

Nineteen Hundred and Twenty-two

**NYIPLA**<sup>®</sup>  
New York  
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## **RECENT US SUPREME COURT DECISIONS ON PATENT LAW AND THE INFLUENCE ON CURRENT PATENT PRACTICE AND POTENTIAL US PATENT LAW REFORM**

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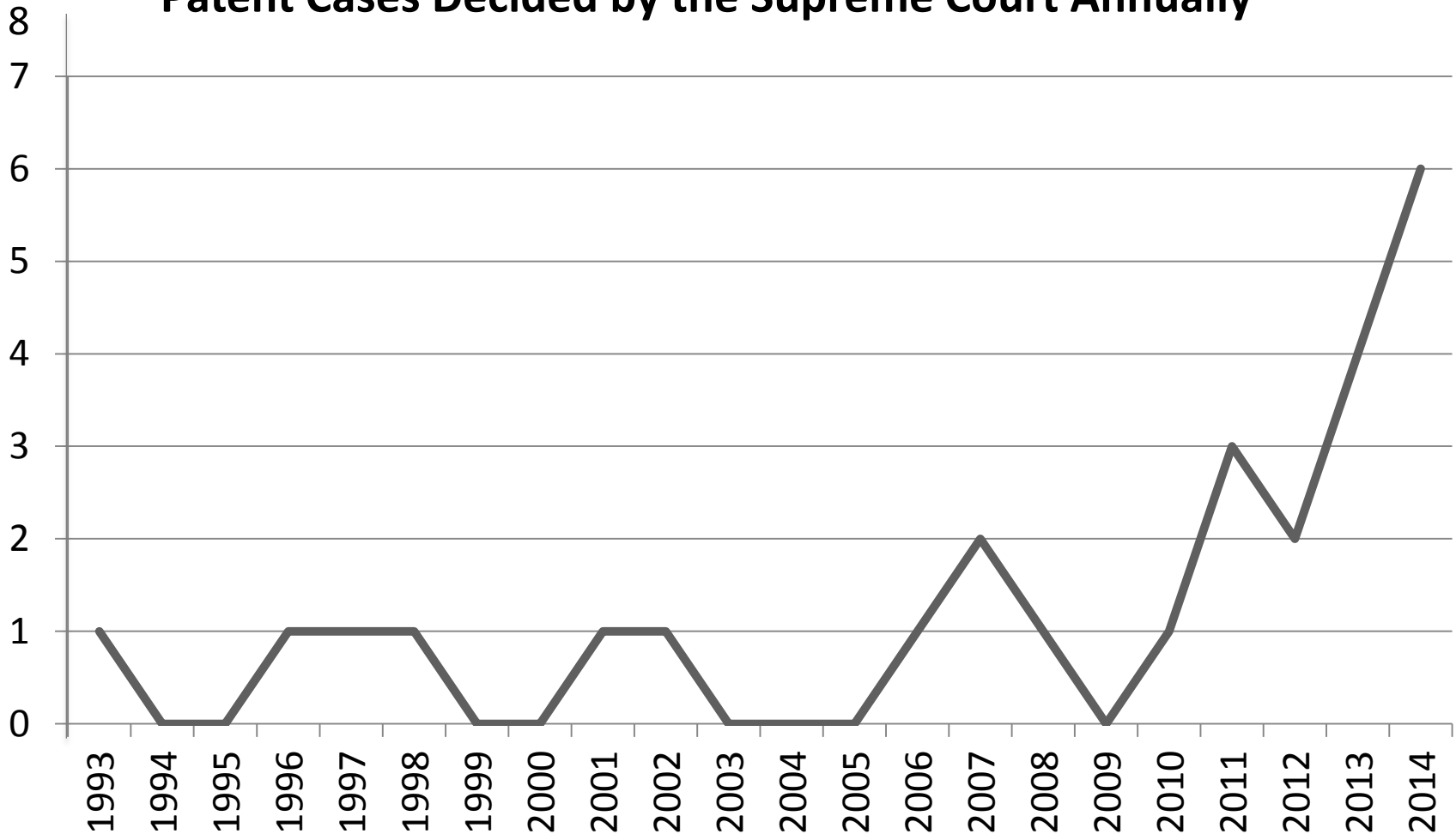
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*Hosted by NYIPLA Programs Committee Co-chairs: Colman Ragan, Robert Rando, Mark Bloomberg,  
Sub-committee Chair: Michael Johnson, and NJIPLA Joint Seminar Committee Co-chair: Nanette Thomas*

# SCOTUS Continues to Grant Certiorari in More Patent Cases

## Patent Cases Decided by the Supreme Court Annually



## **Alice Corp. v. CLS Bank, No. 13-298**

### **Holding:**

The claims of a computer-implemented invention drawn to an abstract idea are not patent-eligible under 35 U.S.C. § 101. In the first step of the *Mayo* analysis, the Court recognized that “[o]n their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.” In applying the second step of the *Mayo* analysis, the Court found that the mere addition of a computer was not “enough” to transform the claim from preempting an abstract idea into a practical application of that idea.

# *Inducement of Infringement by Multiple Actors*

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## ***Limelight Networks, Inc. v. Akamai Technologies, Inc., No. 12-768***

### **Holding:**

A party cannot be found liable for inducement when there is no one who can be found to infringe.

### **Not the Holding:**

*Muniauction's* single actor rule was presumed for purposes of the opinion but not decided or endorsed.

## *Attorney Fees and Fee Shifting*

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***Octane Fitness v. ICON Health & Fitness, No. 12-1184***

***Highmark Inc. v. Allcare Management Sys., No. 12-1163***

### **HOLDINGS:**

“[A]n ‘exceptional’ case is simply one that stands out from others with respect to the substantive strength of a party’s litigating position (considering both the governing law and the facts of the case) or the unreasonable matter in which the case was litigated.” *Octane*, at 7-8.

The “[d]istrict courts may determine whether a case is ‘exceptional’ in the case-by-case exercise of their discretion, considering the totality of the circumstances.” *Octane*, at 8.

# *Claim Definiteness*

## *- 35 U.S.C. § 112*

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### ***Nautilus, Inc. v. Biosig Instruments, Inc., No. 13-369***

#### **Holding:**

- ▶ Federal Circuit’s “insoluble ambiguity” test is wrong.
- ▶ New test:
  - “a patent is invalid for indefiniteness if its claims, read in light of the patent’s specification and prosecution history, fail to inform, with ***reasonable certainty***, those skilled in the art about the scope of the invention.”

# *Why is the Supreme Court Interested in Patent Law?*

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- ▶ **Monitoring the Federal Circuit's Application of Patent Law**
- ▶ **Addressing Increased Congressional Interest in Patent Law Reforms**

# *Why is Congress Seemingly So Interested in Patent Law?*

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- ▶ **Addressing Perceived Short-Comings in the Current Law**
- ▶ **Addressing Perceived Abuses in Patent Litigation**
- ▶ **Addressing Perceived Unfair Letter Writing Practices**



# *Is There Disagreement Between the Courts and Congress*

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▶ **Yes**

# *How Will All of This Affect Me, My Company, and My Clients*

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- ▶ **Supreme Court Decisions, and Subsequent Federal Circuit Decisions Implementing Them Have to Potential to Change Patent Law. Several Changes Have Already Occurred**
- ▶ **Congress May Enact Laws That Have Lasting Effects on Patent Assertions, Including Patent Litigation**