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Federal Circuit Patent Updates - June 2013

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***Ultramercial, Inc. v. Hulu, LLC* (2010-1544, 6/21/13) (Rader, Lourie, O'Malley)**

June 21, 2013 3:10 PM

Rader, J. Reversing dismissal due to lack of subject matter eligibility and remanding. The district court granted defendant's motion to dismiss under Rule 12(b)(6) finding that asserted claim, which relates to a method for distributing copyrighted material over the Internet, failed to satisfy 35 U.S.C. § 101. "[I]t will be rare that a patent infringement suit can be dismissed at the pleading stage for lack of patentable subject matter." Lourie, J. concurred.

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

***Novo Nordisk A/S v. Caraco Pharmaceutical* (2011-1223, 6/18/13) (Newman, Dyk, Prost)**

June 18, 2013 1:22 PM

Prost, J. Affirming determination that claim related to diabetes treatment was obvious and reversing determination that patent was unenforceable due to inequitable conduct. During prosecution, the examiner found that studies submitted by the patentee demonstrated synergy. The patentee argued "that if evidence presented at trial is not new evidence then the district court must defer to [such] findings of the examiner." The Court rejected patentee's argument stating "[n]o decision of the Supreme Court or this court has ever suggested that there is an added burden to overcome PTO findings in district court infringement proceedings…" Newman, J. concurred in the judgment of no inequitable conduct but dissented regarding obviousness.

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

***Bosch, LLC v. Pylon Manufacturing Corp.* (2011-1363, -1364, 6/14/13) (Rader, Newman, Lourie, Dyk, Prost, Moore, O'Malley, Reyna, Wallach)**

June 14, 2013 12:09 PM

Prost, J. The Court addressed two questions en banc: Does 28 U.S.C. § 1292(c)(2) confer

jurisdiction to entertain appeals from patent infringement liability determinations when (1) a trial on damages has not yet occurred and (2) willfulness issues are outstanding and remain undecided. "We answer both questions in the affirmative…" The majority opinion, which reviewed historical precedent at length, found that an "accounting" in the context of § 1292(c)(2) may include a trial on damages and determinations of willfulness. "Finally, we wish to make clear that district courts, in their discretion, may bifurcate willfulness and damages issues from liability issues in any given case. District courts have the authority to try these issues together or separately just as they have the authority to try all issues together at the liability stage. They may decide, for example, for reasons of efficiency due to the commonality of witnesses or issues in any particular case, that bifurcation is not warranted. District court judges, of course, are best positioned to make that determination on a case-by-case basis." In separate opinions, Moore, J. and Reyna, J., concurred-in-part and dissented-in-part. O'Malley J. and Wallach, J. dissented.

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

Association for Molecular Pathology v. Myriad Genetics, Inc. **(No. 12-398, 6/13/13)**

June 13, 2013 7:10 PM

Thomas, J. Unanimous decision holding that "[a] naturally occurring DNA segment is a product of nature and not patent eligible merely because it has been isolated, but cDNA is patent eligible because it is not naturally occurring." Scalia, J. concurred. Read the detailed report.

Organic Seed Growers and Trade v. Monsanto Company **(2012-1298, 6/10/13) (Dyk, Bryson, Moore)**

June 10, 2013 4:26 PM

Dyk, J. Affirming dismissal of declaratory judgment action due to lack of jurisdiction. Agricultural organizations sought declaratory judgments of non-infringement and invalidity of patents related to genetically modified seeds due to concern that they might be sued as a result of inadvertent contamination of their fields with patented seeds. Although the patent owner did not issue a covenant not to sue, other statements disclaiming intent to assert the patents against those who inadvertently use trace amounts of the patented seeds were sufficient to eliminate declaratory judgment jurisdiction.

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

Interdigital Communications v. ITC **(2012-1628, 6/7/13) (Lourie, Bryson, Prost)**

June 7 2013 7:10 PM

Prost. J. Reversing order to terminate investigation, in favor of arbitration, and remanding. The respondent moved to terminate the investigation arguing that it was licensed to sell the accused products and that the license agreement provided for arbitration of disputes.

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

Regents of Univ. of Minnesota v. AGA Medical Corporation **(2012-1167, 6/3/13) (Rader, Dyk, Wallach)**

June 3, 2013 5:06 PM

Dyk, J. Affirming summary judgment of non-infringement and invalidity of patents related to medical devices for repairing heart defects.

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

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