TOP TEN PATENT CASES

Two *Certiorari* Decisions Expected Monday, June 27th

Rank	♦ = *Cert.* granted ♦ = Petition Stage ♦ = @ Federal Circuit ♦ = S. Ct. CVSG order ⊛Major Impact Case
1⊛♦♦	*Impression Products v. Lexmark ;* CVSG Briefing ordered June 20, 2016 International Patent Exhaustion
2⊛♦	*Sequenom v. Ariosa*; **SECOND** Conference was held June 23, 2016 §101 Patent-Eligibility
3⊛♦	*Samsung v. Apple;* Design Patent Damages
4♦	*SCA Hygiene v. First Quality Baby Prods.* Laches, Federal Circuit case law
5♦♦	*Life v. Promega* ; **SECOND** Conference was held June 23, 2016 Active Inducement (§ 271(f)(1)); CVSG Recommendation to Grant Pet.
6⊛♦	*Cooper v. Lee*; *Conference during the October 2016 Term* IPR Constitutionality (*see also* No. (7), below)
7⊛♦	*MCM Portfolio v. Hewlett-Packard* (*see also* No. (6), above) IPR Constitutionality*; Conference during the October 2016 Term*
8♦	*Helsinn Healthcare v. Teva Pharm.;* Fed. Cir. briefing stage Whether *Metallizing Engineering* was overruled by statute
9♦	*Immersion Corp. v. HTC;* petition due September 19, 2016 Section 120 Continuation Copendency Requirement
10♦	*ClearCorrect v. ITC;* cert. petition due June 29, 2016 ITC Jurisdiction over Electronic Signals as "Articles"

Wegner's Top Ten Patent Cases is available at "Wegner's Writings" via the Los Angeles Intell. Property Law Ass'n: www.laipla.net/category/**wegners-writings**/
Recommended Citation: Harold C. Wegner, *Top Ten Patent Cases* (June 24, 2016)

New! Prof. Dennis Crouch on his Patently O website now provides the most comprehensive Supreme Court patent case information , with links to the briefs, e.g., http://patentlyo.com/patent/2016/05/pending-supreme-court-patent-cases-update.html

(1) Patent Exhaustion (*Kirtsaeng; Quanta Computer*)

Current case: *Impression Products, Inc. v. Lexmark International, Inc.*, Supreme Ct. No. 15-1189, petitioner challenges the denial of patent exhaustion at the Federal Circuit, *Lexmark Int'l, Inc. v. Impression Prods., Inc.*, 816 F.3d 721 (Fed. Cir. 2016)(en banc)(Taranto, J.).

Status: CVSG Briefing by the Solicitor General ordered June 20, 2016. (There is no time limit for the filing of his brief which is likely to happen near the end of 2016; an argument would be expected in 2017.

Questions Presented: "The 'patent exhaustion doctrine'—also known as the 'first sale doctrine'—holds that 'the initial authorized sale of a patented item terminates all patent rights to that item.' *Quanta Computer, Inc.* v. *LG Electronics, Inc.*, 553 U.S. 617, 625 (2008). This case presents two questions of great practical significance regarding the scope of this doctrine on which the *en banc* Federal Circuit divided below:

"1. Whether a 'conditional sale' that transfers title to the patented item while specifying post-sale restrictions on the article's use or resale avoids application of the patent exhaustion doctrine and therefore permits the enforcement of such post-sale restrictions through the patent law's infringement remedy.

"2. Whether, in light of this Court's holding in *Kirtsaeng* v. *John Wiley & Sons, Inc.*, 133 S. Ct. 1351, 1363 (2013), that the common law doctrine barring restraints on alienation that is the basis of exhaustion doctrine 'makes no geographical distinctions,' a sale of a patented article—authorized by the U.S. patentee—that takes place outside of the United States exhausts the U.S. patent rights in that article."

Certiorari Fodder: The 90-Plus Page Majority Opinion and the Dissent

The lengthy majority opinion speaks for itself as to the strength *vel non* of its reasoning. There is plenty of red meat in the dissent, particularly as to the "exhaustion" issue.

A Case Destined for Supreme Court Review: Remarkably, the majority (Taranto, J., joined by Newman, Lourie, Moore, O'Malley, Reyna, Wallach, Chen, Stoll, JJ.), maintains its broad denial of exhaustion, distinguishing international intellectual property exhaustion in *Kirtsaeng v. John Wiley & Sons, Inc.*, 133 S. Ct. 1351 (2013), maintaining its denial of exhaustion in *Jazz Photo Corp. v. International Trade Comm'n*, 264 F.3d 1094 (Fed. Cir. 2001), and maintaining contractual restrictions to block exhaustion in the questionable *Mallinckrodt, Inc. v. Medipart, Inc.*, 976 F.2d 700 (Fed. Cir. 1992), and, particularly, distinguishing *Quanta Computer, Inc. v. LG Electronics, Inc.*, 553 U.S. 617 (2008).

Clearly, *certiorari* is never certain, but if ever a case called for grant of review, this case is it.

International Patent Exhaustion: Although the *Kirtsaeng* issue is the *second* Question Presented, this appears to have the greater appeal, given the sharp distinction between the Federal Circuit denial of international intellectual property exhaustion versus the Supreme Court grant of international intellectual property exhaustion in the context of copyright law.

Notwithstanding *Kirtsaeng*, the majority "adhere[s] to the holding of *Jazz Photo Corp. v. International Trade Comm'n*, 264 F.3d 1094 (Fed. Cir. 2001), that a U.S. patentee, merely by selling or authorizing the sale of a U.S.-patented article abroad, does not authorize the buyer to import the article and sell and use it in the United States, which are infringing acts in the absence of patentee-conferred authority." Two members of the Court in dissent "would retain *Jazz Photo* insofar as it holds that a foreign sale does not in all circumstances lead to exhaustion of United States patent rights. But, in my view, a foreign sale does result in exhaustion if an authorized seller has not explicitly reserved the United States patent rights." *Lexmark*, __ F.3d at __, slip op. at 101 (Dyk, J., joined by Hughes, J., dissenting).

Conditional Sales to Avoid Exhaustion: Notwithstanding *Quanta Computer, Inc. v. LG Electronics, Inc.*, 553 U.S. 617 (2008), the same majority "adhere[s] to [its] holding of *Mallinckrodt, Inc. v. Medipart, Inc.*, 976 F.2d 700 (Fed. Cir. 1992), that a patentee, when selling a patented article subject to a single-use/no-resale restriction that is lawful and clearly communicated to the purchaser, does not by that sale give the buyer, or downstream buyers, the resale/reuse authority that has been expressly denied. Such resale or reuse, when contrary to the known, lawful

limits on the authority conferred at the time of the original sale, remains unauthorized and therefore remains infringing conduct under the terms of § 271." The same dissent "agree[s] with the government that *Mallinckrodt*[, *Inc. v. Medipart, Inc.*, 976 F.2d 700 (Fed. Cir. 1992)], was wrong when decided, and in any event cannot be reconciled with the Supreme Court's recent decision in *Quanta Computer, Inc. v. LG Electronics, Inc.*, 553 U.S. 617 (2008). We exceed our role as a subordinate court by declining to follow the explicit domestic exhaustion rule announced by the Supreme Court." *Lexmark*, __ F.3d at __, slip op. at 101 (Dyk, J., joined by Hughes, J., dissenting).

(2) Section 101 Patent-Eligibility: Is a method to determine the presence in a blood sample of a known substance (*here*, DNA) patent-eligible under 35 USC § 101 where that substance, *as such*, is known and not in any event patent-eligible?

Current Case: *Sequenom, Inc. v. Ariosa Diagnostics, Inc.*, Supreme Court No. 15-1182, *proceedings below sub nom Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371 (Fed. Cir. 2015).

Status: Conference June 23, 2016. An announcement whether *certiorari* has been granted is expected as part of the final regular Orders List for the Term that will be published on June 27, 2016. If *certiorari* is granted, the case would be briefed over the Spring and Summer; an oral argument would likely take place in late Fall or early Winter, with a merits decision before the end of June 2017

Question Presented: "Whether a novel method is patent-eligible where; (1) a researcher is the first to discover a natural phenomenon; (2) that unique knowledge motivates him to apply a new combination of known techniques to that discovery; and (3) he thereby achieves a previously impossible result without preempting other uses of the discovery."

(The discussion, *below*, is a shortened version of a paper, *The Sequenom Certiorari Petition: Whither Patent-Eligibility?*(Feb. 19, 2016):

(The *Question Presented* is keyed to the statement of the case set substantially different from the theory set forth in this paper. Whether the current approach is successful in gaining *certiorari* remains to be seen.)

The law of patent-eligibility is in a state of flux with the important case involving the genetic testing method of Sequenom on the verge of a deision whetehr to grant certiorari in a case styled as *Sequenom, Inc. v. Ariosa Diagnostics,*

Inc., Supreme Court No. 15-1182, *proceedings below sub nom Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371 (Fed. Cir. 2015). A response to the petition is due April 20, 2016, after which a vote whether to grant *certiorari* is expected before the end of June when the current Term ends.

A "Microscope" Invention to *Identify* a Known Substance: Like a "microscope" a blood test is a way of identifying the presence of material in a sample. Here, the claimed invention is "[a] method for detecting a paternally inherited nucleic acid[, i.e., DNA,] of fetal origin performed on a maternal serum or plasma sample from a pregnant female ***."[*] The DNA, per se, is *known* and thus unpatentable, but, in any event, it is the object of *identification* of the DNA in the sample of the claimed invention. Grant of a patent would thus not preclude any method of making or using the DNA.

A Method to *Identify* a Known DNA that does not Claim the DNA: Patent-eligibility involving microorganism inventions has not even been in controversy where the microorganism is not claimed nor is there a composition claimed involving the microorganism. *In re Bergy*, 596 F.2d 952, 976-77 (CCPA 1979)(Rich, J.), *aff'd as to Chakrabarty sub nom Diamond v. Chakrabarty,* 447 U.S. 303 (1980)(*citing Cochrane v. Deener*, 94 U.S. 780 (1876); *Risdon Iron & Locomotive Works v. Medart*, 158 U.S. 68 (1895); *Cameron Septic Tank Co. v. Village of Saratoga Springs*, 159 F. 453 (2nd Cir. 1908); *Dick v. Lederle Antitoxin Laboratories*, 43 F.2d 628 (S.D.N.Y.1930))("[The Patent Office] contends that the [microorganism] invention of the Weizmann patent is unpatentable since it is for the life process of a living organism. Were the patent for bacteria per se, a different situation would be presented. As before stated, the patent is not for bacteria per se. It is for a fermentation process employing bacteria discovered by Weizmann under conditions set forth in the specification and claims. Undoubtedly there is patentable subject-matter in the invention.")(original emphasis). Patent-eligibility was denied in *Funk v. Kalo* because the product was claimed, as distinguished from a patent-eligible method of testing. *Funk Bros. Seed Co. v. Kalo Inoculant Co*., 333 U.S. 127, 130 (1948)(citing *Telephone Cases*, 126 U.S. 1, 532, 533 (1888); *De Forest Radio Co. v. General Electric Co*., 283 U.S. 664, 684, 685 (1931); *Mackay Radio & Tel. Co. v. Radio Corp*., 306 U.S. 86, 94 (1939); *Cameron Septic Tank Co. v. Saratoga Springs*, 159 F. 453, 462, 463 (2nd Cir. 1908.)("We do not have

[*] Claim 1: "A method for detecting a paternally inherited nucleic acid of fetal origin performed on a maternal serum or plasma sample from a pregnant female, which method comprises [(a)] amplifying a paternally inherited nucleic acid from the serum or plasma sample and [(b)] detecting the presence of a paternally inherited nucleic acid of fetal origin in the sample."

presented the question whether the methods of selecting and testing the non-inhibitive strains are patentable. We have here only product claims. ***. If there is to be invention [here], it must come from the application of the law of nature to a new and useful end.")

Claims to *Identify* DNA in a Sample do not Implication § 101: It has never before been seriously suggested that a method of several process steps to *identify* DNA lacks patent-eligibility. *See Schering Corp. v. Amgen, Inc.*, 18 F.Supp.2d 372, 387 (D. Del. 1998)("hybridization was used in this invention to identify DNA segments structurally similar to both RNA segments and DNA segments found to code on expression for proteins with the anti-viral characteristics of interferon."). It also cannot be seriously contemplated that a method of testing for DNA in a civil litigation could be denied patent-eligibility, a daily occurrence. *See Franson v. Micelli*, 645 N.E.2d 404, 411 (Ill. App. 1 Dist. 1994)(paternity suit)("The procedures used to 'match' or 'identify' DNA strands…."); *see also Allen v. State of Florida*, 62 So.3d 1199, 1200 (Fla. App. 2011)(criminal lawsuit)("[H]er lab uses the polymerase chain reaction (PCR) process to identify DNA."); *State of Utah v. Maestas*, 2012 UT 46, ¶ 124 (Utah S.Ct. 2012)(PCR evidence to sustain capital murder conviction)("[Expert witness] Dr. Wrigley testified that the Y-STR DNA analysis uses the same process and technology to extract, amplify, and identify DNA that is generally employed with polymerase chain reaction (PCR) STR DNA tests. *** Dr. Wrigley testified that because all males in the same paternal lineage have the same forensic markers, *** the Y-STR analysis indicates whether an individual and all of his paternal relatives can be excluded as possible contributors as the source of a DNA sample."); *People v. Golub*, 601 N.Y.S.2d 502, 503 (N.Y.A.D. 2 Dept. 1993)(second degree murder conviction)("The bloodstains were tested using a then relatively new scientific technique known as 'DNA fingerprinting.'").

An "Adams Battery" *Combination* Invention: The invention is a *combination* invention, including all of its elements in the combination of the claim that is to be evaluated for patent-eligibility and nonobviousness: The claim is not to be dissected element by element. As explained in the *Adams Battery* case, "it is fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention[.]"*United States v. Adams*, 383 U.S. 39, 48-49 (1966)(citing *Seymour v. Osborne*, 78 U.S. (11 Wall.) 516, 547 (1871); *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 312 U.S. 654 (1940); *Schering Corp. v. Gilbert*, 153 F.2d 428 (2nd Cir. 1946)).

As explained in the *Adams Battery* case, *United States v. Adams*, 383 U.S. 39, 48-49 (1966): "While the claims of a patent limit the invention, and specifications cannot be utilized to expand the patent monopoly, *Burns v. Meyer*, 100 U.S. 671, 672 (1880); *McCarty v. Lehigh Valley R. Co*., 160 U.S. 110, 116 (1895), it is fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention, *Seymour v. Osborne*, 78 U.S. (11 Wall.) 516, 547 (1871); *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 312 U.S. 654 (1940); *Schering Corp. v. Gilbert*, 153 F.2d 428 (2nd Cir. 1946)."

Borrowing *Mayo* Dictate to Create a Conflict with Established Law: Taking *dicta* from *Mayo*, *in vacuo,* leads to an unnecessary conflict within the case law of the Supreme Court that has uniformly required consideration of the invention as a whole, "all elements" of the claimed invention in their combination defined by the patentee. In the context of patent infringement, the cases repeatedly spoke of the judicial requirement to construe the subject matter under the "all elements" rule. There is a rich history of precedent more from more than one hundred years ago that established the rule that was established by Justice Story. *See Barrett v. Hall*, 2 F.Cas. 914, 924 (No. 1047)(D. Mass. 1818)(Story, J., riding circuit)("the patent [is] for the combination only[;] it is no infringement of the patent to use any of the machines separately, if the whole combination be not used; for in such a case the thing patented is not the separate machines, but the combination; and the statute gives no remedy, except for a violation of the thing patented."); *see also Prouty v. Draper*, 20 F.Cas. 11, 12 (No. 11,446) (D. Mass. 1841)(Story, J.; riding circuit), *aff'd,* 41 U.S. (16 Pet.) 336 (1842)(Taney, C.J.)(" "The plaintiffs' patent is for an entire combination of all the three things, and not for a combination of any two of them. A patent for a combination of A, B and C, cannot be technically or legally deemed at once a combination of A, B and C, and of A and B alone."); *Eames v. Godfrey*, 68 U.S. (1 Wall.) 78, 79 (1864)("[T]here is no infringement of a patent which claims mechanical powers in combination unless all the parts have been substantially used. The use of a part less than the whole is no infringement."); *Water-Meter Co. v. Desper*, 101 U.S. (11 Otto) 332, 335-37 (1879)("It is a well-known doctrine of patent law, that the claim of a combination is not infringed if any of the material parts of the combination are omitted. ***").

The quoted cases are merely illustrative of the many "all elements" cases from the nineteenth century that include, *inter alia*, *Vance v. Campbell*, 66 U.S. (1 Black) 427, 429 (1861); *Eames v. Godfrey*, 68 U.S. (1 Wall.) 78, 79 (1864); *Gould v. Rees*, 82 U.S. (15 Wall.) 187 (1872); *Dunbar v. Myers*, 94 U.S. (4 Otto) 187, 202 (1876); *Water-Meter Co. v. Desper*, 101 U.S. (11 Otto) 332, 335-37 (1879); *Case*

v. Brown, 69 U.S. (2 Wall.) 320, 327-28 (1864); *Gill v. Wells*, 89 U.S. (22 Wall.) 1, 26-30 (1874); *Fuller v. Yentzer*, 94 U.S. (4 Otto) 288, 297 (1876); *Gage v. Herring*, 107 U.S. (17 Otto) 640, 648 (1882); *Fay v. Cordesman*, 109 U.S. 408, 420-21 (1883); *Rowell v. Lindsay*, 113 U.S. 97, 102 (1885); *Sargent v. Hall Safe & Lock Co.*, 114 U.S. 63, 86 (1885); *Brown v. Davis*, 116 U.S. 237, 252 (1886); *Yale Lock Mfg. Co. v. Sargent*, 117 U.S. 373, 378 (1886); *McClain v. Ortmayer*, 141 U.S. 419, 425 (1891); *Wright v. Yuengling*, 155 U.S. 47, 52(1894); *Black Diamond Coal Mining Co. v. Excelsior Coal Co.*, 156 U.S. 611, 617-18 (1895); *Cimiotti Unhairing Co. v. American Fur Ref. Co.*, 198 U.S. 399, 410 (1905)).

The Aberrant *Flook* Case: To the extent that *Parker v. Flook*, 437 U.S. 584 (1978), stands for the proposition that one may dissect a claim into its constituent elements to determine patent-eligibility based upon the patent-eligibility of one of the components, *Flook* was cabined by *Diamond v. Diehr*, 450 U.S. 175 (1981).

In *Diehr* the Court expressly stated that "[i]n determining the eligibility of [the patent applicants'] claimed process for patent protection under § 101, their *claims must be considered as a whole*. It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis." *Diehr*, 450 U.S. at 188.

Misapplication of the Law of the *Mayo* Case: In voting to deny rehearing en banc in *Ariosa*, the second most senior active member of the Federal Circuit who has been on the bench for twenty-five years manifests a misunderstanding of precedent in the following passage: "In *Mayo Collaborative Services v. Prometheus Laboratories, Inc*., 132 S. Ct. 1289 (2012), the Supreme Court set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts." *Ariosa Diagnostics, Inc. v. Sequenom, Inc*. __ F.3d __, __(Fed. Cir. Dec. 2, 2015)(Lourie, J., joined by Moore, J., concurring in den. reh'g en banc). Precisely. *Mayo* deals with claims to "laws of nature, natural phenomena", but the invention, *here*, has no such claim.

♦ (3) Design patent infringement; damages keyed to component

Current Case: *Samsung Electronics Co., Ltd. v. Apple Inc*., No. 15-777 *opinion below, Apple Inc. v. Samsung Electronics Co., Ltd.*, __ F.3d __ (Fed. Cir. May 18, 2015)(Prost, C.J.), asks whether design patent damages should be limited to profits attributable to a component of a patented design, where the design is applied to only that component.

Status: The case will be briefed over the coming months and then argued during the October 2016 Term with a decision before the Term finishes at the end of June 2017. (Petitioner's brief is due June 1, 2016; Respondent's brief is due July 29, 2016.)

Certiorari was granted March 21, 2016, but *only* as to the *second* Question Presented. The case will be briefed in the coming months with a Fall or early Winter argument and a decision in the Term that expires at the end of June 2017.

Questions Presented: "***The [Federal Circuit] held that a design-patent holder is entitled to an infringer's entire profits from sales of any product found to contain a patented design, without any regard to the design's contribution to that product's value or sales. The *** effect of [this holding] is to reward design patents far beyond the value of any inventive contribution. The questions presented are:
* * *
"2. Where a design patent is applied to only a component of a product, should an award of infringer's profits be limited to those profits attributable to the component?"

A Damages Pandora's Box for "Regular" Patents: If the Court determines that a particular feature of the patented design is responsible for the success of the infringing product and it accounts for, say, ten percent of the profits, what lesson would a ruling limiting the design patentee to ten percent of the profits in *this* case have on "regular" patent infringement cases?

Opening the Door to Future Design Patent Grants of *Certiorari*: One reason why design patents have not been accepted for review by the Supreme Court is because the Court may have been reluctant to grant *certiorari* in an area of law unfamiliar to the members of the Court. This situation is now dramatically

changed with *Samsung Electronics v. Apple* providing a "tutorial" to the Supreme Court on design patent law. What's next?

Historic First Grant of *Certiorari* in a Design Patent Case: Never since the Evarts Act of 1891 gave the Court discretion whether to accept an appeal has the Court previously issued a merits decision on design patent law. The leading design patent case came a generation before the Evarts Act in *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511 (1871), where an appeal could be taken directly from the trial court as a matter of right. (To be sure, discussion of design patent law is found in *dictum* in *Mazer v. Stein*, 347 U.S. 201, 215-16 (1954)(copyright case discussing design patents)(" *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511 (1871), interpret[s] the design patent law of 1842, 5 Stat. 544, granting a patent to anyone who by 'their own industry, genius, efforts, and expense, may have invented or produced any new and original design for a manufacture * * *.' A pattern for flat silver was there upheld. The intermediate and present law differs little. 'Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, * * *' subject generally to the provisions concerning patents for invention. § 171, 66 Stat. 805, 35 U.S.C.A. § 171.")(footnote omitted).

Federal Circuit Activity in Design Patents: To be sure, the Federal Circuit has had a major *en banc* review of a design patent issue. *See Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008)(en banc)(Bryson, J.).

♦ (4) Laches, Federal Circuit case law

***Current Case*: *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods.,LLC*,** S.Ct. No. 15-927, *opinion below, LLC*, 807 F.3d 1311 (Fed. Cir. 2015)(en banc), asks whether Federal Circuit patent laches law consistent with the Supreme Court copyright laches case, *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 134 S.Ct. 1962 (2014).

***Status*:** *Certiorari* granted May 2, 2016. Merits briefing in the coming months with argument in the October 2016 Term, with a decision before the end of June 2017.

Split En Banc Opinion interpreting *Petrella*: The 6-5 *en banc* majority opinion split the court between a majority opinion of Prost, C.J. (joined by Newman, Lourie, Dyk, O'Malley, Reyna, JJ.), and an opinion by Hughes, J. (joined by Moore, Wallach, Taranto, Chen, JJ., concurring-in-part and dissenting-in-part).

The majority opinion explains that the en banc court was convened "to resolve whether, in light of the Supreme Court's recent decision in *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962 (2014), laches remains a defense to legal relief in a patent infringement suit. We conclude that Congress codified a laches defense in 35 U.S.C. § 282(b)(1) that may bar legal remedies. Accordingly, we have no judicial authority to question the law's propriety. Whether Congress considered the quandary in *Petrella* is irrelevant—in the 1952 Patent Act, Congress settled that laches and a time limitation on the recovery of damages can coexist in patent law. We must respect that statutory law."

Implications: No matter the outcome, *SCA Hygience* is a black eye for the Federal Circuit as a court established to provide a uniform body of case law in the patent field. It reaches a conclusion as to laches that differs from *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 134 S.Ct. 1962 (2014)(copyright law) and does so in badly split *en banc* decision with a six vote majority opinion (Prost, C.J., joined by Newman, Lourie, Dyk, O'Malley, Reyna, JJ.) balanced by a five vote minority opinion (Hughes, J., joined by Moore, Wallach, Taranto, Chen, JJ., concurring in part, dissenting in part).

The majority ruled that "laches remains a defense to legal relief in a patent infringement suit after *Petrella* [*v. Metro-Goldwyn-Mayer, Inc.*, 134 S.Ct. 1962 (2014)]. Laches bars legal relief, and courts must weigh the facts underlying laches in the *eBay* framework when considering an injunction. However, absent extraordinary circumstances, laches does not preclude an ongoing royalty."

The dissent disagreed with "the majority [which] adopts a patent-specific approach to the equitable doctrine of laches. In doing so, the majority overlooks Congress' intent and Supreme Court precedent, which demonstrate that laches is no defense to a claim for damages filed within the statutory limitations period established by 35 U.S.C. § 286."

♦ **(5) "Active Inducement" to Infringe (§ 271(f)(1)):** "Whether the Federal Circuit erred in holding that supplying a single, commodity component of a multi-component invention from the United States is an infringing act under 35 U.S.C. § 271(f)(1) ***."

Current Case: *Life Techs. Corp. v. Promega Corp.*, Supreme Court No. 14-1538, opinion below, *Promega Corp. v. Life Techs. Corp.*, 773 F.3d 1338 (Fed. Cir., 2014)(Chen, J.).

Status: ***Second*** Conference June 23, 2016.

Questions Presented: "1. Whether the Federal Circuit erred in holding that a single entity can 'actively induce' itself to infringe a patent under 35 U.S.C. § 271(f)(1).

"2. Whether the Federal Circuit erred in holding that supplying a single, commodity component of a multi-component invention from the United States is an infringing act under 35 U.S.C. § 271(f)(1), exposing the manufacturer to liability for all worldwide sales."

CVSG Recommendation to Grant Review Limited to the Second Question: The Solicitor General in his CVSG brief, filed May 11, 2016, recommends grant of review, but *only* as to the **second** *Question Presented.*

Prior Case Law: Contributory infringement was spawned more than 140 years ago in *Wallace v. Holmes*, 29 F.Cas. 74 (No. 17,100) (CC Conn.1871), as a court-fashioned way for a patentee to sue a third party who supplies a component of the patented invention to numerous third parties, because it would be impossible or next to impossible as a practical matter to sue each of the individual direct infringers. There has never been a prior appellate holding of active inducement other where a third party is induced to infringe.

Implications: This case represents yet another bold stroke by the Federal Circuit to expand the scope of American patent rights to cover extraterritorial activity.

⍟♦ (6) Constitutionality of IPR (public rights)

Current Case:: *Cooper v. Lee*, Supreme Court No. 15-955, presents a serious Constitutional direct or implicit challenge to post-grant review procedures at the Patent Office, *here*, in the context of Inter Partes Review.

Status: Awaiting Conference. On April 26, 2016, the case was scheduled for Conference on May 12, 2016. On May 2, 2016, the docket entry is "Rescheduled".

***Amicus Speaks*, the Greenspoon-Dhuey team**: Complementing petitioner's brief from the pen of Robert P. Greenspoon, is the joint effort of two independent thinkers, practitioner-scholar Andrew J. Dhuey and Professor Adam Mossoff in their filing styled as the *Brief Of Professor Adam Mossoff as Amicus Curiae in Support of Petitioners* (keyed to the thoughtful academic work of the coauthor, Adam Mossoff, *Patents as Constitutional Private Property: The Historical Protection of Patents under the Takings Clause*, 87 B. U. L. Rev. 689 (2007); Adam Mossoff, *Exclusion and Exclusive Use in Patent Law*, 22 Harv. J. L. & Tech. 321 (2009)).

The Greenspoon-Dhuey team has taken on seemingly insurmountable challenges before, most notably their joint representation in *Lighting Ballast Control LLC v. Philips Elecs. N. Am. Corp.*, 744 F.3d 1272 (Fed. Cir., 2014)(en banc), that served as a prelude to the Supreme Court decision in *Teva Pharm. United States, Inc. v. Sandoz, Inc.*, 135 S.Ct. 831 (2015).

Question Presented: Nearly 30 years have passed since this Court last applied Article III Separation of Powers principles to declare the authority of Congress to empower an executive agency to adjudicate a private dispute. More recently in a non-agency context, in *Stern v. Marshall*, 131 S. Ct. 2594 (2011), Justice Scalia's concurring opinion questioned the "multifactors relied upon today [that] seem to have entered our [public rights] jurisprudence almost randomly." *Id.* at 2621 (Scalia, J., concurring). The two other *Stern* opinions (majority and dissent) have all members of this Court expressing dissatisfaction with the clarity of Article III public rights jurisprudence: either it "has not been entirely consistent," *id.* at 2611 (majority), or preceding cases "do not admit of easy synthesis." *Id.* at 2624 (dissent) (citation omitted). Congress continues to pass laws against this murky backdrop, risking inappropriate expansion of the administrative state.

"The question presented is whether 35 U.S.C. §318(b) violates Article III of the United States Constitution, to the extent that it empowers an executive agency

tribunal to assert judicial power canceling private property rights amongst private parties embroiled in a private federal dispute of a type known in the common law courts of 1789, rather than merely issue an advisory opinion as an adjunct to a trial court."

A Unique United States Perspective: Grant of the petition coupled with a merits success by petitioner would cast the United States as odd man out amongst the major patent granting authorities of the world as, for example, a European Patent can be challenged in a vigorous patent office proceeding in the nine months following grant and a similar right is available in Japan.

"Death Squads" *Déjà vu*: The words of the former Chief Judge could yet come back to haunt the appellate court. In a 2003 rant, the former Chief Judge dubbed the Patent Trial and Appeal Board as being "patent death squads". It has since been popular to characterize Federal Circuit invalidity jurisdiction over patents in IPR proceedings as decidedly anti-patentee. Some refer to cases with as few as one of *many claims* being invalidated as counting as invalidation of *the patent*, while at most modest attention has been given to the reality that many patent challengers are reluctant to use the IPR procedure unless they have a rock solid case.

(7) Constitutionality of IPR

***Current Case*:** In *MCM Portfolio LLC v. Hewlett-Packard Co.*, Supreme Court No. 15-1330, *opinion below*, __ F.3d __ (Fed. Cir. Dec. 2, 2015)(Dyk, J.), petitioner challenges Inter Partes Review as unconstitutional.

***Status*:** Response due June 30, 2016 (once extended).

***Questions Presented*:** "1. Does IPR violate Article III of the Constitution? "2. Does IPR violate the Seventh Amendment to the Constitution?"

***Piggybacking Off Top Ten No. 8, Cooper v. Lee*:** The timing of this case is behind *Cooper v. Lee*. It is therefore likely that if *certiorari* is granted in *Cooper v. Lee* that this case will be held for a Conference following a merits decision in

Cooper v. Lee (where, should petitioner in that case be successful on the merits, the court would grant, vacate and remand (GVR) in *MCM Portfolio.*

Goldstein on Patents: Petitioner is represented by the well known Supreme Court advocate, Thomas Goldstein, who has previously been lead counsel in patent cases, *F. Hoffmann-La Roche Ltd v. Empagran S.A.*, 542 U.S. 155 (2004), *KSR Int'l Co. v. Teleflex Inc*., 550 U.S. 398 (2007).

From the Opinion Below: "The Seventh Amendment provides that, '[i]n Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved . . . .' U.S. Const. amend. VII. The Supreme Court has stated that 'the Seventh Amendment is generally inapplicable in administrative proceedings, where jury trials would be incompatible with the whole concept of administrative adjudication and would substantially interfere with [the agency's] role in the statutory scheme.' *Curtis* [*v. Loether*, 415 U.S. 189, 194 (1974),] upheld 'congressional power to entrust enforcement of statutory rights to an administrative process or specialized court of equity free from the structures of the Seventh Amendment.' *Id*. at 195. Similarly, the Court held in *Atlas Roofing Co., Inc. v. Occupational Safety & Health Review Commission*, 430 U.S. 442, 455 (1977), that 'when Congress creates new statutory 'public rights,' it may assign their adjudication to an administrative agency with which a jury trial would be incompatible, without violating the Seventh Amendment's injunction that jury trial is to be 'preserved' in 'suits at common law.' Congress is not required by the Seventh Amendment to choke the already crowded federal courts with new types of litigation or prevented from committing some new types of litigation to administrative agencies with special competence in the relevant field.' *See also Tull v. United States*, 481 U.S. 412, 418 n.4 (1987) ('[T]he Seventh Amendment is not applicable to administrative proceedings.'). Here, when Congress created the new statutory right to inter partes review, it did not violate the Seventh Amendment ***." *MCM Portfolio LLC v. Hewlett-Packard Co*., __ F.3d __, slip op. at 14-15 (Fed. Cir. Dec. 2, 2015)(Dyk, J.).

♦ (8) Secret Commecialization as Prior Art

Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc., Fed. Cir. 2016-1284 Whether the Leahy Smith America Invents *Act* overrules *Metallizing Engineering.*

Medicines Co.* Side Show to the *Helsinn* Main Event**: The full *en banc* Federal Circuit has gone ahead with a *Helsinn* "side show", an *en banc* hearing in *Medicines Co. v. Hospira, Inc.*, 791 F.3d 1368 (Fed. Cir. 2015)(Hughes, J.), *vacated*, 805 F.3d 1357 (Fed.Cir. 2015)(order for en banc briefing)(argued May 5, 2016), where a sale would be negated as a statutory bar *if* the *Metallizing Engineering* case is good law. (*Medicines Co.* is dealt with *infra* under "Other Cases…") There are numerous other fact patterns as well that can be imagined under *Metallizing Engineering* that are unjust and reach a bad public policy outcome ***if the law of *Metallizing Engineering* is followed.

Medicines Co. and other secret "on sale" statutory bar issues are thus subsidiary "side shows" to the main event, whether (as argued in *Helsinn*) the *Metallizing Engineering* case remains good law.

The Scholarship of Prof. Dmitry Karshtedt: Federal Circuit opinions have invoked *Metallizing Engineering* as if it were unquestioned judicial wisdom. Undoubtedly, its author was *indeed* a leading patent scholar, perhaps on a par with the noted jurist from the early days of this country, the late Learned Hand. But, this case is not only out of date as to changed factual circumstances but of at most questionable value *apart from the issue as to whether the case was legislatively overruled as part of the Leahy Smith America Invents Act.*

The weakness of *Metallizing Engineering* is a theme in the *amici* filings of both the United States and The Naples Roundtable, Inc., each citing the scholarship of George Washington University Law School's leading patent scholar, Dmitry Karshtedt, *Did Learned Hand Get it Wrong? The Questionable Patent Forfeiture Rule of Metallizing Engineering*, 57 Villanova L. Rev. 261 (2012).

♦ (9) Section 120 Continuation Copendency Requirement

Immersion Corp. v. HTC Corp. is the expected styling of a petition for *certiorari* to review the Federal Circuit decision, __ F.3d __ (Fed. Cir. June 21, 2016)(Taranto, J.), denying continuation copendency for a new application filed on the last day of pendency of a parent application.

Status: A petition for writ of *certiorari* is due September 19, 2017.

Issue: Continuation applications are frequently filed on the very last day a parent patent application is pending (i.e., the day before the parent application is published as a patent). The question is whether the statutory requirement under Section 120 requires that the new application be "*filed before the patenting*" (as stated in 35 USC §120).

The Federal Circuit in the current opinion says that there *is* copendency for purpose of continuation application status when the continuation is filed on the last day the parent is pending.

♦ (10) ITC Jurisdiction over Electronic Signals as "Articles"

The ITC has jurisdiction to block importation over infringing "articles": Is importation of an electronic signal importation of such an "article"?

Current Case: *ClearCorrect Operating, LLC v. Int'l Trade Comm'n* is the expected styling of a petition for *certiorari* from the decision of the Federal Circuit, __ F.3d __ (Fed. Cir. Nov. 10, 2015)(Prost, J.), *reh'g en banc denied,* __ F.3d __ (Fed. Cir. March 31, 2016), the court reversed an ITC determination that "[t]he Tariff Act of 1930 provides the International Trade Commission [ ] with authority to remedy only those unfair acts that involve the importation of "articles" as described in 19 U.S.C. § 1337(a)[, interpreting] 'articles' [as] "include[ing] electronic transmission of digital data. . ."

Status: The deadline for filing a petition to the Supreme Court for grant of *certiorari* expires June 29, 2016. A decision whether to grant *certiorari* would be expected September 26, 2016, at the Opening Conference for the October 2016 Term.

The Great Dissenter, Déjà vu: Both in the panel decision and in the denial of rehearing en banc, The Great Dissenter, Circuit Judge Newman, issued remarkable dissents. This included, for example, the following statement in her dissent from denial of rehearing *en banc* that "[t]he court's decision is inconsistent with decisions of the Supreme Court, the Federal Circuit, the Court of Customs and Patent Appeals, the Court of International Trade, the Tariff Commission, the Department of Labor, the Bureau of Customs and Border Protection, the Arms Control Export Act, and the Bipartisan Congressional Trade Priorities and Accountability Act."

About the Author

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