

# Federal Circuit: Year in Review

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Association of Corporate Counsel  
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# Introduction



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# Agenda

- **Upcoming Cases**
- **Blockbuster Opinions**
- **PTAB/IPR Cases**
- **Other Notable Cases**
- **En Banc Grant**

# Upcoming Cases

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# *VLSI v Intel*

## **\$2.2B Verdict at Stake**

### **Issues from Intel on appeal:**

- Infringement of '373 patent (2 limitations challenged)
- Infringement of '759 patent (DoE, PH estoppel)
- Allowing noncomparable agreements into evidence
- Challenges to VLSI's damages model
  - Not tied to accused products and patented features
  - Improper request for disgorgement
  - EMVR violations
- Intel's license defense should have been allowed

*VLSI v  
OpenSky and  
Cross-Appeal*

**PTAB finds all challenged claims of VLSI's patents unpatentable**

**But does so in the face of numerous ethical issues raised by the parties' behavior.**

## *Cal v Broad Institute*

**Whether the PTAB properly concluded that the Broad Institute and MIT invented the use of CRISPR in plants and animals *before* Nobel-winning scientists from the University of California and University of Vienna.**

- The PTAB's decision relied in part on lab notes and emails from the Cal/Vienna scientists that the PTAB found showed they weren't sure the invention would work.

# Blockbuster Opinions

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## *In re Collect*

### **Effect of patent term adjustment (PTA) on obviousness-type double patenting (ODP)**

**ODP – judicially created doctrine that prevents obtaining multiple patents with claims that are not patentably distinct**

- Whether challenged claims are obvious in view of other patents or applications with overlapping inventorship
- An applicant can overcome an ODP rejection by filing a terminal disclaimer (and ongoing co-ownership).

## *In re Collect*

**Holding:** ODP for a patent that has received PTA must be based on the expiration date of the patent after PTA has been added.

Otherwise, an applicant could secure later expiration (i.e., a term extension) for non-distinct claims by virtue of the PTA.

*SAS Institute v  
World  
Programming  
Ltd*

**Affirmed district court finding that SAS failed to show its software was copyright protected**

**District court applied the abstraction-filtration-comparison test, first placing the burden on software owner SAS, then shifting to WPL to rebut, then back to SAS**

- SAS had valid copyright registrations, but WPL was able to filter out elements in the public domain.
- SAS did not have responsive arguments on filtration besides contending that their software was “creative.”

# PTAB/IPR cases

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## *Axonics v Medtronic*

### **IPR Petitioner can raise new arguments in its Reply to PO's post-institution Response**

- PO offered a new claim construction proposal in its post-institution Response.
- On appeal, the Federal Circuit held that, under the APA, Petitioner could present new responsive arguments and evidence in its reply briefing.
- Additionally, the Federal Circuit suggested that PO should then have the opportunity to submit further evidence in a sur-reply.

*Rembrandt  
Diagnostics v  
Alere*

**Also relates to scope of arguments that can be raised at the PTAB**

- Allowed responsive arguments (that were fair extensions of previous arguments) to be put forward by Petitioner in reply.
- Such arguments did not constitute new theories.

# *Parus Holdings v Google*

## **Affirming PTAB's prohibition of "incorporation by reference" against PO**

- A "detailed explanation of the evidence" is required.
- Worth looking to see what was provided in the brief as a baseline for evidence.

# Other Notable Cases

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*SNIPR  
Technologies  
Ltd v  
Rockefeller  
University*

**Post-AIA patents may not be subject to an interference, even against a pre-AIA patent application**

*Elekta Ltd v  
Zap Surgical  
Systems*

**Using prosecution history for motivation to combine prior-art elements**

**Citing a reference in an IDS during prosecution essentially admits the reference is relevant prior art**

# *HIP v Hormel Foods*

## **Inventorship case applying the *Pannu* factors**

Under the *Pannu* test, an inventor must have:

- (1) contributed in some significant manner to the conception of the invention;
- (2) made a contribution to the claimed invention that is not insignificant in quality, when that contribution is measured against the dimension of the full invention; and
- (3) done more than merely explain to the real inventors well-known concepts or the state of the art.

# En Banc Grant

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# LKQ v. GM

## En Banc

### Reviewing the proper obviousness standard for design patents

#### Issues to be considered:

- Does KSR International Co. v. Teleflex Inc., 550 U.S. 398 (2007), overrule or abrogate *In re Rosen*, 673 F.2d 388 (CCPA 1982), and *Durling v. Spectrum Furniture Co., Inc.*, 101 F.3d 100 (Fed. Cir. 1996)?
- Assuming that KSR neither overrules nor abrogates *Rosen* and *Durling*, does KSR nonetheless apply to design patents and suggest the court should eliminate or modify the *Rosen-Durling* test? In particular, please address whether KSR's statements faulting "a rigid rule that limits the obviousness inquiry," 550 U.S. at 419, and adopting "an expansive and flexible approach," *id.* at 415, should cause us to eliminate or modify: (a) *Durling's* requirement that "[b]efore one can begin to combine prior art designs . . . one must find a single reference, 'a something in existence, the design characteristics of which are basically the same as the claimed design,'" 101 F.3d at 103 (quoting *Rosen*, 673 F.2d at 391); and/or (b) *Durling's* requirement that secondary references "may only be used to modify the primary reference if they are 'so related to the primary reference that the appearance of certain ornamental features in one would suggest the application of those features to the other,'" *id.* at 103 (quoting *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996)) (internal alterations omitted).

# *LKQ v. GM*

## En Banc

### Issues to be considered (con't):

- If the court were to eliminate or modify the Rosen-Durling test, what should the test be for evaluating design patent obviousness challenges?
- Has any precedent from this court already taken steps to clarify the Rosen-Durling test? If so, please identify whether those cases resolve any relevant issues.
- Given the length of time in which the RosenDurling test has been applied, would eliminating or modifying the design patent obviousness test cause uncertainty in an otherwise settled area of law?
- To the extent not addressed in the responses to the questions above, what differences, if any, between design patents and utility patents are relevant to the obviousness inquiry, and what role should these differences play in the test for obviousness of design patents?



Questions?

**KEKER**  
**VAN NEST**  
**& PETERS**

**Thank you!**

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