

## Brief Summary of Precedential Patent Case Decisions During March 2018

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### I. Introduction

This article presents a brief summary of relevant precedential points of law during the noted time period. However, it lacks the details and nuances of a more extensive review. A more extensive review appears in my "Precedential Patent Case Decisions" monthly articles.

Captions of cases originating in the PTAB are red. Captions of cases of extraordinary importance are blue.

### II. Abstracts of New Points of Law

#### **DSS Technology Management, Inc. v. Apple Inc., 2016-2523, 2016-2524 (Fed. Cir. 3/23/2018).**

This is a decision on appeals from PTAB cases IPR2015-00369, IPR2015-00373. DSS appealed. The Federal Circuit reversed.

**Legal issue, 35 USC 103, obviousness, reliance on common sense to provide a motivation to combine.**

Here, the Federal Circuit found that the PTAB's reliance upon common sense, or ordinary creativity, was conclusory, and not supported by any evidence of record.

#### **Dell Inc. v. Acceleron, LLC, 2017-1101 (Fed. Cir. 3/19/2019).**

This is a decision on an appeal from PTAB case IPR2013-00440. Dell appealed the PTAB's remand determination not consider Dell's new arguments, after remand from the Federal Circuit. The Federal Circuit affirmed.

**Legal Issue, 5 USC 706, agency compliance with its rules.**

Here, Dell argued that the PTAB should have, on remand, considered its new argument first presented at oral hearing. One determinative fact was that such consideration would have been contrary to the PTAB's rules, and therefore an APA violation.

#### **Hologic, Inc. v. Smith & Nephew, Inc., 2017-1389 (Fed. Cir. 3/14/2018).**

This is a decision on an appeal from PTAB case 95/002,058. The PTAB found that Smith & Nephew's (S&N's) claim not obvious. Hologic appealed. The Federal Circuit affirmed.

**Legal issue, 35 USC 112/120, written description support in a parent application.**

In analyzing the facts, the Federal Circuit explained the following principles for written description.

First, when "field of ...[the] invention is a predictable art, ... a lower level of detail is required to satisfy the written description requirement than for unpredictable arts. *See id.* at \*13; *Ariad*, 598 F.3d at 1351."

Second, that when a claim term ("light guide") is generic to the disclosed species ("fibre optic bundle") and various other species were well known in the art, the disclosure provides written description support for a claim to the genus.

Third, that written description does not require that every claimed element be illustrated

in the figures, particularly in predictable arts and where the element not depicted is conventional and not necessary for the understanding of the subject matter sought to be patented.

Fourth, that express disclosure in the specification that some parts of an assembly have a property (not being "permanently affixed", that is being removable), coupled with no disclosure in the specification that a particular part has that property, supports a conclusion that the specification conveys that the particular part has that property (aka being "permanently affixed").

**Nestle USA, Inc. v. Steuben Foods, Inc., 2017-1193 (Fed. Cir. 3/13/2018).**

This is a decision on an appeal from PTAB case IPR2015-00249. The PTAB found claim 9 nonobvious. Nestle appealed. The Federal Circuit vacated and remanded.

**Legal issue, collateral estoppel, claim construction, related patents.**

The Federal Circuit concluded that the issue of the construction of the word "aseptic" was the same as the issue of construction of "aseptic" that the Federal Circuit had decided in a prior case on a related patent. Since the PTAB's construction in the present appeal differed from the Federal Circuit's construction in the prior case, the Federal Circuit concluded that collateral estoppel applied to bar the new PTAB construction.

The Federal Circuit stressed that it was identity of issues, not of patents, that was relevant.

**Steuben Foods, Inc. v. Nestle USA, Inc., 2017-1290 (Fed. Cir. 3/13/2018).**

This is a decision on an appeal from PTAB case IPR2015-00195. The PTAB found claims unpatentable for obviousness. Steuben appealed. The Federal Circuit affirmed.

**Legal issue, 35 USC 112, claim construction.** This is another case showing the deleterious (for the patent owner) impact of a poorly drafted claims. The beneficial invention appears to have been variation in gaseous concentrations of sterilant in chambers of an apparatus for aseptic packaging in which the concentrations of sterilant between the chambers was at least about 5 to 1. A fatal problem, at least for the claims on appeal, was that the claims did not specify gaseous. The relevant claim limitation is "the sterilant concentration levels in the plurality of zones are maintained at a ratio of at least about 5 to 1." The Federal Circuit agreed with the Board that the claims were not limited to determining the sterilant concentration in the gaseous medium.

**Simpleair, Inc. v. Google LLC, 2016-2738 (Fed. Cir. 3/12/2018).**

This is a decision on an appeal from the E.D. Tex district court case 2:16-cv-00488-JRG. Google moved to dismiss under FRCP 12(b)(6). The district court granted the motion. Simpleair appealed. The Federal Circuit vacated and remanded.

**Legal issue, claim preclusion requirement of "the same cause of action."**

The Federal Circuit held that "where different patents are asserted in a first and second suit, a judgment in the first suit will trigger claim preclusion only if the scope of the *asserted patent claims* in the two suits is essentially the same."

**Comment:** The Federal Circuit concluded above that in the "particular context" of this case, "essentially the same" meant "patentably indistinct." However, the Federal Circuit did not clearly define what this "particular context" was. That is, for example, whether the context was the district court's presumption that a terminal disclaimer meant that claims were patentably indistinct, or whether the context applied generally to patents related by continuation filings.

**Snyders Heart Valve LLC v. St. Jude Medical S.C., Inc., 4:16-cv-00812-ALM-KPJ (E.D. Tex. 3/7/2018)(Magistrate Johnson).**

St. Jude moved for summary judgement of improper venue. The magistrate recommended granting the motion.

**Legal issue, 35 USC 1400(b), second prong, acts of infringement in the judicial district.**

The magistrate judge concluded that plaintiff had not met plaintiff's burden to show that facts adduced on discovery supported infringement within the judicial district. Therefore, the magistrate recommended granting defendant's motion to dismiss. The kicker here is that the discovery showed that plaintiff's activity within the judicial district was activity covered by the 35 USC 271(a) safe harbor and therefore not infringing activity.

**Chikezie Ottah v. Fiat Chrysler, 2017-1842 (Fed. Cir. 3/7/2018).**

This is a decision on appeal from the S.D. NY case 1:15-cv-02465-LTS. The district court granted summary judgment of non-infringement for some defendants. The district court dismissed the complaint with prejudice as to several defendants. Ottah appealed. The Federal Circuit affirmed.

This decision would likely have been decided a rule 36 affirmance, but for the fact that the plaintiff was pro se. The Federal Circuit explained that even pro se plaintiffs must make a plausible argument to survive summary judgement. In this case, that facts showed that the plaintiffs argument were far from plausible.

**Knowles Electronics LLC v. Cirrus Logic, 2016-2010 (Fed. Cir. 3/1/2018).**

This is a decision on appeal from PTAB inter partes reexamination cases 95/000,509, 95/001,251, 95/001,363. The PTAB affirmed rejection of claims 1-4 for anticipation, and proposed claims 23-27 for lack of written descriptive support. Knowles appealed. The Federal Circuit affirmed.

**Legal issue, waiver, contesting real party in interest.**

Two of the three reexamination requesters dropped out of the proceeding before the PTAB. The PTAB's replaced the third original petitioner Wolfson, with Cirrus. Before the Federal Circuit, Knowles moved under Federal Circuit Rule 27(e) to strike materials submitted by Cirrus. This motion depended upon Knowles argument that Knowles "was not allowed to contest" the entrance of Cirrus into the PTAB proceeding. The Federal Circuit noted that Knowles presented no evidence to that Knowles had contested entry of Knowles in the proceeding below, and therefore found that Knowles had waived the argument.

Note: A moral of this story is to speak up and contest something the PTAB does, even when there is no clear rule based mechanism to do so.

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