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## Last Month at the Federal Circuit

February 2014



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[Appealed from Board]

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[Appealed from Board]

## Abbreviations

ALJ	Administrative Law Judge
ANDA	Abbreviated New Drug Application
APA	Administrative Procedures Act
APJ	Administrative Patent Judge
Board	Patent Trial and Appeal Board (formerly the Board of Patent Appeals and Interferences)
Commissioner	Commissioner of Patents and Trademarks
CIP	Continuation-in-Part
DJ	Declaratory Judgment
DOE	Doctrine of Equivalents
FDA	Food and Drug Administration
IDS	Information Disclosure Statement
ITC	International Trade Commission
JMOL	Judgment as a Matter of Law
MPEP	Manual of Patent Examining Procedure
NDA	New Drug Application
PCT	Patent Cooperation Treaty
PTO	United States Patent and Trademark Office
SJ	Summary Judgment
TTAB	Trademark Trial and Appeal Board

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### **Prosecution History Estoppel Applies to Design Patents**

*Yieyie Yang\**

**Judges: Dyk (author), Mayer, Chen**

**[Appealed from M.D. Fla., Judge Antoon, II]**

In *Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC*, No. 13-1199 (Fed. Cir. Jan. 8, 2014), the Federal Circuit reversed the district court's grant of SJ of noninfringement in favor of Malibu Boats, LLC ("Malibu Boats") based on prosecution history estoppel and remanded for further proceedings.

Pacific Coast Marine Windshields Limited ("Pacific Coast") is the assignee of U.S. Patent No. D555,070 ("the '070 patent") for an ornamental boat windshield design. As originally filed, the '070 patent's application claimed an "ornamental design of a marine windshield with a frame, a tapered corner post with vent holes and without said vent holes, and with a hatch and without said hatch, as shown and described." Slip op. at 2-3 (citation omitted). During prosecution, the examiner issued a restriction requirement for five distinct groups of windshield designs: windshields with (1) four vent holes and a hatch, (2) four holes and no hatch, (3) two holes and a hatch, (4) no holes and a hatch, and (5) no holes and no hatch. The applicant elected Group I depicting four holes and a hatch, canceled figures representing the other design groups, and amended the claim accordingly. The amended application issued as the '070 patent. The applicant later obtained a patent for the no-hole design from a divisional of the originally filed application.

Pacific Coast sued Malibu Boats for infringement of the '070 patent based on a boat windshield with three vent holes on the corner post. The district court granted Malibu Boats' motion for partial SJ of noninfringement on the ground of prosecution history estoppel. The district court found that the applicant had surrendered the designs reflected in the canceled figures and amended the claim during prosecution in order to obtain the patent, and that the accused three-hole design fell within the territory surrendered between the original and amended claim. Pacific Coast appealed.

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**"We conclude that the principles of prosecution history estoppel apply to design patents as well as utility patents." Slip op. at 11.**

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The Federal Circuit held as an issue of first impression that the principles of prosecution history estoppel apply to design patents. Reviewing the public-notice function of prosecution history estoppel in limiting infringement liability under the DOE for utility patents, the Court explained that the statutory "colorable imitation" standard for design patent infringement requires not identity but rather "sufficient similarity," and thus likewise involves the concept of equivalents. *Id.* at 9. The Court reasoned that, although claim scope in design patents is defined by drawings rather than language, refusing to apply the principles of

prosecution history estoppel would undermine the definitional and public-notice functions of these claims, and thus held that prosecution history estoppel applies to design patents as well as utility patents.

Applying the principles of prosecution history estoppel to the '070 patent, the Federal Circuit first held that there was a surrender of claim scope during prosecution. The Court explained that because the applicant in response to the examiner's restriction requirement amended the claim by canceling figures showing corner posts with two holes and no holes, the applicant had surrendered such designs and limited the claim to the four-hole design and colorable imitations thereof.

The Court next held that the claim scope was surrendered in order to secure the '070 patent. According to the Court, although the surrender was made because of a restriction requirement and not to avoid prior art, and thus not for reasons of patentability, the doctrine is broader than that and "arises when an amendment is made to secure the patent and the amendment narrows the patent's scope." *Id.* at 14 (quoting *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 736 (2002)). The Court explained that because design patents may include only a single claim, and thus only one patentable design, "in design patents, unlike utility patents, restriction requirements cannot be a mere matter of administrative convenience." *Id.* Accordingly, the Court held that, in the design patent context, the surrender resulting from a restriction requirement invokes prosecution history estoppel if the surrender was necessary, as in *Festo*, to secure the patent.

Lastly, the Federal Circuit held that Malibu Boats' accused design was not within the scope of the surrendered subject matter. The Court rejected the district court's reasoning that by abandoning the two-hole design and obtaining patents on the four-hole and no-hole designs, the applicant abandoned the range between four and zero, which included the accused three-hole design. The Court concluded that the range concept did not work in the context of design patents where individual designs, instead of a range, were claimed, and that the applicant surrendered only the two-hole and not the accused three-hole design. Accordingly, the Court held that prosecution history estoppel did not bar Pacific Coast's infringement claim, reversed the district court's grant of SJ of noninfringement, and remanded for further proceedings.

*\*Yieyie Yang is a Law Clerk at Finnegan.*

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### **An Accused Device Must Perform the Claim Limitation of the Asserted Patent Without Modification to Infringe**

*Shaton C. Menzie*

**Judges:** Lourie (concurring), Dyk (author), Wallach  
**[Appealed from N.D. Cal., Senior Judge Whyte]**

In *Nazomi Communications, Inc. v. Nokia Corp.*, No. 13-1165 (Fed. Cir. Jan. 10, 2014), the Federal Circuit affirmed the district court's grant of SJ of noninfringement in favor of defendants Western Digital Corporation and Western Digital Technologies, Inc. (collectively "Western"), and Sling Media, Inc. ("Sling").

Nazomi Communications, Inc. ("Nazomi") owns two patents—U.S. Patent No. 7,080,362 ("the '362 patent") and U.S. Patent No. 7,225,436 ("the '436 patent")—which describe a hardware-based Java Virtual Machine ("JVM") that can process software written in the Java programming language, as well as software that is not written in Java. Nazomi's hardware-based JVM enables the translation of Java bytecodes into instructions executable by a processor, while also retaining the ability to run non-Java applications by processing instructions without using the JVM.

Nazomi sued various technology companies for infringing the '362 and the '436 patents. Two defendants, Western and Sling, filed a motion for SJ contending that their accused products did not infringe the asserted claims.

Western and Sling each manufacture consumer products that include processors designed by ARM Limited ("ARM"). The ARM processor design used in the accused devices includes an optional hardware component called "Jazelle," which enables faster processing of Java bytecodes. In order to utilize the Jazelle hardware, a consumer product manufacturer would need to license ARM's Jazelle Technology Enabling Kit ("JTEK") software. Though the accused devices contained processor designs that included the Jazelle hardware, neither included the JTEK software that would enable the hardware to perform the optional functionality. In their motion for SJ, Western and Sling argued that Nazomi's claims require an accused device to perform the claimed functions themselves, and since their devices were unable to perform that functionality due to lacking the JTEK software, they did not infringe. The district court agreed with Western and Sling, and granted their motion for SJ. Nazomi appealed.

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**"Here, the structure (*i.e.*, JTEK software) necessary to enable Jazelle hardware to process stack-based instructions (*i.e.*, Java bytecodes) is not only inactive, it is not even present on the accused products. The installation of JTEK software is not unlocking existing functionality, but adding new functionality not currently present. There is no infringement." Slip op.**

On appeal, the Federal Circuit began by construing Nazomi's claims. Affirming the district court's findings, the Federal Circuit held that Nazomi's claims were properly construed to cover an apparatus, comprising both hardware and software, capable of practicing the claimed functionality. The Court concluded that "[s]ince hardware cannot meet these limitations in the absence of enabling software, the claims are properly construed as claiming an apparatus comprising a combination of hardware and software capable of practicing the claim limitations." Slip op. at 10.

The Court confirmed that the cases cited by Nazomi did not stand for that proposition that capability alone is enough to support a finding of infringement. For example, the Court distinguished *Intel Corp. v. U.S. International Trade Commission*, 946 F.2d 821 (Fed. Cir. 1991), on the basis that the claims at issue in that case required "programmable selection means." Slip op. at 11 (citing *Intel*, 946 F.2d at 832). The "programmable" claim language required only that the accused product *could be* programmed to perform the required functionality, whereas Nazomi claimed a combination of hardware and software that is capable of performing the required functionality. The Court also noted that Nazomi's arguments were not supported by cases involving the contemplated use of a claimed invention in a particular environment. Rather, the Court has repeatedly distinguished a description of the environment in which a claimed invention operates from a limitation on the claimed invention itself. Because Nazomi's claims require a hardware-software combination, and not simply the hardware that contemplates an environment where it would be combined with software, the Court found Nazomi's reliance on these cases to be misplaced.

After affirming the district court's claim construction rulings, the Court proceeded with its infringement analysis by determining whether the accused devices infringed under the claim construction. Since it was undisputed that the Jazelle hardware was physically present on Western's and Sling's accused devices, and that the Jazelle hardware was not functional without the JTEK software, the Court only addressed Nazomi's reliance on cases in which the Court held that an accused device infringed when the device was designed in a way that enabled use of the claimed function without modifying the product.

The Court distinguished these cases, holding that in order for an accused device to infringe, the device must perform the claim limitation of the asserted patent without modification. According to the Court, an accused device having the capability of being configured or programmed to perform the stated function was not enough to constitute infringement when the device as sold was not structured to perform the stated function. The Court concluded that Nazomi's reliance on "key" cases was inapposite. Unlike cases in which software capable of practicing the claim limitations was already present on the accused device and could be unlocked with a key, "the structure (*i.e.*, JTEK software) necessary to enable Jazelle hardware to process stack-based instructions (*i.e.*, Java bytecodes) is not only inactive, it is not even present on the accused products." *Id.* at 15. Therefore, installing JTEK software was equivalent to "adding new functionality not currently present." *Id.* at 15-16. Because "[t]he purchase and installation of the JTEX software clearly constitutes a 'modification' of the accused products" necessary for the device to perform the claim limitations, the Court held that the Western and Sling products did not infringe. *Id.* at 14.

Judge Lourie concurred in the decision to affirm the district court's decision to grant SJ of noninfringement, but only through the majority's affirmation on the basis "that the claim limitation 'capable of executing a plurality of instruction sets . . .' is not met by Jazelle hardware that is not functional without the JTEK software." Lourie Concurrence at 2.

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### **Examiners May Rely on Incomplete Prior Art References to Establish Obviousness**

*Emmanuel Azih*

**Judges: Dyk (author), O'Malley (dissenting), Taranto**  
**[Appealed from Board]**

In *In re Enhanced Security Research, LLC*, No. 13-1114 (Fed. Cir. Jan. 13, 2014), the Federal Circuit affirmed the Board's decision rejecting as obvious the claims of U.S. Patent No. 6,119,236 ("the '236 patent") owned by Enhanced Security Research, LLC ("ESR").

The '236 patent, as amended, claims a computer security device and method for preventing unauthorized access to a local computer network. Specifically, the '236 patent claims a security device that protects a local network by (1) monitoring communications throughout the network to detect suspicious communication patterns, (2) assigning weighted values to any threatening activity detected, and (3) blocking communications based on their assigned weight value using a firewall.

During a third-party requested ex parte reexamination, the examiner rejected all claims of the '236 patent as obvious based on two potential prior art references: (1) the manual of a software product called NetStalker ("the Manual"), and (2) a scholarly article ("Liepins"). The NetStalker software, similar to the '236 patent, protects local networks from attempted security breaches by monitoring network communications, identifying attempted security breaches, and automatically blocking any unauthorized access attempts. Liepins describes a computer system capable of detecting newly identified anomalous activity by automatically generating, weighing, and applying a set of decision rules. The Board affirmed the examiner's obviousness rejections of the amended claims, and ESR appealed to the Federal Circuit.

The Federal Circuit affirmed. The Court held that substantial evidence supported the Board's obviousness determination that "the Manual in combination with Liepins teaches a person of ordinary skill in the art how to assess the severity of an attempted security breach and then block that attempted breach *based on* its severity." Slip op. at 8. According to the Court, the NetStalker software teaches responding to attempted security breaches *based on* user-defined severity parameters, and while the Manual does not disclose the automatic assignment of different weights to different types of attempted security breaches, Liepins fills this gap by disclosing a systematic rule-based framework capable of automatically identifying exceptional network activity. The Court also held that ESR had waived arguing the separate patentability of any of the dependent claims by failing to argue these claims separately under distinct subheadings as required under 37 C.F.R. § 41.37.

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**"We conclude that the PTO's own rules permit the consideration of selected portions of prior art references so long as the missing portions are not necessary to fully understand the submitted portions." Slip op. at 16.**



The Federal Circuit next rejected ESR's contention that the Board erred in finding that the Manual constituted publicly available prior art. According to the Court, even "relatively obscure documents qualify as prior art so long as the public has a means of accessing them." *Id.* at 13 (citing *In re Hall*, 781 F.2d 897, 899 (Fed. Cir. 1986)). The Court held that substantial evidence supported the Board's finding, including a May 1996 date on the Manual's title page, a declaration from the CEO of the company that produces NetStalker stating that members of the public could have obtained a copy of the Manual, and evidence of NetStalker advertisements published in 1995.

The Federal Circuit also rejected ESR's argument that the Manual should not have been considered because it was missing pages, and thus could not be considered as a whole. The Court first distinguished *Panduit Corp. v. Dennison Manufacturing Co.*, 810 F.2d 1561 (Fed. Cir. 1987), in which the district court had erred by stitching together an obviousness finding from discrete portions of prior art references without considering the references as a whole. The Court also relied on (1) 37 C.F.R. § 1.510, the primary regulation governing reexamination, and specifically § 1.510(b)(3), as well as MPEP § 2218, which permits a requester to submit only the "pertinent parts" of any non-English translation; and (2) 37 C.F.R. § 1.105 and MPEP § 704.14(a), which permit patentee submissions of just selected portions of an article over fifty pages, as was the Manual. Thus, according to the Court, "the PTO's own rules permit the consideration of selected portions of prior art references so long as the missing portions are not necessary to fully understand the submitted portions." Slip op. at 16. And in this case, the Court concluded that nothing in the Manual suggested that the missing pages were necessary to understand the pertinent parts of the reference or contradicted the available portions on which the PTO relied.

Finally, the Federal Circuit rejected ESR's argument that NetStalker was not invalidating prior art because ESR had conceived of the invention before the Manual's publication and diligently reduced its invention to practice. The Court held that the Board did not err in finding no showing of attorney diligence when, during the critical period—between May 1996, when the Manual became available, and October 7, 1996, when the patent application was filed—the prosecuting attorney had a few conversations with the inventor, conducted a prior art search, billed for under thirty hours of work, and drafted the patent application.

Accordingly, the Federal Circuit affirmed the Board's decision rejecting the claims of the '236 patent as obvious.

Judge O'Malley dissented. Judge O'Malley believed that the Board should have refused to rely on the Manual because it was facially incomplete, and thus could not be considered as a whole, and because it was obtained from an interested party who never explained why the reference was submitted in an incomplete form or what the missing portions discussed. According to Judge O'Malley, "due process concerns arise when, as here, a complete version of a reference is unavailable to a patentee, but the PTO relies on it with no explanation from the provider as to why it is incomplete." O'Malley Dissent at 6. Judge O'Malley also disagreed that substantial evidence supported a finding that the Manual was publicly accessible because the declaration on which the Board relied lacked evidence that the version of NetStalker discussed in the Manual was ever advertised or sold before the critical date, and because the Manual bore several indicia of a draft document. Finally, Judge O'Malley took issue with the majority's obviousness decision, accusing the majority of filling in gaps in the Board's analysis with its own alternative analysis.

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### **Prior Art Machine Merely Capable of Performing Claimed Functionality Insufficient to Render Claims Obvious Where Narrow Definition of “Adapted to” Was Used**

**Judges: Rader, Lourie (author), Moore**  
**[Appealed from Board]**

In *In re Giannelli*, No. 13-1167 (Fed. Cir. Jan. 13, 2014), the Federal Circuit reversed the Board’s affirmation of the examiner’s rejection of claims 1-25 of U.S. Patent Application No. 10/378,261 (“the ’261 application”), holding that the claims of the ’261 application were not obvious in light of U.S. Patent No. 5,997,447 (“the ’447 patent”).

Raymond Giannelli filed the ’261 application for “an exercise machine on which a user can perform a rowing motion against a selected resistance, thereby strengthening the back muscles.” Slip op. at 2. The patent examiner initially rejected the claims as anticipated by the ’447 patent, which describes a chest-press exercise machine where the user performs the exercise by pushing on the handles to overcome the selected resistance. In response, Giannelli amended the claims to add the limitation “by a pulling force exerted by a user on the first handle portion in a rowing motion.” *Id.* at 4. Despite this amendment, the examiner rejected the claims as anticipated by and obvious over the ’447 patent. Giannelli appealed to the Board.

The Board did not address the anticipation rejection, but affirmed the obviousness rejection. Finding it reasonable for a user to face the handles of the prior art chest-press machine and exert a pulling force on its handles in a rowing motion, the Board concluded that the ’261 application simply recited a new intended use of rowing for the prior art apparatus. The Board noted that merely reciting a new intended use for an old product did not make a claim to that old product patentable. Because Giannelli had not shown that the prior art chest-press machine could not be used as a rowing machine, the Board found that Giannelli failed to rebut a showing of obviousness. Accordingly, the Board affirmed the examiner’s rejection, and Giannelli appealed.

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**“In the context of the claimed rowing machine, . . . the mere *capability* of pulling the handles is not the inquiry that the Board should have made; it should have determined whether it would have been obvious to modify the prior art apparatus to arrive at the claimed rowing machine.” Slip op. at 8.**

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On appeal, the Federal Circuit reversed the rejection, holding that the Board erred in concluding that the claims of the ’261 application would have been obvious over the ’447 patent. The Court reasoned that the Board did not carry its burden of establishing a *prima facie* case of obviousness. The Court first looked at the ’261 application’s claim language, which recited a “first handle portion adapted to be moved

from a first position to a second position by a pulling force . . . in a rowing motion,” and noted that the written description specifically limited “adapted to” to mean “that the claimed machine is designed or constructed to be used as a rowing machine whereby a pulling force is exerted on the handles.” *Id.* at 7 (citation omitted). The Court stated that, as used in the ’261 application, “adapted to” did not include “capable of” or “suitable for.” *Id.* (citation omitted). The Court found that the relevant question before the Board was thus whether the prior art apparatus was made to, designed to, or configured to allow the user to perform a rowing exercise by pulling on the handles, as claimed in the ’261 application. According to the Court, there was no question that the prior art apparatus did not have handles that were adapted to be pulled in a rowing motion. The Court stated, “In the context of the claimed rowing machine, . . . the mere *capability* of pulling the handles is not the inquiry that the Board should have made; it should have determined whether it would have been obvious to modify the prior art apparatus to arrive at the claimed rowing machine.” *Id.* at 8. The Court thus held that the Board erred in concluding that the examiner had met his initial burden of establishing a prima facie case of obviousness. “[B]ecause the initial burden was not met, Giannelli was not obligated to submit additional evidence to rebut the examiner’s findings of pulling capability.” *Id.* at 9. Accordingly, the Court reversed the Board’s affirmation of the examiner’s rejection of the claims of the ’261 application.

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### **District Court Erred in Not Construing Claims for Contempt Motion Where There Was No Prior Claim Construction Because Infringement Had Been Conceded**

*Elizabeth A. Loughton*

**Judges: Lourie, Schall, Prost (author)**

**[Appealed from D. Mass., Judge Young]**

In *Proveris Scientific Corp. v. Innovasystems, Inc.*, Nos. 13-1166, -1190 (Fed. Cir. Jan. 13, 2014), the Federal Circuit held that the district court erred in failing to construe disputed claim language. The Court thus vacated the district court's order holding Innovasystems, Inc. ("Innova") in contempt of an injunction against continued infringement, vacated the accompanying award of sanctions, and remanded the case for claim construction and renewed contempt proceedings.

Proveris Scientific Corporation ("Proveris") holds U.S. Patent No. 6,785,400 ("the '400 patent"), which claims an apparatus for observing and analyzing aerosol spray plumes generated in the delivery of drugs through spray devices. Proveris previously sued Innova for infringement of the '400 patent, based on Innova's manufacture and sale of its Optical Spray Analyzer ("OSA") device. Innova conceded infringement of claims 3-10 and 13, but disputed infringement of claims 1 and 2. The district court found that the '400 patent was not invalid, and a jury found no infringement of claims 1 and 2, and that no damages had been proven. Based on the conceded infringement of other claims, however, the district court granted a permanent injunction against Innova, and the Federal Circuit affirmed.

Innova introduced a new product, the Aerosol Drug Spray Analyzer ("ADSA"), which Innova claimed did not infringe independent claim 3 of the '400 patent. According to Innova, where the OSA allowed a user to identify a range of images for analysis before activating the spray plume, the ADSA required that the spray plume be activated first, followed by the identification of images for analysis. Innova argued that the ADSA is noninfringing because the preamble of claim 3 specifies that image data may be captured "at a predetermined instant in time." Slip op. at 3.

Proveris filed a contempt motion based on Innova's manufacture and sale of the ADSA. During the contempt proceeding, the district court declined to construe claim 3, reasoning that Innova could have but did not raise claim construction issues in the underlying infringement action. Similarly, the district court did not allow Innova to raise any new invalidity arguments, reasoning that Innova had already attempted to challenge the validity of claim 3 during the underlying infringement action. The district court found that Innova's violation of the injunction was willful, entered a contempt order against Innova, and awarded sanctions. Innova appealed the contempt order and award of sanctions, and Proveris cross-appealed portions of the sanctions ruling.

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**"It is true that we have previously held that in contempt proceedings, 'out of**

**fairness, the district court is bound by any prior claim construction that it had performed in [this] case.’ However, here, there was no prior claim construction because Innova had conceded infringement.” Slip op. at 7 (quoting *TiVo, Inc. v. EchoStar Corp.*, 646 F.3d 869, 883 (Fed. Cir. 2011) (en banc)).**

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On appeal, the Federal Circuit analyzed whether Innova violated the injunction under the two-part test set forth in *TiVo, Inc. v. EchoStar Corp.*, 646 F.3d 869 (Fed. Cir. 2011) (en banc). First, the Court assessed whether the new ADSA product was “not more than colorably different” from the infringing OSA product. Slip op. at 6. Innova argued that the ADSA was more than colorably different from the OSA because it conceded infringement for the OSA based on a feature removed from the ADSA. The Federal Circuit rejected Innova’s position, holding that “[e]ven if it were true that this particular feature was a basis for the prior finding of infringement—a fact that Proveris disputes—*TiVo* makes clear that the court must still determine whether that modification was *significant*.” *Id.* at 5-6 (footnote omitted) (citing *TiVo*, 646 F.3d at 882). The Court concluded that the modification to the OSA was not significant, stating that it was not at all clear from the record whether the purported change actually had any effect. “Thus, [the Court] agree[d] with the district court that the ADSA product [was] not more than colorably different from the infringing OSA product.” *Id.* at 6.

The Court then turned to the second prong of the *TiVo* test—whether the newly accused product infringed the ‘400 patent, noting that this analysis required construction of disputed claim language. The Federal Circuit held that the district court erred in declining to construe claim 3 in the contempt proceeding. The Court noted that even though it had “previously held that in contempt proceedings, ‘out of fairness, the district court is bound by any prior claim construction that it had performed in [this] case,’ . . . here, there was no prior claim construction.” *Id.* at 7 (quoting *TiVo*, 646 F.3d at 883). “Thus, it simply cannot be said that it was the ‘law of the case’ that the preamble was not a claim limitation.” *Id.* (citing *Bass Pro Trademarks, LLC v. Cabela’s, Inc.*, 485 F.3d 1364, 1369 (Fed. Cir. 2007)).

Turning to construction of the disputed claim language, the Court held that the preamble of claim 3 was properly construed as importing a limitation into the claim. The Court reasoned that “the preamble of claim 3 is the only reference in any independent claim to the inventive concept of capturing a sequence of images in order to characterize the time evolution of the spray plume,” and that “[t]his fact alone is likely sufficient to support a conclusion that the preamble is limiting.” *Id.* at 9. The Court further observed that its conclusion was further supported by the claim body itself, because the phrase “the image data” derived antecedent basis from the preamble, which further defined it.

With respect to the proper construction of the disputed language within the preamble, the Court held that it lacked sufficient information to make the determination. The Court thus remanded the case for construction of the disputed claim language and for the district court to then re-evaluate whether the ADSA product in fact infringes claim 3 under the proper construction and therefore constitutes a violation of the injunction.

The Court then turned to the issues raised in Proveris’s cross-appeal relating to sanctions, stating that it was premature to address them. They noted, though, “in the interest of judicial efficiency, . . . that, should the district court again decline to award sanctions for Innova’s overseas sales of certain component parts of the ADSA product or Innova’s sale of the ADSA product to Westech Instrument Services Ltd., we discern no error in those rulings.” *Id.* at 12. The Court thus vacated the district court’s contempt order and sanctions award, and remanded for further proceedings.

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## *Last Month at the Federal Circuit*

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**February 2014**

### **Federal Circuit Modifies the Method for Calculating B-delay in Patent Term Adjustment**

*David Albagli*

**Judges: Newman, Dyk, Taranto (author)**

**[Appealed from D.D.C., Judge Huvelle]**

In *Novartis AG v. Lee*, Nos. 13-1160, -1179 (Fed. Cir. Jan. 15, 2014), the Federal Circuit held that the PTO was partly correct but partly incorrect in its interpretation of 35 U.S.C. § 154(b)(1)(B) for how to calculate patent term adjustment (“PTA”). The Court also affirmed the district court’s ruling that Novartis AG’s (“Novartis”) request for redetermination of PTA under 35 U.S.C. § 154(b)(3) and (b)(4) was untimely with respect to some patents. For the patents in which the request for redetermination was timely filed, the Court partly reversed the judgment regarding PTA and remanded for redetermination in accord with its ruling.

Novartis filed lawsuits claiming that the PTO erred in determining the PTA for twenty-three patents. The claims for nineteen of those patents were filed more than 180 days after the PTO denied reconsideration of the PTA determination. Of the four patents whose claims were filed within 180 days of the PTO decision denying relief, Novartis challenged the PTO’s interpretation of § 154(b)(1)(B), which guarantees no more than three-year application pendency, referred to as “B-delay,” for three patents, and sought a redetermination of PTA under *Wyeth v. Kappos*, 591 F.3d 1364 (Fed. Cir. 2010), for one patent. After considering cross-motions for SJ, the district court ruled that, under § 154(b)(4), the claims filed more than 180 days after the PTO decision were untimely, and Novartis appealed this ruling with respect to fifteen patents. Of the four timely claims, the district court ruled that the PTO’s interpretation of § 154(b)(1)(B) for three of those claims was contrary to law and found in favor of Novartis’s interpretation of how to calculate B-delay. The PTO Director cross-appealed this ruling. Neither party appealed the district court’s ruling that one of the patents should have its PTA recalculated in accord with *Wyeth*.

Turning to Novartis’s contention that the 180-day period prescribed by § 154(b)(4)(A) for challenging a determination applies only to the PTA determination made under § 154(b)(3)(B)(i)—which by its terms only refers to a determination at the time a notice of allowance issues, not to the final PTA determination—the Federal Circuit found this interpretation unreasonable because it focuses on clause (b)(3)(B)(i) and ignores the broad language of several other provisions in paragraph (b)(3). According to the Court, other clauses in paragraph (b)(3) “plainly cover the final adjustment announced at issuance, not just a provisional adjustment announced at allowance.” Slip op. at 10. The Court explained that “[t]he only reasonable construction is that the (b)(3)(B)(i) command regarding transmittal with a notice of allowance is itself implicitly limited to determinations that can be transmitted at that time,” which the Court preferred over Novartis’s proposed construction. *Id.* at 10-11.

The Federal Circuit also rejected Novartis’s two additional arguments that its challenges 180 days after a

PTO decision should be allowed as timely. First, the Court determined that equitable tolling of paragraph (b)(4) was unavailable to Novartis because it did not pursue its rights, but instead waited for another party, Wyeth, to establish the legal standard that it sought to assert. Second, the Court held that Novartis could not challenge the 180-day time bar as an uncompensated taking under the Fifth Amendment. According to the Court, Novartis's own failure to comply with the filing deadline prevented the award of PTA, and the Fifth Amendment does not compensate an entity that neglected to preserve its rights.

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**“The better reading of the language is that the patent term adjustment time should be calculated by determining the length of the time between application and patent issuance, then subtracting any continued examination time (and other time identified in (i), (ii), and (iii) of (b)(1)(B)) and determining the extent to which the result exceeds three years.” Slip op. at 14.**

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The Federal Circuit then ruled on the two aspects of B-delay determination under § 154(b)(1)(B)(i) challenged by the parties for the three timely asserted patents. First, the Court rejected Novartis's argument that once three years have passed since the application filing date, all time until the issue date must be added as B-delay, even if continued examination is requested after that date. Instead, the Court agreed with the PTO's position that no PTA is available for any time consumed by continued examination, regardless of whether the request was filed before or after three years from the application filing date. The Court noted “the textual fact that there is no time-of-initiation restriction on the processes identified in the exclusions” of clauses (b)(1)(B)(i), (ii), and (iii), *id.* at 13, and concluded that the better reading is that PTA should be calculated by determining the length of time between application and issuance, subtracting any continued examination time (and other time identified in (b)(1)(B)(i), (ii), and (iii)), and determining the extent to which the result exceeds three years.

Addressing the second issue, the Court agreed with Novartis “that the ‘time consumed by continued examination’ should be limited to the time before allowance,” and should not include the time between allowance and issuance unless later examination actually occurs. *Id.* at 15. The Court reasoned that time from allowance to issuance would count toward the PTO's three-year allotment in a case not involving a continued examination, and there was no basis for distinguishing a continued examination case. The Court concluded that under § 154(b)(1)(B)(i), “[a]n ‘examination’ presumptively ends at allowance, when prosecution is closed and there is no further examination on the merits in the absence of a special reopening [of prosecution].” *Id.*

Although the PTO identified several circumstances in which an applicant may resume examination after allowance, the Federal Circuit concluded that such circumstances are exceptional and can be accounted for in the adjustment when they occur. The possible existence of such exceptional cases does not demand a general rule excluding time between allowance and issuance from the B-delay determination under § 154(b)(1)(B)(i).

Accordingly, the Court affirmed the district court's untimeliness finding pertaining to Novartis's claims directed to fifteen patents, partly reversed the judgment as to PTA for Novartis's three timely patents, and remanded for redetermination of the proper PTA.

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**February 2014**

### **Intervening Applications Must Specifically Reference All Earlier Applications in Chain of Priority to Comply with 35 U.S.C. § 120**

*Charles W. Mitchell\**

**Judges: Prost (author), Plager, Taranto**

**[Appealed from C.D. Cal., Judge Selna]**

In *Medtronic CoreValve, LLC v. Edwards Lifesciences Corp.*, No. 13-1117 (Fed. Cir. Jan. 22, 2014), the Federal Circuit affirmed the district court's finding that U.S. Patent No. 7,892,281 ("the '281 patent") was not entitled to an earlier priority date because it failed to comply with the requirements of 35 U.S.C. § 120 and that the asserted claims were therefore invalid as anticipated.

Medtronic CoreValve, LLC, Medtronic CV Luxembourg S.a.r.l., and Medtronic Vascular Galway Ltd. (collectively "Medtronic") sued Edwards Lifesciences Corp., Edwards Lifesciences LLC, and Edwards Lifesciences (U.S.) Inc. (collectively "Edwards") for infringement of claims 3, 4, 7, 12, 14, and 15 (collectively "the Asserted Claims") of the '281 patent. The '281 patent issued on February 22, 2011, from U.S. Patent Application No. 12/348,892 ("U.S. Application 10") and claims priority on its face to French Application No. 99/14462 ("French Application 1a"). The Asserted Claims, however, are unrelated to French Application 1a and derive instead from French Application No. 00/14028 ("French Application 1b") through the following priority chain:

Application	Serial Number	Filing Date
French Application 1b	French Application No. FR 00/14028	Oct. 31, 2000
International Application 2b	International Application No. PCT/FR 01/03258	Oct. 19, 2001
U.S. Application 4	U.S. Patent Application No. 10/412,634	Apr. 10, 2003
U.S. Application 6	U.S. Patent Application No. 11/352,614	Feb. 13, 2006
U.S. Application 8	U.S. Patent Application No. 12/029,031	Feb. 11, 2008
U.S. Application 10	U.S. Patent Application No. 12/348,892	Jan. 5, 2009

On Edwards's motion for partial SJ, the district court found that the Asserted Claims were entitled to a priority date no earlier than April 10, 2003, the filing date of U.S. Application 4, because Medtronic failed to comply with the requirements of 35 U.S.C. §§ 119 and 120. Accordingly, the district court granted Edwards's motion for SJ that the Asserted Claims were anticipated by French Application 1b under

35 U.S.C. § 102 and entered final judgment for Edwards.

Medtronic timely appealed, arguing that there was no defect in the '281 patent's priority chain, that the Asserted Claims were therefore entitled to a priority date of at least October 31, 2000, and that, by virtue of this earlier priority date, the Asserted Claims were not invalid as anticipated. On appeal, the Federal Circuit first observed that Medtronic had to successfully prove that the '281 patent complied with both §§ 119 and 120 to be entitled to the earlier priority date and avoid anticipation.

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**“Because Medtronic failed to specifically reference each earlier filed application in the intervening applications in the chain of priority for the '281 patent under 35 U.S.C. § 120, the district court was correct to limit the priority date of the patent to no earlier than April 10, 2003 and thereafter find the Asserted Claims invalid as anticipated.” Slip op. at 14.**

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Electing to analyze the '281 patent's compliance with § 120 first, the Court held that because two intervening applications in the '281 patent's priority chain—U.S. Applications 6 and 8—failed to specifically reference earlier-filed applications in the same chain, as required by the Court's interpretation of § 120 in *Encyclopaedia Britannica, Inc. v. Alpine Electronics of America, Inc.*, 609 F.3d 1345 (Fed. Cir. 2010), the '281 patent was not entitled to the filing date of International Application 2b. A later-filed patent application may claim the benefit of an earlier filing date in the United States if, among other requirements, “it contains or is amended to contain a specific reference to the earlier filed application . . . submitted at such time during the pendency of the application as required by the Director.” Slip op. at 7 (quoting 35 U.S.C. § 120). Specifically, the Court observed that by only reciting that “[t]his application is also a continuation-in-part of International Application No. PCT/FR 01/03258 [International Application 2b],” the priority claims in both U.S. Applications 6 and 8 “insufficiently and incorrectly stated that (1) U.S. Application 6 is a continuation-in-part of International Application 2b, omitting any reference to intermediate U.S. Application 4; and (2) U.S. Application 8 is a continuation-in-part of International Application 2b, omitting citations to both intermediate U.S. Applications 6 and 4.” *Id.* at 9.

Dismissing Medtronic's argument that “this application” as used in the priority claims of U.S. Applications 6 and 8 actually referred to U.S. Application 4 as “an attempt at linguistic gymnastics,” *id.* at 10, the Court also declined Medtronic's invitation to apply a “reasonable person” standard to determine the sufficiency of priority claims under § 120. The Court reasoned that a “reasonable person” standard would conflict with both § 120's “specific reference” language and with the regulation implementing § 120, 37 C.F.R. § 1.78(a)(2)(i), “which requires precise details in priority claims down to the ‘application number (consisting of the series code and serial number).’” *Id.* at 12. Moreover, adopting a “reasonable person” standard would improperly place the burden of interpreting priority claims on the reader or the public. As the Court observed, “[t]he patentee is the person best suited to understand the genealogy and relationship of her applications; a requirement for her to clearly disclose this information should present no hardship.” *Id.* at 13.

Finding Medtronic's reliance on *E.I. du Pont de Nemours & Co. v. MacDermid Printing Solutions, LLC*, 525 F.3d 1353 (Fed. Cir. 2008), misplaced, the Federal Circuit explained that, unlike *MacDermid Printing*, “where certain magic words were not used but the priority claim was otherwise correct, . . . Medtronic used language suggested by the M.P.E.P. in a *contrary* manner, and additionally failed to disclose the correct relationships between the applications at issue.” Slip op. at 14. The Court then found Medtronic's remaining arguments unpersuasive.

By concluding that the '281 patent failed to comply with § 120 because the intervening applications in the priority chain failed to specifically reference all earlier-filed applications in the chain of priority, the Federal Circuit affirmed the district court's finding that the priority date of the '281 patent was no earlier than April 10, 2003, and, thus, all of the Asserted Claims were anticipated by French Application 1b.



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**February 2014**

### **Broad Claim Terms Need Only Connote Sufficiently Definite Structure to Those Skilled in the Art**

*Yieyie Yang\**

**Judges: Rader, Lourie, Prost (author)**

**[Appealed from Board]**

In *EnOcean GmbH v. Face International Corp.*, No. 12-1645 (Fed. Cir. Jan. 31, 2014), the Federal Circuit vacated-in-part the Board's order finding all of EnOcean GmbH's ("EnOcean") claims involved in Patent Interference No. 105,755 with Face International Corporation ("Face") unpatentable, and remanded for further proceedings.

EnOcean owns the rights to U.S. Patent Application No. 10/304,121 ("the EnOcean application"), which contains claims to a self-powered switch. The named inventors on the EnOcean application originally disclosed their new switch in a German application filed on May 24, 2000, and in a PCT application filed on May 21, 2001. Face is the real party of interest in U.S. Patent No. 7,084,529, which also claims a self-powered switch. After the Board declared an interference between EnOcean and Face, it found that all the involved Face claims were unpatentable under 35 U.S.C. § 103 in view of PCT Application No. PCT/GB01/00901 to Burrow ("the Burrow reference") in combination with several other references.

Under 37 C.F.R. § 41.207(c), the Board next applied the presumption that the claims of the EnOcean application would be unpatentable for the same reason that Face's claims were unpatentable. To rebut the presumption, EnOcean needed to show that its involved claims could benefit from the filing date of its German and PCT applications to thereby eliminate the Burrow reference. However, the Board found that EnOcean's disclosure of a "receiver" in its German application did not support the "means for receiving" limitation in the claims of the EnOcean application. The Board also found that while certain receiver claims of the EnOcean application lacked "means for" language, the claims were defined solely by their function, and thus were construed as means-plus-function claims. Because the German application failed to expressly describe the structure of the receiver and did not support EnOcean's means-plus-function claims, the Board accorded no benefit of priority to EnOcean's claims, found all of EnOcean's claims unpatentable under § 103 for the same reason that Face's claims were unpatentable, and dismissed all other pending motions. EnOcean appealed.

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**"Given the demonstrated familiarity that one of skill in the art would have with a 'receiver' and the Board's own factual finding that a skilled worker would know what a 'receiver' is, we hold that in this case the term is not the 'black box that performs a recited function' that Face would have us believe it is." Slip op. at 8.**

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On appeal, the Federal Circuit first determined whether the receiver claims should be treated as means-plus-function claims. Noting that the receiver claims lack the word “means,” the Federal Circuit noted that the claims were entitled to a presumption that they are not means-plus-function claims. Furthermore, the Court found that the term “receiver” presumptively connotes sufficiently definite structure to those of skill in the art. The Court also observed that EnOcean had provided extensive evidence demonstrating that the term “receiver” conveys known structure to the skilled person.

The Court was not persuaded by Face’s argument that the term “receiver” was too broad to recite sufficiently definite structure. Rather, the Court emphasized that just because “the disputed term is not limited to a single structure does not disqualify it as a corresponding structure, as long as the class of structures is identifiable by a person of ordinary skill in the art.” Slip op. at 7 (quoting *Linear Tech. Corp. v. Impala Linear Corp.*, 379 F.3d 1311, 1322 (Fed. Cir. 2004)). The Court’s conclusion that the term “receiver” recited sufficiently definite structure to avoid invoking 35 U.S.C. § 112, ¶ 6 (now 35 U.S.C. § 112(f)), was well supported by the Court’s precedent in similar cases.

Turning to the priority issue, the Court emphasized that to obtain the benefit of a parent application’s filing date, although the claims of the later-filed application must be supported by the written description in the parent in sufficient detail for one skilled in the art to conclude that the inventor made the invention as of the filing date sought, the disclosure of sufficient structure simply needs to permit one of ordinary skill in the art to perceive the bounds of the invention. The Court found that the Board applied an incorrect standard in requiring that the German and PCT applications “expressly describe the structure of the receiver” for a person of ordinary skill to understand the bounds of the invention. *Id.* at 11 (citation omitted). According to the Court, since the structure was well known as of the filing date, a person skilled in the art could understand the bounds of the invention merely by reading the term “receiver” in EnOcean’s German and PCT applications. Accordingly, the Court concluded that the Board erred in finding that the received claims were not entitled to claim the benefit of the German and PCT applications’ priority dates.

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### **Looking Ahead**

On January 10, 2014, the U.S. Supreme Court granted certiorari in two patent cases: *Limelight Networks, Inc. v. Akamai Technologies, Inc.* (No. 12-786), and *Nautilus, Inc. v. Biosig Instruments, Inc.* (No. 13-369). In *Limelight*, the Supreme Court will consider whether liability for inducing patent infringement under 35 U.S.C. § 271(b) requires as a prerequisite direct patent infringement under § 271(a). In *Nautilus*, the Supreme Court will review the Federal Circuit's "insolubly ambiguous" standard for indefiniteness under § 112's requirement that patent claims particularly point out and distinctly claim the invention. Stay tuned to future editions of *Last Month at the Federal Circuit* to see how the pending decisions affect future Federal Circuit decisions.

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### **Spotlight Info**

In *In re Giannelli*, No. 13-1167 (Fed. Cir. Jan. 13, 2014), the Federal Circuit reversed the Board's affirmation of the examiner's rejection of claims 1-25 of U.S. Patent Application No. 10/378,261 ("the '261 application"), holding that the claims of the '261 application were not obvious in light of U.S. Patent No. 5,997,447. The Court reasoned that the Board did not carry its burden of establishing a prima facie case of obviousness because the Board did not determine whether it would have been obvious to modify the prior art apparatus to arrive at the claimed rowing machine. See this month's edition of *Last Month at the Federal Circuit* for a full summary of this decision.

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