

Federal Circuit Patent Updates - October 2013

OCTOBER 30, 2013

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***Randall MFG v. REA* (No. 2012-1611, 10/30/13) (Rader, Dyk, Taranto)**

October 30, 2013 12:22 PM

Taranto, J. Vacating Board determination of nonobviousness in an inter partes reexamination “[b]ecause the Board failed to consider a wealth of well-documented knowledge that is highly material to evaluating the motivation to combine references to arrive at the claimed invention....” “Rejecting a blinkered focus on individual documents, the Court [in KSR] required an analysis that reads the prior art in context, taking account of “demands known to the design community,” “the background knowledge possessed by a person having ordinary skill in the art,” and “the inferences and creative steps that a person of ordinary skill in the art would employ.”” “[W]e have emphasized the importance of a factual foundation to support a party’s claim about what one of ordinary skill in the relevant art would have known. ... One form of evidence to provide such a foundation, perhaps the most reliable because not litigation-generated, is documentary evidence consisting of prior art in the area. ... The significance of those and other references did not depend on any attempt to change the combination that formed the basis of the Examiner’s rejections; rather, the references constitute important evidence of the state of the art and the context in which the Examiner-cited combination should be evaluated.”

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

***Synthes USA, LLC v. Spinal Kinetics, Inc.* (No. 2013-1047, 10/29/13) (Prost, O'Malley, Taranto)**

October 29, 2013 4:38 PM

O'Malley, J. Affirming jury verdict of invalidity for lack of written description. “While broadening claims during prosecution to capture a competitor’s products is not improper, the written description must support the broadened claims.” “The original disclosure claimed and disclosed a plurality of grooves and a plurality of channels, but did not describe “openings” generally.” “[W]hile we did state in *Bilstad* that the mechanical field was “fairly predictable,” we did not hold that all inventions that may be characterized as “mechanical” allow claiming a genus based on disclosure of a single

species.” Taranto, J., dissents.

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

***Commil v. Cisco* (No. 2012-1042, 10/25/13) (Rader, Newman, Lourie, Dyk, Prost, Moore, O'Malley, Reyna, Wallach, Taranto, Chen)**

October 25, 2013 8:33 AM

Per Curiam. Denying plaintiff-appellee’s petitions for panel rehearing and rehearing en banc. Judges Reyna and Newman wrote separate dissents with Judges Rader, Newman, Lourie and Wallach joining Judge Reyna’s opinion and Judges Rader, Reyna and Wallach joining Judge Newman’s opinion. The dissenters would have granted the petition for rehearing en banc and disagreed with the panel’s holding that a good-faith belief of invalidity may negate the requisite intent for induced infringement.

WilmerHale represented defendant-appellant, Cisco Systems, Inc.

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

***Ibormeith IP, LLC v. Mercedes-Benz USA* (No. 2013-1007, 10/22/13) (Lourie, Prost, Taranto)**

October 22, 2013 3:43 PM

Taranto, J. Affirming summary judgment of indefiniteness. The asserted claims, which are directed to monitoring the sleepiness state of a vehicle driver, contain a “computational means for...” limitation and the specification failed to disclose corresponding structure. Patent owner’s argument that the specification adequately disclosed structure in the form of an algorithm was unpersuasive. “A description of an algorithm that places no limitations on how values are calculated, combined, or weighted is insufficient to make the bounds of the claim understandable.”

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

***In re: Biedermann* (No. 2013-1080, 10/18/13) (Moore, Linn, O'Malley)**

October 18, 2013 11:48 AM

Linn, J. Vacating Board decision and remanding because the Board introduced a new ground of rejection. “A new ground of rejection is not negated by the fact that the Board is responding to an appellant’s argument.”

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

***Keurig, Incorporated v. Sturm Foods, Inc.* (No. 2013-1072, 10/17/13) (Lourie, Mayer, O'Malley)**

October 17, 2013 1:12 PM

Lourie, J. Affirming summary judgment of non-infringement of patent directed to coffee brewing. The patent owner sells coffee brewing machines and disposable containers of ground coffee. The

defendant sells disposable containers for use with the patent owner's brewing machines. The patent owner's rights were exhausted by its authorized sale of brewing machines. "Moreover, [patent owner's] argument that patent exhaustion must be adjudicated on a claim-by-claim basis is unavailing. The Court's patent exhaustion jurisprudence has focused on the exhaustion of the patents at issue in their entirety, rather than the exhaustion of the claims at issue on an individual basis."

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

***Ncube Corporation v. Seachange International Inc.* (2013-1066, 10/10/13) (Rader, Prost, Taranto)**

October 10, 2013 2:13 PM

Prost, J. Affirming district court's refusal to hold defendant in contempt for violating injunction.

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

***Intellect Wireless, Inc. v. HTC Corporation* (No. 2012-1658, 10/9/13) (Prost, Moore, O'Malley)**

October 9, 2013 11:22 AM

Moore, J. Affirming finding of inequitable conduct based on false affidavit by inventor concerning when invention was reduced to practice. The materiality prong of inequitable conduct is satisfied when an applicant files a false affidavit and fails to cure the misconduct. Subsequent declarations did not cure misconduct where they failed to expressly advise the PTO of the false representations.

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

***Broadcom Corporation v. Emulex Corporation* (No. 2012-1309, 10/7/13) (Rader, Lourie, Wallach)**

October 7, 2013 3:32 PM

Rader, J. Affirming finding of infringement, non-obviousness and grant of permanent injunction with respect to patent directed to digital communication system. Irreparable harm was shown because money damages were inadequate to compensate the plaintiff for lost profits due to incumbency effect. The district court's analysis of the four factor test for granting an injunction "proceeds under the 'long tradition of equity practice' granting 'injunctive relief upon a finding of infringement in the vast majority of patent cases.'"

WilmerHale represented the Plaintiff-Appellee.

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

***Microsoft Corporation v. ITC* (No. 2012-1445, -1535, 10/3/13) (Rader, Prost, Taranto)**

October 3, 2013 1:22 PM

Taranto, J. Affirming finding of no infringement of one patent and lack of domestic industry for two patents. Reversing finding of non-infringement of a fourth patent based on claim construction.

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

TecSec, Inc. v. International Business Machines (2012-1415, 10/2/13) (Moore, Linn, Reyna)

October 2, 2013 7:47 PM

Linn, J. Reversing summary judgment of non-infringement because of error in claim construction. Mandate rule did not preclude district court from further construing claims notwithstanding a prior appeal in the same case in which the issue of infringement was decided with respect to another defendant. In that appeal, the Court affirmed under Rule 36. Because the Rule 36 affirmance could have been based on claim construction or sufficiency of the evidence, the issue of claim construction was not necessarily decided in the prior appeal. Reyna, J. dissented.

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