

Texas Intellectual Property Law Journal
Spring, 1998

Recent Development

RECENT DEVELOPMENTS IN PATENT LAW

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I. Introduction

This article covers patent related cases and developments which occurred during the period from December 1997 to February 1998. Significant district court, Federal Circuit, and state decisions were considered, including cases reported in Volumes 44 and 45 of The United States Patents Quarterly. While not every decision reported during this time period is reviewed, the four most significant developments are discussed and analyzed.

II. *Jones v. Cooper Industries, Inc.*¹

Contracts assigning or licensing patents are construed according to the usual and established principles of contract law in the forum state, and the fact that the object of the contract is a patent should, in theory, present no special considerations.² Nevertheless, a case which was recently denied certiorari (and has received at least some attention) calls into question many arrangements where patents are assigned, and merits consideration by practitioners.

^{*356} In *Jones*, Jones assigned his interest in a series of patents to Koomey in exchange for a royalty with a minimum payment provision.³ Referred to as the Patent Rights Agreement (PRA), the assignment contract purported to bind Koomey's

“subsidiaries, successors, assigns or licensees.”⁴ Koomey subsequently pledged the patents as collateral for a loan, and when the loan was foreclosed for nonpayment, the patents at issue were assigned to a series of intermediaries.⁵ Cooper Industries, Inc. (Cooper), the defendant, finally took the patents without expressly assuming--but with knowledge of--the terms of the PRA.⁶

Jones brought suit against Koomey and several of the intermediaries for unpaid royalties in breach of the PRA.⁷ The settlement of that litigation released Koomey and the intermediaries from any liability under the PRA but expressly excluded Cooper from the release.⁸ Jones subsequently brought suit against Cooper for unpaid royalties under the PRA and both Jones and Cooper moved for summary judgment.⁹ Jones argued that the obligation to pay royalties ran with and was a condition of title to the patents, like certain interests affecting real estate.¹⁰ In its turn, Cooper simply argued that there was no enforceable agreement between Cooper and Jones.¹¹ The trial court denied Jones’ motion and granted Cooper’s motion.¹²

Citing *Waterman v. Mackenzie*,¹³ the appellate court held that the Jones royalty “interest” could not be a condition to title.¹⁴ In the court’s view, *Waterman* allows for assignment of *only* the whole patent, an undivided share of the patent rights, or the exclusive right to practice the patent in a portion of the United States.¹⁵ *357 Therefore, the court reasoned, an assignment with an obligation to pay royalties as a condition to title is not a possibility recognized in patent law.¹⁶

Finding that the PRA was an assignment, rather than a license, the court held that the obligation to pay royalties could not be a condition of title to the patent rights.¹⁷ The court also held that the reversionary interest did not preclude passage of complete title to the assignee.¹⁸ Finally, the court found that Cooper did not expressly or impliedly assume the obligation to pay royalties when it took the patents in spite of the “successors and assigns” language of the PRA, and held that Cooper was not bound to pay royalties.¹⁹ The court’s opinion seems to indicate that Cooper is the owner of the patents.

The court’s opinion, and particularly its reading of *Waterman*, has deep implications for assignors and should lead many to reconsider assignment practices. The PRA employed terms that are fairly common in patent assignments. Typically, the assignor/patentee is willing to accept payment in the form of royalties only on the condition that royalty payments are guaranteed and the obligation to pay royalties is not separated from title to the patent.²⁰ This is often accomplished through a reversionary interest clause and “successors and assigns” terms like the ones at issue in the Jones PRA.²¹ In the past, some have thought a reversionary interest clause sufficient to protect the assignor/patentee’s interests and have taken no additional steps.

The *Jones* view of *Waterman* nullifies this type of reversionary interest clause,²² leaving many assignors/patentees powerless to ensure that royalties are paid or that the patent is returned. In adopting the court’s view of *Waterman*, the typical assignor/patentee would have no effective recourse should the assignee transfer the patent to some third party (e.g., a holding company) and then declare *358 bankruptcy.²³ In light of the common practice of transferring patents to patent holding companies and the use of patents as collateral subject to foreclosure, the court’s reading of *Waterman* should give assignors pause. Assignors who have not taken additional steps to protect their interests would be well advised to reconsider their positions in light of *Jones*.

The *Jones* decision suggests that the patentee’s interest in ensuring payment of royalties or possession of the patent could be protected by licensing the patent rather than assigning it.²⁴ Unfortunately, it is difficult to see how such a scheme could be effective in light of the court’s reading of *Waterman*. Presumably, the licensee in such a situation would seek rights commensurate with substantially all the attributes of title. While such a transaction might be labeled a license, the *Waterman* case itself alludes to the settled rule of contract interpretation that the nature of the transaction is determined by looking to the legal effect of its provisions and not the label applied.²⁵ Therefore, the effect of a license transferring substantially all the attributes of title, but attempting to retain title to ensure payment of royalties, is uncertain at best.²⁶

Should the *Jones* view of *Waterman* become widely adopted, assignors could be left with limited methods of ensuring that royalties are paid and that title to the patent and the obligation to pay royalties are not separated. Virtually any condition or provision related to title would run afoul of this strict standard. Indeed, it is difficult to imagine how the patentee’s interest could be protected, although recording a security interest in the patent itself might provide some relief.²⁷

Assignors of patents should take at least some comfort from the fact that the *Jones* view of *Waterman* appears to be based on a misapprehension of monopoly *359 rights and ownership interests in patents.²⁸ While the *Waterman* decision held that *monopoly rights* can be assigned only in the specified forms,²⁹ there exists a distinction between subdivision of, or conditions affecting monopoly rights, and those pertaining to ownership.³⁰ in *Waterman* itself, the Supreme Court held that 35 U.S.C. §

261 (then Revised Statute § 4898) prevented assignment of a subdivision of the monopoly rights while also indicating that breach of a condition subsequent may void an assignment of those rights (*i.e.*, revert ownership to the assignor).³¹

In the *Jones* case, the reversionary interest clause should have been enforceable because there was no improper subdivision or condition to the practice of the monopoly rights.³² The reversionary interest clause only placed a condition on retention of ownership of the monopoly rights, which is not prohibited by the *Waterman* decision.³³ While clearly flawed, the *Jones* decision serves as an important reminder that the interaction of patent law and judicial interpretation of state contract law can surprise even the most careful practitioner.

III. Ethicon, Inc. v. United States Surgical Corp.³⁴

In *Ethicon*, the Federal Circuit reaffirmed the long standing rule that a joint inventor/owner of a patent has the power to unilaterally license the patent without accounting to the other inventor/owner.³⁵ However, the court clarified the relationship between joint inventorship claims and sole inventorship claims contained in the same patent in light of the 1984 amendments to 35 U.S.C. § 116.³⁶ The decision illustrates the need for firm agreements whenever there is even the prospect of a joint invention and the important effects of a joint inventorship finding.

***360** The invention at issue in the *Ethicon* case related to an endoscopic surgical device, a trocar.³⁷ Over a period of several years, the primary inventor, Dr. Yoon, began to develop a safety feature to prevent injury when using a trocar.³⁸ During this time, Dr. Yoon became acquainted with an electronics technician, Mr. Choi. Dr. Yoon asked Mr. Choi to assist him with the trocar invention, and Mr. Choi did so for approximately eighteen months without being paid.³⁹ Eventually, the Yoon/Choi collaboration ended and Mr. Choi moved on to other projects.⁴⁰

Dr. Yoon, however, filed an application for a patent on the trocar device and, without informing Mr. Choi, named himself as the sole inventor.⁴¹ A patent was issued in 1985 with some fifty-five claims from the Yoon application, and Dr. Yoon subsequently granted Ethicon, the plaintiff, the exclusive license to practice the patent.⁴² Ethicon later brought suit against U.S. Surgical Corp. (U.S. Surgical), alleging infringement of two claims of the Yoon patent (claims 34 and 50).⁴³

During the litigation, U.S. Surgical learned of Mr. Choi's contribution.⁴⁴ U.S. Surgical then entered into a contract with Mr. Choi in which Mr. Choi "retroactively" licensed U.S. Surgical to practice his "trocar related inventions" in return for a significant payment.⁴⁵ As part of the license, Mr. Choi also agreed to assist U.S. Surgical in the *Ethicon* litigation.⁴⁶

U.S. Surgical then moved to correct the inventorship of the Yoon patent by adding Mr. Choi and the lower court found that Mr. Choi contributed to the subject matter of two of the claims (claims 33 and 47).⁴⁷ With joint inventorship established, U.S. Surgical then moved for dismissal on the grounds that it possessed a valid license to practice the patent from a joint inventor.⁴⁸ The court granted U.S. ***361** Surgical's motion and Ethicon appealed in part on the grounds that any joint inventorship by Mr. Choi was limited to claims 33 and 47 and that U.S. Surgical's license from Choi was also limited to those claims.⁴⁹

After affirming the lower court's finding that Mr. Choi contributed to the conception of claims 33 and 47, the Federal Circuit turned its attention to the broad effects of Mr. Choi's limited contribution.⁵⁰ Because 35 U.S.C. § 116 provides that a "joint inventor" need not make a contribution to the subject matter of every claim,⁵¹ a finding of joint invention as to one claim creates joint invention status as to all the claims of the patent.⁵² In support of this rule, the court noted that other provisions of the Patent Act refer to "joint owners of a patent," not "joint owners of a claim."⁵³ Thus, as a "joint inventor" of claims 33 and 47, Mr. Choi was a joint owner of all the claims of the patent and had the unilateral power to license all the claims without accounting to Ethicon or Yoon.⁵⁴

The court also discussed the effect of Mr. Choi's "retroactive" license and held that a license cannot be "retroactive" because to do so would allow a co-owner to release a claim for damages accrued to the other co-owner.⁵⁵ Thus, the court held that the Choi "retroactive" license did not release U.S. Surgical from Ethicon's claim for pre-license infringement.⁵⁶ However, the same result of a release of U.S. Surgical was achieved when the court held that Mr. Choi was a necessary party to Ethicon's claim for pre-license infringement and that Mr. Choi could not be involuntarily joined to the infringement action.⁵⁷ Because Mr. Choi refused to join Ethicon as a plaintiff against U.S. Surgical, the court held that Ethicon could not maintain an action for pre-license infringement against U.S. Surgical and that dismissal was proper.⁵⁸

***362** While the interaction between joint inventorship and joint ownership continues to present difficult questions in the litigation context,⁵⁹ a firm lesson from the *Ethicon* decision is the importance of memorializing in contract the terms of a joint

inventorship whenever the possibility of joint inventorship exists. As a practical matter, once conception of the invention is complete, it may prove impossible to secure an agreement that allows for effective licensing and management of the patent rights.⁶⁰ *Ethicon* aptly illustrates the devastating impact that the failure to secure agreement from a joint inventor can have.

The impact of the *Ethicon* decision should be limited because joint invention most often occurs in the employee-inventor context. Typically, employee-inventors have executed employment agreements with clauses assigning all their interest in inventions to the employer. Thus, unexpected joint inventorship in this context is less problematic because all of the parties are already contractually bound. However, participants in less formal collaborations should take note of *Ethicon*'s warning.

IV. *Gentry Gallery, Inc. v. Berkline Corp.*⁶¹

In *Gentry*, the perils of listing the objects of an invention were made clear when the Federal Circuit used a stated object of the invention to determine that the claims were invalid for failing to comply with the written description requirement.⁶² Cases discussing claim construction and the requirements of 35 U.S.C. § 112⁶³ are frequently so fact-specific that they are of little assistance to those drafting applications. Nevertheless, the *Gentry* decision illustrates the importance of careful *363 consideration of each aspect of the specification of a patent application, including the practice of listing the so-called “objects of the invention.”

The patent at issue in *Gentry* (the ‘244 patent) related to a sectional sofa with side-by-side recliners.⁶⁴ The prior art disclosed sectional sofas incorporating two recliners.⁶⁵ However, “because recliners usually have adjustment controls on their arms,”⁶⁶ prior art sectional sofas often placed the recliners at either end of the sofa and facing in different directions.⁶⁷ These arrangements were identified in the specification as “not comfortable or conducive to intimate conversation” and “not usually comfortable when the occupants are watching television.”⁶⁸

To remedy this defect, the ‘244 patent proposed placing the recliners side by side, facing in the same direction with a “console” between them.⁶⁹ Controls to adjust both recliners were to be located on this “fixed console.”⁷⁰ An object of the invention was described as providing “a console positioned between [the reclining seats] that accommodates the controls for both of the reclining seats.”⁷¹

Gentry Gallery subsequently brought suit against Berkline Corp. (Berkline) alleging that Berkline’s sectional sofa with double recliners infringed the ‘244 patent.⁷² The Berkline sofa consisted of double recliners, facing in the same direction, separated by a seat with a fold-down back.⁷³ The fold-down back on the seat separating the recliners incorporated a tray.⁷⁴ Thus, the fold-down back could also serve as a small table between both recliners.⁷⁵ While the court found that the Berkline fold-down back was “fixed,” the court affirmed the finding of noninfringement because the fold-down back was not a “console” as that term was used in the patent.⁷⁶

***364** Berkline also argued that the claims directed to sofas with adjustment controls not located on the “console” were invalid because they did not comply with the written description requirement of 35 U.S.C. § 112, ¶ 1.⁷⁷ The Federal Circuit’s conclusion that the claims did not meet the written description requirement merits discussion because the court utilized the stated “objects” of the invention to narrow the scope of the invention to substantially the embodiment described in the specification.⁷⁸

In order to comply with the 35 U.S.C. § 112, ¶ 1 requirement of a written description,⁷⁹ the patent specification must convey to those skilled in the art that the applicant invented the subject matter later claimed.⁸⁰ All the claimed limitations of the invention must be described in order to comply with the written description requirement.⁸¹ Applying this standard to the claims of the ‘244 patent, the court found that claims directed to sofas having recliner controls other than on the console were invalid.⁸² The court looked to the specification for any description of recliner controls on some place other than the console and found none.⁸³

However, the court also considered the statement that an object of the invention was to provide a console that accommodates the controls for both the recliners.⁸⁴ In the court’s view, this statement indicated that housing the controls was the very purpose of the console.⁸⁵ Thus, recliner controls located on any place other than the console did not accord with the object or purpose of the invention.⁸⁶ The court read the stated object of the invention as further evidence that the written description requirement was not satisfied as to claims directed to sofas incorporating controls not located on the console.⁸⁷

The court's consideration of the "purpose" of the invention and its limiting effect in this case should cause practitioners to further avoid the already suspect *365 practice of listing "objects of the invention" in the specification.⁸⁸ While there is no statutory or regulatory requirement that the specification include "objects of the invention,"⁸⁹ a listing of the "objects of the invention" has been common practice in the past. In recent years, however, that practice has been largely discontinued because of concerns that defendants would seize upon this language either as a written description defense or for claim construction purposes.

The *Gentry* decision should further hasten the end of "objects of the invention" language in specifications. It is not clear that *Gentry*'s claims covering embodiments with controls located someplace other than the console would have otherwise survived a written description analysis. However, it is clear that the presence of the "object of the invention" language lent weight to the court's conclusion.⁹⁰ Absent the "object of the invention" language, *Gentry* might have been better positioned to argue that the written description requirement was satisfied.

V. *In re Zurko*⁹¹

On December 2, 1997, the Federal Circuit, sitting en banc, heard oral arguments from the parties in *In re Zurko*.⁹² The issue before the court is the standard of review to apply to Patent and Trademark Office (PTO) fact findings.⁹³ The long-standing practice of the Federal Circuit and its predecessor court has been to apply the same standard of review used for district court fact findings--namely, the clearly erroneous standard.⁹⁴

The invention at issue in *Zurko* relates to a method of improving security in a computer system.⁹⁵ *Zurko* appealed a Board of Patent Appeals and Interferences decision sustaining a PTO rejection of their patent application for obviousness, and *366 the Federal Circuit reversed.⁹⁶ In reversing the PTO's finding of obviousness, the Federal Circuit applied the clearly erroneous standard of review to the underlying facts, or namely, PTO fact findings would be upheld if not clearly erroneous.⁹⁷ The Federal Circuit determined that the fact findings supporting the PTO conclusion of obviousness were clearly erroneous.⁹⁸

However, the PTO petitioned for rehearing on the grounds that the clearly erroneous standard of review violates the Administrative Procedure Act (APA).⁹⁹ Specifically, the PTO maintains that 5 U.S.C. § 706(2)(E) requires the Federal Circuit to defer to PTO fact findings if supported by substantial evidence.¹⁰⁰ At oral argument, the PTO argued that the "substantial evidence" standard would primarily affect the reasoning of decisions issued by the Federal Circuit as opposed to the ultimate outcome.¹⁰¹

Counsel for *Zurko* argued that, while the APA applied to the PTO, the clearly erroneous standard was an "additional requirement ... otherwise recognized by law" within the meaning of 5 U.S.C. § 559.¹⁰² Therefore, *Zurko* argued, enactment of the APA did not repeal the clearly erroneous standard.¹⁰³ *Zurko* also maintained that 5 U.S.C. § 706(2)(E) simply did not apply to PTO findings because the PTO does not conduct a "hearing" before making its findings.¹⁰⁴

The *Zurko* case could have an important effect on patent prosecution by making challenges to PTO findings even more difficult. It is worth noting that both the American Intellectual Property Association (AIPLA) and the International Trademark Association (INTA) oppose any change in the standard of review.¹⁰⁵

VI. Conclusion

Of the cases here reviewed, the decision by the Federal Circuit in the *Zurko* case could have the most profound effect. A move from the clearly erroneous *367 standard to one of substantial evidence would substantially alter the relationship between the applicants, the PTO, and the Federal Circuit.

The *Jones* decision could have an important effect on assignment/licensing transactions in Texas. At present, it appears that many assignors could be powerless to protect their interests in the face of *Jones*' nullification of reversionary interest clauses, at least in the Houston area.¹⁰⁶ In light of the fact that the opinion concerns a difficult area of patent and contract law, this case should continue to attract attention.

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¹ 938 S.W.2d 118 (Tex. App-Houston [14th Dist.] 1996, writ denied, reh'g of writ of error overruled), *cert. denied*, 118 S. Ct. 1044 (1998).

² *Id.* at 124.

³ *Id.* at 120.

⁴ *Id.*

⁵ *Id.* at 121.

⁶ *Id.* at 123.

⁷ *Id.* at 121.

⁸ *Id.*

⁹ *Id.*

¹⁰ *Id.* at 121-22.

¹¹ *Id.* at 122.

¹² *Id.*

¹³ *Waterman v. Mackenzie*, 138 U.S. 252 (1891).

¹⁴ *Jones*, 938 S.W.2d at 122-23.

¹⁵ *Id.* at 122.

¹⁶ *Id.*

¹⁷ *Id.* at 123.

¹⁸ *Id.* at 123 n.2.

¹⁹ *Id.* at 125-26. The ineffectiveness of “successors and assigns” terms in obligating third parties is well known. “Successors and assigns” terms are particularly problematic in the patent licensing context because a presumption exists that a patent license is not

assignable in the absence of express provisions to the contrary. *See, e.g.*, PPG Indus., Inc. v. Guardian Indus. Corp., 597 F.2d 1090, 1094-95, 202 U.S.P.Q. (BNA) 95, 98 (6th Cir. 1979). Therefore, a license truly intended to be assignable should explicitly set forth this intention rather than rely on a “successors and assigns” term.

²⁰ *See, e.g.*, 2 ROGER M. MILGRIM, MILGRIM ON LICENSING § 15.03, at 15-18 to 15-20 (1997).

²¹ *See, e.g.*, *id.* at 15-21 (showing model assignment provision with reversionary interest clause).

²² *See Jones*, 938 S.W.2d at 125-26.

²³ *Id.* The patentee in such a situation would have a definite interest in ensuring that the obligation to pay royalties and title to the patent are not separated. However, the liberal provisions of the Bankruptcy Code would enable the trustee to avoid virtually any contract to prevent separation of title and the obligation to pay royalties. *See* 11 U.S.C. § 365(c), (f) (1994).

²⁴ *Jones*, 938 S.W.2d at 123.

²⁵ *Waterman v. Mackenzie*, 138 U.S. 252, 256 (1892). *See also* *Vaupel Textilmaschinen v. Meccanica Euro Italia*, 944 F.2d 870, 873-74, 20 U.S.P.Q.2d (BNA) 1045, 1047-48 (Fed. Cir. 1991).

²⁶ Indeed, it is unclear why this rationale would not apply to the facts of the *Jones* case itself. *Jones* and Koomey labeled the transaction an “assignment.” *See Jones*, 938 S.W.2d at 120, 122-23. However, the court’s determination that *Jones* sought to condition title--improperly in the court’s view--on the payment of royalties, *id.* at 122, indicates that *Jones* sought to retain at least this attribute of title rendering the transaction a license rather than an assignment. Unfortunately, the court did not address this issue.

²⁷ The court’s view of *Waterman* brings even this standard practice into question. Is a security interest a condition to title? Presumably it is because the transaction is typically structured as a reversionary interest in favor of the secured party while title resides in the debtor. Adopting the *Jones* court’s view of *Waterman*, it is difficult to see how even a secured interest in a patent is enforceable because the secured interest appears to be a condition to title. This reading of *Waterman* could have important effects for those accepting and offering patents as collateral for loans.

²⁸ *See Jones*, 938 S.W.2d at 122-23.

²⁹ *Waterman*, 138 U.S. at 255.

³⁰ *See* 2 MILGRIM, *supra* note 20, § 15.00, at 15-2.

³¹ *Waterman*, 138 U.S. at 256 (citing the predecessor of 35 U.S.C. § 261 (1994)).

An assignment of the entire patent, or of an undivided part thereof, or of the exclusive right under the patent for a limited territory, may be either absolute, or by way of mortgage and liable to be defeated by non-performance of a condition subsequent, as clearly appears in the provision of the statute

Id.

³² *See Jones*, 938 S.W.2d at 122-23.

³³ *See Waterman*, 138 U.S. at 255-56.

³⁴ 135 F.3d 1456, 45 U.S.P.Q.2d (BNA) 1545 (Fed. Cir. 1998).

³⁵ See 35 U.S.C. § 262 (1994).

³⁶ *Ethicon*, 135 F.3d at 1465-66, 45 U.S.P.Q.2d at 1552 (citing 35 U.S.C. § 116 (1994)).

³⁷ A trocar is a surgical tool which can be used to make an incision in the wall of a body cavity. *Id.* at 1459, 45 U.S.P.Q.2d at 1546-47. Once an incision is made using a trocar, endoscopic instruments may then be inserted to perform the desired surgical procedure. *Id.*, 45 U.S.P.Q.2d at 1547.

³⁸ *Id.*

³⁹ *Id.*

⁴⁰ *Id.*

⁴¹ *Id.*

⁴² *Id.*

⁴³ *Id.*

⁴⁴ *Id.*

⁴⁵ *Id.* at 1459, 1465, 45 U.S.P.Q.2d at 1547, 1552.

⁴⁶ *Id.* at 1459, 45 U.S.P.Q.2d at 1547.

⁴⁷ *Id.*

⁴⁸ *Id.*

⁴⁹ *Id.*

⁵⁰ *Id.* at 1460-65, 45 U.S.P.Q.2d at 1548-52.

⁵¹ 35 U.S.C. § 116 (1994).

⁵² See *Ethicon*, 135 F.3d at 1456-66, 45 U.S.P.Q.2d at 1552.

⁵³ *Id.* at 1466, 45 U.S.P.Q.2d at 1552.

54 *Id.*

55 *Id.* at 1467, 45 U.S.P.Q.2d at 1554.

56 *Id.*

57 *Id.* at 1468, 45 U.S.P.Q.2d at 1554.

58 *Id.*

59 In a dissent to *Ethicon*, Judge Newman concluded that a joint inventor of a claim accrues an ownership interest in that claim only, and not the whole patent. *Id.* at 1472, 45 U.S.P.Q.2d at 1557 (Newman, J., dissenting). Judge Newman noted that the 1984 amendments to 35 U.S.C. § 116 were designed to address inequities thought to result from the prior requirement that a joint inventor contribute to all the claims of the patent. *Id.* at 1469, 45 U.S.P.Q.2d at 1555 (Newman, J., dissenting). Under this rule, many patents were invalidated because an inventor was improperly listed as a joint inventor of all the claims, when in fact, the inventor contributed to only some of the claims. Judge Newman concluded that the rule followed in *Ethicon* merely substituted one inequity for another by creating a windfall for a joint inventor of only some of the claims. *Id.* at 1472, 45 U.S.P.Q.2d at 1557-58 (Newman, J., dissenting).

60 The divergence of interests that can occur between inventors is graphically illustrated by the facts of the *Ethicon* case itself. In return for executing the license in favor of U.S. Surgical and agreeing to assist in the Ethicon litigation, Mr. Choi received a lump sum payment of \$300,000 and the contingent right to receive \$100,000 for each of the next ten years. *Id.* at 1465, 45 U.S.P.Q.2d at 1552. Few joint inventors not already contractually bound could resist such an offer, and the alleged infringer would have a strong incentive to play the joint inventors off one another.

61 134 F.3d 1473, 45 U.S.P.Q.2d (BNA) 1498 (Fed. Cir. 1998).

62 *Id.* at 1478-79, 45 U.S.P.Q.2d at 1502-03.

63 35 U.S.C. § 112 (1994).

64 *Gentry*, 134 F.3d at 1474, 45 U.S.P.Q.2d at 1499.

65 *Id.*

66 *Id.* at 1474-75, 45 U.S.P.Q.2d at 1499.

67 *Id.* at 1475, 45 U.S.P.Q.2d at 1499.

68 *Id.*

69 *Id.*

70 *Id.*

71 *Id.* at 1479, 45 U.S.P.Q.2d at 1503.

72 *Id.* at 1475, 45 U.S.P.Q.2d at 1499.

73 *Id.*, 45 U.S.P.Q.2d at 1499-1500.

74 *Id.*

75 *Id.*

76 *Id.* at 1477, 45 U.S.P.Q.2d at 1500-01.

77 *Id.* at 1478, 45 U.S.P.Q.2d at 1502 (citing 35 U.S.C. § 112, ¶ 1 (1994)).

78 *Id.* at 1478-79, 45 U.S.P.Q.2d at 1502.

79 “The specification shall contain a written description of the invention” 35 U.S.C. § 112, ¶ 1.

80 *See, e.g.*, Eiselstein v. Frank, 52 F.3d 1035, 1038-39, 34 U.S.P.Q.2d (BNA) 1467, 1470 (Fed. Cir. 1995); Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 U.S.P.Q.2d (BNA) 1111, 1117 (Fed. Cir. 1991).

81 *Gentry*, 134 F.3d at 1479, 45 U.S.P.Q.2d at 1503 (citing Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 U.S.P.Q.2d (BNA) 1961, 1966 (Fed. Cir. 1997)).

82 *Id.* at 1480, 45 U.S.P.Q.2d at 1504.

83 *Id.* at 1479, 45 U.S.P.Q.2d at 1503.

84 *Id.*

85 *Id.*

86 *Id.*

87 *Id.*

88 Standard patent drafting manuals already counsel against listing the “objects” of the invention because of concern that such a list will be used to limit the claims to embodiments that satisfy all the “objects.” *See, e.g.*, ROBERT C. FABER, LANDIS ON MECHANICS OF PATENT CLAIM DRAFTING § 6, at II-5 (4th ed. 1997).

89 However, note that 37 C.F.R. § 1.73 (1997) provides that any object of the invention should be “commensurate with the invention claimed.” *Id.*

90 *Gentry*, 134 F.3d at 1479, 45 U.S.P.Q.2d at 1503.

91 111 F.3d 887, 42 U.S.P.Q.2d (BNA) 1476 (Fed. Cir. 1997) [[[hereinafter *Zurko I*], *reh’g en banc* granted, 116 F.3d 874 (Fed. Cir. 1997) [[[hereinafter *Zurko II*].

92 *En Banc Federal Circuit Hears Argument on Reviewing PTO Fact Findings*, 55 Pat. Trademark & Copyright J. (BNA) 96, 96 (Dec. 4, 1997) [[[hereinafter *Zurko III*].

93 *Zurko II*, 116 F.3d at 874.

94 *Id.*

95 *Zurko I*, 111 F.3d at 888, 42 U.S.P.Q.2d at 1477.

96 *Id.* at 887, 42 U.S.P.Q.2d at 1477.

97 See *In re Kemps*, 97 F.3d 1427, 1428, 40 U.S.P.Q.2d (BNA) 1309, 1311 (Fed. Cir. 1996).

98 *Zurko I*, 111 F.3d at 889, 42 U.S.P.Q.2d at 1478.

99 *Zurko III*, *supra* note 92, at 96.

100 *Id.* (citing 5 U.S.C. § 706(2)(E) (1994)).

101 *Id.* at 96-97.

102 *Id.* at 97-98 (citing 5 U.S.C. § 559 (1994)).

103 *Id.* at 97.

104 *Id.* at 98.

105 *Patents-Judicial Review: PTO Urges En Banc Federal Circuit to Accord Greater Deference to PTO Findings*, 66 U.S.L.W. 2323 (Dec. 2, 1997).

106 Readers unfamiliar with Texas’ writ histories will note that the *Jones* case contains a “writ denied” notation. By refusing the application for a writ of error (i.e., “review”) with the “writ denied” notation, the Texas Supreme Court indicated that it is not satisfied that the opinion of the court of appeals is correct in all respects, but believes that the application presents no error which requires reversal or which is of such importance to the jurisprudence of the State as to require reversal. *See Tex. R. App. P.* 133(a).

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