# Top Ten Patent Cases

## October 24, 2014

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### About the List – Rankings:
Cases where certiorari has been granted are ranked according to potential impact on patents. Rankings at the petition stage are based upon a blend focusing mainly on the likelihood of grant but also considering the impact of the case. Where certiorari has already been granted, then the main ranking criterion is importance of the outcome as to a potential change in the law. Case rankings for the numbered Top Ten cases are made under this set of criteria. Other cases are not necessarily ranked according to this guideline.

### Authorship:
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“Red”/“Blue” Dates to Announce Certiorari Decisions: The Court notes grants and denials of certiorari as part of an electronic Orders List at 9:30 AM the date of the first session (“red” or “blue”) following the Conference considering the case, except that early in the Term a grant may be issued as part of an earlier, special Orders List.
(1) **Teva v. Sandoz – Deference (Lighting Ballast)**


**Status:** Awaiting decision before the end of the Term in June 2015. Decision unlikely until 2015. Argument was held October 15, 2014.

**Question Presented:** “Whether a district court's factual finding in support of its construction of a patent claim term may be reviewed *de novo*, as the Federal Circuit requires (and as the panel explicitly did in this case), or only for clear error, as Rule 52(a) requires.”

(1a) **Teva “Clones”**

**Lighting Ballast, Piggbacking off Teva v. Sandoz:** *Lighting Ballast Control LLC v. Universal Lighting Technologies, Inc.*. Supreme Court No. 13-1536, is the styling of the petition from review of the *en banc* decision of the Federal Circuit *Lighting Ballast Control LLC v. Philips Electronics North America Corp.*, 744 F.3d 1272 (Fed. Cir. 2014)(en banc), that – under a theory of *stare decisis* – reaffirms the continued validity of appellate *de novo* claim construction under *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448 (Fed. Cir. 1998) (en banc).

**Status:** The case is apparently being held for a *certiorari* vote until after a merits decision in Top Ten No. (1) *Teva v. Sandoz.* (*Lighting Ballast* was scheduled for Conference on September 29, 2014, but no decision was reached.)
Beyond *Lighting Ballast* there are three further petitions that “piggyback” off *Teva v. Sandoz* as raising the identical issue of appellate claim construction deference:

*Gevo, Inc v. Butamax Advanced Biofuels LLC*, Supreme Court No. 13-1286 (distributed for Conference of June 26, 2014, without any further action) (“This Court recently granted the petition for writ of certiorari filed by Teva Pharmaceuticals USA, Inc. raising the same question presented as the Federal Circuit's decision in this case.”)

*Shire Development, LLC v. Watson Pharmaceuticals, Inc.*, Supreme Court No. No. 14-206 (distributed for Conference of October 31, 2014)(“This Court has already granted certiorari in the Teva Pharmaceuticals USA case, which presents the same question to the Court. The Court, therefore, may wish to hold this petition pending a decision by the Court in Teva.”).

*Takeda Pharmaceutical Co. Ltd v. Zydus Pharmaceuticals USA, Inc.*, Supreme Court No. 14-217 (Conference not yet set)(“This case presents a question identical to the one the Court will consider in Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc., No. 13-854: Does the Federal Circuit properly review all aspects of claim construction de novo, or is it bound by Federal Rule of Civil Procedure 52(a)(6) to defer to a district court's resolution of factual issues underlying the interpretation of a patent?”)

*Stryker Corporation v. Hill-Rom Services, Inc.*, Supreme Court No. 14-358 (Petition Response due Oct. 27, 2014)(Because the same question is presented in this petition [and *Teva v. Sandoz*], Stryker requests that the Court hold this petition pending its ruling in *Teva*. If the Court decides that the Federal Circuit must apply a clear-error standard of review for factual findings supporting claim construction, the Court should grant this petition, vacate the Federal Circuit's order, and remand this matter to the Federal Circuit for a claim construction ruling consistent with the Court's decision.”)

(2) *Commil v. Cisco* -- § 271(b) *Scienter*

In *Commil USA, LLC v. Cisco Sys., Inc.* Supreme Court No. 13-896, Petitioner challenges the new Federal Circuit standard of *scienter* for active inducement under 35 USC § 271(b).

**Status:** Awaiting Conference.
A cross-petition has also been filed, infra, as Cisco v. Commil – Jury Trial.”

CVSG Brief Recommends Grant of Certiorari: The Government on invitation of the Court has filed a brief recommending grant of certiorari.

First Question Presented: “Whether the Federal Circuit erred in holding that a defendant’s belief that a patent is invalid is a defense to induced infringement under 35 U.S.C. § 271(b).”


(3) Halo v. Pulse – Seagate Willfulness

In Halo Elecs., Inc. v. Pulse Eng’g, Inc., ___ F.3d ___ (Fed. Cir. 2014) (O’Malley, J., concurring), two members of the panel urge the Federal Circuit to reconsider en banc standards of willfulness.

Status: A petition for rehearing en banc is expected; the panel opinion was issued October 21, 2012.

Discussion: The two members of the panel “urge[ ] the full court to reevaluate our willfulness jurisprudence in light of the Supreme Court’s decisions in Highmark [Inc. v. Allcare Health Management Systems, Inc., 134 S.Ct. 1744 (2014)] and

The concurrence specifically points to inconsistency between both Bard Peripheral Vascular, Inc. v. W.L. Gore & Assocs., Inc., 682 F.3d 1003 (2012), and In re Seagate Technology, LLC, 497 F.3d 1360 (Fed. Cir. 2007)(en banc), and the Supreme Court opinions in Highmark and Octane Fitness.

(4) WildTangent – § 101 Patent-Eligibility

In WildTangent, Inc. v. Ultramercial, LLC, Supreme Court No. 13-255, the Court granted certiorari, vacated the decision below and remanded to the Federal Circuit for further consideration in light of Alice Corporation Pty. Ltd. v. CLS Bank International, 134 S. Ct. 2347 (2014).


Status: The GVR was issued June 30, 2014.

A Partially New Panel: The case is expected to be heard by a panel of Lourie, O’Malley, JJ., and a third judge to be added to the panel. (The original panel included Rader, C.J., who has resigned his commission effective June 30, 2014).

Mode of Proceeding: The panel has the option to simply consider the case anew (which would be consistent with the GVR) but also may first issue an order for additional briefing to address the impact of Alice v. CLS Bank on this case

(5) Biosig v. Nautilus – § 112(b) Indefiniteness

**Status:** Federal Circuit argument October 29, 2014, on remand from Supreme Court, presumably before the same panel as in 2013 before reaching the Supreme Court [Newman, J., Schall, J. (concurring opinion), Wallach, J. (majority opinion)].

**Discussion:** The Supreme Court stated – “According to the Federal Circuit, a patent claim passes the §112, ¶2 threshold so long as the claim is ‘amenable to construction,’ and the claim, as construed, is not ‘insolubly ambiguous.’ 715 F. 3d 891, 898–99 (2013). We conclude that the Federal Circuit’s formulation, which tolerates some ambiguous claims but not others, does not satisfy the statute’s definiteness requirement. In place of the ‘insolubly ambiguous’ standard, we hold that a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” (emphasis added to show the holding).

**Guidance from Interval Licensing:** The panel in BioSig does not write with an empty slate. In *Interval Licensing LLC v. AOL, Inc.*, ___ F.3d ___ (Fed. Cir. 2014)(Chen, J.), as part of an affirmance of an invalidity holding in an inter partes Patent Office decision, a panel interpreted the standard of claim definiteness under what has become 35 USC § 112(b) in the wake of the Supreme Court *Nautilus* decision. The Court states that “[t]he claims, when read in light of the specification and the prosecution history, must provide objective boundaries for those skilled in the art.” In support of this position, the panel cites to and quotes from *Nautilus* as “indicating that there is an indefiniteness problem if the claim language ‘might mean several things and if ‘no informed and confident choice is available among the contending definitions[,]’”(citation omitted).

**6) Perez v. Mortgage Bankers – Interpretative Rules**

In the concurrently granted petitions from the D.C. Circuit in *Perez v. Mortgage Bankers Assoc.*, Supreme Court No. 13-1041, and *Nickols v. Mortgage Bankers Assoc.*, Supreme Court No. 13-1052, consolidated for oral argument, the question is asked whether an Agency can issue an interpretative rule without notice-and-comment rulemaking. The Federal Circuit takes the position that notice-and-commenting is not required for Patent Office interpretative rules.
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**Status:** Certiorari was granted in both cases on January 16, 2014. The cases will be briefed over the summer; oral argument is expected in Fall 2014 with a decision before the end of the Term running through the end of June 2015.

**Perez Question Presented:** “The Administrative Procedure Act (APA), 5 U.S.C. 551 et seq., generally provides that ‘notice of proposed rule making shall be published in the Federal Register,’ 5 U.S.C. 553(b), and, if such notice is required, the rulemaking agency must give interested persons an opportunity to submit written comments, 5 U.S.C. 553(c). The APA further provides that its notice-and-comment requirement ‘does not apply *** to interpretative rules,’ unless notice is otherwise required by statute. 5 U.S.C. 553(b)(A). *** The question presented is:

“Whether a federal agency must engage in notice-and-comment rulemaking before it can significantly alter an interpretive rule that articulates an interpretation of an agency regulation.”

**Nickols Question Presented:** “The Administrative Procedure Act, 5 U.S.C. §§ 551–59, ‘established the maximum procedural requirements which Congress was willing to have the courts impose upon agencies in conducting rulemaking procedures.’ Vt. Yankee Nuclear Power Corp. v. Natural Res. Def. Council, Inc., 435 U.S.519, 524 (1978). Section 553 of the Act sets forth notice-and-comment rulemaking procedures, but exempts ‘interpretative rules,’ among others, from the notice-and-comment requirement. 5 U.S.C. § 553(b). The D.C. Circuit, in a line of cases descending from Paralyzed Veterans of America v.D.C. Arena L.P., 117 F.3d 579 (D.C. Cir. 1997), has created a per se rule holding that although an agency may issue an initial interpretive rule without going through notice and comment, ‘[o]nce an agency gives its regulation an interpretation, it can only change that interpretation as it would formally modify the regulation itself: through the process of notice and comment rulemaking.’ Id. at 586. In this case, the D.C. Circuit invoked the Paralyzed Veterans doctrine—which is contrary to the plain text of the Act, numerous decisions of this Court, and the opinions of the majority of circuit courts—to invalidate a Department of Labor interpretation concluding that mortgage loan officers do not qualify for the administrative exemption under the Fair Labor Standards Act. “The question presented is:

“Whether agencies subject to the Administrative Procedure Act are categorically prohibited from revising their interpretative rules unless such revisions are made through notice-and-comment rulemaking.”


Earlier, the Court explained its position on interpretative rules in Cooper Technologies:

“By its own terms, section 553[, 5 USC § 553,] does not require formal notice of proposed rulemaking for ‘interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice.’ Id. § 553(b)(3)(A); see also id. § 553(d)(2) (exempting ‘interpretive rules and statements of policy’ from publication more than thirty days before its effective date). The Patent Office's interpretation of ‘original application’ was therefore not subject to the formal notice-and-comment requirements of section 553. See also Animal Legal Def. Fund, 932 F.2d at 931 (remarking that not ‘every action taken by an agency pursuant to statutory authority [is] subject to public notice and comment’ because such a requirement ‘would vitiate the statutory exceptions in § 553(b) itself’ including the exception for interpretive rules). Though not required by section 553, the Patent Office's April 6, 2006 notice of proposed rulemaking expressly described the ‘subjects and issues involved’—namely, the operation of the effective date provision of section 4608. See 65 Fed. Reg. § 553(b)(3 at 18,155, 18,177-78. Moreover, the Patent Office received and acted on comments directly relating to the ‘original application’ statutory language. See 65 Fed. Reg. at 76,763; see also 5 U.S.C.§ 553(c) (requiring that agency ‘give interested persons an
opportunity to participate in the rule making through submission of written data, views, or arguments with or without opportunity for oral presentation’).” *Cooper Technologies*, 536 F.3d at 1336-37.

**Packard v. Lee –§ 112(b) Definiteness**

*Packard v. Lee* is the anticipated petition from *In re Packard*, 751 F.3d 1307 (Fed. Cir. 2014) (*per curiam*), where the panel created a new examination regime for indefiniteness under 35 USC § 112(b).

**Status:** Petition due December 2, 2014.

**Petition for Rehearing En Banc:** “The Panel created and decided this case on the basis of a new agency procedure—a ‘prima facie case’ procedure for indefiniteness. This was error. The Patent Office has not enacted any such procedure, and the Board did not rely on any such procedure in rejecting Mr. Packard’s claims. ‘[A]dministrative agencies’ are ‘free to fashion their own rules of procedure.’ *Vermont Yankee Nuclear Power Corp. v. Natural Res. Def. Council, Inc.*, 435 U.S. 519, 543 (1978).

‘[A] fundamental rule of administrative law. . . [is] that a reviewing court, in dealing with a determination or judgment which an administrative agency alone is authorized to make, must judge the propriety of such action solely by the grounds invoked by the [ ] agency.’ *Sec. & Exch. v. Chenery Corp.*, 332 U.S. 194, 196 (1947).”

**Hana Financial – Jury Question**

In *Hana Financial, Inc. v. Hana Bank & Hana Financial Group*, Supreme Court No. No. 13-1211, opinion below, 735 F.3d 1158 (9th Cir. 2013)(*Callahan, J.*), the Court faces the issue as to whether a jury or the court determines trademark “tacking”. Whatever the Court decides may have an impact on jury vs. court decision in patent areas of the law.

**Status:** Argument December 3, 2014.

**Question Presented:** “To own a trademark, one must be the first to use it; the first to use a mark has ‘priority.’ The trademark ‘tacking’ doctrine permits a party to ‘tack’ the use of an older mark onto a new mark for purposes of determining
priority, allowing one to make slight modifications to a mark over time without losing priority. Trademark tacking is available where the two marks are ‘legal equivalents.’

“The question presented, which has divided the courts of appeals and determined the outcome in this case, is:

“Whether the jury or the court determines whether use of an older mark may be tacked to a newer one?”

Discussion: The Federal Circuit has not addressed the jury vs. court issue of determination of “tacking”, but provides its understanding of the substantive law in this area Van Dyne-Crotty, Inc. v. Wear-Guard Corp., 926 F.2d 1156 (Fed. Cir. 1991)(Michel, J.).

0 Suprema v. ITC: Induced Infringement/ITC

The Federal Circuit has granted two petitions for en banc review raising a total of five different questions for en banc review in Suprema, Inc. v. ITC, __ Fed. App’x __(Fed. Cir. 2014)(unpublished Order), vacating panel opinion, 742 F.3d 1350 (Fed. Cir. 2013)(O’Malley, J.). In a nutshell, does the importation of a noninfringing component of a patented combination provide basis for an ITC exclusion order where there is infringement by customers in the United States who practice the patented combination?

Status: Awaiting argument. (The Order granting rehearing en banc was issued May 13, 2014.)

Panel Majority Denies Relief with only Post-Border Crossing Infringement: The panel majority, following the literal wording of the law, found no ITC liability for the post-border crossing infringement.

The third member of the panel disagreed, presenting unique and bold theories that because the ITC is a trade law, the literal wording of the statute should be disregarded:

“My problem with the majority's opinion is that it ignores that Section 337 is a trade statute designed to provide relief from specific acts of unfair trade, including acts that lead to the importation of articles that will result in harm to a domestic industry by virtue of infringement of a valid and enforceable patent. To negate both a statutory trade remedy and its intended relief, the majority overlooks the Congressional purpose of Section 337, the long established agency practice by the
Commission of conducting unfair trade investigations based on induced patent infringement, and related precedent by this Court confirming this practice. In the end, the majority has created a fissure in the dam of the U.S. border through which circumvention of Section 337 will ensue, thereby harming holders of U.S. patents.” *Suprema, Inc. v. ITC*, 742 F.3d at 1372 (Reyna, J., dissenting-in-part)

**Plain Wording of the Statute vs. the “Trade Law” Intent of the Statute:** The dissenting member’s “problem with the majority's opinion is that it ignores that Section 337 is a trade statute designed to provide relief from specific acts of unfair trade….” *Suprema, Inc. v. ITC*, 742 F.3d at 1372 (Reyna, J., dissenting-in-part)(more fully quoted above). But, based upon the wording of the statute, the panel majority in *Suprema* “hold[s] that an exclusion order based on a violation of § 1337(a)(1)(B)(i) may not be predicated on a theory of induced infringement where no direct infringement occurs until post-importation.” *Suprema*, 742 F.3d at 1353. The holding is keyed to the wording of the statute that a patent-based exclusion order must be based upon importation of articles that… infringe a valid and enforceable United States patent. § 1337(a)(1)(B)(i)” The importation into the United States of articles that… infringe a valid and enforceable United States patent.” Thus, the articles must be an infringement of the patent.

The third member of the panel jumps over the literal wording of the statute to look to the point that the ITC statute is a “trade law”: The jurist explains that “[his] problem with the majority's opinion is that it ignores that Section 337 is a trade statute designed to provide relief from specific acts of unfair trade, including acts that lead to the importation of articles that will result in harm to a domestic industry by virtue of infringement of a valid and enforceable patent. To negate both a statutory trade remedy and its intended relief, the majority overlooks the Congressional purpose of Section 337, the long established agency practice by the Commission of conducting unfair trade investigations based on induced patent infringement, and related precedent by this Court confirming this practice. In the end, the majority has created a fissure in the dam of the U.S. border through which circumvention of Section 337 will ensue, thereby harming holders of U.S. patents.” *Suprema, Inc. v. ITC*, 742 F.3d at 1372 (Reyna, J., dissenting-in-part)(emphasis added).
The crux of this case, of course, is whether or not the \textit{definition} of the “specific acts of unfair trade” should be interpreted in a manner that is broad enough to go outside the wording of the statutory definition of § 1337(a)(1)(B)(i).

\textit{“The remedy lies with the law making authority, and not with the courts”}: As explained by then-Justice Rehnquist: "Laws enacted with good intention, when put to the test, frequently, and to the surprise of the law maker himself, turn out to be mischievous, absurd or otherwise objectionable. But in such case the remedy lies with the law making authority, and not with the courts." \textit{Griffin v. Oceanic Contractors}, 458 U.S. 564, 575 (1982)(Rehnquist, J.)(quoting \textit{Crooks v. Harrelson}, 282 U.S. 55, 60 (1930)). "Policy considerations cannot override our interpretation of the text and structure of [a statute], except to the extent that they may help to show that adherence to the text and structure would lead to a result so bizarre that Congress could not have intended it." \textit{Chamberlain Group, Inc. v. Skylink Techs., Inc.}, 381 F.3d 1178, 1192 (Fed. Cir. 2004)(quoting \textit{Central Bank, N.A. v. First Interstate Bank, N.A.}, 511 U.S. 164, 188 (1994)).

\textit{A Limelight “Domino”}: The decision fo the Supreme Court in \textit{Limelight} that will take place in the coming weeks will have a domino impact on the Federal Circuit. Perhaps the first domino to fall will be \textit{Suprema}: To the extent that the Supreme Court \textit{affirms} the divided Federal Circuit in \textit{Limelight} (that will be decided even before the briefing period has expired in \textit{Suprema}) there is a stronger chance that the panel majority will be overturned. But, to the extent that the Supreme Court \textit{reverses} in \textit{Limelight} this may provide a strong indicator that the panel majority, here, should be sustained.

\textit{The Five Questions Rasied in Two Petitions for Rehearing En Banc}: Petitions of both the ITC and one of the parties were granted which cumulatively raise five questions:

\textit{(i) The Commission’s Petition} asks four Questions: 1. Did the panel contradict Supreme Court precedent in \textit{[Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd., 545 U.S. 913 (2005),]} and precedents of this Court\textsuperscript{[*]} when it held that infringement under 35 U.S.C. § 271(b) “is untied to an article”?

2. Did the panel contradict Supreme Court precedent in \textit{Grokster} and this Court’s precedent in \textit{Standard Oil} \textit{[Co. v. Nippon Shokubai Kagaku Kogyo Co., 754 F.2d 345 (Fed. Cir. 1985),]} when it held that there can be no liability for induced
infringement under 35 U.S.C. § 271(b) at the time a product is imported because direct infringement does not occur until a later time?

3. When the panel determined the phrase “articles that . . . infringe” in 19 U.S.C. § 1337(a)(1)(B)(i) does not extend to articles that infringe under 35 U.S.C. § 271(b), did the panel err by contradicting decades of precedent[*] and by failing to give required deference to the [ITC] in its interpretation of its own statute?

4. Did the panel misinterpret the Commission’s order as a “ban [on the] importation of articles which may or may not later give rise to direct infringement” when the order was issued to remedy inducement of infringement and when the order permits U.S. Customs and Border Protection to allow importation upon certification that the articles are not covered by the order?

[*] Beyond Grokster and Standard Oil, the ITC cites Crystal Semiconductor Corp. v. TriTech Microelectronics Int’l, Inc., 246 F.3d 1336 (Fed. Cir. 2001); Young Eng’rs, Inc. v. ITC, 721 F.2d 1305 (Fed. Cir. 1983); Vizio, Inc. v. ITC, 605 F.3d 1330 (Fed. Cir. 2010); and Enercon GmbH v. Int’l Trade Comm’n, 151 F.3d 1376 (Fed. Cir. 1998).

(ii) The Cross Match Petition asks “[w]hether the [ITC] has authority to find a Section 337 violation …where it finds that an importer actively induced infringement of a patented invention using its imported articles but the direct infringement occurred post-importation.” Cross Match cites Young Engineers and Vizio (also relied upon by the ITC) and Disabled Am. Veterans v. Sec’y of Veterans Affairs, 419 F.3d 1317 (Fed. Cir. 2005).

Professor Dennis Crouch provides a complete set of the petition documents as well as his own commentary. See Dennis Crouch, En Banc Federal Circuit to Review ITC’s Power over Induced Infringement, PATENTLY O (May 15, 2014), available at http://patentlyo.com/patent/2014/05/federal-circuit-infringement.html

(10) STC.UNM v. Intel: Rule 19

A petition for certiorari is expected following STC.UNM v. Intel Corp., ___ F.3d ___ (Fed. Cir. 2014)(Order)(per curiam), where the Court denied en banc consideration of the panel’s ruling that precludes a patent owner from using Rule 19 to join an indispensable party, effectively denying the right to enforce the patent.

Status: A petition for certiorari is due December 16, 2014.
Discussion: Plural opinions concurring and dissenting from the denial of rehearing en banc were issued, most notably one from the sharpest pen on the Court, _STC.UNM_, __ F.3d at __ (O’Malley, J., dissenting from den. reh'g en banc, joined by Newman, Lourie, Wallach, JJ.).

**Kimble v. Marvel – Post-Expiration Royalties**

In _Kimble v. Marvel Enterprises, Inc._, Supreme Court No. 13-720, _opinion below_, 727 F.3d 856 (9th Cir. 20130 (Callahan, J.), petitioner challenges the rule of _Brulotte v. Thys_ that a patentee’s use of a royalty agreement that projects payments beyond the expiration date of the patent is unlawful _per se_.

**Status:** CVSG Order (June 2, 2014) outstanding.

**Question Presented:** “Petitioners are individuals who assigned a patent and conveyed other intellectual property rights to Respondent. The [Ninth Circuit] ‘reluctantly’ held that Respondent, a large business concern, was absolved of its remaining financial obligations to Petitioners because of ‘a technical detail that both parties regarded as insignificant at the time of the agreement.’ App. 2-3; 23. Specifically, because royalty payments under the parties’ contract extended undiminished beyond the expiration date of the assigned patent, Respondent’s obligation to pay was excused under _Brulotte v. Thys Co._, 379 U.S. 29, 32 (1964), which had held that ‘a patentee’s use of a royalty agreement that projects beyond the expiration date of the patent is unlawful _per se_.’

“A product of a bygone era, _Brulotte_ is the most widely criticized of this Court’s intellectual property and competition law decisions. Three panels of the courts of appeals (including the panel below), the Justice Department, the Federal Trade Commission, and virtually every treatise and article in the field have called on this Court to reconsider _Brulotte_, and to replace its rigid _per se_ prohibition on post-expiration patent royalties with a contextualized rule of reason analysis.

“The question presented is:

“Whether this Court should overrule _Brulotte v. Thys Co._, 379 U.S. 29 (1964).”
**Consumer Watchdog v. WARF – Post-Grant Standing**

In *Consumer Watchdog v. Wisconsin Alumni Research Foundation*, Supreme Court No. 14A162, *proceedings below,*__ F.3d __ (Fed. Cir. 2014)(Rader, J.), the patent challenger may file a petition that challenges the appellate court’s dismissal of its patentability challenge on the basis of lack of standing.

**Status:** The petition is due October 31, 2014 (once extended).

**Discussion:** The PTO in the decision below had denied the public interest patent challenger’s attack in an *inter partes* reexamination. Although the patent challenger had a *procedural* right to appeal to the Federal Circuit, the Court dismissed the appeal on the basis of lack of standing:

“[W]here Congress has accorded a procedural right to a litigant, such as the right to appeal an administrative decision, certain requirements of standing — namely immediacy and redressability, as well as prudential aspects that are not part of Article III—may be relaxed. See *Massachusetts v. E.P.A.*, 549 U.S. 497, 517–18 (2007). However, the ‘requirement of injury in fact is a hard floor of Article III jurisdiction that cannot be removed by statute.’ *Summers v. Earth Island Inst.*, 555 U.S. 488, 497 (2009)]. That injury must be more than a general grievance, *Hollingsworth v. Perry*, 133 S. Ct. 2652, 2661 (2013)], or abstract harm, *City of Los Angeles v. Lyons*, 461 U.S. 95, 101 (1983).”

**Implications for the America Invents Act Post-Grant Proceedings:** The Federal Circuit decision has manifest implications for the Inter Partes Review and Post Grant Review proceedings of the America Invents Act where a patent challenger who loses before the Patent Trial and Appeal Board has a similar *procedural* right to appeal.

**Implications for AIA Post Grant Proceedings:** Post grant proceedings under the *Leahy Smith America Invents Act* – Inter Partes Review and Post Grant Review – permit public interest groups to challenge patents. If the public interest group loses at the PTAB there is a statutory *procedural* right to appeal to the Federal Circuit just as there is for inter partes review that is the subject of the *Consumer Watchdog* case.


**Glenmark – Standing**


**Status:** Petition response due November 10, 2014.

**Question Presented:** “The patent statute states that the ‘patentee’ shall have a remedy for patent infringement (35 U.S.C. § 281), and that an interest in a patent may be assigned by ‘an instrument in writing.’ 35 U.S.C. § 261. Here, the Federal Circuit held that the U.S. distributor of a patented product had standing to recover lost profits damages for infringement on the ground that it was an ‘implied’ exclusive licensee, even though no written or oral agreement conveyed to that entity any interest in the patent in suit.

“...The question presented is whether a distributor of a patented product, to which no interest in the patent has been assigned, has standing to recover damages for infringement.”

**Porauto – Personal Jurisdiction**


**Status:** Awaiting Conference (Petition Response was due Oct. 18, 2014).

**Question Presented:** “This is a specific personal jurisdiction case in which the Respondents, Kabo [et al., the Plaintiffs] alleged a single claim of patent infringement of a wrench design [ ] against Petitioners, Porauto [et al., the Defendants]. Although Plaintiffs and Defendants are both based in Taiwan, where Plaintiffs have maintained a parallel litigation involving the same wrench design, the Federal Circuit refused to intervene and dismiss Defendants from a Nevada Federal District Court lawsuit due to a lack of specific personal jurisdiction. The parties agree that there is no general personal jurisdiction over Defendants.”
Questions Presented: “1. Whether affidavits of counsel cannot provide a sufficient basis to subject Defendants to specific personal jurisdiction in Nevada for a case alleging patent infringement.

“2. Whether the controlling Federal Circuit reasonable factors for determining specific personal jurisdiction in cases alleging patent infringement are limited by the stream of commerce theory set forth by the plurality opinion in Asahi Metal Industry Co., Ltd. v. Superior Court, 480 U.S. 102 (1987).”

StoneEagle – Actual Controversy


“The question presented is:
“Whether the decision below, like other recent Federal Circuit decisions, unduly restricts Declaratory Judgment Act jurisdiction by refusing to consider extrinsic evidence demonstrating an actual controversy – including a defendant's answer and deposition testimony – and instead determining jurisdiction based solely on a hyper-technical reading of the complaint.”
Conte v. Jakks – Nonobviousness


Status: Awaiting Conference.

Questions Presented: “1. Whether the United States Court of Appeals for the Federal Circuit erred in finding that claim 9 failed because it would have been obvious.

“2. Whether the United States Court of Appeals for the Federal Circuit erred in finding that the district court did not abuse its discretion in refusing to permit plaintiffs to amend the complaint to include claim 1 of the [ ] patent.”

Discussion: Whatever merit the petition may or may not have, the Questions Presented hardly present an issue to invite grant of review.

Madstad v. PTO – First to File Constitutionality

In Madstad Eng'g, Inc. v. United States PTO, Supreme Court No. 14-366, opinion below, 756 F.3d 1366 (Fed. Cir. 2014)(O’Malley, J.), Petitioner challenges the Leahy Smith America Invents Act of 2011 as unconstitutional insofar as the first-to-file provision is concerned.

Status: Response due December 1, 2014.

Questions Presented: “1. Whether the Federal Circuit's decision that Petitioners lack standing to challenge the ‘First-Inventor-to-File’ provisions of the America Invents Act [AIA] conflicts with precedent of this Court and decisions in other circuits.

“2. Whether the ‘First-Inventor-to-File’ provisions of the AIA are unconstitutional under the Intellectual Property Clause of Article I, Section 8, Clause 8.”
In *Cisco Sys., Inc. v. Commil USA, LLC*, Supreme Court No. 13-1044, is a conditional cross-petition for grant of review in the event that *certiorari* is granted in *Commil USA, LLC v. Cisco Sys., Inc.* Supreme Court No. 13-896, *opinion below*, 720 F.3d 1361(Fed. Cir. 2013).

In the cross-petition, cross-petitioner asks whether and when the Seventh Amendment permits a court to order a partial retrial of induced patent infringement without also retrying the related question of patent invalidity. (The main petition challenges the new Federal Circuit standard of *scienter* for active inducement under 35 USC § 271(b)).

**This is a cross-petition from No. (2) Commil v. Cisco.**

**Status:** Awaiting Conference

**CVSG:** The Solicitor General has filed a brief at the invitation of the Court which suggests *denial* of *certiorari* on this cross-petition.

**Questions Presented:** “When a court sets aside a jury verdict and orders a new trial, the Seventh Amendment requires that *all* issues be retried ‘unless it clearly appears that the issue to be retried is so distinct and separable from the others that a trial of it alone may be had without injustice.’ *Gasoline Prods. Co. v. Champlin Ref. Co.*, 283 U.S. 494, 500 (1931).

“In this case, the Federal Circuit directed a retrial of Commil's claim that Cisco induced infringement of its patent, but forbade retrial of Cisco's claim that the patent was invalid, even though – as the Federal Circuit held – Cisco's good-faith belief of the patent's invalidity can negate the requisite intent for induced infringement.
“The question presented is:

“Whether, and in what circumstances, the Seventh Amendment permits a court to order a partial retrial of induced patent infringement without also retrying the related question of patent invalidity.”

Certiorari should be denied (per the SG): While the government recommends grant of certiorari in the petition in Commil v. Cisco, as to the instant cross-petition, the Solicitor General recommends against grant of review.