WILMERHALE

Patent Law and the Supreme Court: Patent Certiorari Petitions Pending

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*W*ilmerHale compiles lists of certiorari petitions that raise patent-law issues. This page contains a consolidated list of all recently pending petitions, organized in reverse chronological order by date of certiorari petition.

Recently pending, granted and denied certiorari petitions

Morris & Associates, Inc. v. John Bean Technologies Corp., No. 18-495

Questions Presented:

In *Petrella v. Metro-Goldwyn-Meyer, Inc.*, 134 S.Ct. 1962 (2014), and *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 137 S.Ct. 954 (2017), this Court held that laches is unavailable to bar actions for copyright and patent infringement brought within the respective statutes of limitation. In these cases, however, this Court noted that in contrast to laches, equitable estoppel remains a viable equitable remedy "long recognized as available in actions at law" against "unscrupulous patentees" where there is "misleading and consequent loss."

For over a century, this Court and the Federal Circuit have held that a finding of equitable estoppel gives an accused infringer an implied license to a patented invention for the life of the patent, thereby constituting a waiver of the right to sue by the patentee. Yet for the first time, the Federal Circuit panel held that an implied license arising by equitable estoppel does not extend to the entire patented invention, but is instead restricted on a claim-by-claim basis to exclude claims added or substantially amended through *ex parte* reexamination, resulting in the implied license applying to select individual claims of a patent but not all.

The two questions presented are:

1. Whether the Federal Circuit erred and contradicted a century of this Court's licensing precedent in holding that implied license rights to a patent arising in equity, particularly equitable estoppel, do not attach to the *entire* patented invention but instead attach only to a subset of the patent's individual claims?
2. Whether the Federal Circuit erred and violated Morris's due process rights by deciding an

issue of first impression *sua sponte* not raised by the parties before the District Court or on appeal, which resulted in the court of appeals creating a new artificial categorical exception that restricts an accused infringer's pre-established implied license rights arising in equity?

Cert. petition filed 10/15/18 (full docket here).

CAFC Opinion, CAFC Argument

SSL Services, LLC v. Cisco Systems, Inc., No. 18-468

Questions Presented:

In 2000, the United States Patent Office (PTO) examined and granted U.S. Patent No. 6,158,011. Over the next 16 years, the '011 Patent produced some $22-million in infringement and licensing revenue. During that same time, the patent withstood scrutiny from nine PTO and judicial reviews challenging the patent's validity. This included three PTO reexaminations, two PTO de novo reviews of those reexaminations, a district court jury verdict and judgment, and a 2014 precedential Federal Circuit decision.

In 2015, Petitioner SSL sued Respondent Cisco for infringing the '011 Patent. Cisco responded by filing a request for inter partes review (IPR) at the PTO, using the same prior art that the patent had already repeatedly overcome in those prior reviews. Yet, instead of denying Cisco's request as duplicative and barred by the "Multiple-Proceedings" rule, 35 U.S.C. § 325(d), the PTO decided to review the patent once more - the tenth review of the '011 Patent's validity. The PTO compounded this error by thereafter incorrectly concluding what none of the other nine prior PTO or judicial reviews had: that the '011 Patent was invalid as obvious over this previously presented and rejected prior art.

In refusing to apply § 325(d), the PTO emphasized that Cisco was not the same party that had prompted the PTO's prior reviews. But this ruling contravened the statute's text and structure, as well as Congress's intent. Congress did not limit § 325(d) to blocking the same party from launching multiple validity challenges to the same patent—rather, § 325(d) applies so long as the "same or substantially the same prior art or arguments were previously presented to the [PTO]." And other related provisions in the statute address and estop the same party from doing so. See 35 U.S.C. §§ 315(e), 325(e). More broadly, in enacting provisions like § 325(d), Congress proclaimed that it did not want IPRs "to be used as tools for harassment … through repeated litigation and administrative attacks on the validity of a patent." H.R. Rep. No. 98, pt. 1, 112th Cong., at 48 (1st Sess. 2011). That is this case.

Nonetheless, the Federal Circuit declined to review the PTO's § 325(d) ruling. The court did so even though the PTO has applied this rule incorrectly and inconsistently in numerous other cases. The Federal Circuit also did so despite this Court's recent holding that PTO institution decisions like these are judicially reviewable under 35 U.S.C. § 314(d) if the challenge thereto does not require evaluating the merits of an IPR petition's invalidity theory. And § 325(d) requires no such merits

analysis; as noted, it asks whether the "same or substantially the same prior art or arguments were previously presented to the [PTO]." Thus, the Federal Circuit not only mistakenly declined to review the PTO's § 325(d) ruling, but also left its own standard for whether it will review such institution rulings both divided and uncertain.

The PTO's and Federal Circuit's failure to follow the law here undermines one of the bedrock elements of our patent system: predictability. And in turn, this unpredictability puts at risk the incentive to innovate that the system has protected and spurred since our Nation's inception. In short, if these rulings stand, it will frustrate the constitutional goals of the patent system. See U.S. Const., art. I, § 8 ("To promote the progress of science and useful arts . . . .").

The questions presented are:

1. Whether courts may review an agency's ruling on whether the § 325(d) Multiple-Proceedings rule applies and bars an IPR's institution when (1) the analysis of whether that rule applies does not require an evaluation of the IPR's invalidity merits; and (2) § 325(d) specifies criteria for the rule's application, viz., that a prior PTO proceeding presented the "same or substantially the same prior art or arguments" as those in the IPR petition.
2. Whether the Board erred in instituting an IPR notwithstanding 35 U.S.C. § 325(d) when (1) the same or substantially the same prior art and arguments in the IPR were presented to the PTO in multiple prior reviews; (2) the text of § 325(d) does not require that the same party have previously filed or participated in such prior PTO reviews, contrary to the Board's standard; and (3) other AIA provisions address this "same party" or "estoppel" context.

Cert. petition filed 10/9/18 (full docket here).

CAFC Opinion, CAFC Argument

Accord Healthcare, Inc. v. UCB, Inc., No. 18-441

Question Presented:

Did the Federal Circuit commit error in holding that a patent claim to an obvious modification of a prior art compound was not invalid as obvious under 35 U.S.C. § 103(a) because the prior art compound would not have been selected as a "lead compound" that was "most promising to modify in order to improve upon its activity and obtain a compound with better activity?

Cert. petition filed 10/3/18 (full docket here).

CAFC Opinion, CAFC Argument

HP Inc. v. Berkheimer, No. 18-415

Question Presented:

This Court has adopted a two-step framework for determining whether an invention is eligible for

patenting under 35 U.S.C. § 101. Alice Corp. Pty. Ltd. v. CLS Bank Int'l, 134 S. Ct. 2347 (2014). Both steps are reserved for the court: First, "we determine whether the claims at issue are directed to [a] patent-ineligible concep[t]." Second, "we . . . determine" whether "additional elements transform the nature of the claim into a patent-eligible application." Id. at 2355.

In this case, the Federal Circuit determined at step one that the claims are directed to an ineligible concept (an abstract idea), but at step two the court below refused to determine whether the additional elements of the claim disclose an inventive concept—declaring that the second step of the Alice framework involves a "question of fact" that could not be resolved by a court on a pretrial motion.

The question presented is whether patent eligibility is a question of law for the court based on the scope of the claims or a question of fact for the jury based on the state of the art at the time of the patent.

Cert. petition filed 9/28/18 (full docket here).

CAFC Opinion, CAFC Argument

Burnett v. Panasonic Corp., No. 14-414

Questions Presented:

1. Whether electronic data is the tangible embodiment of an electromagnetic analog or digital signal and when changed to a new and useful form of electronic data remains a tangible embodiment of an electromagnetic analog or digital signal and is therefore directed to patent-eligible subject matter within the meaning of 35 U.S.C. § 101 as interpreted by this Court.
2. Whether a process that creates a new and useful tangible embodiment of electronic data is therefore directed to patent-eligible subject matter within the meaning of 35 U.S.C. § 101 as interpreted by this Court.

Cert. petition filed 9/18/18 (full docket here).

CAFC Opinion, No CAFC Argument

Parker v. Iancu, No. 18-388

Questions Presented:

In *Dickinson v. Zurko*, 527 U.S. 150 (1999), this Court held that the United States Patent Office must support rejection with substantial evidence. *See Dickinson* at 152, citing 5 U.S.C. § 706(2)(E).

In the instant case, The Patent Office rejects Petitioners' patent claims based on either of two alleged antedating publications. Neither document, however, is of record. This appeal thus raises simple yet fundamental questions of agency overreach:

1. Whether the "substantial" evidence required to support agency action under 5 U.S.C. § 706(2)(E) must be evidence of record?
2. Whether agency rejection is "arbitrary" or "capricious" under 5 U.S.C. § 706(2)(A) if supported only by alleged evidence which is not of record and which the agency has not in fact considered?
3. Whether a document which is not publicly available is a "publication" under 35 U.S.C. § 102(b)?

Cert. petition filed 9/24/18 (full docket here).

CAFC Opinion, CAFC Argument

Wang v. Iancu, No. 18-371

Question Presented:

Whether the claims of the very useful invention contain "additional features" embodying an inventive concept that makes the invention patent-eligible.

Cert. petition filed 9/18/18 (full docket here).

CAFC Opinion, No CAFC Argument

Merck & Co., Inc. v. Gilead Sciences, Inc., No. 18-378

Question Presented:

Whether the equitable defense of unclean hands precludes legal relief in the form of damages.

Cert. petition filed 9/21/18 (full docket here).

CAFC Opinion, CAFC Argument

Capella Photonics, Inc. v. Cisco Systems, Inc., No. 18-314

Question Presented:

Whether the Federal Circuit's practice of routinely issuing judgments without opinions in appeals from the Patent Trial and Appeal Board violates 35 U.S.C. § 144, which provides that the Federal Circuit "shall issue . . . its mandate and opinion" in such appeals.

Cert. petition filed 9/6/18 (full docket here).

CAFC Opinion, CAFC Argument

Bhagat v. Iancu, No. 18-277

Questions Presented:

This petition presents a conflict between the incentive to invent, as the Constitution provides for, and the breadth of patent-eligible subject matter under 35 U.S.C. § 101. It has become difficult to recognize the line between patentable subject matter and non-patentable products of nature. This Court has made conflicting statements regarding that line.

In the case at hand, petitioner, a solo inventor, has invented new and useful lipid compositions that can improve the health of millions of Americans who suffer from chronic illness. Yet she is being denied a patent that would support her in bringing these beneficial inventions to market. This frustrates the purpose of the U.S. patent system.

This petition further presents the issue of holding the federal courts accountable in properly reviewing agency decisions.

The Questions Presented are:

1. a. Whether the Federal Circuit erred in finding petitioner's patent application claims unpatentable under 35 U.S.C. § 101 because the court failed to apply the correct patent-eligibility standard under this Court's conflicting holdings in *Funk Brothers Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127 (1948) and *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576 (2013).
   b. Whether the Federal Circuit erred in finding petitioner's patent application claims unpatentable under 35 U.S.C. § 101 because the court did not apply the patent-eligibility standard set forth in Myriad.
2. Whether the Federal Circuit erred in affirming the USPTO's decisions under 35 U.S.C. §§ 101 and 102(b) because it failed to apply "meaningful review" to that decision, as required by the Administrative Procedure Act.

Cert. petition filed 8/29/18 (full docket here).

CAFC Opinion, No CAFC Argument

Baker v. Micorsoft Corp., No. 18-276

Questions Presented:

Article I, Section 8, Clause 8, of the United States Constitution grants Congress the power "[t]o promote the progress of science and useful arts, by "securing" for limited times to authors and inventors the exclusive right to their respective writings and discoveries." US Patent holders when they give forth their discoveries petitioner believes form a binding contract agreement with the U.S. Government and judiciary to "secure" their private property against infringement. In proceedings today lower courts are not helping to secure for inventors their patents which seriously conflicts with the spirit of the Patent Act of 1790 (1 Stat. 109).

The questions presented are:

1. Whether under rights given by Congress and contained in U.S. Constitution. Article I Section 8. Clause 8 to all U.S. patent holders for disclosure of invention on even a scintilla

of evidence being shown of genuine dispute all courts must forward when requested proceedings to the trier of fact "a trial" otherwise the promise to secure for all inventors their personal property invention is broken by the U.S. Government?

2. Should the U.S. Government compensate inventors when the judiciary have failed to help secure their issued patent, a promise contained in U.S. Constitution. Article I Section 8. Clause 8 is broken?

Cert. petition filed 8/28/18 (full docket here).

CAFC Opinion, No CAFC Argument

Real Estate Alliance Ltd. v. Move, Inc., No. 18-252

Question Presented:

In *Alice Corp. Pty. Ltd. v. CLS Bank Int'l.*, 134 S. Ct. 2347 (2014), this Court reaffirmed its two-part test for determining whether an invention is patent-eligible under 35 U.S.C. § 101: (1) whether the patent claims are directed to a patent ineligible concept, such as laws of nature, natural phenomena, or abstract ideas, and (2), if so, whether the elements of the claim contain an "inventive concept" that transforms the ineligible concept into an invention that is patent-eligible; that is, whether the claims present "something more" than that which was, at the time of the invention, well-understood, routine and conventional.

The proper role of fact-finding with respect to the second part of the *Alice* test is the subject of a split among the judges of the Federal Circuit, and having a clear standard is of vital importance to all lower courts hearing patent cases, as well as to patent examiners of the United States Patent and Trademark Office, and all applicants for letters patent.

The question presented is:

Is whether an ordered combination of elements in a patent claim is "well-understood, routine and conventional" to a skilled artisan in the relevant field under Alice step two a question of fact?

Cert. petition filed 8/24/18 (full docket here).

CAFC Opinion, CAFC Argument

AIDS Healthcare Foundation, Inc. v. Gilead Sciences, Inc. and Japan Tobacco Inc., No. 18-182

Question Presented:

Many patients with HIV depend on lifesaving, low-cost drugs provided by Petitioner AIDS Healthcare Foundation, Inc. ("AHF"), a non-profit organization. Respondent Gilead Sciences, Inc. has patented HIV drugs including Tenofovir Alafenamide ("TAF"). In addition to its patents on TAF, Gilead also obtained five years of exclusivity for drugs containing TAF from the U.S. Food and Drug Administration ("FDA"). During this five-year exclusivity period, AHF and its generic drug suppliers

are prevented from filing an application with the FDA for approval of generic TAF. AHF seeks to introduce generic TAF to its patients as soon as possible (once Gilead's exclusivity period runs out) but is prevented from doing so by Gilead's patents on TAF. AHF filed a declaratory judgment action alleging invalidity of the patents, but the lower courts found that AHF lacked jurisdiction. This case presents the following question:

In the context of patent cases involving pharmaceutical products, does the "actual controversy" requirement of the Declaratory Judgment Act, 28 U.S.C. § 2201(a), require a party seeking to introduce a generic drug product to file an application for FDA approval of that generic drug product before it can file suit for declaratory relief for patent invalidity?

Cert. petition filed 8/7/18 (full docket here).

CAFC Opinion, CAFC Argument

Amgen Inc. v. Sanofi, Aventisub LLC, No. 18-127

Question Presented:

The 1952 Patent Act requires patents to "contain a written description of the invention, and of the manner and process of making and using it." 35 U.S.C. § 112(a). The "written description" must be "in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same." *Id*. "The object of the statute is to require the patentee to describe his invention so that others may construct and use it after the expiration of the patent." *Schriber-Schroth Co. v. Cleveland Tr. Co.*, 305 U.S. 47, 57 (1938).

The Federal Circuit has construed § 112(a) as imposing separate "written description" and "enablement" requirements subject to different standards. Ariad Pharms., Inc. v. Eli Lilly & Co., 598 F.3d 1336, 1344 (Fed. Cir. 2010) (en banc). The Federal Circuit holds that the standard in § 112(a) —"in such full, clear, concise, and exact terms as to enable" skilled artisans "to make and use" the invention—does not govern written description of the invention; it applies only to the "enablement" requirement ("the manner and process of making and using"). Id. For "written description of the invention," the Federal Circuit applies its own standard: The patent disclosure must demonstrate that the inventor "had possession" of the invention "as of the filing date." App., *infra*, 7a (quoting Ariad, 598 F.3d at 1350). The Federal Circuit has announced (and then modified or rescinded) various specialized "possession" sub-tests, as well as the evidence relevant to "possession." The question presented is:

Whether the standard for determining the adequacy of the "written description of the invention" should be as the statute says—that the description must be "in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains . . . to make and use the same" —or whether court-created standards should control instead.

Cert. petition filed 7/23/18 (full docket here).

CAFC Opinion, CAFC Argument

Ariosa Diagnostics, Inc. v. Illumina, Inc., No. 18-109

Question Presented:

In *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390 (1926), this Court held that, regardless of whether a patent claims a particular invention, the description of that invention in the body of the patent creates prior art as soon as the application disclosing the invention is filed, meaning that the disclosure can be used to invalidate any later-filed patent seeking to claim the same invention.

Congress codified and later extended this rule in 35 U.S.C. § 102(e), which provides that an invention "described" in a patent or published patent application is prior art as of its filing date. Congress further provided that where an application claims priority to an even earlier application that "disclosed" the same invention, it "shall have the same effect, as to such invention, as though filed on" the earlier date. 35 U.S.C. §§ 119(e)(1), 120.

The question presented is:

Do unclaimed disclosures in a published patent application and an earlier application it relies on for priority enter the public domain and thus become prior art as of the earlier application's filing date, or, as the Federal Circuit held, does the prior art date of the disclosures depend on whether the published application also claims subject matter from the earlier application?

Cert. petition filed 7/1/18 (full docket here).

CAFC Opinion, CAFC Argument

Advanced Video Technologies LLC v. HTC Corp., No. 18-77

Question Presented:

Rule 19 of the Federal Rules of Civil Procedure provides that where a necessary party to a lawsuit has not been joined, "the court must order that the person be made a party." The Court of Appeals for the Federal Circuit ruled below that involuntary joinder under Rule 19 simply does not apply to patent cases due to a "substantive right" that a co-owner of a patent can impede the right of another co-owner from suing infringers in a patent infringement lawsuit. The majority opinion continues a long trend in which the Federal Circuit ignores Supreme Court precedent, as well as the Federal Rules of Civil Procedure on the basis that these laws and precedents somehow do not apply to patent law.

The question presented is:

Did the Federal Circuit properly create an exception to Rule 19 of the Federal Rules of Civil Procedure in patent law, requiring a dismissal of a case in which Rule 19 would otherwise mandate joinder of an absent patent owner as an involuntary plaintiff?

Cert. petition filed 7/12/18 (full docket here).

CAFC Opinion, CAFC Argument

RPX Corp. v. Chanbond LLC, No. 17-1686

Question Presented:

Can the Federal Circuit refuse to hear an appeal by a petitioner from an adverse final decision in a Patent Office *inter partes* review on the basis of lack of a patent-inflicted injury in fact when Congress has (i) statutorily created the right to have the Director of the Patent Office cancel patent claims when the petitioner has met its burden to show unpatentability of those claims, (ii) statutorily created the right for parties dissatisfied with a final decision of the Patent Office to appeal to the Federal Circuit, and (iii) statutorily created an estoppel prohibiting the petitioner from again challenging the patent claims?

Cert. petition filed 6/18/18, CVSG 10/1/18 (full docket here).

CAFC Opinion, No CAFC Argument

Return Mail, Inc. v. United States Postal Service, No. 17-1594

Questions Presented:

The government cannot be sued for patent infringement under the Patent Act, 35 U.S.C. §§ 1 et seq., because it can take "a license to use the inventio[n]" by "exert[ing] the power of eminent domain." *Crozier v. Fried. Krupp Aktiengesellschaft*, 224 U.S. 290, 305 (1912). Thus, a patent owner's exclusive remedy for governmental use is to pursue a compensation action under 28 U.S.C. § 1498(a) at the U.S. Court of Federal Claims.

In 2011, Congress enacted the Leahy-Smith America Invents Act (AIA), which allows a "person" who has been sued for patent "infringement" to challenge the patent's validity through a covered business method (CBM) review before the Patent Trial and Appeal Board. Respondent, the U.S. Postal Service, petitioned for CBM review of Petitioner's patent after Petitioner filed suit under § 1498(a). The Board instituted the review, concluding that it has authority to adjudicate proceedings initiated by the government, and later issued a final decision invaliding Petitioner's patent. The Federal Circuit affirmed, over a dissenting opinion.

The questions presented are:

1. Whether the government is a "person" who may petition to institute review proceedings under the AIA.
2. Whether a § 1498(a) action for the eminent domain taking of a patent license by the government is a suit for patent "infringement" under the AIA.

Cert. petition filed 5/14/18 (full docket here).

For more information on this or other patent appeal matters, contact:

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