

Texas Intellectual Property Law Journal
Spring, 1999

Recent Development

RECENT DEVELOPMENTS IN PATENT LAW

Shireen Irani Bacon Keiko Ichiye Jane O'Connell^{al}

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***428 I. Introduction**

The cases discussed herein were reported in The United States Patent Quarterly during late December of 1998 and January and February of 1999. This article is not intended to provide a comprehensive analysis of all patent decisions during the relevant period, but rather provides a review of selected patent opinions that the authors believe involve significant or noteworthy decisions in certain interesting areas of patent law. The selected cases discussed within this article are organized by subject matter in order to facilitate the reader's review.

II. Claim Construction

A. Inventor Testimony

In *Voice Technologies Group, Inc. v. VMC Systems, Inc.*,¹ VMC appealed a district court grant of summary judgment that VoiceBridgeII devices made by Voice Technologies Group do not infringe VMC's patent.² The Federal Circuit held in this case that testimony of the inventor was erroneously excluded by the district court, due to an overly strict reading of *Markman*.³ An affidavit and video demonstration by one of the inventors of the patented technology were excluded during claim construction.⁴ The Federal Circuit noted:

This court in *Markman* did not hold that the inventor can not explain the technology and what was invented and claimed; the Federal Circuit held only that the inventor can not by later testimony change the invention and the claims from their meaning at the time the patent was drafted and granted.⁵

Not only is the inventor competent to give testimony about the technology, the Federal Circuit found that the district court's definitions of "telephone emulation" and "direct talk path" are at odds with the clear meanings given to those terms in the patent.⁶ The court therefore rejected the district court's interpretation of the terms.⁷ *429 Due to that misinterpretation, the district court's grant of summary judgment of non-infringement was reversed and remanded.⁸

B. Means Plus Function

In *Personalized Media Communications, LLC v. International Trade Commission*,⁹ the Federal Circuit determined that the International Trade Commission incorrectly construed a claim as a means-plus-function claim. The U.S. International Trade Commission (ITC) initiated an investigation pursuant to 19 U.S.C. Section 1337(a), based on a complaint filed by Personalized Media Communications, L.L.C. (PMC), alleging importation of infringing digital satellite systems by various respondents.¹⁰

PMC is the assignee of U.S. Patent 5,335,277 (the '277 patent), which pertains generally to systems for use in television broadcasting.¹¹ The system of the '277 patent includes a unique receiver station that detects and manipulates digital control

signals that are embedded in a complex broadcast or cablecast transmission.¹² PMC argued that the Commission erred in construing the “digital detector” limitation as a means plus function limitation under 35 U.S.C. Section 112, paragraph 6.¹³

The Federal Circuit agreed that the claim recited sufficiently definite structure and therefore does not come within Section 112, paragraph 6.¹⁴ The fact that a particular mechanism is defined in functional terms is not sufficient to convert a claim element containing that term into a means for performing a specified function within the meaning of Section 112, paragraph 6.¹⁵ What is important is not simply that a mechanism is defined in terms of what it does, but that the term, as the name for structure, has a reasonably well understood meaning in the art.¹⁶ Moreover, the use of the word “means” creates a presumption that Section 112, paragraph 6 applies, and the failure to use the word “means” creates a presumption that Section 112, paragraph 6 does not apply.¹⁷ These presumptions can be rebutted if the *430 evidence intrinsic to the patent and any relevant extrinsic evidence so warrant.¹⁸ In deciding whether either presumption has been rebutted, the focus remains on whether the claim as properly construed recites sufficiently definite structure to avoid the ambit of Section 112, paragraph 6.¹⁹

In this case, neither extrinsic nor intrinsic evidence rebutted this presumption because the term detector is a sufficient recitation of structure and furthermore has a well-known meaning in the art.²⁰ Consequently, the term “detector” is a sufficiently defined structural term to preclude the application of Section 112, paragraph 6.²¹

C. Doctrine of Equivalents

In *Spectrum International, Inc. v. Sterilite Corp.*,²² Spectrum appealed a summary judgment that Sterilite’s storage crates do not infringe Claims 2 and 11 of Spectrum’s patent (’202 patent). The Federal Circuit affirmed the district court’s noninfringement decision on the basis of the ’202 patent’s prosecution history.²³

The ’202 patent is directed to a box-like structure with four walls and a bottom.²⁴ Spectrum contended that Sterilite’s storage crate infringes the ’202 patent.²⁵ The district court reasoned that because Spectrum did not provide any special definition of the claimed term “wall,” the term’s original meaning, as discerned by the court, controlled.²⁶ Given its construction of the claims, the court found that Sterilite’s accused product does not have a front wall as required by claims 2 and 11, and as such does not infringe these claims either literally or under the doctrine of equivalents.²⁷

The Federal Circuit affirmed, holding that prosecution history estoppel prevented Spectrum from arguing that the term “comprising” found in the claims allowed a broad construction that would result in infringement, since Spectrum had *431 clearly relinquished such a construction during prosecution of the patent in order to sustain the patentability of the subject claims over prior art cited by the examiner.²⁸

D. Extrinsic Evidence

In the *Personalized Media* case discussed above, the Federal Circuit also addressed the use of extrinsic evidence to construe claims.²⁹ The Federal Circuit held that extrinsic evidence in the form of expert testimony was inadmissible to construe the term “digital detector” because the term had a well-understood meaning in the art, and because the written specification explicitly defined the term.³⁰

In contrast, the Federal Circuit upheld the district court’s reliance on extrinsic evidence in *Key Pharmaceuticals Inc. v. Hercon Laboratories Corp.*³¹ *Key Pharmaceuticals* was a patent infringement action in which Key Pharmaceuticals Inc. (Key) charged Hercon Laboratories Corporation (Hercon) with infringement of its U.S. Patent No. 5,186,938 (the ’938 patent) embodied in a nitroglycerin skin patch.³² Hercon appealed the trial court’s finding that the ’938 patent was not invalid.³³

Hercon argued that the pertinent claim of the ’938 patent was anticipated and rendered obvious by, among other things, Japanese Kokai 46959-1983, a prior art Japanese published patent application.³⁴ In its review, the Federal Circuit noted that the trial court had relied heavily on the extrinsic testimony of a technical expert in construing the disputed claim.³⁵ Initially, the court noted Hercon’s “highly questionable” tactic of asserting error in the trial court’s adoption of the very position that Hercon had taken at trial.³⁶ It seems that the expert provided by Hercon admitted on cross-examination that he had made a calculation error that rendered Hercon’s position before the trial court undesirable.³⁷ Because Key did not object to this conduct, the Federal Circuit went on to consider Hercon’s objection to the trial *432 court’s consideration of the testimony it

offered through its own expert.³⁸ The Federal Circuit stated that “trial courts generally can hear expert testimony for background and education on the technology implicated by the present claim construction issues, and trial courts have broad discretion in this regard,” and may certainly do so when the intrinsic evidence is insufficient to answer the claim construction question.³⁹

III. Section 112 Issues

A. Enablement

In *National Recovery Technologies Inc. v. Magnetic Separation Systems Inc.*,⁴⁰ the Federal Circuit found clear and convincing evidence that the subject patent’s presumption of validity was overcome and that the patent was invalid for lack of enablement.⁴¹ Plaintiff National Recovery Technologies (NRT) appealed a summary judgment holding its patent claim covering automatic classification and separation of recyclable plastic materials invalid for lack of enablement under 35 U.S.C. Section 112, paragraph 1.⁴² Before analyzing the claim in question, the Federal Circuit noted, “the claim terms are to be given their ordinary meaning unless it is apparent that the inventor intended to use them differently.”⁴³ The district court held that the written description of the ‘576 patent did not meet the strictures of Section 112, paragraph 1.⁴⁴ In particular, it held that one of ordinary skill in the art could not “select for processing those of said process signals which do not pass through irregularities in the bodies of said material items” without undue experimentation because the written description did not explain how to distinguish between signals that passed through irregular portions of the container and those that did not.⁴⁵

In affirming the district court’s grant of summary judgment, the Federal Circuit stated:

*433 The ‘576 patent therefore recognizes a specific need in the materials sorting field and suggests a theoretical answer to that need. It provides a starting point from which one of skill in the art can perform further research in order to practice the claimed invention, but this is not adequate to constitute enablement. The specification of the ‘576 patent therefore does not enable one of ordinary skill in the art to practice the full scope of the invention embodied in claim 1 without undue experimentation. The most that NRT can be credited with is promising the ideal result in claim 1, even though the specification does not completely deliver on this promise.⁴⁶

B. Best Mode

*Bruning v. Hirose*⁴⁷ involved an appeal by junior party Bruning of a decision by the Board of Patent Appeals and Interferences that the subject patents (’750 and ’352) are invalid under the best mode requirement of 35 U.S.C. Section 112.⁴⁸ The interference proceeding involved an issued patent and a pending application.⁴⁹ The Federal Circuit first addressed the issue of burden of proof, then addressed the best mode issue.⁵⁰ Regarding burden of proof, an interference involving a patent that has already issued requires proof by clear and convincing evidence to overcome the presumption of validity.⁵¹ In contrast, where an interference is between a patent that issued on an application that was copending with an interfering application, the applicable standard of proof is a preponderance of the evidence.⁵² The linchpin for deciding burden of proof is whether or not the patent’s application was copending with the interfering application.⁵³

Regarding best mode, the Federal Circuit held that the subject patents were not invalid under the best mode requirement of Section 112.⁵⁴ This inquiry examines what was known to the inventor at the time the application was filed.⁵⁵ At the time of filing, the evidence suggested that Bruning had no subjective awareness of a best mode for practicing the invention. Bruning expressed concern in his notebooks of certain characteristics of the elements.⁵⁶ Significantly, after filing the application, *434 the lens assembly required additional testing and modifications before it would work for its intended purposes.⁵⁷ Moreover, the record did not show that at the time the application was filed, the inventor subjectively believed one embodiment to be a superior mode to carry out the invention.⁵⁸ Furthermore, the record did not show evidence of concealment or of intent to withhold or suppress a known best mode for carrying out the invention.⁵⁹ Finding the Board’s decision on this issue clearly erroneous, the Federal Circuit reversed the Board’s findings that the best mode was not disclosed.⁶⁰

IV. Government Rights

In all three cases covered in this article concerning government rights, the rights of the government in the patents at issue

were upheld, albeit on different grounds.

A. Joint Inventorship between Government Employees and Non-Government Inventors

In *Fretheim v. Department of Air Force*,⁶¹ the plaintiff appealed a determination under 37 C.F.R. 501.8 by the U.S. Air Force that the U.S. Government owns the entire right, title and interest in his joint invention with two other electrical engineers at the Air Force Institute of Technology.⁶² Under Paragraph 1(a) of Executive Order 10096, “the Government shall obtain the entire right, title, and interest in and to all inventions made by any Government employee with a contribution by the Government of facilities, equipment, materials, funds or information or of time or services of other Government employees on official duty.”⁶³ An exception is provided by 37 C.F.R. 501.6(a)(2), which provides the Government with no rights if the contribution is insufficient equitably to justify an assignment.⁶⁴

*435 Fretheim asserted that he made his invention prior to any contribution by the Government, but failed to provide any contemporaneous documentation of his independent conception.⁶⁵ Fretheim and joint inventor Scriber were military officer / graduate students at the Air Force Institute of Technology, and the third joint inventor, De Groat, was an instructor there.⁶⁶ De Groat spent 40 hours of Government time on the invention and Scriber spent 700 hours of Government time, compared to Fretheim’s 320 hours of personal time.⁶⁷ The Department’s decision focused on the participation of the other Government employees and their inclusion as inventors in the patent application.⁶⁸ Due to the amount of Government time spent on the invention, the Department did not feel that it would be inequitable under 37 C.F.R. 501.6(a)(1) to require an assignment to the Government.⁶⁹ Thus, the determination by the U.S. Air Force that the Government owns the entire right, title, and interest in the invention was upheld.⁷⁰

B. Use of Government Resources to Develop the Invention

As with *Fretheim*, *Goldberg v. Department of the Army*⁷¹ also involves the Department of Commerce’s application of Paragraph 1(a) Executive Order 10096. Plaintiffs appealed a determination by the Army that the Government shall obtain the entire right, title and interest in their invention.⁷² The Army’s position was that the Government was entitled to all rights in plaintiffs’ invention because it was made with a contribution of Government resources of facilities, equipment, materials, funds and information.⁷³ Generally, Paragraph 1(a) provides that

the Government shall obtain the entire right, title, and interest in and to all inventions made by any Government employee (1) during working hours, or (2) with a contribution by the Government of facilities, equipment, materials, fund or information or of time or services of other Government employees on official duty, or (3) which bear a direct relation to or are made in consequence of the official duties of the inventor.⁷⁴

*436 Additionally, Paragraph 1(c) of Executive Order 10096 provides a presumption to aid the government, stating “an invention made by an employee hired to (i) invent (ii) conduct research, (iii) supervise Government financed or conducted research, or (iv) act as liaison among Government or non-government agencies conducting such research, shall be presumed to fall under the scope of Paragraph 1(a).”⁷⁵ Plaintiffs in this case were employed by the Army to conduct research and development.⁷⁶ The Department concurred with the Army’s earlier decision that the Government is entitled to the entire right, title and interest in the invention due to the inventors’ job descriptions and “the fact that the inventors may have conceived the invention off their job does not rebut the presumption because they tested their invention at work with Government equipment and money.”⁷⁷

C. Insufficient Governmental Interest in the Invention

Completing the trilogy of decisions favoring the government, the Fifth Circuit upheld a ruling by the U.S. District for the Western District of Texas in *Wright v. United States*.⁷⁸ The Fifth Circuit held that the rights in a strain of BB fungus effective against crop damaging insects belonged to the USDA rather than the individual inventor.⁷⁹ The individual inventor, Dr. Wright, had petitioned the government to grant him ownership rights.⁸⁰ A suit was filed in district court after the Department of Commerce affirmed the USDA’s formal determination that the domestic patent rights in the invention belonged to the U.S. government.⁸¹ The issue before the Fifth Circuit was whether the invention belongs to the government under Commerce Department Regulation, 37 C.F.R. Section 501.6(a)(1) or to Dr. Wright under Section 501.6(a)(2).⁸² At issue was a provision providing that the government should leave title in the employee when the government “has insufficient interest” in the

invention.⁸³ Dr. Wright argued that the government was only interested in publishing the invention and did not initially file a patent application, so the *437 government's interest in the invention was insufficient.⁸⁴ The USDA responded that an agency's desire to publish an invention does not necessarily mean that it is not interested in the invention. Giving great deference to the USDA's interpretation of the words "insufficient interest" in the regulation, the Fifth Circuit found no abuse of discretion and affirmed the district court's holding.⁸⁵

V. On-Sale Bar - Following *Pfaff*

In *Weatherchem Corp. v. J.L. Clark, Inc.*,⁸⁶ the Federal Circuit followed the newly enunciated two-part test for determining the conditions that will trigger the on-sale bar of Section 102(b). The new test was set forth on November 10, 1998 by the U.S. Supreme Court in *Pfaff v. Wells Electronics, Inc.*⁸⁷ The on-sale bar applies when two conditions are satisfied before the critical date: (1) the product must be the subject of a commercial offer for sale, and (2) the invention must be ready for patenting.⁸⁸ The "ready for patenting condition may be satisfied in at least two ways: by proof of reduction to practice before the critical date, or by proof that prior to the critical date the inventor had prepared drawings or other description of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention."⁸⁹ Regarding the first element, the Federal Circuit upheld the district court's finding that it had been satisfied.⁹⁰ Weatherchem received the benefit of at least three commercial transactions with Durkee before the critical date.⁹¹ The last of these transactions constituted at least an offer for sale, if not an outright commercial sale transaction, which Durkee accepted.⁹² It is immaterial that the record shows no delivery of the later patented caps and no exchange of money until after the critical date.⁹³ Record evidence of a signed purchase agreement before the critical date establishes an offer for sale sufficient to evoke the on sale bar.⁹⁴

*438 Regarding the second prong of the *Pfaff* test, the Federal Circuit again upheld the district court's holding that it had been satisfied.⁹⁵ Specifically, a February 8, 1985 drawing showed a cap having all the structural limitations of the claims.⁹⁶ These detailed drawings of the cap design were sufficiently specific to enable a person skilled in the art to practice the invention.⁹⁷ Evidence showed that the invention was ready for patenting at the time of the depiction of the drawing, even though Weatherchem continued to fine tune features not claimed in the patent.⁹⁸ The Federal Circuit considered it important that a commercial quantity of the invention was ordered before the critical date, and that the manufacturer was able to produce the invention using the drawings and specifications.⁹⁹

VI. Reexamination

The Federal Circuit held in *Laitram Corp. v. NEC Corp.*¹⁰⁰ that the scope of the claims at issue was substantially changed during reexamination. Laitram filed suit against NEC for patent infringement.¹⁰¹ NEC appealed a decision denying its motion for Judgment as a Matter of Law (JMOL) in which NEC claimed that reexamined claims 1 and 2 of Laitram's patent, covering a computer printing system, were not identical in scope to original claims 1 and 2.¹⁰² The differing scopes of the claims is important due to the fact that a patentee of a reexamined patent is entitled to infringement damages for the time period between the date of issuance of the original claims and the date of issuance of the reexamined claims if the original and reexamined claims are identical.¹⁰³ Under *Seattle Box Co. v. Industrial Crating & Packaging, Inc.*,¹⁰⁴ reexamined claims are identical to the original claims if they are without substantive change.¹⁰⁵ If substantive changes have been made, the patentee *439 is entitled only to infringement damages for the period following reexamination.¹⁰⁶

The Federal Circuit concurred with NEC that the claim changes were substantive, stating:

NEC correctly observes that a plain reading of the claims would indicate that the original and reexamined claims are of different scope: the original claims appear to cover a printer or method of printing which generates *any* quality of alphanumeric characters, while the amended claims seems to cover only a printing apparatus or method which generates "*type quality*" alphanumeric characters. Most significantly, however, the addition of the "type quality" limitation, along with the other amendments, resulted in the allowance of claims that had been rejected in the reexamination proceeding over prior art; this is a highly influential piece of prosecution history.¹⁰⁷

Although the court disavowed creation of any per se rule, it did acknowledge that "it is difficult to conceive of many situations in which the scope of a rejected claim that became allowable when amended is not substantively changed by the amendment."¹⁰⁸

VII. Patent Litigation

A. Notice of Infringement

In *Mikohn Gaming Corp. v. Acres Gaming, Inc.*,¹⁰⁹ plaintiff and defendant are both manufacturers and sellers of gaming devices such as slot machines.¹¹⁰ Acres was granted a patent relating to gaming devices and proceeded to contact several of Mikohn's customers and potential customers in order to inform them that Mikohn was infringing their patent.¹¹¹ Mikohn brought suit requesting a declaration that their machines did not infringe upon Acres patent and charging that Acres was intentionally interfering with existing and potential business relationship, in violation of Nevada common law.¹¹² The district court granted Mikohn's request for a preliminary injunction enjoining Acres from issuing further statements alleging infringement to Mikohn's customers or potential customers.¹¹³ This appeal *440 followed.¹¹⁴

The patentee's right to notify others of his patent is protected under federal law and is not a matter of state tort law.¹¹⁵ A patentee has the right to inform any potential infringers of the issuance or existence of a patent, in order for the recipient of the information to adjust its activities, seek a license, or otherwise act to protect itself from infringement claims.¹¹⁶ Communication to possible infringers concerning patent rights is not improper if the patent holder has a good faith belief in the accuracy of the communication.¹¹⁷ A finding of bad faith is not supported when the information transmitted is objectively accurate.¹¹⁸

The record showed little evidence of bad faith on Acres' part.¹¹⁹ Additionally, there was no strong showing of irreparable injury or harm that would justify use of a preliminary injunction.¹²⁰ The court concluded that the grant of the preliminary injunction in this case was inappropriate and vacated the injunction.¹²¹

B. Inequitable Conduct

In *Elk Corp. of Dallas v. GAF Building Materials Corp.*,¹²² the Federal Circuit upheld an opinion by the U.S. District Court for the Northern District of Texas that a patent should not be enforced due to inequitable conduct of the applicants and their patent attorney during the prosecution of a design patent. Plaintiff Elk brought a patent infringement action against defendants GAF, who in turn counterclaimed for declaratory judgment that Elk's design patent was unenforceable due to inequitable conduct by plaintiff in the patent application process.¹²³ The district court held that the plaintiff's design patent was unenforceable due to inequitable conduct in its prosecution.¹²⁴ Plaintiff failed to disclose to the PTO prior art patents.¹²⁵ One of the *441 prior art patents was referred to by the co-inventor in correspondence requesting a patentability search.¹²⁶ The co-inventor wrote, "the enclosed sketch described this new product's appearance. This shingle's construction is similar to the one described in Bettoli's patent No. 3,921,358 which is also enclosed."¹²⁷ The other prior art patent not disclosed to the PTO was noted in the search report as being of special interest.¹²⁸

In its analysis, the Federal Circuit stated the standard for inequitable conduct:

Inequitable conduct due to failure to disclose material information must be proven by clear and convincing evidence of: (1) prior art that was material; (2) knowledge chargeable to an applicant of that prior art and of its materiality; and (3) failure of the applicant to disclose the art resulting from an intent to mislead the PTO.¹²⁹

After reviewing the Texas court's decision under an abuse of discretion standard, the Federal Circuit found that "[b]ased upon the foregoing, the district court's findings of materiality and knowledge of materiality of the Bettoli and Giles patents were not clearly erroneous."¹³⁰ Therefore, Elk's design patent was unenforceable.¹³¹

C. Witnesses

1. Corroboration

In *Thomson S.A. v. Quixote Corporation*,¹³² Thomson S.A. (Thomson) sued Quixote Corporation (Quixote) for infringement of patents directed to optical storage devices, such as compact discs (CD's).¹³³ On appeal, Thomson challenged the jury finding that all the representative claims were invalid due to anticipation by an unpatented laser disc system.¹³⁴

Thomson argued that the jury verdict rested upon mere testimonial evidence by two nonparty MCA employees who were working on the video disc project.¹³⁵ *442 Thomson asserts that this evidence is insufficient as a matter of law to support a holding of invalidity under Section 102(g), because such testimonial evidence by inventors of their prior invention requires corroboration.¹³⁶

The Federal Circuit affirmed the verdict of invalidity, stating that there was no need for corroboration under the facts of this case.¹³⁷ While the interested testimony of inventors cannot raise to the level of clear and convincing evidence without corroboration in the context of interference and infringement lawsuits, those cases usually involve testimony by persons who are interested in the outcome of the litigation.¹³⁸ In the current case, however, the purported inventors were non-parties and their testimony concerned an unpatented prior invention.¹³⁹ Consequently, the level of self-interest requiring corroboration was not present in this case.¹⁴⁰

2. Non-Party Witnesses/Contempt

In *Connaught Laboratories, Inc. v. SmithKline Beecham P.L.C.*,¹⁴¹ the FDA (a non-party) appealed a district court's grant of SmithKline's motion to compel testimony of FDA employees. In order to prove that the plaintiff's (Connaught) patent was invalid, SmithKline, the defendant, served subpoenas on three FDA employees in hopes of eliciting testimony that the FDA had performed scientific research on the patented substance before Connaught's priority date.¹⁴²

The Federal Circuit dismissed the appeal for lack of jurisdiction.¹⁴³ The Federal Circuit's jurisdiction is limited to "final decisions" and discovery orders compelling non-party witnesses are subject to this "finality rule."¹⁴⁴ Nonparties may secure review of discovery orders by refusing to comply and then appealing a consequent contempt order.¹⁴⁵ This approach provides an "adequate alternative" to obtain the relief the FDA seeks and therefore precludes the FDA from using the *443 "collateral order" exception and from obtaining mandamus relief.¹⁴⁶

VIII. Conclusion

The brief summaries provided herein demonstrate several trends. First, extrinsic evidence was generally admitted to aid in claim construction unless the specification gave an explicit definition to the disputed term. Second, rights in inventions created by government employees were generally held to reside in the government, and an agency's interpretation of its rules on this issue will be afforded great deference. In addition, the Federal Circuit demonstrated its intent to follow the new two-part *Pfaff* analysis set forth by the U.S. Supreme Court for determining the trigger date for the on-sale bar. Finally, in a case of first impression, the Federal Circuit held that the burden of proof in an interference will be a preponderance, rather than clear and convincing evidence, when the patent application was copending with an interfering application.

Footnotes

^{a1} Strasburger & Price, L.L.P. Any opinions expressed in this article are the opinions of the authors and do not necessarily reflect the opinions of Skjerven, Morrill, MacPherson, Franklin & Friel, L.L.P. nor Strasburger & Price, L.L.P.

¹ 164 F.3d 605, 49 U.S.P.Q.2d (BNA) 1333 (Fed. Cir. 1999).

² *Id.*, 49 U.S.P.Q.2d at 1334.

³ *Id.* at 615, 49 U.S.P.Q.2d at 1340 (citing *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 34 U.S.P.Q.2d 1321 (Fed. Cir. 1995) (in banc), *aff'd* 517 U.S. 370, 38 U.S.P.Q.2d 1461 (1996)).

4 *See generally id.* at 609-11, 49 U.S.P.Q.2d at 1335-37.

5 *Id.* at 615, 49 U.S.P.Q.2d at 1340-41.

6 *Id.*, 49 U.S.P.Q.2d at 1341.

7 *Id.* at 616, 49 U.S.P.Q.2d at 1341.

8 *Id.*

9 161 F.3d 696, 48 U.S.P.Q.2d (BNA) 1880 (Fed. Cir. 1998).

10 *Id.* at 700, 48 U.S.P.Q.2d at 1883.

11 *Id.* at 698, 48 U.S.P.Q.2d at 1881.

12 *Id.*, 48 U.S.P.Q.2d at 1881-82.

13 *Id.* at 703, 48 U.S.P.Q.2d at 1886.

14 *Id.* at 704, 48 U.S.P.Q.2d at 1887.

15 *Id.* at 703, 48 U.S.P.Q.2d at 1886.

16 *Id.* at 704, 48 U.S.P.Q.2d at 1887.

17 *Id.* at 703, 48 U.S.P.Q.2d at 1886-87.

18 *Id.*

19 *Id.* at 704, 48 U.S.P.Q.2d at 1887.

20 *Id.*

21 *Id.* at 705, 48 U.S.P.Q.2d at 1888.

22 164 F.3d 1372, 49 U.S.P.Q.2d (BNA) 1065 (Fed. Cir. 1998).

23 *Id.* at 1381, 49 U.S.P.Q.2d at 1071.

24 *Id.* at 1373, 49 U.S.P.Q.2d at 1065.

25 *Id.* at 1374, 49 U.S.P.Q.2d at 1066.

26 *Id.* at 1375, 49 U.S.P.Q.2d at 1066.

27 *Id.* at 1378, 49 U.S.P.Q.2d at 1068.

28 *Id.* at 1379, 49 U.S.P.Q.2d at 1069-70.

29 Personalized Media Communications, LLC v. International Trade Comm'n, 161 F.3d 696, 703, 48 U.S.P.Q.2d (BNA) 1881, 1887 (Fed. Cir. 1998).

30 *Id.* at 705, 48 U.S.P.Q.2d at 1888.

31 161 F.3d 709, 48 U.S.P.Q.2d (BNA) 1911 (Fed. Cir. 1998).

32 *Id.* at 711, 48 U.S.P.Q.2d at 1912.

33 *Id.* at 713, 48 U.S.P.Q.2d at 1914.

34 *Id.* at 711, 48 U.S.P.Q.2d at 1912-13.

35 *Id.* at 715, 48 U.S.P.Q.2d at 1916.

36 *Id.*

37 *Id.*

38 *Id.*

39 *Id.* at 716, 48 U.S.P.Q.2d at 1917.

40 166 F.3d 1190, 49 U.S.P.Q.2d (BNA) 1671 (Fed. Cir. 1999).

41 *Id.* at 1195-98, 49 U.S.P.Q.2d at 1677.

42 *Id.* at 1192, 49 U.S.P.Q.2d at 1674.

43 *Id.* at 1195, 49 U.S.P.Q.2d at 1675.

44 *Id.* at 1192, 49 U.S.P.Q.2d at 1678.

45 *Id.* at 1195, 49 U.S.P.Q.2d at 1676.

46 *Id.* at 1198, 49 U.S.P.Q.2d at 1677 (citations omitted.)

47 161 F.3d 681, 48 U.S.P.Q.2d (BNA) 1934 (Fed. Cir. 1998).

48 *Id.* at 682, 48 U.S.P.Q.2d at 1935.

49 *Id.* at 684, 48 U.S.P.Q.2d at 1937.

50 *Id.*

51 *Id.* (citing *Price v. Symsek*, 988 F.2d 1187, 1193, 26 U.S.P.Q.2d (BNA) 1031, 1036 (Fed. Cir. 1993)).

52 *Id.* (quoting *Bosies v. Benedict*, 27 F.3d 539, 541-42, 30 U.S.P.Q.2d (BNA) 1862, 1864 (Fed. Cir. 1994)).

53 *Id.* at 685, 48 U.S.P.Q.2d at 1938.

54 *Id.* at 687, 48 U.S.P.Q.2d at 1939.

55 *Id.* at 686, 48 U.S.P.Q.2d at 1939.

56 *Id.* at 687, 48 U.S.P.Q.2d at 1939.

57 *Id.*

58 *Id.*

59 *Id.*

60 *Id.*

61 49 U.S.P.Q.2d (BNA) 1316 (Dept. Comm. 1998).

62 *Id.* at 1317.

63 *Id.* at 1318.

64 *Id.*

65 *Id.*

66 *Id.*

67 *Id.*

68 *Id.*

69 *Id.* at 1318-19.

70 *Id.* at 1319.

71 49 U.S.P.Q.2d (BNA) 1382 (Dept. Comm. 1998).

72 *Id.*

73 *Id.* at 1383.

74 *Id.*

75 *Id.*

76 *Id.*

77 *Id.*

78 164 F.3d 267, 270, 49 U.S.P.Q.2d (BNA) 1542, 1544 (5th Cir. 1999).

79 *Id.* at 269, 49 U.S.P.Q.2d at 1544.

80 *Id.* at 268, 49 U.S.P.Q.2d at 1543.

81 *Id.*

82 *Id.* at 269, 49 U.S.P.Q.2d at 1543.

83 *Id.*, 49 U.S.P.Q.2d at 1543-44.

84 *Id.*, 49 U.S.P.Q.2d at 1544.

85 *Id.* at 269-70, 49 U.S.P.Q.2d at 1544.

86 163 F.3d 1326, 49 U.S.P.Q.2d (BNA) 1001 (Fed. Cir. 1998).

87 119 S.Ct. 304, 48 U.S.P.Q.2d 1641 (1998).

88 *Weatherchem*, 163 F.3d at 1332, 49 U.S.P.Q.2d at 1006.

89 *Id.*

90 *Id.* at 1333, 49 U.S.P.Q.2d at 1007.

91 *Id.*

92 *Id.*

93 *Id.* at 1334, 49 U.S.P.Q.2d at 1007.

94 *Id.* at 1333-34, 49 U.S.P.Q.2d at 1007.

95 *Id.* at 1334, 49 U.S.P.Q.2d at 1007.

96 *Id.*

97 *Id.* at 1333, 49 U.S.P.Q.2d at 1007.

98 *Id.* at 1333, 49 U.S.P.Q.2d at 1007.

99 *Id.*

100 163 F.3d 1342, 49 U.S.P.Q.2d (BNA) 1199 (Fed. Cir. 1998).

101 *Id.* at 1345, 49 U.S.P.Q.2d at 1201.

102 *Id.*

103 *Id.* at 1346, 49 U.S.P.Q.2d at 1202.

104 731 F.2d 818, 221 U.S.P.Q. 568 (Fed. Cir. 1984).

105 *Id.* at 827-28, 221 U.S.P.Q. at 575.

106 *Id.* at 828, 221 U.S.P.Q. at 575.

107 *Laitram*, 163 F.3d at 1348, 49 U.S.P.Q.2d at 1203.

108 *Id.*

109 165 F.3d 891, 49 U.S.P.Q.2d (BNA) 1308 (Fed. Cir. 1998).

110 *Id.* at 893, 49 U.S.P.Q.2d at 1309.

111 *Id.* at 893-94, 49 U.S.P.Q.2d at 1309.

112 *Id.* at 894, 49 U.S.P.Q.2d at 1309.

113 *Id.*

114 *Id.*

115 *Id.* at 896, 49 U.S.P.Q.2d at 1311.

116 *Id.* at 897, 49 U.S.P.Q.2d at 1312.

117 *Id.* at 898, 49 U.S.P.Q.2d at 1312.

118 *Id.*

119 *Id.* at 898, 49 U.S.P.Q.2d at 1312-13.

120 *Id.*, 49 U.S.P.Q.2d at 1313.

121 *Id.*

122 No. 98-1369, 1999 WL 62445 (Fed. Cir. 1999).

123 *Id.* at *1.

124 *Id.* at *2.

125 *Id.*

126 *Id.* at *1.

127 *Id.*

128 *Id.* at *1-2.

129 *Id.* at *2.

130 *Id.* at *4.

131 *Id.* at *5.

132 166 F.3d 1172, 49 U.S.P.Q.2d (BNA) 1530 (Fed. Cir. 1999).

133 *Id.* at 1173, 49 U.S.P.Q.2d at 1530.

134 *Id.* at 1174, 49 U.S.P.Q.2d at 1531.

135 *Id.*

136 *Id.*

137 *Id.* at 1176, 49 U.S.P.Q.2d at 1533.

138 *Id.* at 1175, 49 U.S.P.Q.2d at 1532.

139 *Id.* at 1176, 49 U.S.P.Q.2d at 1533.

140 *Id.*

141 165 F.3d 1368, 49 U.S.P.Q.2d 1540 (BNA) (Fed. Cir. 1999).

142 *Id.* at 1369, 49 U.S.P.Q.2d at 1541.

¹⁴³ *Id.* at 1371, 49 U.S.P.Q.2d at 1542.

¹⁴⁴ *Id.* at 1369-70, 49 U.S.P.Q.2d at 1541.

¹⁴⁵ *Id.* at 1370, 49 U.S.P.Q.2d at 1541.

¹⁴⁶ *Id.*