

---

## Federal Circuit Patent Updates - July 2014

JULY 25, 2014

[View previous updates...](#)

***ePlus, Inc. v. Lawson Software, Inc.* (No. 2013-1506, -1587, 7/25/14) (Prost, Dyk, O'Malley)**

July 25, 2014 11:43 AM

Dyk, J. Following a partial reversal of an infringement finding in a prior appeal, the Federal Circuit remanded to the district court to make modifications to the injunction in light of the claims that survived appeal. On remand, the district court modified the injunction and also found the defendant in contempt with respect to the surviving claim. While the second appeal was pending, the Federal Circuit affirmed a reexamination decision holding the surviving claim invalid. Because the injunction decision was not final at the time the district court imposed contempt sanctions, the intervening cancellation of the claim on which the contempt sanctions were based required that the sanctions be vacated. O'Malley, J. dissented.

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

***In re: Nokia Inc.* (No. 2014-133, 7/23/14) (Newman, Mayer, Bryson)**

July 23, 2014 4:25 PM

Per Curiam. Denying mandamus petition to enforce prior mandate. The Court's prior decision noting that ITC could consider the issue of infringement on remand did not preclude Commission from finding that issue was waived. Newman, J. dissented.

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

***Align Technology, Inc. v. ITC* (No. 2013-1240, 7/18/14) (Prost, Chen)**

July 18, 2014 9:00 AM

Chen, J. Vacating ITC decision that reversed an ALJ order (not initial determination) denying a motion to terminate an investigation. The Commission did not have authority to review the ALJ order. "Whether an ALJ's ruling issues as an initial determination or an order is important because it determines whether the Commission may review the ALJ's decision. ...[T]he rules clearly

prohibited the Commission from reviewing orders like this one."

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

***Arlington Industries, Inc. v. Bridgeport Fittings, Inc.* (No. 2013-1357, 7/17/14) (Chen, Clevenger, Hughes)**

July 17, 2014 3:45 PM

Hughes, J. Dismissing appeal of contempt order for lack of jurisdiction where the contempt order (that did not determine any sanctions for contempt) was not a final judgment or otherwise appealable.

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

***In re: Rajen Patel* (No. 2013-1301, 7/16/14) (O'Malley, Hughes)**

July 16, 2014 7:35 PM

O'Malley, J. Affirming in part and vacating in part PTAB decision of obviousness; the PTAB erred in finding that the examiner established a prima facie case of obviousness for certain claims. "Depending on the technology, even small differences in formulations can be meaningful. Where differences clearly exist and there is no evidence that they are either not meaningful or one of skill in the art would know to discard the limits set by the prior art, proximity alone is not enough to establish a prima facie case of obviousness. We find that the PTAB erred in finding that the examiner established a prima facie case of obviousness solely because the claimed range and the prior art range approach one another."

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

***Medisim LTD. v. BestMed, LLC* (No. 2013-13145140, 7/14/14) (Prost, Taranto, Chen)**

July 14, 2014 12:15 PM

Prost, C. J. Vacating JMOL of invalidity for anticipation because the defendant failed to preserve its right to JMOL of anticipation under Federal Rule of Civil Procedure 50; however, affirming the district court's conditional grant of a new trial on anticipation and JMOL of no unjust enrichment. "[O]ur Federal Rules of Civil Procedure are to be strictly followed in circumstances such as this one." Argument by the defendant in opposition to the plaintiff's motion for JMOL of no anticipation did not preserve the defendant's right to move itself for JMOL of anticipation. "BestMed's counsel made this statement in opposition to Medisim's motion for JMOL under Rule 50(a); BestMed never moved on its own for JMOL on anticipation before the case was submitted to the jury."

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

***Golden Bridge Technology v. Apple Inc.* (No. 2013-1496, 7/14/14) (Moore, Mayer, Chen)**

July 14, 2014 1:20 PM

Moore, J. Affirming summary judgment of noninfringement. "GBT's submissions [in an IDS] during prosecution of its stipulated construction [in a district court litigation] for the term preamble constitute disclaimer." "Although our precedent allows applicants to rescind a disclaimer during prosecution, GBT did not avail itself of this route and never notified the PTO that it sought a meaning of preamble that was different from its stipulated construction." "An argument made for the first time in a motion for reconsideration comes too late and is ordinarily deemed waived."

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

***Troy v. Samson Manufacturing Corp. (No. 2013-1565, 7/11/14) (Prost, Bryson, Moore)***

July 11, 2014 11:30 AM

Moore, J. Vacating and remanding judgment in a civil action under 35 U.S.C. § 146 because the district court erred in refusing to consider evidence pertinent to the determination of priority. "We conclude that the Supreme Court's decision in Hyatt permits new evidence to be admitted without regard to whether the issue was raised before the Board. The Supreme Court held, without qualification, that "there are no evidentiary restrictions beyond those already imposed by the Federal Rules of Evidence and the Federal Rules of Civil Procedure"." "We ... conclude that the Supreme Court's decision in Hyatt applies with equal force to both § 145 and § 146 actions."

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

***H-W Technology, L.C. v. Overstock.com, Inc. (No. 2014-1054, 7/11/14) (Prost, O'Malley)***

July 11, 2014 2:38 PM

Prost, C. J. Affirming judgment (as modified) that claim was invalid as indefinite because it combined two statutory classes of invention (apparatus and method limitations). Another claim that was defective as issued could not be asserted because it was not corrected by the PTO before the lawsuit was filed and could not be corrected by the district court. "When, as here, a claim issues that omits a material limitation, and such omission is not evident on the face of the patent, the patentee cannot assert that claim until it has been corrected by the PTO." A certificate of correction was issued by the PTO, but "the certificate of correction is only effective for causes of action arising after it was issued.... Here, H-W filed this suit before the certificate of correction issued, and neither party has argued that this suit involves causes of action arising after the certificate of correction issued." The district court could not correct the error, because "the error is not evident from the face of the patent. Claim 9 reads coherently without the missing limitation. Nothing in the surrounding claim language indicates that the limitation was missing." "The parties appear to agree that the PTO's error is clear on the face of the prosecution history. But this court has already deemed evidence of error in the prosecution history alone insufficient to allow the district court to correct the error."

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

***Digitech Image Technologies v. Electronics for Imaging, Inc. (No. 2013-1600, 7/11/14) (Moore, Reyna, Hughes)***

July 11, 2014 10:20 AM

Reyna, J. Affirming summary judgment that the asserted claims were invalid under 35 U.S.C. § 101. “[T]he device profile described in the ’415 patent is not a tangible or physical thing and thus does not fall within any of the categories of eligible subject matter.” “The method in the ’415 patent claims an abstract idea because it describes a process of organizing information through mathematical correlations and is not tied to a specific structure or machine.”

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

***Stauffer v. Brooks Brothers, Inc.* (No. 2013-1180, 7/10/14) (Lourie, Schall, Moore)**

July 10, 2014 7:15 PM

Schall, J. Affirming dismissal of false marking suit for lack of standing due to the elimination of the qui tam provision of the false-marking statute. “[T]he AIA amendment to the false-marking statute that eliminated liability for expired patents does not constitute an impermissible pardon.”

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

***Virtualagility Inc. v. Salesforce.com, Inc.* (No. 2014-1340, 7/10/14) (Newman, Moore, Chen)**

July 10, 2014 8:50 AM

Moore, J. Reversing denial of motion to stay lawsuit pending post-grant review of the validity of the asserted claims under the Transitional Program for Covered Business Method Patents (CBM program) as an abuse of discretion. “The district court erred as a matter of law to the extent that it decided to “review” the PTAB’s determination that the claims of the ’413 patent are more likely than not invalid in the posture of a ruling on a motion to stay. Under the statutory scheme, district courts have no role in reviewing the PTAB’s determinations regarding the patentability of claims that are subject to CBM proceedings.” “In this case, the PTAB expressly determined that all of the claims are more likely than not unpatentable. This CBM review could dispose of the entire litigation: the ultimate simplification of issues. ... This weighs heavily in favor of granting the stay.” “Failure to include other known prior art in the CBM petition could ... create a potential tactical advantage for Defendants that would weigh against a stay ....” “Generally, the time of the motion [to stay] is the relevant time to measure the stage of litigation.” “We agree with the district court that competition between parties can weigh in favor of finding undue prejudice.” Newman, J., dissents.

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

***X2Y Attenuators, LLC v. ITC* (No. 2013-1340, 7/7/14) (Moore, Reyna, Wallach)**

July 7, 2014 11:10 AM

Moore, J. Affirming ITC final determination of no violation of 19 U.S.C. § 1337. “The standard for finding disavowal, while exacting, was met in this case.” Reyna, J. concurred.

WilmerHale represented intervenors, Intel Corporation, Intel Americas, Inc., Componentes Intel de Costa Rica S.A., Intel Technology SDN. BHD, Intel Products (Chengdu) Ltd., Apple Inc., and Hewlett-Packard Company.

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

***Retractable Technologies, Inc. v. Becton Dickinson and Company* (No. 2013-1567, 7/7/14)  
(Lourie, Linn)**

July 7, 2014 1:30 PM

Linn, J. Under mandate rule, affirming denial of motion to modify damages award following partially successful appeal of infringement judgment on which the damages award was based.

WilmerHale represented defendant-appellant, Becton Dickinson and Company.

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

***AbbVie Deutschland GmbH & Co. v. Janssen BioTech, Inc.* (No. 2013-1338, 7/1/14) (Lourie, O'Malley, Chen)**

July 1, 2014 10:30 AM

Lourie, J. Affirming denial of JMOL and finding that substantial evidence supported verdict of invalidity due to lack of *written description* for patents related to human antibodies that bind to interleukin 12. "With the written description of a genus, however, merely drawing a fence around a perceived genus is not a description of the genus. One needs to show that one has truly invented the genus, *i.e.*, that one has conceived and described sufficient representative species encompassing the breadth of the genus... Here, the jury heard ample evidence that [plaintiff's] patents only describe one type of structurally similar antibodies and that those antibodies are not representative of the full variety or scope of the genus." Also finding that collateral estoppel did not apply to issues decided by the Board in an interference. "Whether a Board's interference decision that is on appeal under § 141 can have collateral estoppel effect on issues raised in a co-pending litigation is another question, one we need not address here. Here, [defendants] initiated the § 146 action at the district court within the statutorily prescribed time period and was thus entitled to present new evidence at least with respect to the issues of priority and obviousness in the underlying interference action. The factual record in the interference action was therefore open as to those issues, subject to a *de novo* determination by the district court. Consequently, the Board's priority and nonobviousness decisions lacked the requisite finality for purposes of collateral estoppel." O'Malley, J. concurred.

WilmerHale represented appellants, AbbVie Deutschland GMBH & Co., KG, AbbVie Bioresearch Center, Inc., and AbbVie Biotechnology, Ltd."

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

***MadStad Engineering, Inc. v. Pato* (No. 2013-1512, 7/1/14) (Newman, O'Malley, Wallach)**

July 1, 2014 7:42 PM

O'Malley, J. Affirming dismissal, due to lack of standing, of complaint challenging constitutionality of first-inventor-to-file provision of the America Invents Act.

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