Federal Circuit Patent Updates - December 2018

DECEMBER 2018

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In Re: Marco Guldenaar Holding B.V. **(No. 2017-2465, 12/28/18) (Chen, Mayer, Bryson)**

Chen, J. Affirming the PTAB's decision that the patent applicant's claims were correctly rejected under 35 U.S.C. § 101 for claiming patent-ineligible subject matter. The Court explained that the rejected claims were directed to the abstract idea of rules for playing a dice game and the only arguable inventive concept related to the dice markings, which are patent-ineligible printed matter. Judge Mayer concurred in the judgment.

A full version of the text is available in PDF form.

Spineology, Inc. v. Wright Medical Technology Inc. **(No. 2018-1276, 12/14/18) (Prost, Dyk, Moore)**

Moore, J. Affirming denial of motion for attorney fees under 35 U.S.C. § 285. "[W]e caution future litigants to tread carefully in their complaints about district courts not doing enough." The Court also stated that a "district court need not, as [defendant] seems to urge, litigate to resolution every issue mooted by summary judgment to rule on a motion for attorney fees. And we need not, as [defendant] requests, get into the weeds on issues the district court never reached."

A full version of the text is available in PDF form.

VirnetX Inc. v. Apple, Inc. **(No. 2017-2490, 12/10/18) (Newman, O'Malley, Chen)**

O'Malley, J. Affirming Board decision in IPR of obviousness. Patent owner was collaterally estopped from relitigating the question of whether a reference was a printed publication. The Court also concluded that the patent owner "did not preserve the issue of whether inter partes review procedures apply retroactively to patents that were filed before Congress enacted the AIA."

A full version of the text is available in PDF form.

Novartis AG v. Ezra Ventures LLC **(No. 2017-2284, 12/7/18) (Moore, Chen, Hughes)**

Chen, J. Affirming decision that obviousness-type double patenting does not invalidate an otherwise validly obtained patent term extension under § 156.

A full version of the text is available in PDF form.

Novartis Pharmaceuticals Corp. v. Breckenridge Pharmaceutical **(No. 2017-2173, -2175, -2176, -2178, -2179, -2180, -2182, -2183, -2184, 12/7/18) (Prost, Wallach, Chen)**

Chen, J. Reversing decision on obviousness-type double patenting. Of the two patents at issue, one was filed prior to the URAA and entitled to a term of 17 years from issue, and the other was filed after the URAA and entitled to a term of 20 years from the filing date. Due to the difference in terms, the latter of the two patents to issue was the first to expire. "The legal question we confront in this appeal is whether the law of obviousness-type double patenting requires a patent owner to cut down the earlier-filed, but later expiring, patent's statutorily-granted 17-year term so that it expires at the same time as the later-filed, but earlier expiring patent, whose patent term is governed under an intervening statutory scheme of 20 years from that patent's earliest effective filing date." Distinguishing Gilead, in which both patents had been filed after the URAA, the Court found that obviousness-type double patenting did not apply.

A full version of the text is available in PDF form.

Jack Henry & Associates, Inc. v. Plano Encryption Technologies **(No. 2016-2700, 12/7/18) (Newman, Wallach, Stoll)**

Newman, J. Reversing dismissal of declaratory judgement action due to lack of personal jurisdiction and remanding. "[Declaratory judgement defendant] cites *Red Wing Shoe* and *Avocent* for the proposition that patent enforcement letters can never provide the basis for jurisdiction in a declaratory judgment action. *Red Wing Shoe* and *Avocent* did not create such a rule, and doing so would contradict the Court's directive to 'consider a variety of interests' in assessing whether jurisdiction would be fair." Also finding that plaintiff, "as supplier of the accused systems and as indemnitor of the [accused parties], has standing to participate in this action." Stoll, J. and Wallach, J. provided additional views in a separate opinion.

A full version of the text is available in PDF form.