
Federal Circuit Patent Updates - May 2016

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***Ruckus Wireless, Inc. v. Innovative Wireless Solutions* (No. 2015-1425, 1438, 5/31/16) (Prost, Reyna, Stark)**

May 31, 2016 3:11 PM

Reyna, J. Affirming summary judgment of non-infringement of patents based on construction of the phrase “communications path” as excluding wireless embodiments. Stark, J., dissented.

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

***In re Arunachalam* (No. 2016-1560, 5/27/16) (Taranto, Chen, Hughes)**

May 27, 2016 12:44 PM

Hughes, J. Court lacked jurisdiction of an appeal of a rejection after prosecution was reopened where applicant failed to appeal rejection to the Board.

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

***David Netzer Consulting v. Shell Oil Company* (No. 2015-2086, 5/27/16) (Prost, Lourie, Taranto)**

May 26, 2016 10:21 AM

Lourie, J. Affirming summary judgment that claims were not infringed based on disclaimer of subject matter. Summary judgment also entered under the doctrine of equivalents based on disclaimer and holding that accused process was not substantially the same as claimed process.

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

***Profectus Technology LLC v. Huawei Technologies Co., Ltd.* (No. 2015-1016, 1018, 1019, 5/26/16) (Moore, Reyna, Wallach)**

May 26, 2016 5:04 PM

Reyna, J. Affirming claim construction and summary judgment of non-infringement of patent directed to digital image frame. A tablet computer's communication port could not be considered a feature for mounting the device as required by the court's claim construction. Moore, J., dissented.

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

***In re Aqua Products, Inc.* (No. 2015-1177, 5/25/16) (Prost, Reyna, Stark)**

May 25, 2016 3:10 PM

Reyna, J. Affirming PTAB and its procedures for amending claims during an IPR. The Board did not err in failing to evaluate objective indicia and various new limitations where the patentee did not argue that those indicia and limitations rendered the proposed claims patentable.

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

***Tu Communications LLC v. AV Automotive, LLC* (No. 2015-1372, 5/17/16) (Dyk, Schall, Hughes)**

May 17, 2016 5:04 PM

Hughes, J. Affirming dismissal of complaint because the asserted patent failed to claim patent-eligible subject matter under 35 U.S.C. § 101. “[T]he patent-in-suit claims no more than the abstract idea of classifying and storing digital images in an organized manner.” “[A]lthough the claims limit the abstract idea to a particular environment—a mobile telephone system—that does not make the claims any less abstract” “It is well-settled that mere recitation of concrete, tangible components is insufficient to confer patent eligibility to an otherwise abstract idea.”

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

***Diamond Coating Technologies v. Hyundai Motor America* (No. 2015-1844, 5/17/16) (Wallach, Bryson, Taranto)**

May 17, 2016 2:55 PM

Wallach, J. Affirming dismissal of action for lack of standing because the plaintiff did not receive all substantial rights in the patents in suit from its assignor (including the right to practice the patents), and a later *nunc pro tunc* assignment to confer additional rights was not sufficient to confer retroactive standing.

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

***Intendis GMBH v. Glenmark Pharmaceuticals Inc.* (No. 2015-1902, 5/16/16) (Prost, Moore, Taranto)**

May 16, 2016 10:40 AM

Moore, J. Affirming judgment of infringement of an ANDA under the doctrine of equivalents and nonobviousness. “We have never held that a patent must spell out a claim element's function, way, and result in order for the doctrine of equivalents to apply as to that element.” “The relevant inquiry is

what the claim element's function in the claimed composition is to one of skill in the art, and a fact finder may rely on extrinsic evidence in making this factual determination." "Glenmark's repeated statements to the FDA that the claimed excipients function as penetration enhancers tend to show that one of skill in the art would understand the claimed excipients to function as penetration enhancers. We see no reason why a district court acting as a fact finder should ignore a party's representation to a federal regulatory body that is directly on point."

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

***Merck & Cie v. Watson Laboratories, Inc.* (No. 2015-2063, 5/13/16) (Dyk, Mayer, Hughes)**

May 13, 2016 3:18 PM

Mayer, J. Reversing judgment that a claim was not invalid under the on-sale bar of 35 U.S.C. § 102(b) (2006). "An offer to sell is sufficient to raise the on-sale bar, regardless of whether that sale is ever consummated."

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

***Howmedica Osteonics Corp. v. Zimmer, Inc.* (No. 2015-1232, 5/12/16) (O'Malley, Plager, Wallach)**

May 12, 2016 4:30 PM

Plager, J. Affirming summary judgment of noninfringement and judgment prohibiting assertion of doctrine of equivalents where the patentee never sought to amend its infringement contentions to assert that doctrine.

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

***Enfish, LLC v. Microsoft Corporation* (No. 2015-1244, 5/12/16) (Moore, Taranto, Hughes)**

May 12, 2016 2:15 PM

Hughes, J. Reversing summary judgment of invalidity under 35 U.S.C. § 101, vacating summary judgment of invalidity of some claims under § 102, and affirming summary judgment of noninfringement of some claims. "The "directed to" inquiry [of *Mayo/Alice*]... cannot simply ask whether the claims *involve* a patent-ineligible concept, because essentially every routinely patent-eligible claim involving physical products and actions *involves* a law of nature and/or natural phenomenon—after all, they take place in the physical world." "We ... see no reason to conclude that all claims directed to improvements in computer-related technology, including those directed to software, are abstract and necessarily analyzed at the second step of *Alice*, nor do we believe that *Alice* so directs." "In this case ..., the plain focus of the claims is on an improvement to computer functionality itself, not on economic or other tasks for which a computer is used in its ordinary capacity. Accordingly, we find that the claims at issue in this appeal are not directed to an abstract idea within the meaning of *Alice*. Rather, they are directed to a specific improvement to the way computers operate" "Much of the advancement made in computer technology consists of improvements to software that, by their very nature, may not be defined by particular physical

features but rather by logical structures and processes. We do not see in *Bilski* or *Alice*, or our cases, an exclusion to patenting this large field of technological progress.”

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

***IGT v. Aristocrat Technologies, Inc.* (No. 2015-2083, 5/12/16) (Prost, Newman, Lourie)**

May 12, 2016 12:41 PM

Prost, C.J. Affirming denial of a preliminary injunction to prohibit challenging the validity of patents at the PTO based on alleged assignor estoppel . “While we agree with the district court that the circumstances existing at the time of its decision were too speculative to justify a preliminary injunction, we vacate and remand for the court to consider recent updates in events.” “We begin by clarifying what we are *not* deciding in this case. Although both parties brief the question of whether or not the doctrine of assignor estoppel should apply in PTO proceedings, they both conclude that we need not answer that question in this case. We agree. That question is not properly before us and we therefore render no opinion on it.”

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

***Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.* (No. 2015-1693, 5/9/16) (O'Malley, Wallach, Hughes)**

May 9, 2016 10:50 AM

O'Malley, J. Affirming Board decision in *inter partes* review that challenged claims, related to labeling nucleotides, were not obvious. While the Court agreed with the Board's conclusion of obviousness, the Court criticized the Board's analysis of “reasonable expectation of success.” “The Board seemed to believe that the 'reasonable expectation of success' inquiry looked to whether one would reasonably expect the prior art references to operate as those references intended once combined. That is not the correct inquiry—one must have a motivation to combine accompanied by a reasonable expectation of achieving what is claimed in the patent-at-issue.” Also, the Board properly rejected new arguments raised in the petitioner's reply. “Unlike district court litigation—where parties have greater freedom to revise and develop their arguments over time and in response to newly discovered material—the expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute. While the Board's requirements are strict ones, they are requirements of which petitioners are aware when they seek to institute an IPR.”

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