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Recent Development

RECENT DEVELOPMENTS IN PATENT LAW

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*184 I. Expansion of File Wrapper Estoppel

A. File Wrapper Estoppel Expanded to Match Decisions Narrowing the Doctrine of Equivalence'

In an opinion dated November 1, 1993, by Judge Plager, the Federal Circuit affirmed a summary judgment of non-infringement and reversed a grant of attorney fees by Judge Cohill of the Western District of Pennsylvania.²

The accused product was an alloy containing 20.74 to 20.81 percent chromium. The patent claim had a 22 percent chromium limitation. In all other respects, the claim limitations were satisfied by the accused product. During patent prosecution, the patentee had presented claims with successively more narrow ranges of chromium content.³ The patentee at no time amended its claims as to any material matter. Upon rejection over prior art, the patentee presented test data showing that 22 percent chromium resulted in unexpected advantages. After appeal to the Board of Patent Appeals, patentee canceled the broader claims and rewrote in independent form a claim having the 22 percent limitation.⁴ No doubt, the patentee believed that it would be entitled to a reasonable range of equivalents. However, 20.81 percent was not found to be within the range of equivalents due to file wrapper estoppel.⁵

It seemed significant to the Federal Circuit that the patentee had ignored a hint from the Board of Appeals that additional test data might justify the allowance of broader claims.⁶ The significance of this might have been lost on a scholar who assumes that file wrapper estoppel depends on the presence of amendments to the actual claim asserted that were specifically made to avoid prior art. However, the Federal Circuit in this decision (and in *Hoganas, infra*) makes it clear that such a view is incorrect. Rather, the standard for determining what has been relinquished during patent prosecution is to be “measured from the vantage point of what a competitor was reasonably entitled to conclude, from the prosecution history, that the applicant gave up to procure issuance of the patent.”⁷

The most significant statement in this opinion is the following:

In this case, a reasonable competitor could have concluded that Cabot, by canceling claims 1 and 4 and retaining claim 5, and failing to submit additional test data to procure the issuance of those claims in a continuation or reissue application, gave up coverage that would have included Jessop’s alloy.⁸

It seems very strange to assert that a reissue is an appropriate place to pursue claims canceled in the original prosecution. How could the cancellation be called error? This seems to be a ill-considered suggestion. However, the suggestion that a continuation application is necessary in order to avoid file wrapper estoppel seems down right pernicious. Judge Newman, in her concurrence, seems quite right to question this notion.⁹

However, disregarding mere dicta, the holding is fairly mainline, considering the current temper of the court. The Federal Circuit rejected the argument that there is no estoppel, “because Cabot never amended the original claim 5 during prosecution.”¹⁰ While a lot of attorneys out there seem to believe *185 this, it is not now and had never been the law. As the Federal Circuit states in this opinion: “We reject this argument because it exalts form over substance. It also conflicts with out precedent, which has consistently recognized a broad range of activities which can give rise to prosecution history estoppel.”¹¹ Contrary views held by certain members of the patent bar seem to be based upon wishful thinking and self justification.

Despite the ill-considered dicta relating to continuations and reissues, the result reached in the decision seems to be in line with the current trends in the Federal Circuit. In particular, “the broadening of prosecution history estoppel is a corollary to the narrowing of the doctrine of equivalents,” as Judge Newman correctly notes in her concurrence.¹² While Judge Newman and others may decry the narrowing of the doctrine of equivalents, it is clearly underway in the Federal Circuit and apparently irreversible.

*B. File Wrapper Estoppel Measured From the Point of View of the Competitor*¹³

In an opinion by Plager, the Federal Circuit affirmed a decision by Judge Lewis of the Western District of Pennsylvania who had, by summary judgment, found non-infringement with respect to a patent directed to a particular combination of materials used to form monolithic refractory linings for industrial furnaces.¹⁴

This case continues the expansion of the file wrapper estoppel begun ten days before in *Haynes*. A significant statement appears in the sixth footnote:

By its very nature, the doctrine of equivalents operates outside of the literal language of claims. Accordingly, through prosecution history estoppel, an applicant can be estopped from obtaining coverage of a particular range of equivalents even though the estoppel does not find expression in one of the claim terms. [No authority was cited.]¹⁵

As in *Haynes*, the Federal Circuit specifically asserts that the vantage point of a competitor will be used to measure the subject matter relinquished during patent prosecution.¹⁶ Citing a 1984 case,¹⁷ the Federal Circuit made the following assertion: “Our precedent dealing with this specific question recites that the test is measured from the vantage point of a reasonable competitor . . . [T]he point is the knowledge of one reasonably skilled in the art who views the question from the perspective of a competitor in the marketplace.”¹⁸

Also, as in *Haynes*, the patentee had not amended his claims.¹⁹ The Federal Circuit distinguished its decision in *Read Corp. v. Portec, Inc.*²⁰ on the grounds that of two distinctions made over prior art, only one would have been significant from the point of view of a competitor.²¹

***186 II. General Validity Issues**

A. Discredited Patent Given the “Coup de Grace” After Remand From the U.S. Supreme Court²²

Last term, the United States Supreme Court set an outer limit beyond which the Federal Circuit should not go in its arguably self-appointed mission of protecting patent validity.²³

The patent had been the subject of three separate lawsuits in two of which the patent had been held invalid²⁴ (the third is still pending), yet the Federal Circuit had refused to resolve the ongoing dispute over the issue of validity. In the particular case at bar, the district court had found the patent invalid and not infringed.²⁵ The Federal Circuit had determined the issue of invalidity moot in view of the finding of non-infringement.²⁶ The U.S. Supreme Court remanded the case to the Federal Circuit for consideration of the issue of validity. On remand the district court was affirmed in all respects.²⁷

In invalidity in the case at bar was based upon lack of enablement and claim indefiniteness²⁸ -- two areas that one would think are peculiarly within the expertise of the Federal Circuit and on which the Federal Circuit would be glad to venture an opinion without undue prompting. The district court had determined that “clear and convincing evidence has shown that the examples of the ‘881 patent do not produce the postulated compounds.”²⁹ Additionally, considerable evidence exists that those skilled in the art were unable to make the claimed compounds using the procedures of the specification.³⁰ The Federal Circuit admitted that the “fifty-odd examples in the patent obviously teach something,”³¹ but claimed that “the evidence shows that they did not teach what was allegedly defined in the claims.”³²

With respect to claim indefiniteness, the district court had found that one skilled in the art could not determine whether a given compound was within the scope of the claims. The Federal Circuit admitted that the “evidence shows that the claims at issue here are not sufficiently precise to permit a potential competitor to determine whether or not he is infringing.”³³

B. Sharp Disagreement Over the Meaning of the Claim Did Not Mandate a Finding That the Claim Was Indefinite, Even if the Patent Claimant’s Interpretation Was Found To Be Incorrect³⁴

In an opinion by Judge Lourie, the Federal Circuit affirmed-in-part and reversed-in-part a decision by Judge Griesa of the Southern District of New York who had found certain patent claims invalid for indefiniteness and not infringed.³⁵

***187** As for invalidity based on indefiniteness, the Federal Circuit found that the accused infringer had not met its burden under the clear and convincing standard to show that one of ordinary skill would not understand what is included within the claims. The Federal Circuit ruled that the claim clearly related to conjugates having a protein linkage at a single terminal portion of the polysaccharide, not at both terminal portions. “Thus, while the parties in the midst of a dispute have disagreed concerning the meaning of the claims, the claims are not so lacking in clarity as to be invalid under section 112.”³⁶

It was argued that a finding of indefiniteness would follow from a stipulation by the parties that some of the species might be inoperative. The Federal Circuit reasoned that the fact that dependent claims include species which might not meet the objects of the invention does not by itself prove that one skilled in the art cannot ascertain the scope of the asserted claims.³⁷ However, the Federal Circuit seemed to hint that an objection for lack of enablement might have been considered, if it had been presented.

A dissent by Rader asserted that “in a case the district court repeatedly characterized as ‘very close,’”³⁸ the trial court relied heavily on journal articles interpreting the claim and that this error justified reversal.³⁹ However, the dissent seemed to ignore the fact that review of claim construction is de novo, so that the district court’s analysis was somewhat irrelevant.

C. Request for Patent Reissue Requires Genuine Error, Not Just a Change of Strategy⁴⁰

This case involved a male condom catheter patent.⁴¹ The trial court, after obtaining jury answers to special interrogatories,

found the patent infringed.⁴² The Federal Circuit reversed trial court findings of infringement and non-invalidity.⁴³ Certain claims of the reissue patent were found invalid, because the amendment of the original claim was not based on “error” within the meaning of the statute allowing reissue.⁴⁴ The reissued patent owner argued “that recapture is avoided because newly added reissue claims are materially narrower in some respects, albeit broader in others.”⁴⁵ In an opinion by Lourie, the Federal Circuit found, as a matter of law, that “the reissue claims were broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution.”⁴⁶ In contrast, “the added limitations did not narrow the claims in any material respect compared to their broadening.”⁴⁷ “Since none of the reissue claims [met] the legal requirements for reissue, the trial court erred in denying the motion for judgment of invalidity as a matter of law.”⁴⁸ Where the reissue applicant had originally amended its claims “deliberately and intentionally” in response to a prior art rejection, the applicant could not recapture claims of the original scope.⁴⁹

188 D. *Equivalence of Accused Device to Apparatus Claim Saves Obvious Method From Oblivion⁵⁰

Method claims were held invalid as obvious,⁵¹ but apparatus claims implementing the method were entitled to a range of equivalents sufficient to expand from the claimed single enclosure to multiple enclosures.⁵² The Federal Circuit side stepped the issue of the obviousness of dependent claims of an invalid independent method claim. A stipulation among the parties was held to have tied the fate of the dependent claims to the fate of the independent claim.⁵³

The Federal Circuit led by Judge Rader affirmed a trial court finding of patent invalidity of a method patent (Light Microscopy Processing) on obviousness grounds.⁵⁴ Also affirmed was a finding that an apparatus patent was valid over charges that it was indefinite and non-enabling.⁵⁵ It was held that the district court properly invalidated dependent method claims in light of a stipulation that the invalid claim was representative.⁵⁶ The decision also upholds a trial court finding of infringement of the apparatus patent under the doctrine of equivalents.⁵⁷

The claims, specification, and drawings of the apparatus patent all disclosed “a single cabinet enclosing the tissue processing apparatus.”⁵⁸ The Federal Circuit believed that the trial court erred in finding infringement where the accused device was separated into three modules. However, the district court’s finding of infringement was affirmed.⁵⁹ “To allow Shandon to escape infringement simply because it used separate cabinets, as opposed to a single cabinet, is the exact type of injustice the doctrine of equivalents prevents.”⁶⁰

E. *Forged Prior Art Document Sinks Defense, Even if Not Shown to the Jury*⁶¹

Forgery indirectly connected to a finding of invalidity requires that the finding be overturned as a matter of public policy.

This decision reversed and remanded a finding of invalidity.⁶² An official of the accused infringer had forged a document in order to influence witnesses on the point of the existence of prior art. The trial court refused to overturn the jury’s finding of invalidity, because the trial court could not determine if any tainted testimony actually reached the jury.⁶³ Because the trial court’s Reconsideration Order found that some of the defense witnesses had seen the documents, the Federal Circuit determined that the trial court’s “conclusion in its Order that the trial was free of taint was based on clear factual error.”⁶⁴

*189 In addition, the Federal Circuit took the opportunity to point out that fraud in a patent case has effects extending beyond the parties to the litigation and is a matter of public concern.⁶⁵ Even though the trial court believed that there were two other independently sustainable grounds (obviousness and lack of adequate description)⁶⁶ on which the verdict of invalidity could be based, the Federal Circuit found that it was an abuse of discretion to allow any of the special verdicts of invalidity to stand.⁶⁷

III. Damages Issues

A. *Reasonable Royalty Rate Merely the Royalty Rate Offered to Other Companies Prior to Infringement*⁶⁸

Continuing prototype testing and development did not preclude the advent of the on-sale bar. The reasonable royalty rate used for infringement damages purposes may be merely the royalty rate offered to other companies prior to infringement.

In this case the Federal Circuit dealt with an unusually recalcitrant trial judge. For the second time, the Federal Circuit remanded and is asking the trial judge to prepare adequate findings of fact.⁶⁹ Previous remand resulted in mere conclusory findings.⁷⁰ The trial court said in its decision on remand: “This court found and now reaffirms its finding that the dealings prior to the bar date were for experimental purposes and not primarily for profit.”⁷¹ The Federal Circuit considered this a wholly inadequate response, because it merely reiterated “fact-dependent conclusions . . . just as it did in its original opinion.”⁷²

Possibly, the Federal Circuit is preparing to resolve some of the confusion about “on sale” bar requirements and wants a clear record from the trial court as a starting point.

B. Federal Circuit Hints That Patents Valued in Terms of Licensing Royalties Should Not Be the Subject of Lost Profit Damage Awards⁷³

The “but for” test for lost profits was reaffirmed. It was also hinted that patents that have been valued in terms of licensing royalties should not be the subject of lost profit damage awards.

This case involved intervening rights on reissue, evidence of price erosion, and appropriateness of an award for lost profits based upon market share.⁷⁴ The award of lost profits was reversed on the grounds that the patent owner did not show that the infringer’s customers would have otherwise purchased from the patent owner and other manufacturers in proportion to their market shares. The record showed that Windsurfing sold an obsolete board at the high end of the market, while BIC, the infringer, sold a more popular board at the low end of the market.⁷⁵ The patent owner’s boards were sold at a price up *190 to 80% above the infringer’s selling range.⁷⁶ The Federal Circuit held that the district court clearly erred by failing to apply the “but for” test before awarding lost profits. In doing so, the Federal Circuit found that the patent owner’s boards “differed fundamentally” from the infringer’s boards.⁷⁷ The authority cited was *Water Technologies Corp. v. Calco Ltd.*⁷⁸

C. Lost Profits Awarded From Date Marked Products First Consistently Sold, Even if Substantial Unmarked Units Already Sold⁷⁹

In an opinion by Michel, the Federal Circuit panel composed of Nies, Rader and Michel affirmed the trial court’s finding of willfulness and enhanced damages for infringement of a penile prosthesis device, and reversed and remanded a finding limiting recoverable damages to those incurred after the suit was filed (first notice date) based upon marking.⁸⁰ The lower court decision was by Judge Stadtmueller of the Eastern District of Wisconsin.⁸¹

The product (the “Flexi-Flate”) was “a hydraulic, inflatable, fluid-permeable silicone cylinder with a fluid reservoir and pump contained in the cylinder, which was self contained such that the entire prosthesis is implanted in the penis.”⁸² The accused infringer admitted copying the apparatus and method for packaging the Flexi-Flate after seeing an unmarked display at a trade show.⁸³ It was stipulated by all parties that the “wet pack Flexi-Flate” would infringe the patent, if the patent was valid.⁸⁴ After learning of the patent from its own in-house counsel, the Flexi-Flate was redesigned for an alternative packaging configuration.⁸⁵ However, the remaining inventory of the copied configuration was shipped even after the alternative configuration was available.⁸⁶ Lost profits were awarded from the date of actual notice to the date that the alternative configuration became available. After that, reasonable royalties were awarded. The trial court awarded enhanced damages using a 1.5 multiplier. Total damages awarded were \$1.4 million.⁸⁷

The issue was whether lost profits should be awarded all the way back to the date the patent issued? Did the finding of willfulness improperly ignore mitigating circumstances. The Federal Circuit found that lost profits should have been awarded from the date that marked products were first consistently sold, even if a substantial number of unmarked units had already been sold by that time.⁸⁸ The court further held that the finding of willfulness was not clearly erroneous in spite of efforts to find alternative designs and presence of oral opinions of invalidity.⁸⁹

***191 IV. Injunction Issues**

A. Construction of Long Lead Time Plant for Use of Patented Method After Patent Expiration Cannot Be Enjoined⁹⁰

In an opinion by Judge Nies, the Federal Circuit in an interlocutory appeal vacated and remanded a decision of Judge Farnan of the District of Delaware who had entered an injunction against infringement. The claims of the patent at issue were method claims directed to an improved process for desulfurizing flue gas produced from the combustion of fuels which contain sulfur.⁹¹ The following prohibition was the main issue of the appeal: “It is, however, evident that the district court intended to and, the parties agree, did enjoin Flakt from bidding or entering contracts or building a plant which will not be capable of carrying out”⁹² the patented process “until after the patent expires.”⁹³

In vacating the injunction and remanding it, the Federal Circuit noted that “the purpose behind an injunction must be to prevent the violation of any right secured by a patent.”⁹⁴ Further, the Federal Circuit noted that the injunction could not be justified as means of preventing direct infringement, because, “the law is unequivocal that the sale of equipment to perform a process is not a sale of the process within the meaning of section 271(a).”⁹⁵

As for an injunction to prevent active inducement or contributory infringement, the Federal Circuit held that “the injunction cannot be sustained on the ground that sales of equipment without use of the method within the patent term constitutes contributory infringement of the method claim.”⁹⁶

As for protection against future direct infringement, the court noted that periodic reports relating to the use of plants under construction would be preferable to an injunction prohibiting otherwise lawful sales activity.⁹⁷ The Federal Circuit warned the

district courts that “judicial restraint of lawful competitive activities . . . must be avoided.”⁹⁸ This decision should help the bar make some progress towards reforming the current tendency of issuing over-broad and vague injunctions after the conclusion of patent litigation.

V. Declaratory Judgments

*A. Assertion of “Strong Patent Position on Key Elements” of a Technology Does Not Create a Justiciable Controversy*⁹⁹

This case concerned whether or not an actual controversy existed sufficient to support an action for declaratory relief. The trial court plaintiff was a licensing company that did not manufacture. The claim was that its royalty income was being adversely affected by the reluctance of its licensees to risk infringing a Union Carbide patent.¹⁰⁰ Statements by Union Carbide included the following: “We have *192 strong patent positions on key elements of gas phase technology that we feel give our licensees an advantageous position.”¹⁰¹ The Federal Circuit held that there was no justiciable controversy.¹⁰² The Federal Circuit characterized this declaratory judgment action as one brought as a marketing strategy. An important element in this conclusion was that no manufacturer was a party.¹⁰³ However, the Federal Circuit viewed this case “as presenting a close factual question on the issue of reasonable apprehension of suit.”¹⁰⁴

Footnotes

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¹ Haynes Int’l, Inc. v. Jessop Steel Co., 8 F.3d 1573, 28 U.S.P.Q.2d (BNA) 1652 (Fed. Cir. 1993).

² *Haynes*, 8 F.3d at 1580.

³ *Id.* at 1576.

⁴ *Id.* at 1577.

⁵ *Id.* at 1580.

⁶ *Id.* at 1577.

⁷ *Id.* at 1578.

⁸ *Id.*

⁹ *Id.* at 1580-81.

¹⁰ *Id.* at 1579.

¹¹ *Id.*

¹² *Id.* at 1581.

¹³ *Hoganas AB v. Dresser Industries, Inc.*, 9 F.3d 948, 28 U.S.P.Q.2d (BNA) 1936 (Fed. Cir. 1993).

14 *Hoganas*, 9 F.3d at 949.

15 *Id.* at 950.

16 *Id.* at 952.

17 Prodyne Enters., Inc. v. Julie Pomerantz, Inc., 743 F.2d 1581, 1583, 223 U.S.P.Q. (BNA) 477, 478 (Fed. Cir. 1984).

18 *Hoganas*, 9 F.3d at 952 n.15.

19 *Id.* at 952.

20 970 F.2d 816, 824, 23 U.S.P.Q.2d (BNA) 1426, 1433 (Fed. Cir. 1992).

21 *Hoganas*, 9 F.3d at 953.

22 Morton Int'l, Inc. v. Cardinal Chem. Co., 5 F.3d 1464, 28 U.S.P.Q.2d (BNA) 1081 (Fed. Cir. 1993).

23 *Morton Int'l*, 5 F.3d at 1466.

24 Morton Thiokol, Inc. v. Argus Chem. Corp., 873 F.2d 1451, 11 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1989) (non-precedential).

25 *Morton Int'l*, 5 F.3d at 1467.

26 *Id.* at 1466.

27 *Id.* at 1467.

28 *Id.* at 1469.

29 *Id.*

30 *Id.* at 1469-70.

31 *Id.* at 1470.

32 *Id.*

33 *Id.*

34 North Am. Vaccine, Inc. v. American Cynamid Co., 7 F.3d 1571, 28 U.S.P.Q.2d (BNA) 1333 (Fed. Cir. 1993).

35 *North Am. Vaccine*, 7 F.3d at 1580.

36 *Id.* at 1579.

37 *Id.*

38 *Id.* at 1580.

39 *Id.*

40 *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 27 U.S.P.Q.2d (BNA) 1521 (Fed. Cir. 1993).

41 *Mentor Corp.*, 998 F.2d at 993.

42 *Id.* at 994.

43 *Id.* at 997.

44 *Id.* at 996-97.

45 *Id.* at 996.

46 *Id.*

47 *Id.*

48 *Id.* at 997.

49 *Id.* at 995-96.

50 *Miles Labs., Inc. v. Shandon, Inc.*, 997 F.2d 870, 27 U.S.P.Q.2d (BNA) 1123 (Fed. Cir. 1993).

51 *Miles Labs.*, 997 F.2d at 878.

52 *Id.* at 877.

53 *Id.* at 879.

54 *Id.* at 878.

55 *Id.* at 875.

56 *Id.* at 879.

57 *Id.* at 877.

58 *Id.* at 876.

59 *Id.*

60 *Id.* at 877.

61 *Fraige v. American-National Water-Mattress Corp.*, 996 F.2d 295, 27 U.S.P.Q.2d (BNA) 1149 (Fed. Cir. 1993).

62 *Fraige*, 996 F.2d at 296.

63 *Id.* at 297.

64 *Id.* at 298.

65 *Id.*

66 *Id.* at 299.

67 *Id.* at 300.

68 *Atlantic Thermoplastics Co., Inc. v. Faytex Corp.*, 5 F.3d 1477, 28 U.S.P.Q.2d (BNA) 1343 (Fed. Cir. 1993).

69 *Atlantic Thermoplastics*, 5 F.3d at 1478.

70 *Id.* at 1478-79.

71 *Id.* at 1479.

72 *Id.* at 1481.

73 *BIC Leisure Prods., Inc. v. Windsurfing Int'l, Inc.*, 1 F.3d 1214, 27 U.S.P.Q.2d (BNA) 1671 (Fed. Cir. 1993).

74 *BIC Leisure*, 1 F.3d at 1216-17.

75 *Id.* at 1216.

76 *Id.* at 1218.

77 *Id.* at 1219.

78 850 F.2d 660, 671, 7 U.S.P.Q.2d (BNA) 1097, 1106 (Fed. Cir. 1988), *cert. denied*, 488 U.S. 968, 109 S. Ct. 498, 102 L.Ed.2d 534 (1988).

79 *American Medical Sys., Inc. v. Medical Eng'g Corp.*, 6 F.3d 1523, 28 U.S.P.Q.2d (BNA) 1321 (Fed. Cir. 1993) ("*American Medical II*").

80 *American Medical II*, 6 F.3d at 1526-27.

81 *See American Medical Sys., Inc. v. Medical Eng'g Corp.*, 794 F. Supp. 1370, 26 U.S.P.Q.2d (BNA) 1081 (E.D. Wis. 1992) ("*American Medical P*").

82 *American Medical II*, 6 F.3d at 1527.

83 *Id.* at 1528.

84 *Id.* at 1529.

85 *Id.* at 1528.

86 *Id.* at 1528-29.

87 *Id.* at 1530.

88 *Id.* at 1538.

89 *Id.* at 1531-32.

90 *Joy Technologies, Inc. v. Flakt, Inc.*, 6 F.3d 770, 28 U.S.P.Q.2d (BNA) 1378 (Fed. Cir. 1993).

91 *Joy Technologies*, 6 F.3d at 771.

92 *Id.* at 772.

93 *Id.*

94 *Id.*

95 *Id.* at 773.

96 *Id.* at 776.

97 *Id.* at 776-77.

98 *Id.* at 777.

99 *BP Chems. Ltd. v. Union Carbide Corp.*, 4 F.3d 975, 28 U.S.P.Q.2d (BNA) 1124 (Fed. Cir. 1993).

100 *BP Chems.*, 4 F.3d at 978.

101 *Id.* at 979.

102 *Id.* at 980.

103 *Id.* at 980-81.

104 *Id.* at 980.