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Recent Development

RECENT DEVELOPMENTS IN PATENT LAW

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***224 I. Introduction**

This article reviews selected patent decisions that the author believes were the most significant, interesting, or noteworthy cases reported in The United States Patent Quarterly during September, October, and November of 1997. This Article is not intended to provide a comprehensive reference of all patent decisions during the relevant period. The selected cases discussed within this Article are organized by subject matter to facilitate the reader's review.

II. Patent Prosecution

A. Scope of Prior Art is Not Limited to its Preferred Embodiment: *Ultradent Products, Inc. v. Life-Like Cosmetics, Inc.*¹

Ultradent brought suit against Life-Like, a manufacturer and seller of dental bleaching compositions, asserting that Life-Like had infringed three of Ultradent's patents relating to dental compositions and methods for bleaching teeth: U.S. Patent No. 5,098,303 (the '303 patent), U.S. Patent No. 5,234,342 (the '342 patent), and U.S. Patent No. 5,376,006 (the '006 patent).² Life-Like counterclaimed, seeking a declaratory judgment of noninfringement and invalidity with respect to the asserted patents.³ In part, Life-Like contended in its motion for partial summary judgment that the asserted claims in the '303 and '342 patents were invalid because they were anticipated by the prior art.⁴

The critical language of the independent claims of these two patents recites a method for bleaching teeth that employs "a matrix material into which the dental bleaching agent ... is dispersed, said matrix material including carboxypolymethylene ... in the range from about 3.5% to about 12% by weight of the dental bleaching composition."⁵ Taking language directly from the specifications of both patents, the district court defined the term "carboxypolymethylene" to mean "a slightly acidic vinyl polymer with active carboxyl groups."⁶

The relevant prior art patent discloses an antiseptic composition for the treatment of mucous membranes in the oral cavity.⁷ In particular, this patent *225 discloses "the use of a carboxypolymethylene polymer, and preferably ... the use of the glycerol-soluble neutralized salts of such a polymer" to thicken the glycerol solvent.⁸ The patent further discloses that "amounts of from about 0.05 to about 5, preferably from about 0.1 to about 2, and more preferably from about 0.4 to about 1.5, weight percent" of polymer are used.⁹

The district court granted summary judgment in favor of Ultradent, holding that claims 1 of the '303 and '342 patents were not anticipated because the prior art did not disclose the use of a composition containing slightly acidic vinyl polymer with active carboxyl groups.¹⁰ In doing so, the court interpreted the prior art as having only disclosed a neutral salt of a carboxypolymethylene polymer, and not the "slightly acidic vinyl polymer with active carboxyl groups" referenced in the '303 and '342 patents.¹¹

The Federal Circuit reversed, holding that the district court erred in narrowly construing the scope of the prior art disclosure as being limited to its preferred embodiment.¹² The court stated that the prior art patent discloses the use of carboxypolymethylene in general, even though its preferred embodiment adds a quantity of neutralizing base.¹³ Thus, the scope of the prior art is not to be construed narrowly.

B. On-Sale Bar of Invention Under Development: *Pfaff v. Wells Electronics, Inc.*¹⁴

Pfaff, the owner of a patent directed to a socket for testing leadless chip carriers, brought a patent infringement suit against Wells Electronics.¹⁵ In response, Wells contended that certain claims—including the independent claim—in Pfaff's patent were invalid for being on sale more than one year prior to the patent application's filing date.¹⁶ The facts leading to Wells' contention are as follows.

*226 In November 1980, Texas Instruments (TI) contacted Pfaff, asking him to develop a test socket for its leadless chip carriers.¹⁷ In response to this inquiry, Pfaff sketched his concept and subsequently made detailed engineering drawings of the socket.¹⁸ He then sent these drawings to a tooling company for customized tooling and production in February or March of 1981.¹⁹ On April 8, 1981, a test manufacturer issued a written purchase order to Pfaff's company on behalf of TI for 30,100 test sockets for production use.²⁰ This purchase order confirmed an earlier verbal order placed on March 17, 1981.²¹ Pfaff

subcontracted this test socket order and received the manufactured sockets in July of 1981.²² Pfaff did not file his patent application until April 19, 1982.²³

The Federal Circuit began its analysis with the policy underlying the on-sale bar that “prevent[s] inventors from exploiting the commercial value of their inventions while deferring the beginning of the statutory term.”²⁴ The court considered all of the circumstances surrounding the sale or offer to sell, including the stage of development of the invention, the nature of the invention, and the manner in which the invention was sold.²⁵ A commercially satisfactory stage of development for the invention was not a requirement.²⁶

The court had no difficulty in holding that neither a reduction to practice nor a physical embodiment of the invention is a prerequisite to the application of the on-sale bar.²⁷ Instead, the court emphasized that the only step not fully performed at the time of sale was the invention’s customized tooling for production, but this step was routine in light of the nature of the invention.²⁸ Because the invention was substantially complete at the time of the sale such that there was reason to expect that it would work for its intended purpose upon completion, the court found that the invention was on sale within the meaning of 35 U.S.C. § 102(b)²⁹ prior to the critical *227 date of April 19, 1981.³⁰ The court held that these asserted claims were invalid as being on sale within the meaning of the statute, even though no physical embodiment of the invention had been produced at the time of the sale.³¹

C. On-Sale Bar with Respect to Invention Theft: *Evans Cooling Systems, Inc. v. General Motors Corp.*³²

This case also involves an interpretation of the on-sale bar pursuant to Section 102(b).³³ Evans filed a patent application for an aqueous reverse flow cooling system for internal combustion engines on July 1, 1992.³⁴ Therefore, the critical date in view of the statutory one-year on-sale bar, was July 1, 1991.³⁵

Evans conceived of his invention in 1984 and reduced it to practice in 1986.³⁶ In the spring of 1989, he held a demonstration of the invention at the General Motors (GM) test facility.³⁷ Evans alleged that GM stole his invention during this demonstration.³⁸ In April or May of 1991, GM sent an Order Guide for the 1992 Corvette to its independent dealers.³⁹ A supplemental brochure provided additional information specifically stating that the 1992 Corvette had reverse flow engine cooling—the LTI engine.⁴⁰ On June 13, 1991, a retail customer agreed to buy and paid a deposit on a 1992 Corvette with an LTI engine.⁴¹ GM records indicated that over 2,000 Corvettes with LTI engines were ordered before July 1, 1991, with over 300 orders on behalf of specific retail customers.⁴²

The Federal Circuit held that regardless of whether GM misappropriated the idea behind the LTI engine from Evans, the asserted patent was invalid because the dealership offered to sell and a retail customer agreed to buy a 1992 Corvette *228 containing the invention prior to July 1, 1991.⁴³ The court considered Evans’ argument for creating an exception to the on-sale bar but disagreed, stating:

There is not a single word in the statute which would tend to put an inventor, whose disclosures have been pirated, in any different position from one who has permitted the use of his process.... [I]solated instances of injustice may result if the law be strictly applied, but the inventor’s remedy is sure. He is master of the situation and by prompt action [in filing a patent application] can protect himself fully and render the defense of prior public use impossible.⁴⁴

According to the court, when there is a specific and definite offer for sale of a successfully tested device embodying every element of a later patented invention before the critical date, as evidenced by a completed contract for a sale that is clearly for commercial purposes, the analysis ends.⁴⁵ There is no basis in the language of the statute on which to carve an exception to the Section 102(b) bar for those instances in which a third party misappropriates the invention and later places the invention on sale or causes an innocent third party to place the invention on sale.⁴⁶ Thus, activities of third parties trigger the statutory bar of Section 102(b) even if those activities are instigated by the one who allegedly misappropriated the invention.

D. Patent and Trademark Office to Interpret Claims Broadly in Course of Prosecution: *In re Morris*⁴⁷

The issue in this case was the difference in scope between claim construction in an infringement proceeding versus a prosecution proceeding. Morris filed a patent application directed to an acoustic isolator for a disc drive assembly in which

the vibrations of the drive motors are dampened by the design of the housing.⁴⁸ The assembly includes a top and bottom housing attached to the motor, and acoustic dampening is achieved by thinning the portion of the housings around the area of the screws.⁴⁹ During prosecution, Morris amended the independent claim to recite “at least one acoustic compliance area integrally formed ... *as a portion of* a selected area of the support member.”⁵⁰ The claim was rejected as being anticipated by a *229 prior art patent by Brown in which an elastomeric isolator was added between the motor and the housing.⁵¹

Citing *Markman v. Westview Instruments, Inc.*,⁵² Morris appealed, arguing that the Patents and Trademark Office (PTO) is required to interpret the disputed language of the proposed claims in light of the specification in the same manner as courts are required to interpret claims in infringement proceedings.⁵³ The court did not agree, stating that decades of precedent permit the PTO to give a claim its broadest reasonable interpretation.⁵⁴

The court distinguished *Markman*, noting the differences in claim interpretation in prosecution versus infringement proceedings.⁵⁵ The presumption of validity does not attach until a patent has issued, so the applicant bears the burden of production to establish her entitlement to a patent.⁵⁶ Allowing the PTO to give claim language its broadest reasonable interpretation during prosecution promotes the development of the written record that provides public notice of what the applicant claims as the invention.⁵⁷ The court stressed that public notice is an important objective of patent prosecution.⁵⁸

The court also addressed Morris’ arguments based on *In re Donaldson*.⁵⁹ It rejected these arguments based on *Donaldson’s* discussion of means-plus-function language, a difference of fact, and the *Donaldson* court’s support for the PTO to give claims their “broadest reasonable interpretation.”⁶⁰

***230 III. Litigation**

A. Subject Matter Jurisdiction

The next two cases both deal with federal question subject matter jurisdiction. The results are different although not inconsistent. The key is to look to the substance of what the plaintiff has pleaded in the complaint.

1. No Subject Matter Jurisdiction Under Patent Law Where the Plaintiff Asserted Breach of Contract and Other State Law Claims: *McArdle v. Bornhofft*⁶¹

McArdle brought suit against Bornhofft in Maine state court, alleging breach of contract, defamation, and tortious interference with prospective economic advantage.⁶² Bornhofft removed the case to federal district court on the grounds that McArdle alleged patent infringement claims over which the district court has exclusive jurisdiction pursuant to 28 U.S.C. § 1338.⁶³

For a federal court to have jurisdiction under Section 1338(a), the plaintiff’s right to relief on one or more claims must “necessarily [depend] on a resolution of a substantial question of federal patent law, in that patent law is a necessary element of one of the well-pleaded claims.”⁶⁴

McArdle’s contract claim alleged that Bornhofft had breached a Privacy Agreement which prohibited Bornhofft from revealing information relating to, or from applying for a patent for a certain process purportedly developed by McArdle.⁶⁵ The defamation claim alleged that Bornhofft falsely told certain persons that McArdle was guilty of fraud and deceit in connection with the development and use of a compound for which McArdle holds three issued U.S. patents.⁶⁶ The tortious interference claims alleged that Bornhofft attempted to steer business away from them, thus delaying or preventing the establishment of commercial relationships.⁶⁷

*231 The court held that it did not have jurisdiction over the breach of contract claim.⁶⁸ The resolution of whether or not Bornhofft had disclosed confidential information in violation of the Privacy Agreement in no way implicated a question of federal patent law since the Agreement apparently imposed obligations of privacy, secrecy, and confidentiality, and restraint in patent applications, but did not mention patent infringement.⁶⁹

With respect to the defamation claim, the court stated that under Maine law, McArdle was not required to make any affirmative showing of the authenticity of his patents or of the propriety of his development and use of the patented

compound in his case in chief.⁷⁰ The court held that a challenge to the authenticity of any of McArdle's patents by Bornhoff is not sufficient to confer "arising under" jurisdiction in the court.⁷¹

Lastly, the court was unpersuaded by Bornhoff's argument that McArdle's tortious interference claims were in fact artfully pled patent infringement claims.⁷² The court stated that McArdle only needed to show that Bornhoff, by fraud or intimidation, procured a breach of contract.⁷³ That the allegedly tortious conduct may also constitute patent infringement was deemed irrelevant.⁷⁴

Determining that it lacked jurisdiction over all of McArdle's claims, the court remanded the case to state court.⁷⁵ The court observed that "the plaintiff is master of its own claim and can choose to keep its suit in state court if its well-pleaded complaint does not affirmatively rely on federal law."⁷⁶

2. The Fifth Circuit Holds that the District Court Properly Exercised Federal Question Jurisdiction Under Patent Law:

***Scherbatskoy v. Halliburton Co.*⁷⁷**

The Scherbatskoys own patents for procedures relating to "measuring while drilling" (MWD) technology.⁷⁸ Halliburton has a license to use the MWD patents in *232 return for royalties.⁷⁹ The license agreement further provides that if Halliburton acquires a "New Company" that offered MWD services prior to the date of its acquisition, and that new company did not have immunity from suit or a royalty-free license under these MWD patents, then Halliburton must pay additional defined royalties.⁸⁰ Halliburton subsequently acquired certain assets from Smith International, including all of Smith's MWD technology.⁸¹ Halliburton, however, did not pay additional royalties, contending that the transaction with Smith did not result in the acquisition of a "New Company."⁸²

The Scherbatskoys filed suit against Halliburton in Texas state court, alleging breach of contract and breach of fiduciary duty.⁸³ Halliburton removed the action on the basis of federal question jurisdiction pursuant to 28 U.S.C. § 133 8(a),⁸⁴ asserting that the complaint invokes the patent laws.⁸⁵

Thereafter, the federal district court granted summary judgment in favor of Halliburton on the grounds that Halliburton did not acquire a "New Company" and that the breach of fiduciary duty claim was barred by the statute of limitations.⁸⁶ The Scherbatskoys timely but mistakenly filed an appeal with the Fifth Circuit.⁸⁷

Because 28 U.S.C. § 1295⁸⁸ grants the Federal Circuit exclusive appellate jurisdiction for actions arising under patent law, the Fifth Circuit first had to determine its own jurisdictional authority to review the district court's exercise of federal jurisdiction.⁸⁹ The court decided that Section 1295 does not grant to the Federal Circuit exclusive jurisdiction over issues of the propriety of a district court's jurisdiction under Section 1338.⁹⁰ The court first stated that a regional circuit court has inherent jurisdiction to determine its own jurisdiction and supervise the exercise of jurisdiction by the district court within its circuit.⁹¹ Absence of federal *233 jurisdiction would require a remand to the state court.⁹² The court also observed that if only the Federal Circuit has the authority to review the district court's exercise of jurisdiction, then the regional circuits would be subordinated to the Federal Circuit in contravention of Congress' stated intent that all these courts be equal in the federal judicial structure.⁹³

Having concluded that it had jurisdiction to review the district court's exercise of federal jurisdiction, the Fifth Circuit determined that the action arose under patent law.⁹⁴ The court stated that a finding of patent infringement by Smith of the MWD patents was a necessary element to the resolution of the Scherbatskoys' contract claim and their demand for the recovery of additional royalties.⁹⁵ The court then transferred the appeal to the Federal Circuit.⁹⁶

B. Doctrine of Equivalents

Under the doctrine of equivalents, infringement may be found when every limitation of the asserted claim, or its equivalent, is found in the accused device.⁹⁷ The difference from what is literally claimed must be insubstantial, and the elements must perform substantially the same function in substantially the same way to achieve substantially the same result as the asserted claim.⁹⁸ Nevertheless, the Federal Circuit again emphasizes the notice function of patent claims in the following two cases.

1. Sage Products, Inc. v. Devon Industries, Inc.⁹⁹

Sage and Devon both own patents directed to various aspects of containers for disposing hazardous medical waste, such as hypodermic needles.¹⁰⁰ Sage sued Devon for patent infringement, and Devon countersued.¹⁰¹ In particular, Sage's '728 patent claims a container with a slot "at the top of the container body" with a barrier *234 with "a first constriction extending over said slot" and "a complementary second constriction extending beneath said slot."¹⁰² While Devon's accused container included a first constriction and a second constriction to form a barrier, both constrictions were located below the top of the container body.¹⁰³ Nevertheless, Sage contended that Devon infringed its '728 patent under the doctrine of equivalents.¹⁰⁴

In rejecting this argument, the Federal Circuit stated:

Once again, this case raises the question of why the law restricts application of the doctrine of equivalents without further fact finding in some cases, while in other cases the law imposes no such restriction. The claim at issue defines a relatively simple structural device. A skilled patent drafter would foresee the limiting potential of the "over said slot" limitation. No subtlety of language or complexity of the technology, nor any subsequent change in the state of the art ... obfuscated the significance of this limitation at the time of its incorporation into the claim.¹⁰⁵

The court further discussed in dicta why the doctrine of equivalents should not be allowed to expand the claims under these circumstances, emphasizing the notice function of the claims:

[A]s between the patentee who had a clear opportunity to negotiate broader claims but did not do so and the public at large, it is the patentee who must bear the cost of its failure to seek protection for this foreseeable alteration of its claimed structure.... This court recognizes that such reasoning places a premium on forethought and patent drafting. Indeed this premium may lead to higher costs of patent prosecution. However, the alternative rule—allowing broad play for the doctrine of equivalents to encompass foreseeable variations, not just of a claim element, but of a patent claim—also leads to higher costs. Society at large would bear these latter costs in the form of virtual foreclosure of competitive activity within the penumbra of each issued patent claim.¹⁰⁶

Thus, given these two alternatives, the court determined that the patentee should bear any additional costs.¹⁰⁷

2. Wright Medical Technology, Inc. v. Osteonics Corp.¹⁰⁸

Wright owns a patent directed to methods and instruments for reshaping the distal surface of a femur so that an artificial knee may be properly attached to it.¹⁰⁹ *235 The invention achieves the requisite proper alignment of the artificial knee to the central long axis of the femur by inserting a rod into the femur's intramedullary canal and then obtaining an appropriately reshaped distal surface by using a variety of cutting and shaping instruments.¹¹⁰ Wright sued Osteonics for patent infringement, alleging that Osteonics' STAT-IM artificial knee surgery device infringed claims 6-8 and 10 of its patent.¹¹¹ The district court granted summary judgment for Osteonics, stating that the doctrine of equivalents did not apply.¹¹²

Independent claim 6 reads in relevant part:

[A] distal femoral surface shaping guide comprising the combination of:

(A) an intramedullary alignment guide comprising (1) an intramedullary rod portion adapted to *closely fit in and extend through the narrowest portion of the human femur* such that the central long axis of said femur passes through the central long axis of said intramedullary rod portion, (2) a guide handle attached to and set at a preselected angle with respect to said axis of the intramedullary rod portion and being adapted to receive at least one femoral surface modifying instrument *in proper alignment with respect to said handle* and (3) a means for securing the combination of (1) and (2) in a fixed position in the femur....¹¹³

The dispute lay in the proper construction of the terms "closely fit in," and "extend through."¹¹⁴ The court stated:

Wright first argues that because the phrase “adapted to closely fit in and extend through the narrowest portion of the human femur” is modified by the phrase “such that the central long axis of said femur passes through the central long axis of said intramedullary rod portion,” the “closely fit” and “extend through” limitations are met by any intramedullary rod that meets the functional objective of the invention.¹¹⁵

In effect, Wright contended that an infringing rod need only “engage” the isthmus of the femur provided that it is sufficiently co-linear with the central long axis of the femur.¹¹⁶

However, Osteonics contended that the disputed terms mean that an infringing rod must fit tightly into and extend all the way through the isthmus of the femur.¹¹⁷ The court agreed with Osteonics’ construction.¹¹⁸

***236** There was no literal infringement because the intramedullary rods of Osteonics’ STAT-IM device do not fit tightly against or extend through the isthmus of the femur.¹¹⁹ Thus, any infringement would have to be found under the doctrine of equivalents.

The Federal Circuit reiterated that the doctrine of equivalents is not a license to ignore or erase the claim’s structural and functional limitations upon which the public is entitled to rely to avoid infringement.¹²⁰ Nevertheless, the court said that Wright’s assertion of infringement under this doctrine is a permissible attempt to prohibit Osteonics from making and selling a device that combines elements equivalent to the elements in the claimed invention.¹²¹ Thus, the court directed the fact-finder on remand to determine whether the intramedullary rod of the claimed distal femoral surface shaping guide is equivalent to the intramedullary rod of the STAT-IM device.¹²²

C. Narrow Claim Construction:

Regents of the University of California v. Oncor, Inc.¹²³

The Regents of the University of California (the University) own U.S. Patent No. 5,447,841 (the ‘841 patent).¹²⁴ The patent claims methods for staining chromosomes in *in situ* hybridization,¹²⁵ the technology area that has become known as “chromosome painting.”

Oncor sells numerous DNA probes for use in chromosome staining in *in situ* hybridization.¹²⁶ The University contended that Oncor directly infringed the ‘841 patent with its research, and further induced infringement of claims 1 and 6 by instructing its customers to use its products in the methods of those claims.¹²⁷ Both the University and Oncor filed numerous motions, but central to deciding each of the issues raised in these motions was the proper claim construction of independent claim 1.¹²⁸

***237** The method of claim 1 requires detecting chromosomal DNA using labeled nucleic acid probes that have both unique and repetitive DNA sequences and using unlabeled probes that combine with repetitive DNA sequences to block non-specific binding—the latter probes reduces the background “noise” of the detection technique.¹²⁹ At issue is the concluding phrase of the claim, which reads “wherein the chromosomal DNA is present in a *morphologically identifiable chromosome or cell nucleus* during the *in situ* hybridization.”¹³⁰

The University contended that “a chromosome or cell nucleus” must be read in the singular, while Oncor contended that this phrase may mean one or more chromosomes or nuclei.¹³¹ The court acknowledged that various decisions have alternatively construed the article “a” as referring either to only one component or to one or more components.¹³² On the facts of this case, however, the court concluded that the claim should be read in the singular since it translated to a narrower reading of the claim.¹³³

Once again, the notice function of claims was emphasized, and was cited as support for adopting the narrower meaning when there is an equal choice between a broader and narrower meaning of a claim.¹³⁴ An interesting twist to this case is that it was the patentee who was arguing for a narrower claim construction.

IV. Conclusion

The author's intent was to provide a brief but meaningful analysis of selected recent patent decisions reported in The United States Patent Quarterly. The author hopes that she has provided a useful insight into the developments in patent law that occurred during the months of September, October, and November of 1997.

Footnotes

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¹ 127 F.3d 1065, 44 U.S.P.Q.2d (BNA) 1336 (Fed.Cir.1997).

² *Id.* at 1066, 44 U.S.P.Q.2d at 1337-38.

³ *Id.* at 1067, 44 U.S.P.Q.2d at 1338.

⁴ *Id.*

⁵ *Id.*, 44 U.S.P.Q.2d at 1337.

⁶ *Id.*, 44 U.S.P.Q.2d at 1338.

⁷ *Id.* at 1068, 44 U.S.P.Q.2d at 1338.

⁸ *Id.*

⁹ *Id.*

¹⁰ *Id.*, 44 U.S.P.Q.2d at 1339.

¹¹ *Id.*

¹² *Id.*

¹³ *Id.*

¹⁴ 124 F.3d 1429, 43 U.S.P.Q.2d (BNA) 1928 (Fed.Cir.1997).

¹⁵ *Id.* at 1431-32, 43 U.S.P.Q.2d at 1929-30.

¹⁶ *Id.* at 1432, 43 U.S.P.Q.2d at 1930-31.

¹⁷ *Id.*, 43 U.S.P.Q.2d at 1930.

18 *Id.*

19 *Id.*

20 *Id.*

21 *Id.*

22 *Id.*

23 *Id.*

24 *Id.* at 1433, 43 U.S.P.Q.2d at 1931 (quoting *Ferag AG v. Quipp, Inc.*, 45 F.3d 1562, 1566, 33 U.S.P.Q.2d (BNA) 1512, 1515 (Fed.Cir.1995), *cert. denied*, 116 S.Ct. 71 (1995)).

25 *Id.* at 1433-34, 43 U.S.P.Q.2d at 1931-32.

26 *Id.* at 1435, 43 U.S.P.Q.2d at 1932.

27 *Id.* at 1433-34, 43 U.S.P.Q.2d at 1931.

28 *Id.* at 1432, 43 U.S.P.Q.2d at 1932.

29 35 U.S.C. § 102(b) (1994).

30 124 F.3d at 1434-35, 43 U.S.P.Q.2d at 1932-33.

31 *Id.* at 1435, 43 U.S.P.Q.2d at 1933.

32 125 F.3d 1448, 44 U.S.P.Q.2d (BNA) 1037 (Fed.Cir.1997), *petition for cert. filed*, 66 U.S.L.W. 3458 (U.S. Jan. 13, 1998) (No. 97-1038).

33 35 U.S.C. § 102(b) (1994).

34 125 F.3d at 1449, 44 U.S.P.Q.2d at 1038.

35 *See id.* at 1450, 1452, 44 U.S.P.Q.2d at 1039, 1040.

36 *Id.* at 1449, 44 U.S.P.Q.2d at 1038.

37 *Id.* at 1450, 44 U.S.P.Q.2d at 1039.

38 *Id.*

39 *Id.*, 44 U.S.P.Q.2d at 1038.

40 *Id.*

41 *Id.*, 44 U.S.P.Q.2d at 1039.

42 *Id.*, 44 U.S.P.Q.2d at 1038-39.

43 *Id.* at 1454, 44 U.S.P.Q.2d at 1042.

44 *Id.* at 1452-53, 44 U.S.P.Q.2d at 1040-41 (quoting *Lorenz v. Colgate-Palmolive-Peet Co.*, 167 F.2d 423, 429-30, 77 U.S.P.Q. (BNA) 138, 144 (3d Cir.1948)).

45 *Id.* at 1451, 44 U.S.P.Q.2d at 1040.

46 *Id.* at 1454, 44 U.S.P.Q.2d at 1042.

47 127 F.3d 1048, 44 U.S.P.Q.2d (BNA) 1023 (Fed.Cir.1997).

48 *Id.* at 1049-50, 44 U.S.P.Q.2d at 1024-25.

49 *Id.* at 1050-51, 44 U.S.P.Q.2d at 1025.

50 *Id.* at 1052, 44 U.S.P.Q.2d at 1026.

51 *Id.* at 1050, 1052-53, 44 U.S.P.Q.2d at 1024, 1026-27.

52 52 F.3d 967, 34 U.S.P.Q.2d (BNA) 1321 (Fed.Cir.1995) (en banc), *aff'd*, 517 U.S. 370, 38 U.S.P.Q.2d (BNA) 1461 (1996).

53 127 F.3d at 1053, 44 U.S.P.Q.2d at 1027.

54 *Id.* at 1053-54, 44 U.S.P.Q.2d at 1027.

55 *Id.* at 1054, 44 U.S.P.Q.2d at 1027-28.

56 *Id.*, 44 U.S.P.Q.2d at 1029.

57 *Id.* at 1053-54, 44 U.S.P.Q.2d at 1027-28.

58 *Id.* at 1054, 44 U.S.P.Q.2d at 1028.

59 16 F.3d 1189, 29 U.S.P.Q.2d (BNA) 1321 (Fed.Cir.1995).

60 127 F.3d at 1054-55, 44 U.S.P.Q.2d at 1028.

61 980 F.Supp. 68, 44 U.S.P.Q.2d (BNA) 1470 (D.Me.1997).

62 *Id.* at 70, 44 U.S.P.Q.2d at 1470.

63 *Id.* (citing 28 U.S.C. § 1338 (1994)).

64 *Id.* at 71, 44 U.S.P.Q.2d at 1471 (citing *Christianson v. Colt Indus. Operating Corp.*, 486 U.S. 800, 808-09, 7 U.S.P.Q.2d (BNA) 1109, 1113 (1988)).

65 *Id.*

66 *Id.* at 72, 44 U.S.P.Q.2d at 1471.

67 *Id.*, 44 U.S.P.Q.2d at 1472.

68 *Id.* at 71, 44 U.S.P.Q.2d at 1471.

69 *Id.*

70 *Id.* at 72, 44 U.S.P.Q.2d at 1472.

71 *Id.* (citing *American Well v. Layne & Bowles Co.*, 241 U.S. 257,259 (1916)).

72 *Id.* at 72-73, 44 U.S.P.Q.2d at 1472.

73 *Id.* at 72, 44 U.S.P.Q.2d at 1472.

74 *Id.*

75 *Id.* at 73, 44 U.S.P.Q.2d at 1472.

76 *Id.* at 71, 44 U.S.P.Q.2d at 1470 (citations omitted).

77 125 F.3d 288, 44 U.S.P.Q.2d (BNA) 1466 (5th Cir.1997).

78 *Id.* at 289, 44 U.S.P.Q.2d at 1467.

79 *Id.*

80 *Id.*, 44 U.S.P.Q.2d at 1467-68.

81 *Id.*, 44 U.S.P.Q.2d at 1468.

82 *Id.* at 290, 44 U.S.P.Q.2d at 1468.

83 *Id.*

84 28 U.S.C. § 1338(a) (1994).

85 125 F.3d at 290, 44 U.S.P.Q.2d at 1468.

86 *Id.*

87 *Id.* at 290-91, 44 U.S.P.Q.2d at 1468-69.

88 28 U.S.C. § 1295 (1994).

89 125 F.3d at 291, 44 U.S.P.Q.2d at 1468.

90 *Id.*, 44 U.S.P.Q.2d at 1469.

91 *Id.*

92 *Id.*

93 *Id.*

94 *Id.*

95 *Id.*

96 *Id.* at 292, 44 U.S.P.Q.2d at 1467, 1469.

97 Wright Med. Tech., Inc. v. Osteonics Corp., 122 F.3d 1440, 1443, 1445, 43, U.S.P.Q.2d (BNA) 1837, 1840, 1842 (Fed.Cir.1997).

98 *Id.*

99 126 F.3d 1420, 44 U.S.P.Q.2d (BNA) 1103 (Fed.Cir.1997).

100 *Id.* at 1422, 44 U.S.P.Q.2d at 1104-05.

101 *Id.*

102 *Id.*, 44 U.S.P.Q.2d at 1105.

103 *Id.* at 1424, 44 U.S.P.Q.2d at 1106.

104 *Id.*

105 *Id.* at 1425, 44 U.S.P.Q.2d at 1107 (citations omitted).

106 *Id.*

107 *Id.*, 44 U.S.P.Q.2d at 1108.

108 122 F.3d 1440, 43 U.S.P.Q.2d (BNA) 1837 (Fed.Cir.1997).

109 *Id.* at 1441, 43 U.S.P.Q.2d at 1839.

110 *Id.*

111 *Id.* at 1442, 43 U.S.P.Q.2d at 1839.

112 *Id.*

113 *Id.*

114 *Id.*

115 *Id.* at 1443, 43 U.S.P.Q.2d at 1840.

116 *Id.*

117 *Id.*

118 *Id.*

119 *Id.* at 1444, 43 U.S.P.Q.2d at 1841.

120 *Id.* at 1445, 43 U.S.P.Q.2d at 1842.

121 *Id.*

122 *Id.* at 1446, 43 U.S.P.Q.2d at 1842.

123 44 U.S.P.Q.2d (BNA) 1322 (N.D.Cal.1997).

124 *Id.* at 1322.

125 *Id.* at 1323.

126 *Id.*

127 *Id.*

128 *Id.* at 1323-24.

129 *Id.* at 1323.

130 *Id.* at 1324.

131 *Id.* (emphasis added).

132 *Id.* at 1324-25.

133 *Id.* at 1326.

134 *Id.* at 1325-26 (citing *Athletic Alternatives, Inc. v. Prince Mfg.*, 73 F.3d 1573, 1581, 37 U.S.P.Q.2d (BNA) 1365, 1372 (Fed.Cir.1996)).