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2007 Federal Circuit Yearbook

Patent Law Developments in the Federal Circuit

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Each year, the *Federal Circuit Yearbook* provides a concise, comprehensive review of every patent decision published by the U.S. Court of Appeals for the Federal Circuit during the preceding year. With the *Yearbook* in hand, readers may conveniently follow all recent patent law developments in the CAFC, presented in a manner that reduces specialized patent and technical jargon to a minimum.

Although cases have been decided affecting all areas of patent law, topics covered in the greatest depth in the 2007 *Yearbook* include novelty and statutory bars, claim construction, infringement, remedies, and district court jurisdiction and procedure.

Cases summarized in the *Yearbook* include the following, among many others:

Novelty and statutory bars: Drawings in a patent application constitute a “printed publication,” even though canceled during prosecution and such drawings do not appear in the published patent. (See *Bruckelmyer v. Ground Heaters, Inc.*, discussed at § 2.3.)

Nonobviousness: The motivation to combine does not require a specific teaching to combine but may come from the field of the invention, the subject matter of the references, the extent to which the references are in the same or related fields of technology, and other factors. The permissive form of “may” does not narrow a claim. (See *In re Johnson*, discussed at § 3:4.)

Specification and Claims: (1) Examples are not necessary to support the adequacy of a written description; (2) The written description standard may be met even where actual reduction to practice of an invention is absent; and

(3) There is no per se rule that an adequate written description of an invention that involves a biological macromolecule must contain a recitation of known structure. (See *Falkner v. Inglis*, discussed at § 4:3.)

Interference and Priority of Invention: Where a laboratory notebook authored by a non-inventor is offered into evidence pursuant to authentication by an inventor, where the author of the notebook has not testified at trial or otherwise attested to its authenticity, and where the notebook has not been signed or witnessed and has not been maintained in reasonable accordance with good laboratory practices sufficient to reasonably ensure its genuineness under the circumstances, then the corroborative value of the notebook is minimal. (See *Medichem, S.A. v. Rolabo, S.L. (Medichem IV)*, discussed at § 5:3.)

Claim Construction: A preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim. (See *Bicon, Inc. v. Straumann Co.*, discussed at § 6:3.)

Infringement: In determining “equivalents” under § 112(6), the court may not alter the claimed function either during claim construction or during the infringement analysis. (See *Applied Medical Resources Corp. v. United States Surgical Corp. (Applied Medical II)*, discussed at § 7:2.)

Prosecution History Estoppel: Argument-based estoppel, unlike amendment-based estoppel, does not relinquish more than the scope of the argument: the relevant inquiry is whether a competitor would reasonably believe that the applicant had surrendered the relevant subject matter. (See *Conoco, Inc. v. Energy & Environmental International, L.C.*, discussed at § 8:3.)

Inequitable Conduct: Failure to disclose a full English translation of a Japanese publication is not alone sufficient to infer intent. (See *Atofina v. Great Lakes Chemical Corp.*, discussed at § 9:1.)

Remedies: Federal Circuit law applies to question of what effect a dismissal with prejudice has on the legal

requirements under 35 U.S.C. § 285. As a matter of first impression, a dismissal with prejudice is sufficient to establish a “prevailing party” for purposes of § 285. (See *Highway Equipment Co., Inc. v. FECO, Ltd.*, discussed at § 10:8.)

PTO Practice and Procedure: An attorney may be disbarred by the PTO based on disbarment by another state alone, and five-year statute of limitations does not run until such disbarment. (See *Sheinbein v. Dudas*, discussed at § 11:4.)

District Court Jurisdiction and Procedure: When a patentee with the burden of proof seeks summary judgment of infringement, it must make a *prima facie* showing of infringement as to each accused device before the burden shifts to the accused infringer to offer contrary evidence. (See *L&W, Inc. v. Shertech, Inc.*, discussed at § 12:11.)

Appellate Court Jurisdiction and Practice: Failure to object to jury instructions limits scope of appeal to plain error. Failure to move for JMOL or a new trial limits scope of appeal to prejudicial legal error. (See *Serio-US Industries, Inc. v. Plastic Recovery Technologies Corp.*, discussed at § 13:3.)

Ownership Agreements and Inventorship: Performing experiments does not give rise to co-inventorship. (See *Stern v. Trustees of Columbia University, New York*, discussed at § 14:1.)

Design Patents: In applying the “ordinary observer” analysis, the design as a whole must be analyzed, rather than each design element separately. (See *Amini Innovation Corp. v. Anthony California, Inc.*, discussed at § 15:1.)

Miscellaneous: Public interest in encouraging investment in drug development and protecting exclusionary rights conveyed in valid pharmaceutical patents outweighs interest in making generic alternative available. (See *Sanofi-Synthelabo v. Apotex, Inc.*, discussed at § 16:3.)

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