

GIBSON DUNN

Federal Circuit Year in Review 2017/2018

Intellectual Property and Appellate Practice Groups



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INTRODUCTION

The Federal Circuit's 2017-2018 term saw a number of important developments in patent law. The court issued published opinions in a total of 140 cases, including four en banc decisions. Among the significant decisions issued by the court were:

- In *In re Cray Inc.*, 871 F.3d 1355 (Fed. Cir. 2017), the Federal Circuit held that the homes of employees who worked from home were not regular and established places of business for purposes of the venue analysis.
- In *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017) (en banc), the en banc court held that the petitioner—not the patent owner—bears the burden of persuasion with respect to patentability of amended claims.
- In *MasterMine Software, Inc. v. Microsoft Corp.*, 874 F.3d 1307 (Fed. Cir. 2017), the Federal Circuit held that, while claims can be indefinite if they cover both an apparatus and a method of use of that apparatus, they are not indefinite if they make clear whether infringement occurs upon creating the apparatus or upon its use.

There are several notable trends borne out by the statistics this year. For example, the percentage of appeals from the PTO compared to from the district court continues to creep up, with 42% of appeals coming from the PTO this term, up from 36% last term and 31% the prior term. The time from oral argument to written decision dropped this term, down to 157 days on average from 182 days last term. The total time from docketing to Federal Circuit decision, however, increased to 518 days from 464 days last term. This term also saw the number of appeals from the District of Delaware continue to increase, with nearly double the number of appeals from decisions from the Eastern District of Texas.

There are more analytics in the pages that follow, as well as summaries of the precedential decisions from the Federal Circuit this term. We hope this information serves you well this coming year. As always, if we can answer any questions, please do not hesitate to contact us.



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STATISTICAL ANALYSIS
(August 1, 2017 – July 31, 2018)

Number of Precedential Patent Cases Decided:	140
Average Time:	
Lower Tribunal Decision to Federal Circuit Oral Argument	433 Days
Lower Tribunal Decision to Federal Circuit Decision	572 Days
Docketing to Federal Circuit Oral Argument	375 Days
Docketing to Federal Circuit Decision	518 Days
Oral Argument to Federal Circuit Decision	157 Days
Number of <i>En Banc</i> Cases Decided	4
Judge Authoring the Most Opinions	Newman (25)
Judge Authoring the Most Majority Opinions	Lourie (17)
Judges Authoring the Fewest Majority Opinions	Tie: Clevenger (0), Plager (0), Schall (0)
Judges Authoring the Most Concurring Opinions	Newman (4)
Judge Authoring the Most Dissenting Opinions	Newman (13)
Judge Authoring the Fewest Dissenting Opinions	Tie: Bryson (0), Chen (0), Clevenger (0), Dyk (0), Mayer (0), Moore (0), O'Malley (0), Stoll (0)
Judge Authoring the Most Unanimous Decisions	Lourie (13)
Top 5 District Courts in Number of Appeals	District of Delaware (41) Eastern District of Texas (22) Central District of California (13) Northern District of California (7) Northern District of Illinois (6)
Number of Cases With Amicus Briefs	17
District Court (% of cases)	55%
PTO (% of cases)	42%
ITC (% of cases)	1%
CFC (% of cases)	1%
Final Decisions on Validity of the Patent	Valid 26 / Invalid 39 / Both 6
Percentage of Cases Involving:	
Chemical/Pharmaceutical	21%
Biotech/Medical Device	11%
Software/Electrical	38%
Business Method	4%
Mechanical	26%



**TOP ISSUES BEFORE THE FEDERAL CIRCUIT
(BY NUMBER)**

§ 103 / Obviousness	50
§ 102 / Anticipation	27
Claim construction	24
Jurisdiction, Venue, Standing	22
Infringement	20

OVERALL WIN RATE FOR PATENTEE/OPPONENT

Patentee Won	41%	105
Opponent Won	50%	130
Both Won	4%	10
Neither Won	5%	13

PATENTEE AND OPPONENT WIN RATE BY ISSUE

Issue	Patentee	Opponent	Both	Neither
§ 101 / Subject matter eligibility	36%	57%	7%	0%
§ 102 / Anticipation	48%	48%	0%	4%
§ 103 / Obviousness	36%	56%	2%	6%
§ 112 / Written description, Enablement, Definiteness	58%	33%	0%	8%
America Invents Act (AIA)	27%	73%	0	0%
BPCIA	0%	0%	0%	0%
Claim construction	42%	58%	0%	0%
Design Patents	0%	0%	0%	0%
District court procedures	33%	60%	7%	0%
Double Patenting	50%	50%	0%	0%
Federal Circuit procedures	50%	50%	0%	0%
First sale doctrine / implied license / exhaustion	0%	0%	0%	0%
Hatch-Waxman Act procedures	100%	0%	0%	0%
Inequitable conduct	33%	67%	0%	0%
Infringement	55%	35%	5%	5%
Injunctive relief	25%	50%	25%	0%
Inventorship, Interference, Derivation	0%	50%	50%	0%
ITC Procedures	0%	0%	0%	0%
Jurisdiction, Venue, Standing	36%	50%	5%	9%
Laches, Estoppel	50%	50%	0%	0%
Level of skill in the art	0%	100%	0%	0%
Monetary relief	36%	36%	21%	7%
Ownership, Assignments, Recording in PTO	0%	100%	0%	0%
Priority, Conception, Reduction to Practice, Diligence	43%	43%	0%	14%
PTO procedures	40%	47%	0%	13%
Willful infringement	50%	33%	0%	17%

**TOP ISSUES THAT PATENTEE WON
(FREQUENCY OF PREVAILING)**

Hatch-Waxman Act procedures	100%
§ 112 / Written description, Enablement, Definiteness	58%
Infringement	55%
Double Patenting	50%
Federal Circuit procedures	50%
Laches, Estoppel	50%
Willful infringement	50%

**TOP ISSUES THAT PATENTEE WON
(BY NUMBER OF CASES)**

§ 103 / Obviousness	18
§ 102 / Anticipation	13
Infringement	11
Claim construction	10
Jurisdiction, Venue, Standing	8

**TOP ISSUES THAT OPPONENT WON
(FREQUENCY OF PREVAILING)**

Level of skill in the art	100%
Ownership, Assignments, Recording in PTO	100%
America Invents Act (AIA)	73%
Inequitable conduct	67%
District court procedures	60%

**TOP ISSUES THAT OPPONENT WON
(BY NUMBER OF CASES)**

§ 103 / Obviousness	28
Claim construction	14
§ 102 / Anticipation	13
Jurisdiction, Venue, Standing	11
District court procedures	9

**TOP ISSUES THAT BOTH PATENTEE AND OPPONENT WON
(FREQUENCY OF PREVAILING)**

Inventorship, Interference, Derivation	50%
Injunctive relief	25%
Monetary relief	21%
§ 101 / Subject matter eligibility	7%
District court procedures	7%

**TOP ISSUES THAT BOTH PATENTEE AND OPPONENT WON
(BY NUMBER OF CASES)**

Monetary relief	3
Inventorship, Interference, Derivation	1
Injunctive relief	1
§ 101 / Subject matter eligibility	1
District court procedures	1
Infringement	1
Jurisdiction, Venue, Standing	1
§ 103 / Obviousness	1

**TOP ISSUES THAT NEITHER PATENTEE NOR OPPONENT WON
(FREQUENCY OF PREVAILING)**

Willful infringement	17%
Priority, Conception, Reduction to Practice, Diligence	14%
PTO procedures	13%
Jurisdiction, Venue, Standing	9%
§ 112 / Written description, Enablement, Definiteness	8%

**TOP ISSUES THAT NEITHER PATENTEE NOR OPPONENT WON
(BY NUMBER OF CASES)**

§ 103 / Obviousness	3
PTO procedures	2
Jurisdiction, Venue, Standing	2
Willful infringement	1
Priority, Conception, Reduction to Practice, Diligence	1
§ 112 / Written description, Enablement, Definiteness	1
Monetary relief	1
Infringement	1
§ 102 / Anticipation	1

OVERALL ISSUE AFFIRMANCE/REVERSAL RATE

Affirmed	59%	151
Reversed	29%	76
Both	6%	15
Neither	6%	16

AFFIRMANCE/REVERSAL RATE PER ISSUE

Issue	Affirmed	Reversed	Both	Neither
§ 101 / Subject matter eligibility	71%	14%	14%	0%
§ 102 / Anticipation	67%	33%	0%	0%
§ 103 / Obviousness	66%	24%	10%	0%
§ 112 / Written description, Enablement, Definiteness	67%	33%	0%	0%
America Invents Act (AIA)	45%	45%	0%	9%
BPCIA	0%	0%	0%	0%
Claim construction	75%	25%	0%	0%
Design Patents	0%	0%	0%	0%
District court procedures	40%	53%	7%	0%
Double Patenting	100%	0%	0%	0%
Federal Circuit procedures	0%	0%	0%	100%
First sale doctrine / implied license / exhaustion	0%	0%	0%	0%
Hatch-Waxman Act procedures	100%	0%	0%	0%
Inequitable conduct	100%	0%	0%	0%
Infringement	70%	20%	10%	5%
Injunctive relief	25%	50%	25%	0%
Inventorship, Interference, Derivation	50%	0%	50%	0%
ITC Procedures	0%	0%	0%	0%
Jurisdiction, Venue, Standing	41%	27%	0%	32%
Laches, Estoppel	50%	50%	0%	0%
Level of skill in the art	100%	0%	0%	0%
Monetary relief	29%	50%	21%	0%
Ownership, Assignments, Recording in PTO	100%	0%	0%	0%
Priority, Conception, Reduction to Practice, Diligence	71%	29%	0%	0%
PTO procedures	33%	33%	0%	27%
Willful infringement	50%	33%	0%	17%

**TOP ISSUES AFFIRMED BY THE FEDERAL CIRCUIT
(BY FREQUENCY PERCENTAGE)**

Level of skill in the art	100%
Inequitable conduct	100%
Ownership, Assignments, Recording in PTO	100%
Double Patenting	100%
Hatch-Waxman Act procedures	100%

**TOP ISSUES AFFIRMED BY THE FEDERAL CIRCUIT
(BY NUMBER OF CASES)**

§ 103 / Obviousness	33
§ 102 / Anticipation	18
Claim construction	18
Infringement	14
§ 101 / Subject matter eligibility	10

**TOP ISSUES REVERSED BY THE FEDERAL CIRCUIT
(BY FREQUENCY PERCENTAGE)**

District court procedures	53%
Injunctive relief	50%
Monetary relief	50%
Laches, Estoppel	50%
America Invents Act (AIA)	45%

**TOP ISSUES REVERSED BY THE FEDERAL CIRCUIT
(BY NUMBER OF CASES)**

§ 103 / Obviousness	12
§ 102 / Anticipation	9
District court procedures	8
Monetary relief	7
Jurisdiction, Venue, Standing	6
Claim construction	6

**TOP ISSUES BOTH AFFIRMED AND REVERSED BY THE FEDERAL CIRCUIT
(BY FREQUENCY PERCENTAGE)**

Inventorship, Interference, Derivation	50%
Injunctive relief	25%
Monetary relief	21%
§ 101 / Subject matter eligibility	14%
§ 103 / Obviousness	10%
Infringement	10%

**TOP ISSUES BOTH AFFIRMED AND REVERSED BY THE FEDERAL CIRCUIT
(BY NUMBER OF CASES)**

§ 103 / Obviousness	5
Monetary relief	3
Infringement	2
§ 101 / Subject matter eligibility	2
District court procedures	1
Injunctive relief	1
Inventorship, Interference, Derivation	1

**TOP ISSUES NEITHER AFFIRMED NOR REVERSED BY THE FEDERAL CIRCUIT
(BY FREQUENCY PERCENTAGE)**

Federal Circuit procedures	100%
Jurisdiction, Venue, Standing	32%
PTO procedures	27%
Willful infringement	17%
America Invents Act (AIA)	9%

**TOP ISSUES NEITHER AFFIRMED NOR REVERSED BY THE FEDERAL CIRCUIT
(BY NUMBER OF CASES)**

Jurisdiction, Venue, Standing	7
PTO procedures	4
Federal Circuit procedures	2
Infringement	1
America Invents Act (AIA)	1
Willful infringement	1

FREQUENCY THAT COURT, AGENCY, OR JURY DECIDED ISSUE BELOW

District Court	46%	119
Agency	44%	115
Jury	6%	16
None	3%	9

**BREAKDOWN BY ISSUE:
WHETHER COURT, AGENCY, OR JURY DECIDED ISSUE BELOW**

Issue	Court	Agency	Jury	None
§ 101 / Subject matter eligibility	86%	14%	0%	0%
§ 102 / Anticipation	15%	78%	7%	0%
§ 103 / Obviousness	22%	74%	4%	0%
§ 112 / Written description, Enablement, Definiteness	67%	25%	8%	0%
America Invents Act (AIA)	18%	73%	0%	9%
BPCIA	0%	0%	0%	0%
Claim construction	29%	71%	0%	0%
Design Patents	0%	0%	0%	0%
District court procedures	100%	0%	0%	0%
Double Patenting	50%	50%	0%	0%
Federal Circuit procedures	0%	0%	0%	100%
First sale doctrine / implied license / exhaustion	0%	0%	0%	0%
Hatch-Waxman Act procedures	100%	0%	0%	0%
Inequitable conduct	100%	0%	0%	0%
Infringement	67%	10%	24%	0%
Injunctive relief	100%	0%	0%	0%
Inventorship, Interference, Derivation	0%	100%	0%	0%
ITC Procedures	0%	0%	0%	0%
Jurisdiction, Venue, Standing	68%	9%	0%	23%
Laches, Estoppel	50%	50%	0%	0%
Level of skill in the art	0%	100%	0%	0%
Monetary relief	71%	7%	21%	0%
Ownership, Assignments, Recording in PTO	100%	0%	0%	0%
Priority, Conception, Reduction to Practice, Diligence	14%	71%	14%	0%
PTO procedures	20%	73%	0%	7%
Willful infringement	67%	0%	33%	0%

AFFIRMANCE/REVERSAL RATE OF ISSUES DECIDED BY A COURT

COURT DECISIONS				
Issue	Affirm	Reverse	Both	Neither
§ 101 / Subject matter eligibility	75%	17%	8%	0%
§ 102 / Anticipation	50%	50%	0%	0%
§ 103 / Obviousness	82%	18%	0%	0%
§ 112 / Written description, Enablement, Definiteness	50%	50%	0%	0%
America Invents Act (AIA)	50%	50%	0%	0%
BPCIA	0%	0%	0%	0%
Claim construction	86%	14%	0%	0%
Design Patents	0%	0%	0%	0%
District court procedures	40%	53%	7%	0%
Double Patenting	100%	0%	0%	0%
Federal Circuit procedures	0%	0%	0%	0%
First sale doctrine / implied license / exhaustion	0%	0%	0%	0%
Hatch-Waxman Act procedures	100%	0%	0%	0%
Inequitable conduct	100%	0%	0%	0%
Infringement	71%	21%	0%	7%
Injunctive relief	25%	50%	25%	0%
Inventorship, Interference, Derivation	0%	0%	0%	0%
ITC Procedures	0%	0%	0%	0%
Jurisdiction, Venue, Standing	60%	33%	0%	7%
Laches, Estoppel	50%	50%	0%	0%
Level of skill in the art	0%	0%	0%	0%
Monetary relief	30%	50%	20%	0%
Ownership, Assignments, Recording in PTO	100%	0%	0%	0%
Priority, Conception, Reduction to Practice, Diligence	100%	0%	0%	0%
PTO procedures	67%	0%	0%	33%
Willful infringement	50%	25%	0%	25%

AFFIRMANCE/REVERSAL RATE OF ISSUES DECIDED BY AGENCY

AGENCY DECISIONS				
Issue	Affirm	Reverse	Both	Neither
§ 101 / Subject matter eligibility	50%	0%	50%	0%
§ 102 / Anticipation	67%	33%	0%	0%
§ 103 / Obviousness	59%	27%	14%	0%
§ 112 / Written description, Enablement, Definiteness	100%	0%	0%	0%
America Invents Act (AIA)	50%	50%	0%	0%
BPCIA	0%	0%	0%	0%
Claim construction	71%	29%	0%	0%
Design Patents	0%	0%	0%	0%
District court procedures	0%	0%	0%	0%
Double Patenting	100%	0%	0%	0%
Federal Circuit procedures	0%	0%	0%	0%
First sale doctrine / implied license / exhaustion	0%	0%	0%	0%
Hatch-Waxman Act procedures	0%	0%	0%	0%
Inequitable conduct	0%	0%	0%	0%
Infringement	100%	0%	0%	0%
Injunctive relief	0%	0%	0%	0%
Inventorship, Interference, Derivation	50%	0%	50%	0%
ITC Procedures	0%	0%	0%	0%
Jurisdiction, Venue, Standing	0%	50%	0%	50%
Laches, Estoppel	50%	50%	0%	0%
Level of skill in the art	100%	0%	0%	0%
Monetary relief	100%	0%	0%	0%
Ownership, Assignments, Recording in PTO	0%	0%	0%	0%
Priority, Conception, Reduction to Practice, Diligence	60%	40%	0%	0%
PTO procedures	30%	50%	0%	20%
Willful infringement	0%	0%	0%	0%

AFFIRMANCE/REVERSAL RATE OF ISSUES DECIDED BY JURY

JURY DECISIONS				
Issue	Affirm	Reverse	Both	Neither
§ 101 / Subject matter eligibility	0%	0%	0%	0%
§ 102 / Anticipation	100%	0%	0%	0%
§ 103 / Obviousness	100%	0%	0%	0%
§ 112 / Written description, Enablement, Definiteness	100%	0%	0%	0%
America Invents Act (AIA)	0%	0%	0%	0%
BPCIA	0%	0%	0%	0%
Claim construction	0%	0%	0%	0%
Design Patents	0%	0%	0%	0%
District court procedures	0%	0%	0%	0%
Double Patenting	0%	0%	0%	0%
Federal Circuit procedures	0%	0%	0%	0%
First sale doctrine / implied license / exhaustion	0%	0%	0%	0%
Hatch-Waxman Act procedures	0%	0%	0%	0%
Inequitable conduct	0%	0%	0%	0%
Infringement	40%	20%	40%	0%
Injunctive relief	0%	0%	0%	0%
Inventorship, Interference, Derivation	0%	0%	0%	0%
ITC Procedures	0%	0%	0%	0%
Jurisdiction, Venue, Standing	0%	0%	0%	0%
Laches, Estoppel	0%	0%	0%	0%
Level of skill in the art	0%	0%	0%	0%
Monetary relief	0%	67%	33%	0%
Ownership, Assignments, Recording in PTO	0%	0%	0%	0%
Priority, Conception, Reduction to Practice, Diligence	100%	0%	0%	0%
PTO procedures	0%	0%	0%	0%
Willful infringement	50%	50%	0%	0%

AFFIRMANCE/REVERSAL RATE BASED ON DISTRICT

Source	Affirm	Reverse	Both	Neither
Middle District of Alabama	0%	0%	0%	0%
Northern District of Alabama	0%	0%	0%	0%
Southern District of Alabama	0%	0%	0%	0%
District of Alaska	0%	0%	0%	0%
District of Arizona	0%	0%	0%	0%
Eastern District of Arkansas	0%	100%	0%	0%
Western District of Arkansas	0%	0%	0%	0%
Central District of California	29%	57%	14%	0%
Eastern District of California	0%	0%	0%	0%
Northern District of California	100%	0%	0%	0%
Southern District of California	50%	25%	25%	0%
District of Colorado	67%	33%	0%	0%
District of Columbia	0%	0%	0%	0%
District of Connecticut	0%	100%	0%	0%
District of Delaware	76%	24%	0%	0%
Middle District of Florida	0%	100%	0%	0%
Northern District of Florida	100%	0%	0%	0%
Southern District of Florida	80%	0%	20%	0%
Middle District of Georgia	0%	100%	0%	0%
Northern District of Georgia	0%	0%	0%	0%
Southern District of Georgia	0%	0%	0%	0%
District of Guam	0%	0%	0%	0%
District of Hawaii	0%	0%	0%	0%
District of Idaho	0%	0%	0%	0%
Central District of Illinois	0%	0%	0%	0%
Northern District of Illinois	67%	17%	17%	0%
Southern District of Illinois	0%	0%	0%	0%
Northern District of Indiana	0%	100%	0%	0%
Southern District of Indiana	100%	0%	0%	0%
Northern District of Iowa	0%	0%	0%	0%
Southern District of Iowa	0%	0%	0%	0%
District of Kansas	0%	0%	0%	0%
Eastern District of Kentucky	0%	0%	0%	0%
Western District of Kentucky	0%	0%	0%	0%
Eastern District of Louisiana	0%	0%	0%	0%
Middle District of Louisiana	0%	0%	0%	0%
Western District of Louisiana	0%	0%	0%	0%

Source	Affirm	Reverse	Both	Neither
District of Maine	0%	0%	0%	0%
District of Maryland	0%	0%	0%	0%
District of Massachusetts	0%	100%	0%	0%
Eastern District of Michigan	0%	0%	0%	0%
Western District of Michigan	0%	0%	0%	0%
District of Minnesota	33%	67%	0%	0%
Northern District of Mississippi	0%	0%	0%	0%
Southern District of Mississippi	0%	0%	0%	0%
Eastern District of Missouri	0%	0%	0%	0%
Western District of Missouri	0%	0%	0%	0%
District of Montana	0%	0%	0%	0%
District of Nebraska	0%	0%	0%	0%
District of Nevada	0%	0%	0%	0%
District of New Hampshire	0%	0%	0%	0%
District of New Jersey	100%	0%	0%	0%
District of New Mexico	0%	0%	0%	0%
Eastern District of New York	0%	100%	0%	0%
Northern District of New York	0%	0%	0%	0%
Southern District of New York	100%	0%	0%	0%
Western District of New York	0%	0%	0%	0%
Eastern District of North Carolina	0%	0%	0%	0%
Middle District of North Carolina	0%	0%	0%	0%
Western District of North Carolina	0%	0%	0%	0%
District of North Dakota	50%	50%	0%	0%
District of Northern Mariana Islands	0%	0%	0%	0%
Northern District of Ohio	100%	0%	0%	0%
Southern District of Ohio	0%	0%	0%	0%
Eastern District of Oklahoma	0%	0%	0%	0%
Northern District of Oklahoma	0%	0%	0%	0%
Western District of Oklahoma	0%	0%	0%	0%
District of Oregon	0%	0%	0%	0%
Eastern District of Pennsylvania	0%	0%	0%	0%
Middle District of Pennsylvania	100%	0%	0%	0%
Western District of Pennsylvania	0%	0%	0%	0%
District of Puerto Rico	0%	0%	0%	0%
District of Rhode Island	0%	0%	0%	0%
District of South Carolina	0%	0%	0%	0%
District of South Dakota	0%	0%	0%	0%

Source	Affirm	Reverse	Both	Neither
Eastern District of Tennessee	0%	0%	0%	0%
Middle District of Tennessee	0%	0%	0%	0%
Western District of Tennessee	0%	0%	0%	0%
Eastern District of Texas	44%	50%	6%	0%
Northern District of Texas	100%	0%	0%	0%
Southern District of Texas	0%	0%	0%	0%
Western District of Texas	0%	0%	0%	0%
District of Utah	0%	0%	0%	0%
District of Vermont	0%	0%	0%	0%
District of Virgin Islands	0%	0%	0%	0%
Eastern District of Virginia	100%	0%	0%	0%
Western District of Virginia	0%	0%	0%	0%
Eastern District of Washington	0%	0%	0%	0%
Western District of Washington	100%	0%	0%	0%
Northern District of West Virginia	0%	0%	0%	0%
Southern District of West Virginia	0%	0%	0%	0%
Eastern District of Wisconsin	0%	0%	0%	0%
Western District of Wisconsin	100%	0%	0%	0%
District of Wyoming	0%	0%	0%	0%

**TOP DISTRICTS THAT FEDERAL CIRCUIT AFFIRMED/REVERSED
(BY PERCENTAGE)**

	Affirm		Reverse		Both
Northern District of California	100%	Eastern District of Arkansas	100%	Southern District of California	25%
Northern District of Florida	100%	District of Connecticut	100%	Southern District of Florida	20%
Southern District of Indiana	100%	Middle District of Florida	100%	Northern District of Illinois	17%
District of New Jersey	100%	Middle District of Georgia	100%	Central District of California	14%
Southern District of New York	100%	Northern District of Indiana	100%	Eastern District of Texas	6%
Northern District of Ohio	100%	District of Massachusetts	100%		
Middle District of Pennsylvania	100%	Eastern District of New York	100%		
Northern District of Texas	100%	District of Minnesota	67%		
Eastern District of Virginia	100%	Central District of California	57%		
Western District of Washington	100%				
Western District of Wisconsin	100%				



**TOP DISTRICTS THAT FEDERAL CIRCUIT AFFIRMED/REVERSED
(BY NUMBER OF CASES)**

	Affirm		Reverse		Both
District of Delaware	22	Eastern District of Texas	9	Central District of California	1
Eastern District of Texas	8	District of Delaware	7	Southern District of California	1
District of New Jersey	5	Central District of California	4	Southern District of Florida	1
Eastern District of Virginia	5	Eastern District of Arkansas	2	Northern District of Illinois	1
Southern District of Florida	4	Middle District of Florida	2	Eastern District of Texas	1
Northern District of Illinois	4	District of Massachusetts	2		
Southern District of New York	4	District of Minnesota	2		
Northern District of California	3				
Northern District of Florida	3				
Northern District of Texas	3				

PARTY WIN RATE BY DISTRICT

Source	Patentee	Opponent	Both	Neither
Middle District of Alabama	0%	0%	0%	0%
Northern District of Alabama	0%	0%	0%	0%
Southern District of Alabama	0%	0%	0%	0%
District of Alaska	0%	0%	0%	0%
District of Arizona	0%	0%	0%	0%
Eastern District of Arkansas	100%	0%	0%	0%
Western District of Arkansas	0%	0%	0%	0%
Central District of California	62%	31%	8%	0%
Eastern District of California	0%	0%	0%	0%
Northern District of California	43%	29%	14%	14%
Southern District of California	25%	75%	0%	0%
District of Colorado	20%	60%	0%	20%
District of Columbia	0%	0%	0%	0%
District of Connecticut	0%	100%	0%	0%
District of Delaware	61%	37%	0%	2%
Middle District of Florida	100%	0%	0%	0%
Northern District of Florida	0%	75%	0%	25%
Southern District of Florida	80%	0%	20%	0%
Middle District of Georgia	100%	0%	0%	0%
Northern District of Georgia	0%	0%	0%	0%
Southern District of Georgia	0%	0%	0%	0%
District of Guam	0%	0%	0%	0%
District of Hawaii	0%	0%	0%	0%
District of Idaho	0%	0%	0%	0%
Central District of Illinois	0%	0%	0%	0%
Northern District of Illinois	33%	50%	17%	0%
Southern District of Illinois	0%	0%	0%	0%
Northern District of Indiana	100%	0%	0%	0%
Southern District of Indiana	100%	0%	0%	0%
Northern District of Iowa	0%	0%	0%	0%
Southern District of Iowa	0%	0%	0%	0%
District of Kansas	0%	0%	0%	0%
Eastern District of Kentucky	0%	0%	0%	0%
Western District of Kentucky	0%	0%	0%	0%
Eastern District of Louisiana	0%	0%	0%	0%
Middle District of Louisiana	0%	0%	0%	0%
Western District of Louisiana	0%	0%	0%	0%

Source	Patentee	Opponent	Both	Neither
District of Maine	0%	0%	0%	0%
District of Maryland	0%	0%	0%	0%
District of Massachusetts	0%	100%	0%	0%
Eastern District of Michigan	0%	0%	0%	0%
Western District of Michigan	0%	0%	0%	0%
District of Minnesota	67%	33%	0%	0%
Northern District of Mississippi	0%	0%	0%	0%
Southern District of Mississippi	0%	0%	0%	0%
Eastern District of Missouri	0%	0%	0%	0%
Western District of Missouri	0%	0%	0%	0%
District of Montana	0%	0%	0%	0%
District of Nebraska	0%	0%	0%	0%
District of Nevada	0%	0%	0%	0%
District of New Hampshire	0%	0%	0%	0%
District of New Jersey	100%	0%	0%	0%
District of New Mexico	0%	0%	0%	0%
Eastern District of New York	0%	0%	0%	100%
Northern District of New York	0%	0%	0%	0%
Southern District of New York	0%	100%	0%	0%
Western District of New York	0%	0%	0%	0%
Eastern District of North Carolina	0%	0%	0%	0%
Middle District of North Carolina	0%	0%	0%	0%
Western District of North Carolina	0%	0%	0%	0%
District of North Dakota	0%	50%	0%	50%
District of Northern Mariana Islands	0%	0%	0%	0%
Northern District of Ohio	0%	100%	0%	0%
Southern District of Ohio	0%	0%	0%	0%
Eastern District of Oklahoma	0%	0%	0%	0%
Northern District of Oklahoma	0%	0%	0%	0%
Western District of Oklahoma	0%	0%	0%	0%
District of Oregon	0%	0%	0%	0%
Eastern District of Pennsylvania	0%	0%	0%	0%
Middle District of Pennsylvania	0%	100%	0%	0%
Western District of Pennsylvania	0%	0%	0%	0%
District of Puerto Rico	0%	0%	0%	0%
District of Rhode Island	0%	0%	0%	0%
District of South Carolina	0%	0%	0%	0%
District of South Dakota	0%	0%	0%	0%



Source	Patentee	Opponent	Both	Neither
Eastern District of Tennessee	0%	0%	0%	0%
Middle District of Tennessee	0%	0%	0%	0%
Western District of Tennessee	0%	0%	0%	0%
Eastern District of Texas	55%	32%	9%	5%
Northern District of Texas	0%	100%	0%	0%
Southern District of Texas	0%	0%	0%	0%
Western District of Texas	0%	0%	0%	100%
District of Utah	0%	0%	0%	0%
District of Vermont	0%	0%	0%	0%
District of Virgin Islands	0%	0%	0%	0%
Eastern District of Virginia	40%	60%	0%	0%
Western District of Virginia	0%	0%	0%	0%
Eastern District of Washington	0%	0%	0%	0%
Western District of Washington	0%	100%	0%	0%
Northern District of West Virginia	0%	0%	0%	0%
Southern District of West Virginia	0%	0%	0%	0%
Eastern District of Wisconsin	0%	0%	0%	0%
Western District of Wisconsin	0%	100%	0%	0%
District of Wyoming	0%	0%	0%	0%

**TOP PARTY WIN BY DISTRICT
(BY PERCENTAGE)**

	Patentee		Opponent		Both		Neither
Eastern District of Arkansas	100%	District of Connecticut	100%	Southern District of Florida	20%	Eastern District of New York	100%
Middle District of Florida	100%	District of Massachusetts	100%	Northern District of Illinois	17%	Western District of Texas	100%
Middle District of Georgia	100%	Southern District of New York	100%	Northern District of California	14%	District of North Dakota	50%
Northern District of Indiana	100%	Northern District of Ohio	100%	Eastern District of Texas	9%	Northern District of Florida	25%
Southern District of Indiana	100%	Middle District of Pennsylvania	100%	Central District of California	8%	District of Colorado	20%
District of New Jersey	100%	Northern District of Texas	100%				
Southern District of Florida	80%	Western District of Washington	100%				
District of Minnesota	67%	Western District of Wisconsin	100%				
Central District of California	62%	Southern District of California	75%				
District of Delaware	61%	Northern District of Florida	75%				
Eastern District of Texas	55%	District of Colorado	60%				
Northern District of California	43%	Eastern District of Virginia	60%				



**TOP PARTY WIN BY DISTRICT
(BY NUMBER OF CASES)**

	Patentee		Opponent		Both		Neither
District of Delaware	25	District of Delaware	15	Eastern District of Texas	2	Northern District of California	1
Eastern District of Texas	12	Eastern District of Texas	7	Central District of California	1	District of Colorado	1
Central District of California	8	Central District of California	4	Northern District of California	1	District of Delaware	1
District of New Jersey	5	Southern District of New York	4	Southern District of Florida	1	Northern District of Florida	1
Southern District of Florida	4	Southern District of California	3	Northern District of Illinois	1	Eastern District of New York	1
Northern District of California	3	District of Colorado	3			District of North Dakota	1
Eastern District of Arkansas	2	Northern District of Florida	3			Eastern District of Texas	1
Middle District of Florida	2	Northern District of Illinois	3			Western District of Texas	1
Northern District of Illinois	2	Northern District of Texas	3				
District of Minnesota	2	Eastern District of Virginia	3				

PARTY WIN RATE BY TRIBUNAL

Source	Patentee Won	Opponent Won	Both Won	Neither Won
CFC	50%	0%	50%	0%
District Court	49%	41%	4%	6%
ITC	0%	100%	0%	0%
PTO	30%	60%	3%	8%

AFFIRMANCE/REVERSAL RATE BY TRIBUNAL

Source	Affirm	Reverse	Both	Neither
CFC	100%	0%	0%	0%
District Court	59%	27%	6%	8%
ITC	100%	0%	0%	0%
PTO	57%	31%	6%	7%

GIBSON DUNN'S FEDERAL CIRCUIT CLERKS

Gibson Dunn is proud to have as key members of its Appellate and Intellectual Property practices fifteen former clerks from the U.S. Court of Appeals for the Federal Circuit:



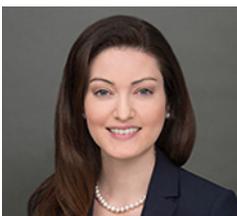
William C. Rooklidge (Former Chief Judge Nies, 1985-87), a partner in the Orange County office of Gibson, Dunn & Crutcher, joined the firm in 2015. A member of the firm's Litigation Department and Intellectual Property Practice Group, he has extensive experience in patent and trademark infringement litigation in the federal district courts and before the United States Court of Appeals for the Federal Circuit, as well as arbitration of patent disputes.



Brian Buroker (Judge Bryson, 1996-97) is a partner in Gibson, Dunn & Crutcher's Washington, D.C. office and is a member of the firm's Intellectual Property Practice. He is a member of the firm's Intellectual Property Practice, focusing on patent litigation, appeals and complex patent issues, having tried patent cases, litigated many patent cases to resolution, argued cases at the Federal Circuit and handled complex patent reexaminations, covered business method review and *inter partes* review proceedings at the U.S. Patent Office.



Stuart M. Rosenberg (Former Chief Judge Michel, 2007-08) is a partner in the Palo Alto office of Gibson, Dunn & Crutcher, where his practice focuses on intellectual property litigation. He has represented clients in a variety of industries and technologies, including software, consumer electronics, medical devices, sporting goods, and automotive design.



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CASE SUMMARIES

01 Communique Lab., Inc. v. Citrix Sys., Inc.,
889 F.3d 735 (Fed. Cir. 2018)

01 Communique Laboratory sued Citrix for infringement of its patent that claimed a system that allows individuals using a remote computer to access a personal computer through the Internet. After Citrix petitioned for IPR of Communique’s patent, the district court stayed proceedings. The PTAB confirmed the patentability of the relevant claims of Communique’s patent, and the parties returned to district court. After a jury found that Communique’s claims were not invalid but not infringed, Communique filed a motion for judgment as a matter of law and a new trial. The district court denied the motions and Communique appealed.

On appeal, the Federal Circuit affirmed in full. Communique argued that the district court improperly permitted Citrix to mislead the jury through a “practicing the prior art” defense that focused on the similarities between Citrix’s accused product and its prior art product, rather than the accused product and Communique’s asserted claims. The Federal Circuit rejected this argument because Citrix carefully explained to the jury the necessity of comparing the accused product to the asserted claims.

The Federal Circuit agreed with Communique that “an accused infringer cannot defeat a claim of literal infringement or establish invalidity merely by pointing to similarities between an accused product and the prior art.” The Federal Circuit concluded, however, that Citrix was not precluded from making the comparison to show that, if Communique’s construction of terms were read on an accused device, it must also be read on the closely aligned prior art. The Court noted that when, as in this case, “an accused product and the prior art are closely aligned, it takes exceptional linguistic dexterity to simultaneously establish infringement and evade invalidity.” Thus, Citrix’s comparisons were not, as Communique argued, “devastatingly prejudicial to the integrity of the trial.”

Finally, the Federal Circuit held that the district court did not err in ruling that the IPR record could be used at trial but that the jury could not be informed that competitor was the party who requested the IPR.

Aatrix Software, Inc. v. Green Shades Software, Inc.,
882 F.3d 1121 (Fed. Cir. 2018)

In this patent eligibility case, the Federal Circuit vacated the district court’s grant of a motion to dismiss, reversed its denial of Aatrix’s motion for leave to file a second amended complaint, and remanded for further proceedings.

Aatrix sued Green Shades for infringement of U.S. Patent Nos. 7,171,615 and 8,984,393, which essentially have the same specification and are directed to systems and methods for designing, creating, and importing data into a viewable form on a computer so that a user can manipulate the form data and create viewable forms and reports. The district court

granted Green Shades' motion to dismiss and then held every claim ineligible under Section 101.

The Federal Circuit held that the district court erred in finding that claim 1 of the '615 patent was ineligible because it was directed to intangible matter, and instead should have engaged in an *Alice/Mayo* test for claim 1. The Federal Circuit stated that while there have been previous decisions in which claims to pure data and claims to transitory signals embedded with data have been found as ineligible under Section 101, such cases are distinguishable from the facts at hand. Here, the '615 patent claims a "data processing system which clearly requires a computer operating software, a means for viewing and changing data, and a means for viewing forms and reports," which is "very much a tangible system."

The Federal Circuit also found that the district court provided no explanation for its denial of Aatrix's motion to amend its complaint. The Federal Circuit stated that the proposed second amended complaint contained allegations that raise factual disputes underlying the Section 101 analysis, such as whether the claim term "data file" can be considered an inventive concept that could merit patent eligibility. Because step two of the *Alice/Mayo* inquiry demands that courts consider whether the claims contain "an inventive concept sufficient to transform the claimed abstract idea into a patent-eligible application," such allegations would have been useful to consider under this part of the test.

Judge Reyna wrote separately, concurring-in-part with the majority's decision to vacate and remand to the district court on the motion to dismiss and dissenting-in-part with the majority's broad statements on the role of factual evidence in a Section 101 inquiry, stating instead that "our precedent is clear that the § 101 inquiry is a legal question."

AbbVie Inc. v. MedImmune Ltd.,
881 F.3d 1334 (Fed. Cir. 2018)

In this case, the Federal Circuit affirmed the district court's dismissal of a declaratory judgment action based on the rule against piecemeal adjudication. In 1995, the predecessors to AbbVie and MedImmune entered into a development and licensing agreement that resulted in the pharmaceutical drug Humira. The agreement, which is governed by British law, licensed AbbVie to practice U.S. Patent No. 6,248,516, among others, and required AbbVie to pay royalties on the sales of certain antibodies until the last of the patents expired or fifteen years from the date of the first sale. The last of the patents to expire was the '516 patent, which had an expiration date of June 19, 2018; the first commercial sale occurred in January 2003. Accordingly, AbbVie's obligation to pay royalties to MedImmune either ceased in January 2018 (if measured from the first commercial sale) or June 2018 (if measured from the expiration date of the '516 patent).

AbbVie, seeking to hasten the end of its royalty obligations, brought a declaratory judgment action in June 2016 seeking a declaration that the '516 patent was invalid. AbbVie argued that a declaration of the '516 patent's invalidity would constitute its expiration for purposes of the 1995 agreement. However, AbbVie did not seek a declaration as to the contract's interpretation, only the invalidity of the patent. The district

court dismissed the complaint on two alternate grounds: first, the court held that because AbbVie was not practicing the '516 patent and was therefore not at risk of an infringement suit, AbbVie lacked standing to bring the action; second, assuming AbbVie had standing, a decision regarding the invalidity question would not resolve the parties' ultimate dispute and would raise additional concerns about foreign law and sovereign immunity since the agreement was governed by British law.

The Federal Circuit disagreed with the district court's first ground for dismissal and held that declaratory judgment jurisdiction extended to contractual disputes regardless of whether infringement was at issue. But the Federal Circuit agreed with the district court's second ground for dismissal under the doctrine of piecemeal adjudication, which prevents parties from using declaratory judgment actions to obtain piecemeal adjudication of issues that would not finally and conclusively resolve the underlying controversy. Because the agreement was governed by British law, it was an open question whether British courts would consider the invalidation of a patent to be tantamount to its expiration for purposes of the 1995 agreement; without a resolution to this question, the parties' contractual dispute would persist. Accordingly, the Federal Circuit affirmed the district court's dismissal of the case without prejudice.

Acceleron, LLC v. Dell, Inc.,
884 F.3d 1364 (Fed. Cir. 2018)

This case concerns two appeals from an IPR. The asserted patent discloses a computer network appliance which contains a number of hot-swappable components that could be replaced without turning off or resetting the whole system. During IPR, the PTAB confirmed the patentability of some of the challenged claims and found other claims to have been proven unpatentable. The patentee and challenger cross-appealed, and the court affirmed-in-part, vacated in-part, and remanded. In the remand order, the court stated that "the agency must . . . provide all interested parties opportunity for the submission and consideration of facts and arguments . . . and must allow a party to submit rebuttal evidence as may be required for a full and true disclosure of the facts."

On remand, the PTAB chose not to consider a new argument presented by the challenger in reply and at oral argument regarding the disclosure of the prior art, as the PTAB insisted that the argument was belatedly raised and non-responsive to patentee's response. The PTAB found the claim at issue valid, and the challenger filed another appeal.

On appeal, the Federal Circuit held that unless the PTAB chose to exercise its waiver authority under 37 C.F.R. § 42.5(b), the PTAB was obligated to dismiss challenger's argument because presenting the issue for the first time at oral argument made it untimely. And, when considering its remand order in the first appeal, the court reasoned that it had not mandated consideration of challenger's new argument and patentee's response, but had merely set out requisite procedures for the PTAB to apply if it did consider those criteria. While the challenger argued that ignoring evidence of unpatentability was against public policy, the court held that adhering to due process and preserving the PTAB's discretion outweigh any potential negative effects of invalidating a patent claim. The Federal Circuit therefore affirmed the PTAB's decision.

Actelion Pharm., Ltd. v. Matal,
881 F.3d 1339 (Fed. Cir. 2018)

Actelion Pharmaceuticals brought action against the Director of the PTO, challenging the determination of the patent term adjustment and denial of Actelion's request for reconsideration of patent term adjustment time. The Eastern District of Virginia granted summary judgment for the PTO, and the Federal Circuit affirmed.

The dispute in this case related to the length of the "A Delay" calculation under 35 U.S.C. § 154 for U.S. Patent No. 8,658,675, which was granted from U.S. Patent No. 13/383,619 and filed as a national stage application. Actelion filed the '619 application on January 12, 2012, asking for early examination, but did not check box 3, which says: "This is an express request to begin national examination procedures." On February 5, 2014, the PTO issued an Issue Notification of the '675 patent, providing a grant of 41 PTA days, and issued the patent on February 25, 2014. In July 2014, Actelion requested the PTO to recalculate the PTA for the '675 patent. In September 2014, the PTO recalculated the PTA, reducing it to 40 days. In November 2013, Actelion filed a petition for reconsideration, asking for at least 41 days, but arguing that it was entitled to 45 days. Actelion argued that the accrual of A Delay for the '675 patent should have been calculated based on the '619 application's filing date, January 12, 2012, or at least based on the 30-month date, January 16, 2012, which was a federal holiday. The PTO denied the petition. Actelion filed suit against the PTO and the district court granted summary judgment in favor of the PTO.

Actelion made three arguments on appeal: (1) the '675 patent's A Delay calculation should have been based on the '619 application's filing date of January 12, 2012, because under the pre-Technical Corrections Act (TCA) version of Section 154(b)(1)(A)(i)(II), Actelion fulfilled the requirements of Section 371(c) as of that date; (2) regardless of what version of the Act applied, Actelion made an "express request" under Section 371(f)—despite its failure to check box 3—because it stated in its preliminary amendment that it was earnestly soliciting early examination; (3) alternatively, the '675 patent's A Delay should have been based strictly on the 30-month date without regard to the fact that it fell on a federal holiday.

The Federal Circuit held that under either pre- or post-TCA law, the PTA for the '675 patent would be the same because the conditions under 35 U.S.C. § 371(b) and (f) were not met on the day the '619 application was filed. Additionally, to enter the national stage early, Actelion was required to make an express request pursuant to Section 371(f), which could be accomplished, for example, by checking box 3, or by making a clear request in another manner, which it failed to do. Finally, the court found that the PTO properly determined that the national stage commenced on the next workday after the 30-month date that fell on a federal holiday as federal holidays are not delays caused by the PTO.

Adidas AG v. Nike, Inc.,
894 F.3d 1256 (Fed. Cir. 2018)

Adidas petitioned for IPR of certain claims against two patents owned by Nike, raising an obviousness challenge based on two separate combinations of prior art. The PTAB

instituted IPR but limited its review to the first combination of prior art. Finding in favor of Nike on the first combination, it never addressed the merits of the second combination.

Adidas appealed. During the pendency of the appeal, the Supreme Court issued its decision in *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018), in which it held that the IPR petition, not the Director, governs the scope of an instituted IPR proceeding: “Nothing suggests the Director enjoys a license to depart from the petition and institute a different inter partes review of his own design.” On that basis, the Federal Circuit remanded Adidas’s appeal so that the PTO could consider the second obviousness combination raised in the petition.

Advanced Video Techs. LLC v. HTC Corp.,
879 F.3d 1314 (Fed. Cir. 2018)

The issue involved in this appeal was whether Vivian Hsiun, a co-inventor of U.S. Patent No. 5,781,788, transferred her co-ownership interests in the patent under the terms of an employment agreement. In 1995, the inventors filed the parent patent to the ’788 patent, but Hsiun refused to assign her interests. AVC filed a petition before the PTO requesting that it be permitted to prosecute the application without an assignment from Hsiun, which the PTO granted. AVC thereafter dissolved and transferred its assets to Advanced Video. In 2011, Advanced Video filed three patent infringement lawsuits against HTC, but the district court found that AVC had failed to comply with Delaware statutory law governing the distribution of assets for dissolved corporations and that no patent rights had transferred from AVC to Advanced Video. Because Advanced Video had no ownership interest in the patent, the cases were dismissed for lack of standing.

After a court-appointed receiver transferred to Advanced Video any patent rights held by AVC, Advanced Video filed new patent infringement suits against HTC. Advanced Video argued that it had all rights in the asserted patent because it had acquired Hsiun’s ownership interests pursuant to three provisions of her employment agreement with Infochips: a “will assign” provision, a trust provision, and a quitclaim provision. The district court rejected the arguments, and consequently, since Hsiun was not a party to the suit, the case was dismissed for lack of standing. This appeal followed.

The Federal Circuit affirmed the district court’s dismissal of Advanced Video’s suits based on lack of standing because Hsiun owned part of the patent but was not a party to the suits and had not consented to the suits. The Federal Circuit held that the “will assign” provision in the employment agreement invoked a promise to do something in the future; it did not effect an immediate present assignment of Hsiun’s rights in the invention to Infochips. It also held that, even if the “will hold in trust provision” immediately placed Hsiun’s interests in the invention in a trust, it did not follow that those interests were automatically transferred out of trust in favor of Infochips—Hsiun would continue to hold the invention rights as a trustee unless she transferred them. Lastly, the Federal Circuit held that the quitclaim provision used the language “assigned hereunder,” not “assignable hereunder,” and as such, only applied to Hsiun’s rights to interests in any patent rights that she assigned under the agreement. Since no patent rights were ever assigned to Infochips, the quitclaim provision had no application.

Judge O'Malley concurred based on binding precedent, but wrote separately to argue that the precedent was wrong. Judge O'Malley wrote that the conclusion that a non-consenting co-owner could never be involuntarily joined in an infringement action pursuant to Rule 19 of the Federal Rules of Civil Procedure was incorrect. Judge Newman dissented as to whether Hsiun ever had co-ownership of the '788 patent, stating that her invention was the property of Infochips.

AIA Am., Inc. v. Avid Radiopharmaceuticals,
866 F.3d 1369 (Fed. Cir. 2017)

In an appeal from an award of attorney's fees, the Federal Circuit held that the Seventh Amendment right to a jury does not apply to a request for attorneys' fees under the Patent Act.

AIA America filed a patent infringement suit against Avid Radiopharmaceuticals relating to patents directed to research technologies stemming from the discovery of genetic mutation relating to early-onset familial Alzheimer's disease. Avid alleged that AIA America lacked standing to sue due to underlying fraud on the part of AIA America. Based on a jury's verdict that the inventor listed on the patents was not the sole inventor and that a previous waiver of rights was invalid due to AIA America's deceit, the district court entered judgment in favor of Avid. After the Federal Circuit affirmed that decision, the district court awarded \$3,943,317.70 of attorney's fees to Avid. AIA America appealed.

The Federal Circuit rejected AIA America's argument that the Seventh Amendment requires a jury trial to decide the facts forming the basis of the attorney's fee award. In applying the two-step inquiry from *Tull v. United States*, 481 U.S. 412, 417–18 (1987), the court found that the request for attorney's fees under Section 285 neither involves legal rights or provides a legal remedy in nature. First, for centuries courts have allowed claims for attorney's fees and, even when brought in courts of law, judges would determine attorney's fees, implying that such awards do not involve legal rights. Second, unlike contractual indemnification, when courts award attorney's fees under a statutory prevailing party provision, such a remedy is "equitable" because the underlying issues are "collateral to and separate from the decision on the merits."

The Federal Circuit also rejected AIA America's argument that the district court erred by making factual findings on issues that were not considered by a jury. The court reiterated that after a trial on legal issues, a court may not make findings inconsistent with the issues decided by the jury, but a court is not precluded from making additional findings when deciding equitable issues. This included the district court's findings about AIA America's state of mind, intent, and culpability.

AIDS Healthcare Found. v. Gilead Sci., Inc.,
890 F.3d 986 (Fed. Cir. 2018)

In this action seeking declarations of invalidity of five patents related to antiviral drugs, the Federal Circuit held that the plaintiff had not established a case of actual controversy within the meaning of the Constitution and the Declaratory Judgment Act.

Plaintiff, a provider of medical care to persons afflicted with AIDS, sought a declaratory judgment of invalidity as to several patents listed in the Orange Book for a branded drug (Genvoya[®]) used in the treatment of AIDS. Plaintiff sought to “clear out the invalid patents” so that it could purchase the drug from generic companies immediately upon the expiration of New Chemical Entity exclusivity, although no ANDAs had yet been filed. The district court granted defendant’s motion to dismiss for lack of “a case of actual controversy” in terms of the Declaratory Judgment Act.

The Federal Circuit affirmed, observing that the Declaratory Judgment Act’s requirement of a “case of actual controversy” conforms to the constitutional limitation of the judicial power to actual cases and immediate controversies. The existence of a patent, without more, does not create a case of actual controversy, and the plaintiff had not met the requirement of immediacy and reality: There had been no meaningful preparation to conduct potentially infringing activity, and the plaintiff could not rely on litigation delay to provide the requisite immediacy and reality for a declaratory judgment action. Nor could the plaintiff proceed under a theory that it might be liable for inducing infringement, because there had been no showing of direct infringement.

The Federal Circuit also held that the plaintiff’s economic interest in buying an infringing product was not an adverse legal interest for declaratory jurisdiction. Further, the defendant’s refusal to grant the plaintiff a covenant not to sue did not create a justiciable case or controversy. Turning to the plaintiff’s policy arguments, the Federal Circuit noted that the Hatch-Waxman Act, which contemplates lawsuits directed to patents listed in the Orange Book prior to the marketing of generic products, is already a balance of several policy interests, and policy arguments are properly addressed to Congress rather than the courts.

Allied Mineral Products, Inc. v. Osmi, Inc.,
870 F.3d 1337 (Fed. Cir. 2017)

In this appeal, the Federal Circuit affirmed the district court’s dismissal for lack of subject matter jurisdiction.

Allied Mineral Products, Inc. (“Allied”) and OSMI, Inc., Stellar Materials, Inc., and Stellar Materials, LLC (collectively, “Stellar”) are all American companies. Allied has two Mexican distributors. In 2015, Stellar notified Allied’s distributors that they were infringing Stellar’s Mexican patent. Claim 16 of that Mexican patent is a Spanish translation of claim 16 of Stellar’s U.S. Patent No. 7,503,974.

Allied filed an action against Stellar in the Southern District of Florida, seeking a declaratory judgment of non-infringement and invalidity of the ’974 patent, unenforceability due to inequitable conduct, and tortious interference with business relationships under Florida state law. Stellar moved to dismiss for lack of subject matter jurisdiction. The district court granted the motion, holding that “Stellar’s decision to enforce its Mexican patent under Mexican law against separate entities cannot, without further affirmative action by Stellar, create an actual controversy with Allied with regard to its U.S. Patent,” and that Allied’s complaint was “devoid of any allegations that Stellar

has done anything to give Allied a reasonable belief that Stellar intends to enforce its '974 Patent in the United States.”

The Federal Circuit affirmed, holding that the “totality of the circumstances in this case does not rise to the level of a case of actual controversy.” The court explained that declaratory judgment jurisdiction “requires some affirmative act by the patentee,” and here Stellar “ha[d] not directed any actions toward Allied, nor ha[d] it litigated or threatened litigation in the United States or on its '974 patent.”

Altaire Pharm., Inc. v. Paragon Biotech, Inc.,
889 F.3d 1274 (Fed. Cir. 2018)

Overturning the PTAB, the Federal Circuit, in a 2-1 decision, reversed-in-part and vacated-in-part a post-grant review decision upholding a patent related to an eye solution used to dilate pupils.

In 2011, Altaire and Paragon entered into an agreement to pursue FDA approval for Altaire’s phenylephrine hydrochloride ophthalmic solution products—a solution used to dilate patient’s pupils. Phenylephrine contains a chiral center with two enantiomers known as R- and S-phenylephrine hydrochloride. To determine the phenylephrine hydrochloride products’ effectiveness, industry members measure the products’ “chiral purity,” which is the relative amount of each enantiomer expressed as a percentage. Under the agreement, Paragon was responsible for preparing and submitting the NDAs in support of the products, while Altaire would provide and bear the costs for the chemistry, manufacturing, and controls in support of the NDA. After Paragon submitted the NDA, the FDA responded by recommending that Paragon add a chiral purity test to the drug product specification or provide a justification for not doing so. In response, Altaire measured the optical rotation of Lot #11578, a 2.5% phenylephrine hydrochloride ophthalmic solution product, and Lot #11582, a 10% phenylephrine hydrochloride ophthalmic solution product. Altaire provided a summary of the optical rotations to Paragon and Paragon subsequently submitted a supplementary NDA to the FDA, which approved Paragon’s NDA in March 2013. In June 2013, after the NDA was approved, Paragon’s counsel proposed an amendment to the agreement to address a new patent application filing that it discussed with Altaire. Altaire replied that the amendment should identify that the formulation, processes, and controls applicable to the products were developed solely by Altaire’s Chief Executive Mr. Al Sawaya and are the proprietary and confidential information of Altaire. Further, the amendment should identify either Mr. Al Sawaya or Altaire as the sole inventor. While Paragon’s counsel expressed interest in further discussions, there is no indication on the record that Paragon’s counsel responded or agreed to the substantive comments.

In November 2013, Paragon filed a drug patent application that issued as U.S. Patent No. 8,859,623. In April 2015 and April 2017, Altaire filed complaints against Paragon in the Eastern District of New York (E.D.N.Y.) for breach of a nondisclosure clause of the agreement and for declaratory judgment, respectively. In May 2015, while both actions were pending in E.D.N.Y., Altaire filed a petition for post-grant review of the '623 patent, arguing that the asserted claims would have been obvious over Lots #11578 and #11581,

and attaching a supporting declaration of Mr. Al Sawaya. Paragon denied the claims and filed a counterclaim seeking to end the agreement before the agreed upon termination date in 2021. Paragon also challenged whether Mr. Al Sawaya was properly considered an expert. In its reply, Altaire included a second declaration regarding Mr. Al Sawaya's qualifications and experience in the pharmaceutical industry. In its Final Written Decision, the PTAB determined that Altaire had failed to prove by a preponderance of the evidence that the asserted claims would have been obvious. In reaching its conclusion, the PTAB determined that Altaire failed to timely qualify Mr. Al Sawaya as an expert, the Lots #11578 and #11582 test data were entitled to no weight, and the optical rotation test data were unpersuasive.

The Federal Circuit addressed the issues of Article III standing and the exclusion or rejection of (1) Mr. Al Sawaya's declarations, (2) Lots #11578 and #11582 test data, and (3) optical rotation test data. Addressing the standing issue, the court wrote that "we conclude that, under the circumstances, Altaire's injury is inevitable," noting that Paragon refused to stipulate during oral arguments that it would not sue Altaire for infringement. The court found that Altaire's injury was further compounded by the likelihood that it would be estopped from arguing that the '623 patent would have been obvious over Lots #11578 and #11582 under the estoppel provision in 35 U.S.C. § 325(e)(2). The court concluded that Altaire demonstrated injury in fact which was both real and imminent, and harm that was concrete and particularized. The court's conclusion rested on the "inevitability" that Paragon would sue Altaire and that the agreement would prevent Altaire from manufacturing its products. The court further concluded, regarding the exclusion of Altaire's evidence, that the PTAB abused its discretion when it assigned no weight to Mr. Al Sawaya's testimony, nor to the Lots #11578 and #11582 test data and optical rotation test data. Altaire properly submitted the Second Al Sawaya Declaration and the PTAB could have permitted Paragon to file a surreply, rather than fail to consider Mr. Al Sawaya's testimony entirely. The court required that on remand, the PTAB must consider Mr. Al Sawaya's testimony when evaluating the reliability of the Lots #11578 and #11582 and optical rotation test data. Addressing the exclusion of the test data, the court held that the PTAB also abused its discretion, given that Altaire submitted the evidence at the first opportunity at which it reasonably could have been expected, seeking to demonstrate the reliability of the testing methods. The court was also persuaded because Paragon relied on the test data for its patent and NDA applications. As with Mr. Al Sawaya's declaration, on remand the PTAB must consider the data from the testing methods.

In his dissent, Judge Schall was unpersuaded that Altaire had shown standing because the issue turned entirely on the pending litigation in E.D.N.Y. The pending litigation failed to demonstrate that Altaire would suffer imminent harm, which was all that was asserted in the case. Judge Schall concluded, rather, that Altaire will either prevail in the pending actions or Paragon will, in which Paragon "*perhaps* will be given the right to terminate" the parties' agreement. A determination of imminent harm, therefore, was merely speculative and did not warrant a determination of standing for Altaire.

Amgen Inc. v. Sandoz Inc.,
877 F.3d 1315 (Fed. Cir. 2017)

In this case regarding preemption of state law by the Biologics Price Competition and Innovation Act (BPCIA), the Federal Circuit held that both field preemption and conflict preemption applied.

The underlying litigation arose as a result of the BPCIA, which establishes an abbreviated pipeline for regulatory approval of follow-on biological products that are “highly similar” to a previously approved product. The statute states that the generic biologic applicant “shall provide” its FDA application and related manufacturing information to the “reference product sponsor,” which in this case was Amgen, Inc. In May 2014, Sandoz Inc. filed an application seeking FDA approval of a biosimilar filgrastim product, of which Amgen’s Neupogen was the reference product. Following the FDA’s notice that its application was under review, Sandoz notified Amgen that it would not be providing its FDA application or manufacturing information. Sandoz noted that Amgen could sue under Section 262(1)(2)(A) to ensure Sandoz made its disclosures. In October 2014, Amgen sued Sandoz in the Northern District of California for failing to produce the application materials and information required by the BPCIA, as well as other federal and California state law claims. Sandoz counterclaimed and sought a declaratory judgment that the BPCIA had permitted its actions, that Amgen’s state law claims were unlawful and/or preempted, and that the ’427 patent was invalid and not infringed. In February 2015, Amgen filed a motion for a preliminary injunction to enjoin Sandoz from launching its biosimilar product, which had received FDA approval.

After appealing the district court’s and Federal Circuit’s previous rulings, Amgen filed a petition for writ of certiorari in the Supreme Court, which subsequently directed the Federal Circuit to determine: (1) whether California law would treat noncompliance with Section 262(1)(2)(A) of the BPCIA as an unlawful business practice, and (2) if so, whether the BPCIA preempts any additional remedy available under state law for an applicant’s failure to comply with Section 262(1)(2)(A). On remand, Amgen argued that: (1) Sandoz waived its preemption defense to its state law claims in the appeal; (2) the BPCIA does not preempt state law remedies for failure to comply with Section 262(1)(2)(A); and (3) failure to comply with Section 262(1)(2)(A) is both “unlawful” under state law and an act of conversion. In considering the parties’ waiver arguments, the Federal Circuit asserted its discretion to address the preemption question in the appeal because Sandoz had preserved the issue at the pleading stage and the Supreme Court had expressly invited the Federal Court to weigh in.

The Federal Circuit addressed both field and conflict preemption under the Constitution’s Supremacy Clause. The court noted that field preemption applies when state law “regulates conduct in a field that Congress intended the Federal Government to occupy exclusively,” including in schemes involving “federal regulation.” The court also noted that state laws are conflict preempted when they conflict with federal law, specifically “where it is impossible for a private party to comply with both state and federal requirements, or where state law stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress.” In the present case, the Federal Circuit found field

preemption to apply, noting that patent law is “inherently federal in character” and thus the BPCIA preempts state law claims “predicated on an applicant’s failure to comply” with the statute. In addition, the court held that conflict preemption barred Amgen’s state law claims because Congress had made a “deliberate choice” not to impose certain penalties as a remedy for noncompliance of the statute.

Amgen Inc. v. Sanofi,
872 F.3d 1367 (Fed. Cir. 2017)

This case relates to Amgen’s patents on antibodies that help reduce cholesterol. At trial, the parties stipulated to infringement, but Sanofi challenged the patents’ validity on written description, enablement, and obviousness grounds. The district court entered final judgment, holding the patents not invalid and granting a permanent injunction enjoining sales of appellant’s drug, Praluent[®]. Sanofi appealed the exclusion of evidence regarding written description and enablement, the jury instructions on written description, the denial of its motion for JMOL of no written description and no enablement, the granting of Amgen’s motion seeking JMOL of non-obviousness, and the permanent injunction.

The Federal Circuit reversed on the issues of written description and enablement and remanded for a new trial. With respect to the written description issue, the Federal Circuit held that it was legal error for the district court to preclude post-priority date evidence proffered to show that a patent failed to disclose a representative number of species. The post-priority date evidence was material to the representativeness question. With respect to the enablement claims, the court held that the post-priority date evidence showing lengthy experimentation was relevant to determining if the claims were enabled as of the priority date.

The Federal Circuit rejected the district court’s jury instruction related to written description. The district court had instructed the jury that a party filing for an antibody patent could satisfy the written description requirement by disclosing the antigens. The Federal Circuit held that the instruction would effectively dispense with the written description requirement by allowing the patentee to claim antibodies by describing something that is not the invention, the antigen.

With respect to the rulings granting judgment as a matter of law, the Federal Circuit held that Sanofi was not entitled to judgment as a matter of law for the claims of no written description and no enablement. The court noted there was an incomplete record on the issues because the district court had improperly excluded evidence. The court upheld that the district court’s grant of JMOL of non-obviousness. Specifically, the district court properly excluded two published PCT applications that did not predate the priority date of the patents at issue.

Finally, the court vacated the permanent injunction. The permanent injunction was improper because the district court had concluded that the injunction would disserve the public but still granted the permanent injunction. Additionally, the district court had improperly weighed the value of taking a drug out of the market. The court reiterated that the value of removing a choice of drug was insufficient to disserve public interest.

Amgen, Inc. v. Hospira, Inc.,
866 F.3d 1355 (Fed. Cir. 2017)

In this interlocutory appeal and decision on a mandamus petition, the Federal Circuit clarified the relationship between the special procedural framework for biosimilar patent suits established under the Biologics Price Competition and Innovation Act (BPCIA) and general rules of civil procedure.

The BCPIA provides for a shortened regulatory pathway for drug products that are “biosimilar” to drugs already approved by the FDA. In exchange for this benefit, applicants are subject to a procedural framework intended to protect the patent rights over the sponsoring drug. This includes a requirement that a biosimilar applicant provide to the sponsor a copy of the application and other information describing the manufacture of the biosimilar product. The specific dispute in this case arose out of Hospira’s failure, as an applicant, to disclose details of a cell-culture medium used in the manufacture of its biosimilar product. Because of this omission at the first stage of the BCPIA process, Amgen, as sponsor, chose to list only two other patents unrelated to the cell-culture medium. It was only in the ensuing infringement actions over the two listed patents that Amgen sought discovery over the cell-culture patent. The district court denied Amgen’s motion to compel discovery. Amgen then appealed the interlocutory order and sought a writ of mandamus to compel the ordering of discovery.

On appeal, the Federal Court first found that it lacked jurisdiction to hear the interlocutory appeal. Observing that denials of discovery motions are typically not subject to interlocutory appeal, the court found that nothing in the statutory purpose of the BCPIA made this specific discovery order different. Next, the Federal Court denied Amgen’s petition for a writ of mandamus, holding that Amgen did not establish a “clear and indisputable” right to such a relief. In seeking mandamus, Amgen argued that Hospira’s failure to disclose details of the cell-culture medium rendered Amgen effectively incapable of asserting a meaningful infringement action over the cell-culture patent. Invoking the threat of Federal Rule of Civil Procedure 11 and antitrust liability, Amgen argued that, had it listed a potential infringement action against the cell-culture patent absent any information about the medium, it could have been subject to sanction.

Rejecting this argument, the Federal Circuit reasoned that the BCPIA framework was more generous to sponsors. Specifically, the BCPIA imposed no sanctions on good faith assertions of actions that “could be reasonably be asserted” against the application, even if such assertions ultimately ended up mistaken. Furthermore, the BCPIA framework allowed a sponsor to reassess its asserted claims upon receipt of the applicant’s arguments for invalidity, unenforceability, and non-infringement. Even better, the applicant’s subsequent failure to provide information on these defenses could itself constitute a “reasonable basis” for asserting a claim. Ultimately, because of this ability for sponsors like Amgen to list all possible claims for infringement, the Federal Circuit reasoned that the typical rules of civil procedure would apply in ensuing infringement actions. In particular, because Federal Rule of Civil Procedure 26(b)(1) allows discovery only of information “relevant to any party’s claim or defense,” a sponsor cannot seek discovery of information over a patent that it had failed to list in the BCPIA process.

Anacor Pharm., Inc. v. Iancu,
889 F.3d 1372 (Fed. Cir. 2018)

In this case involving a patent directed to a new use (the treatment of fungal infections) of a known compound (tavaborole), the Federal Circuit held that substantial evidence supported the PTAB's finding that the claim at issue was unpatentable for obviousness.

During IPR, the PTAB found that all twelve claims of the patent at issue would have been obvious to a person of ordinary skill in the art. The patentee appealed with respect to only one of the rejected claims, arguing that the PTAB violated due process and the procedural requirements of the APA. The Federal Circuit rejected the patentee's argument that the PTAB improperly adopted a new theory of obviousness not presented in the petition: the PTAB's final written decision was based on the same combination of references and the same series of inferences that the petition proposed. The Federal Circuit also rejected the patentee's argument that the PTAB improperly relied on new evidence to which the patentee did not have an opportunity to respond. To the contrary, the patentee had ample notice of and an opportunity to respond to the references in question, which were properly offered in reply to arguments made by the patentee for the purpose of showing the state of the art at the time of the patent application.

The Federal Circuit rejected the patentee's argument that the PTAB improperly shifted the burden of proof by requiring the patent owner to disprove obviousness. There was no explicit indication in the PTAB's final written decision suggesting that the PTAB had done so. The Federal Circuit instead understood the patentee's argument to be that the PTAB improperly relaxed the burden on the opponent to prove its case. That argument was properly directed to the question of whether there was substantial evidence to support the PTAB's finding of obviousness. Considering the record before the PTAB, the court concluded that substantial evidence supported the PTAB's findings that a person of ordinary skill in the art would have been motivated to combine the pertinent teachings of prior applications and would have had a reasonable expectation of success in doing so.

The Federal Circuit rejected the patentee's argument that the PTAB attributed undue significance to the limited structural similarities between the compounds at issue. The PTAB properly understood that the opponent's theory was not based on structural similarities alone, but was based on the combination of structural similarity and functional similarity. Substantial evidence therefore supported the PTAB's finding that a person of ordinary skill in the art would have expected that the compounds at issue would share activities, such as the inhibition of fungi.

Apator Miitors ApS v. Kamstrup A/S,
887 F.3d 1293 (Fed. Cir. 2018)

Kamstrup filed a petition for IPR of Apator's patent to the PTAB. Apator introduced a declaration from the inventor, Mr. Drachmann, to establish that he conceived of the device before the effective filing date of the prior art reference, Nielsen. The PTAB rejected Apator's contention, determining in its final written decision that claim 2 was anticipated by Nielsen and claim 10 was obvious based in part on Nielsen. The PTAB held that Apator

presented no corroborating evidence as to the conception of the device other than Mr. Drachmann's own testimony.

The Federal Circuit agreed. It ruled that while an inventor can swear behind a reference by proving he conceived his invention before the effective filing date of the prior art reference, the party must proffer evidence in addition to the inventor's own statements and documents corroborating the inventor's testimony. Apator introduced emails and drawings that they said were independent evidence that corroborated Mr. Drachmann's testimony. The court saw this as a catch-22 of corroboration in which the email and drawings could only provide corroborating evidence with help from Mr. Drachmann's testimony. The unwitnessed emails and drawings alone were not sufficient to corroborate Mr. Drachmann's testimony as to the timing of the conception. Finally, the court rejected Apator's contention that the fact that its evidence was un rebutted was persuasive to its truth. The court held that Apator's argument misunderstood a patentee's burden of production in the context of establishing conception in which the patentee must establish that its claim invention is entitled to an earlier priority date than an asserted prior art reference.

Aqua Prods., Inc. v. Matal,
872 F.3d 1290 (Fed. Cir. 2017)

In this appeal from an IPR, the Federal Circuit addressed the proper allocation of the burden of proof when a patent owner proffers amended claims during the IPR proceedings. The en banc court concluded that, absent a PTO rule placing the burden of persuasion with respect to the patentability of amended claims on the patent owner that is entitled to deference, the petitioner must bear the burden of persuasion with respect to patentability of amended claims.

In 2003, Zodiac Pool Systems filed an IPR petition challenging certain claims of the '183 patent, which relates to automated swimming pool cleaners. Zodiac asserted invalidity under 35 U.S.C. §§ 102 and 103 in light of several prior art references. The PTAB instituted review and Aqua then moved to amend certain claims. The PTAB denied the motion, concluding that Aqua had failed to prove the substituted claims were patentable. A panel of the Federal Circuit upheld the PTAB's determination, but the court granted Aqua's petition for rehearing en banc.

A majority of the en banc court—seven of the eleven judges—held that the PTAB improperly placed the burden of persuasion on Aqua to prove that its proposed amended claims are patentable. The en banc court found that (1) the PTO has not adopted a rule placing the burden of persuasion with respect to the patentability of amended claims on the patent owner that is entitled to deference; and (2) in the absence of anything that might be entitled deference, the PTO may not place that burden on the patentee. Because the PTAB had not properly allocated the burden in this case, the court vacated the PTAB's decision and remanded for reconsideration of the patent owner's motion to amend under the proper burden of proof.

In analyzing the proper allocation of the burden of persuasion, the court disagreed on whether 35 U.S.C. § 316(e) is ambiguous in addressing which party bears the burden of persuasion for motions to amend. Judge O'Malley, joined by four judges, wrote that Section 316(e) unambiguously places the burden of persuasion on petitioners for a motion to amend, and that the PTO is not entitled *Chevron* deference. Judge O'Malley explained that the language of Section 316(e), the overall statutory scheme for IPR set forth in the AIA, and its legislative history unambiguously placed the burden of persuasion to prove propositions of unpatentability on the petitioner for all claims, including amended claims. Judge O'Malley wrote that even if Section 316(e) were ambiguous, as a majority of the court believed, there was no rulemaking governing the burden of persuasion and so no interpretation to which the court owed *Chevron* deference. Thus, even if there had been statutory ambiguity, Judge O'Malley still would have vacated the PTAB's decision denying the patent owner's motion to amend and remanded the matter requiring the PTAB to assess the patentability of the amended claims without placing the burden of persuasion on the patent owner.

Judge Reyna wrote a separate opinion, joined in full by Judge Dyk, concurring in the judgment reached by Judge O'Malley's opinion but taking a different course. First, Judge Reyna's opinion concluded that Section 316(e) is ambiguous. Because the dissenting judges also found Section 316(e) ambiguous, Judge Reyna points out that a majority of the judges found the statute ambiguous. Judge Reyna concluded, however, that the PTO had not engaged in proper rulemaking under Section 319(a)(9) such that there was no agency regulation for which to consider *Chevron* deference, so the burden of persuasion regarding the patentability of Aqua's proposed amended claims remained on the petitioner. In a final section, Judge Reyna also determined that the patent owner has a burden of production regarding patentability when proposing amended claims during an IPR; a majority of the court joined this section, thereby signaling the court's view on this issue, but it did not form the basis for the court's judgment vacating and remanding the PTAB's decision.

Judge Moore wrote a separate opinion to address why the PTO's purported interpretation of the statute in this case should not be afforded deference. Judge Moore explained that when Congress expressly delegates to the Director the ability to adopt legal standards by prescribing regulations, the Director can only obtain *Chevron* deference if it prescribes regulations. It cannot obtain *Chevron* deference through precedential PTAB decisions.

Judge Taranto, writing in dissent, would have held that the PTO had issued a regulation governing the burden of persuasion and that the patent owner did not present a sound argument against giving *Chevron* deference to that regulation. Judge Taranto's dissent set forth two points similar to Judge Reyna's concurrence: (1) Section 316(e) is ambiguous and does not necessarily bar assigning the burden to the patent owner; and (2) Section 316(a) authorizes the PTO Director to address who has the burden of persuasion for substitute claims. Judges Reyna and Dyk joined these portions of Judge Taranto's opinion.

Judge Hughes, writing in dissent, argued that the court should give deference to the PTO Director's "clear and consistent" interpretation of an ambiguous statute that he is entitled to interpret. Judge Hughes also noted that, even if the scope of the PTO's regulation was

ambiguous, the PTO would still be entitled to *Auer* deference for its interpretation of its own regulation.

Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.,
876 F.3d 1350 (Fed. Cir. 2017))

In this case, the Federal Circuit affirmed a district court’s denial of judgment as a matter of law, which had found that the plaintiff’s patents were non-obvious, that the defendant willfully infringed the patents, and that the jury’s royalty award was not based on improper expert testimony. The Federal Circuit also affirmed the district court’s treble damages award and ongoing royalty determination. The Court vacated the district court’s denial of JMOL as to patent marking and remanded the case for that issue.

The patents in question covered a thrust steering system for personal watercraft (“PWC”) propelled by a jet stream. In particular, the patents claimed a PWC in which thrust is automatically provided whenever a rider attempts to turn the PWC. The rationale behind this invention is that riders typically reduce thrust to slow down before turning. Intuitively this is a natural reaction, but the PWC actually becomes more difficult to turn if thrust is reduced. Therefore, to counteract this intuitive behavior, the patentee developed a feature in which thrust is automatically provided whenever the rider turns the PWC.

The accused infringer argued that this feature was obvious in light of the prior art. The court acknowledged there was “no serious dispute” whether the prior art disclosed all of the elements of most of the claims. The question was whether an ordinarily skilled artisan would have been motivated to combine the appropriate prior art references to achieve the claimed design. The court reviewed to see if the lower court’s decision was supported by substantial evidence and affirmed that it was. While the prior art did provide some reasons to combine the references in question, the prior art also provided a number of reasons that would have discouraged a skilled artisan from being combining the references. The court reasoned that there was substantial evidence to conclude that an ordinarily skilled artisan would not have been motivated to combine the references, and the court therefore stated that it “may not reverse” the finding.

The court then vacated the lower court’s denial of JMOL as to patent marking. The Federal Circuit held that the patentee had the burden of proving that it fully complied with the marking statute, including proving that that no unmarked products practiced the asserted patents. The accused infringer had the burden of production, requiring the identification of supposedly unmarked patent-practicing products. Once identified, it was the patentee’s burden to show that each of those products was either marked or did not practice the patent. The lower court erred in placing the burden on the accused infringer, and the court remanded the case to give the patentee an opportunity to prove that it had complied with the marking statute.

Lastly, the court affirmed the jury’s royalty award, the lower court’s treble damages award, and the lower court’s finding that the accused infringer willfully infringed the asserted patents. For the final holding, the court concluded the jury’s willfulness finding was

supported by substantial evidence, including that the accused infringer “conducted only a cursory analysis” of the asserted patents and waited years to seek advice from counsel.

Arendi S.A.R.L. v. Google LLC,
882 F.3d 1132 (Fed. Cir. 2018)

The Federal Circuit affirmed the PTAB’s judgment of unpatentability based on obviousness, but rejected-in-part and affirmed-in-part the PTAB’s reasoning. Specifically, the court considered the PTAB’s alternate claim constructions, upheld the construction based on a finding of prosecution disclaimer, and rejected the construction which was not so limited.

Google, Motorola Mobility, and Samsung Electronics requested IPR of all the claims of Arendi’s U.S. Patent No. 6,323,853. The claims recite a method of information handling whereby a document is analyzed for information such as a name or address, a database is searched for related information, and the retrieved information is displayed and entered into the document, based on a single command from the user. The PTAB instituted review on the ground of obviousness in view of U.S. Patent No. 5,923,848 (“Goodhand”) and found all claims invalid as obvious.

On appeal, the Federal Circuit affirmed the determination of obviousness but did so on an “alternative holding” by the PTAB. The Federal Circuit first found that the PTAB erred in finding that Arendi’s amendment to add the claim limitation “single entry of the execute command” did not limit the claims to exclude text selection by a user. In particular, the Federal Circuit held that prosecution disclaimer occurred when (1) the applicant amended the claims and explained “what was changed and why,” and (2) the examiner’s “Reasons for Allowance” confirmed that these were the reasons the amended claims were deemed allowable. The PTAB’s alternative holding was that, even in light of the narrowed claims based on prosecution disclaimer, the claims were unpatentable for obviousness in view of Goodhand. The court reasoned that Goodhand disclosed essentially the same textual analysis as Arendi’s patent, as far as its method for automatically identifying text and searching for and retrieving information without user text selection.

Arthrex, Inc. v. Smith & Nephew, Inc.,
880 F.3d 1345 (Fed. Cir. 2018)

In this case, the Federal Circuit decided that the PTAB could issue an adverse judgment when a patentee disclaimed all of the challenged claims before institution of IPR, though one judge dissented.

On April 19, 2016, Smith & Nephew and ArthroCare filed an IPR petition challenging claims 1–9 of a patent owned by Arthrex. On July 22, 2016, Arthrex disclaimed all 9 claims of the challenged patent as permitted under 37 C.F.R. § 42.107(e) and filed a Preliminary Response stating that Arthrex was not requesting an adverse judgment. After further briefing, the PTAB entered an adverse judgment against Arthrex, concluding that its regulations permitted it to construe a statutory disclaimer of all challenged claims as a request for adverse judgment, even when the disclaimer occurred before the PTAB had

entered a decision on institution. 37 C.F.R. § 42.73(b)(2) provides: “A party may request judgment against itself at any time during a proceeding. Actions construed to be a request for adverse judgment include: . . . (2) Cancellation or disclaimer of a claim such that the party has no remaining claim in the trial.” Arthrex appealed, and the petitioners in the IPR moved to dismiss the appeal for lack of subject matter jurisdiction, arguing that 35 U.S.C. § 319 (providing for appeal from a “final written decision”) created the exclusive means of appeal and that the PTAB did not issue a “final written decision” as required by that section.

As for the first issue, the majority held that the adverse judgment was appealable because (1) the adverse judgment in this case was a decision of the PTAB, (2) the decision was “with respect to” an IPR proceeding, and (3) the judgment was final in that it terminated the IPR proceeding. As for the second issue, the Federal Circuit split on whether the PTAB properly entered an adverse judgment pursuant to Section 42.73(b). Arthrex argued that the regulation was inapplicable because Arthrex specifically stated that it was not requesting an adverse judgment. The majority held that the PTAB’s authority to enter an adverse judgment does not turn on the patentee’s characterization of its own request and noted that Section 42.73(b) gives the PTAB authority to construe a patentee’s actions as a request for an adverse judgment.

Arthrex argued, alternatively, that Section 42.73(b)(2) referred to the cancellation of claims such that there was “no remaining claim in the trial” and thus only applied if an IPR proceeding had been instituted. The majority held that the PTAB’s interpretation of Section 42.73(b) was consistent with the regulation because the language of subsection 2 relating to remaining claims “in the trial” could be interpreted to mean that there was no claim remaining for trial, which occurs when, as here, all of the challenged claims have been disclaimed.

Judge O’Malley concurred as to both issues but wrote separately to point out that the PTO’s expansive definition for “proceeding” and the PTAB’s application of that definition to its practice of issuing adverse judgments prior to institution seemed to conflict with *Shaw Industries Group, Inc. v. Automated Creel Systems, Inc.*, 817 F.3d 1293, 1300 (Fed. Cir. 2016), where the Federal Circuit held that an IPR does not begin until it is instituted. Judge Newman, in dissent, disagreed with the majority and argued that an adverse judgment could not be issued on disclaimed claims because Section 42.73(b)(2) authorizes adverse judgment only when there is “no remaining claim in the trial.” Judge Newman criticized the majority for construing “no remaining claim in the trial” to mean “no remaining claim for trial” and argued that the words “in the trial” meant that the PTAB could not issue adverse judgment in this case because Arthrex disclaimed all of the challenged claims before the PTAB decided whether to institute IPR.

BASF Corporation v. Johnson Matthey Inc.,
875 F.3d 1360 (Fed. Cir. 2017)

The Federal Circuit reversed and remanded the district court’s judgment that BASF’s patent was invalid for indefiniteness. The court held that the district court erred in its indefiniteness analysis.

BASF's '185 patent claims "systems for performing catalytic conversion of nitrogen oxides (NO_x) in an exhaust gas stream." In particular, the patent claims a partly dual-layer arrangement of coatings for a two-phase operation, in which the gas stream passes through a coating of composition B and then a coating of composition A. For compositions B and A, the patent referred to a "composition . . . effective to catalyze," which is the language in dispute in this case. Johnson's expert argued that the phrase was indefinite because it did not specify what constituted effectiveness and that a "limitless number" of materials could qualify under the patent's language. BASF's expert disagreed and claimed that a person of ordinary skill in the art could be reasonably certain of the materials covered and what constituted effectiveness. The district court sided with Johnson.

BASF appealed. The Federal Circuit explained that, under the Supreme Court's decision in *Nautilus*, the question presented here is: would the "composition effective to catalyze" language, understood in light of the rest of the patent and the knowledge of the person of ordinary skill in the art, have given the person of ordinary skill a reasonably certain understanding of what compositions are covered. The Federal Circuit criticized the district court for considering the functional character of the claim language, explaining that "reasonable certainty" does not exclude claim language that identifies a product by what it does. Additionally, the Federal Circuit disagreed with the lower court that a "minimum level of function" or "particular measurement method" was necessarily required to be spelled out in order for the claim language to be reasonably certain. On the contrary, the court clarified that this level of specificity would only be required if the person of ordinary skill in the art would need it to be reasonably certain of the language's understanding. Reviewing the record, the Federal Circuit held that the patent was not invalid for indefiniteness since the patent was primarily about identifying performance of a particular conversion process, not the choice of materials for that process.

Bayer Pharma AG v. Watson Labs., Inc.,
874 F.3d 1316 (Fed. Cir. 2017)

In 2013, Bayer Pharma AG obtained U.S. Patent No. 8,613,950 for a drug, vardenafil hydrochloride trihydrate ("vardenafil"), to treat erectile dysfunction ("ED") in the form of an oral disintegrating tablet ("ODT"). Watson Laboratories, Inc. sought approval for a generic version of this drug, which led Bayer to sue for infringement. Watson argued that the '950 patent was invalid since an ODT version of vardenafil would have been obvious to a person of ordinary skill in the art. The district court rejected all of Watson's arguments. The Federal Circuit reversed, holding that the lower court clearly erred in its fact findings and that the '950 patent was invalid for obviousness.

The Federal Circuit first held that the district court clearly erred in determining there was no motivation to formulate vardenafil as an ODT. The district court ignored several references providing such a motivation. The Federal Circuit criticized the lower court noting, "[i]t is well within the district court's discretion to credit one expert's competing testimony over another. . . . But a district court cannot . . . ignore the wealth of evidence, especially as in this case where the expert did not even address it."

The Federal Circuit next analyzed whether a person of ordinary skill in the art would have been motivated to select sorbitol and mannitol as sugar alcohols for the ODT. The district court concluded that since every ODT on the market at the time only contained mannitol (not both sugar alcohols), there was no reason a person of ordinary skill in the art would use sorbitol in creating an ODT version of the drug. The Federal Circuit criticized the lower court for only focusing on the commercial availability of ODTs with both sorbitol and mannitol, and not considering the relevant prior art. The Federal Circuit said there was “no question” that at the time of the ’950 patent’s approval, ODT formulations could and did use mannitol and sorbitol.

The third issue the Federal Circuit resolved was whether the prior art taught away from formulating an ODT version of vardenafil as immediate release. There are only two types of ODT formulations: immediate-release and delayed-release. The district court concluded that since an immediate-release ODT would have a bitter taste and increased bioavailability, the prior art taught away from formulating an immediate-release version. The Federal Circuit held that the question was not whether the immediate-release version was the best formulation, but rather, whether the immediate-release version was a suitable one. Since there are only two versions of ODT, the Federal Circuit rejected the argument that concerns of bitter taste and increased bioavailability taught away from formulating an immediate-release version of an ODT.

Berkheimer v. HP Inc.,

881 F.3d 1360 (Fed. Cir. 2018)

In this patent case on appeal from the Northern District of Illinois, the Federal Circuit affirmed the district court’s decision that certain claims are invalid as indefinite and its grant of summary judgment for claims 1–3 and 9 of U.S. Patent No. 7,447,713 as ineligible under 35 U.S.C. § 101. It also vacated the district court’s grant of summary judgment that claims 4–7 are ineligible under Section 101 and remanded for further proceedings.

Berkheimer appealed the district court’s summary judgment holding on claims 1–7 and 9 of the ’713 invalid as ineligible under 35 U.S.C. § 101 and claims 10–19 invalid for indefiniteness. The ’713 patent relates to digitally processing and archiving files in a digital asset management system, and allows for more efficient editing processes in which a change to one object carries over to all archived documents containing the same object.

Under the indefiniteness analysis, the Federal Circuit held that it was not clear error for the district court to find that a skilled artisan would not have known the meaning of the term “minimal redundancy,” as stated in claim 10, with reasonable certainty. The Federal Circuit found that the claim language used inconsistent terminology to describe the level of redundancy that the system archives, including terms such as “minimizing redundant objects,” “eliminating redundancy” and reducing “redundancies.” The court also clarified that it was not holding that all terms of degree are inherently indefinite, but rather that the term “minimal redundancy” was indefinite in light of the evidence in this specific case. Therefore, the Federal Circuit affirmed the district court’s determination that claims 10–19 were invalid as indefinite.

Under the patent eligibility analysis, the Federal Circuit first found, as a threshold issue, that Berkheimer did not waive his ability to argue that the dependent claims were separately patent eligible. Furthermore, the Federal Circuit found that the district court erred by treating claim 1 as representative merely because it was the only asserted independent claim. Thus, Berkheimer’s separate arguments regarding claims 4–7 were not waived.

After deciding on the independent claims issue, the Federal Circuit applied the two-part *Alice* test for patent eligibility. Under step one, the Federal Circuit determined that the claims were directed to an abstract idea and did not find persuasive Berkheimer’s argument that the parsing limitation roots the claims in technology and transforms the data structure from source code to object code. The Federal Circuit found, rather, that “limiting the invention to a technological environment does not make an abstract concept any less abstract under step one.” Under step two, the Federal Circuit found that the limitations for claims 1–3 and 9 “amount to no more than performing the abstract idea of parsing and comparing data with conventional computer components” and thus those claims were ineligible. The Federal Circuit held, however, that claims 4–7 do contain limitations that are directed to an arguably unconventional inventive concept, and that this step two analysis involved a disputed question of fact. Summary judgment on these claims was therefore improper, and the Federal Circuit remanded the case for consideration of these factual issues.

BioDelivery Sciences Int’l, Inc. v. Aquestive Therapeutics, Inc.,
898 F.3d 1205 (Fed. Cir. 2018)

In this opinion, the Federal Circuit granted *SAS*-based relief in a set of IPRs where the PTAB instituted review on less than all challenged claims and/or grounds, vacating the PTAB’s decisions and remanding for the PTAB to implement the Supreme Court’s *SAS* decision.

The initial basis for this appeal was unrelated—whether *inter partes* reexamination could give rise to collateral estoppel in IPR. The Federal Circuit did not rule on that issue. Instead, after oral argument, the Supreme Court issued its decision in *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018), which found that the PTAB could not institute review on less than all challenged claims and grounds. Nine days after the *SAS* decision issued, the petitioner, BioDelivery, requested the Federal Circuit to remand one of its IPRs to consider the patentability of claims on which the PTAB had not instituted review. After the Federal Circuit began ordering remands in cases where the PTAB instituted on less than all challenged grounds, BioDelivery requested remand on another two of its IPRs where that occurred. The patent owner, Aquestive, and the PTAB opposed the requests. First, they argued that BioDelivery waived its right to seek *SAS*-based relief for not raising it earlier, but the Federal Circuit, citing its decision in *Polaris Indus. Inc. v. Arctic Cat, Inc.*, 724 F. App’x 948 (Fed. Cir. 2018), stated that “*SAS* represented a significant change in law that occurred during the pendency of BioDelivery’s appeals” such that “waiver does not apply.” Aquestive and the PTAB also argued that the second request was untimely. The Federal Circuit disagreed, stating that it “was not untimely simply because BioDelivery did not predict that this court would authorize requests for remand when the PTAB instituted on less than all grounds as well as on all claims. It is undisputed that BioDelivery acted

promptly after these occurrences, requesting remand within days of this court’s first orders granting remand for the PTAB’s failure to institute on all asserted grounds.”

Aquestive also asked that the Federal Circuit decide the appealed, non-*SAS* issues (e.g., collateral estoppel) before remanding if it chose to do so. The Federal Circuit said that doing so would constitute piecemeal litigation and thus should be disfavored. Finally, Aquestive asserted that remand would prejudice it in district court litigations, particularly one that was stayed pending IPR. The Federal Circuit stated that whether the stay continued is within the province of the district court and does not weigh against a remand.

Blackbird Tech LLC v. ELB Elecs., Inc.,
895 F.3d 1374 (Fed. Cir. 2018)

In this case, the Federal Circuit vacated and remanded a final judgment of non-infringement based on a faulty claim construction. The asserted patents related to energy efficient lighting apparatuses. The disputed claim term was “attachment surface.” The claim described, in part, “a fastening mechanism for securing the attachment surface of the lighting apparatus to the illumination surface.” The parties disputed whether the attachment surface should be construed to be secured to the ballast cover or just to the illumination surface. The district court adopted the former construction.

On appeal, the Federal Circuit held that the plain language of the claim did not require the attachment surface be construed to the ballast cover, or anything other than the illumination surface. The court noted that the specification did not suggest this fastener to be particularly important. Embodiments describing this attachment mechanism were exemplary and “[i]t simply cannot be the case that every screw mentioned in the embodiment of the specification must be read into the claim.”

Judge Reyna dissented, arguing that the claim implicitly required the attachment surface be secured to the ballast cover in order to achieve its stated retrofit function because “[w]e cannot discount the importance of the retrofit aspect to the invention as a whole.”

Bosch Auto. Serv. Sols., LLC v. Matal,
878 F.3d 1027 (Fed. Cir. 2017)

In this appeal, the Federal Circuit reviewed a decision of the PTAB, which found all challenged claims unpatentable and denied Bosch’s contingent motion to amend. The court affirmed the PTAB’s finding that claims 1, 4–15, and 20–22 were obvious under Section 103. However, the Federal Circuit vacated and remanded the PTAB’s denial of Bosch’s contingent motion to amend, seeking to substitute amended claims 23–38.

U.S. Patent No. 6,904,796 is directed to a handheld tool for (1) activating remote tire pressure monitoring system (RTMS) tire sensors, and (2) communicating with a vehicle’s RMTS receiving unit. The ’796 patent incorporates into a single, handheld tool, all the known activation and transmission mechanisms such that it can be used on RMTS systems made by different manufacturers. Autel U.S., Inc. and Autel Intelligent Technology Co. Ltd. (“Autel”) filed an IPR petition alleging unpatentability on multiple obviousness and anticipation grounds. These grounds included claims 1 and 4–14 as being obvious over a

combination of patents including European Patent Publication No. 1 026 015A2 (“McClelland”), U.S. Patent Application Publication No. 2003/0080862 (“Kranz”), U.S. Patent No. 6,414,592 (“Dixit”), and British Patent No. 2305074, and claim 15 “as likely obvious” in view of the same combination of patents as well as two additional references. The PTAB also instituted review of claims 20–22 as likely to be anticipated by, and in the alternative obvious over, McClelland. Bosch filed a patent owner response and a “contingent” motion to amend, seeking to substitute amended claims 23–38 for original claims 1, 4–15, and 20–22 should the PTAB find those claims unpatentable. The PTAB found all challenged claims unpatentable and denied Bosch’s motion to amend, finding the proposed substitute claims were indefinite and that Bosch had failed to meet the requisite burden of proof in demonstrating the proposed substitute claims would have been patentable.

On appeal, Bosch first challenged the PTAB’s determination that claims 1 and 4–15 were unpatentable as obvious, but the Federal Circuit held that substantial evidence supported the PTAB’s obviousness determination. The court held that the PTAB had reasonably found that “an ordinarily skilled artisan would have been motivated by the known compatibility issues in the art of RTMS systems and the known solution of a universal communication tool disclosed by both Dixit and Howell to combine the different activation means of McClelland and Kranz into a single universal tool.”

Next, Bosch argued that the PTAB had erred in its evaluation of Bosch’s objective indicia of non-obviousness—specifically evidence of commercial success, licensing, and industry praise. The court found no error in the PTAB’s evidentiary rulings on two pieces of evidence relied upon by Bosch: (1) a declaration from a Bosch director, and (2) claim charts comparing commercially sold reset tools to the claims of the ’796 patent. The Federal Circuit agreed with the PTAB’s determination that the declaration lacked a proper evidentiary foundation because it failed to articulate any explanation to support its analysis that Bosch’s products are covered by the claims. The court also agreed with the PTAB that the claim charts violated the rule against hearsay and lacked an evidentiary foundation. The Federal Circuit agreed with the PTAB’s finding that Bosch was unable to tie industry praise and awards to the claims of the ’796 patent. Thus, the court affirmed the PTAB’s determination that claims 1 and 4–15 were unpatentable as obvious.

Bosch also challenged the PTAB’s finding claims 20–22 unpatentable as anticipated, and argued that McClelland “contemplates using only one means for activating the sensors,” and its disclosure that “other frequencies or ranges of frequencies may be suitable” did not describe the invention at the level of complete detail found in the claims of the ’796 patent. The Federal Circuit disagreed, and held that substantial evidence supported the PTAB’s finding that McClelland had disclosed the requisite plurality of activation means.

Finally, the Federal Circuit vacated and remanded the PTAB’s denial of Bosch’s contingent motion to amend as to proposed substitute claims 23–38. The proposed claims sought to add a “means-plus-function limitation.” The PTAB had found the proposed substitute claim limitation was indefinite under 35 U.S.C. § 112 because it lacked sufficient structure in its specification. The Federal Circuit found that the PTAB had impermissibly assigned

the burden of proof as to the definiteness issue to Bosch and thus vacated the PTAB's denial of Bosch's motion to amend with respect to proposed claims 23–38, and remanded.

CFRD Research v. Matal,
876 F.3d 1330 (Fed. Cir. 2017)

This case resolved three consolidated appeals from three IPRs all involving the same patent, the '233 patent, owned by CFRD. The '233 patent describes methods and systems that allow a user to begin a session on one communication-enabled device (e.g., a cell phone or a laptop computer) and transfer that session to a second device. The Federal Circuit affirmed two of the PTAB's determinations (*Iron Dome* and *Dish Network*) in which the PTAB held the challenged claims unpatentable for obviousness and/or anticipation, and reversed a third determination (*Hulu*) in which the PTAB upheld the challenged claims.

CFRD appealed the PTAB's determination in *Iron Dome*, which found the '233 challenged claims to be unpatentable for anticipation and obviousness. CFRD argued that the prior art did not teach "specifying a second device." However, in the prior art in which an ongoing session could be transferred, the Federal Circuit agreed with the PTAB that any transfer must specify a second device so as to distinguish it from other potential devices. The Federal Circuit affirmed the PTAB's determination that the prior art anticipated this claim. Since CFRD's arguments for non-obviousness were the same as its anticipation arguments, the court affirmed the PTAB's determination that the '233 patent claims were invalid for obviousness too.

Next, the Federal Circuit affirmed the PTAB's determination in *Dish*, which found the '233 patent claims unpatentable for anticipation. Again, the question was whether the prior art anticipated "specifying a second device." Here, the prior art utilized a user ID when transferring sessions. The Federal Circuit agreed with the PTAB's finding that a user selecting a new device for transfer teaches the step of specifying a second device. The court affirmed that the '233 patent was invalid for anticipation and found it unnecessary to consider whether the PTAB correctly concluded the patent was invalid for obviousness.

Lastly, the Federal Circuit reversed the PTAB's determination in *Hulu* upholding the challenged claims. The court held that the PTAB erred in its obviousness analysis of a claim directed to "transmitting a session history of said first device from said first device to a session transfer module after said session is discontinued on said first device." First, the PTAB relied on its anticipation analysis in determining that the '233 patent claims were patentable, but conclusions regarding anticipation "are insufficient as a matter of law to decide the obviousness inquiry." Second, the PTAB failed to review Hulu's separate arguments for obviousness because it thought it "would be redundant" to review prior art references separately after reviewing several combinations. The Federal Circuit agreed with Hulu that this decision was inappropriate and "unfairly prejudice[d] Hulu." Conducting an obviousness analysis, the Federal Circuit held that the '233 patent claims were invalid, finding that the prior art involved a system which left the user with "two predictable choices," and that a person of ordinary skill would be motivated to modify the prior art system to arrive at the claimed invention.

Cisco Sys., Inc. v. Int'l Trade Comm'n,
873 F.3d 1354 (Fed. Cir. 2017)

The Federal Circuit affirmed the ITC's limited exclusion order against Arista Networks, Inc. based on its final determination that Arista infringed three of Cisco's patents. Reviewing an ALJ determination in a Section 337 investigation, the ITC determined that Arista infringed the asserted claims of three out of five patents. The case was a consolidation of both Arista's appeal of the ITC's claim construction of a term in the '537 patent and Cisco's cross-appeal of the ITC's non-infringement finding with respect to the '597 patent.

The Federal Circuit first addressed the claim construction of the disputed term in the '537 patent: "[S]aid router configuration data managed by said database system and derived from configuration commands supplied by a user and executed by a router configuration subsystem before being stored in said database." The parties disputed whether "router configuration data" or "commands supplied by a user" are "stored in said database." The Court affirmed the ITC's construction requiring "router configuration data" to be "stored in said database." As an example, the court discussed representative claim 19 which requires that the referenced database be configured to store router configuration data but does not require configuration to store user-supplied commands. Additionally, the specification also supported the ITC's construction. The title demonstrates that the '537 patent is directed to "managing router configuration data" and the Abstract indicates that the system is "directed to externally managing router configuration data." The specification expressly addresses storage configuration data but does not teach storage of user-supplied commands.

Arista also challenged the ITC's limited exclusion order, arguing that the ITC did not make specific findings that the components of its accused products contribute to or induce infringement of the '537 patent. The Federal Circuit disagreed, concluding that the ITC sufficiently articulated its findings that components of Arista's product induced infringement of the '537 patent. Although the ITC opinion did not separately define "switch hardware," the ALJ's final initial determination defined switch hardware as including all the individual components, such as a processor, memory, CPU card, chassis, switch card, and fan modules. The ITC opinion expressly adopted all ALJ findings that were consistent with its opinion.

Finally, the court addressed Cisco's cross-appeal, challenging whether substantial evidence supported the ITC's determination that Arista's accused products do not infringe the asserted claims of the '597 patent. The asserted claims require that the accused system "detect" a configuration change, but the ITC determined that Arista's accused products instead "inferred" whether a subsystem was functioning. Cisco argued that "inferring" is a form of detection. The ITC had evidence showing that the accused functionality had no access to a subsystem's configuration, and so it could not know whether a configuration had changed—meaning it could "infer" a change but does not know what the change was. Because there was relevant evidence that a reasonable mind might accept as adequate to support the conclusion, the Federal Circuit affirmed the ITC's non-infringement determination.

Core Wireless S.A.R.L. v. LG Elecs., Inc.,
880 F.3d 1356 (Fed. Cir. 2018))

In an appeal from the Eastern District of Texas concerning a patent for improved display interfaces for electronic devices, the panel majority affirmed the district court's denial of summary judgment and denial of JMOL. The panel agreed on subject matter eligibility under Section 101 but split on claim construction, infringement, and anticipation.

Core Wireless sued LG for infringing claims 8 and 9 of U.S. Patent No. 8,713,476 and claims 11 and 13 of U.S. Patent No. 8,434,020. The patents disclosed improved display interfaces for electronic devices, which allowed users to more quickly access desired data and applications. The district court denied LG's motion for summary judgment on the issue of invalidity under Section 101, and after hearing initial testimony at trial, ruled that the claim terms "unlaunched state" and "reached directly" meant "not displayed" and "reached without an intervening step," respectively. The jury found all asserted claims infringed and not invalid. LG moved for judgment as a matter of law on non-infringement, arguing that the correct construction of "unlaunched state" was "not running" and that under this construction, no reasonable jury could have found infringement. The district court declined to revisit claim construction, and denied LG's motion for JMOL on the issue of non-infringement. The district court also denied LG's motion for JMOL on the issue of anticipation.

On the issue of patent eligibility, the panel majority affirmed the district court's finding that the asserted claims were patent eligible. The court found that the asserted claims were directed to an improved user interface for computing devices and not to the abstract idea of an index, as argued by LG. Although the generic idea of summarizing information existed prior to the invention, Core Wireless's claims were directed to a particular manner of summarizing and presenting information in electronic devices. The claim limitations disclosed a specific manner of displaying a limited set of information to the user.

On the issue of anticipation, the panel majority found that the jury could have reasonably concluded that LG had failed to meet its burden of proving by clear and convincing evidence that the Blanchard reference disclosed each element of the asserted claims, despite the fact that Core Wireless chose not to present rebuttal expert testimony on the issue. The court agreed with the district court that this was not a case in which the evidence pointed so strongly and overwhelmingly in favor of LG that reasonable jurors could not arrive at any contrary conclusion.

On the issue of claim construction, the panel majority affirmed the district court's construction of "unlaunched state" as "not displayed" and disagreed with LG's argument that the specification used "launch" and "display" to express two different ideas. The majority pointed to several passages where the two terms were used to convey that a particular view was being displayed to the user and that if the patentee intended "unlaunched" to mean "not running," it knew how to express as much based on the patents' use of the words "running" and "ongoing." The majority concluded that substantial evidence supported the jury's verdict of infringement based on the "reached directly from the main menu" claim limitation and deferred to the jury's findings of fact.

Judge Wallach concurred in part and dissented in part. Judge Wallach concurred that claims 11 and 13 of the '020 patent and claims 8 and 9 of the '476 patent were patent eligible under Section 101. Judge Wallach also concurred with the majority's construction of the "reached directly" claim limitation for purposes of its infringement and anticipation analyses. Judge Wallach dissented, however, as to the majority's ruling affirming the district court's construction of "unlaunched state" as "not displayed." Judge Wallach agreed with LG's construction of the term "unlaunched state" as meaning "not running" and would have remanded the case to determine whether this construction would alter the district court's findings on infringement and anticipation.

D Three Enters., LLC v. SunModo Corp.,
890 F.3d 1042 (Fed. Cir. 2018)

In an appeal from the District of Colorado, the Federal Circuit affirmed the district court's conclusion that a mechanical patent could not claim the priority date of an earlier application.

D Three Enterprises, LLC owned a number of patents directed to mechanical assemblies that allow users to mount objects on a roof and seal the mounting location against water. D Three sued SunModo Corporation and EcoFasten Solar for patent infringement. D Three's asserted patents were issued in 2014 and 2015. The allegedly infringing products, however, were available to the public in June 2009. Thus, to successfully assert its claims, D Three was required to claim priority from a patent application filed in February 2009 ("2009 Application"). SunModo and EcoFasten moved for summary judgment, arguing that D Three's claims were invalid because D Three could not claim priority from the 2009 Application. The district court granted the motion because the asserted claims were broader than the invention disclosed in the 2009 Application. In particular, most of the asserted claims did not disclose the presence of a washer, whereas the 2009 Application disclosed only a single washerless embodiment. The other asserted claims disclosed the presence of a washer without specifying where the washer must be located, whereas the 2009 Application disclosed only washers located in a specific position.

On appeal, D Three argued that summary judgment was improper because genuine issues of material fact existed as to whether the 2009 Application adequately disclosed the configurations of the asserted claims. The Federal Circuit rejected D Three's argument. Procedurally, the panel held that summary judgment was proper because D Three was not prejudiced and had full opportunity to present evidence to support its position. Substantively, the panel held that a person having ordinary skill in the art would not have recognized from the 2009 Application that washerless assemblies could be used in the way contemplated by the asserted claims or that washers could be placed in the positions specified by the asserted claims. Moreover, the panel dismissed language in the 2009 Application regarding "modifications, permutations, additions and sub-combinations" as boilerplate language that did not adequately disclose the actual combinations and attachments used in the asserted claims. Thus, because the asserted patents could not claim priority from the 2009 Application, the asserted claims were invalid based on intervening prior art.

Disc Disease Sols., Inc. v. VGH Sols., Inc.,
888 F.3d 1256 (Fed. Cir. 2018)

Disc Disease sued VGH Solutions for infringing its patents for a spinal brace and method of manufacturing wrinkled band. The following day, amendments to the Federal Rules of Civil Procedure took effect, abrogating Rule 84 and Form 18. The district court concluded that, due to the abrogation of Rule 84 and Form 18, Disc Disease’s complaint was governed by the *Iqbal/Twombly* plausibility pleading standard. The district court concluded that Disc Disease failed to meet the *Iqbal/Twombly* standard and therefore entered final judgment against Disc Disease.

After Disc Disease moved for reconsideration on the basis of an intervening change of law, the district court explained that it denied the request *sub silentio* because Disc Disease had chosen to request leave to amend in a footnote in its opposition to competitor’s motion to dismiss rather than in a separate motion compliant with local rules and government precedent. Disc Disease appealed.

The Federal Circuit reviewed this procedural issue according to the law of the Eleventh Circuit. Although Disc Disease contended that Form 18 pleading requirements should apply rather than the “heightened” *Iqbal/Twombly* standard, the Federal Circuit did not reach that question because it found that the claims were sufficiently pleaded even under *Iqbal/Twombly*. The Federal Circuit disagreed with the district court’s determination that allegations that an accused infringer’s products meet each and every element of at least one of a patentee’s claims is insufficient to state a claim. Because the Federal Circuit held that such allegations are sufficient to provide a defendant with fair notice of infringement of the asserted patents, it reversed and remanded.

Droplets, Inc. v. E*TRADE Bank,
887 F.3d 1309 (Fed. Cir. 2018)

Affirming the PTAB, the Federal Circuit upheld the invalidation of a patent regarding interactive computer links. The appeal largely concerned whether incorporation by reference was sufficient to satisfy a patentee’s burden of providing notice of the asserted priority date under 35 U.S.C. § 120. The Federal Circuit also dismissed E*TRADE’s conditional cross-appeal as improper.

E*TRADE filed a petition for IPR of Droplets’ U.S. Patent No. 8,402,115, which was filed on January 26, 2009. The patent relates to a method for delivering interactive links for presenting applications and second information at a client computer from remote sources in a network-configured computer processing system. The ’115 patent claimed priority to Droplets’ U.S. Patent No. 7,502,838, filed on November 24, 2003. The crux of Droplets’ contention was that the ’115 patent was entitled to the benefit of the earliest-filed application, Provisional Application No. 60/153,917, because the ’115 patent incorporated by reference the ’838 patent, and the ’838 patent claimed priority to the ’917 Provisional. The PTAB, however, disagreed and found that the ’115 patent was not entitled to the ’917 provisional application’s priority date. Droplets appealed.

On appeal, Droplets argued that the PTAB invalidated its patent due to a “hypertechnical violation,” and that IPR was invalid because non-Article III judges cannot revoke a patent without violating the Seventh Amendment and the Director cannot lawfully delegate authority to institute IPR proceedings to the PTAB. The Director successfully intervened to defend against each point and the Federal Circuit ultimately agreed.

Specifically, the court explained that pursuant to Section 120 and 37 C.F.R. § 1.78, “specific reference” must include each prior-filed application’s: (1) application number; and (2) familial relationship, and that the reference must be included in an application data sheet or in the first sentence following the title. Strict adherence to these statutes and regulations was necessary to place the burden on the patent owner to provide a clear, unbroken chain of priority, rather than on the public to engage in a long and expensive search of previous applications to determine the filing date of a later patent. The court thus agreed with the PTAB and the Director that because the ’115 patent did not include a specific reference to the ’917 provisional application, the ’115 patent could not claim the benefit of the earlier filing date.

The court also dismissed E*TRADE’s cross-appeal. E*TRADE relied on 35 U.S.C. § 141(c), which grants appellate jurisdiction to any party who is dissatisfied with the final written decision of the PTAB, to argue that there were alternate grounds to invalidate Droplets’ patent claims and that the PTAB erred in its obviousness analysis. The court, however, found that the cross-appeal was improper given that, under Section 141(c)’s language, the court reviews judgments, not opinions; a cross-appeal is proper only when acceptance of the argument would result in a reversal or modification of a judgment rather than an affirmation. Because the PTAB entered a judgment of invalidity as to all claims, there was no basis for cross-appeal.

DSS Tech. Mgmt. v. Apple Inc.,
885 F.3d 1367 (Fed. Cir. 2018)

In an IPR concerning a patent describing a wireless communication network for a single host device and multiple peripheral devices, the PTAB found all of the challenged claims unpatentable as obvious. The Federal Circuit reversed, holding that the PTAB must support findings of obviousness without wholly relying on “ordinary creativity” as a metric.

During the underlying IPR, the PTAB sided with the challenger that it would have been obvious to a person of ordinary skill in the art to create a base station serving to create low duty cycle radio frequency bursts. More specifically, the challenger asserted that it would have been obvious to modify a base station based on a reference that disclosed the operation of a mobile device. The PTAB agreed, reasoning that a person having ordinary skill in the art would have been motivated to apply the power saving techniques previously applied to mobile devices to base stations. The PTAB further emphasized that a skilled artisan is a person of “ordinary creativity” not an “automaton.”

The sole issue facing the Federal Circuit was whether the PTAB provided sufficient explanation for its finding of obviousness. The court held that the PTAB had failed to

adequately support its finding. In particular, like previous cases in which the PTAB relied on “common sense,” the PTAB’s invocation of “ordinary creativity” of a skilled artisan impermissibly relied on a gap-filler to supply a missing claim limitation. If common sense or ordinary creativity is to be relied upon, there must be a reasoned explanation avoiding conclusory generalizations, but that was not present in this case. The court further determined that the only evidence the PTAB could have logically relied upon for their assertion of obviousness was the conclusory and unspecific declaration of challenger’s expert, which was clearly insufficient. Because a more reasoned explanation could not possibly be gleaned from the record, the court reversed the PTAB’s finding of unpatentability. Judge Newman dissented, arguing that the PTAB’s explanation was sufficient and, in any case, remand would be the proper remedy for inadequate explanation, not reversal.

Elbit Sys. of Am., LLC v. Thales Visionix, Inc.,
881 F.3d 1354 (Fed. Cir. 2018)

In this appeal, Elbit Systems of America, LLC sought IPR of claims of Thales Visionix, Inc.’s U.S. Patent Number 6,474,159. The PTAB issued a final decision in which it determined that Elbit had failed to demonstrate by a preponderance of the evidence that claims 3–5, 13, 24–28, 31, and 34 of the ’159 patent would have been obvious over U.S. Patent No. 4,722,601 (“McFarlane”) in combination with two other prior art references.

The ’159 patent’s claims are directed to an inertial tracking system that tracks the motion of an object relative to a moving reference frame and eliminates the need to calculate an object’s orientation relative to the ground. Applying the substantial evidence standard, the Federal Circuit affirmed the PTAB’s determination that the “relative angular rate signal” required by claim 3 of the ’159 patent would not have been obvious to a person having ordinary skill in the art. The PTAB rejected Elbit’s expert testimony that the two methods were “mathematically equivalent” and had no practical differences, noting that the expert had not accounted for the relative angular signal limitation in his testimony. The Federal Circuit affirmed, finding Thales’s expert testimony that the prior art and asserted claims employ different calculation steps as constituting “substantial evidence” that the prior art did not teach the “relative angular rate signal.”

Endo Pharm. Sols., Inc. v. Custopharm Inc.,
894 F.3d 1374 (Fed. Cir. 2018)

Endo Pharmaceuticals Solutions, Inc.—as NDA holder—and Bayer Pharma AG—as patentee—brought an infringement action against ANDA-applicant Custopharm for two patents covering the drug Aveed[®], which is a long-lasting injectable testosterone replacement therapy for men. The court upheld the decision of the bench trial below that aspects of the claims were not inherently disclosed and that the claims were non-obvious over the prior art.

Aveed[®] is a long-lasting testosterone injectable comprising 750 mg testosterone undecanoate (“TU”) in 3 ml of castor oil and benzyl benzoate co-solvents with 40 to 42 percent by volume castor oil (250 mg/ml). Custopharm put forward two arguments for

why the patents were invalid: first, the product was inherently disclosed in articles describing 1000 mg TU injections without mention of a co-solvent; and second, even if not inherently disclosed, it would have been obvious to reduce the dose to 750 mg of TU and to utilize a co-solvent, as was taught in a certain progesterone injectable for women.

Before the priority date, the prior art disclosed that castor oil had been used in clinical trials with the drug, but it was not until after the priority date that it was disclosed that a co-solvent had been used, and in what proportion. Custopharm made the argument that the benzyl benzoate was “inherently” disclosed because solubility data published with the trials *could* be used to derive the solvents-at-issue. The Federal Circuit found, however, that Custopharm did not carry its burden, which required proof that the solubility data *necessarily* disclosed 40 percent castor oil and 60 percent benzyl benzoate. The court also rejected Custopharm’s arguments that a person of ordinary skill in the art would have been motivated to reduce the dose of TU to 750 mg to prevent overdosing, or that a person of ordinary skill would be motivated to look to a steroid injectable for women teaching the use of benzyl benzoate as co-solvent when seeking to treat men with low testosterone.

Energy Heating, LLC v. Heat On-the-Fly, LLC,
889 F.3d 1291 (Fed. Cir. 2018)

In this case involving a method and apparatus for the continuous preparation of heated water flow for use in hydraulic fracturing, the Federal Circuit: (1) affirmed the district court’s declaratory judgment that the patent was unenforceable due to inequitable conduct; (2) affirmed the district court’s judgment of tortious interference under state law; (3) affirmed the district court’s denial of treble damages and attorneys’ fees under state law; and (4) vacated the district court’s denial of attorneys’ fees under Section 285 and remanded on that issue.

The sole named inventor of the asserted patent had been aware that the patent process required that he file his application within one year of the first offer for sale or public use. Nevertheless, he failed to disclose to the PTO 61 hydraulic fracturing (“frac”) jobs that he and his companies had performed prior to the critical date. As potential offers for sale or public uses of the invention, these jobs may have triggered the on-sale bar. Because of the inventor’s failure to disclose, the Federal Circuit affirmed the district court’s conclusion that the patent was unenforceable due to inequitable conduct. The district court had not clearly erred in finding that the 61 prior frac jobs were not experimental. Nor did the district court abuse its discretion in not considering the PTO’s issuance of a continuation patent, which was issued after the district court’s judgment and related to materially different claims. Finally, the district court did not abuse its discretion in finding that there was clear and convincing evidence that the inventor knew that the prior frac jobs were material and specifically intended to deceive the PTO by not disclosing the jobs.

Despite the patent’s unenforceability, an employee of the patentee had called a competitor’s customer alleging that the competitor was infringing a valid and enforceable patent. This caused the competitor to lose that work. The Federal Circuit denied the patentee’s post-trial motion for judgment as a matter of law of no tortious interference. Because the patentee had failed to object to the testimony at issue, the jury’s verdict did

not rest on improperly admitted hearsay. Nor was the state tort claim preempted by federal patent laws. Rather, this claim fell within an exception to preemption because the jury had reasonably concluded that the patentee had acted in bad faith.

The Federal Circuit affirmed the district court's finding that it did not have authority to award treble damages and attorneys' fees under state law. That cause of action had not been raised in the pleadings, and the patentee did not impliedly consent to trial on the issue. In fact, the patentee had explicitly objected to it.

Finally, unable to affirm that the district court's denial of attorneys' fees under Section 285 was not an abuse of discretion, the Federal Circuit vacated and remanded. While a district court need not always award attorneys' fees following a finding of inequitable conduct, it must articulate a basis for denying attorneys' fees following such a finding. The district court stated that the patentee had raised a meritorious argument against its finding of inequitable conduct. However, inequitable conduct may only be found where the specific intent to deceive is the single most reasonable inference able to be drawn from the evidence. The Federal Circuit found these findings contradictory and was unsure whether the district court's basis for denying attorneys' fees rested on a misunderstanding of the law or an erroneous fact finding. Therefore, it vacated and remanded the denial of attorneys' fees for reconsideration.

Ericsson Inc. v. Intellectual Ventures I LLC,
890 F.3d 1336 (Fed. Cir. 2018)

In an appeal from IPR, the Federal Circuit reversed the PTAB's decision to sustain the patentability of a method of radio frequency hopping.

Intellectual Ventures I LLC ("IV") owned U.S. Patent No. 6,952,408, describing a method of frequency hopping that reduces interference between a base station and devices. Ericsson Incorporated and Telefonaktiebolaget LM Ericsson sought IPR of the '408 patent, arguing that it was anticipated by U.S. Patent No. 5,592,480, which disclosed a similar method of frequency hopping, and obvious in view of the '480 patent and its reference to the GSM, a mobile communication standard that could implement frequency hopping when combined with the '480 patent.

Analyzing only the independent claim, the PTAB concluded that claim 1 was not anticipated by the '480 patent based on the finding that frequency hopping was an optional functionality in the '480 patent. The PTAB also concluded that claim 1 was not obvious because Ericsson failed to show that a skilled artisan would have had a reasonable expectation of success in combining the teachings of the '480 patent and the GSM. Finding claim 1 to be patentable, the PTAB did not analyze the patentability of the remaining dependent claims.

The Federal Circuit, with respect to claim 1, reversed the PTAB's conclusions on anticipation and obviousness and, with respect to the remaining dependent claims, vacated and remanded for determinations of patentability.

Reviewing the PTAB's factual findings for substantial evidence, the Federal Circuit held that claim 1 of the '408 patent was anticipated by the '480 patent, citing the similar diagrams of the preferred embodiments and the fact that each term of claim 1 was recited in the '480 patent. Importantly, the Federal Circuit held that unsupported opinions contradicting a reference were not substantial evidence and dismissed the opinion of IV's expert, who testified that the '480 patent could not support frequency hopping, because the opinion contradicted the '480 patent's statement that the GSM frequency hopping standard may be used.

The Federal Circuit also held that claim 1 was obvious in view of the '480 patent and the GSM reference, stating that the experts agreed that a skilled artisan would have known how to implement frequency hopping. Moreover, the panel held that substantial evidence did not support the PTAB's finding that the components of the '480 patent could not be modified to implement frequency hopping.

Judge Wallach dissented, arguing that the majority improperly substituted its own factual findings for those of the PTAB and conflated the reasonable expectation of success portion of the obviousness analysis with the motivation to combine portion.

Exmark Mfg. Co. Inc. v. Briggs & Stratton Power Prod. Grp., LLC,
879 F.3d 1332 (Fed. Cir. 2018)

Exmark sued Briggs alleging that Briggs infringed claim 1 of Exmark's U.S. Patent No. 5,987,833, the subject of which was a lawn mower with improved flow control baffles. Briggs asserted that the claims of the patent were invalid. The district court granted Exmark's motion for summary judgment that claim 1 was not invalid as anticipated or obvious relying solely on the fact that claim 1 was found patentable after several reexaminations. The district court rejected Briggs' motion for summary judgment that the claim 1 limitation that a portion of the baffle be "elongated and substantially straight" was indefinite, concluding that one skilled in the art would understand the meaning.

The case then went to trial, where the jury found that Briggs willfully infringed Exmark's patent with their original mowers and awarded \$24,280,330 in compensatory damages, which the district court then doubled as enhanced damages. After the trial, Briggs moved for a judgment of laches, which the district court denied, concluding that Briggs had not shown that it was entitled to that equitable defense. The district court also denied Briggs' post-trial motion for a new trial on damages and willfulness. Briggs appealed.

The Federal Circuit first considered whether the district court erred by granting Exmark's motion for summary judgment that claim 1 of the '863 patent was not invalid. The Federal Circuit vacated that decision, holding that a reexamination confirming patentability of a patent claim alone was not determinative of whether a genuine issue of fact precluded summary judgment of no invalidity. The Federal Circuit remanded the question, instructing the district court to consider the entire record, and to resolve any remaining claim construction disputes relevant to the invalidity analysis.

On indefiniteness, the Federal Circuit disagreed with Briggs that the patent did not explain how to objectively determine whether a baffle portion was straight enough or long enough to be “elongated and substantially straight.” The Federal Circuit held that “one skilled in the art would understand that the ‘substantially straight’ portions of the baffle must be sufficiently straight to connect two arcuate portions of the baffle.”

With respect to damages, the Federal Circuit first held that it was appropriate in this case to use the lawn mower sales as the royalty base because the asserted claim was directed to the lawn mower as a whole, not just the baffle. The Federal Circuit further explained that a hypothetical negotiation between the parties would also have used the lawn mower sales in licensing discussions. Second, the Federal Circuit agreed with Briggs that Exmark’s damages expert’s opinion was inadmissible as it failed to adequately tie the expert’s proposed reasonable royalty rate to the facts of this case and did not explain how the evidence factored into the proposed rate. Although Exmark’s expert discussed the advantages of the patented invention, she did not tie the advantages to her proposed royalty rate and did not acknowledge that Briggs (and its co-defendant) also had patents covering components of the accused product. Accordingly, the district court erred in denying a new trial on damages.

Briggs also challenged three evidentiary rules related to damages. First, Briggs argued that the district court improperly excluded evidence of certain non-commercialized prior art, specifically, conventional modes of mowing that Briggs would have introduced to rebut Exmark’s argument that the patent was a significant advancement over prior art. Second, Briggs argued that the district court erred by limiting the damages evidence to prior art directed to side-discharge mowers, excluding mulching mowers. Lastly, Briggs argued it should have been able to introduce evidence of Exmark’s delayed decision to sue for infringement. The Federal Circuit agreed with Briggs as to the first challenge, concluding that the district court should not have excluded non-commercial prior art. The Federal Circuit rejected Briggs’ second challenge, holding it was reasonable to exclude evidence of mulching mowers because the patent required only side-discharge mowers. Lastly, the Federal Circuit rejected Briggs’ third challenge, finding that evidence of Exmark’s delay was irrelevant to damages, as there are many reasons to forego filing a lawsuit.

Finally, Briggs argued that the Supreme Court’s decision in *Halo Electronics, Inc. v. Pulse Electronics, Inc.*, 136 S. Ct. 1923 (2016), warranted a new trial on willfulness. The Federal Circuit agreed with Briggs that the district court’s decision to exclude evidence relevant to Briggs’ state of mind at the time of the accused infringement (*e.g.*, prior art and Brigg’s views on that prior art) did not comport with the standard articulated in *Halo*. The Federal Circuit vacated the jury’s willful infringement finding and remanded for the district court to determine whether a new trial on willfulness is necessary.

***FastShip, LLC v. United States*,**
892 F.3d 1298 (Fed. Cir. 2018))

FastShip sued the United States in the U.S. Court of Federal Claims, seeking damages for infringement of two patents (U.S. Patent Nos. 5,080,032 and 5,231,946) pursuant to 28 U.S.C. § 1498 by two of the Navy’s Littoral Combat Ships, the LCS-1 and LCS-3.

The Court of Federal Claims construed the relevant claim terms and granted the government partial summary judgment, finding that the LCS-3 ship was not “manufactured” by or for the government within the meaning of Section 1498 before the patents expired. Following a bench trial, the court found that the LCS-1 ship, which the parties agreed had been constructed before the patents’ expiration, infringed the asserted patents and awarded FastShip \$6,449,585.82 in damages plus interest. FastShip appealed the grant of summary judgment that the LCS-3 ship had not been “manufactured” before expiration of the asserted patents and the court’s damages calculation. The government cross-appealed alleging that the court improperly modified its prior claim construction, thereby resulting in a determination that the LCS-1 ship infringed.

The Federal Circuit affirmed on both counts, but modified the damages award upward in view of a conceded miscalculation by the Court of Federal Claims. First, the panel determined that the meaning of “manufactured” in Section 1498 was a matter of first impression. The Federal Circuit interpreted “manufactured” under its plain meaning, holding that “a product is ‘manufactured’ when it is made to include each limitation of the thing invented and is therefore suitable for use.” Under this interpretation, the panel held it indisputable that the LCS-3 ship was not “manufactured” under Section 1498 when the asserted patents expired. The asserted claims required, among other things, at least one waterjet and a hull. The record was clear that neither of these ship components was completed or installed in the LCS-3 ship until months after the expiration of the patents.

Regarding the infringement determination of the LCS-1 ship, the Federal Circuit rejected the government’s contentions that the court erred in its factual findings. At issue was the claim requirement to achieve certain speeds through application of less power than would be required with a conventional displacement hull. In making its factual infringement determination, the court compared graphs depicting the patent’s and LCS-1 ship’s power to speed ratios, and converted the LCS-1 ship shaft power measurement evidence to metric units (kilowatts) to conform to the metric units used in the power-speed graph of the patent. The government contended that the units in the patent’s graph were Imperial units (horsepower) and not metric units. Under the government’s interpretation of the patent graphs the LCS-1 ship did not infringe; the government conceded infringement if the graphs were depicted in metric units. The Federal Circuit affirmed the Court of Federal Claims’ factual finding that the units depicted in the patent graphs were metric units, which was based on uncontroverted inventor testimony.

The parties agreed that the court had miscalculated the appropriate damages and the Federal Circuit adjusted the damages award in view of the agreed upon calculation.

Finjan, Inc. v. Blue Coat Sys., Inc.,
879 F.3d 1299 (Fed. Cir. 2018))

Finjan brought suit against Blue Coat for infringement of Finjan’s U.S. Patent Nos. 6,154,844, 7,418,731, 6,965,968, and 7,647,633, which related to systems and methods of identifying and protecting against malware. At trial, the jury found that Blue Coat infringed all four patents. Afterwards, at a bench trial, the district court concluded that the ’844 patent was directed to patent-eligible subject matter. Blue Coat appealed the district

court's rulings on the subject matter eligibility of the '844 patent, the denial of JMOL of non-infringement as to the '844, '731, and '968 patents, and damages for all four patents.

The Federal Circuit first found that the '844 patent was subject matter eligible because the "behavior-based" virus scans and resulting security profiles required by the patent constituted a non-abstract improvement in computer functionality that went beyond traditional virus scans.

The Federal Circuit affirmed the denial of Blue Coat's motions for JMOL of non-infringement of the '844 and '731 patents, but reversed the denial as to the '968 patent. With respect to the '844 patent, Blue Coat raised only claim construction arguments, which the Federal Circuit rejected because Blue Coat raised them for the first time in a post-trial motion. With respect to the '731 patent, Blue Coat argued that it did not infringe because the "security profiles" created by the accused product did not contain the required "list of computer commands." But because Finjan's expert testified that the data contained in certain fields of the scan files created by the accused product were computer commands, the Federal Circuit found that the infringement verdict for this patent was supported by substantial evidence. With respect to the '968 patent, Blue Coat argued that Finjan failed to introduce substantial evidence that the accused product implemented the claimed "policy index," which required storing the "results" of a content evaluator's determination of whether given digital content was allowable relative to a given policy. The Federal Circuit agreed with Blue Coat, saying that, because Finjan's expert admitted that the accused system did not store the results and would instead have to recalculate them each time, Blue Coat was entitled to JMOL of non-infringement.

As to damages for infringement of the '844 patent, the Federal Circuit held that Finjan failed to apportion damages to the infringing functionality of the accused product when calculating the royalty base. Although Finjan apportioned its damages base to a specific part of the accused product, that part had both infringing and non-infringing functions. Further apportionment was therefore required. The Federal Circuit also held that an \$8 per unit royalty was not supported by any evidence. Although Finjan's vice president testified that it was consistent with a jury verdict Finjan received in a previous case, the '844 patent was not at issue in that case and there was no evidence showing that the patents were economically or technologically comparable. The Federal Circuit remanded for the district court to consider whether Finjan waived the right to establish a reasonable royalty under a new theory and whether to order a new trial on damages.

As to damages for the '731 and '633 patents, the Federal Circuit affirmed the jury's award, finding that Finjan's expert did apportion the revenues comprising the royalty base between the infringing and non-infringing functionalities of the accused product by using an architectural diagram of the accused system. Though the experts on both sides disagreed about how to calculate the apportionment, the jury was entitled to believe Finjan's expert, and therefore the damages award was supported by substantial evidence.

First Data Corp. v. Inselberg,
870 F.3d 1367 (Fed. Cir. 2017)

Eric Inselberg is the inventor of various systems by which audiences can interact with live events, including concerts and football games. The patents for his inventions were formerly held by Inselberg Interactive, also a party to the appeal. In 2011, Mr. Inselberg and Inselberg Interactive (collectively, “Inselberg”) defaulted on a loan from Frank Bisignano and entered into an assignment agreement whereby Interactive transferred “all right, title and interest” in its patents to Bisignano. Shortly after, Bisignano became CEO of First Data. In October 2014, Inselberg met with Bisignano claiming that First Data was using his patents without a license and that the assignment to Bisignano was invalid. Eventually, Inselberg filed a complaint in New Jersey Superior Court, asserting various state business tort and contract claims and seeking a declaration that the assignment agreement was invalid and that Interactive owned the patents. Bisignano and First Data (collectively, “First Data”) removed the state court action to district court, invoking the federal court’s jurisdiction over patent cases, and counterclaimed, seeking a declaration that the patents were not infringed and that at least one of the patents was invalid. The district court dismissed the patent invalidity and non-infringement claims for lack of jurisdiction and remanded the state law claims to state court.

On appeal, First Data argued that the district court erred in dismissing their counterclaims and declaratory judgment claims because patent ownership is a merits question, not a jurisdictional prerequisite, that the court should consider when addressing invalidity and non-infringement claims. The Federal Circuit disagreed, explaining that federal question jurisdiction under 28 U.S.C. § 1331 for patent infringement required a “non-frivolous allegation of ownership of the patents.” *Jim Arnold Corp. v. Hydrotech Systems, Inc.*, 109 F.3d 1567 (Fed. Cir. 1997), which did not exist. The Federal Circuit noted that the holding in *Jim Arnold* is limited to cases like the one at hand, where the former owner of a patent has assigned away his interest to another party and therefore cannot bring suit under the patent. With respect to the remand of state law claims, the Federal Circuit held that it was unable to review the remand because the district court remanded the claims under 28 U.S.C. § 1447. Orders remanding a case under 28 U.S.C. § 1447 are “not reviewable on appeal or otherwise.”

Flexuspine, Inc. v. Globus Med., Inc.,
879 F.3d 1369 (Fed. Cir. 2018)

Flexuspine filed a complaint against Globus Medical for infringement, and Globus asserted affirmative defenses of non-infringement and invalidity. The district court granted Globus’s motion for summary judgment of non-infringement with respect to U.S. Patent No. 8,123,810, but there were two remaining patent claims that went to trial. The district court adopted Flexuspine’s proposed jury instructions and verdict form, which conditioned a finding of invalidity on an affirmative finding of infringement. Neither party objected to that stop instruction. After the trial, the jury returned a verdict form that was incorrectly filled out: the jury ignored the stop instruction, finding that the claims were invalid even though they were not infringed. The court instructed the jury to retire again and return an internally consistent verdict form. After the jury returned a verdict finding that the claims

were not infringed, Globus lodged a formal objection. Nevertheless, the court entered judgment that Globus did not infringe the remaining two patents, and did not address their validity.

Globus then filed a Rule 59(e) motion requesting that the judgment be amended to include the jury's invalidity verdict. Globus argued that the fact the jury overlooked the stop instructions was not sufficient to render the verdict internally inconsistent. The Federal Circuit disagreed, noting that answers to the validity and damages questions were predicated on an affirmative response to the infringement question; the jury's answer on those questions necessarily conflicted with the jury's answer of no infringement.

Globus then argued that even if the jury's answers were inconsistent with the verdict form, they were not inconsistent with the jury instructions. The Federal Circuit pointed out that Globus did not object to the verdict form, and the district court clearly instructed the jury on which instructions should control by asking the jury to retire again to return a consistent verdict.

Globus then argued that the district court improperly waived Globus's right to a jury trial on its invalidity counterclaims in violation of Globus's Seventh Amendment rights. The Federal Circuit responded that because Globus failed to object to the verdict form, Globus submitted the issue of invalidity to the jury only as an affirmative defense, not as a counterclaim. As such, the district court did not deprive Globus of its right to a jury trial outright, but merely declined to submit Globus's counterclaims to *this* jury.

After the district court dismissed Globus's 59(e) motion, Globus filed a 50(b) motion for judgment as a matter of law on invalidity which the district court dismissed as moot after dismissing Globus's other counterclaims. The Federal Circuit affirmed, finding that the district court had discretion to deny Globus's 50(b) claim based on precedent: district judges "faced with an invalidity counterclaim challenging a patent that it concludes was not infringed may either rehear the claim or dismiss it without prejudice." *Liquid Dynamics Corp. v. Vaughn Co.*, 355 F.3d 1361 (Fed. Cir. 2004).

Flexuspine also cross-appealed the district court's pre-trial order granting summary judgment of non-infringement on the '810 patent. The Federal Circuit affirmed the district court's decision because Flexuspine did not provide evidence that Globus infringed the second requirement of one of the parties' agreed constructions.

G. David Jang, M.D. v. Boston Scientific Corp.,
872 F.3d 1275 (Fed. Cir. 2017)

In 2002, Dr. Jang executed an agreement assigning the '021 patent to Boston Scientific Corporation ("BSC") in return for \$50 million. Under the agreement, Dr. Jang was entitled to certain royalty payments if BSC ever developed and sold a coronary stent that was covered by or infringed Dr. Jang's patented technology. Dr. Jang first sued BSC in 2005, asserting that their "Express stent" infringed on his patent. The litigation eventually resulted in a trial where the jury found no literal infringement but found infringement under the doctrine of equivalents. The district court conducted a post-trial ensnarement hearing

and then vacated the jury verdict of infringement under the doctrine of equivalents because Dr. Jang did not meet his burden of persuasion, which required him to provide a proper hypothetical claim that does not ensnare the prior art. Dr. Jang appealed the district court's denial of his JMOL for literal infringement and its *vacatur* of the jury verdict.

The Federal Circuit upheld the district court's denial of Dr. Jang's motion for JMOL and its determination that sufficient evidence supported the jury's finding that the accused device did not literally infringe Dr. Jang's patents. The court analyzed expert testimony from trial in assessing whether there was substantial evidence to support the jury's verdict. The court noted that the microelements and macroelements of the Express stent were both more like the claimed expansion columns than the claimed connecting strut columns, and that the Express stent used a "peak-to-valley" configuration as opposed to the claimed "peak-to-peak" configuration.

The Federal Circuit also determined that Dr. Jang failed to submit a proper hypothetical claim and was therefore unable to prove that his doctrine of equivalents theory did not ensnare the prior art. Thus, the district court correctly vacated the jury verdict of infringement under the doctrine of equivalents. The Federal Circuit rejected Dr. Jang's argument that the district court should have devised its own hypothetical claim to proceed with the ensnarement analysis if his proposed hypothetical claims were flawed. The patentee has the burden of establishing the patentability of the hypothetical claim, and the district court was under no obligation to propose a hypothetical claim.

Finally, Dr. Jang argued that BSC had waived its ensnarement defense because: (1) BSC failed to raise the defense in a motion for either summary judgment or JMOL; (2) the defense was a proxy for invalidity defenses that were excluded by the district court earlier in the case; (3) BSC's belated notice to Dr. Jang of the defense was prejudicial because it deprived him of any pre-trial discovery related to the defense; and (4) the defense was never listed in the pretrial order as required by Ninth Circuit law. The Federal Circuit saw nothing legally unsound in BSC raising ensnarement through its pretrial motion *in limine* and was satisfied that Dr. Jang received sufficient notice of BSC's ensnarement argument. The court also explained that not being able to pursue a validity challenge of the asserted claims does not mandate that BCS is barred from challenging a necessarily broader set of hypothetical claims. Finally, the court found that Dr. Jang was not prejudiced by any lack of pretrial discovery as to ensnarement and because ensnarement is a legal question for the district court to decide, it was sufficient that the district court notified the parties before trial that it would resolve that question, if necessary, outside of the trial.

Georgetown Rail Equip. Co. v. Holland L.P.,
867 F.3d 1229 (Fed. Cir. 2017))

After a jury found infringement and awarded lost profits, the district court entered judgment and approved an additional award of enhanced damages based on a finding of willful infringement. The defendant appealed, raising four issues. The Federal Circuit affirmed.

First, the defendant argued that the phrase “mounted on a vehicle for movement along the railroad track,” found in the preamble of the claim, was a claim limitation. The defendant thus argued that its product, which was not capable of being mounted on a vehicle, could not infringe. The Federal Circuit disagreed. Instead, the court emphasized the general principle that language in a preamble generally does not limit the claims. A preamble is limiting only in specific circumstances that suggest an inextricable relationship of dependency between the preamble and the claims, or when there was clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art.

On the facts, the Federal Circuit found these circumstances absent. Instead, while the disputed preamble language described the principal intended use of the invention, the body of the claim still recited a structurally complete invention that could stand on its own two feet. Additionally, the court rejected the defendant’s reliance on ambiguous statements in the prosecution history to suggest that there was reliance on this language during prosecution.

Second, the court acknowledged that a finding of direct infringement requires a party to control and benefit from each and every element of a claimed system. However, the court found that such benefit and control could be established in the present case. In particular, by sending gathered information to the third party together with instructions to process this information, the defendant had ultimate control, and derivation of benefit, from the system.

Third, the court addressed the defendant’s challenge to the award of lost profits, with specific regard to the assertions that there was insufficient evidence to prove demand for the patented invention and the amount of profit the plaintiff would have made. As to proving demand, the court set forth a broad scope of inquiry, one directed to whether demand existed in the general marketplace for the patented product. To the court, evidence showing demand for an analogous product covered by the disputed claim was sufficient evidence. Then, with regard to the calculation of profits that the plaintiff would have made, the court deferred to expert evidence that was based on sound economic proof, confirmed by the historical record, and in line with evidence that parties were operating in a two-supplier market.

Finally, the Federal Circuit affirmed the district court’s finding of willful infringement and its related decision to enhance damages. Key to this finding was the fact that the parties had prior business dealings. To the Federal Circuit, this was sufficient evidence from which the jury could have inferred that the defendant believed it necessary to acquire or license the patented invention, thus allowing a finding of willful infringement.

Gilead Scis., Inc. v. Merck & Co., Inc.,
888 F.3d 1231 (Fed. Cir. 2018)

Merck developed and patented Hepatitis C treatments. Gilead sought declaratory judgment that Merck’s patents were invalid and that Gilead’s own Hepatitis C treatments did not infringe Merck’s patents. Merck counterclaimed for infringement. A jury entered judgment in Merck’s favor, but the district court ruled that the Merck’s unclean hands precluded enforcement of its patents. Merck appealed.

The Federal Circuit concluded the district court did not commit clear error in finding unclean hands and therefore affirmed. First, the district court properly found that patentees engaged in pre-litigation business misconduct by permitting an employee involved in Hepatitis C-related patent prosecutions to participate in a conference call where the structure of its competitor's Hepatitis C antiviral compound was revealed, violating an "firewall" agreement between the two companies. Second, Merck continued to use that employee in related patent prosecutions after the call, and the evidence demonstrated that the improperly acquired knowledge influenced Merck's filings of narrowed claims.

During litigation, Merck also engaged in misconduct when it sponsored its employee's false testimony that he did not participate in the conference call. He also testified about the role that competitor's formula played in filing a narrowed claim, which the court found was so incredible that it must have been intentionally false as well. Because this testimony had an immediate and necessary relation to the equity of patentee's enforcement relief, the district court balanced the equities correctly. Although Merck argued that only one of its two patents could be tainted, the Federal Circuit relied on the district court's finding that the improperly retained employee played a key role in the prosecution of both patents and, therefore, the misconduct meant that both were tainted.

GoPro, Inc. v. Contour IP Holding LLC,
898 F.3d 1170 (Fed. Cir. 2018)

In this opinion, the Federal Circuit vacated and remanded final written decisions by the PTAB in an IPR that a prior art reference was not a printed publication for the purposes of invalidity.

The prior art reference in question was a 2009 GoPro sales catalog ("the GoPro Catalog"). All of GoPro's proposed obviousness grounds relied on the GoPro Catalog. The IPR petitioner, GoPro, submitted a declaration from an employee, who said that, in 2009, he "manned the GoPro booth at [a dealer trade] show, where the GoPro Catalog was displayed, and that he personally distributed the GoPro Catalog to attendees." At the show, "there were approximately 150 vendors and more than 1,000 attendees, including actual and potential dealers, retailers, and customers of portable POV video cameras." After the show, "GoPro continued to make the GoPro Catalog available to GoPro's actual and potential customers, dealers, and retailers through its website, direct mail, and other means of distribution." The patent owner, Contour, submitted evidence that the trade show "was open to dealers but not the public." The PTAB concluded that that "GoPro had not met its burden to show that the GoPro Catalog was disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art and exercising reasonable diligence could have located it." Specifically, "a person ordinarily skilled in the art would not be interested in the dealer show because it was not an academic conference or camera industry conference, but rather a dealer show for action sports vehicles like motorcycles, motorbikes, ATVs, snowmobiles, and watercraft."

On appeal, the Federal Circuit identified the "principal issue" as "whether the GoPro Catalog was sufficiently accessible as contemplated under § 102(b)." It held that "[t]he case law regarding accessibility is not as narrow as the Board interprets it." Instead,

“[t]rade shows are not unlike conferences—a trade show is directed to individuals interested in the commercial and developmental aspects of products. If one desires to examine certain new products on the market, attending a trade show involving identical or similar products is a good option. . . .” The Federal Circuit explained that “it is more likely than not that persons ordinarily skilled and interested in POV action cameras were in attendance or at least knew about the trade show and expected to find action sports cameras at the show.” Finally, the facts showed that “the GoPro Catalog was disseminated with no restrictions and was intended to reach the general public.”

As a result, the Federal Circuit found that the GoPro did in fact meet its burden of proving that the GoPro Catalog was a printed publication. Because the PTAB had not considered the merits of GoPro’s obviousness claims, the Federal Circuit remanded to the PTAB for an evaluation on the merits.

Hologic, Inc. v. Smith & Nephew, Inc.,
884 F.3d 1357 (Fed. Cir. 2018)

In an appeal from an inter partes reexamination, the Federal Circuit held that substantial evidence supported the PTAB’s finding that the patent was entitled to claim priority to the earlier-filed PCT application. The Court reasoned that disclosure of a species may provide written description support for a claimed genus when the field of invention is predictable.

Smith & Nephew owns U.S. Patent No. 8,061,359, which relates to an endoscope and method to remove uterine tissue. Claims 1–3 and 5–7 were at issue in this case, with claim 1 reciting a method of using an endoscope, which includes a “permanently affixed” “light guide” in one of two channels. The ’359 patent claims priority to an earlier-filed PCT application by the same inventor with a nearly identical specification. Yet the Requester cited this earlier-filed PCT application as prior art with respect to the ’359 patent. The PTAB found that the earlier-filed PCT application had sufficient written description to make it a priority document instead of an invalidating obviousness reference for the ’359 patent, and Hologic appealed.

The Federal Circuit affirmed the PTAB’s finding, holding that substantial evidence supports the PTAB’s finding the ’359 patent is entitled to claim priority to earlier-filed PCT application. Specifically, the Court held that substantial evidence supports the PTAB’s finding that the earlier-filed PCT application reasonably conveys to a person of ordinary skill that the inventor had possession of the “first channel having a light guide permanently affixed therein,” as recited in claim 1. Although the earlier-filed PCT application does not explicitly disclose a “light guide,” it discloses a “fiber optics bundle,” and the parties did not dispute that a “fiber optic bundle” is a type of light guide. The court also held that neither party disputed that various types of light guides were well known in the art, and that the PTAB correctly found that the declarations of Hologic’s own experts did not dispute either point in discussing in how one of ordinary skill would interpret the earlier-filed PCT application.

Regarding written description support for the “permanently affixed” limitation, Hologic argued that this limitation is not expressly or inherently disclosed in the earlier-filed PCT

application. The court, however, reasoned that the figures of the earlier-filed PCT application collectively support the PTAB's conclusion that the earlier-filed PCT application contemplated a "permanently fixed" light guide. Indeed, the court agreed with the PTAB that prior art patents showed how a skilled artisan would have understood the earlier-filed PCT application. The court reiterated that the test for written description support is not one of express or inherent disclosure—rather, the specification must reasonably convey "possession" of the claimed invention as of the filing date.

Homeland Housewares, LLC v. Whirlpool Corp.,
865 F.3d 1372 (Fed. Cir. 2017))

A divided Federal Circuit panel reversed a PTAB decision, holding that a household blender patent was invalid as anticipated. Homeland Housewares LLC, manufacturer of household blenders, challenged Whirlpool's patent covering a preprogrammed household blender that alternates between high and low speeds. After IPR, the PTAB found that none of the claims were invalid as anticipated. A split Federal Circuit panel reversed.

Writing for the majority, Judge Dyk repeated the two-step analysis required under an anticipation inquiry. Starting first with the interpretation of the claims, the majority observed that the PTAB failed to adopt a construction of "predetermined settling speed," a key term in the claim. Entering into independent claim construction of this term, the majority emphasized the ordinary and customary meaning of the words, rejecting both Homeland and Whirlpool's asserted interpretations. The majority reasoned that the broadest reasonable construction of "predetermined settling speed" was a speed lower than the normal operating speed, and specifically one that permits settling of blender contents.

The majority then held that the claim, as construed, was anticipated. For this determination, the majority pointed specifically to a patent that taught the use of alternating between "high" and "low" speeds for blenders. To the majority, this prior patent's use of the term "low" speed was properly understood to mean a speed that permitted the settling of blender contents. Accordingly, this prior art contained the same limitations as those found in the Whirlpool patent, rendering the latter invalid. As a final point, the majority addressed unrebutted expert testimony upon which the PTAB had relied for its finding of validity. Reasoning that the expert testimony relied on several statements that were inconsistent with the record, the majority held that the expert testimony was to be disregarded, and thus could not provide support for a finding of validity.

In dissent, Judge Newman wrote that the majority had rewritten the patent claims and failed to adhere to the appropriate standard for reviewing PTAB decisions.

Honeywell Int'l Inc. v. Mexichem Amanco Holding S.A. de C.V.,
865 F.3d 1348 (Fed. Cir. 2017)

In this appeal concerning a patent to compound combinations used in heat transfer systems, the Federal Circuit vacated and remanded a PTAB determination that claims over the combination were obvious.

Honeywell owned a patent directed to the combination and use of an unsaturated hydrofluorocarbon compound (“HFC”), HFO-1234YF, and a polyalkylene glycol lubricant (“PAG”) used in heat transfer systems. In an inter partes reexamination, the examiner found that various claims in the patent were invalid as obvious. Honeywell appealed to the PTAB, arguing that the prior art did not teach or suggest the combination of HFO-1234yf with lubricants, much less the specific PAG lubricant at hand, but the PTAB affirmed.

On appeal, however, the Federal Circuit held that the PTAB committed three legal errors. First, the court reasoned that the PTAB erred in relying too heavily on what it believed to be the inherent miscibility of HFO-1234yf to support a finding of obviousness. Specifically, the court emphasized that inherent characteristics do not render a composition obvious if these inherent characteristics are still unknown or unexpected at the time of invention. Thus, in dismissing properties of the claimed invention as inherent, without further considering unpredictability and unexpectedness, the PTAB committed legal error.

Second, the PTAB erred by implicitly shifting the burden from the examiner to show a “reasonable expectation of success” to the patentee to show “a reasonable expectation of failure.” In particular, after characterizing the state of the art as entirely unpredictable, the PTAB had reasoned that a person of ordinary skill would not have been deterred by an expectation of failure, and thus would have arrived at the claimed combination by “routine testing.” To the Federal Circuit, such logic was impermissible burden shifting.

Finally, the court held that the PTAB had relied on a new ground of rejection on appeal, and thus contravened the APA’s guarantee of full and fair treatment. In particular, the PTAB had raised an additional patent, the Omure patent, as a basis for dismissing Honeywell’s evidence of unexpected results. This patent had been briefed by parties during reexamination, but was never addressed by the examiner. The PTAB, by subsequently relying on Omure and forwarding different reasons for rejection than the examiner, had denied Honeywell their opportunity to respond to this thrust of the rejection.

Judge Wallach issued a partial dissent, agreeing with the decision to vacate and remand based on the obviousness inquiry but taking issue with the majority’s finding that the PTAB had relied on a new ground of rejection.

HTC Corp. v. Cellular Commc’ns Equip., LLC,
877 F.3d 1361 (Fed. Cir. 2017))

In this appeal, HTC Corporation and ZTE USA (collectively, “HTC”) challenged the final written decision of the PTAB in an IPR. The Federal Circuit affirmed the PTAB’s claim construction of the claim term “message” and its patentability determination.

The asserted patent describes methods and apparatuses for a radio communications system. It allows a subscriber station (a mobile device) to adjust the amount of transmission power used at the beginning of a message, which is generally already predetermined by a network provider. This adjustment allows a subscriber station to overcome interference in transmission conditions and avoids “aborted message transmission.”

On appeal, HTC challenged the PTAB's interpretation of the claim term "message." HTC first argued that the PTAB had failed to apply the "broadest reasonable interpretation of the term 'message'" because it defined a message by its content and required a specific beginning and endpoint. However, in oral argument, HTC argued that in construing the term, 'message' the PTAB did not construe it as having an ending requirement. Additionally, HTC argued that the PTAB's claim construction excluded "single frame" Enhanced Dedicated Uplink Channel (EDUC) messages. The court, noting HTC's inconsistent positions throughout the course of the litigation, found that the PTAB had not erred in applying the claim term to encompass both "single" and "multiple" frame message transmissions.

Second, HTC argued that the asserted patent was anticipated by a prior art patent, Baker. This prior art patent disclosed a communications system in which a mobile station transmitted "acknowledgment" or "non-acknowledgment" signals to a base station upon receiving data. HTC argued that Baker disclosed a mobile station that reduces the transmission power of certain codes in a timeslot immediately preceding the "acknowledgment" or "non-acknowledgment" signals. The Federal Circuit noted that HTC failed to identify any disclosure in Baker demonstrating that this timeslot corresponded to the start of a new message transmission, and held substantial evidence supported the PTAB's finding that Baker did not inherently anticipate the claims.

Finally, HTC argued that the asserted patent was obvious over Reed, which is directed to a system, method, and apparatus for "establishing headroom for a mobile station" based on "specific channel variance condition and battery condition." The court found substantial evidence supported the PTAB's finding that Reed only discloses distinct power "headroom" for each data stream as opposed to multiple data streams, as contemplated by the asserted patent.

Idemitsu Kosan Co., Ltd. v. SFC Co. Ltd.,
870 F.3d 1376 (Fed. Cir. 2017)

In this appeal from an *inter partes* reexamination of Idemitsu Kosan's patent, the Federal Circuit affirmed the PTAB's determination that the challenged claims were invalid as obvious under 35 U.S.C. § 103.

Idemitsu's patent claims a device with an "organic medium layered between an anode and cathode" that emits lights "when a voltage is applied through the electrodes." Idemitsu owns another patent, Arakane, which is "an organic electroluminescence device including a pair of electrodes and an organic light emitting medium layer interposed between the electrodes" where the organic light emitting medium layer has a mixture layer containing "(A) at least one hole transporting ["HT"] compound and (B) at least one electron transporting ["ET"] compound." The PTAB found the challenged claims obvious over Arakane.

On appeal, Idemitsu first argued that the PTAB erred in finding that Arakane taught combining those particular compounds for the purpose of creating a light emitting layer in an electroluminescent device. Because the PTAB made no findings with respect to the

energy gap relationship of the particular HT/ET combination corresponding to Idemitsu's patent's components, Idemitsu argued that they must have made one of two erroneous assumptions to find that Arakane taught the combination. The Federal Circuit concluded that the PTAB did not make the first assumption—SFC's argument that a skilled artisan would have expected that all disclosed HT compounds in Arakane have a lower energy gap than all disclosed ET compounds—but simply restated it. And even if the PTAB made the second assumption—that Arakane suggests combinations of HT and ET that do not satisfy the energy gap relation in addition to combinations that do—the court could discern no error in that finding.

Idemitsu then argued that this second assumption, an argument made by SFC, was raised too late because it did not appear in the SFC's petition or the PTAB's institution decision. The Federal Circuit rejected this argument, finding instead that SFC was simply responding to Idemitsu's claim that Arakane teaches away from non-energy-gap combinations. The court made clear that the PTAB can reach a counter-argument even if it was not preemptively addressed by the petition or institution. The court reiterated that there is no requirement for the institution decision to anticipate and set forth every legal or factual issue that might arise in the course of the trial.

According to the Federal Circuit, Idemitsu's only substantive argument on appeal was that the PTAB should not have engaged in factfinding without the benefit of expert testimony or additional extrinsic evidence. The court rejected this argument as well, finding that while SFC bears the ultimate burden of establishing unpatentability, it is not required as a matter of law to rebut attorney argument with expert testimony to satisfy that burden. The court found that the PTAB did exactly what it was supposed to do: weigh the parties competing arguments, each relying solely on the text of Arakane itself, and choose the more plausible one.

Impax Labs. Inc. v. Lannett Holdings Inc.,
893 F.3d 1372 (Fed. Cir. 2018)

The Federal Circuit affirmed the district court's bench trial finding that the asserted patents (U.S. Patent Nos. 6,760,237 and 7,220,767) were not invalid as anticipated or obvious. The only issue on appeal was obviousness under 35 U.S.C. § 103.

Impax (the exclusive licensee) and AstraZeneca (patent owners) sued Lannett for patent infringement based on Lannett's ANDA seeking approval to manufacture and sell generic versions of a nasally administrable migraine medication with the active ingredient zolmitriptan. Lannett disputed infringement and challenged the validity of the two asserted patents. After a bench trial, the parties stipulated that Lannett's product described in its ANDA, if approved by the FDA, will infringe the asserted patents. The district court held that the patents were not invalid as anticipated or obvious. Lannett appealed.

The issue of obviousness under 35 U.S.C. § 103 was the only issue on appeal. The appeal focused on fact-intensive arguments concerning the disclosures in the prior art, individually, and the teachings to one of ordinary skill in the art as a whole. Lannett argued that the district court erred in concluding that the claims at issue would not have been

obvious, based on an erroneous finding that the prior art taught away from nasal formulations of zolmitriptan. Appellees, on the other hand, responded that the district court did not err because it correctly found that a skilled artisan would not have been motivated to make nasal formulations of zolmitriptan or had a reasonable expectation of success in doing so. Appellees argued that the district court's finding of teaching away was not clearly erroneous in view of the court's factual findings, including those supported by record evidence and based on credibility determinations concerning the parties' experts, which such evidence Appellees argued should not be reweighed on appeal.

The panel restated its prior holdings that the presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact, and what a reference teaches and whether it teaches toward or away from the claimed invention are questions of fact. Both parties put forth evidence from the record of various factors a person of ordinary skill in the art would have considered. The Federal Circuit held that, in view of the totality of the record evidence of the state of the prior art, it could not find that the district court clearly erred in its factual findings predicated on its determinations of the expert testimony. Although the panel acknowledged the case was a close one, it deferred to the district court in its fact findings, including what the prior art disclosed and the state of the prior art as a whole, and thus, its determination that a skilled artisan would not have been motivated to make a zolmitriptan nasal spray with a reasonable expectation of success.

In re BigCommerce, Inc.,
890 F.3d 978 (Fed. Cir. 2018)

On a petition for writ of mandamus, the Federal Circuit clarified where a corporate defendant is deemed to reside under the patent venue statute, 28 U.S.C. § 1400.

Diem LLC and Express Mobile, Inc. filed separate patent infringement suits against BigCommerce, Inc. in the Eastern District of Texas. BigCommerce is incorporated in Texas and has its registered office and headquarters in Austin, Texas, which lies in the Western District of Texas. Following the Supreme Court's holding in *TC Heartland*, BigCommerce moved to dismiss the Diem case and transfer the Express case, arguing that venue was proper only in the Western District of Texas. In both cases, the district court disagreed, holding that a corporate defendant incorporated in a state with multiple judicial districts resides in every judicial district for venue purposes. BigCommerce petitioned for a writ of mandamus. The Federal Circuit granted the petition and vacated the district court's orders denying the motion to dismiss and motion to transfer.

After considering the plain meaning and legislative history of Section 1400(b) and Supreme Court precedent on similar venue cases, the panel held that a corporate defendant incorporated in a state with multiple judicial districts is deemed to reside only in the judicial district where the defendant maintains its principal place of business or registered office. In doing so, the panel rejected the argument that, given the fluid and amorphous nature of modern businesses, Section 1400(b) should be construed liberally, stating that such policy considerations were best directed to Congress.

In re Brandt,

886 F.3d 1171 (Fed. Cir. 2018)

Brandt filed a patent application describing high density roof coverboards. The examiner rejected the application as prima facie obvious over the prior art, and the PTAB affirmed the examiner's rejection. Patentees appealed, and the Federal Circuit affirmed.

The first issue on appeal was whether the PTAB erred in affirming the examiner's finding of a prima facie case of obviousness. The examiner found that the difference between the claimed density range and the range taught by the prior art was "virtually negligible." On appeal, Brandt argued that the PTAB erred by applying a per se rule that whenever a claimed range is close to the range taught in the prior art, the claimed range is prima facie obvious. The Federal Circuit rejected that argument, reasoning that the PTAB applied no such per se rule. Instead, the court reasoned that the PTAB correctly found that the claimed range of less than 6 pounds per cubic foot and the prior art range of between 6 and 25 pounds per cubic foot were so mathematically close that any distinction between them was virtually negligible. The court added that Brandt did not, on appeal, dispute that the claimed range and of the range taught in the prior art were not meaningfully distinct. The court further rejected Brandt's argument that an examiner can only find a claimed range prima facie obvious if the claimed range overlaps with the range taught in the prior art.

The second issue was, assuming the PTAB properly found a prima facie case, whether the PTAB nonetheless erred in finding that the prior art does not "teach away" from the claimed invention. The Federal Circuit rejected this argument, holding that the PTAB correctly found that the prior art does not teach away from the claimed density range. The court found that the prior art encouraged the approach described in Brandt's application. The court added that Brandt's arguments turn on the assertion that the claimed density range is critical, but Brandt failed to supply any evidence supporting those arguments.

In re Cray Inc.,

871 F.3d 1355 (Fed. Cir. 2017)

The Federal Circuit granted a petition for a writ of mandamus and directed transfer of the case, finding that the district court's refusal to transfer pursuant to 28 U.S.C. § 1406(a) was an abuse of discretion. The petition arose from a patent infringement action filed by Raytheon against Cray in the Eastern District of Texas. Cray sells advanced supercomputers that Raytheon accuses of infringement. Cray's principal place of business is located in Washington. It maintains facilities in other states, including Wisconsin, but does not rent or own an office or any property in the Eastern District of Texas. Cray allowed two of its employees (Mr. Harless and Mr. Testa) to work remotely from their respective homes in the Eastern District of Texas. In light of the Supreme Court's decision in *TC Heartland*, Cray moved to transfer the suit on the grounds of improper venue, arguing that remote employees working from home did not constitute a "regular and established place of business." The district court rejected that argument, finding that the employees' activities were similar to those in *In re Cordis Corp.*, 769 F.2d 733 (Fed. Cir. 1985), where the Federal Circuit rejected a mandamus request to reverse an order denying transfer for improper venue.

On appeal, the Federal Circuit reiterated three general requirements that must be satisfied to establish a “regular and established place of business” under Section 1400(b): (1) there must be a physical place in the district; (2) it must be a regular and established place of business; and (3) it must be a place of the defendant. The first requirement is that there must be a physical place in the district. Citing dictionaries from the late 19th Century, around when Section 1400(b)’s predecessor statute was enacted, the court defined “place” as a “physical, geographical location in the district from which the business of the defendant is carried out.” While “place” need not be a fixed physical presence, like a formal office or store, it also cannot refer to a virtual space or to electronic communications from one person to another. In *Cordis*, for example, the defendant (1) used its employees’ homes to store its documents and products, (2) treated some homes like distribution centers (storing inventory that was taken directly to its clients), and (3) engaged a secretarial service physically located in the district to perform certain tasks. The second requirement is that the place of business must be regular and established. This requires that the place not be transient and demonstrate sufficient permanence. Accordingly, while a business can move its location, it must for a meaningful time period be stable and established to confer venue. On the other hand, if an employee can move his home out of the district without the approval of the defendant, that would cut against venue. The third requirement is that the place must be of the defendant, not solely of the defendant’s employee. Applying these requirements to the facts of the case, the Federal Circuit held that the facts did not establish that the employees’ homes were places of business of Cray, and therefore venue was improper.

In re Durance,

891 F.3d 991 (Fed. Cir. 2018)

The Federal Circuit vacated a decision by the PTAB that affirmed an examiner’s obviousness rejection of patent application for a method and apparatus of “microwave vacuum-drying of organic materials, such as food products and medicinal plants.” The PTAB had failed to consider arguments in the applicants’ reply brief that were properly made in response to the examiner’s answer. The court remanded for the PTAB to consider applicants’ reply-brief arguments in the first instance.

The Federal Circuit found that if an examiner’s answer includes arguments raised for the first time, an applicant may address those arguments in the reply. Here, the applicant’s reply brief was responsive to the examiner’s answer and included citations indicating the new arguments they were replying to. Therefore, the court found it was an error for the PTAB to disregard these arguments.

In re Hodges,

882 F.3d 1107 (Fed. Cir. 2018)

In this appeal regarding obvious and anticipated claims, the Federal Circuit reversed the PTO’s anticipation determinations, vacated its obviousness determinations, and remanded for further proceedings. Hodges appealed from the examination of U.S. Patent Application No. 12/906,222, in which the PTO affirmed the examiner’s rejection of all claims as anticipated and/or obvious.

The '222 application was directed to a “valve assembly for draining contaminants, condensation, and other fluids that adversely affect the efficiency and function of a pressurized system.” An issue in question was whether two prior art references, U.S. Patent No. 5,531,241 (“Rasmussen”) and U.S. Patent No. 3,262,464 (“Frantz”), anticipated any of the twenty claims of the '222 application. Both the examiner and the PTAB found that Rasmussen and Frantz anticipated multiple claims of the application. The Federal Circuit found that the PTAB did not provide proper evidentiary support for this finding. Rather than remand, however, the Federal Circuit reversed and held that Rasmussen and Frantz did not anticipate the challenged claims.

The Federal Circuit also took issue with the PTO’s lack of evidentiary basis for its finding that the claims would have been obvious. The PTAB simply stated that the claims would have been obvious over Rasmussen in view of Frantz because the unlabeled valve in the Rasmussen drawings could have become a part of the drain valve body, without actually explaining how this could happen. The Federal Circuit noted that when faced with such factually deficient findings by the PTAB, it has consistently vacated and remanded for further proceedings. Therefore, the Federal Circuit followed precedent here by choosing to vacate and remand on the issue of obviousness.

Judge Wallach wrote separately, concurring-in-part and dissenting-in-part. While Judge Wallach agreed with most of the majority’s findings, he disagreed with the majority’s reversal of PTAB’s anticipation finding with respect to Rasmussen. Judge Wallach explained that the majority departed from the default rule that deficient agency decisions should be vacated and remanded, not reversed as it was here.

In re HTC Corp.,

889 F.3d 1349 (Fed. Cir. 2018)

The Federal Circuit denied the alleged infringer’s petition for writ of mandamus after the district court had denied a motion to dismiss for improper venue. A writ of mandamus is a drastic remedy available only in extraordinary circumstances. Such a writ may issue only where the following conditions are met: (1) the petitioner must have no other adequate means to attain the relief desired; (2) the petitioner must demonstrate a “clear and indisputable” right to the issuance of the writ; and (3) even if the first two prerequisites have been met, the issuing court, in the exercise of its discretion, must be satisfied that the writ is appropriate under the circumstances.

The Federal Circuit found that the first condition was not met. The alleged infringer argued that it should be able to avoid the inconvenience of litigation by having the issue of improper venue decided at the outset of its case. The Federal Circuit rejected this argument, finding the ability of an appellate court to vacate a judgment to be an adequate remedy on appeal.

The Federal Circuit further held that the alleged infringer, a non-U.S. corporation, had failed to demonstrate that its right to the writ was clear and indisputable as required by the second condition. A long-established rule provides that suits against aliens are wholly outside the operation of all the federal venue laws, general and special. The Federal Circuit

emphasized the need to avoid a venue gap, where the federal courts have jurisdiction, but where no proper venue to exercise that jurisdiction exists: Congress does not in general intend to create venue gaps, and it is reasonable to prefer the construction of venue statutes that avoids leaving such a gap.

The Federal Circuit did not believe that Congress intended the Federal Courts Jurisdiction and Venue Clarification Act of 2011 to upend the centuries-old understanding that the venue laws do not restrict the location of suits against alien defendants. That Act made only one clear change to the alien-venue rule, a modest adjustment limited to natural persons. There was no comparable change with respect to foreign corporations. While the alleged infringer contended that the alien-venue rule created a loophole for plaintiffs to forum shop, the Federal Circuit found it would be a far more unsatisfactory loophole for patent owners to be completely unable to bring infringement claims against certain alien defendants.

In re Janssen Biotech, Inc.,

880 F.3d 1315 (Fed. Cir. 2018)

In an appeal from the PTAB, the Federal Circuit affirmed the PTAB's rejection of claims 1–7 of U.S. Patent No. 6,284,471 as unpatentable under the doctrine of obviousness-type double patenting.

The court extended its previous ruling in *G.D. Searle LLC v. Lupin Pharmaceuticals, Inc.*, 790 F.3d 1349, 1354–55 (Fed. Cir. 2015), which held that a patent owner could not take advantage of Section 121's safe harbor provision simply by designating the CIP as a divisional application in a reissue application years after the fact. Although *Searle* dealt with Section 121 in the reissue context, the court found *Searle*'s reasoning applicable to this case based on the plain language of the safe harbor provision, which states that a challenged patent must have issued on a divisional application in order to fall within the scope of the safe harbor. For purposes of Section 121, a patent issued on a CIP application cannot retroactively become a patent issued on a divisional application even if that CIP application is redesignated as a divisional application during reexamination. To receive safe harbor protections, the application must be properly designated as a divisional application by the time the challenged patent issues on that application.

Here, Janssen voluntarily and deliberately filed an application properly designated as a CIP and never requested that the application be changed to anything other than a CIP. Once the '471 patent issued on the '093 application, which at the time of issuance included new matter not disclosed in the original application and thus was properly designated a CIP, the '471 patent was barred from safe harbor protections.

The Federal Circuit then determined that the claims were invalid for obviousness-type double patenting. When determining whether claims are invalid for obviousness-type double patenting, the examiner typically applies the one-way test, in which the examiner asks whether the application claims are obvious over the patent claims. In unusual circumstances, however, the examiner may apply the two-way test, in which the examiner also asks whether the patent claims are obvious over the application claims. The court

affirmed the PTAB's finding that Janssen was not entitled to the two-way test because neither of the two conditions for the two-way test had been met. First, the second-filed application did not issue prior to a first-filed application. Second, the PTO was not solely responsible for the delay in the issuance of the first-filed application; in fact, the court found no error with the PTAB's finding that Janssen was responsible for significant delays in the prosecution of the '471 patent. Because the safe harbor provision of Section 121 did not apply and Janssen was not entitled to the two-way test, the court affirmed the PTAB's rejection of Janssen's claims as unpatentable under the doctrine of obviousness-type double patenting.

In re Micron Tech.,

875 F.3d 1091 (Fed. Cir. 2017)

President and Fellows of Harvard College ("Harvard") filed this patent infringement case in the District of Massachusetts against Micron, which is incorporated in Delaware and has its principal place of business in Idaho. At the time, Micron moved under Rule 12(b)(6) to dismiss the complaint for failure to state a claim, but it did not include an objection to venue under Rule 12(b)(3). Following the Supreme Court's decision in *TC Heartland*, Micron filed a motion to dismiss or to transfer the case on the ground that the District of Massachusetts was not a proper venue. The district court denied the motion on the ground that Micron had waived its venue defense by not objecting in its first motion to dismiss. The district court rejected Micron's argument that *TC Heartland* was a change in law that made the Rule 12(h)(1)(A) waiver rule inapplicable. Micron petitioned for a writ of mandamus.

The Federal Circuit recognized that district courts were split whether *TC Heartland* constituted a change of law, which would determine whether a venue objection available to parties before 2017 was waived if not raised at the time. The Federal Circuit resolved this split by holding that as a matter of law the venue defense provided by *TC Heartland* was not available to parties prior to the 2017 decision. The court granted the writ of mandamus and remanded the case.

In addressing this issue, the Federal Circuit reviewed the definition of "resides" as it was understood in August of 2016. In 1990, the Federal Circuit, in *V.E. Holding*, held that the definition of "resides" in 28 U.S.C. § 1391(c), as amended in 1988, applied to Section 1400(b), which stipulates jurisdiction for defendants in patent cases. The language of Section 1391(c) was slightly amended in 2011, but this amendment did not affect the holding of *V.E. Holding* nor the definition of "resides." Since *V.E. Holding* was still "taken as a binding precedent" in August of 2016 in the Federal Circuit, the Federal Circuit held that the district court would have been forced to deny such a venue objection from Micron. As a result, prior to *TC Heartland*, this venue objection was not available to Micron, and Micron did not waive this venue objection.

The Federal Circuit declined to order a dismissal or transfer for lack of venue, instead choosing to remand the case so that the lower court could consider whether there were reasons under Rule 12(h)(1)(A) other than waiver that Micron might have forfeited its venue defense.

In re Nordt Dev. Co.,

881 F.3d 1371 (Fed. Cir. 2018)

In this appeal from the PTAB, the Federal Circuit vacated the PTAB's rejection of the claims of U.S. Patent Application No. 13/241,865 because it was based on an incorrect claim construction.

Nordt Development Co., LLC's '865 application describes an elastic knee brace with "a hinge mechanism comprising an *injection molded* strut component," "an *injection molded* first and second arm components," and "an elastically stretchable framework *injection molded* about the strut," among other parts. The examiner rejected claims 1 and 14 as anticipated by U.S. Patent No. 6,238,360 ("Gildersleeve"). Nordt attempted to differentiate Gildersleeve from the '865 application by qualifying its "strut" and "arm" components with the phrase "injection molded." The examiner continued to reject claims 1 and 14 on the grounds that the phrase "injection molded" describes a "method of manufacturing an apparatus," whereas claim 1 is an apparatus claim. Nordt then appealed to PTAB, arguing that the examiner was mistaken since "injection molded" is actually a structural limitation rather than a method.

Upon PTAB affirming the examiner's rejection, Nordt appealed to the Federal Circuit, arguing that PTAB erred by construing claims 1 and 14 as product-by-process claims with "injection molded" as a process claim, and thus not according the phrase any patentable weight. The Federal Circuit found that the phrase "injection molded" implied structure, as the specification explained injection molding as forming an integral component. Furthermore, neither the PTAB nor the examiner rejected Nordt's statement that a knee brace comprised of fabric components has clear structural differences from a knee brace made with injection-molded components. The Federal Circuit also relied on prior case law holding that "words of limitation that can connote with equal force a structural characteristic of the product or a process of manufacture are commonly and by default interpreted in their structural sense, unless the patentee has demonstrated otherwise."

The Federal Circuit thus rejected the PTAB's claim construction of the term "injection molded" as a process limitation with no patentable weight, vacated the PTAB's finding of anticipation, and remanded for additional proceedings consistent with this opinion.

In re Power Integrations, Inc.,

884 F.3d 1370 (Fed. Cir. 2018))

In this appeal from an *ex parte* reexamination, the Federal Circuit rejected the PTAB's claim construction and unpatentability determination. The Court reasoned, for example, that the PTAB's exclusive reliance on a dictionary definition was incorrect, as the patent's specification and underlying teachings should be considered as well.

The patent at issue in the appeal was, as the Court noted, "no stranger to litigation," as the patent had previously been asserted in the District of Delaware in a case that was appealed to the Federal Circuit. At issue both in the present appeal and the appeal from the district court was a claim to a "circuit" that is comprises of, among other things, a digital to analog

converter and a counter, the digital to analog converter being “coupled” to the counter. In the appeal from the district court case, Federal Circuit had held in favor of the patentee’s proposed claim construction that “coupled” should be interpreted as requiring a specific control relationship between the counter and the digital to analog converter. In two parallel reexamination decisions, however, the PTAB rejected that narrow interpretation and instead adopted the alleged infringer’s broad construction. In siding with the alleged infringer, the PTAB relied solely on the Webster’s Dictionary to determine that, under the broadest reasonable construction standard, “coupling” requires only that two components be joined into one circuit. Unlike that of patentee’s, PTAB’s interpretation of “coupled” allowed a circuit’s counter and pre-programmed memory to function together to drive a converter.

On appeal, the court rejected the PTAB’s construction because the dictionary definition failed to account for the patent specification’s stated purpose of striving to reduce circuit size and the teachings that a functional relationship between the digital to analog converter and the counter was required. Given these considerations, the court further adopted the “specific control relationship” interpretation, which the court reasoned was rooted in plain claim language and congruent with the patent’s specification.

The court added that even under the PTAB’s broadest reasonable construction rubric, claims must still be considered with regard to the specification and teachings of the underlying patent. The PTAB took an unreasonable and overly expansive view which would make every element in a circuit “coupled” to every other element in the circuit, rendering whole phrases of the claim’s language superfluous. Nor was the broad reading supported by the claim’s specification, because the inclusion of a bulky memory between the counter and the digital to analog converter would be inconsistent with the patent’s focus on minimizing circuit size. Accordingly, the Court reversed the PTAB’s decision.

In re Rembrandt Techns. LP Patent Litig.,
899 F.3d 1254 (Fed. Cir. 2018)

After more than a decade of litigation, the district court for the District of Delaware entered an order finding the case exceptional under 35 U.S.C. § 285 and ordered Plaintiff Rembrandt Technologies to pay more than \$51 million in attorney’s fees. On appeal, the Federal Circuit upheld the district court’s “exceptional case” determination, holding there was adequate evidence for each of the three bases on which the court rested its finding. However, the Federal Circuit vacated the award of fees, finding that the district court had not sufficiently determined the causal connection between the misconduct underlying the court’s finding under Section 285 and the claimed fees, and remanded for further consideration.

The district court found that Rembrandt had (1) improperly compensated fact witnesses in violation of professional ethics rules, (2) knowingly allowed document spoliation to occur, and (3) attempted to enforce patents it should have known were unenforceable due to inequitable conduct.

Rembrandt challenged the first finding by arguing that the witnesses in question, whose consulting agreement was arranged before the litigation arose, did not constitute an ethical violation under the case law. The Federal Circuit held that it was a close question, but that the district court did not abuse its discretion in so holding.

Rembrandt challenged the district court's second finding by arguing that it was not in control of the documents that were destroyed and that it lacked the "bad faith" required under Third Circuit law. Although the documents were held by a third party from whom Rembrandt had acquired several of the asserted patents, the Federal Circuit held that there were sufficient facts supporting the conclusion that Rembrandt nonetheless had control. The court also found that Rembrandt "had reason to believe that document destruction was possible" and therefore that the district court "could have found Rembrandt's claim of ignorance to be implausible."

Lastly, Rembrandt challenged the court's finding of inequitable conduct as to two of the asserted patents. The original patent holders had intentionally allowed the patents to lapse, failing to make maintenance payments, because their commercial value did not justify keeping them. However, the original owner later revived the patents by submitting a late payment and telling the PTO that the lapse in payment was "unintentional"—the basis for which was the owner's mistaken belief that patents that lapsed for non-payment of maintenance fees could later be revived. The Federal Circuit held that such a belief could not make the failure to pay the fees "unintentional," that this constituted inequitable conduct rendering the patents unenforceable, and that Rembrandt should have known of this fraud.

In vacating the fees award, the Federal Circuit held that although there was sufficient documentation and consideration of the requested fees, the district court had failed to assign a causal link between the alleged misconduct and the awarded fees. The Federal Circuit remanded the case for the district court to consider which if any of the fees stemmed from those circumstances giving rise to the exceptional-case determination.

In re Smith Int'l, Inc.,

871 F.3d 1375 (Fed. Cir. 2017))

In an appeal from an *ex parte* reexamination of Smith's patent, the Federal Circuit reversed the PTAB's decision that upheld the examiner's rejection of Smith's claims.

On appeal, Smith challenged the PTAB's construction of "body" and determinations of anticipation and obviousness. The '817 patent is directed to a downhole drilling tool for oil and gas operations. The patent describes that "one or more pocket recesses 516" are "formed in the body 510" to provide a "drive mechanism for the moveable tool arms 520 to move tool body 510 with a flowbore 508 extending therethrough" and "one or more moveable, non-pivotable tool arms 520."

The Federal Circuit concluded that the PTAB's construction of "body" was unreasonably broad under general claim construction principles. The Court found that while some of the claims at issue recited a broad term "body" without further elaboration on what that term

encompasses, the remainder of the specification did not use the term as a generic body. It was not disputed that the '817 patent specification consistently described and referred to the "body" as a component distinct from others, such as the mandrel, piston, moveable arms, and drive ring. Accordingly, the Court found that the PTAB's reasoning was erroneous since they concluded that the examiner's interpretation was reasonable just because the specification did not in and of itself proscribe the examiner's construction.

In giving a claim its broadest reasonable interpretation in light of the specification, the correct inquiry is not whether the specification proscribes or precludes some broad reading of the claim. It does not include giving claims "legally incorrect interpretation[s]" that are "divorced from the specification and the record evidence." The correct interpretation corresponds with what and how the inventor describes his invention in the specification. The court explained that the examiner instead arbitrarily included and excluded separately described components to and from the term "body." The court found that giving the term "body" such strained breadth in the face of otherwise different description in the specification was unreasonable.

Because the PTAB's anticipation and obviousness findings depended on an incorrect claim construction, the court found that neither was supported by substantial evidence. Since it was undisputed that the meaning of the term "body" would be dispositive of all the claims, the Federal Circuit held that the challenged claims were not unpatentable as anticipated or obvious and the rejections of all the appealed claims were reversed.

In re Stepan Co.,

868 F.3d 1342 (Fed. Cir. 2017)

In this appeal, the Federal Circuit reversed the PTAB's decision for failing to fully articulate its basis for findings regarding a motivation to combine prior art references in an obviousness analysis.

The PTAB, in this case, had affirmed an examiner's rejection of claims in a patent for herbicidal formulations related to glyphosate. The examiner had found that a skilled artisan would have been motivated to make the formulations because the prior art teaches glyphosate compositions containing surfactants having a cloud point of 60°C, so reaching a cloud point of 70°C would have been routine and "a matter of optimizing the combination." The PTAB had affirmed the finding of obviousness, reasoning that it was "routine optimization" to adjust the claimed surfactants to achieve a cloud point above 70°C because the prior art teaches that the cloud point should be above 50°C and ideally 60°C. But the PTAB provided no explanation as to how it reached that finding.

In its decision, the Federal Circuit reiterated that an obviousness determination requires finding "both that a skilled artisan would have been motivated to combine the teachings of prior art" and that he would have indeed "had a reasonable expectation of doing so." The Federal Circuit found that the PTAB did not provide sufficient detail or "rational underpinning why a person of ordinary skill in the art would have arrived at the claimed invention through routine optimization." While the PTO argued on appeal that substantial evidence supports the PTAB's findings, the court would not accept any "post hoc

rationalization” given that the PTAB’s opinion itself provided scant explanation. Further, the court held that the PTAB erred in placing the burden of proving patentability on the patent applicant and faulted the PTAB for not establishing a prima facie case of obviousness in the first place.

Judge Lourie dissented, opining that the 70°C cloud point is not a component of the composition claim, but rather a result or a property. In his view, the broad claims in the application are obvious given the similarly broad disclosures in prior art.

In re VerHoef,

888 F.3d 1362 (Fed. Cir. 2018)

The Federal Circuit held that the applicant’s failure to name a joint inventor rendered the claimed invention unpatentable under Section 102. The Court held that the applicant could not obtain a patent because “he did not himself invent the subject matter sought to be patented,” under 35 U.S.C. § 102(f) (2006).

VerHoef’s pending patent application generally related to a dog mobility device. The PTAB had found that a third-party veterinarian suggested to the applicant the idea of using a figure eight loop as part of the claimed invention, and the figure eight loop was an essential element of the claimed invention. Thus, the PTAB rejected the application. The Federal Circuit’s review of conception and inventorship was de novo, but premised on underlying factual findings which it reviewed for substantial evidence. The Federal Circuit held the veterinarian to be a joint inventor because she shared in the conception of the claimed invention by contributing the idea of the figure eight loop—an essential feature of the invention not insignificant in quality or well known in the art.

The Federal Circuit declined to adopt a theory, endorsed by an earlier PTAB decision and urged by the applicant, that an inventor does not lose his quality as inventor by reason of having received a suggestion or material from another as long as he maintains “intellectual domination” of the work of making the invention. The Federal Circuit also declined to adopt an “emancipation theory” under which the veterinarian emancipated her idea when she freely gave it to the applicant.

In re ZTE (USA) Inc.,

890 F.3d 1008 (Fed. Cir. 2018)

On a petition for writ of mandamus, the Federal Circuit decided that Federal Circuit law governed the burden of persuasion in showing improper venue in patent cases.

American GNC sued ZTE USA and ZTE (TX) Inc. (collectively, “ZTE”) for patent infringement in the Eastern District of Texas. ZTE filed a motion to dismiss for improper venue under 28 U.S.C. §§ 1406 and 1400(b). Applying Fifth Circuit law, the magistrate judge denied the motion because ZTE had not met its burden of showing that venue was improper. In particular, the magistrate judge determined that ZTE failed to show that it did not have a regular and established place of business in the Eastern District of Texas, as required under Section 1400(b), because ZTE had contracted with a call center in Plano, Texas. The district court adopted the magistrate judge’s determinations.

ZTE petitioned for a writ of mandamus, arguing that the magistrate judge and district court erred by placing the burden on ZTE. The Federal Circuit granted the petition, vacated the order denying ZTE's motion to dismiss, and remanded for reconsideration.

First, the Federal Circuit held that Federal Circuit law governed the placement of the burden of persuasion in showing improper venue. Because regional circuits were split on the burden of persuasion and because the burden was a substantive aspect of Section 1400(b), which is governed by Federal Circuit law, the panel concluded that the burden of persuasion should similarly be governed by Federal Circuit law.

Second, the Federal Circuit held that, upon a motion challenging venue in a patent case, the burden was on the plaintiff to show that venue was proper. The panel noted that the patent venue statute, unlike the general venue provision, was "intended to be restrictive of venue," cautioning against placing the burden on the defendant.

Finally, the Federal Circuit held that the district court failed to consider all of the relevant factors of ZTE's relationship with its call center in determining whether the call center constituted a regular and established place of business of ZTE. An arm's-length contract between the parties was insufficient to conclude the analysis, and the district court failed to consider factors like ZTE's level of control over the call center employees.

Intellectual Ventures I LLC v. Motorola Mobility LLC,
870 F.3d 1320 (Fed. Cir. 2017))

Intellectual Ventures I LLC ("IV") brought suit against Motorola Mobility LLC in the District of Delaware, alleging infringement of certain claims of U.S. Patent Nos. 7,810,144 and 7,120,462. A jury found that the asserted claims were infringed and not invalid. Motorola appealed 4 issues: (1) whether the asserted claim of the '144 patent is invalid for lack of written description; (2) whether the asserted claim of the '144 patent is invalid as obvious; (3) whether the asserted claim of the '144 patent is infringed; and (4) whether the asserted claims of the '462 patent are invalid as obvious.

The '144 patent broadly relates to transferring computer files electronically between two or more computers or computing devices. The '462 patent relates to a laptop computer formed by docking a smartphone into a shell having a larger display and keyboard.

The Federal Circuit first addressed the '144 patent, holding that the asserted claim was valid, but not infringed. Motorola argued that the specification excluded "long-term" or "permanent storage" of data being transmitted on intermediary computing devices based upon some limiting language in the specification. The Federal Circuit agreed with the district court that, under the proper claim construction, the claimed system excludes long-term or permanent storage on intermediary devices. Motorola also argued that the asserted claim of the '144 patent was obvious over two pieces of prior art. The Federal Circuit determined that the jury's finding of validity was supported by substantial evidence because there was competing expert testimony on whether one piece of prior art disclosed a key limitation.

Turning to the issue of infringement, the Federal Circuit held that IV failed to present evidence of a directly infringing “use” of the claimed system because none of the accused direct infringers “used” the limitation that required the “authenticating device configured to . . . generate a delivery report.” First, the Federal Circuit clarified its holding in *Centillion Data Systems, LLC v. Qwest Communications International, Inc.*, 631 F.3d 1279 (Fed. Cir. 2011). The Federal Circuit held that, in a system claim under *Centillion*, proof of an infringing “use” of the claimed system under Section 271(a) requires the patentee to demonstrate that the direct infringer obtained “benefit” from each and every element of the claimed system. Further, the direct or indirect control required is “the ability to place the system as a whole into service.” In this case, IV failed to present any evidence that Motorola’s customers ever controlled or benefited from the delivery reports that were allegedly generated by the third-party authenticating device.

As to the claims of the ’462 patent, the Federal Circuit affirmed that the claims were valid because the two experts presented conflicting testimony as to whether there was motivation to combine the two key prior art references. According to the Federal Circuit, this amounted to substantial evidence that there was no motivation to combine.

Judge Newman concurred in part and dissented in part. She concurred in the finding that the claim of the ’144 patent was not infringed, but had a different interpretation of *Centillion*. According to Judge Newman, *Centillion* does not require a showing of individual benefit from every separate element that is included in the claim. She explained that, under *Centillion*, “use” is properly defined as occurring when, “but for the customer’s actions, the entire system would never have been put into service, and each claimed component is placed in service on the party’s behalf.” Judge Newman dissented as to the validity of the two patents.

Intercontinental Great Brands LLC v. Kellogg N. Am. Co.,
869 F.3d 1336 (Fed. Cir. 2017)

The Federal Circuit affirmed a district court’s summary judgment of invalidity due to obviousness and of no inequitable conduct. Kraft, now Intercontinental Great Brands, owned the ’532 patent which described a combination of packaging: one for a frame with a wrapper, such as used for cookies, the other with a seal that can be pulled back to access the contents and later be resealed, common in wet wipes.

Kraft sued Kellogg for infringement and Kellogg responded by asserting that the patent was unenforceable due to inequitable conduct. The district court properly granted summary judgment of invalidity of the ’532 patent due to obviousness, but also granted summary judgment of no inequitable conduct.

On appeal, the Federal Circuit affirmed both holdings. On obviousness, the Federal Circuit rejected Kraft’s argument that the district court was required to consider objective indicia before its motivation to combine analysis—analyzing objective indicia after considering the prior art and the motivation to combine, but prior to finding obviousness, is not erroneous. Further, the Federal Circuit rejected Kraft’s argument that there was more than one reasonable inference about whether a skilled artisan had motivation to combine the

prior art. Kraft relied on the fact that Kellogg personnel rejected the idea of combining the traditional cookie package with resealable technology. The court explained, however, that a temporary business decision “is not sufficient to defeat the otherwise-compelled inference that combining the Re-Seal It packaging with familiar cookie-package frames . . . was a predictable technological solution to the relevant known market problem.”

The Federal Circuit also held that the district court also properly granted summary judgment for Kraft of no inequitable conduct. Kellogg alleged that Kraft failed to inform the PTAB in an *ex parte* reexamination that a relevant article in *Packaging Material* describing the prior art as not using “conventional wrapping film” was a misprint and that conventional film was indeed used. Kellogg, however, failed to show deceptive intent—there was nothing to indicate that Kraft knew of the misprint at the time of the reexamination.

Judge Reyna, dissenting-in-part, opined that the district court erred in finding “a prima facie case of obviousness before considering Kraft’s evidence of objective indicia of nonobviousness.” Because of its conclusion of obviousness, the Federal Circuit did not review the district court’s finding of literal infringement. Judge Reyna, finding an error in the district court’s claim construction, would reverse literal infringement as well.

Interval Licensing LLC v. AOL, Inc.,
896 F.3d 1335 (Fed. Cir. 2018)

In this case, the Federal Circuit affirmed the district court’s finding that the asserted claims were directed to an abstract idea, and invalidated the claims under Section 101.

The patent claimed the presentation of two sets of information in a non-overlapping way on a display screen. The Federal Circuit found that the claims failed *Alice* step 1 because they encompassed an abstract idea—“providing information to a person without interfering with the person’s primary activity.” The court noted that the district court has “aptly observed” this basic practice had been long used by television stations providing a news ticker at the bottom of the screen, or even one person passing a note to another person who is the middle of a meeting. The court found the broad, results-oriented construction for the “attention manager” limitation did not encompass a technological improvement, as it did not limit how to produce the result of the two non-interfering displays of information. The court further found the claims failed *Alice* step 2, as the claims did not recite an inventive method of information display and application on a computer is insufficient to render claims patent-eligible.

Judge Plager concurred-in-part and dissented-in-part. He agreed with the reasoning of the majority under the “current state of the law,” but found that “the state of the law is such as to give little confidence that the outcome is necessarily correct.” For example, he observed that “abstractness” is nearly impossible to consistently assess and “inventive concept” is an aspect of patent law that “had been put into the dustbin of history.”

Inventor Holdings, LLC v. Bed Bath & Beyond Inc.,
876 F.3d 1372 (Fed. Cir. 2017)

In this appeal, the Federal Circuit unanimously affirmed the district court’s award of attorney’s fees to Bed Bath & Beyond (“BBB”) under 35 U.S.C. § 285. The district court and the Federal Circuit found that the ongoing litigation between Inventor Holdings (“IH”) and BBB was “exceptional” under the *Octane Fitness* standard because IH had an obligation to reassess the merits of its case contemporaneously with new developments in the controlling legal framework.

IH sued BBB for infringement of patents directed towards a method of purchasing goods at a local point-of-sale system from a remote seller. BBB filed a Section 101 motion, arguing that the asserted patent’s claims were barred because they were directed to an abstract idea of “paying for a remote purchase at a local retailer,” and that the claims “do not include any meaningful limitations that would ensure that they amount to ‘significantly more’ than just the ineligible abstract idea.” The district court granted the motion. BBB then moved for an award of attorney’s fees under Section 285, arguing that the case was “exceptional” under the *Octane Fitness* standard because “IH should have reevaluated its case” following the Supreme Court’s decision. The district court granted the motion and awarded BBB its post-*Alice* attorney’s fees. IH appealed.

On appeal, the Federal Circuit agreed with the district court’s finding that the case was “exceptional” based on the weakness of IH’s post-*Alice* patent-eligibility arguments and the need to deter similar litigation in the future. IH made multiple arguments challenging the award of attorney’s fees that the Federal Circuit rejected. For example, IH argued that it was reasonable to believe that the ’582 patent’s claims were patentable because the district court had previously denied Section 101 motions filed by other defendants prior to *Alice*. The Federal Circuit rejected this argument, noting IH’s claims “were dubious even before the *Alice* decision” in light of existing case law and that the district court never endorsed the “patent-eligibility” of the claims, despite denying the other defendants’ Section 101 motions. IH also argued that the Supreme Court’s ruling in *Alice* had not fundamentally changed Section 101 law so as to “render the ’582 patent clearly invalid.” The Federal Circuit disagreed, explaining that *Alice* clarified the state of the law with regards to “computer-implemented business transaction inventions” and patent claims involving the “implementation of economic arrangements using generic computer technology.”

James v. J2 Cloud Servs., LLC,
887 F.3d 1368 (Fed. Cir. 2018)

U.S. Patent No. 6,208,638 claims systems and methods for the conversion of an incoming facsimile or voicemail message into a digital representation, which is then forwarded to an email address associated with the account holder’s phone number. The ’638 patent was originally assigned to JFAX Communications (“JFAX”). At the time of the suit, the ’638 patent was assigned to Advanced Messaging Technologies (“AMT”), and j2 had an exclusive license to it. Plaintiff Gregory James alleged that in 1995, he was introduced to JFAX’s Mr. Rieley, who asked James to develop software that would provide JFAX with

fax-to-email, email-to-fax, and voicemail-to-email functionalities. In 1996, James, for GSP Software, and Rieley, for JFAX, signed a software development agreement (“SDA”) outlining the relationship between the two parties. Although the SDA expressly required the assignment to JFAX of all copyright interests in the developed code and compiled software, the SDA did not mention patent rights. James also claimed that he was not aware of the ’638 patent until 2013, when he was contacted by an attorney representing one of the defendants alleging infringement of the ’638 patent. James subsequently brought suit against j2 and AMT asserting a claim for correction of inventorship under 35 U.S.C. § 256, as well as various state law claims. The district court granted the motion to dismiss for lack of Article III standing on the grounds that James lacked a stake in the controversy because he failed to allege facts sufficient to show that he had an ownership or financial interest in the ’638 patent.

The Federal Circuit disagreed with the district court and reversed the district court’s dismissal for lack of jurisdiction. The court concluded that if James were to prevail on the allegations in this case, he would stand to gain concretely. Further, such a gain would be directly related to the merits of the claim and would redress the asserted injury of being deprived of allegedly rightful ownership. According to the Federal Circuit, the district court did not conclude otherwise but found this line of argument unpersuasive because of the important qualification that when a patent owner assigns away all rights to the patent, neither he nor his later assignee has a concrete financial interest in the patent that would satisfy the standing requirement in a correction of inventorship action. The district court thus concluded that, based on the SDA and the “hired-to-invent” doctrine, the facts indisputably showed that James assigned away, or entered into an enforceable agreement to assign away, any ownership rights he may have had in the patent.

The Federal Circuit disagreed with both conclusions. While the district court found that the SDA necessarily precluded James from retaining ownership of the patent rights, the Federal Circuit found the SDA amenable to the construction that it did not assign, or promise to assign, patent rights that would otherwise accrue to James as an inventor for two reasons. Accordingly, the Federal Circuit held that the SDA did not deprive James of Article III standing.

The Federal Circuit also declined to apply the “hired-to-invent” doctrine to this case for several reasons. For example, the doctrine, which allows an employer to claim an employee’s inventive work where the employer specifically hired or directed the employee to exercise inventive faculties, had never been applied to a case where the underlying agreement for engagement of services was between two artificial legal entities and to which the inventor was not personally a party. The Federal Circuit thus reversed the district court’s order dismissing James’s claims for lack of jurisdiction and remanded for further proceedings.

Jazz Pharm., Inc. v. Amneal Pharm., LLC,
895 F.3d 1347 (Fed. Cir. 2018)

On appeal from six IPRs ruling all instituted claims invalid as obvious, the panel found that (1) it had jurisdiction over the appeal, (2) substantial evidence supported the PTAB’s

finding that the FDA’s Advisory Committee materials (“Advisory Committee Art,” or “ACA”) were printed publications, and (3) that the PTAB’s constructions were correct and that the PTAB did not err in holding that the instituted claims were invalid as obvious.

The asserted patents related to a centralized database for tracking prescriptions of “sensitive drugs,” *i.e.*, those that have a high risk of being abused. A key issue of the case was whether certain FDA Advisory Committee materials concerning the responsible handling of the drug Xylem[®]—which contains the active ingredient gamma-hydroxybutyrate, known as the “date-rape drug”—presented in a June 6, 2001, committee meeting, advertised in a May 14, 2001, Federal Register Notice, and stored on the FDA website were sufficiently publically available to qualify as printed publications. After examining its prior precedent on the issue, the court found that three factors supported the PTAB’s finding that the ACA materials were prior art. First, wide dissemination of a reference through a publication like the Federal Register that those of ordinary skill would be motivated to examine is a factor strongly favoring public accessibility. Second, the ACA materials were available online for a substantial time before the critical date of the patents-in-suit (two months). Third, the ACA materials were distributed via public domain sources with no possible expectation of confidentiality. Accordingly, the ACA materials were publically available and therefore prior art, and the patents were affirmed as invalid for obviousness.

John Bean Techs. Corp. v. Morris & Assocs.,
887 F.3d 1322 (Fed. Cir. 2018)

In an appeal from the Eastern District of Arkansas, the Federal Circuit reversed summary judgment in favor of Morris & Associates (“Morris”) and remanded to the district court for further proceedings. The Federal Circuit found that the district court abused its discretion in finding John Bean Technologies Corporation was equitably estopped from bringing patent infringement claims against Morris.

John Bean and Morris are competitors in the poultry chiller market. John Bean owns U.S. Patent No. 6,397,622—issued on June 4, 2002—which is directed to a “high-side” auger-type chiller for cooling poultry carcasses. The original patent had two claims, independent claim 1 and dependent claim 2. In June 2002, Morris’s counsel sent a letter to John Bean’s counsel, challenging the validity of the ’622 patent as anticipated and obvious. John Bean received but never responded to the letter, so Morris continued to develop and sell its chillers. Then, in December 2013, eleven years after the ’622 patent was first issued, John Bean filed a request for *ex parte* reexamination of the patent with the PTO and amended its two original claims and added six additional claims. After the reexamination certificate was issued, John Bean filed a complaint against Morris for patent infringement from the date of the reexamination certificate, rather than the original patent. Morris asserted the affirmative defenses of equitable estoppel, prosecution laches, and absolute and equitable intervening rights. The district court granted summary judgment for Morris, relying largely on Morris’ letter to reason that (1) John Bean’s decade-long silence constituted misleading conduct, (2) Morris relied on John Bean’s silence, and (3) Morris would be materially prejudiced if John Bean was allowed to pursue its infringement action.

On appeal, the Federal Circuit reviewed the appeal over equitable estoppel in two steps. First, it reviewed de novo whether the district court erred in finding no genuine issues of material fact existed. Then, the court reviewed the district court's application of equitable estoppel for abuse of discretion. Specifically, the Federal Circuit found that John Bean's original claims were narrowed during reexamination to overcome prior art and that the amendments made during reexamination were both substantial and substantive. Thus, when John Bean received Morris's letter challenging the validity of the '622 claims, John Bean could not have engaged in misleading conduct or silence regarding the reexamined claims because those claims did not issue until many years later. The court looked to its holding in *Radio Systems* where equitable estoppel could not apply to pending patent claims even if they could claim priority to a parent patent subject to equitable estoppel. Analogizing to John Bean's case, the court held that claims that have not issued cannot be asserted, and therefore no misleading conduct or silence could be present. The court concluded that the district court abused its discretion by applying equitable estoppel to bar John Bean's infringement action without considering how the *ex parte* reexamination affected the '622 patent claims.

Knowles Elecs. LLC v. Cirrus Logic, Inc.,
883 F.3d 1337 (Fed. Cir. 2018))

The Federal Circuit affirmed the PTAB's decision invalidating a patent as anticipated by the prior art and rejecting proposed claims for lack of written description.

Knowles Electronics appealed an *inter partes* reexamination decision affirming an examiner's rejection of claims 1–4 and proposed claims 23–27 of U.S. Patent No. 6,781,231. The '231 patent discloses microelectromechanical system (“MEMS”) packages comprising a substrate, a microphone, and a cover accommodating the microphone to shield it from interference signal or environmental conditions. The PTAB found claims 1–4 anticipated by the prior art based on its construction of the preamble term “package,” which it found to be limiting. The PTAB also rejected proposed claims 23–27, stating that Knowles did not provide adequate written description as to the “solder reflow process” specified in the patent.

The Federal Circuit found no error in the PTAB's claim construction. The court approved of the PTAB's review of extrinsic evidence that refuted Knowles' contention that the definition of “package” was limited to surface or through-hole mounting. The term “package” had been interpreted in a 2011 Federal Circuit case involving the '231 patent, but here the court clarified that the prior case did not require that a package be mounted via surface or through-hole mounts, and in light of that the PTAB properly construed the claim term in their reexamination. With regard to the proposed claims, the court concluded that substantial evidence supported the PTAB's determination that the specification does not provide adequate written description. The court found that the patent's single line disclosure of solder pads in the specification was insufficient to disclose the claimed solder process.

Judge Newman dissented, arguing that the PTAB should have been bound by the Federal Circuit's construction of the term “package” in a prior case relating to the '231 patent.

Knowles Elecs. LLC v. Iancu,
886 F.3d 1369 (Fed. Cir. 2018)

In this appeal, the Federal Circuit held that the PTO has standing to intervene to defend one of its decisions, even if the third-party requester has declined to defend the opinion on appeal.

Knowles Electronics LLC appealed an adverse decision from an *ex parte* reexamination filed by Analog Devices, Inc., where the PTAB found certain claims in U.S. Patent No. 8,018,04 related to silicon condenser microphone apparatus used in hearing aids were anticipated or obvious in light of prior art. Analog Devices declined to defend the judgment. The Director moved to intervene.

The Federal Circuit first held that the PTO could intervene in appeals to defend PTAB rulings after the challenger departs, pointing to the Director’s statutory right to intervene under 35 U.S.C. § 143. On the merits, the Federal Circuit held that the PTAB properly construed the claims. The court found that the PTAB’s construction was “nearly identical” to one the appeals court used in an earlier case. Similarly, the majority found that the PTAB and the examiner did not rely on a new ground of rejection and, instead, relied on the same grounds, “albeit using slightly different verbiage.”

Judge Newman dissented, arguing that the PTO could only intervene in appeals from the PTAB if it had a “concrete and particularized interest,” which it lacked here. She reasoned that the PTO intervening is improper when the “intervenor does not have an independent interest or injury, and no party remains as appellee on the side favored by the intervenor” because it lacks standing.

Lifetime Indus., Inc. v. Trim-Lok, Inc.,
869 F.3d 1372 (Fed. Cir. 2017)

In this appeal, the Federal Circuit reversed the district court’s decision to grant dismissal on the basis that the plaintiff, Lifetime Industries, Inc., failed to adequately allege that the defendant, Trim-Lok, Inc. directly or indirectly infringed the asserted claims.

The asserted patent claims generally related to a two-part seal for use in a mobile RV with a slide-out room formed by extending a portion of one of the RV’s walls outward. The seal is intended to keep outside debris and other materials from entering the interior living quarters. Lifetime alleged that two of its former engineers began working at Trim-Lok before institution of the action, and soon thereafter Trim-Lok began making—for the first time—an RV with a slide-out room using a two-part seal. Lifetime alleged that Trim-Lok directly or indirectly infringed the asserted claims by causing the two-part seal to be installed on non-Lifetime RVs.

Trim-Lok filed a motion to dismiss the original complaint on the basis that Lifetime failed to adequately identify the accused product that allegedly infringed the asserted claims. The district court granted the motion, as well as a second motion to dismiss the first amended complaint on the same basis. After Trim-Lok filed a third motion to dismiss Lifetime’s second amended complaint, the court granted the motion even though it held that Lifetime

had adequately identified the accused product. As to direct infringement, the district court held that Lifetime failed to adequately plead direct infringement “because the claims require both a two-part seal and an RV, and Trim-Lok only manufactures seals.” As to indirect infringement, the court held that Lifetime failed to allege any facts from which intent could be inferred, and instead offered only conclusory allegations that Trim-Lok had acted knowingly and intentionally.

The Federal Circuit reversed. The Federal Circuit held that Lifetime had adequately alleged direct infringement because it alleged that Trim-Lok “installed the seal onto the RV, and that the resulting seal-RV combination infringed” the asserted claims, which was “consistent with [the Federal Circuit’s] precedents holding that assembling the components of an invention is an infringing act of making the invention.”

The appeals court also held that Lifetime adequately alleged indirect infringement. The Federal Circuit held that Lifetime alleged that Trim-Lok and the two former Lifetime engineers knew of the asserted patent, and thus had knowledge of it. The Federal Circuit also held that Lifetime alleged that Trim-Lok had intent to infringe because, after gaining the knowledge of the asserted patent, Trim-Lok “assisted in or directed the installation of the exactly same type of seal” as described in the patent and had “never made or sold these particular seals prior to gaining that knowledge.”

MACOM Tech. Sols. Holdings, Inc. v. Infineon Techs. AG,
881 F.3d 1323 (Fed. Cir. 2018)

The Federal Circuit affirmed the entry of a preliminary injunction by the Central District of California but vacated one sentence of the injunction for lacking specificity under Rule 65(d) and another sentence for improperly ordering specific performance.

Nitronex (MACOM’s predecessor) obtained several patents related to its development of semiconductors using gallium nitride (“GaN”). It later sold its GaN patents to International Rectifier (Infineon’s predecessor), and as part of that sale, executed a separate license agreement which licensed back to MACOM certain rights under the patents. The agreement defined a “field of use” characterized by GaN-on-silicon (“GaN-on-Si”) technology and licensed MACOM to practice what were now Infineon’s GaN patents within the “field of use only.” MACOM and Infineon shared the rights to practice the licensed patents in the agreement’s field of use. The agreement, however, further defined an “exclusive field” within the field of use in which MACOM had certain exclusive rights to practice the licensed patents—even as against Infineon.

In February 2016, Infineon notified MACOM that it believed MACOM had breached the agreement by making and selling products using GaN-on-silicon-carbide (“GaN-on-SiC”) technology, which was distinct from GaN-on-Si technology and outside the agreement’s field of use. MACOM responded that the GaN-on-SiC sales were minimal and that any breach had been cured, but Infineon terminated the agreement on March 22, 2016, on the grounds that MACOM’s GaN-on-SiC activity was a material breach. MACOM then brought suit against Infineon asserting various contract claims and a claim for declaratory judgment of non-infringement of the licensed patents. MACOM also moved for a

preliminary injunction based on its claim that the agreement was wrongly terminated and remained in effect. The district court granted a preliminary injunction invalidating the termination of the agreement and barring Infineon from designing, developing, making, using, selling, or serving products in MACOM's exclusive field. The injunction also prohibited Infineon from granting licenses or sublicenses to the licensed patents.

Infineon challenged the injunction on three grounds. First, Infineon argued that the district court erred in finding that MACOM showed a likelihood of success on its wrongful termination claim because Infineon's termination of the agreement was not wrongful. Infineon argued that MACOM's GaN-on-SiC activity materially breached the agreement's implied covenant of good faith and fair dealing, justifying the agreement's termination. The Federal Circuit determined that the district court did not err in finding that MACOM could likely establish that its activity outside the field of use did not breach the agreement's implied covenant of good faith and fair dealing because all the agreement conveyed was a promise by the licensor (Infineon) not to sue the licensee (MACOM). In short, the language did not suggest any additional promise or obligation that MACOM breached.

Second, Infineon argued that the district court erred in finding that MACOM showed irreparable harm because MACOM never showed that any of the allegedly marketed products practiced any of the licensed patents and thus there was no causal nexus between the agreement's termination and Infineon's marketing of its GaN-on-Si products in MACOM's exclusive field. The Federal Circuit found that the district court did not rely solely on Infineon's marketing as infringement of the patents in finding irreparable harm but also relied on testimony showing that MACOM's exclusivity provided it with certain commercial benefits (beyond just the right to sue infringers) that would be lost if the termination were effective. Accordingly, the Federal Circuit concluded that a sufficient causal nexus existed between Infineon's termination of the agreement and harm to MACOM.

Finally, Infineon challenged the content of the injunction. The Federal Circuit vacated the first sentence of the third paragraph of the injunction because it lacked the specificity required by Rule 65(d). The court found that the first sentence essentially prohibited infringing acts without actually referencing the particular, adjudicated infringing product, which was not even possible in this case because no product had been adjudicated. The court held that injunctions arising from contractual claims that incorporate patent rights are to be treated the same as injunctions arising from patent infringement claims. The court also vacated the second sentence of the third paragraph of the injunction for improperly ordering specific performance of a contractual provision absent a showing of breach of that provision.

MasterMine Software, Inc. v. Microsoft Corp.,
874 F.3d 1307 (Fed. Cir. 2017)

MasterMine sued Microsoft for infringement of two related patents. The district court entered a claim construction order construing the disputed term "pivot table." In the claim construction order, it also held the asserted claims indefinite for improperly claiming two

different subject matter classes. The parties thereafter stipulated to final judgments of non-infringement and invalidity, and MasterMine appealed.

With respect to the challenged claim construction order, the Federal Circuit upheld the district court's order that the term "pivot table" means an interactive set of data displayed in rows and columns that can be rotated and filtered to summarize or view the data in different ways. The court rejected MasterMine's argument that the district court improperly construed the term "pivot table" because it excluded tables that do not display data. In rejecting this argument, the court noted that every time the claim discussed generating a pivot table, the claim indicated the pivot table contained or presented data. The court also relied on the meaning of claim terms from the prosecution of a patent in the same family.

The Federal Circuit reversed the district court's finding of indefiniteness. The Federal Circuit recognized that claims can be indefinite if they cover both an apparatus and a method of use of that apparatus, but clarified that apparatus claims are not necessarily indefinite if they use functional language. Even though the claims included active verbs like "present," "receives," and "generates," these verbs described capabilities, not activities performed by the user. Thus, the claim made clear to those skilled in the art about the scope of the invention with reasonable certainty. In other words, it was clear from the claim that infringement would occur if and when a party made an apparatus.

MaxLinear, Inc. v. CF CRESPE LLC,
880 F.3d 1373 (Fed. Cir. 2018)

The Federal Circuit vacated the PTAB's decision upholding the patentability of claims 1–4, 6–9, and 16–21 of U.S. Patent No. 7,075,585 because the PTAB based its decision solely on an analysis of independent claims 1 and 17, and the Federal Circuit in a separate case found claims 1 and 17 of the same patent unpatentable.

MaxLinear petitioned for an IPR of claims 1–21 of the '585 patent. The PTAB upheld the patentability of claims 1–4, 6–9, and 16–21 of the '585 patent because each of the challenged claims (except 1 and 17) incorporated the limitations of independent claims 1 and 17. In other words, the PTAB based its finding of nonobviousness entirely on an analysis of claims 1 and 17. MaxLinear appealed the PTAB's decision with respect to dependent claims 4, 6–9, and 20–21. While the appeal was pending, the PTAB in a separate IPR ("the '728 IPR") issued a final written decision that claims 1–3, 5, 10, and 16–19 of the '585 patent were unpatentable, and that decision was affirmed by the Federal Circuit.

The court held that issue preclusion applied to the final written decision of the PTAB and the fact that the '728 IPR became final while this case was pending on appeal was irrelevant for purposes of issue preclusion. Because the PTAB based its decision solely on the patentability of claims 1 and 17 and did not separately address the dependent claims, the court vacated the PTAB's decision and remanded so that the PTAB could consider whether the dependent claims could survive in light of the collateral estoppel effect of the separate finding of unpatentability of claims 1 and 17.

Medtronic, Inc. v. Barry,
891 F.3d 1368 (Fed. Cir. 2018)

This is an appeal of two IPRs finding the petitioner, Medtronic, Inc., had not proven that the challenged patent claims of U.S. Patent Nos. 7,670,358 and 7,776,072 were unpatentable. Medtronic manufactures surgical systems and tools used in spinal surgeries. Spine surgeon Dr. Mark Barry sued Medtronic for patent infringement on two of his patents. Medtronic then petitioned for, and the PTAB instituted, IPR proceedings on both patents. Medtronic challenged the claims as obvious over (1) a published patent application; (2) a book chapter; and (3) a video demonstration and slide presentation Medtronic had presented to spinal surgeons at various industry meetings and conferences. The PTAB issued its patentability decisions over the published patent application and book chapter, but found that the video and slides were not publicly accessible and therefore were not “printed publications.” Medtronic appealed.

The Federal Circuit first affirmed the PTAB’s patentability decisions over the published patent application and book chapter, finding no error in the PTAB’s final determination of patentability. The court then tackled the question of whether the video and slides were “printed publications” under 35 U.S.C. § 102(b). A CD containing the video was distributed at three separate conferences, and binders containing “relevant portions of the slides” were also distributed at two of the conferences. The court found, however, that the district court had not fully considered all of the relevant factors to determine whether these materials were sufficiently publicly accessible, such as the expectations of confidentiality between the distributor and the recipients of the materials. Because the record did not show that the PTAB fully considered all of the relevant factors, the Federal Circuit vacated the PTAB’s finding that the video and slides were not printed publications, and remanded for further proceedings consistent with its opinion.

Merck Sharp & Dohme Corp. v. Amneal Pharms. LLC,
881 F.3d 1376 (Fed. Cir. 2018)

In this appeal, the Federal Circuit affirmed the District of Delaware’s finding of non-infringement and held that the district court did not abuse its discretion in refusing to compel the accused infringer to produce additional samples of the accused product.

Merck Sharp & Dohme Corp. owns U.S. Patent No. 6,127,353, which concerns mometasone furoate monohydrate (“MFM”), the active ingredient in Merck’s Nasonex nasal product. Amneal Pharmaceuticals submitted an ANDA to the FDA seeking approval to market the generic version of Nasonex. Merck filed an infringement suit alleging that Amneal’s product would infringe the ’353 patent. The FDA required Amneal to complete a bulk-hold study, in which Amneal’s commercial batch would be held for a four-day period before being packaged into nasal spray bottles. While Amneal provided Merck with samples from the Day 1 batch of the requested bulk-hold study, it did not provide samples from the Day 4 batch nor the “A Batch,” which was bottled for storage after the study was completed. Merck argued that because the Day 4 and A batches underwent additional mixing, which can promote development of the infringing MFM, it was necessary for Amneal to produce samples from those two batches. The district court, however, refused

to compel Amneal to produce these additional samples and instead gave Merck the opportunity to prove at trial that the Day 4 and A batches are materially different from the Day 1 batch. The district court held, after a bench trial, that Merck did not carry its burden of proving infringement. Merck then appealed.

The Federal Circuit held that (1) it was within the district court's discretion not to compel the competitor to produce additional samples of accused product, (2) the district court's reliance on earlier samples to determine that accused product in ANDA would not infringe the patent, rather than relying on additional samples with additional mixing, was not clear error, and (3) the accused product would not infringe the patent. On the discovery issue, the Federal Circuit held that Merck was unable to prove that Amneal's failure to produce additional samples of the accused product was prejudicial. On the issue of infringement, the Federal Circuit found that the finding of non-infringement was supported by the record. For example, Merck argued that the district court erred by finding that three Raman peaks were required in order to confirm the presence of MFM. The Federal Circuit found, to the contrary, that the district court properly relied on (i) testimony from Amneal's expert that stated that a finding of three Raman peaks was typical when absolutely confirming the presence of MFM, and (ii) other district court opinions that similarly concluded that three peaks were required in such instances.

Merck Sharp & Dohme Corp. v. Hospira Inc.,
874 F.3d 724 (Fed. Cir. 2017)

In this case involving an antibiotic compound, Invanz, the district court held Merck's patent was invalid due to obviousness. The majority on the Federal Circuit upheld the district court's ruling.

Merck challenged the district court's ruling of obviousness for patent '323 because it was undisputed that none of the claimed steps had been disclosed in the prior art. However, the Federal Circuit affirmed that the principles of experimentation were disclosed in the prior art. The elements that were not disclosed were all experimental details that one of ordinary skill would have utilized. Consequently, it was reasonable for the district court to deduce that the order and detail of the process would have been discovered by routine experimentation.

The Federal Circuit also affirmed the district court's determination that Merck's objective evidence of commercial success could not overcome the weight of the evidence of obviousness. However, the Federal Circuit noted that Merck's evidence of commercial success should not have been discounted simply because Merck had control of another patent that precluded competition. The focus of commercial success is on the merits of the invention, not the portfolio of patents. Nonetheless, even giving the evidence of commercial success its full and proper weight, the Court did not discern clear error in the district court's determination that Merck's evidence of commercial success could not overcome the weight of the evidence that the claimed process was substantially described in the prior art and required only improvement by the use of established variations.

Judge Newman dissented, arguing that secondary considerations of non-obviousness should be considered with the with the other three *Graham* factors, not as a “rebuttal” against those factors.

M-I Drilling Fluids UK Ltd. v. Dynamic Air Ltda.,
890 F.3d 995 (Fed. Cir. 2018)

In this case involving alleged patent infringement by a foreign entity on two U.S.-flagged ships, the Federal Circuit held that the assertion of personal jurisdiction over the alleged infringer comported with due process. The patents were generally directed to methods, systems, and apparatuses used in the collection, conveyance, transportation, and storage of drilling waste created around undersea oil wells.

The district court had granted the alleged infringer’s motion to dismiss for lack of personal jurisdiction. In their arguments to the Federal Circuit, the parties disputed whether the exercise of personal jurisdiction over the defendant would comport with due process. This analysis contemplated the defendant’s contacts with the entire United States, as opposed to the state in which the district court sat. The Federal Circuit observed that the defendant had installed pneumatic conveyance systems on U.S.-flagged ships and continued to engage in allegedly infringing activities even after plaintiff had cautioned defendant that its systems infringed the asserted patents. Nothing more was required to show that the defendant’s activities were purposefully directed at the United States, and the claim of patent infringement arose out of those contacts.

The burden then shifted to the defendant to present a compelling case that other considerations rendered jurisdiction unreasonable. The Federal Circuit considered five due process factors: (1) the burden on the defendant; (2) the forum’s interest in adjudicating the dispute; (3) the plaintiff’s interest in obtaining convenient and effective relief; (4) the interstate judicial system’s interest in obtaining the most efficient resolution of controversies; and (5) the shared interest of the states in furthering fundamental substantive social policies. The Federal Circuit relied on precedent to conclude that the first three factors strongly favored the exercise of personal jurisdiction: Progress in communications and transportation had made the defense of a foreign lawsuit less burdensome, and the interests of the United States and the plaintiff sufficiently outweighed any such burden. The fourth and fifth factors were concerned with the potential clash of substantive social policies between competing fora and the efficiency of a resolution to the controversy: In this case, no competing U.S. forum was available, and the Federal Circuit had no reason to believe that the Federal government’s interest in its foreign relations policies with Brazil would be hindered by allowing the district court to exercise personal jurisdiction. The defendant had not met its burden of establishing that this was one of the rare cases in which fair play and substantial justice defeat the reasonableness of a U.S. court exercising personal jurisdiction over a defendant. The Federal Circuit thus concluded that the district court’s exercise of personal jurisdiction over the defendant comported with due process.

Judge Reyna filed a concurring opinion to provide additional reasoning why the exercise of personal jurisdiction in this case did not offend traditional notions of fair play and substantial justice.

Microsoft Corp. v. Biscotti, Inc.,
878 F.3d 1052 (Fed. Cir. 2017)

In 2013, Biscotti sued Microsoft in the Eastern District of Texas alleging Microsoft infringed U.S. Patent No. 8,144,182, which related to video conferencing technology. Microsoft then filed three IPRs in 2014 in response, challenging claims 6 and 69 of the '182 patent on anticipation grounds and challenging claims that depended from 6 and 69 on obviousness grounds over U.S. Patent No. 7,907,164 (“Kenoyer”). The PTAB held that Microsoft failed to prove by a preponderance of the evidence that Kenoyer anticipated the challenged claims or rendered them obvious. The Federal Circuit affirmed.

The Federal Circuit emphasized that the PTAB’s conclusion on anticipation was a finding of fact subject to substantial evidence review, contrary to Microsoft’s assertion in its brief that the PTAB’s conclusion should not be afforded deference. Microsoft argued on appeal that the PTAB applied an overly narrow anticipation standard in its final decision, asserting that a prior art reference does not need to disclose all the limitations arranged or combined as in the claim in order to anticipate if a person of ordinary skill in the art would at once envisage the claimed arrangement. The Federal Circuit held that the PTAB used the correct standard, which is that a prior art reference must provide every element of the claimed invention arranged as in the claim in order to anticipate.

The Federal Circuit first held that the PTAB’s conclusions regarding whether Kenoyer invalidated the challenged claims were supported by substantial evidence, such as the testimony of Biscotti’s expert. Microsoft disputed the PTAB’s interpretation of the term “set-top box,” which Microsoft asserted was defined in the '182 patent as “any device that can provide video tuning, decryption and/or decoding functionality, especially as that functionality relates to reception of broadcast, cable, and/or satellite television signals,” which allegedly included televisions and computers. Microsoft argued that the PTAB erred by limiting Kenoyer to the definition of “set-top box” provided by Kenoyer, instead of using the broader definition of “set-top box” provided by the '182 patent. The Federal Circuit held that Microsoft had waived that construction, and that regardless, the PTAB’s decision did not rely exclusively on the construction of “set-top box.”

Judge Newman dissented, writing that Kenoyer anticipated the '182 patent because every claim component was previously known and performed the same function in the same way in the same combination as disclosed in Kenoyer.

Monsanto Tech. LLC v. E.I. DuPont de Nemours & Co.,
878 F.3d 1336 (Fed. Cir. 2018))

E.I. DuPont de Nemours & Co. sought IPR of Monsanto’s U.S. Patent No. 7,790,953, which claimed a two-step process for mating parent soybean lines to produce soybean seeds with a modified fatty acid profile. The Federal Circuit affirmed the PTAB’s decision that claims 1, 7, 12–22, 24, and 27–30 were anticipated by U.S. Patent No. 6,426,448 (“Booth”), which was also directed toward crossing soybeans to obtain progeny with the desired fatty acid compositions. The Federal Circuit also affirmed the PTAB’s decision that claim 2 was obvious over Booth.

The Federal Circuit affirmed the PTAB's claim construction that Booth's parent line containing 4% linolenic acid was within the scope of "about 3%" as recited in the '953 patent, finding that a person having ordinary skill in the art would reasonably consider "about 3%" to encompass 4% by looking at the examples in the '953 patent, which described a parent line with a range of linolenic acid content from 2.3% to 4.1%.

The Federal Circuit also affirmed the PTAB's finding that the claim limitations in the '953 patent were inherent in Booth. The Kinney Declarations established that carrying out the crosses described by Booth Example 8 would result in progeny within the scope of claim 1 of the '953 patent, thereby inherently anticipating the claim. Monsanto argued, however, that when reviewing only intrinsic evidence, Booth Example 8 did not inevitably produce progeny within the scope of claim 1, and that the PTAB should not have relied on the declarations of one of the Booth inventors submitted during the reexamination. The Federal Circuit concluded that the PTAB may properly consider extrinsic evidence used to support what is "necessarily present" in a prior art's teaching to understand what it would have meant to a person having ordinary skill in the art.

Finally, the Federal Circuit affirmed the PTAB's finding that claim 2 was obvious, because a person having ordinary skill in the art could have been motivated to combine elements of Booth to produce plants having more variable seed oil fatty acid characteristics as found in claim 2 of the '953 patent.

Nalco Co. v. Chem-Mod, LLC,
883 F.3d 1337 (Fed. Cir. 2018)

In this appeal, the Federal Circuit reversed the district court's dismissal of Nalco's claims, and remanded the case for further proceedings. The Circuit found that Nalco adequately stated a claim for infringement under the *Iqbal/Twombly* pleading standard.

Nalco is the exclusive licensee of the '692 patent, which describes a method for the removal of elemental mercury, a toxic pollutant, from the flue gas created by combustion in coal-fired power plants. Nalco alleged that defendants' Chem-Mod Solution Mixture process operates in the same manner as the process encompassed by claim 1 of the '692 patent and filed five successive complaints against the various defendants. In its fourth amended complaint, Nalco alleged two theories of direct infringement, as well as indirect and willful infringement and infringement under the doctrine of equivalents. The district court dismissed Nalco's complaint under Rule 12(b)(6) and Nalco appealed.

On appeal, the Federal Circuit reinstated all of Nalco's claims. For the direct infringement claims, the court held that the defendants' arguments boiled down to objections to the proposed claim construction for "flue gas," a dispute that was found unsuitable for resolution on a motion to dismiss. The court found that resolution of the dispute around interpretation of the reexamination statements was particularly inappropriate in the Rule 12(b)(6) context. For the indirect infringement claims, the court concluded that the complaint alleged facts that plausibly show that defendants intended their customers to infringe the '692 patent, and that they knew the customers' actions would constitute infringement. The court also found that defendants' objections to the pleaded allegations

were factual inquiries not suitable for a motion to dismiss. Finally, for the claim under the doctrine of equivalents, the court found that Nalco had adequately stated a claim for infringement based on the detailed explanations of defendants' use of the Chem-Mod Solution and the similarities to the method described in the '692 patent.

Nantkwest, Inc. v. Iancu,
898 F.3d 1177 (Fed. Cir. 2018)

The question for the en banc court was whether 35 U.S.C. § 145, which provides that “[a]ll the expenses of the proceedings shall be paid by the applicant,” requires the applicant to pay the PTO’s personnel expenses. The majority of the en banc court found that it did not.

The American Rule provides that, in the United States, “[e]ach litigant pays his own attorney’s fees, win or lose.” *Baker Botts L.L.P. v. ASARCO LLC*, 135 S. Ct. 2158, 2164 (2015). The Rule prohibits courts from shifting attorneys’ fees from one party to another absent a “specific and explicit” directive from Congress. The majority, affirming the district court’s judgment, concluded that the phrase “[a]ll the expenses of the proceedings” fell short of this stringent standard.

The majority was not persuaded by the PTO’s arguments for why the American Rule should not apply to litigation under Section 145. To satisfy the Supreme Court’s strict standard under the American Rule, the majority required the PTO to show that “[a]ll the expenses of the proceedings” specifically and explicitly includes attorneys’ fees. The majority concluded that the PTO failed to do so and found that the phrase is at best ambiguous as to attorneys’ fees. To reach its conclusion, the majority examined contemporaneous definitions and usages of “expenses,” Congress’s usage of the terms “expenses” and “attorneys’ fees” in other statutes, and judicial usage of “expenses.”

The dissent would find that the plain text of Section 145 provides the answer: When Section 145 says “[a]ll the expenses of the proceedings shall be paid by the applicant,” it means the applicant must pay *all* the expenses of the proceedings. The dissent points out that it need not rely on the word “expenses” alone. Congress did not simply provide for “expenses of the proceedings” in Section 145—it clarified that it was requiring the applicant to pay “[a]ll the expenses of the proceedings.” The dissent also found support in the legislative history and the purpose of § 145. Finally, the dissent argues that the majority opinion creates an “unfortunate and unnecessary” conflict between the circuits.

Nestle USA, Inc. v. Steuben Foods, Inc.,
884 F.3d 1350 (Fed. Cir. 2018)

The Federal Circuit vacated and remanded the PTAB’s decision finding that a claim in patent for aseptic food packaging was not obvious. The court held that the construction given to the term “aseptic” in a prior appeal governed its meaning in the PTAB’s IPR of the present patent.

The '468 patent is owned by Steuben Foods, Inc. and describes systems for aseptic packaging of food products. Steuben Foods also owns a related patent, the '013 patent, which describes a method and apparatus for providing aseptically processed low acid

products in a container having a small opening at a high output processing speed. Nestle previously petitioned the PTAB for IPR of claims 18–20 of the '013 patent, which the PTAB found not obvious based on its construction of the term “aseptic.” On appeal, the Federal Circuit vacated the PTAB’s construction in that case, relying on binding lexicography in the specification for “aseptic” to construe the term to mean the “FDA level of aseptic.” When Nestle petitioned for IPR of claim 9 of the present patent, the PTAB again resolved the issue of obviousness in favor of Steuben Foods. Nestle appealed the PTAB’s finding that the claim was not obvious, arguing that the PTAB applied an erroneous construction of the terms “aseptic” and “aseptically disinfecting.”

Because neither party pointed to any material difference between the two patents or their prosecution history that would give rise to claim construction issues in the present appeal different from those raised in the prior appeal, the court found that collateral estoppel would apply. The Federal Circuit also noted that the claims at issue in the two appeals used the term “aseptic” in a similar fashion, and both provided identical lexicography for the term “aseptic” in their specifications. The court thus concluded that collateral estoppel protected Nestle and obviated the need to revisit an issue that was already resolved against Steuben Foods.

NFC Technology, LLC v. Matal,
871 F.3d 1367 (Fed. Cir. 2017)

The Federal Circuit reversed the PTAB’s determination that certain third-party activity did not inure to NFC’s benefit and remanded the proceedings back to the PTAB to determine whether NFC presented sufficient evidence that the prototype embodied the claimed invention.

NFC owns the '551 patent, which generally relates to a near-field communication device that uses electromagnetic induction to communicate information over very short distances. The patent claims a priority date of March 15, 1999. HTC alleged that certain claims were unpatentable as obvious over a patent referred to as “Sears,” which has a priority date of February 8, 1999. NFC responded that the inventor of the '551 patent, Bruno Charrat, and his team at INSIDE Technologies had reduced the invention to practice before Sears’s priority date. NFC presented evidence that Charrat’s invention was reduced to practice before Sear’s prior date, including: (1) an initial data sheet that described the device at a high level; (2) undated, unwitnessed excerpts from lab notebooks purportedly authored by Charrat; (3) printed circuit board (“PCB”) layouts for the device; (4) a return of a facsimile cover sheet from Concept Electronique (“CE”), the company commissioned to generate PCBs for the device, dated September 10, 1998, with Charrat’s signature under handwritten “OK FAB”; (5) a document detailing tests and results of the prototype’s antenna; (6) a highlighted wiring diagram purportedly used to verify that the prototype accurately reflected Charrat’s design, dated February 5, 1999; and (7) Charrat’s testimony on his research and testing during the relevant period.

Examining each piece of evidence, the PTAB determined that NFC had introduced insufficient evidence that Charrat had conceived the subject matter of the claims. Additionally, the PTAB determined that NFC had not provided sufficient evidence that CE fabricated the prototype according to Charrat’s design and at his direction because NFC

did not provide evidence relating to what was communicated to CE. Because of these findings, the PTAB did not decide whether the prototype embodied the claimed invention. NFC appealed and the Director of the PTO intervened.

The Federal Circuit limited its analysis to whether NFC provided sufficient evidence corroborating Charrat's conception to establish inurement. Inurement is a question of law that the Court reviews de novo, and conception is a question of law based on subsidiary factual findings. An inventor's testimony, standing alone, is insufficient to prove conception. Some form of corroboration is necessary. Corroboration is determined by a "rule of reason" analysis, where evidence is considered as a whole, not individually.

The Federal Circuit determined that the PTAB's findings as to the contents of the documents were either inconsistent with the documents themselves or did not adequately consider the portions of the documents that supported corroboration, and were therefore not supported by substantial evidence. Taken "as a whole," the Federal Circuit found that the documents corroborated Charrat's account of conception and held that CE's fabrication of the prototype inured to Charrat's benefit. However, the Court explained that that determination does not resolve the case because the PTAB must decide whether the prototype embodied the claimed invention to determine whether Sears can be antedated.

Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Ltd.,
868 F.3d 1013 (Fed. Cir. 2017)

The case arose from Broad Ocean's petition for IPR of Nidec Motor's patent covering a low-noise HVAC system, which the PTAB found both obvious and anticipated. The Federal Circuit, in a per curiam opinion, affirmed the PTAB's decision that claims were invalid as obvious, without addressing the PTAB's ruling on anticipation.

Broad Ocean challenged Nidec's '349 patent as obvious and anticipated. The PTAB instituted the review of the obviousness grounds, but declined to review the anticipation grounds because Broad Ocean failed to prove the accuracy of a Japanese patent publication. Broad Ocean filed a second petition, again alleging anticipation. The PTAB again declined to institute review on grounds of anticipation, finding that the petition was time barred under 35 U.S.C. § 315(b). The panel was expanded to five judges on rehearing, where it was concluded that Section 315(c) permits the joinder of the anticipation issue to the obviousness issue in the original IPR, providing an exception to the Section 315(b) time bar. The PTAB later found the '349 patent both anticipated and obvious.

The Federal Circuit held that the '349 patent was indeed obvious, and therefore did not need to review the PTAB's decision on anticipation and joinder. The court noted that the '349 patent essentially claims an HVAC system that comprises of a system controller and a motor controller that is configured for performing sinewave commutation, whereas conventional HVAC systems use square-wave commutation, which results in more vibration and noise generated from the electric motor. The court held that the combination of a prior art HVAC patent and a doctoral thesis on sinewave commutation in electric motors rendered the claims of the '349 patent obvious, finding that while the prior art patent aimed at reducing HVAC complexity, it did not teach away from sinewave commutation.

Judge Dyk, joined by Judge Wallach, concurred but expressed concern over the PTAB's interpretation of Section 315. For example, they were of the opinion that Section 315(c) does not allow a time-barred petitioner to add new issues, as opposed to belatedly joining a proceeding as a new party.

Organik Kimya AS v. Rohm & Haas Co.,
873 F.3d 887 (Fed. Cir. 2017))

In an appeal from an IPR in which the PTAB sustained the patentability of the challenged claims, the Federal Circuit affirmed the PTAB's decisions.

The PTAB construed 'swelling agent' as "expressing a structural element, i.e., 'an aqueous or gaseous, volatile or fixed base, or combinations thereof,' in functional terms, i.e., 'capable of permeating the shell and swelling the core, in the presence of the multistage polymer and monomer, under the conditions of the specific process for which the agent is to be used.'" Organik challenged the PTAB's interpretation of the term "swelling agent," arguing the PTAB improperly imported additional limitations into the claims by adding a "swelling step." The Federal Circuit affirmed the PTAB's claim construction as supported by the specification.

The PTAB reviewed claims 1–5 of the '435 patent and claims 1–7 of the '004 patent on anticipation and obviousness grounds. The PTAB found that the prior art references at issue in the IPRs showed the production of voided emulsion polymers but did not teach the use of a "swelling agent" to produce the polymers. Rohm and Haas introduced expert testimony and experimental data produced by its expert showing that the prior art reference at issue did not inherently anticipate the claims. Organik argued that the expert evidence was irrelevant and developed using flawed methodology, but Organik did not put forth any evidence of its own to support its argument of inherency. On appeal, Organik argued the PTAB erred in requiring Organik to conduct experiments to support its arguments for inherency. The Federal Circuit affirmed, explaining that the issue was not whether Organik was required to reproduce experiments but whether Organik provided sufficient evidence and argument to negate and outweigh the evidence and argument Rohm and Haas presented. The Federal Circuit also affirmed there was substantial evidence to support the conclusion that a person of ordinary skill would not have understood that the bases used would permeate the polystyrene shell and swell the core.

Ottah v. Fiat Chrysler,
884 F.3d 1135 (Fed. Cir. 2018))

The Federal Circuit affirmed the district court decision granting summary judgment of non-infringement to several defendant automobile companies with respect to U.S. Patent No. 7,152,840 and dismissing the complaint with prejudice as to several other automobile companies.

The '840 patent describes the invention in claim 1 as a removable book holder assembly with adjustable, releasable clipping means and a support arm, for use in a car or other mobile structures. The specification includes the statement that the book holder may be

used to hold items other than books, such as video equipment or cameras. Ottah filed a complaint stating that the defendant automobile companies infringed on his patent by manufacturing and selling mounted back-up cameras in their vehicles. A group of defendant automobile companies (the “MTD Defendants”) moved to dismiss for failure to state a claim. Another group of defendants (the “MSJ Defendants”) moved for summary judgment of non-infringement, claiming that the camera holders did not meet the “removable attachment” limitation of claim 1 because the camera holders on their vehicles cannot be removed without tools.

The district court construed the claim to exclude “fixed mounts” from its scope and ultimately granted the MTD Defendants’ motion to dismiss with prejudice, characterizing Ottah’s arguments as “legally implausible.” The court also granted the MSJ Defendants’ motion for summary judgment of non-infringement, based on the Federal Circuit’s prior ruling on the scope of the ’840 patent. In the previous case, the Federal Circuit held that the claim required that any infringing device must be capable of being removed without tools. Since the MSJ Defendants showed that their cameras were mounted in such a way that tools were necessary to remove them, the district court ruled in their favor.

With regard to the grant of summary judgment of non-infringement, the Federal Circuit found no error in the district court’s decision because no reasonable fact finder could find that the accused cameras met the “removably attached” limitation of claim 1. The Federal Circuit held that there was no error in the district court’s claim construction, and no reason for departing from the rules of collateral estoppel or *stare decisis* as to this claim term. Since it was shown that the MSJ Defendants’ accused cameras utilize fixed mounts that require tools for removal, the court found that they were outside the literal scope of claim 1. The court also upheld the dismissal with prejudice, stating that the district court correctly found that the “book holder” cannot plausibly be construed to include or be the equivalent of a camera holder, in view of the specification and the prosecution history. Although Ottah argued to the contrary, the Federal Circuit observed that his only support for this argument were the statements from the specification that the invention could hold items other than books while claim 1 itself was explicitly limited to books. Despite liberally construing the pleadings, the court concluded that the accusation of infringement lacked plausibility.

Owens Corning v. Fast Felt Corp.,
873 F.3d 896 (Fed. Cir. 2017)

This case concerned an appeal from a decision by the PTAB rejecting an obviousness claim to a patent on IPR. The patent at issue concerned methods for printing nail tabs or reinforcement strips on roofing or building cover material. The PTAB reviewed claims under Section 103. The PTAB held that, while a combination of prior art disclosed all elements of the patented claims, a skilled artisan would not have had a motivation to combine prior art references.

The Federal Circuit reversed the PTAB’s decision, holding the patent obvious as a matter of law. The court held that the PTAB’s finding that there would be no motivation to combine was predicated on an implicit construction of “roofing or building cover material”

that required that the materials eventually be coated with asphalt. Based on the plain language of the claim and the specification, and applying the “broadest reasonable construction” standard, the Federal Circuit held that the term “roofing or building cover material” also included materials that would never be coated in asphalt.

Under the proper claim construction, the court held that the evidence could only support one finding: that a skilled artisan would have been motivated to combine the prior art references. Accordingly, the Federal Circuit reversed and held the patented claims obvious as a matter of law.

Paice LLC v. Ford Motor Co.,
881 F.3d 894 (Fed. Cir. 2018)

In this appeal from final written decisions in six IPR proceedings in which the PTAB held certain challenged claims of U.S. Patent Nos. 7,237,634 and 8,214,097 unpatentable, the Federal Circuit vacated the PTAB’s obviousness determinations as they related to the ’634 patent’s electrical claims and affirmed the PTAB’s obviousness determinations as to all other claims.

Ford filed twenty-five IPR petitions against Paice’s ’634 and ’097 patents, which were directed to a torque-based algorithm for selecting between the engine and battery-powered motor in hybrid vehicles. The PTAB held most of the challenged claims unpatentable as obvious over various combinations of two prior art references: Severinsky and the ’455 PCT publication. Severinsky, which issued to a co-inventor of the ’634 and ’097 patents, described a control strategy for selecting operation modes in a hybrid vehicle. Severinsky also described circumstances in which it was efficient to use the engine, other circumstances in which it was more efficient to use an electric motor, and still other circumstances in which torque was supplied by both the electric motor and the engine. The ’455 PCT publication named the same inventors as the ’634 and ’097 patents and claimed priority to applications that appeared in both patents’ chain of priority. The publication was directed to similar hybrid vehicle technology and was published more than one year before the April 2001 CIP application in which the electrical claims first appeared, therefore nominally qualifying as prior art to those claims.

The PTAB determined that Severinsky disclosed a torque-based algorithm for determining which operating mode to select in a hybrid vehicle. The PTAB also interpreted the term “abnormal and transient conditions” recited in the claims of the ’634 and ’097 patents as including starting and stopping the engine. Finally, the PTAB determined that the ’455 PCT publication disclosed the torque-based control strategy recited in the electrical claims of the ’634 patent and that Severinsky disclosed the electrical limitations themselves.

Paice raised two arguments on appeal. First, Paice argued that the PTAB’s Severinsky-based findings were unsupported by substantial evidence. Specifically, Paice argued that Severinsky disclosed a speed-based algorithm and not a torque-based one and that the PTAB erred in its construction of “abnormal and transient conditions.” As for the PTAB’s finding that Severinsky disclosed a torque-based algorithm, the Federal Circuit disagreed

with Paice and held that the PTAB's determination was supported by reasonable and substantial evidence in the form of Severinsky itself, expert testimony, and the '634 patent's own description of Severinsky. As for the PTAB's interpretation of "abnormal and transient conditions," the court again disagreed with Paice and determined that, based on the prosecution history and the absence of language in the '634 patent specifying what "abnormal" and "transient" conditions were, the PTAB's construction was supported by substantial evidence.

Second, Paice argued that the PTAB erred in finding that the '455 PCT publication qualified as prior art to the '634 patent's electrical claims. Paice argued that the '455 PCT publication was not prior art because Paice claimed priority to an application (the '817 application) that predated the '455 PCT publication. Paice asserted that the '817 application incorporated by reference Severinsky, which itself provided the requisite written description support for the electrical claims, an argument that the PTAB had rejected. The Federal Circuit found that the '817 application expressly incorporated Severinsky in its first sentence. The Federal Circuit remanded for the PTAB to determine in the first instance whether the '817 application, with Severinsky incorporated therein, supplied the requisite written description support for the '634 patent's electrical claims.

Personal Audio LLC v. Elec. Frontier Found.,
867 F.3d 1246 (Fed. Cir. 2017)

In this appeal, the Federal Circuit affirmed a PTAB decision finding that a podcasting patent was invalid as both anticipated and obvious. Personal Audio, LLC owned a patent directed to a system and apparatus for storing and distributing episode media files, otherwise known as podcasting. The Electronic Frontier Foundation ("EFF"), described as a non-profit organization that advocates in the public interest of consumers of digital technology, petitioned for IPR. Agreeing with the EFF, the PTAB held that certain claims under the patent were invalid as anticipated and obvious. Personal Audio appealed.

Affirming the PTAB's findings of invalidity, the Federal Circuit addressed questions of constitutional standing, and fact-specific questions of claim construction and invalidity. With regard to standing, the court made two clarifications. First, because standing is only a requirement for invoking the judicial power under Article III, this requirement does not apply to proceedings before mere administrative agencies like the PTAB. Second, while the need for standing exists for a party seeking review before a federal court, this requirement does not apply to appellees merely seeking to defend the prior judgment in the face of an appeal. Taken together, the Court's position allows for non-profit organizations such as EFF to seek IPR, win, and then defend PTAB determinations on appeal.

As to the fact-specific questions of unpatentability, the court engaged in claim construction of three contested terms, and denied Personal Audio's attempt to avoid invalidity through a narrow construction of the terms. First, the court held that the term "episode" should be properly construed as a "program segment," and did not incorporate a "temporal limitation" as asserted by Personal Audio. Second, the court construed an "updated version of a compilation file" as merely a file that contained information about "currently available episodes," again rejecting Personal Audio's attempts at a narrower construction. Third, the

court rejected Personal Audio's arguments that its "back-end configuration" was not obvious nor anticipated by the prior art. Instead, the court held that the PTAB had sufficient evidence to find that the prior art had disclosed a similar two-processor configuration. Based on these interpretations of the claims and prior art, the court affirmed the PTAB's holding of various claims in Personal Audio's patent invalid.

PGS Geophysical AS v. Iancu,
891 F.3d 1354 (Fed. Cir. 2018)

This is an appeal of three IPRs finding certain claims of the reviewed patent (U.S. Patent No. 6,906,981) invalid as anticipated, and other claims invalid as obvious. The PTAB granted review of only some of the claims challenged, and only on some of the grounds raised by petitioner.

PGS owned the reviewed patent for particular methods and machinery for marine seismic surveying. A competitor (WesternGeco) filed several petitions for IPRs against PGS's patent and the PTAB partially instituted three IPRs. Following the PTAB's decision that certain claims were anticipated and other claims obvious, the parties settled; the PTO Director intervened to defend the PTAB's decisions. PGS appealed the obviousness determinations as to certain claims.

The Federal Circuit first considered whether it had jurisdiction to address the IPR appeals and, if so, whether it may and should decide those appeals and do so without *sua sponte* remanding for the PTAB to address the claims and grounds that WesternGeco included in its petitions but that the PTAB excluded from the IPRs. Both PGS and the Director agreed in the affirmative; the Federal Circuit held the same. Specifically, the Federal Circuit found that the standard for reviewability of final agency action under the APA was met. The PTAB issued institution decisions and final decisions in each IPR and, even if procedurally erroneous, the decisions ultimately terminated the IPR proceedings as to all claims and grounds. The court drew an analogy to circumstances in civil litigation in which a district court, upon receipt of a two-count complaint, incorrectly dismisses one count early in the case (without prejudice to refile in that forum or elsewhere) and proceeds to a merits judgment on the second count. Once the second count is finally resolved, there would be a final judgment in that situation, with both counts subject to appeal. The early dismissal would be final as to that claim, though not immediately reviewable. So too, here.

On the substantive merits of the PTAB's IPR decisions, the Federal Circuit affirmed the PTAB's decision as to obviousness of the appealed claims. The issue presented was whether the PTAB erred in its finding of a motivation to combine two prior art references. Whether there would have been such a motivation on the relevant priority date is an issue of fact, which the Federal Circuit reviews the issue for substantial evidence support. The Federal Circuit reviewed the record and determined that the PTAB found WesternGeco's motivation to combine argument persuasive, and concluded that substantial evidence supported the PTAB's finding of a motivation to combine.

Polara Eng'g Inc. v. Campbell Co.,
894 F.3d 1339 (Fed. Cir. 2018)

Polara Engineering owns a patent that relates to a two-wire control system for push-button crosswalk stations for a traffic-light-controlled intersection (the '476 patent). Prior to the critical date when Polara filed the application that led to the '476 patent, Polara tested prototypes that satisfied the limitations of the asserted claims. Polara tested its prototypes in a laboratory and then at various intersections in California and Canada. For certain locations, Polara did not enter into confidentiality agreements, but witnesses later testified that they did not tell anyone how the prototype worked.

Years after Polara received the '476 patent, Campbell Co. collaborated with another inventor, Dr. Richard Wall, to develop a similar two-wire control system. Dr. Wall and Campbell discussed the '476 patent, and Dr. Wall pointed out the “significant differences” and “similarities” between Campbell’s proposed invention and the '476 patent. Campbell received only one written communication from a law firm regarding the validity of the '476 patent, which discussed only one claim not relevant at the subsequent trial and appeal. Later, Polara sued Campbell for infringement of its '476 patent. A jury found that (1) Campbell willfully infringed the '476 patent; (2) that Polara’s invention was not in public use for more than a year before the filing of the application that led to the '476 patent; and (3) Campbell failed to prove that the '476 patent was invalid under 35 U.S.C. §§ 102 or 103. The district court subsequently enhanced damages.

On appeal, the Federal Circuit affirmed all of the jury’s and district court’s findings except for enhanced damages. First, the Federal Circuit “agree[d] with Polara that substantial evidence supports the jury’s finding of experimental use that negates application of the public use bar.” Because “the invention relates to public safety,” the court wrote, “the inventors could reasonably believe that they needed to ensure the invention’s durability and safety before being certain that it would work for its intended purpose.” The court also noted that “Polara introduced evidence that it maintained the secrecy of the invention” despite not always having confidentiality agreements in place.

Second, the Federal Circuit affirmed the jury’s finding that the '476 patent was not invalid as anticipated or obvious over the prior art because the jury’s findings were supported by substantial evidence.

Third, the Federal Circuit upheld the jury’s finding of willful infringement as supported by substantial evidence. It noted that Campbell failed to produce evidence that it received an opinion of counsel that the asserted claims of the '476 patent are invalid and/or would not be infringed by Campbell’s two-wire control system.

Finally, the Federal Circuit vacated and remanded the district court’s decision to enhance damages because the district court failed to sufficiently explain its reasoning regarding why certain relevant factors were “neutral” in the decision to enhance damages. The Federal Circuit “instruct[ed] the district court to provide a more complete explanation, including a discussion of the public use defense, in exercising its discretion.”

Polaris Indus., Inc. v. Arctic Cat, Inc.,
882 F.3d 1056 (Fed. Cir. 2018)

In this appeal from an IPR, the Federal Circuit affirmed some of the PTAB's obviousness findings, vacated others and remanded for further proceedings, and affirmed the PTAB's determination that a party failed to meet its burden of demonstrating that the challenged claims are unpatentable.

Polaris Industries, Inc. owns U.S. Patent No. 8,596,405, which is directed to "all-terrain vehicles having at least two seats arranged side-by-side." Polaris' competitor, Arctic Cat, Inc. filed two petitions for IPR, challenging the patentability of all thirty-eight claims of the '405 patent as obvious based on different combinations of prior art references, U.S. Patent Nos. 7,658,258 ("Denney"), 5,327,989 ("Furuhashi"), and 3,709,314 ("Hickey"). Denney is a two-wheel drive system, Furuhashi is a four-wheeled buggy for a single rider, and Hickey is a "wheeled high speed, cross-country, rough terrain vehicle suitable for use as a reconnaissance vehicle or for use with highly mobile armored forces or for use as a family recreational vehicle." In one petition, Arctic Cat argued that the patentability of the claims as obvious in view of the combination of Denney and Furuhashi. In the second petition, Arctic cat argued that the thirty-eight claims were obvious in view of Hickey and "at least one other reference." The PTAB reviewed the first petition in the first IPR and decided that all thirty-eight claims had been proven unpatentable as obvious in light of Denney and Furuhashi. In the second IPR, the PTAB reviewed the second petition and determined that Arctic Cat had not met the preponderance of the evidence standard in showing that the claims were obvious over combinations including Hickey.

With respect to the first IPR, the Federal Circuit affirmed the finding that claims 1–16, 20–33 and 35 are unpatentable as obvious, while vacating the PTAB's obviousness determination as to claims 17–19, 34 and 36–38 and remanding for further proceedings. The Federal Circuit held that the PTAB erred by failing to "analyze whether Denney 'teaches away' from claims 17–19 by determining whether a person of ordinary skill, upon reading Denney, would be discouraged from following the path set out in Denney."

With respect to the second IPR, the Federal Circuit agreed with the PTAB's construction of the phrase "extending between" when discussing "a front drive shaft extending between the transmission and the front axle assembly." The Federal Circuit, after reviewing the claims, specification and extrinsic evidence of record, found that the phrase "extending between" requires that the front driveshaft account for the entire distance between the transmission and the front axle assembly, rather than some fraction of that total distance. Thus, the Federal Circuit affirmed the PTAB's determination that Arctic Cat had not shown with a preponderance of the evidence that the claims were obvious.

Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc.,
894 F.3d 1258 (Fed. Cir. 2018))

Power Integrations sued Fairchild Semiconductor for infringement of two patents relating to power supply controller chips. After a first trial, the jury determined that Fairchild infringed claims of both asserted patents. After a second trial, the jury awarded damages

of roughly \$140 million. Fairchild moved for JMOL, which was denied by the district court. Fairchild appealed.

On appeal, Fairchild challenged infringement and the damages award. The Federal Circuit affirmed the infringement decision, determining that substantial evidence supported the jury's conclusion. On the issue of damages, the Federal Circuit vacated the district court's decision and remanded the issue back to the district court. As the Federal Circuit explained, the jury's decision was based on the entire market value rule, and reliance on that rule was inappropriate under the facts of the case. The entire market value rule applies when the patented feature forms the "sole" driver for consumer demand. If there are any other valuable features that drive demand in part, then damages "must be apportioned." This rule requiring apportionment applies "whenever the claimed feature does not define the entirety of the commercial product." Because the accused products included at least some other valuable features, the entire market value rule was inapplicable, and the district court erred in denying JMOL.

Praxair Distrib., Inc. v. Mallinckrodt Hospital Prods. IP Ltd.,
890 F.3d 1024 (Fed. Cir. 2018))

Mallinckrodt Hospital Products IP Ltd. owned a patent directed to methods of distributing nitric oxide gas cylinders for pharmaceutical use. Praxair Distribution, Inc. sought IPR of the patent. Nitric oxide gas can cause adverse side effects in patients with left ventricular dysfunction ("LVD"). Thus, the claims required supplying medical providers with information related to the harmful side effects and asked providers to consider the information. Some dependent claims directed the provider to take actions based on the information. During claim construction, the PTAB interpreted the limitations related to providing information to be either printed matter or purely mental steps without patentable weight. The printed matter doctrine provides that the content of information recorded in a substrate, such as printed matter on a sheet of paper, is not entitled to patentable weight. The PTAB then determined that the remaining limitations were obvious. However, the PTAB upheld the patentability of claim 9, a dependent claim requiring the medical provider to consider the information provided and discontinue treatment if a newborn with LVD experiences a pulmonary edema, because the information in claim 9 had a functional relationship to the rest of the claim and was not obvious.

Praxair appealed the PTAB's decision as to claim 9, and Mallinckrodt cross-appealed the decision as to the rest of the claims. The Federal Circuit reversed the PTAB's decision regarding claim 9 and affirmed the PTAB's decision regarding the rest of the claims.

First, the Federal Circuit held that the PTAB properly applied the printed matter doctrine to the limitations related to providing and evaluating information. The panel held that limitations directed to mental steps may be considered printed matter because they may attempt to capture unpatentable informational content. Further, the PTAB properly construed the terms without reference to the printed matter, depriving the printed matter of a functional relationship to the rest of the limitations. Thus, the printed matter lacked patentable weight. Finally, the panel agreed that the remaining limitations were obvious.

Turning to claim 9, the Federal Circuit agreed with the PTAB's determination that the printed matter in claim 9 had a functional relationship to the rest of the claim because it directed the medical provider to take specific action as a result of the information. However, even though the printed matter had patentable weight, the panel disagreed with the PTAB's conclusion that claim 9 was not obvious, citing prior art that recommended carefully monitoring the treatment of newborns with LVD.

Judge Newman concurred in the judgment. She disagreed with the majority's application of the printed matter doctrine to mental steps and piecemeal analysis of the claims after bracketing the supposed printed matter.

Presidio Components, Inc. v. Am. Tech. Ceramics Corp.,
875 F.3d 1369 (Fed. Cir. 2017)

The Federal Circuit reviewed five questions on appeal: (1) whether the patent at issue (the '356 patent) was invalid for indefiniteness, (2) whether the defendant, American Technical Ceramics ("ATC"), was entitled to absolute intervening rights, (3) whether an award of lost profits was supported by the evidence, (4) whether the district court abused its discretion in declining to award enhanced damages, and (5) whether the district court abused its discretion in granting a permanent injunction. The Court held (1) that the patent was not indefinite, (2) ATC was entitled to absolute intervening rights, (3) the evidence did not support an award of lost profits, (4) the district court did not abuse its discretion in declining to award enhanced damages, and (5) vacated the permanent injunction.

The '356 patent is directed to a multilayer capacitor with a fringe-effect capacitance that was "capable of being determined by measurement in terms of a standard unit." The patent references "insertion loss testing" as a method that may be used to measure capacitance. ATC argued that while insertion loss testing was well known in the art for the purpose of measuring overall performance of capacitors, it was not well known for measuring fringe-effect capacitance in a multilayer capacitor. Presidio's expert disagreed and argued that a person skilled in the art would know how to use this well-known form of testing to measure fringe-effect capacitance. The Federal Circuit affirmed the district court's finding that the patent was not invalid for indefiniteness, explaining that a patent does not need to explicitly include information already well known in the art.

The court next addressed whether the district court correctly granted ATC absolute intervening rights. Presidio had amended claims of the '356 patent during an *ex parte* reexamination and the district court found that these amendments "substantially changed" the scope of the claim. Presidio challenged this conclusion by arguing that its stated goal was to adopt the district court's construction of the claim. The Federal Circuit dismissed these arguments as irrelevant, noting that it does not matter what the party's intent was or even whether the party intended to alter its claim; on the contrary, the only question is "whether the scope of the amended claims is actually identical to the scope of the original claims." The Federal Circuit concluded that the amended claim constituted a substantive change and therefore affirmed the district court's grant of absolute intervening rights to ATC.

The Federal Circuit reversed the district court's decision to award lost profits. In conducting its analysis, the district court considered whether ATC's 560L capacitors were an "acceptable substitute" for its 550 capacitors, the product being accused of infringing the '356 patent. However, the appropriate question under *Panduit*, is not whether another product of ATC's is an acceptable substitute to ATC's infringing product, but whether that alternative product is an acceptable substitute for the patent owner's product. That is to say, instead of comparing ATC's 560L capacitor to its 550 capacitor, the district court should have compared ATC's 560L capacitor with Presidio's product protected by the patent and determined whether the 560L capacitor was an acceptable substitute. Since the district court failed to consider whether the 560L capacitor was an acceptable substitute, there was nothing in the record to support awarding lost profits. The Federal Circuit set aside the award and concluded that a new trial was needed to determine a reasonable royalty award.

With respect to enhanced damages, the Federal Circuit held that the district court was well within its discretion to decline to award enhanced damages. The Court noted that enhanced damages are only appropriate for "egregious cases of misconduct," and that ATC's case was "not meritless" in what was a fair, legitimate, "hard-fought patent case."

Finally, the Federal Circuit vacated the lower court's permanent injunction. Since the conclusion of irreparable harm necessary to grant a permanent injunction was based on the award of lost profits, and the Federal Circuit set aside that award, there no longer was any basis for the injunction. The Court vacated the injunction but remanded the case so that the lower court could consider other evidence of irreparable harm.

Promega Corp. v. Life Techs. Corp.,
875 F.3d 651 (Fed. Cir. 2017)

In a case the Federal Circuit acknowledged as "unusual," the patent owner, Promega, received no damages despite proving infringement. This case returned to the Federal Circuit on remand after the Supreme Court concluded 35 U.S.C. § 271(f)(1) "does not cover the supply of a single component of a multicomponent invention." Promega was the exclusive licensee of a U.S. patent for methods and kits analyzing DNA ("Tautz patent"). The accused infringer, Life Technologies, assembled and sold its own DNA testing kits, which were comprised of five components, at least one of which came from the United States. Promega sued Life for infringing its Tautz patent and Life did not challenge the motion that Life's products met all of the elements of the asserted claims of the Tautz patent. However, Promega pursued an invalid damages theory, which led the Federal Circuit to conclude it waived its right to a damages award, despite having proven infringement.

At the trial level, there was initially some confusion about whether Life conceded liability in addition to conceding that its products met all of the elements of the asserted claims of the Tautz patent. The district court clarified that Life did not concede liability and gave Promega a "second chance" to prove how much Life was liable for. Promega declined to argue more than one number, and continued to assert that all of Life's global sales constituted U.S. sales. The district court initially held that Promega failed to prove its

infringement case and denied Promega's motion for a new trial. On appeal, the Federal Circuit reversed the district court, finding that one component of five did constitute a substantial portion and that consequently Promega's claim that all global sales were U.S. sales was correct. This decision was appealed again to the Supreme Court, which reversed the Federal Circuit, holding that one component of five did not constitute a substantial portion and remanded the case consistent with this holding. On remand, the Federal Circuit now affirmed the original trial court's decision to grant Life's motion for judgment as a matter of law that Promega failed to prove its infringement case and denied Promega's motion for a new trial.

The Federal Circuit in its second opinion explained that the patentee has the burden of proving damages. This burden includes showing the damages by evidence and proving a specific amount. The question was whether Promega waived its right to a damages award if the only figure provided (and supported by evidence) was based on an invalid damages theory (*i.e.*, that all global sales constituted U.S. sales). The court affirmed the trial court's conclusions. Even after the initial second chance offered by the trial judge, Promega focused on proving that damages occurred rather than specifying the amount of damages owed. The only figure Promega presented to the jury was Life's global sales, arguing that all global sales constituted U.S. sales since all of Life's kits contained at least one component from the United States. After the Supreme Court ruled that one component did not constitute a substantial portion, it became clear that not all of Life's global sales constituted U.S. sales, but rather only some unknown, unproven percentage. Since Promega never offered an alternative figure or attempted to prove this alternative amount of U.S. sales, Promega was now unable to prove all of the elements of infringement under 35 U.S.C. § 271(a). The Federal Circuit concluded that Promega waived its right to a damages award and necessarily had to affirm the lower court's granting of Life's motion for judgment as a matter of law. The Federal Circuit then reviewed whether the lower court abused its discretion in denying Promega's motion for a new trial and found that the court was well within its discretion.

Raniere v. Microsoft Corp.,
887 F.3d 1298 (Fed. Cir. 2018)

In this appeal, the Federal Circuit affirmed a finding that the dismissal of Raniere's patent infringement suit with prejudice for lack of standing was tantamount to a judgment on the merits. The court also held that the district court did not abuse its discretion in finding the case exceptional under Section 285's fee-shifting provision and that the district court's discretionary determination of fees and costs to Microsoft and AT&T was well supported and carefully considered. Though the case had been dismissed, the court found Microsoft and AT&T to be the prevailing parties and affirmed the parties' award of \$143,719.26 and \$300,295.71 in costs and fees, respectively.

In 1995, Mr. Raniere, along with the other named inventors of the five patents at issue, assigned all rights in the patents to Global Technologies, Inc. ("GTI"). While GTI was administratively dissolved in 1996, Raniere executed a document on behalf of GTI in December 2014, in which he claimed to be GTI's sole owner and that he had purportedly transferred the asserted patents from GTI to himself. In 2015, Microsoft moved to dismiss

Mr. Raniere's suit for lack of standing, noting that there was no documentation to support Mr. Raniere's claims that he had transferred ownership of the patents to himself. Though the district court ordered that Mr. Raniere produce such documentation to support his claims, nothing he produced established that he owned the patents at issue. The district court found that Mr. Raniere had received "more than a fair opportunity to adduce evidence to establish his standing," and not only had he not done so, he had demonstrated "a clear history of delay and contumacious conduct." The district court concluded that Mr. Raniere was unlikely to be able to cure the standing defect and dismissed the case with prejudice. The Federal Circuit summarily affirmed the district court's dismissal.

While the merits appeal was pending, Microsoft and AT&T filed a motion seeking attorney fees and costs pursuant to 35 U.S.C. § 285. The district court concluded that, for the purposes of Section 285, Microsoft and AT&T were the prevailing parties. It further held that the case was exceptional given Mr. Raniere's untruthful testimony and bad faith conduct, which imposed significant delays and expenditures for the court and Appellees. In the alternative to costs and fees, the district court sanctioned Mr. Raniere's conduct. The district court did not accept the Appellees' fee request in its entirety and reduced the lodestar by twenty percent due to duplication of efforts between the Appellees' attorneys. On appeal, Mr. Raniere raised the issues of: (1) whether the appellees were the prevailing party; and (2) whether the district court abused its discretion in finding the case "exceptional."

For the first issue, the court affirmed the district court's conclusion under two distinct rationales. First, under the Supreme Court's holding in *CRST*, a defendant that succeeds on a jurisdictional issue, such as standing, can be a prevailing party, even where the defendant did not win on the merits. In cases in which the defendant spent significant time and resources fighting the lawsuit or has won a significant victory and permanently changed the legal relationship of the parties, then the defendant may be the prevailing party. Second, the court found that, even without the *CRST* holding, the Appellees were still the prevailing party because the district court dismissed the case *with prejudice*, which was tantamount to a decision on the merits. The district court explicitly found that the standing defect was unlikely to be curable, based on Mr. Raniere's repeated failures to correct the defect and gave Appellees the full relief to which they were entitled.

For the second issue, the Federal Circuit similarly affirmed the district court's conclusion that the case was exceptional. The district court properly examined the totality of the circumstances, including Mr. Raniere's pattern of obfuscation and bad faith, which caused the Appellees to incur substantial costs and fees and delayed an earlier dismissal. The court concluded that the district court was in a better position to determine whether a case is exceptional and did not abuse its discretion in doing so.

Return Mail, Inc. v. U.S. Postal Serv.,
868 F.3d 1350 (Fed. Cir. 2017)

This case arises from a covered business method ("CBM") patent directed to the processing of mail items that are undeliverable due to inaccurate addresses. Return Mail owns U.S. Patent No. 6,826,548. The claimed invention overcomes the problem of handling

undeliverable mail by encoding the address data into a barcode and later sending that data to the sender when mail is undeliverable in order to provide a new address for the addressee. Return Mail sued the United States Postal Service under 28 U.S.C. § 1948(a) for engaging in the unlicensed use and infringement of the '548 patent. The Postal Service later filed a petition for CBM review. The PTAB held that the Postal Service had standing to petition for CBM review and that the '548 patent was invalid due to ineligible subject matter under 35 U.S.C. § 101.

On appeal, the Postal Service first argued that the Federal Circuit does not have the authority to review the PTAB's determination that the Postal Service had standing to petition for CBM review because of the 35 U.S.C. § 324(e) no appeal provision. Citing *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016), for the proposition that there is a "strong presumption in favor of judicial review when interpreting statutes that may limit or preclude review," the Federal Circuit explained that unlike the bar in *Cuozzo*, which was for an "ordinary dispute" about the PTO's decision to institute an IPR, here, whether a party is statutorily allowed to petition for CBM review "is a condition precedent" to a party's right to seek CBM review in the first instance. Therefore, the court held that Section 324(e) does not bar judicial review of the PTAB's decision that a party satisfies the requirements to petition for CBM review.

Return Mail next argued that because Section 1498 is grounded in eminent domain, the suit in question cannot be a suit for "infringement" under Section 18(a)(1), and thus the Postal Service did not have standing to petition for CBM review. The court found, however, that although Section 1498(a) does not explicitly refer to "infringement," legislative history does explicitly show that Section 1498(a) was intended to cover "infringement or unauthorized use of a patented invention." Therefore, the Postal Service had standing to petition for CBM review.

The Federal Circuit affirmed the PTAB's finding of patent ineligibility under Section 101. The court applied *Alice*'s two-step framework for determining whether claims are directed to a patent-ineligible concept. Under the first step, the court found that the patent is directed to the abstract idea of "relaying mailing address data." The court also rejected Return Mail's argument under step 2 of *Alice*. The claims recite only "routine" and "conventional activities." Encoding and decoding data and sending that data to the mail sender does not transform the abstract idea into "something more" that is patent-eligible. Therefore, the court affirmed that the '548 patent is directed to patent-ineligible subject matter.

Judge Newman, dissenting, would have held that the term "person," under Section 18(a)(1)(B) does not include the United States and its agencies, and therefore the Postal Service would not have standing to petition for a CBM review.

Romag Fasteners, Inc. v. Fossil, Inc.,
866 F.3d 1330 (Fed. Cir. 2017)

Romag is the owner of a patent on magnetic snap fasteners which it sells under its registered trademark. Romag successfully sued Fossil, Inc. and various retailers ("Fossil") for, *inter alia*, patent infringement and trademark infringement. Romag then sought attorney's fees

under both the Patent Act, 35 U.S.C. § 285, the Lanham Act, 15 U.S.C. § 1117(a), and a Connecticut unfair trade practices statute. The district court granted attorney’s fees under the Patent Act and Connecticut statute, but not the Lanham Act. Fossil appealed and Romag cross-appealed.

On appeal, the Federal Circuit first addressed the proper standards for attorney fee recovery. In particular, the court held that *Octane Fitness* applied equally to identical language in the Lanham Act. As such, the district court’s insistence on applying a pre-*Octane* standard of bad faith and willful infringement under the Lanham Act was wrong as a matter of law. Instead, attorney’s fees could be recovered under both Acts so long as, under the totality of the circumstances, a party stood out with respect to the substantive strength of its litigating position, or the unreasonable manner in which the case was litigated.

On the merits of the attorney’s fee award, the majority held that the district court’s award of attorney’s fees was an abuse of discretion in three ways: the district court incorrectly determined that Fossil failed to withdraw certain defenses, thus leading to unduly extensive litigation by parties; the district court incorrectly found that Fossil’s defense of indefiniteness was frivolous; and the district court did not take into account Romag’s own attempts to delay litigation.

Judge Newman dissented, arguing that giving the district court the deference it is due under *Octane Fitness*, there was enough evidence for the lower court to decide that Fossil’s conduct stood out as “exceptional.”

Saint Regis Mohawk Tribe v. Mylan Pharm. Inc.,
896 F.3d 1322 (Fed. Cir. 2018)

This case arose when Allergan brought claims against Mylan and others alleging infringement of its patents relating to its drug Restasis. Mylan petitioned for IPR and the PTAB instituted review. Allergan then entered into an agreement with the Saint Regis Mohawk Tribe, transferring to the tribe title of the patents. The PTAB denied the Tribe’s motion to terminate the proceedings based on sovereign immunity.

The Federal Circuit affirmed and held that tribal sovereign immunity does not apply to IPRs. The court observed that “the IPR is more like an agency enforcement action than a civil suit brought by a private party” so tribal immunity was not implicated. The court focused in several factors that distinguish IPRs from civil litigation, including the Directors broad discretion in deciding whether to institute review, the optional participation of the petitioner, and the unique procedural rules of IPR.

Judge Dyk concurred, and wrote separately to discuss the history of the IPR proceedings in greater detail, and their development from the earlier reexamination proceedings, which all parties agreed do not implicate sovereign immunity.

Sanofi v. Watson Labs., Inc.,
875 F.3d 636 (Fed. Cir. 2017)

Sanofi owned U.S. Patent No. 8,318,800 for the antiarrhythmic drug dronedarone (sold as Multaq[®]), and U.S. Patent No. 8,410,167 for methods of administering this drug to patients with particular characteristics. Watson Laboratories Inc. and Sandoz Inc. sought to market generic versions of Multaq[®], arguing that both patents were invalid and that the sale of their proposed generic drugs did not infringe either patent. Sanofi sued Watson and Sandoz for infringement. The district court found in favor of Sanofi on nearly every claim. The issues appealed to the Federal Circuit were (1) whether the proposed labels of Watson and Sandoz infringed the '167 patent, (2) whether the '167 patent was invalid for obviousness, and (3) whether the '800 patent excluded compositions containing polysorbate surfactants, which would determine whether Watson and Sandoz infringed the '800 patent. The court affirmed that Watson and Sandoz infringed the '167 patent, that the '167 patent was not invalid for obviousness, and that Watson and Sandoz infringed the '800 patent.

The first issue regarding infringement of the '167 patent depended on a question of inducement, which the appellate court reviewed for clear error. The Federal Circuit upheld the district court's holding that Watson's and Sandoz's proposed labeling intentionally encouraged infringement of the '167 patent. The court reviewed the record and found there was sufficient evidence that the lower court could reasonably conclude Sanofi had proven its infringement claim. Watson and Sandoz argued that since Multaq[®] has substantial non-infringing uses, it was not possible for them to intend to encourage an infringing use. The Court rejected this substantial non-infringement exception argument as irrelevant since 35 U.S.C. § 271(b), which governs inducement, does not contain such an exception.

The court next addressed whether the '167 patent was invalid for obviousness. Watson and Sandoz's only argument was that a person of ordinary skill in the art would have had a "reasonable expectation" that the methods protected by the '167 patent would succeed. The Federal Circuit held that the district judge applied the correct standard and affirmed the lower court's finding that the patent was not invalid for obviousness. The court rejected Watson and Sandoz's claim that the district court was applying a higher standard than was required. The only remaining question, under the clear error standard, was whether the district court's conclusion that the patent was not invalid for obviousness was reasonable based on the record; the court concluded that given the expert dispute, it was not clearly erroneous.

For the third and final issue, Watson and Sandoz raised one argument to dispute the claim that they infringed the '800 patent. They argued that since Sanofi excluded polysorbate surfactant from a related patent, the '493 patent, Sanofi therefore made a "prosecution disclaimer" that also limited the scope of the claims of the '800 patent. The court, reviewing the argument de novo, rejected the argument, clarifying that when prosecution disclaimers are directed toward specific claims, those disclaimers do not apply to subsequent applications unless the subsequent patents contain the same language. In this case, the '800 patent did not contain the same prosecution disclaimer language present in the '493 patent, so the court affirmed the district court's ruling that Watson and Sandoz infringed the '800 patent.

SAP Am., Inc. v. Investpic, LLC,
890 F.3d 1016 (Fed. Cir. 2018)

In an appeal from the Northern District of Texas, the Federal Circuit held that a system and method of statistical analysis was not patent-eligible.

InvestPic, LLC owned a patent describing and claiming systems and methods for performing statistical analyses of investment information and displaying the results. In particular, the patent stated that current practices relied on faulty assumptions about underlying probability distributions and that the claimed techniques remedied those deficiencies by analyzing financial data without assuming the data followed a normal or Gaussian distribution. SAP America, Inc. sought a declaratory judgment that InvestPic's patent claims were invalid because their subject matter was ineligible under 35 U.S.C. § 101. The District Court for the Northern District of Texas agreed with SAP and granted SAP's motion for judgment on the pleadings.

Applying the two-step framework of *Alice*, the Federal Circuit affirmed. The panel held that, under the first step of the *Alice* framework, the patent claims were directed to abstract ideas that were patent-ineligible. The panel distinguished prior cases by noting that the claims here lacked the specificity required to transform the claims from claiming only a result to claiming a way of achieving the result. Crucially, the focus of the claims was not a physical-realm improvement, but an improvement in “wholly abstract ideas”—the selection, mathematical analysis, and display of information. That the claims were limited to information of real investments did not make the collection and analysis of that information any less abstract.

The panel held that, under the second step of the *Alice* framework, the claim elements did not add an “inventive concept” in the application of the abstract ideas. Even though some claims required various databases and processes, the limitations did not require improved computer resources; the specifications noted that off-the-shelf computers would suffice. InvestPic's invocations of computers and networks thus did not qualify as an inventive concept in the application of the abstract ideas.

Secured Mail Sols. LLC v. Universal Wilde,
873 F.3d 905 (Fed. Cir. 2017)

In this proceeding, the Federal Circuit affirmed the district court's grant of a motion to dismiss under Rule 12(b)(6) on the grounds that the patents were directed to ineligible subject matter under 35 U.S.C. § 101.

Secured Mail Solutions brought a civil suit against Universal Wilde for infringement of seven patents for methods of using a unique identifier on the outside of mail items (*e.g.*, envelopes or packages). The seven patents at issue were grouped into Intelligent Mail Barcode patents, QR Code patents, and Personalized URL patents. The Central District of California dismissed the claims on the grounds that the asserted patents were directed at subject matter ineligible for patenting under 35 U.S.C. § 101.

The Federal Circuit affirmed the district court's decision to dismiss. The Federal Circuit applied the two-step test from *Alice*. The court first held that all seven patents were directed to the abstract idea of communicating information about a mail object by use of a marking. Specifically, the claims were not directed to a new format, improved method, or improved functionality. Secured Mail Solutions did not describe how the claimed "unique identifier" was generated other than to say the sender generated a barcode.

The court then analyzed the claims under the second step of *Alice* to determine whether the claims were transformed into a patent-eligible application of the abstract idea. The Federal Circuit rejected Secured Mail Solution's argument that the district court misconstrued the second step by asking whether the underlying technology was conventional. In affirming the decision to dismiss the case, the Federal Circuit noted that the district court decision had multiple pages analyzing the individual claim elements in response to Secured Mail Solution's argument that the sender-generated identifier was the critical invention. Specifically, there was no showing that the sender-generated identifier, which was not described or limited in the claims, was inventive.

Finally, the Federal Circuit found it was proper for the district court to consider the intrinsic evidence from the specification when evaluating a motion to dismiss. The district court did not need to resolve any questions of fact because it was clear from the claims and the specification that the claims were directed to an abstract idea and contained no inventive steps, using only conventional hardware.

SimpleAir, Inc. v. Google LLC,
884 F.3d 1350 (Fed. Cir. 2018)

The Federal Circuit vacated and remanded the judgment of the Eastern District of Texas, which granted a motion to dismiss in favor of the alleged infringer. The court found that the district court erred by presuming that terminally disclaimed continuation patents are patentably indistinct variations of their parent patents without analyzing the scope of the patent claims.

The parent patent of this family is U.S. Patent 6,021,433 while the rest of SimpleAir's patents asserted against Google's Cloud Messaging and Cloud to Device Messaging Services ("GCM") are children of the '433 patent linked by continuation applications. The child patents share a common specification with the '433 patent. During prosecution, SimpleAir filed terminal disclaimers for each child patent to overcome obviousness-type double patenting rejections at the PTO. This case represents SimpleAir's fourth complaint asserting infringement by GCM, this time of U.S. Patent Nos. 8,639,838 and 8,656,048, which are linked with the '433 patent by continuation applications and are terminally disclaimed to it. The district court dismissed the complaints under Rule 12(b)(6) as barred by claim preclusion and the *Kessler* doctrine.

The district court held that the present case and previous cases involved the same claim or cause of action because the '838 patent and '048 patent shared the same title and specification with the previously adjudicated continuation patents, and the filing of a terminal disclaimer to overcome the PTO's obviousness-type double patenting rejections

indicated that the PTO believed the content of the patents in suit to be patentably indistinct from the earlier patents. That led the district court to conclude that the underlying invention claimed by the various child patents was the same without comparing the claims of the '838 patent and '048 patent to those of the previously adjudicated patents.

The Federal Circuit held that despite the fact that the asserted patents all share a common specification and terminal disclaimer to a common parent, that alone is not sufficient to sustain the district court's holding of claim preclusion. The court observed that the district court did not make any determination of the scope of the '838 and '048 claims in comparison with the patents litigated in the first three actions, and concluded that the district court erred in holding SimpleAir's suit to be claim-precluded. The court left it to the district court's discretion on remand to resolve whether the '838 and '048 claims are essentially the same as those in the previously adjudicated parent patents.

Sirona Dental Sys. GmbH v. Institut Straumann AG,
892 F.3d 1349 (Fed. Cir. 2018)

In a cross-appeal from an IPR decision finding certain claims of U.S. Patent No. 6,319,006 obvious and other claims patentable, the Federal Circuit affirmed the PTAB's decision regarding invalidity/patentability of the claims, but vacated the PTAB's denial of Sirona's (the patent owner's) contingent motion to amend the claims. The PTAB, prior to the Federal Circuit's en banc decision in *Aqua Products*, denied the motion to amend because it determined that Sirona failed to meet its burden of demonstrating that proposed substitute claims would not have been obvious over a combination of prior art.

The patent claims under review relate to a method for producing a drill assistance device for use in tooth implant surgery. The PTAB held that claims 1–8 were obvious and that petitioners had not met their burden of demonstrating claims 9–10 were anticipated or obvious. The PTAB also denied Sirona's contingent motion to amend the claims. The parties cross-appealed the PTAB's determinations.

Regarding the PTAB's obviousness determinations of claims 1–8, the questions on appeal were whether substantial evidence supported the PTAB's findings that the combination of prior art discloses a limitation in the claims, and whether a person of ordinary skill in the art would have been motivated to combine the references. The Federal Circuit held that substantial evidence supported the PTAB's affirmative findings of both issues. The Federal Circuit also affirmed the PTAB's factual findings predicated its affirmance of claims 9 and 10, and held that petitioner's further obviousness arguments as to these claims raised on appeal were not argued at the IPR, and thus, there was no error in the PTAB's decision not to decide grounds of unpatentability not raised in the petition.

The Federal Circuit, however, vacated and remanded the PTAB's denial of Sirona's motion to amend the claims during IPR. The Federal Circuit noted that the PTAB's final written decision issued prior its en banc decision in *Aqua Products*. Thus, the PTAB erred when it placed the burden on Sirona to demonstrate that the proposed substitute claims were patentable. Accordingly, the Federal Circuit remanded the case for reconsideration in view of its decision in *Aqua Products*.

Smart Sys. Innovations, LLC v. Chicago Transit Auth.,
873 F.3d 1364 (Fed. Cir. 2017)

In this litigation about bank cards used in mass-transit systems, the Federal Circuit affirmed the district court decision that the subject matter was patent-ineligible material. The patents related to a system and method for regulating entry to a transit system. The Federal Circuit found that, when stripped of the technical jargon, the patents covered an abstract concept of paying for a public transit ride using a credit card. Even though the inventions would allow riders to access mass transit more quickly and more efficiently, the core claim was directed at a financial transaction and collecting data. Though a financial transaction occurred in a new context, it remained an abstract concept. The claims were not directed at a new type of equipment, such as a new bank card, turnstile, or database. Instead, the claims recited general computer components that collected financial data. Though SSI asserted the district court made the claims too abstract based on the language of the claims, the Federal Circuit found the district court had properly looked at the language of the claim and the legal conclusion was correct. The Federal Circuit found that *Enfish* and *DDR Holdings* were not applicable because SSI had not argued its claims improved computer technology. Additionally, the Federal Circuit restated that preemption concerns were mooted when a claim disclosed patent-ineligible subject matter.

Judge Linn dissented-in-part and concurred-in-part, writing that the abstract idea exception must be applied narrowly, lest the exception swallow the rule. Judge Linn dissented from the majority because the majority overstated the abstractness of some of the claims.

Southwire Co. v. Cerro Wire LLC,
870 F.3d 1306 (Fed. Cir. 2017)

The Federal Circuit upheld the PTO's *inter partes* reexamination determination that Southwire's patent is unpatentable as obvious. Although the Federal Circuit found that the PTAB erred in relying on the doctrine of inherency, it concluded that the error was harmless because the PTAB's factual findings adequately supported its obviousness determination.

Southwire's U.S. Patent No. 7,557,301 was directed to a method of making an electric cable involving incorporating "a lubricant . . . into the outer sheath such that the lubricant migrates to the surface of the sheath and results in a reduction in pulling force required to install the cable." The Examiner conducting the reexamination determined that the claimed method was obvious in view of a prior art patent, Summers, and two secondary references.

Although the examiner found that Summers "does not expressly teach that the friction reducing additive can reduce the pulling force by 'at least about . . . 30%,'" the Examiner agreed with Cerro that that property would be "an inherent result of the cable being made in accordance with the claimed method steps." Southwire appealed to the PTAB which upheld the rejection, agreeing with the examiner that Summers inherently teaches the 30% reduction limitation.

In its decision on appeal, the Federal Circuit reiterated its holding in *Honeywell v. Mexichem* that "the use of inherency in the context of obviousness must be carefully

circumscribed because that which may be inherent is not necessarily known and that which is unknown cannot be obvious.” The court found that the PTAB cited no evidence that a reduction of 30% in the pulling force would necessarily result from the claimed process in Summers, and thus concluded that the PTAB erred in relying on inherency. However, the Federal Circuit found the error harmless because the PTAB had made the necessary underlying factual findings to support an obviousness determination. The court noted that “[n]one of the patented steps differs in any material way from the process disclosed in Summers (in view of Dow),” and “there is no evidence that the claimed 30% reduction in pulling force would have been unexpected or unattainable from the process disclosed in Summers.” The Federal Circuit described the 30% reduction limitation as “an observed result of an old process, written into the claim in an attempt to avoid the prior art process.”

Steuben Foods, Inc. v. Nestle USA, Inc.,
884 F.3d 1352 (Fed. Cir. 2018)

The Federal Circuit upheld the PTAB’s decision finding claims 1–10, 14, 16–21, 25, 27, 29, and 32–36 of the ’435 patent unpatentable as obvious. The court found that the PTAB’s construction of the term “sterilant concentration levels in the plurality zones” was not erroneous and substantial evidence supported the PTAB’s determination that claims disclosing a ratio of sterilant concentration levels were unpatentable as obvious.

The ’435 patent discloses an apparatus and method for providing sterilization zones in an aseptic packaging sterilization tunnel that surrounds containers with pressurized gas. Nestle challenged claims of the ’435 patent, those concerning the sterilization tunnel and maintaining a specific ratio of sterilant concentration levels in the plurality zones in the tunnel, in an IPR. The PTAB found that the challenged claims would have been obvious to a person of ordinary skill in the art in view of prior art references in the record. The PTAB construed “sterilant concentration levels” to be the levels measured “at any point within the sterilization tunnel—including the ‘residual’ concentration on bottle surfaces—such that the 5 to 1 ratio is satisfied.” Steuben Foods argued that the PTAB construed the term “sterilant concentration levels” so broadly as to read on the concentration of sterilant “at any point” within the sterilization zone.

The Federal Circuit found that Steuben Foods’ proposed construction impermissibly restricts the claim term to a specific embodiment disclosed in the specification, and that they fail to point to any language in the claims or disclosure in the specification that supports its position that the claims are limited based on how or where the sterilant concentration levels should be assessed. Because the court concluded that the broadest reasonable construction of “sterilant concentration levels” must encompass both the “in air” sterilant levels as well as the residual sterilant levels on the lids of the bottles and the bottle surface, the PTAB’s construction was not found erroneous.

Stone Basket Innovations, LLC v. Cook Med. LLC,
892 F.3d 1175 (Fed. Cir. 2018)

The Federal Circuit affirmed the Southern District of Indiana’s denial of Defendant’s bid for attorneys’ fees under the *Octane Fitness* standard following cancellation of all patent

claims in an IPR proceeding, because the district court did not abuse its discretion in determining, under the totality of the circumstances, that the case did not rise to the level of “exceptional.”

Stone Basket sued Cook Medical alleging infringement of U.S. Patent No. 6,551,327. Cook Medical petitioned for IPR of all claims of the asserted patent. The next month, the parties jointly moved to stay the district court action during the IPR proceedings (which had not been instituted at the time of stay). Following institution of the IPR, and during the IPR proceedings, Stone Basket requested an adverse judgment and all claims of the patent were canceled. Stone Basket then moved to dismiss its case in the district court that same month. Following the dismissal, Cook Medical moved for attorney fees, arguing (1) that Stone Basket’s litigation position was “exceptional” in view of the alleged substantive weakness of Stone Basket’s litigation position, and (2) Stone Basket’s pattern of vexatious litigation. The district court denied the motion, and Cook appealed.

The Federal Circuit affirmed. Regarding the substantive strength of Stone Basket’s litigation position, the Federal Circuit rejected Cook Medical’s position that its invalidity contentions put Stone Basket on “clear notice” of the patent’s invalidity. Cook Medical’s invalidity contentions listed 32 references and included a general statement of obviousness in “inconsistent and unilluminating” detail. The panel agreed with the district court that such invalidity contentions did not notify Stone Basket how a specific prior art reference—cited on the face of the patent—rendered the asserted patent obvious (the position that ultimately prevailed at the IPR proceedings). The Federal Circuit also found that the inventor’s testimony that a single claim limitation was known in the prior art did not make the case exceptional because patentability is considered by evaluating the claim as a whole.

Additionally, the Federal Circuit found that the district court did not err by considering Cook Medical’s own behavior during litigation, and emphasized that Cook Medical’s failure to inform Stone Basket that it believed the case to be frivolous, or demand that Stone Basket drop the lawsuit due to invalid claims until after the case was already dismissed, weighed against finding the case exceptional under “*Octane’s* totality-of-the-circumstances inquiry, including the conduct of the movant.”

Regarding Cook Medical’s vexatious litigation claims, the Federal Circuit held that the district court did not abuse its discretion by finding that Cook failed to provide evidence that Stone Basket’s litigation practices rose to the level of exceptionality. Stone Basket did not seek immediate settlement, but participated in each stage of infringement action for nearly two years and tested merits of its claims—contrary to Cook Medical’s argument that owner brought the suit for sole purpose of forcing settlements. Cook Medical did not file a Rule 11 motion or motion for summary judgment, and failed to identify “any concrete evidence that the District Court failed to consider Stone [Medical]’s evaluation of its case in light of the evidence of record.”

Sumitomo Dainippon Pharma Co. v. Emcure Pharm. Ltd.,
887 F.3d 1153 (Fed. Cir. 2018)

In this appeal from the District of New Jersey, the Federal Circuit affirmed the district court's claim construction relating generally to novel imide compounds and their acid addition salts useful as antipsychotic agents. Sumitomo Dainippon Pharma brought the action against competitors, Emcure Pharmaceuticals, after Emcure sought approval to market a generic version of Sumitomo's name-brand drug, the active ingredient for which is lurasidone. After the district court found for Sumitomo, Emcure conceded infringement under the court's construction and entry of permanent injunctions, but filed an appeal.

The Federal Circuit held that Emcure infringed Sumitomo's U.S. Patent No. 5,532,372, which discloses and claims more than one billion compounds, including lurasidone. The court construed the scope of the claim depicting lurasidone's chemical structure. While it can exist in two distinct three-dimensional structures that are mirror images of another—known as enantiomers—only the (-)-enantiomer was depicted in claim 14 of the patent. Emcure sought to use a narrow construction of claim 14 that limited it to a “racemic” (50/50) mixture of the two enantiomers, based in part upon extrinsic evidence in chemistry books. The Federal Circuit began its analysis with the plain claim language, which, at a minimum, covered what the claim depicted: the (-)-enantiomer. The finding was enough to resolve the parties' dispute. The court also reasoned that the plain language of the claim negated limiting the interpretation because the claim specially showed the (-)-enantiomer and failed to include any language constraining it to a racemic mixture.

The court did acknowledge that Emcure's arguments were based on extrinsic evidence, including citations in organic chemistry textbooks and expert testimony; however, it did not compel a different result. Extrinsic evidence is generally less significant than intrinsic evidence on the record and, regardless, the court found no clear error. With respect to the textbooks, the court found that the citations were either irrelevant or contradictory to Emcure's claims.

Texas Advanced Optoelectronic Sols., Inc. v. Renesas Elecs. Am., Inc.,
895 F.3d 1304 (Fed. Cir. 2018))

In this appeal from a district court patent litigation over ambient light sensors used in, e.g., smartphones, the Federal Circuit vacated the patent infringement damages award as well as the district court's denial of a permanent injunction. In the early 2000s, Texas Advanced Optoelectronic Solutions, Inc. (the plaintiff, “TAOS”) and Intersil Corporation (the defendant) were developing ambient light sensors, which enable mobile devices to adjust the brightness of the screen based on the ambient light. In February 2004, Intersil approached TAOS, requesting a license to TAOS's design. TAOS instead suggested a merger. The parties engaged in confidential diligence meetings during which TAOS disclosed its not-yet-released design for its newest sensor. The parties were not, however, able to reach an agreement. About one year later after the merger negotiations failed, Intersil launched a competing ambient light sensor. Thereafter, TAOS and Intersil competed for contracts from, for example, Apple with Intersil winning contracts for the iPod and the 3G iPhone.

In late 2008, TAOS sued Intersil asserting, among other claims, trade secret misappropriation and patent infringement. At summary judgment, the district court limited patent damages to only 1.2% of Intersil's sales on the ground that the rest of these sales could not be found to be domestic sales or the result of domestic offers for sale. At trial, the jury found Intersil liable for trade secret misappropriation and patent infringement.

On appeal, Intersil argued that the award for patent infringement was duplicative of the award for trade secret misappropriation. The Federal Circuit agreed, holding that the patent award represents an impermissible double recovery. The court reasoned that TAOS's expert calculated the asserted reasonable royalty for patent infringement based on a subset of the sales for which the expert proposed disgorgement based on trade secret misappropriation. The jury having awarded full amount of the proposed disgorgement, the jury's award of patent infringement damages gave TAOS a double recovery. The court therefore vacated the patent infringement damages award.

In its cross-appeal, TAOS argued that the district court erred in limiting its patent damages to 1.2% of Intersil's sales. The parties did not dispute that, except for this 1.2% of accused products, all of the accused products were manufactured, packaged, tested, and shipped to manufacturers abroad. Yet TAOS argued that Intersil sold or offered to sell its sensors in the United States. The Federal Circuit rejected TAOS's argument, holding instead that TAOS's evidence did not demonstrate substantial activities regarding sales sufficient to raise a dispute as to whether the sales or offers for sale were domestic. For example, TAOS failed to establish domestic business agreements or quarterly pricing negotiations as to specific products.

On appeal, TAOS also argued that the district court erred in denying its request for an injunction. The district court based its denial of the injunction entirely on TAOS's request for a reasonable royalty for future infringement, holding that this request established that TAOS had not shown irreparable harm. The court agreed with TAOS, holding that while such a request may be relevant, it is not conclusive. The court reasoned that a patentee may find that a royalty is the most appropriate remedy, but that does not mean that the "hard-to-measure" harms that justify injunctions are nonexistent.

Texas Advanced Optoelectronic Sols., Inc. v. Renesas Elecs. Am., Inc.,
888 F.3d 1322 (Fed. Cir. 2018))

At trial, in addition to returning a verdict of patent infringement, a jury held the defendant liable for misappropriating three trade secrets: (1) patentee's detailed financial information, which was allegedly utilized by the defendant to make a "Build v. Buy" decision when the two companies were considering a merger; (2) a packaging roadmap specification and cost-breakdown information indicating the high expense of glass packaging, allegedly used by the defendant in deciding to switch to plastic packaging; and (3) the 1:1 interleaved photodiode array structure, allegedly used by the defendant to modify its products. This appeal followed.

With respect to the trade secret issues, the Federal Circuit determined that: (1) the Confidentiality Agreement between these two companies clearly permitted use of financial

information for “Build v. Buy” decisions and thus there was no misappropriation of financial information; (2) the defendant already had access to plastics before seeing the roadmap and patentee failed to show that their cost-breakdown information influenced the defendant’s decision to switch from glass to plastics and thus there was no misappropriation of packing information; and (3) a reasonable jury could find that the photodiode structure was still “secret” at the time of misappropriation. The court, therefore, affirmed the verdict of the defendant’s liability for trade secret misappropriation, but limited it only to the use of the photodiode structure.

The court then vacated the monetary award for misappropriation on the grounds that liability could only properly rest on one of the three bases considered by the jury, whose calculation did not distinguish between those bases. The court also vacated the award on the grounds that 90% of the award was attributable to sales occurring after the defendant was able to access the photodiode structure by proper means. Likewise, because the disgorgement award was vacated, the court determined that the exemplary damages must be vacated. Furthermore, the court determined that the district court erred in relying on the jury’s verdict on disgorgement because patentee did not have a Seventh Amendment right to a jury trial on that issue.

With respect to the patent infringement claims, the court reversed-in-part and affirmed-in-part the jury’s verdict of infringement. Specifically, the court determined that while a lack of evidence that the accused products operated in the only infringing “mode” meant three method claims could not have been directly infringed, three other apparatus claims only required that the accused product be capable of performing in that mode, and a jury could find that the means of doing so is located on the product’s chip as to satisfy the claim requirement. Thus, the court vacated the jury’s finding that the defendant infringed the method claims and remanded for a determination of damages for infringement of the apparatus claims.

The court also held that the district court erred in concluding that the jury’s award for patent infringement was not duplicative of the award for trade secret misappropriation. The patent infringement damages were based on four of the same infringing products as the trade secret misappropriation award and, therefore, represent an impermissible double recovery.

Finally, the court considered a cross-appeal by the patentee regarding the district court’s grant of summary judgment in favor of defendant as to extraterritorial sales. The court affirmed, finding that the patentee did not demonstrate defendant conducted “substantial activities regarding sales” in the United States. It then vacated the issues of (1) whether patentee should be granted an injunction barring defendant’s infringement of their patent and (2) whether patentee is entitled to enhanced damages based on willful infringement. According to the Court, the district court did not adequately justify its opinion that granting patentee a reasonable royalty meant that they could not show irreparable harm sufficient for an injunction, and the denial of enhanced damages had to be vacated because it was based on a standard that had been abrogated by an intervening decision.

TF3 Ltd. v. Tre Milano, LLC,
894 F.3d 1366 (Fed. Cir. 2018)

TF3 appealed the decision of the PTAB in an IPR that certain claims of the challenged patent were anticipated. The asserted patent claimed a “hair styling device” wherein a strand of hair is fed into a chamber of the device, the hair is wound around a rotating curling member in the chamber, the wound hair is heated to preserve the curl, and the curled hair slides off the curling member and exits the chamber. Prior art devices did not allow for the hair to slide off the curler but, instead, required the hair to be unwound from the curler after use. The PTAB found, however, that “allowing hair to slide along the elongate member and subsequently off its free end” was not a requirement of the claims. It thus found the challenged claims anticipated.

The Federal Circuit held that the PTAB applied the wrong construction, broadening the claims beyond the description in the specification and thereby incorrectly finding the claims as anticipated. As explained by the court, the inventor had made clear in the specification that an object of the invention was a curler which did not need to be unwound from the hair after use. The court thus held that the claim phrase “the length of hair can pass through the secondary opening” required wound hair to slide along an elongate member and pass out of chamber in its curled shape. The prior art raised in the IPR did not have any such structure. Because the PTAB’s decision of anticipation was based on an improper enlargement of the claims, the court reversed the finding of anticipation.

The General Hospital Corp. v. Sienna Biopharmaceuticals, Inc.,
888 F.3d 1368 (Fed. Cir. 2018)

In this case involving dismissal of an interference before the PTAB involving the removal of hair using nanoparticles to damage hair follicles, the Federal Circuit held: (1) the PTAB had properly construed “about” to mean “within 10%”; (2) disclosure of a broad range of values did not by itself provide written description support for a particular value within that range, unless the disclosure would have allowed one skilled in the art to immediately discern the limitation at issue in the claims; and (3) given the applicant’s compliance with a Standing Order for conducting interferences which expressly instructed the moving party to “certify” that it was not aware of any reason why a claim was not patentable, the PTAB’s determination that the applicant had failed to meet its burden to show that a proposed claim was patentable was arbitrary and capricious.

The first two holdings concerned the claims of General Hospital Corporation’s (GHC’s) patent application. The PTAB construed “about” by referencing a range of values in the specification, the highest of which was 10%, yet GHC argued that “about” included up to a 20% variation. The Federal Circuit agreed with the PTAB’s construction, concluding that no intrinsic or extrinsic evidence cited by GHC supported its construction. Moreover, the court found that GHC had waived this argument when it contested Sienna’s proposed construction by only generally denying that the broadest reasonable interpretation was “within 10%.”

Based on the construction of “about,” the Federal Circuit agreed with the PTAB’s determination that, while the specification disclosed a broad range of values and cited some discrete values within that range, none of the disclosed values in the application fall within 10% of the claim limitation requiring “about 6.6×10^{11} particles per ml.” The court relied on its prior decisions, noting that “one cannot disclose a forest in the original application, and then pick a tree out of the forest and say here is my invention.” Accordingly, it held that neither the disclosure of a broad range of concentrations nor the disclosure of particular discrete values within that range provided written description support of the claimed concentration. Nor did a disclosed range that minimally overlapped with the claimed range provide written description support for the claimed range.

The third holding concerned the PTAB’s denial of GHC’s contingent motion to add claim 74 to its ’575 application during the interference. The PTAB had determined that GHC failed to show that claim 74 was patentable and failed to meet its burden of showing the proposed claim interfered with any of Sienna’s claims. The Federal Circuit found the PTAB’s denial of GHC’s contingent motion was arbitrary and capricious. This holding was based on the PTAB’s Standing Order for conducting interferences, which expressly instructed the moving party to “certify” that it was not aware of any reason why the claim was not patentable. The Standing Order further explained that a certification that was inconsistent with a file’s prosecution history would be afforded no weight unless the inconsistency was explained. GHC had complied with the Standing Order, and the PTAB did not point to any inconsistency with the prosecution history or otherwise challenge the merits of the certification. The Federal Circuit therefore concluded that the PTAB had acted arbitrarily and capriciously in denying GHC’s contingent motion.

The Medicines Co. v. Hospira, Inc.,
881 F.3d 1347 (Fed. Cir. 2018))

In this patent infringement case, the Federal Circuit affirmed the District of Delaware’s finding of non-infringement, reversed the district court’s conclusion that the Distribution Agreement in question was not a commercial offer for sale, and remanded for the district court to determine whether the offer to sell covered the patented invention.

The Medicines Company owns U.S. Patent Nos. 7,582,727 and 7,598,343, filed on July 27, 2008, which cover an improved process for manufacturing a drug product of bivalirudin, a synthetic peptide used as an anti-coagulant. The Medicines Company has marketed its bivalirudin product under the brand name Angiomax for nearly twenty years, using the patented manufacturing method for some of that time. Hospira sought to market a generic version of Angiomax, and submitted an ANDA to the FDA for that purpose. The Medicines Company then filed suit against Hospira, alleging patent infringement. Hospira denied infringement and asserted that the patents are invalid. Although the case has a lengthy prior appellate history, relevant to this decision is Hospira’s contention that a 2007 distribution agreement invalidates the patents under the on-sale bar.

On February 27, 2007, The Medicines Company and Integrated Commercialization Solutions, Inc. (“ICS”) entered into a Distribution Agreement which stated that that The Medicines Company “now desire[d] to sell the Product” (Angiomax) to ICS and ICS

“desire[d] to purchase and distribute the Product.” The Distribution Agreement stated that upon receipt of Product at the distribution center, title would be passed onto ICS, and that The Medicines Company would not be able to sell the product to any other party in the United States for the three-year contract term. The Distribution Agreement also set forth the price of the product and the purchase schedule, and specified that while The Medicines Company could reject ICS’s purchase orders, it was required to make commercially reasonable efforts to fill the purchase orders.

Based on these facts, the Federal Circuit found that the terms of the Distribution Agreement clearly indicated that the two parties entered into an agreement to sell and purchase the product, and thus constituted a commercial offer for sale for purposes of the on-sale bar. While The Medicines Company argued that the Agreement did not constitute a commercial offer for sale because The Medicines Company could allegedly reject all purchase orders submitted by ICS, the Federal Circuit found the argument unpersuasive because the Distribution Agreement actually stated that The Medicines Company must make “commercially reasonable efforts” to fill the purchase orders. Additionally, the panel relied on the fact that the Distribution Agreement specified the price of the product and the purchase schedule, provided for the passage of title, and stated the parties’ desire to “sell” and “purchase” the product (respectively). In light of the panel’s determination that Distribution Agreement constituted a commercial offer for sale, the Federal Circuit remanded the case for the district court to determine whether the Distribution Agreement covered Angiomax created by the patented process. In addition, the panel affirmed the district court’s holding that Hospira did not infringe upon The Medicines Company’s patented method because “it does not perform ‘efficient mixing,’” as required by the patents, among other differences.

Travel Sentry Inc. v. Tropp,
877 F.3d 1370 (Fed. Cir. 2017)

In this appeal, the Federal Circuit vacated the district court’s entry of summary judgment that Travel Sentry, Inc. and its licensees did not directly infringe on any of the method claims recited in the two patents issued to David A. Tropp under 25 U.S.C. § 271(a).

The asserted patents involved a lock system administered by Tropp that permits the Transportation Security Administration (“TSA”) to unlock, inspect, and relock checked baggage. Travel Sentry also administers a lock system that enables a traveler to lock a checked bag, while also allowing the TSA to open the lock, search the bag as needed and relock it. Travel Sentry entered into a three-page Memorandum of Understanding (“MOU”) with the TSA, in which Travel Sentry agreed to supply the TSA with master keys (passkeys) to open checked baggage with Travel Sentry-certified locks.

At issue was whether Travel Sentry could be held liable for direct infringement under Section 271(a) by “directing or controlling” the TSA’s performance. The district court had found summary judgment of non-infringement was proper and reasoned that Travel Sentry did not have “any influence whatsoever on the third and fourth steps of the method carried out by the TSA, let alone ‘masterminded the entire patented process.’” These steps were: (1) having an identification structure that signals to a luggage screener that the lock may

be opened with a master key, and (2) having the luggage screener, acting pursuant to a prior agreement to look for the identification structure, use the master key, where necessary, to open the lock. The Federal Circuit concluded, however, that a reasonable jury could find that the TSA's performance of the final two claim steps was attributable to Travel Sentry and thus it could be found liable for direct infringement under Section 271(a).

The Federal Circuit noted that the district court had made three specific errors in its analysis: First, the district court erred in its characterization of the relevant "activity," which it defined in an "unduly broad manner" as "the luggage screening mandated by Congress." Referring to the MOU signed between Travel Sentry and the TSA, the Federal Circuit characterized the "activity" more narrowly than the district court as "the screening of luggage that TSA knows can be opened with the passkeys provided by Travel Sentry." Second, the district court erred in assessing the "benefit" that Travel Sentry conditions on the TSA's performance of the final two step claims. The Federal Circuit held that a reasonable jury could find that the "benefit" to the TSA as outlined in the MOU "is the ability to open identifiable luggage using a master key, which would obviate the need to break open the lock." Additionally, the Federal Circuit found that the benefit received by the TSA could only be realized upon exercising the final two steps of Tropp's method claims.

In addition, the Federal Circuit found that Travel Sentry had met the second prong of the *Akamai V* test, requiring Travel Sentry to have established the manner or timing of the TSA's performance. The court noted that in order for the TSA to receive the benefits that flow from using the Travel Sentry inspection system, it must necessarily perform the final two claim steps. The Federal Circuit provided additional support for its conclusion, noting that "an actor 'infringes vicariously by profiting from direct infringement' if that actor has the right and ability to stop or limit the infringement." The court reasoned that Travel Sentry has the "right to stop or limit the infringement" by terminating the MOU, discontinuing its practice of replacing passkeys that are damaged or lost, and changing the design of future locks such that the keys previously provided to TSA no longer work.

The Federal Circuit held the district court had therefore erred in granting summary judgment of non-infringement, vacated, and remanded.

Trustees of Boston Univ. v. Everlight Elecs. Co.,
896 F.3d 1357 (Fed. Cir. 2018)

Trustees of Boston University ("BU") sued Everlight Electronics and Everlight Americas ("Defendants") for infringing BU's patent, U.S. Patent No. 5,686,738, which is directed to the fabrication of light-emitting diodes. A jury found that Defendants infringed the '738 patent and failed to prove that the patent is invalid as not enabled under Section 112. The district court denied Defendants' renewed motion for judgment as a matter of law that the '738 patent is invalid as not enabled. On appeal, the Federal Circuit reversed, holding that the '738 patent is not enabled as a matter of law.

The only issue decided on appeal was whether BU's '738 patent is enabled. The '738 patent is directed to making a semiconductor device with a monocrystalline growth

layer grown directly on an amorphous buffer layer. Defendants contended that the specification does not teach one of skill in the art how to make the claimed device, and the Federal Circuit agreed. In fact, both parties' experts testified that it is impossible to epitaxially grow a monocrystalline film directly on an amorphous structure, and the patent essentially taught only epitaxy.

The court rejected several of BU's arguments in favor of enablement. First, the court held that conclusory testimony from BU's expert was insufficient to support enablement. Second, the court held that inventor testimony relied on by BU was inapposite, as it described the phenomenon at issue in a different context. Third, the court rejected BU's evidence regarding others' ability to create the device, explaining that "the inquiry is not whether it was, or is, possible to make the full scope of the claimed device—a scope that here covers a monocrystalline growth layer directly on an amorphous layer. The inquiry is whether the patent's specification taught one of skill in the art how to make such a device without undue experimentation as of the patent's effective filing date. Viewed in this light, BU's evidence is not probative of enablement." Finally, the court rejected BU's argument that the patent was enabled because five out of the six referenced permutations were enabled, explaining that "the specification must enable the full scope of the claimed invention."

Two-Way Media Ltd. v. Comcast Cable Commc'ns, LLC,
874 F.3d 1329 (Fed. Cir. 2017)

In this case involving a system for streaming audio/visual data over a communications system, the Federal Circuit affirmed the district court's determination that the claims of the asserted patents were ineligible under Section 101.

The patents at issue relate to a system for streaming audio/visual data over a communications system like the internet. Two-Way Media filed a suit for patent infringement in district court. The district court dismissed the case under Rule 12(b)(6) after finding the asserted patents were directed at an abstract idea and no additional elements transformed the nature of the claims into a patent-eligible application. The parties agreed that the district court should adopt Two-Way Media's claim construction. However, after adopting the proposed claim construction, the district court found the patents were directed at abstract ideas, specifically at (1) sending and monitoring the delivery of audio/visual information, and (2) monitoring and measuring the delivery of real-time information to a user.

The Federal Circuit engaged in a two-step analysis from *Alice* and affirmed the district court's decision. First, the Federal Circuit reiterated that claims directed at generalized steps to be performed on a computer using conventional computer activity are not patent eligible. The claims recited methods for routing information using generic computer components, not specific computer architecture. Second, the Federal Circuit held the additional elements of the claims did not transform the nature of the claim into a patent-eligible application. The court repeated that merely reciting the use of a generic computer or adding the words "apply it with a computer" did not make an idea patent-eligible. The claims required conventional computer parts and network components operating according

to their ordinary functions using a conventional ordering of the steps. Fundamentally, Two-Way Media could not overcome the fact that the claim was missing an inventive concept, even if an inventive concept was purportedly described in the specification. The Federal Circuit addressed Two-Way Media's preemption claims by noting that when patents disclosed only ineligible subject matter, then preemption concerns were mooted. Finally, the Federal Circuit held the district court did not err in rejecting Two-Way Media's proffered materials because these materials were relevant to novelty and obviousness analysis, not to eligibility.

UCB, Inc. v. Accord Healthcare, Inc.,
890 F.3d 1313 (Fed. Cir. 2018)

The Federal Circuit, in a Hatch-Waxman case, affirmed the district court's conclusion that a patent covering a compound for epilepsy treatment was not invalid.

Accord Healthcare, Inc. and a group of generic drug manufacturers (collectively, "Accord") filed ANDAs seeking approval for generic epilepsy drugs. Accord certified that its generic products would not infringe U.S. Patent No. RE38,551, which claimed lacosamide, the compound of Accord's generic. UCB, Inc. sued Accord for infringement of the '551 patent in the District of Delaware.

Lacosamide belongs to a class of compounds called functionalized amino acids ("FAA"). Dr. Kohn and Philippe LeGall published a series of papers on the anticonvulsant activity of FAAs, including the anticonvulsant activity of lacosamide's racemate. Subsequently, Kohn filed U.S. Patent No. 5,378,729, the prior art to the '551 patent, which claimed a genus of FAAs, and U.S. Patent No. 5,654,301, a continuation of the '729 patent. Lacosamide is a species of the genus disclosed in the '729 and '301 patents.

Accord argued that (1) the claims of the '551 patent were invalid for obviousness-type double patenting in view of the '301 patent, (2) LeGall's disclosure of lacosamide's racemate, the '729 patent's disclosure of the FAA genus, and the research papers rendered the '551 patent obvious, and (3) LeGall's disclosure of lacosamide's racemate anticipated the '551 patent. The district court rejected all three arguments and found the '551 patent not invalid.

The Federal Circuit affirmed. Regarding obviousness-type double patenting, the panel held that the district court properly considered the differences between the '301 and '551 patents in context of the claims as a whole. The panel affirmed the conclusion that the '551 patent's claims were patentably distinct because a skilled artisan would not have had a reasonable expectation of success in placing the specific chemical groups of lacosamide in the variable positions of the general structure disclosed by the '301 patent.

Regarding obviousness, the Federal Circuit held that although the district court was not required to apply a lead compound analysis, it did not err in doing so. The panel affirmed the conclusion that the '551 patent was not obvious because expert testimony established that a skilled artisan would not have been motivated to select an FAA as a lead compound.

Regarding anticipation, the Federal Circuit held that even if LeGall's research disclosed the racemic mixture, it did not disclose the mixture's separation into individual enantiomers. Thus, lacosamide, the R-enantiomer of the mixture, was not anticipated.

Judge Prost dissented, arguing that, in connection with the obviousness-type double patenting analysis, the prior art supported a reasonable expectation of success in selecting lacosamide's specific chemical groups.

Ultratec, Inc. v. CaptionCall, LLC,
872 F.3d 1267 (Fed. Cir. 2017)

The Federal Circuit held that the PTAB abused its discretion by denying a patentee's request to supplement the record with conflicting testimony made during co-pending district court litigation.

The appeal arises from a series of IPRs between CaptionCall and Ultratec over patents directed to assisted listening systems. CaptionCall retained an expert, Mr. Occhiogrosso, for both the IPRs and district court litigation. A jury in the district court found the patents valid, but shortly thereafter the PTAB issued a final ruling that the patents were invalid. The district court then stayed post judgment proceedings pending final resolution of the IPR. Ultratec then requested to move to supplement the record with Occhiogrosso's trial testimony that conflicted with his IPR testimony. Ultratec was required to make the request because it was more than one month after institution. The PTAB, without actually reviewing the conflicting testimony, denied the request and never issued a written order. The PTAB later issued a final decision invalidating Ultratec's patent and heavily relied on Occhiogrosso testimony from the IPR. The PTAB further denied Ultratec's motion to reconsider and refused to supplement the appellate record beyond including the denial of rehearing.

The Federal Circuit held that the PTAB abused its discretion in refusing to consider the conflicting Occhiogrosso testimony. Because the testimony was from the co-pending district court litigation, it did not exist during the IPR discovery period. Further, "[a] reasonable adjudicator would have wanted to review [the Occhiogrosso testimony]." Therefore, it would have been in the interest of justice to consider this evidence, especially when it would have been minimal additional burden.

The court pointed to a number of procedural problems that contributed to the error. First, the PTAB "lacked the information necessary to make a reasoned decision," because it was not even exposed to the disputed evidence. Second, the PTAB's procedures caused it to make significant evidentiary decisions without providing an explanation for its decision. Third, the PTAB's procedures, by failing to include information in the record, impeded appellate review of the agency's decision making. Therefore, the PTAB abused its discretion when it refused to admit and consider the conflicting Occhiogrosso testimony from the district court. The Federal Circuit vacated and remanded the decisions for full consideration of the trial testimony as well as the expert's credibility as a whole.

Vanda Pharm. Inc. v. West-Ward Pharm.,
887 F.3d 1117 (Fed. Cir. 2018)

In this appeal of two consolidated Hatch-Waxman cases, the Federal Circuit ruled in favor of Vanda Pharmaceuticals and upheld its patent covering the schizophrenia drug, Fanapt.

Vanda's patent (U.S. Patent No. RE39,198) was listed in the Orange Book for Fanapt. West-Ward sought approval from the FDA to commercially manufacture, use, offer to sell, and sell a generic version of Fanapt by filing an ANDA that contained a Paragraph IV certification that Vanda's '198 patent was invalid and/or would not be infringed by West-Ward. After filing the ANDA, U.S. Patent No. 8,586,610, was issued in November 2013, with an expiration of November 2, 2027. In November 2013 and June 2014, Vanda filed a civil action in the district court alleging West-Ward's infringement of the '198 and '610 patents, respectively. After the suits were filed, the '610 Patent was added to the Orange Book. Then, in May 2015, West-Ward sent Vanda a Paragraph IV notice with respect to the '610 patent notifying Vanda that it amended one of the ANDAs to contain a Paragraph IV certification that the '610 patent is invalid and/or not infringed. Soon after, the district court consolidated the two suits. Following a bench trial, the district court ruled that West-Ward did infringe the patent through its proposed generic version of the drug and that the patent was valid under 35 U.S.C. § 101.

On appeal, the Federal Circuit reviewed multiple substantive issues. First, the Federal Circuit held the district court had jurisdiction over the second lawsuit even though the lawsuit was filed before West-Ward amended its ANDA to submit the second Paragraph IV certification on the '610 patent. Jurisdiction was proper, according the Federal Circuit, because the complaint alleged that West-Ward infringed the second patent under 35 U.S.C. § 271(e)(2)(A) by filing the ANDA and the lack of a Paragraph IV certification did not negate the justiciable controversy.

Second, the Federal Circuit found that there could be infringement despite the fact the fact that Vanda sued for infringement of the '610 patent before West-Ward submitted a Paragraph IV certification. Specifically, the Federal Circuit held that amendments to an ANDA constitute an act of infringement.

Third, the Federal Circuit addressed patent eligibility under *Alice/Mayo*. Specifically, the Federal Circuit reasoned that the claims at issue were not abstract, but rather were directed to a specific method of treatment because, while the "claim in *Mayo* recited administering a thiopurine drug to a patient, the claim as a whole was not directed to the application of a drug to treat a particular disease"; here, however, the patent claims are directed towards specific patients using a specific compound at specific doses to achieve a specific outcome. The court further explained that the *Mayo* claims were not "method of treatment" claims which practically apply a natural relationship between different compounds, but which recite a method of treating patients based on the relationship between compounds.

The Federal Circuit affirmed the decision of the district court and grant of injunctive relief.

Chief Judge Prost dissented, arguing that the majority conflated the *Alice/Mayo* standard and that, “[w]hile the claims here do not solely state a law of nature, they do no more than simply direct the relevant audience to apply it.” Accordingly, Chief Judge Prost concluded that the claims are ineligible under *Alice/Mayo*.

***Vicor Corp. v. SynQor, Inc.*,**
869 F.3d 1309 (Fed. Cir. 2017)

SynQor owns several related patents directed to direct current-to-direct current (DC-DC) power converters. In an IPR, the PTAB affirmed the examiner’s rejection of claims in the ’290 patent, but also affirmed the examiner’s finding that the ’021 patent was patentable over prior art. The Federal Circuit affirmed-in-part and vacated-in-part the PTAB’s decision due to inconsistencies.

First, the Federal Circuit affirmed the PTAB’s finding that certain claims in the ’290 patent were nonobvious because a person skilled in the art would not have been motivated to combine the prior art due to frequency incompatibilities between the circuits in the power converters. Next, as to other claims in the ’290 patent, the court vacated the PTAB’s finding that the claims were nonobvious because it relied “only on SynQor’s proffered objective evidence of nonobviousness.” The court reaffirmed that the PTAB must review all four *Graham* factors. Here, the PTAB only reviewed one of the four factors. Further, the court found that the PTAB reached inconsistent conclusions regarding the weight of evidence presented in both of the reexaminations of the SynQor patents. The Federal Circuit explained that while inconsistent outcomes are not necessarily erroneous, when the outcome of “the same technical issue between the parties on the same record” is inconsistent and lacking any explanation, it is best to vacate and remand the findings for further consideration.

As to another group of claims in the ’290 patent, the court again vacated the PTAB’s finding that the claims were nonobvious because the PTAB reached essentially the opposite conclusion on the same issue in the ’021 reexamination on the same record. The court found the PTAB’s minimal reasoning insufficient. It further explained that agency error is not necessarily whenever the agency reaches inconsistent outcomes in related cases, but that it is “the best course . . . to vacate and remand for further consideration” so that the PTAB can provide a reasoned basis for reaching opposite holdings.

As to the ’021 patent, the Federal Circuit affirmed the finding that certain claims were anticipated. The court rejected SynQor’s argument that the PTAB relied on a new ground of rejection on rehearing. The court also affirmed the finding that another set of claims was obvious, noting that the PTAB provided sufficient reasoning for its finding. Finally, the court vacated the PTAB’s findings of obviousness as to certain claims in the ’021 patent due to inconsistent treatment and lack of explanation vis-à-vis the ’290 reexamination.

***Visual Memory LLC v. NVIDIA Corp.*,**
867 F.3d 1253 (Fed. Cir. 2017))

The Federal Circuit reversed the district court’s decision to dismiss an infringement lawsuit under Rule 12(b)(6) for patent ineligibility under 35 U.S.C. § 101. The court held that the

patent's claims were directed to patent-eligible subject matter of improved computer memory systems, not to the abstract idea of categorical data storage.

Visual Memory's U.S. Patent No. 5,953,740 teaches that computer systems generally use three-tiered memory hierarchy to enhance performance. According to the '740 patent, while some memory systems can operate with multiple processors, there are necessary design tradeoffs that diminish performance. The '740 patent claims a memory system with programmable operational characteristics that can be tailored for use with multiple different processors without reduction in performance.

The district court concluded that the claims were directed to the “abstract idea of categorical data storage,” which humans have practiced for many years.” The district court came to its conclusion because the claimed components (a main memory, cache, bus, and processor) were generic and conventional. The Federal Circuit reversed.

The Federal Circuit explained that one relevant question is whether the claims focus on the specific asserted improvement in the computer capabilities. The '740 patent discloses that a memory system with programmable operational characteristics permits different types of processors to be installed without compromising individual performance. Although prior art memory systems could operate with multiple different processors, the “one-size-fits-all approach” caused a tradeoff in performance. Therefore, the court found that the claims are directed to a technological improvement, not to an abstract idea. Because the claim was not an abstract idea, the court did not proceed to step two of the *Alice* test.

Judge Hughes, dissenting, argued that the court expressed the basic concept of the claims in the '740 patent at a lower level of abstraction than in the claims themselves.

Voter Verified, Inc. v. Elec. Sys. & Software LLC,
887 F.3d 1376 (Fed. Cir. 2018)

The Federal Circuit affirmed the district court's dismissal under Rule 12(b)(6) of Voter Verified, Inc.'s claim of patent infringement because the claims of '449 patent are directed to patent-ineligible subject matter under 35 U.S.C. § 101.

The '449 patent assigned to Voter Verified is directed to voting methods and systems that provide for “auto-verification” of a voter's ballot. The patent discloses a process by which a voter enters a vote into a voting system, the system generates a corresponding print ballot, and the voter verifies the printed ballot and submits it for tabulation.

In November 2009, Voter Verified sued the predecessor companies of Election Systems & Software, LLC (“Election Systems”) in the Middle District of Florida alleging infringement of the '449 patent. Election Systems counterclaimed that the claims in the '449 patent were invalid under Sections 101, 102, 103, and 112. In its summary judgment briefing, Election Systems failed to present any arguments or evidence regarding the ineligibility of all the '449 patent claims under Section 101. As a result, the district court entered summary judgment in favor of Voter Verified, concluding that all the claims of the '449 patent, except claim 94, were not ineligible or invalid under Sections 101 and 112.

In July 2016, Voter Verified sued Elections Systems in the Northern District of Florida, alleging that certain voting systems made or operated by Elections Systems infringed the '449 patent. In response, Election Systems filed a motion to dismiss, alleging all the asserted claims as ineligible under Section 101. Next, Voter Verified responded by arguing that issue preclusion prevented Election Systems from re-litigating the Section 101 issue. Election Systems countered, arguing that issue preclusion did not apply because there was an intervening change in the law and two of the four required elements of the doctrine were not met.

The district court granted Election System's motion to dismiss, concluding that issue preclusion did not apply in the case as the *Alice* decision constituted a "substantial change" in the law of patentable subject matter. On appeal, Voter Verified argued that issue preclusion should not apply because *Alice* did not constitute a change in the law but rather applied a rule established in a previous case. While the Federal Circuit agreed with Voter Verified that *Alice* did not constitute an intervening change in the law, it concluded that issue preclusion did apply on independent bases. The court restated the four elements required under issue preclusion doctrine and found that the Section 101 issue was never "actually litigated" in the previous action because Election Systems did not respond to Voter Verified's patent eligibility arguments in its summary judgment motion. In addition, the Federal Circuit held that the Section 101 issue was not "a critical and necessary part of the judgment" in the previous case.

In examining the merits of the Section 101 issue, the Federal Circuit applied the two-step framework from *Alice*. The court held that the claims are directed to patent-ineligible subject matter because they are drawn from an abstract activity—the concept of voting—and that the since the claimed abstract methods are performed using generic computer components, there was nothing to transform the abstract idea into a patent-eligible application.

WesternGeco LLC v. ION Geophysical Corp.,
889 F.3d 1308 (Fed. Cir. 2018)

In this case involving three patents directed to marine seismic survey systems (the '607 patent, the '520 patent, and the '967 patent), WesternGeco LLC appealed from six final written decisions of the PTAB in IPRs instituted by Petroleum Geo-Services, Inc. ("PGS"). The PTAB had granted a motion by ION Geophysical Corp. to join those IPRs. The Federal Circuit held that ION was not subject to the statutory time bar on IPRs because it was not in privity with PGS. The Federal Circuit then affirmed the PTAB's unpatentability determination, holding that the PTAB had correctly construed the claims at issue.

Because PGS was not a privity of ION, WesternGeco's previous patent infringement complaint against ION did not trigger the statutory time bar against PGS. In so holding, the Federal Circuit applied the common law definition of privity, subject to the limits of due process. While the Federal Circuit agreed with WesternGeco that control was not the exclusive analytical pathway for analyzing privity, it held that the PTAB had sufficiently considered factors other than control in rejecting WesternGeco's argument that PGS was a

privity of ION. Substantial evidence supported the PTAB's conclusion that ION's relationship with PGS was not sufficiently close such that the ION proceeding would have given PGS a full and fair opportunity to litigate the validity of the claims of the WesternGeco patents.

The Federal Circuit rejected a number of challenges WesternGeco had raised against the PTAB's determination of unpatentability. Regarding the '607 patent, the PTAB had correctly construed "predicting positions" to mean "estimating the actual locations." Nothing in the specification indicated that a narrower construction, such as one limited to a preferred embodiment, was appropriate. Regarding the '520 patent, the PTAB had correctly declined to read unsupported limitations into the term "control mode." The PTAB was also correct in holding that a prior patent rendered the '520 patent's "feather angle mode" unpatentable, as substantial evidence showed that this modification would have been obvious to a skilled artisan. Regarding the '967 patent, the construction of "global control system" was a disputed issue, and the PTAB was therefore permitted to issue a new construction in the final written decision. Moreover, the PTAB had not erred in considering a reference's background, as well as the '967 patent's own characterization of that reference, in its analysis of anticipation and obviousness. Lastly, the PTAB had correctly found that WesternGeco had failed to establish a nexus between the claims at issue and purported objective indicia of nonobviousness. While the product was allegedly a commercial success, WesternGeco had not shown that the driving force behind the product sales was a direct result of the unique characteristics of the claimed invention.

Wi-Fi One, LLC v. Broadcom Corp.,
887 F.3d 1329 (Fed. Cir. 2018)

The Federal Circuit, sitting en banc, held that the PTAB's time-bar determinations are appealable and remanded to the original merits panel. On remand, the panel majority affirmed the PTAB's denial of Wi-Fi One's discovery motion and finding that Broadcom Corp.'s ("Broadcom") IPR petition was not time barred.

In 2010, Wi-Fi's predecessors (collectively, "Ericsson") sued D-Link Systems, Inc. and several other defendants for infringement of U.S. Patent No. 6,772,215, which is directed to a method for improving efficiency of a telecommunications systems' notification of message errors to senders, as well as eight other patents. Following a judgment of infringement for Ericsson of the '215 patent and two other patents, Broadcom (which had no role in the "D-Link" litigation) petitioned for IPR. Wi-Fi argued that Broadcom was time barred from seeking IPR under 35 U.S.C. § 315(b) because Broadcom was allegedly in privity or a real party in interest with some or all of the previous defendants to the D-Link litigation. The PTAB rejected Wi-Fi's argument, denied Wi-Fi's discovery request, and determined that the '215 patent's claims were unpatentable as anticipated.

On appeal, Wi-Fi contended that the PTAB erred by (1) applying the incorrect legal standard in deciding the privity issue; (2) denying Wi-Fi's request for discovery of evidence; and (3) failing to support its decision regarding the Section 315(b) issue with substantial evidence; (4) determining that prior art anticipated the '215 patent; and (5) misconstruing certain claim language.

First, the majority rejected Wi-Fi's argument that the PTAB applied an incorrect legal standard in its analysis of the privity or real party in interest issue. Wi-Fi argued that the PTAB had required it to show that Broadcom "had the right to control the District Court litigation" to find privity or a real party in interest. The majority disagreed, noting that the PTAB had not applied a "control" test and recognized that "a number of factors may be relevant to the analysis" of any finding of privity or real party in interest.

Second, Wi-Fi argued that the PTAB improperly denied its discovery request for evidence such as indemnity agreements between Broadcom and the D-Link litigants. Wi-Fi also challenged the PTAB's rejection of its request for "additional discovery," which requires the party seeking discovery to demonstrate that the discovery request is "in the interest of justice" and would "be likely to produce favorable evidence." The majority affirmed the PTAB's denial of additional discovery because the PTAB "explored the discovery issue in detail and applied the proper legal test."

Third, the majority rejected Wi-Fi's arguments that the PTAB did not adequately explain its ruling on the Section 315(b) issue and that its decision was not supported by substantial evidence. The majority also affirmed the PTAB's finding regarding privity because the PTAB "reasonably concluded" that the evidence failed to show that Broadcom had sufficient control over the district court litigation so as to bind it to the result.

Fourth, the majority concluded that substantial evidence supported the PTAB's anticipation finding. And finally, the majority upheld the PTAB's claim construction and considered Wi-Fi's alternative construction to be "unreasonable."

Judge Reyna dissented regarding the proper legal standard to be applied in a privity analysis, reasoning that the PTAB had improperly narrowed its analysis on the "right to control" the litigation rather than the independent bases articulated by Wi-Fi.

Wi-Fi One, LLC v. Broadcom Corp.,
878 F.3d 1364 (Fed. Cir. 2018)

The Federal Circuit granted en banc review to answer the question of whether the bar on judicial review of institution decisions in 35 U.S.C. § 314(d) applied to time-bar determinations made under 35 U.S.C. § 315(b) (both sections of the America Invents Act), and consequently, whether it should overrule the conclusion in *Achates Reference Publishing, Inc. v. Apple Inc.*, 803 F.3d 652 (Fed. Cir. 2015), that time-bar determinations were final and nonappealable. The Federal Circuit concluded that time-bar decisions under Section 315(b) are not exempt from judicial review and overruled *Achates*.

In 2010, Telefonaktiebolaget LM Ericsson ("Ericsson") filed a complaint for infringement of patents 6,772,215, 6,466,568, and 6,424,625 in the Eastern District of Texas against multiple defendants. The jury in that case found that the defendants infringed the asserted claims.

In 2013, Broadcom, which was not one of the defendants in that litigation, filed three IPR petitions of Ericsson's patents asserted in the 2010 case. Wi-Fi One, to whom Ericsson transferred ownership of the three patents during the pendency of the IPRs, argued that the

PTO Director was prohibited from instituting review of the petitions under Section 315(b) because Broadcom was in privity with the defendants and more than one year had gone by since the defendants had been served with the complaint for infringement. However, the PTAB found that Wi-Fi One had not shown that Broadcom was in privity with the prior defendants and therefore the IPR petitions were not time barred. The PTAB then instituted review of the IPR petitions, finding the challenged claims unpatentable. Wi-Fi One appealed to the Federal Circuit in 2016, but the decision was affirmed based on the *Achates* precedent.

In *Achates*, a panel of the Federal Circuit held that Section 314(d) precluded judicial review of Section 315(b) time-bar determinations. Subsequently, the Supreme Court decided *Cuozzo Speed Technologies, LLC v. Lee*, 136 S. Ct. 2131 (2016), holding that Section 314(d) did not bar review of determinations by the PTO that a petition for IPR complied with the “particularity” requirement in Section 312(a)(3). The Supreme Court specifically left open the potential for review of decisions to institute IPR, saying that its holding “applie[d] where the grounds for attacking the decision to institute [IPR] consist[ed] of questions that [were] closely tied to the application and interpretation of statutes related to” the institution decision.

In the instant case, the Federal Circuit held that there was not a clear and convincing indication from Congress in the statutory language, legislative history, or statutory scheme of the America Invents Act to disregard the strong presumption in favor of judicial review. Additionally, the Federal Circuit noted that the holding in *Cuozzo* pointed towards unreviewability being limited to the Director’s determinations that were closely related to the preliminary patentability determination or the exercise of discretion not to institute, and that whether a petitioner had complied with Section 315(b) was not such a determination.

Judge O’Malley concurred, writing that consistent with *Cuozzo*, Section 315(b)’s time bar was not “closely tied to the application and interpretation of statutes” related to the PTO’s decision to initiate an IPR. In other words, because Section 315(b)’s time bar had nothing to do with the substantive adequacy of the petition and was directed, instead, to the Director’s authority to act, Section 314(d) did not apply to decisions under that provision.

Judge Hughes wrote in his dissent that because the PTO evaluates timeliness within the context of the PTO’s preliminary determination of whether to institute an IPR at all, timeliness is therefore plainly a question closely tied to the Director’s decision to institute an IPR, and was specifically a requirement for institution.

Xitronix Corp. v. KLA-Tencor Corp.,
882 F.3d 1075 (Fed. Cir. 2018)

In this appeal over a monopolization claim, the Federal Circuit declined to exercise jurisdiction and transferred the case to the United States Court of Appeals for the Fifth Circuit.

The sole cause of action in this case is a *Walker Process* monopolization claim under the Sherman Act, alleging that KLA “intentionally made false representations to the PTO on

which the examiner relied during prosecution.” Although both parties asserted that the Federal Circuit had appellate jurisdiction over the case, the court disagreed. The Federal Circuit explained that its jurisdiction extends to cases in which “patent law is a necessary element of one of the well-pleaded claims,” and therefore the only question at issue is “whether the monopolization allegation necessarily depends on resolution of a substantial question of federal patent law, in that patent law is a necessary element of one of the well-pleaded claims.” With respect to this case, the Federal Circuit found that there was “nothing unique to patent law about allegations of false statements” and pointed to the fact that both parties focused on fraud and misrepresentation, not patent law. Thus, the Federal Circuit declined to exercise jurisdiction and instead transferred the case to the United States Court of Appeals for the Fifth Circuit.

XY, LLC v. Trans Ova Genetics, L.C.,
890 F.3d 1282 (Fed. Cir. 2018)

In an appeal from the District of Colorado, the Federal Circuit applied collateral estoppel from a PTAB determination to override a jury’s invalidity findings.

XY, LLC (“XY”) owned patents directed to methods for sorting animal sperm cells and entered into a licensing agreement with Trans Ova Genetics, L.C. (“Trans Ova”), authorizing Trans Ova to use XY’s technology. XY sought to terminate the agreement, but Trans Ova refused and continued to use XY’s technology. XY sued Trans Ova for breach of contract and patent infringement. Trans Ova counterclaimed for monopolization under the Sherman Act, breach of contract, and patent invalidity.

The jury found that none of the patent claims were invalid and that Trans Ova willfully infringed. The district court upheld the jury’s verdict on validity and willful infringement. The court also set an ongoing royalty as an equitable remedy for Trans Ova’s future infringement by averaging the jury’s royalty rate and the royalty rate stipulated by the licensing agreement.

The Federal Circuit affirmed most of the validity conclusions, vacated the royalty, and remanded for a new calculation of the royalty rate. Specifically, regarding invalidity, the Federal Circuit affirmed the validity of the claims of all patents except one because, in a separate case, the Federal Circuit had agreed with the PTAB determination that the claims of one of XY’s patents were invalid. Based on that prior finding, the panel *sua sponte* held that collateral estoppel precluded XY from asserting the claims of that patent in the instant case.

Regarding the ongoing royalty, the Federal Circuit held that the district court abused its discretion in calculating the rate. XY was in a stronger bargaining position post-verdict, after a finding that Trans Ova infringed, so the district court’s calculation focusing on pre-verdict factors, like the prior agreement between the parties, was improper.

Regarding willful infringement, the Federal Circuit noted that the district court declined to award enhanced damages and that the issue was therefore moot.

Judge Newman concurred in part and dissented in part. She disagreed only with the application of collateral estoppel, arguing that using the PTAB's subsequent invalidity determination to override the district court's and the jury's findings without affording the parties an opportunity to respond violated collateral estoppel precedent and upset the constitutional balance between courts and agencies.

Zeroclick, LLC v. Apple Inc.,
891 F.3d 1003 (Fed. Cir. 2018)

Zeroclick sued Apple for patent infringement of a graphical user interface for devices like cell phones or computers that allows the device to be controlled by a predefined pointer or touch, rather than mouse clicks. In response, Apple asserted invalidity of those claims. The district court found the asserted claims invalid for indefiniteness, reasoning that the claims recited means-plus-function terms for which the specifications do not disclose sufficient structure. The Federal Circuit vacated and remanded these findings because the district court failed to undertake the relevant inquiry and make related factual findings to support its conclusion that the asserted claims recited means-plus-function terms.

The Federal Circuit found that the district court erred in construing "program" and "user interface code" as means-plus-function limitations. The fact that neither of the limitations at issue uses the word "means" creates a rebuttable presumption that Section 112, ¶ 6 does not apply. The presumption may be rebutted "if the challenger demonstrates that the claim term fails to recite sufficiently definite structure or else recites function without reciting sufficient structure for performing that function," but Apple failed to provide the necessary evidentiary support to do so here.

When evaluating whether a claim limitation invokes Section 112, ¶ 6, the essential inquiry remains "whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure." That determination must be made under the traditional claim construction principles, on an element-by-element basis, and in light of evidence intrinsic and extrinsic to the asserted patents. The Federal Circuit found that the district court erred by not giving effect to the unrebutted presumption and remanded the case to the district court.

ZUP, LLC v. Nash Mfg., Inc.,
896 F.3d 1365 (Fed. Cir. 2018)

In this case, the Federal Circuit affirmed the district court's grant of summary judgment of invalidity, holding that the district court had properly applied the law in finding ZUP's patent, directed to a wakeboard with features to assist unskilled riders, obvious over several prior art patents.

On appeal, ZUP argued that (1) the district court had not properly considered whether there would have been a motivation to combine the prior art references in the claimed manner, and (2) the district court had improperly shifted the burden to patentee to prove non-obviousness in the context of secondary considerations.

In dismissing the first argument, the Federal Circuit held that the prior art of record held ample motivation to incorporate each rider-assisting feature of the claimed wakeboard, including a tow hook, handles, foot bindings, and rails on the bottom of the board. The court noted in a footnote that to the extent ZUP was arguing that no motivation existed to employ all of these features simultaneously, that this was “simply the predictable use of prior art elements according to their established functions.”

In dismissing the second argument, the Federal Circuit noted that although the burden of persuasion always remains with the challenger, “a patentee bears the burden of production with respect to evidence of secondary considerations of nonobviousness.” Here, the court found that the district court had properly concluded that there was no material fact, despite patentee’s expert’s conclusions on secondary considerations, because the “weak evidence of secondary considerations presented here simply cannot overcome the strong showing of obviousness.”

Judge Newman, dissenting, argued that the majority’s application of the law of obviousness violated the principles set forth in *Graham* that require secondary considerations to be considered before making an initial determination as to obviousness, and that the patentee cannot be required to prove that these secondary considerations outweigh the remaining *Graham* factors.

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