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Federal Circuit Update (February 2024)

Client Alert | March 5, 2024

This edition of Gibson Dunn's Federal Circuit Update for February 2024 summarizes the current status of several petitions pending before the Supreme Court, and recent Federal Circuit decisions concerning printed publications, written description, claim construction, and inequitable conduct.

Federal Circuit News

Noteworthy Petitions for a Writ of Certiorari: There were no new potentially impactful petitions filed before the Supreme Court in February 2024. We provide an update below of the petitions pending before the Supreme Court that were summarized in our January 2024 update:

- In ***Vanda Pharmaceuticals Inc. v. Teva Pharmaceuticals USA, Inc.*** (US No. 23-768), after the respondents waived their right to file a response, the Court requested a response, which is due March 18, 2024. Three *amicus curiae* briefs have been filed.
- In ***Ficep Corp. v. Peddinghaus Corp.*** (US No. 23-796), the respondent filed its opposition brief on February 23, 2024.
- The Court denied the petitions in ***Liquidia Technologies, Inc. v. United Therapeutics Corp.*** (US No. 23-804) and ***VirnetX Inc. v. Mangrove Partners Master Fund, Ltd.*** (US No. 23-315).

Federal Circuit Practice Update ***Promptu Systems Corp. v. Comcast Corp. et al.***, No. 22-1093 (Fed. Cir. Feb. 16, 2024): The Federal Circuit (Moore, C.J., Prost and Taranto, JJ. (per curiam)) issued *sua sponte* an order in four related cases (Nos. 19-2368 (consolidated with 19-2369), 20-1253, 22-1093, 22-1939) clarifying that Rule 28 of the Federal Rules of Appellate Procedure prohibits counsel from exceeding the word count through incorporation by reference. The appellee incorporated by reference multiple pages of argument from the brief in one case into another and was asked by the Court why appellee should not be sanctioned. Although the Court chose not to award sanctions in this case, it made clear that "violating these provisions in the future will likely result in sanctions." ***New Oral Argument Scheduling Conflicts Guidance***. On February 26, 2024, the clerk's office provided guidance clarifying what would be considered allowable and unallowable scheduling conflicts for upcoming oral argument sessions. This guidance is published here.

Upcoming Oral Argument Calendar

The list of upcoming arguments at the Federal Circuit is available on the court's website.

Key Case Summaries (February 2024)

Weber, Inc. v. Provisur Technologies, Inc., No. 22-1751, 22-1813 (Fed. Cir. Feb. 8, 2024): Weber filed petitions for *inter partes* review ("IPR") against Provisur's patents directed to high-speed mechanical slicers used in food processing plants to slice and package foods, like meats and cheeses. The invalidity grounds asserted in the IPR petitions included combinations based on Weber's operating manuals. The Patent Trial and Appeal Board ("Board") concluded that Weber's operating manuals were not prior art

Related People

Blaine H. Evanson

Jaysen S. Chung

Audrey Yang

Vivian Lu

Julia G. Tabat

Michelle J. Zhu

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printed publications. The panel (Reyna, J., joined by Hughes and Stark, JJ.) reversed-in-part, vacated-in-part, and remanded. The Court concluded that Weber's operating manuals were printed publications because they were intended to be "accessible to interested members of the relevant public by reasonable diligence" and were not subject to confidentiality restrictions by Weber's copyright notice and terms and conditions. ***RAI Strategic Holdings, Inc. v. Philip Morris Products, S.A.***, No. 22-1862 (Fed. Cir. Feb. 9, 2024): Philip Morris filed a petition for post-grant review challenging RAI's patent directed to electrically powered smoking articles. The Board found that the claims lacked written description support because the claimed "length of about 75% to 85% of a length of the disposable aerosol forming substance" for the heating member was narrower than the ranges disclosed in the specification. Specifically, the specification disclosed ranges of 75% to 125%, 85% to 110%, and 90% to 110%. No range disclosed in the specification contained the upper limit of 85%. The Federal Circuit (Stoll, J., joined by Chen and Cunningham, JJ.) affirmed-in part, vacated-in-part, and remanded. The Court vacated the Board's determination that the broader ranges disclosed in the specification did not provide written description support for the narrower claimed range. "Given the predictability of electro-mechanical inventions such as the one at issue here, and the lack of complexity of the particular claim limitation at issue—*i.e.*, reciting the length of a heating member—a lower level of detail is required to satisfy the written description requirement than for unpredictable arts." Specifically, there was no evidence that changing the length of the heating member changed the invention's operability, effectiveness, or other parameters. ***Promptu Systems Corp. v. Comcast Corp. et al.***, No. 22-1939 (Fed. Cir. Feb. 16, 2024): Promptu sued Comcast for infringing Promptu's patents directed to speech recognition technology. Promptu stipulated to non-infringement under the district court's constructions, and challenged the constructions on appeal. The Federal Circuit (Taranto, J., joined by Moore, C.J., and Prost, J.) vacated and remanded. The Court held that the district court erred or erred-in-part in its construction of four claims terms because the constructions were not consistent with disclosures in the specification. The Court additionally explained that "only those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy." Thus, although the Court determined that the district court's construction of certain terms were too narrow, it was unclear what aspects of those terms needed clarification "for resolution of the liability issues." The Court therefore remanded to the district court to make that determination in the first instance. ***Freshub, Inc. v. Amazon.com, Inc.***, No. 22-1391 (Fed. Cir. Feb. 26, 2024): Freshub sued Amazon for infringing Freshub's patent related to voice-processing technology. Amazon denied infringement and asserted the defense that the patents are unenforceable due to inequitable conduct committed by Freshub's parent company, Ikan Holdings LLC. Specifically, Amazon argued when Ikan revived the abandoned patent application from which the asserted patents claim priority, Ikan had intentionally misrepresented to the U.S. Patent and Trademark Office ("PTO") that the application had been unintentionally abandoned when the abandonment was actually intentional. A jury found Amazon did not infringe the patents. Subsequently, the district court held a bench trial on the inequitable conduct claim, but found that Amazon had failed to prove the inequitable conduct by clear and convincing evidence. The Federal Circuit (Taranto, J., joined by Reyna and Chen, JJ.) affirmed. The claim limitation at issue was whether Amazon's shopping list met the "identify an item" limitation. Amazon presented evidence that the shopping-list feature added words to a shopping list whether or not it corresponded to a purchasable item, and therefore, did not meet the limitation. Although there was no claim construction narrowing the meaning of "item" to only purchasable items, this was one reasonable interpretation of the claim language, and therefore, the Court determined that substantial evidence supported the jury's finding of noninfringement. The Court also affirmed the district court's rejection of Amazon's inequitable conduct defense. "To prevail on the defense of inequitable conduct, the accused infringer must prove that the applicant misrepresented or omitted material information with the specific intent to deceive the PTO." *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276, 1287 (Fed. Cir. 2011) (en banc). While the Court found that Amazon had presented evidenced that Ikan's counsel knew that the application had been abandoned, the Court determined that Amazon had not presented by clear and convincing evidence that Ikan intentionally abandoned the application. The Court

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determined that Amazon therefore could not show that counsel's statement that the abandonment was unintentional was made with the specific intent to deceive the PTO.

The following Gibson Dunn lawyers assisted in preparing this update: Blaine Evanson, Jaysen Chung, Audrey Yang, Vivian Lu, Julia Tabat, and Michelle Zhu. Gibson Dunn's lawyers are available to assist in addressing any questions you may have regarding developments at the Federal Circuit. Please contact the Gibson Dunn lawyer with whom you usually work, any leader or member of the firm's Appellate and Constitutional Law or Intellectual Property practice groups, or the following authors: Blaine H. Evanson – Orange County (+1 949.451.3805, bevanson@gibsondunn.com) Audrey Yang – Dallas (+1 214.698.3215, ayang@gibsondunn.com) **Appellate and Constitutional Law**: Thomas H. Dupree Jr. – Washington, D.C. (+1 202.955.8547, tdupree@gibsondunn.com) Allyson N. Ho – Dallas (+1 214.698.3233, aho@gibsondunn.com) Julian W. Poon – Los Angeles (+ 213.229.7758, jpoon@gibsondunn.com) **Intellectual Property**: Kate Dominguez – New York (+1 212.351.2338, kdominguez@gibsondunn.com) Y. Ernest Hsin – San Francisco (+1 415.393.8224, ehsin@gibsondunn.com) Josh Krevitt – New York (+1 212.351.4000, jkrevitt@gibsondunn.com) Jane M. Love, Ph.D. – New York (+1 212.351.3922, jlove@gibsondunn.com) © 2024 Gibson, Dunn & Crutcher LLP. All rights reserved. For contact and other information, please visit us at www.gibsondunn.com. Attorney Advertising: These materials were prepared for general informational purposes only based on information available at the time of publication and are not intended as, do not constitute, and should not be relied upon as, legal advice or a legal opinion on any specific facts or circumstances. Gibson Dunn (and its affiliates, attorneys, and employees) shall not have any liability in connection with any use of these materials. The sharing of these materials does not establish an attorney-client relationship with the recipient and should not be relied upon as an alternative for advice from qualified counsel. Please note that facts and circumstances may vary, and prior results do not guarantee a similar outcome.

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