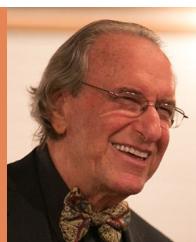


2011 FEDERAL CIRCUIT PATENT RULINGS



Paul J. Sutton
Sutton Magidoff LLP

Twenty eleven was an extremely busy year for the US ‘patent court’. The US Court of Appeals for the Federal Circuit heard dozens of patent appeals in 2011, and its decisions have had far-reaching consequences for inventors, patent practitioners and industry. In nearly half these appeals, the court overturned or vacated, in whole or in part, the lower district court’s decision, granting a win to the appellant.

Appellant victories

- Reversed a California district court’s award for discovery and copying costs, but affirmed the award insofar as depositions were concerned, in *Synopsys v Ricoh Company*.
- Reversed a Delaware district court’s refusal to award Robert Bosch a permanent injunction against Pylon Manufacturing.
- Reversed and remanded a California district court’s dismissal of Powertech Technology’s declaratory judgment action against Tessera based on lack of subject matter jurisdiction.
- Remanded Hemcon’s equitable intervening rights claim against Marine Polymer Technologies to the lower court in New Hampshire.
- Upheld a Delaware district court’s finding of patent invalidity and non-infringement in *Cordance v Amazon.com*.
- Granted *mandamus*, directing a California district court to vacate its order that disqualified law firm Floyd & Buss LLP in *Shared Memory Graphics v Nintendo*.
- Reversed a California district court’s dismissal of Ultramerical’s patent lawsuit against Hulu, YouTube and WildTangent, holding that the patent-in-suit claims a “process” within the meaning of US patent law.
- Vacated a New Hampshire district court’s summary judgment of non-infringement in *Markem-Imaje v Zipher and Videojet Technologies*.
- Reversed in part, affirmed in part and vacated in part (on remand from the US Supreme Court) *Classen Immunotherapies v Biogen Idec, Glaxosmithkline, Merck & Co.* relating to patent eligibility.

“ IN NEARLY HALF THESE APPEALS, THE COURT OVERTURNED OR VACATED, IN WHOLE OR IN PART, THE LOWER DISTRICT COURT’S DECISION. ”

- Reversed a Tennessee district court’s summary judgment of invalidity in *AIA Engineering v Magotteaux International S/A*.
- Affirmed the denial of Star Scientific’s JMOL (judgment as a matter of law), but reversed the Maryland district court’s denial of Star Scientific’s JMOL on validity, in its suit against R.J. Reynolds Tobacco Company.
- Reversed in part, affirmed in part, and remanded California grape grower Delano Farms’ royalty suit against The California Table Grape Commission and the US Department of Agriculture.
- Vacated a Minnesota district court’s judgment of patent infringement, damages award and an injunction in *August Technology v Camtek*.
- Reversed in part, affirmed in part, and vacated in part a Texas district court’s holding that MHL Teck has standing to assert three patents in suit and a summary judgment of non-infringement by Nissan Motor Co. *et al*.
- Reversed a Georgia district court’s summary judgment of patent invalidity in *CBT Flint Partners v Return Path and Cisco Ironport Systems*.
- Reversed in part a New York district court’s invalidity summary judgment involving Myriad Genetics’ human genetics patents, in a suit brought by



US PATENTS

- several medical organisations, researchers, genetics counsellors and patients.
- Reversed in part and affirmed in part a Florida district court's decision in *Creative Compounds v Starmark Laboratories*.
- Reversed a Delaware district court's patent claim construction in *Inventio AG v Thyssenkrupp Elevator Americas et al*.
- Remanded to a Minnesota district court its damages and attorney fees determination, and affirmed a Spectralytics infringement judgment against Cordis.
- Reversed a Missouri district court's non-infringement finding in Advanced Software Design's patent suit against Fiserv.
- Reversed a California district court's inequitable conduct/patent unenforceability decisions, greatly limiting this defence, in *Therasense v Becton, Dickinson et al*.
- Reversed a Georgia district court's dismissal of Arris Group's declaratory judgment suit against British Telecommunications, based on lack of subject matter jurisdiction.
- Reversed a Delaware district court's finding that Allergan Inc's patents were infringed by Apotex and Exela Pharmsci.
- Reversed a Delaware district court's sanction dismissing Rambus' defence in its suit against Micron Technology, but affirmed the court's finding that Rambus spoliated documents.
- Reversed a Delaware district court's invalidation of Wellman's patents in its suit against Eastman Chemical.
- Reversed an Ohio invalidation of Crown Packaging Technology's patents in its suit against Ball Metal Beverage Container.
- Granted a petition for a writ of *mandamus* to Verizon Business Network Services and affiliates, requiring a Texas district court to permit the transfer of the case to a more convenient forum.
- Vacated a Louisiana district court's summary judgment of non-obviousness in *Innovation Toys v MGA Entertainment*.
- Reversed an Ohio district court's award for attorney fees after a finding of wilful patent infringement in *Old Reliable Wholesale v Cornell Corp*.
- Granted a petition for a writ of *mandamus*, ordering an Illinois district court to dismiss the complaint with leave to amend, in *In Re BP Lubricants USA*.
- Reversed a California district court's summary judgment of invalidity of Hologic's patent, which was asserted against Senorx.
- Reversed a Texas district court's award to Centocor Ortho Biotech and NYU for \$1.67 billion in damages against Abbott Laboratories and affiliates, and invalidated the patent in suit.
- Reversed a Texas district court's dismissal of ABB's declaratory judgment complaint against Cooper Industries.
- Reversed an Indiana district court's summary judgment of non-infringement in *Centillian Data Systems v Qwest Communications*.
- Vacated a Pennsylvania district court's summary judgment of non-infringement in *Arlington Industries v Bridgeport Fittings*.
- Vacated a Michigan district court's dismissal of a legal malpractice complaint in patent dispute *Warrior Sports v Dickinson Wright*.
- Reversed a Kentucky district court's award for attorney fees after a non-infringement finding in *Ilor v Google*.

Appellant losses

- Affirmed a Florida district court's finding of wilful infringement and enhanced damages award, favouring Michael S Powell against The Home Depot USA.
- Affirmed a Nebraska district court's decision to award priority of invention in favour of Streck as a senior party in US Patent and Trademark Office interference proceedings against Research & Diagnostic Systems.
- Affirmed a New York district court's victory for Sanofi-Aventis, holding Apotex jointly and severally liable for damages in a dispute concerning the Hatch-Waxman Act (the Drug Price Competition and Patent Term Restoration Act of 1984).

US PATENTS

- Affirmed a Texas district court's judgment for Absolute Software in its dispute with Stealth Signal.
- Affirmed a Massachusetts district court's summary judgment of invalidity against Atlantic Research Marketing Systems in its patent fight with Stephen P. Troy Jr. and Troy Industries.
- Affirmed a Delaware district court's summary judgment of non-infringement against Bally Gaming International *et al* in their patent infringement fight with IGT.
- Affirmed an Ohio district court's denial of a new trial on infringement, but vacated the court's denial of a new trial on obviousness in Bettcher Industries' patent fight with Bunzl USA *et ano*.
- Affirmed a Wisconsin district court's JMOL that Boston Scientific does not literally infringe a Cordis patent.
- Affirmed an Indiana district court's summary judgment of patent infringement against Monsanto in its suit with Vernon Hugh Bowman.
- Affirmed a New York district court's victory for Unigene Laboratories and Upsher-Smith Laboratories in their patent fight with Apotex.
- Affirmed a Delaware district court's dismissal of Genetics Institute's patent interference action against Novartis patents.
- Affirmed a California district court's summary judgment of invalidity, favouring Retail Decisions in its patent fight against Cybersource.
- Affirmed a Washington state district court's finding of non-infringement for Flagstar Bancorp and sanctions in its patent dispute with Eon-Net LP and counsel Zimmerman & Levi, LLP.
- Affirmed a New York district court's summary judgment of non-infringement of Duramed Pharmaceuticals' patent under the doctrine of equivalents.
- Affirmed in part a Texas district court's patent infringement finding against Becton, Dickinson in its suit against Retractable Technologies and Thomas J. Shaw.
- Affirmed a New Mexico district court's decision against Leviton Manufacturing Co., finding that it relinquished its patent rights in its settlement agreement with plaintiffs General Protecht Group *et al*.
- Affirmed a California district court's non-infringement decision favouring American Honda Motor Co. in its patent litigation with American Calcar.
- Affirmed a New Jersey district court's summary judgment invalidating Tyco Healthcare Group's patent, in its suit against Mutual Pharmaceutical Company *et ano*.
- Affirmed a Delaware district court's finding that Boston Scientific patents are invalid in its suit against Johnson & Johnson, Cordis and Wyeth.
- Affirmed a Delaware district court's summary judgment for Hynix Semiconductor in its suit against Rambus, while vacating a spoliation finding.
- Affirmed a California district court's summary judgment of patent invalidity against Billups-Rothenberg in its suit with Associated Regional and University Pathologists *et al*.
- Affirmed a California district court's dismissal of a false marking *qui tam* action by Juniper Networks against Shipley.
- Affirmed a Tennessee district court's dismissal of Radio Systems' suit against Accession for lack of jurisdiction.
- Affirmed an Illinois district court's finding that Northgate Technologies *et al* infringed a Lexion Medical patent.
- Affirmed a Texas district court's finding of contempt and sanctions against Echostar *et al* and vacated in part other contempt findings in its suit against Tivo.
- Affirmed in part a Virginia district court's summary judgment invalidating claims in a Rembrandt Data Technologies patent in its suit against AOL *et al*.
- Affirmed a Virginia district court's summary judgment of non-infringement in *American Piledriving Equipment v Geoquip*, and reversed the claim construction that a California district court used for the same patent.
- Affirmed a Delaware district court's denial of Saint-Gobain's motion for a new trial, but vacated the damages award to Siemens Medical Solutions USA.
- Affirmed in part a California district court's non-infringement and invalidity findings in *Ronald A. Katz Technology Licensing LP v American Airlines et al*.
- Affirmed a California district court's summary judgment of patent invalidity in *Tokai v Easton Enterprises*.

Paul J. Sutton is a founding partner of Sutton Magidoff LLP. He can be contacted at: paul@suttonmagidoff.com

Paul J. Sutton, with a juris doctor degree, an 'AV Preeminent' highest Martindale-Hubbell rating, and four decades of intellectual property law counselling and litigation strategy experience, was honoured by *Super Lawyers* magazine, and is listed in Strathmore's *Who's Who*. He is adjunct professor of law at the Polytechnic Institute of New York University. Prior to practising law, Sutton was a member of the team that designed the Apollo Saturn third-stage booster rocket structure, which carried the first US astronauts to the Moon.