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## Federal Circuit Patent Updates - November 2016

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***Apple Inc. v. Ameranth* (No. 2015-1703, 11/29/16) (Reyna, Chen, Stoll)**

November 29, 2016 4:52 PM

Reyna, J. Affirming in part and reversing in part decisions in Covered Business Method (CBM) reviews and holding all claims unpatentable under 35 U.S.C. § 101. “We affirm the Board’s determinations that these are not patents for technological inventions. ... We agree with the Board’s determination that these claims do not solve technical problems using technical solutions.” “We affirm the Board’s conclusion that the claims in these patents are directed to an abstract idea. The patents claim systems including menus with particular features. They do not claim a particular way of programming or designing the software to create menus that have these features, but instead merely claim the resulting systems.” “The difficulty of the programming details for this functionality is immaterial because these details are not recited in the actual claims. The degree of difficulty in implementing an abstract idea in this circumstance does not itself render an abstract idea patentable.” “Generally, a claim that merely describes an effect or result dissociated from any method by which it is accomplished is not directed to patent-eligible subject matter.” (quotation omitted).

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

***Unwired Planet, LLC v. Google Inc.* (No. 2015-1812, 11/21/16) (Reyna, Plager, Hughes)**

November 21, 2016 4:55 PM

Reyna, J. Reversing Board’s decision with respect to what constitutes a “Covered Business Method (CBM)” patent. The patent in suit was directed to a method for managing location information for wireless devices, which the Board found claimed “activities that are financial in nature, incident to a financial activity or complementary to a financial activity.” The Court held that only the “financial in nature” aspect of the test was consistent with the statute.

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

***Alfred E. Mann Foundation v. Cochlear Corporation* (No. 2015-1580, -1606, -1607, 11/17/16)  
(Newman, Chen, Hughes)**

November 17, 2016 1:32 PM

Hughes, J. Affirming district court's finding that means-plus-function element of one claim was indefinite where the specification did not disclose an algorithm for practicing the claimed function. However, a second claim was found not to be indefinite where a person skilled in the art would know from the art how to make a required measurement. Also, finding lack of appellate jurisdiction over the a grant of a new trial on damages based on lack of finality and because new trial order was not certifiable under Rule 54(b). Newman, J. dissented on the issues of indefiniteness and jurisdiction.

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

***In Re: Rearden LLC* (No. 2016-125, 11/17/16) (Moore, Hughes, Stoll)**

November 17, 2016 9:12 AM

Stoll, J. Holding that jurisdiction existed to decide petition for a writ of mandamus but denying it with respect to the production of privileged documents. Because an infringement counterclaim was compulsory in connection with a state law ownership dispute, the Court held it had jurisdiction under the AIA.

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

***Unwired Planet, LLC v. Google Inc.* (No. 2015-1810, -1811, 11/15/16) (Reyna, Plager, Hughes)**

November 15, 2016 2:18 PM

Reyna, J. In IPR, affirming finding that claims were invalid as obvious after holding that key reference was analogous art.

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

***Perfect Surgical Techniques v. Olympus America, Inc.* (No. 2015-2043, 11/15/16) (Moore, Schall, O'Malley)**

November 15, 2016 12:44 PM

Moore, J. In IPR, reversing finding of anticipation on grounds that Board (1) erred in refusing to rely on translation of prior art that did not translate bibliographic page containing publication date and (2) applied too stringent a standard in holding that applicant did not exercise reasonable diligence in reducing invention to practice. Schall, J. dissented on the diligence issue.

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

***In Re: NuVasive, Inc.* (No. 2015-1672, -1673, 11/9/16) (Moore, Wallach, Taranto)**

November 9, 2016 10:08 AM

Taranto, J. Affirming finding of obviousness with respect to one IPR but vacating finding in another where patentee was not given adequate opportunity to address the specific portion of prior art ultimately relied on by Board.

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

***REG Synthetic Fuels, LLC v. Neste Oil OYJ* (No. 2015-1773, 11/8/16) (Prost, Taranto, Chen)**

November 8, 2016 4:05 PM

Chen, J. In IPR, affirming one finding of anticipation. Converting one unit of measurement into another unit of measurement that satisfies the claim element is not an issue of inherency.

However, with respect to another finding of anticipation, the Court erred in excluding as hearsay documents that showed a prior conception by the applicant.

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

***SAS Institute, Inc. v. ComplementSoft, LLC* (No. 2015-1346, -1347, 11/7/16) (*en banc*)**

November 7, 2016 11:18 AM

Denying petition for rehearing on banc on whether Board can institute review of fewer than all claims challenged in a petition. Newman J., dissented.

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

***Amdocs (Israel) Limited v. Openet Telecom, Inc.* (No. 2015-1180, 11/1/16) (Newman, Plager, Reyna)**

November 1, 2016 1:22 PM

Plager, J. Reversing judgment on the pleadings that the patents were not directed to patent eligible subject matter under § 101. “Our cases generally follow the step one/step two Supreme Court [Alice] format, reserving step two for the more comprehensive analysis in search of the ‘inventive concept.’ Recent cases, however, suggest that there is considerable overlap between step one and step two, and in some situations this analysis could be accomplished without going beyond step one.” “[A] search for a single test or definition [for or of an ‘abstract idea’] in the decided cases concerning § 101 from this court, and indeed from the Supreme Court, reveals that at present there is no such single, succinct, usable definition or test.” “Instead of a definition, then, the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided.” “[T]h[e] claim [here] entails an unconventional technological solution ...to a technological problem .... The solution requires arguably generic components.... However, the claim’s enhancing limitation necessarily requires that these generic components operate in an unconventional manner to achieve an improvement in computer functionality.” Reyna, J., dissented.

WilmerHale represented the plaintiff-appellant.

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