

## Precedential Patent Case Decisions During July, 2016

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### I. Introduction

This paper abstracts what I believe to be the most significant new points of law from the precedential decisions in patent cases, during July, 2016. This month, all such decisions are from the Federal Circuit.

Cases relating to the PTAB are in red font. Cases of extraordinary importance are in blue font.

### II. Abstracts of New Points of Law

Advanced Ground Info. Sys., Inc. v. Life360, Inc., 2015-1732 (Fed. Cir. 7/28/2016). Legal issue, 35 USC 112, claim construction: Requirement of the specification to disclose means of a MPF claim recitation, for the claim to be definite. Facts: Patent disclosed database and data used for a computer determination, but not the algorithm for the determination. Held: Failed the MPF definiteness requirement.

Verinata Health, Inc. v. Ariosa Diagnostics, Inc., 2015-1970 (Fed. Cir. 6/26/2016). Legal issue, 35 USC 282, construction of scope of patent license: Scope of arbitration provision and whether it covers specific defense of license to a specific charge of infringement. "The counterclaims [of license] all rise or fall on the scope determination of licensed intellectual property rights, a matter that the parties expressly agreed to exempt from arbitration."

In Magnum Oil Tools International, 2015-1300 (Fed. Cir. 7/25/2016). Legal issue, 35 USC 316(e), IPR burden of proof. Reiterating that "In an *inter partes* review, the burden of persuasion is on the petitioner to prove 'unpatentability by a preponderance of the evidence,' 35 U.S.C. § 316(e), and that burden never shifts to the patentee." Chastising the Director for implying that a "Board's conclusion on obviousness in an IPR can be based on less than a preponderance of the evidence if the patent holder does not affirmatively *disprove* the grounds upon which the IPR was initiated."

Unwired Planet, LLC v. Apple Inc., 2015-1725 (Fed. Cir. 7/22/2016). Legal issue, 35 USC 271(b), willful blindness requirement for a factual determination of subjective intent of the infringer. "The proper focus of indirect infringement analysis is on the subjective knowledge of the accused infringer, and the district court's conclusion that Apple's non-infringement defenses were strong at most created a factual question as to Apple's own subjective beliefs. \*\*\* Because the district court's grant of summary judgment was based exclusively on its view of the strength of Apple's non-infringement argument, we vacate. "

Polar Electro OY v. Suunto OY, 2015-1930 (Fed. Cir. 2/20/2016). Legal issue, specific

personal jurisdiction. Products shipped from Finland to Delaware. "Although ASWO provided the destination addresses, took title to the goods in Finland, and directed and paid for shipping, it was Suunto, not ASWO, who physically fulfilled the orders, packaged the products, and prepared the shipments in Finland. Suunto admits as much. \*\*\* Through its own conduct, Suunto purposefully availed itself of the Delaware market."

WBIP, LLC v. Kohler Co., 2015-1038, 2015-1044 (Fed. Cir. 7/19/2016). Legal issue, 35 USC 103, required nexus between secondary indicia evidence and claims for evidence to be probative of non-obviousness. Held: Secondary indicia need not be tied to claim limitation missing from prior art.

We further reject Kohler's categorical claim that objective evidence must be tied exclusively to claim elements that are not disclosed in a particular prior art reference in order for that evidence to carry substantial weight. \*\*\* This is especially true for situations like those at issue here, where the claimed invention is, admittedly, a combination of elements that were known individually in the prior art. [WBIP, LLC v. Kohler Co., 2015-1038, 2015-1044 (Fed. Cir. 7/19/2016).]

WBIP, LLC v. Kohler Co., 2015-1038, 2015-1044 (Fed. Cir. 7/19/2016). Legal issue, 35 USC 283, injunctions. Weight of factors for deciding a motion for a permanent injunction. Held: Public interest factor, favoring multiple suppliers, by itself, is insufficient basis to deny a permanent injunction.

WBIP cross-appeals the district court's denial of a permanent injunction. \*\*\* On appeal, WBIP argues that the district court erred in its consideration of the *eBay* factors. We agree that the district court's analysis is sufficiently flawed to constitute an abuse of discretion warranting vacating the judgment. \*\*\* The district court's decision is based on its reasoning that having more manufacturers of a lifesaving good in the market is better for the public interest \*\*\* We note that the district court limited its analysis to the public interest factor alone and that its decision to deny an injunction cannot be affirmed on this basis in light of this record. [WBIP, LLC v. Kohler Co., 2015-1038, 2015-1044 (Fed. Cir. 7/19/2016).]

Skyhawk Technologies, LLC v. Deca International Corp., (Fed. Cir. 7/15/2016). Legal issue, 35 USC 141, right of appeal, meaning of "dissatisfied." Held: Prevailing party dissatisfied with the PTAB's reasoning has no right of appeal. "Although the ordinary rule in *Deposit Guaranty* and *Rooney* is most clearly applicable with respect to appeals taken from United States district courts, where the statute providing for such appeals refers to "appeals from all final decisions," 28 U.S.C. § 1291 (2012), we see no material difference from the statute here that provides for appeals when "dissatisfied with the final decision" of the Board."

The Medicines Company v. Hospira, Inc., 14-1469 (Fed. Cir. 7/11/2016) (en banc). Legal issue, 35 USC 102(b) anticipation, and what constitutes a sale within the meaning of 102(b). Held: "a contract manufacturer's sale to the inventor of manufacturing services where neither title to the embodiments nor the right to market the same passes to the supplier does not constitute an invalidating sale under § 102(b)." Stating: "There are, broadly speaking, three reasons for our judgment in this case: (1) only manufacturing services were sold to the inventor—the invention was not; (2) the inventor maintained control of the invention, as shown by the retention of title to the embodiments and the absence of any authorization to Ben Venue to sell the product to others; and (3) "stockpiling," standing alone, does not trigger the on-sale bar."

Amgen Inc. v. Apotex Inc., 16-1308 (Fed. Cir. 7/5/2016). Legal issue, 42 USC 262(l)(2)(A) requirement for 180 days notice. "We conclude that an applicant must provide a reference product sponsor with 180 days' post-licensure notice before commercial marketing begins, regardless of whether the applicant provided the (2)(A) notice of FDA review."

Rapid Litigation Management v. Cellzdirect, Inc., 15-1570 (Fed. Cir. 7/5/2016). Legal issue: 35 USC 101, *Alice* step 1. Held: Fractionation, recovering, and then cryopreserving cells is not a patent ineligible abstract concept. "The claims in this case are immediately distinguishable from those we have found patent ineligible in cases since *Mayo* and *Alice*. \*\*\* The end result of the '929 patent claims is not simply an observation or detection of the ability of hepatocytes to survive multiple freeze-thaw cycles. Rather, the claims are directed to a new and useful method of preserving hepatocyte cells."

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