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QUESTIONS RE THE EFFECT OF FEDERAL CIRCUIT DECISIONS ON PATENT LITIGATION

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In view of Federal Circuit precedent, as compared to the status of the law prior to 1983:

1. A patentee is more likely to send out a cease and desist letter before bringing suit. VE Holding, 917 F.2d 1574; Tempco Elec. 819 F.2d 746
2. For purposes of appeal, a patentee is more likely to choose a jury over a judge to try his case.
3. The patentee, with clear evidence of infringement, should usually move for a preliminary injunction.
4. The presumption of validity of 35 U.S.C. Section 282 is stronger than ever.
Roper Corp. 757 F.2d 1266
5. The non-obvious defense is less likely to be successful when suing a company founded by the inventor of the patent-in-suit.
Diamond Scientific Co. v. Ambico, Inc., 848 F.2d 1220
6. The alleged infringer is more likely to stress the non-obviousness defense.
7. In defending a design patent infringement action, the alleged infringer should introduce evidence as to the level of ordinary skill in the art.
In re Cho, 813 F.2d 378
8. The alleged infringer is more likely to stress the lack synergism of the claimed invention.
Stratoflex Inc. v. Aeroquip, 713 F.2d 1530
9. The patentee is less likely to stress secondary considerations in the case in chief, relying on the presumption of validity.
Stratoflex Inc. v. Aeroquip Corp., 713 F.2d 1530
10. The on sale bar is less likely to succeed as a defense. UMC Electric, 816 F.2d 647
11. The enablement defense is less likely to succeed as a defense.
12. The defendant is more likely to conduct extensive discovery on how the invention was to be implemented at the time of filing of the application.
13. The defendant can succeed on an inequitable conduct defense by showing that a material reference, known to the patentee and his patent attorney during prosecution, through gross negligence, was not cited to the patent office. Kingsdown Medical Consultants, Ltd. v. Hollister, Inc., 863 F.2d 867
14. Infringement based on the doctrine of equivalents is less likely to be successful.

Principals:

Parts of patentee case Fed Circuit like, and certain defenses favored - go for them when pick issues to try.

ANSWERS:

1. False. VE Holding - corporate venue statute, personal jurisdiction Tempco - First to file even when DJ action
2. Not matter statistically; see pp. 860-61
3. False; 1989-mid 1993 only 1 out of 9 affirmed, and that was against patentee; no reversal where denied
4. True; Patent born valid. Roper Corp. V. Litton
If validity key issue, patentee wants jury and defendant wants judge because judge more likely that gov't wrong.
5. True. Assignor estoppel. Bring motion for partial summary judgment.
6. True; commercial success very important; affirmed 40% invalid for obviousness; affirmed not obvious 82%
7. True; not obviousness from eyes of an "ordinary intelligent man" or "ordinary observer".
8. True: lack of synergism not make invention obvious, but can be presence is indicative of obviousness, so if present, patentee should introduce.
9. False. Must be considered. Stratoflex
10. False - UMC reduction to practice not needed.
Invalid on-sale affirmed 63%
11. False. Vas-Cath - drawing alone sufficient. Almost all lack of enablement invalidity reversed, but best mode OK
12. True. Best mode defense has positive reception. Even authority that can be inadvertent, i.e. no intent.
Good equitable argument to give patentee black hat before jury.
13. Need intent to deceive. Gross negligence by itself insufficient.
14. True - gross negligence by itself sufficient, but retreated; only 46% are affirmed
15. True
Penwalt- need every element
Wilson - hypothetical claim
London v Carson Piren - exception rather than the rule.

Conclusions

1. Sue and then negotiate
2. Non-infringement defense is best, followed by best mode
3. Presumption of validity is great, particularly with commercial success; obviousness is tough issue to win on. Assignor estoppel.
4. Money recovery is significant.
5. Win at the trial court - Don't try your case for the Appeals court.
6. If validity is key issue, patentee wants jury and infringer wants judge. If infringement is key issue, patentee wants judge and defendant wants jury.