

Patent Law and the Supreme Court: Certiorari Petitions Denied in 2011

DECEMBER 31, 2011

WilmerHale compiles lists of certiorari petitions that raise patent-law issues. This page contains a consolidated list of denied petitions for this year, organized in reverse chronological order by date of certiorari petition.

Spanion, Inc., et al. v. ITC, et al., No. 11-127

Questions Presented:

1. Whether the petition should be granted, the decision below vacated, and the case remanded, in light of *Global-Tech Appliances, Inc. v. SEB S.A.*, 131 S. Ct. 2060 (2011).
2. Whether the asserted patent claims, which were unlimited by any objective standard, are invalid as indefinite.

Cert petition filed 7/27/11. **Petition denied 11/28/11.**

[CAFC Opinion](#), [CAFC Argument](#)

Qualcomm Inc. v. ITC, No. 11-128

Questions Presented:

1. To be liable for contributory infringement of a patent under 35 U.S.C. § 271(c), must the defendant know that the component it sells is used in a combination that infringes the patent, as this Court held in *Aro Manufacturing Co. v. Convertible Top Replacement Co.*, 377 U.S. 476 (1964), and recently reaffirmed in *Global-Tech Appliances, Inc. v. SEB, S.A.*, 131 S. Ct. 2060 (2011)?
2. Is a patent claim defined in terms of function and unlimited by any objective standard invalid under 35 U.S.C. § 112?

Cert petition filed 7/27/11. **Petition denied 11/28/11.**

[CAFC Opinion](#), [CAFC Argument](#)

***Barr Laboratories, Inc., et al. v. Cancer Research Technology Ltd., et al.*, No. 11-131**

Questions Presented:

1. Whether the defense of prosecution laches requires an accused infringer to prove intervening rights, where the patent applicants unreasonably delayed prosecution of their application, thereby extending the term of their patent.
2. Whether, in analyzing whether a patent is unenforceable due to inequitable conduct, the finder of fact may rely on the same piece of evidence as proof of both materiality and intent.

Cert petition filed 7/28/11.

Conference 10/28/11. **Petition denied 10/31/11.**

[CAFC Opinion](#), [CAFC Argument](#)

***APP Pharmaceuticals, LLC v. Navinta LLC*, No. 10-1502**

Question Presented:

Did the Federal Circuit err in creating a new body of federal common law to govern contracts assigning patents, in the absence of a significant conflict between state law and any federal interest that might justify preemption?

[Cert. petition](#) filed 6/13/11.

Conference 9/26/11. **Petition denied 10/3/11.**

[CAFC Opinion](#), [CAFC Argument](#)

***White v. Hitachi, Ltd., et al.*, No. 10-1504**

Questions Presented:

1. Whether California's policy that patent licenses are freely transferable should apply to patent licenses?
2. If so, whether the Federal Circuit erred by effectively creating new federal common law that ignores both the California law exceptions to *Farmland Irrigation, Co., Inc. v. Dopplmaier*, 48 Cal. 2d 208, 222 (Cal. 1957), and the federal presumption against free transferability of a patent license.

[Cert. petition](#) filed 6/15/11.

Distributed for conference of 9/26/11 on 7/27/11; **Petition denied 10/3/11.**

[CAFC Opinion](#), [CAFC Argument](#)

***Shum v. Intel Corp.*, No. 10-1444**

Questions Presented:

1. Whether a plaintiff has standing under Article II of the US Constitution to assert federal inventorship issues subsumed within his state law claims in a removed state court complaint when defendants, the parties asserting federal jurisdiction, claim that plaintiff suffered no injury and cannot receive any benefits from his success on these federal issues.
2. Whether a patent co-owner who is defrauded by his fellow co-owner's assignment of the "sole and exclusive" patent rights has any continuing rights in those patents, or may the federal courts disregard the evidentiary and legal importance of those fraudulent patent assignments, and grant judgment as a matter of law to defendants.
3. Whether defendants, the losing party on plaintiff's federal correction of inventorship claims which have given rise to federal subject matter jurisdiction, should be deemed the "prevailing party" for cost award purposes under FRCP Rule 54 on the grounds that the plaintiff did not receive any benefit from that victory.

[Cert. petition](#) filed 5/25/11.

Conference 6/16/11; response requested 6/8/11; brief in opposition filed 8/8/11; distributed for conference of 9/26/11 on 8/24/11; **Petition denied 10/3/11.**

[CAFC Opinion](#), [CAFC Argument](#)

WilmerHale represents respondent Intel Corp.

Lockwood, et al. v. Sheppard, Mullin, Richter & Hampton, LLP, et al., No. 10-1339

Question Presented:

Whether under the implied preemption principles in *Buckman Co. v. Plaintiffs' Legal Comm.*, 531 U.S. 341 (2001), federal patent law bars an aggrieved patent owner-plaintiff from asserting a state law claim seeking relief for harm to patent property rights caused by a private party maliciously initiating a sham administrative patent reexamination proceedings before the U.S. Patent and Trademark Office, where "fraud on the agency" is not an element of the claim, and where the agency itself cannot remedy the harm addressed by state law.

[Cert. petition](#) filed 4/28/11.

Conference 9/26/11; **Petition denied 10/3/11.**

[CAFC Opinion](#), [CAFC Argument](#)

[iRunway Amicus Brief ISO Cert.](#), [Law Professors Amicus Brief ISO Cert.](#), [TPL Group and T. Tafas Amicus Brief ISO Cert.](#)

Max Rack, Inc. v. Hoist Fitness Sys., Inc., No. 10-1384

Question Presented:

Whether it is a denial of due process in violation of the Fifth Amendment to the United States Constitution for the Federal Circuit Court of Appeals to merely affirm a decision of the District Court on the scope of a patent property right with no expressed independent analysis of issues for which *de novo* review is required.

[Cert. petition](#) filed 5/11/11.

Conference 9/26/11; **Petition dismissed 8/9/11.**

[CAFC Opinion](#), [CAFC Argument](#)

Abbyy Production, LLC v. Nuance Communications, Inc., No. 10-1019

Questions Presented:

1. Where a treaty between the United States and the Russian Federation applies and governs service of process on a Russian national in Russia, may a US litigant elected to bypass the treaty's requirements in favor of a more convenient means of service of process if evidence suggests that Russia in the past failed to perform under the treaty?
2. Is a Russian software developer's act of electronically shipping a master copy of software to a nonexclusive licensee in California an act of importation under 35 U.S.C. § 271 upon which a federal court may assert personal jurisdiction over the Russian developer consistent with due process?

Cert. petition filed 2/10/11.

Conference 4/15/11; response requested 4/7/11; conference 6/23/11; conference 6/27/11. **Petition denied 6/28/11.**

[CAFC Opinion](#), [CAFC Argument](#)

L-3 Commc'ns Corp, et al. v. Honeywell Int'l Inc., et al., No. 10-491

Questions Presented:

1. Whether every element of a patent claim must have been previously disclosed in the prior art for the claim to be considered obvious, and thus unpatentable, under 35 U.S.C. § 103(a).
2. Whether petitioners must prove their obviousness defense by clear and convincing evidence.

Cert. petition filed 10/8/10.

Conference 6/16/11. **Petition denied 6/20/11.**

[CAFC Opinion](#), [CAFC Argument](#)

Applera Corp. v. Enzo Biochem, Inc., No. 10-426

Question Presented:

Whether the Federal Circuit's standard for definiteness is consistent with the language of 35 U.S.C. § 112.

Cert. petition filed on 9/23/10.

Conference 12/10/10; CVSG 12/13/10; conference 6/16/11. **Petition denied 6/20/11.**

[CAFC Opinion](#), [CAFC Argument](#)

Extreme Networks, Inc. v. Enterasys Networks, Inc., No. 10-1199

Questions Presented:

1. Whether an unqualified money judgment for a sum certain is final for purposes of appellate jurisdiction under 28 U.S.C. §§ 1291 and 1295.
2. Whether, when a postjudgment motion tolls the time to file a notice of appeal under Federal Rule of Appellate Procedure 4(a)(4)(A), the time to appeal runs from the date of an order granting the motion or from the date of a judgment's alteration or amendment upon such motion.

Cert. petition filed 3/31/11.

Conference 6/2/11. **Petition denied 6/6/11.**

[CAFC Opinion](#), [CAFC Argument](#)

Howmedica Osteonics Corp. v. Zimmer, Inc., et al, No. 10-1161

Questions Presented:

1. Has the U.S. Court of Appeals for the Federal Circuit improperly eroded or eliminated a patent-holder's Seventh Amendment right to a trial by jury in patent infringement cases by making the affirmative defense of invalidity for indefiniteness of patent claims (35 U.S.C. § 112, ¶ 2) a pure question of law for the court?
2. Has the U.S. Court of Appeals for the Federal Circuit improperly treated invalidity of patent claims for indefiniteness as a pure question of law when the dispute arises around a factual determination of whether a value associated with patent claim language can be measured or calculated by persons of ordinary skill in the art using the disclosures of the patent?

Cert. petition filed 3/14/11.

Conference 5/12/11. **Petition denied 5/16/11.**

[CAFC Opinion](#), [CAFC Argument](#)

MedioStream, Inc. v. Acer America Corp., No. 10-1090

Question Presented:

Did the Federal Circuit err in reweighing a district court's discretionary § 1404(a) analysis in the manner of the 6th, 7th, 10th and 11th Circuits, or is the proper approach under the All Writs Act, 28 U.S.C. § 1651, that of the 1st and 3rd Circuits which decline review of discretionary venue decisions?

Cert. petition filed 3/3/11.

Conference 5/12/11. **Petition denied 5/16/11.**

[CAFC Opinion](#)

***Eli Lilly & Co. v. Sun Pharm. Indus., Ltd*, No. 10-972**

Question Presented:

Whether the Federal Circuit improperly transformed the doctrine of "double patenting," in conflict with a "vast body of precedent" cited by four dissenting judges, by creating a new bright-line rule that invalidates a subsequent patent on a nonobvious, newly discovered use of a basic invention solely because it was disclosed, but not claimed, in the final text of the earlier basic patent.

Cert. petition filed 1/28/11.

Conference 5/12/11. **Petition denied 5/16/11.**

[CAFC Opinion](#), [CAFC Argument](#)

WilmerHale filed an amicus brief in support of cert on behalf of Pharmaceutical Research and Manufacturers of America.

***Princo Corp. v. Int'l Trade Comm. et al.*, No. 10-898**

Question Presented:

Should the equitable doctrine of patent misuse remain a flexible doctrine to be applied when a patent holder has impermissibly attempted to extend the scope of his patent, or, as a divided Federal Circuit has held, be conditioned on a showing of "leveraging," "with anticompetitive effects" and in a manner previously "held to be outside...the patent grant"?

Cert. petition 1/5/11.

Conference 5/12/11. **Petition denied 5/16/11.**

[CAFC Opinion](#), [CAFC Argument](#)

WilmerHale represents respondent U.S. Philips.

***Mylan, Inc. v. Daiichi Sankyo Co., Ltd*, No. 10-770**

Question Presented:

Whether, contrary to this Court's decision in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398

(2007), the Federal Circuit has erred in applying a “lead compound test” as the exclusive standard for determining whether a patent claim directed to a new chemical compound is “obvious” and therefore invalid under 35 U.S.C. § 103(a).

Cert. petition filed 12/8/10.

Conference 3/18/11. **Petition denied 3/21/11.**

[CAFC Opinion](#), [CAFC Argument](#)

***Baran v. Medical Device Tech., Inc.*, No. 10-862**

Question Presented:

Whether 35 U.S.C. § 112, ¶ 6 permits a patent claim expressed as a “means...for performing a specific function” to be construed to require functions not recited in the means clause.

Cert. petition filed 12/29/10. 2010

Conference 3/4/11. **Petition denied 3/7/11.**

[CAFC Opinion](#), [CAFC Argument](#)

***Louisiana Wholesale Drug Co., Inc., et al. v. Bayer AG, et al.*, No. 10-762**

Question Presented:

Absent patent fraud or sham litigation, is a brand drug maker's substantial payment to a competing generic drug maker to forego judicial testing of the patent and restrict entry per se lawful under the Sherman Act?

Cert. petition filed 12/6/10.

Conference of 3/4/11. **Petition denied 3/7/11.**

[US Court of Appeals for the Second Circuit Opinion](#)

***Wyers, et al. v. Master Lock Co.*, No. 10-899**

Questions Presented:

1. Whether the Court of Appeals denied Wyers' Seventh Amendment right to a jury trial by substituting its own evaluation of the *Graham* factual findings for those made by the jury in its general verdict.
2. Whether the Court of Appeals erred in applying the “clear error” standard to the jury's factual findings rather than the substantial evidence standard.

Cert. petition filed 1/10/11.

Waiver filed 1/26/11; conference 2/18/11. **Petition denied 2/22/11.**

[CAFC Opinion](#), [CAFC Argument](#)

Papyrus Tech. Corp. v. New York Stock Exchange, Inc., No. 10-866

Question Presented:

By failing to give the patent holder (1) notice that a newly identified technology might be used to invalidate a patent and (2) an opportunity to present evidence and set forth facts supporting the validity of the patent in view of this newly identified technology, did the trial court disregard Rule 56 and deprive the patent holder of a property right without due process of law?

Cert. petition filed 12/30/10.

Waiver filed 1/13/11; conference 2/18/11. **Petition denied 2/22/11.**

[CAFC Opinion](#), [CAFC Argument](#)

Landmark Screens, LLC v. Morgan, Lewis & Bockius LLP, et al., No. 10-499

Question Presented:

Whether a legal malpractice claim against a patent lawyer that involves no actual patent and will have no impact on patent rights arises under an Act of Congress relating to patents so as to invoke the exclusive jurisdiction of the federal district courts under 28 U.S.C. § 1338.

Cert. petition filed 10/12/10.

Response requested 11/16/10, conference 2/18/11. **Petition denied 2/22/11.**

[Court of Appeals of California, Sixth Appellate District Opinion](#)

Romala Stone, Inc. v. The Home Depot USA, Inc., No. 10-777

Questions Presented:

1. Did the Federal Circuit's use of Rule 36 in this case effectively deprive Romala of its statutory right of appeal (See 28 U.S.C. § 1291, "An appeal is not a matter of absolute right, independently of constitutional or statutory provisions allowing such appeal." *McKane v. Durston*, 153 U.S. 684, 687 (1894))
2. Does Rule 36 when it is used by the Federal Circuit in any case effectively deprive appellants of their statutory right of appeal?

Cert. petition filed 12/8/10.

Waiver filed 12/23/10; conference 1/21/11. **Petition denied 1/24/11.**

[CAFC Opinion](#), [CAFC Argument](#)

Vanderbilt University v. ICOS Corporation., No. 10-412

Questions Presented:

1. Whether the Court of Appeals can impose a clear and convincing evidence burden on a

statutory civil action where there is no indication in the statute or its legislative history that Congress intended a burden of proof higher than the preponderance of evidence standard normally imposed upon civil actions.

2. Whether the Court of Appeals' failure to remand the case to the District Court conflicts with the United States Supreme Court's decision in *Pullman-Standard v. Swint*, 456 U.S. 273 (1982).

Cert. petition filed 9/21/10.

Response requested 10/20/10; conference 1/21/11. **Petition denied 1/24/11.**

[CAFC Opinion](#), [CAFC Argument](#)

***Apotex, Inc. v. Sebelius*, No. 10-453**

Question Presented:

May a generic drug manufacturer forfeit marketing exclusivity under 21 U.S.C. § 355(j)(5)(D) based on “unilateral” action by the holder of the challenged patent?

Cert. petition filed 10/4/10.

Conference 1/14/11. **Petition denied 1/18/11.**

[US Court of Appeals for the District of Columbia Circuit](#)

***Desenberg v. Google, Inc.*, No. 10-706**

Questions Presented:

1. Whether the Courts erred in dismissing the case by interpreting the BMC precedent to mean all patented inventions used by multiple parties are invalid per se, and even in cases when all of the steps of a pioneer web site patent is performed by a single web site.
2. Whether the Courts misinterpreted the web site patent as not having direction and control over its users, when Courts in the USA and other countries have found Google guilty for vicarious liability for the actions of its users.
3. Whether the Court erred in interpreting “user” must refer to a real person, since “user” in computers often refers to a program, and not a person, nor a representative.
4. Did the Court err by allowing Defendant, during litigation, to change status quo to hide infringement by changing the very patented technology under dispute; and has only changed over ten years as a response to the this case; without a Markman nor other hearing to check if AdWords is equivalent to the patented technology?
5. Whether the Courts erred in not recognizing Defendant and Courts failed to state a specific claim as to which step of the patent, in its entirety, violates a precedent from a case; and then dismiss based on a general non-specific claim without comparing Defendant's methods to the patent and without discovery.
6. Did the Court err in not granting a preliminary injunction as: (i) the traditional four factor test supports such action; (ii) Defendant has no patent; (iii) there is no prior art; (iv) Defendant's

“Quality Score” bid rigging function would be removed benefiting the public interest; and (v) Defendant would not suffer significant hardship nor revenue loss; and (vi) the principals of equity have been ignored by the Courts.

7. Who has rights to write standard architectures for the industry: (i) the CEO from the infringing startup company, who introduced bid rigging, educated the public to think bid rigging is unavoidable and acceptable, and instituted a version of the patented method enabling over \$3 billion of fraud per year; or (ii) the Inventor and CEO of the startup company who endured for seven years to earn the patent rights from the USPTO in order to prevent excessive fraud for the public interest?

Cert. petition filed 11/26/10.

Waiver filed 12/6/10. **Petition denied 1/10/11.**

[CAFC Opinion](#),

Avid Identification Sys., Inc. v. The Crystal Import Corp., et al., No. 10-509

Questions Presented:

1. Whether a patent may be rendered unenforceable based solely on the failure to disclose prior art by an individual who was not involved in the preparation or submission of any evidence or argument to the Patent Office to convince it to issue the patent.
2. Whether a patent made be rendered unenforceable due to the failure to disclose a prior art reference that does not render the patent invalid or otherwise contradict the applicant's statements to the Patent Office.

Cert petition filed 10/13/10.

Conference 1/7/11. **Petition denied 1/10/11.**

[CAFC Opinion](#)

Patent certiorari petitions denied this year

Patent certiorari petitions denied in: 2015, 2014, 2013, 2012, 2011, 2010, 2009

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