

Brief Summary of Precedential Patent Case Decisions During August 2018

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I. Introduction

This paper contains brief summary abstracts of what I believe to be the significant new points of law from the precedential decisions in patent cases this month. Cases captions relating to the PTAB are in **red** text. Case captions of extraordinary importance are in **blue** text.

II. Abstracts and New Points of Law

Ericsson Inc. v. Intellectual Ventures I LLC, 2017-1521 (Fed. Cir. 8/27/2018).

This is a decision on an appeal from PTAB case IPR2015-01367. The PTAB found certain claims of IV's patent not unpatentable under 35 USC 103. Ericsson appealed. The Federal Circuit vacated and remanded.

Legal Issue: 5 USC 554(b)(3), (c), notice an opportunity to be heard, scope of petitioner reply.

The Federal Circuit concluded that the PTAB erred by failing to provide notice and opportunity to be heard, by failing to consider Ericsson's reply, after the PTAB changed claim constructions, and then relying upon the changed claim construction, in its final decision.

In re Maatita, 2017-2037 (Fed. Cir. 8/20/2018).

This is a fascinating decision on an appeal from PTAB case 29/404,677 (series 29 identifies a design patent application). The PTAB affirmed examiner's rejections of the claim under 35 USC 112 as non-enabled and indefinite. Maatita appealed. The Federal Circuit reversed.

The relevant facts were that the disclosed and therefore claimed design consisted of a plan view figure showing the bottom of a shoe, having a plurality of features. The application included no figure showing whether the design features projected from, recessed into, or were flat, relative to the surface of the remainder of the bottom of the shoe, and there was no figure showing which of the plurality of design features were projected, recessed, or flat, relative to the remainder of the bottom of the shoe. In other words, the claimed design was so broad that it read on all variations of projections, recesses, and flat regions for each of the plurality of design features. The claim was rejected for lack of enablement and definiteness based upon these facts.

Legal Issue: 35 USC 112, design claim definiteness for design patents disclosing only a plan view.

The Federal Circuit held that a design patent containing only a plan view "demonstrates the perspective from which the shoe bottom [sic; accused infringing article] should be viewed," and therefore is not indefinite. In other words, the patent, by including only a plan view, specified that view as the test for infringement. The Federal Circuit reasoned that, because an ordinary observer would know to compare the patent to a plan view of a shoe bottom to determine infringement, a patent specifying only a plan view was not indefinite.

35 USC 112: design patent definiteness determined from the perspective of an ordinary observer.

The Federal Circuit also held that definiteness of a design patent was determined from the perspective of an ordinary observer.

Core Wireless Licensing S.A.R.L. v. Apple Inc., 2017-2102 (Fed. Cir. 8/16/2018).

This is a decision on an appeal from the N.D. Cal. case 5:15-cv-05008-NC. The district court *inter alia* rejected Apple's argument that the '151 patent was unenforceable due to implied waiver. On this issue, the Federal Circuit vacated and remanded.

Legal issue: 35 USC 282(b)(1) unenforceability, implied waiver, failure to timely disclose patent application embodying proposed addition to a standard.

The Federal Circuit concluded that the district court erred in finding that Nokia did not have a duty to promptly disclose the Finnish application to ETSI (a standards body) when it requested the feature defined by the Finnish application be included in the ETSI standard.

Click-To-Call Technologies, LP v. Ingenio, Inc., 2015-1242 (Fed. Cir. 8/16/2018)(en banc as to footnote 3).

Legal issue: 35 USC 315(b), time bar, effect of voluntary dismissal.

The en banc court held that voluntary dismissal of a complaint is not relevant to the 35 USC 315(b) one year time bar.

Luminara Worldwide, LLC v. Iancu, 2017-1629, 2017-1631, 2017-1633 (Fed. Cir. 8/16/2018).

This is a decision on appeals from PTAB cases IPR2015-01352; IPR2015-01656; IPR2015-01657; and IPR2015-01658. The PTAB held claims of each patent unpatentable. Luminara appealed on the grounds that the IPR proceedings were time barred under 315(b). The Federal Circuit vacated and remanded for dismissal of the decision in on IPR, holding the time bar applied, citing its same-day en banc *Click-To-Call Technologies* holding.

In re Power Integrations, Inc., 2018-144, 2018-145, 2018-146, 2018-147 (Fed. Cir. 8/16/2018).

This is a decision on mandamus petitions from PTAB proceedings IPR2017-01903; IPR2017-01904; IPR2017-01944; and IPR2017-01975. The PTAB denied the IPR petitions. Power petitioned for review of the denials. The Federal Circuit denied the petitions.

Legal issue: 35 USC 314(d) nonappealability of the Director's decision whether to institute.

The substantive issue in this case was the PTAB's conclusion that Power failed to show that references relied upon in the petitions were time-wise available prior art to the challenged claims. The Federal Circuit concluded *inter alia* that the petitions merely challenged the PTAB's finding that the information presented in the petition did not warrant review, and therefore the petitions were barred by 314(d); *Dominion Dealer Solutions*; and *Cuozzo*.

In re Rembrandt Technologies LP Patent Litigation, 2017-1784 (Fed. Cir. 7/27/2018).

This is an appeal from 17 D. Del. district court cases.

Legal issue: 35 USC 285, exceptionality factors.

The Federal Circuit found that: (1) the district court's findings that Rembrandt's contract to pay consultants dependent upon the outcome of the case, which consultants became fact witnesses; that Rembrandt failed to prevent widespread foliation; and (3) that Rembrandt committed inequitable conduct, were not clearly erroneous and supported the district court's finding exceptionality. The Federal Circuit concluded that the fact that some factors did not

apply to all defendants in this large MDL consolidated proceeding, did not require the district court to make case by case exceptionality determinations.

Legal issue: 35 USC 285, fee award requirements, causal connection to misconduct.

The Federal Circuit concluded that the district court had not establish the necessary causal connection between the claimed misconduct to entitled the specified fees awards for every defendant. This was at least because the claimed misconduct affected only some patents asserted against some defendants, a factor not addressed by the district court. So, while the Federal Circuit concluded exceptionality did not require a case-by-case analysis in a large MDL situation, fee awards did.

BSG Tech LLC v. Buyseasons, Inc., 2017-1980 (Fed. Cir. 8/15/2018).

This is a decision on appeals from the E.D. Tex. district court cases 2:16-cv-00529-RWS and 2:16-cv-00530-RWS. The district court concluded that all asserted patent claims were ineligible under 35 USC 101, and consequently dismissed the civil action. BSG, the plaintiff, appealed. The Federal Circuit affirmed.

Legal issue: 35 USC 101, patent eligibility, abstraction, *Alice* step 1.

The Federal Circuit agreed with the district court that a method of indexing and retrieving data, in which the system performing the method displayed to a person categorizing a new entry, the existing stored comparison information, was abstract, failing *Alice* step 1. In response to arguments on appeal, the Federal Circuit explained that: (1) that limiting a claim to components more specific than a generic computer; (2) that limiting a claim to applying an abstract idea in a narrow way; and (3) that limiting a claim resulting in better user input that did not affect how (or improve how) a database stored information, were all still abstract, failing *Alice* step 1.

JTEKT Corporation v. GKN Automotive Ltd., 2017-1828 (Fed. Cir. 8/3/2018).

This is a decision on an appeal from PTAB case IPR2016-00046. Petitioner JTECK appealed. The Federal Circuit dismissed the appeal.

Issue: Article III, standing, injury in fact

The evidence showed that JTEKT's "design ... concept ... may change until it is completely finalized" and JTEKT could not "say whether or not it will infringe the '440 patent." On those facts, notwithstanding that statutory estoppel would apply against JTEKT if it ever did infringe, the Federal Circuit held JTEKT had failed to show injury in fact sufficient to entitle it to standing to appeal.

SAP America, Inc. v. InvestPic , LLC, 2017-2081 (Fed. Cir. 8/2/2018).

This is a decision on an appeal from N.D. Tex. case 3:16-cv-02689-K. The district court held all claims ineligible under 35 USC 101, on the pleadings. InvestPic appealed. The Federal Circuit affirmed. The Federal Circuit reissued its May 15, 2018 opinion, on 8/2/2018, apparently modified to explain the status of claims as a result of USPTO reexamination, which status was not clear in its original opinion. Other than that, I find no difference in the opinions.

Advantek Marketing, Inc., v. Shanghai Walk-long Tools Co., Ltd., 2017-1314 (Fed. Cir. 8/1/2018).

This is a decision on an appeal from the C.D. Cal. district court case 2:16-cv-03061-RFFM. The district court granted Shanghai's motion for judgment on the pleadings under FRCP 12(c), holding that prosecution history estoppel barred Advantek from enforcing the D'006 patent against the allegedly infringing product. Advantek appealed. The Federal Circuit reversed and remanded.

Legal issue, 35 USC 112, claim construction, design patent.

The Federal Circuit in essence concluded that response to an election in a design patent application between a genus claim and a species claim did not preclude infringement of the genus claim by a product embodying the species. Basically, the district court misapplied the doctrine of prosecution history estoppel to reach a legally incorrect conclusion.

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