Federal Circuit Patent Updates - December 2013

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Allergan, Inc. v. Athena Cosmetics, Inc. **(No. 2013-1286, 12/30/13) (Rader, Moore, Wallach)**

December 30, 2013 10:23 AM

Moore, J. Federal Circuit retained jurisdiction to decide non-patent claims notwithstanding dismissal of patent claims "without prejudice" by district court where court had previously entered summary judgment on claims and therefore parties were not left in the same position as if the claims had never been filed.

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

Institut Pasteur & Universite v. Focarino **(No. 2012-1485, 12/30/13) (Newman, Clevenger, Taranto)**

December 30, 2013 12:55 PM

Taranto, J. In appeal from an inter partes reexamination, reversing finding of obviousness with respect to one patent, and remanding with respect to a second patent for a determination of what motivation a person skilled in the art would have had to pursue the claimed invention. In determining whether there is an expectation of success, the expectation must "match the highly desired goal that would motivate pursuit of the method." The Board also erred in failing to properly credit secondary considerations of licensing and industry praise. Also dismissing as moot rejections of amended claims which narrowed the scope of the original claims because patent expired subsequent to Board's rejection.

WilmerHale represented the Appellee.

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Kilopass Technology, Inc. v. Sidense Corporation **(No. 2013-1193, 12/26/13) (Rader, Lourie, O'Malley)**

December 26, 2013 5:10 PM

O'Malley, J. Vacating decision of district court refusing to award attorney's fees. For a case to be exceptional, actual knowledge that claim is baseless is not required. A "defendant need only prove reckless conduct to satisfy the subjective component of the analysis." "Objective baselessness alone can create a sufficient inference of bad faith to establish exceptionality under §285 . . ." Rader, J., concurred.

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AstraZeneca AB v. Hanmi USA, Inc. **(No. 2013-1490, 12/19/13) (Dyk, Moore, Taranto)**

December 19, 2013 8:09 AM

Taranto, J. Affirming judgment of noninfringement because the written description of the patent limited the claim term "alkaline salt" to certain specifically named salts. "The written description describes the invention clearly and narrowly as including only those salts, and AstraZeneca points to nothing in the intrinsic record that is sufficient to overcome that disclaimer." Statements in the specification "clearly confine the invention to the six identified cations, disclaiming anything else."

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

Motorola Mobility v. ITC **(No. 2012-1535, 12/16/13) (Rader, Prost, Taranto)**

December 16, 2013 12:49 PM

Rader, C. J. Affirming ITC determination of Motorola's violation of 19 U.S.C. § 1337 by importing and selling mobile devices that infringe a Microsoft patent. Substantial evidence supported findings of no invalidity and a domestic industry. "[N]othing in § 337 precludes a complainant from relying on investments or employment directed to significant components, specifically tailored for use in an article protected by the patent. The investments or employment must only be "with respect to the articles protected by the patent." 19 U.S.C. § 1337(a)(3). An investment directed to a specifically tailored, significant aspect of the article is still directed to the article."

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Suprema, Inc./Cross Match v. ITC **(No. 2012-1170, 12/13/13) (Prost, O'Malley, Reyna)**

December 13, 2013 1:54 PM

O'Malley, J. Vacating ITC exclusion and cease and desist orders and remanding. "[A]n exclusion order based on a violation of 19 U.S.C. § 1337(a)(1)(B)(i) may not be predicated on a theory of induced infringement under 35 U.S.C. § 271(b) where direct infringement does not occur until after importation of the articles the exclusion order would bar. … The Commission's exclusion order must be revised, accordingly, to bar only those articles that infringe a claim or claims of an asserted patent at the time of importation." Also affirming noninfringement findings as to certain products and nonobviousness. Reyna, J., concurs in part and dissents in part.

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CBT Flint Partners, LLC v. Return Path, Inc. **(No. 2013-1036, 12/13/13) (Dyk, O'Malley, Taranto)**

December 13, 2013 9:12 AM

Taranto, J. Reversing in part and vacating in part an award of costs. “[W]e conclude that recoverable costs under section 1920(4) are those costs necessary to duplicate an electronic document in as faithful and complete a manner as required by rule, by court order, by agreement of the parties, or otherwise.” Extensive discussion of what electronic discovery expenses are taxable as “costs.” Prior art search expenses were not taxable costs. O’Malley, J., concurs in part and dissents in part.

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Galderma Laboratories v. Tolmar **(No. 2013-1034, 12/11/13) (Newman, Bryson, Prost)**

December 11, 2013 3:25 PM

Prost, J. Reversing holding of nonobviousness. “Nothing in the statute or our case law requires Tolmar to prove obviousness by starting with a prior art commercial embodiment and then providing motivation to alter that commercial embodiment. …See KSR, 550 U.S. at 419 (“In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim….”).” “The mere fact that generic pharmaceutical companies seek approval to market a generic version of a drug, without more, is not evidence of commercial success that speaks to the non-obviousness of patent claims.” Newman, J., dissents.

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

Futurewei Technologies, Inc. v. Acacia Research Corp. **(No. 2013-1090, 12/3/13) (Reyna, Mayer, Taranto)**

December 3, 2013 9:10 AM

Taranto, J. Affirming dismissal of counts in a declaratory judgment action in favor of an earlier filed action.

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