
Federal Circuit Patent Updates - May 2017

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***Impression Products v. Lexmark* (No. 2015-1189, 5/30/17)**

May 30, 2017 12:14 PM

Roberts, J. Reversing CAFC decision regarding scope of patent exhaustion. “We conclude that a patentee’s decision to sell a product exhausts all of its patent rights in that item, regardless of any restrictions the patentee purports to impose or the location of the sale.” “In sum, patent exhaustion is uniform and automatic. Once a patentee decides to sell—whether on its own or through a licensee—that sale exhausts its patent rights, regardless of any post-sale restrictions the patentee purports to impose, either directly or through a license.” “Exhaustion does not depend on whether the patentee receives a premium for selling in the United States, or the type of rights that buyers expect to receive. As a result, restrictions and location are irrelevant; what matters is the patentee’s decision to make a sale.” Ginsburg, J., concurred in part and dissented in part.

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

***Halo Electronics, Inc. v. Pulse Electronics, Inc.* (No. 2016-2006, 5/26/17) (Lourie, Moore, Hughes)**

May 26, 2017 1:08 PM

Lourie, J. Dismissing appeal from decision awarding prejudgment interest because that decision was not yet final.

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

***Rivera v. ITC* (No. 2016-1841, 5/23/17) (Reyna, Linn, Chen)**

May 23, 2017 4:40 PM

Linn, J. Affirming ITC holding that all asserted claims were invalid for lack of written description. The specification did not support the broad claims to a coffee brewing machine.

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

***TC Heartland LLC v. Kraft Foods Group Brands LLC* (No. 2016-341, 5/22/17)**

May 22, 2017 10:28 AM

Thomas, J. Reversing and remanding denial of dismissal for improper venue. “We ... hold that a domestic corporation ‘resides’ only in its State of incorporation for purposes of the patent venue statute,” 28 U.S.C. §1400(b). “We conclude that the amendments to [28 U.S.C.] §1391 did not modify the meaning of §1400(b).”

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

***Mylan Institutional LLC v. Aurobindo Pharma Ltd.* (No. 2017-1645, 5/19/17) (Lourie, Moore, Reyna)**

May 19, 2017 10:02 AM

Lourie, J. Affirming the grant of a preliminary injunction under one asserted patent against a chemical product. However, the district court erred in granting the injunction under two other patents based on likely infringement under the doctrine of equivalents. “[W]e conclude that the district court’s analysis of equivalence in this case was flawed, no doubt because of the sparse and confusing case law concerning equivalents, particularly the paucity of chemical equivalence case law, and the difficulty of applying the legal concepts to the facts. We will attempt to provide more clarity on these subjects.” “When the case goes back to the district court for a full trial on the merits, the court may wish to consider whether the substantiality of the differences test may be more applicable in this case. Even if evaluating the ‘function’ and ‘way’ prongs is feasible, the FWR test may be less appropriate for evaluating equivalence in chemical compounds if it cannot capture substantial differences between a claimed and accused compound. For example, consider the well-known compounds aspirin and ibuprofen, which chemists would not usually consider to be structural equivalents under the insubstantial differences test.However, the two compounds would seem to be substantial equivalents under the FWR test. ...Thus, a compound may appear to be equivalent under the FWR test, but not under the substantiality of the differences test. Hence, the substantial differences test may be more suitable than FWR for determining equivalence in the chemical arts.”

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

***Arcelormittal v. Steel Corporation* (No. 2016-1357, 5/16/17) (Moore, Wallach, Hughes)**

May 16, 2017 4:22 PM

Hughes, J. Affirming denial of motion to dismiss for lack of subject matter jurisdiction and the grant of summary judgment of invalidity of reissue patent claims. The patentees did not moot the case and remove jurisdiction by offering a covenant not to sue where “no unconditional covenant was ever unconditionally delivered to Defendants before the court resolved the merits of the validity of [the] claims....” Wallach, J., dissented.

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

***Rovalma, S.A. v. BÖHLER Edelstahl GmbH & Co. KG* (No. 2016-2233, 5/11/17) (Wallach, Taranto, Stoll)**

May 11, 2017 12:10 PM

Taranto, J. Vacating and remanding PTAB obviousness determinations in an IPR because the PTAB did not sufficiently explain the basis for its determinations.

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

***Nova Chemicals Corporation v. Dow Chemical Company* (No. 2016-1576, 5/11/17) (Prost, Dyk, Hughes)**

May 11, 2017 3:45 PM

Prost, C.J. Affirming an award of attorney fees and finding of an exceptional case under 35 U.S.C. § 285, because the district court did not abuse its discretion in finding a party's litigating position objectively baseless.

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

***Cascades Projection LLC v. Epson America, Inc.* (No. 2017-1517, 5/11/17) (en banc)**

May 11, 2017 11:18 AM

Per Curiam. Precedential order denying rehearing en banc to review the constitutionality of the PTAB cancelling claims in an IPR. Newman, Dyk, Prost, Hughes, JJ., concurred; O'Malley and Reyna, JJ., dissented.

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

***Aylus Networks, Inc. v. Apple Inc.* (No. 2016-1599, 5/11/17)**

May 11, 2017 9:08 AM

Stoll, J. Affirming summary judgment of noninfringement. On an issue of first impression, holding that statements made by a patent owner during an IPR proceeding, whether before or after an institution decision, can be relied on to support a finding of prosecution disclaimer during claim construction. "Extending the prosecution disclaimer doctrine to IPR proceedings will ensure that claims are not argued one way in order to maintain their patentability and in a different way against accused infringers."

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

***Cisco Systems, Inc. v. Cirrex Systems, LLC* (No. 2016-1143, 5/10/17) (Prost, Wallach, Chen)**

May 10, 2017 4:48 PM

Chen, J. Affirming in part and reversing in part PTAB findings in a reexamination and holding all

claims unpatentable for lack of written description support.

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

***In re AT&T Intellectual Property II* (No. 2016-1830, 5/10/17) (Dyk, Mayer, Reyna)**

May 10, 2017 1:22 PM

Reyna, J. Affirming PTAB finding of anticipation in a reexamination.

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

***In re Affinity Labs of Texas, LLC* (No. 2016-1092, -1172, 5/5/17) (Taranto, Chen, Stoll)**

May 5, 2017 3:19 PM

Chen, J. The estoppel provision of pre-AIA section 317(b) did not serve as a bar to maintain an *inter partes* reexamination where district court invalidity claims had been dismissed without prejudice. On the merits, affirming claim construction under broadest reasonable interpretation standard.

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

***In re Affinity Labs of Texas, LLC* (No. 2016-1173, 5/5/17) (Taranto, Chen, Stoll)**

May 5, 2017 12:10 PM

Chen, J. The estoppel provision of pre-AIA section 317(b) did not serve as a bar to maintain *inter partes* reexaminations with respect to claims that were not subject to district court judgment or against parties that were not part of the judgment or with respect to a consolidated *ex parte* reexamination.

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

***Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc.* (No. 2016-1284, -1787, 5/1/17) (Dyk, Mayer, O'Malley)**

May 1, 2017 9:41 AM

Dyk, J. Reversing district court holding in Hatch-Waxman case that four patents (one of which was governed by the AIA and three of which were not) were not invalid under on-sale bar. With respect to the pre-AIA patents, an agreement for the sale of goods contingent on regulatory approval constitutes a commercial sale. With respect to the post-AIA patent, "We conclude that, after the AIA, if the existence of the sale is public, the details of the invention need not be publicly disclosed in the terms of sale." The invention was "ready for patenting" because it was reduced to practice prior to the critical date.

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