

CHISUM PATENT ACADEMY[®]

Announcing the Academy's Awards for 2016:

The Chisum Patent Academy's Nominees for the 15 Most Impactful Federal Circuit Patent Decisions of 2016 (the Good, the Bad, and the Ugly)

By Donald Chisum and Janice Mueller
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Authors' Note: Chisum and Mueller selected the following 15 cases as the most impactful of the Federal Circuit's precedential patent law decisions issued in 2016. We excluded Supreme Court patent decisions, all of which are inherently impactful. Our remarks about each case indicate our view as to why it made a difference—for better or worse. Our comments, views, and opinions are strictly our own and do not reflect the views of any persons other than Chisum and Mueller.

We have listed our selections by patent law topic/issue rather than rank the cases in an overall sense. Nor did we attempt to include every disputed issue in patent law. The order of topics and the number assigned to each case within a topic does not indicate a ranking.

A. Patent Claim Construction/Interpretation

1. *Trustees of Columbia University in the City of New York v. Symantec Corp.*, 811 F.3d 1359 (Fed. Cir. Feb. 2, 2016) (DYK, Prost & Hughes). This case starkly illustrates one of the continuing schisms in Federal Circuit approaches to claim interpretation. The court held that *explicit* redefinition or disavowal is *not* required to support departure from a claim term's "ordinary" meaning. In rejecting a "strong" presumption of plain meaning without express definition or disavowal, the court adopted a position contrary to its earlier holding in *Thorner v. Sony Computer Entertainment America LLC*, 669 F.3d 1362 (Fed. Cir. 2012).

2. *Eon Corp. v. Silver Eon Corp. v. Silver Spring Networks, Inc.*, 815 F.3d 1314 (Fed. Cir. Feb. 29, 2016) (PROST & Hughes; BRYSON, dissenting). We found this case intriguing primarily because of the dissent by Judge Bryson, author of the 2005 *en banc Phillips* decision. The dissent agreed with the district court's interpretation of the claim terms "portable" and "mobile" based on two dictionary definitions that captured the terms' ordinary meaning. The majority disagreed on the merits of the constructions, and further held that the district court improperly delegated its claim construction responsibilities to the jury by instructing it to give the disputed terms

their “readily understandable” plain and ordinary meaning, rather than provide an express definition of the terms.

3. *Poly-America, L.P. v. API Industries, Inc.*, 839 F.3d 1131 (Fed. Cir. Oct. 14, 2016) (REYNA, Prost & Hughes). During 2016 the Federal Circuit frequently addressed arguments that language in a patent’s specification, such as “the present invention,” alone or in connection with arguments in prosecution, disavowed some embodiment or aspect of claim scope. Despite the court’s rigorous “clear and unmistakable” standard for disavowal, the argument succeeded in several cases. In addition to *Poly-America*, see *David Netzer Consulting Engineer LLC v. Shell Oil Co.*, 824 F.3d 989 (Fed. Cir. May 27, 2016) (LOURIE, Prost & Taranto) (finding a disclaimer). Compare *Massachusetts Institute of Technology v. Shire Pharmaceuticals, Inc.*, 839 F.3d 1111 (Fed. Cir. Oct. 13, 2016) (STOLL & Chen; O’MALLEY, concurring) (no disclaimer).

B. Patent-Eligibility under 35 U.S.C. §101

1. *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. May 12, 2016) (HUGHES, Moore & Taranto). Section 101 patent eligibility competes with *inter partes* review issues as the Federal Circuit’s “Top Topic of 2016.” *Enfish* was only one of fifteen (15) precedential decisions on eligibility. The Circuit held that intangible subject matter, an improved way of modeling data base entries, was §101 eligible, noting that claims to computer software were *not* “inherently abstract” and were *not* “doom[ed]” merely because they did not define an improvement “by reference to ‘physical’ components” or because the claimed improvement could be “run on a general-purpose computer.” *Enfish* breathed life into *Alice*’s step one inquiry (i.e., is the claim “directed to” an abstract idea?). Later cases involving arguably similar patent claims distinguished *Enfish*, e.g., *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016), and *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138 (Fed. Cir. 2016), but the court followed *Enfish* in others, e.g., *McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299 (Fed. Cir. 2016). *Enfish*’s focus on specific claim limitations in determining *Alice* step one was received cautiously in a later decision by Judge Chen, *Bascom Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016). *Bascom* found at least a disputed issue about *Alice* step two requiring reversal of a dismissal based on the “face of the patent”: did the limitations, as an “ordered combination,” constitute the necessary step two “inventive concept”?

2. *Intellectual Ventures I, LLC v. Symantec Corp.*, 838 F.3d 1307 (Fed Cir. Sept. 30, 2016) (DYK; MAYER, concurring; STOLL, dissenting-in-part). Four patents sank under Judge Dyk’s pen. Judge Mayer wrote a provocative concurring essay, arguing not only that all software patents were ineligible (and disagreeing with cases such as *Enfish*), but also that enforcement of such patents against internet communication violated the constitutional guarantee of free expression. Judge Stoll dissented as to one patent, the claims of which a jury had found novel and non-obvious. She posed the difficult-to-answer question: how could the majority find the claims’ added limitations “conventional” (and thus §101-ineligible under *Alice*’s step two (“inventive step”)) when a jury had found the limitations novel over the prior art? In Judge Stoll’s view, the majority had concluded paradoxically that something novel was “conventional.”

3. *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288 (Fed. Cir. Nov. 1, 2016) (PLAGER & Newman; REYNA, dissenting). This was the Circuit’s penultimate §101 case issued in 2016. The majority, per Judge Plager, reversed a district court invalidation of four related patents that concerned gathering and processing information on usage of a network by devices for purposes such as accounting and billing. Unlike *Enfish* and *McRO*, Judge Plager linked his holding to step two of *Alice*. He asserted that the Supreme Court had refused to define an “abstract” idea. Nor had the Federal Circuit’s decisions settled on a clear analytic test. That left the lower courts to apply the law in a common-law, case precedent manner, simply comparing the claims at issue to the claims held either eligible or not eligible in prior cases.

Dissenting in *Amdocs* as to two of the four patents, Judge Reyna argued for a different approach. Judge Reyna linked the “abstract idea” exception to the principle, recognized by the Supreme Court long ago in cases such as *O’Reilly v. Morse*, 56 U.S. 62 (1854), that a patent claim must be limited to particular *means* for achieving a result or function. The limiting means could be structural or procedural and need not be tangible, but the limitations must not be “illusory” (e.g., generic computer implementation, such being necessarily required for automation) or merely “contextual” (e.g., a field-of-use restriction).

Judge Reyna has previously convinced his colleagues to rehear cases *en banc*. See, e.g., *Suprema, Inc. v. International Trade Commission*, 742 F.3d 1350, 1371 (Fed. Cir. 2013) (Reyna, J., dissenting in part) (chastising panel majority for its “decision to negate the Commission’s statutory authority to stop induced infringement at the border”), *reh’g en banc granted, opinion vacated*, 36 ITRD 392 (Fed. Cir. 2014), *on reh’g en banc*, 796 F.3d 1338 (Fed. Cir. 2015) (*en banc*) (Reyna, J., for the court; Dyk, O’Malley, Prost & Lourie, JJ., dissenting). Judge Reyna may well campaign for *en banc* review of the §101 eligibility morass. Whether examining the issue *en banc* would produce a positive outcome remains to be seen. The last time the Federal Circuit looked at §101 as an *en banc* court was in *Alice*. The judges splintered badly, inducing the Supreme Court to grant *certiorari* and inflict upon the patent system the current vague two-part test.

C. On Sale Bar under 35 U.S.C. §102(b) (2006)

1. *Medicines Company v. Hospira, Inc.*, 827 F.3d 1363 (Fed. Cir. July 11, 2016) (*en banc*) (O’MALLEY, Prost, Newman, Lourie, Dyk, Moore, Reyna, Wallach, Taranto, Chen, Hughes, and Stoll). The *en banc* court held unanimously, under the very particular circumstances of the case, that a pre-critical date transaction by the patent owner with its contract supplier did *not* trigger a §102(b) on sale bar. Rather surprisingly, *Medicines Company* is the Circuit’s first-ever *en banc* case to address the on sale bar. Query how a court sitting *en banc* can write so much and yet decide so little on such an important topic. A somewhat similar exercise (concerning obviousness in jury trials) in *Apple v. Samsung*, discussed below, drew three sharp dissents and wins our “Stinker of 2016” award.

D. Exhaustion of Patent Rights

1. *Lexmark Int'l, Inc. v. Impression Prods., Inc.*, 816 F.3d 721 (Fed. Cir. Feb. 12, 2016) (*en banc*) (TARANTO, Prost, Newman, Lourie, Moore, O'Malley, Reyna, Wallach, Chen, and Stoll; DYK & Hughes, dissenting), *cert. granted*, No. 15-1189, 2016 WL 1117396 (U.S. Dec. 2, 2016). This massively detailed *en banc* decision decided two main issues: (1) conditioned sales of patented products, when made under a restriction that is otherwise lawful and within the scope of the patent grant as held in *Mallinckrodt, Inc. v. Medipart, Inc.*, 976 F.2d 700 (Fed. Cir. 1992) (Newman, J.), do *not* give rise to patent exhaustion; and (2) sales made or authorized by the patentee outside the United States of its U.S.-patented products do not trigger “international exhaustion,” even when no reservation of U.S. rights accompanies the sale. In other words, unauthorized imports into the United States and sales and uses of those items in the United States remain acts of §271(a) infringement not excused by the exhaustion defense. The *en banc* court concluded that the no-exhaustion principle of *Jazz Photo Corp. v. International Trade Comm'n*, 264 F.3d 1094 (Fed. Cir. 2001) (Newman, J.), remains sound even after the Supreme Court's decision in *Kirtsaeng v. John Wiley & Sons, Inc.*, 133 S. Ct. 1351 (2013), which dealt with international exhaustion in copyright law.

The Federal Circuit's recent track record at the Supreme Court has not been stellar, especially in cases when the Circuit propounds a complex line of reasoning to distinguish broad, casual language in prior Supreme Court precedents. But in *Lexmark*, Judge Taranto put forth a herculean, scholarly effort to defend the Federal Circuit's rules on non-exhaustion. Will his precise and extended arguments persuade a Supreme Court often disposed to overturn decisions of the “patent court” not to do so in this case?

E. Inequitable Conduct

1. *Ohio Willow Wood Co. v. ALPS South, LLC*, 813 F.3d 1350 (Fed. Cir. Feb. 19, 2016) (BRYSON, Dyk & Wallach). Some may assume that inequitable conduct via violation of the duty of candor owed to the USPTO was essentially dead as an issue in patent infringement litigation after *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276 (Fed. Cir. 2011) (*en banc*). But the *Ohio Willow* decision showed that the doctrine still has teeth. A take-home lesson is that patent owners need to be especially careful with prosecution in post-grant proceedings, such as *ex parte* reexamination, and especially in the submission of factual assertions about information from parallel litigation involving the patent at issue.

2. *TransWeb, LLC v. 3M Innovative Properties Co.*, 812 F.3d 1295 (Fed. Cir. Feb. 10, 2016) (HUGHES, Wallach & Bryson). Conduct by an in-house attorney and a director of research in delaying and then misleadingly disclosing a public use bar involving an accused infringer's product led to a finding of antitrust fraud. As a result, the accused infringer recovered trebled attorney fees incurred in defending the infringement suit.

F. *Inter Partes* Review

1. *Wi-Fi One, LLC v. Broadcom Corp.*, 837 F.3d 1329 (Fed. Cir. Sept. 16, 2016) (BRYSON & Dyk; REYNA, concurring), *vacated and rehearing en banc granted*, ___ F.3d ___, No. 2015-1944 (Fed. Cir. Jan. 4, 2017) (*en banc*). In this post-*Cuozzo* decision, the panel majority reaffirmed the Circuit’s position taken in its pre-*Cuozzo* decision *Achates Reference Publ’g, Inc. v. Apple Inc.*, 803 F.3d 652, 657 (Fed. Cir. Sept. 30, 2015) (Linn, J.), that it did not have jurisdiction to review a Board institution determination (which the Board reaffirmed in its final written decision) that no time bar under 35 U.S.C. §315 precluded Apple’s IPR petitions. The *Wi-Fi One* panel majority “[saw] nothing in the *Cuozzo* decision that suggests *Achates* has been implicitly overruled.” Dissenting Judge Reyna contended that a §315 time bar determination is reviewable by the Circuit as part of the PTAB’s final written decision. The Circuit granted rehearing *en banc* on January 4, 2017, to consider whether it should “overrule *Achates* . . . and hold that judicial review is available for a patent owner to challenge the PTO’s determination that the petitioner satisfied the timeliness requirement of 35 U.S.C. § 315(b) governing the filing of petitions for inter partes review.”

2. *In re Magnum Oil Tools International, Ltd.*, 829 F.3d 1364 (Fed. Cir. July 25, 2016) (O’MALLEY, Newman & Chen). This case addresses questions about burdens of proof and persuasion in IPRs. In particular, does the procedural construct of “prima facie” obviousness, which is applied during *ex parte* examination and prosecution to shift the burden of production of evidence to a patent owner on issues such as unexpected results and objective indicia (see, e.g., *In re Urbanski*, 809 F.3d 1237 (Fed. Cir. 2016), and *ACCO Brands Corp. v. Fellowes, Inc.*, 813 F.3d 1361 (Fed. Cir. 2016)), apply with equal force in a contested *inter partes* review? In this opinion, Judge O’Malley says no. See also *TriVascular, Inc. v. Samuels*, 812 F.3d 1056 (Fed. Cir. 2016) (O’MALLEY, Moore & Wallach). But the holding in *Magnum Oil* may not be consistent with the Supreme Court’s direction in *Cuozzo* that IPR is a “hybrid” proceeding; i.e., a contested proceeding between adversaries but also an opportunity for the USPTO to review its original patentability determination.

G. Evidentiary Privileges

1. *In re Queen’s University*, 820 F.3d 1287 (Fed. Cir. Mar. 7, 2016) (O’MALLEY & Lourie; REYNA, dissenting). Resolving an issue of first impression for the Circuit, the majority recognized a patent agent-client privilege (which it inartfully termed a “patent-agent privilege”) that protects from discovery in litigation certain communications between non-attorney but USPTO-registered patent agents and their clients. The majority indicated that USPTO regulations setting forth the scope of an agent’s practice before the agency would also set the contours of the patent agent-client privilege. However, communications that are “not reasonably necessary and incident to the prosecution of patents” before the USPTO are not protected by the privilege. Examples would include “communications with a patent agent who is offering an opinion on the validity of another party’s patent in contemplation of litigation or for the sale or purchase of a patent, or on infringement.”

H. Venue

1. *In re TC Heartland LLC*, 821 F.3d 1338 (Fed. Cir. April 29, 2016) (MOORE, Linn & Wallach), *cert. granted sub nom. TC Heartland LLC v. Kraft Food Brands Grp. LLC*, No. 16-341, 2016 WL 4944616 (U.S. Dec. 14, 2016). The United States Code has long included a special provision for venue in intellectual property cases. Section 1400 (“Patents and copyrights, mask works, and designs”) of 28 U.S.C. provides that “[a]ny civil action for patent infringement may be brought in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business.” In *Fourco Glass Co. v. Transmirra Prods. Corp.*, 353 U.S. 222 (1957), the Supreme Court confirmed that for corporate defendants, the word “resides” meant only the state of incorporation; it held that 28 U.S.C. §1400(b) was “the sole and exclusive provision controlling venue in patent infringement actions, and . . . it is not to be supplemented by the provisions of 28 U.S.C. s 1391(c).” In 1990, however, the Federal Circuit in *VE Holding Corp. v. Johnson Gas Appliance Co.*, 917 F.2d 1574 (Fed. Cir. 1990) (Plager, J.), dramatically broadened patent venue by holding that for patent infringement suits against a corporation, the phrase “where the defendant resides” in the patent-specific venue statute, 28 U.S.C. §1400(b), had to be read in accordance with the much broader definition of residence provided for corporate defendants in the general federal venue statute, 28 U.S.C. §1391(c), as that statute was amended in 1988. When the Circuit decided *VE Holding* in 1990, §1391(c) provided that “[f]or purposes of venue under this chapter, a defendant that is a corporation shall be deemed to reside in any judicial district in which it is subject to personal jurisdiction at the time the action is commenced.” Thus, *VE Holding* effectively established patent infringement venue for an accused U.S. corporation in any forum in which it was subject to personal jurisdiction. In view of the Supreme Court’s unresolved “minimum contacts” precedent, corporations potentially may be deemed to reside in any federal judicial district in which their alleged infringing product can be purchased, for example, in a local retail outlet.

The venue expansion wrought by *VE Holdings* has undeniably made patent litigation a cottage industry for certain federal districts. Notably, some 43% of all patent infringement cases filed in the United States in 2015 were brought in a single federal district, the Eastern District of Texas. Continued criticism of the *VE Holdings* rule led to a closely-watched mandamus petition filed in 2015 by TC Heartland. In early 2014, Kraft Foods Group Brands LLC, a company organized and existing under Delaware law (and part of the Kraft food and beverage conglomerate), sued in the District of Delaware TC Heartland LLC, a limited liability company organized and existing under Indiana law and headquartered in Indiana. In response, TC Heartland filed a motion to dismiss or transfer the action to Indiana, essentially arguing for a return to pre-*VE Holdings* law. After the Delaware district court denied its motion, TC Heartland petitioned the Federal Circuit for a writ of mandamus. In its April 2016 order in *In re TC Heartland LLC*, 821 F.3d 1338 (Moore, J.), the appellate court denied the petition, stating that “[t]he arguments raised regarding venue have been firmly resolved by *VE Holding*, a settled precedent for over 25 years. . . . As a panel, we are bound by the prior decisions of this court.”

In December 2016, the Supreme Court granted TC Heartland’s subsequent petition for *certiorari*, which asserted that a “plague” of forum shopping has resulted by reason of the Federal Circuit’s departure in *VE Holding* from the Supreme Court’s *Fourco* holding. The Question

Presented is “[w]hether 28 U.S.C. § 1400(b) is the sole and exclusive provision governing venue in patent infringement actions and is not to be supplemented by 28 U.S.C. § 1391(c).” A *Wall Street Journal* article termed the *certiorari* grant in *TC Heartland* “welcome news for corporate defendants that long have lamented rules that allow patent claims against companies in almost any U.S. location.”

We believe strongly that the Supreme Court should restore patent venue law to its *Fourco* limits, that is, that a domestic corporate defendant should only be subject to suit for patent infringement in the state of its incorporation or in the state where it committed acts of infringement and has a regular and established place of business. No legislative history supports the view that Congress intended by its 1988 amendment of the general venue statute to override the patent-specific venue statute and the Supreme Court’s interpretation thereof in *Fourco* (or that Congress was even aware it was doing so). Moreover, a return to the *Fourco* limitation on venue for corporate defendants would undoubtedly staunch the rampant district court-level forum shopping that has ensued post-*VE Holdings*.

I. Our 2016 “Stinker” Award

1. *Apple Inc. v. Samsung Electronics Co., Ltd.*, 839 F.3d 1034 (Fed. Cir. Oct. 7, 2016) (*en banc*) (MOORE, Newman, Lourie, O’Malley, Wallach, Chen & Stoll; HUGHES, concurring in result without opinion; PROST, dissenting; DYK, dissenting; REYNA, dissenting). This case troubled us on a number of levels. As a due process matter, the case was re-decided *en banc* without any opportunity for additional briefing (or any public notice, for that matter). The *en banc* majority asserted that no additional briefing was necessary because the relevant law was clear (e.g., the majority stated that “[w]e did not take this case *en banc* to decide important legal questions about the inner workings of the law of obviousness”). If that is so, why did the case merit re-decision *en banc*?

On the merits, the *en banc* majority corrected firstly the panel majority’s claim construction, which it contended had improperly relied on extra-record extrinsic evidence to construe the claims in violation of *Teva*.

As to obviousness, the *en banc* majority faulted the panel for reversing, “across three patents,” “nearly a dozen jury fact findings, including infringement, motivation to combine, the teachings of prior art references, commercial success, industry praise, copying, and long-felt need.” The majority thus restored the jury’s no-obviousness verdicts. The three dissenting judges charged that the *en banc* majority had elevated the status of “secondary considerations” and made issues on the motivation to combine more fact-intensive. Making obviousness more factual could well impact the scope of Federal Circuit review of PTAB decisions in *inter partes* review (now the largest part of the court’s docket). On the merits, the obviousness challenges were hardly insubstantial. In one instance, the claimed solution to a problem (avoiding inadvertent activation of a touchscreen portable device) was a slide-to-unlock mechanism. One reference showed a portable device with a touchscreen; the other, a slide-to-unlock mechanism of a wall-mounted touchscreen.

Appendix

Complete List of 2016 Precedential Patent Cases (Federal Circuit and Supreme Court)

By Donald S. Chisum

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NOTE: This list collects, in chronological order, all the Supreme Court and precedential Federal Circuit decisions relating to patent law issued in calendar year 2016. There were about 150 such decisions. The list includes the author of the opinion and other judges (or justices) participating.

For each decision, there is a “quick fire” listing of concepts as a guide to the major issues the decision addresses.

The list is prepared as part of the process of updating the annual publication, Chisum, *Patent Law Digest*, and also the “Supreme Court Guide” volumes of the treatise *Chisum on Patents*.

January 8

Wi-Lan, Inc. v. Apple Inc., 811 F.3d 455 (Fed. Cir 2016) (REYNA, Wallach & Hughes)
Claim construction; order of steps; claim requiring randomizing data before combining data;
accused device: combine data before randomizing data
Doctrine of equivalents; mathematically identical results but different structure; expert testimony
that difference not insubstantial
Means-plus-function limitation
New, post-verdict claim construction to save validity
Jury verdict of invalidity for anticipation
District court JMOL of no invalidity based on improper new, narrowing reconstruction of claims
after jury verdict

January 8

Urbanski, *In re*, 809 F.3d 1237 (Fed. Cir. 2016) (LOURIE, Bryson & Chen)
Obviousness rejection affirmed
Method for making “enzymatic hydrolysate of a soy fiber”; two prior art references on making
fiber;
Board finding of motivation to modify first prior art reference process to shorten reaction time as
taught by second reference; substantial evidence
Claimed properties: “result-effective variables”
Prima facie case of obviousness not rebutted

Motivation to combine for desirable property even at expense of a benefit taught by a reference
No teaching away; modifying reference rendering it “inoperative” for reference’s purpose

January 13

Ethicon Endo-Surgery, Inc. v. Covidien LP, 812 F.3d 1023 (Fed. Cir. 2016) (DYK & Taranto; NEWMAN, dissenting)

Inter partes review

Same PTAB panel making both decision to institute and final decision; no statutory or constitutional violation; due process; combination of functions; agency power to delegate
Obviousness; combination of prior art elements; no synergism asserted; commercial success of challenger’s product; long-felt need; no nexus; success attributable to unclaimed features and feature in prior art

January 20

Mortgage Grader, Inc. v. First Choice Loan Services Inc., 811 F.3d 1314 (Fed. Cir. 2016) (STARK, district judge, O’Malley & Taranto)

Method for enabling borrower to shop for loan; Section 101 “abstract idea”

District court “Standing Patent Rules”; injecting Section 101 invalidity defense after dropping it;
Alice: giving merit to previously meritless defense

Addition of generic computer steps to fundamental economic practice

Summary judgment; expert declarations: not create fact issue precluding summary judgment on Section 101 invalidity

January 22

Lumen View Technology LLC v. Findthebest.com, Inc., 811 F.3d 479 (Fed. Cir. 2016) (LOURIE, Moore & Wallach)

Attorney fee award to accused infringer

Exceptionality finding affirmed; baseless suit

Amount of fees; lodestar approach; Enhancement of fees: *not* for deterrence of baseless litigation strategy or for expedited schedule lowering “lodestar” amount

January 22

Pfizer, Inc. v. Lee, 811 F.3d 466 (Fed. Cir. 2016) (O’MALLEY & Dyk; NEWMAN, dissenting)
Patent term adjustment

Delay (197 days) between first restriction requirement and corrected restriction requirement;
examiner failure to classify dependent claims

Section 132 notice requirement; first restriction sufficiently clear

January 29

Avid Technology, Inc. v. Harmonic, Inc., 812 F.3d 1040 (Fed. Cir. 2016) (TARANTO, Reyna & Stoll)

Claim construction; jury’s non-infringement verdict

Narrow construction of claim element: district court error in finding prosecution disclaimer; no

clear and unmistakable disclaimer

Erroneous instruction to jury; general verdict; no separate instruction on distinct grounds of infringement; patent owner entitled to new trial (but not judgment) on infringement of other elements even though accused infringer did not contest patent owner's contention that accused system satisfied element under broader construction

January 29

Akzo Nobel Coatings, Inc. v. Dow Chemical Company, 811 F.3d 1334 (Fed. Cir. 2016) (LOURIE, Reyna & Chen)

Claim construction

Indefiniteness; 'viscosity'; no temperature specified; extrinsic evidence: at room temperature when no temperature specified

Claim limitation on process 'carried out at a temperature'; failure to state explicitly which steps carried out; skilled artisan's understanding

Claims construed in light of specification, not rewritten to sustain validity

Summary judgment; no literal infringement

Doctrine of equivalents; no erroneous application of 'vitiation' or impermissible 'binary choice' analysis; no showing that differences insubstantial; expert declaration: too general

Claim construction

Summary judgment; no literal infringement

Doctrine of equivalents; no erroneous application of "vitiation" or impermissible "binary choice" analysis; no showing that differences insubstantial

Indefiniteness; "viscosity"; no temperature specified: implicitly at room temperature

Claim limitation on process "carried out at a temperature"; failure to state explicitly which steps carried out; skilled artisan's understanding

January 29

Agilent Technologies, Inc. v. Waters Technologies Corporation, 811 F.3d 1326 (Fed. Cir. 2016) (O'MALLEY, Moore & Taranto)

Inter partes reexamination

Successor to third-party requester: no right to appeal Board decision in favor of patent owner; failure to establish status as successor-in-interest

No appeal by mere "privy" of third-party requester

February 1

Purdue Pharma L.P. v. Epic Pharma, LLC., 811 F.3d 1345 (Feb. 1, 2016) (PROST, Reyna & Stark, district judge)

Hatch-Waxman Act suit; reformulated oxycodone

Invalidity; discovery of source of problem, *Eibel Process* (1923); obvious; claims: *not* to solution

Process limitation disregarded in determining patentability of product-by-process claim

Commercial success; nexus

Failure of others; long-felt need

Industry; surprise

Anticipation; inherency; no improper reassembly of embodiment from distinct sections of reference

Collateral estoppel; patent owner suits on patent against other accused infringers

February 2

Trustees of Columbia University in the City of New York v. Symantec Corp., 811 F.3d 1359 (Fed. Cir. 2016)(DYK, Prost & Hughes)

Claim construction

No “strong” presumption of plain meaning without express definition or disavowal

Explicit redefinition or disavowal: **not** required

Provisional applications incorporated by reference; support for claim construction

Indefiniteness: patent owner stipulation of indefiniteness under district court construction

February 5

TriReme Medical, LLC v. AngioScore, Inc., 812 F.3d 1010 (Fed. Cir. 2016) (DYK, Prost & Chen)

Inventorship suit; standing

Allegedly omitted inventor granting exclusive license to potential infringer

Consulting agreement; provisions on licensing prior inventions; assignment of inventions conceived or reduced to practice after effective date

February 5

TriVascular, Inc. v. Samuels, 812 F.3d 1056 (Fed. Cir. 2016) (O’MALLEY, Moore & Wallach)

Inter partes review

Claim construction; broadest reasonable construction: reasonable in light of specification and claim language; no “unfettered license”; PTAB proper rejection of petitioner’s unreasonably broad construction

Dictionary definition;

Prosecution history disclaimer; change of position by applicant and examiner after interview; case law on requirement of written documentation of examiner position

Obviousness

No inconsistency between institution decision and finding of no motivation to combine

Substantial evidence supporting PTAB findings Combining particular features of prior art references; violating objectives of inventions references disclosed

February 9

Rosebud LMS Inc. v. Adobe Systems Inc., 812 F.3d 1070 (Fed. Cir. 2016) (MOORE, Hughes & Stoll)

Preissuance royalties under Section 154(d); published application

Actual notice

Affirmative act of notification by patent applicant *not* required

Knowledge of related applications (e.g., grandparent): legally insufficient

February 10

TransWeb, LLC v. 3M Innovative Properties Co., 812 F.3d 1295 (Fed. Cir. 2016) (HUGHES, Wallach & Bryson)

Inequitable conduct

Walker Process antitrust violation

Oral testimony on invalidity; corroboration

“Definitional case of but-for materiality”

Intentional inaccurate disclosure

Attorney fees defending infringement as antitrust injury and basis for damages

February 10

Synopsys Inc. v. Mentor Graphics Corp., 814 F.3d 1309 (Fed. Cir. 2016) (DYK & Wallach; NEWMAN, dissenting)

Inter partes review; institution on fewer than all claims raised in petition; Section 318(a) final decision on any “challenged” claim; “challenged” as only claims for which review instituted

Claims not invalid for anticipation

PTAB requirement of expert testimony; complex technology

Anticipation; inherency: not mere possibility

Denial of motion to amend and substitute claims; *Proxycorm* and *Prolitec*: burden properly on patent owner

Section 315(b) time-bar on institution; petitioner acquisition of entity sued more than year before petition filed; PTAB determination of no privity: no reviewable by Federal Circuit

Newman, dissenting: AIA change in way validity disputes resolved as significant as creation of Federal Circuit

February 10

Synopsys, Inc. v. Lee, 812 F.3d 1076 (Fed. Cir. 2016) (DYK & Wallach; NEWMAN, dissenting)

District court suit under Administrative Procedure challenging PTO rule and PTAB practice on instituting and deciding review of fewer than all claims raised in petition for inter partes review

District court dismissal

Appeal moot in light of decision resolving issues in companion case on appeal from final decision

February 10

Convolve, Inc. v. Compaq Computer Corp., 812 F.2d 1313 (Fed. Cir. 2016) (HUGHES, Dyk & Taranto)

Claim construction; “user interface”

Intervening rights; claims amended during reexamination; amendment: not necessarily substantively change claim scope

Amendment adding “seek” to “acoustic noise” required by examiner giving claim broadest reasonable interpretation; in intervening rights analysis, claim construed under *Phillips* standard; claims, as originally drafted, limited to “seek” despite lack of express recitation; prior prosecution statements limiting original claim phrase

Phrase “a processor” *not* limited to single processor; indefinite article (“a” or “an”) in open-ended

claim with “comprising” transition meaning “one or more” absent clear contrary evidence

February 11

Nike, Inc. v. Adidas AG, 812 F.3d 1326 (Fed. Cir. 2016) (CHEN, Mayer & Stoll)

Inter partes review

Denial of motion to amend and substitute claims

Burden to show patentability of substitute claims

Obviousness; age of references; secondary considerations

Permissibility of multiple substitute claims; patentable distinction

Written description requirement; proposed substitute claims adequately supported by specification; negative limitation; distinction made in specification and in original claims

Error to deny substitute claims for failure to show patentability over “prior art not of record but known to the patent owner”; compliance with duty of candor (IPR Rule 11)

February 12

Lexmark International, Inc. v. Impression Products, Inc., 816 F.3d 721 (Fed. Cir.) (en banc) (TARANTO, Prost, Newman, Lourie, Moore, O'Malley, Reyna, Wallach, Chen, and Stoll; DYK & Hughes, dissenting)

Exhaustion

Sales outside the United States; absence of express reservation of U.S. rights implied license

Sales conditioned on single use

Supreme Court precedent; dictum in *Quanta* (2008)

Differences between copyright law and patent law; *Kirtsaeng* (2013) on international copyright exhaustion

February 16

Listmont v. Alexander Binzel Corp., 813 F.3d 998 (Fed. Cir. 2016) (CHEN, Lourie & Reyna)

Inventorship claim under Section 256

Laches; presumption: 10 years after patent issued; no rebuttal

Prior litigation of inventorship claim in foreign (German) courts; no notice of intent to pursue patent rights in the United States on completion of German litigation

February 19

Zoltek Corp. v. United States, 815 F.3d 1302 (Fed. Cir. 2016) (NEWMAN, Clevenger & Moore)

Third appeal in suit against United States for compensation for use of patented method of making carbon fiber sheets

Reissue claims; no written description violation; elimination from method claim+ of step of preparing starting material; broadening claim by eliminating requirement that step be performed by same entity

Obviousness: erroneous finding; expert’s reconstruction of patent’s figure illustrating discovery; hindsight

Bifurcation of validity issue; “state secret privilege”

February 19

Ohio Willow Wood Co. v. ALPS South, LLC, 813 F.3d 1350 (Fed. Cir. 2016) (BRYSON, Dyk & Wallach)

Inequitable conduct during second reexamination

Director of research as conduit between litigation counsel and reexamination counsel

Failure to disclose known evidence corroborating testimony on prior public sale after counsel's assertion to PTO Board that there was no corroborating evidence

Unenforceability not extended to related patents

Cross-appeal; finding of no inequitable conduct in first reexamination; not merely alternative ground for affirmance of judgment of unenforceability; larger attorney fee award (from date of first rather than second reexamination)

February 22

ACCO Brands Corp. v. Fellowes, Inc., 813 F.3d 1361 (Fed. Cir. 2016) (CHEN, Newman & Hughes)

Prima face obviousness concept; framework

Inter partes reexamination

Board error in reversing examiner finding of prima facie obviousness over prior art

KSR (2007): claimed configuration as one of two obvious configurations

Remand for consideration of rebuttal evidence; dependent claims

February 22

Nuance Communications, Inc. v. ABBYY USA Software House, Inc., 813 F.3d 1368 (Fed. Cir. 2016) (PROST, Dyk & Chen)

Claim construction; "identifying"; jury verdict of non-infringement

Patent owner initial proposal of "plain meaning"; after construction, proposed new construction

District court refusal to revisit construction; adoption of dictionary construction; no erroneous failure to construe claims, *O2 Micro*

Due process; assertion of multiple patents and claims; voluntary narrowing; noninfringement judgment against *all* patents; no second trial on unselected patents

February 22

PPC Broadband, Inc. v. Corning Optical Communications RF, LLC, 815 F.3d 734 (Fed. Cir. 2016) (MOORE, O'Malley & Wallach)

Inter partes view; PTAB obviousness determination; construction: "continuity" and "continuous"

Broadest reasonable construction rule: claim construction: outcome determinative

Construction: broader than *Phillips* but not unreasonable

Objective considerations; PTAB findings against long-felt need, copying, failures supported by substantive evidence

Commercial success: PTAB error in finding no nexus; presumption of nexus when claims cover product: not applicable in ex parte context but applicable in contested IPR

February 22

PPC Broadband, Inc. v. Corning Optical Communications RF, LLC, 815 F.3d 747 (Fed. Cir. 2016)

(MOORE, O'Malley & Wallach)

Inter partes review; PTAB obviousness determination;

PTAB construction of “reside *around*” as merely “near”: not reasonable; only reasonable construction: “surround” or “encircle”

Broadest reasonable interpretation standard: making easy case (under Phillips) closer

Dictionary definitions: broadest definition offered by party not necessarily reasonable

Construction covering most embodiments: not necessarily reasonable

February 26

Apple Inc. v. Samsung Electronics Co., Ltd., 2016 U.S. App. LEXIS 3432 (Fed. Cir. 2016) (DYK, Prost & Reyna), *vacated & reinstated in part*, 839 F.3d 1034 (Fed. Cir. 2016) (en banc)

Smartphones; validity and infringement of five Apple patents, two Samsung patents

Obviousness

En banc decision vacating panel and reinstating panel decision holding two Apple patents not infringed, one Samsung patent not infringed, and one Samsung patent infringed

Claim constructions urged by patent owner after trial; jury verdict based on plain and ordinary meaning

Means-plus-function clause; corresponding structure including software, not just hardware

February 29

Luminara Worldwide, LLC v. Liown Electronics Co., 814 F.3d 1343 (Fed. Cir. 2016) (MOORE, O'Malley & Taranto)

Preliminary injunction vacated

Standing; exclusive license; failure to join patent owner; licensee with all substantial rights; patent owner reservation of use by licensed affiliates

Preliminary claim construction; substantial question of invalidity for anticipation by prior art reference; disclaimer of ordinary meaning

February 29

Eon Corp. v. Silver Spring Networks, Inc., 815 F.3d 1314 (Fed. Cir. 2016) (PROST & Hughes; BRYSON, dissenting)

Claim construction; “portable” and “mobile”; overturning jury verdict of infringement

Failure to construe claims; improper delegation of construction to jury and experts, *O2*

No single plain and ordinary meaning; context of patent; specification

No infringement

BRYSON, dissenting: district court citation of two dictionary definitions that captured ordinary meaning

March 1

Blue Calypso, LLC v. Groupon, Inc., 815 F.3d 1331 (Fed. Cir. 2016) (CHEN & Reyna; SCHALL, dissenting)

Covered Business Method (CBM) Reviews; five patents

Peer-to-peer advertising system for mobile device

“Technological invention”; “subsidies”; financial assistance; conventional computer components
Written description; Board: undue emphasis on absence of exact claim terms from specification
Prior art; publication; public availability; report available as hyperlink on the personal webpage; no
evidence interested party could locate report with reasonable diligence; *Vote Verified* (2012);
published article: not adequate “roadmap” to report
Anticipation; all claim elements in prior; “arranged as in the claim”; ability to “at once envisage”
claimed invention; reference disclosing tools; contemplate that tools be used in combination
Schall, dissenting: reference at most showing system with multiple tools capable of functioning
together; no inherency or contemplation of combination; analysis only for obviousness, not
anticipation

March 1

Harmonic Inc. v. Avid Technology, Inc., 815 F.3d 1356 (Fed. Cir. 2016) (STOLL, Chen & Mayer)
Inter partes review
Obviousness; combination of references; petitioner failure provide evidence supporting conclusory
assertion that reference disclosed or suggested claim limitation
Board institution on subset of grounds in petition
Board refusal to revisit noninstituted “redundant” grounds of unpatentability of claim (based on
other references) after finding claim not unpatentable on instituted ground
No Federal Circuit jurisdiction to review institute decision
PTAB authority to institute on subset of grounds in petition

March 1

UltimatePointer, L.L.C. v. Nintendo Co., Ltd., 816 F.3d 816 (Fed. Cir. 2016) (LOURIE, Dyk &
Wallach)
Claim construction; “handheld device”; limited to direct pointing device; specification: repeatedly
extolling virtues of direct pointing; criticism of indirect pointing
Non-infringement; “sometimes” infringing arrangement; accused device: not infringe under *any*
arrangement
Indefiniteness; apparatus claims reciting capability, not activities of user

March 7

Queen’s University, *In re*, 820 F.3d 1287 (Fed. Cir. 2016) (O’MALLEY & Lourie; REYNA,
dissenting)
Communications privilege; non-attorney patent agents

March 9

Bamberg v. Dalvey, 815 F.3d 793 (Fed. Cir. 2016) (HUGHES, Moore & Stoll)
Interference
Broadest reasonable interpretation of claims
Written description; no “possession” of what described as undesirable

March 10

Smith, *In re*, 815 F.3d 816 (Fed. Cir. 2016) (STOLL, Moore & Hughes)
Section 101; patent-ineligible subject matter
Blackjack variation
Section 101; patent-ineligible subject matter
Abstract idea of rules for playing wagering game
Conventional steps (shuffling and dealing standard deck of cards)

March 10

Varma, *In re*, 816 F.3d 1352 (Fed. Cir. 2016) (TARANTO, Wallach & Clevenger)
Related reexaminations (one inter partes, one ex parte); reversing Board cancellation of claims
Claim construction errors; unreasonable interpretations in rejecting claims
Comprising
Indefinite article “a”; context
Principle that claim phrase as same meaning in all claims in same patent

March 14

Halo Creative & Design Limited v. Comptoir Des Indes Inc., 816 F.3d 1366 (Fed. Cir. 2016) (DYK, Mayer & Hughes)
Forum non conveniens
Suit by Hong Kong IP owner against Canadian company for violation of U.S. design patents, copyrights and trademarks
District court err in dismissing suit on ground that Canadian court was “far superior”
Enforceability of U.S. patent and copyright in Canadian court

March 15

Dell Inc. v. Accelaron, LLC, 818 F.3d 1293 (Fed. Cir. 2016) (TARANTO, Moore & Hughes)
Inter partes review
Anticipation
Claim construction error
Procedural error: relying on petitioner’s factual assertion raised only at oral argument
PTO Trial Practice Guide: no new evidence or arguments at oral argument

March 18

Acorda Therapeutics Inc. v. Mylan Pharmaceuticals Inc., 817 F.3d 755 (Fed. Cir. 2016) (TARANTO & Newman; O’MALLEY, concurring)
Specific personal jurisdiction in Delaware
Section 271(e)(1) suit against ANDA filer (large generic drug manufacturer) seeking approval to sell drugs throughout United States, including in Delaware; certification that patents not infringed or invalid
Due process clause; minimum contacts with a state
ANDA filings as reliable indicator of planned contact with Delaware
General personal jurisdiction based on registration to do business in a Delaware: not addressed

March 21

Cree, Inc., *In re*, 818 F.3d 694 (Fed. Cir. 2016) (BRYSON, Chen & Clevenger)
Cree, Inc., *In re*, 818 F.3d 694 (**March 21, 2016**) (BRYSON, Chen & Clevenger)
Ex parte reexamination; rejection for obviousness
Down-conversion to create white light with LED
Board: no improper to incorporate portions of Examiner's Answer
Substantial evidence; references disclosures; motivation to combine
No hindsight or burden-shifting
Secondary evidence
Industry praise; praising work of others; self-serving statements
Licensing; nexus not shown; broad cross licenses
Commercial success; conclusory assertion of nexus

March 23

MAG Aerospace Industries, Inc. v. B/E Aerospace, Inc., 816 F.3d 1374 (Fed. Cir. 2016) (PROST, Mayer & Reyna)
Assignor estoppel; bar to validity challenge; privity: inventor and former employee; hired by accused infringer to work on accused product
Summary judgment of noninfringement; claim: "toollessly" replaceable; no tool of any kind; negative limitation; not just conventional tool

March 23

Shaw Industries Group, Inc. v. Automated Creel Systems, Inc., 817 F.3d 1293 (Fed. Cir. 2016) (MOORE & Wallach; REYNA, concurring)
Inter partes review; appeal and writ of mandamus; petition on multiple grounds; institution on only some grounds; some grounds: denied as "redundant"
Decision institute on some but not other grounds for claims: not reviewable with final decision; benefit in PTO institution on only some grounds; "redundancy": choice not to review for efficiency reasons
Mandamus: no other means of review? potential estoppel? Section 315(e) estoppel: only grounds that could be raised *during* IPR; plain language of statute
Second petition for IPR; more than year after service of complaint in infringement suit); institution on some grounds, remaining grounds: "redundant"; no Section 315(b) time-bar because suit voluntarily dismissed
Decision to institute; Section 315(b) bar: not reviewable; issue before Supreme Court in *Cuozzo*
REYNA, concurring: concerns about "Redundancy Doctrine"; "profound" effects of estoppel

March 31

Clare v. Chrysler Group LLC, 819 F.3d 1323 (Fed. Cir. 2016) (MOORE, Prost & Wallach)
Summary judgment of non-infringement affirmed
"External" and "appearance"; no error to construe; not "readily apparent to layperson";
fundamental dispute, *O2 Micro*

“Substantially”; claim differentiation: not as strong across related patents
Excluding embodiment

March 31

Romag Fasteners, Inc. v. Fossil, Inc., 817 F.3d 782(Fed. Cir. 2016) (DYK, Wallach & Hughes)
Laches

District court: reduce jury damages by 18%; period of deliberate delay in suing for patent and trademark infringement (until “Black Friday”)

Infringer profits recovery for trademark infringement; willfulness

March 31

ClearCorrect Operating, LLC v. International Trade Commission, 819 F.3d 1334 (Fed. Cir. 2016) (en banc) (PROST & O’Malley, concurring in denial of rehearing en banc; NEWMAN, dissenting from denial of rehearing en banc)

ClearCorrect Operating, LLC v. International Trade Commission, 819 F.3d 1334 (**March 31, 2016**) (en banc) (PROST & O’Malley, concurring in denial of rehearing en banc; NEWMAN, dissenting from denial of rehearing en banc)

Electronic transmission; not an “article”; ITC jurisdiction; *Suprema* distinguished

Denial of rehearing en banc (see 810 F.3d 1283 (Fed. Cir. 2015))

April 1

Simpleair, Inc. v. Sony Ericsson Mobile Communications AB, 820 F.3d 419 (Fed. Cir. 2016) (WALLACH, Moore & Reyna)

Simpleair, Inc. v. Sony Ericsson Mobile Communications AB, 820 F.3d 419 (**April 1, 2016**) (WALLACH, Moore & Reyna)

Jury verdict; patent claims not invalid and infringed by Google “Cloud”; \$85 million damages

Claim construction error; “data channel”; no infringement

Construction reading “some portion of claim language superfluous” to be avoided: not “inflexible rule”

No indefiniteness

April 1

Microsoft Corp. v. GeoTag, Inc., 817 F.3d 1305 (Fed. Cir. 2016) (WALLACH, Lourie & Stoll)

Declaratory judgment suit; response to patent owner’s 10 suits against 300+ entities using

Microsoft and Google (“AdWords” system) “store locator services”

Federal Circuit, not regional circuit law, applicable to jurisdiction question

Retention of jurisdiction over infringement counterclaims

Claim construction; noninfringement; “dynamic replication”; “hierarchy of geographic areas”

April 5

HP Inc. v. MPHJ Technology Investments, LLC, 817 F.3d 1339 (Fed. Cir. 2016) (LOURIE, Schall & Hughes)

Inter partes review

Board decision that patent claims anticipated except claim 13 not anticipated
Decision not to institute review of claim 13 on obviousness grounds; redundant; not reviewable
Failure to give reasons for redundancy determination
Estoppel: noninstituted grounds not part of IPR

April 5

Pride Mobility Products Corp. v. Permobil, Inc., 818 F.3d 1307 (Fed. Cir. 2016) (TARANTO, Reyna & Chen)
Inter partes review; wheelchairs traveling over obstacles
Board cancels all claims as obvious
Reversal of one claim; claim construction; “oriented perpendicular”; ordinary geometry meaning; axis: *not* “perpendicular” to three dimensional object
Affirm as to other claims; motivation to make claimed combination; combination creating instability problem; crediting petitioner’s expert that skilled artisan would have known of various ways to compensate

April 5

Cardpool, Inc. v. Plastic Jungle, Inc., 817 F.3d 1316 (Fed. Cir. 2016) (NEWMAN, Reyna & Wallach)
Cardpool, Inc. v. Plastic Jungle, Inc., 817 F.3d 1316 (**April 5, 2016**) (NEWMAN, Reyna & Wallach)
Claims held invalid; claims replaced during reexamination; accused infringer no longer in the business
Denial of vacatur
Judgment: not automatically res judicata against new claims; Aspex: effect depends on facts and issue during reexamination

April 5

High Point SARL v. Sprint Nextel Corp., 817 F.3d 1325 (Fed. Cir. 2016) (REYNA, Mayer & Chen)
Equitable estoppel
Patent owner’s predecessor helped accused infringer build network “through licensed and unlicensed activity for over a decade”
Laches: not addressed

April 7

Rembrandt Vision Technologies, L.P. v. Johnson & Johnson Vision Care, Inc., 818 F.3d 1320 (Fed. Cir. 2016) (STOLL & Moore; DYK, dissenting)
New trial
False testimony by expert witness

April 8

Genetic Technologies Limited v. Merial L.L.C., 818 F.3d 1369 (Fed. Cir. 2016) (DYK, Prost & Taranto)

Methods of detecting genetic variations
Section 101; ineligible subject matter; following *Mayo* and *Ariosa*
Rule 12(b)(6) motion (failure to state claim)
Novelty and utility: insufficient “inventive concept”

April 19

Man Machine Interface Technologies LLC, *In re*, 822 F.3d 1282 (Fed. Cir. 2016) (STOLL, Lourie & O’Malley)

Ex parte reexamination; rejections for anticipation and obviousness
Broadest reasonable interpretation; reasonableness in light of specification; no coverage of subject matter expressly distinguished
“Adapted to” as having either narrow meaning (“made to”) or broad meaning (“capable of”)
Adapted to be activated by human hand; switch activated by human thumb

April 19

Sport Dimension, Inc. v. Coleman Co., 820 F.3d 1316 (Fed. Cir. 2016) (STOLL, Moore & Hughes)

Design patent; personal flotation device
Stipulated judgment of noninfringement; claim construction
Verbal description; distinguishing ornamental and functional features
Error to “entirely eliminate a structural element from the claimed ornamental design, even though that element also served a functional purpose”
Exclusion of accused infringer’s “expert” witness; “industrial design consultant”; no experience in field of personal flotation devices; testimony on alternative designs and functionality

April 22

Mankes v. Vivid Seats Ltd., 813 F.3d 998 (Fed. Cir. 2016) (TARANTO, Schall & Chen)

Divided infringement; direct infringement
Judgment on pleadings against patent owner under then-existing “tighter restraints” on attributing to accused infringer another entity’s activities
Remand to apply new *Akamai* (2015) standards relaxing attribution requirements
Pleading “ongoing interactive commercial relationship”; plausible establishment of *Akamai* standard for “conditions participation”
Amendment to complaint at early stage of case
Attorney fees; prevailing party; patent owner reasonably seeking change in the law

April 26

South Alabama Medical Science Foundation v. Gnosis S.P.A., 818 F.3d 1380 (Fed. Cir. 2016) (en banc) (O’MALLEY, Wallach & Stoll, concurring in denial of rehearing en banc; NEWMAN, dissenting from denial of rehearing en banc)

Inter partes review
Substantial evidence standard for reviewing PTAB findings
PTAB obvious conclusion affirmed despite error in finding no nexus as to patent owner’s licensing

evidence

April 26

Merck & Cie v. Gnosis S.p.A., 820 F.3d 432 (Fed. Cir. 2016) (en banc) (O'MALLEY, Wallach & Stoll, concurring in denial of rehearing en banc; NEWMAN, dissenting from denial of rehearing en banc)

Inter partes review

Substantial evidence standard for reviewing PTAB findings; standard set in *Zurko* and not altered by Congress for IPRs

April 29

TC Heartland, *In re*, 821 F.3d 1338 (Fed. Cir. 2016) (MOORE, Linn & Wallach)

Venue

Personal jurisdiction

May 9

Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd., 821 F.3d 1359 (Fed. Cir. 2016) (O'MALLEY, Wallach & Hughes)

Inter partes review

PTAB no obviousness decision affirmed

PTAB error in relying on absence of reasonable expectation of success; expectation pertaining to claimed invention

Motivation to combine; petitioner failure to provide support

Improper reply brief and expert declaration; "new theory of invalidity"; different rationale for motivation to combine

May 12

Enfish, LLC v. Microsoft Corp., 822 F.3d 1327 (Fed. Cir. 2016) (HUGHES, Moore & Taranto)

Section 101; claims not drawn to abstract ideas

Improvement in computer-related technology; software: *not* inherently abstract

Improvement not defined by 'physical' features

Indefiniteness; means-plus-function element; sufficient algorithm

Anticipation (Section 102); inappropriately broad reading of claim

'A' logical table: single table; *not* 'one or more'

Estoppel for inter partes review? *not* addressed

Infringement; corresponding structure for means-plus-function clause; single embodiment in specification: separate figure showing intermediate stage, not alternative embodiment; no equivalent in accused product

May 13

Merck & Cie v. Watson Laboratories, Inc., 822 F.3d 1347 (Fed. Cir. 2016) (MAYER, Dyk & Hughes)

On-sale bar (Section 102(b))

Joint venture to market drug
Commercial offer
Confidentiality

May 16

Intendis GmbH v. Glenmark Pharmaceuticals Inc., 822 F.3d 1355 (Fed. Cir. 2016) (MOORE, Prost & Taranto)

Pharmaceutical compositions

Infringement under doctrine of equivalents; ensnarement of prior art; disavowal

Function prong of function, way, result test for equivalents; determination of function not limited to intrinsic evidence and patent's disclosure

Prosecution history estoppel; argument-based estoppel

Obviousness; no motivation to combine

May 17

Diamond Coating Technologies, LLC v. Hyundai Motor America, 823 F.3d 615 (Fed. Cir. 2016) (WALLACH, Bryson & Taranto)

Standing to sue for infringement; agreement between original assignee and plaintiff not sufficient to confer "patentee status"

Nunc pro tunc agreements after district court no-standing decisions: not effective

May 17

TLI Communications LLC Patent Litigation, In re, 823 F.3d 607 (Fed. Cir. 2016) (HUGHES, Dyk & Schall)

Section 101; abstract idea; failure to claim patent-eligible subject matter

Method and system for taking, transmitting, and organizing digital images

Enfish (2016) distinguished; no improvement to computer functionality

"Abstract functional descriptions devoid of technical explanation"

May 25

Aqua Products, Inc., 823 F.3d 1369 (Fed. Cir. 2016) (REYNA, Prost & Stark (district judge))

PTAB denial of motion to substitute claims; patent owner failure to demonstrate patentability over art of record

No obligation to address objective indicia or new limitations in substitute claims when patent owner failed to argue that the indicia or limitations distinguished proposed substitute claims over PTAB cited combination of prior art references

May 26

Profectus Technology LLC v. Huawei Technologies Co., 823 F.3d 1375 (Fed. Cir. 2016) (REYNA & Wallach; MOORE, dissenting)

Claim construction; summary judgment of non-infringement

"Mountable"; not just capable of being mounted; specification

Extrinsic evidence, including dictionaries: less significant; unlike *Thorner*, no erroneous importation of term of degree

Communications ports on computer tablets: not mountable

May 27

David Netzer Consulting Engineer LLC v. Shell Oil Co., 824 F.3d 989 (Fed. Cir. 2016) (LOURIE, Prost & Taranto)

Standing to sue; name change of patent-owning entity

Summary judgment of non-infringement

Claim construction; “fractionating”; separating components, not extraction

Specification: clear disclaimer of conventional extraction; “present invention”

“Comprising”

Doctrine of equivalents: disclaimer for literal infringement equally applicable to equivalents

May 27

Arunachalam, *In re*, 824 F.3d 987 (Fed. Cir. 2016) (HUGHES, Taranto & Chen)

Non-final appeal from PTAB decision designating new ground of rejection; examiner final rejection in reopened prosecution

No jurisdiction

May 31

Ruckus Wireless, Inc. v. Innovative Wireless Solutions, LLC, 824 F.3d 999 (Fed. Cir. 2016) (REYNA & Prost; STARK, dissenting (district judge))

Non-infringement

“Campaign against hotels and coffees shops” providing WiFi internet access using off-the-shelf WiFi equipment

Collision avoid; “communications path”

Limitation to wired rather than wireless communication

“Canons” of claim construction; use of patent’s title

Ambiguous claim; construction to preserve validity; written description problem: no mention of wireless communication in specification

District court: technology tutorial with expert testimony; reliance only on intrinsic evidence; de novo review

June 3

Warsaw Orthopedic, Inc. v. NuVasive, Inc., 824 F.3d 1344 (Fed. Cir. 2016) (DYK & Lourie; REYNA, concurring)

Active inducement; knowledge of infringement; jury verdict

Infringer’s asserted claim construction: contrary to clear language of claim

Supreme Court remand for reconsideration in light of *Commil* (2015)

June 6

Indacon, Inc. v. Facebook, Inc., 824 F.3d 1352 (Fed. Cir. 2016) (STOLL, Newman & Reyna)

Claim construction; stipulation of non-infringement

Method of search and indexing files in database; “alias,” “custom link”, “custom linking relationship,” “link term”

“Alias” limited to textual expression, not graphical

Link terms: no plain meaning: therefore, no construction broader than disclosure in specification; limited to allowing each instance of link term to be identified and displayed as link

Claim differentiation: no application to independent claims not otherwise identical in scope

June 10

SAS Institute, Inc. v. ComplementSoft, LCC, 825 F.3d 1341 (Fed. Cir. 2016) (STOLL & Chen; NEWMAN, concurring-in-part & dissenting-in-part)

Inter partes review

PTAB changing and narrowing in final decision a claim construction adopted in its institution decision; petitioner’s rights under Administrative Procedure Act to notify and opportunity to respond

Broadest reasonable interpretation: narrow interpretation of claim phrased based on express definition in patent specification of similar phrase used interchangeably

No need for PTAB to address in final decision claims for which IPR not instituted

June 13

Halo Electronics, Inc. v. Pulse Electronics, 136 S. Ct. 1923 (2016) (ROBERTS for unanimous Court; BREYER, Kennedy & Alito, concurring)

Enhancement of damages (Section 284); district court discretion; limitation to “egregious” infringement

Improper Federal Circuit *Seagate* two-part test requiring objective recklessness

Burden of proof: preponderance of evidence, not clear and convincing evidence

Appellate review: abuse of discretion

Willfulness of infringement: time of conduct

1952 Act and AIA reenactment of Section 284: no change in standard set by 180 years of Supreme Court precedent

June 14

Genzyme Therapeutic Products Limited Partnership v. Biomarin Pharmaceutical Inc., 825 F.3d 1360 (Fed. Cir. 2016) (BRYSON, Moore & Reyna)

Inter partes review; obviousness

APA notice and opportunity to respond; PTAB reliance in final decision on facts and arguments not in institution decision; no “changing theories in midstream”; same combinations of references

New evidence during trial permissible

Claim construction: no change between institution and final decisions

Failure to make explicit finding on level of skill: parties’ nearly identical proposals

Reasonable expectation of success

June 15

Allied Erecting & Dismantling Co., Inc. v. Genesis Attachments, LLC, 825 F.3d 1373 (Fed. Cir. 2016) (WALLACH, Newman & Dyk)
Inter partes reexamination; obviousness
Motivation to combine; teaching away

June 16

Kirtsaeng v. John Wiley & Sons, Inc., 133 S. Ct. 1351 (2016) (KAGAN for a unanimous Court)
Copyright; attorney fees to prevailing party
Discretion to award fees even if losing party advanced reasonable claim or defense

June 20

Cuozzo Speed Technologies, LLC v. Lee, 136 S. Ct. 2131 (2016) (BREYER for unanimous Court (Parts I and III) and with Roberts, Kennedy, Thomas, Ginsburg & Kagan (Part II), THOMAS, concurring, ALIOTO & Sotomayor, concurring in part and dissenting in part)
Broadest reasonable construction (BRC) in inter partes review (IPR; BRC as protecting the public PTO authority to adopt regulations governing inter partes review; Chevron deference;
Section 314(d) ban on appeals of IPR institution decision: not limited to barring interlocutory appeals

June 21

Immersion Corp. v. HTC Corp., 826 F.3d 1357 (Fed. Cir. 2016) (TARANTO, Prost & Linn)
Effective filing date; avoiding Section 102(b) bar by publication of PCT counterpart application more than one year before continuation's filing date
Section 120 requirement of filing subsequent application "before the patenting" of an earlier application
Reliance on consistent PTO position that "copending" means filing subsequent application on same day or before as patenting of prior application
10,000 patents jeopardized

June 22

Ethicon Endo-Surgery, Inc. v. Covidien LP, 826 F.3d 1366 (Fed. Cir. 2016) (en banc)
(NEWMAN, dissenting from denial of rehearing en banc)
Inter partes review
Board making both decision to institute and final decision
Denial of rehearing en banc

June 27

Bascom Global Internet Services, Inc. v. AT&T Mobility LLC, 827 F.3d 1341 (Fed. Cir. 2016)
(CHEN & O'Malley; NEWMAN, concurring)
Section 101; filtering Internet content; controlling end-user access to websites
Error to dismiss complaint for failure to state claim; claim limitations construed in patent owner's favor as for specific improvement in an existing technological process
Abstract idea under *Alice* test's first step; claim preamble describing abstract idea (filtering

content); filtering content as well-known human activity; filtering on Internet: still abstract
Allegation that claims contained “inventive concept” in “ordered combination of limitations”:
sufficient to satisfy *Alice* test’s second step
Specific filtering method as technical solution to problems with prior art Internet content filtering
systems

July 5

Rapid Litigation Management Ltd. v. CellzDirect, Inc., 827 F.3d 1042 (Fed. Cir. 2016) (PROST,
Moore & Stoll)

Section 101; law of nature

First discovery of ability of hepatocytes to withstand multiple freezing

Claims using natural law to improve existing “cryopreservation” process to make new and useful
improved product

Claims: *not* ineligible; improvement to existing technological process; *Mayo* (2012) and *Ariosa*
(2015) distinguished

Mayo/Alice step one: “directed to” ineligible concept, not merely “involving” concept

Contrary ruling as threat to “thousands” of claims to methods of producing products

Step two: combination of individually known steps (repeating known freeze/thaw cycle)

Obviousness once natural law discovered: *not* the standard; claims previously found unobvious
because prior art taught away from multiple freezing

July 5

Amgen, Inc. v. Apotex Inc., 827 F.3d 1052 (Fed. Cir. 2016) (TARANTO, Wallach & Bryson)
Biologics Price Competition and Innovation Act of 2009

Preliminary injunction

July 11

Medicines Company v. Hospira, Inc., 827 F.3d 1363 (Fed. Cir. 2016) (en banc) (O’MALLEY,
Prost, Newman, Lourie, Dyk, Moore, Reyna, Wallach, Taranto, Chen, Hughes, and Stoll)

On sale bar; Section 102(b)

Supplier manufacturing embodiments (batches of drug) for inventor; sale of services, not
embodiments; inventor retention of title; confidentiality

Commercial sale under Uniform Commercial Code

Commercial benefit; stockpiling *not*, as such, commercial marketing

Outsourced manufacturing not distinguishable from in-house manufacturing

Product-by-process claims: for validity, claims cover product

Experimental use doctrine: not addressed; experimentation after reduction to practice

America Invents Act amendment to Section 102

July 15

SkyHawke Technologies, Inc. v. Deca International Corp., 828 F.3d 1373 (Fed. Cir. 2016)
(HUGHES, Taranto & Chen)

Inter partes reexamination
Prevailing patent owner appeals claim construction
No jurisdiction

July 19

WBIP, LLC v. Kohler Co., 829 F.3d 1317 (Fed. Cir. 2016) (MOORE, O'Malley & Chen)
Objective considerations: overcoming “strong” prima facie case
Nexus, presumption; fact-dependent
Long-felt need; praise, skepticism, copying, commercial success
Written description
Willful infringement determination affirmed (post-Halo); fact issue for jury
Denial of permanent injunction remanded

July 20

Polar Electro Oy v. Suunto Oy, 829 F.3d 1343 (Fed. Cir. 2016) (LOURIE, Newman & Chen)
Swedish patentee suing Swedish accused infringer
No personal jurisdiction in Delaware; insufficient contacts
Activities of U.S. distributor

July 22

Unwired Planet, LLC v. Apple Inc., 829 F.3d 1353 (Fed. Cir. 2016) (MOORE, Bryson & Reyna)
Claim construction; ordinary meaning; no disclaimer in “summary of the invention”
Active inducement; willful blindness

July 25

In re Magnum Oil Tools International, Ltd., 829 F.3d 1364 (Fed. Cir. 2016) (O'MALLEY, Newman & Chen)
Inter partes review; burden of proof; no shifting of burden of production of evidence on obviousness to patent owner after PTAB institutes review based on petitioner's reasonable likelihood of success
Petition alleging a *first* contention based on a first primary reference and a *second* contention based on a second primary reference
Improper attempt to incorporate by reference arguments and evidence on first contention into second contention; references different in relation to claimed invention
PTAB statements on obviousness and burden of proof made in *institution* decision: reviewable on appeal from *final* decision
PTAB adoption of obviousness theory petitioner could have (but did not) include in petition; *Cuozzo* (2016); IPR procedure based on arguments and evidence advanced by one party with opportunity for other party to respond

July 26

Verinata Health, Inc. v. Ariosa Diagnostics, Inc., 830 F.3d 1335 (Fed. Cir. 2016) (REYNA, Clevenger & Wallach)

Arbitration agreement in supply agreement
Counterclaim for breach of contract in patent infringement suit: not subject to compulsory arbitration

July 28

Advanced Ground Information Systems, Inc. v. Life360, Inc., 830 F.3d 1341 (Fed. Cir. 2016) (WALLACH, Moore & Mayer)
Means-plus-function; invalidity for indefiniteness
“Symbol generator” evoking Section 112/6
No algorithm sufficiently disclosed

August 1

GPNE Corp. v. Apple Inc., 830 F.3d 1365 (Fed. Cir. 2016) (PROST, Taranto & Chen)
Jury verdict of noninfringement (but no invalidity) affirmed
Claim construction; paging system; “nodes” construed as “pager”
No error by allowing jury to construe claims, *O2 Micro* (2008)
Claim differentiation
“Present invention” characterization limiting claim scope

August 1

Electric Power Group, LLC v. Alstom S.A., 830 F.3d 1350 (Fed. Cir. 2016) (TARANTO, Bryson & Stoll)
Section 101; abstract idea; claims not patent-eligible
Collecting, analyzing and displaying data on monitoring electrical power grid
Defining “desirable information-based result”; no limitation to technical means for performing function that advanced “conventional computer and network technology”
“Information”: intangible; mental steps
Enfish (2016) and *DDR Holdings* (2014) distinguished
“Result-focused, functional” claim language

August 1

Murata Mach. USA, Inc. v. Daifuku Co, 830 F.3d 1357 (Fed. Cir. 2016) (STOLL, Reyna & Chen)
Stay pending inter partes review
Denial of motions to lift stay and for preliminary injunction
Interlocutory jurisdiction over appeal; denial of injunction appealable; pendent jurisdiction over stay refusal
No error on stay; three-factor test for stays; four-factor variant in CBM statute; “burden of litigation”
Error by cursory denial of preliminary injunction

August 1

Wi-Lan USA, Inc. v. Apple Inc., 811 F.3d 455 (Fed. Cir. 2016) (CHEN, Lourie & Bryson)
Summary judgment of noninfringement

Claim construction

Patent owner's "late stage" new claim construction argument; no waiver

No error in two constructions: "specified connection" and "UL connections"

Teva standard of review: applicable even when construction resolved in summary judgment rather than *Markman* claim construction

Consistent use in specification

Prosecution history: representations about claim language to avoid prior art

Claim differentiation argument: not "strong enough"

August 4

Multilayer Stretch Cling Film Holdings, Inc. v. Berry Plastics Corp., 831 F.3d 1350 (Fed. Cir. 2016) (DYK & Plager; TARANTO, dissenting-in-part)

Claim construction

Markush group listing four resins; only one of listed resins; coverage of blends and mixtures
"Consisting of"

Rendering dependent claims meaningless

Rule 11 sanctions denied

Dependent claim contradicting independent claim: invalid under Section 112/4 (112(d))

August 5

Halo Electronics., Inc. v. Pulse Electronics., Inc., 831 F.3d 1369 (Fed. Cir. 2016), on remand from, 136 S. Ct. 1923 (2016)

Case reopened after Supreme Court remand

Remand to district court; discretion to increase damages; unchallenged jury verdict of willful infringement

"Sale" and "offer for sale" "in the United States"; extraterritoriality; prior decision reaffirmed

Summary judgment of noninfringement by products made and delivered outside United States

Direct infringement: products delivered in U.S.; inducement: products delivered outside U.S. but ultimately imported into U.S. in finished end products

Obviousness; all claim limitations in prior art; jury verdict of no obviousness; failure to file Rule 50(a) motion: waiver of right to challenge jury's implicit factual findings

August 9

In re Warsaw Orthopedic, Inc., 832 F.3d 1327(Fed. Cir. 2016) (WALLACH, Prost & Bryson)

Inter partes review; claims invalid for obviousness; affirm in part, reversal and remand in part

Petitioner withdrawal from appeal; PTO defense of PTAB decision

Prior art reference need not teach claim limitations "exactly"; teaching away? no elevating one aspect of reference over another

Motivation to combine

PTAB: insufficient explanation of reasoning why reference disclosed limitation; remand "for additional explanation"

August 9

DONE

In re CSB-System International, Inc., 832 F.3d 1335 (Fed. Cir. 2016) (STOLL, Newman & Moore)

Ex parte reexamination

Patent expiring during reexamination (after examiner rejection and pending appeal to PTAB; *Phillips* standard for claim construction, not broadest reasonable construction

PTAB construction: correct even under *Phillips* standard; rejection of claims over prior art affirmed

‘Personal computer’: not limited to computers running software to emulate terminals

‘LAN server’: plain meaning

August 10

Arendi S.A.R.L. v. Apple Inc., 832 F.3d 1355 (Fed. Cir. 2016) (O’MALLEY, Moore & Linn)

Inter partes review

Impermissible use of “common sense in an obviousness analysis”

Consider common sense; three caveats

Provide motivation to combine, not missing claim limitation

Simple limitation, straightforward technology

No wholesale substitute for reasoned analysis

August 10

Vapor Point LLC v. Moorhead, 832 F.3d 1343 (Fed. Cir. 2016) (PER CURIAM, O’Malley, Chen & Stoll; O’MALLEY, concurring)

Section 256 inventorship correction

Contribution to one aspect of one claim sufficient to require joinder of inventor

Contribution to one claim

Former employer-inventor obligation to assign inventorship interests; assertion as equitable affirmative defense to state law claims: not addressed; waiver: patent owner concession that resolution of inventorship correction against it was “dispositive” of patent infringement claim

Case not “exceptional” for attorney fee purposes

O’MALLEY, concurring: no assignment of patents without writing; implied-in-fact” contract theory in *Teets* (1996): impermissible exception to statutory requirement of writing; distinguish equitable defense and title (“hired-to-invent” and “shop right”) from assignment conferring standing to sue for infringement

August 12

In re Aqua Products, Inc., 833 F.3d 1335 (Fed. Cir. 2016), *granting rehearing en banc & vacating* 807 F.3d 1369 (Fed. Cir. 2016) (Fed. Cir. 2016) (En Banc Order)

Inter partes review; motions to amend claim under Section 316(d)

Placing burden of persuasion or production on patentability of amended claim on patent owner; violation of Section 316(e)?

PTAB raising sua sponte patentability challenge to amended claim absent challenge by petitioner

August 15

ScriptPro, LLC v. Innovation Associates, Inc., 833 F.3d 1336 (Fed. Cir. 2016) (MOORE, Taranto & Hughes)

Written description requirement

Summary judgment of invalidity reversed

Original claims part of specification

August 26

Liberty Ammunition, Inc. v. United States, 835 F.3d 1388 (Fed. Cir. 2016) (STOLL & Prost, NEWMAN, concurring-in-part & dissenting-in-part)

Section 1498(a) suit against U.S. in Court of Federal Claims

Claim construction errors

Term of degree; avoiding claim construction rendering claim indefinite; “reduced area of contact”; baseline for reduction provided by specification; reduced compared to “conventional” items, meaning those meeting standard as of patent’s filing date

“Including” and “comprising”; open-ended end term not permitting abrogation of claim limitation

Nondisclosure agreement (NDA): government official signing NDA lacked authority

August 30

Veritas Technologies LLC v. Veeam Software Corp., 835 F.3d 1406 (Fed. Cir. 2016) (TARANTO, Lourie & O’Malley)

Inter partes review

Claim construction affirmed; broadest reasonable interpretation (BRI); obviousness of challenged claims

Denial of conditional amendment for substitute claims: PTAB insistence that patent owner separately discuss whether each newly added feature was “separately known in prior art” and that patent owner’s discussion of an added feature in combination with other known features was *not* sufficient; unreasonable and arbitrary (regardless of outcome of pending en banc *Aqua* appeal on burden of proof with claim amendments in IPR)

September 8

UCB, Inc. v. Yeda Research & Development Co., Ltd., 837 F.3d 1256 (Fed. Cir. 2016) (NEWMAN, Lourie & Chen)

Non-infringement; summary judgment; claim construction

Prosecution history estoppel; arguments without amendments

Claims reciting “monoclonal antibodies”; not infringed by chimeric or humanized antibodies

September 8

Asia Vital Components Co., Ltd. v. Asetek Danmark A/S, 837 F.3d 1249 (Fed. Cir. 2016) (PROST, Linn & Taranto)

Declaratory judgment jurisdiction

Substantial controversy; demand letter indicating intent to enforce patent

September 12

Dynamic 3D Geosolutions LLC v. Schlumberger Limited, 837 F.3d 1280 (Fed. Cir. 2016) (LOURIE & Hughes; WALLACH, concurring)

Disqualification of counsel

Dismissal of infringement complaint without prejudice

September 12

Stryker Corp. v. Zimmer, Inc., 837 F.3d 1268 (Fed. Cir. 2016) (PROST, Newman & Hughes)

On remand from Supreme Court; willful infringement; jury verdict of willfulness affirmed; remand district court decision to treble damages; discretion to enhance

Attorney fees

Claim construction; disclaimer on limitation in narrow claim: applicable to same limitation in broader claim

Substantial evidence supporting jury infringement verdict; summary judgment on infringement

Jury verdicts of no anticipation or obviousness

Marking with different patent number: not sufficient

September 13

McRO, Inc. v. Bandai Namco Games America Inc., 837 F.3d 1299 (Fed. Cir. 2016) (REYNA, Taranto & Stoll)

Section 101; claims *not* directed to abstract idea

Consideration of specific claim limitations during both *Alice* step one and *Alice* step two

Claims to method of automatically animating lip synchronization and facial expression of animated characters; “ordered combination of claimed steps using unconventional rules”

Tangibility

Claims to genus; rules defined by characteristics

September 16

Wi-Fi One, LLC v. Broadcom Corp., 837 F.3d 1329 (Fed. Cir. 2016) (BRYSON & Dyk; REYNA, concurring)

Inter partes review

PTAB finding that petitioner not in privity with “time-barred district court litigant (Section 315(b)); *Achates* (2015) holding that decision not reviewable because of Section 314(d) *not* undermined by Supreme Court’s *Cuozzo*

Claims properly construed; anticipation by prior art reference

REYNA, concurring; petitioner not in privity with litigants; Section 315(b) reviewable as per *Cuozzo*

September 16

LifeNet Health v. Lifecell Corp., 837 F.3d 1316 (Fed. Cir. 2016) (PROST, Reyna & Chen)

Jury verdict: patent infringed and not invalid; damages: affirmed \$34 million

Claim construction: improperly submitted to jury? failure to object to instructions; factual finding by jury

Divided infringement; limitation met without action by third party
Indefiniteness: no coverage of both apparatus and method

Anticipation and obviousness; “classical factual dispute” on what reference disclosed; for jury resolution

September 20

Yeda Research & Development Co. v. Abbott GMBH & Co., 837 F.3d 1341 (Fed. Cir. 2016)
(REYNA, Wallach & Hughes)
Written description requirement
Inherent disclosure

September 21

WesternGeco L.L.C. v. ION Geophysical Corp., 837 F.3d 1358 (Fed. Cir. 2016) (DYK & Hughes;
WALLACE, dissenting-in-part)
Willful infringement; enhanced damages (on remand from Supreme Court to consider *Halo*
(2016))
Revisiting only enhanced and not other aspects of earlier panel opinion; lost profits (addressed by
dissent): not at issue
Jury finding of willfulness; instruction under *Seagate* standard

September 22

ClassCo, Inc. v. Apple, Inc., 838 F.3d 1214 (Fed. Cir. 2016) (STOLL, Bryson & Taranto)
Obviousness; inter partes review; affirm rejections
KSR: no requirement that combination only unite old elements without changing their functions;
flexible approach; combination with no more than predictable approach
Objective evidence; improper to dismiss evidence on praise; nexus; commensurate in scope
Analysis of commercial success, licensing: also flawed
No error in ultimate conclusion; strong showing of obviousness; objective: not strong
Claim construction; no importing additional limitations

September 23

Cox Communications, Inc. v. Sprint Communications Company, 838 F.3d 1224 (Fed. Cir. 2016)
(PROST, Newman & Bryson)
Indefiniteness

September 23

Affinity Labs of Texas, LLC v. DIRECTTV, LLC, 838 F.3d 1253 (Fed. Cir. 2016) (BRYSON,
Prost & Wallach)
Section 101; abstract idea
“Abstract idea” step and “inventive concept” step
Elusive boundary between abstract and concrete: substantial guidance from four years, post-*Mayo*
Federal Circuit precedent

Streaming regional broadcast signals to cellular phones located outside region; out-of-area broadcasting commonplace; use of cell phones but only for conventional components and routine functions

Dependent claims: particular choices from range of existing content or hardware

September 23

Affinity Labs of Texas, LLC v. Amazon.com Inc., 838 F.3d 1266 (Fed. Cir. 2016) (BRYSON, Prost & Wallach)

Section 101; abstract idea, ineligible subject matter for patenting

Media systems delivering content to handheld wireless electronic device

Functional nature of claims

Novelty not same as eligibility

September 23

Husky Injection Molding Systems Ltd. v. Athena Automation Ltd., 838 F.3d 1236 (Fed. Cir. 2016) (LOURIE & Stoll; PLAGER, dissenting)

Inter partes review;

PTAB finding that petitioner not barred by assignor estoppel; no Federal Circuit jurisdiction to review institution, *Cuozzo* (2016)

Anticipation; incorporation by reference; no “word-for-word” test; skilled artisan’s ability to deduce from language (“however imprecise” what host document aided to incorporate

September 29

Drone Technologies, Inc. v. Parrot S.A., 838 F.3d 1283 (Fed. Cir. 2016) (SCHALL & Chen; NEWMAN, concurring)

Inventorship; Section 102(f)

Lack of standing because patent owner’s assignor (named inventor) was not true inventor

Invalidity for improper inventorship

Accused infringer: discovery sanction of default judgment because of failure to turn over source code

September 30

Lyda v. CBS Corp., 838 F.3d 1331 (Fed. Cir. 2016) (STOLL, Reyna & Hughes)

Joint patent infringement

Pleading standard; Form 18 not applicable

September 30

Intellectual Ventures I LLC v. Symantec Corp., 838 F.3d 1307 (Fed Cir. 2016) (DYK; MAYER, concurring; STOLL, dissenting-in-part)

Claims to screen e-mail and data over network for spam and viruses: abstract ideas without “inventive step”; no improvement to computers or Internet

STOLL, concurring: ordered combination of components solving problems with prior art systems

MAYER, concurring: all software patents ineligible; patents on Internet communication violating

First Amendment freedom of expression

October 7

Apple Inc. v. Samsung Electronics Co., Ltd., 839 F.3d 1034 (Fed. Cir. 2016) (en banc) (MOORE, Newman, Lourie, O'Malley, Wallach, Chen & Stoll; HUGHES, concurring in result without opinion; PROST, dissenting; DYK, dissenting; REYNA, dissenting)

En banc review of panel decision without additional briefing

Panel error by consideration of issues not raised

Extra-record extrinsic evidence to construe patent claim in violation of *Teva*

Substantial evidence

Obviousness; motivation to combine; secondary considerations; nexus; commercial success; industry praise; copying; long-felt need

October 11

Fairwarning IP v. Iatric Systems, Inc., 839 F.3d 1089 (Fed. Cir. 2016) (STOLL, Lourie & Plager)

Section 101; ineligible subject matter

System and method of detecting fraud in in computer environment

Collecting information in particular context as abstract idea; *Electric Power*

Use of rules; *McRo* distinguished

Motion to dismiss complaint

October 13

Massachusetts Institute of Technology v. Shire Pharmaceuticals, Inc., 839 F.3d 1111 (Fed. Cir. 2016) (STOLL & Chen; O'MALLEY, concurring)

Claim construction

Indefiniteness

October 14

Poly-America, L.P. v. API Industries, Inc., 839 F.3d 1131 (Fed. Cir. 2016) (REYNA, Prost & Hughes)

Poly-America, L.P. v. API Industries, Inc., 839 F.3d 1131 (**Oct. 14, 2016**) (REYNA, Prost & Hughes)

Claim interpretation

Disavowal of claim scope; characteristic of “the present invention”

Limiting claim to feature when feature mentioned in every section of specification and in every embodiment

Prosecution history; statement distinguishing prior art applicable to all claims

Claim differentiation

October 17

Synopsys, Inc. v. Mentor Graphics Corp., 839 F.3d 1138 (Fed. Cir. 2016) (CHEN, Lourie & Moore)

Section 101; abstract idea

Translating functional description of logic circuit into hardware component description of logic circuit via a novel intermediate step description

Undisputed construction: no requirement that computer or any hardware be used; generated circuit as representation

Abstract ideas as “mental processes”

New abstract idea still abstract; Section 101 inquiry distinct from Section 102 and 103 inquiries

Could claims based on patent’s description “pass muster” if to computerized tool? Not decided

October 18

In re Efhymiopoulos, 839 F.3d 1375 (Fed. Cir. 2016) (PROST & Bryson, NEWMAN, dissenting)

Obviousness rejection

Oral inhalation of drug previously administered only intra-nasally

Prior art: similar compound administered orally

Substantial evidence supporting PTAB findings on reasonable expectation of success and lack of unexpected results

October 20

Medtronic, Inc. v. Robert Bosch Healthcare Systems, Inc., 839 F.3d 1382 (Fed. Cir. 2016) (DYK, Lourie & Hughes)

Inter parties review (IPR)

PTAB institution and subsequent termination of IPR; Section 312(a)(2) bar; failure to name real party in interest

No Federal Circuit review; Section 314(d); termination as reconsideration of institution decision
Supreme Court’s *Cuozzo*: not alter *GTNX* (2015)

November 1

Amdocs (Israel) Ltd. v. Openet Telecom, Inc., 841 F.3d 1288 (Fed. Cir. 2016) (PLAGER & Newman; REYNA, dissenting)

Section 101; “abstract idea”

Absence of single definition of “abstract idea”; classic case law development; similarity of claims to ones previously held eligible and ineligible

REYNA: abstract idea exception linked to principle that patent claims must be limited to particular means for achieve result, function or goal; limitations: by structural or procedure (process), not field-of-use (contextual) or illusory (computer automation necessarily requiring computer)

November 7

SAS Institute, Inc. v. ComplementSoft, LLC, 842 F.3d 1223 (Fed. Cir. 2016) (en banc order; NEWMAN, dissenting)

Inter partes review; Section 318 final written decision by PTAB

PTAB practice of deciding some but not all challenged claims

November 8

Reg Synthetic Fuels, LLC v. Neste Oil OYJ, 841 F.3d 954 (Fed. Cir. 2016) (CHEN, Prost & Taranto)

Inter partes review

Anticipation; translation of percentages in prior art references

Patent owner's asserted pre-filing invention date; PTAB error on document as conception; remand for findings on diligence and reduction to practice

Exclusion of document as hearsay; consideration for non-hearsay purpose

November 9

Nuvasive, Inc., *In re*, 841 F.3d 966 (Fed. Cir. 2016) (TARANTO, Moore & Wallach)

Inter partes review; obviousness

Notice and opportunity to address PTAB reading of prior art reference

November 15

Unwired Planet, LLC v. Google Inc., 841 F.3d 995 (Fed. Cir. 2016) (REYNA, Plager & Hughes)

Inter partes review

Claims obvious

Analogous art; field of endeavor

Motivation to combine; many rationales (*KSR*); potential of combination to prove prior art

Reference "sometimes" performing method claim steps

Covered Business Method (CMB) patent review: moot

November 15

Perfect Surgical Techniques, Inc. v. Olympus America, Inc., 841 F.3d 1004 (Fed. Cir. 2016) (MOORE & O'Malley; SCHALL, concurring-in-part & dissenting-in-in-part)

Inter partes review

Petitioner's failure to provide complete translation of Japanese reference; violation of rules but harmless error; untranslated information discernable

Patent owner reliance on pre-filing invention date; PTAB: standard for diligence to reduction to practice "too exacting"; remand

Claim construction; "perforated"

Meaning of term to skilled artisan at particular time: fact finding

Specification redefinition

SCHALL, dissenting: PTAB application of correct standard for diligence

November 17

Rearden LLC, *In re*, 841 F.3d 1327 (Fed. Cir. 2016) (STOLL, Moore & Hughes)

Mandamus

Discovery order compelling product of privileged documents

Federal Circuit jurisdiction; infringement of patent as compulsory counterclaim to suit contesting patent ownership

November 17

Alfred E. Mann Foundation for Scientific Research v. Cochlear Corp., 841 F.3d 1334 (Fed. Cir. 2016) (HUGHES & Chen; NEWMAN, concurring-in-part & dissenting-in-part)

Infringement; claim construction

Indefiniteness; means-plus-function claim; failure to disclose algorithm for one claim; sufficient algorithm for another claim

No willfulness finding: remand in light of *Halo* (2016)

Damages: new trial ordered by district court: no final decision; no appellate jurisdiction

November 21

Unwire Planet, LLC v. Google Inc., 841 F.3d 1376 (Fed. Cir. 2016) (REYNA, Plager & Hughes)

Covered business method (CBM) review

PTAB: incorrect definition of CBM: “incidental to a financial activity”

November 29

Apple, Inc. v. Ameranth, Inc., 842 F.3d 1229 (Fed. Cir. 2016) (REYNA, Chen & Stoll)

Section 101; patent eligibility; abstract idea

Creating and managing menus, such as for restaurants, transmission to wireless handheld device or Web page

Difficulty in programming

December 6

Samsung Electronics Co., Ltd. v. Apple Inc., 137 S. Ct. 429 (2016) (SOTOMAYOR for a unanimous Court)

Design patent infringement; smartphones

Section 289 on recovery of infringer’s “total” profit

“Article of manufacture”; design extending to component not separately sold

December 6

Astek Danmark A/S v. CMI USA, Inc., 842 F.3d 1350 (Fed. Cir. 2016) (TARANTO & Newman; PROST, dissenting)

Jury verdict; infringement; jury instruction applying only language of claims; sufficiency of evidence assessed by ordinary meaning; “removably attached” or “coupled”

Obviousness; fact issue whether claim limitation (“thermal exchange chamber”) met by prior art reference (“sucking channel”)

Reasonable royalty; 14.5%; patent owner’s per-unit profit margin

Injunction; obligations on related party dismissed by stipulation

December 7

Nuvasive, Inc., *In re*, 2016 U.S. App. LEXIS 21748 (Fed. Cir. 2016) (WALLACH, Moore & Taranto)

Obviousness; inter partes review

Waiver of argument that references were not printed publications

PTAB: failure to articulate motivation to combine prior art references

December 12

Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc., 2016 U.S. App. LEXIS 21975 (Fed. Cir. 2016) (CHEN, Prost & Schall)

Jury verdicts

Anticipation

Inducement: incorrect instruction

Obviousness

Doctrine of equivalents

December 13

Medgraph, Inc. v. Medtronic, Inc., 2016 U.S. App. LEXIS 22067 (Fed. Cir. 2016) (LOURIE, Plager & Taranto)

Divided infringement; applying Akamai; method claims: steps performed by patient or physician as well as by accused infringer; no basis for attribution

Claim construction; “and” not meaning “or”

December 15

United Constr. Prods. v. Tile Tech, Inc., 2016 U.S. App. LEXIS 22248 (Fed. Cir. 2016) (WALLACH, Moore & Stoll)

Default judgment; permanent injunction

Discovery violations

December 15

U.S. Water Servs. v. Novozymes A/S, 2016 U.S. App. LEXIS 22244 (Fed. Cir. 2016) (WALLACH, Hughes & Stoll)

Inherent anticipation; fact issue precluding summary judgment

Inequitable conduct; correct summary judgment: undisclosed

December 22

D'Agostino v. MasterCard International Inc., 2016 U.S. App. LEXIS 23025 (Fed. Cir. 2016) (TARANTO, Linn & Stoll)

Inter partes review

PTAB finding claims anticipated and obvious

Unreasonable claim interpretation