

## Federal Circuit Patent Updates - September 2018

SEPTEMBER 2018

[View previous updates...](#)

***Wisconsin Alumni Research v. Apple Inc.* (No. 2017-2265, -2380, 9/28/18) (Prost, Bryson, O'Malley)\***

Prost, C.J. Reversing the district court's denial of Apple's post-trial motion for judgment as a matter of law that the accused products did not infringe. The Court agreed with Apple that no reasonable juror could have found infringement based on the evidence presented at trial. The case involved a microprocessor prediction technology to increase the accuracy of microprocessor speculation. The patent claims at issue require a prediction associated with a "particular [load] instruction." The Court held that there was no substantial evidence that Apple's accused processors, which associate predictions with groups of load instructions, satisfy the "particular" limitation under its plain meaning. The Court also held that there was no substantial evidence to support the Plaintiff's theory that, in Apple's accused products, a prediction is sometimes associated with a single load instruction. The Court also affirmed the district court's grant of summary judgment that the patent was not invalid as anticipated.

\*WilmerHale represented the Defendant-Appellant, Apple Inc.

A full version of the text is [available in PDF form](#).

***Bennett Regulator Guards, Inc. v. Atlanta Gas Light Company* (No. 2017-1555, -1626, 9/28/18) (Lourie, Clevenger, Stoll)**

Stoll, J. Vacating a PTAB IPR decision finding the challenged claims unpatentable because the IPR was precluded by the time bar of 35 U.S.C. § 315(b). The Court held that the PTAB erred by evaluating the time bar with respect to a newly filed complaint, instead of an earlier complaint that had been dismissed without prejudice but that was filed more than one year before the IPR petition. The Court explained that there are no exceptions to the time bar for dismissed complaints. The Court also declined to review and remanded the PTAB's decision to sanction the petitioner for failure to timely disclose its changed corporate parentage, because the PTAB's decision, which did not quantify the amount of monetary sanctions, was not yet final.

A full version of the text is [available in PDF form](#).

***Gust, Inc. v. AlphaCap Ventures LLC* (No. 2017-2414, 9/28/18) (Wallach, Linn, Hughes)**

Linn, J. Reversing an award of attorneys' fees to the defendants under 28 U.S.C. § 1927. The Court held that the district court abused its discretion in finding that the patent owner's counsel unreasonably and vexatiously multiplied the proceedings by making arguments on patent eligibility and venue, and by failing to resolve the litigation earlier than it did.

A full version of the text is [available in PDF form](#).

***Hyatt v. Pato* (No. 2017-1722, 9/24/18) (Reyna, Wallach, Hughes)**

Hughes, J. Reversing dismissal for lack of subject matter description stating, "the exclusive jurisdiction of this court and the Eastern Virginia district court to review final PTAB decisions under § 141 and § 145 does not displace the district court's jurisdiction over APA challenges to the PTO's denial of a petition for rulemaking." Also affirming summary judgment on alternate grounds. Some of the plaintiff's challenges to PTO rulemaking were time-barred. The Court also upheld an examiner's ability to reopen prosecution after an appeal brief has been filed. "[T]he prospect that prosecution reopenings after the filing of an appeal brief might be used abusively cannot override the plain meaning of § 6(b)(1)."

A full version of the text is [available in PDF form](#).

***Power Integrations, Inc. v. Fairchild Semiconductor* (No. 2016-2691, -1875, 9/20/18) (Dyk, Clevenger, Chen)**

Dyk, J. In a modified opinion following petition for reheating, the Court vacated damages award and remanded because the evidence presented by plaintiff was insufficient to invoke the entire market value rule: "[W]hen the product contains multiple valuable features, it is not enough to merely show that the patented feature is viewed as essential, that a product would not be commercially viable without the patented feature, or that consumers would not purchase the product without the patented feature." Also affirming judgement of infringement of patents related to power supplies. The Court affirmed that the claim's requirement of a "fixed frequency" allowed for some variation: "A reasonable jury could have found that the accused products have a 'fixed' or 'non-varying' frequency despite slight variance due to operating conditions." Also, defendant waived a claim construction argument by not raising the issue before submission to the jury.

A full version of the text is [available in PDF form](#).

***E.I. DuPont de Nemours v. Synvina C.V.* (No. 2017-1977, 9/17/18) (Lourie, O'Malley, Chen)**

Lourie, J. Reversing Board decision in IPR of nonobviousness of claims related to process for producing a compound using specific conditions for a chemical reaction. In a case of first impression, the Court held that the same burden-shifting framework used in district court and PTO examinations for "overlapping range" cases applies to IPRs. "Thus, 'where there is a range disclosed in the prior art, and the claimed invention falls within that range, the burden of production

falls upon the patentee to come forward with evidence' of teaching away, unexpected results or criticality, or other pertinent objective indicia indicating that the overlapping range would not have been obvious in light of that prior art." Petitioner established that "ranges disclosed in the prior art overlapped with those of [the claims]." That showing "shifted the burden of production to the patent owner to demonstrate teaching away, unexpected results, or some other evidence of nonobviousness." Because the patent owner failed to present such evidence, the Court found the claims obvious. Patent owner also unsuccessfully argued that the petitioner lacked standing to appeal because no infringement action had been filed.

A full version of the text is [available in PDF form](#).

***Nobel Biocare Services AG v. Intradent USA, Inc.* (No. 2017-2256, 9/13/18) (Prost, Lourie, Chen)**

Lourie, J. Affirming Board decision in IPR that claims related to dental implants are invalid. After the IPR petition was filed, the International Trade Commission decided that a product catalog had not been proven to qualify as prior art, and the Court subsequently affirmed. In the IPR, petitioner presented additional evidence, not used in the International Trade Commission, showing that the catalog had been publicly disseminated and did qualify as prior art. In the IPR, the Board found that the catalog did qualify as prior art and that it invalidated the claims, and the Court affirmed. "We thus conclude that our prior affirmance of the ITC's judgment on a different factual record with a different burden of proof does not dictate the outcome of this appeal."

A full version of the text is [available in PDF form](#).

***ParkerVision, Inc. v. Qualcomm Incorporated* (No. 2017-2012, -2013, -2014, -2074, 9/13/18) (O'Malley, Reyna, Taranto)**

O'Malley, J. Affirming Board decision in IPRs that apparatus claims had been proven to be unpatentable and that method claims had not. The prior art was capable of being operated in accordance with the claims but was also capable of operating in other ways. The Court found that sufficient to invalidate the apparatus, but not the method, claims. "The method claims present a different story, however. While [petitioner] was only required to identify a prior art reference that discloses an apparatus 'capable of' performing the recited functions to prove that the apparatus claims would have been obvious, more was required with respect to the method claims. Specifically, [petitioner] needed to present evidence and argument that a person of ordinary skill would have been motivated to operate [the prior art] in a manner that satisfied the [claim] limitation." The Court also addressed the difference between "configured" and "capable" claim limitations. "In other words, we found that, where an apparatus needed to be altered in order to be 'configured' as claimed and there was no evidence of such alteration, it does not infringe those claims... In contrast, where claim language recites 'capability, as opposed to actual operation,' an apparatus that is 'reasonably capable' of performing the claimed functions 'without significant alterations' can infringe those claims."

A full version of the text is [available in PDF form](#).

***Acorda Therapeutics, Inc. v. Roxane Laboratories, Inc.* (No. 2017-2078, -2134, 9/10/18)**

**(Newman, Dyk, Taranto)**

Taranto, J. Affirming district court judgment that claims directed to dosing of drug to treat multiple sclerosis were obvious. The prior art did not teach away and would have led to a reasonable expectation that the claimed dosing method would be efficacious. Pharmacokinetic limitations of the claims were inherent in the claimed method. The district court did not clearly err in discounting evidence of commercial success in light of a blocking patent. Newman, J., dissented.

A full version of the text is [available in PDF form](#).

***University of California v. Broad Institute, Inc.* (No. 2017-1907, 9/10/18) (Prost, Schall, Moore)**

Moore, J. Affirming Board's finding that there was no interference-in-fact between patents and patent applications directed to gene editing. Substantial evidence supported Board's finding that there was no reasonable expectation that method of UC's application would work in eukaryotic cells as claimed by Broad Institute and therefore claims were not obvious in light of UC's invention. The Board considered fact of simultaneous invention and did not err in finding that it was insufficient to find non-obviousness.

A full version of the text is [available in PDF form](#).

***IXI IP, LLC v. Samsung Electronics Co., Ltd.* (No. 2017-1665, 9/10/18) (O'Malley, Mayer, Reyna)**

Reyna, J. Affirming IPR decision that claims directed to wireless devices were obvious.

A full version of the text is [available in PDF form](#).

***Orexo AB v. Actavis Elizabeth LLC* (No. 2017-1333, 9/10/18) (Newman, Hughes, Stoll)**

Newman, J. Reversing holding that patent direct to formulation of drug for treating opioid abuse was obvious where record did not contain clear and convincing evidence of a teaching or suggestion to use one of the components of the formulation or that it would produce beneficial results. Enhanced bioavailability of the formulation was one of kind, not degree, and showed non-obviousness as an unexpected result.

A full version of the text is [available in PDF form](#).

***Worlds Inc v. Bungie, Inc.* (No. 2017-1481, -1546, -1583, 9/7/18) (Prost, O'Malley, Taranto)**

Prost, J. In IPR, vacating Board's decision based on erroneous real-party-in-interest analysis. In determining whether a petition is time-barred based on service of a complaint served on an alleged real-party-in-interest, petitioner bears the ultimate burden of persuasion. Although there is no presumption that the identification by the petitioner of the real-party-in-interest is correct, it should be accepted unless disputed by the Patent Owner with "**some** evidence that tends to show that a particular third party should be named." The Court also remanded for determination of whether earlier, non-appealed, IPRs rejecting Patent Owner's arguments regarding the real-party-in-interest estopped patent owner based on issue preclusion.

A full version of the text is [available in PDF form](#).

***Intellectual Ventures I LLC v. T-Mobile USA, Inc.* (No. 2017-2434, -2435, 9/4/18) (Prost, Moore, Reyna)**

Bryson, J. Denying petitions for a writ of mandamus challenging the PTAB's denial of institution of four IPRs on the ground that the petitioner had not shown that the cited prior art was publicly accessible before the patents' priority date. The Court explained that the PTAB's decisions regarding whether to institute IPRs are not appealable under 35 U.S.C. § 314(d), and a writ of mandamus is not a valid alternative means of challenging the denial of an IPR.

A full version of the text is [available in PDF form](#).