
Federal Circuit Patent Updates - April 2017

APRIL 2017

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***Nichia Corporation v. Everlight Americas, Inc.* (No. 2016-1585, -1618, 4/28/17) (Reyna, Hughes, Stoll)**

April 28, 2017 5:10 PM

Stoll, J. Affirming judgment that three patents directed to LEDs were infringed and not invalid, mostly on claim construction grounds. Also, deferring to district court and affirming denial of permanent injunction based on past licensing practicing and minimal competition between defendant and plaintiff.

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

***Recognicorp, LLC v. Nintendo Co., Ltd.* (No. 2016-1499, 4/28/17) (Lourie, Reyna, Stoll)**

April 28, 2017 11:10 AM

Reyna, J. Affirming summary judgment that patent “directed to the abstract idea of encoding and decoding composite facial images using a mathematical formula” did not claim ineligible subject matter.

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

***Fairchild (Taiwan) Corp. v. Power Integrations, Inc. [Motion Panel Order]* (No. 2017-1002, 4/21/17) (Lourie, Moore, Reyna)**

April 21, 2017 3:14 PM

Reyna, J. Ordering Board to dismiss reexamination of some claims and further ordering the Board to enter a reexamination certificate invalidating other claims. In prior litigation, the jury rejected defendant's obviousness arguments and the jury's determination of no obviousness was affirmed on appeal. The defendant requested *inter partes* reexamination based on a different combination of references than was used at the prior trial and the Board subsequently affirmed rejection of those claims. The Court ordered the Board to dismiss the reexamination as to those claims because the

pre-AIA version of 35 U.S.C. § 317(b) precluded maintaining the reexamination on issues that the defendant “raised or could have raised” in the prior litigation.

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

***Intellectual Ventures II LLC v. Ericsson Inc.* (No. 2016-1803, 4/18/17) (Lourie, Reyna, Stoll)**

April 18, 2017 2:41 PM

Lourie, J. Affirming Board decision in IPR finding claims obvious over a combination of four references.

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

***Phil-Insul Corp. v. Airlite Plastics Co.* (No. 2016-1982, 4/17/17) (O'Malley, Bryson, Wallach)**

April 17, 2017 4:18 PM

O'Malley, J. Affirming summary judgment of non-infringement because patentee's claims are barred by collateral estoppel. Patentee argued that “a Rule 36 judgment can never serve as a basis for collateral estoppel” and the Court rejected that argument. “Despite [patentee's] arguments to the contrary, *TecSec* did not create a categorical ban against asserting a Rule 36 judgment for collateral estoppel purposes. Instead, it stands for the proposition that collateral estoppel cannot apply where the appellate court affirmed, without explanation, the judgement of a trial court that 'determined two issues, either of which could independently support the result,' because it is not known which issue was 'necessary' to the final appellate judgment.”

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

***Rembrandt Wireless v. Samsung Electronics* (No. 2016-1729, 4/17/17) (Taranto, Chen, Stoll)**

April 17, 2017 10:09 AM

Stoll, J. Affirming verdict of infringement and no invalidity of patents relating to communication between modems. The Court affirmed the district court's claim construction noting that it was different than a construction previously used by the patent office in an IPR, stating “the Board in IPR proceedings operates under a broader claim construction standard than the federal courts.” Regarding “motivation to combine” and “teaching away,” the Court stated, “Surely a showing that a prior art reference teaches away from a given combination is evidence that one of skill in the art would not have been motivated to make that combination to arrive at the claimed invention. But, the absence of a formal teaching away in one reference does not automatically establish a motivation to combine it with another reference in the same field.” The Court also vacated denial of motion based on the marking statute and remanded. A licensee previously sold unmarked products covered by one of patentee's claims. The patentee subsequently disclaimed the relevant claim and argued that the disclaimer removed any obligation to mark. “[Patentee's] position ... effectively provides an end-run around the marking statute and is irreconcilable with the statute's purpose. Allowing [patentee] to use disclaimer to avoid the consequence of its failure to mark undermines

the marking statute's public notice function.” The Court also remanded “to the district court to address in the first instance whether the patent marking statute should attach on a patent-by-patent or claim-by-claim basis.”

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

***Core Wireless Licensing v. Apple Inc.* (No. 2015-2037, 4/14/17) (O'Malley, Bryson, Wallach)**

April 14, 2017 5:17 PM

Bryson, J. Affirming verdict of non-infringement and affirming district court's denial of motion for JMOL. The district court correctly interpreted “means for comparing” to require the mobile phone to “have the capability to perform 'channel selection'” and under that construction there was no infringement.

WilmerHale represented the defendant-appellee, Apple, Inc.

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

***Novartis AG v. Torrent Pharmaceuticals* (No. 2016-1352, 4/12/17) (Taranto, Chen, Stoll)**

April 12, 2017 4:40 PM

Chen, J. Affirming Board decision of invalidity in IPR of patent relating to composition for treating autoimmune diseases. The Board rejected patentee's argument that the Board had violated the APA's requirement for due process. In its decision on institution, (1) the Board instituted based on the combination of two references, Chiba and Aulton and (2) the Board declined to institute based on another reference, Sakai. In its final written decision, the Board used Sakai as background reference that provided further evidence of motivation for combining Chiba and Aulton. Patentee argued that the Board's institution decision had “ruled Sakai entirely out of the case” and that the Board's subsequent use of Sakai in the final written decision was improper. The Court rejected patentee's argument that the Board's use of Sakai in its final written decision constituted unfair surprise and further rejected the argument that the Board's use of Sakai was inconsistent with its decision on institution. Regarding secondary considerations, the Court rejected patentee's argument that “a feature that is known in the art but not actually available to the market—i.e., in commerce—cannot be used to disprove [patentee's] attempts to establish a nexus based on that claimed feature.” In rejecting that argument, the Court stated “In evaluating whether the requisite nexus exists, the identified objective indicia must be directed to what was not known in the prior art...”

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

***In Re Apple Inc.* (No. 2016-1402, 4/12/17) (Prost, Dyk, Stoll)**

April 12, 2017 11:31 AM

Stoll, J. Affirming-in part, vacating-in-part and remanding Board decision in reexamination. The Board incorrectly construed “rubberbanding” because it failed to note that “rubberbanding requires

the content to slide backwards at the end of a scroll.” The Court vacated the Board’s rejection of claims that require “rubberbanding” and remanded. The Court also affirmed the Board’s construction of “scroll or gesture.”

WilmerHale represented the appellant, Apple Inc.

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

***The Medicines Company v. Mylan, Inc.* (No. 2015-1113, 4/6/17) (Dyk, Wallach, Hughes)**

April 6, 2017 12:05 PM

Dyk, J. Affirming judgment of noninfringement of one patent and reversing judgment of infringement of another patent. All asserted claims required a particular process step, construed as defined by one example in the specification, which was not met by the accused ANDA. “The patentee’s construction of [the step] ... attempts to claim all solutions to the identified ... problem, without describing the entire range of solutions to that problem. {This} construction is therefore not permissible.”

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

***Wasica Finance GmbH v. Continental Automotive Systems* (No. 2015-2078, 4/4/17) (Prost, Schall, Chen)**

April 4, 2017 4:57 PM

Schall, J. Affirming in part and reversing in part PTAB (un)patentability decisions in IPR proceedings. Where the specification and claims use words “interchangeably[,] [t]his drafting choice equates the two terms for claim construction purposes.”

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

***Novartis AG v. Noven Pharmaceuticals Inc.* (No. 2016-1678, 4/4/17) (Prost, Wallach, Stoll)**

April 4, 2017 1:12 PM

Wallach, J. Affirming PTAB rulings of obviousness in inter partes reviews. Prior judicial decisions did not bind the PTAB. “[E]ven if the record were the same, ... the PTAB properly may reach a different conclusion based on the same evidence,” because of the different burdens of proof in judicial and IPR proceedings.

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

***Asetek Danmark v. CMI USA Inc.* (No. 2016-1026, 4/3/17) (Prost, Newman, Taranto)**

April 3, 2017 10:08 AM

Taranto, J. Upon rehearing of case after decision at [Asetek Danmark A/S v. CMI USA Inc. \[OPINION\]](#), denying rehearing en banc but granting in part panel rehearing and issuing a new opinion that affirmed the district court’s liability and damages rulings but vacated in part and

remanded for further consideration the injunction against a non-party insofar as the injunction reaches conduct by the non-party regarding the covered products that goes beyond abetting a new violation by the named defendant.

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