



Federal Circuit Review

VOLUME 3 | ISSUE 3 MARCH 2013

State Courts Should Handle Patent Malpractice Cases

In ***Gunn v. Minton*** (S. CT.) (J., ROBERTS), the Supreme Court reversed the Texas Supreme Court's decision that a patent malpractice claim was within the exclusive jurisdiction of the federal courts.

A patentee brought a state-law malpractice claim in Texas state court alleging that his attorneys had committed malpractice in prior patent litigation by failing to raise the experimental use defense to the on-sale bar, resulting in his patent being invalidated. The trial court granted summary judgment against the patentee on his malpractice claim, citing a lack of proof. The Texas Court of Appeals affirmed. The Texas Supreme Court, however, dismissed the entire action for lack of jurisdiction, holding that the state-law claim was within the exclusive jurisdiction of the federal courts because it raised an issue of patent law: whether an "experimental use" argument would have been successful if raised during the prior patent litigation. In dismissing the case, the Texas Supreme Court followed Federal Circuit precedent holding that state-law claims are within the exclusive jurisdiction of the federal courts if they require the resolution of patent-law issues.

The Supreme Court reversed, 9-0, applying its 2005 decision in *Grable & Sons Metal Prods. v. Darue Eng'g & Mfg.*, 545 U.S. 308 (2005). Pursuant to *Grable*, federal jurisdiction over a state law claim will lie if a federal issue is: (1) necessary for the claim to succeed, (2) actually disputed, (3) substantial, and (4) capable of resolution in federal court without disrupting the federal-state balance approved by Congress. The Supreme Court held that the patent-law issue was necessary and actually disputed, but not "substantial." While the outcome of the issue was important to the parties, it was not sufficiently important "to the federal system as a whole." The Court rejected the argument that allowing state courts to resolve patent-law issues in this context would undermine the uniformity of patent law. The Court also rejected the argument that federal courts' greater familiarity with patent law justified litigating legal malpractice cases in federal court.

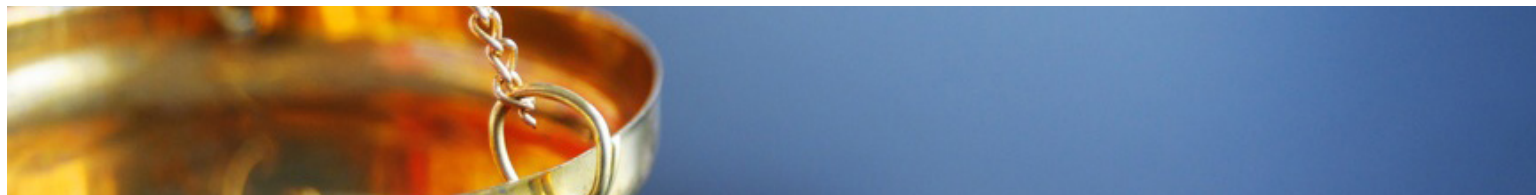
"A" and "An" in Claims Mean "One or More"

In ***Accent Packaging v. Leggett & Platt***, Appeal No. 2012-1011, the Federal Circuit reversed-in-part, affirmed-in-part, and remanded the district court's grant of summary judgment of noninfringement.

Accent Packaging ("Accent") appealed the district court's grant of summary judgment to Leggett & Platt ("Leggett") of noninfringement of claims from two patents disclosing a wire tying device. The disclosed device includes four "elongated

In This Issue

- State Courts Should Handle Patent Malpractice Cases
- "A" and "An" in Claims Mean "One or More"
- No Direct Infringer Needs to be Identified in Declaratory Judgment Jurisdiction Over Indirect Infringement



operator bodies.” The asserted claims of the first patent recite “with each of the operator bodies being operably coupled with a respective one” of four operator elements. Leggett argued that its product (“Pinnacle”) did not satisfy this limitation because the language “each” and “a respective one” requires four operator bodies, each operably coupled to one and only one of the operator elements. Because Leggett’s Pinnacle device has only two operator bodies, Leggett asserted that it cannot infringe these claims. The district court agreed and granted summary judgment of non-infringement as to all claims.

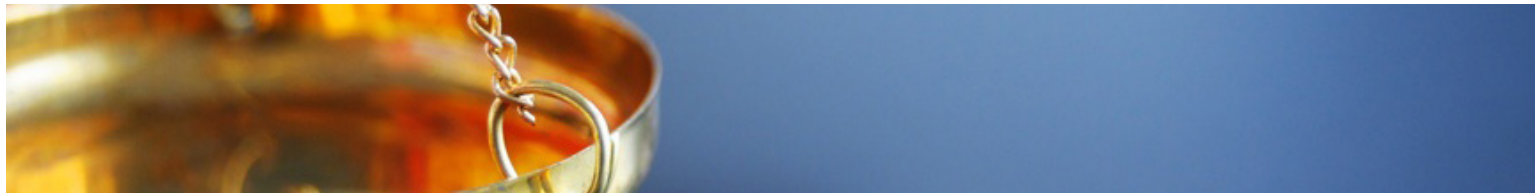
The Federal Circuit held that the district court erred in construing the terms “each” and “a respective one” to require that each of the elongated operator bodies correspond to one and only one of the elements. However, the Federal Circuit explained that the preferred embodiment features an elongated operator body coupled to one or more operator elements. The Federal Circuit stated that a claim interpretation that excludes a preferred embodiment from the scope of the claims is rarely, if ever, correct. Furthermore, an indefinite article such as “a” or “an” carries the meaning of “one or more” unless the patentee has evidenced a clear intent to limit “a” or “an” to “one.” In this case, there was no such clear intent. Thus, the Federal Circuit reversed the district court’s grant of summary judgment of noninfringement to Leggett regarding these claims and remanded to the district court to enter summary judgment of infringement in favor of Accent.

No Direct Infringer Needs to be Identified in Declaratory Judgment Jurisdiction Over Indirect Infringement

In *Arkema Inc. v. Honeywell International, Inc.*, Appeal No. 12-1308, the Federal Circuit reversed the district court’s denial of the plaintiff’s motion to supplement its complaint to add additional declaratory claims.

Arkema sought a declaratory judgment that Honeywell’s ’451 and ’366 patents, which are directed to automotive refrigerant compositions, were invalid and not infringed. While the suit was pending, Honeywell obtained the ’120 and ’882 patents, which are directed to methods of using the compositions. Arkema moved to supplement its complaint to add the ’120 and ’882 patents. The district court denied Arkema’s motion, finding the new claims did not present a justiciable controversy because Arkema would not be a direct infringer and is not in imminent danger of facing liability for indirect infringement. Arkema appealed.

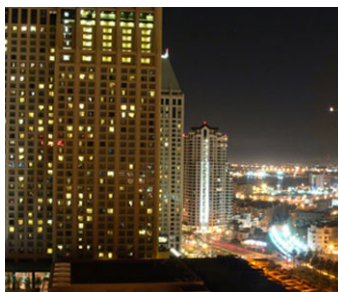
The Federal Circuit reversed, noting that “[w]here, as here, there is no dispute that the intended use would be at least arguably infringing and actively encouraged by the declaratory judgment plaintiff, a controversy is ‘sufficiently real’ for the purposes of declaratory judgment jurisdiction.” The court also stated that there is no requirement that Arkema identify the particular customer that will commit direct infringement or when it will occur. Furthermore, Arkema alleged a present intent to supply automobile manufacturers with the refrigerant for potentially infringing uses, not merely that it would consider potentially infringing activities.



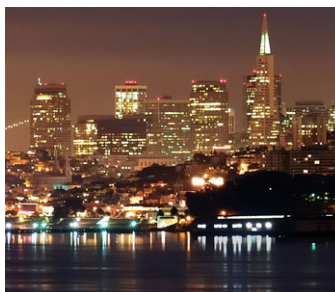
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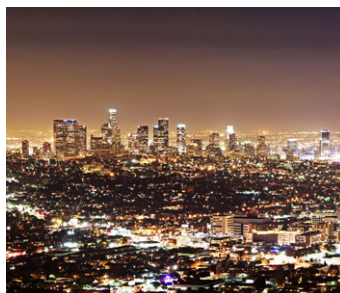
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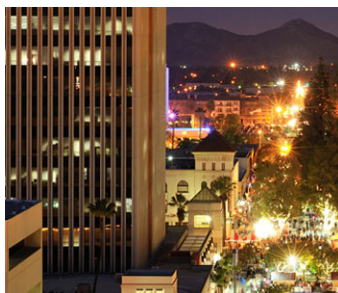
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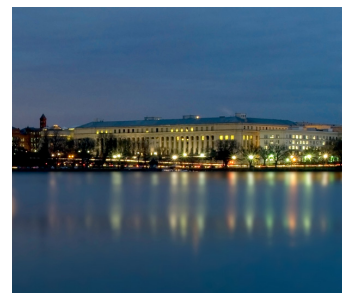
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