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Recent Development

RECENT DEVELOPMENTS IN PATENT LAW

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***464 I. Introduction**

This article reviews selected noteworthy patent cases reported in *United States Patents Quarterly*, Second Series, Volume 40, Number 9 (December 2, 1996) through Volume 41, Number 6 (February 10, 1997). The analysis provided for each case is not intended to be an exhaustive analysis of the issues presented in the case. Instead, the analysis reflects the authors' beliefs as to the important aspects of each case.

During this period, a number of cases have been decided which shed light on how district courts and the Court of Appeals for the Federal Circuit will deal with the issue of claim construction after the Supreme Court's decision in *Markman v. Westview Instruments, Inc.*¹ Several cases illustrate that the judges of the Federal Circuit do not necessarily agree on several important issues in patent law. In particular, recent cases indicate that clear disagreements exist over the treatment of "means-plus-function" elements in a claim, the standard of review for a district court's claim construction, and whether public use and experimental use are issues of law or issues of fact.

Just prior to completion of this article, the Supreme Court decided *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*² Thus, this article includes a brief analysis of the Supreme Court's decision even though the decision was not published in the *United States Patents Quarterly* during the period reviewed.

II. *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*: The Supreme Court Attempts to Clarify the Doctrine of Equivalents

On March 3, 1997, the Supreme Court reversed and remanded the Federal Circuit's en banc decision of *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.*³ *465 Despite reversing and remanding for further consideration of issues concerning prosecution history estoppel, the Court declined to "speak the death" of the doctrine of equivalents.⁴ Instead, the Court sought to clarify the confusion surrounding the application of the doctrine first announced in *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*,⁵ and set forth the essential inquiry in any doctrine of equivalents analysis: "Does the accused product or process contain elements identical or equivalent to each claimed element of the patented invention?"⁶

Justice Thomas, writing for a unanimous Court, also addressed several other issues concerning the doctrine of equivalents that have plagued patent practitioners for many years. The Court asserted that it:

share[d] the concern of the dissenters below that the doctrine of equivalents, as it has come to be applied since *Graver Tank*, has taken on a life of its own, unbounded by the patent claims. There can be no denying that the doctrine of equivalents, when applied broadly, conflicts with the definitional and public-notice functions of the statutory claiming requirement.⁷

In recognition of these concerns, the Court indicated that it concurred with Judge Nies' dissent in *Hilton Davis*, in which she argued that the doctrine of equivalents must be applied to individual elements of the claim, and not to the invention as a whole.⁸ Therefore, the Court appears to have adopted the "All-Elements" rule as set forth by the Federal Circuit in *Pennwalt Corp. v. Durand-Wayland, Inc.*⁹

The Supreme Court also tackled the issue of prosecution history estoppel, and when it should be invoked to preclude application of the doctrine of equivalents.¹⁰ The Court stated that prosecution history estoppel should apply only when claims have been amended for a limited number of reasons, such as avoidance of prior art.¹¹ The court refused to adopt a more rigid rule that would invoke prosecution history estoppel and thereby preclude application of the doctrine of equivalents regardless of the reasons for the amendments in the prosecution history.¹² In the present case, the *466 claims were amended during prosecution, but the applicant disclosed no reason as to why they were amended.¹³ To provide guidance in situations like this case, the Court created a rebuttable presumption that prosecution history estoppel applies when a claim is amended during prosecution.¹⁴ However, the patentee may rebut this presumption by offering an appropriate reason for amending the claim, other than distinguishing the claim over the prior art or demonstrating patentability.¹⁵ The court will then have to decide if the offered reason is sufficient to rebut the presumption of prosecution history estoppel to prevent application of the doctrine of equivalents.¹⁶ Thus, in accordance with this new standard, the Supreme Court remanded to the Federal Circuit for consideration of why particular amendments to the claims were made in this case.¹⁷

The Court also went on to criticize the Federal Circuit's en banc treatment of the issue of intent in a doctrine of equivalents analysis. In its decision, the Federal Circuit stated that intentional copying raises a rebuttable presumption of the insubstantiality of the differences, and that designing around raises an inference of substantial differences.¹⁸ The Supreme Court found that "t his explanation leaves much to be desired."¹⁹ Instead, the Court found that intent plays no role whatsoever in the application of the doctrine of equivalents.²⁰

The Court also rejected the argument that the doctrine of equivalents should be limited to equivalents disclosed in the specification when the patent issues.²¹ In particular, the Court stated that "the proper time for evaluating equivalency—and thus knowledge of interchangeability between elements—is at the time of infringement, not at the time the patent was issued."²²

Finally, the Court declined to take up the issue of whether the doctrine of equivalents should be decided by a judge or jury.²³ However, the Court did find *467 ample support in the Supreme Court's prior case law for the Federal Circuit's decision that a jury could decide the issue.²⁴ Moreover, the Court found nothing in its recent *Markman* decision that necessitated a different result.²⁵ Therefore, even though the Supreme Court did not address this issue directly, the Federal Circuit's en banc decision should control in future cases.

III. Patent Litigation

A. Claim Construction

1. The Requirements to Invoke 35 U.S.C. § 112, ¶ 6: *Cole v. Kimberly-Clark Corp.*²⁶

In *Cole*, the Federal Circuit addressed when a court should invoke 35 U.S.C. § 112, ¶ 6 for purposes of construing a claim element.²⁷

The plaintiff, *Cole*, obtained a patent for disposable briefs used when toilet training children.²⁸ One element of the claim at issue required a "perforation means extending from the leg band means to the waist band means through the outer impermeable layer means for tearing."²⁹ Based on its conclusion that this language recited structure requiring "perforations," the district court declined to construe "perforation means" under 35 U.S.C. § 112, ¶ 6 as covering all structures disclosed in the specification "for tearing."³⁰ Therefore, the court determined that Kimberly-Clark did not literally infringe because the accused products sold by Kimberly-Clark did not include "perforations."³¹

On appeal, the Federal Circuit affirmed, finding that the claim element "perforation means" provided sufficient structure to preclude application of section 112, paragraph 6.³² In doing so, the court stated that the use of the word "means" did not automatically invoke section 112, paragraph 6.³³ Conversely, the court acknowledged that the failure to use the word "means" did not preclude application *468 of section 112, paragraph 6.³⁴ Instead, the court explained that the determination whether sufficient structure has been recited must be made on an element-by-element basis, based upon the patent and its prosecution history. In this case, the court found that the claim described not only the structure to perform the tearing function, but also its

location on the disposable brief: “An element with such a detailed recitation of its structure, as opposed to its function, cannot meet the requirements of section 112, paragraph 6.”³⁵

Judge Rader dissented, maintaining that the “perforation means” claim element should have been construed under section 112, paragraph 6.³⁶ In support, Judge Rader argued that prior case law established at least a presumption in favor of construing the “perforation means” element under section 112, paragraph 6.³⁷ Therefore, he would have honored the presumption and construed “perforation means” under that section.³⁸

2. The Effect of Prosecution History on Means-Plus-Function Limitations: *Alpex Computer Corp. v. Nintendo Co.*³⁹

Alpex Computer Corporation owns U.S. Patent No. 4,026,555 (‘555 patent), which is directed to a new microprocessor-based home video game system that uses plug-in cartridges to permit home video systems to play multiple games. In the early 1980s, Nintendo began marketing a home video game system called the “Nintendo Entertainment System.”⁴⁰ When Alpex learned of Nintendo’s system, Alpex filed suit in the Southern District Court of New York.⁴¹ After a four-week liability trial, a jury returned a verdict in favor of Alpex finding the patent valid and infringed, and later returned a damages verdict resulting in an award of over \$250 million.⁴²

***469** The parties’ primary dispute concerning infringement focused on the meaning of the limitation in the claims requiring a “means for generating a video signal.”⁴³ The system disclosed by the specification of the ‘555 patent uses random access memory (RAM) to store a video image, with each pixel of the image being stored in a discrete storage position, or “bit-map.”⁴⁴ The Nintendo system, on the other hand, does not have a storage position for each discrete portion of the image, but instead uses a patented picture processing unit (PPU) to generate pictures by using shift registers to process slices of the image.⁴⁵ Despite these differences, the jury still found infringement.⁴⁶

On appeal, Nintendo argued that the district court adopted an erroneous claim construction by permitting the jury to find infringement of a means-plus-function limitation, when the plaintiff’s patent specifically requires a RAM based, bit-mapped video display.⁴⁷ The Federal Circuit agreed, finding certain statements made by the patentee during prosecution of the ‘555 patent particularly compelling.⁴⁸ In particular, Alpex had distinguished an unasserted claim in the ‘555 patent, with a “means for” limitation similar to that in the asserted claim, from a prior art patent that disclosed a shift register-based video display structure.⁴⁹ In relying on these statements to limit the scope of the claim, the court found “no reason why prosecution history relating to the structure of the video display in the means-plus-function limitations of an unasserted claim is not pertinent to the same structure of the same display system in the means-plus-function limitations of the asserted claims.”⁵⁰ The court based its reasoning on the concept of estoppel:

If an applicant specifically distinguishes a structure from what is claimed during prosecution, the applicant will be estopped from asserting a scope of the same claim that covers that structure.... Just as prosecution history estoppel may act to estop an equivalence argument under the doctrine of equivalents, positions taken before the PTO may bar an inconsistent position on claim construction under § 112, ¶ 6.⁵¹

The court also found that Alpex’s evidence presented during trial was insufficient to establish infringement under the doctrine of equivalents.⁵² According ***470** to the court, Alpex failed to provide any evidence that the differences between its claims and the accused device were insubstantial.⁵³ Therefore, the court reversed the finding of infringement.⁵⁴

3. The Appellate Court’s Standard for Reviewing a District Court Claim Construction: *Metaullics Systems Co. v. Cooper*⁵⁵

Many practitioners may have believed that the Supreme Court’s decision in *Markman v. Westview Instruments, Inc.*⁵⁶ ended the debate as to whether claim construction was a question of law or fact. However, the Federal Circuit’s order in *Metaullics*, indicates that at least two judges of the Federal Circuit believe that the Supreme Court left this issue open for debate.⁵⁷

In *Metaullics*, the court dismissed as moot an appeal from a denial of a preliminary injunction concerning an expired patent.⁵⁸ In dictum, however, the court analyzed the Supreme Court’s decision in *Markman* and determined that claim construction was a mixed question of law and fact.⁵⁹ Therefore, “w here a district court makes findings of fact as a part of claim construction, the court may not set them aside absent clear error.”⁶⁰ In support, the court relied on the Supreme Court’s

statements that claim construction was a “mongrel practice,” consisting of factual and legal components.⁶¹

Judge Lourie concurred in the court’s dismissal; however, he criticized the majority for reading more into the Supreme Court’s decision than it should have.⁶² In particular, he asserted that the Supreme Court did not overrule any aspect of the Federal Circuit’s en banc ruling that claim construction is a question of law.⁶³

*471 As with the previously discussed case, it remains to be seen how these conflicting positions will be reconciled. In the interim, patent practitioners must deal with some uncertainty as to the appropriate standard of review for a district court’s claim construction.

4. Non-Disputed Claim Terms Do Not Require a *Markman* Hearing: *United States Surgical Corp. v. Ethicon, Inc.*⁶⁴

In this case, U.S. Surgical sued Ethicon for infringement of two patents.⁶⁵ Each of the patents concerned surgical instruments used during endoscopic surgery to ligate blood vessels and other tissues by applying multiple ligating clips in sequence.⁶⁶ Prior art ligating instruments for endoscopic surgery could apply only one clip at a time, requiring reloading after each use.⁶⁷

A jury found that one patent was infringed, one patent was not infringed, and that both patents were invalid for obviousness.⁶⁸ Originally, the Federal Circuit affirmed the judgment without opinion.⁶⁹ Seven weeks later, the Supreme Court decided *Markman v. Westview Instruments, Inc.*,⁷⁰ holding that claim construction is a matter of law.⁷¹ The Supreme Court then vacated the *United States Surgical* holding in light of *Markman*, and remanded the case to the Federal Circuit for further consideration.⁷²

During the original trial, Ethicon argued obviousness by asserting that U.S. Surgical had simply adapted its own prior art multiple clip applicator to endoscopic use by elongating the body and providing a seal.⁷³ During the course of expert testimony—which involved extensive explanations and comparisons of the prior art with the U.S. Surgical patented devices—the parties never disputed the structures described in the patents, nor did they dispute the meaning of technical terms or words of art as used in the prior art or as used in the two disputed patents.⁷⁴ Neither *472 U.S. Surgical nor Ethicon discussed any particular claim construction, nor did either party depart from the plain meaning of the words used in the claims or specifications.⁷⁵

The jury instructions included questions of credibility and weight as well as factual issues, but the jury was not required to choose between alternative meanings of technical terms or words of art, nor was it required to decide the scope of the claims.⁷⁶ The trial court therefore refused to enter U.S. Surgical’s proposed claim construction instruction and instead instructed the jury that the technical terms retained their plain meaning.⁷⁷

In its appeal on remand, U.S. Surgical argued that notwithstanding the fact that claim construction was not an issue at trial, the trial court should have followed *Markman* and instructed the jury regarding the function and the structure of the inventions, or the means that performed the function.⁷⁸ The Federal Circuit disagreed and refused U.S. Surgical’s request for a new trial since the proposed instruction on claim construction was undisputed and it simply parroted the words of the claim and repeated the rule concerning infringement of means-plus-function claims.⁷⁹ The court succinctly pointed out that “ t he *Markman* decisions do not hold that the trial judge must repeat or restate every claim term in order to comply with the ruling that the claim construction is for the court.”⁸⁰ Holding that no prejudicial error had been shown in the instructions or that the verdict of obviousness was against the clear weight of the evidence,⁸¹ the court affirmed the judgment of patent invalidity.⁸²

B. Infringement

1. Summary Judgment: *Wiener v. NEC Electronics, Inc.*⁸³

In *Wiener*, the patentee’s claims were directed to a means for addressing a memory array in a read only memory (ROM) site that requires byte-by-byte data *473 extraction from the array.⁸⁴ The patent described the memory array as a matrix of columns and rows with one piece of data stored at the intersection of each column and row.⁸⁵ The district court interpreted the term “column” in the claims as covering only passive elements within the data matrix.⁸⁶ Thus, the court granted summary judgment of noninfringement because the data in defendant’s memory was extracted from the memory matrix via a data register that included active elements.⁸⁷

On appeal, the Federal Circuit disagreed with the district court's claim interpretation and held that "columns" could include active elements.⁸⁸ The court further concluded that the "columns" must be part of and located on the data matrix of the chip.⁸⁹ Despite the district court's erroneous claim interpretation, the Federal Circuit affirmed the grant of summary judgment.⁹⁰ The court observed that an error in claim interpretation does not necessarily require a remand for further proceedings on infringement when the parties do not dispute the technical functions of the accused devices, and when application of the claims does not create any further factual disputes.⁹¹ In this case, the Federal Circuit found that, contrary to the claims which required the columns to be part of and located on the data matrix, the data register in defendant's memory was outside of and isolated from the data matrix.⁹² Therefore, the court affirmed the grant of summary judgment on the issue of literal infringement.⁹³

Moreover, the court found it unnecessary to remand on the fact-intensive issue of doctrine of equivalents.⁹⁴ Relying on *Dolly, Inc. v. Spalding & Evenflo Co.*,⁹⁵ the court determined that the structure of the defendant's device was specifically excluded by the claims and therefore the defendants could not infringe under the doctrine of equivalents.⁹⁶

***474 2. Prosecution History Estoppel: *Ekchian v. Home Depot, Inc.*⁹⁷**

Ekchian involved an issue that at least one party characterized as one of first impression for the Federal Circuit: whether statements made in an Information Disclosure Statement (IDS) can provide a basis for prosecution history estoppel, precluding a finding of infringement under the doctrine of equivalents.⁹⁸

Ekchian, the patentee, contended that statements made in an IDS cannot form the basis for estoppel because the IDS is not submitted to the Patent Office to overcome a rejection by an examiner.⁹⁹ The Federal Circuit rejected *Ekchian's* argument, stating that "an argument contained in an IDS which purports to distinguish an invention from the prior art ... may affect the scope of the patent ultimately granted."¹⁰⁰ The court, therefore, found that any argument in an IDS distinguishing the claimed invention over the prior art is by implication surrendering protection and potentially creates an estoppel bar.¹⁰¹

Despite rejecting *Ekchian's* argument that an IDS cannot create an estoppel, the court vacated the summary judgment in favor of the accused infringers and remanded the cause to the lower court for further proceedings on the material issues of fact regarding the patent.¹⁰² The Federal Circuit held that the district court erroneously construed *Ekchian's* patent claims and erred when it found prosecution history estoppel based on the particular statement *Ekchian* made during prosecution of the patent.¹⁰³

C. Patent Validity

1. On-Sale Bar: *Micro Chemical, Inc. v. Great Plains Chemical Co.*¹⁰⁴

The Federal Circuit attempted to clear up any confusion that might have existed after its prior decision in *UMC Electronics Co. v. United States*¹⁰⁵ concerning the on-sale bar. In *UMC*, the Federal Circuit held a patent to be invalid on the basis of an on-sale bar, even though the invention had not yet been reduced to *475 practice.¹⁰⁶ In *Micro Chemical*, the court analyzed the facts behind the *UMC* decision and attempted to summarize when an invention is sufficiently complete to trigger the on-sale bar:

UMC thus stands for the proposition that, even though the technical requirements of a reduction to practice have not been met, a sale or a definite offer to sell a substantially completed invention, with reason to expect that it would work for its intended purpose upon completion, suffices to generate a statutory bar.¹⁰⁷

Applying this standard to the facts of this case, the Federal Circuit reversed the district court's holding that the inventor's offer to sell constituted an on-sale bar.¹⁰⁸ In 1984, the inventor had conceived the idea of an improved method and apparatus for adding small amounts of ingredients to animal food.¹⁰⁹ The invention included both a weighing component and a mixing component of the system.¹¹⁰ In December of 1984, prior to completing a working model of the invention and prior to the critical date of February 26, 1985,¹¹¹ the inventor offered to sell the system.¹¹² At that time, the inventor had developed a prototype of the weighing portion of the system; however, he had only made a sketch of the mixing portion of the system.¹¹³ Thereafter, in attempting to build the entire system, the inventor's primary challenge was in isolating the weighing portion of

the system from the adverse effects of vibrations caused by the mixing portion of the system.¹¹⁴ In late February 1985, the inventor completed a prototype that overcame this problem.¹¹⁵ Based on these undisputed facts, the court concluded that “because the inventor was not close to completion of the invention at the time of the alleged offer and had not demonstrated a high likelihood that the invention would work for its intended purpose upon completion,” the on-sale bar did not apply.¹¹⁶

***476 2. Fact/Law Distinction for Purposes of Determining Public Use Under 35 U.S.C. § 102(b):¹¹⁷ *Lough v. Brunswick, Corp.*¹¹⁸**

Steven Lough, a mechanic at a marina in Florida, invented an improved upper seal assembly for Brunswick inboard/outboard motors.¹¹⁹ Lough made six useable prototypes on his grandfather’s metal lathe in the spring of 1986. He installed one prototype in his own boat at his home. Three months later he gave a second prototype to a friend who installed it in his boat. He also installed prototypes in the boat of the owner of the marina where he worked and in the boat of a marina customer. He gave the remaining prototypes to longtime friends who were employees at another marina. Lough did not charge anyone for the prototypes. Following the installation of these prototypes, Lough testified that he neither asked for nor received any comments about their operability.¹²⁰

On June 6, 1988, over two years after installing the first prototype, Lough filed a patent application.¹²¹ After the patent issued, Lough sued Brunswick for patent infringement.¹²² After a seventeen-day jury trial, a jury found that Brunswick failed to prove that Lough’s invention was in public use before the critical date of June 6, 1987.¹²³ The jury also found infringement and awarded damages of \$1.5 million in lost profits.¹²⁴

On appeal, a panel of the Federal Circuit reversed the district court’s refusal to grant judgment as a matter of law overruling the jury verdict.¹²⁵ In its decision, the Federal Circuit panel stated that “whether an invention was in public use prior to the critical date within the meaning of a section 102(b) is a question of law.”¹²⁶ The panel further noted that Lough had either admitted or did not dispute the facts as outlined in the opinion.¹²⁷ The panel went on to conclude that, accepting those facts, it could not reasonably be disputed that Lough’s use of the invention was not “experimental” so as to negate a conclusion of public use.¹²⁸

***477** Lough petitioned for rehearing and suggested en banc review.¹²⁹ A divided Federal Circuit, with four judges dissenting, refused to grant en banc review on whether public and experimental use are issues of law or issues of fact.¹³⁰ Although Judge Michel agreed with the panel’s decision, he would have granted en banc review in order to clarify the law on this issue.¹³¹ However, three dissenters strenuously argued that a determination of public versus experimental use is a question of fact.¹³²

Presumably, after this denial, the panel’s decision creates controlling precedent that public versus experimental use is an ultimate conclusion of law. However, Judge Rader’s dissent raises some difficult issues that practitioners and courts may have to address in the future. Judge Rader maintained that Supreme Court decisions, in addition to decisions by the predecessor court to the Federal Circuit, categorized the public use issue as a question of fact.¹³³ If Judge Rader’s interpretation of precedent is accurate, a judge could ignore Federal Circuit decisions that characterize the issue as an ultimate conclusion of law. Therefore, despite the Federal Circuit’s denial of en banc review, a potential uncertainty remains concerning this issue.

IV. Patent Prosecution

A. Obviousness

1. Overcoming a Prima Facie Case of Obviousness: *In re Huang*¹³⁴

Huang applied for a patent that claimed a shock absorbing grip for sports equipment.¹³⁵ The Board of Patent Appeals and Interferences held that Huang’s claims were obvious in view of prior art under 35 U.S.C. § 103, and were therefore unpatentable.¹³⁶ In particular, the Board found that the prior art created a prima facie case of obviousness.¹³⁷ Huang attempted to overcome this prima facie case by ***478** submitting an affidavit in which he averred commercial success based on his company’s sales of over one million grips to other companies, including Wilson Sporting Goods.¹³⁸ He further argued that this commercial success derived from the claimed invention.¹³⁹ However, the Board held that Huang’s affidavit was

insufficient to support his claims of commercial success.¹⁴⁰

The Federal Circuit agreed, noting that commercial success is not merely found in a large number of sales alone:

Although Huang's affidavit certainly indicates that many units have been sold, it provides no indication of whether this represents a substantial quantity in this market. This court has noted in the past that evidence related solely to the number of units sold provides a very weak showing of commercial success.¹⁴¹

Moreover, the court found that Huang's conclusory affidavit was insufficient to provide the required nexus between the claimed features and the commercial success.¹⁴² Instead, the court suggested that Huang should have supplied an affidavit from a customer, such as Wilson Sporting Goods, explaining that the company purchased the product because of the claimed features.¹⁴³ Accordingly, the court affirmed the Board's decision.¹⁴⁴

2. Method of Making a Compound May Render That Compound Obvious: *Ex parte Goldgaber*¹⁴⁵

The Board of Patent Appeals and Interferences affirmed the examiner's rejection of Goldgaber's claims as prima facie obvious over a combination of two references.¹⁴⁶ The claims were directed to DNA sequences hybridizable to the beta-amyloid polypeptide (AAP) associated with Alzheimer's disease.¹⁴⁷ In making this rejection, the examiner first established that the Glenner reference presented working examples of the isolation and characterization of the beta-amyloid polypeptide.¹⁴⁸ Glenner also stated that

*479 with the determination of the amino acid sequence of AAP, it is possible to ascertain the base sequence of *the gene coding for AAP* Having established the amino acid sequence of AAP, a nucleotide probe can be constructed which is complementary to *the DNA or mRNA coding for AAP* or a portion thereof.¹⁴⁹

During prosecution, Goldgaber argued that this statement was simply prophetic, since Glenner did not disclose the actual construction of a DNA library or the screening of that library using any degenerate probes.¹⁵⁰

Affirming the rejection on appeal, the Board reasoned that a person having ordinary skill in the art would have been motivated to isolate a cDNA probe hybridizable to AAP, based on the level of skill in the molecular biology art¹⁵¹ and the Glenner patent.¹⁵² The Board said that Glenner put the skilled artisan in possession of two sets of fully degenerate probes, and within each set was a single probe having a nucleotide sequence that was perfectly complementary to the DNA sequence for AAP.¹⁵³ Moreover, the second cited reference was said to provide more recent techniques than those set forth in Glenner that would enable the skilled artisan to construct and screen a DNA library.¹⁵⁴

Quoting *In re Bell*,¹⁵⁵ Goldgaber argued on appeal that a composition could not be obvious in view of the method of making that composition.¹⁵⁶ The Board squarely met this argument, distinguished the present facts from those in *Bell* and *In re Deuel*,¹⁵⁷ and held that the cited art provided the requisite motivation and predictability of success to maintain the obviousness rejection.¹⁵⁸ In comparing the sets of facts, the Board concluded that Glenner disclosed more comprehensive *480 information than was taught in the prior art at issue in *Bell* and *Deuel*.¹⁵⁹ The Board concluded that Glenner had constructed a "bridge" of information leading from protein to gene, thus rendering Goldgaber's claims obvious.¹⁶⁰

The dissenting Board member argued that while the present fact pattern may have made Goldgaber's claims obvious in the "real world" of biotechnology, the Federal Circuit's directive in *Deuel* was clear.¹⁶¹ A claimed DNA encoding a protein cannot be prima facie obvious over that protein, absent either a clear teaching of the identical or substantially identical DNA sequence, or a teaching of the complete amino acid sequence with clear instruction of how to isolate the corresponding DNA.¹⁶² Since these exceptions were not present in Goldgaber's case, the dissenting member argued that the rejection should have been reversed.¹⁶³

3. Unexpected Results Do Not Always Rebut Obviousness: *In re Mayne*¹⁶⁴

Mayne applied for a patent on two proteins that were made utilizing recombinant DNA technology.¹⁶⁵ The appealed claims were directed to hybrid or fusion proteins that each comprised the amino acid Met hoionine , an enterokinase cleavage site,

and either human growth hormone (HGH) or bovine growth hormone (BGH).¹⁶⁶

The Board of Patent Appeals and Interferences held that the claims were obvious over three primary prior art references, reasoning that Mayne simply substituted one functionally equivalent enterokinase cleavage site for another, and that such a substitution was obvious over the cited art.¹⁶⁷ Mayne argued that their compounds viewed as a whole were not prima facie obvious since the references provided insufficient motivation to combine them.¹⁶⁸ The Federal Circuit agreed with the Board, adding that the prior art sequences and those claimed by Mayne were *481 “strikingly close.”¹⁶⁹ Moreover, the Federal Circuit noted that knowledge of structural relationships often provides the requisite motivation to modify known compounds to obtain new ones.¹⁷⁰

Alternatively, Mayne argued that even if the claimed compounds were obvious, such obviousness was rebutted by additional references showing that the claimed invention exhibited unexpected properties.¹⁷¹ However, the Board and the Federal Circuit were not convinced.¹⁷²

First, the court noted that none of the four references contained any comparative test data to show that the claimed compounds exhibited low immunogenicity when compared to the prior art.¹⁷³ “Without such comparative data, Mayne’s argument is wholly based on inferences drawn from the prior art as to how a different protein would be expected to produce results based on responses not measured,” reasoned Judge Rader.¹⁷⁴

Second, Mayne’s arguments relating to the unexpectedness of biological activity before cleavage were rejected by the court, primarily because Mayne’s specification “fail[ed] to explain the significance or applicability of the data.”¹⁷⁵ Moreover, Mayne only offered conclusory statements of unexpected biological activity, and made no attempt, through affidavit or declaration, to show that BGH or HGH would be biologically inactive when fused to similar enterokinase cleavage sites.¹⁷⁶ The court therefore affirmed the obviousness determination.¹⁷⁷

V. Other Issues

A. Abrogation of State Eleventh Amendment Immunity From Infringement Suits: *Genentech, Inc. v. Regents of the University of California*¹⁷⁸

In 1992, Congress amended the Patent Act to make clear that state government entities are not immune from a patent infringement suit based on the Eleventh *482 Amendment of the United States Constitution.¹⁷⁹ These provisions, however, were recently called into question under the Supreme Court’s decision in *Seminole Tribe of Florida v. Florida*.¹⁸⁰ In *Seminole*, the Supreme Court determined that a federal statute enacted pursuant to Congress’s power under Article I of the Constitution could not abrogate state immunity.¹⁸¹ The Supreme Court reasoned that:

Even when the Constitution vests in Congress complete lawmaking authority over a particular area, the Eleventh Amendment prevents congressional authorization of suits by private parties against unconsenting States. The Eleventh Amendment restricts the judicial power under Article III, and Article I cannot be used to circumvent the constitutional limitations placed upon federal jurisdiction.¹⁸²

Therefore, pursuant to *Seminole Tribe*, if the statutes enacted in 1992 by Congress were enacted only pursuant to its Article I authority, then Article III courts would lack jurisdiction over infringement claims against government entities.

In *Genentech*, a district court in the Southern District of Indiana addressed this issue in the context of a declaratory judgment.¹⁸³ Genentech filed a complaint seeking a declaratory judgment that the University of California’s (UC’s) U.S. Patent No. 4,363,877 (’877 patent) was invalid, unenforceable, and not infringed.¹⁸⁴ In 1996, after the *Seminole Tribe* decision, UC filed a motion to dismiss based on its argument that Congress had no power to abrogate UC’s immunity from the declaratory judgment action.¹⁸⁵

Initially, the district court recognized that Congress had not only relied on its Article I powers to enact sections 271(h) and 296, but had also invoked the *483 Fourteenth Amendment.¹⁸⁶ Specifically, the court found that the legislative history made it clear that the provision was justified in view of the Fourteenth Amendment prohibition against a State depriving a person of property without due process of law.¹⁸⁷ Therefore, the court recognized that “if Genentech were the owner of the ’877 patent

and Genentech were suing UC for infringement of that patent, the Fourteenth Amendment would provide Congress with the power necessary to abrogate UC's immunity."¹⁸⁸

The district court further recognized, however, that this was not the issue before the court because Genentech had no protectable property right in the subject patent.¹⁸⁹ Genentech had filed a declaratory judgment action of patent invalidity against a state patent holder.¹⁹⁰ Therefore, the district court concluded that the Patent Act did not abrogate UC's sovereign immunity because "doing so would require that the court apply the subject statutes in an unconstitutional manner."¹⁹¹

Undoubtedly, other district and appellate courts will be faced with these issues concerning the abrogation of state immunity.¹⁹² It remains to be seen if other courts will follow this court's logic.

B. Discovery Sanctions: *Cochran Consulting, Inc. v. Uwatec USA, Inc.*¹⁹³

Cochran sued Uwatec USA and its Swiss parent company for infringement of a SCUBA indicator device.¹⁹⁴ The district court ordered Uwatec to produce a printed version of a computer ROM code, even though the code was not under Uwatec's control, and the patent did not specifically claim or disclose such a code.¹⁹⁵ Consequently, Uwatec sued a third company in Switzerland to obtain the code, claiming that it owned the information since it had funded the underlying research and development.¹⁹⁶ A Swiss court rejected Uwatec's claim of ownership rights, *484 holding that if the code was produced without permission and in violation of Swiss law, Uwatec would be subject to criminal liability.¹⁹⁷ Nevertheless, the district court imposed discovery sanctions for failure to comply with its discovery order.¹⁹⁸

In reversing the district court, the Federal Circuit reviewed conflict of law provisions, and noted that Uwatec had made all appropriate efforts to comply with the court's order and with Swiss law.¹⁹⁹ Applying the principles of *Société Internationale Pour Participations Industrielles et Commerciales, S.A. v. Rogers*,²⁰⁰ the court noted that Uwatec sought no special privileges, had made appropriate good faith efforts to comply with the discovery demand, and had brought suit in Switzerland to obtain the ROM code.²⁰¹ Moreover, no evidence was presented showing that Uwatec was attempting to use Swiss laws to circumvent the discovery order.²⁰² Finally, the court noted that *Société Internationale* requires that the needs of the requesting party must be balanced with the necessity of that information to the particular case.²⁰³ The court noted that the ROM code was not claimed in Cochran's patent and was not necessary to the function of the patent, and furthermore, any necessary information relating to the code could have been obtained from other sources.²⁰⁴

In a sharp dissent, Judge Rader noted that the third company retaining the ROM code was formed by Uwatec for the sole purpose of developing ROM code for Uwatec's exclusive use.²⁰⁵ In Judge Rader's view, the discovery order and the resulting sanctions for non-compliance were proper because the district court had determined that Uwatec actually controlled the ROM code.²⁰⁶

485 C. Lack of Federal Standing Bars Supplemental Jurisdiction: *Gaia Technologies, Inc. v. Reconversion Technologies, Inc.²⁰⁷

When federal jurisdiction does not exist at the onset of a case, supplemental jurisdiction does not attach to the state claims.²⁰⁸ Here, Gaia sued Reconversion in federal district court for patent and trademark infringement, as well as for various state law claims, including unfair competition, tortious interference with prospective contractual relations, and wrongful appropriation of trade secrets.²⁰⁹ Reconversion countered by arguing that Gaia lacked federal standing, since Gaia did not own the patents and trademarks at the time the suit was filed.²¹⁰

The Federal Circuit agreed, holding that while it is discretionary for the district court to accept supplemental jurisdiction of state law claims under certain circumstances pursuant to 28 U.S.C. § 1367(c), supplemental jurisdiction may not be exercised if there was no federal jurisdiction at the onset of the case.²¹¹ When this occurs, as in the present case, the lack of standing indicates that no Article III case or controversy existed at the time of filing the lawsuit and 28 U.S.C. § 1367 does not apply.²¹²

Gaia's only hope in retaining the case in federal district court was the fact that Lanham Act § 43(a) and civil RICO claims were also pleaded.²¹³ The Federal Circuit therefore remanded the case for a determination of whether the district court should retain supplemental jurisdiction over the state law claims based on these federal statutes.²¹⁴

VI. Conclusion

A number of cases have recently been decided by the Federal Circuit that shed light on how district courts and the Court of Appeals for the Federal Circuit will deal with the issue of claim construction after the Supreme Court's *Markman* decision. Similarly, a stream of new cases concerning the doctrine of equivalents is likely to follow in the footsteps of the Supreme Court's recent decision in *Hilton Davis*.

*486 Moreover, our review of recent cases indicates that the judges of the Federal Circuit do not necessarily agree on several important issues in patent law. Therefore, practitioners can expect decisions in the future that attempt to clarify these issues, including such issues as the treatment of "means-plus-function" elements in a claim and the standard of review for examining a district court's claim construction.

Footnotes

^a Mr. Thomas and Mr. Sertich are associated with the law firm of Arnold, White & Durkee in Austin, Texas. The authors gratefully acknowledge the critical review of this article by Amber L. Hatfield, also of Arnold, White & Durkee.

¹ 116 S.Ct. 1384, 38 U.S.P.Q.2d (BNA) 1461 (1996).

² 117 S.Ct. 1040, 41 U.S.P.Q.2d (BNA) 1865.

³ *Id.* at 1046.. The Federal Circuit decision is: *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 35 U.S.P.Q.2d (BNA) 1641 (Fed. Cir.1995).

⁴ 117 S.Ct. at 1045.

⁵ *Id.* (citing *Graver Tank & Mfg. Co. v. Linde Air Prod. Co.*, 339 U.S. 605, 85 U.S.P.Q. (BNA) 328 (1950)).

⁶ *Id.* at 1054.

⁷ *Id.* at 1048-49.

⁸ *Id.* at 1049.

⁹ 833 F.2d 931, 935, 4 U.S.P.Q.2d (BNA) 1737, 1739 (Fed. Cir.1987) (in banc). In its opinion, the Supreme Court did not define an "element" of a claim. It remains to be seen if courts will define "element" to mean a series of limitations as defined in *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1259, 9 U.S.P.Q.2d (BNA) 1962, 1968 (Fed. Cir.1989) ("In the All Elements rule, 'element' is used in the sense of a limitation of a claim.... An equivalent must be found for every limitation of the claim somewhere in an accused device, but not necessarily in a corresponding component, although that is generally the case.").

¹⁰ *Hilton Davis*, 117 S.Ct. at 1049.

¹¹ *Id.* at 1050.

12 *Id.*

13 *Id.* at 1051.

14 *Id.*

15 *Id.*

16 *Id.*

17 *Id.*

18 *Id.* at 1052.

19 *Id.*

20 *Id.*

21 *Id.* at 1053. Interestingly, after the in banc *Hilton Davis* decision, the Federal Circuit ruled directly contrary to this argument. In particular, the Federal Circuit held that subject matter disclosed in the specification, but not claimed, is dedicated to the public and cannot be recaptured under the doctrine of equivalents. *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1106-07, 39 U.S.P.Q.2d (BNA) 1001, 1006 (Fed. Cir.1996).

22 *Hilton Davis*, 117 S.Ct. at 1053.

23 *Id.*

24 *Id.*

25 *Id.*

26 102 F.3d 524, 41 U.S.P.Q.2d (BNA) 1001 (Fed. Cir.1996).

27 *Id.* at 530, 41 U.S.P.Q.2d at 1005.

28 *Id.* at 526, 41 U.S.P.Q.2d at 1002.

29 *Id.* (emphasis omitted).

30 *Id.* at 527, 41 U.S.P.Q.2d at 1003.

31 *Id.*

32 *Id.* at 530-31, 41 U.S.P.Q.2d at 1006.

33 *Id.* at 531, 41 U.S.P.Q.2d at 1006.

34 *Id.*

35 *Id.*

36 *Id.* at 533, 41 U.S.P.Q.2d at 1008 (Rader, J., dissenting).

37 In the majority opinion, Judge Rich specifically rejected the dissent's statement that the use of the word "means" in a claim element created a presumption that § 112, ¶ 6 applied. *Cole*, 102 F.3d at 531, 41 U.S.P.Q.2d at 1006. Notably, the case Judge Rader cites for this proposition, *York Products, Inc. v. Central Tractor Farm & Family Center*, 99 F.3d 1568, 40 U.S.P.Q.2d (BNA) 1619 (Fed. Cir.1996), was written by Judge Rader several months prior to this decision. The *York Products* and the *Kimberly-Clark* decisions appear to be irreconcilable. It remains to be seen how district courts and the Federal Circuit will sort out this issue in the future.

38 *Cole*, 102 F.3d at 533, 41 U.S.P.Q.2d at 1008 (Rader, J., dissenting).

39 102 F.3d 1214, 40 U.S.P.Q.2d (BNA) 1667 (Fed. Cir.1996).

40 *Id.* at 1216, 40 U.S.P.Q.2d at 1669.

41 *Id.*

42 *Id.*

43 *Id.* at 1218, 40 U.S.P.Q.2d at 1670.

44 *Id.* at 1216-17, 40 U.S.P.Q.2d at 1669.

45 *Id.* at 1218, 40 U.S.P.Q.2d at 1669.

46 *Id.* at 1219, 40 U.S.P.Q.2d at 1670.

47 *Id.*

48 *Id.*, 40 U.S.P.Q.2d at 1671.

49 *Id.*

50 *Id.* at 1220, 40 U.S.P.Q.2d at 1672.

51 *Id.* at 1221, 40 U.S.P.Q.2d at 1673.

52 *Id.* at 1223, 40 U.S.P.Q.2d at 1674.

53 *Id.*

54 *Id.*

55 100 F.3d 938, 40 U.S.P.Q.2d (BNA) 1798 (Fed. Cir.1996).

56 116 S.Ct. 1384, 38 U.S.P.Q.2d (BNA) 1461 (1996).

57 Interestingly, these two judges, Judge Mayer and Judge Rader, did not join the majority opinion in the Federal Circuit's decision in *Markman*. Judge Mayer concurred in the judgment, but wrote that the majority "eviscerate [d] the role of the jury preserved by the Seventh Amendment." *Id.* at 988, 34 U.S.P.Q.2d at 1337 (Mayer, J., concurring). Judge Rader concurred in the judgment because he did not believe that the Court should have reached the issue. *Markman*, 52 F.3d at 998, 34 U.S.P.Q.2d at 1345 (Rader, J., concurring).

58 *Metaullics*, 100 F.3d at 939, 40 U.S.P.Q.2d at 1799.

59 *Id.*

60 *Id.*

61 *Id.* (citing *Markman*, 116 S.Ct. at 1390, 38 U.S.P.Q.2d at 1465).

62 *See id.* at 940, 40 U.S.P.Q.2d at 1799 (Lourie, J., concurring).

63 *Id.*, 40 U.S.P.Q.2d at 1800 (Lourie, J., concurring).

64 103 F.3d 1554, 41 U.S.P.Q.2d (BNA) 1225 (Fed. Cir.1996) (*on remand from* 116 S.Ct. 1562 (1996), *vacating* 48 F.3d 1237 (Fed. Cir.1995)).

65 *Id.* at 1557, 41 U.S.P.Q.2d at 1227.

66 *Id.*

67 *Id.*

68 *Id.* at 1556, 41 U.S.P.Q.2d at 1226.

69 United States Surgical Corp. v. Ethicon, Inc., 48 F.3d 1237 (Fed. Cir.1995).

70 116 S.Ct. 1384, 38 U.S.P.Q.2d (BNA) 1461 (1996).

71 *Id.* at 1395, 38 U.S.P.Q.2d at 1470.

72 United States Surgical Corp. v. Ethicon, Inc., 116 S.Ct. 1562 (1996).

73 *United States Surgical*, 103 F.3d at 1558, 41 U.S.P.Q.2d at 1229.

74 *Id.* at 1559-64, 41 U.S.P.Q.2d at 1229-32.

75 *Id.* at 1562, 41 U.S.P.Q.2d at 1231.

76 *Id.* at 1562-63, 41 U.S.P.Q.2d at 1231-32.

77 *Id.* at 1568, 41 U.S.P.Q.2d at 1236.

78 *Id.* at 1569, 41 U.S.P.Q.2d at 1237.

79 *Id.* at 1567-68, 41 U.S.P.Q.2d at 1236.

80 *Id.* at 1568, 41 U.S.P.Q.2d at 1236.

81 *Id.*

82 *Id.* at 1570, 41 U.S.P.Q.2d at 1238.

83 102 F.3d 534, 41 U.S.P.Q.2d (BNA) 1023 (Fed. Cir.1996).

84 *Id.* at 536, 41 U.S.P.Q.2d at 1024.

85 *Id.*

86 *Id.* at 537, 41 U.S.P.Q.2d at 1026.

87 *Id.* at 537-38, 41 U.S.P.Q.2d at 1025-26.

88 *Id.* at 540, 41 U.S.P.Q.2d at 1027.

89 *Id.*, 41 U.S.P.Q.2d at 1027-28.

90 *Id.* at 540-41, 41 U.S.P.Q.2d at 1027.

91 *Id.*

92 *Id.* at 541, 41 U.S.P.Q.2d at 1028.

93 *Id.*

94 *Id.* at 541-42, 41 U.S.P.Q.2d at 1028-29.

95 16 F.3d 394, 29 U.S.P.Q.2d (BNA) 1767 (Fed. Cir.1994).

96 *Wiener*, 102 F.3d at 541, 41 U.S.P.Q.2d at 1028-29.

97 104 F.3d 1299, 41 U.S.P.Q.2d (BNA) 1364 (Fed. Cir.1997).

98 *Id.* at 1303, 41 U.S.P.Q.2d at 1368.

99 *Id.*

100 *Id.* at 1304, 41 U.S.P.Q.2d at 1368.

101 *Id.*

102 *Id.* at 1305, 41 U.S.P.Q.2d at 1369.

103 *Id.* at 1303-04, 41 U.S.P.Q.2d at 1368.

104 103 F.3d 1538, 41 U.S.P.Q.2d (BNA) 1238 (Fed. Cir.1997).

105 816 F.2d 647, 2 U.S.P.Q.2d (BNA) 1465 (Fed. Cir.1987).

106 *Id.* at 656, 2 U.S.P.Q.2d at 1471.

107 *Micro Chemical*, 103 F.3d at 1545, 41 U.S.P.Q.2d at 1244.

108 *Id.* at 1544, 41 U.S.P.Q.2d at 1244.

109 *Id.* at 1543, 41 U.S.P.Q.2d at 1242.

110 *Id.*

111 The on-sale statutory bar applies to inventions that were on sale in the United States more than one year before the application date for the patent. 35 U.S.C. § 102(b) (1994). The filing date for the patent was February 26, 1986, making February 26, 1985 a key date in terms of application of the statutory bar. *Micro Chemical*, 103 F.3d at 1543 n.1, 41 U.S.P.Q.2d at 1242 n.1.

112 *Micro Chemical*, 103 F.3d at 1543, 41 U.S.P.Q.2d at 1242.

113 *Id.*

114 *Id.*

115 *Id.*

116 *Id.* at 1545, 41 U.S.P.Q.2d at 1243.

117 35 U.S.C. § 102(b)(1994).

118 103 F.3d 1517, 41 U.S.P.Q.2d (BNA) 1384 (Fed. Cir.1997).

119 *Lough v. Brunswick Corp.*, 86 F.3d 1113, 1116, 39 U.S.P.Q.2d (BNA) 1100, 1102 (Fed. Cir.1996), *reh'g denied, reh'g in banc denied*, 103 F.3d 1517, 41 U.S.P.Q.2d 1384 (Fed. Cir.1997).

120 *Id.*

121 *Id.*

122 *Id.* at 1118, 39 U.S.P.Q.2d at 1103.

123 *Id.*

124 *Id.*

125 *Id.* at 1123, 39 U.S.P.Q.2d at 1107.

126 *Id.* at 1120, 39 U.S.P.Q.2d at 1104.

127 *Id.* at 1121, 39 U.S.P.Q.2d at 1105.

128 *Id.*

129 *Lough*, 103 F.3d at 1517, 41 U.S.P.Q.2d at 1385.

130 *Id.* at 1518, 41 U.S.P.Q.2d at 1385.

131 *Id.* at 1526, 41 U.S.P.Q.2d at 1392 (Michel, J., dissenting).

132 *Id.* at 1519-26, 1528-38, 41 U.S.P.Q.2d at 1387-92, 1394-1403 (Newman, J., with whom Rader, J., joins, dissenting; Plager, J., with whom Rader, J., joins, dissenting; Rader, J. dissenting).

133 *Id.* at 1530, 41 U.S.P.Q.2d at 1395 (Rader, J., dissenting).

134 100 F.3d 135, 40 U.S.P.Q.2d (BNA) 1685 (Fed. Cir.1996).

135 *Id.* at 136, 40 U.S.P.Q.2d at 1686.

136 *Id.*; 35 U.S.C. § 103 (1994).

137 *Id.* at 137, 40 U.S.P.Q.2d at 1687.

138 *Id.*

139 *Id.*

140 *Id.*

141 *Id.* at 140, 40 U.S.P.Q.2d at 1689 (citations omitted).

142 *Id.* at 140, 40 U.S.P.Q.2d at 1690.

143 *Id.*

144 *Id.*

145 41 U.S.P.Q.2d (BNA) 1172 (B.P.A.I. 1996).

146 *Id.* at 1178.

147 *Id.* at 1173.

148 *Id.* at 1174.

149 *Id.* at 1173-74 (emphasis in original).

150 *Id.* at 1175.

151 *Id.* at 1174. *See* Amgen, Inc. v. Chugai Pharmaceutical Co., 13 U.S.P.Q.2d (BNA) 1737, 1784 (D.Mass. 1989) (noting that the hypothetical person skilled in the art of molecular biology is presumed to be familiar with the technology and techniques in the field of cloning at the time the invention was made).

152 *Goldgaber*, 41 U.S.P.Q.2d at 1174.

153 *Id.*

154 *Id.*

155 991 F.2d 781, 785, 26 U.S.P.Q.2d (BNA) 1529, 1532 (Fed. Cir.1993).

156 *Goldgaber*, 41 U.S.P.Q.2d at 1176.

157 51 F.3d 1552, 34 U.S.P.Q.2d (BNA) 1210 (Fed. Cir.1995). *Deuel* in essence stands for the proposition that “a general method of isolating DNA or DNA molecules is essentially irrelevant to the question whether the specific molecules themselves would have been obvious, in the absence of other prior art that suggests the claimed DNAs.” *Goldgaber*, 41 U.S.P.Q.2d at 1176 (citing *Deuel*, 51 F.3d at 1559, 34 U.S.P.Q.2d at 1215). The prior art overcome by *Deuel* contained no disclosure of a DNA or mRNA coding for the polypeptide, only a partial polypeptide sequence. *Deuel*, 51 F.3d at 1558, 34 U.S.P.Q.2d at 1215.

158 *Goldgaber*, 41 U.S.P.Q.2d at 1176.

159 *Id.* *See also* *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1268, 229 U.S.P.Q. (BNA) 805, 809 (Fed. Cir 1986) (acknowledging that each case under 35 U.S.C. § 103 (1994) is decided on its own particular facts).

160 *Goldgaber*, 41 U.S.P.Q.2d at 1177.

161 *Id.* at 1182, 1884 (Gron, J., dissenting).

162 *Id.* at 1184 (Gron, J., dissenting).

163 *Id.* (Gron, J., dissenting).

164 104 F.3d 1339, 41 U.S.P.Q.2d (BNA) 1451 (Fed. Cir.1996).

165 *Id.* at 1340, 41 U.S.P.Q.2d at 1452.

166 *Id.*

167 *Id.* at 1340-41, 41 U.S.P.Q.2d at 1452-53.

168 *Id.* at 1341, 41 U.S.P.Q.2d at 1453.

169 *Id.* at 1343, 41 U.S.P.Q.2d at 1454.

170 *Id.* (citing *In re Deuel*, 51 F.3d 1552, 1558, 34 U.S.P.Q.2d 1210, 1214 (Fed. Cir.1995)).

171 *Id.* at 1341, 41 U.S.P.Q.2d at 1453.

172 *Id.*

173 *Id.* at 1343-44, 41 U.S.P.Q.2d at 1455.

174 *Id.* at 1344, 41 U.S.P.Q.2d at 1455.

175 *Id.*, 41 U.S.P.Q.2d at 1455-56.

176 *Id.*, 41 U.S.P.Q.2d at 1456.

177 *Id.*

178 939 F.Supp. 639, 40 U.S.P.Q.2d (BNA) 1768 (S.D. Ind. 1996).

179 In terms of patent infringement, 35 U.S.C. §§ 271(h)(1994) states:
the term “whoever” includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this title in the same manner and to the same extent as any non-governmental entity.
35 U.S.C. § 296(a) (1994) states:
Any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his official capacity, shall *not* be immune, under the eleventh amendment of the Constitution of the United States ... from suit in Federal Court by any person ... for infringement of a patent under section 271, or for any other violation under this title.
(emphasis added).

180 116 S.Ct. 1114 (1996).

181 *Id.* at 1119.

182 *Id.* at 1131-32.

183 *Genentech*, 939 F.Supp. at 641-42, 40 U.S.P.Q.2d at 1770.

184 *Id.* at 640, 40 U.S.P.Q.2d at 1769.

185 *Id.*

186 *Id.* at 643, 40 U.S.P.Q.2d at 1771.

187 *Id.*, 40 U.S.P.Q.2d at 1772.

188 *Id.*

189 *Id.*

190 *Id.*

191 *Id.* at 644, 40 U.S.P.Q.2d at 1772.

192 On December 13, 1996, the District Court of New Jersey also concluded that, because a patent was “property,” state immunity from patent infringement suits under the Eleventh Amendment was properly abrogated by Congress under its Fourteenth Amendment legislative authority. *See* *College Savings Bank v. Florida Prepaid Postsecondary Education Expense Bd.*, 948 F.Supp. 400 (D.N.J. 1996).

193 102 F.3d 1224, 41 U.S.P.Q.2d (BNA) 1161 (Fed. Cir.1996).

194 *Id.* at 1225, 41 U.S.P.Q.2d at 1162.

195 *Id.*

196 *Id.* at 1228, 41 U.S.P.Q.2d at 1165.

197 *Id.* at 1230, 41 U.S.P.Q.2d at 1166.

198 *Id.* at 1225, 41 U.S.P.Q.2d at 1162.

199 *Id.* at 1226, 41 U.S.P.Q.2d at 1163.

200 357 U.S. 197 (1958).

201 *Cochran*, 102 F.3d at 1226, 41 U.S.P.Q.2d at 1163.

202 *Id.* at 1228, 41 U.S.P.Q.2d at 1165.

203 *Id.* at 1227, 41 U.S.P.Q.2d at 1164.

204 *Id.* at 1231, 41 U.S.P.Q.2d at 1167.

205 *Id.* at 1232, 41 U.S.P.Q.2d at 1168 (Rader, J., dissenting).

206 *Id.* at 1236, 41 U.S.P.Q.2d at 1171 (Rader, J., dissenting).

207 41 U.S.P.Q.2d (BNA) 1134 (Fed. Cir.1996) (for court order resulting from this opinion, refer to 104 F.3d 1296 (Fed. Cir.1996)).

208 41 U.S.P.Q.2d at 1140.

209 *Id.* at 1136.

210 *Id.*

211 *Id.* at 1140.

212 *Id.* (citations omitted).

213 *Id.* at 1140-41.

214 *Id.* at 1141.