
Federal Circuit Patent Updates - September 2014

SEPTEMBER 30, 2014

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In re: Taylor Made Golf Co. (No. 2013-1552, 9/30/14) (Dyk, O'Malley)

September 30, 2014 2:15 PM

Per Curiam. Vacating Board decision of nonobviousness. "Because the Board erroneously failed to consider the general knowledge possessed by one skilled in the art of press fitting in applying the obviousness standard, we vacate the Board's decision and remand for further proceedings." "We find that the Board was obligated to consider whether it would have been obvious to utilize press fitting even though the prior art did not disclose the use of press fitting for the specific purpose of the invention." "[A] Wikipedia article ... is itself indicative of common knowledge...."

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

EMD Millipore Corporation v. AllPure Technologies, Inc. (No. 2014-1140, 9/29/14) (Prost, O'Malley, Hughes)

September 29, 2014 4:30 PM

Prost, J. Affirming summary judgment of non-infringement. Prosecution history estoppel barred application of the doctrine of equivalents.

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

American Calcar, Inc. v. American Honda Motor Co. (No. 2013-1061, 9/26/14) (Prost, Newman, Wallach)

September 26, 2014 3:22 PM

Prost, J. Affirming judgment of unenforceability due to inequitable conduct. Newman, J. dissented.

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

Benefit Funding Systems v. Advance America Cash (No. 2014-1122, -1124, -1125, 9/25/14) (Prost, Lourie, Hughes)

September 25, 2014 10: 45 AM

Prost, J. Affirming stay of litigation pending covered business method review.

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

***UPI Semiconductor Corporation v. ITC* (No. 2013-1157, 9/25/14) (Newman, Moore, Chen)**

September 25, 2014 4:15 PM

Newman, J. Affirming Commission's ruling that respondent violated consent order, affirming modified penalty for that violation, reversing ruling of no violation as to post consent order products, and remanding.

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

***SCA Hygiene Products v. First Quality Baby Products* (No. 2013-1564, 9/17/14) (Reyna, Wallach, Hughes)**

September 17, 2014 3:05 PM

Hughes, J. Affirming summary judgment of laches, reversing summary judgment of equitable estoppel, and remanding. Regarding laches, the Court rejected the patent owner's argument that the Supreme Court's recent opinion in *Petrella v. Metro-Goldwyn-Mayer, Inc.* overruled *Aukerman*. Whether patent owner's delay of more than six years in filing suit "was excusable relates to the question of whether it can rebut the presumption of unreasonable and inexcusable delay, not whether the presumption applies in the first place." The Court also rejected patent owner's argument that the duration of an intervening reexamination should be excluded from the total delay. "Given the circumstances, [patent owner] should have been prepared to reassert its rights against [defendant] shortly after [the patent] emerged from reexamination... But [patent owner] remained silent for more than three years after the patent came out of reexamination." Regarding equitable estoppel, the Court found that genuine issues of material fact remain regarding whether [defendant] relied upon [patent owner's] silence. "[E]ven the most rudimentary due diligence by [defendant] would have revealed that [patent owner] had filed a reexamination request for [the patent]. Thus, a reasonable juror could conclude that [defendant's] reliance, to the extent it can be established, was not reasonable."

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

***STC.UNM v. Intel Corporation* (No. 2013-1241, 9/17/14) (Prost, Newman, Lourie, Dyk, Moore, O'Malley, Wallach, Taranto, Chen, Hughes)**

September 17, 2014 8:50 AM

Per Curiam. Denying petition for panel rehearing and for rehearing en banc. Judges Dyk, Moore, and Taranto concurred. Judges Newman, Lourie, O'Malley and Wallach dissented, in two separate opinions, from the denial of the petition for rehearing en banc. The opinions discuss Federal Rule

19 and involuntary joinder.

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

***VirnetX, Inc. v. Cisco Systems, Inc.* (No. 2013-1489, 9/16/14) (Prost, Chen)**

September 16, 2014 12:40 PM

Prost, J. Reversing damages award for patent related to Internet security, finding that testimony of patent owner's damages expert should have been excluded and remanding. Also affirming finding of infringement and no invalidity of some claims, reversing finding of infringement under the doctrine of equivalents, reversing claim construction, and affirming exclusion of evidence relating to reexamination of the patents-in-suit. The Court found a jury instruction regarding the entire market value rule improper because it "mistakenly suggests that when the smallest salable unit is used as the royalty base, there is necessarily no further constraint on the selection of the base. That is wrong. For one thing, the fundamental concern about skewing the damages horizon – of using a base that misleadingly suggests an inappropriate range – does not disappear simply because the smallest salable unit is used." "The law requires patentees to apportion the royalty down to a reasonable estimate of the value of its claimed technology, or else establish that its patented technology drove demand for the entire product." Also, regarding damages arguments based on the Nash bargaining theorem, the Court stated that "[a]nyone seeking to invoke the theorem as applicable to a particular situation must establish that fit, because the 50/50 profit-split result is proven by the theorem only on those premises."

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

***Boston Scientific Corporation* (No. 2014-134, 9/16/14) (Dyk, Plager, Linn)**

September 16, 2014 1:25 PM

Linn, J. Denying petition for interlocutory review and declining to transfer case to the Court of Appeals for the Ninth Circuit.

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

***Facebook, Inc. v. Pragmatus AV, LLC* (No. 2013-1350, 9/11/14) (Moore, O'Malley, Taranto)**

September 11, 2014 6:30 PM

Moore, J. Although patent had not expired when it was before the Board, which therefore applied the broadest reasonable interpretation standard to claim construction, the Court construed the claims under Phillips because the patent had expired by the time of appeal. However, the Court's construction under Phillips was broader than the Board's construction, so the Board's construction was necessarily erroneous even under the broadest reasonable interpretation standard.

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

***Scientific Plastic Products v. Biotage AB* (No. 2013-1219, -1220, -1221, 9/10/14) (Newman,**

Moore, Wallach)

September 10, 2014 12:15 PM

Newman, J. Affirming Boards rejection of claims as obvious in inter partes reexamination. The Board was correct in viewing cited art as “analogous” where art had the same purpose as the claimed invention. Moore, J., dissented.

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

***Interval Licensing LLC v. AOL, Inc.* (No. 2013-1282, -1283, -1284, -1285, 9/10/14) (Taranto, Chen)**

September 10, 2014 5:10 PM

Chen, J. Affirming judgment that certain claims were invalid as indefinite, while reversing claim construction of other claims. Claim phrase “in an unobtrusive manner” that “does not distract a user” had “too uncertain a relationship to the patents’ embodiments” to “provide a reasonably clear and exclusive definition.”

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

***EPOS Technologies, Ltd. v. Pegasus Technologies, Ltd.* (No. 2013-1330, 9/5/14) (Bryson, Hughes)**

September 5, 2014 10:24 AM

Hughes, J. Reversing summary judgment of non-infringement of claims to digital pens. The district court erred in construing claims to be limited to features of a preferred embodiment and, in one instance, construed claims to exclude the preferred embodiment. The district court also misapplied the all elements rule in finding no infringement under the doctrine of equivalents.

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

***BuySAFE, Inc. v. Google, Inc.* (No. 2013-1575, 9/3/14) (Taranto, Hughes)**

September 3, 2014 3:20 PM

Taranto, J. Affirming judgment that claims directed to means for guaranteeing a party’s performance of an online transaction were invalid under Section 101.

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