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Recent Developments

RECENT DEVELOPMENTS IN PATENT LAW

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***306 I. Introduction**

This article covers patent cases reported in Volume 48 of the United States Patents Quarterly, Second Edition, beginning September 1998 and continuing through December 1998. Although not all cases are discussed, most Federal Circuit decisions through December are included, as are significant district court decisions and, of course, the Supreme Court's decision in *Pfaff v. Wells Electronics*.

II. Validity

A. On-Sale Bar

In *Pfaff v. Wells Electronics, Inc.*,¹ the Supreme Court rejected the argument that reduction to practice is a prerequisite to application of the on-sale bar under 35 U.S.C. Section 102(b). However, in considering the proper standard of completion for the on-sale inquiry, the Supreme Court rejected the Federal Circuit's "substantially complete" test and advanced a new "ready for patenting" standard for determining when to invoke the on-sale bar.²

Pfaff had accepted a purchase order for sockets for computer chips prior to the critical date.³ Drawings had been prepared prior to the purchase order and were the basis for the customized tooling and subsequent manufacture of the socket after the critical date.⁴ In its opinion below, the Federal Circuit had held that Pfaff's socket was substantially complete at the time of the sale, and therefore met its "totality of the circumstances" test for on-sale bars under 35 U.S.C. Section 102(b).⁵

***307** The Supreme Court rejected adoption of a reduction to practice standard, as urged by Pfaff, noting that "the word 'invention' in the Patent Act unquestionably refers to the inventor's conception rather than to a physical embodiment of the idea."⁶ The Supreme Court also noted that the term "reduction to practice" is found only in 35 U.S.C. Section 102(g), which provides for resolution of priority contests between inventors, and refused to incorporate the need for "reduction to practice" into the word "invention" found in 35 U.S.C. Section 102(b).⁷

However, the Supreme Court found that the Federal Circuit's "substantially complete" analysis undermined the goal of providing inventors with a definite standard for determining when patent applications must be placed on file.⁸ Thus, the Supreme Court rejected the multi-factored totality of the circumstances inquiry developed by the Federal Circuit.⁹ Deciding that the word "invention" refers to a concept that is complete rather than substantially complete, the Supreme Court instead adopted a "ready for patenting" standard to replace the "substantially complete" standard.¹⁰

Thus, the Supreme Court found "that the on-sale bar applies when two conditions are satisfied before the critical date. First, the product must be the subject of a commercial offer for sale."¹¹ The Supreme Court reasoned that the timing of a commercial offer is controllable and understandable by the inventor, noting that the experimental use doctrine had not created uncertainty.¹² The second condition that must be satisfied is that the "the invention must be ready for patenting."¹³ That condition may be satisfied either by (1) a reduction to practice, or (2) "by proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention."¹⁴

In *Weatherchem Corporation v. J.L. Clark, Inc.*,¹⁵ the Federal Circuit applied *Pfaff*'s two-part test for the first time. The Federal Circuit applied the *Pfaff* test to *308 claims directed to a lid for a spice jar and found those claims to be invalid under 35 U.S.C. Section 102(b).¹⁶ In particular, the Federal Circuit found that the ordering of 275,000 caps constituted a commercial offer for sale, thus satisfying the first part of the test.¹⁷ "Record evidence of a signed purchase agreement before the critical date establishes an offer for sale sufficient to invoke the on-sale bar."¹⁸ The fact that goods were not delivered and money did not exchange hands until after the critical date was held immaterial.¹⁹ The second part of the *Pfaff* test was satisfied because the invention was found to be ready for patenting based on drawings prepared more than eight months prior to the critical date, even though additional refinement work was necessary.²⁰ Two other facts were also found to be important: (1) a commercial quantity of the invention was ordered, 275,000 caps, prior to the critical date, and (2) as in *Pfaff*, the manufacturer was able to produce the invention using the drawings.²¹

In *Mas-Hamilton Group, Inc. v. LaGard, Inc.*,²² the Federal Circuit affirmed a decision of the Eastern District of Kentucky that found that a patent was not invalid under the on-sale bar of 35 U.S.C. Section 102(b).²³ Although the decision pre-dates the Supreme Court's decision in *Pfaff*, the Federal Circuit's affirmance was based on commercial sale analysis and, as a result, is not likely implicated by the Supreme Court's "ready for patenting" analysis.

Of note, the Federal Circuit held that, with respect to the factual issues underlying the on-sale determination, the district court did not clearly err in holding that Mas-Hamilton failed to meet its burden²⁴ of providing clear and convincing evidence despite factual findings: (1) that "La presented a prototype to Mosler and offered to furnish additional prototypes that were essentially the same device described in the [subject] patent,"²⁵ (2) that money changed hands,²⁶ and (3) that Mosler provided a purchase order,²⁷ all prior to the *309 critical date. According to the Federal Circuit, the district court found that Mosler was a potential licensee rather than a potential customer,²⁸ that the devices presented to Mosler were for testing or show, and that "La Gard's offer to Mosler was only an offer of either (1) production rights in the invention, or of (2) the exclusive right to market the invention to the government, neither of which involved a sale or offer to sell the devices themselves."²⁹ The Federal Circuit affirmed.³⁰

In *Scaltech, Inc. v. Retec/Tetra, L.L.C.*,³¹ the Federal Circuit vacated the Southern District of Texas' summary judgment of invalidity under the on-sale bar and remanded the matter for further proceedings.³² Though the Federal Circuit's decision was rendered under the now defunct "substantially completed invention" standard, the result under *Pfaff* would likely be the same because the Federal Circuit found that the invention was not conceived until after the critical date.³³ Despite on-going commercial activities beginning before the critical date, the invention was not conceived until Scaltech had discovered, after the critical date, the particle size and solids concentration limitations of the claim.³⁴

In remanding the case, the Federal Circuit's opinion hinted at the possibility that commercial activity that embodied less than all the elements of the claimed invention might constitute "technical prior art" for purposes of a Sections 102(b)/103 type obviousness analysis.³⁵ The Court also hinted at the potential role of experimental use analysis on remand.³⁶ In this regard, it is notable that the Federal Circuit seemed intent on suggesting the distinction between experimental use negation and an experimental stage doctrine "rejected by [the Federal Circuit] and the Supreme Court."³⁷ Whether or not the Supreme Court has breathed new life into the experimental stage doctrine³⁸ is yet to be determined.

***310 B. Written Description — Omitted Element**

In the first major district court decision following the Federal Circuit's controversial opinion in *Gentry Gallery, Inc. v. Berkline Corporation*,³⁹ the Northern District of California in *Reiffen v. Microsoft Corporation*⁴⁰ granted summary judgment of invalidity for failure to comply with the written description requirement of 35 U.S.C. Section 112. The district court found that although *Ethicon Endo-Surgery*⁴¹ supports the well-established proposition that a patent owner may assert claims that go beyond the specific embodiment shown in her application,⁴² that the decision in *Gentry Gallery* means that the written description requirement now includes an omitted element test.⁴³

The district court explained *Gentry Gallery* as holding that "a patent holder cannot assert claims that omit elements of the invention as originally disclosed if a person skilled in the art would have understood those elements to be essential to the disclosed invention."⁴⁴ The opinion in *Reiffen* is notable for its adherence to *Gentry Gallery*, rather than any particular reasoning it employs. The patents in issue were directed to multi-threaded software technology and were asserted against Microsoft® Windows®) 98 and other products. It was undisputed that four "elements" disclosed in Reiffen's original

application, namely an editor, a compiler, an interrupt means and a return means, were missing from each of Reiffin's seventy-seven asserted claims.⁴⁵ In deciding that the four omitted elements were essential as originally disclosed, the district court apparently relied on the following: (1) "reference to all four elements" in the Summary of the Invention,⁴⁶ (2) "reference to all four *311 elements" in the Abstract,⁴⁷ (3) "discus[sion of] the importance of an editor and compiler" in both the Object of the Invention section and the Description of the Prior Art,⁴⁸ and (4) suggestion by the application's background section and title of the importance of a compiler to the invention.⁴⁹

The *Reiffin* court also looked to the original claims contained in the application as filed and found that "[e]ither directly or indirectly, each of Reiffin's 21 original claims references one, if not more, of the four elements."⁵⁰ Finally, the *Reiffin* court apparently discounted Reiffin's prophylactic statements to the contrary, stating "although Reiffin's application strategically suggests that the described embodiment is only one preferred embodiment, Reiffin's repeated discussion of the four elements within the summary strongly suggests that he did not envision an application without these elements."⁵¹

C. Reexamination

In *Anderson v. International Engineering and Manufacturing, Inc.*,⁵² the Federal Circuit held that the broadening of a claim term in reexamination rendered the claim invalid. The claim related to inserting and securing studs in snowmobile tracks.⁵³ "The question of whether the claims have been materially or substantially enlarged must be determined upon the claim as a whole."⁵⁴ Although the Federal Circuit noted that "the circumstances of presentation in the specification may temper the general rule that broadening of any term of a claim is fatal, even when other terms are narrowed, it is appropriate to consider other factors including whether the applicant intended to have originally covered the challenged subject matter."⁵⁵ Here, the Federal Circuit looked at the plaintiff Anderson's assertion that the intention was to claim broadly (generically) in original claim 1.⁵⁶ The Federal Circuit determined that the original claims, when objectively viewed did not cover the broader concept *312 urged by the patentee, particularly because the specification did not "suggest or imply" the broader concept urged by the patentee.⁵⁷

III. Infringement

A. Claim Construction

1. Extrinsic Evidence after *Vitronics*

During the Fall of 1998, the Federal Circuit decided a large number of cases involving claim construction issues. Not surprisingly, the role of extrinsic evidence was center stage in several of the cases. In particular, three decisions, *Renishaw PLC v. Marposs Societa' per Azioni*,⁵⁸ *Phillips Petroleum Company v. Huntsman Polymers Corporation*,⁵⁹ and *Desper Products, Inc. v. QSound Labs, Inc.*⁶⁰ took a rather deferential view of cautionary statements in *Vitronics*⁶¹ on the proper use of extrinsic evidence. On the other hand, Judge Newman's opinions in *EMI Group North America, Inc. v. Intel Corporation*⁶² and *ATD Corporation v. Lydall Inc.*,⁶³ as well as her concurrence in *Phillips Petroleum*⁶⁴ suggest routine use of extrinsic evidence. Finally, *Key Pharmaceuticals v. Hercon Laboratories Corp.*,⁶⁵ attempts to clarify the standard, but does little more than reiterate the malleable language.

In *Renishaw*, the Federal Circuit affirmed the Eastern District of Michigan's finding of non-infringement on an intrinsic evidence-based construction of the claim term "when."⁶⁶ The *Renishaw* court reviewed the familiar, but competing, cannons *313 of claim construction,⁶⁷ and noted that the two rules share two underlying propositions. First, according to the court, "it is manifest that a claim must explicitly recite a term in need of definition before a definition may enter the claim from the written description."⁶⁸ "The intrinsic evidence, and, in some cases, the extrinsic evidence, can shed light on the meaning of the terms recited in a claim, either by confirming the ordinary meaning of the claim terms or by providing special meaning for claim terms."⁶⁹ "Thus, a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, at the very least, point to a term or terms in the claim with which to draw in those statements."⁷⁰ Second, according to the court, if the patent applicant has "elected to be a lexicographer by providing an explicit definition in the specification for a claim term, then that definition controls."⁷¹ "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim."⁷²

Based on the above, the Federal Circuit began with the specific language of the claim and found that “when” was not limited to the precise moment of contact between a stylus and a work piece.⁷³ Renishaw argued that “when” should receive a broader dictionary definition such as “at or after the time that,” “in the event that,” or “on condition that.”⁷⁴ However, “[a]s evidenced by the several common meanings of ‘when,’ the term is imprecise as used in the [subject] patent.”⁷⁵ This imprecision provided an entry point into the claim for the intended meaning of a term from the written description.⁷⁶ Nonetheless, despite any imprecision, “[t]he term [was] not ambiguous, ... because the written description provides overwhelming evidence to guide a proper interpretation of the term.”⁷⁷ The applicant’s usage of the term “when” was imprecise, but did not rise to the level of “ambiguity,” and therefore extrinsic evidence need not be consulted. According to the court, several passages *314 from the specification⁷⁸ make it “abundantly clear that ‘when’ in the patent means at the time of, and not some appreciable time thereafter.”⁷⁹

In *Phillips Petroleum*, the Federal Circuit affirmed the Southern District of Texas’ grant of summary judgment of non-infringement based primarily on construction of the claim term “block copolymer.”⁸⁰ Like the *Renishaw* court, the majority in *Phillips Petroleum* ascertained though extrinsic evidence that the meaning of a term was susceptible to clarification.⁸¹ Also like the *Renishaw* court, the majority in *Phillips Petroleum* satisfied its need for clarification entirely with intrinsic evidence (in this case, from the considerable prosecution history) and without resort to extrinsic evidence.⁸² “[W]e only consider extrinsic evidence ‘if there were still some genuine ambiguity in the claims, after consideration of all available intrinsic evidence.’”⁸³

In contrast, in *EMI Group North America, Inc. v. Intel Corporation*,⁸⁴ the Federal Circuit embraced extrinsic evidence, placing a specific numerical threshold on the claim term “relatively thicker.” The court gave lip service to limitations on the use of extrinsic evidence, citing *Markman* and *Cybor*,⁸⁵ though not a single reference was made to *Vitronics*. Indeed, the court made a point of noting throughout the opinion that it had relied on expert witness testimony.

[O]ur determination of the issues on appeal had drawn on the record of the *Markman* hearing and the testimony of the expert witnesses, including their conflicting views of the significance of various distinctions drawn during patent *315 prosecution with respect to the prior art, as well as with respect to the accused Intel methods and their relation to the EMI method and prior art methods.⁸⁶

In stark contrast with the decisions in *Phillips Petroleum* and *Renishaw*, the *EMI Group* panel endorsed a claim construction that draws heavily from expert testimony to require characteristics, including a top oxide to substrate oxide thickness ratio of at least 1.77:1, “some of which are stated in the claim and some of which are not.”⁸⁷

Justice Newman’s concurrence in *Phillips Petroleum* echoed a similar theme, which at least in that case, was unable to carry the majority:

I believe it is seriously incorrect to foreclose consideration of such “extrinsic” evidence. It is increasingly recognized that courts must be enabled and encouraged to receive and understand the guidance of experts. The scientific witnesses for both sides agreed as to the uncertainties of this chemistry and the ensuing ambiguity of interpretation of the claims in light of the state of the art when the invention was made. This court’s refusal to consider the evidence of experts for both sides (although it is mentioned even as it is discounted) is not the path to enlightenment on the complexities of polymer chemistry and technology. Judicial doubt can not be resolved by exclusion of the evidence that explains the scientific issues.⁸⁸

In *Key Pharmaceuticals, Inc. v. Hercon Laboratories Corporation*,⁸⁹ the Federal Circuit approved the district court’s claim construction which incorporated extrinsic evidence of FDA approved dosages to define the claim term “pharmaceutically effective amount.”⁹⁰ The Federal Circuit also commented on the confusion surrounding the cautionary statement in *Vitronics*⁹¹ regarding the use of extrinsic evidence. The Federal Circuit noted:

[Vitronics] might be misread by some members of the bar as restricting a trial court’s ability to *hear* [extrinsic] evidence. We intend no such thing. To the contrary, trial courts generally can hear expert testimony for background and education on the technology implicated by the presented claim construction issues, and trial courts have broad discretion in this regard.

...

*316 What is disapproved of is an attempt to use extrinsic evidence to arrive at a claim construction that is clearly at odds

with the claim construction mandated by the claims themselves, the written description, and the prosecution history, in other words, with the written record of the patent.⁹²

However, a seemingly contradictory approach is suggested in *ATD Corporation v. Lydall, Inc.*,⁹³

[When] the specification explains and defines a term used in the claims, without ambiguity or incompleteness, there is no need to search further for the meaning of the term. (citations omitted) However, when such definition is challenged it is often appropriate, despite facial clarity and sufficiency of the specification and the prosecution history, to receive evidence of the meaning and usage of terms of art from persons experienced in the field of the invention.⁹⁴

Though cloaked in familiar language, the approach of the court in *ATD Corp.* would seem to set an exceedingly low threshold for receiving extrinsic evidence. The court cites the Federal Rules of Evidence as allowing the introduction of expert evidence of the meaning of a term despite “facial clarity” of the term and “sufficiency of the specification and the prosecution history” to provide its meaning.⁹⁵

2. Prosecution History

In *Desper Products, Inc. v. QSound Labs, Inc.*,⁹⁶ the Federal Circuit affirmed the Central District of California’s entry of summary judgment of non-infringement based on construction of the claim terms “following” and “prior to,” describing the portion of a signal pathway from a signal alteration point to a transducer in which first and second channels were to be maintained separate and apart from each other.⁹⁷ Although the plain meaning of the claim terms supported a broader construction for the term “prior to,” the Federal Circuit found that, based on the intrinsic evidence of the written description and prosecution history, “prior to” should not be given its ordinary meaning.⁹⁸

Indeed, the Federal Circuit concluded that the prosecution history supported construing “prior to” in claim 7 in the same manner as the term “following” in claim *317 1, because during the prosecution, QSound treated claim 1 and claim 7 together even though one used “following” language and the other used “prior to” language.⁹⁹ According to the court’s rendition of the prosecuting attorney’s remarks, QSound argued during prosecution that “‘claims 1 and [7] have been amended hereby to make it more clear that the first channel signal is always maintained separate and apart from the second channel signal *following* the step of altering the amplitude and shifting the phase in at least one of those signals.’”¹⁰⁰ Accordingly, different terms were construed to have the same meaning since they cover the same subject matter.¹⁰¹

In *Bai v. L&L Wings, Inc.*,¹⁰² the Federal Circuit upheld a summary judgment that the defendant did not infringe claims directed to a target game, literally or under the doctrine of equivalents.¹⁰³ The Federal Circuit found that the record clearly indicated that the reason for an amendment narrowing the claim by adding the limitation “hemispherical” was to avoid the prior art.¹⁰⁴ As a result, the presumption under *Warner-Jenkinson* that an amendment is related to patentability unless otherwise explained was not implicated, and Bai’s arguments in rebuttal were irrelevant.¹⁰⁵ Furthermore, the action of an Examiner, deleting the term “hemispherical” to broaden the count in a subsequent interference did not limit the estoppel.¹⁰⁶

3. Section 112(6)

In *Unidynamics Corporation v. Automatic Products International, Ltd.*,¹⁰⁷ the court construed a claim limitation “spring means tending to keep the door closed” under 35 U.S.C. Section 112, paragraph 6.¹⁰⁸ In its analysis, the Federal Circuit disagreed with the district court’s decision that recitation of the word “spring,” *318 which is structural language, took the limitation outside the ambit of Section 112, paragraph 6.¹⁰⁹ The court noted that under *Greenberg*, “use of the term ‘means’ generally (but not always) shows that the patent applicant has chosen ... [to invoke] § 112, paragraph 6.”¹¹⁰ The court further noted that recitation of some structure in a means-plus-function element does not preclude the applicability of Section 112(6) when the structure “merely serves to further specify the function of the means.”¹¹¹

In distinguishing *Cole v. Kimberly Clark Corporation*,¹¹² the Federal Circuit indicated that the “perforation means” language then in issue “not only described definite structure, perforations, that supported the described function, tearing, but also described the location and extent of the structure.”¹¹³ In contrast, the *Unidynamics* court found that in “spring means” limitation, “spring [was] the only recitation of structure with the remainder pertaining solely to the function of the means

limitation.”¹¹⁴

In *Mas-Hamilton*, the Federal Circuit construed a “lever operating means ...,” a “substantially non-resilient lever moving element ...,” and “a movable link member ...” under 35 U.S.C. Section 112, paragraph 6.¹¹⁵ In the latter two cases, the court noted that a lack of means language does not prevent a limitation from being construed as a means-plus-function limitation,¹¹⁶ and “there was no evidence that the lever moving element or the movable link member had a *generally understood structural meaning in the art.*”¹¹⁷

***319** In *Personalized Media Communications, LLC v. International Trade Commission*,¹¹⁸ the Federal Circuit reversed a portion of the Commission’s decision finding the asserted claims invalid as indefinite under the second paragraph 35 U.S.C. Section 112. The administrative law judge (ALJ) found that the term “digital detector for ...” invoked 35 U.S.C. Section 112, paragraph 6 as the term was functional and not limited to a particular structure.¹¹⁹ The ALJ also found that the claim was indefinite since it failed to disclose sufficient structure corresponding to the means claim.¹²⁰ The Federal Circuit found that the term “digital detector” did recite sufficient structure to avoid Section 112, paragraph 6 since the term had a well known meaning in the art “connotative of structure.”¹²¹ The term “detector” was sufficiently definite in terms of structure, even though the term is defined in terms of function, and even though the term does not “connote a precise physical structure,” since it does convey a “variety of structures” to those of skill in the art.¹²² Once the claim was outside of Section 112, paragraph 6, the Federal Circuit found that the claim was not indefinite since it adequately informed one skilled in the art the scope of the invention when read in light of the specification.¹²³

B. Doctrine of Equivalents

In *Institutform Technologies, Inc. v. Cat Contracting, Inc.*,¹²⁴ the Federal Circuit affirmed the Southern District of Texas’ judgment of infringement under the doctrine of equivalents with respect to a first process, the “multiple cup” process, and reversed with respect to a second process, the “needle” process.¹²⁵ With respect to the multiple cup process, the Federal Circuit was rather unstructured in its limitation-by-limitation analysis. In particular, the court said, [A]lthough claim 1 only claims the method of using one cup to impregnate the tube with resin, the multiple cups used in the accused process each perform precisely the same steps and functions as the single cup of the claimed method. Every limitation ***320** in claim 1, therefore, is met by at least one cup in Defendants’ multiple cup process. That all the cups together may not meet every limitation does not necessarily avoid equivalent infringement.¹²⁶ In considering the needle process, the Federal Circuit noted that the district court had incorrectly merged its identification of the cup’s “function” with the “way” and the “result,” such that all defined basically the same thing.¹²⁷ After more narrowly defining the “way” part of the function-way-result analysis, the Federal Circuit held that there were substantial differences between the claimed single cup process and the accused multiple needle process.¹²⁸

Of note, the Federal Circuit considered as a factor in its analysis, facts indicating that the inventor had attempted, prior to filing his patent application, to use a needle instead of a cup.¹²⁹ Although the parties disputed whether the needle attempt indicated that needles were known substitutes, or whether the inventor’s failure with needles was evidence of substantial differences, the Federal Circuit found that “[t]he evidence that the inventor first tried to use needles and then changed to cups without disclosing to the public that needles were, indeed, an option, supports an inference that the inventor was unable satisfactorily to practice his claimed method using a needle instead of a cup.”¹³⁰

C. 35 USC Section 271(a) — Offer for Sale

In *3D Systems, Inc. v. Aarotech Laboratories, Inc.*,¹³¹ the Federal Circuit held personal jurisdiction existed over one of the three defendants. In so doing, the Federal Circuit found it necessary to address the 1994 statutory change¹³² that expanded the set of infringing activities under 35 U.S.C. § 271(a) to include an “offer to sell.”

Section 271(i) defines “an ‘offer for sale’ or an ‘offer to sell’ by a person other than the patentee or any designee of the patentee, as that in which the sale will occur before the expiration of the term of the patent.”¹³³ The court’s analysis came in the ***321** context of the second prong of the *Akro v. Luker*¹³⁴ minimum contacts test used to determine if specific jurisdiction existed over the defendants. Co-defendant Aaroflex argued that state law should determine whether there was an offer for

sale. However, the Federal Circuit refused to limit the “tort of patent infringement” based on an offer to sell, to state contract law and thereby to limit Federal Circuit personal jurisdiction law by state common law definitions of federal statutory terms.¹³⁵ The Federal Circuit also refused to import the on-sale bar analysis associated with 35 U.S.C. Section 102(b) into Section 271(a) “offer for sale” analysis.¹³⁶ Instead, the Federal Circuit determined that the price quotation letters sent by the defendant to California residents, although on their face stating that they were not offers, should in fact be considered “offers for sale” since they included both a description of, and a price for, the allegedly infringing merchandise.¹³⁷ The Federal Circuit held that the purpose of adding the “offer to sell” language was to prevent “generating interest in a potential infringing product to the commercial detriment of the rightful patentee.”¹³⁸

D. Design Patents

In *Unidynamics Corporation v. Automatic Products International, Ltd.*¹³⁹ which is introduced above, the Federal Circuit vacated the Eastern District of Mississippi’s grant of summary judgment of infringement of a design patent for failure to correctly apply the ordinary observer test. In particular, the district court committed legal error when it merged the ordinary observer and the point of novelty tests.¹⁴⁰

“In determining whether a product design infringes a design patent, two distinct tests must be applied: the ordinary observer test set forth in *Gorham v. White*,¹⁴¹ and the point of novelty test.”¹⁴² In determining overall similarity of *322 design, the ordinary observer must be deceived by the ornamental, rather than functional, features common to the claimed and accused designs.¹⁴³ The point of novelty test requires that, in addition to the ordinary observer test, the accused device appropriate the novelty that distinguishes the patented device from the prior art.¹⁴⁴ According to the Federal Circuit, the district court, in its ordinary observer analysis, mistakenly ignored ornamental features because it found that they were irrelevant to the point of novelty.¹⁴⁵ Accordingly, the Federal Circuit vacated the district court’s grant of summary judgment.¹⁴⁶

In *Goodyear Tire & Rubber Company v. Hercules Tire and Rubber Company*,¹⁴⁷ the Federal Circuit upheld a district court ruling that a Hercules tire tread design did not infringe Goodyear’s design patent even though Hercules had intended to appropriate the general appearance of the Goodyear tire.¹⁴⁸ In determining infringement of a design patent, that is whether an ordinary observer would be misled by the similarity to the patented design to think that the patentee’s design is being purchased, the focus is whether the ordinary purchaser, here a trucker, of the allegedly infringing product that was actually purchased, a truck tire, would be deceived when such person gives the attention usually given by a purchaser of the item bearing the design.¹⁴⁹ It is not a matter of claim construction to determine who is the appropriate ordinary observer.¹⁵⁰ Deception with regards to the patented design, and hence infringement, is determined from the viewpoint of the person who is the ordinary purchaser of the allegedly infringing article.¹⁵¹

Infringement of a design patent requires that the designs have the same general visual appearance, such that it is likely that the purchaser would be deceived into confusing the design of the accused article with the patented design. The accused *323 design must also contain substantially the same point of novelty that distinguished the patented design from the prior art.¹⁵²

“Similarity of overall appearance is an insufficient basis for a finding of infringement, unless the similarity embraces the points of novelty of the patented design.”¹⁵³ “The points of novelty relate to differences from prior designs and are usually determinable based on the prosecution history.”¹⁵⁴

E. “Consisting Essentially Of”

In *PPG Industries, Inc. v. Guardian Industries Corporation*,¹⁵⁵ the Federal Circuit upheld a jury verdict of noninfringement of a claim written in partially closed form using the term “consisting essentially of,” because the allegedly infringing glass included an ingredient not listed in the claim that materially altered the basic and novel properties of the claimed glass.¹⁵⁶ The determination of whether the ingredient materially altered the basic and novel properties of the claim was an infringement question and thus a question of fact for the jury.¹⁵⁷

F. Willful Infringement

In *Comark Communications, Inc. v. Harris Corporation*,¹⁵⁸ the Federal Circuit affirmed a jury verdict of willful infringement despite the presence of an opinion of counsel. Although Comark did not challenge the legal competence of the opinion, it

argued that Harris' own actions rendered the opinion incompetent and unreliable.¹⁵⁹ Comark argued that the opinion could not have been reasonably relied upon because Harris intentionally withheld from its counsel important information that Harris believed would result in an unfavorable opinion.¹⁶⁰ In particular, the evidence indicated that:

*324 (1) Harris directed its opinion counsel to obtain information from an engineer other than the primary design engineer;¹⁶¹

(2) the opinion expressly restricted its analysis to a waveform monitor embodiment rather than a spectrum analyzer embodiment; therefore, reliance was unreasonable and Harris should have sought a revised opinion when the design was changed to include a spectrum analyzer;¹⁶²

(3) counsel was not informed that, prior to the rendering of his opinion, the primary design engineer had developed a modulator/detector combination circuit that other evidence indicated exhibited the same spectral characteristics as the claimed circuit, particularly in light of the opinion, which distinguished the claimed invention from the Harris device based on differing spectral characteristics;¹⁶³ and

(4) the original design included a spectrum analyzer, use of the spectrum analyzer was dropped due to infringement concerns, and use of the spectrum analyzer was reinstated several months after the opinion was delivered to Harris management.¹⁶⁴

In short, the Federal Circuit found that the record included substantial evidence from which the jury could find by clear and convincing evidence that Harris willfully infringed the subject patent.¹⁶⁵ Despite the presence of an opinion of counsel, “[w]henver material information is intentionally withheld, or the best information is intentionally not made available to counsel during the preparation of the opinion, the opinion can no longer serve its prophylactic purpose of negating a finding of willful infringement.”¹⁶⁶

In *Yamanouchi Pharmaceutical Company v. Danbury Pharmacal, Inc.*,¹⁶⁷ the district court found that the defendant willfully infringed the patent, determined the case to be exceptional and awarded the plaintiff attorneys fees under 35 U.S.C. Section 285. The court determined that the defendant failed to meet its affirmative duty of due care, relying on an inadequate opinion of counsel, in filing a certification under 21 U.S.C. Section 355(j)(2)(A)(iv)(IV) that the patent covering the drug in question was invalid.¹⁶⁸

***325 IV. Patent Misuse**

In *PSC, Inc. v. Symbol Technologies, Inc.*,¹⁶⁹ the district court held that Symbol misused its patents by collecting double royalties on patents for the same products. Symbol collected royalties from both PSC, the upstream supplier, on all products it manufactured that practiced the patented invention when installed in other products and from the downstream manufacturer of those other products.¹⁷⁰

V. Interference

In *Bruning v. Hirose*,¹⁷¹ the Federal Circuit determined that “during an interference involving a patent issued from an application that was copending with the interfering application, the appropriate standard of proof for validity challenges is the preponderance of the evidence standard” as opposed to a clear and convincing standard.¹⁷²

The Federal Circuit also reversed the Board's finding of invalidity due to failure to disclose the best mode (the inventor did not disclose details of a lens assembly) because the evidence suggested that the inventor had no subjective awareness of a best mode for practicing the invention at the time of filing.¹⁷³ The inventor had expressed concerns over certain characteristics of the elements in the lens assembly and the lens assembly had required additional testing and modifications before it would work for its intended purpose.¹⁷⁴

VI. Miscellaneous Procedural

A. Jurisdiction or Venue

In *3D Systems, Inc. v. Aarotech Laboratories, Inc.*,¹⁷⁵ the Federal Circuit, applying *Hunter Douglas, Inc. v. Harmonic Design Inc.*,¹⁷⁶ found federal jurisdiction would be proper for the state law trade label claim pursuant to *326 28 U.S.C. Section 1338(a) as arising under an Act of Congress relating to patents “in that whether 3D libeled the defendants by accusing them of infringing 3D’s patents necessarily depends on resolution of a substantial question of federal patent law.”¹⁷⁷

B. Stay of Interfering Patents Suit

In *Slip Track Systems, Inc. v. Metal Lite, Inc.*,¹⁷⁸ the Federal Circuit vacated the Central District of California’s stay of an interfering patents suit brought under 35 U.S.C. Section 291.¹⁷⁹ The district court below had entered a stay of the Section 291 action pending the outcome of a reexamination of Slip Track’s patent in the United States Patent & Trademark Office (PTO).¹⁸⁰ In a strange twist, two patents ostensibly directed to the same invention were apparently issued by the PTO on the same day.¹⁸¹ The first, the Paquette patent owned by Metal Lite, was filed first, and the second, the Brady patent, was owned by Slip Track.¹⁸² A summary of the relevant facts is taken from the Federal Circuit’s opinion:

In August 1997, Metal Lite requested that the PTO conduct a reexamination of the Brady patent in light of the Paquette patent. The PTO determined that the Paquette patent raised a substantial new question concerning the patentability of the Brady patent and began a reexamination [[[under] 35 U.S.C. Sections 303-305.

The first office action in the reexamination resulted in a rejection of all the claims of the Brady patent as anticipated by the Paquette patent [under] 35 U.S.C. § 102(e). Slip Track’s efforts to introduce evidence showing that it had invented the claimed subject matter before Paquette were dismissed as outside the scope of the reexamination proceeding. *See Manual of Patent Examining Procedure* (MPEP) § 706.02(b)(4) (6th ed. 1997) (affidavit in reexamination may not be used to swear behind a United States patent claiming the same invention). The examiner did note, however, that Slip Track could file a reissue application and seek to provoke an interference with the Paquette patent. Rather than file a reissue application, Slip Track filed an interfering patents suit [under 35 U.S.C. § 291] in the district court against Metal Lite.¹⁸³

*327 After a series of motions not relevant to this discussion, Metal Lite filed a motion to stay the district court proceedings pending the outcome of the PTO reexamination.¹⁸⁴ The district court granted Metal Lite’s motion to stay the interfering patents suit.¹⁸⁵

The Federal Circuit noted that the stay order was subject to appellate review because “it effectively puts Slip Track out of Federal Court.”¹⁸⁶ Slip Track could not litigate priority issues in the PTO reexamination, nor could it swear behind the anticipatory Paquette reference.¹⁸⁷

Under those circumstances, the reexamination, if carried to completion, [[[was] likely to result in the cancellation of all of the claims of the Brady patent. That in turn [would] require a dismissal of the interfering patents suit, since a necessary condition for such an action is the existence of two valid and interfering patents. As a result, the district court [would] have no occasion to consider the issue of priority of invention following the resolution of the PTO proceeding. That consequence provides sufficient finality to make the stay order a “final decision” for appealability purposes.¹⁸⁸

Having established that the stay was appealable, the Federal Circuit then decided that the stay was improper, “because a foreseeable consequence of staying Slip Track’s interfering patents suit in favor of the reexamination proceedings is that Slip Track will be unable to raise the issue of priority of invention in any forum.”¹⁸⁹ The court distinguished other decisions in which a stay in favor of copending proceedings in the PTO was justified.¹⁹⁰

C. Attorney Client Privilege—Electronic Mail

In *Amylin Pharmaceuticals, Inc. v. University of Minnesota*,¹⁹¹ the district court held that the attorney-client privilege applies to email messages, although the court noted that it “is questionable whether there can be an anticipation of confidentiality in email messages such that those messages can be privileged.”¹⁹²

***328 D. International Trade Commission**

In *San Huan New Materials High Tech, Inc. v. International Trade Commission*,¹⁹³ the Federal Circuit upheld the right of the

International Trade Commission to assess and impose civil penalties under 19 U.S.C. Section 1337(f)(2) for violation of consent orders.¹⁹⁴

E. Estoppel, Waiver or Invited Error

In *Key Pharmaceuticals, Inc. v. Hercon Laboratories Corporation*,¹⁹⁵ the Federal Circuit warned litigants that arguing against a position espoused at the district court would be viewed with extreme disfavor.¹⁹⁶ The defendant-appellant, Hercon, argued that the district court erred by adopting a claim construction that was urged by Hercon at trial.¹⁹⁷ The Federal Circuit indicated that doctrines of estoppel, waiver, or invited error would prohibit litigants from taking such positions on appeal.¹⁹⁸ However, the Federal Circuit, in an abundance of fairness and because no prior opinions had clearly condemned such behavior to thereby put Hercon on notice, and because plaintiff Key did not object to Hercon's conduct, considered Hercon's alternative claim construction before upholding the district court's claim construction and finding that Hercon failed to prove the patent invalid based on prior art.¹⁹⁹

F. Special Verdict Interrogatories

In *Comark Communications, Inc. v. Harris Corporation*,²⁰⁰ the Federal Circuit affirmed the decision of the Eastern District of Pennsylvania in denying a motion for JMOL that the evidence of record was legally insufficient proof to support the jury's findings of infringement under the doctrine of equivalents.²⁰¹ Of note, the Federal Circuit's affirmance was in large measure due to the Harris' failure to use a special *329 verdict interrogatory to determine which limitations were met literally and which were met by equivalents.²⁰²

The Federal Circuit agreed with Harris that its prior precedents stand for the proposition that "mere generalized testimony as to equivalence is insufficient as a matter of law to support a jury verdict finding infringement under the doctrine of equivalents."²⁰³ Nonetheless, the court decided that, in choosing to concentrate its defense on the insufficiency of evidence to support a jury finding that an equivalent of a "video delay circuit" present in the accused device, Harris ignored the possibility that the jury found that the "video delay circuit" limitation was met literally.²⁰⁴ In particular, the Federal Circuit noted:

[T]o arrive at its verdict of infringement under the doctrine of equivalents, the jury must have found that one or more claim elements were met by equivalents, and could have found the remainder of the claim elements were met literally.... Because no special verdict interrogatory was used to determine which elements were met literally and which were met equivalently, this court cannot presume to ascertain which elements the jury found to be met only by equivalents. Thus, this court must uphold the jury verdict if there is sufficient evidence of equivalents and linking testimony such that a reasonable jury could have found that at least one element was met by equivalents.

...

[W]here there is no specific finding by the jury of equivalence as to a particular element, and the defendant has not successfully argued that a particular limitation could not be met literally, the defendant has assumed the burden of proving not only that there is insufficient evidence under *Lear Siegler* for a jury to find that the limitation could not be met equivalently, and it must also establish that there is no substantial evidence in the record that would permit the jury to find that any limitation has been met by equivalents.²⁰⁵

"Because there [was] substantial evidence in the record from which a reasonable jury could find that the 'video delay circuit' limitation could be met literally, and because Harris [had] not shown a failure of proof of equivalents on all of the remaining limitations at issue in the trial," the Federal Circuit affirmed the decision denying Harris' motion for JMOL.²⁰⁶

***330 G. Discovery**

In *ATD Corporation v. Lydall, Inc.*,²⁰⁷ the Federal Circuit held that prior art was properly excluded because it was not timely provided within the discovery period set by the district court. Section 282 of the Patent Act provides for a minimum 30 day before trial period to supply patents or publications to be relied on at trial.²⁰⁸ However, the minimum time set in 35 U.S.C. Section 282 does not override judicial directives for timing of discovery.²⁰⁹

Footnotes

^{a1} Zagorin, O'Brien & Graham, L.L.P., Austin, Texas

¹ 119 S.Ct. 304, 48 U.S.P.Q.2d (BNA) 1641 (1998).

² *Id.* at 311, 48 U.S.P.Q.2d at 1647.

³ *Id.* at 308, 48 U.S.P.Q.2d at 1643.

⁴ *Id.*

⁵ *Pfaff v. Wells Elecs., Inc.*, 124 F.3d 1429, 1435, 43 U.S.P.Q.2d (BNA) 1928, 1932 (Fed. Cir. 1997).

⁶ *Pfaff*, 119 S.Ct. at 308, 48 U.S.P.Q.2d at 1644.

⁷ *Id.* at 308-09, 48 U.S.P.Q.2d at 1644-45.

⁸ *Id.* at 310-11, 48 U.S.P.Q.2d at 1646.

⁹ *Id.* at 311, 48 U.S.P.Q.2d at 1646.

¹⁰ *Id.* at 312, 48 U.S.P.Q.2d at 1647.

¹¹ *Id.* at 311, 48 U.S.P.Q.2d at 1646.

¹² *Id.* at 311-12, 48 U.S.P.Q.2d at 1646-47.

¹³ *Id.* at 312, 48 U.S.P.Q.2d at 1647.

¹⁴ *Id.*

¹⁵ 163 F.3d 1326, 49 U.S.P.Q.2d (BNA) 1001 (Fed. Cir. 1998) (opinion by Rader, panel consisting of Mayer, Michel and Rader).

¹⁶ *Id.* at 1332-33, 49 U.S.P.Q.2d at 1007.

¹⁷ *Id.*

¹⁸ *Id.*

19 *Id.*

20 *Id.*

21 *Id.*

22 156 F.3d 1206, 48 U.S.P.Q.2d (BNA) 1010 (Fed. Cir. 1998) (opinion by Michel, panel consisting of Michel, Plager and Gajarsa).

23 *Id.* at 1217, 48 U.S.P.Q.2d at 1019.

24 *Id.*

25 *Id.*

26 *Id.*

27 *Id.* The purchase order was apparently never filled and no agreement was reached about the particulars of the proposed lock prior to the critical date. *Id.*

28 *Id.*

29 *Id.*

30 *Id.*

31 156 F.3d 1193, 48 U.S.P.Q.2d (BNA) 1037 (Fed. Cir. 1998) (opinion by Rich, panel consisting of Rich, Plager and Gajarsa).

32 *Id.* at 1193, 48 U.S.P.Q.2d at 1037.

33 *Id.* at 1197-98, 48 U.S.P.Q.2d at 1040.

34 *Id.* at 1198, 48 U.S.P.Q.2d at 1040.

35 *Id.*

36 *Id.*, 48 U.S.P.Q.2d at 1041.

37 *Id.*, 48 U.S.P.Q.2d at 1041 & n.4 (“Scaltech argues that its invention was still experimental at the time Scaltech was soliciting an opportunity to practice the invention. This argument fails because it is premised on the ‘experimental stage’ doctrine which has been rejected by both this court and the Supreme Court. *See* Lough v. Brunswick Corp, 86 F.3d 1113, 39 U.S.P.Q.2d (BNA) 1100

(Fed. Cir. 1996); *City of Elizabeth v. American Nicolson Paving Co.*, 97 U.S. 127 (1877). The experimental stage doctrine finds its genesis in *Eastman v. Mayor, Etc. of City of New York*, 134 F. 844, 858 (3d Cir. 1905) (“As soon as the invention is completed, viz.: ‘in such a condition that the inventor can apply for a patent for it,’ the [grace] period begins to run and the application must be made within this period”), and has been advocated sporadically since then. *See, e.g.*, *Pharmacia, Inc. v. Frigitronics, Inc.*, 13 USPQ2d (BNA) 1833, 1841 (D. Mass. 1989). However, the policy underlying experimental use negation is to give the inventor an opportunity to reduce the invention to practice, not the *time* to do so. *City of Elizabeth*, 97 U.S. at 135-36).

38 *See Pfaff*, 119 S.Ct. at 311 n.12, 48 U.S.P.Q.2d at 1646 n.12.

39 *Gentry Gallery, Inc. v. Berklene Corp.*, 134 F.3d 1473, 45 U.S.P.Q.2d (BNA) 1498 (Fed. Cir. 1998).

40 *Reiffin v. Microsoft Corp.*, 48 U.S.P.Q.2d (BNA) 1274, 1280 (N.D. Calif. 1998).

41 *Ethicon Endo-Surgery, Inc. v. United States Surgical Corp.*, 93 F.3d 1572, 40 U.S.P.Q.2d (BNA) 1019 (Fed. Cir. 1998).

42 *Reiffin*, 48 U.S.P.Q.2d at 1276.

43 *Id.* at 1279.

44 *Id.* at 1277.

45 *Id.* at 1279.

46 *Id.*

47 *Id.*

48 *Id.*

49 *Id.*

50 *Id.*

51 *Id.* at 1279-80

52 160 F.3d 1345, 48 U.S.P.Q.2d (BNA) 1631 (Fed. Cir. 1998) (opinion by Newman, panel consisting of Newman, Skelton and Michel).

53 *Id.* at 1346, 48 U.S.P.Q.2d at 1632.

54 *Id.* at 1349, 48 U.S.P.Q.2d at 1634.

55 *Id.*

56 *Id.*

57 *Id.* (citations omitted).

58 158 F.3d 1243, 48 U.S.P.Q.2d (BNA) 1117 (Fed. Cir. 1998) (opinion by Clevenger, panel consisting of Plager, Clevenger and Gajarsa).

59 157 F.3d 866, 48 U.S.P.Q.2d (BNA) 1161 (Fed. Cir. 1998) (per curiam opinion, panel consisting of Rich, Newman and Schall).

60 157 F.3d 1325, 48 U.S.P.Q.2d (BNA) 1088 (Fed. Cir. 1998) (opinion by Plager, panel consisting of Plager, Clevenger and Gajarsa).

61 *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 39 U.S.P.Q.2d (BNA) 1573 (Fed. Cir. 1996).

62 157 F.3d 887, 48 U.S.P.Q.2d (BNA) 1181 (Fed. Cir. 1998) (opinion by Newman, panel consisting of Newman, Plager and Bryson).

63 159 F.3d 534, 48 U.S.P.Q.2d (BNA) 1321 (Fed. Cir. 1998) (opinion by Newman, panel consisting of Rich, Newman and Clevenger).

64 *Phillips Petroleum*, 157 F.3d at 878-79, 48 U.S.P.Q.2d at 1171-72.

65 161 F.3d 709, 48 U.S.P.Q.2d (BNA) 1911 (Fed. Cir. 1998) (opinion by Plager, panel consisting of Mayer, Plager and Clevenger).

66 *Renishaw*, 158 F.3d at 1250-51, 48 U.S.P.Q.2d at 1122.

67 “(a) one may not read a limitation into a claim from the written description, but (b) one may look to the written description to define a term already in a claim limitation, for a claim must be read in view of the specification of which it is a part.” *Renishaw*, 158 F.3d at 1248, 48 U.S.P.Q.2d at 1120.

68 *Id.*

69 *Id.*

70 *Id.*

71 *Id.*

72 *Id.*

73 *Id.* at 1250-51, 48 U.S.P.Q.2d at 1123.

74 *Id.* at 1250, 48 U.S.P.Q.2d at 1122.

75 *Id.* at 1251, 48 U.S.P.Q.2d at 1123.

76 *Id.*

77 *Id.*

78 For example, the description of the invention's place in the prior art, the "Summary of the Invention," and statements in the "Description of the Preferred Embodiments" that use the term "when" to describe a time very close to the precise instant that the stylus contacts the work piece and not some appreciable time thereafter. *Renishaw*, 158 F.3d at 1252, 48 U.S.P.Q.2d at 1123-24.

79 *Id.*, 48 U.S.P.Q.2d at 1124.

80 *Phillips Petroleum*, 157 F.3d 866, 867-68, 48 U.S.P.Q.2d (BNA) 1161, 1170-71 (Fed. Cir. 1998).

81 *Id.* at 870-72, 48 U.S.P.Q.2d at 1164-65 (discussing the affidavit of an expert witness and concluding that the ordinary meaning of the term "block copolymer" was disputed by those skilled in the art at the time the application was filed).

82 *Id.* at 870-76, 48 U.S.P.Q.2d at 1165-69.

83 *Id.* at 876, 48 U.S.P.Q.2d at 1169 (citing *Vitronics*, 90 F.3d at 1584, 39 U.S.P.Q.2d at 1578).

84 157 F.3d 887, 48 U.S.P.Q.2d (BNA) 1181 (Fed. Cir. 1998).

85 "The Federal Circuit has admonished that claims should preferably be interpreted without recourse to extrinsic evidence such as expert testimony, other than perhaps dictionaries or reference books, and that expert testimony should be received only for the purpose of educating the judge." *EMI Group*, 157 F.3d at 892, 48 U.S.P.Q.2d at 1184 (citing *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 983, 34 U.S.P.Q.2d (BNA) 1321, 1133 (Fed. Cir. 1995)). "In *Cybor* the court reaffirmed that extrinsic evidence including expert testimony is not to be relied upon for purpose of claim interpretation, other than to aid the judge in understanding the technology." *Id.* at 892, 48 U.S.P.Q.2d 1184 (citing *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454 n.3, 1455-56, 46 U.S.P.Q.2d (BNA) 1169, 1173 n.3, 1174 (Fed. Cir. 1998)).

86 *Id.* at 892, 48 U.S.P.Q.2d at 1185.

87 *Id.* at 893, 48 U.S.P.Q.2d at 1185. The 1.77:1 ratio does not appear in the specification, but was apparently derived "[w]ith the guidance of expert testimony" from a reference distinguished during prosecution. *Id.* at 894, 48 U.S.P.Q.2d at 1186-87.

88 *Phillips Petroleum*, 157 F.3d at 879, 48 U.S.P.Q.2d at 1171 (Newman, J., concurring).

89 161 F.3d 709, 48 U.S.P.Q.2d (BNA) 1911 (Fed. Cir. 1998) (opinion by Plager, panel consisting of Mayer, Plager and Clevenger).

90 *Id.* at 717-18, 48 U.S.P.Q.2d at 1918.

91 *Vitronics*, 90 F.3d at 1583, 39 U.S.P.Q.2d at 1577.

92 *Key Pharm.*, 161 F.3d at 716, 48 U.S.P.Q.2d at 1917.

93 159 F.3d 534, 48 U.S.P.Q.2d (BNA) 1321 (Fed. Cir. 1998) (opinion by Newman, panel consisting of Rich, Newman and Clevenger).

94 *Id.* at 540, 48 U.S.P.Q.2d at 1324.

95 *Id.*

96 157 F.3d 1325, 48 U.S.P.Q.2d (BNA) 1088 (Fed. Cir. 1998) (opinion by Plager, panel consisting of Plager, Clevenger and Gajarsa).

97 *Id.* at 1328-31, 48 U.S.P.Q.2d 1090-91.

98 *Id.* at 1336, 48 U.S.P.Q.2d 1096.

99 *Id.* at 1337, 48 U.S.P.Q.2d 1096.

100 *Id.*, 48 U.S.P.Q.2d 1096-97.

101 *Id.*, 48 U.S.P.Q.2d 1097 (citing *Tandon Corp. v. United States Int'l Trade Comm'n*, 831 F.2d 1017, 1023, 4 U.S.P.Q.2d (BNA) 1283, 1288 (Fed. Cir. 1987)).

102 160 F.3d 1350, 48 U.S.P.Q.2d (BNA) 1674 (Fed. Cir. 1998) (opinion by Lourie, panel consisting of Rich, Lourie and Rader).

103 *Id.* at 1352-54, 48 U.S.P.Q.2d 1675-76.

104 *Id.* at 1355-56, 48 U.S.P.Q.2d at 1678-79.

105 *Id.* at 1355, 48 U.S.P.Q.2d at 1678 (citing *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 117 S.Ct. 1040, 1051, 41 U.S.P.Q.2d (BNA) 1865, 1873 (1997)).

106 *Id.* at 1354, 48 U.S.P.Q.2d at 1677.

107 157 F.3d 1311, 48 U.S.P.Q.2d (BNA) 1099 (Fed. Cir. 1998) (opinion by Rich, panel consisting of Rich, Michel and Schall).

108 *Id.* at 1318-22, 48 U.S.P.Q.2d at 1104-06.

109 *Id.* at 1319, 48 U.S.P.Q.2d at 1104.

110 *Id.* (citing *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1584, 39 U.S.P.Q.2d (BNA) 1783, 1786-87 (Fed. Cir. 1996)).

111 *Id.*, 48 U.S.P.Q.2d at 1104-05 (quoting *Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1536, 19 U.S.P.Q.2d (BNA) 1367, 1369 (Fed. Cir. 1991)).

112 102 F.3d 524, 41 U.S.P.Q.2d (BNA) 1001 (Fed. Cir. 1996), *cert. denied*, 118 S. Ct. 56 (1997).

113 *Unidynamics*, 157 F.3d at 1319, 48 U.S.P.Q.2d at 1105 (citing *Cole*, 102 F.3d at 531, 41 U.S.P.Q.2d at 1006). In *Cole*, the limitation “perforation means extending from the leg band means to the waist band means through the outer impermeable layer means for removing the training brief in case of an accident by the user” was interpreted outside the ambit of § 112, paragraph 6.
Id.

114 *Id.*

115 *Mas-Hamilton*, 156 F.3d 1206, 1212-15, 48 U.S.P.Q.2d (BNA) 1010, 1015-1017 (Fed. Cir. 1998). In particular, claim 1 required, a “*lever operating means* for positively driving said lever toward said cam in response to continued dial rotation after said combination has been entered ...” *Id.* at 1212, 48 U.S.P.Q.2d at 1015. Claim 3 required, a “*substantially non-resilient lever moving element* for moving the lever from its disengaged position for engaging the protrusion of the lever with the cam surface on the cam wheel so that the rotation of the cam wheel thereafter in the given direction changes the locking mechanism from the locked condition to the unlocked condition ...” *Id.* at 1213, 48 U.S.P.Q.2d at 1016. Claims 34 and 43 required, a “*movable link member* for holding the lever out of engagement with the cam surface before entry of a combination and for releasing the lever after entry of the combination.” *Id.* at 1214, 48 U.S.P.Q.2d at 1017.

116 *Id.*, 48 U.S.P.Q.2d at 1016-17.

117 *Id.* at 1213, 48 U.S.P.Q.2d at 1016 (emphasis added).

118 161 F.3d 696, 48 U.S.P.Q.2d (BNA) 1880 (Fed. Cir. 1998) (opinion by Lourie, panel consisting of Rich, Michel and Lourie).

119 *Id.* at 700, 48 U.S.P.Q.2d at 1883-84.

120 *Id.*, 48 U.S.P.Q.2d at 1884.

121 *Id.* at 704-05, 48 U.S.P.Q.2d at 1887-88.

122 *Id.* at 705, 48 U.S.P.Q.2d at 1888.

123 *Id.* at 705-06, 48 U.S.P.Q.2d at 1888.

124 156 F.3d 1199, 48 U.S.P.Q.2d (BNA) 1019 (Fed. Cir. 1998) (opinion by Michel, panel consisting of Michel, Archer and Schall), *opinion recalled and superceded as*, 161 F.3d 688, 48 U.S.P.Q.2d (BNA) 1610 (Fed. Cir. 1998) (vacating the district court’s finding of induced infringement for failing to establish an alter ego relationship between a business affiliate and the alleged inducer and remanding as to that issue, but leaving other aspects of the opinion unaffected).

125 *Insituform*, 156 F.3d at 1204-06, 48 U.S.P.Q.2d at 1024-25.

126 *Id.* at 1203-04, 48 U.S.P.Q.2d at 1023.

127 *Id.* at 1204, 48 U.S.P.Q.2d at 1024.

128 *Id.* at 1205, 48 U.S.P.Q.2d at 1024.

129 *Id.*

130 *Id.*

131 160 F.3d 1373, 48 U.S.P.Q.2d (BNA) 1773 (Fed. Cir. 1998) (opinion by Gajarsa, panel consisting of Newman, Bryson and Gajarsa).

132 Uruguay Round Agreements Act, Pub. L. No. 103-465, § 533(a)(1)(A), 108 Stat. 4809, 4988 (1994).

133 35 U.S.C. § 271(i) (1994).

134 45 F.3d 1541, 1544, 33 U.S.P.Q.2d (BNA) 1505, 1507 (Fed. Cir. 1995).

135 *3D Sys.*, 160 F.3d at 1378-79, 48 U.S.P.Q.2d at 1777.

136 *Id.* at 1379 n.4, 48 U.S.P.Q.2d at 1777 n.4.

137 *Id.*, 48 U.S.P.Q.2d at 1777.

138 *Id.*

139 157 F.3d 1311, 48 U.S.P.Q.2d (BNA) 1099 (Fed. Cir. 1998) (opinion by Rich, panel consisting of Rich, Michel and Schall).

140 *Id.* at 1324, 48 U.S.P.Q.2d at 1107.

141 *Gorham Mfg. Co. v. White*, 81 U.S. 511 (1871). Under the *Gorham* test, the fact finder must determine “if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.” *Unidynamics*, 157 F.3d at 1323, 48 U.S.P.Q.2d at 1107 (quoting *Gorham*, 81 U.S. at 528).

142 *Unidynamics*, 157 F.3d at 1323, 48 U.S.P.Q.2d at 1107.

143 *Id.* (citing *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 825, 23 U.S.P.Q.2d (BNA) 1426, 1434 (Fed. Cir. 1992), *abrogation recognized by*, *Hoechst Celanese Corp. v. BP Chems., Ltd*, 78 F.3d 1575, 1578, 38 U.S.P.Q.2d (BNA) 1126, 1128 (Fed. Cir.

1996)).

144 *Id.*

145 *Id.* at 1324, 48 U.S.P.Q.2d at 1107-08.

146 *Id.* at 1325, 48 U.S.P.Q.2d at 1108.

147 162 F.3d 1113, 48 U.S.P.Q.2d (BNA) 1767 (Fed. Cir. 1998) (opinion by Newman, panel consisting of Newman, Plager and Schall).

148 *Id.* at 1121, 48 U.S.P.Q.2d at 1772.

149 *Id.* at 1116, 48 U.S.P.Q.2d at 1769.

150 *Id.*

151 *Id.*

152 *Id.* at 1118, 48 U.S.P.Q.2d at 1770.

153 *Id.*

154 *Id.*

155 156 F.3d 1351, 48 U.S.P.Q.2d (BNA) 1351 (Fed. Cir. 1998) (opinion by Bryson, panel consisting of Michel, Plager and Bryson).

156 *Id.* at 1357-58, 48 U.S.P.Q.2d at 1356-57.

157 *Id.* at 1355, 48 U.S.P.Q.2d at 1354.

158 156 F.3d 1182, 48 U.S.P.Q.2d (BNA) 1001 (Fed. Cir. 1998) (opinion by Gajarsa, panel consisting of Newman, Schall and Gajarsa).

159 *Id.* 156 F.3d at 1191, 48 U.S.P.Q.2d at 1009.

160 *Id.*

161 *Id.* at 1185-86, 1191, 48 U.S.P.Q.2d at 1004, 1009.

162 *Id.* at 1191, 48 U.S.P.Q.2d at 1009.

163 *Id.*

164 *Id.* at 1192, 48 U.S.P.Q.2d at 1009.

165 *Id.* at 1192-93, 48 U.S.P.Q.2d at 1010.

166 *Id.* at 1191, 48 U.S.P.Q.2d at 1009.

167 21 F. Supp.2d 366, 48 U.S.P.Q.2d (BNA) 1741 (S.D.N.Y. 1998).

168 *Id.* 21 F. Supp.2d at 375, 48 U.S.P.Q.2d at 1748.

169 26 F. Supp.2d 505, 48 U.S.P.Q.2d (BNA) 1838 (W.D.N.Y. 1998).

170 *Id.* at 512, 48 U.S.P.Q.2d at 1843-44.

171 161 F.3d 681, 48 U.S.P.Q.2d (BNA) 1934 (Fed. Cir. 1998) (opinion by Rader, panel consisting of Plager, Rader and Bryson).

172 *Id.* at 686, 48 U.S.P.Q.2d at 1938.

173 *Id.* at 686-87, 48 U.S.P.Q.2d at 1939.

174 *Id.* at 687, 48 U.S.P.Q.2d at 1939.

175 160 F.3d 1373, 48 U.S.P.Q.2d (BNA) 1773 (Fed. Cir. 1998) (opinion by Gajarsa, panel consisting of Newman, Bryson and Gajarsa).

176 153 F.3d 1318, 47 U.S.P.Q.2d (BNA) 1769 (Fed. Cir. 1998).

177 *3D Sys.*, 160 F.3d at 1377 n.2, 48 U.S.P.Q.2d at 1775 n.2.

178 159 F.3d 1337, 48 U.S.P.Q.2d (BNA) 1055 (Fed. Cir. 1998) (opinion by Bryson, panel consisting of Newman, Skelton and Bryson).

179 *Id.* at 1338, 48 U.S.P.Q.2d at 1055.

180 *Id.* at 1339, 48 U.S.P.Q.2d at 1056.

181 *Id.* at 1338, 48 U.S.P.Q.2d at 1056.

182 *Id.*

183 *Id.* at 1338-39, 48 U.S.P.Q.2d at 1056 (citations omitted).

184 *Id.* at 1339, 48 U.S.P.Q.2d at 1056.

185 *Id.*

186 *Id.* at 1340, 48 U.S.P.Q.2d at 1057.

187 *Id.*

188 *Id.*

189 *Id.*

190 *Id.*, 48 U.S.P.Q.2d at 1058.

191 48 U.S.P.Q.2d (BNA) 1861 (S.D. Cal. 1998).

192 *Id.* at 1862.

193 161 F.3d 1347, 48 U.S.P.Q.2d (BNA) 1865 (Fed. Cir. 1998) (opinion by Newman, panel consisting of Rich, Newman and Michel).

194 *Id.* at 1357, 48 U.S.P.Q.2d at 1873.

195 161 F.3d 709, 48 U.S.P.Q.2d (BNA) 1911 (Fed. Cir. 1998) (opinion by Plager, panel consisting of Mayer, Plager and Clevenger).

196 *Id.* at 715, 48 U.S.P.Q.2d at 1915.

197 *Id.* at 714, 48 U.S.P.Q.2d at 1914.

198 *Id.* at 715, 48 U.S.P.Q.2d at 1915.

199 *Id.* at 715-16, 48 U.S.P.Q.2d at 1916.

200 156 F.3d 1182, 48 U.S.P.Q.2d (BNA) 1001 (Fed. Cir. 1998) (opinion by Gajarsa, panel consisting of Newman, Schall and Gajarsa).

201 *Id.* at 1189, 48 U.S.P.Q.2d at 1007.

202 *Id.*

203 *Id.* at 1188, 48 U.S.P.Q.2d at 1006 (citing *Texas Instruments, Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1567, 39 U.S.P.Q.2d (BNA) 1492, 1499 (Fed. Cir. 1996)).

204 *Id.*

205 *Id.* at 1188-89, 48 U.S.P.Q.2d at 1006-07 (footnotes omitted).

206 *Id.*

207 159 F.3d 534, 48 U.S.P.Q.2d (BNA) 1321 (Fed. Cir. 1998) (opinion by Newman, panel consisting of Rich, Newman and Clevenger).

208 *Id.* at 550-51, 48 U.S.P.Q.2d at 1333.

209 *Id.* at 551, 48 U.S.P.Q.2d at 1334.