

Intellectual Property for Judges

Presented by The Honorable Kathleen M. O'Malley and
George F. Pappas

List of Cases Discussed By Topic

Jurisdiction

- *Robert Bosch, LLC v. Pylon Mfg.*, 719 F.3d 1305, 1319-20 (Fed. Cir. 2013) (en banc) (holding that liability determinations in patent cases are final for purposes of immediate appeal under 28 U.S.C. § 1292(c), even when a jury trial on damages and willfulness remains).
- *Gunn v. Minton*, 133 S. Ct. 1059, 1068 (2013) (holding that malpractice claims, based on an attorney's handling of a patent case, are not subject to exclusive jurisdiction of federal courts).
- *MadStad Eng'g, Inc. v. United States PTO*, Nos. 2013-1511, 2013-1512, 2014 WL 2938080, at *1 (Fed. Cir. July 1, 2014) (holding that challenges to the constitutionality of the America Invents Act arise under the patent laws for purposes of appellate jurisdiction and affirming the district court's finding that MadStad lacked standing to challenge the constitutionality of the "first-inventor-to-file" provision of the AIA).

Burden of Proof & Pleading Requirements

- *Medtronic, Inc. v. Mirowski Family Ventures, LLC*, 134 S. Ct. 843, 846 (2014). ("We hold that, when a licensee seeks a declaratory judgment against a patentee to establish that there is no infringement, the burden of proving infringement remains with the patentee.")
- *K-Tech Telecomms., Inc. v. Time Warner Cable, Inc.*, 714 F.3d 1277, 1283 (Fed. Cir. 2013) (finding that proper use of Form 18 of the Federal Rules of Civil Procedure for a complaint asserting direct patent infringement "effectively immunizes a claimant from attack regarding the sufficiency of the pleading").

Section 101

- *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2352 (2014) ("We hold that the claims at issue are drawn to the abstract idea of intermediated settlement, and that merely requiring generic computer implementation fails to transform that abstract idea into a patent-eligible invention.")
- *AMP v. Myriad Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2111 (2013). ("We hold that a naturally occurring DNA segment is a product of nature and not patent eligible merely because it has been isolated, but that cDNA is patent eligible because it is not naturally occurring.")

Claim Construction

- *Lighting Ballast Control LLC v. Philips Elecs. N. Am. Corp.*, 744 F.3d 1272, 1276-77 (Fed. Cir. 2014) (en banc) (“[W]e apply the principles of *stare decisis*, and confirm the *Cybor* standard of de novo review of claim construction, whereby the scope of the patent grant is reviewed as a matter of law.”).
- *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 723 F.3d 1363 (Fed. Cir. 2013), *cert granted* 2014 U.S. LEXIS 2312 (U.S. Mar. 31, 2014) (No. 13-854). The Supreme Court granted cert to address “whether a district court’s factual finding in support of its construction of a patent claim term may be reviewed de novo, as the Federal Circuit requires (and as the panel explicitly did in this case), or only for clear error, as Federal Rule of Civil Procedure 52(a) requires.”

Indefiniteness

- *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2129 (2014) (rejecting the Federal Circuit’s “insolubly ambiguous” test for indefiniteness and reading 35 U.S.C. § 112, ¶ 2 “to require that a patent’s claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty”).

Obviousness

- *In re Cyclobenzaprine Hydrochloride Patent Litig.*, 676 F.3d 1063, 1075-77 (Fed. Cir. 2012) (holding that there is no burden shifting framework in the obviousness analysis and that all evidence of obviousness and nonobviousness must be considered before reaching a determination).
- *Leo Pharm. Prods., Ltd. v. Rea*, 726 F.3d 1346, 1357 (Fed. Cir. 2013) (emphasizing that “consideration of the objective indicia is part of the whole obviousness analysis, not just an after-thought”).

Joint/Induced Infringement

- *Limelight Networks, Inc. v. Akamai Techs., Inc.*, 134 S. Ct. 2111, 2117 (2014) (“[L]iability for inducement must be predicated on direct infringement.”).
- *Commil USA, LLC v. Cisco Systems, Inc.*, 720 F.3d 1361, 1368 (Fed. Cir. 2013) (finding that “a good-faith belief of invalidity is evidence that may negate the specific intent to encourage another’s infringement, which is required for induced infringement.”).

Patent Exhaustion

- *Bowman v. Monsanto Co.*, 133 S. Ct. 1761, 1764 (2013) (“Under the doctrine of patent exhaustion, the authorized sale of a patented article gives the purchaser, or any subsequent owner, a right to use or resell that article. Such a sale, however, does not allow the purchaser to make new copies of the patented invention. The question in this case is whether a farmer who buys patented

seeds may reproduce them through planting and harvesting without the patent holder's permission. We hold that he may not.”).

Exceptional Cases

- *Highmark Inc. v. Allcare Health Mgmt. Sys.*, 134 S. Ct. 1744, 1748 (2014) (holding that the Federal Circuit should review a district court's “exceptional case” determination under an abuse of discretion standard rather than a *de novo* standard).
- *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 134 S. Ct. 1749, 1755–56 (2014) (holding that the Federal Circuit's *Brooks Furniture* test for an “exceptional case” under 35 U.S.C. § 285 was “unduly rigid” and the new test for an “exceptional case” is whether the case “stands out from others with respect to the substantive strength of a party's litigating position . . . or the unreasonable manner in which the case was litigated”).
- *Kilopass Tech., Inc. v. Sidense Corp.*, 738 F.3d 1302, 1310, 1314 (Fed. Cir. 2013) (holding that actual knowledge of baselessness is not required to satisfy the subjective bad faith prong for an “exceptional case,” the requisite showing of bad faith must be based on the “totality of the circumstances,” and “[o]bjective baselessness alone can create a sufficient inference of bad faith to establish exceptionality under § 285, unless the circumstances as a whole show a lack of recklessness on the patentee's part”).

Finality

- *Fresenius USA, Inc. v. Baxter Int'l, Inc.*, 721 F.3d 1330, 1340 (Fed. Cir. 2013) (“[W]hen a claim is cancelled, the patentee loses any cause of action based on that claim, and any pending litigation in which the claims are asserted becomes moot.”).
- *ePlus, Inc. v. Lawson Software, Inc.*, Nos. 2013-1506, 2013-1587, 2014 WL 3685911, at *7 (Fed. Cir. July 25, 2014) (vacating a district court's injunction and contempt order where the PTO cancelled the claim at issue in reexamination while the district court litigation was pending).

Miscellaneous

- *FTC v. Actavis, Inc.*, 133 S. Ct. 2223, 2237-38 (2013) (holding that a “rule of reason” analysis applies to determine whether a reverse-payment patent settlement violates federal antitrust laws).