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2018 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: Where claims "are substantially similar and linked to the same" law of nature, analyzing representative claims is proper. Section 101 issues may be resolved at the pleading stage before formal claim construction: "we have repeatedly affirmed § 101 rejections at the motion to dismiss stage, before claim construction or significant discovery has commenced." See *Cleveland Clinic Foundation, Cleveland Heartlab, Inc. v. True Health Diagnostics LLC*, discussed at § 1:1.

Novelty and Statutory Bars: Federal Circuit concludes that inventor declaration without corroborating evidence alone is not always sufficient to overcome section 102(e) prior art. Despite prior case law (particularly CCPA), Federal Circuit seems to move law under section 102(e), directed to showing prior disclosure subject matter was not "by another," closer to case law under section 102(g), directed to showing prior inventorship. See *EmeraChem Holdings, LLC v. Volkswagen Group of America, Inc.*, discussed at § 2:4.

Nonobviousness: Circuit Judge Newman, in dissent, urges that it is time to "remedy" the *Graham* analysis—namely that the objective factors should be considered together with the first three *Graham* factors rather than first determining whether a prima facie case of obviousness had been shown. See *Merck Sharp & Dohme Corp. v. Hospira, Inc.*, discussed at § 3:7.

Specification and Claims: As a matter of first impression, the Federal Circuit holds that evidence showing the state of the art subsequent to the priority date is not relevant to written description, but evidence showing that a claimed genus does not disclose a representative number of species may include evidence of species that fall within the claimed genus and such evidence may postdate the priority date. See *Amgen Inc. v. Sanofi, Aventisub LLC*, discussed at § 4:1.

Interference and Priority of Invention: In determining whether patent-in-interference provides written description support for later added claims PTAB must determine whether POSITA would have concluded that inventors

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were in possession of the later claimed invention as of the relevant filing date. See *Board of Trustees of the Leland Stanford Junior University v. Chinese University of Hong Kong*, discussed at § 5:1.

Claim Construction: Using functional language in an apparatus claim does not necessarily mean that the claim improperly covers both an apparatus and method. Functional language described capabilities of a system rather than user actions. See *MasterMine Software, Inc. v. Microsoft Corp.*, discussed at § 6:5.

Infringement: As a matter of "clarifying" prior opinions, Federal Circuit reasons that the "insubstantial differences test" rather than the "function-way-result" analysis is more appropriate when considering equivalence in pharmaceutical/chemical cases. See *Mylan Institutional LLC v. Aurobindo Pharma Ltd.*, discussed at § 7:10.

Inequitable Conduct: Trial misconduct may result in an adverse inference of intent to deceive for purposes of inequitable conduct where litigation misconduct is sufficiently tied to patent prosecution. See *Regeneron Pharmaceuticals, Inc. v. Merus N.V.*, discussed at § 9:2.

Remedies: As a matter of first impression, the Federal Circuit holds that the Seventh Amendment right to a jury trial does not apply to requests for attorney's fees under section 285. See *AIA America, Inc. v. Avid Radiopharmaceuticals*, discussed at § 10:1.

PTO Practice and Procedure: The Federal Circuit's prior affirmance of a jury's obviousness determination, and a reversal and remand on infringement invokes the bar of section 317(b) (pre-AIA). See *Fairchild (Taiwan) Corp. v. Power Integrations, Inc.*, discussed at § 11:6.

District Court Jurisdiction and Procedure: Federal Circuit explains that "regular and established place of business" in section 1400(b) requires "(1) there must be a physical place in the district; (2) it must be a regular and established place of business; and (3) it must be the place of the defendant." See *In re Cray Inc.*, discussed at § 12:6.

Appellate Court Jurisdiction and Practice: Federal Circuit has appellate jurisdiction to review PTAB decision regarding party standing—distinguishes *Cuozzo* and *Achates*. See *Return Mail, Inc. v. United States Postal Service*, discussed at § 13:10.

Ownership Agreements and Inventorship: Suggestions from individuals at FDA to perform further research to support inclusion of a particular agent in a pharmaceutical formulation does not constitute conception of an invention in which that agent is removed—or in derivation. See *Cumberland Pharmaceuticals Inc. v. Mylan Institutional LLC*, discussed at § 14:1.