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Supreme Court Rejects 10 Patent Cases

By **Dani Kass**

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Law360 (January 13, 2020, 6:47 PM EST) -- The U.S. Supreme Court on Monday turned away 10 patent cases, including ones looking at state sovereign immunity, the Patent Act's on-sale bar and the Federal Circuit's one-line orders.

Five of the rejections deal with patent eligibility, but the other five cover a broader range of patent law, including written description requirements and the so-called relation back doctrine.

Here's a look at the non-eligibility cases. Unless otherwise specified, the parties didn't respond to requests for comment on Monday.

Regents of the University of Minnesota, Petitioner v. LSI Corp.

The University of Minnesota had **asked the Supreme Court** in September to hold that it's entitled to sovereign immunity in challenges at the Patent Trial and Appeal Board, after the Federal Circuit found otherwise. The university warned that without its immunity protections, billions of dollars in patent rights will be up in the air.

The appeal combined cases from Ericsson Inc., LSI and Avago Technologies, and Gilead Sciences Inc.

Ericsson had asked the justices to **hold off** until **uncertainty** created by the Federal Circuit's October decision in Arthrex v. Smith & Nephew was resolved. That case placed the entire structure of the PTAB in flux, Ericsson said.

LSI and Ericsson also said the case fails on the merits, as the Supreme Court made it clear last year that the government can face inter partes reviews. The companies pointed to a high-profile **Federal Circuit decision** in which the court said Native American tribes are not immune from IPRs and which the justices declined to review.

Representatives for the university and counsel for LSI and Avago declined to comment.

The university is represented by Goldstein & Russell PC and Wolf Greenfield & Sacks PC.

LSI and Avago are represented by Kilpatrick Townsend & Stockton LLP. Ericsson is represented

by Orrick Herrington & Sutcliffe LLP. Gilead is represented by Bartlit Beck LLP.

The case is Regents of the University of Minnesota, Petitioner v. LSI Corp. et al., case number 19-337, in the Supreme Court of the United States.

Medtronic Inc. v. Mark A. Barry

Medtronic's **September petition** claimed that the Federal Circuit added a new requirement to the on-sale bar rule when upholding a $23.5 million patent infringement verdict against the company.

The **panel had been divided** on whether Dr. Mark Barry's patents were invalid under the rule, which blocks patents from being issued if the invention was on sale or in public use and "ready for patenting" more than a year before the patent filing. The doctor-inventor had been using the invention in surgeries before filing for his patents.

The majority ruled that the bar didn't apply, because Barry's invention was not "ready for patenting," as it didn't yet work for its "intended purpose." But Medtronic said the majority's additional "intended purpose" requirement conflicts with high court precedent.

Medtronic is represented by WilmerHale.

Barry is represented by Kilpatrick Townsend & Stockton LLP.

The case is Medtronic Inc. v. Barry, case number 19-414, in the Supreme Court of the United States.

Chestnut Hill Sound Inc. v. Apple Inc.

The Supreme Court **once again** refused to take up a challenge to the Federal Circuit's one-line orders.

Chestnut Hill's **October petition** said that orders in which the judges give no insight on their reasoning are issued disproportionately to patent owners. They wanted the justices to block the orders altogether, or at least mandate some parity on who is entitled to fleshed-out opinions.

Apple had successfully challenged Chestnut Hill's audio entertainment system patent at the PTAB, and the Federal Circuit **upheld that ruling** with a one-line order.

Chestnut Hill is represented Glast Phillips & Murray PC.

Apple is represented by Fish & Richardson PC.

The case is Chestnut Hill Sound Inc. v. Apple Inc., case number 19-591, in the Supreme Court of the United States.

Nuvo Pharmaceuticals v. Dr. Reddy's Laboratories Inc.

Also in October, Horizon Therapeutics PLC and partner Nuvo Pharmaceuticals brought up an issue of **written description requirements** in a case over its pain reliever Vimovo. The **Federal Circuit had invalidated** two patents covering Vimovo for failing to satisfy those requirements.

The companies argued that the Federal Circuit heightened the standard for patenting new drugs by requiring companies to prove that new inventions are effective to satisfy written description requirements. They said companies need to seek patent protections before clinical trials.

The decision was a victory for Dr. Reddy's, Mylan Inc. and Lupin Ltd., which all have generic versions of Vimovo in the works.

Counsel for Lupin and Dr. Reddy's declined to comment.

Nuvo is represented by Baker Botts LLP. Horizon is represented by Finnegan Henderson Farabow Garrett & Dunner LLP.

Dr. Reddy's is represented by Kirkland & Ellis LLP. Mylan is represented by Perkins Coie LLP. Lupin is represented by Schiff Hardin LLP.

The case is Nuvo Pharmaceuticals (Ireland) Designated Activity Co. et al. v. Dr. Reddy's Laboratories Inc. et al., case number 19-584, in the Supreme Court of the United States.

Mushkin Inc. v. Anza Technology

Finally, in November, computer memory company Mushkin **asked the justices** to set a definitive standard to review the "relation back" doctrine, saying the Federal Circuit enhanced a circuit split when allowing Anza to switch out the patents it was asserting against Mushkin.

According to Mushkin, there was already a two-way circuit split over when to allow an amended pleading to take the date of the original pleading under the doctrine — which can help dodge time bars — and the Federal Circuit added a third with its **August ruling**. The company asked the Supreme Court to set a standard once and for all — just not the Federal Circuit's more liberal one.

Mushkin is represented by Senter Goldfarb & Rice LLC.

Anza is represented by Polsinelli PC.

The case is Mushkin Inc. v. Anza Technology Inc., case number 19-610, in the Supreme Court of the United States.

--Additional reporting by Tiffany Hu and Adam Lidgett. Editing by Nicole Bleier.