
Federal Circuit Patent Updates - September 2017

September 2017

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***Jang v. Boston Scientific Corporation* (No. 2016-1575, 9/29/17) (Prost, O'Malley, Chen)**

September 29, 2017 1:08 PM

Chen, J. Affirming denial of motion for JMOL, vacatur of verdict of infringement under the doctrine of equivalents, and judgment of non-infringement. “A doctrine of equivalents theory cannot be asserted if it will encompass or 'ensnare' the prior art.” Patentee “did not meet his burden of proving that his doctrine of equivalents theory did not ensnare the prior art as he failed to draft a proper hypothetical claim.”

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

***In Re Smith International, Inc.* (No. 2016-2302, 9/26/17) (Lourie, Reyna, Hughes)**

September 26, 2017 11:42 AM

Lourie, J. Reversing Board decision of obviousness in an inter partes reexamination due to an improper claim construction. “The correct inquiry in giving a claim term its broadest reasonable interpretation in light of the specification is not whether the specification proscribes or precludes some broad reading of the claim term adopted by the examiner. And it is not simply an interpretation that is not inconsistent with the specification. It is an interpretation that corresponds with what and how the inventor describes his invention in the specification, *i.e.*, an interpretation that is 'consistent with the specification.'”

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

In Re Cray Inc. (No. 2017-129, 9/21/17) (Lourie, Reyna, Stoll)

September 21, 2017 3:39 PM

Lourie, J. Order granting petition for mandamus directing case be transferred out of the Eastern District of Texas because of improper venue. “The district court misinterpreted the scope and effect of our precedent in determining that [defendant] maintained 'a regular and established place of business' in the Eastern District of Texas within the meaning of 28 U.S.C. § 1400(b).” In meeting this statutory venue requirement, there are “three general requirements relevant to the inquiry: (1) there must be a physical place in the district; (2) it must be a regular and established place of business; and (3) it must be the place of the defendant. If any statutory requirement is not satisfied, venue is improper under § 1400(b).” A defendant's employee's house out of which he worked was not a “physical” place of business “of the defendant.” “The statute ... cannot be read to refer merely to a virtual space or to electronic communications from one person to another.”

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

NFC Technology, LLC v. Matal (No. 2016-1808, 9/20/17) (Newman, Lourie, Hughes)

September 20, 2017 5:17 PM

Lourie, J. Reversing PTAB finding of obviousness in an IPR and remanding. The patentee argued that it had created a prototype embodying the claimed invention before the priority date of a cited reference. The Board erred in finding that the prototype that was fabricated by a third party was not conceived by the patentee and that the third-party's activity did not inure to the patentee's benefit.

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

Idemitsu Kosan Co., Ltd. v. SFC Co. Ltd. (No. 2016-2721, 9/15/17) (Prost, O'Malley, Chen)

September 15, 2017 4:51 PM

O'Malley, J. Affirming PTAB finding of obviousness in an IPR. The IPR petitioner “of course, bears the ultimate burden of establishing unpatentability, but it is not required as a matter of law to rebut mere *attorney argument* with *expert testimony* in order to satisfy that burden.” “Evidence concerning whether the prior art teaches away from a given invention must relate to and be commensurate in scope with the ultimate claims at issue.”

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

First Data Corporation v. Inselberg (No. 2016-2677, 9/15/17) (Newman, O'Malley, Stoll)

September 15, 2017 1:33 PM

O'Malley, J. Affirming dismissal of federal claims for lack of subject matter jurisdiction, and a remand of state law claims to state court was not reviewable. "The relatively unique facts of this case show that, at the very least, the counterclaims and the declaratory judgment claims are not ripe at this time." "[I]n recent years the Supreme Court has clarified the difference between merits issues and jurisdictional issues arising from federal statutory requirements."

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

Waymo LLC v. Uber Technologies, Inc. (No. 2017-2235, 9/13/17) (Newman, Wallach, Stoll)

September 13, 2017 6:07 PM

Wallach, J. Denying petition for writ of mandamus seeking relief from orders compelling production of allegedly privileged documents. "[I]t is apparent that [petitioner] cannot invoke attorney-client privilege or work-product protection." "[T]o invoke the common interest doctrine, a party first must demonstrate the elements of privilege and then must demonstrate that the communication was made in pursuit of common legal claims including common defenses."

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

Waymo LLC v. Uber Technologies, Inc. (No. 2017-2130, 9/13/17) (Newman, Wallach, Stoll)

September 13, 2017 3:48 PM

Newman, J. Affirming denial of motion to compel arbitration.

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

Intellectual Ventures I LLC v. Motorola Mobility LLC (No. 2016-1795, 9/13/17) (Newman, Dyk, Taranto)

September 13, 2017 12:16 PM

Dyk, J. Affirming in part and reversing in part jury verdict of infringement and validity and remanding. "The proper result is not that claim 41 fails for lack of written description but that it should be construed 'in view of the specification' to be limited." "In an analysis of a system claim under *Centillion*, proof of an infringing 'use' of the claimed system under § 271(a) requires the patentee to demonstrate that the direct infringer obtained 'benefit' from each and every element of the claimed system." Newman, J., concurred in part and dissented in part.

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

***Allied Mineral Products, Inc. v. OSMI, Inc.* (No. 2016-2641, 9/13/17) (Moore, Reyna, Stoll)**

September 13, 2017 9:27 AM

Moore, J. Affirming dismissal of declaratory judgment (DJ) action for lack of subject matter jurisdiction. The patentee/DJ defendant's actions (suing the DJ plaintiff's Mexican distributors in Mexico for infringement of a Mexican patent, with no threat of suit against the DJ plaintiff in the US under a US patent) did not create a justiciable case or controversy. “[T]he fear of a future infringement suit is insufficient to confer jurisdiction.”

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

***Southwire Company v. Cerro Wire LLC* (No. 2016-2286, 9/8/17) (Lourie, Moore, Hughes)**

September 8, 2017 11:08 AM

Lourie, J. Affirming conclusion of obviousness in *inter partes* reexamination. The Board erred in relying on inherency, but the error was harmless. “In sum, the Board's underlying factual findings are supported by substantial evidence and reasonably support its conclusion that it would have been 'obvious to have selected such amounts' as would achieve the claimed” requirements.

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

***Intercontinental Great Brands v. Kellogg North America Company* (No. 2015-2082, -2084, 9/7/17) (Prost, Reyna, Taranto)**

September 7, 2017 3:26 PM

Taranto, J. Affirming summary judgment of obviousness of patent relating to resealable food package. Also affirming summary judgment rejecting counterclaim of unenforceability. The district court conducted its obviousness analysis in this order: (a) finding that all elements of the independent claims were shown in the prior art, (b) finding that a person of ordinary skill would have been motivated to combine the references, (c) finding no basis for a different conclusion about the art-based portion of the obviousness analysis for the dependent claims, and (d) concluding that defendant's “evidence of certain objective indicia, though substantial, was simply not entitled to such weight in the ultimate legal assessment of obviousness as to produce a bottom-line conclusion of anything but invalidity.” The Court rejected defendant's argument that objective indicia must be evaluated before drawing a conclusion about motivation to combine and found that the district court's “structuring of the analysis fulfills the requirement that the approach to determine obviousness is 'expansive' and 'flexible.’” Patentee's argument that the prior art had been

considered by the PTO during reexamination and therefore placed an “enhanced burden” on defendant was unpersuasive. Regarding inequitable conduct, the patentee used a reference “that was the central focus before the Board” that contained a misprint. However, defendant did not establish that patentee used that reference with an intent to deceive. Reyna, J. dissented-in-part.

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

Lifetime Industries, Inc. v. Trim-Lok, Inc. (No. 2017-1096, 9/7/17) (Lourie, Moore, O'Malley)

September 7, 2017 1:19 PM

Lourie, J. Reversing grant of motion to dismiss for patent related to recreational vehicles (RVs). Patentee adequately pleaded direct infringement of claim requiring an RV and a seal by pleading that defendant installed the claimed seal into an RV. “[Defendant’s] complaints concerning lack of detail ask for too much. There is no requirement for [patentee] to ‘prove its case at the pleading stage.’” Patentee also adequately pleaded induced and contributory infringement.

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

Mentor Graphics Corporation v. Eve-USA, Inc. (No. 2015-1470, -1554, -1556, 9/1/17) (Prost, Newman, Lourie, Dyk, Moore, O'Malley, Reyna, Wallach, Taranto, Chen, Hughes, Stoll)

September 1, 2017 9:08 AM

Per Curiam. Denying petitions for panel rehearing and rehearing en banc.

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