
Federal Circuit Patent Updates - February 2018

FEBRUARY 2018

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***Nalco Company v. Chem-Mod, LLC* (No. 2017-1036, 2/27/18) (Moore, Schall, O'Malley)**

February 27, 2018 10:03 AM

O'Malley, J. Reversing district court's dismissal of patent claims for failure to state a claim. The district court's dismissal of direct infringement claims was implicitly based on resolution of a plausible claim construction dispute. The complaint was also sufficient in pleading infringement under the doctrine of equivalents, indirect infringement and facts sufficient to overcome a divided infringement defense.

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

***Arendi S.A.R.L. v. Google LLC* (No. 2016-1249, 2/20/18) (Newman, Bryson, Moore)**

February 20, 2018 3:17 PM

Newman, J. Affirming PTAB obviousness decision. The PTAB erred in declining to apply prosecution disclaimer. However, the Court affirmed the PTAB's obviousness analysis under an alternative claim construction, which did apply the prosecution disclaimer.

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

***Aatrix Software, Inc. v. Green Shades Software, Inc.* (No. 2017-1452, 2/14/18) (Moore, Reyna, Taranto)**

February 14, 2018 6:08 PM

Moore, J. Vacating grant of motion to dismiss, vacating denial of patent owner's motion to file an amended complaint and remanding. "The proposed [amended complaint] contains allegations that, taken as true, would directly affect the district court's patent eligibility analysis. These allegations at a minimum raise factual disputes underling the § 101 analysis, such as whether the claim term 'data file' constitutes an inventive concept, alone or in combination with other elements, sufficient to survive an *Alice/Mayo* analysis at the Rule 12(b)(6) stage... Therefore, it was an abuse

of discretion for the district court to deny leave to amend.”

Reyna, J. concurred-in-part and dissented-in-part.

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

***In re Hodges* (No. 2017-1434, 2/12/18) (Lourie, O'Malley, Wallach)**

February 12, 2018 8:49 AM

O'Malley, J. Reversing PTAB rejection of claims in examination as anticipated and vacating and remanding obviousness determinations. “The Patent Office shoulders the burden during initial examination of establishing that the examined claims are anticipated.” Substantial evidence did not support the Board's anticipation findings, and its “strained interpretation” of a claim term was “unreasonably broad.” Wallach, J., concurred in part and dissented in part.

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

***Xitronix Corporation v. KLA-Tencor Corporation* (No. 2016-2746, 2/9/18) (Moore, Mayer, Hughes)**

February 9, 2018 3:18 PM

Moore, J. Precedential order transferring the appeal to the Fifth Circuit. Despite both parties' assertions to the contrary, the Federal Circuit did not have jurisdiction over a *Walker Process* monopolization claim based on alleged fraud on the PTO. “We acknowledge that a determination of the alleged misrepresentations to the PTO will almost certainly require some application of patent law. ... But consistency with the federal question jurisdiction statute requires more than mere resolution of a patent issue in a 'case within a case'. ... Something more is required to raise a substantial issue of patent law sufficient to invoke our jurisdiction under 28 U.S.C. § 1295(a)(1). ... The underlying patent issue in this case, while important to the parties and necessary for resolution of the claims, does not present a substantial issue of patent law.”

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

***Polaris Industries, Inc. v. Arctic Cat, Inc.* (No. 2016-1807, 2/9/18) (Lourie, O'Malley, Hughes)**

February 9, 2018 12:27 PM

O'Malley, J. Affirming in part, vacating in part, and remanding PTAB findings on obviousness in IPRs. “We have never articulated a framework for analyzing whether claims would have been obvious that includes the phrase 'subjective preference' or that permits a tribunal to wholly disregard the significance of prior art teachings based on such a characterization. ... There are three specific problems with the 'subjective preference' analysis espoused and applied by the Board. First, by completely disregarding certain teachings as ill-defined 'subjective preferences,' the Board's approach invited the 'distortion caused by hindsight bias' into the fold.... Second, the Board focused on what a skilled artisan would have been *able* to do, rather than what a skilled artisan would have been *motivated* to do at the time of the invention. ... Third, the Board's analysis encourages the fact-finder to outright discard evidence relevant both to 'teaching away' and to whether skilled artisans

would have been motivated to combine references.” “[E]ven if a reference is not found to teach away, its statements regarding preferences are relevant to a finding regarding whether a skilled artisan would be motivated to combine that reference with another reference.”

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

Merck Sharp & Dohme Corp. v. Amneal Pharmaceuticals LLC (No. 2017-1560, 2/9/18) (Taranto, Clevenger, Stoll)

February 9, 2018 10:36 AM

Stoll, J. Affirming judgment of noninfringement by an ANDA and denial of further discovery or a new trial. “[W]e have not said that the proof of infringement in the ANDA context must necessarily be based on any particular sample. ... Regardless of the type of sample (e.g., commercial or batch), the critical inquiry is whether it is representative of what is likely to be approved and marketed.”

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

In re Nordt Development Co., LLC (No. 2017-1445, 2/8/18) (Moore, Taranto, Stoll)

February 8, 2018 4:08 PM

Stoll, J. Vacating rejection of claims in an application. “[W]e disagree with the Board’s claim construction of ‘injection molded’ as a process limitation with no patentable weight.” “We have held that, when considering the patentability of product claims that contain process limitations, claim scope is generally based on the product itself, not the process. ... If the process limitation connotes specific structure and may be considered a structural limitation, however, that structure should be considered.”

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

Berkheimer v. HP Inc. (No. 2017-1437, 2/8/18) (Moore, Taranto, Stoll)

February 8, 2018 1:55 PM

Moore, J. Affirming summary judgment that certain claims were invalid as indefinite, but vacating summary judgment that other claims were invalid as patent ineligible under 35 U.S.C. § 101 and remanding. “The question of whether a claim element or combination of elements is well-understood, routine and conventional to a skilled artisan in the relevant field is a question of fact. ... Whether a particular technology is well-understood, routine, and conventional goes beyond what was simply known in the prior art. The mere fact that something is disclosed in a piece of prior art, for example, does not mean it was well-understood, routine, and conventional.”

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

Macom Technology Solutions v. Infineon Technologies Americas (No. 2017-1448, 1/29/18) (Prost, Wallach, Stoll)

January 29, 2018 3:57 PM

Prost, C .J. Affirming in part and vacating in part and remanding a preliminary injunction ordering the defendant to comply with an agreement. “Whether this injunction derives its force from the patents themselves or a contract referencing the patents, it prohibits the same conduct in the same manner as injunctions we have held violated Rule 65(d). Routing the prohibited conduct through a contract does not improve the Injunction’s specificity.”

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

Medicines Company v. Hospira, Inc. (No. 2014-1469, 2/6/18) (Dyk, Wallach, Hughes)

February 6, 2018 2:28 PM

Hughes, J. Affirming finding of noninfringement but reversing and remanding finding that a distribution agreement was not a commercial offer for sale under 35 U.S.C. § 102(b). The distribution agreement “provided all of the necessary terms and conditions to constitute a commercial offer for sale,” despite the patentee’s argument that the agreement permitted the patentee to reject all purchase orders submitted. “[T]he on-sale bar does not exempt commercial agreements between a patentee and its supplier or distributor.”

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

Elbit Systems of America, LLC v. Thales Visionix Inc. (No. 2017-1355, 2/6/18) (Moore, Wallach, Stoll)

February 6, 2018 11:08 AM

Wallach, J. Affirming PTAB decision in an IPR that the claims were not proved obvious.

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

Actelion Pharmaceuticals, Ltd. v. Matal (No. 2017-1238, 2/6/18) (Lourie, O'Malley, Wallach)

February 6, 2018 10:43 AM

Lourie, J. Affirming summary judgment as to length of patent term adjustment under 35 U.S.C. § 154.

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

AbbVie Inc. v. Medimmune Limited (No. 2017-1689, 2/5/18) (Prost, Dyk, Chen)

February 5, 2018 9:08 AM

Dyk, J. Affirming dismissal of declaratory judgment action for lack of jurisdiction. The plaintiff licensee’s claim that a licensed patent it did not practice was invalid would not actually resolve the parties’ contractual dispute as to whether royalties were due under the license.

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

***Paice LLC v. Ford Motor Company* (No. 2017-1387, 2/1/17) (Lourie, O'Malley, Taranto)**

February 1, 2018 4:17 PM

O'Malley, J. Affirming in part, vacating in part, and remanding PTAB obviousness determinations in an IPR. The Board erred in determining that a priority application did not incorporate the entirety of a prior patent by reference. "The applicability of a document's disclosed features and the incorporation of the document itself are distinct concepts, and one does not imply the other."

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