

# CAFC Happenings

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**Claim Construction:** Patent examiner's claim construction reviewed de novo by CAFC and so does not bind CAFC; a bicycle handgrip recited to be "on the end of a handlebar" must be a mechanically separate from the handlebar and thus cannot be construed to be a part of the handlebar, SRAM Corp. v. AD-II Engineering, Inc., no. 05-1365.

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**Damages:** Money damage award for trademark infringement improperly cumulative to patent infringement damages when both sets of damages arise from the same set of operable facts (in this case, not only selling a knockoff of a patented product but also using the patentee's trademark to do so). The CAFC rather unconvincingly distinguished this case from Nintendo of America, Inc. v. Dragon Pacific International (40 F.3d 1007 (Fed. Cir. 1994) (holding that both trademark and copyright damages could be recovered for the single act of selling cartridges) by simply noting that the Nintendo plaintiff recovered actual damages under the Lanham Act and statutory damages under the Copyright Act - but nevertheless based on the "same set of operable facts."

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**Obviousness/motivation to combine:** CAFC again emphasizes that its critics regarding its obviousness jurisprudence misread and misdescribe the presumably clear suggestion test, accusing certain critics by name of quoting case language out of context despite the CAFC being forced to admit that the language is "arguably imprecise". To clarify, the requisite suggestion to modify a reference to meet the claimed

invention may be found in the cited references, or the knowledge in the art, or the nature of the problems to be solved. Focusing on *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the current panel notes that it reversed the Board because the Board had relied on unidentified "suggestions" in the references being applied, noting that the position advanced by the Commissioner on appeal in *Dembiczak* (that the knowledge in the art could have supplied the requisite suggestion) was "likely affirmable" but that since the argument was new on appeal, the CAFC had declined to consider it. The CAFC's point is that regardless of the source of the suggestion, there must be some evidence to support it, and an utter failure to explain the "common knowledge" being relied on dooms a case of unpatentability, *Dystar Textilfarben GmbH v. C. H. Patrick Co.*, no. 06-1088.

Additionally, in cases in which the motivation for the patented product is to make it stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient, the desire to do these things is universal, motivation exists to combine references absent a suggestion to do in the references. In such situations, the proper question is whether the ordinary artisan possesses skills and knowledge rendering him **capable** of combining the references; for example, when the only difference between an invention and the prior art is replacing welds with studs, and studs are cheaper and faster than welds, no further motivation is needed.

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**Recapture in Reissue:** Although an "unconditional" pacing embodiment of a pacemaker was deleted from claims in original patent and later covered in claims in reissue patent, no impermissible recapture was found because the examiner indicated that the removal was a "minor wording change", with majority finding that this did not amount to a "deliberate surrender" and instead indicated an attorney mistake, and with the dissent stating that despite the examiner's comment the deletion of the unconditional embodiment was no minor wording change and that, contrary to how the majority saw it, the amendment indeed was made to overcome prior art, *Medtronic Inc. v. Guidant Corp.*, no. 05-1515.



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### **Trademarking Varietal Plant Name:**

The name given to a new varietal plant or seed cannot be trademarked, since it is generic in that it denotes not the source of the plant but the plant itself; trademark rights can be obtained for a particular seed variety by associating a brand name with the seed, but having designated a term as the **varietal** name and having not associated any additional word with the term that would indicate the seed's source, trademark rights cannot be accorded in the "generic and only" name of the seed, *In re Pennington Seed, Inc.*, no. 06-1133.

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### **Litigation Stay Pending Arbitration:**

Vacating district court refusal to stay litigation pending arbitration, when arbitration agreement contains broad clause that "any dispute...arising out of this agreement...shall be settled in accordance with AAA rules", and it happens that the AAA rules state that the determination of arbitrability rests with the arbitrator, not a court, then the court can refuse to stay litigation only if the case for arbitration is "wholly groundless", an analysis erroneously not employed by the district court, *Qualcomm, Inc. v. Nokia Corp.*, 2006-1317.

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**Reissue:** Failing to file requisite supplemental inventor declaration in first reissue patent is a valid "error" under the reissue statute (35 U.S.C. '251) to support the filing of a second reissue patent, reversing district court holding of invalidity of the second reissue patent on the erroneous ground that only errors in the specification, drawings, and claims are correctable by reissue, *Medrad, Inc. v. Tycos Healthcare Group LP*, no. 06-1082. **(IPT)**