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 Recent Developments

RECENT DEVELOPMENTS IN PATENT LAW

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I. Introduction

This article contains recent developments from the Federal Circuit Court of Appeals in patent law over the past year (2000). For brevity and maximum usefulness to the practitioner, this article limits its discussion to recent Federal Circuit case law that presents a novel or interesting twist in patent law.

Without doubt, the most significant opinion from the Federal Circuit the past year was the en banc decision of Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co. As will be discussed in greater detail below, the Federal Circuit decided four issues, the most significant of which is that a patentee is not entitled to rely upon the doctrine of equivalents to prove infringement of a particular element, if that element has been narrowed for any purposes related to patentability during the prosecution history. This was a fairly dramatic change in the law, which had generally held that the range of equivalents after a narrowing amendment was dependent upon the nature of the invention, the prior art, and whether the prosecution history indicated that subject matter had been clearly relinquished. If this ruling is not reversed or modified by the Supreme Court, several practical effects may result, as discussed later.

II. Validity

A. Patentable Subject Matter

In Pioneer Hi-Bred International v. J.E.M. AG Supply, the defendant in a patent infringement case argued that the plaintiff’s patent was invalid because the subject matter was not patentable under 35 U.S.C. § 101. The plaintiff obtained a patent on a sexually reproduced, i.e., a seed-grown, plant. In attempting to invalidate the plaintiff’s patent, the defendant argued that Congress did not intend for seed-grown plants to be included as patentable subject matter under § 101, and that this is evidenced by the adoption of the Plant Variety Protection Act of 1970 (PVCA). The defendant argued that § 101 should not “be interpreted as available to seed-grown plants, when Congress believed otherwise.” The Federal Circuit disagreed and held that seed-grown plants were patentable subject matter under 35 U.S.C. § 101, stating that the PVCA did not remove seed grown plants from patentable subject matter under § 101. In the end, the court stayed truthful to the Diamond v. Chakrabarty statutory interpretation that “Congress intended statutory subject matter to include anything under the sun that is made by man...”

B. Obviousness

In Ruiz v. A. B. Chance Co., the Federal Circuit held that from the record or opinion of the district court, it must be clear that the district court applied the obviousness test articulated in Graham v. John Deere Co. and made the necessary Graham factual findings. The district court must make fact findings on the following four Graham criteria: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the difference in the claim invention and the prior art; and (4) secondary considerations of nonobviousness, including commercial success, long-felt but unresolved need, failure of
In Ruiz, the Federal Circuit reversed the district court’s finding that the patent in question was invalid for obviousness because it was not clear from the district court’s opinion that the district court applied the Graham test and made the Graham factual findings. The district court’s opinion did not mention Graham, nor did it provide an analysis of what was disclosed, the prior art, or the testimony presented by the parties. The court noted that the Graham factual findings are especially important to prevent the occasional tendency to look “to the tempting but forbidden zone of hindsight.” Although the court did not remand the case solely for not including any one particular factual finding in its legal opinion, the Federal Circuit considered the district court’s failure to include the Graham factual findings in its opinion “as evidence that Graham was not in fact applied.” Therefore, the Federal Circuit remanded the case back to the district court to make the Graham factual findings.

C. Best Mode

In Eli Lilly & Co. v. Barr Laboratories, Inc., the Federal Circuit held that a patentee did not violate the best mode requirement by failing to disclose the preferred method of making a commercially available starting material for making the claimed invention. In Eli Lilly, the patent owner had patents on a particular chemical and a method of using that chemical. The patentee disclosed his preferred method of making the patented chemical in both patents as originating from a commercially available starting chemical. However, the patentee did not disclose his preferred method of making the commercially available starting chemical. Because the starting chemical was expensive, the patentee was forced to synthesize his own starting material from a process that would be adequate to produce enough of the starting chemical at a reasonable price. After research and experimentation, the patentee developed his own method of preparing the starting chemical that was “real cheap” because it could be produced from other chemicals that were available “in tank car quantities.” The Federal Circuit noted that “if the best mode for carrying out a claimed invention involves novel subject matter, then an inventor must disclose a method for obtaining that subject matter even if it is unclaimed.” Since the patentee did not claim the starting material and the starting material was commercially available, the Federal Circuit held that the patentee did not violate the best mode requirement. The court stated that rather than establishing a best mode violation, the evidence established production concerns such as cost, volume, and manufacturing details.

In Eli Lilly, the defendant also argued that the patent was invalid for failing to disclose the recrystallization solvent that the patentee used to purify the patented chemical. However, the patents did not claim a process for recrystallization. The patents disclosed that the best mode of making the claimed chemical was through recrystallization, but the patents did not state what solvent should be used for performing the recrystallization. The Federal Circuit again held that the patentee did not violate the best mode requirement because the patent did not claim the process for recrystallization or the recrystallization solvent. The court noted that the evidence showed that choosing a solvent for recrystallization was a routine detail in the art. The court reasoned that the best mode requirement “is a two way street” and that the patents in the lawsuit did not grant the patentee the right to exclude others from practicing the patentee’s method of recrystallization.

*434 D. 35 U.S.C. § 112 P 2 Requirement--“What the Applicant Regards as His Invention”

In Solomon v. Kimberly-Clark Corp., Solomon sued Kimberly-Clark for infringing its patent on disposable panty liners. The defendant defended on the ground that the patent was invalid for failing to claim the subject matter that the inventor regarded as her invention. The defendant asserted that during the inventor’s deposition, the inventor defined her invention differently than was claimed in her patent application. The district court held the patent invalid for failing to claim the subject matter that the inventor regarded as her invention. The Federal Circuit reversed the district court.

The court noted that a patentee must comply with the two requirements of 35 U.S.C. § 112 second paragraph: (1) the applicant must claim what he regards as his invention, and (2) the applicant must particularly point out and distinctly claim the subject matter that the applicant regards as his invention. The court then held that the determination of whether a claim recites the subject matter that the applicant regards as his invention is a question of law for the court, which the Federal Circuit reviews on appeal de novo. The court reasoned that the right to decide all 35 U.S.C. § 112 second paragraphs issues stems from the court’s power to construe claims.
The Federal Circuit noted that during prosecution, a claim’s compliance with both elements of § 112, second paragraph “may be analyzed by consideration of evidence beyond the specification, including an inventor’s statements to the Patent and Trademark Office.” However, the Federal Circuit held that “[a] more limited range of evidence should be considered in evaluating validity as opposed to patentability under either portion of § 112, paragraph 2, because the language of issued claims is generally fixed . . . .” Further, the court held that both § 112, second paragraph elements are objective inquiries to be decided in view of the written description. Therefore, the Federal Circuit concluded that “inventor *435 testimony, obtained in the context of litigation, should not be used to invalidate issued claims under § 112, paragraph 2.”

E. 35 U.S.C. § 102(f)—Invalid for Wrong Inventor

In Solomon v. Kimberly-Clark Corp., the Federal Circuit also rejected an argument by defendant’s patent counsel that the plaintiff’s patent was invalid under 35 U.S.C. § 102(f) for not listing the correct inventorship in the patent. The defendant asserted that during the inventor’s deposition, the inventor defined her invention differently than was claimed in her patent application. Therefore, the defendant alleged the patent was invalid for failing to name the correct inventorship.

Although the facts are sparse in the court’s opinion, the defendant seemed to allege that the plaintiff’s patent attorney might have contributed novel subject matter to the invention in the process of drafting the patent application. With little analysis, the court held that “to assert that proper performance of the attorney’s role is a ground for invalidating the patent constitutes a failure to understand the proper role of the patent attorney.” Therefore, the Federal Circuit held that 35 U.S.C. § 102(f) did not invalidate the patent.

F. Inequitable Conduct

Although inequitable conduct is discussed in the “Validity” section of this paper, technically a patent is held unenforceable for inequitable conduct, rather being invalid.


In Semiconductor Energy Laboratory Co. v. Samsung Electronics Co., the defendant defended against a patent infringement suit on the ground that the patentee had performed inequitable conduct on the Patent and Trademark Office *436 (PTO). In the patent application’s Information Disclosure Statement, the patentee disclosed a prior art Japanese patent application to the PTO by providing the examiner with an untranslated copy of the prior art patent application accompanied by an explanation of its relevance and an existing one-page partial English translation from a prior unrelated patent application. However, the patentee’s explanation of the Japanese application’s relevance that accompanied the prior art Japanese patent application did not discuss an important point that was relevant to the patentee’s patent application.

The patentee argued that he subjectively believed that the Japanese patent was only valuable for what he disclosed, and, therefore, he did have the intent required for inequitable conduct. The defendant argued that the patentee had committed inequitable conduct by misleading the PTO. The patentee replied that he had technically complied with all the PTO rules.

The Federal Circuit began by laying out the black letter law of inequitable conduct. Interestingly, when discussing the materiality component for inequitable conduct, the court quoted the new Rule 56 for what information is material to patentability.

The Federal Circuit affirmed the district court’s finding that the record as a whole reflected a clear pattern of initial disclosure followed by incremental disclosure only when compelled by the circumstances to do so, followed by mischaracterization. The Federal Circuit noted that the district court had found that the patentee, a solid state physicist whose native language is Japanese, understood the materiality of the prior art reference. Further, the Federal Circuit affirmed the district court finding of intent because the patentee knew that a more complete translation or explanation of the Japanese patent application would decrease the likelihood that his patent would be issued. Interesting facts in the record supported the district court’s conclusion. One of the facts was that Gerard Ferguson, the patentee’s patent attorney, prosecuted all of the patentee’s patent applications except during a brief period when the patentee revoked his power of attorney because Mr. Ferguson sought to submit prior art references to the PTO.
In The Li Second Family Partnership v. Toshiba Corp., the prosecution of the patent application committed inequitable conduct by misrepresenting the inventorship per se was incorrect in the issued patent, but whether misinformation communicated to the PTO was material in inventorship during prosecution.

The court held that irrespective of whether the inventorship was correct as issued, the intentional misrepresentation of inventorship during prosecution before the PTO was material because there is a requirement for obtaining a patent, inventorship is material.

First, the Federal Circuit accepted the district court’s factual finding as not clearly erroneous that the defendant in at least five specific instances committed acts of intentional falsehoods, misrepresentations, and omissions concerning the inventorship of the allegedly infringed patent during prosecution before the PTO.

Pharmacia alleged that PerSeptive committed inequitable conduct by intentionally misrepresenting the inventorship of the allegedly infringed patent during prosecution of the patent application.

PerSeptive argued that its failure to disclose the possible co-inventors was unintentional. In the alternative, PerSeptive seemed to argue that even if it intentionally failed to disclose possible co-inventors at some points during prosecution of the patent, there could be no inequitable conduct because when the patent issued, the patent had the correct inventorship. PerSeptive argued that after the supposed inequitable conduct took place, PerSeptive narrowed the claims, thus making any inequitable conduct immaterial.

First, the Federal Circuit accepted the district court’s factual finding as not clearly erroneous that the defendant in at least five specific instances committed acts of “intentional falsehoods, misrepresentations, and omissions to the PTO” concerning the inventorship of the allegedly infringed patent. The court then turned to issue of materiality, noting that “[a]s a critical requirement for obtaining a patent, inventorship is material.” Furthermore, the court found that misrepresentations or omissions concerning inventorship are material because there is “a substantial likelihood that a reasonable examiner would consider it important in deciding whether to allow the application to issue as a patent.”

The court held that irrespective of whether the inventorship was correct as issued, the intentional misrepresentation of inventorship during prosecution amounted to inequitable conduct. The court reasoned that the issue was not whether inventorship per se was incorrect in the issued patent, but whether misinformation communicated to the PTO was material and intentionally communicated. Therefore, the Federal Circuit affirmed the district court’s finding that PerSeptive committed inequitable conduct by misrepresenting the inventorship or failing to disclose possible co-inventors during the prosecution of the patent application.

2. PerSeptive Biosystems, Inc. v. Pharmacia Biotech, Inc.

In PerSeptive Biosystems, Inc. v. Pharmacia Biotech, Inc., PerSeptive sued Pharmacia for patent infringement. Pharmacal alleged that PerSeptive had committed inequitable conduct during prosecution of the patent application.

Pharmacia argued that PerSeptive committed inequitable conduct by intentionally misrepresenting the inventorship of the allegedly infringed patent during prosecution before the PTO. In particular, Pharmacia alleged that PerSeptive intentionally failed to disclose two possible co-inventors because the possible co-inventors were not employed by PerSeptive.

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3. The Li Second Family Partnership v. Toshiba Corp.

In The Li Second Family Partnership v. Toshiba Corp., Li alleged that Toshiba infringed its patented process. Toshiba
defended on the ground that Li’s ‘800 patent was unenforceable because Li committed inequitable conduct during prosecution of the ‘102 patent application that issued as the ‘800 patent." In particular, Toshiba alleged that Li failed to disclose a ruling of the Board of Patent Appeals and Interferences (Board) concerning a sister application (‘758 application) that claimed priority from the same parent application (‘300 application) as the ‘800 patent."

During prosecution, the examiner rejected the ‘102 application over certain prior art. In response to the examiner’s rejection, Li claimed priority from a grandparent application. However, Li failed to disclose to the examiner that, in the sister application, the Board had ruled that the written description of the parent ‘300 application did not support the subject matter claimed in the ‘102 application, which issued into the allegedly infringed ‘800 patent. Therefore, the ruling of the Board in the sister application was directly relevant for determining the date of priority for the allegedly infringed patent.

When Li sued Toshiba, the issue was whether Li had committed inequitable conduct by not disclosing the Board’s ruling in the sister application. The *Federal Circuit held that Li had committed inequitable conduct. The court noted that the only reason the examiner allowed the ‘102 application was because of Li’s argument that the ‘102 application could properly claim priority from the grandparent application. The court concluded that “an applicant’s misrepresentation that he is entitled to the benefit of an earlier filing date is highly material.”

Li also argued that it had not committed inequitable conduct, because it orally briefed the examiner of the Board’s ruling in the sister application. During trial, Li offered the testimony of the patent attorney who prosecuted the ‘102 patent application before the examiner, to support this claim. However, the Federal Circuit rejected this testimony, noting that the PTO requires all business before it to be conducted, or at least documented, in writing. Further, the court stated that under PTO rules, “[i]t is the responsibility of the applicant to ensure that the substance of an interview with the examiner is included in the written record of the application, unless the examiner indicates that he will do so.” Further, the Federal Circuit affirmed the district court’s finding that the attorney’s testimony was not credible.

Li also attempted to argue that the references cited by the examiner during prosecution were not material because they would not have led to a valid rejection. The Federal Circuit rejected that argument, holding that the “[i]nformation concealed from the PTO may be material even though it would not invalidate the patent.” Finally, the court held that “the test for materiality is whether a reasonable examiner would have considered the information important, not whether the information would conclusively decide the issue of patentability.”

A. Offer to Sell--35 U.S.C. § 271(a)

35 U.S.C. § 271(a) states that whoever “makes, uses, offers to sell or sells any patented invention, within the United States . . . infringes the patent.” In Rotec Industries, Inc. v. Mitsubishi International Corp., Rotec alleged that the defendants made an offer in the United States to sell Rotec’s patented invention. It was undisputed that certain acts happened in the United States, but what was disputed was whether those acts constituted an offer for sale within the meaning of 35 U.S.C. § 271(a). Therefore, the issue was whether there was an offer within the United States to sell the patented invention.

In Rotec, the Federal Circuit stated that the phrase “offer to sell” should be interpreted according to its ordinary meaning in contract law. However, the court did not feel that state contract law should apply; instead, the court developed federal common law to define “offer to sell.” Under federal common law, the court held, “offer to sell” would be interpreted “according to its ordinary meaning in contract law, as revealed by traditional sources of authority.” As for traditional sources of authority, the court quoted the Second Restatement of Contracts to define an offer as a “manifestation of willingness to enter into a bargain, so made as to justify another person in understanding that his assent to that bargain is invited and will conclude it.” In particular, the court held that an “offer to sell” required at minimum a communication with a third party. Under the facts of the case, there was no admissible evidence that an offer was communicated in or from the
United States. Therefore, the Federal Circuit affirmed the district court’s dismissal of the case. 

In the course of its opinion, the court also held that an offer under 35 U.S.C. § 271(a) had to be of the entire invention as claimed in the patent. The court analyzed DeepSouth Packing Co. v. Laitram Corp. and concluded that “as to claims brought under § 271(a), Deepsouth remains good law: one may not be held liable under § 271(a) for ‘making’ or ‘selling’ less than a completed invention.” The court reasoned that there was no reason why an offer to sell under 35 U.S.C. § 271(a) should be different. Therefore, an offer to sell has to be of the “entire invention as claimed in the patent.”


In a case alleging infringement of a patented process based on the importation, sale, offer for sale, or use of a product which is made from the process, 35 U.S.C. § 295 shifts the burden of proof to an alleged infringer when the patentee establishes two elements to the trial judge: “1) a substantial likelihood exists that the product was made by the patented process, and 2) the plaintiff has made a reasonable effort to determine the process actually used in the production of the product and was unable so to determine.”

In Nutrinova Nutrition v. International Trade Commission, the issue before the Federal Circuit was when during a trial does the trial judge have to decide whether a patentee has proved the two elements of § 295 so that the burden shifts to the alleged infringer to disprove infringement. In Nutrinova, the plaintiff argued that the judge should have decided the motion during the discovery process. However, the Federal Circuit held that a trial judge has discretion when to decide a motion under § 295, stating that when to decide a § 295 motion varies with the facts and circumstances of every case. Further, the court analogized when to decide a § 295 motion with when to decide a motion for summary judgment: both are procedural matters that are within the discretion of the trial judge.

C. Doctrine of Equivalents--Prosecution History Estoppel

In Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., the Federal Circuit decided, en banc, the four following significant issues on the issues of prosecution history and the doctrine of equivalents. First, narrowing amendments made for any purpose related to statutory reasons of patentability triggers prosecution history estoppel. Therefore, prosecution history estoppel is triggered not only by narrowing amendments made in connection with § 102 and 103 amendments, but also for amendments related to § 112. 

Second, voluntary amendments which narrow claims trigger prosecution history estoppel. Therefore, prosecution history is not limited to narrowing amendments made in response to a rejection by an examiner for a stated reason. 

Third, no range of equivalents is available for an element that has been narrowed during prosecution. This was the major issue. The Federal Circuit reviewed prior cases and concluded that there were two lines of authority: one in which an absolute bar was applied; and a second in which a flexible bar was applied. Recognizing that the second line of authority constituted the greater body of law, eight out of twelve of the Federal Circuit judges (Michel, Linn, Rader, and Newman, J.J., dissenting) nevertheless concluded that the better approach was to apply an absolute bar against reliance on the doctrine of equivalents. Overriding considerations of the majority included the notice function of claims, certainty to the public, and enforcing the disclaimer effect of a narrowing claim amendment.

Fourth, if “no explanation” is established for an amendment, no range of equivalents is available for the amended element. There was no disagreement on this issue, and the decision on this point actually confirmed a ruling made in Sextant Avionique S.A. v. Anaolog Devices, Inc. The rationale is that, when balancing the considerations of the public and the need for certainty in claim interpretation, the patentee cannot benefit from any uncertainty created in the prosecution history.

The Festo decision has several practical effects. First, estoppel will no longer be tailored to the practical aspects of the case. In other words, neither the closeness of the prior art nor the pioneering nature of the invention will be considered on the issues of prosecution history estoppel and the doctrine of equivalents. Most practitioners appear to be in disagreement with this result. Yet, unless the Supreme Court takes the case and reverses this issue, this will be the result.

Second, competitors may review the prosecution history, find an element that has been narrowed, regardless of how
insignificant the element is to the invention, and design around that element.

Third, seemingly greater effort should be put into the prosecution of a patent. This might include taking more appeals than in the past. Previously, practitioners would sometimes negotiate with an examiner to obtain an allowance, secure in the belief that the doctrine of equivalents could be relied upon if necessary. Now, that may not be the case. If the inventor firmly believes that an element should not be narrowed, but the examiner is steadfast in her rejection, there may be no alternative but to appeal the case in view of the Festo decision.

Fourth, will practitioners find ways to avoid the Festo effect? One approach might be to draft claims with a few, very narrow elements. Any element not narrowed during prosecution would not be subject to the absolute bar and would qualify for the application of the doctrine of equivalents. Without doubt, much testing of the application and limits of the Festo effect will be had in court as well as in prosecution practice.

IV. Litigation

A. Attorney-Client Privilege

In In re Spalding Sports Worldwide, Inc., the issue was whether the attorney-client privilege applied to an invention record submitted by inventors to their employer’s corporate patent counsel. In In re Spalding, the patentee sued the defendant for patent infringement, and the defendant defended on inequitable conduct. During discovery, the defendant sought to discover the patentee’s invention record that he sent to his employer’s corporate legal department, but the patentee claimed that the document was privileged. According to the patentee’s corporate counsel, it was the policy of patent counsel to refer to the invention record when making patentability determinations. The district court directed the patentee to produce the invention record to the defendant. In order to avoid producing the invention record, the patentee sought a writ of mandamus from the Federal Circuit directing the district court to vacate the order. The Federal Circuit granted mandamus and held that the invention record was a privileged communication because it was submitted to counsel for obtaining legal advice.

In trying to obtain evidence for its inequitable conduct defense, the defendant argued that even if the court found the invention record to be privileged, the portion of the invention record that listed prior art should be disclosed because it did not seek legal advice. However, the court stated that it did “not consider it necessary to dissect the document to separately evaluate each of the components. It is enough that the overall tenor of the document indicates that it is a request for legal advice or services.” The court concluded that, to the extent that the patentee’s invention record listed prior art or technical information, the inclusion of such information does not render the document discoverable, because requesting “legal advice on patentability or for legal services in preparing a patent application necessarily require[s] evaluation of technical information such as prior art.” Therefore, the Federal Circuit held the invention record was privileged “in its entirety.” This holding is significant, because it could limit the common discovery procedure of simply redacting the privileged material from documents produced in discovery.

In a footnote, the Federal Circuit stated that it “was aware of several district court opinions that have held that technical information communicated to an attorney, and documents relating to the prosecution of patent applications are non-privileged, based on the rationale that the attorney is acting as a mere ‘conduit’ between the client and the PTO.” The court distinguished those cases on the grounds that they “did not deal specifically with invention records” and that they were not binding on the Federal Circuit. The court concluded that “the better rule is the one articulated in this case.” Interestingly, the Federal Circuit chose to distinguish, rather than overrule, the cases that label patent prosecution attorneys as “mere conduits” of the PTO. Therefore, the Federal Circuit left itself room for future decisions to find that factual communications concerning patent prosecution are non-privileged communications.

The court also held that simply proving inequitable conduct did not invoke the crime-fraud exception to the attorney-client privilege. The court reasoned that both common law fraud and Walker Process fraud are different than inequitable conduct. The court noted that common law fraud requires that five indispensable elements be proven. In addition, the court noted that “inequitable conduct in fact is a lesser offense than common law fraud, and includes types of conduct less serious than ‘knowing and willful’ fraud.” The court also noted that inequitable conduct is a broader than Walker Process Fraud. Further, Walker Process fraud is more difficult to prove.
B. Federal Rule of Civil Procedure 11—Sanctions

1. View Engineering, Inc. v. Robotic Vision Systems

In View Engineering, Inc. v. Robotic Vision Systems, View Engineering (“View”) sued Robotic Vision Systems (“Robotic”) for declaratory judgment that Robotic’s patents were not infringed by View’s products or, in the alternative, that Robotic’s patents were invalid. Before filing its lawsuit, Robotic asked View to provide it with the manufacturing information of the accused device, but View refused. After approximately four months, Robotic counterclaimed, alleging that View’s products infringed eight of Robotic’s patents. At the time the counterclaims were filed, the only basis for Robotic’s belief that the patents were infringed was based on Robotic’s knowledge of the art and publicly available information, such as View’s advertising and statements View made to its customers. Robotic did not investigate View’s allegedly infringing device, because the machine would cost several hundred dollars to purchase and it believed that View would not sell it one. After Robotic filed its counterclaim, View moved for sanctions against Robotic under Federal Rule of Civil Procedure 11 (Rule 11).

The Federal Circuit affirmed the district court’s finding that Robotic’s law firm had violated Rule 11. The court held that, at a bare minimum, a party must apply the claims of each and every patent that is alleged to be infringed “to an accused device and conclude that there is a reasonable basis for a finding of infringement of at least one claim of each patent so asserted.” Further, the court stated that View was not required to allow Robotic pre-litigation discovery to inspect the allegedly infringing device. The court stated that if challenged, a patent-owner must be prepared to demonstrate to both the court and the alleged infringer exactly why it believed it had a reasonable chance of proving infringement. Further, the court stated that “[f]ailure to do so should ordinarily result in the district court expressing its broad discretion in favor of Rule 11 sanctions, at least in the absence of a sound excuse or considerable mitigating circumstances.”

Robotic seemed to have a good argument to avoid Rule 11 sanctions because Robotic’s pre-trial investigation seemed reasonable considering what information was available to it before filing a counterclaim. However, the Federal Circuit held that before filing a counterclaim, the patentee should have performed a reasonable investigation into the factual basis to support such a claim. Further, the Federal Circuit did not find that the district court abused its discretion in awarding damages. In fact, the Federal Circuit commended the district judge for a “careful and thoughtful opinion.”

*448 2. Hoffman-La Roche, Inc. v. Invamed, Inc.

In Hoffman-La Roche, Inc. v. Invamed, Inc., Hoffman-La Roche (“Roche”) sued Torpharm and other generic drug manufacturers for infringing its patent on a process for manufacturing a drug. Before suing, Roche learned that Torpharm had filed a drug application covering a generic form of a drug on which Roche had a patent. Roche attempted to ascertain the process that Torpharm used to manufacture the drug, but that was impossible from studying the drug application. Roche asked Torpharm to disclose its manufacturing process, but Torpharm refused to do so because of a confidentiality agreement with another company. Torpharm did provide Roche with samples of its generic drug, but it could not be determined from the drug what processes had been used to manufacture the drug. Subsequently, Roche sued Torpharm for patent infringement.

At the outset of the suit, Roche agreed to receive information about the manufacturing process in confidence and to drop the suit if there was no infringement. Thereafter, Roche received the manufacturing information, determined that Torpharm was not infringing its patent, and dismissed the suit. Torpharm followed by making a Rule 11 motion for sanctions. On appeal, the Federal Circuit held that Roche did not violate Rule 11, because Roche did everything it could do to determine whether Torpharm infringed its patent. The court stated “[i]f Torpharm initially had told them, under a confidentiality agreement, the process used to manufacture the drug—as it subsequently did—it could have avoided this litigation and the expenses incurred in defending it.” This was an interesting statement from the Federal Circuit, because it seems to conflict with the reasoning underlying View Engineering, in which the Federal Circuit did not seem to weigh the denial of pre-litigation discovery by the alleged infringer in assessing whether to award Rule 11 sanctions. It should be noted that Hoffman-La Roche was decided only six days before View Engineering. Therefore, neither decision discussed the other. In conclusion, the Federal Circuit affirmed the district court’s conclusion that Roche’s “initial claim of infringement was not unreasonable in light of the available information at the time of filing.”

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In Automated Business Companies v. NEC America, Inc., Automated Business Companies (ABC) brought a baseless patent suit against NEC America, Inc. After the district court dismissed the lawsuit, NEC America moved for sanctions. The district court deemed the case exceptional and directed NEC America to submit documentation for determining an award for attorney fees. NEC America submitted documentation “that included invoices generated by Sidley & Austin, lead counsel for the NEC America, and McLean & Sanders, local counsel for NEC America.”

However, the documentation included invoices to NEC Corp. for work done defending the lawsuit. NEC Corp. is the parent corporation of NEC USA, Inc., which is the parent of NEC America. NEC America was the only corporation named as infringer in the ABC’s complaint. The district court awarded attorney fees that included the invoices directed to NEC Corp. in the calculation.

ABC appealed, arguing that the damage award should not have included invoices directed to NEC Corp., NEC America’s grandparent corporation. The Federal Circuit disagreed, holding that “[t]he terms under which NEC America arranged for payment of at least some of its legal fees with NEC Corp.” was not relevant. The court stated that in a case where a company’s “grandparent company assisted in the defense of an infringement action properly deemed exceptional and assumed some of the legal expenses, the company is no less due an award of attorney fees for the total amount it would have paid had it defended against the action on its own.”

D. Ownership of Patents

In Banks v. Unisys Corp., Unisys hired Banks to work on its Image Camera Project, which was engaged in the development of an image camera for use with a high-speed document sorter. Upon employment, Unisys requested Banks to sign an agreement that assigned his interest in any inventions that he developed during his employment with Unisys. Courts have held that an employee's refusal to assign his inventive rights to his employer has no legal significance.

On his own initiative and on his own time, Banks “tested the camera to confirm some problems he had detected, and recommended a redesign of the camera’s optics.” As a result of Banks’ efforts, the project developed an improved design that produced an acceptable image in the camera. Unisys incorporated Banks’ development into a high-speed document sorter. Based on Banks’ development, Unisys filed six patents in which it named Banks as a co-inventor. However, on three of the applications, Banks was listed as a co-inventor without his consent or knowledge. Unisys asked him to sign the patent forms and represented that he would be paid for each one. Unisys did not explain the importance of the patents. “Banks signed three separate declarations and patent assignments, but Unisys later told him he would be paid nothing.”

Upon the last day of Banks’ employment, he also refused a “Restricted Information Obligation” form that he believed would have assigned his inventions to Unisys.

Unisys argued that under the “employed to invent” rule, the law requires no express agreement of assignment to be made; therefore, “an employee’s refusal to assign his inventive rights to his employer has no legal significance.” Unisys seemed to assert that an implied contract was made when Brooks accepted the job to work on developing and improving cameras. First, the court set out that the general rule for ownership of patent rights is that the employee-inventor owns the patent rights even though he might have conceived it or reduced it to practice during his employment. Second, the court stated that the patent rights may belong to the employer where the employee “is hired to invent something or solve a particular problem . . . .” However, the court held that the exception is grounded on principles of contract law—the freedom to contract. The court held that, under the facts of the case, there was a genuine issue of material fact of whether there was a meeting of the minds, a necessary requirement for an implied-in-fact contract. Therefore, the Federal Circuit directed the district court to consider all the evidence and determine whether an implied contract was made.

E. Federal Circuit Jurisdiction

In Nilssen v. Motorola, Inc., Nilssen sued Motorola for patent infringement and various other state law claims in federal district court. After discovery was complete, the district court felt that bifurcating the trial between the patent claims and the other state law claims would be the best way to manage the trial because of all the claims. Accordingly, the court dismissed Nilssen’s patent claims without prejudice under Federal Rule of Civil Procedure 41(b), the section for involuntary dismissal of claims, and granted Nilssen leave to file a new complaint alleging patent infringement. Oddly, even though the
district court dismissed the patent infringement claim as an “involuntary dismissal” under Rule 41(b), the court noted that “its order was being entered ‘without objection by . . . Nilssen.””

The issue on appeal was whether the Federal Circuit had jurisdiction to hear the appeal.237 Nilssen argued that the jurisdiction of the Federal Circuit is determined at the outset upon the filing of the complaint.238 Motorola argued that the Federal Circuit lacked jurisdiction to hear the appeal because dismissing the case without prejudice was tantamount to amending the claims.239

The Federal Circuit agreed with Motorola. First, the court stated that under 28 U.S.C. § 1338, it had jurisdiction over “an appeal from a final decision of a district court of the United States . . . if the jurisdiction of that court was based, in whole or part, on 28 U.S.C. Section 1338.”240 Further, the court stated that “Section 1338(a) grants federal district courts jurisdiction over patent cases.”241 The court then noted that “[j]urisdiction normally attaches at the time of filing based on the pleadings.”

However, the court held that the fact that Nilssen’s patent claims were dismissed without prejudice was equivalent to the patent claims never being filed.242 Therefore, the Federal Circuit held that it did not have jurisdiction.243 The court noted that it had previously held that the Federal Circuit retained jurisdiction if the patent claim upon which jurisdiction was based was dismissed with prejudice.244

Judge Rader dissented. He would have held that because the dismissal was involuntary, the Federal Circuit had jurisdiction of Nilssen’s appeal.245 Judge Rader would have followed the Federal Circuit’s en banc holding in Atari, Inc. v. JS & A Group, Inc.,246 which he felt was closer to the facts at issue in this case and dealt more convincingly with the statutory language and jurisdictional policies such as forum shopping.247

F. Interference Appeals—35 U.S.C. § 146

35 U.S.C. § 146 provides that a party to an interference that is dissatisfied with a decision of the Board may file a “civil action” in district court.248 Unlike an appeal from an interference to the Federal Circuit, § 146 provides that the parties may submit new testimony that was not before the Board.249 However, § 146 does not state with what standard the district court shall review the Board’s decision where new evidence is submitted in the district court proceeding.

In Winner International Royalty Corp. v. Wang,250 Wu provoked an interference between his patent application and a patent issued to Wang.251 During the course of the interference, it became apparent to Wang that his patent’s claim to priority was inferior to Wu’s patent application.252 Wang then filed a preliminary motion that the interference count was obvious under 35 U.S.C. § 103.253 The Board ruled that most of the claims in Wu’s patent application were invalid as obvious under 35 U.S.C. § 103.254 Wu appealed the interference proceeding to the District Court for the District of Columbia under 35 U.S.C. § 146.255 The district court heard live testimony on each factual issue before the Board and concluded that the Board erred.

The issue on appeal to the Federal Circuit was what standard of review the district court was to give the Board’s factual findings.256 The Federal Circuit held “that the admission of live testimony on all matters before the Board in a § 146 action, as in this case, makes a factfinder of the district court and requires a de novo trial.”257 Further, the court held that although the live testimony presented to the district court “might be the same or similar testimony before the Board in the form of affidavits and deposition transcripts, a district court should still make de novo factual findings . . . .”258

In a footnote, the court specifically limited its holding to situations in which a party submits live testimony on all the issues that were before the Board.259 The court stated it did not decide what standard of review would apply if live testimony was submitted on only some of the issues before the Board.260

The court based its holding on the idea that deference is usually given to the fact finder because it is able to observe the live testimony of the witnesses.261 By observing the witnesses, the fact finder is best able to judge credibility and 262 demeanor. However, the court noted that the Board does not hear live testimony, but simply “reviews testimony in the form of affidavits and transcripts of depositions, and other facts in the form of responses to interrogatories and requests for admissions.”263 Further, the parties are able to add new evidence in the district court proceeding that was not presented to the Board.264

The court concluded that its holding would provide a clear rule: “Live testimony admitted on all matters that were before the
Board triggers de novo review. The court stated that if were to decide otherwise, the rule would be difficult to administer. For example, if the district court had to determine whether the Board heard the exact same testimony to determine what standard of review to give, it would be too burdensome on the district court.

The holding in this case will undoubtedly lead to more interference appeals to district court. In fact, if one loses before the Board, by then appealing to district court and presenting the evidence all over again, he gets, in effect, another chance to try the case with no deference to the Board’s findings.

G. Antitrust

In In re Independent Service Organizations Antitrust Litigation, Xerox refused to sell patented replacement parts for its copiers to independent service organizations, who were in the business of repairing Xerox copiers. CSU, an independent service company, was forced to cannibalize replacement parts from used Xerox equipment in order to stay in business. CSU sued Xerox under the Sherman Act for antitrust. Xerox counterclaimed for patent infringement.

On appeal, the issue was whether Xerox must sell its patented replacement parts or license its patents to the independent service organizations. The Federal Circuit held that Xerox did not violate the antitrust laws and that Xerox did not have to license its patent. First, the court noted that “there is no reported case in which a court has imposed antitrust liability for unilateral refusal to sell or license a patent.” Further, the court noted that 35 U.S.C. § 271(d) states that “no patent owner otherwise entitled to relief shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his (4) [having] refused to license or use any rights to the patent.”

CSU argued that Xerox tied its monopoly in patented parts to the service market of repairing copiers. The Federal Circuit rejected CSU’s tying argument, holding that a “patent holder cannot use his statutory right to refuse to sell patented parts to gain a monopoly in a market beyond the scope of the patent.” Therefore, the court felt that the key to deciding whether a party was unlawfully tying its legal monopoly granted in a patent to a tied product or service was determining whether the tied product or service was within the scope of the patent grant.

Under the facts of the case, the Federal Circuit held that Xerox’s refusal to sell its patented parts did not exceed the scope of the patent grant. The court concluded that “[i]n the absence of any indication of illegal tying, fraud in the Patent and Trademark Office, or sham litigation, the patent holder may enforce the statutory right to exclude others . . . free from liability under the antitrust laws.”

V. Conclusion

The Federal Circuit started out the new millennium with a big bang when it issued its monumental decision in Festo Corp. v. Shoketsu Kinzoku Kogyo Kabcushiki Co. Unless reversed by the Supreme Court, the repercussions of the decision surely will be felt for the next couple of decades. Every pending patent application and issued patent that has been amended for patentability reasons is now estopped by prosecution history estoppel from claiming subject matter under the doctrine of equivalents for the particular element amended in the claim.

One welcomed decision in the year 2000 was In re Spalding Sports Worldwide, Inc., which clarified the attorney-client privilege for patent practitioners. There is certainly more to clarify in the attorney-client privilege area. Nonetheless, not only did In re Spalding clarify the attorney-client privilege as it relates to patent law, but it also gives new hope that the Federal Circuit will grant mandamus more frequently in future cases.

One last decision that deserves special attention for the year 2000 is Winner International Royalty Corp. v. Wang, which held that the standard of review for interference appeals is de novo where a party puts on the same live testimony in the district court. Therefore, if a practitioner loses an interference case in the PTO, she should appeal to the district court to try her case de novo.

Footnotes

J.D., cum laude, Wayne State University Law School, 2000; B.S., Chemical Engineering, Michigan State University, 1997. Associate at Sidley & Austin’s Dallas office.


Id. at 563, 56 U.S.P.Q.2d at 1866.

See, e.g., Litton Sys., Inc. v. Honeywell, Inc., 140 F.3d 1449, 1456, 46 U.S.P.Q.2d (BNA) 1321, 1326 (Fed. Cir. 1998) (“[A]n amendment to claim language in response to prior art ‘may have a limiting effect within a spectrum ranging from great to small to zero.’” ) (citations omitted); Hughes Aircraft Co. v. United States, 140 F.3d 1470, 1476, 46 U.S.P.Q.2d (BNA) 1285, 1290 (Fed. Cir. 1998) (“In evaluating the reason behind an amendment, a court must determine what subject matter the patentee actually surrendered.”); Festo Corp. v. Shoketsu Kinzoku Kabushiki Co., 72 F.3d 857, 37 U.S.P.Q.2d (BNA) 1161, 1165 (Fed. Cir. 1995) (“In determining whether prosecution history estoppel applies when there has been a change in claim language during prosecution, the court must consider both what was changed and the reason for the change. The scope of any asserted estoppel is determined in light of the prior art in the field of art relevant to the change, the statements made to the patent examiner as to the reason for the change, and the purpose of the change as it relates to the allowance of the claims.”).


Id. at 1376, 53 U.S.P.Q.2d at 1441.

Id. at 1375, 53 U.S.P.Q.2d at 1440.

The Plant Variety Protection Act ("PVCA") establishes protection for seed-grown and tuber propagated plants that is different from the patent statute. See id. at 1377, 53 U.S.P.Q.2d at 1442; 7 U.S.C. §2402(a). The PVCA is administered by the Department of Agriculture. See Pioneer Hi-Bred, 200 F.3d at 1377, 53 U.S.P.Q.2d at 1442. Under the PVCA, there is no extensive examination procedure. Id.

Pioneer Hi-Bred, 200 F.3d at 1376, 53 U.S.P.Q.2d at 1441.

Id. at 1377-78, 53 U.S.P.Q.2d at 1442.

Id. at 1378, 53 U.S.P.Q.2d at 1443.


Id. at 309, 206 U.S.P.Q. at 197.

234 F.3d 654, 57 U.S.P.Q.2d (BNA) 1161 (Fed Cir. 2000).


In many cases, the obviousness factual findings control the outcome of the obviousness determination. For example, in Riverwood International Corp. v. The Mead Corp., the magistrate judge made the four factual findings and concluded that the patentee’s invention was obvious. The district court accepted the magistrate’s factual findings but concluded that the ultimate conclusion was that the patentee’s invention was not obvious. The Federal Circuit reversed and held on appeal that in view of the factual findings, the conclusion of the district court could not be supported by the factual findings. 212 F.3d 1365, 54 U.S.P.Q.2d (BNA) 1763 (Fed. Cir. 2000).

Id. at 673, 57 U.S.P.Q.2d at 1174.

Id. at 663, 57 U.S.P.Q.2d at 1166.

Id.

Id at 663-64, 57 U.S.P.Q.2d at 1166.

Id. at 667, 57 U.S.P.Q.2d at 1169 (citations omitted).

Id. at 660, 57 U.S.P.Q.2d at 1163.


Id. at 982, 55 U.S.P.Q.2d at 1615.

Id. at 976, 55 U.S.P.Q.2d at 1610.

Id. at 982, 55 U.S.P.Q.2d at 1615.

Id.

Id. at 978, 55 U.S.P.Q.2d at 1612.

Id.

Id.

Id. at 982, 55 U.S.P.Q.2d at 1615 (citations omitted).

Id.

Id.

Id. at 983, 55 U.S.P.Q.2d at 1616.
33 Id.

34 Id. at 979, 55 U.S.P.Q.2d at 1613.

35 Id. at 983, 55 U.S.P.Q.2d at 1616.

36 Id. at 984, 55 U.S.P.Q.2d at 1617.

37 Id. at 983, 55 U.S.P.Q.2d at 1616.

38 Id. at 984, 55 U.S.P.Q.2d at 1617.

39 Id.


41 Id. at 1375, 55 U.S.P.Q.2d at 1280.


43 Id.

44 Id.

45 Id. at 1380, 55 U.S.P.Q.2d at 1284.


47 Id.

48 Id., 55 U.S.P.Q.2d at 1281.

49 Id., 55 U.S.P.Q.2d at 1282 (citations omitted).

50 Id. at 1379, 55 U.S.P.Q.2d at 1283.

51 Id.

52 Id. 1380, 55 U.S.P.Q.2d at 1284.

Id. at 1380, 55 U.S.P.Q.2d at 1284.

Id.

Id.

Id. at 1382, 55 U.S.P.Q.2d at 1285.

Id.

Id.


204 F.3d 1368, 54 U.S.P.Q.2d (BNA) 1001 (Fed. Cir. 2000).

Id. at 1372, 54 U.S.P.Q.2d at 1003-04.

Id. at 1371-72, 54 U.S.P.Q.2d at 1003.

Id. at 1372, 54 U.S.P.Q.2d at 1004.

Id. at 1375, 54 U.S.P.Q.2d at 1006.

Id. at 1372, 54 U.S.P.Q.2d at 1004.

Id. at 1375, 54 U.S.P.Q.2d at 1006.

Id. at 1374, 54 U.S.P.Q.2d at 1005 (citing 37 C.F.R. §1.56 (1995)).

Id. at 1376, 54 U.S.P.Q.2d at 1006.

Id.

Id.

Id. at 1371, 54 U.S.P.Q.2d at 1003.
Id. at 1376, 54 U.S.P.Q.2d at 1006-07.

Id. at 1376, 54 U.S.P.Q.2d at 1007.

Id. at 1376-77, 54 U.S.P.Q.2d at 1007.

Id. at 1376, 54 U.S.P.Q.2d at 1007.

Id. at 1377, 54 U.S.P.Q.2d at 1007.

Id.

Id.

Id.

Id.


Id. at 1317, 56 U.S.P.Q.2d at 1002.

Id.

Id.

Id. at 1320, 56 U.S.P.Q.2d at 1010-11.


Id. at 1322, 56 U.S.P.Q.2d at 1018.

Id.

Id., 56 U.S.P.Q.2d at 1020.

Id. at 1321, 56 U.S.P.Q.2d at 1015.

Id., 56 U.S.P.Q.2d at 1016 (citations omitted).
The '102 application was a continuation-in-part of the '300 application, which was a continuation-in-part of a 1968 grandparent application. Li claimed that the 1968 grandparent application entitled him to priority over the prior art. Id. at 1375-76, 56 U.S.P.Q.2d at 1682-83.
Id.

Id. at 1380, 56 U.S.P.Q.2d at 1686.

Id.

Id.

Id. at 1257, 1257 n.5, 55 U.S.P.Q.2d at 1008, 1008 n.5 (quoting Restatement (Second) of Contracts § 24 (1979)) (noting that “[a]lthough not authoritative, the Restatement has long been recognized as useful in establishing the general law governing law of contracts, including offers”).

Id.

Id. at 1258, 55 U.S.P.Q.2d at 1009.

Id. at 1252, 55 U.S.P.Q.2d at 1005.


Id. at 1252, 55 U.S.P.Q.2d at 1005.


Id. at 1249, 55 U.S.P.Q.2d at 1003.

Id. at 1251, 55 U.S.P.Q.2d at 1004.

Id.

Id. at 1255, 55 U.S.P.Q.2d at 1007.

Id. at 1254, 55 U.S.P.Q.2d at 1006.

Id. at 1255, 55 U.S.P.Q.2d at 1007.

Id. at 1257, 1257 n.5, 55 U.S.P.Q.2d at 1008, 1008 n.5 (quoting Restatement (Second) of Contracts § 24 (1979)) (noting that “[a]lthough not authoritative, the Restatement has long been recognized as useful in establishing the general law governing law of contracts, including offers”).

Id.

Id. at 1258, 55 U.S.P.Q.2d at 1009.

Id. at 1252, 55 U.S.P.Q.2d at 1005.


Id. at 1360, 55 U.S.P.Q.2d at 1954.

Id.

Id.

Id.


Id. at 566, 56 U.S.P.Q.2d at 1870.

Id. at 567, 56 U.S.P.Q.2d at 1871.

Id. at 568, 56 U.S.P.Q.2d at 1871.

Id.

Id. at 569, 56 U.S.P.Q.2d at 1872.

Id. at 572, 56 U.S.P.Q.2d at 1875.

Id. at 574, 56 U.S.P.Q.2d at 1877.

See id. at 577, 56 U.S.P.Q.2d at 1879.

Id. at 578, 56 U.S.P.Q.2d at 1880.


See id. at 831-32, 49 U.S.P.Q.2d at 1875.

“Invention records are standard forms generally used by corporations as a means for inventors to disclose to the corporation’s patent attorneys that an invention has been made and to initiate patent action. They are usually short documents including space for such information as names of inventors, description and scope of invention, closest prior art, first date of conception and disclosure to others, dates of publication, etc.” 203 F.3d at 802 n.2, 53 U.S.P.Q.2d at 1748 n.2.

See id. at 804, 53 U.S.P.Q.2d at 1750.

See id. at 802, 53 U.S.P.Q.2d at 1749.

See id.

See id. at 805, 53 U.S.P.Q.2d at 1751.

Id. at 803, 53 U.S.P.Q.2d at 1749.

See id.

See id. at 805-06, 53 U.S.P.Q.2d at 1751-52.

See id. at 806, 53 U.S.P.Q.2d at 1751.

Id.

Id., 53 U.S.P.Q.2d at 1752 (citations omitted).

Id.

Id.


Id.

Id.

Id.

Id. at 807, 53 U.S.P.Q.2d at 1753.

Id.
Id. (stating that to prove common law fraud, a party must prove five indispensable elements: “(1) a representation of material fact, (2) the falsity of that representation, (3) the intent to deceive or, at least, a state of mind so reckless as to the consequences that it is held to be the equivalent of intent (scienter), (4) a justifiable reliance upon the misrepresentation by the party deceived which induces him to act thereon, and (5) injury to the party deceived as a result of his reliance on the misrepresentation,” quoting Nobelpharma AB v. Implant Innovations, Inc., 141 F.3d 1059, 1069-70, 46 U.S.P.Q.2d (BNA) 1097, 1106 (Fed. Cir. 1998)).


Id. (citations omitted).

Id. (citations omitted).


Id. at 983, 54 U.S.P.Q.2d at 1180.

Id. at 986 n.6, 54 U.S.P.Q.2d at 1183 n.6.

Id. at 986, 54 U.S.P.Q.2d at 1183.

Id. at 985, 54 U.S.P.Q.2d at 1182.

Id. at 985 n.5, 54 U.S.P.Q.2d at 1182 n.5.

Id. at 983, 54 U.S.P.Q.2d at 1181.

Id., 54 U.S.P.Q.2d at 1180.

Id. at 986, 54 U.S.P.Q.2d at 1183.

Id. at 986, 986 n.6, 54 U.S.P.Q.2d at 1183, 1180 n.6.

Id. at 986, 54 U.S.P.Q.2d at 1183.

Id. (emphasis added).

Id.

Id. at 988, 54 U.S.P.Q.2d at 1185.

Id. at 1361, 54 U.S.P.Q.2d at 1847.

Id.


Id. at 1363, 54 U.S.P.Q.2d at 1849.

Id.

Id.

Id. at 1362, 54 U.S.P.Q.2d at 1848.

Id.

Id.

Id. at 1364, 54 U.S.P.Q.2d at 1849.

Id.

Id.

208 F.3d 981, 986, 54 U.S.P.Q.2d (BNA) 1179, 1183 (Fed. Cir. 2000) (“View is not required to allow pre-litigation discovery, as requested by Robotic, nor is it required to allow Robotic any not approved by the court.”).

Hoffman-LaRoche, 213 F.3d at 1365, 54 U.S.P.Q.2d at 1850.


Id. at 1354, 53 U.S.P.Q.2d at 1602.

Id. 1354-55, 53 U.S.P.Q.2d at 1602.

Id. at 1355, 53 U.S.P.Q.2d at 1602.

Id.

Id.
Id. at 1354, 53 U.S.P.Q.2d at 1602.

Id. at 1355, 53 U.S.P.Q.2d at 1602.

Id., 53 U.S.P.Q.2d at 1603.

Id. at 1356, 53 U.S.P.Q.2d at 1603.

Id.

228 F.3d 1357, 56 U.S.P.Q.2d (BNA) 1222 (Fed. Cir. 2000).

Id. at 1358, 56 U.S.P.Q.2d at 1223.

Id.

Id.

Id.

Id.

Id.

Id.

Id.

Id.

Id.

Id.

Id.

Id.

Id.

Id.

Id. at 1359, 56 U.S.P.Q.2d at 1224.

Id. at 1359, 56 U.S.P.Q.2d at 1224.

Id.
Id.

Id.

Id.

Id. at 1360, 56 U.S.P.Q.2d at 1224.

Id.


Id. at 783, 53 U.S.P.Q.2d at 1766.

Id.

Id.

Id. at 783-84, 53 U.S.P.Q.2d at 1766.

Id. at 784, 53 U.S.P.Q.2d at 1766.

Id. at 783-84, 53 U.S.P.Q.2d at 1766.

Id. at 784, 53 U.S.P.Q.2d at 1767.

Id.

Id.

Id. at 785, 53 U.S.P.Q.2d at 1767.

Id.

Id. (citing Zenith Elecs. Corp. v. Exzec, Inc., 182 F.2d 1340, 51 U.S.P.Q.2d (BNA) 1337 (Fed. Cir. 1999)).

Id. at 785, 53 U.S.P.Q.2d at 1768.

Id. at 1343, 53 U.S.P.Q.2d at 1582.

Id. at 1344-45, 53 U.S.P.Q.2d at 1583-84.

Id. at 1347, 53 U.S.P.Q.2d at 1585.

Id., 53 U.S.P.Q.2d at 1585-86.

Id. at 1347 n.4, 53 U.S.P.Q.2d at 1585 n.4.

Id. at 1346-47, 53 U.S.P.Q.2d at 1585.

Id. at 1347, 53 U.S.P.Q.2d at 1585. Interestingly, Charles L. Gholz, co-counsel for Wu and Winner International Royalty Corp., stated in a recent article that the Board has heard live testimony in at least one case and can view depositions submitted on a video tape. See Charles L. Gholz, Why 35 USC 146 Practice Should Boom, Intellectual Property Today, Dec. 2000, at 48-49.


267 Id.
268 Id.
270 Id. at 1324, 53 U.S.P.Q.2d at 1853.
271 Id., 53 U.S.P.Q.2d at 1854.
272 Id.
273 Id.
274 Id. at 1324, 53 U.S.P.Q.2d at 1853-54.
275 Id. at 1329, 53 U.S.P.Q.2d at 1858.
276 Id. at 1326, 53 U.S.P.Q.2d at 1855.
277 Id. (emphasis added).
278 See id.
279 Id. at 1327, 53 U.S.P.Q.2d at 1856.
280 Id. at 1328, 53 U.S.P.Q.2d at 1856.
281 See id. at 1327, 53 U.S.P.Q.2d at 1856.

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