UNITED STATES DISTRICT COURT
DISTRICT OF CONNECTICUT

Applera Corporation and Roche Molecular Systems, Inc., plaintiffs,	:	
v.	:	**3:98cv1201 (JBA)**
MJ Research Inc. and Michael and John Finney, defendants.	:	

Ruling on Plaintiffs' Motion in Limine to Preclude Defendants from Arguing that the Patents-in-Suit are Not Infringed, Directly or by Inducement, on the Basis that They are Allegedly Invalid or Unenforceable [Doc. #762-8]

Plaintiffs move to preclude defendants from providing any argument (or testimony or other evidence) at trial that the patents-in-suit are not infringed, directly or by inducement, on the grounds that the patents are allegedly invalid or unenforceable, contending that such an argument, if made, would directly contradict well-established United States Supreme Court and Federal Circuit precedents, which provide that patent infringement is a separate and distinct issue from validity and enforcement and to be determined separately. Plaintiffs cite, among other cases, Cardinal Chem. Co. v. Morton Int'l, Inc., 508 U.S. 83, 96 (1993);[1] Spectra-Physics, Inc. v. Coherent, Inc., 827 F.2d 1524, 1535 (Fed. Cir. 1987);[2] Medtronic, Inc. v. Cardiac

[1] "A party seeking a declaratory judgment of invalidity presents a claim independent of the patentee's charge of infringement."

[2] "[An instruction] to the jury that invalid claims cannot be infringed is a nonsense statement...."

Pacemakers, Inc., 721 F.2d 1563, 1583 (Fed. Cir. 1983);[3] Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1540-41 (Fed. Cir. 1983);[4] Gardco Mfg, Inc. v. Herst Lightning Co., 820 F.2d 1209, 1213 (Fed. Cir. 1987).[5] The impetus for plaintiffs' motion is the concern raised by one of defendants' answers to plaintiffs' interrogatories and deposition testimony of individual defendant Michael Finney and defendants' opinion counsel Jason Mirabito to the effect that a patent can not be infringed that is either invalid or unenforceable. See Cote Decl. [Doc. # 784] Ex. 20 at 2-3 ¶ 1.c;[6] Michael Finney Depo. at

[3] "Though an invalid claim cannot give rise to liability for infringement, whether it is infringed is an entirely separate question capable of determination without regard to its validity."

[4] "When presented with patent validity and infringement issues, trial courts should ... decide both. ... the parties, witnesses and exhibits involved in both issues are before the court. If a judgment limited to one issue is reversed, it may become necessary to again call many of the same persons before the court for trial or argument on the other. In any event, a remand would normally be necessary for a return by the trial court to whatever fact finding process may be involved in a determination of the undecided issue."

[5] "The simple fact is that a patent may be valid and yet be rendered unenforceable for misuse or inequitable conduct. Similarly, a valid patent may be (in the abstract) infringed, that is, the accused device may fall within the scope of the claim, but there will be no liability to the patentee when the patent is unenforceable. Thus the conduct-of-the-applicant-in-the-PTO issue raised in the nonjury trial and the separated infringement/validity issues are distinct and without commonality either as claims or in relation to the underlying fact issues."

[6] "[Defendants do not infringe the patents-in-suit because] [p]laintiffs have engaged in patent misuse and have acted in violation in (sic) federal and state antitrust laws, including, but not limited to, Sections 1 and 2 of the Sherman Act, through their anticompetitive licensing scheme/thermal cycler authorization program. As a result, the Patents-In-Suit are invalid and unenforceable and there is no inducement of infringement."

538:8-19;[7] Supp. Cote Decl. [Doc. #824] Ex. 84 (Mirabito Depo.) at 42:11-14.[8]

Defendants characterize the motion as "unduly vague, ... speculative and premature," Opp'n [Doc. #859] at 1, but allow that they do "not intend to argue that patents-in-suit are not infringed because they are invalid or unenforceable, only that there can be no liability for any such infringement." Id. at 1-2. Plaintiffs next take issue with defendants' additional statement: "MJ will argue that opinions concerning invalidity and unenforceability are relevant to the intent element of inducement of infringement." Id. at 2.

Thus, the parties are in agreement with the legal premise that a patent can be infringed notwithstanding that it may also be invalid or unenforceable, and counsel will be expected to refrain from arguing or eliciting testimony to the contrary. Defendants may argue that they have no liability for any patent

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[7] Q. How did you come to the conclusion that the machine probably infringes?

A. Based on my own reading of the claims as they were written ... except for the fact you can't infringe an invalid patent.

Mem. [Doc. #772-8] at 3 n.1. Plaintiffs did not submit the actual deposition transcript as an exhibit or, if they did, did not direct the Court to it; defendants, however, do not take issue with the substance of the quotation.

[8] Q. What does this mean?

A. What this means is irrespective of the issue of validity, which of course if the patent is invalid, none of the claims would be infringed....

infringement found if that patent is found invalid or unenforceable. They may not argue, however, that opinions concerning invalidity and unenforceability are relevant to the intent element of 35 U.S.C. § 271(b). Legal opinion is only relevant to the intent analysis to the extent the advice bears on whether the alleged direct infringer actually infringes patented claims. See Manville Sales Corp. v. Paramount Systems, Inc., 917 F.2d 544, 553-54 (Fed. Cir. 1990).[9] Opinions on validity or unenforceability, which bear on infringement only with respect to liability, are thus legally irrelevant as to whether or not the alleged indirect infringer has the requisite intent to induce actual infringement. As set forth above, plaintiffs' motion [Doc. #762-8] is GRANTED.

IT IS SO ORDERED.

/s/

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Janet Bond Arterton, U.S.D.J.

Dated at New Haven, Connecticut, this 24th day of February 2004.

[9] For discussion of the Court's determination that the Manville Sales standard for intent under 35 U.S.C. § 271(b) will be applied, the reader is directed to the Court's ruling on plaintiffs' motion in limine Doc. #762-7.