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## Federal Circuit Patent Updates - June 2017

JUNE 2017

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***Stanford University v. The Chinese Univ. of Hong Kong* (No. 2015-2011, 6/27/17) (O'Malley, Reyna, Chen)**

June 27, 2017 12:17 PM

O'Malley, J. In interference, vacating and remanding Board's decision that patent lacked written description for further fact finding of whether certain products referred to in specification would have been understood to practice aspect of claims. Also holding that discovery in district court proceeding commenced under 35 U.S.C. § 146 could not be relied on in appeal where district court lacked jurisdiction and case had been transferred to CAFC.

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

***Nantkwest, Inc. v. Matal* (No. 2016-1794, 6/23/17) (Prost, Dyk, Stoll)**

June 23, 2017 3:19 PM

Prost, J. Under 35 U.S.C. § 145 (appeal of PTO decision to the district court) "all expenses of the proceedings" provision authorizes an award of the USPTO's attorneys' fees. Stoll, J., dissented.

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

***Storer v. Clark* (No. 2015-1802, 6/21/17) (Prost, Newman, Dyk)**

June 21, 2017 8:42 AM

Newman, J. In interference, affirming Board finding that provisional application's disclosure of general schemes for synthesizing a class of compounds did not enable claimed compounds

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

***NexLearn, LLC v. Allen Interactions, Inc.* (No. 2016-2107, -2221, 6/19/17) (Moore, Schall, Hughes)**

June 19, 2017 10:09 AM

Moore, J. Affirming dismissal due to lack of personal jurisdiction. .

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

***The Cleveland Clinic v. True Health Diagnostics LLC (No. 2016-1766, 6/16/17) (Lourie, Reyna, Wallach)***

June 16, 2017 3:34 PM

Reyna, J. Affirming decision that claims relating to “testing for myeloperoxidase [MPO] in a bodily sample” and “treating a patient that has cardiovascular disease” are not directed to patent-eligible subject matter. The district court did not err in addressing only representative claims. “Each limitation [raised by the patentee], however, merely recites known methods of detecting MPO or MPO derivatives and applies the correlation between these biomarkers and cardiovascular health. Where, as here, the claims ‘are substantially similar and linked to the same’ law of nature, analyzing representative claims is proper.” Also, “it was appropriate for the district court to determine that the testing patents were ineligible under § 101 at the motion to dismiss stage.” Also affirming dismissal of contributory and induced infringement claims. “A party that provides a service, but no ‘material or apparatus,’ cannot be liable for contributory infringement.”

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

***Outdry Technologies v. Geox S.P.A. (No. 2016-1769, 6/16/17) (Dyk, Moore, Reyna)***

June 16, 2017 11:22 AM

Moore, J. Affirming Board decision in IPR that claims relating to waterproofing leather are obvious.

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

***EmeraChem Holdings, LLC v. Volkswagen Group of America (No. 2016-1984, 6/15/17) (Moore, Clevenger, Chen)***

June 15, 2017 9:41 AM

Moore, J. Affirming Board decision in IPR that some claims are obvious and remanding for other claims. The Board did not err in rejecting an inventor's declaration and finding the inventor's work to be prior art under § 102(e). “We do not hold that corroboration of an inventor's declaration is required in every case, but we recognize that corroborating an inventor's testimony is a well-established principle in our case law.” Regarding the remanded claims, “the Board violated the APA's requirements of notice and an opportunity to respond with regard to [a prior art reference]... Because we are unable to discern whether the Board found [that another prior art reference] does not disclose the dependent limitations in [some claims] we vacate the Board's decision as to these claims and remand for clarification.” “Where the petitioner uses certain prior art references to target specific claims with precision, or the Board does the same in its decision to institute, the patent owner is directed to particular bases for alleged obviousness. A general statement that lists all challenged claims and all asserted prior art is not a separate, additional articulation that *each* of the

claims may be obvious over any combination of *all* listed prior art.”

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

***One-E-Way, Inc. v. ITC* (No. 2016-2105, 6/12/17) (Prost, Wallach, Stoll)**

June 15, 2017 5:51 PM

Stoll, J. Reversing decision of indefiniteness because “the term virtually free from interference, as properly interpreted in light of the specification and prosecution history, would inform a person of ordinary skill in the art about the scope of the invention with reasonable certainty... While [patentee] did not define the scope of the term ‘virtually free from interference’ in a technical sense as both the ALJ and Respondents would seemingly require, the lack of a technical definition does not render the term indefinite.” Prost, J. dissented.

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

***Sandoz Inc. v. Amgen Inc.* (No. 2015-1039, -1195, 6/12/17)**

June 15, 2017 3:18 PM

Thomas, J. Affirming that “an injunction under federal law is not available to enforce 42 U.S.C. § 262(l)(2)(A),” which requires that an “applicant seeking FDA approval of a biosimilar must provide its application materials and manufacturing information to the manufacturer of the corresponding biologic within 20 days of the date the FDA notifies the applicant that it has accepted the application for review.” Remanding for determination of “whether California law would treat noncompliance with § 262(l)(2)(A) as ‘unlawful.’” Also reversing regarding a question of “whether the applicant must give notice to the manufacturer after, rather than before, obtaining a license from the FDA for its biosimilar. We conclude that an applicant may provide notice before obtaining a license.”

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

***Credit Acceptance Corp. v. Westlake Services* (No. 2016-2001, 6/9/17) (Dyk, Mayer, Reyna)**

June 9, 2017 9:20 AM

Dyk, J. Affirming Board decision in CBM proceeding that claims are directed to patent-ineligible subject matter. “We conclude that 35 U.S.C. § 325(e)(1) does not apply in a subsequent proceeding to claims upon which the Board declined to institute review.” Also, the Court had jurisdiction to hear patentee’s challenge to the Board’s decision that the petitioner was not estopped from seeking CBM review of the challenged claims. Mayer, J. dissented “from the court’s determination that we have jurisdiction to review a decision by the [Board] to deny a motion to terminate a post-grant review proceeding as barred by 35 U.S.C. § 325(e)(1).”

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

***New World International, Inc. v. Ford Global Technologies, LLC* (No. 2016-2097, 6/8/17) (Prost, Bryson, Wallach)**

June 8, 2017 3:36 PM

Bryson, J. Affirming dismissal due to lack of personal jurisdiction.

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

***Skky, Inc. v. MindGeek, S.A.R.L. (No. 2016-2018, 6/7/17) (Lourie, Reyna, Wallach)***

June 7, 2017 2:17 PM

Lourie, J. Affirming Board decision in IPR that claims are unpatentable. The Board did not err in concluding that “wireless device means” is not a means-plus-function term because it recites sufficient structure and does not recite functionality. Also, the Board did not err in finding that the claims do not require multiple processors or a specialized processor. Also, the Board did not abuse its discretion in not striking petitioner’s reply brief. The reply brief “responded to positions laid out by [patent owner] and the Board.”

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

***Secure Access, LLC v. PNC Bank National Association [order denying Pet RHG] (No. 2016-1353, 6/6/17) (Prost, Newman, Plager, Lourie, Dyk, Moore, O'Malley, Reyna, Wallach, Taranto, Chen, Hughes)***

June 6, 2017 12:39 PM

Per Curiam. Denying petitions for panel rehearing and for rehearing en banc.

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

***Rothschild Connected Devices v. Guardian Protection Services (No. 2016-2521, 6/5/17) (Prost, Mayer, Wallach)***

June 5, 2017 4:19 PM

Wallach, J. Reversing denial of award of attorney fees to the defendant and remanding. “The District Court clearly erred by failing to consider Rothschild’s willful ignorance of the prior art.” “The conclusory and unsupported statements from Rothschild’s counsel and founder that claim 1 of the ‘090 patent is valid have no evidentiary value.” “[I]n the absence of evidence demonstrating that Rothschild engaged in reasonable conduct before the District Court, the undisputed evidence regarding Rothschild’s vexatious litigation warrants an affirmative exceptional case finding here.” “The District Court erred as a matter of law when, as part of its analysis, it stated that an attorney fee award under § 285 would ‘contravene[] the aims of Rule 11[’s]’ safe-harbor provision.” Mayer, J., concurred.

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

***Checkpoint Systems, Inc. v. All-Tag Security S.A. (No. 2016-1397, 6/5/17) (Newman, Lourie, Moore)***

June 5, 2017 1:40 PM

Newman, J. Reversing finding of an exceptional case and award of attorney fees to the defendant.

“‘[M]otivation’ to harass or burden an opponent may be relevant to an ‘exceptional case’ finding.”

“However, motivation to implement the statutory patent right by bringing suit based on a reasonable belief in infringement is not an improper motive.” “[T]he record shows that the charge of infringement was reasonable and the litigation was not brought in bad faith or with abusive tactics.”

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

***Preston v. Nagel* (No. 2016-1524, 6/1/17) (Dyk, Taranto, Hughes)**

June 1, 2017 11:07 AM

Hughes, J. Dismissing appeal because the district court's remand of the case to state court for lack of subject matter jurisdiction that was appealed was unreviewable pursuant to 28 U.S.C. § 1447(d).

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