the drug-eluting polymer stent of figure 3B. Cordis argued that it would have been obvious to combine Wolff’s figure 3B and figure 4.

Boston Scientific replied that claim 8 was not obvious because Wolff failed to recognize the additional nonthrombogenic benefits of a substantially drug-free topcoat over a topcoat that contains drugs, that Wolff only disclosed a single coating, and that nonthrombogenicity is not inherent in Wolff’s topcoats. As secondary considerations of nonobviousness, Boston Scientific pointed to the apparent failure of others to design a drug-eluting stent before the ‘536 patent’s priority date. Boston Scientific also argued that Cordis’s expert admitted a long-felt need for such stents and that Cordis’s

witness stated Cypher’s success was due to the claimed polymer coating system.

The Federal Circuit agreed with Cordis that Wolff alone rendered claim 8 of the ‘536 patent obvious and therefore invalid. Pointing to figure 3B and the specification of the ‘536 patent, the Court noted that figure 3B shows a layer made of polymer covered by a second layer of polymer. The Court further noted that the specification teaches that the stent in figure 3B may be made from one or several layers of polymer. The Court also pointed to passages of the ‘536 patent showing Wolff’s contemplation of using stent design to reduce thrombogenesis, in addition to using the elution of a thrombolytic drug to reduce thrombogenesis. Finally, the Court rejected Boston Scientific’s argument that Wolff failed to recognize the additional nonthrombogenic benefits of the topcoat, explaining that Wolff need not have recognized the additional benefit of one embodiment to have rendered the claim obvious.

For these reasons, the Court concluded that Wolff teaches all of the limitations of claim 8 of the ‘536 patent, and the record did not contain substantial evidence for the jury to conclude otherwise. The Court qualified this statement of fact in that all of the limitations were found in two separate embodiments pictured side by side in Wolff, not in one embodiment. However, “[c]ombining two embodiments disclosed adjacent to each other in a prior art patent does not require a leap of inventiveness.” *Id.* at 17. The Court concluded that one of ordinary skill would have been motivated to coat the metal stent of figure 4, including its layer of drug-containing polymer, with a second layer of polymer, like the layer depicted in figure 3B, and that the combination constitutes claim 8. The Court found the weak secondary considerations of nonobviousness did not overcome the strong prima facie case showing that Wolff renders claim 8 of the ‘536 patent obvious. Therefore, the Federal Circuit concluded that the district court incorrectly upheld the jury’s nonobviousness verdict, and held as a matter of law that claim 8 would have been obvious in view of Wolff.

## The District Court Erred in Granting SJ of Obviousness and by Not Taking into Account Evidence of Secondary Considerations

Troy A. Petersen

**Judges: Rader, Friedman, Bryson (author)**

**[Appealed from W.D. Ky., Judge Simpson]**

In *Süd-Chemie, Inc. v. Multisorb Technologies, Inc.*, No. 08-1247 (Fed. Cir. Jan. 30, 2009), the Federal Circuit vacated the district court's grant of SJ that U.S. Patent No. 5,743,942 ("the '942 patent") was invalid due to obviousness and remanded. The Court found that the evidence before the district court did not support its conclusion that the prior art disclosed every claim limitation.

Süd-Chemie, Inc. ("Süd-Chemie") owns the '942 patent. The '942 patent is directed to desiccant containers, which are frequently used to maintain a dry environment for products during storage or shipping. Some desiccants function by absorbing water vapor and undergoing a phase change into liquid form. Leakage of the liquid from the desiccant container would defeat the purpose of the desiccant and could damage either the products that are maintained in a dry environment or the container in which the products are shipped. The '942 patent discloses a desiccant container made from a water-vapor-permeable, multilayered packaging material. The '942 patent, contrary to the prior art, sought to solve the problem of water leakage by requiring the use of packaging films that are not coated with adhesives but that are "compatible" with each other.

Süd-Chemie sued Multisorb Technologies, Inc. ("Multisorb") for infringement. After the district court issued an order construing claim 1, the only independent claim of the '942 patent, both parties filed cross-motions for SJ on the issues of infringement and validity. The central issue with respect to validity was whether U.S. Patent No. 4,487,791 ("Komatsu") rendered the '942 patent invalid for obviousness. The district court granted SJ that the '942 patent was invalid for obviousness in view of Komatsu. Süd-Chemie appealed.

Süd-Chemie asserted that Komatsu failed to teach three of the limitations pertaining to the desiccant container recited in claim 1. The Federal Circuit agreed with Multisorb that Komatsu taught two of those limitations, but concluded that the evidence before the district court did not support its conclusion that Komatsu disclosed the third limitation. Specifically, claim 1 of the '942 patent requires that the inner surfaces of the microporous and laminate films recited in the claim be "comprised of compatible polymeric materials." The district court concluded that Komatsu taught the use of compatible films because "[t]he Komatsu patent suggest[ed] the employment of the same materials claimed by the '942 patent to be 'compatible polymeric materials.'" Slip op. at 8 (first alteration in original).

The Federal Circuit found that Komatsu disclosed the same general classes of materials that were identified in the '942 patent. The Court, however, noted that the district court failed to acknowledge that the specified classes of materials comprised a large number of substances with quite different properties, and that various combinations of those materials could be compatible or incompatible, depending on how they are assembled in layers to form the container. Relying on the definition of "compatible" given in the specification of the '942 patent, the Federal Circuit found that Komatsu taught the use of incompatible materials, not compatible materials as claimed in the '942 patent. The Court observed that the district court failed to recognize that Komatsu disclosed the use of incompatible materials, whereas the '942 patent required compatible materials. As such, the Court vacated the district court's grant of SJ of invalidity for obviousness and remanded.

In so doing, the Federal Circuit reiterated that evidence relating to secondary considerations "can be quite instructive in the obviousness inquiry." *Id.* at 12. While the Court made no judgment as to the probative value of Süd-Chemie's evidence regarding the asserted secondary considerations, it emphasized that the district court should take such evidence into account when conducting obviousness analysis.

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## Abbreviations

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 and Drug Administration
IDS.....	Information Disclosure Statement
ITC.....	International Trade Commission
JMOL.....	Judgment as a Matter of Law
MPEP .....	Manual of Patent Examining Procedure
NDA .....	New Drug Application
PCT.....	Patent Cooperation Treaty
PTO .....	United States Patent and Trademark Office
SJ.....	Summary Judgment
TTAB.....	Trademark Trial and Appeal Board

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## Looking Ahead

On January 21, 2009, defendant St. Jude Medical, Inc. ("St. Jude") filed a petition for en banc rehearing in *Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*, Nos. 07-1296, -1347 (Fed. Cir. Dec. 18, 2008). In 2007, the Supreme Court found that software cannot be considered per se a "component" under 35 U.S.C. § 271(f). *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437 (2007). In *Cardiac Pacemakers*, the Federal Circuit held that *Microsoft* did not overrule a prior precedential ruling in *Union Carbide Chemicals & Plastics Technology Corp. v. Shell Oil Co.*, 425 F.3d 1366 (Fed. Cir. 2005), that § 271(f) does extend to cover components of a claimed method. If St. Jude's petition for en banc rehearing is unsuccessful, a petition for a writ of certiorari at the Supreme Court is possible.