
Federal Circuit Patent Updates - November 2017

NOVEMBER 2017

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***Presidio Components, Inc. v. American Technical Ceramics* (No. 2016-2607, -2650, 11/21/17)
(Dyk, Moore, Taranto)**

November 21, 2017 3:49 PM

Dyk, J. Affirming holdings that claims were not invalid as indefinite, that defendant was entitled to absolute intervening rights based on a change in claim scope during reexamination and that plaintiff was not entitled to enhanced damages notwithstanding willfulness verdict. Reversing award of lost profits as unsupported by evidence of a lack of non-infringing substitutes and vacating permanent injunction based on that same unsupported finding. The claims were sufficiently definite even though the testing method to prove one of the limitations had not been published because the general approach was within the knowledge of someone skilled in the art.

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

***BASF Corporation v. Johnson Matthey Inc.* (No. 2016-1770, 11/20/17) (Lourie, O'Malley, Taranto)**

November 20, 2017 10:17 AM

Taranto, J. Reversing judgment of indefiniteness for patent related to catalytic converter. The Court rejected the argument that "composition ... effective to catalyze" was indefinite. "The intrinsic evidence in this case makes clear that the asserted advance over the prior art is in the partly-dual-layer arrangement to create a two-phase operation for performing the identified conversion processes, not in the choices of materials to perform each of the required catalytic processes. It is in this context that the question of the certainty or uncertainty experienced by a relevant skilled artisan in understanding the claims, read in light of the specification, is presented. And it is in this context that the relevant skilled artisan would be informed by the specification's numerous examples of qualifying compositions A and B, disclosure of the stoichiometric reactions, and equating of the 'composition . . . effective to catalyze' phrases with familiar terms such as 'SCR catalyst' and 'AMOX catalyst.'"

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

***In Re Micron Technology, Inc.* (No. 2017-138, 11/15/17) (Taranto, Chen, Hughes)**

November 15, 2017 12:32 PM

Taranto, J. Granting petition for writ of mandamus vacating order denying motion to dismiss or transfer and remanding. “We conclude that *TC Heartland* changed the controlling law in the relevant sense: at the time of the initial motion to dismiss, before the Court decided *TC Heartland*, the venue defense now raised by [defendant] (and others) based on *TC Heartland*’s interpretation of the venue statute was not ‘available,’ thus making the waiver rule of Rule 12(g)(2) and (h)(1)(A) inapplicable. But that waiver rule, we also conclude, is not the only basis on which a district court might reject a venue defense for non-merits reasons, such as by determining that the defense was not timely presented. A less bright-line, more discretionary framework applies even when Rule 12(g)(2) and hence Rule 12(h)(1)(A) does not.”

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

***Promega Corp v. Life Tech* (No. 2013-1011, -1029, -1376, 11/13/17) (Prost, Mayer, Chen)**

November 13, 2017 4:49 PM

Chen, J. On remand from the Supreme Court, reaffirming holdings regarding enablement, licensing, and active inducement issues. Also affirming district court’s grant of JMOL of no infringement and denial of new trial. Some of the accused products were sold in the US and others were assembled in the UK, using a component supplied from the US, and sold outside the US. The Supreme Court ruled that supplying a single component from the US could not result in infringement under 271(f)(1) and that therefore many of the non-US sales did not infringe. Without support for worldwide damages, affirming district court ruling that plaintiff waived the right to establish damages for US sales alone even though the defendant had admitted to infringement in the US. “This is an unusual case. Patent owners who prove infringement are typically awarded at least some amount of damages,” but “a patent owner may waive its right to a damages award” by pursuing “an ultimately invalid damages theory.”

WilmerHale represented the plaintiff-cross-appellant, Promega Corporation.

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

***Sanofi v. Watson Laboratories Inc.* (No. 2016-2722, 11/9/17) (Prost, Wallach, Taranto)**

November 9, 2017 3:50 PM

Taranto, J. Affirming judgement of no obviousness of patents related to cardiovascular drug. Also affirming finding of infringement. The Court rejected defendants’ argument that there would have been no inducement because the drug “has substantial noninfringement uses... Section 271(b), on inducement, does not contain the ‘substantial noninfringing use’ restriction of section 271(c), on contributory infringement.”

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

Bayer Pharma AG v. Watson Laboratories, Inc. (No. 2016-2169, 11/1/17) (Lourie, Moore, O'Malley)

November 1, 2017 2:08 PM

Moore, J. Reversing finding of nonobviousness and holding claims invalid as obvious. “[T]he district court clearly erred in finding a skilled artisan would not have been motivated to use the claim elements.” “The motivation to combine inquiry is not limited to what products are forthcoming or currently available on the market. Particularly given the lengthy FDA approval process, the pharmaceutical industry is no exception. Any motivation, ‘whether articulated in the references themselves or supported by evidence of the knowledge of skilled artisan, is sufficient’.” “[T]he teaching away inquiry does not focus on whether a person of ordinary skill in the art would have merely *avored* one disclosed option over another disclosed option. In assessing whether prior art teaches away, that ‘better alternatives exist in the prior art does not mean that an inferior combination is inapt for obviousness purposes’.”

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

Two-Way Media Ltd. v. Comcast Cable Communications (No. 2016-2531, 11/1/17) (Lourie, Reyna, Hughes)

November 1, 2017 10:23 AM

Reyna, J. Affirming finding that claims were invalid as directed to patent ineligible subject matter under 35 U.S.C. § 101. “[T]he claims [which ‘generally relate to a system for streaming audio/visual data over a communications system like the internet’] are directed to abstract ideas and contain no additional elements that transform the nature of the claims into a patent-eligible application of the abstract ideas.”

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