WILMERHALE

Federal Circuit Patent Updates - May 2014

MAY 30, 2014

View previous updates...

***K/S HIMPP v. Hear-Wear Technologies, LLC* (No. 2013-1549, 5/27/14) (Lourie, Dyk, Wallach)**

May 27, 2014 9:05 AM

Lourie, J. Affirming Board determination of nonobviousness. "[A]n assessment of basic knowledge and common sense as a replacement for documentary evidence for core factual findings lacks substantial evidence support." "We recognize that the Board has subject matter expertise,but the Board cannot accept general conclusions about what is "basic knowledge" or "common sense" as a replacement for documentary evidence for core factual findings in a determination of patentability." "Although a patent examiner may rely on common knowledge to support a rejection, that is appropriate only in narrow circumstances." Dyk, J. dissents.

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

***Suffolk Technologies, LLC v. AOL Inc.* (No. 2013-1392, 5/27/14) (Rader, Prost, Chen)**

May 27, 2014 4:30 PM

Prost, J. Affirming summary judgment of invalidity by anticipation. Holding that a CGI newsgroup post was a "printed publication" under 35 U.S.C. § 102. "[A] printed publication need not be easily searchable after publication if it was sufficiently disseminated at the time of its publication."

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

***Tobinick v. Olmarker* (No. 2013-1499, 5/19/14) (Lourie, Reyna, Wallach)**

May 19, 2014 11:28 AM

Reyna, J. Reversing Board's dismissal of an interference count due to lack of written description. Also affirming construction of "administered locally" for claims related to treatment of spinal injuries. In finding that the application satisfied the written description requirement, the Court noted that although some embodiments did not meet the "administered locally" limitation, others did. "The [application] need only reasonably convey to one skilled in the art that [the applicant] had

possession of at least one embodiment that meets the Board's construction of local administration."

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

***Monsanto Company v. E.I. Du Pont De Nemours* (No. 2013-1349, 5/9/14) (Lourie, Reyna, Wallach)**

May 9, 2014 3:30 PM

Lourie, J. Affirming district court sanction award striking defenses and awarding attorney fees.

WilmerHale represented the plaintiff-appellee Monsanto.

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

***Intouch Technologies, Inc. v. VGo Communications, Inc.* (No. 2013-1204, 5/9/14) (Rader, Lourie, O'Malley)**

May 9, 2014 12:55 PM

O'Malley, J. Affirming judgment of non-infringement of asserted patents and denial of new trial, while reversing findings of obviousness of two patents for lack of substantial evidence.

WilmerHale represented the defendant-appellee VGo.

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

***General Electric Company v. Wilkins.* (No. 2013-1170, 5/8/14) (Lorie, Taranto, Chen)**

May 8, 2014 6:18 PM

Lourie, J. Affirming declaratory judgment rejecting inventorship claim based on credibility findings of district court judge. "[W]ithout credible testimony from Wilkins, there was nothing to corroborate."

WilmerHale represented the plaintiff-appellee GE Lighting.

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

***In re: Packard* (No. 2013-1204, 5/6/14) (O'Malley, Plager, Taranto)**

May 6, 2014 11:10 AM

Per Curium. Affirming rejection of claims as indefinite. "Insolubly ambiguous" standard inapplicable to PTO proceedings. "[w]hen the USPTO has initially issued a well-grounded rejection that identifies ways in which language in a claim is ambiguous, vague, incoherent, opaque, or otherwise unclear in describing and defining the claimed invention, and thereafter the applicant fails to provide a satisfactory response, the USPTO can properly reject the claim as failing to meet the statutory requirements of § 112(b). Plager, J. wrote a concurring opinion.

WilmerHale represented the Petitioner.

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

In re: Roslin Institute (Edinburgh) **(No. 2013-1407, 5/8/14) (Dyk, Moore, Wallach)**

May 8, 2014 12:15 PM

Dyk, J. Affirming Board decision rejecting application for claims directed to "a live-born clone of a pre-existing, nonembryonic,
donor mammal," (based on the first cloned animal, "Dolly" the sheep) as unpatentable products of nature where clones are "are exact genetic copies of patent ineligible subject matter."

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

Microsoft Corporation v. DataTern, Inc. **(No. 2013-1184, -1185, 5/5/14) (Prost, Moore, (Rader recused after argument))**

May 5, 2014 9:30 AM

Moore, J. Affirming in part and reversing in part existence of declaratory judgment jurisdiction and summary judgment rulings of infringement. Declaratory judgment jurisdiction did not exist for manufacturer based solely on customer's request for indemnification and when infringement actions in other forums were already pending against customers. Also holding that scope of declaratory judgment with respect to patents and products should be governed by complaint, not by infringement contentions.

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