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Federal Circuit Reverses Summary Judgment Of Noninfringement

In *Amdocs Limited v. Openet Telecom Inc*. (Appeal No. 2013-1212), the Federal Circuit reversed the district court's grant of summary judgment of noninfringement with respect to three patents, and vacated the district court's grant of summary judgment of noninfringement with respect to a fourth patent.

Amdocs and Openet compete in the market for "data mediation software" which helps internet service providers track their customer's network usage and generate bills. Amdocs filed an infringement action against Openet asserting infringement of four patents.

Openet moved for summary judgment of noninfringement of all four patents, and the district court granted the motions, finding that Amdocs had not raised a genuine question of material fact as to whether the accused devices practiced "completing" or "enhancing" "in a distributed fashion", a requirement which it construed to be common to all asserted claims.

On appeal, the Federal Circuit agreed with the district court's claim construction of three of the patents, but found that documentary evidence describing the structure and operation of the accused product created genuine factual issues regarding whether the product meets these constructions. Accordingly, for the three patents, the Federal Circuit reversed the district court's grant of summary judgment and remanded the case.

Regarding the fourth patent, the Federal Circuit held that the district court had erred in construing the term "a single record represent(ing) each of the plurality of services" to mean "one record that includes customer usage data for each of the plurality of services used by the customer on the network." The Federal Circuit held that the term does not simply encompass a record in which usage data is separately represented, but includes a record in which usage data is represented in the aggregate. Accordingly, the Federal Circuit vacated the district court's claim construction as erroneous, and remanded the case for determination of infringement under the proper claim construction.

Federal Circuit Reverses Summary Judgment Of Invalidity

In *ScriptPro LLC v. Innovation Associates* (Appeal No. 2013-1561), the Federal Circuit reversed the district court's summary judgment of invalidity.

ScriptPro sued Innovation for infringing its patent related to automated prescription container dispensing system that automatically fills and labels pill bottles. Innovation moved for summary judgment of invalidity under 35 U.S.C. § 112 ¶ 1. The district court granted summary judgment finding that the patent was invalid for lack of an adequate written description. The district court determined that the specification of the patent-in-suit described a machine having sensors, but that the asserted claims did not recite a sensor. The district court concluded that based upon the written description in the patent, no reasonable jury could find that the machine disclosed in the patent could operate without sensors.

On appeal, the Federal Circuit noted that under 35 U.S.C. § 112(a), a specification must contain a description of an invention that would enable any person that is skilled in the field of that invention to make and use the invention. The Federal Circuit also noted that the patent did not include any dispositive language describing sensors as essential elements. The patent specification did not contain a "clear statement of limitation" because it described the collating unit as "broadly include[ing]" and "broadly comrpris[ing]" the sensors. Other portions of the specification also described the sensors as a "security feature" or could be read by a reasonable, skilled artisan to mean that the sensors were optional.

Accordingly, the Federal Circuit reversed the district court's grant of summary judgment that the claims were invalid under § 112 for lack of written description, finding that sensors were not a required component.

Federal Circuit Affirms Grant Of JMOL Of No Infringement

In *Mformation Technologies Inc. v. Research In Motion Ltd*. (Appeal Nos. 2102-1679, 2013-1123), the Federal Circuit affirmed the district court's judgment as a matter of law ("JMOL") that RIM did not infringe the asserted patent which related to wireless activation and management of an electronic device without the need to have physical access to the device.

Mformation filed a patent infringement suit against RIM. After trial, the jury found infringement of all asserted claims of the patent and returned a verdict of $147.2 million in favor of Mformation. RIM filed a JMOL motion, arguing that Mformation did not present evidence that a connection is completely established before the start of the "transmitting" sub-step in the patent. The district court granted RIM's motion, overturning the verdict and granted RIM's conditional motion for a new trial.

On appeal, the Federal Circuit affirmed the district court's grant of JMOL of no infringement, upheld the award against Mformation for $206,363.28 in
costs.

Federal Circuit Affirms Judgment Of Invalidity For Obviousness-Type Double Patenting

In *AbbVie Inc. v. Kennedy Inst. Of Rheumatology*. (Appeal No. 2013-1545), the Federal Circuit affirmed district court judgment of invalidity for obviousness-type double patenting.

AbbVie sought a declaratory judgment that claims of the '442 patent were invalid over the '766 patent for obviousness-type double patenting. After a

bench trial, the district court ruled that all of the claims that were the subject of the declaratory judgment action were invalid over claims of the '766 patent.

Kennedy had conceded that the '766 patent encompasses the same inventive subject matter as the '442 patent (i.e., that the '766 patent is a dominant patent), but contended that the '442 patent was patentable over the '766 patent arguing that the '766 patent claims a "broad genus" of methods for treating rheumatoid arthritis, whereas the '442 patent claims a "narrower species" of those treatment methods with unexpected results.

The Federal Circuit noted that a crucial purpose of the doctrine of double patenting was to "prevent an inventor from securing a second, later expiring patent for the same invention." The Federal Circuit stated that patents claiming overlapping subject matter that were filed at the same time could have different patent terms due to examination delays at the PTO, and where an applicant chooses to file separate applications for overlapping subject matter and to claim different priority dates for the applications, the separate patents will have different expiration dates since the patent term is measured from the claimed priority date. The Federal Circuit stated that when such situations arise, the doctrine of obviousness-type double patenting ensures that a particular invention (and obvious variants thereof) does not receive an undue patent term extension.

The Federal Circuit held that the doctrine of obviousness-type double patenting continues to apply where two patents that claim the same invention have different expiration dates, and that Kennedy would not be entitled to an extra six years of monopoly solely because it filed a separate application unless the two inventions are patentably distinct. The Federal Circuit then concluded that the '442 patent does not claim a species manifesting unexpected results, and therefore the '442 patent would have been obvious over the '766 patent. Accordingly, the Federal Circuit affirmed the district court's judgment that the '442 patent is invalid for obviousness-type double patenting in light of the '766 patent.

Contact Us:

www.gbpatent.com

gbpatent@gbpatent.com

703-716-1191 (phone)

703-716-1180 (fax)