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## Federal Circuit Patent Updates - March 2016

MARCH 2016

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***Clare v. Chrysler Group LLC* (No. 2015-1999, 3/31/16) (Prost, Moore, Wallach)**

March 31, 2016 2:14 PM

Moore, J. Affirming summary judgment of non-infringement of patents related to storage compartment for pickup trucks. The Court rejected patentee's argument that the district court should not have construed limitations because their meaning was readily apparent to a lay person. "Although those words may be readily apparent to a lay person there existed a fundamental dispute regarding the scope of those limitations." The district court also was correct to provide the same construction for two different limitations.

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

***Romag Fasteners, Inc. v. Fossil, Inc.* (No. 2014-1856, 2014-1857, 3/31/16) (Dyk, Wallach, Hughes)**

March 31, 2016 12:05 PM

Dyk, J. Affirming reduction of patent damages due to latches because plaintiff delayed bringing suit until just before "Black Friday." Also affirming that plaintiff could not recover defendant's profits for trademark infringement because the jury had found that defendant's trademark infringement was not willful.

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

***ClearCorrect Operating, LLC v. ITC* (No. 2014-1527, 3/31/16) (Prost, Newman, Lourie, Dyk, Moore, O'Malley, Reyna, Wallach, Taranto, Chen, Hughes, Stoll)**

March 31, 2016 10:18 AM

Per Curiam. Denying petitions for rehearing en banc. Prost, J., O'Malley, J., and Wallach, J. filed a separate concurrence stating that the "panel majority was correct in interpreting the word 'articles' in Section 337 to mean 'material things.'" Newman, J. dissented.

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

***Shaw Industries Group v. Automated Creel Systems* (No. 2015-1116, 2015-1119, 3/23/16)  
(Moore, Reyna, Wallach)**

March 23, 2016 3:30 PM

Moore, J. Holding that the Court lacked jurisdiction to review PTAB's refusal to institute an IPR on some grounds on the basis that the grounds were redundant of the grounds on which institution had been granted. Also denying petition for a writ of mandamus on the same issue and finding that there would be no litigation estoppel related to the non-instituted ground. On the merits, vacating a finding that a limitation was not present in the art where the basis of the Board's decision was ambiguous. With respect to a cross-appeal, the Court held that it did not have jurisdiction to review the Board's decision to institute a second IPR as timely under §315(b) and affirmed the Board's obviousness determination on the merits. Reyna, J., concurred, writing separately to criticize the Board's "Redundancy Doctrine."

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

***MAG Aerospace Industries, Inc. v. B/E Aerospace, Inc.* (No. 2015-1370, 2015-1426, 3/23/16)  
(Prost, Mayer, Reyna)**

March 23, 2016 11:10 AM

Prost, J. Affirming summary judgment that claims were not infringed and summary judgment of no invalidity based on assignor estoppel.

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

***In Re Cree, Inc.* (No. 2015-1365, 3/21/16) (Chen, Clevenger, Bryson)**

March 21, 2016 2:11 PM

Bryson, J. Affirming PTAB decision in *ex parte* reexamination that claims were obvious.

WilmerHale represented the appellant.

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

***Acorda Therapeutics Inc. v. Mylan Pharmaceuticals Inc.* (No. 2015-1460, 3/18/16) (Newman, O'Malley, Taranto)**

March 18, 2016 4:45 PM

Taranto, J. Holding that Hatch-Waxman plaintiff had specific personal jurisdiction over defendant, while not addressing issue of general jurisdiction. "[I]t suffices for Delaware to meet the minimum-contacts requirement in the present cases that Mylan's ANDA filings and its distribution channels establish that Mylan plans to market its proposed drugs in Delaware and the lawsuit is about patent constraints on such in-State marketing." The defendant could not demonstrate "other

considerations [that] render jurisdiction unreasonable” where the burden of its litigating in Delaware would be modest. O’Malley, J., concurred, writing separately to find existence of general jurisdiction or, alternatively, special jurisdiction based on harm to Delaware plaintiffs.

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

***Dell Inc. v. Acceleron, LLC* (No. 2015-1513, -1514, 3/15/16) (Moore, Taranto, Hughes)**

March 15, 2016 1:09 PM

Taranto, J. On review of an IPR, vacating PTAB’s cancellation of claims where Board’s claim construction failed to give meaning to all of the claim terms and where finding that claim element was satisfied by specific figure in prior art was first advanced in oral argument. Other findings of the Board were affirmed.

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

***Halo Creative & Design v. Comptoir Des Indes Inc.* (No. 2015-1375, 3/14/16) (Dyk, Mayer, Hughes)**

March 14, 2016 2:50 PM

Dyk, J. Reversing dismissal of case on *forum non conveniens* grounds. The Federal Court of Canada was not an adequate alternative forum where the plaintiff’s “complaint seeks redress for alleged infringement of its United States intellectual property rights that occurred in the United States” and “[t]here is no evidence of any predicate act of infringement that occurred in Canada—let alone evidence that such a predicate act, if found, would enable the Federal Court of Canada under Canadian law to redress subsequent infringing acts in the United States.”

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

***In Re Varma* (No. 2015-1502, 3/10/16) (Wallach, Clevenger, Taranto)**

March 10, 2016 4:19 PM

Taranto, J. Reversing in part and vacating in part PTAB cancellation of claims in reexamination because of erroneous claim constructions. “Although the transitional term ‘comprising’ indicates that the claim is open-ended, the term does not render each limitation or phrase within the claim open-ended. ‘Comprising’ means that the claim can be met by a system that contains features over and above those specifically required by the claim element, but only if the system still satisfies the specific claim-element requirements: the claim does not cover systems whose unclaimed features make the claim elements no longer satisfied.” “For a dog owner to have ‘a dog that rolls over and fetches sticks,’ it does not suffice that he have two dogs, each able to perform just one of the tasks.” “[T]he principle that the same phrase in different claims of the same patent should have the same meaning is a strong one, overcome only if ‘it is clear’ that the same phrase has different meanings in different claims.”

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

***In Re Smith* (No. 2015-1664, 3/10/16) (Moore, Hughes, Stoll)**

March 10, 2016 3:41 PM

Stoll, J. Affirming PTO rejection of claims for claiming patent-ineligible subject matter under 35 U.S.C. § 101 and declining to review whether the PTO's 2014 Interim Guidance on Patent Subject Matter Eligibility exceeds the scope of § 101 and the Supreme Court's *Alice* decision. "[T]he claims cover only the abstract idea of rules for playing a wagering game and use conventional steps of shuffling and dealing a standard deck of cards." "That is not to say that all inventions in the gaming arts would be foreclosed from patent protection under § 101. We could envisage, for example, claims directed to conducting a game using a new or original deck of cards potentially surviving step two of *Alice*."

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

***Bamberg v. Dalvey* (No. 2015-1548, 3/9/16) (Moore, Hughes, Stoll)**

March 9, 2016 9:18 AM

Hughes, J. Affirming in part, vacating in part, reversing in part, and remanding summary judgment of noninfringement. The district court erred by importing limitations into certain claim steps and in granting summary judgment based on intervening rights. In determining whether intervening rights apply following reexamination, "amendments made during reexamination do not necessarily compel a conclusion that the scope of the claims has been substantively changed... This is true even where the claims at issue were amended during reexamination after a rejection based on prior art."

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

***In Re Queen's University at Kingston* (No. 2015-145, 3/7/16) (Lourie, O'Malley, Reyna)**

March 7, 2016 12:42 PM

O'Malley, J. Granting mandamus directing the district court to withdraw its order compelling production of petitioner's communications with its non-attorney patent agents. For the first time, "We ... recognize a patent-agent privilege extending to communications with non-attorney patent agents when those agents are acting within the agent's authorized practice of law before the Patent Office." Reyna, J., dissents.

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

***UltimatePointer, LLC v. Nintendo Co. Ltd.* (No. 2015-1297, 3/1/16) (Lourie, Dyk, Wallach)**

March 1, 2016 5:22 PM

Lourie, J. Affirming summary judgment of noninfringement and reversing summary judgment of invalidity for indefiniteness. Claim limitation of "an image sensor, said image sensor generating data" was not a combined apparatus/method limitation rendering the claim invalid because "the

'generating data' limitation reflects the capability of that structure rather than the activities of the user.” “Unlike the claims in *IPXL* and *Katz*, the claims do not recite functionality divorced from the cited structure. Therefore, the claims do not reflect an attempt to claim both an apparatus and a method, but instead claim an apparatus with particular capabilities.”

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

***Harmonic, Inc. v. Avid Technology, Inc.* (No. 2015-1072, 3/1/16) (Chen, Mayer, Stoll)**

March 1, 2016 1:12 PM

Stoll, J. Affirming PTAB confirmation of claims in an *inter partes* review (IPR) and concluding that the Court did not have jurisdiction to review the PTAB's decision to institute IPR on certain grounds but not on other grounds that the PTAB deemed “redundant.”

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

***Blue Calypso, LLC v. Groupon, Inc.* (No. 2015-1391, 3/1/16) (Reyna, Schall, Chen)**

March 1, 2016 10:19 AM

Chen, J. Affirming PTAB decision in a Covered Business Patent review that claims were anticipated but reversing PTAB conclusion that certain claim terms lacked written description support. A written report by a graduate student that was made available via a hyperlink on her personal webpage was not a “printed publication” that could be relied upon to prove unpatentability where there was no evidence that the report was viewed or downloaded, that a person skilled in the art would know the address of her webpage, or that the webpage address was indexed or locatable through a search engine. “The written description requirement is an important component of maintaining the integrity of our patent system.” Schall, J., dissented in part.

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