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## Federal Circuit Patent Updates - June 2015

JUNE 30, 2015

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***SpeedTrack, Inc. v. Office Depot, Inc.* (No. 2014-1475, 6/30/15) (Prost, Mayer, O'Malley)**

June 30, 2015 10:30 AM

O'Malley, J. Affirming summary judgment that Kessler doctrine precluded infringement claims. In the prior action, the plaintiff unsuccessfully asserted its patent against different defendants using the same software as used by the defendants in this action. The Kessler doctrine could be asserted by customers as well as manufacturers and barred the claim in full where defendants use of the software was "essentially" the same as the use in the prior action.

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

***Mohsenzadeh v. Lee* (No. 2014-1499, 6/25/15) (Moore, Schall, Reyna)**

June 25, 2015 1:12 PM

Reyna, J. Affirming PTO's calculation of patent term adjustment. The Patent Act "does not provide patent term adjustments in continuing applications based on delays in the prosecution of parent applications."

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

***Gaymar Industries, Inc. v. Cincinnati Sub-Zero Products* (No. 2014-1174, 6/25/15) (Prost, Bryson, Dyk)**

June 25, 2015 11:30 AM

Dyk, J. Reversing failure to award attorneys fees based on litigation misconduct by plaintiff. Arguments made by the plaintiffs could be characterized as overstatements or sloppy argument, but did not amount to misconduct.

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

***Internet Patents Corporation v. Active Network, Inc.* (No. 2014-1048, -1061, -1062, -1063,**

**6/23/15) (Newman, Moore, Reyna)**

June 23, 2015 4:40 PM

Newman, J. Affirming holding that claims were drawn to ineligible subject matter under Section 101 where claims were directed to abstract concept of retaining information lost in the navigation of online forms.

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

**G.D. Searle LLC v. Lupin Pharmaceuticals, Inc. (No. 2014-1476, 6/23/15) (Prost, Bryson, Hughes)**

June 23, 2015 12:05 PM

Bryson, J. Affirming invalidity of patent for obviousness-type-double patenting. Alleged error in filing application as a continuation in part rather than as a divisional application not correctable by reissue where reissue application was not descended from divisional application. Section 121 safe harbor also not applicable where restriction requirement of reference patent did not carry forward to subsequent application which was a result of a later restriction requirement on a different application.

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

**Lighting Ballast Control LLC v. Philips Electronics North America (No. 2012-1014, 6/23/15) (Lourie, O'Malley, Reyna)**

June 23, 2015 10:33 AM

Reyna, J. Following remand from Supreme Court for reconsideration in light of *Teva v. Sandoz*, affirming district court's factual finding concluding that claim element was not a means-plus-function element under §112, ¶6 where finding was supported by the extrinsic evidence (in its prior opinion, the Panel had reversed the district court). The Court also made three waiver findings: (1) the issue of whether the claim element was governed by §112, ¶6 (and whether, if it was, the claim was indefinite for lack of corresponding structure) was preserved by the parties' pre-trial motions notwithstanding the failure to present the issue in post-trial motions, (2) a second claim construction ruling that, if reversed, would allegedly have led to a finding of anticipation was not preserved where it was only made in the course of a denial of a motion for summary judgment by the defendant and (3) a requested claim construction made for the first time in post-trial motions was not preserved.

A full version of the text is not available at this time.

**Tomtom, Inc. v. Adolph (No. 2014-1699, 6/19/15) (Wallach, Hughes, Fogel [of the N.D. Cal., sitting by designation])**

June 19, 2015 3:50 PM

Wallach, J. Reversing judgment of noninfringement because of erroneous claim construction and

remanding. A portion of a claim preamble was a limitation, while the rest of the preamble was not; “the court erred in determining that it had to construe the entire preamble if it construed a portion of it.”

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

***Teva Pharmaceuticals USA v. Sandoz Inc.* (No. 2012-1567, 6/18/15) (Moore, Mayer, Wallach)**

June 18, 2015 2:40 PM

Moore, J. Upon remand from the Supreme Court, “[a]pplying the legal standards set forth in the Supreme Court’s *Teva* and *Nautilus II* decisions, we hold that the Group I claims are invalid for indefiniteness.” “A party cannot transform into a factual matter the internal coherence and context assessment of the patent simply by having an expert offer an opinion on it. The internal coherence and context assessment of the patent, and whether it conveys claim meaning with reasonable certainty, are questions of law.” “*Teva* cannot transform legal analysis about the meaning or significance of the intrinsic evidence into a factual question simply by having an expert testify on it.” “A statement made during prosecution of related patents may be properly considered in construing a term common to those patents, regardless of whether the statement pre- or post-dates the issuance of the particular patent at issue.”

A full version of the text is not available at this time.

***ePlus, Inc. v. Lawson Software, Inc.* [Order en banc rehearing] (No. 2013-1506, 6/18/15) (en banc)**

June 18, 2015 11:15 AM

Per Curiam. Order denying rehearing en banc in case 2013-1506 above. Newman, O’Malley, Moore, Reyna, and Wallach, JJ., dissented.

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

***ePlus, Inc. v. Lawson Software, Inc.* [Revised Majority Opinion] (No. 2013-1506, 6/18/15) (Prost, Dyk, O’Malley)**

June 18, 2015 11:15 AM

Dyk, J. Vacating injunction and contempt order that were based on a patent claim that the PTO later cancelled in reexamination. “[A]n injunction can [not] continue after the PTO has cancelled the only claim on which the injunction was based. ...[C]ivil contempt remedies based on the violation of an injunction are [not] appropriate when the injunction has been overturned on direct appeal.” O’Malley, J., dissented.

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

***Richard Williamson v. Citrix Online, LLC* (No. 2013-1130, 6/16/15) (portion of opinion en banc; the rest panel of Moore, Lin, Reyna)**

June 16, 2015 9:44 AM

Linn, J. Vacating judgment of noninfringement certain claims and affirming judgment of invalidity of other claims. Overruling certain precedent regarding the application of 35 U.S.C. § 112, 6. Prior precedent “established a heightened bar to overcoming the presumption that a limitation expressed in functional language without using the word “means” is not subject to § 112, para. 6. Our consideration of this case has led us to conclude that such a heightened burden is unjustified and that we should abandon characterizing as “strong” the presumption that a limitation lacking the word “means” is not subject to § 112, para. 6. That characterization is unwarranted, is uncertain in meaning and application, and has the inappropriate practical effect of placing a thumb on what should otherwise be a balanced analytical scale. It has shifted the balance struck by Congress in passing § 112, para. 6 and has resulted in a proliferation of functional claiming untethered to § 112, para. 6 and free of the strictures set forth in the statute.” “[We] expressly overrule the characterization of that presumption as “strong.” We also overrule the strict requirement of “a showing that the limitation essentially is devoid of anything that can be construed as structure.” The standard is whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure.” “Module” is a well-known nonce word that can operate as a substitute for “means” in the context of § 112, para. 6.” “The prefix “distributed learning control” does not impart structure into the term “module.”” “[T]he fact that one of skill in the art could program a computer to perform the recited functions cannot create structure where none otherwise is disclosed.” Reyna, J., concurred in part and dissented in part. Newman, J., dissented..

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

***Microsoft Corporation v. Proxyconn, Inc.* (No. 2014-1542, 6/16/15) (Prost, Lourie, Gilstrap [from the E.D. Tex., sitting by designation])**

June 16, 2015 1:05 PM

Prost, C .J. Affirming in part and vacating in part PTAB decision in an inter partes review. Certain of the PTAB’s unpatentability determinations were based on “unreasonably broad constructions” of claim terms. Affirming denial of the patentee’s motion to amend. 37 C.F.R. “§ 42.121(a)(2) is not an exhaustive list of grounds upon which the Board can deny a motion to amend.”

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

***Cephalon, Inc. v. Abraxis Bioscience, LLC* (No. 2014-1411 6/17/15) (Wallach, Mayer, Chen)**

June 17, 2015 3:10 PM

Wallach, J. Affirming judgment of noninfringement. In construing claim terms, “[t]he terms “microparticles” and “nanoparticles” are technical words, and how the relevant scientific community understands them is therefore a question of fact reviewable for clear error.” However, “a definition need not be universally accepted to form a proper basis for claim construction.”

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

***GTNX, Inc. v. INTTRA, Inc.* (No. 2015-1349, 6/16/15) (Dyk, Taranto, Chen)**

June 16, 2015 10:45 AM

Taranto, J. Order dismissing appeal and denying mandamus following PTAB termination of covered business method patent review. “GTNX’s appeal falls outside 35 U.S.C. §§ 141 and 329 and hence outside this court’s jurisdiction under 28 U.S.C. § 1295(a)(4)(A).”

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

***Ariosa Diagnostics, Inc. v. Sequenom, Inc.* (No. 2014-1139, 6/12/15) (Reyna, Linn, Wallach)**

June 12, 2015 4:40 PM

Reyna, J. Affirming summary judgment that asserted claims were invalid under 35 U.S.C. § 101 for failure to claim patentable subject matter.

The claims were directed to a paternity test involving detecting paternal DNA in maternal blood. “Where claims of a method patent are directed to an application that starts and ends with a naturally occurring phenomenon, the patent fails to disclose patent eligible subject matter if the methods themselves are conventional, routine and well understood applications in the art.” “Sequenom and amici encourage us to draw distinctions among natural phenomena based on whether or not they will interfere significantly with innovation in other fields now or in the future. The Supreme Court cases, however, have not distinguished among different laws of nature or natural phenomenon according to whether or not the principles they embody are sufficiently narrow.” “We do not disagree that detecting cfDNA in maternal plasma or serum that before was discarded as waste material is a positive and valuable contribution to science. But even such valuable contributions can fall short of statutory patentable subject matter, as it does here.” Linn, J., concurred.

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

***OIP Technologies, Inc. v. Amazon.com, Inc.* (No. 2012-1696, 6/11/15) (Taranto, Mayer, Hughes)**

June 11, 2015 11:10 AM

Hughes, J. Affirming judgment on the pleadings that patent was invalid under 35 U.S.C. § 101 for failure to claim patentable subject matter. “[T]he patent-in-suit claims no more than an abstract idea coupled with routine data-gathering steps and conventional computer activity....” “At best, the claims describe the automation of the fundamental economic concept of offer-based price optimization through the use of generic-computer functions.” “But relying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible.” Mayer, J., concurred.

A full version of the text is not available at this time.

***Kaneka Corporation v. Xiamen Kingdomway* (No. 2014-1373, 6/10/15) (Newman, Reyna, Hughes)**

June 10, 2015 3:20 PM

Reyna, J. Affirming in part and vacating in part summary judgment of noninfringement because of erroneous claim construction and remanding. "Summary judgment should ordinarily be vacated or reversed if the district court bases summary judgment on an erroneous claim construction."

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

***Apls South, LLC v. Ohio Willow Wood Co.* (No. 2013-1452, -1488, 2014-1147, -1426, 6/5/15)  
(Lourie, Moore, Chen)**

June 5, 2015 9:44 AM

Chen, J. Vacating judgment and remanding with instructions to dismiss due to lack of standing. "Precedent dictates that the original [license] agreement's field of use restriction is fatal to [plaintiff's] argument that it had standing to file this action." Also, plaintiff's attempt to cure its standing deficiency with a *nunc pro tunc* assignment was unsuccessful.

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

***Global Traffic Technologies v. Morgan* (No. 2014-1537, 2014-1566, 6/4/15) (Dyk, O'Malley, Taranto)**

June 4, 2015 2:13 PM

O'Malley, J. Reversing award of enhanced damages. Regarding enhanced damages, "the district court should have considered whether Appellants acted 'despite an objectively high likelihood that its actions constituted infringement of a valid patent.' This requires analysis of all the infringer's non-infringement and invalidity defenses, even if those defenses were developed for litigation." Also upholding the jury's finding that patentee complied with the marking statute. "[W]e hold that, when a patentee marks the packaging rather than the article, the district court should evaluate the specific character of the article at issue... This factual inquiry regarding the character of the patented article, moreover, may be submitted to a jury..." Also affirming finding of infringement.

WilmerHale represented the Defendants-Appellants.

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

***Shire Development v. Watson Pharmaceuticals* (No. 2013-1409, 6/3/15) (Prost, Chen, Hughes)**

May 18, 2015 4:12 PM

Hughes, J. On remand from the Supreme Court, reversing district court construction and findings of infringement, and remanding. In *Teva*, the Supreme Court "did not hold that a deferential standard of review is triggered any time a district court hears or receives extrinsic evidence. Here, there is no indication that the district court made any factual findings that underlie its constructions... Accordingly, we reverse the district court's constructions ... and its subsequent infringement determination, and we remand for proceedings consistent with this opinion."

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

