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SUITS**

## ASYST TECHNOLOGIES V. JENOPTIK ET AL.

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FENWICK & WEST)



In one of the top-five patent litigation awards in the past 15 months, a federal jury in San Jose awarded \$74.7 million to Asyst Technologies, Inc., a Silicon Valley company that makes equipment for semiconductor foundries. The January 31 decision against Jenoptik Aktiengesellschaft, a Jena, Germany-based manufacturer of optics, lasers, and sensors, marks the end of an 11-year battle.

In 1987 Fremont, California-based Asyst applied for a patent on a technology that uses infrared sensors to track semiconductor wafers via microscopic bar codes during the manufacturing process. Prior to the technology's development, tracking the wafers was a tedious process conducted by hand. The patent was granted in 1992.

Asyst claimed at trial that when the technology—known as the SMART-Traveler System—came onto the market in the early 1990s, it fundamentally changed the industry. But in 1995, Asyst alleged, Jenoptik began marketing its own version, based in part on inside information obtained by executives of a Jenoptik subsidiary that had partnered with Asyst in the 1980s. Asyst claimed that the executives from that subsidiary later headed the Jenoptik division that caused Asyst's sales to drop.

Jenoptik countered that its technology was substantially different from Asyst's, and that Asyst had

patented a technology that was already in widespread use at the time. Jenoptik left the wafer-sorting business in 1999, and the subsidiary charged with infringing on Asyst's patent, Meissner + Wurst GmbH, was sold to another company.

The case was on the docket for so long that Asyst's second chair was still in law school when the company first filed suit in federal district court in San Jose in 1996. Trial was originally scheduled for 1998, but over the next seven years the case was dismissed on summary judgment twice, and appellate judges overturned the dismissal each time. Then a criminal matter on the judge's calendar bumped trial back another year.

The nine-day trial began on January 12, 2007. The jury awarded \$43.2 million to Asyst for price erosion, with the balance for lost profits through 1998. The defense says it plans to appeal.

But Asyst's lawyers face one more hurdle. Just before trial, Jenoptik sought to invalidate Asyst's patent on grounds that Asyst had applied for it twice, allegedly to extend the patent; Judge Jeremy Fogel granted the motion. To quash the issue, Asyst sought a terminal disclaimer, whereby any second patent would expire at the same time as the first. With trial looming, the judge did not rule on Asyst's request. At press time his ruling was pending.

FOR PLAINTIFF ASYST TECHNOLOGIES, INC. (FREMONT, CALIFORNIA)

**FENWICK & WEST:** Michael Sacksteder, Darryl Woo, and associates Joseph Belichick, Jeffrey Lasker, Mashhood Rassam, David Schumann, and Karen Server. (All are in Mountain View, California except for Sacksteder, Schumann, and Server, who are in San Francisco.) Woo brought the matter to the firm when he lateraled in from Cooley Godward (now known as Cooley Godward Kronish) in 2000.

FOR DEFENDANT JENOPTIK AKTIENGESELLSCHAFT (JENA, GERMANY)

**HOWREY:** Stephen Edwards, Floyd Nation, Daniel Shvodian, and James Valentine. (Edwards and Nation are in Houston; Shvodian and Valentine are in East Palo Alto, California.) The firm got the matter in 2000 from Arnold, White & Durkee when the firms merged. Howrey was lead trial counsel for the other Jenoptik subsidiaries listed as defendants—Emtrak, Inc., Jenoptik Infab GmbH Integrated Fabrication Systems, and Meissner + Wurst. None still exist as Jenoptik-related entities. —B.B

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