

Brief Summary of Precedential Patent Case Decisions During February 2019

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I. Introduction

This paper contains 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. Brief Summary Abstracts and New Points of Law

University of Florida Research Foundation, Inc. v. General Electric Company, 2018-1284 (Fed. Cir. 2/26/2019).

This is a decision on an appeal from the S.D. Fla. case 1:17-cv-00171-MW-GRJ. The district court granted General Electric (GE)'s FRCP 12b(6) motion to dismiss on the ground that the patent claimed ineligible subject matter. Florida appealed. The Federal Circuit affirmed.

Legal issue: Eleventh Amendment of the constitution, sovereign immunity, whether a subject matter eligibility challenge is defense to a claim of infringement, thereby constituting waiver of sovereign immunity.

The Federal Circuit concluded subject matter eligibility challenge is defense to a claim of infringement, thereby constituting waiver of sovereign immunity.

CODA Development S.R.O. v. Goodyear Tire & Rubber Company, 2018-1028 (Fed. Cir. 2/22/2019).

This is a decision on an appeal from the N.D. Ohio district court case 5:15-cv-01572-SL. CODA sued Goodyear for patent inventorship correction. The district court dismissed the complaint for failure to state a claim. CODA appealed. The Federal Circuit vacated and remanded.

Legal issue: FRCP 12(b)(6), sufficiency of the complaint, plausibility requirement.

This opinion indicates that district court committed multiple procedural errors, including the consideration of material outside the pleadings and taking judicial notice of contested facts, leading to its incorrect result.

Dr. Falk Pharma GMBH v. Generico, LLC, 2017-2312; 2017-2636; 2018-1320; and 2018-2097 (Fed. Cir. 2/8/2019; published 2/20/2019).

This is a decision on appeals from PTAB cases IPR2016-00297; IPR2016-01386; and IPR2016-01409; the N.D.W. Va. district court case 1:15-cv-00109-IMK; and the D.N.J. district court cases 2:15-cv-08180-SRC-CLW; 2:15-cv-08353-SRC-CLW; 2:16-cv-00035-SRC-CLW, 2:16-cv-00889-SRC-CLW; and 2:17-cv-06714-SRC-CLW.

Legal issue: Model Rule of Professional Conduct 1.7(a), concurrent conflict of interest; conflicts defined by engagement contracts and interrelated corporate entities.

The Federal Circuit concluded that the law firm, Katten Muchin Rosenman LLP, was in violation of the rule after applying the "total context" test. The "total context" included Katten's general engagement agreement with Bausch & Lomb, and entity affiliated with the movant entities. That agreement precluded Katten from representations against affiliates, parents, and

subsidiaries, of Bausch & Lomb.

Centrak, Inc. v. Sonitor Technologies, Inc., 2017-2510 (Fed. Cir. 2/14/2019).

This is a decision on an appeal from the D. Del. district court case 1:14-cv-00183-RGA. The district court granted Sonitor's SJ motion that some claims were invalid for lack of written description and others were not infringed. Sonitor appealed. The Federal Circuit reversed and remanded.

Legal issue: Genuine issue of material fact regarding written description; whether it adequately convey to a skilled artisan that the inventors possessed.

The specification discussed an ultrasonic alternative to infrared, in two sentences. The Federal Circuit relied upon the written description test, that the specification should identify the claimed invention in a definite way, to conclude that the specification satisfied the ultrasonic embodiment defined by the claims.

Adello Biologics LLC v. Amgen Inc., PGR2019-00001, paper 11 (PTAB 2/14/2019; designated precedential 2/14/2019).

Legal issue: 35 USC 322(a)(2), PGR petition requirement to identify all real parties in interest, addition of RPI after filing and prior to institution.

The PTAB allowed the petitioner to add an RPI after filing and prior to a decision on institution, noting that the original RPI allowed the PTAB to effectively check for conflicts, and there was no undue prejudice to Patent Owner.

Continental Circuits LLC v. Intel Corporation, 2018-1076 (Fed. Cir. 2/8/2019).

This is a decision on an appeal from the D. Az. district court case 2:16-cv-02026-DGC. The parties stipulated to noninfringement based upon the district court's claim construction. The district court entered judgement of noninfringement. Continental appealed. The Federal Circuit vacated and remanded.

Legal Issue: 35 USC 112, claim construction, product-by-process.

The Federal Circuit disagreed with the conclusions the district court that the claimed device required structure "*produced by a repeated desmear process.*" That is, a product-by-process limitation. The Federal Circuit disagreed on virtually all of the district court conclusions regarding what implications arose from the specification, prosecution history, and extrinsic evidence.

Momenta Pharmaceuticals, Inc. v. Bristol-Myers Squibb Company, 2017-1694 (Fed. Cir. 2/7/2019).

This is a decision on an appeal from PTAB case IPR2015-01537. Momenta appealed the PTAB's sustaining patentability of patent claims. The Federal Circuit dismissed for lack of standing, and for mootness.

Legal issues: Article III Standing, mootness, and speculation.

Bristol-Myers's patent covered the drug having brand name Orenicia®. Momenta's FDA filings indicated that it abandoned its attempt to commercialize an infringing compound at some time prior to the Federal Circuit's decision in this case. However, had been in a development project with Mylan. Momenta asserted to the Court that it still had "an economic interest in ... biosimilar that might be developed by Mylan." The Federal Circuit concluded that the possibility that Mylan might be obliged to pay Momenta royalties in the future, if Mylan subsequently produced an infringing compound, was insufficient to confer Article III standing.

Athena Diagnostics, Inc. v. Mayo Collaborative Services, LLC, 2017-2508 (Fed. Cir. 2/6/2019).

This is a decision on an appeal the D. Mass district court case 1:15-cv-40075-IT. Judge Lourie wrote the majority opinion, joined by Judge Stool. Judge Newman dissented.

The district court held Athena's claims 6-9 invalid under 35 UCS 101 and dismissed Athena's complaint pursuant to FRCP 12(b)(6). Athena appealed. The Federal Circuit affirmed.

Legal issue: 35 USC 101, Alice step 1, "directed to," natural law test.

The majority concluded that claims that "involve both the discovery of a natural law and certain concrete steps to observe its operation" were invalid when the concrete steps used in making the observation were conventional.

Legal issue: FRCP12(b)(6), evidence submitted in opposition

The majority concluded that the District Court was not required to consider Athena's expert declaration submitted with its opposition to the 12(b)(6) motion, first, because of applicable first circuit law, and second, because the declaration asserted facts not consistent with the complaint nor defined by the claims.

Note: A big problem here was with Athena's patent's disclosure. Why did the patent not disclose "breaking up MuSK into smaller fragments"; claim the "factors [that] contribute" to adequacy of the binding site; and information showing uncertainty in "immunoprecipitation"? Why did the patent instead characterize all procedures as conventional? It seems that this case was lost at the patent drafting stage.

In re Google, 2018-152 (Fed. Cir. 2/5/2019).

Legal issue: 35 USC 1400(b), venue, what constitutes a regular and established place of business in e-commerce.

Google petitioned for rehearing en banc of its petition for a writ of mandamus to the E.D. Tex. judge in case 2:17-cv-00442-JRG, to grant Google's 1400(b) venue motion. The en banc Federal Circuit denied rehearing. The dissent by Judges Reyna, Lourie, and Newman, to the denial of rehearing en banc identified the issue of what constitutes a regular and established place of business in e-commerce, as one of substantial and widespread importance "that increasingly affects venue in legal actions involving e-commerce."

Mylan Pharmaceuticals Inc. v. Research Corporation Technologies, Inc., 2017-2088, 2017-2089, 2017-2091 (Fed. Cir. 2/1/2019).

This is a decision on appeals from PTAB cases IPR2016-00204, IPR2016-01101, IPR2016-01242, IPR2016-01245. The interesting issues relate to standing and waiver, not to the merits of the case.

Legal Issue: Article III Standing, 35 USC 315(b) time-bar, and zone of interests test.

The Federal Circuit concluded that Congress authorized appeal in section 391, and the timing of the petition more than one year after having been sued for infringement did not annul section 319's right to an appeal.

Legal issue: Waiver of SAS relief, timing of the request for relief.

The Federal Circuit held that raising a SAS argument only in rebuttal at oral argument was too late, and constituted waiver.

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