

Brief Summary of Precedential Patent Case Decisions During December 2018

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I. Introduction

This paper contains summary abstracts of what I believe to be the significant new points of law from the precedential decisions in patent cases this month. Cases captions relating to the PTAB are in **red** text. Case captions of extraordinary importance are in **blue** text.

II. Brief Summary Abstracts and New Points of Law

In re Marco Guldenaar Holding B.V., 2017-2465 (Fed. Cir. 12/28/2018).

This is a decision on an appeal from PTAB case 13/078,196. The examiner had rejected the claims as patent ineligible. The PTAB affirmed. Marco appealed. The Federal Circuit affirmed. Judge Mayer concurred, stating that “claims directed to dice, card, and board games can never meet the section 101 threshold because they endeavor to influence human behavior rather than effect technological change.”

Legal issue: 35 USC 101, patent eligibility, *Alice/Mayo* step 2, and printed matter doctrine.

The appellant argued that novel indicia on dice used in the claimed dice game were unconventional and amounted to significantly more than an abstract idea. The Federal Circuit disagreed, noting the indicia provided no new functionality, and therefore were mere, patent ineligible, printed matter.

Spineology, Inc. v. Wright Medical Technology, Inc., 2018-1276 (Fed. Cir. 12/14/2018).

This is a decision on an appeal from the D. Minn. district court case 0:15-cv-00180-JNE-FLN. The district court denied Wright's motion for attorney's fees. Wright appealed. The Federal Circuit affirmed.

Legal issue: District court discretion to decide motions for attorney's fees.

The Federal Circuit made it clear that it was displeased with attempts to require district courts to do unnecessary work on fees motions (“we caution future litigants to tread carefully in their complaints about district courts not doing enough.”)

Virnetx Inc. v. Apple, Inc., 2017-2490, 2017-2494 (Fed. Cir. 12/10/2018).

This is a decision on two appeals from PTAB case IPR2016-00331. The PTAB held that claims of the patent were unpatentable for obviousness. Virnetx appealed. The Federal Circuit affirmed, stating in relevant part that “Because VirnetX is collaterally estopped from relitigating the threshold issue of whether prior art reference RFC 24011 was a printed publication ... we affirm.”

Legal issue: Collateral estoppel based upon a rule 36 affirmance.

The Federal Circuit noted that the finding that a certain reference was a prior art printed publication was “essential or necessary to the Rule 36 judgment” in a prior case involving the same parties, and, therefore concluded that collateral estoppel applied to the same finding in this

case.

Novartis AG v. Ezra Ventures LLC, 2017-2284 (Fed. Cir. 12/7/2018).

This is a decision on appeals from the D. Del. district court cases 1:15-cv-00150-LPS and 1:15-cv-00975-LPS. The district court found the '229 patent valid, unexpired, and enforceable with the PTE, found infringement of the '229 patent, and imposed an injunction on Ezra's ANDA product until the expiration of the '229 patent in 2019. Ezra appealed. The Federal Circuit affirmed.

Legal issue: 35 USC 156(c)(4), construction of “in no event shall more than one patent be extended.”

The Federal Circuit held that the limit to extension of the term of one patent per product in 35 USC 156(c)(4) referred to the one patent for which PTE was requested pursuant to 35 USC 156, and that 35 USC 156(c)(4) did not include any patent whose exclusive right was effectively extended as a result of PTE on the requested patent.

Legal issue: 35 USC 156 PTE, and double patenting invalidity.

In dicta, the Federal Circuit concluded that a patent accorded PTE, for which there is obviousness-type double patenting over another patent and in which no terminal disclaimer was filed, would be invalid for double patenting.

Novartis Pharmaceuticals Corporation v. Breckenridge Pharmaceutical Inc., 2017-2173, 2017-2175, 2017-2176, 2017-2178, 2017-2179, 2017-2180, 2017-2182, 2017-2183, 2017-2184 (Fed. Cir. 12/7/2018).

This is a decision on appeals from the D. Del. district court cases: 1:14-cv-01043-RGA; 1:14-cv-01196-RGA; 1:14-cv-01289-RGA; 1:14-cv-01494-RGA; 1:14-cv-01508-RGA; 1:15-cv-00078-RGA; 1:15-cv-00128-RGA; 1:16-cv-00431-RGA; 1:17-cv-00389-RGA; and 1:17-cv-00420-RGA.

Legal issue: Non statutory double patenting, whether a post-URAA patent having (1) the same effective filing date as a pre-URAA patent and (2) a relatively earlier expiration date than the pre-URAA patent, is a double patenting reference against the pre-URAA patent.

URAA means the Uruguay Round Agreements Act of 1994 (URAA), § 532, Pub. L. No. 103-465, 108 Stat. 4809, 4983, which is effective for all applications filed after June 7, 1995.

A pre-URAA patent is a patent having a term of 17 years from issue date.

A post-URAA patent is a patent having a term of 20 years from US non-provisional filing date, plus any patent term adjustment.

The Federal Circuit held that a post-URAA patent having (1) the same effective filing date as a pre-URAA patent and (2) a relatively earlier expiration date than the pre-URAA patent, is not a double patenting reference against the pre-URAA patent.

Two other Federal Circuit holdings relate directly to this case. *Gilead Sciences, Inc. v. Natco Pharma Ltd.*, 753 F.3d 1208, 1212 (Fed. Cir. 2014) holds that a post-URAA patent (1) with a relatively earlier effective filing and (2) a relatively later issue date than *another* post-URAA, is a double patenting reference against *the other* post-URAA patent. *AbbVie, Inc. v. Mathilda & Terence Kennedy Institute of Rheumatology Trust*, 764 F.3d 1366 (Fed. Cir. 2014) holds that obviousness-type double patenting continues to apply, post-URAA.

Jack Henry & Associates, Inc. v. Plano Encryption Technologies LLC, 2016-2700

(Fed. Cir. 12/7/2018).

This is a decision on an appeal from the N.D. Tex. case 3:15-cv-03745-N. The district court dismissed Jack's complaint for a DJ action, for lack of personal jurisdiction over Plano Encryption Technologies ("PET"). Jack appealed. The Federal Circuit reversed.

Legal issue: Personal jurisdiction, minimum contacts, letters asserting patent infringement from a different judicial district in the same state as the district court.

PET resides in Plano Texas, which is in the eastern district of Texas. It sent letter with detailed accusations of patent infringement to several banks. Jack (provider of the alleged infringing software) and the banks filed a DJ action in the northern district of Texas.

The Federal Circuit clarified that its prior holding in *Avocent Huntsville Corp. v. Aten Int'l Co.*, 552 F.3d 1324, 1333 (Fed. Cir. 2008) (holding that a resident in Taiwan was not subject to personal jurisdiction for a DJ action filed in Alabama) "did not establish a general rule applicable to all circumstances and all forms of contact and all locales." The Federal Circuit indicated that the district court's contrary conclusion was incorrect.

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