

Tech. Licensing Corp. v. Videotek, Inc.

Nos. 07-1441, -1463, Fed. Cir. (Newman, Plager,* Schall)

[O]nce a challenger (the alleged infringer) has introduced sufficient evidence to put at issue whether there is prior art alleged to anticipate the claims being asserted, prior art that is dated earlier than the apparent effective date of the asserted patent claim, the patentee has the burden of going forward with evidence and argument to the contrary.

On October 10, 2008, the Federal Circuit, inter alia, affirmed the district court's judgment that defendants Gennum and Videotek infringed U.S. Patents No. 5,486,869 and No. 5,754,250, which related to the separation of synchronization signals from video signals. The Federal Circuit stated:

Since TLC has conceded that the Elantec chips [meet] all the limitations of the asserted claims of the '250 patent (independent claim 33 and dependent claims 34-37 and 39), the issue is whether the Elantec chips were in fact prior art. The '250 patent issued from a CIP application filed in 1995. If claim 33 is only entitled to the benefit of the 1995 date, as Gennum maintains, the Elantec data sheets were indeed prior art that anticipates claim 33.

TLC's counterargument is that claim 33 is entitled, under 35 U.S.C. § 120, to the benefit of the 1992 filing date of its ancestor, the original '323 application. That statute provides that a patent application for an "invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States . . . shall have the same effect, as to such invention, as though filed on the date of the prior application" In essence, this means that in a chain of continuing applications, a claim in a later application receives the benefit of the filing date of an earlier application so long as the disclosure in the earlier application meets the requirements of 35 U.S.C. § 112, ¶1, including the written description requirement, with respect to that claim. If the effective filing date of claim 33 under § 120 is 1992, then the Elantec data sheets, dated in 1993, are not prior art to the claim.

The dispute as to whether claim 33 is entitled to the benefit of the '323 application's filing date involves the "other circuit" limitation in step (a) of claim 33. Gennum maintains that the only written description support for that limitation in the '250 patent is new matter that was added in 1995, specifically resistors 1604 and 1605 in Figure 16, along with accompanying text. TLC's position is that resistors R21 and R26 in Figure 3 of the '250 patent, which were originally disclosed in Figure 3 of the '323 application, also correspond to and thus support the "other circuit" limitation in claim 33. The ultimate question, then, is whether the disclosure of the '323 application satisfies the written description requirement with respect to claim 33, and particularly with respect to the "other circuit" limitation in step (a). The trial court answered this question in the negative, and therefore found that claim 33 was not entitled to the 1992 effective filing date of the '323 application. Accordingly, the trial court found that the Elantec data

sheets were indeed prior art, and concluded that claim 33 is invalid for anticipation. . . .

In the case before us, plaintiff/patentee TLC, alleging infringement by Genum, has the burden of persuasion that Genum infringes, under the usual civil law standard of preponderance of the evidence. In response to the argument by TLC that Genum infringes claim 33 of the '250 patent, Genum raises the affirmative defense that claim 33 is invalid because it is anticipated by the prior art. When an alleged infringer attacks the validity of an issued patent, our well-established law places the burden of persuasion on the attacker to prove invalidity by clear and convincing evidence. Neither TLC's burden to prove infringement nor Genum's burden to prove invalidity, both ultimate burdens of persuasion, ever shifts to the other party—the risk of decisional uncertainty stays on the proponent of the proposition. . . . Here, TLC, the plaintiff in the suit, has the initial burden of going forward with evidence to support its allegation that Genum infringes claim 33. Genum, having the ultimate burden of proving its defense of invalidity based on anticipating prior art, then has the burden of going forward with evidence that there is such anticipating prior art, which in Genum's view means art that is prior to the 1995 application date of the '250 patent.

At that point TLC has the burden of going forward with evidence either that the prior art does not actually anticipate, or, as was attempted in this case, that it is not prior art because the asserted claim is entitled to the benefit of a filing date prior to the alleged prior art. This requires TLC to show not only the existence of the earlier application, but why the written description in the earlier application supports the claim. In the context of the allegedly anticipating Elantec prior art, that means producing sufficient evidence and argument to show that an ancestor to the '250 patent, with a filing date prior to the Elantec date, contains a written description that supports all the limitations of claim 33, the claim being asserted. Assuming then that TLC's evidence and argument in support of the earlier filing date is now before the court, the burden of going forward again shifts to the proponent of the invalidity defense, Genum, to convince the court that TLC is not entitled to the benefit of the earlier filing date. "Convince" is the operative word, because if the court is not persuaded by clear and convincing evidence that Genum is correct, Genum has failed to carry its ultimate burden of persuasion, and its defense of invalidity, based on anticipation by the Elantec art, fails.

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