

Federal Circuit Patent Updates - November 2015

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***Straight Path IP Group, Inc. v. Sipnet EU S.R.O.* (No. 2015-1212, 11/25/15) (Dyk, Taranto, Hughes)**

November 25, 2015 3:15 PM

Taranto, J. Reversing PTAB decision canceling claims in an inter partes review (IPR) because of erroneous claim construction. “When claim language has as plain a meaning on an issue as the language does here, leaving no genuine uncertainties on interpretive questions relevant to the case, it is particularly difficult to conclude that the specification reasonably supports a different meaning. The specification plays a more limited role than in the common situation where claim terms are uncertain in meaning in relevant respects.” “[T]he prosecution history ... is to be consulted even in determining a claim’s broadest reasonable interpretation.” Because “written-description and enablement challenges were not, and could not have been, part of the inter partes review that is now before us ..., arguments about insufficient specification support for the claims if they are given their plain meaning, arguments not adopted by the Board, do not alter our conclusion about claim construction.” Dyk., J., concurs in part and dissents in part.

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

***Carnegie Mellon University v. Marvell Technology Group, LTD* (No. 2014-1492, 11/17/15) (Prost, Newman, Lourie, Dyk, Moore, O'Malley, Reyna, Wallach, Taranto, Chen, Hughes, Stoll)**

November 17, 2015 12:41 PM

Per Curiam. Holding in abeyance damages issue raised in petition for rehearing in banc pending the Supreme Court’s decision in *Halo Electronics Inc. v. Pulse Electronics Inc.* and *Stryker Corp. v. Zinner, Inc.* and denying rehearing on other issues.

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

***Akamai Technologies, Inc. v. Limelight Networks, Inc.* (No. 2009-1372, -1380, -1416, -1417, 11/16/15) (Prost, Linn, Moore)**

November 16, 2015 4:08 PM

Linn, J. Remanding with instructions to reinstate the jury verdict of infringement and the jury's damages award. The district court did not err in its claim construction or by allowing patentee's expert to testify regarding lost profits. Regarding claim construction, the defendant "cannot argue at the jury instruction stage – after the bulk of the trial was framed and directed by the *Markman* construction to which it agreed – that the construction was somehow too broad." Regarding lost profits, patentee's damages expert's "25% adjustment for market elasticity was sufficiently grounded in economic principles for the district court to allow it. Though [defendant] is correct that its customers expressed a clear preference for lower-priced products — as evidenced by their buying [defendant's] significantly cheaper product — and therefore would have been less likely to buy [patentee's] products than the average consumer, [patentee's expert's] testimony took this consideration into account both in excluding the lowest 25% of [defendant's] customers from his lost profits analysis, and for discounting the potential award for price elasticity. Whether this discount was sufficient is not a legal challenge to the availability of lost profits, but as to the *amount* of lost profits, which [defendant] failed to address in its panel briefing."

WilmerHale represented the plaintiffs-appellants, Akamai Technologies, Inc. and the Massachusetts Institute of Technology.

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

***Ariosa Diagnostics v. Verinata Health, Inc.* (No. 2015-1215, -1226, 11/16/15) (Prost, Wallach, Taranto)**

November 16, 2015 1:22 PM

Taranto, J. Vacating Board decision in inter partes review of patent relating to noninvasive prenatal diagnostics and remanding. "The Board's language on its face supports [petitioner's] interpretation of what the Board meant—that the Board was declining to consider Exhibit 1010, even as evidence of the background understanding of skilled artisans as of January 2010, simply because the brochure had not been identified at the petition stage as one of the pieces of prior art defining a combination for obviousness. If that is what the Board meant, the Board erred. Art can legitimately serve to document the knowledge that skilled artisans would bring to bear in reading the prior art identified as producing obviousness. [citation omitted] [Petitioner's] Petitions and opening declarations invoked Exhibit 1010 in that way... Given those references in the Petitions and supporting declarations, Exhibit 1010 had to be considered by the Board even though it was not one of the three pieces of prior art presented as the basis for obviousness."

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

***The Medicines Company v. Hospira, Inc.* (No. 2014-1469, -1504, 11/13/15) (Prost, Newman, Lourie, Dyk, O'Malley, Reyna, Wallach, Taranto, Chen, Hughes, Stoll)**

November 13, 2015 2:14 PM

Per Curiam. Granting petition for rehearing en banc and requesting briefing on the following issues:

“(a) Do the circumstances presented here constitute a commercial sale under the on-sale bar of 35 U.S.C. § 102(b)? (i) Was there a sale for the purposes of § 102(b) despite the absence of a transfer of title? (ii) Was the sale commercial in nature for the purposes of § 102(b) or an experimental use? (b) Should this court overrule or revise the principle in *Special Devices, Inc. v. OEA, Inc.*, 270 F.3d 1353 (Fed. Cir. 2001), that there is no ‘supplier exception’ to the on-sale bar of 35 U.S.C. § 102(b)?”

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

***Inphi Corporation v. Netlist, Inc.* (No. 2015-1179, 11/13/15) (O'Malley, Reyna, Chen)**

November 13, 2015 10:19 AM

O'Malley, J. Affirming decision that claims amended during inter partes reexamination to include a negative limitation complied with 35 U.S.C. § 112. “The question that remains is whether properly describing alternative features—without articulating advantages or disadvantages of each feature—can constitute a ‘reason to exclude’ under the standard articulated in *Santarus*. We hold that it can... We hold that *Santarus* did not create a heightened written description standard for negative claim limitations and that properly described, alternative features are sufficient to satisfy the written description standard of § 112, paragraph 1 for negative claim limitations.”

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

***Advanced Steel Recovery, LLC v. X-Body Equipment, Inc.* (No. 2014-1829, 11/12/15) (Prost, Moore, Stoll)**

November 12, 2015 1:10 PM

Stoll, J. Affirming summary judgment of no infringement of patent related to method of loading shipping containers.

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

***Delorme Publishing Co., Inc. v. ITC* (No. 2014-1572, 11/12/15) (Moore, Reyna, Taranto)**

November 12, 2015 11:45 AM

Moore, J. Affirming Commission’s finding of violation of consent order and imposition of a civil penalty. Subsequent invalidation of the relevant claims in federal court did not retroactively eliminate the consent order. “The Order explains that it applies ‘until’ one of the triggering events. [It] contains no language that could be construed as requiring (or even allowing) the triggering events to apply retroactively.” Taranto, J. dissented-in-part.

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

***Cubist Pharmaceuticals, Inc. v. Hospira, Inc.* (No. 2015-1197, -1204, -1259, 11/12/15) (Wallach, Bryson, Hughes)**

November 12, 2015 10:44 AM

Bryson, J. Affirming judgment holding some claims related to the antibiotic daptomycin valid and infringed and other claims invalid. A certificate of correction issued by the PTO, which corrected a structural diagram of daptomycin, did not alter the scope of the patent. “Even though researchers had previously been mistaken about the precise chemical structure of daptomycin, it was nonetheless clear from the specification that the patentees possessed daptomycin (with the D-isomer of asparagine) and that the references to Formula 3 in the claims of the [patent] were directed to daptomycin.” Also, the “fact that the inventors were mistaken as to one aspect of the structure of daptomycin at the time the application for the original [patent] was filed does not render the specification inadequate to satisfy the written description requirement.” Claims related to “dosing” and “purity” of daptomycin were obvious. The district court, which “concluded that [the product’s] commercial success is mainly attributable to daptomycin itself” and “is attributable only in small measure to the dosage and interval protocols disclosed in the dosing patents” did not err in finding that secondary considerations failed to overcome obviousness arising from the prior art.

WilmerHale represented the plaintiff-cross-appellant, Cubist Pharmaceuticals, Inc.

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

***Prometheus Laboratories, Inc. v. Roxane Laboratories, Inc.* (No. 2014-1634, -1635, 11/10/15)
(Dyk, Taranto, Hughes)**

November 10, 2015 5:16 PM

Dyk, J. Affirming decision that claims related to a method of treatment for irritable bowel syndrome were obvious.

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

***Imaginal Systematic, LLC v. Leggett & Platt, Inc.* (No. 2014-1845, 11/10/15) (Moore, Schall, O'Malley)**

November 10, 2015 3:21 PM

O'Malley, J. Affirming summary judgment of non-infringement of patent related to a process for building box springs.

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

***Momenta Pharmaceuticals, Inc. v. Teva Pharmaceuticals USA Inc.* (No. 2014-1274, -1277, 11/10/15) (Dyk, Moore, Wallach)**

November 10, 2015 12:19 PM

Wallach, J. Affirming holding of no infringement under § 271(g) of patent to a process for ensuring that batches of generic enoxaparin, an anticoagulant marketed under the trade name Lovenox, meet quality standards. The Court found that “the ordinary meaning of ‘made’ as used in § 271(g) means ‘manufacture,’ and extends to the creation or transformation of a product, such as by synthesizing, combining components, or giving raw materials new properties. However, ‘ma[king]’

does not extend to testing to determine whether an already synthesized drug substance possesses existing qualities or properties.” Also vacating determination that one party’s activities fall within the § 271(e)(1) safe harbor and remanding. Dyk, J. concurred in part and dissented in part.

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

***ClearCorrect Operating, LLC v. ITC* (No. 2014-1527, 11/10/15) (Prost, Newman, O'Malley)**

November 10, 2015 10:42 AM

Prost, J. Reversing decision of Commission and remanding. The Court held that “articles” in Section 337 “means ‘material things’ and does not extend to electronically transmitted digital data.” The Commission lacked jurisdiction because this case turned on the transmission of digital data. Newman, J. dissented and O'Malley, J. filed a separate concurring opinion.

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

***Belden Inc. v. Berk-Tek LLC* (No. 2014-1575, -1576, 11/5/15) (Newman, Dyk, Taranto)**

November 5, 2015 3:55 PM

Taranto, J. On appeal from an IPR, reversing Board’s holding that only some claims at issue were obvious. Also holding that a petition need not be supported by a declaration and that the patentee’s declaration filed after institution responded only to arguments made in the response.

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