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## Federal Circuit Patent Updates - December 2017

DECEMBER 2017

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***Microsoft Corporation v. Biscotti, Inc.* (No. 2016-2080, -2082, -2083, 12/28/17) (Newman, O'Malley, Reyna)**

December 28, 2017 10:19 AM

O'Malley, J. Affirming Board decisions in IPRs that petitioner failed to establish invalidity of claims related to video conferencing. Newman, J. dissented.

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

***Bosch Automotive Service v. Matal* (No. 2015-1928, 12/22/17) (Newman, Chen, Hughes)**

December 22, 2017 12:24 PM

Chen, J. Affirming Board's finding of unpatentability in IPR, vacating Board's denial of contingent motion to amend and remanding. The Board impermissibly assigned to the patent owner the burden of proof regarding indefiniteness and patentability over prior art for the motion to amend.

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

***Regeneron Pharmaceuticals v. Merus N.V.* (No. 2016-1346, 12/21/17) (Prost, Newman, Lourie, Dyk, Moore, O'Malley, Reyna, Wallach, Taranto, Chen, Hughes, Stoll)**

December 21, 2017 4:37 PM

Per Curiam. Denying petition for panel rehearing and denying petition for rehearing en banc in case relating to inequitable conduct. Newman, J. and Reyna, J. dissented.

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

***Travel Sentry, Inc. v. David Tropp* (No. 2016-2386, -2387, -2714, 2017-1024, 12/19/17) (Lourie, O'Malley, Taranto)**

December 19, 2017 2:17 PM

O'Malley, J. Vacating summary judgement of noninfringement of claims related to inspection of luggage. "We find that, under the circumstances presented here, a reasonable jury could conclude that TSA's performance of [claim steps] is attributable to [defendant] such that [defendant] is liable for direct infringement under § 271(a). Although the partnership-like relationship between [defendant] and TSA differs in several respects from the service provider-customer and physician-patient relationships in *Akamai V* and *Eli Lilly*, a common thread connects all three cases: evidence that a third party hoping to obtain access to certain benefits can only do so if it performs certain steps identified by the defendant, and does so under the terms prescribed by the defendant... The district court interpreted *Akamai V* too narrowly when it concluded that the decision 'did not disturb' any aspects of our holdings in *BMC* and *Muniauction*. While we did reaffirm the concept of a single-actor theory of direct infringement, we made clear that the restrictive view of when the acts of a third party can be attributable to another evidenced in those cases is no longer the governing law. In other words, we 'broaden[ed] the circumstances in which others' acts may be attributed to an accused infringer to support direct-infringement liability for divided infringement, relaxing the tighter constraints in such attribution reflected in our earlier precedents and in the three previous rulings of Limelight on direct infringement."

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

***American Innotek, Inc. v. US* (No. 2017-1178, 12/19/17) (Moore, Taranto, Stoll)**

December 19, 2017 10:55 AM

Taranto, J. Affirming judgment of obviousness. "The Court of Federal Claims suggested the existence of a categorical rule that objective indicia, no matter how indicative of non-obviousness they are, 'cannot overcome a strong showing of obviousness based on combinations of prior art applied according to the prior art's expected function.' [citation omitted] That goes too far. 'Objective indicia of non-obviousness must be considered in every case where present [citation omitted] and the Supreme Court has warned against transforming '[h]elpful insights' about assessing obviousness into 'rigid and mandatory formulas' [citation omitted]."

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

***HTC Corporation v. Cellular Communications Equip.* (No. 2016-1880, 12/18/17) (Dyk, Reyna, Taranto)**

December 18, 2017 1:08 PM

Reyna, J. Affirming PTAB determination of patentability in an *inter partes* review. "Despite no express construction ... below, Board findings establishing the scope of the patented subject matter may fall within the ambit of claim construction."

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

***Amgen Inc. v. Sandoz* (No. 2015-1499, 12/14/17) (Newman, Lourie, Chen)**

December 14, 2017 11:13 AM

Lourie, J. On remand from the Supreme Court, affirming dismissal of state law unfair competition and conversion claims, because the Biologics Price Competition and Innovation Act of 2009 preempts state law remedies for an applicant's failure to comply with 42 U.S.C. § 262(l)(2)(A). "Because § 262(l)(9)(C) provides the exclusive federal remedy for failure to comply with § 262(l)(2)(A), federal law does not permit injunctive relief or damages for such failure."

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

***NobelBiz, Inc. v. Global Connect, LLC* (No. 2016-1104, 12/8/17) (en banc)**

December 8, 2017 10:50 AM

Per Curiam. Precedential order denying panel rehearing and rehearing en banc in a case applying *O2 Micro International Ltd. v. Beyond Innovation Technology Co.*, 521 F.3d 1351 (Fed. Cir. 2008). O'Malley, Newman and Reyna, JJ., dissented.

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

***Arctic Cat Inc. v. Bombardier Recreational* (No. 2017-1475, 12/7/17) (Moore, Plager, Stoll)**

December 7, 2017 4:36 PM

Moore, J. Affirming in part, vacating in part, and remanding. Affirming denial of judgment as a matter of law of obviousness, improper reasonable royalty rate, and no willfulness, and district court orders granting an ongoing royalty and trebling damages. Vacating denial of judgment as a matter of law as to compliance with the patent marking statute. Regarding obviousness, "[e]vidence suggesting reasons to combine cannot be viewed in a vacuum apart from evidence suggesting reasons not to combine. In this case, the same reference suggests a reason to combine, but also suggests reasons that a skilled artisan would be discouraged from pursuing such a combination. Under such circumstances, the jury's fact finding regarding motivation is supported by substantial evidence." "The burden of proving compliance with marking is and at all times remains on the patentee." Resolving a split among district courts, "We hold an alleged infringer who challenges the patentee's compliance with [35 U.S.C.] § 287 bears an initial burden of production to articulate the products it believes are unmarked 'patented articles' subject to § 287. To be clear, this is a low bar. The alleged infringer need only put the patentee on notice that he or his authorized licensees sold specific unmarked products which the alleged infringer believes practice the patent. The alleged infringer's burden is a burden of production, not one of persuasion or proof. ... Once the alleged infringer meets its burden of production, however, the patentee bears the burden to prove the products identified do not practice the patented invention."

WilmerHale represented the defendants-appellants.

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

***CRFD Research, Inc. v. Matal* (No. 2016-2198, -2298, -2437, 12/5/17) (Newman, Mayer, O'Malley)**

December 5, 2017 9:47 AM

O'Malley, J. Affirming in part and reversing in part PTAB determinations on obviousness and anticipation issues in *inter partes* reviews of patents directed to “user-directed transfer of an on-going software-based session from one device to another device.”

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