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DEVELOPMENTS IN PATENT LAW 2001

December 2000 through November 2001

I. NEW PATENT LEGISLATION

- II. CASE LAW
- III. TRENDS IN PATENT LAW

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I. <u>NEW PATENT LEGISLATION</u>

No new patent legislation has been enacted in the past year. However, several bills were introduced that may become law in the near future, including:

H.R. 1333: "Patent Improvement Act of 2001," introduced April 3, 2001:

- Introduces patent opposition procedure similar to that used by other countries (can oppose an issued patent within 9 months after issuance)
- Makes it easier to prove that a computer-implemented invention is obvious
- Requires patent applicants to disclose whether they did a prior art search

H.R. 1332: "Business Method Patent Improvement Act of 2001," introduced April 3, 2001:

- Requires that patent applications for "business methods" be published at 18 months
- Provides opposition procedures for "business method" patents (up to 9 months)
- Lowers the burden of proof for invalidating "business method" inventions
- Makes it easier to prove that a "business method" invention is obvious
- Requires "business method" applicants to disclose whether they did a prior art search

S. 320: "Intellectual Property and High Technology Technical Amendments Act of 2001:"

- Makes minor amendment to section 102(e) (prior art effect of PCT applications)
- Changes "Director" title back to "Commissioner"

H.R. 1886 (no short title), introduced May 17, 2001, passed by House on September 5, 2001:

• Allows third parties in patent re-examinations to appeal to the Federal Circuit

H.R. 1866 (no short title), introduced May 17, 2001, passed by House on September 5, 2001:

• Allows PTO to re-examine patents on basis of previously considered prior art (overrules <u>Portola Packaging</u> decision by Federal Circuit)

S. 1611 and H.R. 3204, "Intellectual Property Protection Restoration Act of 2001," introduced November 1, 2001:

- Restores liability of states for patent infringement to circumvent Supreme Court decision in <u>Florida Prepaid</u>
- States not entitled to sue for patent infringement unless they waive sovereign immunity for suits against them

II. CASE LAW

A. <u>PATENTABILITY & VALIDITY</u>

1. STATUTORY SUBJECT MATTER

<u>Pioneer Hi-Bred Int'l, Inc. v. J.E.M. AG Supply, Inc.</u>, 200 F.3d 1374, 53 USPQ2d 1440 (Fed. Cir. 2000). The Supreme Court has agreed to review this Federal Circuit decision, which held that seed-reproduced plants can be patented under section 101 of the patent statute, despite the fact that the Plant Patent Act of 1930 and the Plant Variety Protection Act of 1970 also cover such plants. Pioneer's utility patents on new varieties of hybrid and inbred corn and on their seeds were upheld as patentable subject matter.

2. WRITTEN DESCRIPTION

<u>Turbocare Div. of Demag Delaval Turbomachinery Corp. v. General Elec. Co.</u>, 264 F.3d 1111 (Fed. Cir. 2001). A patent claim is invalid if it includes new matter added during prosecution of the patent. The inventor amended the claims to refer to a specific location of a spring, but the specification had not specifically described such a location for the spring. The Federal Circuit held that the claim was invalid for lack of written description, noting that the inventor could not rely on any alternative date for the new matter since no continuation-in-part had been filed.

3. ANTICIPATION

<u>Telemac Cellular Corp. v. Topp Telecom, Inc.</u>, 247 F.3d 1316 (Fed. Cir. 2001). A party may rely on extrinsic evidence to show that a prior art reference inherently includes a particular feature. In this case, the court relied on the patent owner's own documents and testimony to show that a certain feature in a prior art patent "necessarily included" a claim limitation even though it was not explicitly described in the prior art patent.

<u>Dow Chem. Co. v. Astro-Valcour, Inc.</u>, 267 F.3d 1334 (Fed. Cir. 2001). A prior inventor under 35 U.S.C. § 102(g) need not appreciate that he is an "inventor" in the legal sense of the word in order for his or her work to invalidate another patent. Employees of Astro-Valcour reduced to practice a foam that anticipated claims in the Dow patent, but the employees did not appreciate that they had created a potentially patentable invention. Nevertheless, the Federal Circuit held that the actual reduction to practice was sufficient to invalidate Dow's patent.

4. ON-SALE BAR

<u>Group One, Ltd. v. Hallmark Cards, Inc.</u>, 254 F.3d 1041 (Fed. Cir. 2001). In order to constitute an invalidating bar to patentability, an offer to sell an invention must be "a formal offer in the contract sense" (i.e., legally binding). In this case, the offer to sell the invention did not bar the patent because the parties did not communicate specific terms, such as price and quantity. The Federal Circuit held that "the question of whether an invention is the subject of a commercial offer for sale is a matter of Federal Circuit law, to be analyzed under the law of contracts as generally understood." The court looked to the UCC to conclude that the communication from the inventor could not have been accepted as a legally binding contract.

<u>Monon Corp. v. Stoughton Trailers, Inc.</u>, 239 F.3d 1253 (Fed. Cir. 2001). An offer to sell an invention will not necessarily invalidate a patent if the sale is primarily "experimental" in nature as opposed to "commercial" in nature. In this case, the inventor sold a single truck for \$18,640 to another company, purportedly to allow the company to evaluate its suitability for use. The Federal Circuit concluded that such evidence was sufficient to avoid invalidity on summary judgment.

<u>Robotic Vision Sys., Inc. v. View Eng'g, Inc.</u>, 249 F.3d 1307 (Fed. Cir. 2001). An invention was held to be "on sale" more than one year before the filing date of the patent, even though the inventor had not yet reduced it to practice; had no drawings; and was not confident that it would work for its intended purpose. The Federal Circuit found it sufficient that one of the co-inventors had described the invention to a computer programmer in sufficient detail that the programmer later was able to make it work. The Federal Circuit concluded that this "enabling disclosure" was all that was required under the Supreme Court's <u>Pfaff</u> standard.

<u>Space Systems/Loral, Inc. v. Lockheed Martin Corp.</u>, F.3d ____, 2001 WL 1403311 (Nov. 13, 2001). A document that is not enabling cannot form the basis for showing that an invention was "on sale" more than one year before the filing date of a patent application. In this case, the inventor sent a proposal including rough drawings outlining a possible system that met the later-claimed limitations. The Federal Circuit noted that the inventor was not sure that his concept would work, and that a "mere conception" was insufficient to invoke the on-sale bar. The court also stated that "the fact that a concept is eventually shown to be workable does not retrospectively convert the concept into one that was 'ready for patenting' at the time of conception."

<u>Special Devices, Inc. v. OEA, Inc.</u>, F.3d ____, 2001 WL 1298888 (Fed. Cir. Oct. 26, 2001). The Federal Circuit rejected a "supplier exception" to the on-sale bar, finding that a patent owner's contract with a supplier to produce the later-patented invention invalidated the patent. The patent owner waited more than one year after contracting with its supplier to mass-produce the invention before filing its patent application.

5. OBVIOUSNESS

<u>McGinley v. Franklin Sports, Inc.</u>, 262 F.3d 1339 (Fed. Cir. 2001). A baseball with eggshaped "finger placement indicia" (i.e., finger marks) showing a pitcher how to hold the ball was not obvious over an earlier design that had similar markings. Although obviousness is a legal question, the jury's presumed factual finding that one of skill in the art would not have been motivated to combine two prior art references essentially ended the obviousness inquiry. Judge Michel dissented, stating that a jury verdict on obviousness would be "essentially immune" from review on appeal. Judge Michel also pointed to the "unfortunate practice" of allowing juries to render a general verdict on a legal issue without requiring express findings on each underlying factual issue.

6. DOUBLE PATENTING

<u>Eli Lilly & Co. v. Barr Labs., Inc.</u>, 251 F.3d 955 (Fed. Cir. 2001). A patent covering Lilly's Prozac drug was invalid for "obviousness-type" double patenting over another Lilly patent that was filed years later. The court reached the same result as its earlier decision, reported at 222 F.3d 973 (Fed. Cir. 2000), which was vacated by the <u>en banc</u> court. This time, the panel invalidated the patent (covering the administration of Prozac to prevent sertonin uptake in animals) over a later-filed but earlier-granted Lilly patent. The earlier-granted patent claimed the administration of Prozac to treat anxiety in humans. The Court stated that "a later genus claim limitation is anticipated by, and therefore not patentably distinct from, an earlier species claim."

7. CORRECTION OF PATENTS

<u>Fina Tech., Inc. v. Ewen</u>, 265 F.3d 1325 (Fed. Cir. 2001). A court does not have the authority to order the PTO to change the order in which the inventors' names appear on a patent. Neither section 256 of the statute (correction of named inventors) nor section 255 (correction of patents) gives a court the authority to change the order of correctly named inventors. Moreover, the order in which the names appear on a patent is of no legal consequence.

<u>Superior Fireplace Co. v. Majestic Prods. Co.</u>, F.3d ____, 2001 WL 1338793 (Fed. Cir. Nov. 1, 2001). The PTO does not have the authority to issue a certificate of correction to change a claim from "rear walls" to "rear wall." Section 255 of the patent statute only authorizes correction of clerical or typographical errors if such a mistake is evident from the record. Here, the broadening correction of the claim was invalid, and the patent claims were interpreted to be limited to their original uncorrected state. The Federal Circuit also stated that one challenging the validity of a certificate of correction must do so under a "clear and convincing" evidentiary standard.

B. INTERPRETATION OF PATENTS

1. CLAIM CONSTRUCTION

<u>Bell Atl. Network Services, Inc. v. Covad Communications Group, Inc.</u>, 262 F.3d 1258 (Fed. Cir. 2001). An inventor defined a claim term "by implication" because he repeatedly used the term to refer a specific embodiment. Although the ordinary definition of the claimed "mode" might be broader than the three different modes described in the specification, the term was defined "by implication" because the patentee used the term "throughout the entire specification, in a manner consistent with only a single meaning." The court provided little guidance for determining how a term would be defined by implication, other than pointing to "the term's consistent use throughout the [patent] specification."

<u>Budde v. Harley-Davidson, Inc.</u>, 250 F.3d 1369 (Fed. Cir. 2001). A defendant who argues that there is no disclosed structure corresponding to a means-plus-function limitation in a claim must prove such a position by clear and convincing evidence. To hold otherwise would effectively permit an infringer to invalidate the claim under a lower burden of proof.

<u>Amazon.com v. Barnesandnoble.com, Inc.</u>, 239 F.3d 1343 (Fed. Cir. 2001). In this first "business method" patent case to reach the Federal Circuit, the court vacated a preliminary injunction entered against Barnesandnoble.com, because it raised a substantial question regarding the validity of the claims. In concluding that Amazon's "one-click" patent claims appeared to be obvious when compared to various forms of prior art, the Federal Circuit rejected Amazon's argument that the claims should be interpreted to require a "single click" to purchase an item only after a user made a decision to purchase the item. The court noted that it was "not prepared to assign a meaning to a patent claim that depends on the state of mind of the accused infringer."

2. DESIGN PATENTS

<u>Door-Master Corp. v. Yorktowne, Inc.</u>, 256 F.3d 1308 (Fed. Cir. 2001). A design patent for a cabinet door was limited to the features shown not only on the front of the door but also on the back of the door, which could be seen when the cabinet door was opened. The court rejected the patent owner's argument that the patent should be interpreted so that the claims did not include the back of the door, noting that the inventor could have shown the features on the back of the door using broken lines.

3. DOCTRINE OF EQUIVALENTS (SCOPE OF CLAIMS)

<u>Johnson & Johnston Assoc. Inc. v. R.E. Service Co.</u>, 238 F.3d 1347 (Fed. Cir. 2001). The Federal Circuit <u>sua sponte</u> took this case <u>en banc</u> to determine whether a patent owner can rely on the doctrine of equivalents for subject matter that was disclosed but not claimed in the patent. It will hopefully resolve an apparent conflict between two earlier cases on this point. Oral argument was heard on October 3, 2001.

4. PROSECUTION HISTORY ESTOPPEL

<u>Mycogen Plant Science, Inc. v. Monsanto Co.</u>, 252 F.3d 1306 (Fed. Cir. 2001). Canceling a dependent claim and moving the limitations of the dependent claim into an independent claim creates estoppel that bars any equivalence as to the limitation that was moved into the independent claim. The Federal Circuit applied the <u>Festo</u> "complete bar" rule and ruled that no infringement under the doctrine of equivalents was possible. (Note: the Supreme Court has scheduled oral argument in the <u>Festo</u> appeal for January 8th, 2002, at 10:00am).

<u>Pioneer Magnetics, Inc. v. Micro Linear Corp.</u>, 238 F.3d 1341 (Fed. Cir. 2001). A patent attorney's statement that he narrowed a claim limitation through "sheer inadvertence" was insufficient to avoid application of the "complete bar" rule under <u>Festo</u>. Because there was no explanation in the record regarding why a particular claim limitation was added, the patent owner was not entitled to any range of equivalents as to the amended limitation.

<u>Turbocare Div. of Demag Delaval Rubomachinery Corp. v. General Elec. Co.</u>, 264 F.3d 1111 (Fed. Cir. 2001). A claim amendment is not "narrowing" (and thus no prosecution history estoppel applies under <u>Festo</u>) if the inventor merely "redefined" a term in a claim that was previously apparent from the specification. The original claim required a "small diameter position corresponding to . . . small clearance." In the face of a rejection, the inventor canceled the claim and replaced it with a new claim that recited "contact" between the surfaces. The Federal Circuit looked to the specification and concluded that "small diameter position" meant the same thing as "contact," and thus no estoppel applied.

C. ENFORCEMENT OF PATENTS

1. OWNERSHIP OF PATENTS

<u>Chou v. University of Chicago</u>, 254 F.3d 1347 (Fed. Cir. 2001). A person who claims to be an inventor on a patent has standing to sue for correction of the patent, even though the person is obligated to assign any patent rights to another. In this case, Chou was permitted to sue under 35 U.S.C. § 256 to be named as an inventor on a patent, despite having signed an employment agreement with the University of Chicago that obligated her to assign her patent rights to the University. The court noted that inventorship is a separate legal determination from ownership, and rejected the district court's ruling that Chou had no standing since she had no ownership rights.

International Nutrition Co. v. Horphag Research Ltd., 257 F.3d 1324 (Fed. Cir. 2001). A district court was permitted to defer, under principles of comity, to a French court's determination regarding ownership of a U.S. patent under a French contract.

<u>Rhone-Poulenc Agro, S.A. v. DeKalb Genetics Corp.</u>, F.3d. , 2001 WL 1456869 (Fed. Cir. Nov. 19, 2001). The bona fide purchaser for value rule, as applied to a licensee, is a question of federal common law, rather than state law. In this case, Monsanto was immune to patent infringement because it was a bona fide purchaser for value of a sublicense under the patent, even

though the original license was rescinded by the district court on account of fraud.

2. INEQUITABLE CONDUCT

<u>Brasseler, U.S.A. v. Stryker Sales Corp.</u>, 267 F.3d 1370 (Fed. Cir. 2001). A patent attorney has a duty to investigate a potential on-sale bar once he or she is aware of the potentially barring event; the attorney cannot willfully ignore the event and fail to disclose it to the patent office. In this case, a patent attorney was told that a potential sale of the invention might have taken place more than one year before the patent application was filed. Rather than investigate, the patent attorney followed his supervising attorney's instructions to file the patent application on a rush basis. The sale was never disclosed to the patent office. In upholding an inequitable conduct finding that rendered the patent unenforceable, the Federal Circuit stated that the attorney was not entitled to rely on a mistaken understanding that the sale was not invalidating merely because it occurred between two corporations for which the co-inventors were employed.

<u>Aptix Corp. v. Quickturn Design Sys., Inc.</u>, F.3d ____, 2001 WL 1380851 (Fed. Cir. Nov. 5, 2001). The Federal Circuit upheld an "unclean hands" defense in which the patent owner's lawsuit was dismissed for falsifying notebooks during litigation. However, the Federal Circuit held that it was improper for the district court to render the patent unenforceable, since the inequitable conduct did not occur during prosecution of the patent.

3. INFRINGEMENT

<u>Hilgreave Corp. v. Symantec Corp.</u>, 265 F.3d 1336 (Fed. Cir. 2001). An accused device can infringe if it is "reasonably capable" of infringing the claims, even though the device is capable of non-infringing modes. In this case, a computer virus checker could be found to infringe the patent, even though the defendant's expert demonstrated unusual conditions under which the accused virus checker did not appear to infringe.

<u>Waymark Corp. v. Porta Sys. Corp.</u>, 245 F.3d 1364 (Fed. Cir. 2001). One who exports components of a patented invention intending that they be combined outside of the United States can be held liable as a direct infringer under 35 U.S.C. § 271(f)(2), even if the components are never actually combined outside the country. The Federal Circuit found that, in contrast to contributory infringement, no direct infringement was necessary to find liability.

<u>Mycogen Plant Science, Inc. v. Monsanto Co.</u>, 252 F.3d 1306 (Fed. Cir. 2001). One cannot infringe a patent under 35 U.S.C. § 271(g) (product made by a patented process) unless the patent was issued before the product was made by the patented process. In this case, Monsanto was held not to infringe a process patent for products that it made before the patent issued, even though it sold the products after the patent issued.

4. PERSONAL JURISDICTION

Inamed Corp. v. Kuzmak, 249 F.3d 1356 (Fed. Cir. 2001). A New Jersey patent owner who sent a notice of infringement to the New York address of a California company, coupled with the patent owner's negotiation of agreements with the California company over the telephone and by mail, was sufficient "minimum contacts" with California to sue him there. The Federal Circuit stated that although merely sending an infringement letter would not create sufficient minimum contacts with California, negotiating agreements with the California company by phone and mail were acts "purposefully directed" at California.

5. REPAIR VS. RECONSTRUCTION

Jazz Photo Corp. v. International Trade Comm'n, 264 F.3d 1094 (Fed. Cir. 2001). Installing new film, batteries, and winding wheels in disposable cameras constitutes permissible repair, rather than infringing reconstruction. When Fuju sold its cameras in the United States, it could not prevent others from refurbishing the cameras overseas and then re-importing them into the United States. The court rejected Fuji's argument that it had intended that the cameras be limited to a single use, and rejected Fuji's argument that the cameras contained a "license" that prohibited their further use.

<u>Surfco Hawaii v. Fin Control Sys. Pty.</u>, 264 F.3d 1062 (Fed. Cir. 2001). The replacement of fins on a surfboard with modified fins, even if not replacing a part that was broken or worn, constitutes permissible "repair" rather than infringing reconstruction. The court found that the sale of replacement fins did not induce infringement of the patent.

6. PATENT MARKING (DAMAGES)

<u>Gart v. Logitech, Inc.</u>, 254 F.3d 1334 (Fed. Cir. 2001). A patent owner's letter stating that Logitech "may wish to have its patent counsel examine the patent to determine whether a nonexclusive license under the patent is needed" was sufficient notice to start the damages period under the patent marking statute. It did not matter that the letter failed to specifically accuse the defendant of patent infringement.

Lans v. Digital Equip. Corp., 252 F.3d 1320 (Fed. Cir. 2001). A letter received from someone closely associated with the patent owner, rather than the actual patent owner, does not provide sufficient notice to satisfy the patent marking statute. In this case, the inventor had assigned his patent to a company, but years later the inventor (rather than the company) sent infringement notices to various accused infringers. The Federal Circuit reasoned that "without knowledge of the patentee's identity, an alleged infringer may lose the benefit of this primary purpose of the notice requirement."

7. COLLATERAL ESTOPPEL (CLAIM PRECLUSION)

<u>Hallco Mfg. v. Foster</u>, 256 F.3d 1290 (Fed. Cir. 2001). An accused infringer is precluded from challenging the validity of a patent if he entered into a consent judgment in an earlier infringement case concerning a device that was "insubstantially different" from the newly accused device.

8. RIGHT TO JURY TRIAL

<u>Tegal Corp. v. Tokyo Electron Am., Inc.</u> 257 F.3d 1331 (Fed. Cir. 2001). A defendant has no right to a jury trial where a plaintiff seeks only an injunction and the defendant fails to counterclaim for invalidity. The Federal Circuit reviewed eighteenth-century English jurisprudence to conclude that the nature of the action was equitable, rather than legal.

9. LACHES DURING PROSECUTION

Symbol Techs. Inc. v. The Lemelson Medical, Ed. & Res. Found., Ltd., 2000 WL 1300430 (Misc. Docket No. 626 Fed. Cir. August 30, 2000)(nonprecedential). The Federal Circuit heard oral argument in an interlocutory appeal to decide the viability of the so-called defense of "prosecution laches." Manufacturers of bar code readers argued in the district court that Lemelson's patents are unenforceable because Lemelson delayed issuance of patents for decades, thus causing an entire industry to reasonably rely on the availability of the technology. Various lawsuits brought by and against Lemelson are pending in Arizona and Nevada. A decision is expected soon.

10. PROCEDURE

<u>Advanced Cardiovascular Sys. v. Medtronic, Inc.</u>, 265 F.3d 1294 (Fed. Cir. 2001). The Federal Circuit will apply its own law, rather than deferring to regional circuit law, to determine whether a district court abused its discretion by refusing to permit a defendant to amend its pleadings to add an additional invalidity defense. In this case, the district court properly refused to permit Medtronic to add an invalidity counterclaim based on 35 U.S.C. ¶ 112, second paragraph, where Medtronic waited until after the <u>Markman</u> hearing to do so.

<u>Interactive Gift Express, Inc. v. Compuserve Inc.</u>, 256 F.3d 1323 (Fed. Cir. 2001). A party is permitted to make new arguments on appeal in support of its claim construction position, as long as those arguments do not change the scope of the claim construction that it argued in the lower court. In this case, Interactive Gift Express was permitted on appeal to make new arguments concerning portions of the specification that supported its claim construction position, even though it had not made those arguments in the district court.

<u>Mylan Pharm., Inc. v. Thompson</u>, 268 F.3d 1323 (Fed. Cir. 2001). A generic drug company cannot sue under the Declaratory Judgment Act or the patent laws to de-list a patent from the FDA's "orange book." Bristol-Myers Squibb had listed a patent that purportedly covered one of its drugs. Mylan, which wanted to produce a generic version of the drug, sued to force Bristol-Myers to

remove the patent from the list, because Mylan contended that the patent did not actually cover the drug. The Federal Circuit held that Congress did not intend to create a private cause of action that would permit Mylan to sue to change "orange book" drug listings.

<u>Special Devices, Inc. v. OEA, Inc.</u>, F.3d , 2001 WL 1327109 (Oct. 30, 2001). A district court's order finding a case exceptional and awarding attorney fees could not be appealed until the amount of the fees had been determined. The defendant appealed the district court's order, which had deferred calculation of the amount of the fees. The Federal Circuit held that the order was not a final judgment that could be appealed.

III. TRENDS IN PATENT LAW

1. The Federal Circuit continues to expand its definition of what constitutes a "patent issue," thus allowing it to apply its own law rather than that of the regional circuits. See, for example, <u>Group One v. Hallmark</u>, wherein the Federal Circuit applied its own common law for determining whether an offer constitutes an invalidating on-sale bar; <u>Rhone-Poulenc v. DeKalb</u>, wherein the Federal Circuit applied its own common law for interpreting the bona fide purchaser for value rule; and <u>Advanced Cardiovascular v. Medtronic</u>, where the court stated that amendments to patent pleadings would be reviewed under Federal Circuit law rather than regional circuit law.

2. After <u>Festo</u>, the Federal Circuit has with increasing frequency found that patent owners are estopped from asserting infringement under the doctrine of equivalents because of <u>Festo's</u> "complete bar" rule. <u>See</u>, e.g., <u>Monsanto v. Mycogen</u> and <u>Pioneer Magnetics v. Micro Linear</u>.

3. The Federal Circuit has continued its trend of closely scrutinizing patent applications to determine whether they comply with the written description requirement. <u>See</u>, e.g., <u>Turbocare v.</u> <u>General Electric</u> and <u>Superior Fireplace v. The Majestic Products Co.</u>

4. There is a continuing trend toward harmonizing U.S. patent laws and regulations with those of foreign countries. Examples include publication of pending applications; proposed opposition and re-examination procedures; and stricter scrutiny of so-called "business method" inventions.

5. In general, the Federal Circuit appears to be moving toward more bright-line rules when interpreting various parts of the patent statute. Examples include application of the on-sale bar; application of prosecution history estoppel; and reliance on the public notice function of patents.

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