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Think Carefully When Filing Continuation Applications

By Jeffrey R. Kuester

While rule-making efforts by the U.S. Patent and Trademark Office ("USPTO") to reduce patent continuation filings have an unclear future due to the decision on March 20, 2009, in *Tafas v. Doll*, No. 2008-1077, by the U.S. Court of Appeals for the Federal Circuit ("Federal Circuit"), other decisions by the Federal Circuit are clearly creating additional problems for continuation filings. The Federal Circuit is now imposing new hurdles for patent continuations that arise from remarks made during prosecution and from the written description and enablement requirements of 35 U.S.C. § 112(1). Consequently, much greater care should now be taken when filing continuation applications.

CLAIM SCOPE DISCLAIMER RESCISSIONS NOW OFTEN

NECESSARY IN CONTINUATIONS

In *Hakim v. Cannon Avent Grp.*, 479 F.3d 1313 (Fed. Cir. 2007), the Federal Circuit affirmed a summary judgment of noninfringement for a patent covering a leak-resistant cup. The asserted continuation patent was based upon a continued prosecution application ("CPA") that was filed after its parent application received a Notice of

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TS Tech's Impact on Transfer Decisions

By Trevor Carter and Brandon Judkins

In response to a writ of *mandamus*, on Dec. 29, 2008, the Federal Circuit in *TS Tech* ordered transfer of a patent litigation case out of the Eastern District of Texas. *In re TS Tech*, 555 F.3d 1315 (Fed. Cir. 2008). Two months before the *TS Tech* decision issued, the Fifth Circuit issued an *en banc* transfer decision in response to a writ of *mandamus*. *In re Volkswagen of Am., Inc.*, 545 F.3d 304 (5th Cir. 2008) (*en banc*). In *Volkswagen*, the Fifth Circuit ordered that a product liability case be transferred out of the Eastern District of Texas. *TS Tech* and, to a lesser extent, *Volkswagen* have impacted patent litigation transfer decisions in 2009.

In *TS Tech*, the plaintiff patent owner filed suit in the Eastern District of Texas. The defendant filed a § 1404 motion to transfer venue to the Southern District of Ohio. The district court denied the motion, and *TS Tech* petitioned for a writ of *mandamus*.

The Federal Circuit applied the Fifth Circuit's law that "a motion to transfer venue should be granted upon a showing that the transferee venue is 'clearly more convenient' than the venue chosen by the plaintiff." *TS Tech*, 555 F.3d at 1319. In making this determination, the Fifth Circuit applies the "public" and "private" factors for forum *non conveniens*. *Id.* "The 'private' interest factors include: (1) the relative ease of access to sources of proof; (2) the availability of compulsory process to secure the attendance of witnesses; (3) the cost of attendance for willing witnesses; and (4) all other practical problems that make a trial easy, expeditious and inexpensive." *Id.* "The 'public' interest factors to be considered are: (1) the administrative difficulties flowing from court congestion; (2) the local interest in having localized interests decided at home; (3) the familiarity of the forum with the law that will govern the case; and (4) the avoidance of unnecessary problems of conflicts of law [or in] the application of foreign law." *Id.* (quoting *Volkswagen II*, 545 F.3d at 315).

The Federal Circuit, applying this Fifth Circuit law and, in particular, the Fifth Circuit's recent *en banc* decision in *Volkswagen*, identified several issues with the

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district court's analysis. "First, the district court gave too much weight to Lear's choice of venue under Fifth Circuit law. While the plaintiff's choice of venue is accorded deference, ... Fifth Circuit precedent clearly forbids treating the plaintiff's choice of venue as a distinct factor in the § 1404(a) analysis. Rather, the plaintiff's choice of venue corresponds to the burden that a moving party must meet in order to demonstrate that the transferee venue is a clearly more convenient venue." *Id.* at 1320.

The next issue addressed by the Federal Circuit was the convenience of the witnesses. In *TS Tech*, all of the identified key witnesses were in Ohio, Michigan, and Canada. The Federal Circuit found that the district court did not properly weigh the inconvenience to the witnesses in traveling to Texas, instead of Ohio. In particular, the Federal Circuit applied the Fifth Circuit's 100-mile rule, which counsels that "[w]hen the distance between an existing venue for trial of a matter and a proposed venue under § 1404(a) is more than 100 miles, the factor of inconvenience to witnesses increases in direct relationship to the additional distance to be traveled." *Id.* (quoting *In re Volkswagen AG*, 371 F.3d 201, 204-05 (5th Cir. 2004)).

The third issue discussed by the Federal Circuit was the relative ease of access to sources of proof. The Federal Circuit found that "[b]ecause all of the physical evidence, including the headrests and the documentary evidence, are far more conveniently located near the Ohio venue, the district court erred in not weighing this factor in favor of transfer." *Id.* at 1321.

The Federal Circuit also criticized the district court for disregarding

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"Fifth Circuit precedent in analyzing the public interest in having localized interests decided at home." *Id.*

In particular, "the vehicles containing TS Tech's allegedly infringing headrest assemblies were sold throughout the United States, and thus the citizens of the Eastern District of Texas have no more or less of a meaningful connection to this case than any other venue." *Id.*

Since the *TS Tech* decision issued on Dec. 29, 2008, several district courts have cited *TS Tech* in transfer decisions. Not surprisingly, because the Federal Circuit applied Fifth Circuit transfer law in *TS Tech*, district courts in the Fifth Circuit have followed all of the holdings in *TS Tech*. Conversely, courts outside of the Fifth Circuit have, in some instances, acknowledged but not applied *TS Tech* and, in other instances, applied some of the holdings in *TS Tech*. As of May 19, 2009, 22 district court decisions have cited *TS Tech*.

TRANSFER CASES FROM THE FIFTH CIRCUIT CITING TS TECH

All but one of the Fifth Circuit cases citing *TS Tech* are from the Eastern District of Texas (one decision coming from the Northern District of Texas). These cases are included in Chart 1, on page 3.

As shown in Chart 1, half of the transfer decisions have resulted in transfer. In general, these decisions include lengthy discussions of the public and private interest factors from the Fifth Circuit transfer analysis. To determine what particular facts and issues led to the ultimate transfer decision, it is helpful to look at the conclusion sections included in several of these decisions. Several of these sections are provided below.

CASES DENYING TRANSFER

Novartis Vaccines and Diagnostics, Inc. v. Hoffman-La Roche Inc., et al.:

Under the Fifth Circuit's *In re Volkswagen* standard, the movant must "clearly demonstrate that a transfer is for the convenience of parties and witnesses, [and] in the interest of justice."

545 F.3d at 314. Because this case is nationwide in scope,

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each factor is either neutral or does not weigh in favor of transfer as demonstrated above. As such, Defendants have not clearly demonstrated that transfer is appropriate.

Novartis at *6.

J2 Global Communications, Inc. v. Protus IP Solutions, Inc.:

Only one factor weighs slightly in favor of transfer in these cases — the potential need for compulsory process to secure the testimony of four witnesses. Defendants have not shown that these four witnesses are of critical importance, or even that their testimony is more important than the witness that this Court would have subpoena power over. As more fully explained in the Court's December 23 Order, this is not a situation where the transferee district has had extensive involvement with the patents and products at issue. Nor are these cases where all of the parties and witnesses are localized in one general geographic area. *Compare Network-I Sec. Solutions, Inc.*, 433 F. Supp. 2d at 800 (denying transfer where witnesses were located all over the world); *with Odom*, 2009 WL 279968 at *4 (granting transfer where all of the witnesses were localized in one general geographic area). Based on this analysis, the Court finds that Defendants have failed to show that transfer to the Central District of California would be clearly more convenient for the parties and witnesses. *See Volkswagen II*, 545 F.3d at 325. [FN3]

FN3. Even if the Court did not consider the prior art witnesses identified by Easylink and Protus when applying the convenience of witnesses factor in the Captaris case, the Court would deny Captaris' Motion. Because the parties are not localized in one geographic area, this factor would weigh only somewhat

in favor of transfer. Because only two factors would weigh slightly in favor of transfer, Captaris cannot meet its burden of showing that transfer would be clearly more convenient for the parties and witnesses.

J2 at *7.

Invitrogen Corp. v. General Electric Co., et al ("Invitrogen 1")

Under the circumstances presented here, only two factors weigh slightly in favor of transfer — the convenience of witnesses, and the potential need for compulsory process with regard to three nonparty witnesses — all other factors are neutral. While some witnesses are in the North-

east, the Court is not persuaded that this overrides the fact that other witnesses are in California and that this forum is more convenient for those witnesses. *See Network-I Sec. Solutions, Inc.*, 443 F. Supp. 2d at 800 (denying transfer where witnesses were not localized in one geographic area); *See Aloft Media LLC v. Adobe Sys. Inc.* No. 6:07-cv-355, 2008 WL 819956 at *5-7 (Mar. 25, 2008) (same). Unlike the 112 case [*Invitrogen 2*], this is not a situation where the transferee district has had extensive involvement with the patents and products at issue. Based on this analysis, the

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Chart 1

Fifth Circuit Cases	Transfer Requested To	Decision
<i>Novartis Vaccines & Diagnostics, Inc. v. Hoffman-LA Roche, Inc., et al.</i> , 2009 WL 349760 (E.D. Tex.)	E.D. of North Carolina	Denied
<i>MHL TEK, LLC v. Nissan Motor Co., et al.</i> , 2009 WL 440627 (E.D. Tex.)	E.D. Michigan	Denied
<i>J2 Global Commc'ns, Inc. v. Protus IP Solutions, Inc.</i> , 2009 WL 440525 (E.D. Tex.)	C.D. California	Denied
<i>Invitrogen Corp. v. Gen. Elec. Co., et al.</i> , 2009 WL 331889 (E.D. Tex.) (" <i>Invitrogen 1</i> ")	District of Maryland	Denied
<i>Invitrogen Corp. v. Gen. Elec. Co., et al.</i> , 2009 WL 331891 (E.D. Tex.) (" <i>Invitrogen 2</i> ")	District of Maryland	Granted
<i>Odom v. Microsoft Corp.</i> , 2009 WL 279968 (E.D. Tex.)	District of Oregon	Granted
<i>Fifth Generation Computer Corp. v. Int'l Bus. Machs. Corp.</i> , 2009 WL 398783 (E.D. Tex.)	S.D. New York	Granted
<i>Partsriver, Inc., v. Shopzilla, Inc.</i> , 2009 WL 279110 (E.D. Tex.)	N.D. California	Granted
<i>Jackson V. Intel Corp.</i> , 2009 WL 749305 (E.D. Tex.)	N.D. Illinois	Granted
<i>AT&T Intellectual Property I, L.P., et al. v. Airbiquity, Inc.</i> , 2009 WL 774350 (N.D. Tex.)	W.D. Washington	Granted
<i>Sanofi-Aventis, GmbH v. Genentech, Inc.</i> , 2009 WL 764303 (E.D. Tex.)	N.D. California	Denied
<i>Konami Digital Entertainment Co. v. Harmonix Music Sys., Inc., et al.</i> , 2009 WL 781134 (E.D. Tex.)	D. Massachusetts	Denied
<i>Knapper v. Safety Kleen Sys., Inc.</i> , 2009 WL 909479 (E.D. Tex.)	S.D. Texas or S.D. Florida	Denied
<i>Sanofi-Aventis, GmbH v. Novo Nordisk, Inc.</i> , 2009 WL 903380 (E.D. Tex.)	S.D. New York	Stayed (pending resolution of other issue)

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Court finds that Defendant has failed to show the transfer to the District of Maryland would be clearly more convenient. *See Volkswagen II*, 545 F.3d at 315. *Invitrogen 1* at *5.

CASES GRANTING TRANSFER

Invitrogen Corp. v. General Electric Co., et al. (“*Invitrogen 2*”):

Under the circumstances presented here, the concern for judicial economy weighs significantly in favor of transfer, with the other factors neutral or weighing slightly in favor of transfer. While Plaintiff’s witnesses reside in California, all other key witnesses reside in the Northeast or England. No Texas resident is a party to this litigation, nor is any Texas state law cause of action asserted. Most importantly, a Maryland court has had extensive involvement with three of the six patents at issue and a settlement agreement was entered into in the Maryland litigation that forms the basis of Defendant’s patent exhaustion defense. Based on this analysis, the Court finds that Defendant has shown that transfer to the District of Maryland would be clearly more convenient. *See Volkswagen II*, 545 F.3d at 315.

Invitrogen 2 at *6.

Fifth Generation Computer Corp. v. International Business Machines Corp.:

After careful analysis of the private and public interest factors, the court concludes that transfer is warranted in this case. Public interest factor 1 weighs against transfer, factors 3 and 4 are neutral, and factor 2 weighs in favor of transfer. Private interest factor 2 is neutral and factor 4 weighs somewhat against transfer. However, factors 1 and 3 — the relative ease of access to sources of proof and the cost of attendance for witnesses — both weigh fairly heavily in favor of transfer.

Key to the court’s decisions are the facts that no Blue Genes have been sold in Texas; no act of infringement has been identified as occurring in the Eastern District; only one potential witness has been identified as having any connection to Texas at all; multiple potential witnesses are located in or near the Southern District of New York (*i.e.*, two of the inventors, at least one integral member of the research and development team, and the prosecuting attorneys); and both parties have their principal places of business in the Southern District. Although other witnesses and evidence may be located outside of New York, FGC fails to specifically identify any such individuals or documents to the court. Under these facts, transfer to the Southern District of New York is appropriate.

Fifth Generation at *6.

Odom v. Microsoft Corporation, 2009 WL 279968 (E.D. Tex.):

Under the circumstances presented here, the convenience of witnesses and localized interests weigh in favor of transfer with the other factors neutral or weighing slightly in favor of transfer. This is a case that is significantly localized in the Northwest. Both parties are residents of the Northwest, and Microsoft’s equitable defenses all arise out of conduct and contracts in the Northwest. No Texas resident is a party to this litigation, nor is any Texas state law cause of action asserted. All identified witnesses — with the possible exception of one — are located in the Northwest. This is not a case where witnesses are expected to be traveling from all over the country or world. In summary, there is little convenience to the parties for this case to remain in Texas, while there are several reasons why it should be more convenient for the parties to litigate this case in Oregon.

The Court finds that Defendant

has shown that transfer to the District of Oregon would be clearly more convenient. *See Volkswagen II*, 545 F.3d at 315. *Odom* at *7.

In view of these decisions, a road map is forming, which shows what facts support, and what facts weigh against, transfer and how best to present those facts. In short, these facts relate to two issues: 1) the overall regional or national nature of the case; and 2) the importance of related cases. When looking at the regional or national nature of the case, courts pay particular attention to: 1) locations of parties and key third parties, 2) locations of key witnesses, and 3) locations of documents and things that cannot be produced electronically.

For a party seeking to have a case transferred, this developing road map provides insight into the transferee venue to select. That is, while facts of a case may warrant transfer to a venue, that does not mean that transfer will be granted to any venue. Indeed, the analysis is still whether the transferee venue is more convenient.

OVERALL REGIONAL OR NATIONAL NATURE OF CASE

Following *TS Tech*, courts in the Fifth Circuit look to whether the case is regional or national. In doing so, they look to the location of parties, witnesses, physical items, and documents that cannot be transferred electronically. In some cases, the court’s conclusions lump all of these facts together in making a determination about the national or regional nature of the case. For example, in *Partsriver*, in a sentence that summarizes the bases for the decision, the court states, “The Court finds that the overall nature of this case, considering all of the involved parties, is regional and would therefore be more conveniently handled by the Northern District of California.” *Partsriver* at *2; *see also, Odom* at *7.

In contrast, a finding that a case is nationwide or worldwide can

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profoundly influence a transfer decision. For example, the conclusion section for *Novartis* shows that the decision not to transfer was summed up as the case being “nationwide in scope.” *Novartis* at *6; see also, *J2* at *7. Indeed, in the only Federal Circuit decision addressing this issue written after *TS Tech*, the court upheld the denial of a request to transfer a case from the Eastern District of Texas to the Northern District of Illinois when parties, witnesses, physical items, and documents were not clustered around one region, but were instead spread around the country (parties, witnesses, and documents were located in Chicago, Atlanta, and Dallas).

The location of parties and witnesses and the Fifth Circuit’s 100-mile rule were addressed in detail in *TS Tech*, with the location of the parties and witnesses concentrated in a region close to the transferee district. Fifth Circuit district court cases issuing after *TS Tech* have been sensitive to the 100-mile rule and convenience of witnesses. However, as discussed in *J2*, it is important to set forth the relative importance of the witnesses that the parties want considered in this analysis. *J2* at *7. (“Only one factor weighs slightly in favor of transfer in these cases — the potential need for compulsory process to secure the testimony of four witnesses. Defendants have not shown that these four witnesses are of critical importance, or even that their testimony is more important than the witness that this Court would have subpoena power over.”) Moreover, when witnesses are spread throughout the United States or world, this issue does not even slightly favor transfer. See e.g., *Invitrogen 1* at *5 (“While some witnesses are in the Northeast, the Court is not persuaded that this overrides the fact that other witnesses are in California and that this forum is more convenient for those witnesses.”)

In *re D-Link Corp.*, 183 Fed. Appx. 967 (Fed. Cir. 2006), an unpublished opinion from the Federal Circuit, addressed the distinction

between documents and things that cannot be produced electronically and documents that readily can be produced electronically to any location. In short, the former has a bearing, which is potentially significant, as discussed above, on the § 1404 determination, while the latter has none. *D-Link* at *2. This distinction regarding electronically available documents has been followed and noted by several post-*TS Tech* cases. See e.g., *Odom* at *3; *MHL Tek* at *5.

IMPORTANCE OF RELATED CASES

Related cases can have a significant impact on the transfer decision, based on considerations related to judicial economy and preventing inconsistent adjudications. The importance of this factor is best illustrated by the different outcomes of *Invitrogen 1* and 2. In *Invitrogen 2*, related cases in the transferee forum were the most important fact in the transfer decision. *Invitrogen 2* at *6. (“Most importantly, a Maryland court has had extensive involvement with three of the six patents at issue and a settlement agreement was entered into in the Maryland litigation that forms the basis of Defendant’s patent exhaus-

tion defense.”) Conversely, in *Invitrogen 1*, while not identified as the most important fact in the decision not to transfer, the court concluded its decision by stating that, unlike *Invitrogen 2*, “this is not a situation where the transferee district has had extensive involvement with the patents and products at issue.” *Invitrogen 1* at *5.

Another example is in *MHL Tek*. There, the court discussed judicial economy and preventing inconsistent adjudications in view of two other pending cases involving the exact same patents. In the conclusion section of its opinion, the court specifically noted that “it is necessary to retain this case in order to preserve judicial economy and prevent inconsistent adjudications.” *MHL Tek* at *7-8.

CASES OUTSIDE OF THE FIFTH CIRCUIT CITING TS TECH

As of May 19, 2009, eight decisions outside of the Fifth Circuit have cited *TS Tech*. Chart 2, below, lists those decisions.

In *Acer*, two suits involving overlapping patents were addressed in the transfer decision. The first-filed

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Chart 2

Cases Outside the Fifth Circuit	Transfer Requested To	Decision
<i>Acer, Inc., et al., v. Tech. Props. Ltd., et al.</i> , 2009 WL 279330 (N.D. Cal.)	E.D. Texas	Denied
<i>Media Queue, LLC v. Netflix, Inc.</i> , 2009 WL 464456 (E.D. Okla.)	N.D. California	Granted
<i>Wacoh Co. v. Chrysler LLC</i> , 2009 WL 36666 (W.D. Wis.)	E.D. Michigan	Granted
<i>Ledelite Architectural Prods. v. Pinnacle Architectural Lighting, Inc.</i> , 2009 WL 54239 (W.D. Wis.)	District of Colorado	Denied
<i>Rabbit Tanaka Corp. USA v. The Paradies Shops, Inc.</i> , 2009 WL 174983 (N.D. Ill.)	C.D. California	Denied
<i>Kannar v. Alticor, Inc.</i> , 2009 WL 975426 (N.D. Cal.)	W.D. Michigan; or C.D. California	Denied (W.D. Michigan) Granted (C.D. California)
<i>Medimmune, LLC v. PDL Biopharma, Inc.</i> , 2009 WL 1011519 (N.D. California)	D. Delaware	Denied
<i>Casana Furniture Co. LTD. v. Coaster Co. of America</i> , 2009 WL 783399 (M.D.N.C.)	C.D. California	Denied

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suit was a declaratory judgment action on nine patents. The suit was filed in the Northern District of California. The second-filed suit was filed by the patent owner in the Eastern District of Texas against the Northern District of California declaratory judgment plaintiffs. The second suit involved seven of the nine patents. The Northern District of California denied the transfer to the Eastern District of Texas. In a footnote, the Northern District of California cited *TS Tech* for the proposition that “the convenience factors in the instant actions would favor transfer of any litigation between the parties out of the Eastern District of Texas.” *Acer* at *3 n.8. Thus, part of the decision in *Acer* was based on the court’s belief that the Eastern District of Texas should transfer its case to the Northern District of California.

Continuation

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Allowance from the USPTO. The claims in the parent application included the claim term “slit,” while the continuation patent claims included the broader claim term, “opening.” Unfortunately for the patentee, the court interpreted the claimed “opening” in the continuation to be limited to a “slit” because of arguments in the parent application distinguishing prior art on that basis.

According to the court, while it is recognized that an applicant can broaden, as well as restrict claims during prosecution, and that continuing applications may present

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On Jan. 7, 2009, less than two weeks after the *TS Tech* decision, the Western District of Wisconsin cited *TS Tech* in two decisions, *Wacoh* and *Ledalite*. In *Wacoh*, the court summarily addressed *TS Tech* stating, “I am skeptical of its applicability,” and deciding not to consider *TS Tech* because “it is unnecessary to the resolution” of the case. *Wacoh* at *3. In *Ledalite*, the court distinguished *TS Tech* based on the facts of the case. Significantly, the court used its “rocket docket” case schedule as a distinguishing factor in the transfer analysis. *Ledalite* at *3 (“In this case, as in nearly every case before this court, plaintiff has an interest not at issue in *TS Tech*: speed.”).

CONCLUSION

TS Tech and, to a lesser extent for patent cases, *Volkswagen*, have changed the landscape of § 1404(a) cases in the Fifth Circuit. Patent cases that once would not have been

transferred out of the Fifth Circuit may now be transferred based on *TS Tech*. As such, parties need to be mindful of these cases, and all facts relevant to the public and private interest factors described therein, before proceeding with patent litigation in the Fifth Circuit district courts. In particular, parties need to consider whether the parties, witnesses, physical items, and documents are centered around a single region, or whether related cases give a particular court experience with the claims-at-issue before determining where to file or how to proceed with a transfer request. In courts outside the Fifth Circuit, parties should determine if courts within their circuit-of-interest have applied *TS Tech* or if the transfer law of the circuit aligns with Fifth Circuit transfer law such that *TS Tech*, in whole or part, applies.



broader claims than were allowed in a parent, a disclaimer of scope (e.g., an argument distinguishing prior art over a particular claim term) must be properly rescinded to permit recapture. More specifically, “the prosecution history must be sufficiently clear to inform the examiner that the previous disclaimer, and the prior art that it was made to avoid, may need to be re-visited.”

In this case, the patent attorney actually did try to avoid the result that was ultimately reached. The patent attorney “informed the examiner that the new claims were broader than those previously allowed,” thus arguing that “when the examiner allowed the new claims without rejection, there is a presumption that the examiner had assured himself of the patentability of the new claims.” However, the accused infringer argued that the patentee still “did not specifically point out that he no longer intended to be limited to the specific mechanism that he had previously argued was the distinguishing feature of his invention.”

Consequently, it should now be a recommended prosecution practice to review the claims in every con-

tinuing application in view of statements made to the USPTO during prosecution of parent applications. If previous claim elements are being broadened in the continuing application and were previously distinguished over prior art, it would be advisable to include an explicit rescission of any previous claim scope disclaimers arising from those distinguishing statements. Likewise, if a patent in litigation is a continuation that does not include such a needed disclaimer, the patent may be subject to a narrower claim construction that results in noninfringement.

FILING CONTINUATIONS AIMED AT COMPETITOR PRODUCTS QUESTIONED

The written description, enablement, and best mode requirements

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Continuation

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flow from 35 U.S.C. § 112(1), which is as follows:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

In *Liebel-Flarsheim v. Medrad*, 481 F.3d 1371 (Fed. Cir. 2007), the Federal Circuit affirmed summary judgment findings of invalidity for lack of enablement (without needing to consider the additional lower court finding of invalidity for lack of written description) for patents directed to a front-loading fluid injector with a replaceable syringe capable of withstanding high pressures for delivering a contrast agent to a patient. The asserted patents were continuations that did not include a “pressure jacket” claim element that appeared in a parent patent.

The Federal Circuit observed that the patentee deleted the “pressure jacket” element from the continuation claims after learning of the defendant’s product, which did not include the pressure jacket. The court also stated that there was no suggestion in the specification of an embodiment that would not include a pressure jacket; the “Background” teaches pressure jackets are needed, thus teaching against removing them; and other evidence showed undue experimentation would have been needed to develop such a device. Because there was evidence of undue experimentation being needed in this case, the “full scope of the claimed invention,” which includes systems with and without a pressure jacket, was not enabled.

Consequently, in addition to the customary practice of disclosing embodiments with alternative elements

in patent applications, practitioners should also evaluate disclosing that certain elements are not included in some embodiments. Furthermore, before deciding to accept a first patent and file a continuation seeking claims without a particular claim element, practitioners should review the specification to first determine if there is a statement in the specification that the claim element is not necessary or does not exist in some embodiments. If the specification does not include such a statement or teaches against embodiments without a particular claim element, it may be better to pursue the broader protection in the first patent application.

LATE CLAIMING CREATES NEW WRITTEN DESCRIPTION PROBLEMS

In *ICU Medical v. Alaris Medical Systems*, No. 2008-1077 (Fed. Cir. March 13, 2009), the Federal Circuit again affirmed a grant of summary judgment of invalidity of continuation patents based on § 112(1), but for lack of written description. The continuation patents for medical valves failed to include a “spike,” despite that element being included in the initial claims and being in all embodiments. While the result is similar to that reached in *Gentry Gallery*, the Federal Circuit did not reference that case or rely upon common facts that were relied upon by the district court. For example, there were affirmative statements in the Summary about the “invention” including a “spike,” but the Federal Circuit did not rely on that statement. Thus, regardless of whether a patent specification suggests an element is “essential,” the broadest initial claim scope may be a barrier, absent specification statements that initial elements are optional.

Consequently, for each new patent application, care should be taken to make sure the original independent claims are as broad as possible, and if any elements could possibly be omitted or broadened in the future, the specification should state that those elements are not included in some embodiments. However, additional care should also be taken to

make sure alternative embodiments are fully enabled in view of the recent cases of *Sitrick v. Dreamworks*, 516 F.3d 993 (Fed. Cir. 2008), and *Auto. Tech v. BMW*, 501 F.3d 1274 (Fed. Cir. 2007), since those cases require heightened enablement for alternative embodiments. In addition, if any elements of original independent claims are effectively deleted or broadened in continuing applications, it may be useful to notify the USPTO to bolster the presumption of validity under § 112(1).

PRIORITY DATES UNDER ATTACK

In *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299 (Fed. Cir. 2008), the Federal Circuit affirmed summary judgment findings of invalidity under 35 U.S.C. § 102(b) of continuing patents resulting from the patents losing their benefit to the filing date of an earlier patent under 35 U.S.C. § 120. The filing date benefit was denied because of a continuation-in-part (“CIP”) filing in the continuity chain that the court used as evidence that the specification of the earliest patent did not support the asserted claims by providing the written description required by 35 U.S.C. § 112.

The *PowerOasis* patents covered a vending machine for dispensing telecommunications channel access, and the asserted claims included a “customer interface” that the patentee unsuccessfully argued was supported by at least one embodiment in the earliest specification. Originally, the customer (or user) interface was disclosed (in all originally disclosed embodiments) as being located on the vending machine itself, but the CIP application disclosed that it could also be located as a software display on a customer laptop (which also corresponds to the accused system). Even though the claim did not explicitly reference

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MOVERS & SHAKERS

Katten Muchin Rosenman LLP has announced that **Jeffrey Alan Hovden** has joined the firm as a New York-based partner in its Intellectual Property Practice. Hovden, who concentrates his practice in intellectual property litigation, was previously a partner in the New York office of Frommer Lawrence & Haug LLP.

Hovden's practice focuses on litigating patent infringement and invalidity actions on most of the world's top-selling prescription drugs, for both generic and name-brand clients. He also litigates pharmaceutical patent cases under the Hatch-Waxman Act. Hovden has experience advising clients on drug-approval provisions under the Food, Drug and Cosmetic Act and their attendant regulations.

He provides infringement, validity and due-diligence opinions, and counsels biotechnology clients on licensing matters. Hovden has also worked in the area of copyrights, particularly of functional works.

The Dallas trial law firm **Rose•Walker, L.L.P.**, has announced the addition of intellectual property attorney **John Pinkerton** as a partner.

Pinkerton's intellectual property practice focuses on patent litigation, patent and technology license agreements, and opinions of counsel on issues of patent infringement, validity, and enforceability. His expertise also includes cases involving trademark and copyright infringement and trade secret misappropriation, as well as trademark registrations

and trademark opposition and cancellation proceedings.

"John is a seasoned intellectual property attorney and a great addition to the firm," says Rose•Walker Administrative Partner Mike Richardson. "His lengthy career in IP law adds to our expertise and increases the courtroom threat we present in the ever-expanding number of IP cases we handle."

Pinkerton joins Rose•Walker from Gardere Wynne Sewell LLP, where he was a partner in the firm's intellectual property section. He previously handled intellectual property matters while practicing with Hunton & Williams LLP and Jones, Day, Reavis & Pogue in Dallas, and also served in the U.S. Army Judge Advocate General's Corps.



Continuation

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the location of the customer display element, the court found that there was no written description support in the original specification for a customer interface located on a customer's laptop.

By noting that there were no original embodiments that did not locate the customer interface on the vending machine, the court narrowly construed the "customer interface" claim element in a way that, by definition, could not have been supported by the original specification. This type of result may be possible in every patent having a CIP in its continuity chain. In other words, if any genus claim element in a CIP covers one species disclosed in a parent application and another species disclosed in a CIP application, the genus claim element may not have written description support in the parent application. Furthermore, this result is

theoretically not limited to CIP continuity chains. For example, similar results may be reached when patents claim priority to provisional applications that disclose fewer embodiments or are less extensive than the resulting patent disclosures.

There are several practice tips to take from this decision. For CIPs, utility applications claiming priority to provisional applications, and continuations of both, claims intended to have original filing dates should be drafted to explicitly exclude all new matter. In other words, to be assured of earliest priority for a particular set of claims, it may be necessary to make sure that it is not possible for any new matter to fall within the scope of those claims in any way. In addition, the Federal Circuit also noted in this case that the USPTO did not make a priority determination during examination. While such determinations rarely occur unless intervening prior art happens to arise, practitioners may wish to prompt such deter-

minations when possible, in view of this decision.

CONCLUSION

Recent decisions have assaulted continuations on several fronts. Because of a new requirement to rescind claim scope disclaimers, it will be easier to avoid infringement of continuations, and because of strengthening enablement and written description requirements, more continuations will be invalidated on those grounds and on prior art grounds when priority claims are more easily broken. Consequently, care should be taken in the preparation and prosecution of any patent application claiming priority to another application.



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