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## Federal Circuit Patent Updates - April 2016

APRIL 2016

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***In Re TC Heartland LLC* (No. 2016-105, 4/29/16) (Moore, Linn, Wallach)**

April 29, 2016 11:18 AM

Moore, J. Denying petition for mandamus seeking dismissal or transfer.

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

***Largan Precision Co. v. Genius Electronic Optical Co.* (No. 2015-1695, 4/27/16) (Lourie, Moore, Chen)**

April 27, 2016 2:45 PM

Moore, J. Affirming summary judgment of non-infringement of patents related to camera lenses. Patentee failed to offer evidence of direct infringement and therefore failed to establish that defendant induced infringement. Patentee and defendant both sell camera lenses in Asia that are used by others to produce cameras, which are then used by others to produce phones and tablets that are then distributed worldwide. Patentee failed to establish that any products containing defendant's lenses had been sold in the United States.

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

***Merck & Cie v Gnosis P.A.* (No. 2014-1779, 4/26/16) (Prost, Newman, Lourie, Dyk, Moore, O'Malley, Reyna, Wallach, Taranto, Chen, Hughes, Stoll)**

April 26, 2016 5:34 PM

Per Curiam. Denying petition for rehearing en banc. O'Malley, J. wrote a separate concurrence, which was joined by Judges Wallach and Stoll, stating, "... I agree with the dissent to the extent that it argues that a substantial evidence standard of review makes little sense in the context of an appeal from an IPR proceeding. But the question is one for Congress... Unless and until Congress or the Supreme Court sees fit to change our standard of review expressly, we must continue to review factual findings of the Board for substantial evidence." Newman, J. dissented.

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

***South Alabama Medical Science v. Gnosis S.P.A. [Order denying en banc]*** (No. 2014-1778, -1780, -1781, 4/26/16) (Prost, Newman, Lourie, Dyk, Moore, O'Malley, Reyna, Wallach, Taranto, Chen, Hughes, Stoll)

April 26, 2016 1:12 PM

Per Curiam. Denying petition for rehearing en banc in companion appeal to [MERCK & CIE v. GNOSIS S.P.A.](#) (Gnosis). Judges O'Malley, Wallach and Stoll concurred for the same reasons addressed in Gnosis. Newman, J. dissented stating, "I believe en banc consideration is necessary to realign the appellate standard of review of these inter partes proceedings with the statutory purpose of the America Invents Act... Although the panel majority finds substantial evidence to support the PTAB's conclusion, less than all of the evidence was analyzed and weighed by the PTAB. On the entirety of the record, including the objective considerations, the petitioner has not established invalidity by a preponderance of the evidence, as required by statute."

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

***Mankes v. Vivid Seats Ltd.*** (No. 2015-1909, 4/22/16) (Taranto, Schall, Chen)

April 22, 2016 4:30 PM

Taranto, J. Vacating judgment on the pleadings dismissing cases for inadequately pleading divided infringement and remanding for consideration in light of *Akamai Technologies, Inc. v. Limelight Networks, Inc.*, 797 F.3d 1020 (Fed. Cir. 2015) (en banc) (*Akamai IV*), *cert. denied*, 2016 WL 442440 (U.S. Apr. 18, 2016).

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

***Sport Dimension, Inc. v. The Coleman Company, Inc.*** (No. 2015-1553, 4/19/16) (Moore, Hughes, Stoll)

April 19, 2016 2:08 PM

Stoll, J. Vacating and remanding judgment of noninfringement of a design patent because of improper claim construction. Also affirming exclusion of an expert witness who had no experience in the field of the patent.

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

***In re Man Machine Interface Tech LLC*** (No. 2015-2016, 4/19/16) (Lourie, O'Malley, Stoll)

April 19, 2016 9:40 AM

Stoll, J. Affirming in part, reversing in part, and vacating in part and remanding rejection of claims. The PTAB employed an incorrect (overly broad) claim construction. "This court's cases on BRI make clear that the proper BRI construction is not just the broadest construction, but rather the broadest

*reasonable construction in light of the specification.*” “The broadest reasonable interpretation of a claim term cannot be so broad as to include a configuration expressly disclaimed in the specification.” “We have noted that the phrase “adapted to” generally means “made to,” “designed to,” or “configured to,” though it can also be used more broadly to mean “capable of” or “suitable for.” ... Here, “adapted to,” as used in the '614 claims and specification, has the narrower meaning ....”

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

***Genetic Technologies Limited v. Merial LLC (No. 2015-1202, 4/8/16) (Prost, Dyk, Taranto)***

April 8, 2016 11:18 AM

Dyk, J. Affirming dismissal for failure to state a claim because the asserted claim was ineligible for patenting under 35 U.S.C. § 101. The asserted claim was directed to a law of nature and thus failed the first step of the *Mayo/Alice* test. “Claim 1 is directed to the relationship between non-coding and coding sequences in linkage disequilibrium and the tendency of such non-coding DNA sequences to be representative of the linked coding sequence – a law of nature.” Patentee argued unsuccessfully that the claim’s requirement of analyzing amplified DNA “to detect the allele” satisfied the second step of the *Mayo/Alice* test. The claim term “‘to detect the allele’ (in the sense of examining the non-coding region to detect an allele in the coding region) is a mental process step, one that provides [the claim] with a purpose but does not create the requisite inventive concept, because it merely sets forth a routine comparison that can be performed by the human mind.”

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

***Rembrandt Vision Techs., L.P. v. Johnson & Johnson Vision Care (No. 2015-1079, 4/7/16) (Dyk, Moore, Stoll)***

April 7, 2016 1:55 PM

Stoll, J. Reversing denial of motion for new trial and remanding for a new trial. Following the trial, plaintiff learned that defendant’s expert testified falsely during the trial. “[H]e testified falsely about his personal involvement in the testing, as well as his experience with the relevant testing methodologies. He also withheld contradictory test results on third-party lenses known to infringe and generated at the request of [defendant’s] counsel. Because these test results were not produced, [defendant’s expert] testified without contradiction about alleged differences between the accused lenses and third-party lenses to show that the accused lenses did not have the claimed surface layer... Under these circumstances, we cannot agree with the district court that this conduct did not prevent [plaintiff] from fully and fairly presenting its infringement case. The verdict was irretrievably tainted...” Dyk, J. dissented.

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

***Cutsforth, Inc. v. MotivePower, Inc. (No. 2015-1314, 4/6/16) (Prost, Clevenger, Moore)***

April 6, 2016 3:20 PM

Moore, J. Reversing Board's claim constructions and anticipation decisions in *inter partes* review. "The Board's interpretation of 'a projection extending from the mounting block' far exceeds the scope of its plain meaning and is not justified by the specification. We hold that the Board's interpretation, which encompasses a structure that recedes into the mounting block rather than jutting out from it, is unreasonable." Also reversing construction that permitted a claim element to be "a sub-component of the 'beam' and still be considered to be 'coupled to the beam.'"

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

***HP Inc. v. MPHJ Technology Investments* (No. 2015-1427, 4/5/16) (Lourie, Schall, Hughes)**

April 5, 2016 6:50 PM

Lourie, J. Affirming Board decision in inter partes review ("IPR"). The Board instituted IPR on anticipation grounds but declined to institute on the petitioner's obviousness ground, finding that the obviousness ground was redundant. The final written decision then found that one of the challenged claims was not anticipated. Petitioner unsuccessfully challenged the Board's refusal to institute on the obviousness ground. "[W]e cannot review [petitioner's] argument that the Board erred by instituting review on only a subset of grounds, and we conclude that the Board did not err in only addressing the instituted grounds in its final written decision... Allowing an APA challenge to the Board's decision to institute on the basis that the Board had insufficiently articulated its reasoning would eviscerate § 314(d) by allowing substantive review of the institution decision." The Court also noted that the IPR estoppel provisions would not apply to noninstituted grounds. "[T]he noninstituted grounds do not become part of the IPR. Accordingly, the noninstituted grounds were not raised and, as review was denied, could not be raised in the IPR. Therefore, the estoppel provisions of § 315(e)(1) do not apply."

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

***Pride Mobility Products Corp. v. Permobil, Inc.* (No. 2015-1585, -1586, 4/5/16) (Reyna, Taranto, Chen)**

April 5, 2016 4:35 PM

Taranto, J. Affirming cancellation of multiple claims of two patents related to wheelchairs. Also reversing Board's construction of "mounting plate [that] is substantially perpendicular to the drive wheel axis" and reversing cancellation of one dependent claim based on that construction.

WilmerHale represented the Appellee, Permobil, Inc.

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

***Cardpool, Inc. v. Plastic Jungle, Inc.* (No. 2014-1562, 4/5/16) (Newman, Reyna, Wallach)**

April 5, 2016 3:18 PM

Newman, J. Affirming denial of joint motion to vacate judgment of invalidity.

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

***High Point Sarl v. Sprint Nextel Corporation* (No. 2015-1298, 4/5/16) (Reyna, Mayer, Chen)**

April 5, 2016 1:28 PM

Reyna, J. Affirming summary judgment that patentee is equitably estopped from prosecuting suit.

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

***SimpleAir, Inc. v. Sony Ericsson Mobile* (No. 2015-1251, 4/1/16) (Moore, Reyna, Wallach)**

April 1, 2016 11:423PM

Wallach, J. Vacating verdict, vacating denial of JMOL and remanding with instructions to enter judgment of non-infringement. The district court incorrectly construed “data channel” and “whether said computing devices are online or offline from a data channel associated with each device” and there was no infringement under the correct construction. “The choice to use 'data channel' in claim 1 rather than 'data feed,' notwithstanding use of the latter elsewhere in the patent, lends further support to our conclusion that 'data feed' does not carry the same meaning as 'data channel.'” The Court also stated regarding claim construction that it “is true that 'interpretations that render some portion of the claim language superfluous are disfavored.’ [citation omitted] The preference for giving meaning to all terms, however, is not an inflexible rule that supersedes all other principles of claim construction.”

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

***Microsoft Corporation v. Geotag, Inc.* (No. 2015-1140, 4/1/16) (Lourie, Wallach, Stoll)**

April 1, 2016 9:22 AM

Wallach, J. Affirming summary judgment of non-infringement and affirming subject matter jurisdiction decision. Federal Circuit law, rather than Third Circuit law, governed the question of subject matter jurisdiction. The Court found that even if the declaratory judgment complaint were dismissed or deficient, the district court properly retained subject matter jurisdiction over patent infringement counterclaims. Distinguishing *DataTern*, the Court stated that the *DataTern* decision “did not consider the distinct question of whether a district court could retain subject matter jurisdiction over a counterclaim if a complaint is dismissed or deemed defective.” “We have not addressed whether a counterclaim's permissive or compulsory status is relevant to retaining jurisdiction under 28 U.S.C. § 1338. However, nothing in the text of section 1338 suggests that Congress conditioned its grant of jurisdiction to the District Court on the compulsory or permissive nature of the counterclaim.” Regarding non-infringement, because the accused product “searches its entire database without regard to geography and then filters the results, rather than searches only within a targeted geographic area and automatically adds results from outside that area in the manner claimed by the [asserted] patent, [the accused product] does not practice 'dynamic

replication' under any construction of that limitation."

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