
Federal Circuit Patent Updates - July 2016

JULY 2016

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***Advanced Ground Information v. Life360, Inc.* (No. 2015-1732, 7/28/16) (Moore, Mayer, Wallach)**

July 28, 2016 3:22 PM

Wallach, J. Affirming decision that claims are indefinite. The claim term “symbol generator” invoked “the application of § 112, ¶ 6 because it fails to describe a sufficient structure and otherwise recites abstract elements 'for causing actions' [citation omitted], or elements 'that can perform functions [citation omitted]'... A patentee cannot claim a means for performing a specific function and subsequently disclose a 'general purpose computer as the structure designed to perform that function' because this amounts to pure functional claiming. [citation omitted] Accordingly, because the specifications of the patents-in-suit do not disclose sufficient structure for the 'symbol generator' function and the asserted claims include this term, the asserted claims are indefinite under 35 U.S.C. § 112, ¶ 2.”

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

***Verinata Health, Inc. v. Ariosa Diagnostics, Inc.* (No. 2015-1970, 7/26/16) (Reyna, Clevenger, Wallach)**

July 26, 2016 10:35 AM

Reyna, J. Affirming order denying compulsory arbitration.

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

***In Re Magnum Oil Tools International* (No. 2015-1300, 7/25/16) (Newman, O'Malley, Chen)**

July 25, 2016 10:43 AM

O'Malley, J. Reversing Board decision in IPR. The Board's final written decision found claims relating to oil drilling obvious. But, the Board improperly shifted the burden of proof to the patentee. Regarding burdens, “[w]here, as here, the only question presented is whether due consideration of the four *Graham* factors renders a claim or claims obvious, no burden shifts from the patent

challenger to the patentee. This is especially true where the only issues to be considered are what the prior art discloses, whether there would have been a motivation to combine the prior art, and whether that combination would render the patented claims obvious... Instead, the petitioner continues to bear the burden of proving unpatentability after institution, and must do so by a preponderance of the evidence at trial. [citation omitted] And, the Board has an obligation to assess the question anew after trial based on the totality of the record.” Regarding appeal to the Federal Circuit, “[n]owhere does the statute granting parties the right to appeal a final written decision in an IPR require that the party first file a request for rehearing before the Board, especially a rehearing of the initial institution decision. Instead, a party who is dissatisfied with the final written decision of the Board can elect to directly appeal that decision.”

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

Unwired Planet, LLC v. Apple Inc. (No. 2015-1725, 7/22/16) (Moore, Bryson, Reyna)

July 22, 2016 2:18 PM

Moore, J. Reversing construction of the claim term “voice input” in patent related to speech recognition in mobile phones and vacating summary judgment of non-infringement because it was based on an erroneous construction. Also reversing construction of the claim term “user information” in another patent related to mobile phones and vacating summary judgment of non-infringement of that patent. Also affirming summary judgment of non-infringement of another patent related to mobile phones. Also vacating summary judgment of no indirect infringement for another patent related to mobile phones.

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

Polar Electro Oy v. Suunto Oy (No. 2015-1930, 7/20/16) (Newman, Lourie, Chen)

July 20, 2016 10:37 AM

Lourie, J. Vacating and remanding because the district court improperly granted a motion to dismiss. Significant discussion of due process. “This is not a case where a small manufacturer sells its products to an independent distributor, who then distributes the products to consumers across the nation. [Defendant] did not simply place its products in the stream of commerce, with the products fortuitously reaching Delaware as a result of the unilateral effort of [its sister company]. Rather, ‘acting in consort’ with [its sister company, defendant] deliberately and purposefully shipped the accused products to Delaware retailers. [Defendant’s] active participation in supplying and shipping the accused products to Delaware thus constitutes purposeful availment.”

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

WBIP, LLC v. Kohler Co. (No. 2015-1038, -1044, 7/19/16) (Moore, O’Malley, Chen)

July 19, 2016 4:22 PM

Moore, J. Affirming decision that claims related to marine generators are not obvious and did not

lack written description. Significant discussion of objective considerations of non-obviousness. “[Patentee] was entitled to the presumption of nexus for its objective evidence of non-obviousness because it established that the specific products [] are embodiments of the invention in the asserted claims... We further reject [defendant’s] categorical claim that objective evidence must be tied exclusively to claim elements that are not disclosed in a particular prior art reference in order for that evidence to carry substantial weight.” Regarding long-felt need, “[w]e similarly reject [defendant’s] argument that the product liability suits are irrelevant to whether there was a long-felt need for a solution to carbon monoxide poisoning on boats and whether this need was met by the claimed invention.” Also affirming decisions of willful infringement and to enhance damages by 50%. Also vacating denial of motion for permanent injunction and remanding... The district court’s decision is based on its reasoning that having more manufacturers of a lifesaving good in the market is better for the public interest. But this reasoning is true in nearly every situation involving such goods, such that, if it alone is sufficient, it would create a categorical rule denying permanent injunctions for life-saving goods, such as many patented pharmaceutical products. In denying [patentee] a permanent injunction on these grounds, the district court abused its discretion.”

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

***Skyhawk Technologies, LLC v. Deca Int. Corp.* (No. 2016-1325, -1326, 7/15/16) (Taranto, Chen, Hughes)**

July 15, 2016 10:19 AM

Hughes, J. No appellate jurisdiction to consider claim construction in appeal by patent owner that won IPR. “While administrative decisions by the US Patent and Trademark Office can ground issue preclusion in district court when the ordinary elements of issue preclusion are met, . . . we cannot foresee how the claim construction reached by the Board in this case could satisfy those ordinary elements.”

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

***The Medicines Company v. Hospira, Inc.* (No. 2014-1469, -1504, 7/11/16) (Prost, Newman, Lourie, Dyk, Moore, O’Malley, Reyna, Wallach, Taranto, Chen, Hughes and Stoll)**

July 11, 2016 3:40 PM

O’Malley, J. Before the critical date, the patentee paid a third party for “manufacturing services” to make substantial amount of the patented product. These transactions did not constitute an on-sale bar because “(1) only manufacturing services were sold to the inventor—the invention was not; (2) the inventor maintained control of the invention, as shown by the retention of title to the embodiments and the absence of any authorization to Ben Venue to sell the product to others; and (3) “stockpiling,” standing alone, does not trigger the on-sale bar.”

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

***Amgen Inc. v. Apotex Inc.* (No. 2016-1308, 7/5/16) (Wallach, Bryson, Taranto)**

July 5, 2016 12:05 PM

Taranto, J. In a suit under the Biologics Price Competition and Innovation Act, affirming the grant of a preliminary injunction against the biologics license applicant entering the market unless it has given the patentee notice after receiving the requested FDA license and then waiting 180 days. “We hold that the commercial marketing provision is mandatory and enforceable by injunction even for an applicant” who “did launch the statutory process for exchanging patent information and channeling patent litigation.” “We conclude that an applicant must provide a reference product sponsor with 180 days’ post-licensure notice before commercial marketing begins, regardless of whether the applicant provided the (2)(A) notice of FDA review.”

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

Rapid Litigation Management v. CellzDirect, Inc. (No. 2015-1570, 7/5/16) (Prost, Moore, Stoll)

July 5, 2016 10:40 AM

Prost, C. J. Vacating summary judgment of invalidity under 35 U.S.C. § 101 because the claims were not directed to a patent-ineligible law of nature as the district court held. “The district court identified in these claims what it called a “natural law”—the [hepatocytes] cells’ capability of surviving multiple freeze-thaw cycles. We need not decide in this case whether the court’s labeling is correct. It is enough in this case to recognize that the claims are simply not directed to the ability of hepatocytes to survive multiple freeze-thaw cycles. Rather, the claims of the ’929 patent are directed to a new and useful laboratory technique for preserving hepatocytes. This type of constructive process, carried out by an artisan to achieve “a new and useful end,” is precisely the type of claim that is eligible for patenting.” “The inventors certainly discovered the cells’ ability to survive multiple freeze-thaw cycles, but that is not where they stopped, nor is it what they patented. ... They employed their natural discovery to create a new and improved way of preserving hepatocyte cells for later use.” “Repeating a step that the art taught should be performed only once can hardly be considered routine or conventional. This is true even though it was the inventor’s discovery of something natural that led them to do so.”

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