
Federal Circuit Patent Updates - February 2017

FEBRUARY 2017

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***Los Angeles Biomedical v. Eli Lilly and Company* (No. 2016-1518, 2/28/17) (Newman, Bryson, Moore)**

February 28, 2017 12:48 PM

Bryson, J. Vacating Board decision of invalidity of patent related to treating penile fibrosis and remanding. “Because the Board’s obviousness determination was predicated on an erroneous claim construction ... and because the Board did not make factual findings as to whether there was an apparent reason to combine the prior art references to treat penile fibrosis and whether a person of skill in the art would have had a reasonable expectation of success from such a combination, we remand this case to the Board.” Also, the patent was not entitled to an earlier priority date. “[P]roof of priority requires written description disclosure in the parent application, not simply information and inferences drawn from uncited references ...” Newman, J. concurred-in-part and dissented-in-part.

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

***Eli Lilly and Company v. Los Angeles Biomedical* (No. 2016-1547, 2/28/17) (Newman, Bryson, Moore)**

February 28, 2017 8:31 AM

Bryson, J. Affirming Board decision of no anticipation of patent related to treating penile fibrosis. The prior art reference did not teach daily dosing for at least 45 days.

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

***Icon Health and Fitness, Inc. v. Strava, Inc.* (No. 2016-1475, 2/27/17) (O'Malley, Reyna, Wallach)**

February 27, 2017 9:08 AM

Wallach, J. Affirming in part and vacating in part PTAB rejection of claims as obvious in an inter partes reexamination. “[T]here is no per se prohibition against relying on an expert’s declaration in

support of factual findings underlying a legal conclusion of obviousness solely because the declaration states that something 'would have been obvious.' Indeed, we frequently have affirmed PTAB determinations on obviousness that rely on expert declarations that include such statements, so long as other aspects of the declarations contain statements related to factual findings.”

Vacating and remanding rejections of certain claims because the PTAB did not make the requisite “factual findings or supply the requisite explanation that must accompany such findings.” “Attorney argument is not evidence or explanation in support of a conclusion.” O'Malley, J., concurred.

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

***Life Technologies Corp. v. Promega Corp.* (No. 2014-1538, 2/22/17) (Sotomayor, Kennedy, Ginsburg, Breyer, Kagan, Thomas, Alito)**

February 22, 2017 4:27 PM

Sotomayor, J. Reversing Federal Circuit decision that the supply from the United States of a single component of a patented invention assembled abroad could constitute “a substantial portion” of the components of the invention such as can give rise to liability under 35 U.S.C. § 271(f)(1). “We hold that the phrase 'substantial portion' in 35 U. S. C. §271(f)(1) has a quantitative, not a qualitative, meaning. We hold further that §271(f)(1) does not cover the supply of a single component of a multicomponent invention.” “We do not today define how close to 'all' of the components 'a substantial portion' must be. We hold only that one component does not constitute 'all or a substantial portion' of a multicomponent invention under §271(f)(1).” Alito and Thomas, JJ., concurred.

WilmerHale represented the respondent.

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

***Secure Access, LLC v. PNC Bank National Association* (No. 2016-1353, 2/21/17) (Lourie, Plager, Taranto)**

February 21, 2017 3:08 PM

Plager, J. Reversing PTAB determination that a patent determined obvious was a covered business method (CBM) patent. “The issue here is not whether a particular patent falls within the properly-understood scope of the statutory definition of a CBM patent; rather, the issue here is whether the Board properly understood the scope of the statutory definition. ...[W]e conclude that, as a matter of law, the statutory definition of a CBM patent precludes the Board's determination.” “Necessarily, the statutory definition of a CBM patent requires that the patent have a claim that contains, however phrased, a financial activity element.” “[J]ust because an invention could be used by various institutions that include a financial institution, among others, does not mean a patent on the invention qualifies under the proper definition of a CBM patent.” Lourie, J., dissented.

WilmerHale argued for all appellees.

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

***In re: Depomed, Inc.* (No. 2016-1378, 2/21/17) (Dyk, Reyna, Stoll)**

February 21, 2017 12:45 PM

Stoll, J. Affirming PTAB decision in an IPR that all claims at issue would have been obvious. “Though we have held that long-felt but unmet need is closely related to the failure of others, they are distinct considerations. ...[A] patent owner may establish a long-felt but unmet need without presenting evidence of failure of others.” Reyna, J., concurred.

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

***Slot Speaker Technologies v. Apple Inc.* (No. 2015-2038, 2/17/17) (Lourie, Dyk, O'Malley)**

February 17, 2017 1:40 PM

O'Malley, J. Affirming in part and reversing in part PTAB decision in an IPR and holding that all claims at issue would have been obvious. “There need not be an explicit teaching to combine references in the prior art. ...[A] motivation to make a particular modification may be a matter of common sense. ... While we do not rely on common sense lightly, where, as here, the only evidence of record supports the conclusion that the modification at issue is readily within the ken of those skilled in the art, it is appropriate to do so.”

WilmerHale represented the appellee/cross-appellant.

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

***Metalcraft of Mayville, Inc. v. The Toro Company* (No. 2016-2433, 2/16/17) (Moore, Hughes, Stoll)**

February 16, 2017 3:22 PM

Moore, J. Affirming grant of a preliminary injunction against infringement. “Where the injury cannot be quantified, no amount of money damages is calculable, and therefore the harm cannot be adequately compensated and is irreparable.”

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

***Xilinx, Inc. v. Papst Licensing GmbH & Co. KG* (No. 2015-1919, 2/15/17) (Prost, Newman, Dyk)**

February 15, 2017 2:11 PM

Dyk, J. Reversing dismissal of declaratory judgment (DJ) action for lack of personal jurisdiction. The district court had specific jurisdiction over the German non-practicing entity patentee who had minimum contacts with the forum, and “[w]hile the reasonableness inquiry is not limited to considering the minimum contacts, the Supreme Court has made clear that the reasonableness prong is typically satisfied by a showing of minimum contacts.” The case was not mooted by the later transfer to the DJ forum of the patentee's competing infringement suit filed in another court, where the DJ plaintiff had not filed counterclaims. “The mere availability of this unpursued

alternative route to relief [filing DJ counterclaims in that suit] does not render moot [the original DJ] action seeking the same relief.”

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

***Organik Kimya v. ITC* (No. 2015-1774, 2/15/17) (Lourie, Mayer, O'Malley)**

February 15, 2017 10:17 AM

O'Malley, J. Affirming ITC entry of a default judgment as a sanction for spoliation of evidence and entry of a limited exclusion order. There was “spoliation of evidence on a staggering scale” “despite explicit orders from the ALJ to preserve the evidence” “coupled with the multitude of lies ... knowingly and deliberately presented to hide or explain away ... wrongdoing”

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

***Personal Web Technologies, LLC v. Apple Inc.* (No. 2016-1174, 2/14/17) (Taranto, Chen, Stoll)**

February 14, 2017 4:19 PM

Newman, J. Affirming PTAB decision in IPR that claims directed to document managing system and process were anticipated and obvious. O'Malley, J., dissented on claim construction point.

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

***MPHJ Technology Investments v. Ricoh Americas Corporation* (No. 2016-1243, 2/13/17) (Newman, Lourie, O'Malley)**

February 13, 2017 11:19 AM

Newman, J. Affirming PTAB decision in IPR that claims directed to document managing system and process were anticipated and obvious. O'Malley, J., dissented on claim construction point.

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

***Shire Development, LLC v. Watson Pharmaceuticals, Inc.* (No. 2016-1785, 2/10/17) (Prost, Taranto, Hughes)**

February 10, 2017 3:45 PM

Hughes, J. Reversing district court in Hatch Waxman case and finding claims not infringed for failure to satisfy closed Markush group requirement.

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

***PPG Industries, Inc. v. Valspar Sourcing, Inc.* (No. 2016-1406, -1409, 2/9/17) (Newman, Lourie, Dyk)**

February 9, 2017 10:05 AM

Newman, J. Petitioner who lost *inter partes* reexamination had standing to appeal when appeal

was taken under *Consumer Watchdog v. WARF* because it had legitimate concern its products would draw an infringement action. However, patentee's subsequent tender of a unilateral covenant-not-to-sue mooted the appeal.

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