



When “Valid” Patent Claims Are Not Enforceable

by Anthony P. Filomena II of Taft, Stentinius & Hollister. Reprinted with permission.

Some valid patent method claims allowed by the U.S. Patent and Trademark Office and found novel over the prior art during litigation are not enforceable when infringed. The Federal Circuit Court of Appeals has ordered an *en banc* rehearing of two recent cases to consider this apparent discrepancy. Usually a panel of three judges from an appeals court hears and decides an appeal based on prior case precedent. However, when the appeals court considers overruling their precedent and revising their interpretation of the law, all of the judges for that circuit hear and decide the case *en banc*. Thus, a change may be coming.

En banc rehearings have been ordered in *Akamai Technologies, Inc. v. Limelight Networks, Inc.*¹ and in *McKesson Technologies Inc. v. Epic Systems Corp.*² to answer the following question:

If separate entities each perform separate steps of a method claim, under what circumstances, if any, would either entity or any third party be liable for inducing infringement, contributory infringement or direct infringement of the claim.³

Several cases have addressed this question over the past few years and the answer has been “where the actions of multiple parties combine to perform every step of a claimed method, the claim is directly infringed only if one party exercises ‘control or direction’ over the entire process such that every step is attributable to the controlling party.”⁴ It may be thought that even though there is not infringement by a single party, there could still be indirect or joint infringement by multiple parties. However, the current law is that to find indirect or joint infringement, you must first find that one of the accused actors has committed the entire act of direct infringement.⁵

In the *McKesson* decision, two Federal Circuit judges expressed concern about this reasoning. In a concurring opinion, Circuit Judge Bryson wrote:

I agree that the decision in this case is correct in light of this court’s decisions in *BMC Resources*, *Muniauction*, and *Akamai Technologies*. Whether

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Tech Tip: Google Reader 101

By Julie Koehne, Systems Librarian

How many websites do you visit each day to keep up with the news that interested you? Why not bring that information to you in one consolidated spot with Google Reader?

Have trouble keeping up with the sites you visit?

Read them in one place with Google Reader, where keeping up with your favorite websites is as easy as checking your email.

Stay up to date
Google Reader constantly checks your favorite news sites and blogs for new content.

Share with your friends
Use Google Reader's built-in public page to easily share interesting items with your friends and family.

Use it anywhere, for free
Google Reader is totally free and works in most modern browsers, without any software to install.

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Sign in with your **Google Account**

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Step 1: <http://www.google.com/reader>

Google reader

Enter a search term to find feeds or paste a feed url.

e.g., googleblog.blogspot.com or cnn

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You can now search for people sharing publicly in Reader.

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Step 3:

Click on “Add a subscription”, add the URL you want, then click Add.

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Visit your reader daily.

Upcoming CLEs

Ten Things You and Your Client Need to Know About Long Term Care Legal Issues

Tuesday, September 13

Noon-1pm

Presenters Mary Ann Jacobs and James T. O'Reilly will address legal issues that attorneys should consider when addressing elder clients' needs related to nursing homes and other long term care. Among the topics to be addressed:

- Financial considerations
- Categories of care
- Residency agreements
- Patients' rights and responsibilities
- Credentialing and certification of medical staff
- Assault and other incidents
- Litigation and liability issues
- Documentation needed

Approved for 1.0 hour of general CLE credit in Ohio and Kentucky.

Free to law library subscribers; \$50 for non-subscribers.

Lexis CLE (Two Sessions)

Wednesday, November 16

Session 1: 2:30-1:30– Lexis Search Tips

Session 2: 1:45-2:45– Litigation Research: Focus on treatises, forms, and jury instructions

Each session is approved for 1.0 hour of general credit in Ohio.

Free to law library subscribers; \$35 per session for nonsubscribers.

To register for any of these CLE events contact Mary Ann Sweeny at 513.946.5300 or via email at masweeney@cms.hamilton-co.org

Cincinnati Hosts Ohio Regional Association of Law Libraries

From October 19-21, 2011, Cincinnati will serve as the host city for the annual meeting of the Ohio Regional Association of Law Libraries. ORALL is a chapter of the American Association of Law Libraries that includes libraries in Ohio, Indiana and Kentucky. It was formed in 1949 to further the development and usefulness of law libraries and to stimulate a spirit of mutual helpfulness among law libraries of this region. The Hyatt Regency is the conference hotel and the opening reception will be held at the National Underground Railroad Freedom Center. Hamilton County Law Library will welcome visitors for a tour on October 19. Library staff members will have the opportunity to attend programs. If your law firm would like to make a sponsorship donation to defray librarians' cost of attending or if you would like to contribute promotional materials for attendees' conference bags, please contact mjenkins@cms.hamilton-co.org.

Technical Services Librarian Search

As of this writing, we are interviewing candidates for the Technical Services Librarian position and checking references. We look forward to welcoming our new hire before long. Thanks to our patrons for patience as we have been short-handed.

those decisions are correct is another question, one that is close enough and important enough that it may warrant review by the en banc court in an appropriate case.

In a dissenting opinion, Circuit Judge Newman wrote:

A patent that cannot be enforced on any theory of infringement, is not a statutory patent right. It is a cynical, and expensive, delusion to encourage innovators to develop new interactive procedures, only to find that the courts will not recognize the patent because the participants are independent entities. From the error, confusion, and unfairness of this ruling, I respectfully dissent.⁷

In another recent decision, *SiRF Technology, Inc. v. International Trade Commission*,⁸ a panel of Federal Circuit judges interpreted patent method claims to only require actions by one party, even though the appellant argued several parties were involved. With this single-party interpretation, the method claims were enforceable and the appellant was found to infringe.

Brief summaries of the *Akamai*, *McKesson* and *SiRF* cases are provided below, followed by the current conclusion. We look forward to the *en banc* rehearings by the Federal Circuit on joint infringement to find out whether a new conclusion is warranted.

Akamai Technologies, Inc. v. Limelight Networks, Inc.

Akamai, a licensee of Massachusetts Institute of Technology, accused Limelight of infringing method claims in three of their patents. Akamai and Limelight are competitors that both provide content delivery networks and services to deliver web page content for their customers. The Akamai patents claim methods to speed the delivery of web page content over the Internet using “tagging.” The method claims of the Akamai patents include a step of “tagging” the content.

Limelight, aware of the Akamai patents, has clauses in their customer contracts that in-

form Limelight customers that the customer has to: (1) choose the content to be stored on the Limelight content delivery network, and (2) tag the content for storage on the Limelight content delivery network. Limelight provides technical assistance to help their customers perform these steps. Thus, Limelight’s customer performs the “tagging” step of the method claims and Limelight performs the remaining steps. Together Limelight and its customers perform every step of the Akamai method claims.

The court found that Limelight’s “contract does not *obligate* Limelight’s customers to perform any of the method steps. It merely explains that the customer will have to perform the steps *if* it decides to take advantage of Limelight’s service.”⁹ Therefore, Limelight did not “direct or control” their customers. Since the method steps are performed by multiple parties and neither “directs or controls” the other, neither party was found liable for infringement.

McKesson Technologies Inc. v. Epic Systems Corp.

McKesson owns a patent claiming a method for electronic communication between healthcare providers and patients involving personalized web pages for doctors and their patients. Epic licenses software that enables doctors to set-up personalized web pages for their patients. The McKesson patent claims methods in which a patient initiates communication with their personalized web page, and the web page automatically responds to the communication with information from their healthcare provider.

The doctor using the Epic software (Epic’s customer/licensee) performs each of the steps of the McKesson method claims except for the step in which the patient initiates communication with their personalized web page. Neither the doctor nor Epic requires patients to use their personalized web page. Therefore, neither the doctor nor Epic “directs or controls” the patients. The majority held that since the method steps are performed by multiple parties and none of the

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parties “directs or controls” the other, none of the parties are liable for infringement.¹⁰

SiRF Technology, Inc. v. International Trade Commission and Broadcom Corp.

Broadcom owns several patents for global positioning system (GPS) devices and methods. The Broadcom patents have method claims that include steps of receiving satellite signals at a receiving station, transmitting portions of the satellite signals to remote GPS devices, and the remote GPS devices further processing the received portions of the satellite signals. SiRF sells integrated circuit chips for GPS devices, and SiRF’s customers use these chips in end user GPS devices. SiRF also provides GPS data to its customers, and its customers supply location data to the end user GPS devices.

SiRF argued that the end user performed the steps on the end user GPS device, and its customer performed the steps of communicating with the end user GPS device. Thus there are multiple parties performing the method steps and, as in the above cases, no infringement liability should be found. However, the court disagreed.

First, the court found that the steps of communicating with the end user GPS device were from the SiRF servers to their customer servers to the end user GPS devices. Since the claims did not require direct communication, this indirect communication initiated by the SiRF servers satisfied these claim steps of communicating with the end user GPS device.¹¹ Second, the court found that even though the processing at the end user GPS device required activating or enabling the end user device, the processing itself was performed by the SiRF chips and accompanying software.¹² The court construed “the ‘processing’ ... steps of the asserted claims as taking place in a GPS receiver that is enabled and ready to process data.”¹³ With this interpretation of the claim language, the court found “SiRF performs all of the claim limitations of [the asserted claims], and therefore directly infringes the asserted claims.”

Conclusion

At this point, valid patent method claims that require the combined actions of multiple parties are not enforceable, unless one party “controls or directs” the other parties. Carefully drafted method claims that only require the actions of a single party can be enforceable. We await the *en banc* rehearings by the Federal Circuit of the *Akamai* and *McKesson* cases to find out whether the playing field will change and valid method claims requiring the combined actions of multiple parties will also be enforceable. For more information about this issue, please contact Tony Filomena or any member of Taft’s Intellectual Property Practice Group.

1 *Akamai Technologies, Inc. v. Limelight Networks, Inc.*, No. 2009-1372, -1380, -1416, -1417 (Fed. Cir. 2010)

2 *McKesson Technologies, Inc. v. Epic Systems Corp.*, No. 2010-1291 (Fed. Cir. 2011)

3 *Akamai* (Fed. Cir. April 20, 2011) (*en banc* order) and *McKesson* (Fed. Cir. May 26, 2011) (*en banc* order)

4 *Miniauction, Inc. v. Thomson Corp.*, 532 F.3d 1318, 1329 (Fed. Cir. 2008)

5 *BMC Resources, Inc. v. Paymentech, L.P.*, 498 F.3d 1373, 1379 (Fed. Cir. 2007)

6 *McKesson* (Bryson, C.J., concurring)

7 *McKesson*, slip op. at 17 (Newman, C.J., dissenting)

8 *SiRF Technology, Inc. v. International Trade Commission and Broadcom Corp.*, No. 2009-1262 (Fed. Cir. 2010)

9 *Akamai*, slip op. at 16 (emphasis in original)

10 *McKesson*, slip op. at 8-9

11 *SiRF*, slip op. at 16-18

12 *SiRF*, slip op. at 18-19

13 *SiRF*, slip op. at 19

14 *SiRF*, slip op. at 19

For more information contact Anthony P. Filomena (afilomena@taftlaw.com.)

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You and the Legal System: Personal Injury

Brett Goodson of Goodson & Co., Ltd., a Cincinnati trial lawyer whose practice focuses on personal injury, is the next speaker in our *You and the Legal System* series for the public. He will speak about personal injury on Friday, September 16, 2011 at 12:00 noon at the Law Library. The program is free to the public. To register, call 513.946.5300. Mr. Goodson will address these points:

- What is a personal injury case?
- What is a Tort?
- How do I know if my injury results in a personal injury case?
- Can a death caused by negligence be a personal injury case?
- What are my time limits for making a claim?
- How is the value of a personal injury case decided?
- What if I want to settle without filing a lawsuit?
- How much do attorneys charge?
- Other types of cases
- What is tort reform?

Please note that this is not a CLE event; it is intended for the general public. However, attorneys are welcome to attend and may also want to pass along the program announcement to clients, staff, and community organizations. If you would like flyers to distribute, please contact law librarian Mary Jenkins at 513.946.5300.

You and the Legal System is brought to you as a public service by the Hamilton County Law Library, in conjunction with the Cincinnati Bar Association's Lawyer Referral Service.

Save the date for the next event in the *You and the Legal System* series: Karen Brinkman will present on Family Law on October 21; details forthcoming.

Personal Injury Information Resources

Law Library patrons have access to many good books and online materials on personal injury law. We offer jury verdicts databases via *Westlaw* and several other online resources, including *Consumer Product Safety Guide* (CCH), *Health Law & Business Library* (BNA), *Personal Injury* (Aspen), *Ohio Personal Injury Practice* (West), *Product Liability* (Aspen), *Products Liability Reporter* (CCH), *Product Safety and Liability Report* (BNA), and Baldwin's *Tort Law*. If you would like to use one of the books listed below, just call and we'll hold it for you. Questions about using the Law Library's online databases? Just ask a librarian for guidance.

Advanced personal injury [in Ohio] : Mastering your practice.
KFO539 .P4 O533 2008

Advanced workers' compensation [in Ohio]
REF KFO342 .W62 2010

Bad faith insurance claims [in Ohio].
REF KFO198.I58 B328 2008

Comparative negligence / Victor E. Schwartz with Evelyn F. Rowe.
KF1286 .S38 2010

Defense strategies in personal injury cases [in Ohio]
REF KFO197.P3 P541 2008

Discipline of students with special needs [in Ohio] / prepared by: James D. Basham ... [et al.]
REF KFO392 .D57 2009

Every dog's legal guide : a must-have book for your owner / by Mary Randolph.
KF390.5.D6 R36 2007

Everybody's guide to small claims court / by Ralph Warner and Emily Doskow.
KF8769.Z95 W37 2008

Handling the Police liability claim/ prepared by Donald R. Caster...[et al.].
REF KFO535 .P651 2011

Kentucky wrongful death actions.
KFK1397.D25 K46

Medical plans : COBRA, HIPAA, HRAs, HSAs and disability / by Greta E. Cowart.
KF6289.A1 T35 no. 389-5th

Ohio insurance coverage / by Ed E. Duncan.
REF KFO185 .D86 2008-

Personal injury cases : calculating and proving damages /
KFO197.P3 P54 2008

A practitioner's guide to hospital liability / James T. O'Reilly... [et al.].
KF3825.3 .O74 2011

New Books

You can see new books on display in the Law Library or by clicking on *Lists* along the top of the library catalog at <http://www.hamilton-co.org/cinlawlib/catalog/>. Here are just a few of our recent acquisitions:

- Drunk driving and related vehicular offenses
- Employee documentation, discipline & discharge
- Immigration employment compliance handbook
- Kentucky divorce
- Lesbian, gay, bisexual and transgender family law
- Social security disability boot camp
- Traffic law update

We also receive all of the OSBA's new CLE booklets on a quarterly basis. You will find them shelved on the bookcase facing the Ohio Revised Code near the photocopier room.

Upcoming Events

September 13: CLE: Ten Things You and Your Client Need to Know About Long Term Care Legal Issues

September 16: You and the Legal System: Personal Injury

October 6: Hamilton County Law Library Resources Board Meeting

October 21: You and the Legal System: Family Law

November 16: Lexis CLEs: Search Tips & Litigation Research

September Holidays

The law library will be closed on Monday, September 5 in observance of Labor Day.



September 2011 Law Library Newsletter

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