

Federal Circuit Year in Review

September 22, 2016

Professor Gaia Bernstein

Seton Hall University School of Law

Obviousness

Arendi v Apple (Fed. Cir. 2016)

- Common sense cannot supply a missing element or limitation unless it is “unusually simple”
- Use of common sense in obviousness inquiry is permitted under *KSR* but not to substitute reasoned analysis and evidentiary support

Induced Infringement

Commil v. Cisco (Sup. Ct. 2015)

- Mere belief of patent invalidity is not a defense for inducing infringement.
- Induced infringement requires D to know or be willfully blind to:
 - (a) the existence of the infringed patent and;
 - (b) that the acts defendant induced were infringing.

Warsaw Orthopedic v. Nuvasive (Fed. Cir. 2016)

- Knowledge or willful blindness exist when D's non-infringement theory was objectively unreasonable

Unwired Planet v. Apple (Fed Cir. 2016)

- A D's objectively reasonable theory of non-infringement is insufficient for a finding of knowledge or willful blindness.
- Liability needs to be based also on D's subjective knowledge

Exhaustion



Lexmark v. Impression (Fed. Cir. 2016)

- A patentee can contractually restrict downstream purchasers' re-sale and re-use of a patented product.
- Sales of a product abroad (even without contractual restrictions) do not exhaust the US patent rights associated with the product

Term

Pfizer v. Lee (Fed. Cir 2016)

- A-Delay – failure to act by examination deadline – justifies term extension
- An incomplete restriction requirement that notifies applicant of broad grounds for claim rejection does not warrant term extension as an A-Delay.

Trademarks

In re Tam (Federal Circuit 2015)

- Sec. 2(a) of the Lanham Act prohibits registering marks that are scandalous, deceptive, immoral or disparaging
- Prohibition on registering disparaging marks is unconstitutional under a strict scrutiny test because it is viewpoint discriminatory