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2010 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.

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

- **Utility and Inventions Patentable:** The application of human intelligence to the solution of practical problems is not in and of itself patentable. (See *In re Comiskey*, discussed at § 1:1.)
- **Novelty and Statutory Bars:** Clear and convincing evidence of anticipation may come from expert witness testimony. (See *Ecolab, Inc. v. FMC Corp.*, discussed at § 2:6.)
- **Nonobviousness:** Obviousness may arise from combining two embodiments in a reference. When there are no fact issues in dispute, the Federal Circuit may decide obviousness as a question of law and overturn a jury verdict to the contrary. (See *Boston Scientific Scimed, Inc. v. Cordis Corp.*, discussed at § 3:3.)
- **Specification and Claims:** Reference to a computer does not provide sufficient structure for a claim drafted in means-plus-function format. (See *Blackboard, Inc. v. Desire2Learn, Inc.*, discussed at § 4:2.)
- **Interference and Priority of Invention:** In section 146 actions, if the parties present new evidence to the district court that conflicts with the record before the board, the district court must make de novo factual findings regarding that new evidence. (See *Agilent Technologies, Inc. v. Affymetrix, Inc.*, discussed at § 5:2.)
- **Claim Construction:** Process limitations in a product-by-process claim limit the claim for purposes of validity, but not for purposes of infringement. (See *Amgen, Inc. v. F. Hoffman-La Roche Ltd.*, discussed at § 6:2.)
- **Infringement:** Bioequivalency is not sufficient to show equivalency for purposes of the doctrine of equivalents. (See *Abbott Laboratories v. Sandoz, Inc.*, discussed at § 7:1.)

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- **Prosecution History Estoppel:** The presumption of prosecution history estoppel attaches when a patentee cancels an independent claim and rewrites a dependent claim in independent form for reasons related to patentability, even if the amendment alone does not succeed in placing the claim in condition for allowance. (See *Felix v. American Honda Motor Co.*, discussed at § 8:1.)

- **Inequitable Conduct:** Failure to disclose two office actions in continuation application may be material because of examiner's rationale, even though all substantive prior art has been disclosed and examiner later withdraws rejection. (See *Larson Manufacturing Co. of Soutn Dakota v. Aluminart Products Ltd.*, discussed at § 9:3.)

- **Remedies:** A patent may qualify as an essential patent in a patent pool if a license to practice the patent could be viewed as reasonably necessary to practice an industry standard. However, agreement between competitors not to license pool patent for non-industry-standard purposes may constitute anticompetitive conduct and may constitute patent misuse. (See *Princo Corp. v. U.S. Int'l Trade Comm'n*, discussed at § 10:15.)

- **PTO Practice and Procedure:** The "safe harbor" of section 121 is limited to divisional applications denominated as such and does not extend to continuations. (See *Amgen, Inc. v. F. Hoffman-La Roche Ltd.*, discussed at § 11:1.)

- **District Court Jurisdiction and Procedure:** Striking pleadings and dismissing an action for discovery violations is a "remedy of last resort," and a district court abuses its discretion when lesser sanctions are available. (See *ClearValue, Inc. v. Pearl River Polymers, Inc.*, discussed at § 12:7.)

- **Appellate Court Jurisdiction and Practice:** Failing to distinguish between multiple defendants, especially when combined with other alleged litigation misconduct, may lead to a finding that an appeal is both frivolous as filed and frivolous as argued. (See *E-Pass Technologies, Inc. v. 3Com Corp.*, discussed at § 13:2.)

- **Ownership Agreements and Inventorship:** One who simply provides well-known principles or suggests a result without supplying a definite and firm idea of the claimed combination does not qualify as a joint inventor. (See *Narton Corp. v. Schukra USA, Inc.*, discussed at § 14:2.)

- **Design Patents:** The ordinary observer test is the sole test for anticipation: comparison to the prior art includes those portions of the design visible at the time of purchase. (See *International Seaway Trading Corp. v. Walgreens Corp.*, discussed at § 15:1.)

- **Miscellaneous:** The right to "make, use, and sell" a product inherently includes the right to have it made by a third party, absent a clear indication of intent to the contrary. (See *CoreBrace LLC v. Star Seismic LLC*, discussed at § 16:1.)