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Federal Circuit Patent Bulletin: *Medisim Ltd. v. BestMed LLC*

July 14, 2014

"[Strict adherence to the Federal Rules of Civil Procedure dictates that parties forfeit] the right to move under Rule 50(b) by failing to first properly move under Rule 50(a)."

On July 14, 2014, in *Medisim Ltd. v. BestMed LLC*, the U.S. Court of Appeals for the Federal Circuit (Prost,* Taranto, Chen) affirmed-in-part, vacated-in-part, and remanded the district court's judgment as a matter of law that U.S. Patent No. 7,597,668, which was directed to a fast non-invasive thermometric device that displays a core body temperature, was invalid as anticipated by Medisim's own prior art FHT-1 thermometer. The Federal Circuit stated:

In the past we have found that parties forfeited the right to move under Rule 50(b) by failing to first properly move under Rule 50(a). . . . Medisim first argues that BestMed failed to move for JMOL on anticipation under Rule 50(a), so it was foreclosed from doing so under Rule 50(b). Therefore, Medisim claims that the district court should have refrained from ruling on anticipation after the jury verdict under Rule 50(b). BestMed denies such forfeiture. In support of its argument, it points to a statement it made on the record at the close of evidence in opposition to Medisim's JMOL motion for no anticipation. . . . While BestMed concedes that this statement was "not a model of clarity," it argues that Medisim was on notice of BestMed's position. . . .

The district court concluded that Medisim had not been unfairly surprised by BestMed's anticipation contentions. . . . While Medisim may not have been surprised by BestMed's invalidity contentions, the Supreme Court has held previously that our Federal Rules of Civil Procedure are to be strictly followed in circumstances such as this one. . . . With that principle in mind, we conclude that Best-Med forfeited its right to move for JMOL on anticipation. . . . Therefore, we conclude that the district court legally erred in ruling on any validity issues after the jury verdict under Rule 50(b). . . . Because we vacate the district court's grant of JMOL on anticipation due to forfeiture, we need not consider whether the district court erred in granting JMOL on anticipation on the merits. . . .

A court may set aside the verdict and order a new trial even if no motion for JMOL was made under Rule 50 (a). . . . Below, the district court did not elaborate on its reasons for granting BestMed's motion for a new trial, conditioned on our determination that BestMed failed to preserve its right to bring a post-trial motion for JMOL on anticipation. Instead, it made its ruling in a footnote. . . . Given the context and the surrounding discussion, the district court's reasoning is clear enough to pass Rule 50(c)(1) muster. The section of its opinion where the district court conditionally granted the new trial is entitled "The '668 Patent Is Anticipated by the FHT-1 Thermometer." In that section, the district court calls BestMed's anticipation argument overwhelmingly strong. . . .

The record shows that Medisim's expert witness, Dr. Lipson, conceded that the FHT-1 calculated an intermediate temperature and that if "the intermediate temperature calculated by . . . the prior art FHT-1 thermometer, is a deep tissue temperature," then the FHT-1 anticipates claim 1 of the '668 patent and "whatever [other claims] require[] the deep tissue limitation." Therefore, as the district court correctly noted, anticipation turns on one issue in this case: whether the intermediate temperature concededly calculated by the FHT-1 using the heat-flux algorithm of the '397 patent qualifies as a deep tissue temperature as claimed in the '668 patent. [The] intrinsic evidence, all discussed by the district court, heavily supports the conclusion that the FHT-1 calculates a deep tissue temperature and, therefore, anticipates the '668 patent.

BestMed's expert, Mr. Goldberg, also offered supporting testimony, which the district court considered. For example, Mr. Goldberg identified particular portions of code that shows a calculation of a deep tissue temperature. Additionally, Medisim produced and distributed many pre-litigation documents stating that its R.A.T.E.™ technology as found in the FHT-1 thermometer measures the temperature under the skin. While not dispositive in and of themselves, these documents further support the district's court conclusion that BestMed is entitled to a new trial. For example, one such document stressed that "[i]n R.A.T.E.™ technology we do not use [a] prediction forgetting the final temperature, but we use [a] calculation in real time of the temperature beneath the skin." Medisim tried to dismiss this evidence as marketing fluff, but the documents addressed sophisticated audiences and contained equations and other technical descriptions. This too supports the conclusion that the R.A.T.E.™ technology found in the FHT-1 used the heat-flux algorithm of the '397 patent in the same way described in the '668 patent.

While we acknowledge that the district court's discussion of the aforementioned evidence ends with the grant of JMOL on anticipation, we conclude that this same reasoning is applicable to the conditional grant of a new trial. Therefore, the district court's conditional grant of a new trial was amply supported by the evidence. It did not abuse its discretion in granting BestMed's motion for a new trial.