

Court withdrew its en banc opinion, vacated the underlying Board decision, and dismissed the veteran's appeal as moot. *Id.* at 1367.

This court reversed. It held that the Veterans Court was authorized to make its judgment effective *nunc pro tunc*, and that such retroactive relief was "appropriate in this case." *Id.* at 1368. Recognizing "the general rule that a veteran's claim for benefits ends with his death," *id.* at 1370, it held that the veteran's widow should be substituted for him, since if "Mrs. Padgett could not be substituted, *nunc pro tunc* relief would be inappropriate," *id.*

In *Padgett*, making the Veterans Court judgment effective *nunc pro tunc*—presumably to the day before the veteran died—meant that prior to his death, Padgett had established his entitlement to disability benefits. Under the statutory scheme, his widow could recover those benefits.

In the present case, however, Mrs. Pelea has not contended that the Veterans Court judgment in her favor should be made effective *nunc pro tunc* to the date of her death. More importantly, to do so would not entitle her to any accrued benefits. The Veterans Court held only that the Board should further consider whether the VA had adequately informed her what additional evidence she should submit to support her claim. Under that ruling, she still was a long way from establishing either that her deceased husband had served in the United States military or that his death was connected with such service.

### III

Since we hold that Mrs. Pelea's right to pursue her claim for dependency and indemnity compensation benefits terminated

on her death, it follows that the Veterans Court properly denied her estate's application to be substituted for her as a party in the case. *Padgett*, 473 F.3d at 1370.

### CONCLUSION

The judgment of the Veterans Court is *AFFIRMED*.



**BOSTON SCIENTIFIC SCIMED, INC.**  
(formerly known as Scimed Life Systems, Inc.), Plaintiff–Appellant,

v.

**MEDTRONIC VASCULAR, INC.** (also known as Medtronic AVE, Inc.),  
Defendant–Appellee,

and

**Eric C. Martin, Defendant.**

No. 2006–1434.

United States Court of Appeals,  
Federal Circuit.

Aug. 8, 2007.

**Background:** Board of Patent Appeals and Interferences, 2001 WL 1339890, issued final decision denying priority benefit to assignee of earlier-filed European patent application. Assignee brought action

challenging Board's final decision in interference proceeding. The United States District Court for the District of Columbia, Richard J. Leon, J., 468 F.Supp.2d 60, affirmed. Assignee appealed.

**Holdings:** The Court of Appeals, Mayer, Circuit Judge, held that:

- (1) statute that governed right of priority and benefit of earlier filing date in foreign country did not permit applicant for United States patent to benefit from priority of foreign application previously filed by entity that was not acting on behalf of United States applicant at time of filing, and
- (2) assignee could not present evidence to district court to support new legal theories.

Affirmed.

#### 1. Federal Courts ◊776

A de novo standard is applied when reviewing questions of law, including a trial court's interpretation of statutory language.

#### 2. Patents ◊90(1)

Statute that governed right of priority and benefit of earlier filing date in foreign country did not permit applicant for United States patent to benefit from priority of foreign application previously filed by entity that was not acting on behalf of United States applicant at time of filing. 35 U.S.C.A. § 119(a).

#### 3. Patents ◊90(1)

Statute that governs right of priority and benefit of earlier an filing date in a foreign country requires that a nexus exist between the inventor and the foreign applicant at the time the foreign application was filed. 35 U.S.C.A. § 119(a).

#### 4. Patents ◊90(1)

A foreign application may form the basis for priority only if that application was filed by either the United States applicant himself or by someone acting on his behalf at the time the foreign application was filed. 35 U.S.C.A. § 119(a).

#### 5. Patents ◊113(6)

A party may present new evidence to the trial court when appealing a decision of the Board of Patent Appeals and Interferences in an interference proceeding.

#### 6. Patents ◊113(6)

A party may not advance new legal theories at the trial court level when appealing a decision of the Board of Patent Appeals and Interferences in an interference proceeding, even if the overarching legal issue was presented below.

#### 7. Patents ◊113(6)

Assignee could not present evidence to district court to support new legal theories in action challenging final decision of Board of Patent Appeals and Interferences denying priority benefit to assignee of earlier-filed European patent application in interference proceeding; parties stipulated that only issue to be resolved by district court was whether Board correctly ruled on inventor's motion attacking priority benefit initially granted to other inventor and assignee did not raise those new legal theories before Board.

#### Patents ◊328(2)

5,575,817. Cited.

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Gregory A. Castanias, Jones Day, of Washington, DC, argued for the plaintiff-

appellant. With him on the brief were Gidon D. Stern, Thomas E. Friebel, Catharina J. Chin Eng, and Brent P. Ray, of New York, NY.

Brian E. Ferguson, McDermott Will & Emery LLP, of Washington, DC, argued for the defendant-appellee. On the brief were Paul Devinsky, John R. Fuisz, Stephen K. Shahida, and Natalia V. Blinkova. Of counsel were Joel M. Freed and Amanda E. Koenig.

Before MAYER, BRYSON and PROST, Circuit Judges.

MAYER, Circuit Judge.

Boston Scientific Scimed, Inc. (“Scimed”)\* appeals the district court’s grant of summary judgment affirming the Board of Patent Appeals and Interferences’ final decision, which denied Scimed the priority benefit of an earlier-filed European patent application for the subject matter at issue in Patent Interference Number 104,192 (“the ‘192 interference”). *Scimed Life Sys., Inc. v. Medtronic Vascular, Inc.*, 468 F.Supp.2d 60 (D.D.C.2006). We affirm.

#### *Background*

This appeal stems from an interference proceeding before the United States Patent and Trademark Office Board of Patent Appeals and Interferences. Scimed and Medtronic Vascular, Inc. (“Medtronic”) are each assignees of different United States patent applications covering the same invention. Andrew Cragg and Michael Dake (collectively “Cragg”) filed patent application 08/461,402 (“the ‘402 application”) for the invention in question on June 5, 1995.

\* Plaintiff-appellant Boston Scientific Scimed, Inc., was formerly known as Scimed Life Sys-

tems, Inc., and will be referred to throughout this opinion as “Scimed.”

Cragg then assigned all rights in the ‘402 application to Boston Scientific Technology, Inc., which later merged into Scimed, the plaintiff-appellant and current legal owner of the ‘402 application. Also on June 5, 1995, Thomas J. Fogarty, Timothy J. Ryan, and Kirsten Freislinger (collectively “Fogarty”) filed patent application 08/463,836 (“the ‘836 application”) for the same invention. Fogarty assigned their rights in the ‘836 application to a company that eventually became Medtronic, the defendant-appellee and current legal owner of the ‘836 application. Eric Martin, a third-party to the instant appeal, owns U.S. Patent No. 5,575,817 (the “Martin patent” or “ ‘817 patent”), which resulted from an application filed on August 19, 1994.

On April 23, 1998, the board declared an interference between Scimed’s ‘402 application, Medtronic’s ‘836 application, and Martin’s ‘817 patent. The purpose of the interference was to determine which party had priority of inventorship, thereby entitling it to the invention as set forth in the sole count of the interference:

An apparatus for reinforcing a bifurcated lumen comprising:

a first section, configured to be positioned within the lumen, comprising:

an upper limb, configured to fit within the lumen upstream of the bifurcation;

a first lower limb, configured to extend into the first leg of said bifurcation when said first section is positioned in the lumen, and

a second lower limb, shorter than said first lower limb, and configured so that when said first section is positioned in

tems, Inc., and will be referred to throughout this opinion as “Scimed.”

the lumen, said second lower limb does not extend into a second leg of said bifurcation, and further comprising

a second section configured to be positioned separately within the lumen and joined to said second lower limb of the first section, effectively extending said second lower limb into said second leg of said bifurcation.

*Cragg v. Martin*, Patent Interference No. 104,192, Paper No. 187, 2001 WL 1339890 at \*2-3 (B.P.A.I. Jan. 01, 2001) (“*Final Interference Decision*”).

The board initially gave Cragg the benefit of the filing dates of two European patent applications filed by MinTec SARL (“MinTec”), a French company. The earlier of these dates was February 9, 1994. At the time these European applications were filed, no legal relationship existed between MinTec and Cragg, nor was MinTec acting on behalf of Cragg. Fogarty was granted the benefit of the filing date of U.S. patent application 08/255,681, which was June 8, 1994. Martin was accorded benefit of the application that led to the '817 patent, which was filed on August 19, 1994. Accordingly, the PTO initially designated Cragg as the senior party in the interference.

Fogarty responded by filing a motion attacking the priority benefit granted to Cragg. The board granted the motion, declaring Fogarty the senior party in the interference. After Cragg protested this

decision, the board issued a final decision denying his request to be declared the senior party. The board ruled that Cragg was not entitled to priority benefit under 35 U.S.C. § 119 because neither Cragg nor Dake had assigned their rights to MinTec until after it had filed the European applications. *Final Interference Decision*, 2001 WL 1339890, at \*5.

Scimed, the assignee of Cragg’s U.S. patent application, then brought an action in the United States District Court for the District of Columbia challenging the board’s final decision in the '192 interference. The district court affirmed the board’s final decision, *Scimed*, 468 F.Supp.2d at 61, and Scimed filed this appeal. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

#### Discussion

[1] We review a district court’s grant of summary judgment *de novo*. *Monsanto Co. v. Scruggs*, 459 F.3d 1328, 1344 (Fed. Cir.2006). We also apply a *de novo* standard when reviewing questions of law, including a trial court’s interpretation of statutory language. *Pitsker v. Office of Pers. Mgmt.*, 234 F.3d 1378, 1381 (Fed.Cir. 2000).

[2] At issue here is whether 35 U.S.C. § 119(a)\*\* permits an applicant for a United States patent to benefit from the priority of a foreign application previously filed by an entity that was not acting on

\*\* 35 U.S.C. § 119(a) reads in relevant part:

An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United

States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed . . .

behalf of the U.S. applicant at the time of filing. We hold that it does not.

A similar issue was addressed by the Court of Customs and Patent Appeals in *Vogel v. Jones*, 486 F.2d 1068 (CCPA 1973), which, to the extent relevant here, is binding upon us, *South Corp. v. United States*, 690 F.2d 1368, 1370 (Fed.Cir.1982) (en banc). According to *Vogel*, “§ 119 gives rise to a right of priority that is personal to the United States applicant.” 486 F.2d at 1072. Due to the personal nature of this right, an applicant for a U.S. patent may only benefit from the priority of a foreign application if it was filed by the U.S. applicant or “on his behalf.” *Id.*

Scimed argues that *Vogel* does not require the foreign applicant to have been acting on behalf of the U.S. applicant at the time the foreign application was filed. It points to the following passage in support:

This practice [of allowing a U.S. applicant to claim priority from a foreign application filed by someone else] arose because it was recognized that in many foreign countries, unlike in the United States, the actual applicant for a patent can be other than the inventor, e.g., an assignee. In light of this, we regard the language in § 119 referring to legal representatives and assigns to merely represent a codification of the actual practice under [the predecessor statute to § 119]. Since under United States law an application for patent must be made by the inventor, that practice was based on the requirement that the foreign application, regardless of the identity of the applicant, must have been filed for an invention actually made by the inventive entity seeking to rely upon it for priority purposes. We think § 119 must be construed to the same end.

*Id.* (footnote omitted). Scimed attempts to construe this language as permitting a U.S. applicant to benefit from a foreign application’s earlier filing date whenever “the invention described in the foreign application [is the same] one actually made by the U.S. applicant,” “regardless of the identity of the applicant’ of the foreign application.” According to its interpretation, “the *Vogel* court did *not* hold that the foreign application must have been filed by a person who was an assignee or legal representative of the U.S. inventor at the time the foreign application was filed, or that the foreign application must have been filed on his behalf in order for there to be priority benefit.” We disagree.

[3, 4] *Vogel* clearly held that the above-quoted passage “means that an applicant for a United States patent can rely for priority on the ‘first filed’ application by an assignee on his behalf.” *Id.* (emphasis added). Moreover, “the existence of an application made by [the inventor’s] assignee in a foreign country on behalf of one other than the United States inventor is irrelevant to his right of priority based on applications made on his behalf.” *Id.* In other words, while the foreign application must obviously be for the same invention and may be filed by someone other than the inventor, section 119(a) also requires that a nexus exist between the inventor and the foreign applicant at the time the foreign application was filed. Indeed, as a matter of pure logic, an entity could not have filed a foreign application “on behalf of” an inventor without the inventor’s knowledge or consent; that the foreign application may have been filed in accordance with the laws of the country in which it was filed has no bearing here. Therefore, to the extent that there may have been any uncertainty or ambiguity in *Vogel*, we now explicitly hold that a foreign

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