

## Top Ten Patent Cases\*

Harold C. Wegner

**No. (6) AMP v. Myriad DNA-Patent-Eligibility (pp. 9-11):  
End of the Patent-Eligibility Highway for the ACLU?**

**Myriad is one of five cases with a certiorari decision likely February 21<sup>st</sup>**

|      | Supreme Court in Blue                                     | Circuit Courts in Red                |                               |
|------|---|--------------------------------------|-------------------------------|
| Rank | Case Name   | Issue                                | Status                        |
| 1    | <i>Mayo v. Prometheus</i>                                 | § 101 Patent-Eligibility             | Awaiting decision             |
| 2    | a) <i>Kirstsaeng v. Wiley</i><br>b) <i>Liu v. Pearson</i> | International Exhaustion             | Petition Response due March 5 |
| 3    | <i>Kappos v. Hyatt</i>                                    | § 145 de novo Review                 | Awaiting decision             |
| 4    | <i>Caraco</i>   | ANDA Counterclaim                    | Awaiting decision             |
| 5    | <i>Akamai/McKesson</i>                                    | “All Elements” Rule                  | Awaiting en banc decision     |
| 6    | <i>AMP v. Myriad</i>                                      | § 101; Standing                      | Cert. dec. Feb. 21            |
| 7    | <i>Marine Polymer</i>                                     | Intervening Rights                   | Amici Briefs due Feb.10       |
| 8    | <i>Taniguchi</i>  | Taxing Translation Costs             | Argument February 21          |
| 9    | <i>Saint-Gobain</i>                                       | <i>Doc. Equiv.; Evidentiary Std.</i> | Awaiting CVSG Brief           |
| 10   | <i>In re Lee</i>  | Nonobviousness Double Patenting      | Awaiting Appeal Notice        |
|      | <i>Apotex v. Unigene</i>                                  | Chemical Nonobviousness              | Response due Febr. 17         |
|      | <i>Aerotel v. Telco</i>                                   | “Means” Claiming                     | Response due Febr. 13         |
|      | <i>Janssen v. Abbott</i>                                  | <i>Ariad</i> “Possession”            | Cert. dec. Feb. 21            |
|      | <i>Perfect 10 v. Google</i>                               | Preliminary Injunction               | Awaiting Conference           |
|      | <i>Eastman v. Wellman</i>                                 | Indefiniteness                       | Cert. dec. Feb. 21            |
|      | <i>Hynix v. Rambus</i>                                    | Prosecution laches                   | Cert. dec. Feb. 21            |
|      | <i>In re Youman</i>                                       | Recapture Rule                       | Awaiting decision             |
|      | <i>In re Staats</i>                                       | Broadening Reissue                   | Awaiting decision             |
|      | <i>Classen v. Biogen</i>                                  | <i>Prometheus déjà vu</i>            | Awaiting Cert. Petition       |
|      | <i>Soverain v. Newegg</i>                                 | “All Elements”                       | Awaiting decision             |
|      | <i>Minkin v. Gibbons</i>                                  | Malpractice (Claim Scope)            | Awaiting decision             |
|      | <i>Bowman v. Monsanto</i>                                 | Patent Exhaustion (Seeds)            | Response due Feb. 27          |
|      | <i>Chet’s Shoes</i>                                       | Frivolous Petition                   | Cert. dec. Feb. 21            |

\*About this List, see page 2.

This revision: February 6, 2012

# SUPREME COURT CALENDAR

## October 2011 Term (sessions in 2012)

**Hearing Sessions**

**Non-Hearing Sessions**

**Certiorari Votes (private)**

| JANUARY |    |    |    |    |    |    |
|---------|----|----|----|----|----|----|
| S       | M  | T  | W  | T  | F  | S  |
| 1       | 2  | 3  | 4  | 5  | 6  | 7  |
| 8       | 9  | 10 | 11 | 12 | 13 | 14 |
| 15      | 16 | 17 | 18 | 19 | 20 | 21 |
| 22      | 23 | 24 | 25 | 26 | 27 | 28 |
| 29      | 30 | 31 |    |    |    |    |

| FEBRUARY |    |    |    |    |    |    |
|----------|----|----|----|----|----|----|
| S        | M  | T  | W  | T  | F  | S  |
|          |    |    | 1  | 2  | 3  | 4  |
| 5        | 6  | 7  | 8  | 9  | 10 | 11 |
| 12       | 13 | 14 | 15 | 16 | 17 | 18 |
| 19       | 20 | 21 | 22 | 23 | 24 | 25 |
| 26       | 27 | 28 | 29 |    |    |    |

| MARCH |    |    |    |    |    |    |
|-------|----|----|----|----|----|----|
| S     | M  | T  | W  | T  | F  | S  |
|       |    |    |    | 1  | 2  | 3  |
| 4     | 5  | 6  | 7  | 8  | 9  | 10 |
| 11    | 12 | 13 | 14 | 15 | 16 | 17 |
| 18    | 19 | 20 | 21 | 22 | 23 | 24 |
| 25    | 26 | 27 | 28 | 29 | 30 | 31 |

| APRIL |    |    |    |    |    |    |
|-------|----|----|----|----|----|----|
| S     | M  | T  | W  | T  | F  | S  |
| 1     | 2  | 3  | 4  | 5  | 6  | 7  |
| 8     | 9  | 10 | 11 | 12 | 13 | 14 |
| 15    | 16 | 17 | 18 | 19 | 20 | 21 |
| 22    | 23 | 24 | 25 | 26 | 27 | 28 |
| 29    | 30 |    |    |    |    |    |

| MAY |    |    |    |    |    |    |
|-----|----|----|----|----|----|----|
| S   | M  | T  | W  | T  | F  | S  |
|     |    | 1  | 2  | 3  | 4  | 5  |
| 6   | 7  | 8  | 9  | 10 | 11 | 12 |
| 13  | 14 | 15 | 16 | 17 | 18 | 19 |
| 20  | 21 | 22 | 23 | 24 | 25 | 26 |
| 27  | 28 | 29 | 30 | 31 |    |    |

| JUNE |    |    |    |    |    |    |
|------|----|----|----|----|----|----|
| S    | M  | T  | W  | T  | F  | S  |
|      |    |    |    |    | 1  | 2  |
| 3    | 4  | 5  | 6  | 7  | 8  | 9  |
| 10   | 11 | 12 | 13 | 14 | 15 | 16 |
| 17   | 18 | 19 | 20 | 21 | 22 | 23 |
| 24   | 25 | 26 | 27 | 28 | 29 | 30 |

### About This List:

Harold C. Wegner is solely responsible for this list. The author is a former Professor of Law at the George Washington University Law School and is currently a partner in the international law firm of Foley & Lardner LLP.

Any opinions or characterizations expressed in this paper represent the personal viewpoint of the author and do not necessarily reflect the viewpoint of any colleague, organization or client thereof. The writer acknowledges participation as counsel for amicus Alnylam on its brief at the Federal Circuit in No. (6) Myriad.

**SUPREME COURT DECISIONS THIS TERM**

***Golan v. Holder*: Art. I, § 8, cl. 8 Constitutional Challenge Denied**

In *Golan v. Holder*, 565 U.S. \_\_\_\_ (January 18, 2012)(Ginsburg, J.), the Supreme Court denied a Constitutional challenge to the retroactive extension of the terms of certain expired copyrights which had been challenged on two grounds, including the Patent and Copyright Clause, Art. I, § 8, clause 8, which sanctions legislation to “Promote the Progress of Science and the Useful Arts....”.

In its 6-2 affirmance of the Circuit Court denial of the Constitutional challenge, the Court sustained the statute following the rationale of its earlier decision in *Eldred v. Ashcroft*, 537 U.S. 186 (2003)(Ginsburg, J.). (Breyer, J., joined by Alito, J., dissented, while Kagan, J., was recused.)

**“First Inventor to File” Constitutional Challenge, an Uphill Battle:** In arguments leading up to the enactment of *the Leahy Smith America Invents Act*, Public Law 112-29 (September 16, 2011), voices were heard that the “first inventor to file” provision of the new law would be challenged as contrary to the Patent and Copyright Clause.

As in *Eldred v. Ashcroft*, the Court in *Golan v. Holder* showed great deference to Congress as to how a statute should be drafted to implement the goals of the Constitution:

“In *Eldred*, we rejected an argument nearly identical to the one petitioners rehearse. \* \* \* [W]e explained, the Clause ‘empowers Congress to determine the intellectual property regimes that, overall, in that body’s judgment, will serve the ends of the Clause.’ [*Eldred v. Ashcroft*, 537 U.S. at 222.]”

The Court stated that “[g]iven the authority we hold Congress has, we will not second-guess the political choice Congress made....”

Since the “first inventor to file” provision of the new law mandates that the patent should be given to an *inventor* who is first to file (consistent with the wording of the Clause), it is difficult to see the Supreme Court second guessing a new statutory regime that implements the Patent and Copyright Clause and is consistent with the literal wording of the Constitutional provision.

**(1) *Mayo v. Prometheus* – “Metabolite déjà vu”**

In *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, Supreme Court No. 10-1150 – “Metabolite déjà vu” – the patent challenger seeks review of *Prometheus Laboratories, Inc. v. Mayo Collaborative Services*, 628 F.3d 1347 (Fed. Cir. 2010)(Lourie, J.), *prior decision*, *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, \_\_\_ U.S. \_\_\_ (2010)(per curiam), *grant of certiorari, vacation and remand from the Supreme Court in light of Bilski v. Kappos*, \_\_\_ U.S. \_\_\_ (2010), *prior opinion*, 581 F.3d 1336 (Fed. Cir. 2009)(Lourie, J.), where the Federal Court once again reversed the District Court to rule Prometheus diagnostic method to be patent-eligible subject matter under 35 USC § 101.

**Status:** Awaiting decision (argued December 7, 2011).

**(2a) *Kirtsaeng v. John Wiley: International Exhaustion***

*Kirtsaeng v. John Wiley & Sons, Inc.*, Supreme Court No. 11-697, *opinion below*, 654 F.3d 210 (2d Cir. 2011)(Cabranes, J.), has the same denial of international exhaustion as in *Omega S.A. v. Costco Wholesale Corp.*, 541 F.3d 982 (9th Cir. 2008)(Smith, Jr., J.), where the Court accepted review but then left the issue in the air with a 4-4 tie vote affirmance, *Costco Wholesale Corp. v. Omega, S.A.*, 131 S.Ct. 565 (2010)(per curiam without opinion).

**Status:** Response to the Petition is due March 5, 2012. If *certiorari* is granted, argument would be during the October 2012 Term running through June 2013.

**Question Presented:** “This case presents the issue that recently divided this Court, 4-4, in *Costco Wholesale Corp. v. Omega, S.A.*, 131 S. Ct. 565 (2010). Under § 602(a)(1) of the Copyright Act, it is impermissible to import a work ‘without the authority of the owner’ of the copyright. But the first-sale doctrine, codified at § 109(a), allows the owner of a copy ‘lawfully made under this title’ to sell or otherwise dispose of the copy without the copyright owner's permission.

“The question presented is how these provisions apply to a copy that was made and legally acquired abroad and then imported into the United States. Can such a foreign-made product *never* be resold within the United States without the copyright owner's permission, as the Second Circuit held in this case? Can such a foreign-made product *sometimes* be resold within the United States without

## Wegner's Top Ten Patent Cases [February 6, 2012]

---

permission, but only after the owner approves an earlier sale in this country, as the Ninth Circuit held in *Costco*? Or can such a product *always* be resold without permission within the United States, so long as the copyright owner authorized the first sale abroad, as the Third Circuit has indicated?"

***International Patent Exhaustion:*** While the Supreme Court established *domestic* patent exhaustion in nineteenth century cases including *Bloomer v. McQuewan*, 55 U.S. (14 How.) 539 (1852), the Court never in its entire history has ever determined whether the United States has a doctrine of *international* patent exhaustion. An opinion in *Kirtsaeng*, which examines international exhaustion in the context of a copyright, may well prove instructive as to the Court's views for the parallel issue in patents.

The Federal Circuit in a series of cases starting with *Jazz Photo Corp. v. Int'l Trade Comm'n*, 264 F.3d 1094 (Fed.Cir.2001)(Newman, J.), has *denied* the existence of international patent exhaustion. The later cases have simply relied upon *Jazz Photo* as binding precedent, while *Jazz Photo* explains its holding in one line, citing its mistaken understanding that the Supreme Court had denied international patent exhaustion in *Boesch v. Graff*, 133 U.S. 697 (1890), a case having absolutely nothing to do with exhaustion but instead the German national prior user right statute.

***Federal Circuit – Absence of Policy Analysis:*** Is international exhaustion good for the United States? Bad? There have been *thousands* of pages written on the subject in the context of the international controversy over this issue. To the extent the Federal Circuit considers its *holding* in *Jazz Photo* to be sound, it would be more defensible if its viewpoint were supported by reasoned policy analysis than a simple citation to a nineteenth century Supreme Court case having no relevance to the issue whatsoever.

**(2b) *Liu v. Pearson*: International Exhaustion**

*Liu v. Pearson*, Supreme Court No.11-708, raises an issue of international exhaustion similar to No. (2a) *Kirtsaeng v. John Wiley & Sons, Inc.*, Supreme Court No. 11-697, *supra*.

**Status:** Response to the Petition is due March 5, 2012. If *certiorari* is granted, argument would be during the October 2012 Term running through June 2013.

**Question Presented:** “Whether the Copyright Act’s first-sale doctrine, as codified in 17 U.S.C. § 109(a) – under which the owner of any particular copy ‘lawfully made under this title’ may resell that copy without the authority of the copyright holder – applies to copies lawfully manufactured abroad by the holder of U.S. copyright, or whether the redistribution of such copies remains under the U.S. copyright holder’s perpetual control simply because those copies were manufactured abroad.”

**(3) *Kappos v. Hyatt* – § 145 *De Novo* Review**

In *Kappos v. Hyatt*, Supreme Court No. 10-1219, the government seeks review of *Hyatt v. Kappos*, 625 F.3d 1320 (Fed. Cir. 2010)(*en banc*), which sustained the *de novo* nature of a civil action under 35 USC § 145.

**Status:** Awaiting decision (argument January 9, 2012).

**Questions Presented:** “When the [PTO] denies an application for a patent, the applicant may seek judicial review of the agency’s final action through either of two avenues. The applicant may obtain direct review of the agency’s determination in the Federal Circuit under 35 U.S.C. 141. Alternatively, the applicant may commence a civil action against the Director of the PTO in federal district court under 35 U.S.C. 145. In a Section 145 action, the applicant may in certain circumstances introduce evidence of patentability that was not presented to the agency. The questions presented are as follows:

“(1) Whether the plaintiff in a Section 145 action may introduce new evidence that could have been presented to the agency in the first instance.

## Wegner's Top Ten Patent Cases [February 6, 2012]

---

“(2) Whether, when new evidence is introduced under Section 145, the district court may decide de novo the factual questions to which the evidence pertains, without giving deference to the prior decision of the PTO.”

### **(4) Caraco – ANDA Counterclaim**

In *Caraco Pharmaceutical Laboratories, Ltd. v. Novo Nordisk A/S*, Supreme Court No. 10-844, *opinion below*, *Novo Nordisk A/S v. Caraco Pharmaceutical Laboratories, Ltd.*, 601 F.3d 1359 (Fed. Cir. 2010)(Fed. Cir. 2010)(Rader, J.), *reh'g den*, 615 F.3d 1374 (2010), petitioner-ANDA defendant challenges denial of its counterclaim under Section 355(j)(5)(C)(ii)(I) that alleges that the brand-name manufacturer's patent information does not accurately and precisely describe the method of use claimed by its patent.

**Status:** Awaiting decision (argued December 5, 2011).

*Caraco* presented a perfect storm for grant of review that combines a pioneer v. generic drug controversy, a sharp dissent from two members of the Federal Circuit from the denial of rehearing *en banc* at that Court and, most importantly, the strong support of the Department of Justice in the form of the Solicitor General's recent *amicus* briefing supporting grant of review.

**Question Presented:** “By filing an abbreviated new drug application (ANDA), a manufacturer may seek approval from the Food and Drug Administration (FDA) to market a generic version of a previously approved brand-name drug. The ANDA must address, *inter alia*, each patent that claims a method of using the drug. If the ANDA seeks approval for a use claimed by a patent, it must include a certification that the patent has expired, will expire, is invalid, or would not be infringed by the sale or use of the generic drug. Alternatively, the ANDA applicant may inform FDA that it seeks approval for a method of use that the patent does not claim. To determine whether an ANDA seeks approval for a patented use - and hence whether it includes the required certifications - FDA relies on information describing the relevant patent's scope submitted by the brand-name manufacturer under FDA regulations.

## Wegner's Top Ten Patent Cases [February 6, 2012]

---

“The brand-name manufacturer may sue the ANDA applicant for patent infringement if, *inter alia*, the ANDA seeks approval for a patented use before the relevant patent has expired. The ANDA applicant may respond with ‘a counterclaim seeking an order requiring the [brand-name manufacturer] to correct or delete the patent information [it previously] submitted \*\*\* on the ground that the patent does not claim either - (aa) the drug for which the application was approved; or (bb) an approved method of using the drug.’ 21 U.S.C. 355(j)(5)(C)(ii)(I). The question presented is as follows:

“Whether an ANDA applicant may assert a counterclaim under Section 355(j)(5)(C)(ii)(I) by alleging that the brand-name manufacturer's patent information does not accurately and precisely describe the method of use claimed by its patent.”

### **(5) Akamai/McKesson “All Elements” Rule**

In *Akamai Technologies, Inc. v. Limelight Networks, Inc.*, Fed. Cir. 2009-1372, and *McKesson Technologies Inc. v. Epic Systems Corp.*, App. No. 2010-1291, the Court will hear *en banc* arguments in each case to seek to better define the situations where infringement liability attaches where a multi-step process claim is performed by different parties. The vacated panel opinions are *Akamai*, 629 F.3d 1311 (Fed. Cir. 2010), and *McKesson*, \_\_\_ F.3d \_\_\_, 2011 WL 1365548 (Fed. Cir. 2011), both following *BMC Resources, Inc. v. Paymentech, L.P.*, 498 F.3d 1373 (Fed. Cir. 2007), that denies the existence of infringement of a multi-step process claim where different independent parties collectively perform all steps but there is not one single direct infringer who performs and/or directs all steps of the process.

**Status:** Awaiting decisions in each case (*en banc* arguments were held November 18, 2011).

**A Tale of Two Different Approaches at the Oral Arguments:** Appellant in each of the *en banc* arguments took decidedly different approaches. Going first in the *Akamai* appeal, Donald R. Dunner boldly, frontally assaulted the viability of *BMC v. Paymentech* based upon pre-1952 case law.

## Wegner's Top Ten Patent Cases [February 6, 2012]

---

In *McKesson*, former Principal Deputy Solicitor General Daryl Joseffer *accepted* the "single actor" rule of *BMC v. Paymentech*, but instead sought a broadening of the narrow scope of acts of third parties deemed under the direction and control of the "single actor": Under this theory, steps performed by third parties could be deemed to have been performed under the direction and control of the single actor to find infringement.

**"Wordsmithing": The Akamai Bench Returns to the Original Petition:** While appellant in *Akamai* at the argument launched a frontal assault on *BMC v. Paymentech*, the bench redirected counsel's attention to the issue of "wordsmithing" that was at the heart of the original petition for rehearing en banc. This aspect is considered in this writer's paper, *Wordsmithing, Akamai and the "All Elements Rule"*, includes this writer's views of the *Akamai* case insofar as it relates to last Friday's bench questions concerning "wordsmithing", which is found at § VII, *Akamai, Failure to Define a Single Direct Infringer* (pp. 15-19). (The paper is available at [www.GrayOnClaims.com/hal](http://www.GrayOnClaims.com/hal).)

**A Problem Recognized for at Least the Past Ten Years:** The issue was thoroughly aired at an experts' conference a decade ago where it was difficult if not impossible to see a situation where claims could not be fashioned focused upon the acts of a single actor as part of a multiparty transaction. *See* Softic Symposium 2001: Information Distribution and Legal Protection in Cyberspace – In search of a New System, § C, *Patent Infringement Suits in Global Network Age*, pp. 82-93, <http://www.softic.or.jp/en/symposium/proceedings.htm>.

The underlying case law and solutions to provide single actor claims was explained in Wegner, *E-Business Patent Infringement: Quest for a Direct Infringement Claim Model*, SOFTIC Symposium (2001), [http://www.softic.or.jp/symposium/open\\_materials/10th/index-en.htm](http://www.softic.or.jp/symposium/open_materials/10th/index-en.htm).

### **(6) AMP v. Myriad – § 101 Patent-Eligibility**

In the *Myriad* case, *Association for Molecular Pathology v. Myriad Genetics, Inc.*, Supreme Court No. 11-725, *opinion below*, *Association for Molecular Pathology v. U.S. Patent and Trademark Office*, 653 F.3d 1329 (Fed. Cir. 2011)(Lourie, J.), the ACLU *et al.* seek review of the panel decision of the Federal Circuit overturning a summary judgment ruling that various claims to DNA lack patent-eligibility under 35 USC § 101, 653 F.3d 1329 (Fed. Cir. 2011)(Lourie, J.).

## Wegner's Top Ten Patent Cases [February 6, 2012]

---

**Status:** A certiorari decision is expected as part of the Orders List for February 21, 2012. (The *certiorari* vote is expected for the Conference scheduled for February 17, 2012.)

Response to the Petition is due January 13, 2013 (not yet extended). If *certiorari* is granted the argument will either be in the October 2012 Term running through June 2013 or, if there remains an opening in the current Term, April 18-20 or 25-27.

**Questions Presented:** 1. Are human genes patentable?

“2. Did the court of appeals err in adopting a new and inflexible rule, contrary to normal standing rules and this Court’s decision in *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118 (2007), that petitioners who have been indisputably deterred by Myriad’s “active enforcement” of its patent rights nonetheless lack standing to challenge those patents absent evidence that they have been personally and directly threatened with an infringement action?”

**Respondent’s Opposition:** There are plural reasons given by the Respondent why *certiorari* should be denied. Particularly forceful arguments are made that the merits question raises a question for an advisory opinion divorced from the specific questions answered by the appellate tribunal; a standing argument is also presented:

**(1) An Advisory Opinion:** *First*, on the merits, Respondent points out that the broad *Question Presented* (“Are human genes patentable?”) is *not* what was decided by the appellate tribunal below:

Rather, the question ... was whether particular isolated molecules of DNA, which were never available to the public until humans invented them, and whose utility is clear and unquestioned, were eligible for patenting as “compositions of matter” under 35 U.S.C. § 101.”

“[T]he posture of this case - a declaratory-judgment action mounted by 20 recruited plaintiffs - makes this case a poor vehicle. This case is an abstract challenge seeking an advisory opinion. The particular patent claims put at issue were selected for a § 101 challenge by petitioners alone. Yet petitioners did not contest all of the claims of Myriad's challenged patents.”

## Wegner's Top Ten Patent Cases [February 6, 2012]

---

**(2) Lack of Continued Standing:** Respondent also questions standing: “The Federal Circuit concluded that only one of the 20 plaintiffs had a sufficiently real and immediate dispute with the patentee Myriad [ ] to satisfy the case-or-controversy requirement.”

“[E]ven the one petitioner held by the Federal Circuit to have standing – Dr. Ostrer – in fact has no sufficiently live case-or-controversy with Myriad to sustain jurisdiction under Article III. The ‘case-or- controversy requirement subsists through all stages of federal judicial proceedings, trial and appellate. To sustain our jurisdiction ... it is not enough that a dispute was very much alive when suit was filed, or when review was obtained in the Court of Appeals.; *Lewis v. Continental Bank Corp.*, 494 U.S. 472, 477-78 (1990).....”

Dr. Ostrer's resignation from his place of employment where he was held to have standing is argued to terminate the sole basis the Federal Circuit had concluding that there is standing:

“[T]his case is now moot because of Dr. Ostrer's change in employment. Importantly, the Federal Circuit rooted its finding that Dr. Ostrer had standing based on a controversy stemming from a collaborative license offer that Myriad made to NYU in 1998 that would “require[ ] NYU to make a payment to Myriad” for certain BRCA1/2 testing performed by an NYU laboratory at which Dr. Ostrer was formerly employed. *Id.* at 32a-34a. Myriad, however, has never had any controversy with Montefiore, Dr. Ostrer's current employer; indeed, the record reflects no Myriad communication with Montefiore, no actions directed to Montefiore by Myriad, and no awareness by Myriad of any actions being taken by Montefiore. And, any controversy created by Myriad's 1998 offer of a collaborative license to NYU cannot follow Dr. Ostrer to his employment at an entirely different institution, Montefiore. ...these jurisdictional deficiencies thus render this case a poor vehicle for resolving the questions presented.”

**Professor Holman cited as Authority:** Respondent relies in particular on writings of Professor Christopher Holman; *see* Christopher M. Holman, *Gene Patents Under Fire: Weighing the Costs and Benefits*, in *Biotechnology and Software Patent Law 260* (Emanuela Arezzo & Gustavo Ghidini eds., 2011); *id.*, in *Human Gene Patent Litigation*, 322 *Science* 198 (2008)

**(7) *Marine Polymer – Intervening Rights***

In *Marine Polymer Technologies, Inc. v. HemCon, Inc.* \_\_ Fed. Appx. \_\_ (Fed. Cir. 2012)(Order)(en banc)(per curiam), *panel opinion*, 659 F.3d 1084 (2011)(Dyk, J.), reconsideration en banc has been granted to determine whether intervening rights should apply against an *original* claim of the patent which received a narrowed interpretation in reexamination proceedings.

**Status:** An Order dated January 26, 2012, permits amici briefs if filed by February 10, 2012. (In its original Order on January 20, 2012, the court states that “[t]his appeal will be heard en banc on the basis of the originally filed briefs. No additional briefing or oral argument will be requested.”)

**Issue:** Whether intervening rights under 35 USC §§ 307(b), 316(b), can apply to an *original* claim of the patent?

**Discussion:** Intervening rights were determined to be present by the majority because original claims received a different (narrower) interpretation in post-grant reexamination proceedings *without changing the wording of the claims*.

The dissent points out that “[i]ntervening rights under 35 U.S.C. §§ 307(b) and 316(b) apply only to ‘amended or new claims.’ Thus only ‘amended or new claims’ have the effect specified in 35 U.S.C. § 252. Claims 12 and 20 were not new or amended. They are claims from the original patent and their language was not in any way changed. An unchanged original claim should not be considered to be changed for intervening rights purposes based in part on the cancellation during a separate reexamination proceeding of other claims in the patent.” *Marine Polymer*, 659 F.3d at 1096 (Lourie, J., dissenting).

**Conflict with the Principal Draftsman of the 1952 Patent Act:** The question of intervening rights can only arise when the only claims infringed are claims of the reissued patent which were not in the original patent. ...[I]f the defendant infringes repeated original claims he is liable for infringement, if he does not infringe repeated original claims but infringes only new or amended claims, then the question of intervening rights may be raised.” P.J. Federico, *Commentary on the New Patent Act*, 75 J. P & T. Off. Soc’y 161, 206-07 (1993).

**Conflict with Precedent from the Court of Claims:** The majority ruling is in conflict with the precedential ruling of one of the predecessor courts, *Regent Jack Mfg. Co. v. United States*, 155 Ct.Cl. 222, 235 (1961)) (“ Each [accused embodiment] is found to infringe claims 2 and 6 of the reissue patent, which two claims were also in plaintiff's original patent and are valid. Under these circumstances, no intervening rights accrued....”)

**Conflict with Sister Circuits:** *Weller Manufacturing Company v. Wen Products, Inc.*, 231 F.2d 795, 799 (7th Cir. 1956) (“ It is apparent that the argument [based on intervening rights] has no application if claim 3 is valid and infringed ...for claim 3 of the reissue is identical with claim 3 of the original patent.”); *Kansas City Southern Ry. Co. v. Silica Products Co.*, 48 F.2d 503, 508 (8th Cir. 1931) (“the first ten claims [ ] are identical with the ten claims of the original patent.... So far, therefore, as these ten claims are concerned, there can be no intervening rights....”)

### **(8) Taniguchi – Translation Costs**

In *Taniguchi v. Kan Pacific Saipan, Ltd.*, Supreme Court No. 10-1472, *opinion below*, 633 F.3d 1218 (9th Cir. 2011)(Rawlinson, J.), the Court is asked to resolve an inter-circuit conflict as to whether a federal court may tax document translation costs under 28 USC § 1920(6), a matter of interest in patent litigation involving overseas parties and international discovery.

**Status:** Argument February 21, 2012. A decision is expected before the end of June 2012.

**Question Presented:** “Section 1920 of 28 U.S.C. sets out the categories of costs that may be awarded to the prevailing party in a federal lawsuit. One of the listed categories is ‘compensation of interpreters.’ *Id.* § 1920(6).

“The question presented is whether costs incurred in translating written documents are ‘compensation of interpreters’ for purposes of section 1920(6).”

**Discussion:** The *res* of this suit is the cost of translations following grant of a motion for summary judgment by property owner Marianas Resort and Spa (Kan Pacific Saipan, Ltd.) in Japanese basketball player Kouichi Taniguchi 's personal injury action.

## Wegner's Top Ten Patent Cases [February 6, 2012]

---

***Patent Litigation Costs:*** While patents are not a focus of this case, Petitioner cites two patent cases, *Chore-Time Equip., Inc. v. Cumberland Corp.*, 713 F.2d 774, 782 (Fed. Cir. 1983)(cited for the proposition that “[t]he award of costs for translation of a German patent ... was appropriate under 28 U.S.C. § 1920(6).”); and *Studiengesellschaft Kohle mbH v. Eastman Kodak Co.*, 713 F.2d 128, 133 (5th Cir. 1983) (cited as “affirming award of translation expenses as taxable costs”).

***Federal Circuit Relies on Taniguchi:*** Although the Federal Circuit *Chore-Time* opinion, *supra*, is directly on point, the Federal Circuit recently in *In re Ricoh Co., Ltd. Patent Litig.*, \_\_ F.3d \_\_ (Fed. Cir. 2011)(Dyk, J.), has reached the same conclusion but with reliance on the Ninth Circuit opinion now on review at the Supreme Court: “[T]he district court taxed Ricoh for all depositions taken in the case. ... Because translation was necessary in connection with a number of these depositions, those costs are taxable under section 1920 as well. See *Taniguchi v. Kan Pac. Saipan, Ltd.*, 633 F.3d 1218, 1221–22 (9th Cir. 2011).”

The *Ricoh* opinion does not mention that the *Taniguchi* case is now on appeal at the Supreme Court.

### **(9) *Saint–Gobain v. Siemens* – Doctrine of Equivalents**

In *Saint–Gobain Ceramics & Plastics, Inc. v. Siemens Medical Solutions USA, Inc.*, Supreme Court No. 11-301, *opinion below*, *Siemens Medical Solutions USA, Inc. v. Saint–Gobain Ceramics & Plastics, Inc.* 647 F.3d 1373 (Fed Cir. 2011)(Lourie, J.), *reh’g den*, 647 F.3d 1373 (2011), the Supreme Court has asked the Solicitor General for the views of the United States whether to grant *certiorari* in a case involving standards for establishing the doctrine of equivalents. With four separate opinions supporting or opposing denial of rehearing en banc, such an intra-circuit split in an appellate court handling virtually all patent appeals presents an inviting challenge for grant of review.

***Status:*** Awaiting a CVSG brief from the Solicitor General expressing the views of the United States whether the Court should grant *certiorari*. (The Order asking for such briefing was issued November 7, 2011.)

***Questions Presented (per Petitioner):*** “The [PTO] determines whether the standards governing patentability are met, including whether a claimed invention is non-obvious over prior art. 35 USC § 103. Where the PTO finds that these standards are satisfied, the resulting patent (and the patentability determinations

## Wegner's Top Ten Patent Cases [February 6, 2012]

---

underlying it) are presumed valid, *id.* § 282, and that presumption can be overcome only by clear and convincing evidence. *Microsoft Corp. v. i4i. Ltd. P'ship*, 131 S. Ct. 2238 (2011). In light of this scheme, the questions presented are:

“1. Whether the PTO's presumptively valid finding that an invention is not obvious and is thus patentable over a prior art patent is impermissibly nullified or undermined when a jury is allowed to find, by a mere preponderance of the evidence, that the patented invention is ‘insubstantially different’ from the very same prior art patent, and thus infringes that prior art patent under the ‘doctrine of equivalents.’”

“2. Whether, as the dissent below warned, the Federal Circuit's failure to impose a heightened evidentiary standard to ensure that juries do not use the doctrine of equivalents to override the PTO's presumptively valid non-obvious determinations undermines the reasonable reliance of competitors and investors on such PTO determinations, thereby intolerably increasing uncertainty over claim scope, fostering litigation, ‘deter[ring] innovation and hamper[ing] legitimate competition.’ App. 89a (Dyk, J., dissenting from the denial of rehearing en banc).”

*Questions Presented (per Respondent):* “For over 120 years, patent holders have been required to prove claims of infringement by a preponderance of the evidence. *Bene v. Jeantet*, 129 U.S. 683 (1889). When the claim of infringement is brought under the doctrine of equivalents and there is evidence that the accused product is covered by a second patent, courts have consistently held that the second patent is simply relevant evidence to the claim of infringement, but neither alters the standard of proof nor creates a presumption of noninfringement.

“The petition presents the following questions:

“1. Whether the trial court and the court of appeals both correctly declined to rewrite the standard for proving infringement under the doctrine of equivalents to require heightened, clear-and-convincing, proof of infringement for the first time in U.S. history.

“2. Whether, in a case in which no party raised a claim or defense of invalidity, the trial court properly declined to instruct the jury that the second patent - presented only for evidentiary purposes was presumptively valid.”

## Wegner's Top Ten Patent Cases [February 6, 2012]

---

***Rader, C.J., in support of denial of rehearing en banc:*** “The jury properly reached, and the district judge properly upheld, the doctrine of equivalents verdict in this case. A major, if not the primary, purpose of the doctrine of equivalents is to protect inventions from infringement by after-arising technology.

At its heart, the patent system incentivizes improvements to patented technology. Indeed the Patent Act itself provides patent protection to inventions and discoveries, then specifically extends that protection to ‘improvement[s] thereof.’ 35 U.S.C. § 101. Inventing an improvement to patented inventions, however, does not entitle such an inventor to infringe the underlying patented technology. The doctrine of equivalents ensures that both the basic inventor and the inventive improver obtain their deserved protection.

“Without the doctrine of equivalents, improving technology could deprive basic inventors of their rights under the patent system. This court examined those principles in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*:

“A primary justification for the doctrine of equivalents is to accommodate after-arising technology. Without a doctrine of equivalents, any claim drafted in current technological terms could be easily circumvented after the advent of an advance in technology. A claim using the terms ‘anode’ and ‘cathode’ from tube technology would lack the ‘collectors’ and ‘emitters’ of transistor technology that emerged in 1948. Thus, without a doctrine of equivalents, infringers in 1949 would have unfettered license to appropriate all patented technology using the out-dated terms ‘cathode’ and ‘anode’. Fortunately, the doctrine of equivalents accommodates that unforeseeable dilemma for claim drafters. Indeed, in *Warner–Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 37 (1997), the Supreme Court acknowledged the doctrine's role in accommodating after-arising technology.’

“234 F.3d 558, 619 (Fed.Cir.2000)(en banc) (Rader, J., concurring).

“Of course, if an equivalent was foreseeable as available technology at the time of filing, the applicant has an obligation to claim that technology. If the applicant discloses, but does not claim, foreseeable technology, that subject matter enters the public domain. *Johnson & Johnston Assocs. Inc. v. R.E. Serv. Co., Inc.*, 285 F.3d 1046 (Fed.Cir.2002) (en banc) (per curiam). ‘[A]n equivalent is foreseeable if the

## Wegner's Top Ten Patent Cases [February 6, 2012]

---

equivalent was generally known to those skilled in the art at the time of amendment as available in the field of the invention as defined by the pre-amendment claim scope.’ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 493 F.3d 1368, 1380 (Fed.Cir.2007); *Sage Prods. Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1424 (Fed.Cir.1997); *Johnson*, 285 F.3d at 1056–59. In other words, ‘[t]he applicant is charged with surrender of foreseeable equivalents known before the amendment, not equivalents known **after** the amendment.’ *Festo*, 493 F.3d at 1380 (emphasis added). Thus, the doctrine of equivalents allows patent owners to cover after-arising technology.

“In sum, this court in *Siemens Med. Solutions USA, Inc. v. Saint–Gobain Ceramics & Plastics, Inc.*, 637 F.3d 1269 (Fed.Cir.2011), correctly applied the doctrine of equivalents to after-arising technology and correctly maintained the proper evidentiary burden for the infringement inquiry.” *Siemens Medical Solutions*, 647 F.3d at 1375-76 (Rader, C.J., joined by Newman, Lourie, Linn, JJ., concurring in den. of pet. for reh’g en banc).

***Dyk, J., in dissent from denial of rehearing en banc:*** “[W]here the purported equivalent is embodied in a subsequent patent, the finder of fact should afford a presumption of validity to the subsequent patent. Contrary to the panel majority’s suggestion, the Supreme Court did not hold to the contrary in *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30 (1929). There, the Court found a patent infringed under the doctrine of equivalents even though the accused device was claimed in a subsequent patent. *Id.* at 43; *see Siemens*, 637 F.3d at 1280. But the Court found that the equivalent was ‘merely a colorable departure from the [claimed] structure’ and was a ‘close copy which [sought] to use the substance of the invention ... [to] perform precisely the same offices with no change in principle.’ *Sanitary Refrigerator*, 280 U.S. at 41–42. The Court’s only reference to the subsequent patent was a single sentence stating: ‘Nor is the infringement avoided, *under the controlling weight of the undisputed facts*, by any presumptive validity that may attach to the [subsequent] patent by reason of its issuance after the [asserted] patent.’ *Id.* at 43 (emphasis added). Evidently, the Court found that the ‘controlling weight of the undisputed facts’ overcame the subsequent patent’s presumption of validity, not that the presumption of validity was irrelevant.

## Wegner's Top Ten Patent Cases [February 6, 2012]

---

“In short, a purported equivalent cannot be both insubstantially different and nonobvious, and in no event should the doctrine of equivalents permit a patent to capture another's subsequent invention that is novel and nonobvious. The majority's contrary approach will deter innovation and hamper legitimate competition.” *Siemens Medical Solutions*, 647 F.3d at 1379-80 (Dyk, J, joined by Gajarsa, Prost, JJ., dissenting from den. of pet. for reh'g en banc)(footnotes omitted).

***A Deeply Divided En Banc Federal Circuit:*** What greatly enhances the chance for grant of review is the presence of multiple opinions in connection with the denial of rehearing en banc which manifests a major intra-circuit split within the court that handles patent appeals. In addition to the two opinions quoted above supporting and dissenting from denial of rehearing en banc, additional opinions were filed in connection with the denial of rehearing en banc, there were two further opinions, *Siemens Medical Solutions*, 647 F.3d at 1374 (Lourie, J., joined by Rader, C.J., Newman, Linn, Moore, O'Malley, JJ., concurring in den. of pet. for reh'g en banc); *Siemens Medical Solutions*, 647 F.3d at 1376 (Newman, J., joined by Rader, C.J., Lourie, J., concurring in den. of pet. for reh'g en banc).

### **(10) *In re Lee* – Nonobviousness Double Patenting**

*In re Lee* is an expected appeal from the split Board decision in *Ex parte Lee*, App. No. 2011-002616, Ser. No. 10/850,072 (PTO Bd. App. & Int. 2011)(Grimes, APJ), where the Patent Office *reversed* an obviousness rejection based upon unexpected results in rebuttal of a prima facie case of obviousness, but *affirmed* a rejection on the same rationale but keyed to double patenting. The Board relies on *dicta* in several cases, overlooking *In re Papesch*, 315 F.2d 381 (CCPA 1963)(Rich, J.) and the reasoning of the *Papesch* line of case law. The *Papesch* line of case law is explained in Wegner, *Post-KSR Chemical Obviousness, déjà vu* (December 16, 2011), available at [www.GrayOnClaims.com/hal](http://www.GrayOnClaims.com/hal).

**Status:** A Notice of Appeal has not yet been filed. (The Board decision is dated December 16, 2011.)

**Discussion:** The reasoning of the Board is explained: “Appellant argues that the showing of unexpected results in the Lee Declaration rebuts the obviousness-type double patenting rejection for the same reason that it rebuts the rejections based on 35 U.S.C. § 103.

“We agree, however, with the Examiner that ‘while a Declaration showing unexpected results can overcome a [§] 103(a) obviousness rejection, the same Declaration cannot overcome an obviousness double patenting rejection’ (Answer 11). The Examiner’s position is supported by the case law. *See Geneva Pharms., Inc. v. GlaxoSmithKline PLC*, 349 F.3d 1373, 1378 n.1 (Fed. Cir. 2003) (‘The distinctions between obviousness under 35 U.S.C. § 103 and nonstatutory double patenting include: . . . Obviousness requires inquiry into objective criteria suggesting non-obviousness; nonstatutory double patenting does not.’); *Procter & Gamble Co. v. Teva Pharms. USA, Inc.*, 566 F.3d 989, 999 (Fed. Cir. 2009) (‘In general, the obviousness analysis applies to double patenting, except for three distinctions. . . . Finally, double patenting does not require inquiry into objective criteria suggesting non-obviousness.’).

“Thus, unexpected results cannot be relied on to rebut a rejection for nonstatutory, obviousness-type double patenting. . . .” (internal citations omitted).

### ***Apotex v. Unigene* – Chemical Nonobviousness**

In *Apotex, Inc. v. Unigene Laboratories, Inc.*, Supreme Court No. 11-879, *opinion below*, *Unigene Laboratories, Inc. v. Apotex, Inc.*, 655 F.3d 1352 (Fed. Cir. 2012)(Rader, C.J.), Petitioner challenges the Federal Circuit case law on chemical nonobviousness as being inconsistent with *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

**Status:** Response to the Petition is due February 17, 2012.

**Question Presented:** “In *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), this Court rejected the use of ‘mandatory formulas’ to determine whether a patent would have been obvious under 35 U.S.C. § 103 and instructed that courts must take an ‘expansive and flexible approach’ to the obviousness inquiry in *all* patent cases. Despite those clear directives, the Federal Circuit has continued to apply an inflexible and formalistic ‘lead compound’ test as the exclusive standard for determining obviousness of chemical compositions. The question presented is:

“Whether the Federal Circuit's rigid application of the ‘lead compound’ test to determine whether a patent directed to a chemical composition would have been obvious under 35 U.S.C. § 103 conflicts with *KSR* and impermissibly creates different patentability standards for chemical and nonchemical inventions.”

***Aerotel v. Telco*—“Means” Claiming**

In *Aerotel, Ltd. v. Telco Group, Inc.*, Supreme Court No. 11-871, *opinion below*, 433 Fed.Appx. 903 (Fed. Cir. 2011)(O'Malley, J.), Petitioner seeks grant of what would be a case of first impression at the Supreme Court, the interpretation of the “means” provision of 35 USC § 112, ¶ 6, that was introduced into the patent law nearly sixty years ago as part of the 1952 Patent Act.

**Status:** A Response to the Petition is due February 13, 2013.

**Question Presented:** “The 1952 Patent Act authorizes patent claims that describe ‘[a]n element in a claim \*\*\* as a *means* \*\*\* for performing a specified function without the recital of structure.’ 35 U.S.C. 112, ¶ 6 (emphasis added). When drafted this way, the ‘claim shall be construed to cover the corresponding structure \*\*\* described in the specification *and equivalents thereof.*’ *Ibid.* (emphasis added). Congress endorsed this special manner of drafting ‘means’ claims to remove the doubt that this Court's decision in *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1 (1946), had cast on using functional language in claims.

“Although this Court has never construed a ‘means-plus-function’ patent claim, the Federal Circuit, prior to this appeal, has recognized that the language of Paragraph 6 requires that such claims be construed in a multi-step process. The court first identifies the function based on the ordinary meaning of the words recited in the claim itself. Only thereafter does the court identify the structures disclosed in the specification that correspond to the claimed function. A means-plus-function claim covers all disclosed structures as well as equivalent structures. *Micro Chem., Inc. v. Great Plains Chem. Co.*, 194 F.3d 1250, 1258 (Fed. Cir. 1999).

“The question presented is whether a court errs when, as in this case, it conflates the multiple steps for construing means-plus-function claims and narrows the ordinary meaning of the claimed function by reading into it limitations of a disclosed embodiment, thereby effectively eliminating the benefits of a means-plus-function type of claim that Congress endorsed in Section 112, ¶ 6.”

**Discussion:** The leading case on the interpretation of a “means” defined claim is *In re Donaldson Co.*, 16 F.3d 1189 (Fed.Cir.1994) (en banc)).

***Janssen v. Abbott – Ariad “Possession”***

In *Janssen Biotech, Inc. v. Abbott Laboratories*, Supreme Court No. 11-596, *opinion below*, *Centocor Ortho Biotech, Inc. v. Abbott Laboratories*, 636 F.3d 1341 (Fed. Cir. 2011)(Prost, J.), Petitioner challenges the “possession” requirement for enablement under *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1354 (Fed.Cir.2010)(en banc).

**Status:** Conference February 17, 2012, with decision on certiorari likely February 21, 2012.

**Question Presented (per Petitioner):** “The Patent Act provides, in relevant part:

“The specification [for a patent] shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.’

“35 U.S.C. § 112 (2010). The Federal Circuit has read into Section 112 a ‘written description’ mandate that goes beyond disclosing the invention and enabling others to make and use it. The question presented is:

“Whether Section 112 forecloses the Federal Circuit's written-description mandate, which in implementation (i) has required a heightened, actual-reduction-to-practice standard for biotechnology patents, (ii) has licensed de novo appellate review of what the Federal Circuit labels a fact question, and (iii) has led to substantial unpredictability and instability in patent protection.”

**Question Presented (Per Respondent):** “Did the court of appeals correctly apply the written description requirement of 35 U.S.C. § 112 in holding that no reasonable jury could find that a 1994 patent application directed to chimeric anti-TNF $\alpha$  antibodies provided written description support for later-added claims to fully-human, high-affinity, neutralizing, A2-specific anti-TNF $\alpha$  antibodies that the patentees added to ‘ensnare’ antibodies that respondents had already invented and patented?”

## Wegner's Top Ten Patent Cases [February 6, 2012]

---

**Discussion:** The panel opinion below restates the *Ariad* standard:

“To satisfy the written description requirement, ‘the applicant must ‘convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention,’ and demonstrate that by disclosure in the specification of the patent.’ *Carnegie Mellon Univ. v. Hoffmann–La Roche Inc.*, 541 F.3d 1115, 1122 (Fed.Cir.2008) (quoting *Vas–Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed.Cir.1991)). Assessing such ‘possession as shown in the disclosure’ requires ‘an objective inquiry into the four corners of the specification.’ *Ariad*, 598 F.3d at 1351. Ultimately, ‘the specification must describe an invention understandable to [a person of ordinary skill in the art] and show that the inventor actually invented the invention claimed.’ *Id.* A ‘mere wish or plan’ for obtaining the claimed invention is not adequate written description. *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1566 (Fed.Cir.1997).”

*Centocor*, 636 F.3d at 1348.

### **Perfect 10 v. Google – Preliminary Injunctions**

In *Perfect 10, Inc. v. Google, Inc.*, Supreme Court No. 11-704, *opinion below*, *Perfect 10, Inc. v. Google, Inc.*, 653 F.3d 976 (9th Cir. 2011)(Ikuta, J.), plaintiff seeks reversal of a denial of a preliminary injunction:

**Status:** Awaiting Conference. (Respondent’s brief was filed February 3, 2012.)

**Question Presented:** Did this Court's decision in *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006), overrule established precedent in virtually every circuit, that a showing of likelihood of success on the merits in a copyright infringement claim raises a presumption of irreparable harm for purposes of obtaining a preliminary injunction?

**Discussion:** The court grounded its conclusion on the basis that “[b]ecause Perfect 10 has not demonstrated that it would likely suffer irreparable harm in the absence of a preliminary injunction, we affirm the district court's denial of that relief.”

***Eastman v. Wellman – Claim Indefiniteness***

In *Eastman Chemical Co. v. Wellman, Inc.*, Supreme Court No. 11-584, *opinion below*, . 642 F.3d 1355 (Fed. Cir. 2011)(Rader, C.J.), the question of indefiniteness under 35 USC § 112, ¶ 2, is raised.

**Status:** Conference February 17, 2012, with decision on certiorari likely February 21, 2012.

**Question Presented:** “Under 35 U.S.C. § 112, ¶ 2, a patent holder must definitively claim the subject matter covered by the patent. The district court below held that the patents in issue, covering a special plastic used for bottles containing hot liquid, were invalid for indefiniteness because a skilled artisan could not determine from the patent how to prepare samples for testing to assess whether those samples infringed any of the patent claims. The Federal Circuit reversed, joining one of two conflicting lines of its precedent, and held that the patent claims were not invalid for indefiniteness because the claims were ‘amenable to construction.’”

“The question presented is:

“Whether the legal standard for patent indefiniteness is an artificial and blunt rule assessing whether patent claims are ‘amenable to construction,’ or a more textually grounded and nuanced rule assessing whether the patent notifies a skilled artisan of the bounds of the patent claims and what would infringe those claims.”

***Hynix Semiconductor v. Rambus – Prosecution laches***

In *Hynix Semiconductor Inc. v. Rambus Inc.*, Supreme Court No. 11-549, *opinion below*, 645 F.3d 1336 (Fed. Cir. 2011)(Linn, J.), petitioner challenges the delayed issuance of patents under an equity theory keyed to prosecution laches case law.

**Status:** Conference February 17, 2012, with decision on certiorari likely February 21, 2012.

**Questions Presented:** “1. Whether principles of equity recognized in *Miller v. Brass Co.*, 104 U.S. 350 (1882), and *Woodbridge v. United States*, 263 U.S. 50 (1923), foreclose the infringement claims of a participant in a standard-setting organization that conceals its pending applications while secretly amending its claims to cover the emerging standard; delays the issuance of its amended claims

## Wegner's Top Ten Patent Cases [February 6, 2012]

---

until after it has exited the organization; and then alleges that standard-compliant products infringe claims descending from the concealed applications.

“2. Whether the specification and the prosecution history of a patent are the principal guides to construction of the patent's claims, as the Federal Circuit held in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), or whether the specification and the prosecution history are relevant only if they amount to a “clear disclaimer or disavowal” of the dictionary meaning of claim terms, as the Federal Circuit held in this case.”

### ***In re Youman – Recapture Rule***

In *In re Youman*, Fed. Cir. 2011-1136, appellant challenges the recapture rule.

**Status:** Awaiting decision (argued December 9, 2011 (Lourie, Schall, Prost, JJ.))

**Issues (Per Appellant):** “1. Did the Board of Appeals and Patent Interferences err as a matter of law in affirming the Examiner's decision rejecting Appellants' reissue claims for violating the Recapture Rule, where the reissue claims modify a limitation that was added during the original prosecution to overcome prior art but do not entirely eliminate that limitation, such that the limitation continues to materially narrow the reissue claims relative to the surrendered subject matter so that the surrendered subject matter has not crept into the reissue claim?”

“2. Did the Board of Appeals and Patent Interferences err as a matter of law in affirming the Examiner's decision rejecting Appellants' reissue claims for violating the Recapture Rule, by applying a *per se* rule requiring the rejection of any reissue claim that omits, *or broadens* in any way, any limitation that was added or argued during the original prosecution to overcome a prior art rejection, where such a rule conflicts with settled case law of this Court?”

**Issues (Per Appellee PTO):** “...The issue raised in this appeal is whether, by amending the claims in the original application to require a means for cycling forward and/or backward through alphanumeric characters, Youman surrendered to the public other means for changing the characters.”

***In re Staats – Broadening Reissue***

In *In re Staats*, Fed. Cir. No. 2010-1443, appellant-reissue applicant had filed a broadening reissue within two years from grant and subsequently added additional claims after that time; the Board distinguished *In re Doll*, 419 F.2d 925 (CCPA 1970)(sanctioning this practice) on the basis that the further broadened invention was to a ‘different embodiment’ than the original reissue claims.

**Status:** Awaiting decision; argument Sept. 8, 2011. (Dyk, O’Malley, Reyna, JJ.)

**Issue Presented (per appellant):** “This case concerns the circumstances under which patent claims may be broadened through a reissue application under 35 U.S.C. §251. Under §251, any reissue application that broadens the patent's claims must be filed within two years of the patent's issuance. Four decades ago, this Court's predecessor held in *In re Doll* that, so long as ‘a broadening reissue application [i]s on file within the two year period,’ the patent's ‘claims c[an] be further broadened after the two year period.’ *In re Fotland*, 779 F.2d 31, 34 (Fed. Cir. 1985) (citing *In re Doll*, 419 F.2d 925 (CCPA 1970)). Here, on the two-year anniversary of the patent's issuance, the inventors filed a broadening reissue application. Later, in a continuation application, the inventors sought to broaden additional claims. A Board panel held that, because the later broadening concerned a ‘different embodiment’ of the invention than the first reissue application, it was ‘unforeseeable’ and impermissible under § 251. The question presented is:

“Whether the Board's rejection of the broadening based on its new ‘different embodiment’ or ‘foreseeability’ requirement is contrary to the statute, inconsistent with precedent, in conflict with Patent and Trademark Office rules and guidance, or otherwise arbitrary, capricious....”

**Issue Presented (per PTO):** “Section 251 of the Patent Act permits broadening of claims in a reissued patent, but requires the broadening to be applied for ‘within two years from the grant of the original patent.’ 35 U.S.C. § 251, ¶ 4. The two-year limit was designed to give the public prompt notice that broadening was to occur as well as an identification of the subject matter to be broadened.

“[A] first broadening reissue application [was filed] within two years of the original patent grant and a second broadening reissue application (as a continuing

## Wegner's Top Ten Patent Cases [February 6, 2012]

---

reissue) further broadening the same subject matter. Then, nearly eight years after the original patent grant, Staats presented additional broadened claims drawn to different subject matter in a third reissue application (a second continuing reissue). His newly-presented broadened claims were drawn to subject matter unrelated to, and unforeseeable from, the subject matter identified and broadened in his earlier reissue applications and claimed in his original patent. Although this Court has interpreted section 251 to permit broadening outside the two-year limit under certain circumstances, it has permitted such broadening only in the factual context where that broadening was related to, and foreseeable from, subject matter identified and broadened earlier within the two-year limit.

“The issue in this case is whether the Board properly construed section 251 to prohibit broadened claims presented nearly eight years after the original patent grant in a continuing reissue application drawn to subject matter unrelated to, and unforeseeable from, subject matter identified and broadened in an earlier reissue filed within the statutory two-year limit.”

***Classen v. Biogen – Mayo v. Prometheus déjà vu***

A Supreme Court petition for *certiorari* is expected in *Classen Immunotherapies, Inc. v. Biogen IDEC*, opinion below, \_\_ F.3d \_\_ (Fed. Cir. 2011)(Newman, J.), on remand from the Supreme Court upon Order granting, vacating and remanding in light of *Bilski*, 130 S.Ct. 3541 (2010), earlier Federal Circuit opinion, 304 Fed.Appx. 866 (Fed. Cir. 2008)(Moore, J.), a clone is presented of the fact pattern of both No. (2) *Mayo v. Prometheus* and the *Metabolite* case. The trial court opinion is reported at 381 F.Supp.2d 452 (2005).

**Status:** A petition for *certiorari* is due February 28, 2012, based upon, the November 30, 2011, denial of the petition for rehearing *en banc* at the Federal Circuit.

**Piggybacking Off Mayo v. Prometheus:** It is expected that if there is a petition for *certiorari* the Court will hold the petition until after a merits decision in No. (1) *Mayo v. Prometheus*, after which the Court could either simply deny *certiorari* or issue yet a further GVR order sending the case back once again to the Federal Circuit.

The three member panel issued three separate opinions including one by the Chief Judge (joined by the writer of the majority opinion) and a dissent by the author of the original opinion for a then-unanimous panel.

**First Panel Opinion, One of the Shortest Merits Opinions in History:** The original panel opinion consists of less than 100 words: “In light of our decision in *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (en banc), we affirm the district court's grant of summary judgment that these claims are invalid under 35 U.S.C. § 101. Dr. Classen's claims are neither ‘tied to a particular machine or apparatus’ nor do they ‘transform[ ] a particular article into a different state or thing.’ *Bilski*, 545 F.3d at 954. Therefore we *affirm*”

***Soverain v. Newegg – “All Elements” (Centillion)***

*Soverain Software LLC v. Newegg Inc.*, Fed. Cir. No. 2011-1009, as one of the several issues on appeal, questions an infringement judgment of a “systems” claim, raising issues following *Centillion Data Systems, LLC v. Qwest Communications Intern., Inc.*, 631 F.3d 1279 (Fed. Cir. 2011)(Moore, J.).

**Status:** Awaiting decision; argument August 4, 2011 (Newman, Prost, Reyna, JJ.)

**Issue as Phrased by Appellant:** “Did the district court misapply the all-elements rule by... refusing to enter judgment as a matter of law that Newegg did not induce infringement of the system claims ..., given that Newegg and its customers separately owned and controlled distinct components of the accused system...?”

**Discussion:** This case presents a challenge to a District Court decision finding infringement of a system claim that now finds support from the Federal Circuit’s recent panel opinion, *Centillion Data Systems, LLC v. Qwest Communications International, Inc.*, 631 F.3d 1279, 1284 (Fed.Cir.2011)(Moore, J.) (“*NTP [, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1317 (Fed.Cir.2005),] ... interpreted the definition of ‘use’ under § 271(a). We hold that to ‘use’ a system for purposes of infringement, a party must put the invention into service, *i.e.*, control the system as a whole and obtain benefit from it.”).

***Minkin v. Gibbons, P.C. – Malpractice (Narrow Claims)***

In *Minkin v. Gibbons, P.C.*, Fed. Cir. No. 2011-1178, appellant-inventor charges malpractice against the firm that successfully prosecuted his patent application but (per appellant) failed to gain sufficiently broad coverage to block its competitor.

**Status:** Awaiting decision; arg. Sept. 9, 2011. (Rader, C.J., O'Malley, Reyna, JJ.).

**Issues (per plaintiff-appellant):** “1. Plaintiffs ...allege that defendant Gibbons, P.C., committed legal malpractice in prosecuting Minkin's United States patent application ...for a tool known as extended reach pliers ...[which] plaintiffs successfully marketed ... for a period of time until their largest customer began manufacturing it on its own, as the [ ] Patent had been drafted so narrowly as to provide no meaningful patent protection...Plaintiffs maintain that the District Court erred in requiring plaintiffs to present on a summary judgment motion a patentability analysis similar to that required in an invalidity trial, contrary to *Davis v. Brouse McDowell, L.P.A.*, 596 F.3d 1355 (Fed. Cir. 2010).

“2. In the District Court proceeding, through their expert, plaintiffs provided alternate claims language which they maintained could have been employed in defendant's application for a patent for the ERP, and would have provided meaningful patent protection to the ERP, which was lacking in the '363 Patent. Plaintiffs maintained that their expert's proposed claims language would have led to the issuance of a patent by PTO no less readily than did that drafted by defendant and incorporated into the '363 Patent. Plaintiffs provided two expert's reports, the second of which consisted solely of distinguishing plaintiffs' proposed claims language from the prior art. Plaintiffs maintain that the District Court erred in concluding that those expert proofs failed to satisfy plaintiffs' burden of making a *prima facie* case of non-obviousness of their proposed claims language.

“3. In this legal malpractice action, the parties and the lower court concurred that a ‘case within a case’ analysis was appropriate. Plaintiffs maintain that where such an analysis is employed in a legal malpractice action concerning an issued patent, and where the plaintiff must prove causation of loss through alternate claims language, the aspects of the underlying application process which are unaffected by the proposed alternate claims language should not require separate expert proofs in order for patentability to be established. Additionally, the procedural developments which actually occurred in the application process should be accorded relevance in assessing the outcome of the patent application in the absence of the defendant's negligence.”

***Defendant-Appellee's Statement of the Issues:*** “1. The issue on this appeal is whether the District Court correctly ruled that plaintiffs failed to demonstrate a genuine issue of fact for trial on the causation element of their case. More specifically, in this legal malpractice case, the question is whether the opinions of plaintiffs' proposed expert witness... present a triable question of case-within-a-case causation under New Jersey law.

“2. Plaintiffs' Statement of Issues No. 3 reprises a non-issue that was thoroughly vetted and correctly rejected below. There is no principle of law or patent examination procedure that provides for an assumption or inference that a finding of non-obviousness as to a set of patented claims, such as those in plaintiffs'[ ] patent at issue, is somehow transferable to “alternate” claims pertaining to the same device....

“3. Plaintiffs' Statement of the Issues No. 1 derives from an incorrect interpretation and analysis of this Court's decision in *Davis v. Brouse McDowell, L.P.A.*, 596 F. 3d 1355 (Fed. Cir. 2010).”

### ***Bowman v. Monsanto – Patent Exhaustion***

In *Bowman v. Monsanto Co.*, Supreme Court No. 11-796, *proceedings below*, *Monsanto Co. v. Bowman*, 657 F.3d 1341 (Fed. Cir. 2011)(Linn, J.), Petitioner challenges the denial of “patent exhaustion” as to harvested seeds produced from patented plant technology.

***Status:*** Response due February 27, 2012. (After Respondent waived a right to respond, the Court distributed the case for Conference for February 17, 2012, but then the next day requested a Response from Respondent by February 27, 2012.)

***Question Presented:*** “Patent exhaustion delimits rights of patent holders by eliminating the right to control or prohibit use of the invention after an authorized sale. In this case, the Federal Circuit refused to find exhaustion where a farmer used seeds purchased in an authorized sale for their natural and foreseeable purpose - namely, for planting. The question presented is:

“Whether the Federal Circuit erred by (1) refusing to find patent exhaustion in patented seeds even after an authorized sale and by (2) creating an exception to the doctrine of patent exhaustion for self-replicating technologies?”

***Chet's Shoes – Frivolous Petition***

In *Kastner v. Chet's Shoes, Inc.*, Supreme Court No. 11-776, *proceedings below, Chet's Shoes, Inc. v. Kastner*, \_\_ Fed.Appx.\_\_, 2011 WL 3416582 (Fed. Cir. 2011)(aff. Local Rule 36 without opinion)(Lourie, Moore, Reyna, JJ.), Petitioner complains that the appellate tribunal affirmed the District Court with a simple order without opinion.

**Status:** Conference February 17, 2012, with decision on certiorari likely February 21, 2012.

**Question Presented:** “Whether the U.S. Court of Appeals for the Federal Circuit can properly affirm an obviously incorrect district court holding with the single word, Affirmed [as part of an Order under Local Rule 36], thereby leaving the appellant completely without knowledge as to the basis for the affirmance.”

**Discussion:** Far too many petitions in the intellectual property arena lack any chance of success. The instant petition manifests a total lack of any relevant legal research whatsoever. Just months ago the very same issue was unsuccessfully raised in *Max Rack, Inc. v. Hoist Fitness Systems, Inc.*, 132 S.Ct. 54 (2011)(dismissing petition upon stipulation of the parties.)

The well settled acceptance by the judiciary of Rule 36 and the absence of inter-circuit conflicts are explained in the *Brief in Opposition to Petition for Writ of Certiorari* in the *Max Rack* case, 2011 Westlaw 2326719. Perhaps this pleading stimulated the stipulated dismissal of the *certiorari* petition.

There have been numerous cases in the past generation where Rule 36 has central to a petition:

**Certiorari Petitions since 1992 Challenging**

**Fed. Cir. Rule 36 Procedure**

*In re Bucknam*, 502 U.S. 1060 (1992)(Order denying certiorari) (*Third Question Presented*: “Can the United States Court of Appeals for the Federal Circuit properly disregard the requirement of 35 U.S.C. 144 that an opinion shall be rendered on appeals from the Patent and Trademark Office?”)

*Astronics Corp. v. Patecell*, 506 U.S. 967 (1992)(Order denying certiorari)(*Question Presented*: “In an appeal raising independently dispositive grounds ( *e.g.*, insufficient evidence; legal error in instructions), does a court impermissibly curtail the scope of appellate review by affirming without opinion where it finds the evidence sufficient to support a jury verdict, while not addressing dispositive legal error in jury instructions?”)

*Intermedics, Inc. v. Ventritex Co., Inc.*, 513 U.S. 876 (1994) (Order denying certiorari)(*First and Second Questions Presented*: “1. Whether a Court of Appeals errs when, in a case presenting a ‘difficult and significant’ issue of ‘first impression,’ it affirms without explanation or opinion a published District Court decision. 2. Whether the Court of Appeals for the Federal Circuit improperly departs from the accepted and usual course of appellate judicial proceedings in its use of its Local Rule of Practice 36, which provides for no-opinion affirmance.”)

*U.S. Surgical Corp. v. Ethicon, Inc. Johnson & Johnson*, 517 U.S. 1164 (1996)(GVR on a different *Question Presented* in light of *Markman v. Westview Instruments*, 517 U.S. 370 (1996))(*Question Presented*: “Whether the Court of Appeals for the Federal Circuit, when it summarily affirmed the judgment so as not to apply a soon-to-be-issued *en banc* ruling that would require a new trial in this case, so far departed from the usual and accepted course of judicial proceedings as to call for the exercise of this Court's power of supervision?”)

**Fed. Cir. Rule 36 Petitions (con'd)**

*Pirkle Therm-Omega-Tech v. Ogontz Controls Co.*, 516 U.S. 863 (1995)(Order denying certiorari)(*Third Question Presented*: “Whether a Court of Appeals panel's summary affirmance of an appeal, so as to avoid application of a rule of law of the Court in banc with which that panel disagrees, denies the appellants their statutorily granted right of appeal?”)

*Schoonover v. Wild Injun Products*, 516 U.S. 960 (1995)(Order denying certiorari)(*First Question Presented*: “Whether the Federal Circuit's continued improper use of Federal Circuit Rule 36 is contrary to appropriate appellate judicial procedure to warrant invocation of this Court's supervisory power.”)

*Donaldson Co., Inc. v. Nelson Industries, Inc.*, 516 U.S. 1072 (1996)(Order denying certiorari)(*Second Question Presented*: “Whether an Appeals Court may summarily affirm a district court judgment so as to effectively extend prior precedent to dramatically different facts, without rendering an opinion to provide guidance regarding its reasoning.”)

*Bowen v. Board of Patent Appeals and Interferences*, 530 U.S. 1263 (2000)(Order denying certiorari)(*First Question Presented*: “Has the Federal Circuit Erred By Issuing A Rule 36 Affirmance Without Opinion For A Question Of Law Requiring a *De Novo* Review Due To A Misinterpretation of *Dickinson v. Zurko*?”)

*Laberge v. Department of the Navy*, 541 U.S. 935(2004)(Order denying certiorari)(*First Question Presented*: “ Whether the Federal Circuit erred in issuing a Rule 36 decision in this case..., given that Merit Systems Protection Board [ ] Member Slavet's concurrence ... raised a significant question regarding the Federal Circuit precedence.”)

**Fed. Cir. Rule 36 Petitions (con'd)**

*Bivings v. Department of Army*, 541 U.S. 935 (2004)(Order denying certiorari)(*First Question Presented*: “Whether the Federal Circuit erred in issuing a Rule 36 decision in *Bivings v. Dep't of the Army*, given that Board Member Slavet's concurrence in *Laberge v. Dep't of the Navy* raised a significant question regarding the Federal Circuit precedence.”)

*DePalma v. Nike, Inc.*, 549 U.S. 811 (2006)(Order denying certiorari)(*Fifth Question Presented*: “Whether Rule 36 of the United States Court of Appeals for the Federal Circuit, which permits in certain circumstances the entry of judgment affirming without opinion, and Rule 47.6(b) of that court, which prohibits citation of unpublished opinions but has now been overruled by the new F.R.A.P. 32.1, improperly facilitate the rendering of inconsistent decisions among its panels and deprive parties of judgment according to *stare decisis*, as a matter of expediency, so as to call for an exercise of this Court's supervisory power?”).

*Hancock v. Department of Interior*, 549 U.S. 885(2006)(Order denying certiorari)(*Third and Fourth Questions Presented*: “[3.] Whether the Court of Appeals' clear restatement of [petitioner]'s procedural due process issues during oral argument obliged the Court of Appeals to address those issues in a written Opinion? [4.] Under the circumstances of this case, whether the Court of Appeals' invoking of Federal Circuit Rule 36 amounts to avoiding or neglecting the Court of Appeals' responsibility to provide a reasonable basis for its ultimate decision?”

*City of Gettysburg, South Dakota v. United States*, 549 U.S. 955 (2006)(Order denying certiorari)(*Question Presented*: “Whether this Court should exercise its supervisory authority to require that federal courts of appeals articulate some explanation or rationale for the disposition of appeals taken as a matter of statutory right.”)

**Fed. Cir. Rule 36 Petitions (con'd)**

*Tehrani v. Polar Electro*, 129 S.Ct. 2384 (2009)(Order denying certiorari)(*Third Question Presented*: “Whether the Court of Appeals for the Federal Circuit erred by affirming the district court's ruling, holding that numerous embodiments of [the patent] were dedicated to the public without providing any opinion or justification.”)

*Wayne-Dalton Corp. v. Amarr Co.*, 130 S.Ct. 503, (2009) (Order denying certiorari)(*Second Question Presented*: “ Does the Federal Circuit's practice of disposing of appeals with one-word judgments of affirmance and designating them as ‘non-precedential’ violate one or more of the following articles or amendments of the Constitution: Article III, Amendment I, and Amendment V?”).

*Romala Stone, Inc. v. Home Depot U.S.A., Inc.*, 131 S.Ct. 1055 (2011)(Order denying certiorari) (*First and Second Questions Presented*: “1. Did the Federal Circuit's use of Rule 36 in *this* case effectively deprive Romala of its statutory right of appeal? 2. Does Rule 36 when it is used by the Federal Circuit in *any* case effectively deprive appellants of their statutory right of appeal?”)

*White v. Hitachi, Ltd.*, 132 S.Ct. 115 (2011)(Order denying certiorari) (*Question Presented*: “At a minimum, the Supreme Court should grant certiorari, vacate the Federal Circuit's summary affirmance, and remand with instructions to issue a written opinion that informs the Court and the parties of the Federal Circuit's reasons for affirming the district court's summary judgment.”)

*Max Rack, Inc. v. Hoist Fitness Systems, Inc.*, 132 S.Ct. 54 (2011)(dismissing petition under Rule 46.1 following stipulation of the parties to dismiss)(*Question Presented*: “ Whether it is a denial of due process in violation of the Fifth Amendment to the United States Constitution for the Federal Circuit Court of Appeals to merely affirm a decision of the District Court on the scope of a patent property right with no expressed independent analysis of issues for which *de novo* review is required.”).