Kluwer Patent Blog

Fordham Conference 2015 – US Patent Law Developments

Daniel Byrne (Bristows) · Wednesday, April 8th, 2015

Dimitrios T Drivas (White & Case) gave the speedy run down on the following points and cases, which some might find useful for following up on points of interest:

Supreme Court

The decision that in exceptional cases reasonable attorney's fees may be paid to the prevailing party (an exception to the rule that each party bears its own costs in the USA). The exception was interpreted to mean some sort of 'bad faith' by the Federal Circuit overturning the District Court decision. The Supreme Court found that the District Court's decision should be given due deference.

'Indefiniteness' has gone from 'insoluble ambiguity' to 'fails to inform with reasonable certainty'.

Induced infringement (*Limelight v Akamai*) was said to not require a single act and this was appealed. The Supreme Court reversed the decision and remanded it to the Federal Circuit.

Patentable subject matter (*Alice Corp v CLS Bank Int'l*): whether claims to an abstract idea is patentable.

Appellate deference to claim construction (*Teva v Sandoz*): claim construction is a legal question which is reviewed *de novo* but must take into account the findings of the lower court.

Defence to induced infringement (*Commil v Cisco*): comes into play if the patent is found valid. If the defendant believed the patent to be invalid is that a defence to the inducement claim? It remains to be seen.

Royalties post-patent expiry (*Kimble v Marvel*): is it still justified to have the rule that royalties be payable after the patent expires or is void?

Federal Circuit

The imported device itself is not infringing at the point it is imported (*Suprema v ITC*).

Laches not applicable to copyright due to the 3 years statue of limitations, in the patent case there is a restriction on damages but no statue of limitations so should laches be available (*SCA Hygiene v First Quality Baby Products*)?

Obviousness in view of unexpected results (*Bristol Myers Squibb v T*eva). That was not sufficient because it was not known at the time of the invention.

Joinder of parties (*STC v Intel*). Only one of the co-owners brought the suit. The court has the power to join other parties, but does a co-owner have the right not to assert the patent. Yes, that is a substantive right and overcomes the procedural point on an indispensible party. Denied certiorari and therefore this ruling stands.

Effect of claim amendments (*Vederi v Google*): construction of 'substantially elevations', what does 'substantially' mean? The specification is relevant but should the fact of the amendment be presumed to be narrowing?

Obviousness – double patenting (*Gilead Sciences Inc. v Natco Pharma Ltd*), term restricted.

Doctrine of Equivalents (*Cadence v Exela*). Construction of claim that active ingredient be dissolved before deoxygenation. Even though the relevant step occurred afterwards in the equivalent, this was acceptable.

This entry was posted on Wednesday, April 8th, 2015 at 5:49 pm and is filed under Enforcement, literally fulfil all features of the claim. The purpose of the doctrine is to prevent an infringer from stealing the benefit of an invention by changing minor or insubstantial details while retaining the same functionality. Internationally, the criteria for determining equivalents vary. For example, German courts apply a three-step test known as Schneidmesser's questions. In the UK, the equivalence doctrine was most recently discussed in Eli Lilly v Actavis UK in July 2017. In the US, the function-way-result test is used.">Equivalents, Exceptions to patentability, Extent of Protection, Industrial application, Inventive step, Scope of protection, United States of America
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