
Federal Circuit Patent Updates - March 2018

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***In Re Brandt* (No. 2016-2601, 3/27/18) (Lourie, Reyna, Taranto)**

March 27, 2018 5:07 PM

Reyna, J. Affirming PTAB rejection of application claims for obviousness. “Based on Appellants’ many concessions that there is no meaningful difference between the prior art’s disclosed range and the claimed range, the Board did not err in affirming the examiner’s obviousness rejection of these abutting ranges in this simple case.”

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

***DSS Technology Management v. Apple Inc.* (No. 2016-2523, -2524, 3/23/18) (Newman, O’Malley, Reyna)**

March 23, 2018 3:18 PM

O’Malley, J. Reversing Board decision of obviousness. The opinion reviews the *Arendi* standard for use of common sense in an obviousness analysis and found that the Board’s use of “ordinary creativity” did not satisfy the *Arendi* standard. Newman, J. dissented.

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

***In re: Power Integrations, Inc.* (No. 2017-1304, 3/19/18) (Moore, Mayer, Stoll)**

March 19, 2018 10:29 AM

Mayer, J. Reversing Board finding of anticipation because it was based on an unreasonably broad claim construction. In prior litigation, the district court construed the claim term “coupled” in the context of a circuit for reducing noise and found claims to be not invalid under that construction. The Court subsequently affirmed. In *ex parte* reexamination, the Board construed “coupled” more broadly and found the claims invalid over some of the same prior art used in the litigation. On appeal, the Court vacated the Board’s decision, finding that the “board had an obligation ... to evaluate [the district court construction] and to determine whether it was consistent with the

broadest reasonable construction.” On remand, the Board acknowledged that the Court “had expressed ‘concern’ that its original decision had failed to assess whether the district court’s interpretation of the word ‘coupled’ was consistent with the broadest reasonable construction of the term. [citation omitted] It concluded, however, that a comparison of its claim construction with that of the district court was ‘unwarranted.’ [citation omitted] In the board’s view, a district court’s construction is ‘typically’ narrower than the broadest reasonable construction of a term.” The Board then again found the claims invalid using the same construction of “coupled.” The Court found the Board’s construction of “coupled” to be overly expansive. “The board has had two opportunities to come up with a sustainable interpretation that differs from the one that survived litigation and has failed. We conclude that there is not one.”

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

***Dell Inc. v. Acceleron, LLC* (No. 2017-1101, 3/19/18) (Moore, Reyna, Taranto)**

March 19, 2018 4:51 PM

Reyna, J. Affirming Board decision in IPR to decline to consider a new argument on remand. At the IPR oral hearing, petitioner presented a new argument and patentee objected arguing that the argument was not timely raised and that it should be permitted to present evidence to rebut the new argument. The Board denied patentee’s objection and in a final written decision canceled claims. The Court subsequently remanded because the “Board denied [patentee] is procedural rights by relying in its decision on a factual assertion introduced into the proceeding only at oral argument, after [patentee] could meaningfully respond.” On remand, the Board declined to consider the argument that had been raised for the first time at the original oral hearing. “We find that under these circumstances, due process and preserving the Board’s discretion outweigh any negative effects of not invalidating a patent claim, especially since our decision does not preclude another party from challenging the validity of [the claim] on the same basis.”

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

***Hologic, Inc. v. Smith & Nephew, Inc.* (No. 2017-1389, 3/14/18) (Newman, Wallach, Stoll)**

March 14, 2018 11:38 AM

Stoll, J. Affirming Board decision in inter partes reexamination that the patent properly claimed priority to an earlier-filed PCT application. “The issue before the Board – and before us on appeal – is whether [the PCT application] ... provides sufficient written description to support ... the [claims]. If it does, then the [patent] properly claims priority based on [the PCT application]. If it does not, then [the PCT application] is prior art to the [patent] and invalidates it as obvious.” Although the PCT application used different language, “substantial evidence supports the Board’s finding that the [patent] is entitled to claim priority to [the PCT application].”

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

***Nestle USA, Inc. v. Steuben Foods, Inc.* (No. 2017-1193, 3/13/18) (Dyk, Reyna, Hughes)**

March 13, 2018 5:27 PM

Hughes, J. Vacating Board decision of non-obviousness and remanding. The Court vacated the Board's construction of "aseptic" and, because of collateral estoppel, construed it to mean "FDA level of aseptic."

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

***Steuben Foods, Inc. v. Nestle USA, Inc.* (No. 2017-1290, 3/13/18) (Dyk, Reyna, Hughes)**

March 13, 2018 1:43 PM

Hughes, J. Affirming Board decision of unpatentability of claims related to aseptic packaging. One prior art reference disclosed "that the specific concentration of hydrogen peroxide in the spraying zone is around 300,000 ppm." Other prior art taught "'limiting the concentration of [hydrogen peroxide] in the filling zone in order to comply with regulatory limits' of, for instance, no more than 0.5 ppm in the United States." The Court found that, together, this art "fairly suggests maintaining 'at least about 5 to 1' or 'at least about 1,000 ppm to 0.1 ppm' ratio of sterilant concentration levels recited in the claims." Also, Patentee's construction of "sterilant concentration levels in the plurality of zones" would have improperly restricted the claim term to a specific embodiment.

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

***SimpleAir, Inc. v. Google LLC* (No. 2016-2738, 3/12/18) (Lourie, Reyna, Chen)**

March 12, 2018 2:07 PM

Lourie, J. Reversing district court's dismissal of claims based on claim preclusion and the *Kessler* doctrine where plaintiff had asserted terminally disclaimed continuation patents against products previously found not to infringe parent patents. Although the new patents issued after the first action was commenced, they could be barred by claim preclusion, but the district court erred in presuming that the new patent claims were precluded based on a common specification and a terminal disclaimer. "Where different patents are asserted in a first and second suit, a judgment in the first suit will trigger claim preclusion only if the scope of the asserted patent claims in the two suits is essentially the same." However, "[a]lthough a terminal disclaimer does not conclusively show that a child patent involves the same cause of action as its parent, the terminal disclaimer is still very relevant to that inquiry." The same analysis applied to the district court's reliance on the *Kessler* doctrine.

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

***Ottah V. Fiat Chrysler* (No. 2017-1842, 3/7/18) (Newman, Hughes, Stoll)**

March 7, 2018 4:52 PM

Newman, J. Affirming summary judgment of non-infringement as to some defendants, and dismissal with prejudice as to others, based on claim construction in prior case which was either collateral estoppel or stare decisis. The doctrine of equivalents was barred by prosecution history

estoppel.

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

Knowles Electronics LLC v. Cirrus Logic, Inc. (No. 2016-2010, 3/1/17) (Wallach, Chen, Newman)

March 1, 2018 1:08 PM

Wallach, J. Affirming PTAB decision in inter partes reexamination that existing claims were anticipated and proposed claims were invalid under the written description requirement. With respect to written description, the specification described a genus of solder pads but failed to disclose the claimed species of solder pads connected by a particular process. Newman, J., dissented, believing that a prior construction of the claims by the Federal Circuit was inconsistent with the PTAB's construction. Although the PTAB had found it was not bound by the prior construction, the majority did not address the issue in ruling that the constructions were not inconsistent.

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