

Patent

First Sale Doctrine Barred Recovery for Government Infringement

Night Vision Goggles Patent Obvious; Written Description Inadequate
Honeywell International, Inc. v. United States, 81 Fed Cl. 514 (Apr. 14, 2008)

The United States military uses night vision goggles ("NVG") to assist pilots in operating rotary and fixed wing aircraft, as NVGs create a brighter night view of terrain outside the cockpit. Dual amplification, however, can distort a pilot's vision and interrupt NVG functionality. In 1985, Richard Cohen an employee of Allied Signal Technologies, Inc. created in invention to solve the visibility problems by using red-light and full color displays on cockpit controls. Cohen's invention was ultimately sold to Honeywell International, Inc., and the U.S. Patent and Trademark Office issued the '914 and related patents to Honeywell in 2002.

After the Federal Court of Claims held that Honeywell lacked standing to pursue a claim for damages under the Invention Secrecy Act for the 17-year delay in issuance of the patent (*Honeywell International, Inc. v. U.S.*, 81 Fed.Cl. 224 (U.S. Fed. Cl., Apr. 14, 2008)), the Court addressed Honeywell's assertion that the United States government ("Government") used the '914 and related patents without a license in violation of 28 U.S.C. §1498 (a), and that such use constituted a taking of Honeywell's patent rights without just compensation in violation of the Fifth Amendment.

The Government and Intervenor Lockheed Martin Corp. and L-3 Communications Corp. asserted ten patent defenses against Honeywell arguing: invalidity; anticipation; obviousness; violations of the written description and best mode requirements; definiteness; violation of the "First Sale" Doctrine; inequitable conduct and prosecution laches.

The Government presented nineteen prior art references showing that the '914 and related patents were within the scope of prior art. Honeywell responded that the references to liquid crystal display technology ("LCD") claimed in its patents were not analogous to prior art because the prior art did not relate to "aircraft cockpits or NVG compatibility."

The Court followed the requirements of the Federal Circuit in considering the two factors to determine whether the prior art was analogous: (1) whether the art was from the same field of endeavor, regardless of the problem addressed; and (2) whether the reference, if not within the field of the inventor's endeavor, was still reasonably pertinent to the particular problem. *In re Clay*, 966 F.2d 656 (Fed. Cir. 1992).

After engaging in a detailed analysis of each claim of the '914 patent compared to each of the nineteen prior art references, the Court found that Honeywell's references to LCD technology described a "display system" but did not require that the system be used in aircraft cockpits. The '914 patent was in the same field of endeavor as the prior art patents and was analogous to art existing prior to the date of the '914 patent. The Court found, however, that the Government failed to prove that all claims of the '914 patent were anticipated by prior art under 35 U.S.C. §102(a) and (b).

Using the framework set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), the Court then considered the differences between the prior art and the claims at issue according to the level of ordinary skill in the pertinent art and decided that Claim 2 of the '914 patent, which described a local color display using blue, red and green color bands, was invalid as obvious under 35 U.S.C. §103(a). The evidence revealed that one particular German patent, not translated for the patent examiner during prosecution, disclosed all but two elements of Claim 2.

Turning to alleged violations of 35 U.S.C. §112, the Court first found that the '914 patent failed to meet the written description requirement. Honeywell completely abandoned the specific color output display envisioned by Cohen which was defined by its structure using separate primary color light sources, broadening the description to include a "local color display" system that filtered a narrowband of red color from a single multiband source of light.

L-3 failed to establish, however, that the '914 patent failed to fully inform the public about its invention, in that it could not be recreated without "undue experimentation" in violation of the "enablement" section of 35 U.S.C. §112. The experimentation required to measure the wavelength required to integrate the NVG technology was not "undue."

Section 112 also required that a specification set forth the "best mode contemplated by the inventor of carrying out his invention." L-3 argued that Cohen established that the "best mode" for the NVG was the CRT technology available at the time but that the specification of the '914 patent did not comport with Cohen's testimony, as it specified a Color Multi-Function Display System ("CMFD"). The Court held that best mode involved the inventor's state of mind at the time of filing of the patent, but that the specification need not disclose the best mode.

Addressing the last defense under Section 112, the Government, Lockheed and L-3 failed to show that the lower court's interpretations of technical terms describing the invention were invalid because they failed to allow one skilled in the art to understand the scope of the claim; the Court found the claim sufficiently clear to avoid invalidity for indefiniteness. 35 U.S.C. §112 ¶ 2.

The "First Sale" Doctrine provides that patented articles, when sold, become the private individual property of the purchasers and are no longer protected by patent laws. The Court agreed that even if the '914 and related patents were valid, Honeywell could not recover damages from the Government's sale of CMFDs under 35 U.S.C. §271(a) because the infringing CMFDs were sold to the Government under an implied license prior to Honeywell's merger with Allied Signal.

L-3 failed to prove that Honeywell engaged in inequitable conduct by misrepresenting the inventorship of the '914 patent to the PTO; Honeywell appropriately amended its patent application numerous times to address the examiner's concerns. Nor did the 17-year delay in the issuance of the patent constitute prosecution laches; Honeywell was prevented from pursuing the patent due to entry of the Secrecy Order.

The Court barred Honeywell from recovering damages from the Government.

Plaintiff Lawyer(s)	Plaintiff Law Firm(s)
Lawrence J. Gotts	Paul, Hastings, Janofsky & Walker, LLP
Mark Koehn	Paul, Hastings, Janofsky & Walker, LLP
Elizabeth Miller Roesel	Paul, Hastings, Janofsky & Walker, LLP

Defendant Lawyer(s)	Defendant Law Firm(s)
Christopher L. Crumbley	U.S. Department of Justice
Trevor M. Jefferson	U.S. Department of Justice

Intervenors Lawyer(s)	Intervenors Law Firm(s)
John Harbin	King & Spalding
Paul A. Debolt	Venable, LLP
Thomas J. Madden	Venable, LLP
Justin E. Pierce	Venable, LLP

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