

**FEDERAL CIRCUIT SUMMARY FOR WEEK ENDING JULY 14, 2023**

**Axionics, Inc. v. Medtronic, Inc., No. 22-1451 (July 10, 2023) (precedential) (3-0); Patent Nos. 8,626,314; 8,036,756**

**Key point(s):**

- The claim, rather than the specification, defines the invention whose obviousness is being assessed.
- A skilled artisan may be motivated to combine particular features of different references to secure some benefits at the expense of others, even when bodily incorporation would be impossible or inadvisable.

**Facts/Background:** Axionics, having been sued by Medtronic for infringement, petitioned for IPR of Medtronic’s ‘314 and ‘756 patents, which share a specification and relate to a neurostimulation lead and a method for implanting and anchoring the lead. Axionics argued that a relevant artisan would have been motivated “to replace the one electrode of Young with multiple electrodes at the distal end distal to the anchoring mechanism, as taught in Gerber, in order to provide more flexibility in activation of a wider area and provide the possibility for bipolar electrical stimulation, as taught in Young.” The Board held all the challenged claims not unpatentable for obviousness. The Board found that “the relevant art is medical leads specifically for sacral neuromodulation,” J.A. 13; see J.A. 15, relying on the “field of the invention” statements to narrow the field in that way even though the claims are not limited to sacral nerves. The Board further found that the purpose of Young’s lead “is electrical stimulation of the trigeminal sensory root,” so Young’s sentence on improvement by adding electrodes would not have motivated a relevant artisan to combine Young’s lead with a plurality of electrodes distal to all of the tines (as taught in Gerber), because “such an arrangement would not be feasible in the trigeminal nerve region” given the tight tissue related spacing constraints of that particular nerve region. The Board therefore concluded that Axionics failed to prove that a relevant artisan would have been motivated to combine the teachings of Young and Gerber. Medtronic appealed.

**Holding:** Vacated and remanded. The Federal Circuit held that the Board committed “a fundamental legal error in confining the motivation inquiry to whether a motivation would exist to make the proposed combination for use in the Young-specific trigeminal-nerve context—to which the Medtronic patents are not limited.” The Federal Circuit also held that the Board was incorrect in its view that “the relevant art is medical leads specifically for sacral neuromodulation,” as the Medtronic patents’ claims are not limited to the sacral-nerve context and the shared specification, properly read, is not so limited either. The Federal Circuit further held that “the claim defines the invention whose obviousness is being assessed and ... a skilled artisan may be motivated to combine particular features of different references, e.g., to secure some benefits at the expense of others, even when bodily incorporation would be impossible or inadvisable.” As such, the Federal Circuit held that the Board erred in its limitation of “the relevant art” to sacral-nerve stimulation and in rejecting the asserted motivation to combine Young with Gerber and, therefore, the Federal Circuit vacated the Board’s judgment.

**In re Float'N'Grill, Inc., No. 22-1438 (July 12, 2022) (precedential) (3-0); Patent No. 9,771,132**

**Key point(s):**

- Reissue claims broadening a limitation to cover undisclosed alternatives to a particular feature appearing from the face of the original specification to be a necessary, critical, or essential part of the invention, do not meet the original patent requirement of § 251.

**Facts/Background:** Float'N'Grill LLC ("FNG") filed a reissue application for the '132 patent, which is directed to a float designed to support a grill to facilitate a user grilling food while remaining in a body of water, seeking broader claims. The specification of the '132 patent describes a single embodiment, which includes a plurality of magnets. The examiner rejected claims 4, 8, 10–13 and 19–22 as indefinite and claims 4, 8, 10–14, and 17–22 for failure to satisfy the reissue standard of 35 U.S.C. § 251. On appeal, the PTAB affirmed the examiner's rejections (except for indefiniteness of claims 19 and 20), finding that the plurality of magnets was a critical element of the invention, as the magnets alone are responsible for effecting a safe and stable attachment between the floating apparatus and the grill, and that the relevant claims of the reissue application did not include the plurality of magnets. FNG appealed to the Federal Circuit.

**Holding:** Affirmed. The Federal Circuit held that "the original specification describes a single embodiment of the invention characterized as a float apparatus having a grill support including a plurality of magnets for safely and removably securing the grill to the float" and that "[t]he plurality of magnets component of the grill support structure, which has been eliminated in the reissue claims, is the only disclosed component for removably securing the grill to the support." The Federal Circuit held that "reissue claims broadening a limitation to cover undisclosed alternatives to a particular feature appearing from the face of the original specification to be a necessary, critical, or essential part of the invention, do not meet the original patent requirement of § 251." In its decision, the Federal Circuit relied upon the U.S. Supreme Court Decision *U.S. Industrial Chemicals*, where "the original specification and claims treated the voluntary introduction of water as 'a necessary step' in the process" and the absence of the introduction of water "in the reissue claims rendered those claims invalid as directed to a different invention than originally disclosed." The Federal Circuit held that "just as the added water in *U.S. Industrial Chemicals* was 'not designated as optional or desirable but described and claimed as an integral part of the whole operation,' ... the plurality of magnets in FNG's specification was described in definitional and necessary terms." Thus, the Federal Circuit held that the Board did not err in affirming the rejection of reissue claims 4, 8, 10–14, and 17–22 for failure to satisfy the original patent requirement of § 251, and did not need to reach the issue of indefiniteness.

**Trinity Info Media, LLC v. Covalent, Inc., No. 22-1308 (July 14, 2023) (precedential) (3-0); Patent Nos. 9,087,321; 10,936,685**

**Key point(s):**

- Claims can be directed to an abstract idea even if the claims require generic computer components or require operations that a human could not perform as quickly as a computer.

**Facts/Background:** Trinity sued Covalent for infringement of claims of the '321 and '685 patents relating to methods and systems for connecting users based on their answers to polling questions. The district court granted Covalent's motion to dismiss, concluding that the asserted patents do not claim patentable subject matter under 35 U.S.C. § 101. In particular the district court held that the asserted claims were directed to the abstract idea of "matching users who gave corresponding answers to a question," did not contain an inventive concept, and did not improve computer functionality but instead used "generic computer components as tools to perform the functions faster than a human would." Trinity appealed.

**Holding:** Affirmed. The Federal Circuit held that "[a] human mind could review people's answers to questions and identify matches based on those answers," and therefore agreed with the district court that the independent claims of both patents are directed to an abstract idea, "matching based on questioning." The Federal Circuit held that the '685 patent's requirements that the abstract idea be performed on a "hand-held device" or that matches are "reviewable by swiping" did not alter its conclusion that the focus of the asserted claims remains directed to an abstract idea because linking an abstract idea to "a particular environment" or adding generic computing components does "not prevent the claim from being directed to an abstract idea." Regarding Trinity's argument that the claims recite a technical improvement, the Federal Circuit held that Trinity's "specifications frame the inventor's problem in terms of how to improve existing polling systems by performing progressive polling, not how to improve computer technology." Trinity argued that humans could not mentally engage in the "same claimed process" because they could not perform "nanosecond comparisons" and aggregate "result values with huge numbers of polls and members," nor could they select criteria using "servers, storage, identifiers, and/or thresholds." The Federal Circuit disagreed, holding that Trinity's arguments were not tethered to the asserted claims, which do not require "nanosecond comparisons" or aggregating "huge numbers of polls and members" and that "Trinity's asserted claims can be directed to an abstract idea even if the claims require generic computer components or require operations that a human could not perform as quickly as a computer." Regarding Trinity's arguments under Step 2 of the 101 *Alice* analysis that the asserted claims recite an inventive concept, the Federal Circuit held that Trinity's "conclusory allegations that the prior art lacked elements of the asserted claims are insufficient to demonstrate an inventive concept" and that the claims "do not provide an inventive concept by virtue of their use of multiple processors, match servers, unique identifications and/or a match aggregator." Thus, the Federal Circuit held that the asserted claims are patent ineligible under § 101 and affirmed the district court's judgment.

**SNIPR Technologies Limited v. Rockefeller University, No. 22-1260 (July 14, 2023) (precedential) (3-0); Patent Nos. 10,463,049; 10,506,812; 10,561,148; 10,524,477; 10,582,712**

**Key point(s):**

- Pure AIA patents may not be part of an interference.

**Facts/Background:** The PTAB declared an interference between claims 20–33 of the Rockefeller Application (15/159,929) and all claims of the SNIPR Patents (the ‘049, ‘812, ‘148, ‘477, and ‘712 patents) to determine which party was the first to invent the claimed subject matter after Rockefeller amended its claims to cover the same subject matter as the SNIPR Patents. The Rockefeller application was entitled to a pre-AIA priority date of February 7, 2013 while the SNIPR Patents had post-AIA priority dates. SNIPR moved to terminate the interference as contrary to the AIA because “interference[s are] unavailable to assess patents that are governed by the AIA.” The Board denied SNIPR’s motion, reasoning that pre-AIA patent claims (such as Rockefeller’s) must “comply with [pre-AIA] 35 U.S.C. § 102(g),” which requires an interference under pre-AIA § 135 between the claims of the Rockefeller Application and the SNIPR Patents. Because SNIPR had not filed any priority statement asserting an invention date earlier than Rockefeller’s earliest accorded benefit date, the Board found that SNIPR failed to overcome Rockefeller’s senior party status, and thus, the Board entered judgment against SNIPR and cancelled all claims of the SNIPR Patents. SNIPR appealed.

**Holding:** Reversed. The Federal Circuit held that “pure AIA patents may not be part of an interference.” Rockefeller and the Director argued that the SNIPR Patents can be subject to an interference based on the language “any unexpired patent” in pre-AIA § 135(a). The Federal Circuit disagreed, holding “[w]e do not interpret the language ‘any unexpired patent’ in pre-AIA § 135 to include pure AIA patents” and that “SNIPR’s pure AIA patents were examined and issued under the AIA’s first-inventor-to-file patentability requirements; they cannot then be cancelled under the different, pre-AIA invention priority requirements.” As such, the Federal Circuit held that “the Director erred by declaring an interference involving the SNIPR Patents.” The Federal Circuit held that “we must read pre-AIA § 135 in light of the AIA and its effective date provisions in AIA § 3(n).” Furthermore, the Federal Circuit held that interpreting “any unexpired patent” in pre-AIA § 135 to include pure AIA patents would “defeat a central purpose of the AIA” – namely, “to transition the U.S. patent system to a first-inventor-to-file system and eliminate the specter of interferences going forward for new applications.” Thus, because it was undisputed that the SNIPR Patents have an effective filing date after March 16, 2013 and are “pure AIA patents,” the Director erred by subjecting the SNIPR Patents to an interference.” Therefore, the Federal Circuit reversed the Board’s judgment.