

Precedential Patent Law During May 2020

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Outline of Webinar

- CLE credit information
- Case summaries and discussions
- General discussion, practice tips and IP updates

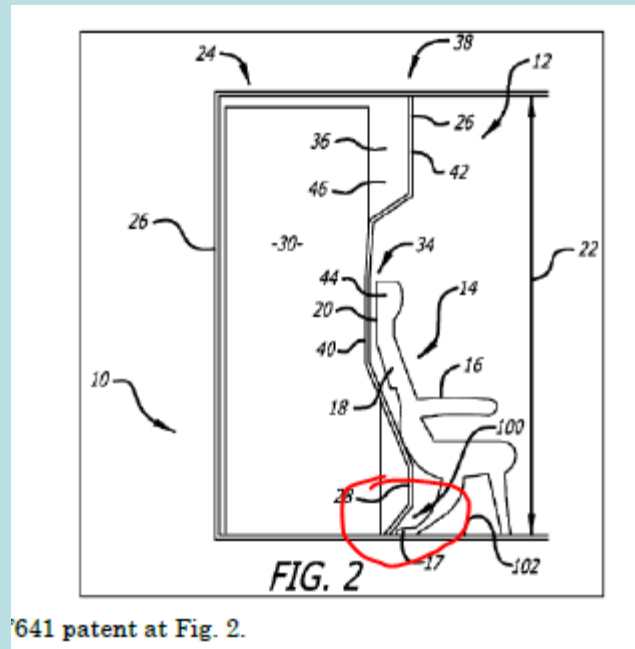
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B/E Aerospace, Inc. v. C&D Zodiac, Inc., 2019-1935, 2019-1936 (Fed. Cir. 6/26/2020). 1

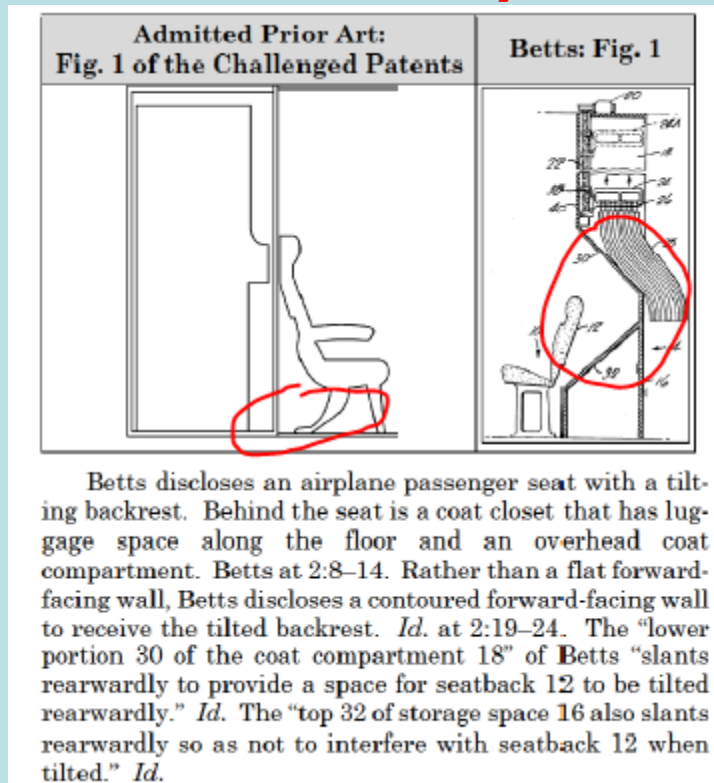
- This is a decision on appeals from IPR2017-01275 and IPR2017-01276. The PTAB found certain claims of B/E's patents obvious. B/E appealed. The Federal Circuit affirmed.
- **Legal issue: 35 USC 103, obviousness, limitations not disclosed by the prior art.**
- The Federal Circuit agreed with both rationales upon which the PTAB concluded that a claim defining a limitation not present in the prior art was nevertheless obvious.

B/E Aerospace, Inc. v. C&D Zodiac, Inc., 2019-1935, 2019-1936 (Fed. Cir. 6/26/2020). 2



Claim: Airplane forward facing lavatory
Missing limitation, second recess, circled.

B/E Aerospace, Inc. v. C&D Zodiac, Inc., 2019-1935, 2019-1936 (Fed. Cir. 6/26/2020). 3



Admitted Prior Art: Lavatory support seat leans back, has support leg extending back. Lacks a wall recesses.

Becks Prior Art: Recess for airplane passenger seat

B/E Aerospace, Inc. v. C&D Zodiac, Inc., 2019-1935, 2019-1936 (Fed. Cir. 6/26/2020). 4

- The relevant facts were that the same advantage (of *increasing airplane passenger cabin space*) obtained by modifying the primary reference to include the prior art feature (a first recess in a wall of the passenger cabin space), was also obtained by further modifying the primary reference to include the missing limitation (the second recess in the same wall), and *both modifications of the primary reference were similar*, both recesses.

B/E Aerospace, Inc. v. C&D Zodiac, Inc., 2019-1935, 2019-1936 (Fed. Cir. 6/26/2020). 5

- First, the Federal Circuit affirmed on the rationale that the missing limitation was a
- predictable application of known technology and a POSITA would have seen the benefit of
- including the missing limitation because it was the obvious solution to a known problem.
- Second, the Federal Circuit affirmed on the rationale that it would have been a matter of
- common sense to include the missing limitation, and that PTAB had provided “sufficient
- reasoning” and evidentiary support for the PTAB’s obviousness conclusion.

B/E Aerospace, Inc. v. C&D Zodiac, Inc., 2019-1935, 2019-1936 (Fed. Cir. 6/26/2020). 6

- First, the Federal Circuit affirmed on the rationale that the missing limitation was a predictable application of known technology and a POSITA would have seen the benefit of including the missing limitation because it was the *obvious solution to a known problem*.
- Second, the Federal Circuit affirmed on the rationale that it would have been a matter of *common sense* to include the missing limitation, and that PTAB had provided *“sufficient reasoning” and evidentiary support* for the PTAB’s obviousness conclusion. (Evidentiary support: PTAB found that “recesses configured to receive seat supports ‘were known in the art’.”)

B/E Aerospace, Inc. v. C&D Zodiac, Inc., 2019-1935, 2019-1936 (Fed. Cir. 6/26/2020). 7

- Second, the Federal Circuit affirmed on the rationale that it would have been a matter of *common sense* to include the missing limitation, and that PTAB had provided *“sufficient reasoning” and evidentiary support* for the PTAB’s obviousness conclusion.
- Evidentiary support: PTAB had found that “recesses configured to receive seat supports ‘were known in the art’.”

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Shoes by Firebug LLC v. Stride Rite Children's Group, LLC, 2019-1622, 2019-1623 (Fed. Cir. 6/25/2020). 1

- This is a decision on appeals from PTAB cases IPR2017-01809 and IPR2017-01810. The PTAB held claims of two patents unpatentable as obvious. Shoes appealed. The Federal Circuit affirmed.
- **Legal issue: 35 USC 112, claim construction, preamble, circumstances under which the preamble limits the claim.**

Shoes by Firebug LLC v. Stride Rite Children's Group, LLC, 2019-1622, 2019-1623 (Fed. Cir. 6/25/2020). 2

- The Federal Circuit construed the same preamble (“*internally illuminated textile footwear*”) in two independent claims, finding that preamble limiting in one claim and not limiting in the other claim.

Shoes by Firebug LLC v. Stride Rite Children's Group, LLC, 2019-1622, 2019-1623 (Fed. Cir. 6/25/2020). 3

- Claim 1 of the '038 patent read “1. An internally illuminated *textile footwear* comprises: *a footwear*; *the footwear comprises a sole and an upper*; an illumination system; ... the illumination system being housed within the footwear....” (preamble held **non-limiting**, not limiting the “upper” to be “textile.”)
- Claim 1 of the '574 patent, read “1. An internally illuminated *textile footwear* comprises: *a sole and an upper*; an illumination system;*** the illumination system being housed within the *footwear*,...” (preamble held **limiting**, limiting the “upper” to be “textile”.)

Shoes by Firebug LLC v. Stride Rite Children's Group, LLC, 2019-1622, 2019-1623 (Fed. Cir. 6/25/2020). 4

- The Federal Circuit concluded that the “*internally illuminated textile footwear*” preamble of claim 1 of the ‘038 did not limit the claimed “upper” to be a textile upper, because the body of that claim positively recited a “footwear” element (which comprised an upper).

Adidas AG v. Nike, Inc., 2019-1787, 2019-1788 (Fed. Cir. 6/25/2020). 1

- This is a decision on appeals from PTAB cases IPR2016-00921 and IPR2016-00922.
- The PTAB held that the challenged claims of two patents were unpatentable. Adidas appealed. The Federal Circuit affirmed.
- **Legal issue: Article III Standing to appeal, facts sufficient to meet the injury in fact requirement.**

Adidas AG v. Nike, Inc., 2019-1787, 2019-1788 (Fed. Cir. 6/25/2020). 2

- The Federal Circuit concluded that the following facts were sufficient to meet the injury in fact requirement:
- (1) Adidas and Nike were direct competitors;
- (2) Nike previously accused Adidas of infringing a corresponding foreign patent;
- (3) Nike expressed its intent to protect corresponding rights (against Adidas) globally;
- (4) Adidas sells, in the United States, the same product accused of infringing the foreign patent;
- (5) Nike refused to grant Adidas a covenant not to sue.

In re PersonalWeb Technologies, LLC, 19-1918 (Fed. Cir. 6/17/2020). 1

- This is a decision on appeal from none the N.D. Cal. district court cases.
- The district court dismissed the cases under Kessler doctrine, due to dismissal with prejudice of prior suit against Amazon.
- **Legal issue: Kessler doctrine, whether non-infringement must be “actually litigated” in order for the *Kessler* doctrine to apply.**

In re PersonalWeb Technologies, LLC, 19-1918 (Fed. Cir. 6/17/2020). 2

- The Federal Circuit held that a dismissal with prejudice of the prior infringement action is sufficient to bar later suit.
- *Kessler/PersonalWeb* doctrine is an expansion of the *Kessler* doctrine.

**Curt G. Joa, Inc. v. Fameccanica.data
S.P.A., IPR2016-00906, paper 61 (PTAB
6/20/2017; designated informative
6/11/2020).**

- PTAB decision on joint motion to seal the PTAB hearing.
- PTAB ordered the hearing be bifurcated into public and sealed portions.

Sattler Tech Corp. v. Humancentric Ventures, LLC, PGR2019-00030, paper 9 (PTAB 7/26/2019; designated informative 6/11/2020).

- Sattler petitioned for post-grant review. The PTAB instituted review.
- **Legal issue: 35 USC 324(a), meaning of “unpatentable” in 324(a).**
- The PTAB implicitly concluded that lack of 35 USC 171 “ornamentality” met the “unpatentable” requirement of 35 USC 324(a).
- (Note: This is not a case about the specific requirements for ornamentality.)

**DTN, LLC v. Farms Technology, LLC,
IPR2018-01412 and IPR2018-01525
(6/14/2019 PTAB; designated
precedential 6/11/2020). 1**

- The parties filed joint motions to expunge collateral agreements to a settlement agreement. The PTAB **denied** the motions.
- **Legal issue: 35 USC 317(b), statutory constructions of “between the patent owner and a petitioner” and “any collateral agreements.”**
- The PTAB concluded that an agreement between the parties to an IPR was an agreement
- between the petitioner and the patent owner, and that “any collateral agreement” was not limited
- to agreements between the petitioner and patent owner.

**DTN, LLC v. Farms Technology, LLC,
IPR2018-01412 and IPR2018-01525
(6/14/2019 PTAB; designated
precedential 6/11/2020). 2**

- The PTAB concluded
- (1) that an agreement between the parties to an IPR was an agreement between the petitioner and the patent owner, and
- (2) that “any collateral agreement” was not limited to agreements between the petitioner and patent owner.
- (Parties cannot with agreements having non party signatories made in contemplation of settlement.)

Amneal Pharmaceuticals LLC v. Almirall, LLC, 2020-1106 (Fed. Cir. 6/4/2020). 1

- This is an order in an appeal from PTAB case IPR2018-00608. Both parties moved to dismiss the appeal. Almirall also moved for **attorneys fees**. The Federal Circuit dismissed the appeal and denied the motion for fees.
- **Legal issue: 35 USC 285, fees for attorney costs incurred before the PTO during an IPR proceeding.**

Amneal Pharmaceuticals LLC v. Almirall, LLC, 2020-1106 (Fed. Cir. 6/4/2020). 2

- This is an order in an appeal **from PTAB case IPR2018-00608**. Both parties moved to dismiss the appeal. Almirall also moved for **attorneys fees**. The Federal Circuit dismissed the appeal and denied the motion for fees.
- **Legal issue: 35 USC 285, fees for attorney costs incurred before the PTO during an IPR proceeding.**

Amneal Pharmaceuticals LLC v. Almirall, LLC, 2020-1106 (Fed. Cir. 6/4/2020). 3

- The Federal Circuit held that 35 USC 285 generally does not authorize it to award attorneys fees for attorney costs incurred before the PTO during an IPR proceeding.
- (Note: This is an appeal *from an IPR*; not an appeal *from a civil action* with a corresponding IPR.)

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General Discussions

- General legal issues?
- Practice tips?
- Anything else of import?

Thank you!

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