FEDERAL CIRCUIT PATENT LAW CASE UPDATE

Cytologix Corp. v. Ventana Med. Sys., Inc., 04-1446 (Fed. Cir. Sept. 21, 2005) (Dyk, J.)

Disagreeing with aspects of the district court's claim construction on both substantive and procedural grounds, the court upheld an injunction based on jury infringement findings for some claims in two Cytologix patents for equipment that automatically stains tissue sample slides, but reversed infringement for other claims, and also remanded for a new trial the issue of obviousness for some claims. The procedural error, which did not create grounds for reversal because it went without objection, was allowing the parties' experts to testify before the jury about claim meanings.

Cytologix owns U.S. Pat. Nos. 6,180,061 and 6,183,693, claiming an "automated slide stainer used to stain tissue samples mounted on microscope slides." Ventana competes with Cytologix for automated staining equipment.

> [I]n this case the parties agreed, contrary to the district court's wishes, not to have a Markman hearing, and that the claims were not construed until the close of evidence. This was not erroneous since we have held that the district court has considerable latitude in determining when to resolve issues of claim construction. . . . However, by agreement the parties also presented expert witnesses who testified before the jury regarding claim construction, and counsel argued conflicting claim constructions to the jury. This was improper, and the district court should have refused to allow such testimony despite the agreement of the parties. The risk of confusing the jury is high when experts opine on claim construction before the jury even when, as here, the district court makes it clear to the jury that the district court's claim constructions control.
>
> Although in this case there is no ground for reversal since there was no objection to the expert testimony as to claim construction, it appears that the conflicting expert views as to claim construction created confusion and may have led to a verdict of infringement with respect to the asserted claims of the '061 patent that was not supported by substantial evidence under the district court's claim construction.

Regardless, the court upheld the infringement judgment because under the proper claim construction, the evidence supported infringement of the '061 patent. The district court's unexplained construction of the term "heating station" to disallow stations holding a single slide contradicted the claim language: "adapted to support at least one microscope slide." Claim differentiation supported the broad reading, and the prosecution history did not disclaim claim scope.

For another claim phrase in the '061 patent, the court misconstrued "separate electrical power connections being provided to said first and second heating elements" by limiting it such that it excluded a preferred embodiment.

The invalidity issues for the '061 patent turned in part on waiver.

> Here we conclude that issues of written description and anticipation do not warrant a new trial, but that a new trial may be appropriate on obviousness. . . . The testimony concerning obviousness was far more detailed than the testimony concerning written description, considering at length the prior art and the issue of motivation to combine. That evidence may have constituted substantial evidence that would support a jury verdict of obviousness under the correct claim construction.

With respect to the '693 patent, the court addressed only infringement issues.

> Ventana also challenges the jury verdict of infringement of claims 1-3 and 4-9 of the '693 patent. Ventana argues that the claims require that the "temperature controller" must communicate with the off-carousel computer.

The court determined that under its reading of the claim construction that sufficient evidence supported the jury verdict. A similar analysis applied for other claims, except for claim 13.

> Here, CytoLogix failed to identify the structure in the specification that is the "temperature controller means" and compare it to the structure of the accused device. Accordingly, because CytoLogix failed to present substantial evidence of infringement of claim 13 of the '693 patent, the jury verdict of infringement of claim 13 must be reversed.

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