



Invalidation of Certain Claims under § 101 Does Not Preclude All Claims of the Same Patent

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Defendant relied on Federal Circuit precedent that “complete identity of claims is not required to satisfy the identity of issues requirement for claim preclusion,” and argued that claim preclusion applied to the non-adjudicated patent claims because those claims did not materially alter the question of invalidity.

Although the court precluded infringement allegations for many of the previously non-adjudicated claims, it denied summary judgment for some of the claims that had non-generic claim elements. Defendant had argued that the additional non-generic elements were well known in the prior art, and therefore added nothing of patentable significance. The court, however, disagreed. “[I]t does not follow that the inclusion of any previously known element in a claim necessarily defeats subject matter eligibility. If that were so, then obviousness under § 103 would always default to ineligibility under § 101.”

Exergen Corp. v. Kaz USA, Inc., 1-13-cv-10628 (D. Ma. December 7, 2015).

Categories

District Court

35 U.S.C. § 101

Invalidity

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