
Federal Circuit Patent Updates - November 2013

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Apple Inc. v. Samsung Electronics Co. LTD. (No. 2013-1129, 11/18/13) (Prost, Bryson, O'Malley)

November 18, 2013 1:12 PM

Prost, J. Affirming denial of permanent injunction with respect to design patents and trade dress , but vacating denial with respect to utility patents. "Some causal nexus" between infringing conduct and harm must be shown, but this does not require patentee to show that the infringing feature was the sole reason for customer demand. Rather, "Apple must show some connection between the patented feature and demand for Samsung's products." The district court also erred in "its wholesale rejection of Apple's attempt to aggregate patents for purposes of analyzing irreparable harm."

WilmerHale represented the Plaintiff-Appellant Apple, Inc.

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

Ohio Willow Wood Co. v. ALPS South, LLC (No. 2012-1642, 2013-1024, 11/15/13) (Dyk, Bryson, Reyna)

November 15, 2013 4:49 PM

Reyna, J. Applying collateral estoppel based on prior ruling of obviousness to different patent where difference in claim scope was not patentably significant. Also granting summary judgment of obviousness of claims not subject to estoppel and reversing summary judgment of no inequitable conduct because of disputed issues of fact where patentee failed to disclose evidence that may have corroborated invention by a prior inventor.

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

Sanofi-Aventis v. Pfizer Inc. (No. 2012-1345, 1/5/13) (Newman, Lourie, Davis [of the E.D. Tex., sitting by designation])

November 5, 2013 6:11 PM

Newman, J. Affirming award of priority in an interference. Priority of conception was proven by the isolation of the claimed polynucleotide even without a completely accurate analysis of the entire nucleotide sequence at the time due to sequencing errors that were later corrected. “We conclude that the Board correctly based conception and reduction to practice on the possession of the isolated DNA segment that was shown to have the desired properties. When the subject matter is a DNA segment, conception requires possession and appreciation of the DNA segment that is claimed.” “Discussing the consequences of Pfizer’s flawed sequence analysis that was corrected after the Sanofi priority date, the Board stated that “[f]or proteins and polynucleotide species, a sequence is the gold standard for identifying species with precision It does not, however, thereby follow that a sequence is the only way to identify the composition precisely.”

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

Fresenius USA, Inc. v. Baxter International, Inc. (No. 2012-1334, 11/5/13) (Per Curiam)

November 5, 2013 4:38 PM

Precedential Order denying rehearing en banc in case involving the effect of the PTO finding a patent invalid after it had been upheld in court. Newman, J., Rader, C. J., O’Malley, J., and Wallach, J., dissented from the denial of rehearing en banc.

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

LifeScan Scotland, LTD. v. Shasta Technologies, LLC (No. 2013-1271, 11/4/13) (Dyk, Prost, Reyna)

November 4, 2013 10:55 AM

Dyk, J. Reversing grant of preliminary injunction against the defendant’s sale of blood glucose monitoring system test strips because of method patent exhaustion by the plaintiff’s sale of blood glucose monitoring meters. “[T]he claimed inventive concept of the method claims of the ’105 patent lies in the meter, rather than the strips, because the meters “control” and “carry out” the inventive functions of the method claims...” “The question is what the inventive features of the method claims were. What is “inventive” about patent claims in the patent exhaustion context is what distinguishes them from the prior art.” “[E]ven if LifeScan’s proposed alternative uses for its meters were reasonably available to users, they were plainly not intended, and are therefore not relevant to the issue of patent exhaustion.” “Rejecting a claim of exhaustion in this case would be particularly problematic because LifeScan would be permitted to eliminate competition in the sale of the strips even though the strips do not embody the claimed invention and are themselves not patentable. Allowing LifeScan to control sale of the strips would be akin to allowing a tying arrangement whereby the purchasers of the meters could be barred from using the meters with competing strips.” “To be sure, if a patent had actually issued on the strips, the patentability of the strips could be relevant to exhaustion.” Also deciding “as a matter of first impression, whether patent exhaustion applies to a product distributed for free. We conclude that, in the case of an

authorized and unconditional transfer of title, the absence of consideration is no barrier to the application of patent exhaustion principles.” Reyna, J., dissents.

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

***Integrated Technology Corp. v. Rudolph Technologies, Inc.* (No. 2012-1007, 11/4/13) (Rader, Clevenger, Moore)**

November 4, 2013 11:45 AM

Moore, J. Reversing judgment of infringement by some products under the doctrine of equivalents because of prosecution history estoppel. “ITC’s representations convey to the public that it was relying on physical contact to overcome the prior art. The public is entitled to rely on those representations. Whether ITC’s interpretation of the prosecution history is plausible is irrelevant.” Also affirming award of damages and no laches for literal infringement by other products. “ITC proffered a two-supplier theory of lost profits that was independent of the existence of noninfringing alternatives.”

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