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2015 Federal Circuit Yearbook

Patent Law Developments in the Federal Circuit

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Each year, the *Federal Circuit Yearbook* provides a concise, comprehensive review of every patent decision published by the U.S. Court of Appeals for the Federal Circuit during the preceding year. With the *Yearbook* in hand, readers may conveniently follow all recent patent law developments in the CAFC, presented in a manner that reduces specialized patent and technical jargon to a minimum.

Cases summarized in the *Yearbook* include the following, among many others:

Utility and Inventions Patentable: Relying on the Supreme Court's decision in *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, the Federal Circuit holds that a "familiar commercial arrangement" is drawn to patent-ineligible subject matter. See *buySAFE, Inc. v. Google, Inc.*, discussed at § 1:1.

Novelty and Statutory Bars: That administration of an ophthalmic solution for treatment of glaucoma "could" result in eyelash growth was insufficient to support anticipation through inherency. See *Allergan, Inc. v. Apotex Inc.*, discussed at § 2:1.

Nonobviousness: FDA's "fast track" approval for a drug that is the commercial embodiment of the claims may furnish grounds for asserting long-felt but unresolved need supporting obviousness contention. See *Ferring B.V. v. Watson Laboratories, Inc.-Florida*, discussed at § 3:3.

Specification and Claims: Federal Circuit panel majority distinguishes *Interval Licensing LLC v. AOL, Inc.* and *Datamize, LLC v. Plumtree Software, Inc.*, holding that claim terms "look and feel" and "visually perceptible elements" do not render claims invalid as being indefinite. See *DDR Holdings, LLC v. Hotels.Com, L.P.*, discussed at § 4:4.

Claim Construction: Federal Circuit panel splits on proper analysis of claims in computer-implemented inventions when limitation does not use the word "means." See *Apple Inc. v. Motorola, Inc.*, discussed at § 6:3.

Infringement: As a matter of first impression, and over a dissent by Chief Judge Prost, Federal Circuit panel majority concludes that "to actively induce

(continued on reverse)

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the combination” does not require involvement of a third party. “[S]ubstantial portion of the components of a patented invention” does not require at least two components. See *Promega Corp. v. Life Technologies Corp.*, discussed at § 7:6.

Inequitable Conduct: Federal Circuit panel majority holds that “but for” materiality may be found even though patentability over non-disclosed prior art is confirmed in a reexamination, and intent may be inferred from intentional selective disclosure and lack of witness credibility. See *American Calcar, Inc. v. American Honda Motor Co., Inc. (American Calcar II)*, discussed at § 9:1.

Remedies: Appellate and remand fees are awardable where those stages of litigation are deemed independently exceptional within the meaning of section 285. District court has broad discretion in awarding “fees seeking fees.” See *Therasense, Inc. v. Becton, Dickinson & Co. (Therasense IV)*, discussed at § 10:6.

PTO Practice and Procedure: Federal Circuit reverse district court order for summary judgment, finding that PTO did not act arbitrarily or capriciously, or abuse its discretion in declining to use its inherent authority to withdraw a disclaimer filed by applicant’s attorney of record (apparently through error) that had been duly filed in accordance with PTO regulations. See *Japanese Foundation for Cancer Research v. Lee*, discussed at § 11:1.

District Court Jurisdiction and Procedure: When a plaintiff consents to jurisdiction by bringing suit in a forum district, case may be properly transferred under section 1404(a) to another district even though the transferee district does not have personal jurisdiction over the plaintiff. See *elcommerce.com, Inc. v. SAP AG*, discussed in § 12:12.

Appellate Court Jurisdiction and Practice: The Federal Circuit explains the two parts to the entire market value rule and the use of expert testimony, and the apportionment analysis for standard essential patents and related jury instructions. See *Ericsson, Inc. v. D-Link Systems, Inc.*, discussed at §§ 13:5, 13:6 and 13:7.

Ownership Agreements and Inventorship: License to identified patents that also includes “continuation, continuation-in-part and divisional patent applications that claim priority to” the identified patents does not cover other patents claiming priority to earlier common provisional application. See *Endo Pharmaceuticals, Inc. v. Actavis, Inc.*, discussed at § 14:1.

Design Patents: Trial court does not err by failing to describe the claimed design in words, as required by *High Point*, if the trial court’s analysis makes clear the trial court’s construction of the design. See *MRC Innovations, Inc. v. Hunter Manufacturing, LLP*, discussed at § 15:1.

Miscellaneous: Federal Circuit concludes that claims in reissue patent fail to meet the original patent requirement, holding that “for § 251, ‘it is not enough that an invention might have been claimed in the original patent because it was suggested or indicated in the specification.’ . . . Rather, the specification must clearly and unequivocally disclose the newly claimed invention as a separate invention.” See *Antares Pharma, Inc. v. medac Pharma Inc.*, discussed at § 16:2.