

---

## Federal Circuit Patent Updates - October 2016

OCTOBER 2016

[View previous updates...](#)

***Medtronic, Inc. v. Robert Bosch Healthcare* (No. 2015-1977, -1986, -1987, 10/20/16) (Lourie, Dyk, Hughes)**

October 20, 2016 3:41 PM

Dyk, J. Denying petition for rehearing and confirming the Court's earlier order. "The Board's vacatur of its institution decisions and termination of the proceedings constitute decisions whether to institute *inter partes* review and are therefore 'final and nonappealable' under § 314(d). Nothing in *Cuozzo* is to the contrary." Defendant in litigation filed petitions for *inter partes* review and those petitions were denied. Defendant was subsequently acquired. Less than a year after litigation was initiated, the new corporate parent of the defendant filed additional petitions for inter partes review naming itself as the sole real party in interest and stating it had acquired defendant in the litigation. The Board granted institution of those petitions, but those institutions were subsequently vacated when the Board determined that the corporate parent was not the sole party in interest. The defendant was also a real party in interest and the petitions were therefore time-barred under § 315(b). In a panel decision, the Court found the Board's vacatur of its institution decision and decision terminating the instituted IPRs to be not reviewable.

WilmerHale represented the Appellant, Medtronic, Inc.

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

***In Re: Efthymiopoulos* (No. 2016-1003, 10/18/16) (Prost, Newman, Bryson)**

October 18, 2016 9:45 AM

Prost, J. Affirming Board's rejection, as obvious, of claims related to an oral inhalation influenza treatment. One prior art reference taught the relevant compound and another prior art reference taught oral inhalation and it was obvious to combine those references. Newman, J. dissented.

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

***Synopsys, Inc. v. Mentor Graphics Corporation* (No. 2015-1599, 10/17/16) (Lourie, Moore, Chen)**

October 17, 2016 5:10 PM

Chen, J. Affirming summary judgment that claims related to logic circuit design are invalid under § 101. The claims were “so broad as to read on an individual performing the claimed steps mentally or with pencil and paper.” The patentee “equates the inventive concept inquiry with novelty and contends that the Asserted Claims contain an inventive concept because they were not shown to have been anticipated (by 35 U.S.C. § 102) or obvious over (35 U.S.C. § 103) the prior art. [citation omitted] That position misstates the law... [A] claim for a *new* abstract idea is still an abstract idea. The search for a § 101 inventive concept is thus distinct from demonstrating § 102 novelty... [The asserted] claims are directed to an abstract mental process and contain no inventive concept. The claims are therefore invalid under 35 U.S.C. § 101.”

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

***Poly-America, L.P. v. API Industries, Inc.* (No. 2016-1200, 10/14/16) (Prost, Reyna, Hughes)**

October 14, 2016 4:50 PM

Reyna, J. Affirming judgment of infringement of patent related to trash bags. The Court upheld a determination that claim term “short seal” required inward extensions. “Every embodiment described in the specification has inwardly extended short seals and every section of the specification indicates the importance of inwardly extended short seals. These two facts provide together a proper reason to limit the claims in this way. Moreover, even if these indications were not themselves sufficient, they, when taken together with statements from [the specification and prosecution history] provide clear and unequivocal evidence that the inventor intended to disavow any claim scope encompassing short seals that are not inwardly extended.” The Court also rejected arguments that claim differentiation required a different result. Claim “differentiation does not serve to broaden claims beyond their meaning in light of the patent as a whole, and it cannot override clear statements of claim scope found in the specification and prosecution history.”

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

***MIT v. Shire Pharmaceuticals, Inc.* (No. 2015-1881, 10/13/16) (O'Malley, Chen, Stoll)**

October 13, 2016 11:10 AM

Stoll, J. Affirming judgment of validity and infringement of patents related to producing organ tissue in vivo. The Court upheld a determination that prosecution history estoppel did not preclude claim term “vascularized organ tissue” from encompassing “skin.” The Court also affirmed a determination that claim term “three-dimensional scaffold” is not indefinite. O'Malley concurred.

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

***FairWarning IP, LLC v. Iatric Systems, Inc.* (No. 2015-1957, 10/11/16) (Lourie, Plager, Stoll)**

October 11, 2016 4:22 PM

Stoll, J. Affirming district court holding that claims to “A method of detecting improper access of a patient’s protected health information (PHI) in a computer environment” were directed to patent-ineligible subject matter.

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

***Apple Inc. v. Samsung Electronics Co., Ltd. (No. 2015-1171, -1195, -1994, 10/7/16) (en banc)***

October 7, 2016 10:17 AM

Moore, J. Reinstating jury verdict of infringement of one patent and non-obviousness of two others after panel decision had reversed district’s denial of JMOL on those issues. “We granted Apple’s en banc petition to affirm our understanding of the appellate function as limited to deciding the issues raised on appeal by the parties, deciding these issues only on the basis of the record made below, and as requiring appropriate deference be applied to the review of fact findings.” Prost, Dyk and Reyna, J. dissented.

WilmerHale represented the appellant Apple.

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