



PATENT HAPPENINGS

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on judicial, legislative, and administrative developments in patent law.

HIGHLIGHTS

1. *Failure to obtain and produce opinion of counsel may be used as circumstantial evidence to support inducing infringement claim.....* 1
2. *Inference of intent still alive as means to prove inequitable conduct.....* 2
3. *PTO reexamination may be based on the same invalidity issue unsuccessfully raised in a district court litigation.....* 3
4. *Accused infringer may not raise improper revival by the PTO as an invalidity defense* 5
5. *"Point of novelty" test abolished* 6
6. *Inventor's testimony on his subjective intent in claiming the invention irrelevant to claim-construction analysis even if testimony is adverse to patentee* 7
7. *Displaying product at a trade show is not "use" infringement if product is not "put into service"* 8
8. *Single Species Does Not Provide Adequate Support for Generic Plasmid Claims.....* 9
9. *Attempt to use extra-judicial help in forum to stop alleged infringement supported exercising personal jurisdiction over patentee* 10
10. *Corresponding structure limited to specific subcomponent that performs function* 10
11. *Patentee's exhaustion of patent rights does not provide an affirmative claim of relief* 11
12. *Federal Circuit urged to simplify the law on proving an earlier invention date* 11
13. *Patent prosecution highway updates* 12
14. *Thomson-Reuters releases Matthews's "Patent Jury Instruction Handbook".....* 12

JUDICIAL HAPPENINGS

Failure to Obtain Opinion of Counsel

The Federal Circuit's holding in *Seagate* that, in the context of willful infringement, "there is no affirmative obligation to obtain opinion of counsel[,...]"¹ may have led some to believe that the need to obtain opinions of counsel has drastically waned. Splashing a bucket of ice water on this notion, the Federal Circuit opinion in *Broadcom Corp. v. Qualcomm, Inc.*, No. 2008-1199, 2008 WL 4330323, *11-*14 (Fed. Cir. 2008), may cause practitioners to rethink the calculus for when an opinion of counsel is needed. For in *Broadcom*, the court held that the failure of an accused infringer to obtain a noninfringement opinion of counsel was circumstantial evidence that could be used by the patentee as a factor to prove the intent prong for an inducing infringement claim. *Id.* at *13.

More specifically, in *Broadcom*, the accused infringer had obtained invalidity opinions, but chose to maintain privilege and did not produce those opinions. *Id.* at *11. After being served with the infringement complaint, the accused infringer did not obtain a noninfringement opinion and continued with its pre-suit accused activities. *Id.* at *14. At trial the district court instructed the jury that to find inducing infringement the jury had to find that the accused infringer "is aware of the patent, knows and should have known that the encouraged acts constitute infringement of the patent, and has an intent to cause the encouraged acts." *Id.* at *12. The district court further instructed the jury that "[w]hen considering whether [the accused infringer] knew or should have known that the induced actions would constitute infringement, in the totality of the circumstances, you may consider all of the circumstances, including whether or not [the accused infringer] obtained the

¹ *In re Seagate Technology*, 497 F.3d 1360, 1371 (Fed. Cir. 2007) (*en banc*).

advice of a competent lawyer. . .” *Id.* The jury was also instructed, as part of the instructions on willful infringement that “[t]he absence of a lawyer’s opinion, by itself, is insufficient to support a finding of willfulness, and you may not assume that merely because a party did not obtain an opinion of counsel, the opinion would have been unfavorable. However, you may consider whether [the accused infringer] sought a legal opinion as one factor in assessing whether, under the totality of the circumstances, any infringement by [the accused infringer] was willful.” *Id.* Following these instructions, and hearing evidence that the accused infringer had not obtained any noninfringement opinions, the jury found inducing infringement.

In seeking a new trial on the inducing infringement issue, the accused infringer argued that it was improper for the jury to consider the absence of a noninfringement opinion as a factor proving inducement since *Seagate* held that an accused infringer is no longer obligated to obtain an opinion of counsel. Rejecting this argument, Judge Linn, writing for the court, explained that *Seagate* did not alter the state-of-mind requirement for inducing infringement set forth in the *en banc* portion of *DSU*. *Id.* at 13.² Thus, the critical criterion is whether the accused infringer knew or should have known that its actions would cause another to infringe. The court held that “[b]ecause opinion-of-counsel evidence, along with other factors, may reflect whether the accused infringer ‘knew or should have known’ that its actions would cause another to directly infringe, we hold that such evidence remains relevant to the second prong of the intent analysis.” *Id.* Noting that in *DSU* the court held that the presence of an opinion of counsel may provide evidence that negates a finding of intent,³ the *Broadcom* court concluded that “[i]t would be manifestly unfair to allow opinion-of-counsel evidence to serve an exculpatory function, as was the case in *DSU* itself, and yet not permit patentees to identify failures to procure such advice as circumstantial evidence of intent to infringe.” *Id.* Concluding “that the failure to procure such an opinion may be probative

of intent,” the panel ruled that there was “no legal error in the district court’s jury instructions as they relate to inducement.” It also stated that “the district court did not err in instructing the jury to consider ‘all of the circumstances,’ nor in instructing the jury to consider—as one factor—whether [the accused infringer] sought the advice of counsel as to non-infringement.” *Id.*

In what may bode ill for accused infringers opting to rely on privilege and not produce an opinion of counsel, the Federal Circuit appeared to tacitly approve the district court’s exclusion of any evidence that the accused infringer had obtained invalidity opinions while permitting the jury to be told that the accused infringer had not obtained a noninfringement opinion. *Id.* at 14 (“Although [the accused infringer] stresses that it *did* obtain opinions of counsel regarding invalidity of the patents in suit, it concedes that the district court properly excluded this fact from evidence in light of [the accused infringer]’s decision not to waive privilege with respect to these opinions.”).

Broadcom does not answer the question of what will happen if an accused infringer obtains both noninfringement and invalidity opinions, and, choosing to preserve privilege, refuses to produce either opinion.

Inference of Intent to Deceive

The Federal Circuit’s recent inequitable conduct cases, such as *Star Scientific*, appeared to signal that the court was attempting to pull back from the rampant use of inferences of intent to deceive whenever an applicant withholds highly material prior art.⁴ Indeed, in *Star Scientific*, the court instructed that in drawing an inference of an intent to deceive, “the inference must not only be based on sufficient evidence and be reasonable in light of that evidence, but it must also be the single most reasonable inference able to be drawn from the evidence to meet the clear and convincing standard.” Proving that the use of inferences of intent are not yet dead, the Federal Circuit in *Praxair, Inc. v. Atmi, Inc.*, No. 2007-1483, 2008 WL 4378391, *4-*9 (Fed. Cir. Sept. 29, 2008), affirmed a finding of inequitable conduct where the only evidence of intent to deceive was an inference based on the high materiality of the withheld prior art and a lack of an adequate explanation from the patent attorney for why he withheld the prior art.

² *DSU Medical Corp. v. JMS Co., Ltd.*, 471 F.3d 1293, 1306 (Fed. Cir. 2006) (*en banc*). See generally, Robert A. Matthews, Jr., *Annotated Patent Digest* § 10:45 Know or Should Know Acts Will Cause Infringement [*hereinafter APD*].

³ *DSU Med.*, 471 F.3d at 1307; see generally, APD § 10:49 Applicability of Opinion of Counsel to Knowledge Requirement and § 10:51 —Cases Finding Obtaining an Opinion Defeated Inducement Claims.

⁴ *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1366 (Fed. Cir. 2008); see also *Patent Happenings*, “Tightening the Reins on Inequitable Conduct,” Aug. 2008.

In *Praxair*, the applicant withheld information regarding a prior art device (the RFO art) that did not meet all of the claim limitations. During prosecution, however, the patent attorney made four statements to the PTO regarding the state of the prior art to support patentability. As a result of those statements, the withheld prior art device became highly material since the art may have contradicted the generalized statements about the state of the prior art. *Id.* at *6. Further, the panel concluded that since the attorney made the four statements to the PTO he was “aware of the obvious materiality” of the withheld art in light of those statements. *Id.* at *8.

The court also affirmed the finding that the patent attorney’s testimony failed to show a good faith explanation for withholding the prior art device.⁵ The attorney had testified, in conclusory fashion, that “he never ‘intentionally misled the United States Patent Office about anything’ at any time during his career, and that with respect to the ’609 and ’115 patent prosecutions he ‘did not knowingly withhold any information from the Patent and Trademark Office.’” The court ruled that “[s]uch statements are entitled to no weight.” *Id.* at *8. The attorney also gave vague testimony that the prior art before the Examiner made the withheld prior art device cumulative. But the attorney failed to point to any specific art before the examiner that supported his contention or show that he held the belief of cumulativeness at the time he withheld the prior art device. Thus, his testimony was insufficient to establish cumulativeness as a good faith explanation for withholding the prior art. *Id.* The court instructed that “[h]indsight construction of reasons why a reference might have been withheld cannot suffice as a credible explanation of why, at the time, the reference was not submitted to the PTO.” *Id.*

Considering the issue of intent to deceive, the court ruled that “[b]ased on its predicate findings that the RFO art was highly material, that the applicants knew of the RFO art and at least should have known of its materiality, and that the applicants had failed to present any good faith explanation for withholding the highly material RFO art from the PTO, the district court properly inferred that the applicants intended to deceive the PTO by failing to disclose the RFO art.”⁶ *Id.*

⁵ See generally, APD § 27:63.50 Pattee’s Burden to Provide Good Faith Explanation.

⁶ See generally, APD § 27:65 Applicant’s Knowledge of High Materiality.

Interestingly, Judge Dyk, who wrote the opinion, and who was a member of the panel in *Star Scientific*, did not cite *Star Scientific*, nor address *Star Scientific*’s requirement that the inference of intent to deceive be “the single most reasonable inference able to be drawn from the evidence.”

Judge Lourie dissented. He disagreed with the majority’s finding that the patent attorney knew, or should have known of the materiality, of the withheld prior art device. Judge Lourie stated that “[a]n inference of intent to deceive requires more than knowledge of the existence of the nondisclosed art; it also requires a finding that the applicant knew, or should have known, of the materiality of that art.” *Id.* at *20. He viewed the record as having no evidence to show that the attorney knew that the withheld prior art was material. *Id.*

Second-Bites at the Invalidity Apple

To prevent harassing patentees and unfairly burdening the PTO with repetitive reexamination proceedings, the law limits reexaminations to situations where the offered prior art presents a “substantial new question of patentability affecting any claim of the patent.”⁷ The recent Federal Circuit opinion of *In re Swanson*, No. 2007-1534, 2008 WL4068691 (Fed. Cir. Sept. 4, 2008), appears to give an accused infringer who fails to invalidate a patent in a district court action a second opportunity to challenge validity in a subsequent PTO reexamination using the same prior art and same invalidity theories that did not prevail in the district court action. The decision also clarifies that the PTO’s consideration of a reference in an original examination will not *per se* bar using that reference to reject claims in a reexamination.

In its 1997 decision in *Portola Packaging*, the Federal Circuit gave teeth to the “new question of patentability” standard by holding that a rejection in a reexamination could not be based solely on prior art considered in the original examination.⁸ The court rationalized that because the law presumes that during the original prosecution the examiner considered all possible uses of the submitted prior art, basing a rejection in a reexamination solely on art considered in the original prosecution was impermissibly considering

⁷ 35 U.S.C. §§ 303(a), 304, 312(a), 313; see generally, APD § 25:99 Strictly Limited to New Questions of Patentability.

⁸ *In re Portola Packaging, Inc.*, 110 F.3d 786, 790 (Fed. Cir. 1997), superseded by statute, 35 U.S.C. §§ 303(a) and 312(a) (Supp. 2002).

an issue addressed in the original prosecution, and therefore it did not raise a “substantial new question of patentability.”⁹ Consequently, *Portola Packaging* established a bright-line rule that a reexamination could not be based solely on prior art previously considered by the PTO. Congress overruled *Portola Packaging*, with its 2002 amendments to § 303(a) and § 312(a), by adding to these statutory provisions the caveat that “[t]he existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.”¹⁰

Having its first opportunity to address the impact of the 2002 amendments in *Swanson*, the Federal Circuit held that under the amended statute the PTO may find a substantial new question of patentability based on prior art it had previously considered, as long as it uses that art in a new context and is not considering the same issue the PTO considered during the original prosecution. The Federal Circuit also held that a district court’s finding that an accused infringer failed to prove that a prior art reference invalidated the claims in litigation does not bar the PTO from conducting a reexamination requested by the accused infringer on that same prior art reference *even if the same specific invalidity issue raised in the district court is being raised in the reexamination.*

Regarding the PTO’s use in a reexamination of prior art it considered in the original prosecution, the Federal Circuit rejected the patentee’s argument that the court should adopt a bright-line rule that a substantial new question of patentability does not exist if the asserted prior art reference was previously considered by the PTO for the same or broader claims. The court found this argument to be “plainly inconsistent with the clear text of the amendment.” *Id.* at *8. The court explained:

The 2002 amendment removes the focus of the new question inquiry from whether the reference was previously considered, and returns it to whether the particular question of patentability presented by the reference in reexamination was previously evaluated by the PTO. As was true before the

amendment, an “argument already decided by the Office, whether during the original examination or an earlier reexamination” cannot raise a new question of patentability. . . . Section 303(a) as amended . . . requires a more context-specific approach that is based on an analysis of what the PTO actually did.

Id. at *9.

The court further instructed that “[d]etermining the scope of an examiner’s previous consideration of a reference will generally require an analysis of the record of the prior proceedings to determine if and how the examiner used the reference in making his initial decisions.” *Id.* Applying this standard, the court held that the limited use of a prior art reference as a secondary reference to reject some dependent claims in the original prosecution did not preclude the reference from showing a substantial new question of patentability as to an analytical method disclosed in the reference and not considered by the examiner in the original prosecution. *Id.* at *10. Because the patentee had not challenged on appeal the substantive merits of the anticipation rejection based on the previously considered reference, the Federal Circuit affirmed the rejection. *Id.* at *11.

Regarding the use of the prior art reference in the reexamination in view of the requester’s failure to prove invalidity in a district court litigation with that same reference, the Federal Circuit concluded that “the statutory language, legislative history, and different purposes underlying reexamination and federal court proceedings suggest that the determination of a substantial new question is unaffected by these court decisions.” *Id.* at *5. Initially, the court noted that “a prior holding of validity is not necessarily inconsistent with a subsequent holding of invalidity,’ and is not binding on subsequent litigation or PTO reexaminations.” *Id.* at *6. Noting the different purposes and proof burdens applicable to invalidity challenges in courts and patentability examination in the PTO, the Federal Circuit concluded that “considering an issue at the district court is not equivalent to the PTO having had the opportunity to consider it.” *Id.* at *7. Thus, the Federal Circuit agreed with the PTO’s position that “a final court decision of a claim’s validity will not preclude a finding of a substantial new question of validity based on the same art[.]” *Id.* It further concluded that:

Congress did not intend a prior court judgment upholding the validity of a claim to prevent the

⁹ *Id.* at 790. See *In re Recreational Technologies, Corp.*, 83 F.3d 1394, 1398-99 (Fed. Cir. 1996) (holding that “[a] second examination, on the *identical ground* that had been previously raised and overcome, is barred.”) (emphasis added).

¹⁰ The amended version of § 303(a) and § 312(a), only applies to reexaminations initiated on or after November 2, 2002. *In re Bass*, 314 F.3d 575, 576 n.* (Fed. Cir. 2002).

PTO from finding a substantial new question of validity regarding an issue that has never been considered by the PTO. To hold otherwise would allow a civil litigant's failure to overcome the statutory presumption of validity to thwart Congress' purpose of allowing for a reexamination procedure to correct examiner errors, without which the presumption of validity never would have arisen.

Id.

Given the Federal Circuit's holding that in a reexamination the PTO may consider the identical invalidity issue based on a printed-publication or prior art patent that a district court previously ruled on, *Swanson* may give an adjudicated infringer a second opportunity to challenge the validity of an infringed claim after the conclusion of a district court action. As shown below, this potential new avenue of review will likely raise many questions for future litigations.

Swanson arose in the context of an *ex parte* reexamination. The Federal Circuit did not expressly address the applicability of claim or issue preclusion.¹¹ It seems possible that given the differences between the two proceedings, the Federal Circuit may have concluded that the requirement of identicality of issue was not present to apply issue preclusion.¹² Claim preclusion may not have applied since the PTO was not a party to the district court litigation or in privity with the requester.¹³ Additionally, the public policy of removing invalid patents may have minimized the justification for applying any preclusion.¹⁴ To what extent, if any, issue or claim preclusion may apply for an *inter partes* reexamination where an accused infringer presents in the reexamination the same invalidity issue it failed to prove in a prior litigation

¹¹ Cf. *In re Freeman*, 30 F.3d 1459 (Fed. Cir. 1994) (in a reexamination, applying issue preclusion against a patentee on a claim construction issue); see generally APD § 38:27 Ex Parte Prosecution in the PTO.

¹² See generally, APD § 38:41 Requirement of Identicality.

¹³ See *In re Trans Texas Holdings Corp.*, 498 F.3d 1290, 1297-98 (Fed. Cir. 2007) (PTO not bound under issue preclusion to claim construction rendered by district court since PTO did not participate in the district court proceeding); see generally, APD § 38:9 Same Parties or their Privies.

¹⁴ *In re Oelrich*, 666 F.2d 578, 580 n.2 (CCPA 1981) ("[R]es judicata does not have its usual impact when considering ex parte patent appeals; the public interest in granting valid patents outweighs the public interest underlying collateral estoppel and res judicata, particularly where the issue presented is not substantially identical to that previously decided.").

presents an intriguing question sure to be addressed in future cases.

Future cases will also need to consider what should happen to a judgment entered against an accused infringer who fails to prove invalidity in litigation, but subsequently succeeds in a later reexamination in getting the PTO to invalidate the claims found infringed. Should Fed.R.Civ.P 60(b)(5) provide total relief on the grounds that the prior infringement judgment is void?

Additionally, the Federal Circuit will undoubtedly have to grapple with the question of whether a post-verdict instituted reexamination proceeding provides grounds to stay an appeal during the pendency of a reexamination? If so, should that provide a basis for modifying or suspending any injunctive relief?

Swanson may also give incentive to successful patentees to exercise some degree of willingness to enter into post-verdict settlements so that an infringer can be contractually prohibited from filing any subsequent reexamination requests or otherwise challenge, or assist in challenging, the validity of the patent.

While resolving one point of PTO practice, *Swanson* may have opened a whole new can of worms for patent litigation.

"Improper Revival" is not a Defense

Over the last few years some accused infringers have successfully invalidated patents by showing that the PTO erred in reviving an abandoned application that led to the asserted patents. The "error" arose from the PTO's permitting the applicant to show that the abandonment was "unintentional" even though the applicable statutes required the applicant show that the abandonment was "unavoidable."¹⁵ Expressly sidestepping the issue of whether the PTO did in fact err in the standard it applied to revive an abandoned patent application, the Federal Circuit in *Aristocrat Tech. Australia PTY Ltd. v. Int'l Game Technology*, No. 2008-1016, 2008 WL 4290841 (Fed. Cir. Sept. 22,

¹⁵ See e.g., *New York University v. Autodesk, Inc.*, 495 F. Supp. 2d 369, 374 (S.D.N.Y. July 13, 2007); *Aristocrat Technologies Australia Pty Ltd. v. Int'l Game Technology*, 491 F. Supp. 2d 916, 929-30 (N.D. Cal. June 13, 2007); *Lawman Armor Corp. v. Simon*, 74 USPQ2d 1633, 1637-38 (E.D. Mich. 2005), *appeal dismissed*, 172 Fed. Appx. 319 (Fed. Cir. Feb. 14, 2006); *Field Hybrid LLC v. Toyota Motor Corp.*, 2005 WL 189710, *6 - *8 (D. Minn. Jan. 27, 2005). See generally, APD § 16:4 Reviving Abandoned Applications and Challenges Thereto.

2008), held that, absent inequitable conduct, the PTO's granting of a petition to revive an abandoned patent application, even if legally erroneous, is "not a cognizable defense," and therefore may not be raised by an accused infringer as a defense to invalidate the patent. *Id.* at *6.

Focusing on the defenses identified in 35 U.S.C. § 282, the court held that an improper revival did not fall under any of the four categories of defenses identified in the statute. It held that improper revival is not an invalidity ground since it does not meet the requirement of being a "condition for patentability" of § 282(2). According to the court, § 282(2)'s "conditions of patentability" are limited to § 101, § 102 and § 103. *Id.* at *3-*4.¹⁶ The court also held that improper revival did not fall under the catch-all provision of § 282(4), which makes "[a]ny other fact or act made a defense by this title" a defense to patent infringement. Under the Federal Circuit's view, the catch-all provision only applies where another provision of the Patent Act states that the provision is providing a defense to a claim of infringement or its violation will render the patent invalid. *Id.* at *4-*5. But since the statutory sections noting that the failure to comply with a time deadline could be forgiven if the delay was "unavoidable" were silent on whether they provided a defense, the Federal Circuit ruled they did not fall within § 282(4). *Id.* The court also rationalized its position by noting that in an infringement litigation district courts should be not side-track by "prosecution irregularities" that do not affect the substantive merits of whether the patent should have issued over the prior art.

There is good reason not to permit procedural irregularities during prosecution, such as the one at issue here, to provide a basis for invalidity. Once a patent has issued, the procedural minutiae of prosecution have little relevance to the metes and bounds of the patentee's right to exclude. If any prosecution irregularity or procedural lapse, however minor, became grist for a later assertion of invalidity, accused infringers would inundate the courts with arguments relating to every minor transgression they could comb from the file

¹⁶ Section 282(3) makes the failure to comply with a requirement of § 112 or § 251 its own defense to an infringement action, and therefore, according to the Federal Circuit, § 112 does not fall under the "condition of patentability" of § 282(2). *Id.* at *4 ("the requirements in section 112 are not conditions for patentability; they are merely requirements for obtaining a valid patent").

wrapper. This deluge would only detract focus from the important legal issues to be resolved—primarily, infringement and invalidity.

Id. at *5

The Federal Circuit also rejected the argument that the PTO's alleged improper revival could be challenged under the Administrative Procedure Act, but it provided no details as to why it held that that the "APA provides no relief" to the accused infringer. *Id.* at *6. Consequently, in view of the court's holding, it appears that the PTO's granting of a petition to revive an abandoned patent application is effectively unreviewable.

The "improper revival" issue also has importance to patents that lapsed for failure to timely pay a maintenance fee.¹⁷ The reasoning of *Aristocrat* may make those revivals immune from judicial review.

Point of Novelty Test Abolished

Addressing the concern that the "point of novelty test" was difficult to apply where an ornamental design had many points of novelty, or may have been a new combination of design items in the prior art, the Federal Circuit abolished the "point of novelty" test for design patent infringement in a unanimous opinion in *Egyptian Goddess, Inc. v. Swisa, Inc.*, No. 2006-1562, 2008 WL 4290856 (Fed. Cir. Sept. 22, 2008) (*en banc*). The court concluded that "the point of novelty test, as a second and free-standing requirement for proof of design patent infringement, is inconsistent with the ordinary observer test laid down in *Gorham*, is not mandated by *Whitman Saddle* or precedent from other courts, and is not needed to protect against unduly broad assertions of design patent rights." *Id.* at *6.

While abolishing the point of novelty test as a separate test of design patent infringement, the Federal Circuit held that the prior art remains an important component of a design patent infringement analysis. Thus, in applying the "ordinary observer" test of *Gorham*, the analysis must be based on the hypothetical ordinary observer looking at the ornamental design in the context of all the prior art. *Id.* at *12. According to the court, "a test that asks how an ordinary observer with knowledge of the prior art designs would view the differences between the claimed and accused designs is likely to produce

¹⁷ See generally, APD § 24:26 Erroneous Revival as an Affirmative Defense.

results more in line with the purposes of design patent protection.” *Id.* at *11.

The court also held that under its new framework, the patentee continues to have the burden of persuasion in proving infringement under a preponderance of the evidence standard. The accused infringer has a burden of *production* to produce prior art it contends should be considered as part of the analysis of whether an ordinary observer would find the accused design deceptively similar to the claimed design. *Id.* at *12; *see also id.* at *17 (“we hold that the accused design could not reasonably be viewed as so similar to the claimed design that a purchaser familiar with the prior art would be deceived by the similarity between the claimed and accused designs, ‘inducing him to purchase one supposing it to be the other.’”).

While it may seem that the new standard requiring a court to consider the prior art as part of the ordinary observer test could raise numerous factual issues precluding summary judgments, the Federal Circuit in *Egyptian Goddess* affirmed the district court’s summary judgment of noninfringement. The court concluded that the accused product, a four-sided rectangular frame with buffer pads on only three sides, did not infringe the claimed ornamental design of a four-sided rectangular frame with buffer pads on all four sides. The court noted that the patentee’s expert failed to present any nonconclusory testimony showing why the accused product with pads on only three of the four sides was more similar to the claimed design than to the prior art. The accused infringer’s expert gave testimony that the accused design was nothing more than a modification of one prior art design based on another prior art design. He also gave testimony that three-side and four-side padded blocks had been on the market for many years and purchasers considered the number padded sides important, and therefore would find a distinction between the claimed design with pads on all four sides with the accused product having pads on only three of the four sides. *Id.* at *15. In light of this evidence, the court determined that “[i]n light of the similarity of the prior art buffers to the accused buffer, we conclude that no reasonable fact-finder could find that EGI met its burden of showing, by a preponderance of the evidence, that an ordinary observer, taking into account the prior art, would believe the accused design to be the same as the patented design.” *Id.* at *16.

The Federal Circuit also held that a district court has full discretion on whether to provide a verbal

construction of the design patent claim. The court expressly instructed that a district court “is not obligated to issue a detailed verbal description of the design if it does not regard verbal elaboration as necessary or helpful.” *Id.* at *13. Indeed, the Federal Circuit also stated that “[g]iven the recognized difficulties entailed in trying to describe a design in words, the preferable course ordinarily will be for a district court not to attempt to ‘construe’ a design patent claim by providing a detailed verbal description of the claimed design.” *Id.*

Inventor Testimony on Claim Construction

Self serving, litigation inspired, testimony from an inventor as to the scope of a patent claim has long been regarded as having little weight in construing a claim, especially where the testimony appears at odds with the intrinsic evidence.¹⁸ In some circumstances, however, the courts appear willing to credit inventor testimony that is adverse to the inventor’s or patentee’s interest, presumably under the rationale that being adverse to the patentee, the testimony is reliable.¹⁹ Stating the view that inventors may not truly understand the nuances of claim construction, the Federal Circuit held in *Howmedica Osteonics Corp. v. Wright Medical Tech., Inc.*, No. 2007-1363, 2008 WL 4072052, *8 (Fed. Cir. Sept. 2, 2008), that inventor testimony regarding the inventor’s subjective intent in claiming his or her invention is “irrelevant” to the claim-construction analysis.

In *Howmedica*, the court was faced with construing claims directed to a knee prosthesis. The claim recited that the prosthesis had “*at least one* condylar element.” The claim then further recited that “*the* condylar element” have certain geometric characteristics. The accused product had two condylar elements, but only one of which met the geometric characteristics. The district court construed the claim to require that if a device had two condylar elements, both elements had to meet the geometric characteristics. This construction was consistent with the testimony from the inventor, who testified that he intended that the claim be broad enough to cover a unicondylar device and to cover a

¹⁸ See generally, APD § 7:2 Inventor Testimony Irrelevant if at Odds with Intrinsic Evidence; see also APD § 7:3 Inventor Testimony Admissible if Consistent with Intrinsic Evidence.

¹⁹ E.g., *Jonsson v. The Stanley Works*, 903 F.2d 812, 821 (Fed. Cir. 1990) (ruling that district court’s reliance on inventor’s deposition testimony that was contrary to patent holder’s litigation-induced interpretation was proper); see generally, APD § 7:4 Inventor Testimony Admissible if Adverse to Patentee’s Case.

bicondylar device where both condylar elements met the geometric characteristics. Indeed, the specification, in describing the bicondylar embodiment only described an embodiment with both condylar elements meeting the geometric characteristics. Nonetheless, over the dissent of Judge Prost, the Federal Circuit panel held that the district court erred in construing the claim to require that both condylar elements had to meet the geometric characteristics.

In making its ruling, the Federal Circuit addressed several points of claim construction. As to the issue of the use of inventor testimony, the court restated the basic rule that “[t]he testimony of an inventor ‘cannot be relied on to change the meaning of the claims.’” *Id.* at *7. The court then expressly rejected the argument that inventor testimony adverse to the inventor’s interest should have weight in a claim-construction analysis. It explained that “[w]hether an inventor’s testimony is consistent with a broader or narrower claim scope, that testimony is still limited by the fact that an inventor understands the invention but may not understand the claims, which are typically drafted by the attorney prosecuting the patent application.” *Id.* at *8. Accordingly, the court held that “inventor testimony as to the inventor’s subjective intent is irrelevant to the issue of claim construction.” *Id.*

The court also rejected the accused infringer’s attempt to rely on a letter from the prosecution counsel to the inventor, which letter allegedly showed that the prosecuting attorney and the examiner understood the claim as requiring that each condylar element had to meet the geometric characteristics. The court ruled that the letter was not part of the prosecution history, and therefore only constituted extrinsic evidence. Since the letter did not shed light on how one of skill would understand the claim scope or provide information regarding the field of the invention, the court held the letter was of “no value to the construction of the disputed claim language.” *Id.* at *7.

The court acknowledged that the specification only described an embodiment with both condylar elements meeting the geometric characteristics. Nonetheless, it held that the narrow disclosure did not limit the claim because the specification did not “make[] clear that the invention requires two condyles meeting the specified geometry.” *Id.* at *6. The court appeared to anchor its plain-language analysis on its observation that had the inventor intended to limit the claim to require that both condylar elements had to meet the geometric characteristics, the inventor could have written the

claim to recite that “*each* condylar element” meet the required geometry rather than “*the* condylar element” have the geometry.²⁰ *Id.* at *5. Judge Prost took issue with this aspect, stating “the fact that a claim could have been drafted more clearly is not, by itself, a sufficient basis to adopt a particular interpretation of claim language. A claim can often be drafted more clearly—litigation only arises because it was not.” *Id.* at *14.

“Use” by Displaying at a Trade Show

Whether the act of displaying an accused device at a trade show constitutes an infringing “use” of the device appears to be an unsettled question. Some district courts have held that merely displaying a device at a trade show without a subsequent sale of the device will not constitute an infringing “use.”²¹ Other courts have rejected that narrow of a standard, and have held that demonstrating a device at a trade show for purposes of garnering future sales can be a “use” under the patent statute.²² In *Medical Solutions, Inc. v. C Change Surgical LLC*, No. 2007-1163, 2008 WL4137898 (Fed. Cir. Sept. 9, 2008), the Federal Circuit considered whether displaying an accused device at a trade show was an infringing “use” of a claimed invention that could support specific personal jurisdiction.

The device at issue in *Medical Solutions* was directed to an apparatus for heating surgical tools. The district court had ruled that the accused infringer’s demonstration of its device at a trade show in the forum did not constitute a “use” of the claimed invention, nor was it an “offer-for-sale” of the claimed invention.²³ On appeal, the patentee dropped its argument that displaying the accused device at the trade show constituted an offer for sale, but maintained its counterclaim that displaying the device constituted an infringing “use.” Examining the totality of the circumstances, the Federal Circuit disagreed. Sidestepping the issue of whether merely displaying a product at a trade show could be a use without a subsequent sale arising from that demonstration, the court examined the circumstances to see if the accused

²⁰ See also APD § 5:47 Inventor “Could Have Claimed” Contentions to Support Broad Claim Construction.

²¹ See generally, APD § 10:4 [Use infringement from] Displaying at a Trade Show; For cases addressing an “offer for sale” arising from displaying a product at a trade show see APD § 10:18 Displaying at a Trade Show.

²² *Id.*

²³ 468 F. Supp. 2d 130, 134-35 (D.D.C. Dec. 29, 2006).

infringer actually “used” the claimed invention at the trade show. To perform this analysis, the court relied on the basic definitional standard for “use” as meaning “to put into action or service.” *Id.* at *4. Applying this definition, the court noted that the claimed invention was directed to an apparatus to heat surgical tools, but there was no evidence that any surgical tools were heated by the displayed device at the trade show. *Id.* Accordingly, the court found that the accused product was not “used” at the trade show since the patentee failed to prove a *prima facie* case that the accused product was put into service. The court instructed that “a ‘use’ under the statute . . . would involve, at a minimum, practicing all of the elements of at least one claim.” The Federal Circuit further ruled that the acts of displaying a prototype of the product, staffing a booth with representatives who could answer questions about the device, and making available brochures about the product did not put the device into service, and therefore did not show an infringing “use.” *Id.*

The Federal Circuit also ruled that the district court did not abuse its discretion in denying the patentee jurisdictional discovery before dismissing the complaint for lack of personal jurisdiction. The court found that the alleged areas of discovery denied to the patentee were not relevant to the jurisdictional basis asserted by the patentee. *Id.* at *4-*5.

Single Species Did Not Support Claims to Genus

Whether describing only a single species of an invention will provide adequate support for a claim to a genus that includes that species often turns on whether the art is predictable. For predictable arts, the disclosure of a single species may provide sufficient information and guidance so that one of skill in the art would readily know the other members of the genus, thereby showing that the applicant possessed the invention directed to the genus. Where the art is unpredictable the disclosure of a single species with a genus may not give sufficient information for one of skill to readily know the other members of the genus.²⁴ Addressing this issue in the context of claims directed to recombinant plasmids for enhanced expression of bacterial DNA polymerase I (encoded by the *polA* gene), the Federal Circuit in *Carnegie Mellon University v. Hoffmann-La Roche Inc.*, No. 2007-1266, -1267 2008 WL 4111410, *7-*11 (Fed. Cir. Sept. 8, 2008), affirmed the district court’s holding that the

claims failed to satisfy the written description requirement under *Eli Lilly*.

Analyzing the written description issue, the Federal Circuit noted that the claims were broadly defined only by function (e.g., encoding DNA polymerase I) and that the generic claims were “not limited to a single bacterial species, but cover all bacterial species.” *Id.* at *7. In contrast, the patents at issue disclosed only a single bacterial gene encoding DNA polymerase: the *E. coli polA* gene. The district court found that the disclosure of a single gene was not representative and failed to adequately support the full scope of the claimed genus. The Federal Circuit agreed, noting that “at the time of the invention, only three bacterial *polA* genes . . . out of thousands of bacterial species had been cloned, and only *E. coli* was described in the patents[,] and that the *polA* gene “varied from one bacterial source to another.” *Id.* at *9-*10. In addition, the Federal Circuit pointed to excerpts from the patents “clearly indicat[ing] that the *polA* gene is critical to the claimed invention[,]” as further limiting the disclosure. For example, while the patents emphasize that “an important feature of this invention [is] that the cloned *polA* gene fragment contains essentially none or at the most only a portion of the activity of its natural promoter,” the Federal Circuit noted that “the patents fail to disclose the nucleotide sequence or other descriptive features for a *polA* gene (including the promoter sequence) from any bacterial source other than *E. coli*.” *Id.* at *9. Agreeing with the district court, the Federal Circuit found “that the narrow disclosure of the *E. coli polA* gene is not representative and fails to adequately support the entire claimed genus under *Eli Lilly*.” Of note, the Federal Circuit cited the 2001 PTO written description guidelines as “persuasive authority” for providing guidance for determining whether the written description requirement is met for generic claims. *Id.* at *8.²⁵

The Federal Circuit also affirmed a non-infringement finding of dependent claims expressly reciting that the bacterial source is *E. coli*. The patentee argued that Roche’s plasmid expressing a DNA polymerase from a bacterial source other than *E. Coli* (i.e., the DNA polymerase from the *Thermus aquaticus* bacteria, also known as *Taq* DNA polymerase) infringed under the doctrine of equivalents. Applying the “all limitations rule,” the

²⁴ See generally, APD § 22:40 Disclosure of Species Providing Support for Genus.

²⁵ See also APD § 2:4 MPEP and Other Patent Office Publications.

Federal Circuit rejected this argument, observing that “a finding that *Taq* is an equivalent of *E. coli* would essentially render the ‘bacterial source [is] *E. coli*’ claim limitation meaningless, and would thus vitiate that limitation of the claims.” *Id.* at *13.

Personal Jurisdiction for DJ Claim

In view of a patentee’s right to notify a potential infringer of suspected infringement, Federal Circuit case law generally holds that a patentee does not subject itself to personal jurisdiction by sending a cease and desist letter to an accused infringer in a forum if the patentee does not conduct any further activity in the forum.²⁶ In *Campbell Pet Co. v. Miale*, No. 2008-1109, 2008 WL 4249767 (Fed. Cir. Sept. 18, 2008), the Federal Circuit addressed whether a nonresident patentee’s extra-judicial efforts to stop alleged infringement in a forum should be treated the same as notification of patent rights by a cease and desist letter or whether the efforts make the exercise of personal jurisdiction over the patentee constitutionally permissible.

In *Campbell*, a California patentee attended a trade show in Washington. During the trade show, the patentee observed a competitor’s product that it thought infringed. The patentee made verbal statements to the competitor that the competitor’s product infringed. It also attempted unsuccessfully to have the trade show exhibit manager force the competitor to cease displaying the accused product at the show. The competitor brought a declaratory judgment claim against the patentee in Washington, its home forum. Granting the patentee’s motion to dismiss for lack of personal jurisdiction, the district court equated the patentee’s acts done during the trade show as being equivalent to a cease and desist letter. It found the patentee’s acts at the trade show insufficient to support specific personal jurisdiction.²⁷

The Federal Circuit reversed. It acknowledged that the patentee had a right to notify the competitor of the suspected infringement without subjecting itself to personal jurisdiction in the forum. But, the Federal Circuit further held that the patentee’s efforts to limit competition from the competitor at the trade show via the assistance of a third party went “beyond simply informing the accused infringer of the patentee’s allegations of infringement.” *Id.* at *6. Hence, the

patentee’s attempt to extra-judicially use its alleged patent rights to restrain competition in the forum made it fair to require the patentee to judicially defend its patent in the forum. Additionally, even though the patentee’s efforts to restrain the competitor were unsuccessful, the Federal Circuit ruled that this did “not affect whether it is fair and just to treat her actions directed at Campbell as sufficient to trigger personal jurisdiction in the forum state.” *Id.*

Subcomponents as Corresponding Structure

A means-plus-function limitation covers the corresponding structure disclosed in the patent specification that performs the recited function.²⁸ Federal Circuit precedent limits the scope of corresponding structure to the structure that is minimally necessary to perform the recited function.²⁹ Recently, the Federal Circuit effectively applied this principle, without stating it, in *Commonwealth Scientific and Industrial Research Organisation v. Buffalo Technology (USA)*, No. 2007-1449, 2008 WL 4274482, *17-*18 (Fed. Cir. Sept. 19, 2008), in the context of corresponding structure have separate subcomponents.

The means-plus-function claim limitation at issue in *Buffalo Tech.*, required the performance of a data reliability enhancement function. The district court construed the corresponding structure to be a “rate ½ TCM encoder.” The rate ½ TCM encoder shown in the patent consisted of two subcomponents; a convolutional encoder, which performed the data reliability enhancement function, and a signal mapping subcomponent, which performed a signal mapping function. Notably, the court found that the performance of the signal mapping function was separable from the data reliability enhancement function.

The accused product contained a convolutional encoder, but did not have structure coupled to its encoder that performed signal mapping. Relying on the district court’s construction of the corresponding structure as being the rate ½ TCM encoder, the accused infringer argued that it did not infringe since its

²⁶ See generally, APD § 36:124 Cease-and-Desist Letters or other Enforcement Threats.

²⁷ 2007 WL 4023629, *1 (W.D. Wash. Nov. 14, 2007).

²⁸ See generally, APD § 8:22 Claim Scope is Limited to the Corresponding Structure and its Equivalents. The specification must also clearly link or associate that structure with the performance of the function. See generally, APD § 8:31 Limited to Structure Actually Specified as Being the Means.

²⁹ See generally, APD § 8:32 Structure Minimally Necessary to Actually Perform Claimed Function.

product did not have signal mapping structure. The district court rejected this argument, and granted summary judgment of infringement. The Federal Circuit affirmed.

Rejecting the accused infringer's argument, the Federal Circuit instructed that “[b]ecause the second subcomponent of the rate ½ TCM encoder receives output from the first subcomponent and then processes that input, the two subcomponents are properly viewed as separable and distinct, even though the patent describes them as performed by a single device.” *Id.* at *17. Accordingly, the accused infringer “does not avoid infringement simply because the device disclosed in the patent subsequently performs a function distinct from that required by the data reliability enhancement means limitation.” *Id.* at *18. Thus, the Federal Circuit viewed the district court’s identification of the rate ½ TCM encoder as effectively being just an identification of the convolutional encoder subcomponent, as that structure was the structure minimally necessary to perform the recited function. *See id.*

Patent Exhaustion Applies Only as a Defense

Applying the well-established principle that a defense created by patent-law does not make a cause of action arise under the patent laws for purposes of establishing subject matter jurisdiction under 28 U.S.C. § 1338(a),³⁰ the Federal Circuit affirmed the dismissal of a licensee’s complaint against a patentee in *ExcelStor Technology, Inc. v. Papst Licensing GMBH & Co. KG*, No. 2008-1140, 2008 WL 4207435 (Fed. Cir. Sept. 16, 2008). The plaintiff in *ExcelStor* alleged that the patentee had fraudulently collected royalties from it on products for which the patentee had also collected royalties from others. According to the licensee, because the patentee had collected royalties from one party, the doctrine of patent exhaustion barred the patentee from collecting a second royalty from the plaintiff. Pursuing this theory, the plaintiff brought a declaratory judgment claim seeking a judgment that the patentee had violated the “patent exhaustion/first sale” doctrine.

Affirming the district court’s dismissal for lack of subject matter jurisdiction,³¹ the Federal Circuit characterized the plaintiff’s complaint as being based on a “fundamental” misunderstanding of the doctrine

of patent exhaustion. The court explained that patent exhaustion only applies as a defense to a charge of patent infringement, and does not provide a basis for an affirmative claim of relief. *Id.* at *2. Further, the Federal Circuit explained that patent exhaustion does not necessarily prevent a patentee from having multiple licenses apply to the same product enforced by contractual obligations. Rather exhaustion only prevents a patentee from using the “patent law to control postsale use of the article.” *Id.* at *3. Hence, the court stated “there is no federal cause of action for collecting royalties twice on the same goods. Patent exhaustion prohibits patentees from enforcing patent rights in certain circumstances, but it does not forbid multiple licenses on a single product or even multiple royalties.” *Id.* Noting that the plaintiff did not allege that the patentee had invoked the patent laws to control the post-sale use of the particular product at issue, but only invoked contract law, the Federal Circuit concluded that the plaintiff’s claim did not require a resolution of a substantial question of patent law. Thus, the plaintiff had to rely on state contract and fraud law to support its claim. As diversity jurisdiction was lacking between the parties, the matter had to be adjudicated “by state, not federal, courts, under state law of contract and fraud.” *Id.*

Plea to Federal Circuit to Clarify and Simplify

Addressing a patentee’s attempt to remove prior art offered by an accused infringer by showing an earlier date of invention, Judge Patrick J. Schiltz of the United States District Court for the District of Minnesota in *Spectralytics, Inc. v. Cordis Corp.*, 2008 WL 4216343, *10-*16 (D. Minn. Sept. 16, 2008), provided a detailed analysis of the Federal Circuit case law on the issue. In his analysis he noted the complexities arising from the different production and persuasion burdens imposed on the parties. He also noted the inherent complexities in applying the different procedural and substantive standards for showing corroboration of a prior date of invention. Judge Schiltz also attempted to identify and segregate the portions of the analysis that must be determined by the court and the portions that are jury questions. After completing his survey of the law, Judge Schiltz concluded that courts and jurors would benefit from a simplification of the rules and made a plea to the Federal Circuit to do just that:

[T]he Court takes this occasion to respectfully urge the Federal Circuit to revisit the extraordinarily complex set of rules that this Court has spent the

³⁰ See generally, APD § 36:7 Patent Law Providing a Defense does Not “Arise Under”.

³¹ 2007 WL 3145013, *4 (N.D. Ill. Oct. 24, 2007).

past fifteen-plus pages trying (perhaps unsuccessfully) to decipher. Rules assigning burdens of production and proof-and dividing responsibilities between judges and jurors-have to be understood and applied by the ordinary mortals who sit on district-court benches and in jury boxes. Moreover, at some point distinctions become so fine that they become lost on typical jurors (or even typical judges) and thus have little practical impact. Simplification and clarification of these rules would be most welcome.

Id. at *16.

ADMINISTRATIVE HAPPENINGS

PPH Pilot Program Begins in EPO

Effective September 29, 2008, the U.S. Patent and Trademark Office (USPTO) and the European Patent Office (EPO) have agreed to implement a one-year trial cooperation initiative called the Patent Prosecution Highway (PPH). Under the PPH, an application containing at least one claim determined to be allowable in the Office of first filing (OFF) may request that the Office of second filing (OSF) accelerate the examination of the corresponding application in the OSF in view of the search and examination results from the OFF. PCT international applications (including national stage applications filed under 35 U.S.C. § 371 are excluded from the pilot program. Currently, the USPTO also has a full-time PPH program with the Japan Patent Office and pilot PPH programs with the United Kingdom Intellectual Property Office, the Canadian Intellectual Property Office, and the Korean Intellectual Property Office.

Extension of UK Pilot PPH

The requirements of the PPH pilot program between the USPTO and the United Kingdom Intellectual Property Office (UKIPO) were modified on January 28, 2008, to allow certain applications based on PCT applications to participate in the pilot

program. Because of the change in the requirements, the USPTO has decided to extend the PPH pilot program with the UKIPO until further notice.

USPTO and KIPO Sign MOU

The USPTO and Korean Intellectual Property Office (KIPO) signed a memorandum of understanding (MOU) this month to promote cooperation and work sharing between the two offices. The MOU outlines a plan to harmonize the patent examination environment of Korea and the U.S., for example, by creating a common search database, developing a standardized patent classification system, using common examiner training, and increasing the reliance on the other office's search results. Representatives from the two offices will meet later this year to start planning how to implement this harmonization.

FIRM HAPPENINGS

Patent Jury Instruction Handbook

The firm is proud to announce the release of Robert A. Matthews, Jr.'s newest publication *Patent Jury Instruction Handbook*. Published by Thomson-Reuters (formerly West), the PJIH serves as a useful reference for crafting jury instructions for patent infringement trials. The PJIH contains approximately 25 sample sets of instructions given by federal judges in infringement actions with commentary on points of law and trial practice. The collection of instructions was carefully chosen to provide a comprehensive coverage of the issues most likely to arise in an infringement action, including how courts are instructing juries on *KSR* and *Seagate*. Additionally, the model patent jury instructions published by AIPLA and the Northern District of California are included with appreciated permission from these organizations. The PJIH is available from Thomson-West (<http://west.thomson.com/productdetail/148343/40641259/productdetail.aspx>) It will be updated annually.

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