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Board should not issue inconsistent conclusions even if that means entering a new ground of rejection.

Federal Circuit concludes that the Southern District of California erred when it (1) found that the patentee's preliminary infringement contentions were defective under the court's Patent Local Rule 3.1; (2) ordered that the patentee may supplement its contentions, but on the condition that the patentee concurrently pay the defendants' attorneys' fees and costs associated with the defendants' motion for summary judgment; and (3) when the patentee objected, granted summary judgment of non-infringement.

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“When, as here, a claim issues that omits a material limitation, and such omission is not evident on the face of the patent, the patentee cannot assert that claim until it has been corrected by the PTO.”

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As a matter of first impression—to the extent not answered in Ethicon—“this court holds that the right of a patent co-owner to impede an infringement suit brought by another co-owner is a substantive right that trumps the procedural rule for involuntary joinder under Rule 19(a).”

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Declaratory Judgment Act is not an independent basis for subject matter jurisdiction: district court lacks declaratory judgment jurisdiction in ownership dispute where complaint does not allege a justiciable issue of inventorship.

§ 12:30 In re Teles AG Informationstechnologien.......................355
After statutory amendments in 1999, section 145 civil actions are not available to patent owners to challenge adverse ex parte reexamination decisions.

§ 12:31 Tempo Lighting, Inc. v. Tivoli, LLC .................................357
Board erred by failing to consider requester’s arguments because the requester had not filed a cross-appeal.
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§ 12:32 In re Toyota Motor Corp. ....................................................... 358
District court errs in denying motion to transfer venue when none of the factors weigh in favor of transferor district.

§ 12:33 Vaillancourt v. Becton Dickinson & Co. ............................. 360
The patent owner, not the patent owner's delegate, has authority to appeal to the Federal Circuit from an adverse decision in an inter partes reexamination.

§ 12:34 Versata Software, Inc. v. Callidus Software, Inc. ............... 361
District court erred in failing to grant a stay pending CBM review: “Stays can be warranted even when a CBM proceeding does not address all asserted patents, claims, or invalidity defenses.”

§ 12:35 VirtualAgility Inc. v. Salesforce.com, Inc. ......................... 364
District court errs as a matter of law in deciding to “review” PTAB’s determination in granting a petition for post-grant review that claims are more likely than not invalid. Proper time for measuring the stage of litigation is the filing date of the motion to stay.

Chapter 13 Appellate Court Jurisdiction and Practice ......................................................... 369

§ 13:1 Aqua Shield v. Inter Pool Cover Team ............................... 369
District court may consider an infringer’s actual profits, but errs in treating actual profits as a royalty cap. That incorrectly replaces the hypothetical inquiry into what the parties would have anticipated, looking forward when negotiating, with a backward-looking inquiry into what turned out to have happened.

§ 13:2 Aqua Shield v. Inter Pool Cover Team ............................... 371
“In a later willfulness determination, the significance of a preliminary-injunction denial depends on why the preliminary injunction was denied.”

The Federal Circuit can exercise jurisdiction under section 1292(c)(1) if the district court has modified the injunction,
but not if the district court has simply interpreted the injunction, and has not otherwise entered a final appealable judgment.

Federal Circuit declines to adopt rule exempting non-practicing entities from receiving prejudgment interest.

§ 13:5 Ericsson, Inc. v. D-Link Systems, Inc. ..............................374
The Federal Circuit explains the two parts to the EMVR and the use of expert testimony.

District court erred by instructing jury on multiple Georgia-Pacific factors that, under the facts of the case, which included RAND obligations, were not relevant or misleading, including at least factors 4, 5, 8, 9 and 10.

§ 13:7 Ericsson, Inc. v. D-Link Systems, Inc. ..............................381
The Federal Circuit sets out the Apportionment Analysis for Standard Essential Patents (SEPs), and related jury instructions.

§ 13:8 Halo Electronics, Inc. v. Pulse Electronics, Inc. .................383
Two judges call for en banc review of the willfulness analysis in light of Octane Fitness and Highmark.

Federal Circuit concludes it has appellate jurisdiction over contract claim under four-part test of Gunn v. Minton.

§ 13:10 Krauser v. BioHorizons, Inc. ...........................................386
Although original transfer from the Eleventh Circuit would normally constitute the “law of the case” per Christianson v. Colt Industries Operating Corp., and would counsel against “re-transferring” the case back to the Eleventh Circuit, Federal Circuit holds that there was no “plausible” basis for Federal Circuit jurisdiction, and re-transferred the case back to the Eleventh Circuit.
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§ 13:11  *In re Nokia Inc.* ................................................................. 389

Writ of mandamus is not available to compel compliance with mandate that did not specify the desired relief.


If a party appeals only infringement and validity issues, and does not appeal—or request remand of—damages issues if infringement and/or validity issues are resolved in its favor, mandate rule may preclude later changes to the award of damages even if the basis for the damages award has changed.

§ 13:13  SSL Services, LLC v. Citrix Systems, Inc. ....................... 391

District court does not err in excluding evidence of ongoing reexaminations in connection with reasonableness of asserted defenses. Succeeding on some defenses does not necessarily avoid a finding of willfulness.

§ 13:14  SSL Services, LLC v. Citrix Systems, Inc. ....................... 393

“To be the ‘prevailing party,’ we require: (1) that the party ‘received at least some relief on the merits,’ and (2) ‘[t]hat relief must materially alter the legal relationship between the parties by modifying one party’s behavior in a way that “directly benefits” the opposing party.’ . . . A party does not need to prevail on all claims to qualify as the prevailing party.”

§ 13:15  State of Vermont v. MPHJ Technology Investments, LLC ............................. 394

Under 28 U.S.C. § 1447(d), “An order remanding a case to the State court from which it was removed is not reviewable on appeal or otherwise[.]”—such an order is not reviewable if based on the grounds specified in section 1447(c).

§ 13:16  Stryker Corp. v. Zimmer, Inc............................................ 396

Objective recklessness, even though “predicated on underlying mixed questions of law and fact, is best decided by the judge as a question of law subject to de novo review.” Objective recklessness will not be found where the accused infringer’s “position is susceptible to a reasonable conclusion of no infringement.” District court errs when it fails to undertake an objective assessment of the defendant’s defenses.
§ 13:17 Troy v. Samson Manufacturing Corp. ..............................397

Holding in Kappos v. Hyatt that “there are no limitations on a patent applicant’s ability to introduce new evidence in a § 145 proceeding beyond those already present in the Federal Rules of Evidence and the Federal Rules of Civil Procedure,” applies to section 146 actions as well. The Supreme Court’s decision in Hyatt also permits new evidence to be admitted without regard to whether the issue was raised before the board; prior Federal Circuit precedent to the contrary is no longer “viable.”

§ 13:18 VirnetX, Inc. v. Cisco Systems, Inc...................................399

Relying on the “smallest salable unit” is not enough: “Where the smallest salable unit is, in fact, a multi-component product containing several non-infringing features with no relation to the patented feature . . ., the patentee must do more to estimate what portion of the value of that product is attributable to the patented technology.” Court rejects “Nash Bargaining Solution” as a model for reasonable royalty damages without sufficiently establishing that the premises of the theorem actually apply to the facts of the case.

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§ 14:1 Endo Pharmaceuticals, Inc. v. Actavis, Inc. .....................403

License to identified patents that also includes “continuation, continuation-in-part and divisional patent applications that claim priority to” the identified patents does not cover other patents claiming priority to earlier common provisional application.

§ 14:2 General Electric Co. v. Wilkins ...............................408

Asserted inventor’s testimony was not credible given substantial payments made by company challenging patent, and witness’s evasive testimony; overall, no clear and convincing evidence of co-inventorship.
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§ 15:1  MRC Innovations, Inc. v. Hunter Manufacturing, LLP  415

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§ 15:2  Pacific Coast Marine Windshields Ltd. v. Malibu Boats, LLC ........................................................ 421

*Principles of prosecution history estoppel apply to design patents. Responding to a restriction requirement in a design application by cancelling drawing figures to non-elected embodiments constitutes an amendment to secure a patent.*

## Chapter 16  Miscellaneous ............................................................ 427

§ 16:1  Align Technology, Inc. v. U.S. International Trade Comm'n  427

*Although the commission has power to waive or amend its rules, until it does so, the commission is required to follow its own rules.*

§ 16:2  Antares Pharma, Inc. v. medac Pharma Inc  430

*Federal Circuit concludes that claims in reissue patent fail to meet the original patent requirement. Federal Circuit concludes that “for § 251, 'it is not enough that an invention might have been claimed in the original patent because it was suggested or indicated in the specification.' . . . Rather, the specification must clearly and unequivocally disclose the newly claimed invention as a separate invention.”*

§ 16:3  Fleming v. Escort Inc  433

*That an applicant wrote an application from the position of a programmer does not preclude asserting error based on failure to appreciate the full scope of the invention.*

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