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Federal Circuit Patent Updates - January 2016

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Purdue Pharma L.P. v. Epic Pharma, LLC **(No. 2014-1294, 2/3/16) (Prost, Reyna, Stark)**

February 1, 2016 9:22 AM

Prost, J. Affirming finding that formulation patents were obvious and anticipated in Hatch-Waxman case. With respect to one patent, the district court correctly disregarded process limitations in a product by process claim when evaluating obviousness. With respect to a second patent, testing showed a claim limitation was inherent in the prior art reference, and the district court did not improperly combine discrete disclosures of the prior art reference.

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

Akzo Nobel Coatings, Inc. v. Dow Chemical Company **(No. 2015-1331, 2015-1389, 1/29/16) (Lourie, Reyna, Chen)**

January 29, 2016 6:43 PM

Lourie, J. Affirming summary judgment of non-infringement and that the claims are not indefinite. An expert's conclusory declaration did not create an issue of fact on the doctrine of equivalents. In affirming the summary judgment regarding definiteness, the Court found the district court's evaluation of the extrinsic evidence not “clearly erroneous.”

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

Avid Technology, Inc. v. Harmonic, Inc. **(No. 2015-1246, 1/29/16) (Reyna, Taranto, Stoll)**

January 29, 2016 4:54 PM

Taranto, J. Where there was a general verdict of infringement, a remand for a new trial was required based on an unduly narrow claim construction of one element, but the evidence did not compel a finding of infringement of another element, that had not been construed by the district court. The claim construction error was the result of an incorrect finding of a disclaimer in the file history.

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Agilent Technologies v. Waters Technologies **(No. 2015-1280, 1/29/16) (Moore, O'Malley, Taranto)**

January 29, 2016 2:06 PM

O'Malley, J. Dismissing appeal of an inter partes reexamination because appellant was not the same as the third-party requester and did not demonstrate that it was the requester's successor-in-interest.

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

Lumen View Technology LLC v. Findthebest.com, Inc. **(No. 2015-1275, 2015-1325, 1/22/16) (Lourie, Moore, Wallach)**

January 22, 2016 1:44 PM

Lourie, J. Affirming finding that case was exceptional based on a frivolous infringement theory but remanding based on the failure of the district court to justify award of a multiplier on the defendant's fees.

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

Pfizer Inc. v. Lee **(No. 2015-1265, 1/22/16) (Newman, Dyke, O'Malley)**

January 22, 2015 10:28 AM

O'Malley, J. Affirming district court's decision that Patent Office had properly calculated a patent term adjustment. The examiner's initial rejection, which included an incorrect restriction requirement that was replaced by a later corrected office action, was sufficiently clear to stop the delay period from accruing after it issued. Newman, J., dissented.

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

Mortgage Grader, Inc. v. First Choice Loan Services **(No. 2015-1415, 1/20/16) (O'Malley, Taranto, Stark)**

January 20, 2016 3:35 PM

Stark, J. Affirming summary judgment that claims directed to methods for evaluating loan packages were directed to ineligible subject matter. In addition, the district court did not abuse its discretion in refusing to strike defendant's invalidity contentions, which were justified in adding a 101 defense after *Alice Corp. v. CLS Bank* was decided by the Supreme Court.

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

Biomet Orthopedics, LLC v. Puget Bioventures, LLC **(No. 2015-1468, 1/14/16) (Moore, O'Malley, Taranto)**

January 14, 2016 1:15 PM

Moore, J. Vacating Board decision for some claims, and affirming Board decision for other claims, in inter partes reexamination. The patent expired after the Board decision but before the Court's decision. “This case presents an unusual procedural issue… Amendments are not effective until the certificate issues… Thus, the [amended claims] cannot issue. We therefore vacate the Board's decision with respect to the [amended claims] and remand for the PTO to take whatever action it deems appropriate.”

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

Ethicon Endo-Surgery, Inc. v. Covidien LP **(No. 2014-1771, 1/13/16) (Newman, Dyk, Taranto)**

January 13, 2016 10:28 AM

Dyk, J. Affirming Board decision in IPR finding claims related to a surgical device obvious. “[W]e hold that neither the statute nor the Constitution precludes the same panel of the Board that made the decision to institute inter partes review from making the final determination.” The Court also held that “35 U.S.C. § 314(d) does not preclude us from hearing [patent owner's] challenge to the authority of the Board to render a final decision.” Newman, J. dissented..

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

In re Urbanski **(No. 2015-1272, 1/8/16) (Lourie, Bryson, Chen)**

January 8, 2016 12:52 PM

Lourie, J. Affirming Board's decision that claims related to enzymatic hydrolysis of soy fiber are obvious over the combination of two references, Gross and Wong. “As the Board properly found, one of ordinary skill would have been motivated to pursue the desirable properties taught by Wong, even if that meant forgoing the benefit taught by Gross. And [the] claims do not require Gross's benefit that is arguably lost by combination with Wong. The Board therefore did not err in rejecting [applicant's] inoperability argument.”

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

Wi-Lan, Inc. v. Apple Inc. **(No. 2014-1437, 2014-1485, 1/8/16) (Reyna, Wallach, Hughes)**

January 8, 2016 4:41 PM

Reyna, J. Affirming district court's denial of JMOL as to non-infringement because the jury's verdict of non-infringement was supported by substantial evidence. Also, reversing district court's JMOL determination of no invalidity because that determination was based on a “post-verdict reconstruction of the claims.” Regarding non-infringement, use of the term “the” in the claims imposed an order, requiring data symbols to be randomized before being combined. Because the accused products do not use the claimed order, they do not infringe literally or by equivalents. It was reasonable for the jury to conclude that the differences between the claim and the accused product were substantial based on expert testimony that the accused products, which contain millions of transistors, eliminate in the relevant portion of the chip “20 out of a few hundred transistors.”

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