

RECENT DEVELOPMENTS IN PATENT LAW (FALL 2019)
UPDATED THROUGH 10/30/2019
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PATENTABLE SUBJECT MATTER.....	5
<i>Am. Axle & Mfg., Inc. v. Neapco Holdings LLC</i> , 939 F.3d 1355 (Fed. Cir. October 3, 2019)	5
<i>Chamberlain Grp., Inc. v. Techtronic Indus. Co.</i> , 935 F.3d 1341 (Fed. Cir. August 21, 2019)	6
Software and Business Method Cases	7
Unpatentable	7
<i>Solutran, Inc. v. Evalon, Inc.</i> , 931 F.3d 1161 (Fed. Cir. July 30, 2019).....	7
<i>Trading Techs. Int’l, Inc. v. IBG LLC</i> , Nos. 2017-2257, 2017-2621, 2018-1063 (Fed. Cir. Apr. 18, 2019).....	8
<i>ChargePoint, Inc. v. SemaConnect, Inc.</i> , 920 F.3d 759 (Fed. Cir. Mar. 28, 2019)	9
<i>University of Florida Research Found. v. General Elec. Co.</i> , 916 F.3d 1363 (Fed. Cir. Feb. 26, 2019).....	10
Patentable	11
<i>SRI Int’l, Inc. v. Cisco Sys., Inc.</i> , 930 F.3d 1295 (Fed. Cir. Mar. 20, 2019, modified July 12, 2019).....	11
<i>Cellspin Soft, Inc. v. Fitbit, Inc.</i> , 927 F.3d 1306 (Fed. Cir. June 25, 2019).....	12
<i>Ancora Techs, Inc. v. HTC Am., Inc.</i> , 908 F.3d 1343 (Fed. Cir. Nov. 16, 2018, amended Nov. 20, 2018).....	14
Life Sciences Claims	16
Unpatentable	16
<i>Cleveland Clinic Found. v. True Health Diagnostics LLC</i> , No. 2018-1218, 2019 WL 1452697 (Fed. Cir. Apr. 1, 2019)	16
<i>Athena Diagnostics, Inc. v. Mayo Collaborative Servs., LLC</i> , 915 F.3d 743 (Fed. Cir. Feb. 6, 2019), <i>reh’g and reh’g en banc denied</i> , 927 F.3d 1333 (Fed. Cir. July 3, 2019).....	17
Patentable	24
<i>Natural Alternatives Int’l, Inc. v. Creative Compounds, LLC</i> , 918 F.3d 1338 (Fed. Cir. Mar. 15, 2019)	24
<i>Endo Pharms. Inc. v. Teva Pharms. USA, Inc.</i> , 919 F.3d 1347 (Fed. Cir. Mar. 28, 2019)	26
Printed Matter.....	27
<i>In re Guldenaar Holding B.V.</i> , 911 F.3d 1157 (Fed. Cir. Dec. 28, 2018).....	27

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DISCLOSURE	29
Definiteness	29
<i>HZNP Medicines LLC v. Actavis Labs. UT, Inc.</i> , No. 2017-2149, 2019 WL 5076226 (Fed. Cir. Oct. 10, 2019).....	29
Enablement and Written Description	30
<i>Enzo Life Scis., Inc. v. Roche Molecular Sys.</i> , 928 F.3d 1340 (Fed. Cir. July 5, 2019)	30
<i>Nuvo Pharms. (Ireland) Designated Activity Co. v. Dr. Reddy’s Labs. Inc.</i> , 923 F.3d 1368 (Fed. Cir. May 15, 2019)	31
<i>Centrak, Inc. v. Sonitor Techs., Inc.</i> , 915 F.3d 1360 (Fed. Cir. Feb. 14, 2019).....	32
SECTION 102	34
On-Sale Bar	34
<i>Barry v. Medtronic, Inc.</i> , 914 F.3d 1310 (Fed. Cir. Jan. 24, 2019)	34
<i>Helsinn Healthcare S.A. v. Teva Pharms. USA, Inc.</i> , 139 S.Ct. 628 (Jan. 22, 2019). 36	
OBVIOUSNESS	38
<i>OSI Pharm., LLC v. Apotex Inc.</i> , 939 F.3d 1375 (Fed. Cir. Oct. 4, 2019).....	38
<i>Endo Pharms. Inc. v. Actavis LLC</i> , 922 F.3d 1365 (Fed. Cir. May 3, 2019).....	39
<i>Grunenthal GMBH v. Alkem Labs. Lmtd.</i> , 919 F.3d 1333 (Fed. Cir. Mar. 28, 2019) 40	
Secondary Considerations.....	42
<i>Forest Labs., LLC v. SigmaPharm Labs., LLC</i> , 918 F.3d 928 (Fed. Cir. Mar. 14, 2019)	42
<i>Realtime Data, LLC v. Iancu</i> , 912 F.3d 1368 (Fed. Cir. Jan. 10, 2019).....	44
Obviousness-Type Double Patenting	45
<i>Novartis Pharms. Corp. v. Breckenridge Pharm. Inc.</i> , 909 F.3d 1355 (Fed. Cir. Dec. 7, 2018)	45
<i>Novartis AG v. Ezra Ventures LLC</i> , 909 F.3d 1367 (Fed. Cir. Dec. 7, 2018)	46
CLAIM CONSTRUCTION	48
<i>MTD Prod. Inc. v. Iancu</i> , 933 F.3d 1336 (Fed. Cir. August 12, 2019).....	48
<i>Ajinomoto Co. v. ITC</i> , 932 F.3d 1342 (Fed. Cir. August 6, 2019).....	49
<i>Sony Corp. v. Iancu</i> , 924 F.3d 1235 (Fed. Cir. May 22, 2019)	50
<i>BTG Int’l Ltd. v. Amneal Pharms. LLC</i> , 923 F.3d 1063 (Fed. Cir. May 14, 2019)....	50
<i>Amgen Inc. v. Sandoz Inc.</i> , 923 F.3d 1023 (Fed. Cir. May 8, 2019).....	51
<i>Du Pont v. Unifrax I LLC</i> , No. 2017-2575, 2019 WL 1646491 (Fed. Cir. Apr. 17, 2019)	52
<i>Continental Circuits LLC v. Intel Corp.</i> , 915 F.3d 788 (Fed. Cir. Feb. 8, 2019)	54

INFRINGEMENT	56
Joint Infringement	56
<i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 2018-1309, 2019 WL 1510676 (Fed. Cir. Apr. 8, 2019)	56
Doctrine of Equivalents	57
<i>Eli Lilly & Co. v. Hospira, Inc.</i> , 2019 WL 3756065, at *1 (Fed. Cir. Aug. 9, 2019) .	57
<i>Amgen Inc. v. Coherus Biosciences Inc.</i> , 931 F.3d 1154 (Fed. Cir. July 29, 2019) ...	58
DEFENSES	60
Assignor Estoppel	60
<i>Arista Networks, Inc. v. Cisco Sys., Inc.</i> , 908 F.3d 792 (Fed. Cir. Nov. 9, 2018).	60
Claim and Issue Preclusion	61
<i>CFL Techs. LLC v. Osram Sylvania, Inc.</i> , No. 1:18-cv-01445-RGA, 2019 WL 2995815, at *1 (D. Del. July 9, 2019).....	61
REMEDIES	63
Damages	63
<i>Omega Patents, LLC v. CalAmp Corp.</i> , No. 2018-1309, 2019 WL 1510676 (Fed. Cir. Apr. 8, 2019)	63
<i>Enplas Display Device Corp. v. Seoul Semiconductor Co.</i> , 909 F.3d 398 (Fed. Cir. Nov. 19, 2018)	63
<i>WesternGeco LLC v. Ion Geophysical Corp.</i> , 913 F.3d 1067 (Fed. Cir. Jan. 11, 2019)	65
Attorneys Fees	67
<i>NantKwest, Inc. v. Iancu</i> , 898 F.3d 1177 (Fed. Cir. July 27, 2018) (en banc)	67
PRACTICE AND PROCEDURE	69
Personal Jurisdiction	69
<i>Jack Henry & Assocs. v. Plano Encryption Techs. LLC</i> , 910 F.3d 1199 (Fed. Cir. Dec. 7, 2018).....	69
Forum Selection / Governing Law Clauses in License Agreements	70
<i>Dodocase VR, Inc. v. MerchSource, LLC</i> , No. 2018-1724, 2019 WL 1758481 (Fed. Cir. Apr. 18, 2019).....	70
Venue	71
<i>Westech Aerosol Corp. v. 3M Co.</i> , 927 F.3d 1378 (Fed. Cir. July 5, 2019)	71
<i>In re Google Inc.</i> , No. 2018-152, 2018 WL 5536478 (Fed. Cir. Oct. 29, 2018), <i>reh’g denied</i> , <i>In re Google Inc.</i> , 914 F.3d 1377 (Fed. Cir. Feb. 5, 2019)	72

Unreasonable Delay and Patent Term Adjustment.....	74
<i>Supernus Pharms., Inc. v. Iancu</i> , 913 F.3d 1351 (Fed. Cir. Jan. 23, 2019).....	74
 PATENT TRIAL AND APPEAL BOARD.....	76
Inter Partes Review Procedure.....	76
<i>BioDelivery Sciences International, Inc. v. Aquestive Therapeutics, Inc.</i> , 935 F.3d 1362 (Fed. Cir. August 29, 2019)	76
<i>Celgene Corp. v. Peter</i> , 931 F.3d 1342 (Fed. Cir. July 30, 2019)	77
<i>DexMedia Inc. v. Click-to-Call Techs., LP</i> , 139 S.Ct. 2742 (June 24, 2019).....	78
<i>Return Mail, Inc. v. U.S. Postal Service</i> , 139 S. Ct. 1853, 1867-68 (U.S. June 10, 2019).	78
 DESIGN PATENTS.....	79
Design Patent Exhaustion.....	79
<i>Automotive Body Parts Ass’n v. Ford Global Techs., LLC</i> , 930 F.3d 1314 (Fed. Cir. July 23, 2019).....	79
<i>MyMail, Ltd. v. ooVoo, LLC</i> , 934 F.3d 1373 (Fed. Cir. August 16, 2019).....	Error!
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PATENTABLE SUBJECT MATTER

Mechanical Inventions

Am. Axle & Mfg., Inc. v. Neapco Holdings LLC, 939 F.3d 1355 (Fed. Cir. October 3, 2019)

In this appeal from the District of Delaware, the Federal Circuit (Judges Dyk and Taranto) affirmed the claims for propeller shaft vibration attenuation liners were patent ineligible for being directed towards Hooke’s law, a law of physics concerning elasticity, without an inventive concept.⁴ Judge Moore dissented.

American Axle & Manufacturing’s (“AMM”) ‘911 patent involved a “method for manufacturing driveline propeller shafts (‘propshafts’) with liners designed to attenuate vibrations through a shaft assembly.”⁵ Propshafts in operation generate noise through three different modes of vibration at different frequencies.⁶ Prior art used liners or weights to dampen individual modes of vibration.⁷ The ‘911 patent claims included an instruction to “tune” a liner to dampen two modes of vibration at once.⁸ The district court found the claims were essentially just a direction to apply Hooke’s Law, a law of physics describing an object’s elasticity and vibration frequency, and did not provide a means of crafting the liner or propshaft.⁹ Because the claims were directed toward a law of nature without an inventive concept, the district court held the patent invalid.¹⁰

The Federal Circuit affirmed. At step one of the *Alice* test, the court found the claims were directed towards a law of nature.¹¹ While the method of actually tuning the liner for the desired result may have been more complex than merely applying Hooke’s law, such a method was not claimed in the patent.¹² Essentially, the claim’s instruction was to perform “an ad hoc trial-and-error process of changing the characteristics until a desired result is achieved” using known laws of physics.¹³ Since the claim involved applying natural laws, it failed step one of *Alice*.¹⁴ At step 2 of the *Alice* test, the court found no inventive concept because the steps cited in the claims were either conventional or prior art.¹⁵ The court declined to separately consider the dependent claims because AAM did not argue the dependent claims would change the eligibility analysis and thus waived the argument.¹⁶

⁴ *Am. Axle & Mfg., Inc. v. Neapco Holdings LLC*, 939 F.3d 1355 (Fed. Cir. 2019).

⁵ *Id.* at 1358 (internal quotations and alterations omitted) (quoting U.S. Patent No. 7,774,911).

⁶ *Id.*

⁷ *Id.*

⁸ *Id.* at 1359.

⁹ *Id.* at 1360.

¹⁰ *Id.*

¹¹ *Id.* at 1368.

¹² *Id.* at 1364.

¹³ *Id.*

¹⁴ *Id.* at 1367.

¹⁵ *Id.* at 1368.

¹⁶ *Id.* (citing *Affinity Labs*, 838 F.3d at 1256 n.1).

Judge Moore dissented. At step one of *Alice*, she would have held the claims not directed at a law of nature because the independent claims involved more than just applying Hooke’s law and the dependent claims limited “the physical characteristics of the liners to be used and their positioning within the drive shaft.”¹⁷ At step two of *Alice*, she would have held the claims contained “many” inventive concepts that at least should have been tried as questions of fact.¹⁸ In particular, she found persuasive AAM’s assertion that liners had not previously been used to attenuate “bending mode” vibrations in propshafts.¹⁹ Further, she believed the majority’s issue with the claims were really with enablement, not eligibility, and thus improperly ruled the patent ineligible under § 101.²⁰

***Chamberlain Grp., Inc. v. Techtronic Indus. Co.*, 935 F.3d 1341 (Fed. Cir. August 21, 2019)**

In this appeal from the Northern District of Illinois, the Federal Circuit (Judges Lourie, O’Malley, and Chen) reversed a decision of patent eligibility, holding claims for a moveable barrier operator that wirelessly communicated its status was directed to the abstract idea of wireless communication without an inventive concept.²¹

Chamberlain Group’s (“CG”) ‘275 patent involved an apparatus and method for wirelessly communicating status information of moveable barriers, such as garage doors.²² The district court held found claims were directed towards wireless, status-transmitting garage door openers, not just the abstract idea of data transmission.²³ Further, the court found the invention was an improvement over the data transmitting process in the prior art.²⁴

The Federal Circuit reversed.²⁵ At step one of the *Alice* test, the court found the only difference in the claimed moveable barrier operator from the prior art was that it communicated status information wirelessly.²⁶ Thus, the claim was directed to “wirelessly communicating status information about a system.”²⁷ Having already found similar claims to be abstract ideas in past cases, the court held the “broad concept of communicating information wirelessly, without more, is an abstract idea.”²⁸

At step two, the court found no inventive concept in the patent.²⁹ The invention included “conventional components, all recited in a generic way.”³⁰ While the prior art

¹⁷ *Id.* at 1369 (quoting Appellant’s Reply Brief).

¹⁸ *Id.* at 1370.

¹⁹ *Id.* at 1371.

²⁰ *Id.* at 1374-75.

²¹ *Chamberlain Grp., Inc. v. Techtronic Indus. Co.*, 935 F.3d 1341, 1342 (Fed. Cir. 2019).

²² *Id.* at 1345 (citing U.S. Patent No. 7,224,275).

²³ *Id.*

²⁴ *Id.* at 1345-46.

²⁵ *Id.* at 1342.

²⁶ *Id.* at 1346.

²⁷ *Id.*

²⁸ *Id.* at 1347 (citing *Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1258 (Fed. Cir. 2016); *Affinity Labs of Texas, LLC v. Amazon.com Inc.*, 838 F.3d 1266 (Fed. Cir. 2016))

²⁹ *Id.* at 1349.

³⁰ *Id.* at 1348.

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