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**Updates in Science & Technology Law —
Patent Law and the Federal Circuit in 1995**

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IN RE ASAHI/AMERICA INC., 1995 U.S. APP. LEXIS 3660
(FED. CIR. FEB. 24, 1995).

1. Asahi, assignee of a U.S. patent to Ziu ("Ziu"), appealed a decision of the United States Patent and Trademark Office ("PTO") Board of Appeals ("Board") (1) affirming the examiner's final rejection, upon reexamination, of claims 1-3 of Ziu as being anticipated by a patent to Sweeney ("Sweeney") under 35 U.S.C. §102(e), and (2) affirming the examiner's finding that Asahi's 37 C.F.R. § 1.131 ("131") declaration did not show facts sufficient to establish reduction to practice of the invention claimed in Ziu prior to the filing date of Sweeney. The 131 declaration contained, *inter alia*, a photograph of an alleged reduction to practice according to the invention.
2. The Board relied on *Newkirk v. Lulejian*, 825 F.2d 1581, 3 U.S.P.Q.2d 1793 (Fed. Cir. 1987), in holding that Asahi's 131 declaration was insufficient to prove reduction to practice because the 131 declaration failed to show that the invention worked for its intended purpose. The Federal Circuit noted, however, that the invention in *Newkirk*, an "electronic glassware conveyor delivery apparatus having a pushout robot means," was "relatively complex" compared to the "double containment pipe system" in Ziu. The Federal Circuit concluded that the Ziu device was so simple that mere construction of it was sufficient to constitute reduction to practice. The photograph, coupled with the entirety of the 131 declaration, established that the pipe system had been constructed and thus reduced to practice prior to the filing date of Sweeney. The Federal Circuit, therefore, reversed the rejection.

COMAIR ROTRON, INC. V. NIPPON DENSAN CORP., 1995 U.S. APP. LEXIS 3770
(FED. CIR.(CONN.) FEB. 24, 1995).

3. The district court granted summary judgment in favor of Nippon Densan Corp. ("Nidec"), holding that Comair Rotron, Inc., ("Rotron") could not charge Nidec with infringement of Rotron's patents, due to collateral estoppel from prior litigation in New Jersey between Rotron and Matsushita. In the damages phase of the New Jersey action, one issue had been whether Matsushita's damages should be based on a royalty or a lost profits measure. The issue required determination of whether Matsushita had established a significant presence in the market for noninfringing substitutes of the patented device. The New Jersey court concluded that since noninfringing substitutes existed in the market, *including Nidec's*, the damages awarded for Matsushita's infringement should use a royalty measure. The Federal

Circuit determined that the district court had failed to show that its finding as to Nidec was essential to this holding, for the New Jersey court's decision was supportable whether or not the Nidec products were found to be infringing. The Federal Circuit reached the lower court's decision on review of its findings that the products of other manufacturers, with or without Nidec, were fully competitive substitutes. The district court's finding as to Nidec's infringement sufficed to negate estoppel because the infringement finding was not essential to the damages decision in the New Jersey action. Accordingly, the Federal Circuit reversed.

4. In a concurrence, Judge Rader found additional factors supporting reversal, including that the two actions arose "in two entirely different contexts," the absence of "actual litigat[ion]" with regard to Nidec, and Rotron's lack of "opportunity" to compel discovery from Nidec.

L.E.A. DYNATECH, INC. V. EDWARD F. ALLINA & METER TREATER, INC., 1995 U.S. APP. LEXIS 3417 (FED. CIR.(FLA.) FEB. 17, 1995).

5. In February 1991, L.E.A. Dynatech, Inc. ("LEA") filed suit against Edward Allina and Meter Treater, Inc. (together "Meter Treater") seeking a declaratory judgment of noninfringement and unenforceability of five patents owned by Meter Treater. Meter Treater counterclaimed for infringement of one of the patents. In November 1991, Meter Treater filed a reissue application on the patent, adding claims to initiate an interference with a third party. Meter Treater informed neither the district court nor LEA of its application for reissue.
6. When LEA learned of the reissue application in February 1992, it moved to stay the district court case. LEA sought the stay to avoid unnecessary and duplicative discovery and to minimize trial preparation. Meter Treater vigorously opposed the motion. The district court denied LEA's motion to stay in March 1992. Discovery proceeded.
7. In June 1992, the PTO examiner rejected all the claims in the reissue application, including the claims as originally filed. In September 1992, seven months after Meter Treater had opposed LEA's motion for a stay, and immediately prior to the pre-trial conference, Meter Treater made its own motion to stay pending completion of the reissue proceeding. LEA opposed the motion and urged that the case proceed to trial. In the alternative, LEA asked for dismissal without prejudice, as well as attorney's fees and costs. The district court did not rule on Meter Treater's motion.

8. In April 1993, after learning that the examiner had issued a Final Office Action rejecting all the claims of the Meter Treater application, LEA again moved to dismiss without prejudice and for attorney's fees and costs. Meter Treater opposed LEA's motion to dismiss, but did not respond to the request for fees. The district court then dismissed all claims and counterclaims in the litigation without prejudice. The district court also awarded attorney's fees and costs accruing from March 6, 1992, the date the district court had denied LEA's motion to stay. Meter Treater appealed to the Federal Circuit in May 1993.
9. In August 1993, the Federal Circuit stayed the appeal pending the district court's calculation of the fee award. In February 1994, the district court directed Meter Treater to pay LEA \$537,541.60 in fees and costs. LEA then moved for entry of final judgment. Meter Treater responded by moving to amend or vacate the April 1993 Order. Meter Treater also opposed entry of final judgment. Meter Treater raised, for the first time, objections to the district court's fee award in its supporting memorandum, asserting, *inter alia*, that the fee award would bankrupt it.
10. On April 14, 1994, the district court denied Meter Treater's motion to amend and entered final judgment. Meter Treater then appealed to the Federal Circuit. Also before the Federal Circuit was Meter Treater's May 1993 appeal, because the district court's entry of final judgment had lifted the Federal Circuit's earlier stay. Using an abuse of discretion standard, the Federal Circuit affirmed the district court on both the dismissal and the award of attorney's fees.
11. Several policies supported the district court's dismissal without prejudice. The dismissal removed the case from the district court's docket pending the agency appeal. The dismissal also preserved the resources of the court and the parties by preventing further discovery and litigation on claims that might not have survived the reissue. In addition, the dismissal eliminated any prejudice to LEA from the bare existence of the infringement suit. Finally, the dismissal without prejudice left undisturbed Meter Treater's opportunity to enforce any patent claims surviving the reissue process. The Federal Circuit, moreover, noted that dismissal without prejudice may operate as an alternative to a stay of proceedings.
12. On the issue of attorney's fees, the Federal Circuit stated that the record showed that Meter Treater had manipulated the timing of court proceedings to suit its own interests and that the district court had properly tailored the award to Meter Treater's period of manipulation. With regard to Meter Treater's bankruptcy

argument, the Federal Circuit found no showing that bankruptcy would foreclose enforcement of legitimate intellectual property rights by Meter Treater's successor in interest. In addition, the bankruptcy argument came too late since Meter Treater had not raised it with the district court and none of the relevant exceptions applied.

13. Judge Schall dissented on the issue of attorney's fees, arguing that the record did not support the necessary factual finding of bad faith or abuse of the judicial process and that the sanction was premature, given that an appeal involving the reissue application was still pending.

MOLINS PLC V. TEXTRON, INC., 1995 U.S. APP. LEXIS 2959
(FED. CIR.(DEL.)FEB. 16, 1995).

14. Molins PLC ("Molins") filed suit against Textron, Inc., ("Textron") alleging infringement. After approximately three years of discovery, Textron filed a summary judgment motion asserting that the patents were unenforceable due to inequitable conduct in connection with the prosecution of the patents, in particular, concealment of a Wagenseil reference and other information from the PTO. The motion was denied. After more discovery, Textron again moved for summary judgment, adding new allegations of inequitable conduct relating to the failure of Molin's patent attorney, Smith, to disclose to the PTO allegedly material information regarding a copending patent application in the name of Jerome Lemelson, whom Smith also represented. Again, the court denied summary judgment. In doing so, the court severed the issue of inequitable conduct and held a bench trial.
15. At trial, the court held both patents unenforceable due to inequitable conduct. The court found the case to be "exceptional" within the meaning of 35 U.S.C. § 285 (1988) and held Molins and Smith jointly and severally liable for all the defendants' attorney's fees, costs, and expenses. Molins and Smith appealed.
16. The Federal Circuit stated that "inequitable conduct includes affirmative misrepresentation of a material fact, failure to disclose material information, or submission of false material information, coupled with an intent to deceive." The withholding of information must meet thresholds of both materiality and intent. The standard a court should apply in determining whether a reference is "material" is not whether the particular examiner of the application at issue considered the reference to be important, rather, it is that of a "reasonable examiner." The fact

that the examiner did not rely on Wagenseil to reject the claims under reexamination was not conclusive with regard to whether the reference was material.

17. Because the trial court found that Molins and Smith had known that Wagenseil was material and had heard testimony and judged matters of credibility concerning intent, the Federal Circuit sided with the trial court. According to the Federal Circuit, those who are not “up front” with the PTO run the risk that, years later, a fact-finder might conclude they intended to deceive.
18. With regard to the Lemelson patents, the Federal Circuit sided with Molins and Smith. The latter argued that the trial court erred in finding inequitable conduct in their failure to cite the Lemelson patents, because the patents had actually been cited by the PTO, had been considered during prosecution, had been used to reject pending claims, and had been overcome prior to issuance. In addition, the issue of whether or not there was a conflict of interest due to Smith’s dual representation was not before the Federal Circuit.
19. Finally, the Federal Circuit remanded on the issue of attorneys’ fees, because the trial court’s decision on that issue had been based on the trial court’s erroneous findings of “repeated instances of inequitable conduct” and “litigation conduct.”
20. Judge Newman argued separately that the attorney-client privilege takes precedence over PTO regulations and therefore Smith had no duty to disclose the confidences of an unrelated client.
21. Judge Nies argued separately that Molins and Smith were guilty of a pattern of misconduct in the course of the prosecution, the subsequent reexamination, and the litigation below, during which they had destroyed documents. These acts were interrelated and could not be isolated from each other.

ABBOTT LABS. V. DIAMEDIX CORP., 1995 U.S. APP. LEXIS 2298
(FED. CIR.(ILL.) FEB. 7, 1995).

22. Prior to 1988, Diamedix Corp. (“Diamedix”) granted eight non-exclusive licenses under its patents. In August 1988, following a dispute with Abbott Laboratories (“Abbott”) over alleged infringement of the patents, Diamedix entered into a license agreement with Abbott. In exchange for annual royalty payments, Abbott received a worldwide license to make, use, and sell products incorporating the

inventions claimed in the patents. The license was exclusive to Abbott and its affiliates, but was subject to the rights Diamedix had previously granted to its licensees. In addition, the agreement reserved to Diamedix the right to make and use products that exploited the patents, as well as the right to sell these products to Diamedix's previous licensees, to Abbott's sublicensees, to end users, and to certain other parties to fulfill Diamedix's existing contractual obligations. The agreement was to remain in effect for the life of the patents unless Abbott decided to terminate it earlier. Neither party could assign the agreement without the consent of the other.

23. In January 1994, Abbott filed an action in district court, charging appellee Ortho with infringing the patents. Ortho denied the allegations of infringement, asserted as an affirmative defense that the patents were invalid, and claimed that Abbott's delay in bringing suit barred it from seeking relief. Because Abbott did not join Diamedix as a party to the lawsuit, Diamedix promptly filed a motion to intervene and a complaint as plaintiff-intervenor alleging that Ortho had infringed its rights under the patents. In its motion, Diamedix argued that its rights as legal owner of the patents entitled it to intervene under Fed. R. Civ. P. 24(a)(2). In the alternative, Diamedix moved to be permitted to intervene under Fed. R. Civ. P. 24(b). Diamedix also suggested that as the holder of legal title to the patents, it might be required to participate in order to give the district court jurisdiction over the suit. Ortho supported Diamedix's motion to intervene on the ground that Diamedix retained a significant interest in the patents under its agreement with Abbott and might be an indispensable party under Fed. R. Civ. P. 19(b).
24. The district court denied Diamedix's motion to intervene, concluding that Abbott adequately represented Diamedix's interests in the lawsuit. The court explained that Diamedix and Abbott shared the common goals of enforcing the patent rights against Ortho and maximizing the recovery of monetary damages. Diamedix argued that Abbott had a disincentive to defend the validity of the patents with great vigor, since a decision invalidating the patents would free Abbott from its royalty obligations. The district court dismissed Diamedix's contention, noting that the agreement with Diamedix obligated Abbott not to "prejudice or impair the patent rights" and no basis existed to believe that Abbott would fail to honor this obligation in the action against Ortho. In addition, the court concluded as a practical matter that Diamedix's intervention would be nothing more than a paper entry into the clerk's docket because Abbott had the right under the licensing agreement to control the prosecution of any infringement action that it had

initiated. Diamedix took an immediate appeal from the order denying its motion to intervene.

25. The Federal Circuit stated that this case could best be resolved by addressing a related but logically antecedent question: whether a licensee such as Abbott has the statutory right to bring an action for infringement without joining the patent owner. The Federal Circuit cited *Waterman v. Mackenzie*,¹ in which the Supreme Court stated that an assignment by the patent owner of the whole of a patent right, or of an undivided part of a right, or of all rights in a specified geographical region, gives an assignee the right to bring an action for infringement in its own name. A transfer of anything less, the Court explained, is a license, not an assignment. If the patent owner grants only a license, title remains in the owner of the patent. Suit may be brought only in the owner's own name, and never in the name of the licensee alone, unless necessary to prevent an absolute failure of justice, such as where the patentee is the infringer and cannot sue itself. According to the Court, any rights of the licensee must be enforced through or in the name of the owner of the patent, and perhaps, if necessary to protect the rights of all parties, by joining the licensee as a plaintiff.
26. Abbott argued that it was not necessary to join Diamedix in this action because the agreement between Abbott and Diamedix transferred all substantial rights under the patents to Abbott. The Federal Circuit disagreed. Although the agreement effected a broad conveyance of rights to Abbott, Diamedix retained substantial interests, and therefore Abbott did not have an independent right to sue for infringement as a "patentee" under the patent statute.
27. In discussing Fed. R. Civ. P. 19(a), the Federal Circuit rejected Abbott's argument that if a patentee in Diamedix's position declined to participate, the action could not go forward. The court found that a patentee who does not voluntarily join an action prosecuted by its exclusive licensee may be joined as a defendant or, in a proper case, made an involuntary plaintiff if the licensee is not subject to service of process. Here, however, the Federal Circuit decided only that when a patent owner retains a substantial proprietary interest in the patent and wishes to participate in an infringement action, the court must allow it to do so. The Federal Circuit noted that the nature of Diamedix's participation was a different matter and refrained from commenting on the extent to which the "control" clause of the license gave Abbott the right to control Diamedix's conduct as a party in the case.

SAGE PRODS. V. DEVON INDUS., 1995 U.S. APP. LEXIS 1485
(FED. CIR.(CA.) JAN. 26, 1995).

28. Sage Products ("Sage") owned a utility patent on a combination of an outer enclosure and a replaceable inner container, sold by Sage as a medical waste disposal system to hospitals. The inner container had no separate utility patent protection. The specification of the patent and Sage's marketing directed the hospitals to dispose of filled inner containers. Sage refused to do business with hospitals that did not so dispose. The claims of the patent, however, spoke not of a "disposable" inner container, but only of a "removable" one.
29. Devon Industries ("Devon") sold replacement inner containers for use with Sage's system. Sage sued Devon for contributory and/or inducement of infringement, claiming that hospitals were impermissibly reconstructing and therefore directly infringing the patented combination by using Devon's containers with Sage's outer enclosure. Disagreeing, the Federal Circuit held that Devon was not liable for infringement, because hospitals were conducting permissible repair when they replaced Sage's containers with Devon's.

FERAG AG V. QUIPP INC., 1995 U.S. APP. LEXIS 1430, 33 U.S.P.Q.2D (BNA) 1512
(FED. CIR.(FLA.) JAN. 24, 1995).

30. Ferag AG sold a product embodying its patent to a related entity, Ferag Inc., and to an unrelated party. In an infringement suit brought by Ferag AG against Quipp Inc. ("Quipp"), Quipp countered by claiming that the patent was invalid under the on-sale bar due to these sales. The district court held that these sales were not sufficient to raise the bar for two reasons. First, Ferag Inc. was not a separate entity from Ferag AG. Second, to trigger the bar, Ferag AG must have had an intent to sell the invention prior to the bar date, and it must have communicated that intent to the public for the purposes of eliciting a sale prior to the bar date.
31. Reversing the district court's decision, the Federal Circuit found that the same person or group did not control Ferag AG and Ferag Inc. In addition, the proper inquiry for applying the bar was whether, under the totality of the circumstances, the inventor had placed his or her invention on sale, objectively manifested by a sale or offer for sale of a product that embodied the invention claimed in the patent. The Federal Circuit emphasized that this was an objective test and that at its heart lay the inventor's attempt to commercialize the invention. The district court mistakenly relied on the seller's intent and the purchaser's understanding. The

measure of the bar, the Federal Circuit held, was what was offered, not the patentee's intent.

GLAVERBEL SOCIÉTÉ ANONYME & FOSBEL, INC. V. NORTHLAKE MKTG. & SUPPLY,
1995 U.S. APP. LEXIS 1211, 33 U.S.P.Q.2D (BNA) 1496
(FED. CIR.(IND.) JAN. 23, 1995).

32. Northlake Marketing & Supply ("Northlake") appealed the judgment of the district court upholding the validity of patents held by Glaverbel Société Anonyme and Fosbel, Inc. (together "Glaverbel") and declining to find fraudulent procurement or that Glaverbel had used the patents to violate the antitrust laws. Glaverbel cross-appealed the grant of Northlake's motion for summary judgment of non-infringement.
33. With regard to anticipation, the Federal Circuit stated that "the claims are read in the context of the patent specification in which they arise and in which the invention is described." If needed to impart clarity or avoid ambiguity, the prosecution history and the prior art may also be consulted in order to ascertain whether the patentee's invention is novel or was previously known to the art. The Federal Circuit found no clear error in the district court's methodology in finding no anticipation.
34. With regard to obviousness, Northlake complained that remand was required because the district court did not make explicit findings on each of the well-known *Graham* factors. Glaverbel pointed out that Northlake had presented no evidence of the level of ordinary skill in the art or concerning the alleged similarities between the prior art and the patents in suit. Glaverbel also contends that Northlake had failed to argue any special considerations or details with respect to these factual aspects. Agreeing with Glaverbel, the Federal Circuit noted that the burden of pointing out any facts requiring particular attention was on Northlake not the trial judge. Although appropriate circumstances might warrant remand for additional findings, Northlake had not directed the Federal Circuit's attention to any clear error in the nature or completeness of the district court's findings of fact relevant to the issue of obviousness. The burden of proving invalidity was on Northlake.
35. On inoperability, Northlake's argument was "tardy" and the Federal Circuit found that the district court did not deny justice by refusing to allow Northlake to introduce the issue.

36. With regard to inequitable conduct, the Federal Circuit dealt with Northlake's claim quickly. Northlake failed to show that Glaverbel had presented material and intentional misinformation to the patent examiner. Northlake also failed to show that the district court's ruling that Northlake had not established inequitable conduct was based on clearly erroneous findings of fact or misapplication or misinterpretation of law, or manifested clear error of judgment.
37. The Federal Circuit viewed Northlake's antitrust and misuse claims similarly. Northlake stated that Glaverbel was suing it in other countries for violation of Glaverbel's foreign patents on the same technology, and that the cost of these foreign suits was "crippling." According to the Federal Circuit, "[p]arties who engage in international business may indeed encounter litigation in foreign courts; such actions, and their cost and consequences, do not of themselves constitute violation of the Sherman Act." It was Northlake's burden to show that Glaverbel's purpose was to harass Northlake in bad faith regardless the outcome. Northlake, however, did not direct the Federal Circuit to any evidence to this effect.
38. With regard to infringement, although Northlake requested partial summary judgment as to specific formulations, the court granted judgment encompassing all its formulations, whether or not the motion included them. The Federal Circuit held this to be incorrect — district courts cannot grant summary judgment on a ground to which the nonmoving party is given "either an inadequate opportunity or no opportunity to respond." The Federal Circuit remanded the cause for further proceedings in this regard.

AKRO CORP. V. LUKER, 1995 U.S. APP. LEXIS 1190, 33 U.S.P.Q.2D (BNA) 1505 (FED. CIR.(OHIO) JAN. 20, 1995).

39. Akro Corp. ("Akro") was an Ohio corporation with manufacturing facilities in Ohio. Luker, the defendant patentee, was an individual who resided in and conducted business from Orange County, California. Luker had never been in Ohio, and no one in Ohio had ever been his agent or personal representative.
40. In 1990, Luker sent Akro a warning letter claiming that Akro was infringing its patent. Akro referred this letter to its patent counsel, located in North Carolina. For three years, Akro and Luker, through their respective counsel, attempted to negotiate a settlement to their dispute. While the negotiations proceeded, Luker's counsel reiterated the accusations of infringement and the threats of litigation in six separate warning letters to Akro's counsel.

41. The warning letters made it clear that Luker had entered into an exclusive license agreement with Pretty Products, an Ohio corporation that manufactured floor mat carpets and was one of Akro's competitors in Ohio. Although the text of the license agreement was not of record in this case, Luker's letters to Akro were.
42. Eventually Akro filed a declaratory judgment action against Luker in the U.S. District Court for the Northern District of Ohio. Luker did not answer the allegations in Akro's complaint. Instead, he filed a Fed. R. Civ. P. 12(b)(2) motion to dismiss Akro's suit for lack of personal jurisdiction. He also filed a supporting affidavit. Though it contained neither denials nor rebuttals to Akro's complaint, the affidavit stated that Luker had never been in Ohio and that Pretty Products was not his agent in Ohio or anywhere else. The trial court then entered judgment pursuant to Fed. R. Civ. P. 12(b)(2), dismissing Akro's action for want of personal jurisdiction. Akro appealed.
43. The Federal Circuit noted that "no shortage of cases" existed construing the "transacting any business" portion of the Ohio long-arm statute to extend to the greatest reach consistent with due process. As a result, the Federal Circuit's sole inquiry became whether the trial court could exercise personal jurisdiction over Luker consistent with due process.
44. First, the Federal Circuit noted that Luker initiated each of his contacts with Ohio, directing them toward residents of Ohio — either Pretty or Akro — over a span of three years. Moreover, the exclusivity of Luker's license agreement with Pretty Products created continuing obligations between Pretty and Luker and "eliminated any possibility of his entering into any type of licensing arrangement" with Akro. These facts satisfied the "purposely directed activities" requirement for personal jurisdiction.
45. Next, since Luker had voluntarily entered into a number of business transactions, including the acquisition of the patent and attempts at enforcement, which he knew would have consequences in the state, the Federal Circuit believed that the contacts were sufficiently connected with the cause of action to satisfy due process.
46. Finally, Luker, despite bearing the burden on this issue, failed to point to any considerations rendering jurisdiction unreasonable that could not be addressed by filing for a change of venue under 28 U.S.C. § 1404(a) (1988). The Federal Circuit noted that Luker incorrectly asserted that the burden was on Akro to show that jurisdiction was reasonable in this case. The Federal Circuit concluded that

Luker did show that personal jurisdiction would be unreasonable and therefore unconstitutional.

IN RE LOCKWOOD, 1995 U.S. APP. LEXIS 599, 33 U.S.P.Q.2D (BNA) 1406 (FED.CIR.(CAL.) JAN. 11, 1995).

47. Lockwood filed a patent infringement claim against American Airlines, seeking both damages and injunctive relief, together with a timely jury demand. American Airlines counterclaimed for a declaration that Lockwood's patents were invalid. The district court, concluding that the declaratory judgment action was equitable in nature, struck Lockwood's jury demand. Lockwood petitioned the Federal Circuit for a writ of mandamus directing the district court to reinstate his jury demand.
48. The Federal Circuit reinstated Lockwood's jury demand, stating that "if a particular action entails either the adjudication of legal rights ... or, alternatively, the implementation of legal remedies, ... the district court must honor a jury demand." The Federal Circuit could not, consistently with the Seventh Amendment, deny Lockwood the jury demand merely because the validity of his patents came before the court in a declaratory judgment action for invalidity rather than as a defense to an infringement suit.

THERMA-TRU CORP. V. PEACHTREE DOORS INC., 44 F.3D 988 (FED.CIR.(MICH.) 1995).

49. Therma-Tru Corp. charged Peachtree Doors Inc. ("Peachtree") with willful patent infringement. Peachtree raised the defenses of patent invalidity on various grounds and unenforceability due to inequitable conduct in the PTO. The parties tried the case to a jury, with the exception that the judge decided the issue of inequitable conduct on evidence the parties presented at trial. The jury found willful infringement and no invalidity. Concurrently, the trial judge held the patent unenforceable due to inequitable conduct.
50. The Federal Circuit affirmed the judgment with respect to validity and infringement, but reversed the holding of unenforceability. Simultaneous determinations by the jury and the judge did not authorize judicial findings independent of and contrary to the facts found by the jury in reaching its verdict. Intent as an essential predicate to patent unenforceability does not mean that the inventor intended to do what he or she did in patent prosecution. Rather, intent means that the inventor intended to deceive or mislead the examiner into granting the patent. Failure to meet a

requirement of patentability, such as enablement, does not of itself establish the intent element of inequitable conduct. Given no evidence of intent to mislead or deceive, the Federal Circuit concluded that the district court's finding on the issue of intent was clearly erroneous.

ENDNOTES

¹ 138 U.S. 252 (1891).