
Federal Circuit Patent Updates - January 2014

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***EnOcean GmbH v. Face International Corp.* (No. 2012-1645, 1/31/14) (Rader, Lourie, Prost)**

January 31, 2014 9:13 AM

Prost, J. Vacating Board obviousness determinations in an interference because the Board erred in treating certain claims that did not use "means for" language as means-plus-function claims and in finding that certain claim limitations lacked support in priority foreign and PCT applications.

"Receiver for" was a not a means-plus-function limitation.

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

***Realtime Data, LLC v. Morgan Stanley* (No. 2013-1093, et al., 1/27/14) (Lourie, Mayer, Wallach)**

January 27, 2014 5:45 PM

Lourie, J. Affirming summary judgment of noninfringement of various claims and invalidity under 35 U.S.C. § 112 for lack of written description of various claims. "In connection with patents that are part of an extended family of patents, a patentee's disclaimers made during prosecution are "relevant" both as a statement made with regard to the patent at issue and with regard to related or "sibling" patents."

WilmerHale represented appellee Credit Suisse.

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

***SmartGene, Inc. v. Advanced Biological Lab* (No. 2013-1186, 1/24/14) (Lourie, Dyk, Taranto)**

January 24, 2014 11:28 AM

Taranto, J. Affirming summary judgment of invalidity under 35 U.S.C. § 101 of claims that claimed "a process defined simply as using a computer to perform a series of mental steps that people, aware of each step, can and regularly do perform in their heads."

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

Medtronic Corevalve, LLC v. Edwards Lifesciences Corp. (No. 2013-1117, 1/22/14) (Prost, Plager, Taranto)

January 22, 2014 7:33 PM

Prost, J. Affirming summary judgment of invalidity and limiting a patent's effective priority date because of noncompliance with 35 U.S.C. § 120. "We decline to adopt the "reasonable person" test proposed ... to interpret the sufficiency of a priority claim under 35 U.S.C. § 120. [This] proposal runs afoul of the language of the statutory provision, which requires "a specific reference" to each earlier filed application, as well as the implementing regulation for § 120...."

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

Novartis AG v. Focarino (No. 2013-1160, -1179, 1/15/14) (Newman, Dyk, Taranto)

January 15, 2014 1:25 PM

Taranto, J. Dismissing some claims for patent term adjustment as untimely, partly reversing judgment as to patent term adjustment for other patents and remanding. "We reject the PTO's view that the time after allowance, until issuance, is 'time consumed by continued examination' and so is excluded from adjustments given to the patentee."

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

In re: Enhanced Security Research LLC (No. 2013-1114, 1/13/14) (Dyk, O'Malley, Taranto)

January 13, 2014 11:55 AM

Dyk, J. Affirming Board's obviousness rejection of patent related to network security in ex parte reexamination. One of the prior art references used in the Board's obviousness rejection was a product manual. The patent owner challenged the manual's status as prior art arguing that it was a draft document rather than a final document that would have been available to the public. In view of a date on the manual's title page, a supporting declaration and product advertisements "we conclude that substantial evidence supports the Board's finding that the Manual constituted publically-available prior art..." O'Malley, J. dissented finding that the manual did not qualify as prior art.

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

In re: Giannelli (No. 2013-1167, 1/13/14) (Rader, Lourie, Moore)

January 13, 2014 3:10 PM

Lourie, J. Reversing Board's obviousness rejection of claims directed to a rowing machine based on a prior art chest press machine. The claims required a handle adapted to be moved "by a pulling force." Although the prior art chest press machine was designed so that the handle would be pushed, rather than pulled, the "Board deemed it reasonable that a user could face the handles of the prior art chest press machine and exert a pulling force on its handles.... Physical capability

alone does not render obvious that which is contraindicated. And, on this record, it is not obvious to modify a machine with handles designed to be pushed to one with handles adapted to be pulled.”

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

***Proveris Scientific Corp. v. InnovaSystems, Inc.* (No. 2013-1166, -1190, 1/13/14) (Lourie, Schall, Prost)**

January 13, 2014 10:43 AM

Prost, J. Vacating contempt order and remanding for claim construction and renewed contempt proceedings. In prior litigation, a permanent injunction issued precluding sales of defendant’s product. The defendant then began selling a new redesigned product and the patent owner filed a contempt motion. In the contempt proceeding, defendant argued that it did not infringe based on a claim term that was not at issue in the original litigation. The “district court erred by failing to engage in a claim construction analysis relating to the contempt proceedings.”

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

***Nazomi Communications, Inc. v. Nokia Corporation* (No. 2013-1165, 1/10/14) (Lourie, Dyk, Wallach)**

January 10, 2014 3:16 PM

Dyk, J. Affirming summary judgment of non-infringement of patents related to a Java virtual machine (“JVM”). The accused products contained a JVM but lacked enabling software. Because the claims required both hardware and software capable of practicing the claimed functionality, and the accused products lacked such software, there was no infringement. An example of a limitation found to require both hardware and software is “an execution unit and associated register file, the execution unit to execute instructions of a plurality of instruction sets, including a stack-based and a register-based instruction set.” “Since hardware cannot meet these limitations in the absence of enabling software, the claims are properly construed as claiming an apparatus comprising a combination of hardware and software capable of practicing the claim limitations.” Lourie, J. concurred.

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

***Pacific Coast Marine v. Malibu Boats, LLC* (No. 2013-1199, 1/8/14) (Dyk, Mayer, Chen)**

January 8, 2014 8:22 PM

Dyk, J. Reversing summary judgment of non-infringement of design patent. In deciding an issue of first impression, the Court concluded “that the principles of prosecution history estoppel apply to design patents as well as utility patents.” During prosecution, the patent owner surrendered scope to traverse a restriction requirement. But, the accused design was not within the scope of the surrender so prosecution history estoppel did not apply. “[W]hile we look primarily to the wording of the claims in utility patents for the purpose of prosecution history estoppel, we must look at the

requisite drawings in design patents to determine whether a surrender has occurred.”

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