
Federal Circuit Patent Updates - August 2013

AUGUST 19, 2013

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***Trading Technologies Intl v. Open E Cry, LLC* (2012-1583, 8/30/13) (Laurie, Plager, Benson)**

August 30, 2013 9:22 AM

Lourie, J. Reversing summary judgment of invalidity based on written description requirement and of non-infringement based on prosecution history estoppel. The Federal Circuit's prior determinations of claim scope of related patents in *Trading Technologies International, Inc. v. eSpeed, Inc.*, 595 F.3d 1340 (Fed.Cir. 2010) did not resolve the issue of whether claims in patents from the same family were adequately described. With respect to prosecution history estoppel, an estoppel found in the previous case did not extend to claims of a CIP.

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

***Aevoe Corp. v. AE Tech Co., Ltd.* (2012-1422, 8/29/13) (Rader, Lourie, O'Malley)**

August 19, 2013 3:02 PM

O'Malley, J. Dismissing appeal for lack of jurisdiction. The district court granted an injunction from which the defendant did not appeal. The court later concluded that the defendant had violated the injunction and altered certain language in the injunction. Additional parties were also mentioned by name in the second order. Because the district court merely clarified the scope of the original injunction in its subsequent order and the new parties had always been subject to the injunction, there was no modification that "substantially changed the legal relationship" between the parties and therefore no basis for an interlocutory appeal.

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

***Apple Inc. v. Samsung Electronics Co., Ltd.* (2012-1600, -1606, 2013-1146, 8/23/13) (Prost, Bryson, O'Malley)**

August 23, 2013 6:04 PM

Prost, J. Reversing as an abuse of discretion district court's refusal to seal confidential information

of the parties. “We recognize the importance of protecting the public’s interest in judicial proceedings and of facilitating its understanding of those proceedings. That interest, however, does not extend to mere curiosity about the parties’ confidential information where that information is not central to a decision on the merits.” The Court had jurisdiction of the appeal under the collateral order doctrine.

WilmerHale represented the Appellant, Apple, Inc.

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

SkinMedica Inc. v. Histogen Inc. (2012-1560, 8/23/13) (Rader, Clevenger, Prost)

August 23, 2013 11:03 AM

Prost, J. Affirming summary judgment of non-infringement based on a disclaimer of the ordinary meaning of a claim term. Rader, J. dissented.

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

University of Utah v. Max-Planck-Gesellschaft (2012-1540, 8/19/13) (Moore, Reyna, Wallach)

August 19, 2013 10:12 AM

Reyna, J. Affirming denial of motion to dismiss complaint seeking to correct inventorship for alleged lack of jurisdiction, sovereign immunity, and failure to join an indispensable party. Extensive discussion of issues of sovereign immunity and federal jurisdiction that arise when state universities are involved on both sides of an inventorship dispute. “Because UMass [one of the owners of the patents in issue] is not a real party in interest under the Supreme Court’s case law, we hold that this is not a conflict between States subject to the Court’s exclusive original jurisdiction.” “We hold that a State has no core sovereign interest in inventorship.” “State ownership of patent rights is not akin to State ownership of water rights, natural resources, or other property issues that implicate serious and important concerns of federalism and rise to the level of core sovereign interests.” (quotation omitted) “Because this case does not involve a suit by citizens against a State, there is no sovereign immunity issue here.” One of the owners of the patents in issue was not an indispensable party. Moore, J., dissents.

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

Hamilton Beach Brands v. Sunbeam Products (2012-1581, 8/14/13) (O’Malley, Bryson, Reyna)

August 14, 2013 4:23 PM

O’Malley, J. Affirming summary judgment of invalidity under the on-sale bar. “[I]t is of no consequence that the “commercial offer for sale” at issue in this case was made by Hamilton Beach’s own supplier and was made to Hamilton Beach itself.” “[A] commercial offer for sale made by a foreign entity that is directed to a United States customer at its place of business in the United States may serve as an invalidating activity.” Reyna, J. dissents.

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

Monolithic Power Systems, Inc. v. O2 Micro International Ltd. (2012-1221, 8/13/13) (Prost, Mayer, Reyna)

August 13, 2013 5:10 PM

Prost, J. Affirming finding of exceptional case and award of attorney fees against patentee. “[M]any forms of misconduct can support a district court’s exceptional case finding.” “[L]itigation misconduct alone may suffice to make a case exceptional.” “O2 Micro is incorrect in suggesting that findings of “bad faith” and “objectively baseless” litigation are always required in addition to a “litigation misconduct” finding for an exceptional case.” The misconduct included filing repeated suits against customers that were later withdrawn after substantial litigation had taken place, misrepresenting the date a of schematic diagram used to attempt to predate prior art, and filing baseless motions. An attorney fee award that included discovery-related expenses incurred in a related ITC proceeding was proper. “[W]e agree with the district court that O2 Micro’s rampant misconduct so severely affected every stage of the litigation that a full award of attorney fees was proper here.”

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

Leo Pharmaceutical Products v. REA (2012-1520, 8/12/13) (Rader, O'Malley, Reyna)

August 12, 2013 8:33 AM

Rader, J. concurred. Rader, C. J. Reversing Board claim construction and determination of obviousness in an inter partes reexamination. “[A]n invention can often be the recognition of a problem itself.” “If these discoveries and advances were routine and relatively easy, the record would undoubtedly have shown that some ordinary artisan would have achieved this invention within months of [the prior art]. Instead this invention does not appear for more than a decade.” “Objective indicia of nonobviousness play a critical role in the obviousness analysis.” “Here, the objective indicia—taken in sum—are the most “probative evidence of nonobviousness...”.”

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

Taurus IP v. DaimlerChrysler (2008-1462, 8/9/13) (Prost, Schall, Reyna)

August 9, 2013 2:12 PM

Schall, J. Affirming judgments of noninfringement, invalidity, and exceptional case and the resulting award, as well as ruling on various non-patent issues. “After an accused infringer has put forth a prima facie case of invalidity, the burden of production shifts to the patent owner to produce sufficient rebuttal evidence to prove entitlement to an earlier invention date.” “When patentees have sought unreasonable claim constructions divorced from the written description, this court has found infringement claims objectively baseless.” “While an adverse claim construction generally cannot, alone, form the basis for an exceptional case finding, this court’s decisions in DePuy Spine and Medtronic Navigation do not undermine the rule that a party cannot assert baseless infringement claims and must continually assess the soundness of pending infringement claims, especially

after an adverse claim construction.”

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

***Aria Diagnostics, Inc. v. Sequenom, Inc.* (2012-1531, 8/9/13) (Rader, Dyk, Reyna)**

August 9, 2013 11:48 AM

Rader, C. J. Vacating denial of a preliminary injunction because “the district court incorrectly interpreted the asserted claims and improperly balanced factors regarding issuance of a preliminary injunction.” “As a consequence, the district court erred in finding a substantial question of noninfringement.” The district court should not have employed an assumption where “patents would lose their character as an exclusive right as articulated by the Constitution and become at best a judicially imposed and monitored compulsory license.” “A record showing that the infringer will be put out of business is a factor ... but does not control the balance of hardships factor. ... This court can easily imagine a situation where the loser on either side may have to close its doors.”

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

***Rembrandt Vision Tech v. Johnson & Johnson Vision* (2012-1510, 8/7/13) (Dyk, Clevenger, Moore)**

August 7, 2013 5:10 PM

Moore, J. Affirming judgment of noninfringement. The district court did not err in excluding late opinions in trial testimony by the patentee’s infringement expert witness, and there was no admissible circumstantial evidence of noninfringement.

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

***Apple Inc. v. ITC* (2012-1338, 8/7/13) (Moore, Linn, Reyna)**

August 7, 2013 6:04 PM

Moore, J. Affirming in part, reversing in part, vacating in part, and remanding ITC decision of noninfringement and invalidity. A “passing reference” in a prior art patent to another prior art reference did not “incorporate” the disclosure of that reference. Failure to consider “secondary considerations” in the obviousness analysis was not harmless error. Reyna, J., concurs in part and dissents in part.

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

***Cheese Systems, Inc. v. Tetra Pak Cheese* (2012-1463, 8/6/13) (Rader, Reyna, David [of the E.D. Tex., sitting by designation])**

August 6, 2013 3:22 PM

Rader, C. J. Affirming summary judgment of infringement and no invalidity for anticipation or obviousness.

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

3M Innovative Properties v. Tredegar Corporation (2012-1241, 8/6/13) (O'Malley, Plager, Reyna)

August 6, 2013 4:19 PM

Reyna, J. Vacating judgment of noninfringement because of erroneously narrow claim constructions. "This court does not rely on the prosecution history to construe the meaning of the claim to be narrower than it would otherwise be unless a patentee limited or surrendered claim scope through a clear and unmistakable disavowal." "Where an applicant's statements are amenable to multiple reasonable interpretations, they cannot be deemed clear and unmistakable." "[A]n examiner's statement during reexamination was, at most, representative of how one of skill in the art would understand the term. the claim construction is not decided based on isolated statements of one of skill in the art." Plager, J., concurs. O'Malley, J., concurs in part and dissents in part.

WilmerHale represented appellant Cisco on appeal.

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