

GIBSON DUNN

Federal Circuit Year in Review 2021/2022

Intellectual Property and Appellate Practice Groups



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TABLE OF CONTENTS

	<u>Page</u>
INTRODUCTION	1
ACKNOWLEDGEMENT.....	2
GIBSON DUNN’S FEDERAL CIRCUIT CLERKS.....	3
STATISTICAL ANALYSIS	6
INDEX BY ISSUE	26
CASE SUMMARIES.....	37
ALPHABETICAL INDEX OF ALL CASES.....	110

INTRODUCTION

We are pleased to present to you Gibson Dunn's Federal Circuit Year in Review for the Federal Circuit's 2021–2022 term. In the pages that follow, we provide summaries of all patent law-related precedential decisions from the Federal Circuit this term. We also provide various analytics and categorizations of these decisions, to make them as useful to you in your practice as possible.

We hope this information serves you well this coming year and in the future. As always, if we can answer any questions, please do not hesitate to contact us.



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GIBSON DUNN'S FEDERAL CIRCUIT CLERKS

Gibson Dunn is proud to have as key members of its Appellate and Intellectual Property practices 14 former clerks from the U.S. Court of Appeals for the Federal Circuit:



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Kate Dominguez (Judge Taranto, 2013–2014) is a partner in the New York office of Gibson Dunn and is a member of Gibson Dunn's Intellectual Property Practice Group. Ms. Dominguez has litigated patent cases across a broad spectrum of technologies, including global positioning systems, interactive television, intrusion detection, mobile communications, and wireless networking.



Jaysen Chung (Former Chief Judge Rader, 2014) is a partner in the San Francisco office of Gibson Dunn and is a member of the firm's Litigation department. He focuses on patent and appellate litigation, and has experience in a range of arts and practices, including pharmaceuticals, DNA sequencing applications, RF switch circuits, and semiconductor products and processes.



Nathan R. Curtis (Judge Dyk, 2011–2012) is of counsel in the Dallas office of Gibson Dunn, where his practice focuses on intellectual property litigation before district courts, the Patent Trial and Appeal Board, and the U.S. International Trade Commission. Mr. Curtis litigates intellectual property cases in a wide range of technological fields, including telecommunications, computer architecture, medical devices, semiconductors, and manufacturing.



Christine Ranney (Judge Newman, 2013–2015) is an associate in the Denver Office of Gibson Dunn and is a member of the firm's Litigation department, where she focuses on patent litigation. Before her clerkship, Ms. Ranney was an analyst in a leadership development program at Merck & Co.



Ryan Iwahashi (Judge O'Malley, 2014–2015) is an associate in the Palo Alto office of Gibson Dunn and is a member of the firm's Litigation department. His practice focuses on intellectual property litigation and he has experience in a range of technologies, including software, consumer electronics, and medical devices.



Andrew Robb (Judge Dyk, 2014–2015) is an associate in the Palo Alto office of Gibson Dunn. He is a member of the firm's Litigation department, with a focus on intellectual property and other technology-based litigation. He has litigated cases across a broad range of industries and technologies, including wireless telecommunications, consumer fitness devices, mobile gaming network architecture, and mechanical sleep aids.



Allen Kathir (Judge Hughes, 2016–2017) is an associate in the New York office of Gibson Dunn. Allen is a member of the firm's Litigation Department, and his practice focuses on intellectual property litigation. He has experience litigating a broad range of technologies, including representing mobile telecommunications providers and medical device manufacturers.



Audrey Yang (Judge Lourie, 2017–2019) is an associate in the Dallas office of Gibson Dunn. Audrey is a member of the firm's Litigation Department and focuses on intellectual property litigation.



Vladimir Semendyai (Judge Reyna, 2018–2019) is an associate in the Washington, D.C. office and is a member of the firm's Intellectual Property and Appellate and Constitutional Law practices, focusing on intellectual property and appellate litigation.



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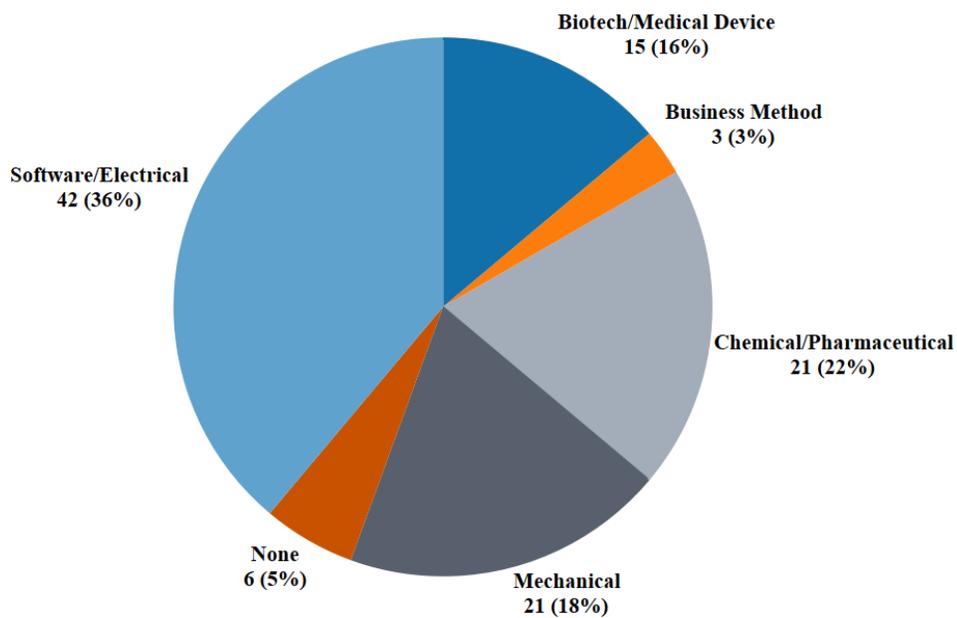
Al Suarez IV (Judge Reyna, 2021–2022) is an associate in the Dallas office of Gibson Dunn. Al is a member of the firm’s Litigation Department and focuses on intellectual property litigation. He has experience litigating a broad range of technologies, including mobile telecommunications, microprocessors, medical devices, consumer fitness devices, and artificial intelligence.



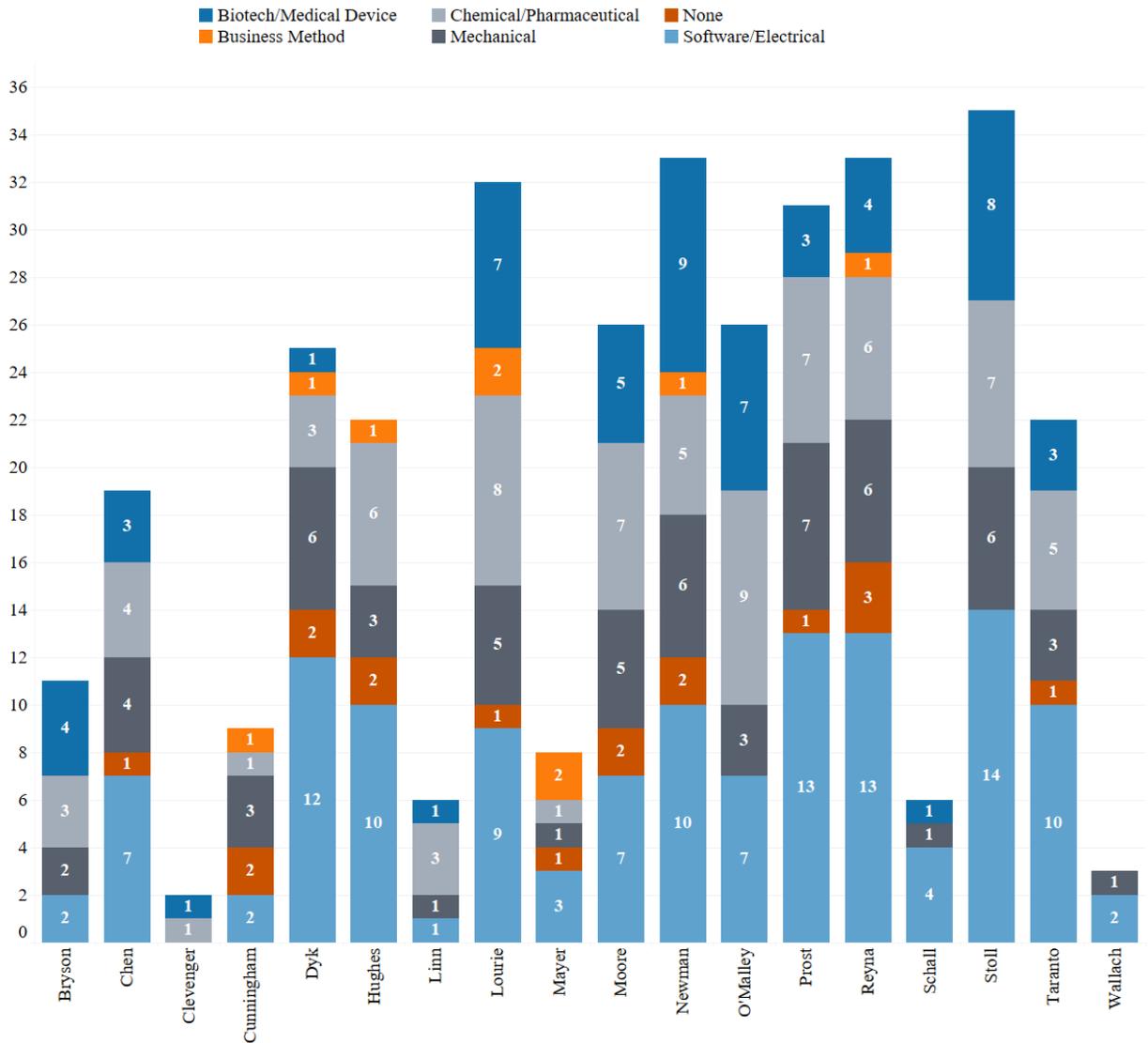
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STATISTICAL ANALYSIS
(August 1, 2021 – July 31, 2022)

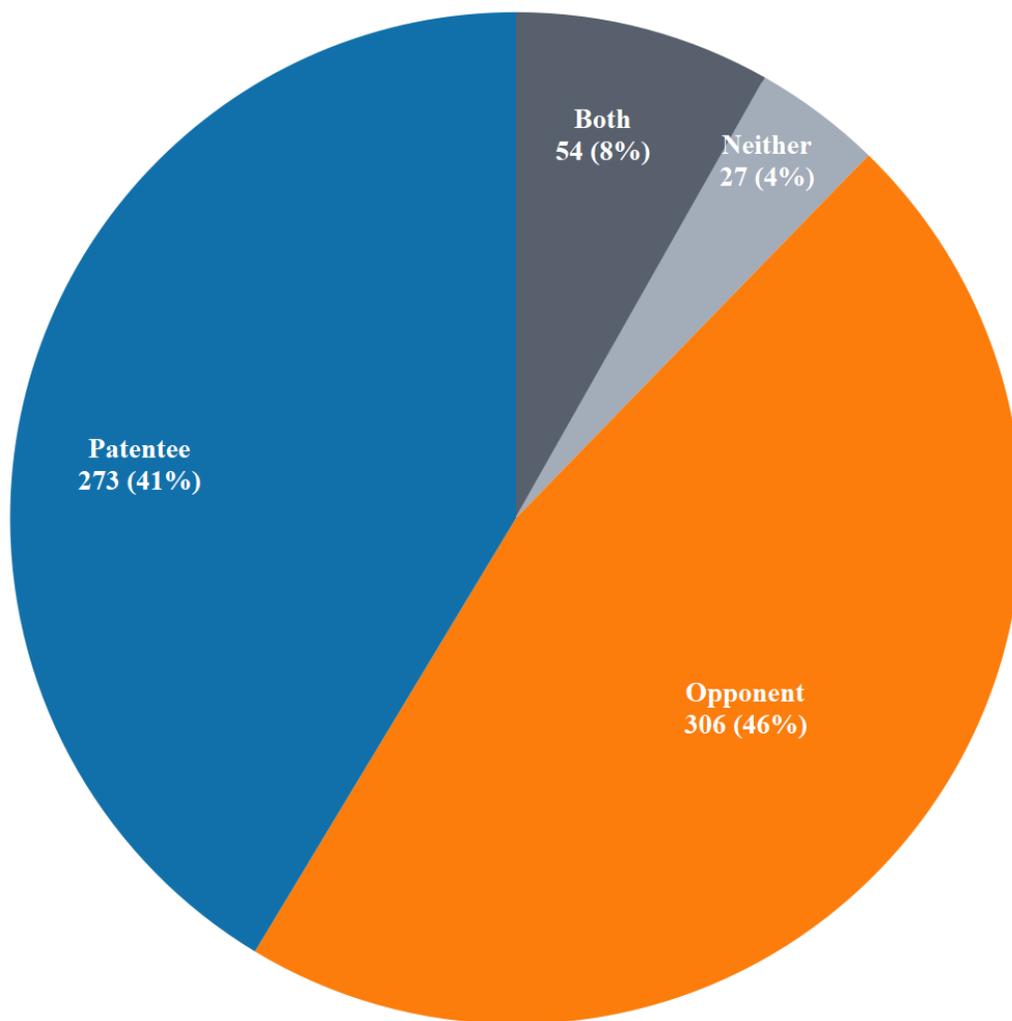
Decisions by Patent Subject Matter



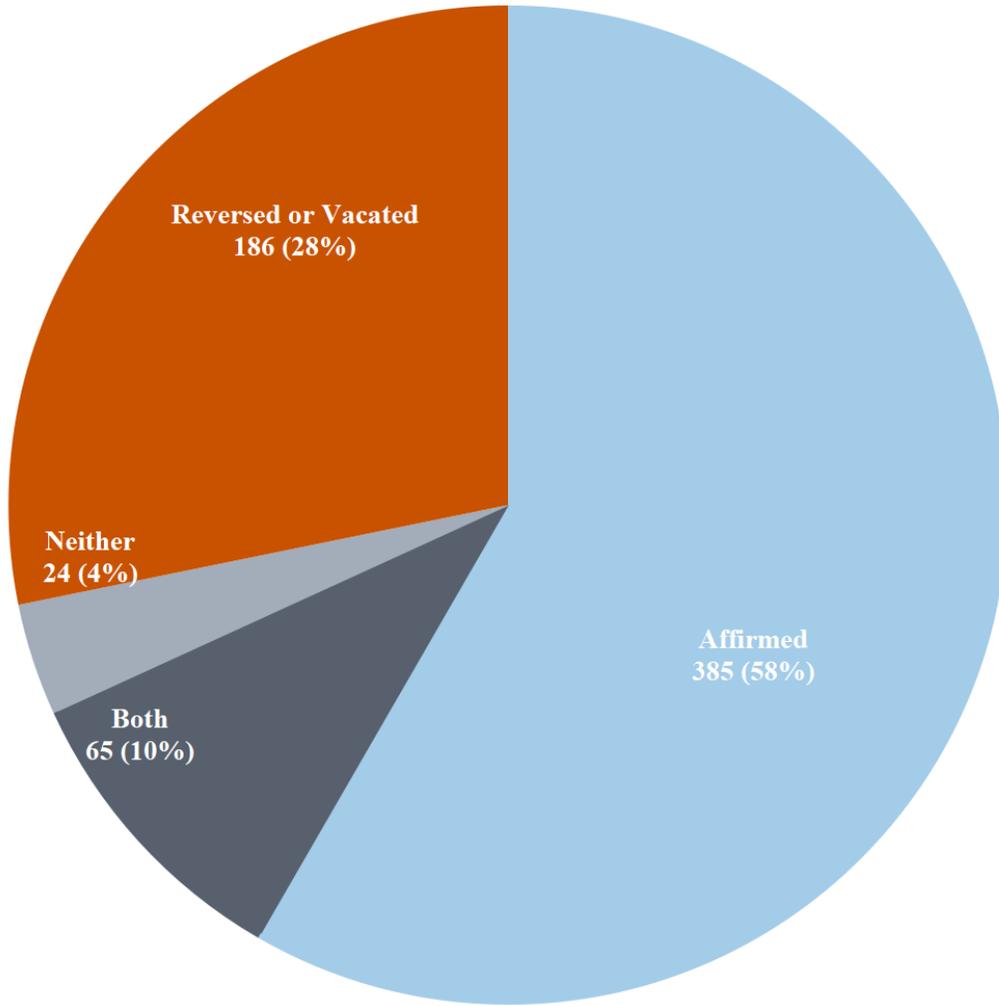
Patent Subject Matter by Author



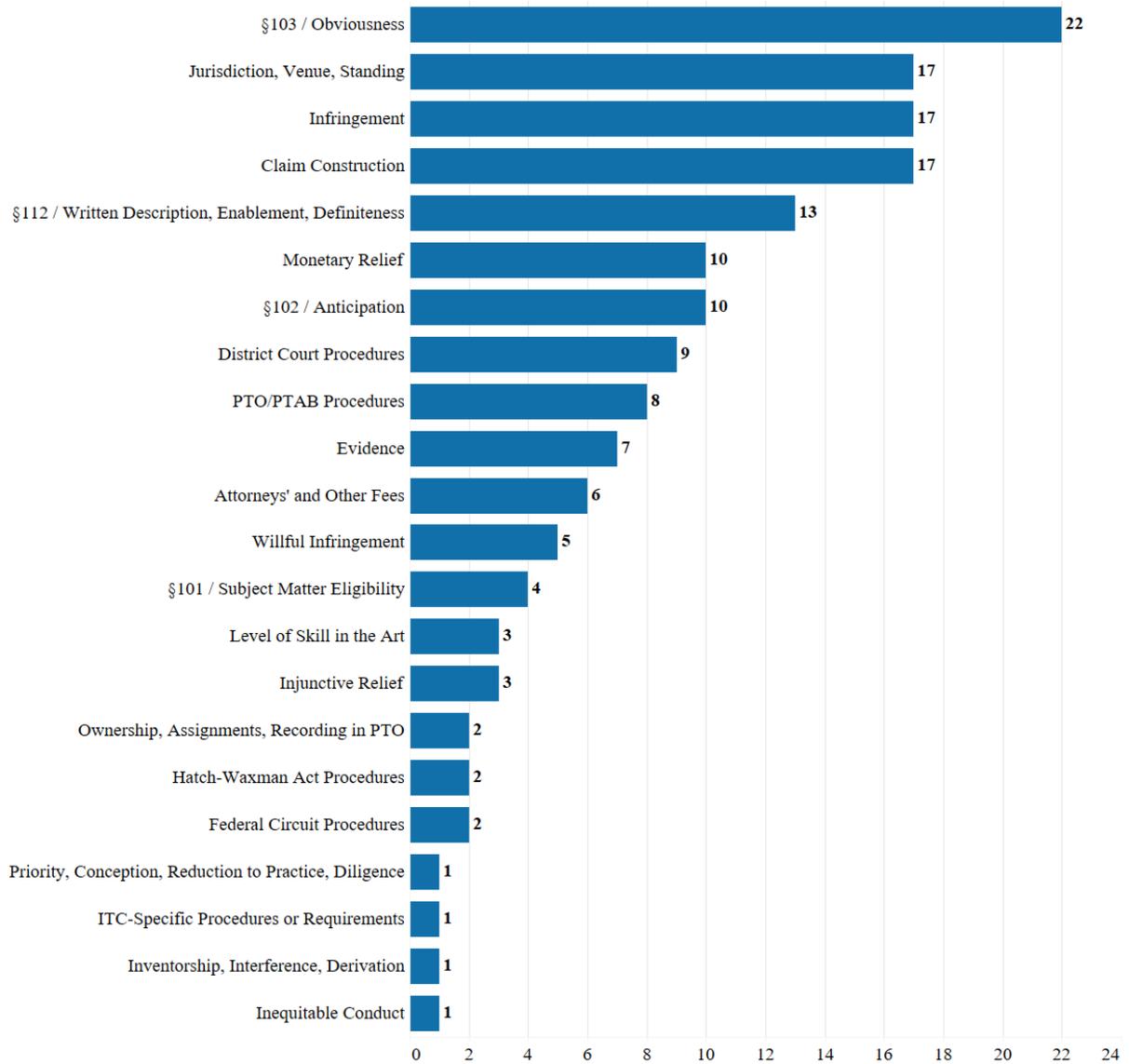
Overall Outcomes: Party Win Rate



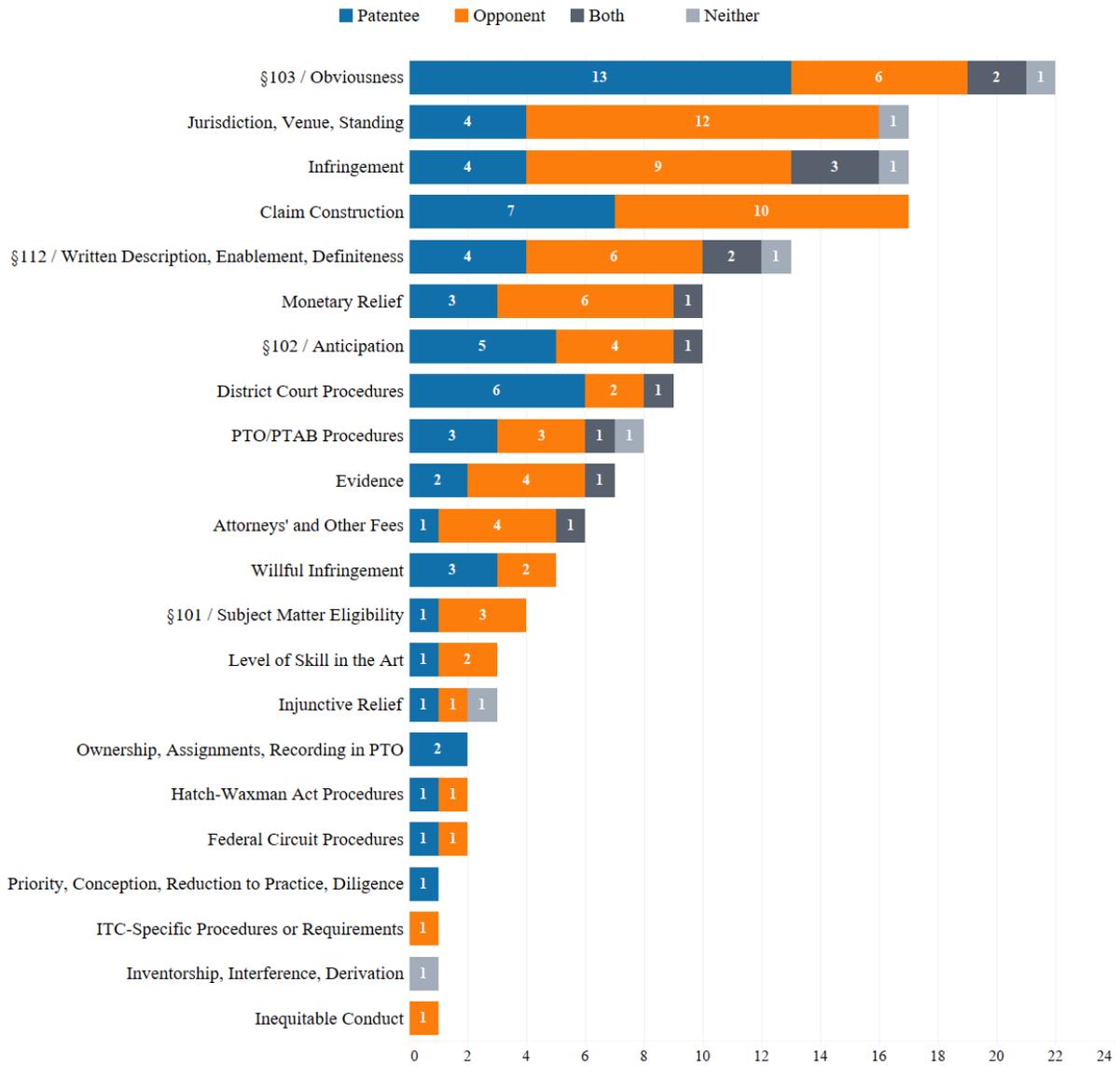
Overall Outcomes: Affirmance/Reversal



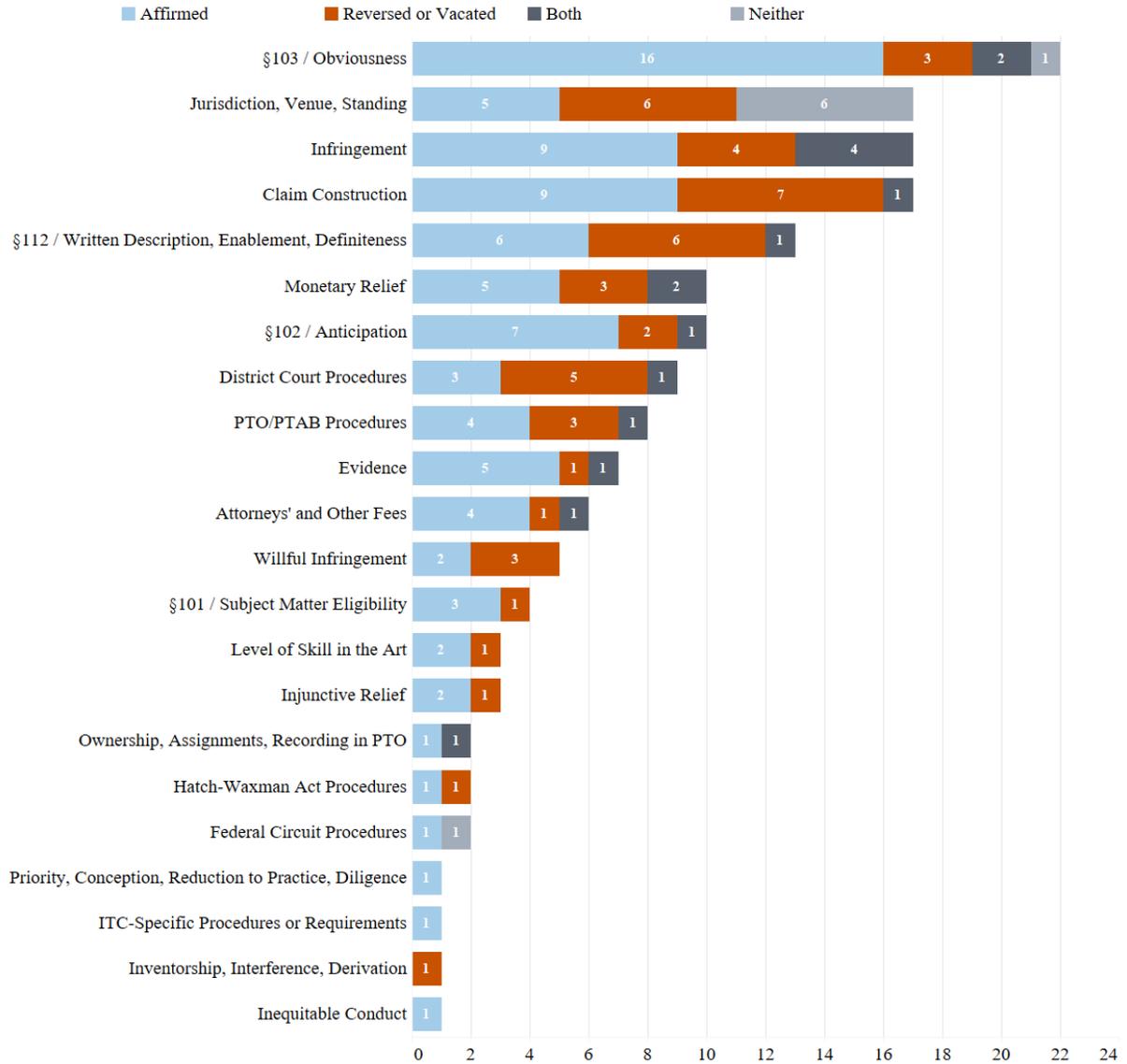
Top Issues



Winning Side by Issue

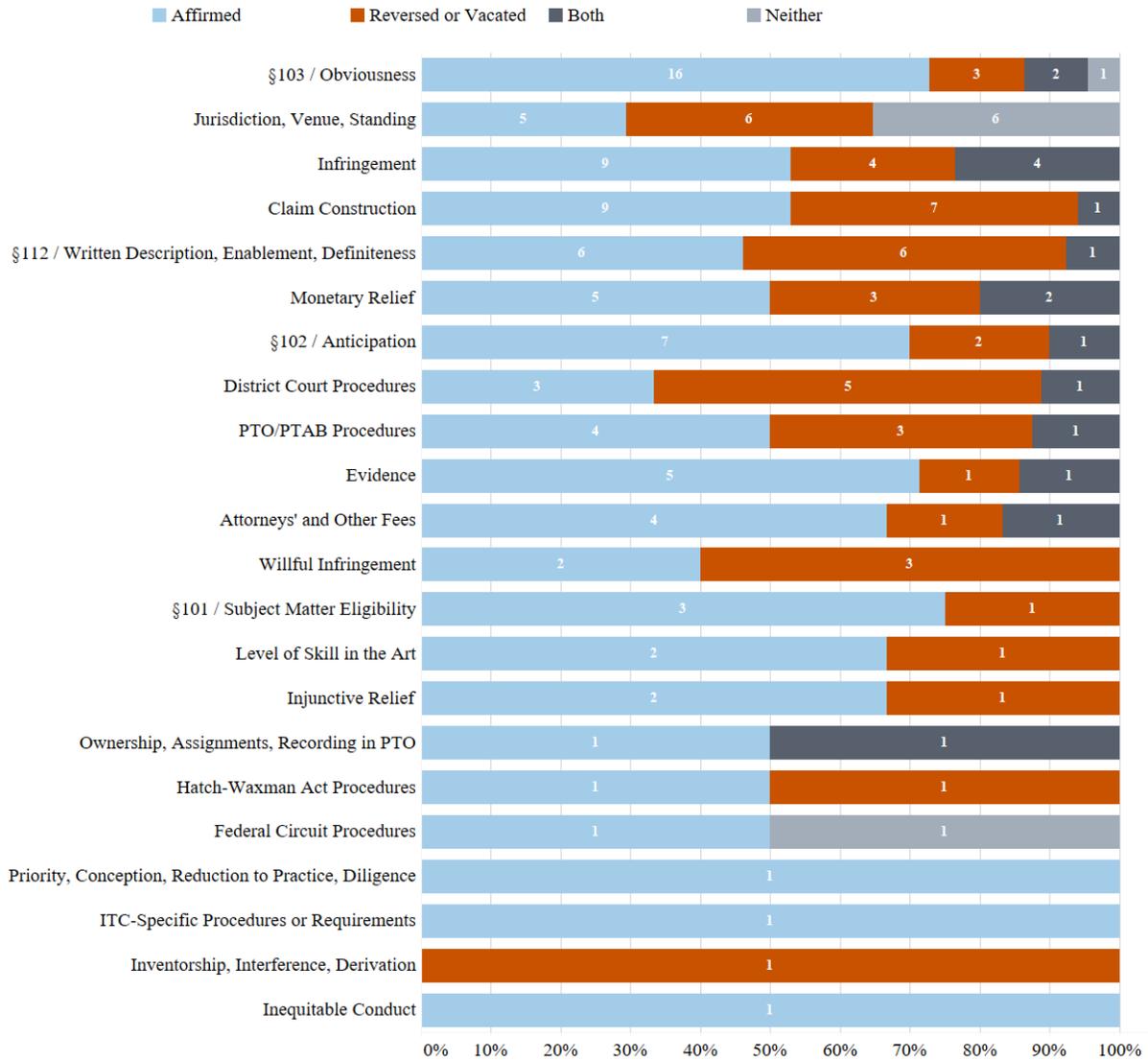


Outcome by Issue

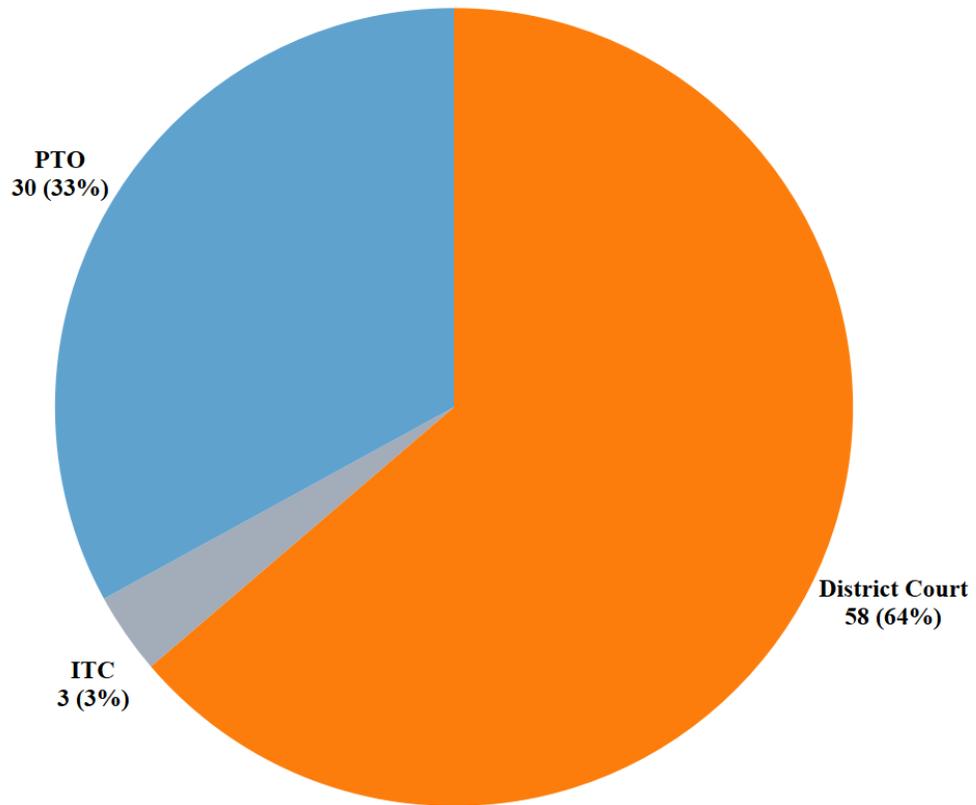


Outcome Rates by Issue

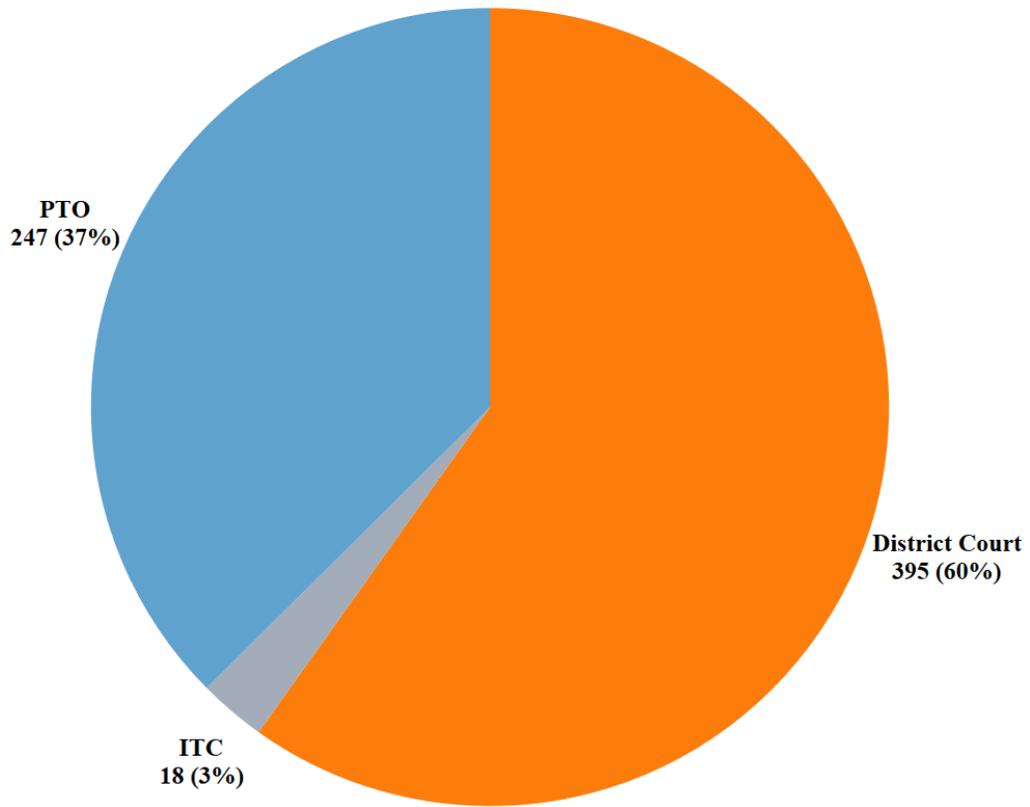
Number of Issue Outcomes Shown in Bars



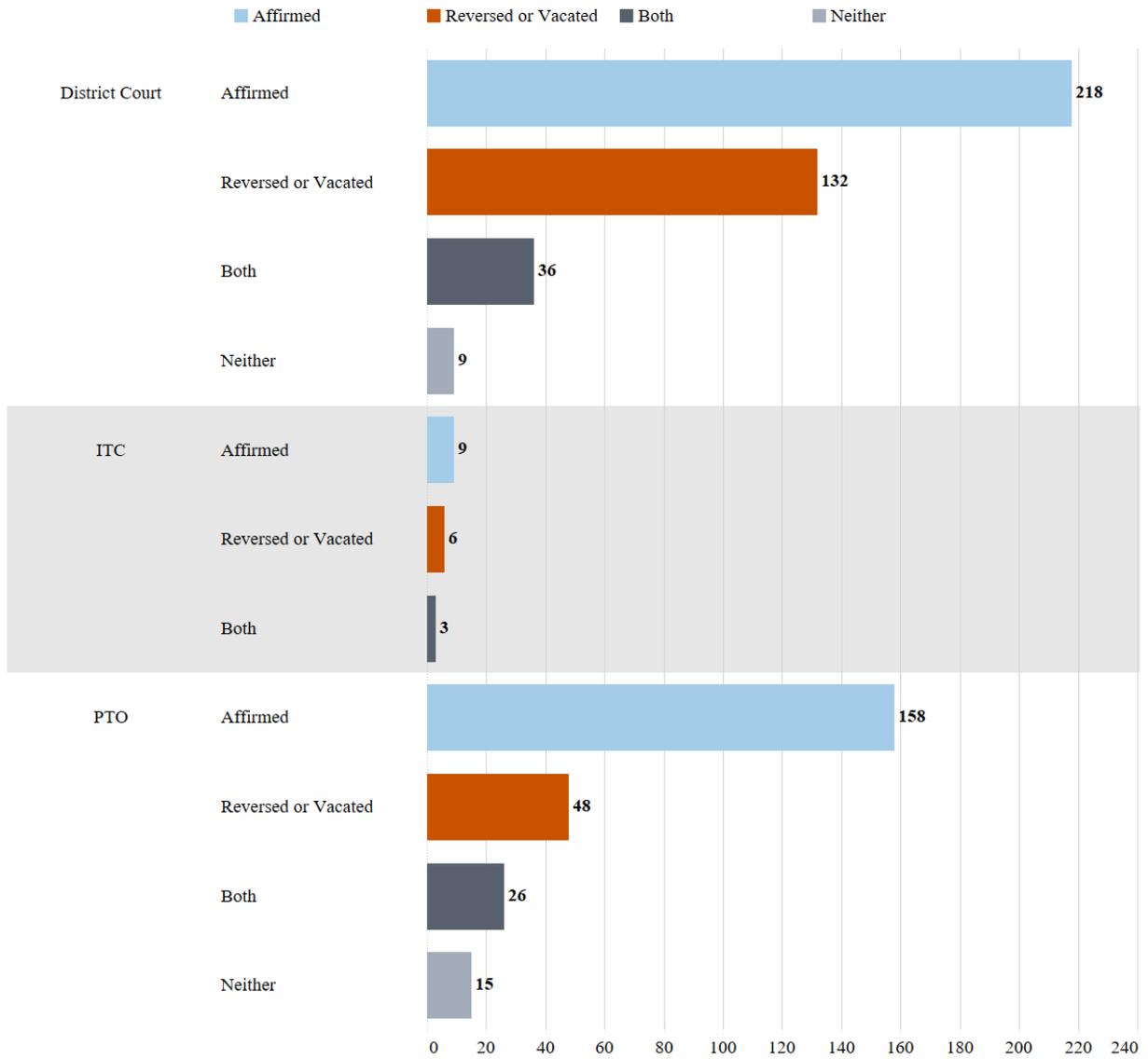
Number of Cases by Source



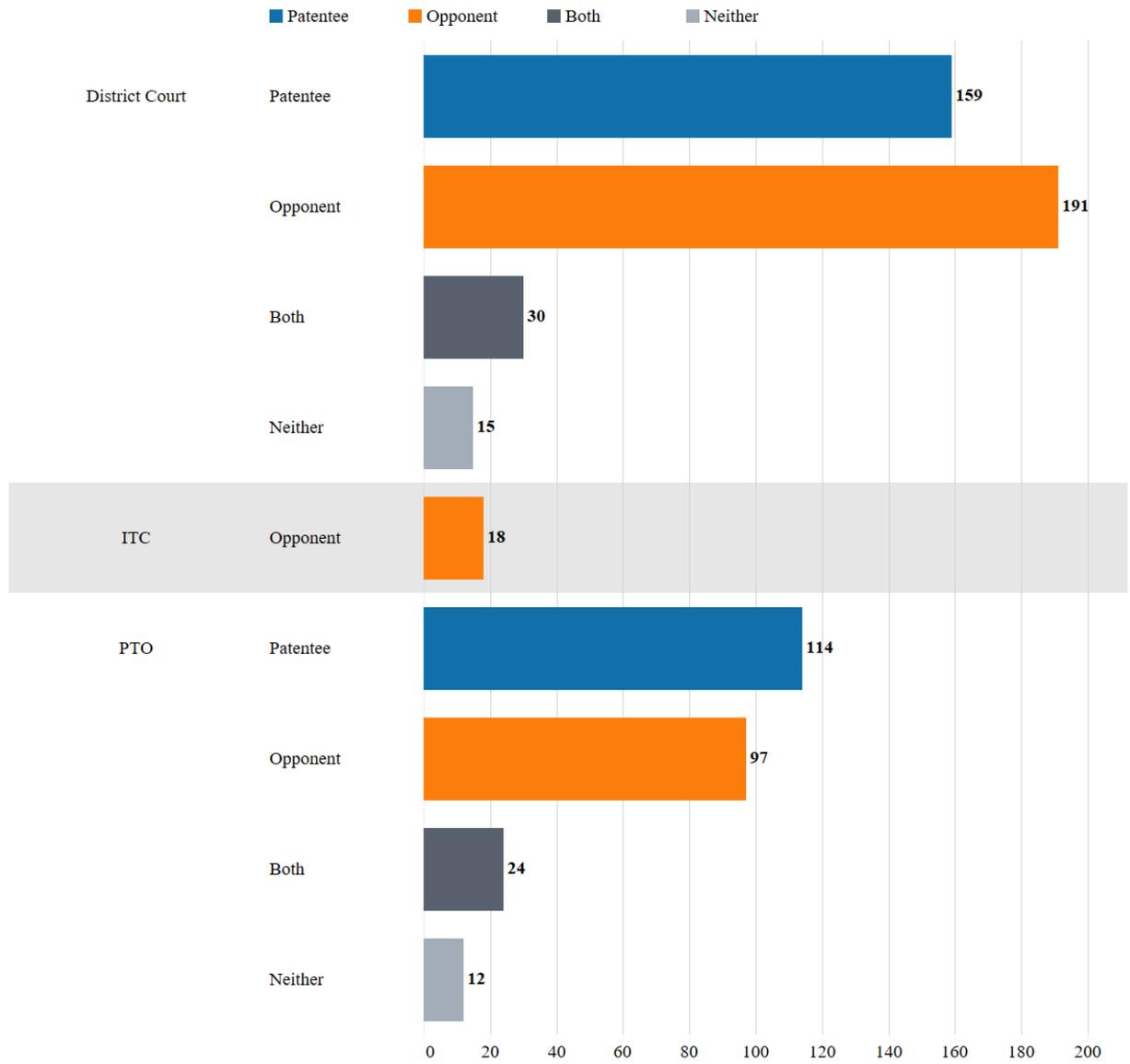
Number of Issues by Source



Outcome by Source

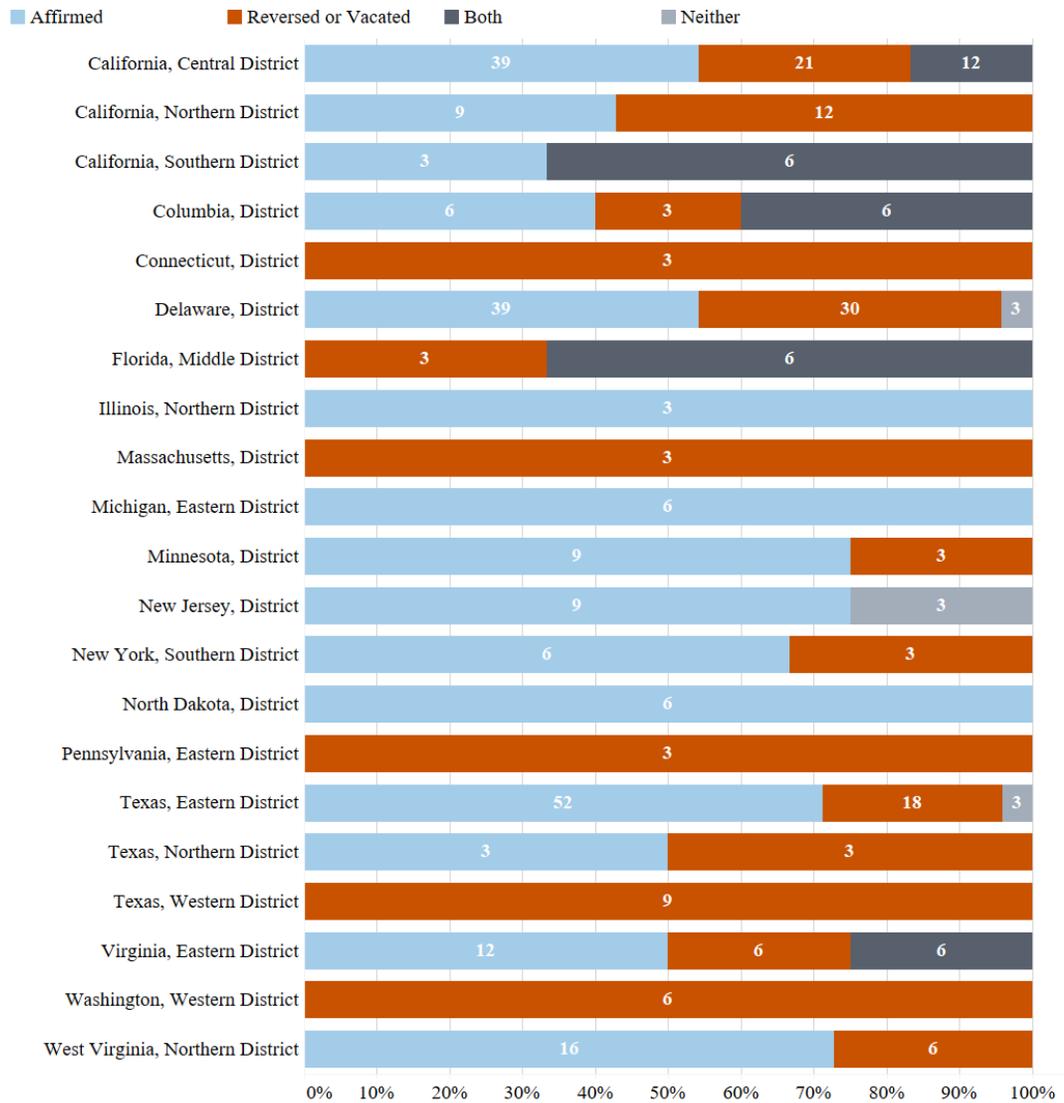


Winner by Source

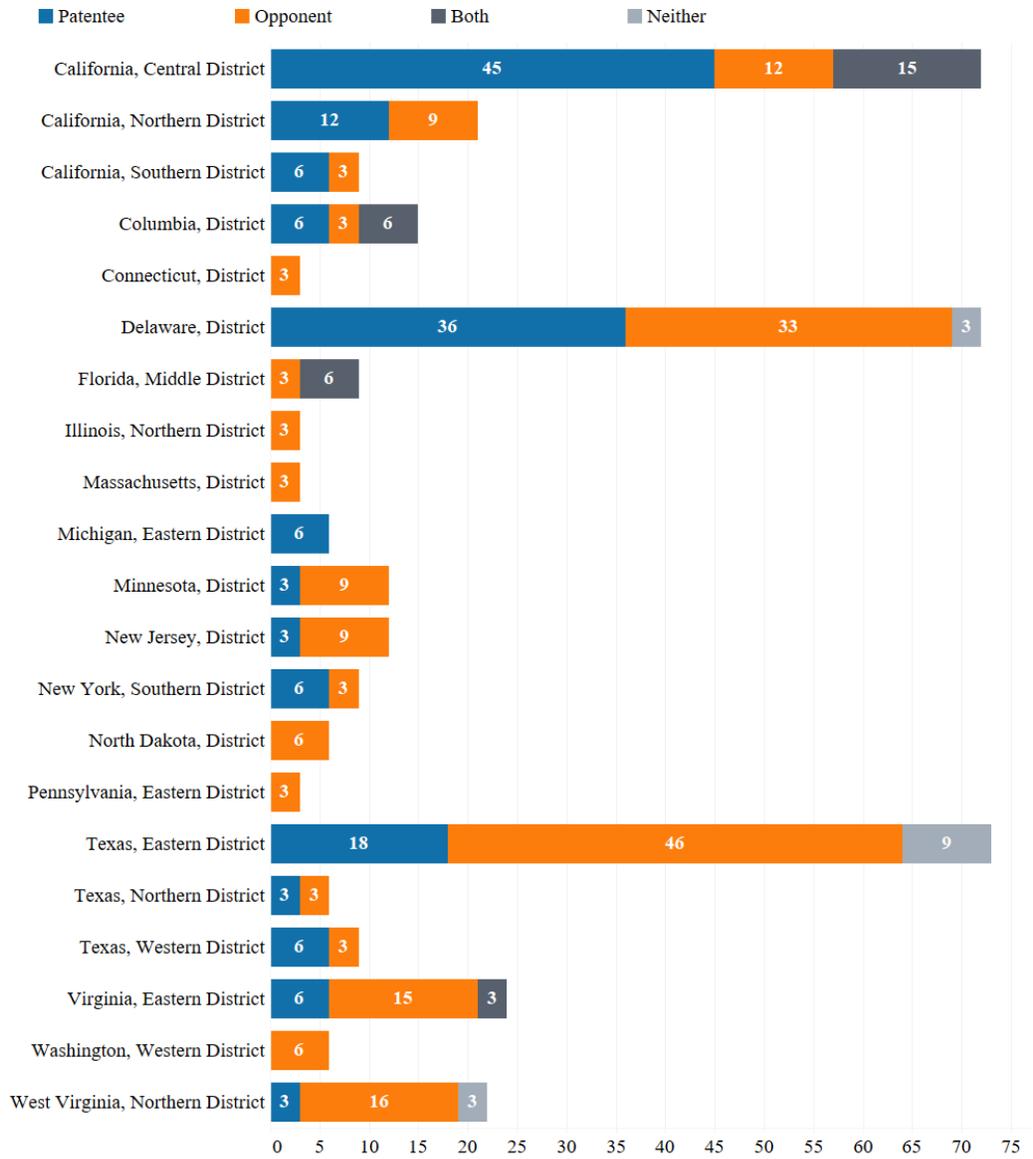


Outcome Rates by District Court

Number of Issue Outcomes Shown in Bars

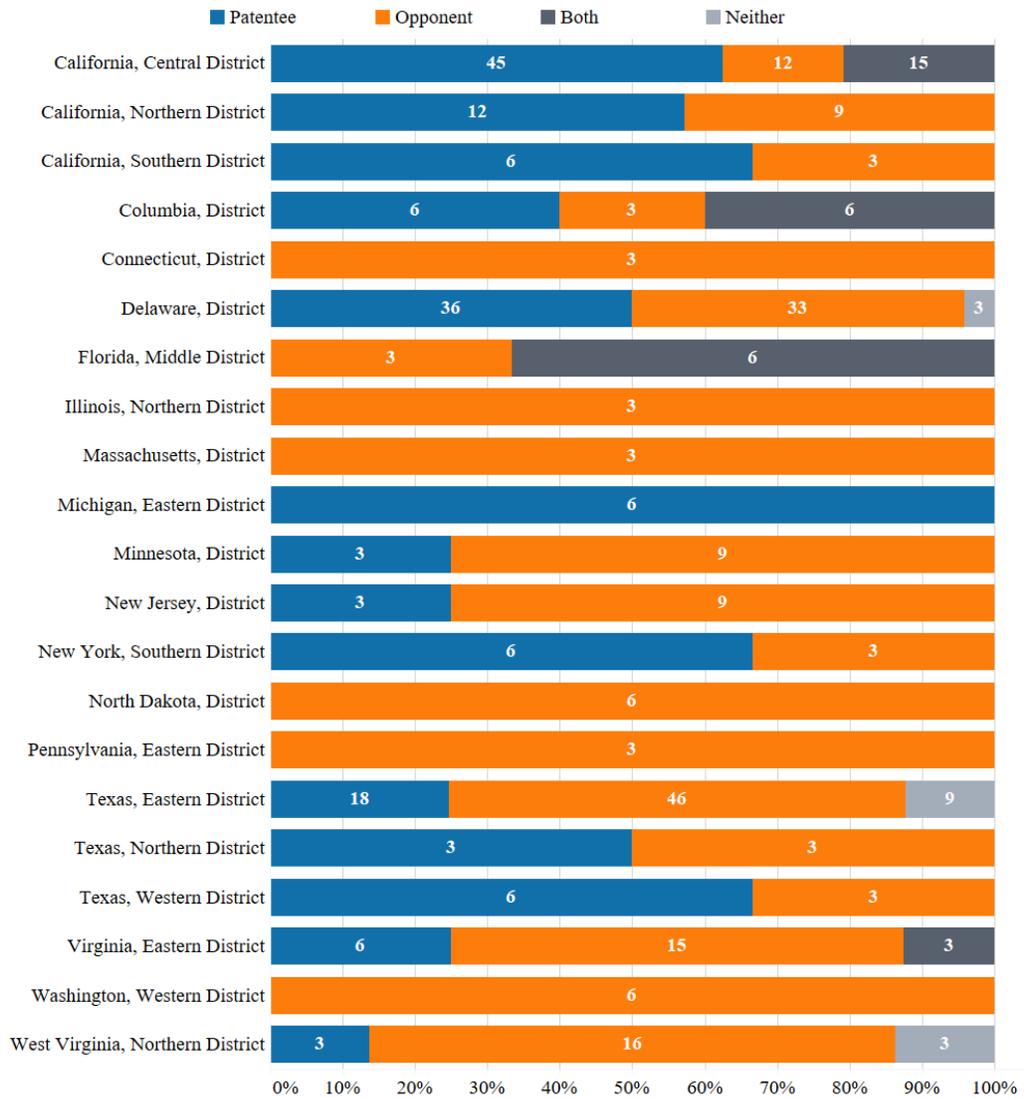


Winner by District Court



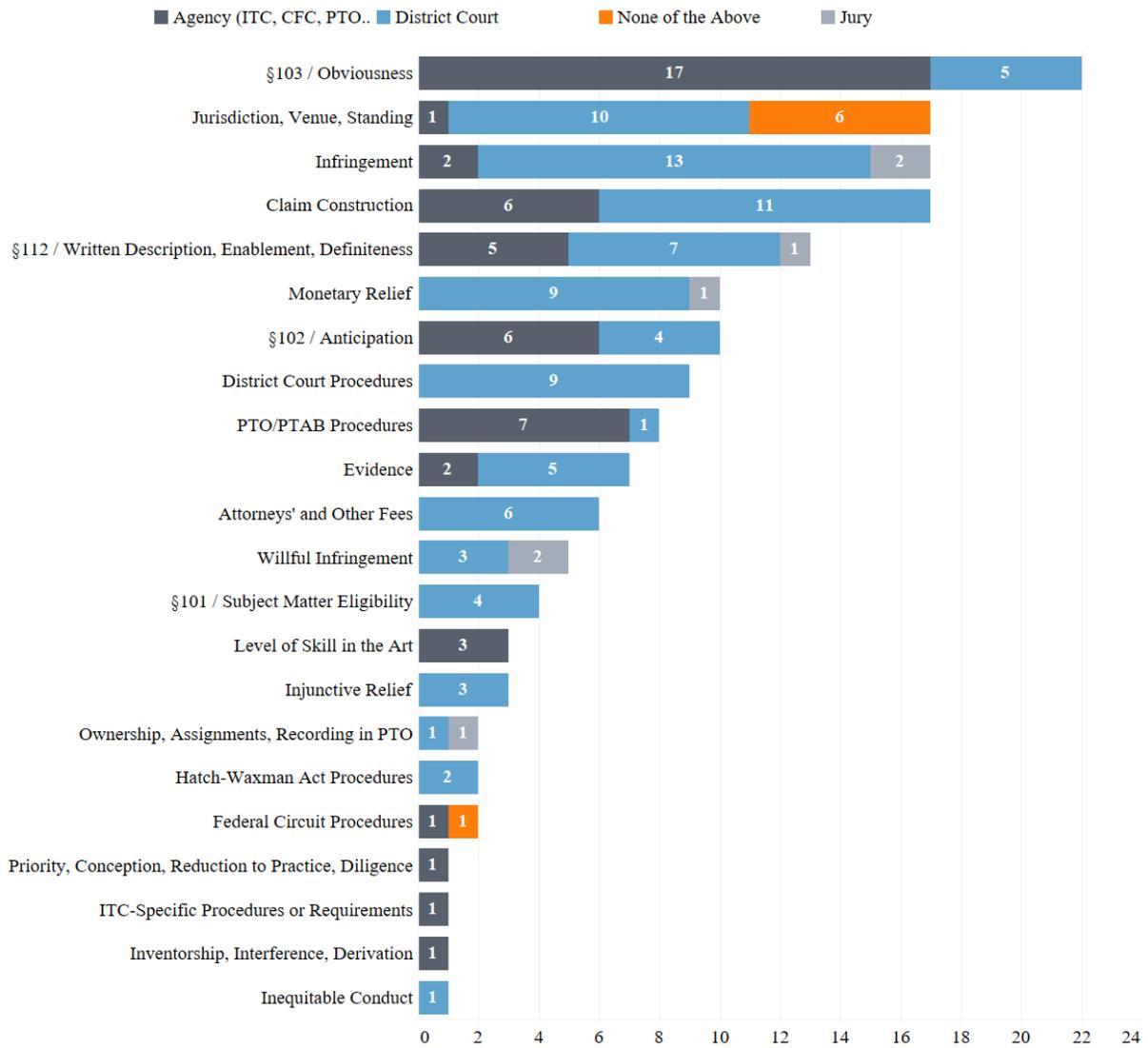
Winner Rate by District Court

Number of Issue Outcomes Shown in Bars



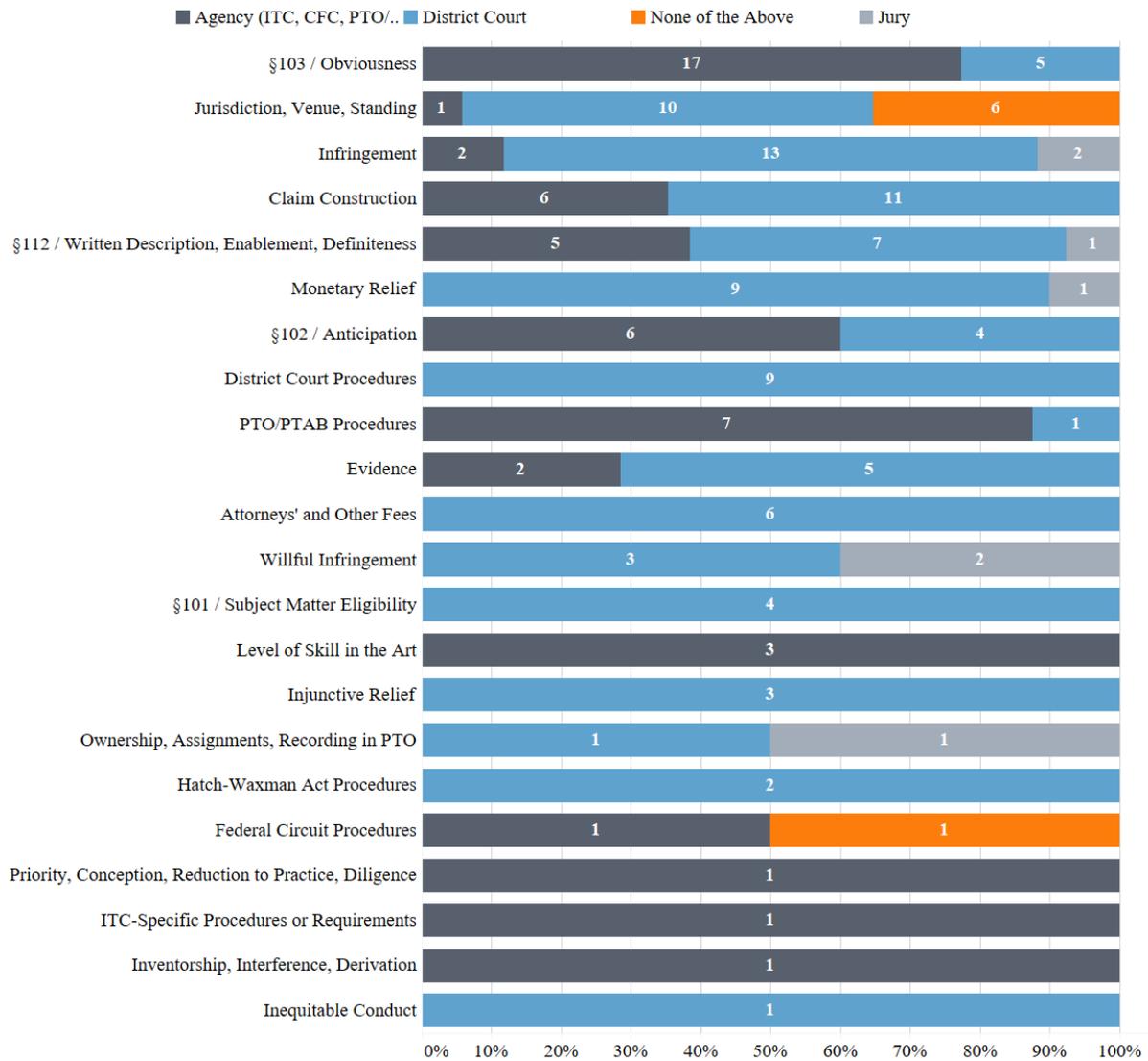
Source Breakdown by Issue

Whether Court, Agency or Jury Decided Issue Below

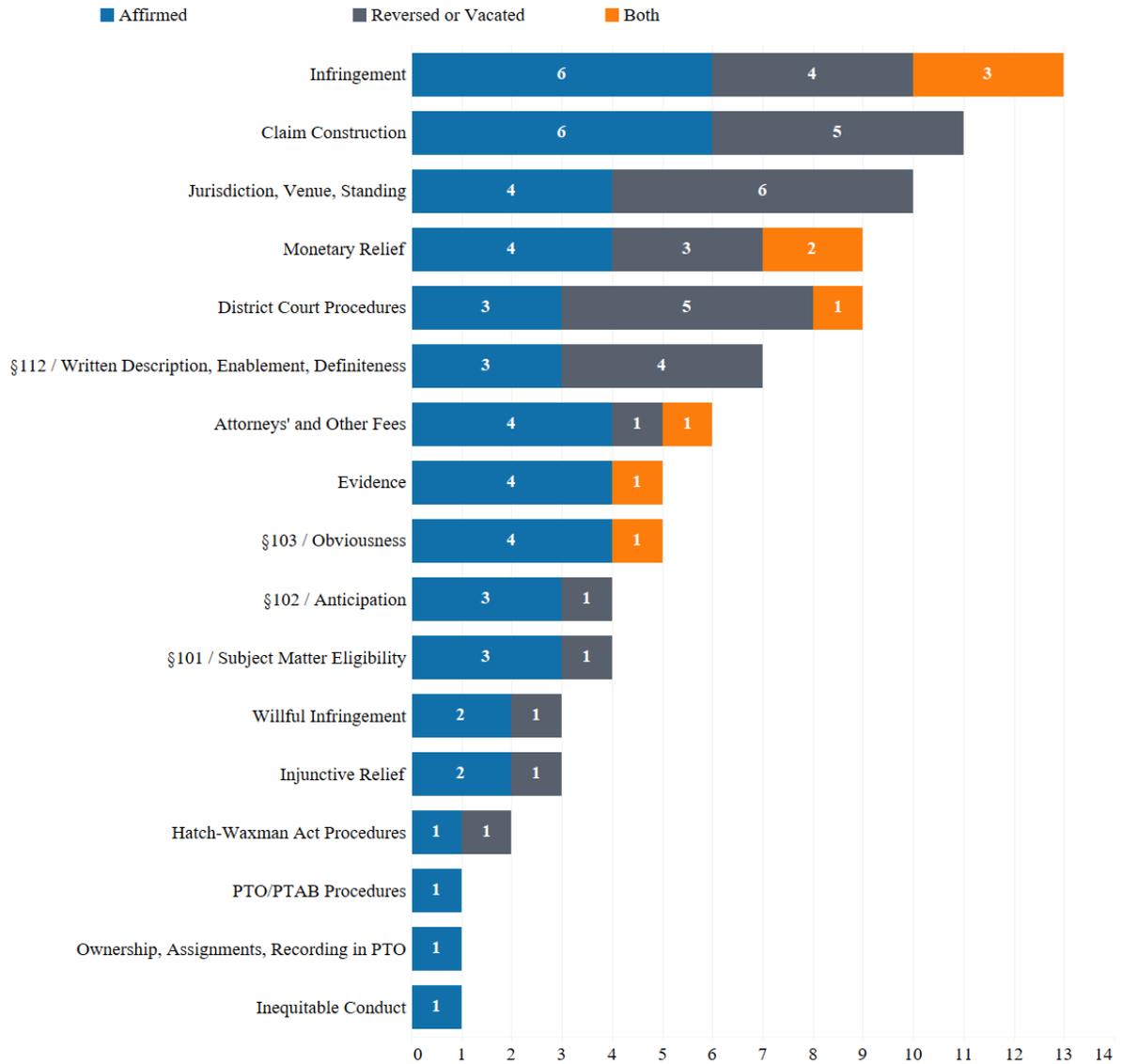


Source Breakdown by Issue, Rates

Whether Court, Agency, or Jury Decided Issue Below

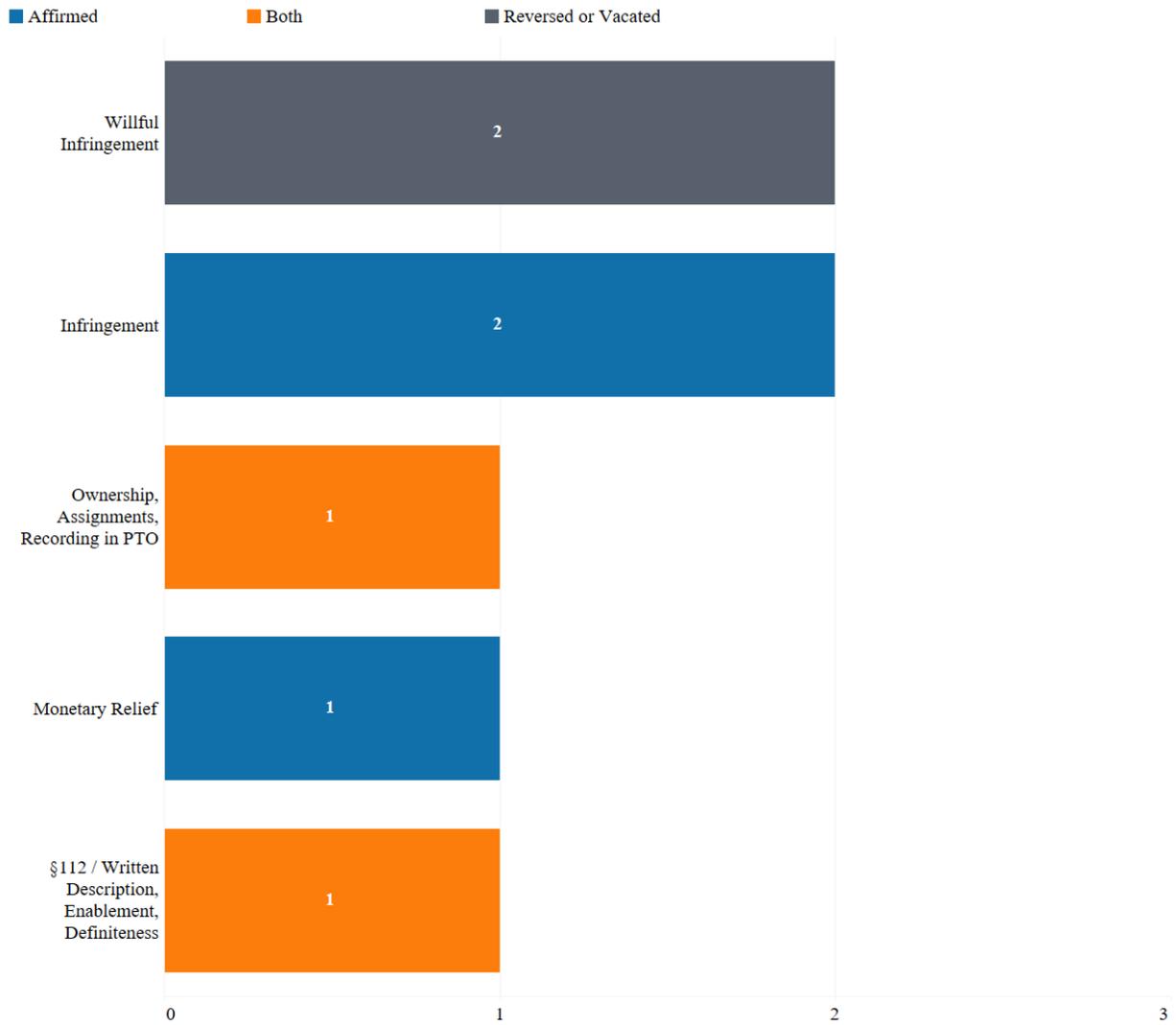


Affirmance/Reversal of Issues Decided by a Court



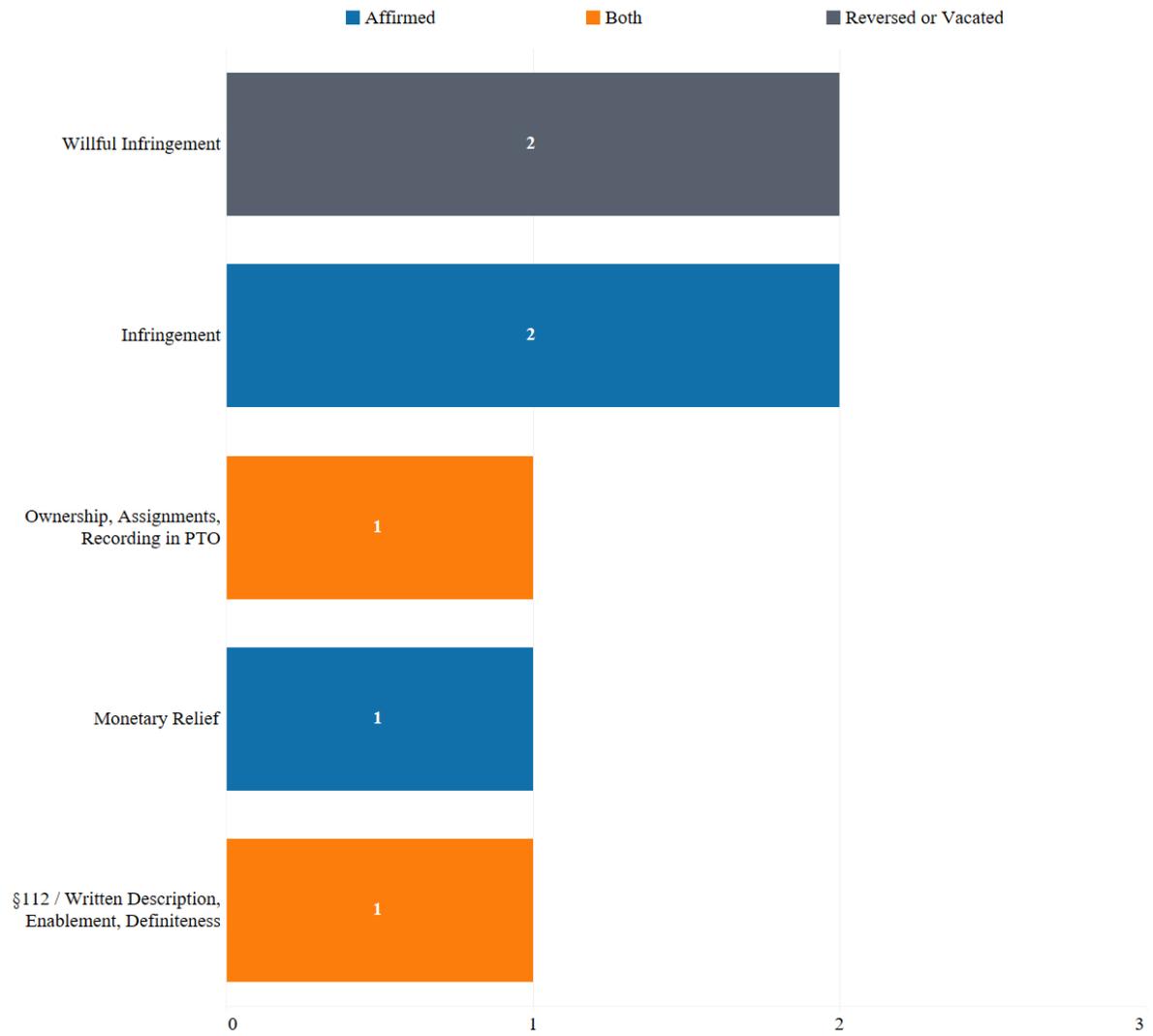


Affirmance/Reversal Of Issues Decided By A Jury





Affirmance/Reversal of Issues Decided by a Mix



INDEX BY ISSUE

I. § 101 / Subject Matter Eligibility

<i>CareDx, Inc. v. Natera, Inc.</i> 40 F.4th 1371 (Fed. Cir. 2022).....	56
<i>CosmoKey Sols. GmbH & Co. KG v. Duo Security LLC</i> 15 F.4th 1091 (Fed. Cir. 2021).....	60
<i>PersonalWeb Techs. LLC v. Google LLC</i> 8 F.4th 1310 (Fed. Cir. 2021)	92
<i>Universal Secure Registry LLC v. Apple Inc.</i> 10 F.4th 1342 (Fed. Cir. 2021).....	108

II. § 102 / Anticipation

<i>Arthrex, Inc. v. Smith & Nephew, Inc.</i> 35 F.4th 1328 (Fed. Cir. 2022).....	44
<i>BlephEx, LLC v. Myco Indus., Inc.</i> 24 F.4th 1391 (Fed. Cir. 2022).....	52
<i>CommScope Techs. LLC v. Dali Wireless Inc.</i> 10 F.4th 1289 (Fed. Cir. 2021).....	59
<i>Hunting Titan, Inc. v. DynaEnergetics Europe GmbH</i> 28 F.4th 1371 (Fed. Cir. 2022).....	68
<i>In re SurgiSil, L.L.P.</i> 14 F.4th 1380 (Fed. Cir. 2021).....	71
<i>Invidior UK Ltd. v. Dr. Reddy's Lab 'ys S.A.</i> 18 F.4th 1323 (Fed. Cir. 2021).....	76
<i>Junker v. Med. Components, Inc.</i> 25 F.4th 1027 (Fed. Cir. 2022).....	77
<i>ModernaTx, Inc. v. Arbutus Biopharma Corp.</i> 18 F.4th 1352 (Fed. Cir. 2021).....	86
<i>Valve Corp. v. Ironburg Inventions Ltd.</i> 8 F.4th 1364 (Fed. Cir. 2021)	109

III. § 103 / Obviousness

Adapt Pharma Ops. Ltd., et al. v. Teva Pharms. USA, Inc., et al.
 25 F.4th 1354 (Fed. Cir. 2022).....38

Almirall, LLC v. Amneal Pharm. LLC
 28 F.4th 265 (Fed. Cir. 2022)39

Apple Inc. v. MPH Tech. Oy
 28 F.4th 254 (Fed. Cir. 2022)41

AstraZeneca AB v. Mylan Pharms. Inc.
 19 F.4th 1325 (Fed. Cir. 2021).....45

Auris Health, Inc. v. Intuitive Surgical Operations, Inc.
 32 F.4th 1154 (Fed. Cir. 2022).....47

BlephEx, LLC v. Myco Indus., Inc.
 24 F.4th 1391 (Fed. Cir. 2022).....52

Broadcom Corp. v. ITC
 28 F.4th 240 (Fed. Cir. 2022)53

Cal. Inst. of Tech. v. Broadcom Ltd.,
 25 F.4th 976 (Fed. Cir. 2022)54

Campbell Soup Co. v. Gamon Plus, Inc.
 10 F.4th 1268 (Fed. Cir. 2021).....55

Eli Lilly and Co. v. Teva Pharm.
 8 F.4th 1331 (Fed. Cir. 2021)62

Fleming v. Cirrus Design Corp.
 28 F.4th 1214 (Fed. Cir. 2022).....64

Hunting Titan, Inc. v. DynaEnergetics Europe GmbH
 28 F.4th 1371 (Fed. Cir. 2022).....68

Intel Corp. v. Qualcomm Inc.
 21 F.4th 784 (Fed. Cir. 2021)74

LG Elecs. Inc. v. Immervision, Inc.
 39 F.4th 1364 (Fed. Cir. 2022).....80

ModernaTx, Inc. v. Arbutus Biopharma Corp.
 18 F.4th 1364 (Fed. Cir. 2021).....85

ModernaTx, Inc. v. Arbutus Biopharma Corp.
 18 F.4th 1352 (Fed. Cir. 2021).....86

<i>Qualcomm Inc. v. Apple Inc.</i> 24 F.4th 1367 (Fed. Cir. 2022).....	94
<i>Quanergy Sys., Inc. v. Velodyne Lidar USA, Inc.</i> 24 F.4th 1406 (Fed. Cir. 2022).....	95
<i>Teva Pharm. Int’l GmbH v. Eli Lilly & Co.</i> 8 F.4th 1349 (Fed. Cir. 2021)	100
<i>Teva Pharms. USA, Inc. v. Corcept Therapeutics, Inc.</i> 18 F.4th 1377 (Fed. Cir. 2021).....	102
<i>Univ. of Strathclyde v. Clear-Vu Lighting LLC</i> 17 F.4th 155 (Fed. Cir. 2021)	107

IV. § 112 / Written Description, Enablement, Definiteness

<i>Arthrex, Inc. v. Smith & Nephew, Inc.</i> 35 F.4th 1328 (Fed. Cir. 2022).....	44
<i>BASF Plant Sci., LP v. Commonwealth Sci. Indus. Rsch. Org.</i> 28 F.4th 1247 (Fed. Cir. 2022).....	47
<i>Biogen Int’l GmbH v. Mylan Pharms. Inc.</i> 28 F.4th 1194 (Fed. Cir. 2021).....	50
<i>Biogen Int’l GmbH v. Mylan Pharms. Inc.</i> 18 F.4th 1333 (Fed. Cir. 2021).....	51
<i>ClearOne, Inc. v. Shure Acquisition Holdings</i> 35 F.4th 1345 (Fed. Cir. 2022).....	58
<i>Intel Corp. v. Qualcomm Inc.</i> 21 F.4th 801 (Fed. Cir. 2021)	74
<i>Invidior UK Ltd. v. Dr. Reddy’s Lab’ys S.A.</i> 18 F.4th 1323 (Fed. Cir. 2021).....	76
<i>Juno Therapeutics, Inc. v. Kite Pharma, Inc.</i> 10 F.4th 1330 (Fed. Cir. 2021).....	77
<i>Kyocera Senco Indus. Tools Inc. v. Int’l Trade Comm’n</i> 22 F.4th 1369 (Fed. Cir. 2022).....	79
<i>Niazi Licensing Corp. v. St. Jude Med. SC, Inc.</i> 30 F.4th 1339 (Fed. Cir. 2022).....	88
<i>Univ. of Mass. v. L’Oréal S.A.</i> 36 F.4th 1374 (Fed. Cir. 2022).....	105

V. Claim Construction

<i>Acceleration Bay LLC v. 2K Sports, Inc.</i> 25 F.4th 1069 (Fed. Cir. 2021).....	37
<i>Apple Inc. v. Wi-LAN Inc.</i> 25 F.4th 960 (Fed. Cir. 2022)	43
<i>AstraZeneca AB v. Mylan Pharms. Inc.</i> 19 F.4th 1325 (Fed. Cir. 2021).....	45
<i>Genuine Enabling Tech. v. Nintendo Co., Ltd.</i> 29 F.4th 1365 (Fed. Cir. 2022).....	65
<i>Intel Corp. v. Qualcomm Inc.</i> 21 F.4th 784 (Fed. Cir. 2021)	74
<i>Intel Corp. v. Qualcomm Inc.</i> 21 F.4th 801 (Fed. Cir. 2021)	74
<i>Kaufman v. Microsoft Corp.</i> 34 F.4th 1360 (Fed. Cir. 2022).....	79
<i>Kyocera Senco Indus. Tools Inc. v. Int’l Trade Comm’n</i> 22 F.4th 1369 (Fed. Cir. 2022).....	79
<i>Littelfuse, Inc. v. Mersen USA EP Corp.</i> 29 F.4th 1376 (Fed. Cir. 2022).....	81
<i>Nature Simulation Sys. Inc. v. Autodesk, Inc.</i> 23 F.4th 1334 (Fed. Cir. 2022).....	87
<i>Omega Pats., LLC v. CalAmp Corp.</i> 13 F.4th 1361 (Fed. Cir. 2021).....	90
<i>Pavo Sols. LLC v. Kingston Tech. Co.</i> 35 F.4th 1367 (Fed. Cir. 2022).....	92
<i>Quanergy Sys., Inc. v. Velodyne Lidar USA, Inc.</i> 24 F.4th 1406 (Fed. Cir. 2022).....	95
<i>Seabed Geosolutions (US) Inc. v. Magseis FF LLC</i> 8 F.4th 1285 (Fed. Cir. 2021)	97
<i>Sound View Innovations, LLC v. Hulu, LLC</i> 33 F.4th 1326 (Fed. Cir. 2022).....	98
<i>Traxcell Tech., LLC v. Nokia Sols. & Networks</i> 15 F.4th 1136 (Fed. Cir. 2021).....	102

<i>Traxcell Techs., LLC v. Sprint Commc'ns Co.</i> 15 F.4th 1121 (Fed. Cir. 2021).....	103
<i>Valve Corp. v. Ironburg Inventions Ltd.</i> 8 F.4th 1364 (Fed. Cir. 2021)	109
VI. Infringement	
<i>Acceleration Bay LLC v. 2K Sports, Inc.</i> 15 F.4th 1069 (Fed. Cir. 2021).....	37
<i>Apple Inc. v. Wi-LAN Inc.</i> 25 F.4th 960 (Fed. Cir. 2022)	43
<i>AstraZeneca AB v. Mylan Pharms. Inc.</i> 19 F.4th 1325 (Fed. Cir. 2021).....	45
<i>Broadcom Corp. v. Int'l Trade Comm'n</i> 28 F.4th 240 (Fed. Cir. 2022)	53
<i>Cal. Inst. of Tech. v. Broadcom Ltd.,</i> 25 F.4th 976 (Fed. Cir. 2022)	54
<i>CommScope Techs. LLC v. Dali Wireless Inc.</i> 10 F.4th 1289 (Fed. Cir. 2021).....	59
<i>Data Engine Techs. LLC v. Google LLC</i> 10 F.4th 1375 (Fed. Cir. 2021).....	61
<i>Evolution Concepts, Inc. v. HOC Events, Inc.</i> 22 F.4th 1361 (Fed. Cir. 2022).....	64
<i>Lubby Holdings, LLC v. Chung</i> 11 F.4th 1355 (Fed. Cir. 2021).....	81
<i>Mobility Workx, LLC v. Unified Patents, LLC</i> 15 F.4th 1136 (Fed. Cir. 2021).....	84
<i>Omega Pats., LLC v. CalAmp Corp.</i> 13 F.4th 1361 (Fed. Cir. 2021).....	90
<i>Roche Diagnostics Corp. v. Meso Scale Diagnostics, LLC</i> 30 F.4th 1109 (Fed. Cir. 2022).....	96
<i>Sound View Innovations, LLC v. Hulu, LLC</i> 33 F.4th 1326 (Fed. Cir. 2022).....	98
<i>SRI Int'l, Inc. v. Cisco Sys. Inc.</i> 14 F.4th 1323 (Fed. Cir. 2021).....	98

<i>Traxcell Tech., LLC v. Nokia Sols. & Networks</i> 15 F.4th 1136 (Fed. Cir. 2021).....	102
<i>Traxcell Techs., LLC v. Sprint Commc'ns Co.</i> 15 F.4th 1121 (Fed. Cir. 2021).....	103
<i>Universal Secure Registry LLC v. Apple Inc.</i> 10 F.4th 1342 (Fed. Cir. 2021).....	108
VII. Willful Infringement	
<i>GlaxoSmithKline LLC v. Teva Pharms. USA, Inc.</i> 7 F.4th 1320 (Fed. Cir. 2021)	65
<i>Niazi Licensing Corp. v. St. Jude Med. SC, Inc.</i> 30 F.4th 1339 (Fed. Cir. 2022).....	88
<i>Pavo Sols. LLC v. Kingston Tech. Co.</i> 35 F.4th 1367 (Fed. Cir. 2022).....	92
<i>Roche Diagnostics Corp. v. Meso Scale Diagnostics, LLC</i> 30 F.4th 1109 (Fed. Cir. 2022).....	96
<i>SRI Int'l, Inc. v. Cisco Sys. Inc.</i> 14 F.4th 1323 (Fed. Cir. 2021).....	98
VIII. Injunctive Relief	
<i>BASF Plant Sci., LP v. Commonwealth Sci. Indus. Rsch. Org.</i> 28 F.4th 1247 (Fed. Cir. 2022).....	47
<i>Koninklijke Philips N.V. v. Thales USA, Inc.</i> 39 F.4th 1377 (Fed. Cir. 2022).....	79
<i>Mitek Sys., Inc. v. United Services Auto. Ass'n</i> 34 F.4th 1334 (Fed. Cir. 2022).....	82
<i>Nippon Shinyaku Co., Ltd. v. Sarepta Therapeutics, Inc.</i> 25 F.4th 998 (Fed. Cir. 2022)	89
IX. Monetary Relief	
<i>Apple Inc. v. Wi-LAN Inc.</i> 25 F.4th 960 (Fed. Cir. 2022)	43
<i>BASF Plant Sci., LP v. Commonwealth Sci. Indus. Rsch. Org.</i> 28 F.4th 1247 (Fed. Cir. 2022).....	47

<i>Energy Heating, LLC v. Heat On-The-Fly, LLC</i> 15 F.4th 1348 (Fed. Cir. 2021).....	63
<i>GlaxoSmithKline LLC v. Teva Pharms. USA, Inc.</i> 7 F.4th 1320 (Fed. Cir. 2021)	65
<i>Hyatt v. Hirshfeld</i> 16 F.4th 855 (Fed. Cir. 2021)	69
<i>Kaufman v. Microsoft Corp.</i> 34 F.4th 1360 (Fed. Cir. 2022).....	79
<i>Lubby Holdings, LLC v. Chung</i> 11 F.4th 1355 (Fed. Cir. 2021).....	81
<i>Omega Pats., LLC v. CalAmp Corp.</i> 13 F.4th 1361 (Fed. Cir. 2021).....	90
<i>Pavo Sols. LLC v. Kingston Tech. Co.</i> 35 F.4th 1367 (Fed. Cir. 2022).....	92
<i>Sunoco Partners Marketing v. U.S. Venture, Inc.</i> 32 F.4th 1161 (Fed. Cir. 2022).....	99
X. Inequitable Conduct	
<i>Belcher Pharms., LLC v. Hospira, Inc.</i> 11 F.4th 1345 (Fed. Cir. 2021).....	49
XI. Ownership, Assignments, Recording in PTO	
<i>BASF Plant Sci., LP v. Commonwealth Sci. Indus. Rsch. Org.</i> 28 F.4th 1247 (Fed. Cir. 2022).....	47
<i>Omni MedSci, Inc. v. Apple Inc.</i> 7 F.4th 1148 (Fed. Cir. 2021)	91
XII. Inventorship, Interference, Derivation	
<i>Google LLC v. IPA Techs. Inc.</i> 34 F.4th 1081 (Fed. Cir. 2022).....	67



XIII. PTO Procedures

Arthrex, Inc. v. Smith & Nephew, Inc.
 35 F.4th 1328 (Fed. Cir. 2022).....44

Cal. Inst. of Tech. v. Broadcom Ltd.,
 25 F.4th 976 (Fed. Cir. 2022)54

In re Maxpower Semiconductor, Inc.
 13 F.4th 1348 (Fed. Cir. 2021).....71

In Re VIVINT, INC.
 14 F.4th 1342 (Fed. Cir. 2021).....72

Intuitive Surgical, Inc. v. Ethicon LLC
 25 F.4th 1035 (Fed. Cir. 2022).....75

Mobility Workx, LLC v. Unified Patents, LLC
 15 F.4th 1136 (Fed. Cir. 2021).....84

Qualcomm Inc. v. Apple Inc.
 24 F.4th 1367 (Fed. Cir. 2022).....94

Valve Corp. v. Ironburg Inventions Ltd.
 8 F.4th 1364 (Fed. Cir. 2021)109

XIV. ITC-Specific Procedures or Requirements

DBN Holding, Inc. v. Int’l Trade Comm’n
 26 F.4th 1363 (Fed. Cir. 2022).....61

XV. District Court Procedures

Andra Grp., LP v. Victoria’s Secret Stores, LLC
 6 F.4th 1283 (Fed. Cir. 2021)40

BASF Plant Sci., LP v. Commonwealth Sci. Indus. Rsch. Org.
 28 F.4th 1247 (Fed. Cir. 2022).....47

Centripetal Networks, Inc. v. Cisco Sys., Inc.
 38 F.4th 1025 (Fed. Cir. 2022).....57

In re Juniper Networks, Inc.
 14 F.4th 1313 (Fed. Cir. 2021).....70

Lubby Holdings, LLC v. Chung
 11 F.4th 1355 (Fed. Cir. 2021).....81

<i>Mitek Sys., Inc. v. United Services Auto. Ass'n</i> 34 F.4th 1334 (Fed. Cir. 2022).....	82
<i>Roche Diagnostics Corp. v. Meso Scale Diagnostics, LLC</i> 30 F.4th 1109 (Fed. Cir. 2022).....	96
<i>Uniloc USA, Inc. v. Apple Inc.</i> 25 F.4th 1018 (Fed. Cir. 2022).....	104
<i>Valve Corp. v. Ironburg Inventions Ltd.</i> 8 F.4th 1364 (Fed. Cir. 2021)	109

XVI. Jurisdiction, Venue, Standing

<i>Acceleration Bay LLC v. 2K Sports, Inc.</i> 15 F.4th 1069 (Fed. Cir. 2021).....	37
<i>Alarm.com Inc. v. Hirshfeld</i> 26 F.4th 1348 (Fed. Cir. 2022).....	38
<i>Andra Grp., LP v. Victoria's Secret Stores, LLC</i> 6 F.4th 1283 (Fed. Cir. 2021)	40
<i>Apple Inc. v. Qualcomm Inc.</i> 17 F.4th 1131 (Fed. Cir. 2021).....	42
<i>Apple Inc. v. Zipit Wireless, Inc.</i> 30 F.3th 1368 (Fed. Cir. 2022).....	43
<i>Atlanta Gas Light Co. v. Bennett Regulator Guards, Inc.</i> 33 F.4th 1348 (Fed. Cir. 2022).....	46
<i>BASF Plant Sci., LP v. Commonwealth Sci. Indus. Rsch. Org.</i> 28 F.4th 1247 (Fed. Cir. 2022).....	47
<i>Celgene Corp. v. Mylan Pharms. Inc.</i> 17 F.4th 1111 (Fed. Cir. 2021).....	56
<i>In re Juniper Networks, Inc.</i> 14 F.4th 1313 (Fed. Cir. 2021).....	70
<i>In re Volkswagen Grp. of Am., Inc.</i> 28 F.4th 1203 (Fed. Cir. 2022).....	73
<i>Intel Corp. v. Qualcomm Inc.</i> 21 F.4th 784 (Fed. Cir. 2021)	74
<i>Kannuu Pty Ltd. v. Samsung Elecs. Co.</i> 15 F.4th 1101 (Fed. Cir. 2021).....	78

<i>Mitek Sys., Inc. v. United Services Auto. Ass’n</i> 34 F.4th 1334 (Fed. Cir. 2022).....	82
<i>ModernaTx, Inc. v. Arbutus Biopharma Corp.</i> 18 F.4th 1364 (Fed. Cir. 2021).....	85
<i>PlasmaCAM, INC. v. Cncelectronics, LLC</i> 24 F.4th 1378 (Fed. Cir. 2022).....	93
<i>Univ. of S. Fla. Rsch. Found., Inc. v. Fujifilm Med. Sys. U.S.A., Inc.</i> 19 F.4th 1315 (Fed. Cir. 2021).....	106
<i>Valve Corp. v. Ironburg Inventions Ltd.</i> 8 F.4th 1364 (Fed. Cir. 2021)	109
 XVII. Federal Circuit Procedures	
<i>Arthrex, Inc. v. Smith & Nephew, Inc.</i> 35 F.4th 1328 (Fed. Cir. 2022).....	44
<i>In re Violation of the Revised Protocols for In-Person Arguments & Related Order</i> 26 F.4th 1270 (Fed. Cir. 2022).....	72
<i>Mondis Tech. Ltd. v. LG Elecs. Inc.</i> 6 F.4th 1379 (Fed. Cir. 2021)	86
 XVIII. Hatch-Waxman Act Procedures	
<i>Celgene Corp. v. Mylan Pharms. Inc.</i> 17 F.4th 1111 (Fed. Cir. 2021).....	56
<i>GlaxoSmithKline LLC v. Teva Pharms. USA, Inc.</i> 25 F.4th 949 (Fed. Cir. 2022)	67
 XIX. Evidence	
<i>Hunting Titan, Inc. v. DynaEnergetics Europe GmbH</i> 28 F.4th 1371 (Fed. Cir. 2022).....	68
<i>Kyocera Senco Indus. Tools Inc. v. Int’l Trade Comm’n</i> 22 F.4th 1369 (Fed. Cir. 2022).....	79
<i>MLC Intell. Prop., LLC v. Micron Tech., Inc.</i> 10 F.4th 1358 (Fed. Cir. 2021).....	83
<i>Niazi Licensing Corp. v. St. Jude Med. SC, Inc.</i> 30 F.4th 1339 (Fed. Cir. 2022).....	88

<i>Omega Pats., LLC v. CalAmp Corp.</i> 13 F.4th 1361 (Fed. Cir. 2021).....	90
<i>Pavo Sols. LLC v. Kingston Tech. Co.</i> 35 F.4th 1367 (Fed. Cir. 2022).....	92
<i>Sound View Innovations, LLC v. Hulu, LLC</i> 33 F.4th 1326 (Fed. Cir. 2022).....	98
XX. Level of Skill in the Art	
<i>Almirall, LLC v. Amneal Pharm. LLC</i> 28 F.4th 265 (Fed. Cir. 2022)	39
<i>Arthrex, Inc. v. Smith & Nephew, Inc.</i> 35 F.4th 1328 (Fed. Cir. 2022).....	44
<i>Auris Health, Inc. v. Intuitive Surgical Operations, Inc.</i> 32 F.4th 1154 (Fed. Cir. 2022).....	47
XXI. Attorneys' and Other Fees	
<i>Energy Heating, LLC v. Heat On-The-Fly, LLC</i> 15 F.4th 1348 (Fed. Cir. 2021).....	63
<i>Hyatt v. Hirshfeld</i> 16 F.4th 855 (Fed. Cir. 2021)	69
<i>Niazi Licensing Corp. v. St. Jude Med. SC, Inc.</i> 30 F.4th 1339 (Fed. Cir. 2022).....	88
<i>Realtime Adaptive Streaming LLC v. Netflix, Inc.</i> 41 F.4th 1372 (Fed. Cir. 2022).....	96
<i>SRI Int'l, Inc. v. Cisco Sys. Inc.</i> 14 F.4th 1323 (Fed. Cir. 2021).....	98
XXII. Priority, Conception, Reduction to Practice, Diligence	
<i>Invidior UK Ltd. v. Dr. Reddy's Lab'ys S.A.</i> 18 F.4th 1323 (Fed. Cir. 2021).....	76

CASE SUMMARIES

Acceleration Bay LLC v. 2K Sports, Inc.

15 F.4th 1069 (Fed. Cir. 2021)

In this appeal from the District of Delaware, the Federal Circuit affirmed the district court's grant of summary judgment of noninfringement with respect to two of the patents at issue (the '069 and '497 patents) and found the appeal moot with respect to the other two patents at issue (the '344 and '966 patents).

Acceleration Bay sued 2K Sports, Inc., Rockstar Games, Inc., and Take-Two Interactive Software, Inc. in the U.S. District Court for the District of Delaware for patent infringement, alleging that the software of certain video games infringed its patents. Four patents that were held by Acceleration Bay and describe a networking technology broadcast technique were at issue in this appeal. The claims at issue from the '344 and '966 patents describe the virtual network itself; those from the '069 patent describe how participants are added to the network; and those from the '497 patent describe how the network uses a call-in port. The district court construed certain terms relevant to the claims and granted summary judgment of noninfringement for all four patents. The district court held that the '344 and '966 patents were not infringed because the customer, not the accused infringer, performed the final step to assemble the system. The district court also held that Take Two did not satisfy the '497 patent's "component" limitation, which was construed as requiring hardware, because customers used their own hardware. Finally, the district court held that Take Two did not infringe the '069 patent because it did not meet the m-regular limitation that the court had determined was included in two separate terms of the patent: "fully connected portal computer" and "each participant being connected to three or more other participants." The district court applied this same reasoning to the '344 and '966 patents, providing an additional independent ground for summary judgment of noninfringement. Acceleration Bay appealed both the grant of summary judgment with respect to all four patents and the construction of the claims of the '069 patent.

On appeal, the Federal Circuit accepted Take Two's argument that the appeal was moot with respect to the '344 and '966 patents because Acceleration Bay challenged only one of multiple independent grounds for summary judgment articulated by the district court, and therefore the grant of summary judgment would remain intact even if the Federal Circuit reversed the district court on the ground that was challenged. The Federal Circuit rejected Acceleration Bay's argument that a reversal on the issue it challenged would grant effectual relief because it would help them oppose Take Two's "exceptional case motion" that was forthcoming. The Court also rejected the argument that an impact on other cases conferred jurisdiction. The Federal Circuit affirmed the district court's summary judgment of noninfringement as to the '069 patent for a similar reason—Acceleration Bay challenged only one of the terms that the district court had interpreted to include the m-regular limitation, so the district court's grant of summary judgment would remain intact even if the Court accepted Acceleration Bay's proposed interpretation of the term whose construction it challenged. Finally, the Federal Circuit affirmed the district court's

summary judgment of noninfringement as to the '497 patent, rejecting Acceleration Bay's argument that Take Two was the "final assembler" of the systems.

Adapt Pharma Ops. Ltd. v. Teva Pharms. USA, Inc.

25 F.4th 1354 (Fed. Cir. 2022)

Adapt Pharma Operations Ltd., Adapt Pharma, Inc., Adapt Pharma Ltd., and Opiant Pharmaceuticals, Inc. (collectively, "Adapt") sued Teva Pharmaceuticals USA, Inc. and Teva Pharmaceuticals Industries, Ltd. (collectively, "Teva") for infringement of four patents claiming methods of treating opioid overdose by intranasal administration of a naloxone formulation. After a bench trial, a New Jersey district court determined that the asserted claims would have been obvious in view of the prior art. Adapt appealed and the Federal Circuit affirmed the invalidity of the patents-in-suit.

The Federal Circuit found that the district court did not clearly err in its finding that a skilled artisan would have been motivated to improve upon and combine prior art references to arrive at the claimed invention. The district court also applied the correct legal standard in determining that prior art did not teach away from the claimed invention. It rightly considered the teachings of the prior art as a whole rather than whether the reference discouraged a certain path or encouraged a path that diverged from that taken by the applicant.

Additionally, the Federal Circuit held that objective indicia, when present, must always be considered in the overall obviousness analysis, but that a strong showing of obviousness may stand even in the face of considerable evidence of objective indicia. Thus, the district court did not clearly err in finding that the claimed method's 56 percent increase in drug delivery compared to the prior art, competitors' alleged copying of the dosage amount, and industry skepticism regarding the dosage amount were not probative of nonobviousness.

Judge Newman dissented on the grounds that the Federal Circuit's finding of obviousness was unsupported by the facts and contrary to law. The district court, she argued, did not sufficiently consider the objective evidence of nonobviousness, particularly that the prior art neither taught nor suggested the combination of ingredients used in the claimed method to achieve the described beneficial results. Specifically, all the components of Narcan composition were separately known, but the specific combination of components and concentrations described and claimed were not known or suggested in the prior art, while the extent of improvement achieved in treating opioid overdose was striking. Newman criticizes the majority opinion for not giving fair weight to the objective indicia in an area of public concern, where other products have failed to meet with FDA approval.

Alarm.com Inc. v. Hirshfeld

26 F.4th 1348 (Fed. Cir. 2022)

In 2015, Alarm.com challenged three Vivint patents in *inter partes* review (IPR) proceedings. The PTAB instituted the IPRs, but upheld the patent claims in 2017. Nonetheless, in 2020, Alarm.com filed three requests for *ex parte* reexamination of the

same claims with the PTO, which the PTO Director vacated under the IPR estoppel provisions (§ 315(e)(1)) without deciding whether the requests presented a “substantial new question of patentability.” Alarm.com challenged this decision under the APA as arbitrary, capricious, and an abuse of discretion. Vivint moved to dismiss the case under Rule 12(b)(1) for lack of jurisdiction, arguing that APA review of the vacatur decision was precluded by the structure of the *ex parte* reexamination scheme. The district court agreed with Vivint and dismissed the case. The Federal Circuit reversed.

The IPR estoppel provision states that a petitioner “may not request or maintain a proceeding before the [PTO] with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that *inter partes* review.” 35 U.S.C. § 315(e)(1). The Federal Circuit noted that there is a strong general presumption of judicial review that can only be overcome by “clear and convincing” indications of Congressional intent. Although the *ex parte* reexamination statute provides that “[a] determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable,” 35 U.S.C. § 303(c), the Director did not make any determination that there was no substantial new question of patentability. The Court concluded that, although the statute expressly prohibits review on certain grounds, judicial review is not precluded for all other grounds where, as here, there is no contrary Congressional intent.

Almirall, LLC v. Amneal Pharm. LLC

28 F.4th 265 (Fed. Cir. 2022)

Almirall, LLC appealed a PTAB finding that claims 1–8 of its ’219 patent were obvious over prior art, as argued in a petition for *inter partes* review by Amneal Pharmaceuticals LLC. The Federal Circuit affirmed the PTAB decision and found that it had sufficient evidence to determine that the ’219 patent was indeed obvious over prior art.

The ’219 patent detailed methods for treating acne or rosacea using dapson formulations that include both acrylamide/sodium acryloyldimethyl taurate copolymer (“A/SA”) thickening agent and solvent diethylene glycol monoethyl ether (“DGME”), but not commonly used compound Adapalene. Amneal argued that claims 1–8 were obvious over the combination of Garrett and Nadau-Fourcade and the combination of Garrett and Bonacucina.

Like the ’219 patent, Garrett also detailed formulations of dermatological treatments using dapson and listed preferred concentration ranges for each ingredient in claims 1–8, but did not mention A/SA. Instead, Garrett focused on the use of carbomers such as Carbopol. Nadau-Fourcade detailed the creation of topical treatments for acne and rosacea using carbomers, such as Carbopol, and A/SA agents, such as Sepineo. Bonacucina presented findings that Sepineo, the A/SA described in Nadau-Fourcade, had self-gelling properties lending itself to emulsion. In presenting the prior art above, Amneal argued, and the PTAB agreed, that a POSITA would find it obvious to substitute the carbomer in Garrett’s dapson formulations for the A/SA agents detailed in both Nadau-Fourcade and Bonacucina. Specifically, the PTAB found it obvious to incorporate Nadau-Fourcade’s

A/SA gelling agent into Garrett’s formula because the class of hydrophilic gelling agents and the examples in the concentrations of formula ingredients disclosed in Garrett overlapped with the gelling agents taught by Nadau-Fourcade. Further, the PTAB found that the advantages of Bonacucina’s Sepineo would provide a person of ordinary skill with adequate motivation to replace Garrett’s Carbopol with Sepineo. Further, the PTAB found that Garrett taught the ’219 patent’s negative Adapalene limitation by failing to explicitly, inherently, or implicitly requiring Adapalene. Thus, the Board agreed with Amneal, that Garrett in combination with Nadau-Fourcade and Bonacucina rendered claims 1–8 of the ’219 patent obvious.

The Federal Circuit reviewed the PTAB’s decision to determine whether there was substantial evidence to support a finding of obviousness against Almirall. The Court held that the PTAB’s findings were adequately based upon a combination of expert testimony and a reasonable showing that a POSITA would have expected success in using Nadau-Fourcade’s A/SA in Garrett’s formulations. Additionally, it found that a POSITA would have been motivated to use Bonacucina’s A/SA in Garrett’s formulations with a reasonable expectation of success because of its well-known advantages over carbomer.

The Court emphasized that a finding of success must be reasonable, and not absolute, in determining reasonable expectation of success. Further, the Court negated Almirall’s argument that Garrett did not expressly describe the negative Adapalene claim limitation by pointing to precedent establishing that a reference does not need to state a feature’s absence to establish a negative limitation.

Andra Grp., LP v. Victoria’s Secret Stores, LLC
6 F.4th 1283 (Fed. Cir. 2021)

Andra Group sued several Victoria’s Secret entities and their corporate parent in the Eastern District of Texas (“the District”) for infringement of the ’498 patent that has claims directed to technology for displaying articles on a webpage. The Victoria’s Secret entities were: (1) the operator of the physical stores (“Stores”); (2) the manager of the website and mobile app (“Direct”); and (3) the creator of branded apparel and products (“Brand”). Defendants moved to dismiss for improper venue, arguing that Stores did not commit acts of infringement in the District and that the Non-Store Defendants did not have regular and established places of business in the District. The district court dismissed the Non-Store Defendants without prejudice for improper venue. Andra appealed, and the Federal Circuit affirmed.

The Federal Circuit agreed that the Stores locations in the District cannot be considered regular and established places of business of the Non-Store Defendants. The Court rejected Andra’s argument that Stores employees in the District are agents of the Non-Store Defendants, finding that Andra had not established that any of the Non-Store Defendants exercise a sufficient degree of control over Stores employees. The Court also rejected Andra’s argument that the Non-Store Defendants may be said to maintain regular and established places of business in the District because they each allegedly ratified Stores locations as their own places of business.

Apple Inc. v. MPH Tech. Oy

28 F.4th 254 (Fed. Cir. 2022)

Appeal appealed the PTAB's *inter partes* review decision finding that Apple failed to show that three secure messaging patents owned by MPH Tech. Oy would have been obvious. The patents relate to securely transmitting messages from one computer to another via an intermediate computer. Apple filed the IPR against these patents, primarily based on two pieces of prior art. The Federal Circuit affirmed the PTAB's finding.

The PTAB found that the phrase “the source address of the forwarded message is the same as the first network address,” claimed in the '494 and '362 patents covering the intermediate computer in the messaging network, did not require that the secure message be sent “*directly*” to the intermediate computer, thus finding that this element was not disclosed from the prior art which did not require direct transmission. Apple argued that the PTAB's construction is inconsistent with claim 1 of the '494 patent, from which the above phrase depends, which recites, “intermediate computer configured to receive from a mobile computer a secure message sent to the first network address.” The Court found that the plain meaning of this phrase required the mobile computer to send the message to the first network address directly, stating that the “the proximity” between the sender and the destination in this phrase “links them together,” such that “the plain language establishes direct sending.” The Court added that this conclusion was supported by the specification, which indicated “no passthrough destination address.”

Apple also challenged the PTAB's interpretation of claim 4 of the '494 patent and claim 5 of the '362 patent—directed to encryption-related “information fields”—as requiring “two or more fields” to exist in the intermediate computer (the prior art disclosed only a single field). The Court disagreed based on plain reading of the plural phrase. The Court also found that the PTAB was correct to reject Apple's conclusory expert testimony that the single-field prior art reference could be modified to teach plural information fields.

The Court then turned to Apple's challenge of claim 2 of the '494 patent and claim 3 of the '362 patent. The PTAB had construed the term “substitute” in both claims to mean “changing or modifying, not merely adding to” security elements in data transmission. Apple failed to rebut this construction, and the Court thus found that the claim was obvious by in view of the prior art which merely disclosed “adding to.”

Addressing the challenge to claim 9 of the '494 patent and claim 10 of the '362 patent, the Court, again, affirmed the PTAB's construction based on plain meaning, finding that the term “modify” implied that there was already an existing address field to alter and did not encompass creating a new table with different address fields as Apple suggested. The Court also affirmed, based on plain meaning, the PTAB's finding for claim 10 of patent '362, finding that the term “update” required an existing field.

Lastly, the Court reviewed Apple's challenge of claim 7 of the '502 patent, which covered the computer sending the message. The Court agreed with the PTAB in its nonobviousness

finding, on the basis that this claim was distinguishable from prior art as the claim involved communicating a new address rather than signaling an address change.

Apple Inc. v. Qualcomm Inc.

17 F.4th 1131 (Fed. Cir. 2021)

After the PTAB’s determination that Apple Inc. (Apple) had failed to prove that various claims of patents owned by Qualcomm Inc. (Qualcomm) were unpatentable, Apple appealed, and Qualcomm moved to dismiss for lack of standing. The Federal Circuit agreed, and dismissed the appeal.

Qualcomm sued Apple for patent infringement, and Apple countered by challenging the asserted patents before the PTAB in an *inter partes* review. The parties ultimately settled all of their patent infringement litigation worldwide and entered a global patent license agreement, resulting in the dismissal of the district court action. The IPRs gave rise to two appeals: *Apple I* and this current appeal. In *Apple I*, Qualcomm also moved to dismiss for lack of standing, and the Federal Circuit dismissed the appeal.

The Federal Circuit determined that *stare decisis* compelled the same result and dismissed the case for lack of standing. The Court outlined the requirements for establishing Article III standing: “an ‘injury in fact’ that is...‘fairly traceable’ to the defendant’s challenged conduct and is...‘likely to be redressed by a favorable judicial decision.’” *See Spokeo Inc. v. Robins*, 578 U.S. 330, 338 (2016). The Court emphasized that the operative facts in this case are the same as in *Apple I*: “Qualcomm sued Apple for patent infringement, Apple petitioned for IPR, the parties settled and licensed, Apple failed to prove certain claims unpatentable at the Board, and Apple appealed,” using the same declarations in support of standing—the fact that the patents involved are different is “irrelevant,” as “the settlement and license agreement cover both sets of patents.”

The Court next declined Apple’s request to vacate the PTAB’s prior decisions based on a finding of lack of jurisdiction. Apple compared this case to *United States v. Munsingwear, Inc.*, which instructs court “to vacate the underling decision in certain appeals that have become moot during their pendency.” 340 U.S. 36 (1950). The Court did not find this persuasive and saw no reason to conflate mootness (and *Munsingwear*) with standing, which is a distinctly different inquiry. Moreover, Apple’s voluntary action in entering a settlement agreement, which caused the mootness, does not justify vacatur of a judgment under review. *U.S. Bancorp Mortg. Co. v. Bonner Mall P’ship*, 513 U.S. 18, 29 (1994).

Judge Newman dissented, arguing that when parties enter into settlement agreements, this does not divest the court of jurisdiction. She argued that the unresolved controversy underlying the license agreement—Apple being sued for infringement—would suffice by itself to establish standing to challenge the validity of the licensed patents since the settlement did not cover the entire life span of the patents. Furthermore, she argued that *Munsingwear* would properly apply to this case, and that “Apple should not be subject to estoppel if it is prevented from challenging the PTAB decision on the merits.”

Apple Inc. v. Wi-LAN Inc.

25 F.4th 960 (Fed. Cir. 2022)

Apple Inc. (“Apple”) sought a declaratory judgment of non-infringement and invalidity against Wi-LAN Inc. (“Wi-LAN”) for all claims of the ’745 and ’145 patents, which relate to the allocation of bandwidth, improvement of signal quality, and error protection in data transmission in a wireless communications system. Wi-LAN counterclaimed, alleging that certain Apple devices infringed at least one claim of those patents based on their use of the Long-Term Evolution (“LTE”) wireless communication standard. Following a jury trial that found infringement of both patents and a second trial on damages that granted Wi-LAN \$85.23 million in damages, Apple appealed and Wi-LAN cross appealed.

The Federal Circuit held in favor of Wi-LAN regarding claim construction and infringement. Rejecting Apple’s argument that the written description redefined a claim term as customer premises equipment (“CPE”) because CPE was used interchangeably with the claim term and as the sole embodiment of the claim term, the Federal Circuit upheld the district court’s finding that the claim term should be given its plain and ordinary meaning. The Federal Circuit also held that the district court did not err in denying Apple’s motion for summary judgment that the accused products did not infringe. It concluded that substantial evidence, including expert testimony, supported the jury’s finding that the accused iPhones included an infringing subscriber unit. However, the Federal Circuit reversed the district court’s partial summary judgment that iPhones with Intel chips did not infringe Wi-LAN’s patents. The Court held that Wi-LAN’s license agreement with Intel unambiguously granted a term—rather than a perpetual—license. Thus, the license did not extend to activities that occurred after the expiration of the agreement.

Despite finding for Wi-LAN regarding infringement, the Federal Circuit held that the district court acted within its discretion in granting Apple’s motion for a second trial for damages. The district court erred, however, in denying Apple a third trial because it admitted expert testimony analyzing comparable license agreements that contained methodological and factual errors.

Apple Inc. v. Zipit Wireless, Inc.

30 F.3th 1368 (Fed. Cir. 2022)

The Federal Circuit reversed and remanded a district court’s dismissal of Apple, Inc.’s complaint for declaratory judgment of noninfringement against Zipit Wireless, Inc. for lack of personal jurisdiction in the Northern District of California.

Apple’s lawsuit followed a seven-year period of communication between Apple and Zipit regarding Zipit’s patents ’870 and ’836. The patents detailed wireless messaging devices that used W-Fi to send and receive messages. Zipit flew to Apple’s California office to discuss the asserted patents. Over the course of three years, the parties discussed Apple’s potential purchase or licensing of Zipit’s patents, the *inter partes* review proceedings regarding Zipit’s patents, and Apple’s potential infringement of Zipit’s patents. The parties exchanged several phone calls, letters, and emails in an attempt to draft a licensing

agreement. When that attempt failed, Zipit filed a patent infringement complaint against Apple in 2020. After Zipit voluntarily dismissed the complaint, Apple filed a complaint seeking declaratory noninfringement of the '870 and '836 patents.

The district court granted Zipit's motion to dismiss Apple's declaratory judgment complaint for lack of specific personal jurisdiction over Zipit. Although the district court found exercising jurisdiction over Zipit would be fair and reasonable, it found that exercising personal jurisdiction would be unconstitutional because Zipit lacked binding obligations tying it to California and because Zipit's contacts with the state related to its attempt at resolving the status of its patents.

On appeal, the Federal Circuit agreed that Zipit was subject to personal jurisdiction based on the *Burger King* requirements. However, the Federal Circuit found that the district court erred in finding exercise of personal jurisdiction would be unconstitutional. The Federal Circuit explained that the district court incorrectly read Federal Circuit precedent as creating a bright-line rule that communications directed towards "the attempted resolution" of the parties' dispute cannot serve as the basis for personal jurisdiction.

In its analysis, the Federal Circuit emphasized that a court must consider several things in determining whether personal jurisdiction is both constitutional and fair, including the *Burger King* factors and the *Red Wing Shoe* requirement to consider attempts to settle. First, the court analyzed the *Burger King* factors and found that Zipit (1) failed to provide more than general allegations of inconvenience regarding suit in California and (2) could have expected future litigation after it filed a complaint against Apple. Second, the Court reasoned that both California and Apple had strong, mutual interests in adjudicating accusations of patent infringement in California court. Further, the Court found that there was no conflict between litigating in California and another state. Although the court acknowledged Zipit's attempt to settle out of court, it ultimately found that the sole factor in its favor would not render exercise of personal jurisdiction unconstitutional or unreasonable.

Arthrex, Inc. v. Smith & Nephew, Inc.
35 F.4th 1328 (Fed. Cir. 2022)

The Federal Circuit affirmed a final written decision by the PTAB to find claims 1, 4, 8, 10–12, 16, 18, and 25–28 of Athrex's patent '907 unpatentable as anticipated by prior art. Arthrex appealed the PTAB's decision on the merits and argued that the PTAB lacked constitutional authority to issue final decisions because the Administrative Patent Judges were not appointed by the President and confirmed by the Senate, as required by the Appointments Clause. The Federal Circuit agreed, ruled only on the Constitutional issue and issued a remedy, but its decision was vacated and remanded by the Supreme Court.

The Supreme Court remanded the case to the Federal Circuit with two remedies: (1) the Director was allowed to grant rehearing of a PTAB decision contrary to 35 USC § 6(c) and (2) decisions to grant rehearing would be remanded to the Director. Arthrex requested rehearing by the Director; however, the office of the Director and the office of the Deputy

Director were both vacant and temporarily filled by the Commissioner of Patents, who denied the request for rehearing and deemed the PTAB's decision final.

Arthrex appealed from the Commissioner's decision to deny rehearing on the merits. On appeal, Arthrex argued that it was not offered the remedy proscribed by the Supreme Court because the Commissioner, filling in for the Director and Deputy Director of Patents, violated the Appointments Clause, the Federal Vacancies Reform Act (FVRA), and the Constitution's separation of powers in making the final decision to deny rehearing.

The Federal Circuit found that the Appointments Clause was not violated because inferior officers may perform the duties of a Presidentially appointed and Senate confirmed ("PAS") officer. Examining past precedent, as well as Congressional intent in allowing delegation of Director duties, the Court held that the Commissioner acted within his capacity as a time-limited delegate of the Director of Patents. Next, the Court conducted a plain meaning reading of the FVRA and examined legislative intent; the Court determined that the FVRA was inapplicable because it applied only to non-delegable PAS duties, reflecting Congressional intent to avoid a government shutdown due to vacancies in agency offices. After finding no statute, regulation, act, or law suggesting that rehearing requests were delegable by only the Director, the Court held that the Commissioner's denial did not violate the FVRA. Lastly, there was no violation of the separation of powers because the President was not required to have cause to remove the Commissioner from temporarily filling in for the Director, as opposed to the cause required by 35 USC § 3(b)(2)(c) to remove the Commissioner from his appointed position.

On the merits, the Court affirmed the PTAB's finding of unpatentability. The '907 patent discloses a surgical device for attaching soft tissue to bone by tying suture knots through flexible and inflexible eyelets. Arthrex argued that the prior art alleged to anticipate the '907 and '280 patents was incorporated by reference in its intervening application for the '707 patent. The Court disagreed and held that a reasonable person would consider the '707 patent to fail the written description requirement because it disclaimed and criticized the previously incorporated flexible design. Further, the Federal Circuit denied Arthrex's argument that the PTAB lacked statutory authority to hear whether the '707 patent met this requirement because the *inter partes* review was correctly brought on invalidity grounds under Section 102.

AstraZeneca AB v. Mylan Pharms. Inc.

19 F.4th 1325 (Fed. Cir. 2021)

AstraZeneca sued Mylan for infringement of its '328, '239, and '137 patents (the "asserted patents"), related to stable pharmaceutical compositions for use with inhalers. The district court held a claim construction hearing concerning the construction of "0.001%" of PVP, a formulation stabilizer. After the district court sided with AstraZeneca's construction, Mylan stipulated to infringement of some of the claims. The district court held a bench trial on the validity of the asserted claims, ultimately rejecting Mylan's obviousness claim and entering a final judgment of no invalidity.

Mylan appealed, challenging the district court’s construction of “0.001%” and some of the factual findings that supported the district court’s nonobviousness determination.

Regarding claim construction, the majority sided with Mylan, finding that “0.001%” meant 0.001% with only minor variations, rather than AstraZeneca’s proposed construction of 0.001% within one significant figure, encompassing a concentration of PVP in the range of 0.0005% to 0.0014%. The Federal Circuit found that while AstraZeneca’s proposed construction was consistent with the “plain and ordinary” meaning of “0.001%,” the majority believed the specification and prosecution history of the patent—which distinguished formulations with 0.001% w/w PVP from other formulation with 0.0005% w/w PVP—dictated a narrower construction. The majority’s opinion fell short of finding that the patentee had acted as its own lexicographer or that disclaimer applied, calling it a “close case” based on the context of the intrinsic record. Judge Taranto dissented, finding that the plain and ordinary meaning should apply in the absence of a finding of lexicography or that disclaimer.

Regarding nonobviousness, the panel as a whole did not discern any clear error in the district court’s factual findings, affirming the determination of nonobviousness.

Atlanta Gas Light Co. v. Bennett Regulator Guards, Inc.
33 F.4th 1348 (Fed. Cir. 2022)

Atlanta Gas petitioned the PTAB for *inter partes* review of the ’029 patent. Previously, the patent owner, Bennett, initially argued that Atlanta Gas was time-barred from petitioning for *inter partes* review under 35 U.S.C. § 315(b). Bennett also petitioned the PTAB for sanctions based on Atlanta Gas’s failure to timely update its real party in interest disclosure. The PTAB rejected Bennett’s time-bar argument and found the challenged claims unpatentable, but awarded Bennett monetary sanctions. Before the PTAB finalized its sanctions decision, both parties appealed. The Federal Circuit previously found that Atlanta Gas’s petition was time-barred and vacated the PTAB’s unpatentability determination. However, before the Federal Circuit’s mandate issued, the Supreme Court decided *Thryv, Inc v. Click-To-Call Technologies*, holding that time-bar determinations are not reviewable by appellate courts. Thus, on remand from the Supreme Court, the Federal Circuit assessed only the merits and affirmed the PTAB’s decision finding the ’029 patent unpatentable, but affirmed the PTAB’s sanctions determination and remanded the case for the PTAB to quantify any sanctions. On remand, the PTAB reconsidered its sanctions order, and in light of the Patent Office’s new policy on the time bar, the PTAB vacated its institution decision, terminated the proceeding, and declined to award monetary sanctions. Atlanta Gas appealed.

The majority found that the Federal Circuit lacks jurisdiction to hear the appeal. Because the PTAB’s termination decision was based on its evaluation of the time-bar and not solely a sanctions decision, the Court held that it lacked jurisdiction under 35 U.S.C. § 314(d) and the Supreme Court’s decision in *Thryv*.

Auris Health, Inc. v. Intuitive Surgical Operations, Inc.

32 F.4th 1154 (Fed. Cir. 2022)

Auris petitioned for *inter partes* review of Intuitive’s ’447 patent, which was directed towards a robotic surgery system with an improved ability to quickly swap surgical instruments during an operation. The PTAB found the ’447 patent not obvious and valid. Auris appealed. The Federal Circuit agreed with Auris and vacated and remanded a PTAB decision, holding that general skepticism cannot serve as the sole basis for defeating an obviousness claim.

In its petition, Auris argued that combining two previously existing references, Smith and Faraz, would have disclosed every limitation of the challenged claims. Smith described a robotic exoskeleton designed for surgeons to wear to control remote robotic arms using a pulley system. Faraz described a robotic stand for holding surgical instruments to reduce the need for assistants in the surgical room and to physically hold up surgeons. Auris argued that a POSITA would be motivated to combine the two robotic structures to decrease the number of assistants needed in a surgical room.

Intuitive responded with expert testimony stating that there was no motivation to combine the two references because of general skepticism around robotic surgery. The PTAB agreed with Intuitive, and found that a POSITA would not be motivated to further complicate independently complex robotic systems by combining them because of their general skepticism around robotic surgery.

The Federal Circuit disagreed with the PTAB’s analysis and held that evidence of skepticism must be specific to the invention, not generic to the field. Thus, the PTAB’s notation of Intuitive’s expert testimony was insufficient to support a finding of lack of motivation to combine. On remand, the Federal Circuit directed the PTAB to reexamine whether there was sufficient evidence to conclude there was motivation to combine given the new guidance on skepticism.

Judge Reyna dissented, disagreeing that the PTAB relied on general skepticism, and, more generally, arguing that general skepticism can support a finding of no motivation to combine. Judge Reyna stated that the opinion would be misread as a rule against relying on general skepticism in spite of established precedent calling for a flexible approach in determining obviousness in dangerous fields like robotic surgery.

BASF Plant Sci., LP v. Commonwealth Sci. Indus. Rsch. Org.

28 F.4th 1247 (Fed. Cir. 2022)

The Federal Circuit affirmed in part, reversed in part, vacated in part, and remanded a district court decision in the Eastern District of Virginia regarding a patent dispute between BASF Plant Science, Inc. (“BASF”) and the Commonwealth Scientific and Industrial Research Organization (“CSIRO”).

This case concerns six patents owned by CSIRO, relating to methods for genetically modifying canola plants to produce certain polysaturated fatty acids. BASF filed a complaint for declaratory judgment of noninfringement of six CSIRO patents, alleging that it co-owned the patents and that they were invalid for lack of written description. In response, CSIRO filed a counterclaim for patent infringement against BASF and BASF's partner, Cargill. Cargill's 12(b)(3) motion to dismiss for improper venue was denied and the case went to a bifurcated validity and damages trial. At trial, the jury determined that there was adequate written description of four of the six patents in dispute and also found one of the six patents was co-owned by BASF. Appeal was taken regarding Cargill's venue motion, validity, co-ownership (and by consequence infringement), and several issues in the conduct of the trial and jury instructions.

On appeal, the Federal Circuit affirmed the venue ruling. It based this decision on Congressional intent and a parallel reading of 28 USC § 1400(b) against 28 USC § 1441, which both use the term "defendant" in the same manner. Cargill argued that it was entitled to protection under Section 1400(b) because it was a defendant in a patent case, but the Federal Circuit disagreed based on a prior analysis of Section 1441. The Court noted that Section 1441 was held to refer to the narrow scope of originally named defendants, not counterclaim defendants such as Cargill, and it pointed to Congressional intent in drafting similar statutes that expressly named "counterclaim defendants" or "any party." As Section 1400(b) used only the term "defendant," the Court construed it to be as narrow and inapplicable to counterclaim defendants as Section 1441 was held to be.

On written description, the Federal Circuit affirmed with respect to claims expressly referencing "canola" and reversed with respect to claims reciting a broad genus of plant cells. The Court found that there was sufficient evidence to show that CSIRO had success in genetically modifying canola plants, but not in all plants, based on expert testimony and provisional applications drawing back to 2004.

On co-ownership, the Federal Circuit affirmed no co-ownership for five of the six patents, and reversed the jury on the final patent, such that all six were not co-owned and therefore were infringed. The Court evaluated BASF's argument that the MTEA contained a provision for joint ownership of any intellectual property arising from the results, data, or constructs developed by the brief partnership. The Court disagreed with this reading and found that the parties would not have agreed to a provision binding them together in the future. Further, the court held that there was no co-ownership as to the '792 patent, contrary to the jury's verdict, because BASF failed to provide evidence showing that the patent contained any intellectual property directly taken from BASF. Instead, the Court found that the jury relied on an "impermissible" amount of speculation in deciding co-ownership based on BASF's argument that '792 "drew upon" widely known BASF genes used in the MTEA research.

Finally, the Federal Circuit evaluated CSIRO's appeal of the district court's decision to preclude the presentation of willfulness and certain damages theories to the jury. The Court affirmed the decision to preclude the jury from hearing evidence on willfulness due to insufficient evidence showing that BASF knew the patents existed. In evaluating whether

the district court erred in denying CSIRO from preventing evidence on royalties for past infringement, the Court affirmed, holding that CSIRO failed to lay a foundation by omitting information about the timeline and financial effect of the alleged infringement on its research costs. On the issue of forward-looking remedies, the Court affirmed the denial of an infringement-stopping injunction based on the expected negative impact on the commercial market, and it remanded the question of the ongoing royalty back to the district court. The Court instructed the district court on remand to reconsider its analysis of refusing to use non-competitor licensing agreements as a baseline for the ongoing royalty in light of new facts, such as CSIRO entering the commercial market.

Dissenting, Judge Newman argued that the jury verdict regarding BASF's co-ownership of the '792 patent should have been affirmed, pursuant to the jury finding sufficient evidence to conclude BASF materials provided under the MTEA were used in the '792 patent.

Belcher Pharms., LLC v. Hospira, Inc.

11 F.4th 1345 (Fed. Cir. 2021)

In this appeal from the District of Delaware, the Federal Circuit affirmed the district court's holding that Belcher Pharmaceuticals' patent was unenforceable due to inequitable conduct engaged in by Belcher's Chief Science Officer during the patent's prosecution.

Belcher applied for a patent on August 15, 2014 for its epinephrine formulation which had a pH range of 2.8 to 3.3 (the '197 patent). According to Belcher, this formulation was a nonobvious solution to the problem of racemization and reduced overages of epinephrine that existed in Sintetica SA's original formulation that it improved upon. During prosecution, the application was rejected as obvious based on a Canadian Patent Application (Helenek) for a similar injection with a pH range of 2.2 to 5.0. The patent was ultimately allowed based on Belcher's argument that Helenek's pH range did not make the claim obvious because the 2.8 to 3.3 range was "unexpectedly found to be critical ... to reduce the racemization of l-epinephrine," which was not suggested by the prior art.

Belcher sued Hospira, Inc. for patent infringement after Hospira submitted a New Drug Application (NDA) seeking approval of an epinephrine formulation which included a certification that the '197 patent was invalid, unenforceable, or not infringed by the product. At the two-day bench trial, Belcher's Chief Science Officer Darren Rubin—who was involved in not only prosecuting the '197 patent, but also in developing the product and drafting the NDA—testified that he was aware of an epinephrine product that had been introduced to the market by a company named JHP before 2014. That product's label specified that its pH was between 2.2 and 5.0. Based on this information, the district court decided that the '197 patent was unenforceable for inequitable conduct, finding the information that Rubin withheld material and concluding that Rubin had the requisite intent to deceive the PTO. Belcher appealed.

On appeal, the Federal Circuit affirmed the district court's holding that the '197 patent was unenforceable for inequitable conduct. First, the Court found that the prior art reference was necessarily material because Belcher had not challenged the district court's decision

that JHP's product made the claims invalid as obvious, and "prior art is but-for material information if the PTO would not have allowed a claim had it been aware of the undisclosed prior art." The Court explicitly rejected Belcher's argument that the JHP product was cumulative of the Helenek patent, explaining that this argument was "directly at odds with [Belcher's] argument during prosecution that the claimed range was 'critical.'" Second, the Court held that the district court did not err in inferring that Rubin possessed specific intent to deceive the PTO. The Court relied on the fact that Rubin was involved in the FDA approval process, knew that Belcher had reverted from the 2.4 to 2.6 range to the 2.8 to 3.3 range because it would expedite FDA approval, and described the 2.8 to 3.3 pH range as "a 'critical' innovation contrary to the knowledge of a person of ordinary skill in the art that yielded 'unexpected results'" while possessing knowledge that the prior art taught of that pH range. The Court was not persuaded by Belcher's argument that Rubin withheld the references because he thought they were irrelevant due to their high overages because the district court had relied not only on its finding that Rubin's purported reasons were implausible, but also on these additional factors, in finding the requisite intent.

Biogen Int'l GmbH v. Mylan Pharms. Inc.

28 F.4th 1194 (Fed. Cir. 2021)

In June 2020, the United States District Court for the Northern District of West Virginia found Biogen's patent covering its multiple sclerosis (MS) drug, Tecfidera, invalid for lack of a written description. Biogen's '514 patent claims a method to treat MS through the oral administration of dimethyl fumarate (DMF), monomethyl fumarate (MMF), or some combination thereof at the effective amount of "about 480 mg per day." The patent specification makes notes a range of effective doses for the drug including "from about 480 mg to about 720 mg per day." The Federal Circuit issued a 2-1 panel decision in November 2021, affirming the district court's decision. In this case, the Federal Circuit denied Biogen's petition for panel rehearing and for rehearing en banc. The court issued no opinion, but a strong dissent was published by three judges—Lourie, Moore, and Newman—who argued that the district court had erroneously broadened the written description requirement, and that the Court should have clarified the applicable legal standard.

The dissent notes four points of error in the panel majority's opinion that they would have corrected en banc: "First, the panel majority and district court overly emphasized unclaimed disclosures in the specification. Second, they erroneously imposed a heightened burden on the patentee to show that the specification proves efficacy. Third, they imported legal factors from other patentability requirements. And fourth, they were influenced by irrelevant extrinsic evidence."

Regarding the first error, the dissent stated that the "written description support for the claimed 480 mg per day dose is not undermined by the fact that it appears one time in the specification or by the fact that the patent also discloses unclaimed dose ranges." The dissent also took issue with the panel majority's reliance on "blaze marks" precedent, since the desired dose was "expressly described in the specification." Second, the dissent criticized the panel majority's finding that the written description requirement was not met

because “nothing in [the specification] teaches a [POSITA] that a 480 mg/day dose of DMF is therapeutically effective for treating MS,” insisting that the “imposition of a burden of proof on the patentee to show that the specification proves the efficacy of the claimed pharmaceutical composition” was erroneous because “it is unnecessary to prove that a claimed pharmaceutical compound actually achieves a certain result.”

Third, the dissent found the “panel majority’s focus on the efficacy of the claimed pharmaceutical composition” was erroneous because the operability of a claimed invention is an enablement issue, and should not have been considered as a written description requirement. The same issue arose when the “panel majority and the district court considered factors relevant to the inventorship of the ’514 patent,” which blurred the lines between written description and enablement. Finally, the dissent criticized the panel majority’s use of extrinsic evidence “to cast doubt on the meaning of what is disclosed” since “the ’514 patent contains a disclosure that corresponds to what is claimed.” In the dissent’s view, the district court erred by using the “guise of considering what a [POSITA] would have known as of the claimed priority date” as a way to place “considerable weight on whether Biogen’s clinical trials before the filing date would have been sufficient to show the efficacy of particular doses of DMF to treat [MS].” The dissent concluded by noting that “the court has lost an opportunity to provide clarity for future litigants by reaffirming the proper boundaries of the written description requirement in 35 U.S.C. § 112.”

Biogen Int’l GmbH v. Mylan Pharms. Inc.

18 F.4th 1333 (Fed. Cir. 2021)

The Federal Circuit affirmed the district court’s ruling that Biogen’s ’514 patent was invalid for lack of written description, holding that the specification did not show that the inventors possessed the claim at issue and the patent was ineligible for the priority date. The ’514 patent claimed a method of treating multiple sclerosis (“MS”) with the dimethyl fumarate drug (“DMF”). Biogen filed a provisional application in 2007 and filed the ’514 patent in 2012. Biogen filed a claim against Mylan Pharmaceuticals for patent infringement, and Mylan counterclaimed for a declaratory judgment that the patent was invalid. Because the original specification did not support possession of the “therapeutically effective DMF480 dose” of medication, the Court held Biogen was unable to take advantage of the priority filing date.

Emphasizing that the relevant question was whether a POSITA would know from reading the specification that DMF480 would be a therapeutically effective treatment for MS, the court noted several issues in the specification that led to its determination that Biogen did not have possession of the DMF480 dose at the priority date. First, while the supported DMF720 mg dose was listed independently in the specification, DMF480 was listed only once in the specification—and was listed at the end of a range rather than independently. Another issue was the specification’s “focus on basic research and broad DMF-dosage ranges,” which demonstrated Biogen did not possess a therapeutically effective DMF480 dose when filing the 2007 provisional application. Finally, the recitation of several DMF doses in ranges further contributed to the finding that Biogen was not in possession of the DMF480 dose. And although Biogen advanced several arguments as to why the district

court erred in its determination that the dissent found compelling, the majority quickly rejected its arguments.

Judge O'Malley dissented and argued that the district court erred in three ways: it mistakenly applied judicial estoppel, conflated therapeutic and clinical efficacy, and incorrectly applied the "blaze marks" precedent. First, the district court should not have judicially estopped Biogen from asserting the difference between clinical and therapeutic efficacy. Second, the '514 patent claimed therapeutic rather than clinical efficacy, and so the district court's determination that the patent did not demonstrate possession because it lacked clinical efficacy data was in error. Finally, because the '514 patent did not contain a "laundry list" of disclosures but rather claimed the specific DMF480 dose, the district court's application of the "blaze marks" precedent was erroneous.

BlephEx, LLC v. Myco Indus., Inc.

24 F.4th 1391 (Fed. Cir. 2022)

BlephEx, LLC sued Myco Industries, claiming that Myco's product, a treatment device for blepharitis (an ocular disorder), infringed BlephEx's '087 patent for a blepharitis treatment instrument comprised of a cotton swab attached to an electromechanical device. The district court granted a preliminary injunction enjoining Myco from selling, distributing, or offering to sell or distribute their product over Myco's arguments that the '087 patent was likely invalid. Myco appealed to the Federal Circuit.

In district court, Myco argued that the '087 patent was anticipated by Nichamin, a patent application that includes two diagrams: one depicting a wand used to remove debris from eyelids and one depicting an electromechanical device used to apply the wand. Myco argued that the two diagrams should be viewed together while BlephEx argued that the two diagrams were meant to be viewed as separate depictions. The district court agreed with BlephEx, finding that Nichamin did not anticipate the '087 patent. Myco also argued that the '087 patent was invalid for obviousness, which the district court rejected as Myco failed to provide any supporting expert evidence. Solely on appeal, Myco argued that although Nichamin does not expressly combine the two diagrams, Nichamin may still anticipate the '087 patent if Nichamin teaches that the diagrams could be combined and that a person of skill could implement the combination.

On appeal, the Federal Circuit affirmed the district court's findings. Regarding Myco's anticipation argument, the Court found that Myco failed to present evidence that a person of skill could have implemented the combination of Nichamin's two diagrams. The Court also rejected Myco's argument that the district court improperly deferred to the Examiner, who is presumed to have considered Nichamin during prosecution when, as here, the reference is listed on the patent. Regarding obviousness, the Court found that the district court did not err in requiring expert testimony to support Myco's obviousness argument because although expert testimony is not required for cases involving simple technology, it is required for this case, which involves an art that requires a high level of skill. The Federal Circuit also rejected Myco's challenges to the preliminary injunction on the basis of scope.

Broadcom Corp. v. Int'l Trade Comm'n
28 F.4th 240 (Fed. Cir. 2022)

Broadcom Corporation filed a complaint with the ITC claiming the importation of products by Renesas Electronics Corporation and others infringed the '583 and '752 patents under Section 337, which are directed to reducing power consumption in computer systems and memory access unit with improved efficiency, respectively. The administrative law judge determined that Broadcom failed to demonstrate any with respect to the '583 patent because it failed to satisfy the domestic industry requirement and because there was no infringement of claim 25. The ALJ also found that claim 5 of the '752 patent would have been unpatentable as obvious over certain prior art. A subsequent Commission Review affirmed the relevant portions of the initial determination by the ALJ. Additionally, Renesas filed an *inter partes* review of the asserted patents. The PTAB held claims 25 and 26 of the '583 patent and claims 1, 2, 5, 7, and 8 of the '752 patent as obvious, but upheld claims 17 and 18 and 20–24 of the '583 patent. The parties appealed the Commission's and the Board's respective findings.

The Court first addressed Broadcom's challenge to the ITC's finding of no domestic industry and thus no infringement of claim 25 of the '538 patent. Here, the Federal Circuit agreed with the Commission and the ALJ that Broadcom had not satisfied the technological prong of the domestic industry requirement in alleging their violation. Broadcom had identified its system-on-a-chip (SoC) as the only domestic industry article, but sought to hold Renesas responsible for their use of a "clock tree driver" which was stored separately from the SoC. Broadcom attempted to argue that it works with its customers to integrate its SoC with external memory to execute the "clock tree driver" firmware, but the Court rejected this argument, noting that no such integration had actually been created by Broadcom. Instead, the Court, agreeing with the Commission, found that Broadcom had not identified an actual integration protected by the patent, instead merely positing a purely hypothetical device to support their argument of infringement.

Next, the Court turned to the Renesas's challenge to the PTAB's determination upholding claim 17 of the '538 patent as nonobvious, which alleged that the PTAB improperly relied on Broadcom's expert opinion (software instructions halting a processor) in contradiction to the prior art (hardware halting a processor). The Court reviewed the Board's analysis of whether the combination of prior art explained how to achieve the claimed system with a processor that controls clock gates connected to devices (i.e., hardware). Here, the Court explained that, unlike claim 17, prior art did not disclose a processor that turns clock gates on and off and instead was focused on determining the operational setting of a processor. Accordingly, they affirmed the holding that claim 17 was nonobvious.

The Court's then addressed the PTAB's determination that claims 25 and 26 of the '538 patent were invalid as obvious. Broadcom argued that the PTAB improperly reconstructed the claim by modifying and combining the prior art references based on merely a "generic motivation to combine software power management" disclosed in two references. The Court disagreed, finding that the prior art were "directed to the same field of art," as evidenced by its specific disclosures of power management elements.

Lastly, the Court found that the PTAB's finding of obviousness as to all challenged claims of the '752 patent based on the Foster reference. With respect to claim 1, the Court found that Broadcom's argument that the PTAB improperly combined the embodiments failed to recognize that PTAB plausibly found that Foster discloses "an output port" and "a queue" as part of a memory access unit which are directed to the same invention. Similarly, for claims 2 and 5, the Court found that Broadcom failed to meaningfully challenge the PTAB's finding of claim elements disclosed in the Foster reference.

Cal. Inst. of Tech. v. Broadcom Ltd.

25 F.4th 976 (Fed. Cir. 2022)

Caltech's '710 and '032 patents are directed to circuits that produce and receive irregular repeat and accumulate codes configured to enhance the speed and dependability of data transmissions. Caltech's '781 patent is directed to a method for creating codewords in which "information bits appear in a variable number of subsets."

Caltech sued Broadcom and Apple, alleging infringement by Broadcom wireless computer chips in Apple products. Both defendants filed counterclaims for declaratory judgment of noninfringement, invalidity, and unenforceability due to inequitable conduct. Before trial, Apple filed multiple IPR petitions challenging the validity of the claims at issue. The PTAB determined Apple did not show by a preponderance of the evidence that the claims were unpatentable as obvious. In the district court, Apple and Broadcom asserted counterclaims of invalidity based on prior art and grounds not raised in the IPRs. The district court granted summary judgment to Caltech of no invalidity, ruling that these invalidity challenges were estopped under 35 U.S.C. § 315(e)(2) because Apple and Broadcom were aware of these prior art references when they filed their IPR petitions and reasonably could have raised them in those petitions.

On appeal, the Federal Circuit affirmed and clarified the scope of IPR estoppel, holding that "estoppel applies not just to claims and grounds asserted in the petition and instituted for consideration by the Board, but to all grounds not stated in the petition but which reasonably could have been asserted against the claims included in the petition." In reaching this holding, the panel overruled *Shaw Industries Group, Inc. v. Automated Creel Systems, Inc.*, 817 F.3d 1293, 1300 (Fed. Cir. 2016), which held that because IPR "does not begin until it is instituted," estoppel did not apply to grounds raised in a petition, but not instituted, as such grounds were not raised "during the IPR." In Caltech, however, the Court explained that *Shaw's* reasoning was irreconcilable with the Supreme Court's decision in *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018), which "made clear both that there is no partial institution authority conferred on the Board by the America Invents Act and that it is the petition, not the institution decision, that defines the scope of the IPR." The panel explained that it had authority to overrule *Shaw* without en banc action because the Supreme Court's *SAS* decision "undercut the theory or reasoning underlying" the *Shaw* decision "in such a way that the cases are clearly irreconcilable."

On the merits, the Court affirmed the district court's denial of JMOL on infringement of the '710 and '032 patents. The Court also affirmed the district court's ruling finding claim

13 of the '781 patent patent-eligible, but vacated the jury's verdict of infringement of that claim and remanded for a new trial on infringement as to that claim, holding that the district court failed to properly instruct the jury on the construction of a relevant claim term. The Court also affirmed the district court's finding of no inequitable conduct and its decision with respect to its jury instructions on extraterritoriality, but vacated and remanded for a new trial on damages, holding that the record did not support Caltech's two-tier damages theory.

Judge Dyk concurred in part and dissented in part, disagreeing with the majority's holding that substantial evidence supports the jury's verdict of infringement of the claims of the '710 and '032 patents. Judge Dyk concluded that the district court's construction of the term "repeat" with respect to certain bits required Caltech to show that additional bits were generated. Because, in Judge Dyk's view, the record contained no evidence demonstrating that additional bits were generated by the accused products, Judge Dyk would have reversed the district court's denial of JMOL of no literal infringement of those two patents. Judge Dyk also would have reversed the denial of JMOL with respect to the '781 patent instead of remanding for a new infringement trial.

Campbell Soup Co. v. Gamon Plus, Inc.

10 F.4th 1268 (Fed. Cir. 2021)

This case concerns whether design patents have the same nexus requirement under an obviousness analysis as utility patents. Gamon sued Campbell and its manufacturer for patent infringement in the United States District Court for the Northern District of Illinois. In response to the lawsuit, Campbell petitioned for IPR of Gamon's two patents on multiple grounds, including that the claimed designs are obvious. The PTAB found that Campbell failed to prove unpatentability because Campbell had not set forth a proper primary reference because the prior art was not similar enough to the claimed designs. Campbell appealed, and the Federal Circuit vacated the PTAB's decision and remanded. On remand, the PTAB found that Campbell did not prove unpatentability because while the patent had the same overall visual appearance as the prior art, the objective indicia of obviousness—commercial success and Campbell's praise of the invention—outweighed the concern of a similar visual appearance. Furthermore, the PTAB presumed a nexus between the objective indicia and the claimed design and found that Gamon produced evidence to support a nexus-in-fact.

Again, Campbell appealed the PTAB's decision to the Federal Circuit. The Federal Circuit reversed the PTAB's decision, finding that the claimed designs would have been obvious over the prior art. The Federal Circuit agreed with the PTAB's determination that the claimed designs shared the same overall visual appearance with the prior art. However, the Federal Circuit found that the PTAB erred in its decision because substantial evidence did not support either a presumption of nexus or a finding of nexus-in-fact. First, the Federal Circuit found that no reasonable trier of fact could find the product coextensive with the claim designed because of significant unclaimed functional elements. Second, the Federal Circuit held that Gamon did not establish a nexus-in-fact because Gamon failed to show that the commercial success and praise of the product derived from its unique

characteristics. The Federal Circuit held that, as in the utility patent context, objective indicia must be linked to a design patent claim's unique characteristics. Accordingly, the Federal Circuit reversed the PTAB's decisions, finding the claimed designs would have been obvious over the prior art.

CareDx, Inc. v. Natera, Inc.

40 F.4th 1371 (Fed. Cir. 2022)

Stanford owned three patents—the '652, '497, and '607 patents—related to diagnostic techniques for predicting whether an organ transplant would be successful. Representative claims for all three patents each included the four steps of (1) obtaining cell-free DNA (cfDNA) samples from the recipient, (2) sequencing the donor and/or recipient genomes to create polymorphism profiles, (3) sequencing the cfDNA samples, and (4) determining the amount of donor cfDNA.

CareDX, as licensee of the patents, sued Natera for infringement of the three patents. Natera moved to dismiss the complaint on the basis that the patents lack patent-eligible subject matter under § 101. The district court denied the motion to dismiss to allow for limited discovery on the issue of whether the methods employed by the claims were “conventional.” The district court ultimately granted a motion for summary judgment by Natera that the patents were directed to patent-ineligible subject matter and recited only conventional techniques.

The Federal Circuit agreed with Natera that this was not a case involving a new detection method or technique. Unlike *Mayo*, CareDx was not even alleging that it was the one to discover the correlation between donor cfDNA and the likelihood of organ transplant rejection. Accordingly, the Federal Circuit affirmed the district court's opinion, holding that the patents merely apply conventional measurement techniques to detect a natural phenomenon, and, therefore, are patent ineligible.

Celgene Corp. v. Mylan Pharms. Inc.

17 F.4th 1111 (Fed. Cir. 2021)

In this dispute under the Hatch-Waxman Act, the Federal Circuit affirmed the district court's dismissal for improper venue as to the domestic-corporation defendants, Mylan Pharmaceuticals Inc. (MPI) and Mylan Inc. (Mylan), and for failure to state a claim as to Mylan N.V., the foreign-corporation defendant. MPI submitted an ANDA seeking approval to market a generic version of one of Celgene's pharmaceuticals. In response, Celgene sued MPI, Mylan, and Mylan N.V. under the Hatch-Waxman Act, asserting a number of patents. Following venue-related discovery, the defendants moved to dismiss, which the district court granted, and Celgene appealed.

The Federal Circuit affirmed the district court's dismissal of MPI and Mylan for improper venue. Since the defendants were not residents of New Jersey, Celgene needed to show that MPI and Mylan committed infringing acts in New Jersey and also had a regular and established place of business in the state. 28 U.S.C. § 1400(b). The Court concluded that

MPI and Mylan did not commit acts of infringement in New Jersey: in Hatch-Waxman cases, “it is the submission of the ANDA, and only the submission, that constitutes an act of infringement” for purposes of venue. *See Valeant Pharm. N. Am. LLC v. Mylan Pharms. Inc.*, 978 F.3d 1374, 1379 (Fed. Cir. 2020). The ANDA itself was submitted outside of New Jersey, and the paragraph IV notice letter sent to Celgene’s New Jersey headquarters *after* the submission of the ANDA did not qualify as an infringing act. Furthermore, MPI and Mylan did not have a regular and established place of business in New Jersey. Celgene attempted to impute venue via several homes and storage lockers associated with employees and affiliates of Mylan, as well as the office of a now-defunct subsidiary of MPI. None of these locations were sufficient to find a regular and established place of business for MPI or Mylan, and the Court declined to impute the subsidiary’s presence to the parent company without a showing that the parties disregarded the corporate form in their dealings. Accordingly, the district court’s finding of improper venue was affirmed.

The Federal Circuit also affirmed the district court’s dismissal of Celgene’s complaint against Mylan N.V. for failure to state a claim. Celgene alleged that Mylan N.V. submitted the ANDA, but it was indisputably MPI who signed and physically submitted it. Celgene failed to plead sufficient facts regarding Mylan N.V.’s involvement in the ANDA and could not show that MPI acted as Mylan N.V.’s alter ego. The Court also found that the district court did not abuse its discretion in declining Celgene’s request for leave to amend, as Celgene missed scheduling-order deadlines in requesting leave to amend and failed to demonstrate good cause for amending after the deadline.

Centripetal Networks, Inc. v. Cisco Sys., Inc.
38 F.4th 1025 (Fed. Cir. 2022)

Cisco Systems, Inc. appealed from a judgment awarding more than \$2.75 Billion in damages to Centripetal Networks, Inc. for the willful infringement of four of Centripetal’s patents. This judgment came from the Eastern District of Virginia and was decided by Judge Henry C. Morgan, Jr. Less than two months before issuing his decision, Judge Morgan notified the parties that his wife owned \$4,687.99 in Cisco stock, but explained that at the time he was informed of this financial conflict, he had already completed “a full draft of [his] opinion” and that “[v]irtually every issue was decided prior thereto.”

Following Judge Morgan’s disclosure, Centripetal informed the court that it had no issue with Judge Morgan remaining on the case. Conversely, Cisco filed a motion requesting Judge Morgan’s recusal under 28 U.S.C. § 455(a) and (b)(4). Section 455(a) broadly requires that a judge recuse himself “in any proceeding in which his impartiality might reasonably be questioned.” Section 455(b)(4) is more specific, requiring recusal when a judge, judge’s spouse, or judge’s minor child residing in their household “has a financial interest in the subject matter in controversy or in a party to the proceeding, or any other interest that could be substantially affected by the outcome of the proceeding.” However, a judge may be relieved of his or her duty to recuse under Section 455(f), which states that disqualification is not required when a judge “divests himself or herself of the interest that provides the grounds for disqualification.” Although he recognized that “the simplest thing

would be to sell the stock,” Judge Morgan declined to do so, concerned about the potential insider trading implications. Instead, Judge Morgan placed the stock in a blind trust, which he believed to constitute “divestiture” under Section 455(f)’s safe harbor. Accordingly, Judge Morgan denied Cisco’s Motion for Recusal.

The Federal Circuit reviewed Judge Morgan’s denial of the Motion for Recusal for an abuse of discretion. The Federal Circuit considered two key questions: whether Judge Morgan was correct that placing the stock in a blind trust constituted divestiture pursuant to Section 455(f) and, if not, “whether Judge Morgan’s failure to disqualify himself was a harmless error.” First, the Court reasoned that divestment requires one to be “deprived or dispossesse[d]” of one’s ownership, which requires the interest to be “sold or given away.” Here, Judge Morgan’s wife “still ‘[had] a financial interest’ in Cisco,” and, thus, while her control over the stock was eliminated, her beneficial interest in it was not.

The Court then determined that the appropriate remedy was reversal and vacatur. Using the factors laid out by the Supreme Court in *Liljeberg* to consider “(1) ‘the risk of injustice to the parties in the particular case’; (2) ‘the risk that the denial of relief will produce injustice in other cases’; and (3) ‘the risk of undermining the public’s confidence in the judicial process,’” the Court found the error was not harmless. The Court also noted that it “should be a very unusual case where vacatur is denied when a judge discovers a clear disqualifying interest under Section 455(b)(4), recusal is required, there is a failure to divest, and the judge proceeds to rule on the case despite that clear obligation.” Concluding that the blind trust did not satisfy the statutory requirements of divestiture under Section 455(f), and that the failure to recuse was not harmless, the Federal Circuit reversed and remanded for “further proceedings before a newly appointed judge.” Judge Morgan passed away on May 1, 2022, shortly before this case was decided.

ClearOne, Inc. v. Shure Acquisition Holdings

35 F.4th 1345 (Fed. Cir. 2022)

ClearOne, Inc. appealed from an *inter partes* review final written decision holding the “self-similar” configuration term in Shure’s ’493 patent not indefinite and from the PTAB’s denial of ClearOne’s request to file a sanctions motion against Shure. The ’493 patent relates to “arrays of microphones and housings for the arrays” wherein the array is configured, in one embodiment, to “include[] a plurality of microphone transducers selectively positioned in a self-similar or fractal-like configuration, or constellation.” During *inter partes* review, Shure moved to amend the claims of the ’493 patent and added independent claim 57, which “recites in relevant part: A microphone assembly comprising: an array microphone comprising a plurality of microphones *arranged in a self-similar configuration.*” The PTAB granted Shure’s motion and concluded that a POSITA would understand the term “self-similar” to have had a well-known meaning and include the specification’s disclosure. ClearOne requested a rehearing and leave to file a motion for sanctions against Shure for its alleged failure to disclose “material prior art.” Denying each of ClearOne’s motions, the PTAB found that Shure had not violated its duty to disclose because the prior art “was cumulative of references asserted by ClearOne in its IPR

petition” and that allowing the sanctions motion would be akin to allowing ClearOne “a second opportunity at its IPR.”

The Federal Circuit affirmed the Board’s determination that claim 57’s self-similar configuration limitation is not indefinite and that a POSITA would understand the term to include the specification’s example patterns, based on the extrinsic evidence considered by the PTAB, as well as the intrinsic record standing alone. The court rejected ClearOne’s argument that the phrases “self-similar or fractal-like” must be understood as distinct from one another, since the context demonstrated that they *equate* “self-similar to fractal-like or repeating patterns” rather than *juxtapose* them. Looking to the extrinsic evidence, the Federal Circuit found that both the dictionary definition of “self-similar” as well as ClearOne’s own expert confirmed that a POSITA would have understood the term with reasonable certainty. While ClearOne had shown that “self-similar” was subject to multiple meanings, that did not necessarily render it indefinite.

Finally, reviewing for an abuse of discretion, the Federal Circuit affirmed the PTAB’s decision to deny ClearOne’s request to file sanctions. The court found that “Shure did not intend to breach its duty to disclose references” and that ClearOne’s request “nothing more than a thinly veiled attempt at a second bite at the apple,” which “would result in an inefficient proceeding.” The Federal Circuit then held that the PTAB’s procedures were sufficient to meet ClearOne’s due process rights.

CommScope Techs. LLC v. Dali Wireless Inc.

10 F.4th 1289 (Fed. Cir. 2021)

CommScope sued Dali in the Northern District of Texas for alleged infringement of five of CommScope’s telecommunication patents. Dali counterclaimed, alleging CommScope infringed two of Dali’s patents also relating to telecommunications technology. The jury rendered a verdict of infringement for both CommScope and Dali. The district court denied both parties’ motions for judgment as a matter of law, and denied CommScope’s motion for a new trial and request for attorneys’ fees. CommScope appealed and Dali cross-appealed to the Federal Circuit.

The decision focused on just one of Dali’s asserted patents, the ’521. The Court chided Dali for arguing different standards for infringement and anticipation, stating that it fell “squarely within the principle that a patent may not, like a nose of wax, be twisted one way to avoid anticipation and another to find infringement.” Dali also had an argument rejected because it was “confined to a footnote.” The Court further chided Dali for unsupported hyperbole when it argued that the lower court’s claim construction was “literal nonsense.”

Noting that the positions Dali took for infringement and invalidity were incompatible, the Court reversed the denial of the motion for judgment as a matter of law, effectively reversing the judgment of infringement.

CosmoKey Sols. GmbH & Co. KG v. Duo Security LLC

15 F.4th 1091 (Fed. Cir. 2021)

In this appeal from the District of Delaware, the Federal Circuit reversed the district court’s judgment on the pleadings and held that the claims at issue were patent-eligible under the *Alice* framework.

CosmoKey owns the ’903 patent, titled “Authentication Method.” The authentication works as follows: the user activates the authentication function on his/her mobile device, the function is detected as active, and the authentication function is then deactivated. The specification purports to improve existing mobile phone authentication methods by reducing the complexity of the function and enhancing security (by creating a limited time window in which authentication may occur). CosmoKey sued Duo Security, Inc. for infringement of this patent. Duo Security moved for judgment on the pleadings under Federal Rule of Civil Procedure 12(c), and the district court granted that motion. The district court explained that the claims failed the *Alice* two-step framework. At step one, the court concluded that the claims were “directed to the abstract idea of verifying identity to permit access to transactions.” Then, at step two, the court concluded that the patent merely taught functionality to perform the abstract concept. CosmoKey appealed.

On appeal, the Federal Circuit reversed the district court, holding that the claims were eligible under 35 U.S.C. § 101. First, the Court described various cases in which it had considered the eligibility of claims related to authentication and explained that “claims directed to specific verification methods that depart from earlier approaches and improve computer technology” have been held to be eligible if they involve a specific technique that solves a specific problem. Then, after suggesting that it disagreed with the district court’s “broad characterization” of the focus of the claimed advance, describing it with greater specificity, the Federal Circuit explicitly chose not to answer the question of whether that characterization would be an “abstract idea” or a “specific improvement.” Instead, the Federal Circuit jumped ahead to step two of the *Alice* inquiry and held that the patent claims described a “specific improvement to authentication that increases security, prevents unauthorized access by a third party, is easily implemented, and can advantageously be carried out with mobile devices of low complexity.” The Court expressly rejected the district court’s reasoning that the last four steps in the claim were well understood and conventional, explaining that the claimed steps did not exist in the prior art and provided advantages over the prior art.

Judge Reyna filed a concurring opinion that found the claims patent-eligible under step one of the *Alice* analysis, rather than step two. He argued that skipping step one is impermissible. He also argued that the majority’s reasoning—that the claims “recite a *specific improvement to authentication*”—was actually relevant at step one.

Data Engine Techs. LLC v. Google LLC

10 F.4th 1375 (Fed. Cir. 2021)

Data Engine Technologies (DET) sued Google, alleging that Google’s web-based spreadsheet program Google Sheets infringed patents directed to “three-dimensional spreadsheets.” In a previous appeal, the Federal Circuit reversed and remanded the district court’s grant of judgment on the pleadings to Google under § 101, in part because of DET’s arguments that “three-dimensional” spreadsheets were a “distinct improvement” and the invention applied only to them.

On remand, the district court reopened claim construction for the preamble term “three-dimensional spreadsheet.” The court construed it as requiring a “mathematical relation among cells on different spreadsheet pages,” and subsequently granted Google’s motion for summary judgement of noninfringement.

DET argued on appeal that the preamble term “three-dimensional spreadsheet” was not limiting. The Federal Circuit rejected that argument because of DET’s prior argument that a “three-dimensional” spreadsheet was the “distinct improvement” allowing it to overcome the district court’s § 101 rejection, and, thus, it must have patentable weight. DET argued secondly that a “three-dimensional spreadsheet” did not require a “mathematical relation” among cells of different pages. This argument was rejected over statements in the prosecution history. During prosecution, DET attempted to distinguish prior art Lotus 1-2-3 by creating an “explicit definition of a ‘true’ three-dimensional spreadsheet” which included, in the applicant’s words, “a mathematical relation among cells on the different pages.” DET’s only argument to the contrary was a later, more ambiguous statement that Lotus 1-2-3 was in fact a three-dimensional spreadsheet, so that could not have been the basis of allowance.

The Federal Circuit’s holdings caution that statements in prior proceedings regarding claim scope can certainly be applicable in later proceedings, even if the issues are not identical. Similarly, that arguably gratuitous statements made during prosecution, if sufficiently precise, can work an estoppel nonetheless.

DBN Holding, Inc. v. Int’l Trade Comm’n

26 F.4th 1363 (Fed. Cir. 2022)

Appellants DBN Holding, Inc. and BDN LLC (together, “DBN”) appealed the ITC’s denial of their challenge to a civil monetary penalty after violating a consent order issued by the ITC, which prohibited importing “any two-way global satellite communication” apparatus, “until the expiration, invalidation, and/or unenforceability of” the ’380 patent. DBN had signed the consent order in exchange for terminating the Section 337 investigation regarding the ’380 patent. DBN subsequently violated the consent order, and the ITC imposed a civil penalty in the amount of \$6,242,500 on DBN. Prior to this appeal, the Federal Circuit affirmed the District Court for the Eastern District of Virginia’s determination that the relevant claims of the ’380 patent were invalid. On that basis, DBN petitioned for modification or rescission of its civil penalty under Section 210.76. The ITC

initially denied the petition, and DBN subsequently appealed. On remand, the ITC again found that the penalty was appropriate. DBN then filed the current appeal.

The Federal Circuit reviewed the ITC's denial of DBN's petition for abuse of discretion. The Court rejected DBN's argument that the ITC decision misapplied the relevant case law. First, the Court distinguished the main authority cited by DBN, finding that the cited case (*Magnets*) involved a retroactive settlement license where the consent order in this case had a forward-looking "invalidation trigger" and, thus, "DBN remained potentially liable for any violations up to the time of invalidation."

Next, the Court rejected DBN's argument for reversal under that the six-factor test under the *EPROMS* case (i.e., "(1) the good or bad faith of the respondent, (2) the injury to complainant, (3) respondent's ability to pay, (4) the extent to which respondent has benefited from its violations, (5) the need to vindicate the authority of the Commission, and (6) the public interest."). The Court found that a good-faith belief that the underlying patent would be invalidated was not sufficient to show a lack of bad faith in violating a consent order. With respect to the fourth factor, the Court rejected DBN's assertion that they "[could] not be deemed to have benefitted from its violations (which were patent infringements) because the subsequent invalidation ... negated all such infringement," stating that this view neglected the contractual nature of the consent order. With respect to the fifth and sixth factors, the Court found that the ITC's enforcement of the order was a "reasonable exercise of its enforcement authority," and that deterring conduct violating agency orders was in the public interest. Accordingly, the Federal Circuit affirmed, concluding that the agency did not abuse its discretion in denying DBN's petition to rescind or modify their civil penalty.

Eli Lilly & Co. v. Teva Pharms. Int'l GmbH

8 F.4th 1331 (Fed. Cir. 2021)

Eli Lilly and Company ("Eli Lilly") challenged three of Teva Pharmaceuticals ("Teva")'s patents in IPR: '045, '907, and '908, directed to methods of using humanized antagonist antibodies that target calcitonin gene-related peptide ("CGRP") in *inter partes* review. Eli Lilly argued that the patents would have been obvious in light of three prior art sources, including a clinical trial, a publication, and an established method of altering antibodies to more easily inject monoclonal antibodies into humans. After the PTAB denied the petition, Eli Lilly appealed, and the Federal Circuit reviewed de novo.

The Federal Circuit upheld all three patents as nonobvious because Eli Lilly failed to prove that a POSITA would have a reasonable expectation that the claimed migraine treatment would be effective. The Court rejected Eli Lilly's arguments that: (1) the claim preambles were nonlimiting; (2) the PTAB erred when it required proof of a reasonable expectation of success rather than only proof that a skilled artisan would have been motivated to combine the prior art references; and (3) even if that standard was correct, it was incorrectly applied by the PTAB.

The Federal Circuit found the preamble to be limiting because, unlike apparatus and composition claims, claims to methods of using apparatuses or compositions typically focus on the intended purpose of the method. The court stated, “we have generally construed statements of intended purpose in such method claims as limiting.” The Federal Circuit found that the PTAB did not err when it required proof of a reasonable expectation of success because the claims were written in a “‘method for treating’ format and comprise[d] a single step of administering an effective amount of a compound.” This distinction made the case analogous to *Novartis Pharmaceuticals Corporation v. West-Ward Pharmaceuticals International Ltd.*, 923 F.3d 1051 (Fed. Cir. 2019), which established that patent challenges in such cases must prove not only motivation to combine the prior art references, but also a reasonable expectation of success in administering the claimed combination for the claimed treatment. Finally, the Federal Circuit found that the PTAB correctly applied that standard because it did not, as Eli Lilly argued, require efficacy data to prove reasonable expectation of success. Instead, the PTAB simply noted the lack of efficacy data as a part of its obviousness analysis. The Federal Circuit found that the PTAB correctly weighed each side of the factual dispute before finding that sufficient uncertainty and unpredictability of success remained to support nonobviousness.

Energy Heating, LLC v. Heat On-The-Fly, LLC
15 F.4th 1348 (Fed. Cir. 2021)

Energy Heating, LLC brought an action against Heat On-The-Fly, the patent owner and licensee of the '993 patent, a patent related to heated water for use in hydraulic fracturing. Energy Heating sought declaration that the patent was unenforceable due to inequitable conduct. The District Court for North Dakota ruled the patent unenforceable, denied the defendant's motion for renewed judgment as a matter of law on jury verdict, and denied attorneys' fees for Energy Heating. On appeal before the Federal Circuit, the Court affirmed the lower court's finding of patent unenforceability and vacated and remanded the judgment regarding the attorneys' fees. On remand, the lower court found the case exceptional under Section 285 and awarded attorneys' fees to Energy Heating. In this case, the issue on appeal is the district court's exceptionality determination under Section 285.

Heat On-The-Fly challenged the exceptionality determinations on grounds that: (1) the lower court relied on an erroneous factual finding, (2) the lower court failed to properly weigh the relevant factors, and (3) the lower court failed to properly apply the law. Reviewing for an abuse of discretion, the Court rejected Heat On-The-Fly's arguments and affirmed the lower court's findings. First, the Court found that the district court's judgment that Heat On-The-Fly “made representations in bad faith that it held a valid patent” was within the lower court's equitable discretion to consider. The Court further rejected that the jury's finding that Heat On-The-Fly did not commit the tort of deceit meant that the Heat On-The-Fly did not engage in inequitable conduct, as this finding has no bearing on inequitable conduct. Second, the Court found that the lower court correctly weighed the relevant factors, including the “strength or weakness of the litigation position, the absence of a finding of litigation misconduct, and the PTO's subsequent allowance of certain continuation patents claiming priority to the '993 patent.” The Court noted that the lower court provided ample support for its conclusions as to these factors and properly considered

the totality of the circumstances when it found that the defendant litigated the case in an unreasonable manner. Lastly, the Court found that there was no abuse of discretion in the district court's application of the relevant law as, contrary to Heat On-The-Fly's argument, the district court did not view an inequitable conduct finding as mandating a finding of exceptionality. Although the Court had the authority to award appellate fees, it declined to consider the merits of this request given that it was premature under Federal Circuit Rule 47.7 (requiring that the application must be made within thirty days *after* entry of judgment).

Evolution Concepts, Inc. v. HOC Events, Inc.

22 F.4th 1361 (Fed. Cir. 2022)

Evolution Concepts, Inc. ("Evolution") owned a patent for a device and method for converting a semi-automatic rifle with a detachable magazine to one with a fixed magazine; the stated purpose in the patent's specification for fixing the magazine to the rifle was to circumvent a proposed piece of legislation in Congress that would have banned semi-automatic firearms with detachable magazines. Evolution sued Juggernaut Tactical, Inc. ("Juggernaut") for infringement based on Juggernaut's manufacture and sale of its "Hellfighter Mod Kits," which convert a firearm with a detachable magazine to a firearm with a fixed magazine.

On the parties' cross-motions for summary judgment regarding infringement, the parties only disputed the meaning of the term "magazine catch bar" in the asserted patent; specifically, whether that term would include a factory-installed catch bar. The district court, relying primarily on a single sentence in the specification, found that the disputed term would not include a factory-installed catch bar, and awarded summary judgment of noninfringement to Juggernaut, as Juggernaut's modification kits used the factory-installed catch bar.

On appeal, the Federal Circuit disagreed with the district court's construction of the disputed term. Specifically, the Federal Circuit disagreed with Juggernaut's argument that because the disputed term recited "a magazine catch bar," and not antecedent basis language such as "the" or "said," that the disputed term could not include a factory-installed catch bar. The Federal Circuit held that the use of the term "a," "by its ordinary meaning, could be either the removed [factory-installed] catch bar or a new or different catch bar." As such, accepting Juggernaut's interpretation "would amount to reading additional limitations into [the] claim ... not required by its language." Ruling as such, the Federal Circuit reversed the grant of summary judgment to Juggernaut and the denial of summary judgment to Evolution and remanded to the district court.

Fleming v. Cirrus Design Corp.

28 F.4th 1214 (Fed. Cir. 2022)

On appeal from *inter partes* review proceeding, Patentee sought review of PTAB's determination that the challenged patent was invalid due to obviousness, and denial of

motion to amend the challenged claims. The Federal Circuit Court reviewed and affirmed the Board's determinations.

The challenged patent claimed an "intelligent ballistic parachute system" capable of determining whether "a pre-activation action must be performed before deploying the parachute," such as increasing altitude or reducing speed. Patentee contended that neither of the references in the combination that the PTAB found invalidating disclosed commanding an autopilot to perform specific actions upon receipt of a parachute deployment request, including "increasing pitch" or "changing altitude." The Federal Circuit found that substantial evidence supported the PTAB's finding that, while neither reference of the proposed combination explicitly disclosed these limitations, a POSITA would nonetheless be motivated to implement these actions to "ensure safety" of the proposed combination. The Federal Circuit highlighted the "flexibility" in obviousness analyses required by *KSR v. Teleflex*, stating that "it is appropriate to consider the knowledge, creativity, and common sense of a skilled artisan in an obviousness determination."

Genuine Enabling Tech. v. Nintendo Co., Ltd.

29 F.4th 1365 (Fed. Cir. 2022)

Patentee appealed District Court finding of summary judgment of non-infringement of asserted patent directed to the combination of multiple data streams derived from user inputs to conserve computing resources in a computer. The District Court construed the claim term "input signal" to mean "signals above 500 Hz and excluding signals generated from positional change information, user selection information, physiological response information, and other slow-varying information." The District Court's decision was based on expert testimony offered by the patent challenger that patentee had disclaimed "slow varying" signals, such as "signals below the audio frequency spectrum," as "input signals" during prosecution, which the expert opined were signals below 500Hz.

The Federal Circuit reversed, finding that the District Court improperly relied upon extrinsic evidence to draw a bright line in claim scope at 500Hz, which was not a "clear and unmistakable disavowal" of claim scope based on patentee's disavowal of "slow varying" signals. The Federal Circuit found "undue reliance" on extrinsic evidence over the language of the claims, cautioning that extrinsic evidence "might have been selectively plucked from the unbounded universe of potentially relevant material to advance a litigants position." Accordingly, the Federal Circuit concluded that the District Court erred in crediting patent challenger's expert testimony, because the expert "relied on extrinsic evidence upon extrinsic evidence to draw a bright line in claim scope not suggested anywhere in the intrinsic record."

GlaxoSmithKline LLC v. Teva Pharms. USA, Inc.

7 F.4th 1320 (Fed. Cir. 2021)

GSK sued Teva in the District of Delaware for infringement of GSK's '000 patent. The '000 patent is a reissue of GSK's '069 patent, which was a method of treatment with the

medicinal product “carvedilol” claimed by GSK in its ’067 patent. The ’000 patent is a method of decreasing mortality from congestive heart failure (CHF) by administering carvedilol with at least one other therapeutic agent. In 2002, Teva applied for FDA approval of its generic carvedilol, certifying in the ANDA that its product would not be launched until the ’067 patent expired in 2007. Teva also certified, and notified GSK, that the ’069 patent was unenforceable, not infringed, or invalid for anticipation or obviousness. FDA tentatively approved for Teva’s generic drug to become effective on expiration of the ’067 patent. In 2003, GSK filed an application to reissue the ’069 patent, resulting in the ’000 patent at issue in this case.

In 2007, Teva launched its generic carvedilol with a “partial label” that included only carvedilol’s two non-CHF indications, but Teva’s press releases and marketing materials touted the product as “indicated for treatment of heart failure” and as a generic version of GSK’s brand-name drug. In 2011, following GSK’s delisting of the ’069 patent and pursuant to the FDA’s instruction, Teva amended its carvedilol label to be a “full label” that included the CHF indication.

After a trial, the jury found the patent valid and willfully infringed, and assessed damages. The district court subsequently granted Teva’s JMOL motion, stating that the induced-infringement verdict was not supported by substantial evidence. GSK appealed, Teva conditionally cross-appealed the damages verdict, and, in October 2020, the Federal Circuit reversed the grant of JMOL and reinstated the jury verdicts. Teva filed a petition for *en banc* rehearing, which the Court construed as also requesting panel rehearing. Teva argued that the panel decision could be broadly read to impose liability, in direct contravention of the Hatch-Waxman Act, on ANDA filers that carve out patented uses when seeking approval to market generics. Many *amici* also raised concerns. In order to “make clear how the facts of this case place it clearly outside the boundaries of the concerns expressed by *amici*,” the Court granted the petition for panel rehearing, vacated the October 2020 judgment, and withdrew the October 2020 opinion.

On rehearing, the Federal Circuit again vacated the grant of JMOL and reinstated the jury’s verdict and damages award. The Court emphasized that “substantial evidence supports a jury finding that the patented use was on the generic label at all relevant times and that, therefore, Teva failed to carve out all patented indications.” The Court agreed with GSK that substantial evidence supported the jury’s verdict that Teva’s partial label encouraged an infringing use (via the post-myocardial-infarction, left-ventricular-dysfunction indication) and that Teva’s marketing materials encouraged prescribing carvedilol in a manner that would cause infringement of the ’000 patent. The Court also agreed that substantial evidence supported the finding that Teva encouraged physicians to use its carvedilol for an infringing purpose (CHF) during the full-label period. Whereas the district court accepted as sufficient to overcome the jury’s verdict Teva’s argument that doctors knew to treat CHF using carvedilol long before Teva launched its generic, the Federal Circuit concluded that the jury had sufficient circumstantial evidence to conclude that Teva influenced doctors to prescribe carvedilol for the infringing use. Finally, the Court concluded that the district court did not err in its jury instructions on damages, so it sustained the damages verdict.

Judge Prost dissented, arguing that “no reasonable jury could have found (1) culpable intent to encourage infringement or (2) causation, much less both.” Judge Prost argued that, “by accepting the FDA-provided skinny label, which hewed to GSK’s patent declarations, Teva relied on GSK’s representations of patent scope.” Judge Prost stated that the majority weakened the intentional-encouragement requirements for labels, eviscerating the causation requirement, and creating confusion about skinny labels.

GlaxoSmithKline LLC v. Teva Pharms. USA, Inc.

25 F.4th 949 (Fed. Cir. 2022)

GSK sued Teva Pharmaceuticals after it marketed a generic version of carvedilol, a drug which GSK had patented for use in treating congestive heart failure. GSK’s patent on carvedilol expired in 2007, and Teva had marketed their product with a “skinny” label advertising only non-patented uses (in this case, treatment for left ventricular dysfunction following myocardial infarction). GSK suggested that portions of Teva’s skinny label could be “pieced together” to suggest the patented use for congestive heart failure, demonstrating Teva’s intent to induce infringement. After the jury found for GSK, the federal district judge set aside the verdict and GSK appealed. A Federal Circuit panel reinstated the verdict as supported by substantial evidence. The Court denied Teva’s petition for rehearing en banc.

Amici submitted briefs noting that “most skinny labels contain language that (with clever expert testimony) could be pieced together to satisfy a patent claim.” The dissenters argued that under the Hatch-Waxman Act’s skinny-label provisions (21 U.S.C. § 355(j)(2)(A)(v)), generic drugs must contain the same label as the name-brand version and can only omit aspects of labelling protected by the patent, which is up to the brand (here, GSK) to specify. For its part, the concurrence suggested that Teva had never raised the incompatibility between FDA regulations mandating the skinny label and patent law as an issue on appeal, an assertion the dissenters strongly contested. Chief Judge Moore admitted in her concurrence that she was “troubled” by GSK’s representations to the FDA, which confirmed that the only patented use of the drug was for congestive heart failure, and being “at odds with its enforcement efforts in this case.” Judge Moore suggested that the district court should consider Teva’s affirmative defense of equitable estoppel on remand as a result of these representations.

Google LLC v. IPA Techs. Inc.

34 F.4th 1081 (Fed. Cir. 2022)

Google LLC (“Google”) filed three petitions for *inter partes* review of the ’115 and ’560 patents. The inventors of the ’115 and ’560 patents are Martin and Cheyer. Google argued that the challenged claims were obvious over a reference by Martin, Cheyer, and Moran. According to Google, the Martin reference was prior art as work “by others” because it described the work of an inventive entity (Martin, Cheyer, and Moran) different from the inventive entity of the challenged patents (Martin and Cheyer). The PTAB instituted review, but, after the trial, found that Google had not shown that Moran’s contribution established he was an inventive entity with respect to the Martin reference. Because each

Google's grounds relied on the Martin reference, the PTAB found that Google had not shown the challenged claims to be unpatentable. Google appealed.

The Federal Circuit vacated the PTAB's decision, remanding the case for further proceedings. The Court explained that Google had the burden to show that the Martin reference was prior art "by another." The Court found that the PTAB failed to resolve conflicting testimony between Martin, Cheyer, and Moran. The Court stated that the PTAB erroneously rejected Moran's testimony the basis that it was insufficiently corroborated. However, the Court explained that the record contained more than adequate evidence of corroboration and, thus, the PTAB needed to resolve whether Moran's testimony should be credited over Cheyer and Martin. Finally, the patent owner argued that Google's argument should nevertheless be rejected because it is inconsistent for Google to argue Moran contributed invalidating subject matter to the Martin reference even though Moran is not a named inventor on the challenged patents. The Court rejected the patent owner's argument, finding the patent owner could not raise this defense without actually seeking a correction of inventorship to add Moran as an inventor.

Hunting Titan, Inc. v. DynaEnergetics Europe GmbH
28 F.4th 1371 (Fed. Cir. 2022)

During *inter partes* review proceeding, PTAB found the challenged patent invalid as both anticipated and obvious. Patentee moved to amend to add substitute claims, which patentee challenged opposed on only obviousness grounds. The PTAB denied patentee's motion to amend on the grounds that the proposed substitute claims were anticipated. Patentee sought Precedential Opinion Panel (POP) review of PTAB's decision, which was granted to determine "under what circumstances and at what time during an *inter partes* review the Board may raise a ground of unpatentability that a petitioner did not advance or insufficiently developed against substitute proposed claims in a motion to amend." On POP review, the Panel vacated the PTAB's decision denying leave to amend because patent challenger had not shown that the proposed substitute claims were invalid. Both parties appealed the decision to the Federal Circuit.

On appeal, the Federal Circuit affirmed that PTAB's determination that the original claims were invalid. The Federal Circuit also affirmed that the PTAB's decision to deny patentee's motion to amend was properly vacated. The Federal Circuit began by confirming that the PTAB does not have "an affirmative duty, without limitation or exception, to *sua sponte* raise patentability challenges to a proposed substitute claim." However, the Federal Circuit then addressed when the PTAB "*should*" raise such challenges, agreeing with the Panel that the PTAB *should* raise such challenges "where certain evidence of unpatentability has not been raised by the petitioner, but is readily identifiable and persuasive such that the *1382 Board should take it up in the interest of supporting the integrity of the patent system."

Hyatt v. Hirshfeld

16 F.4th 855 (Fed. Cir. 2021)

In this appeal from the District Court for the District of Columbia, the Federal Circuit both affirmed the district court’s denial of expert fees and vacated its award of attorney’s fees.

After the PTO denied Hyatt’s patent application, Hyatt sued the PTO in district court to challenge its decision. The PTO moved to dismiss for prosecution laches, but the district court rejected that motion and ordered the PTO to issue a patent to Hyatt. The PTO appealed. While the appeal was pending, Hyatt sought attorney’s fees, and the district court granted that motion in part. However, after that decision, the Federal Circuit vacated and remanded the earlier decision regarding the patent application (*Hyatt I*) based on the PTO’s theory of prosecution laches. Based on that decision, the PTO argued at the district court that it should be reimbursed for its expert witness fees, and the district court denied expert fees. The PTO appealed, and also argued that, after the Federal Circuit’s decision in *Hyatt I*, Hyatt was not a prevailing party and therefore was not entitled to the attorney’s fees that were previously awarded to him.

On appeal, the Federal Circuit first vacated the district court’s holding that Hyatt was entitled to attorney’s fees because Hyatt was no longer a prevailing party. It then considered whether 35 U.S.C. § 145, which requires a patent applicant to pay for “[a]ll the expenses of the proceedings,” requires the patent applicant to pay the PTO’s expert witness fees. Like the district court, the Federal Circuit held that the statute was not “sufficiently specific to overcome the presumption against fee-shifting.” The Court emphasized the strength of the American Rule’s presumption against fee shifting and then applied the reasoning of the 1870 case *NantKwest, Inc. v. Iancu*, 898 F.3d 1177 (Fed. Cir. 2018), in which the Federal Circuit held that the term “expenses” in 35 U.S.C. § 145 (the language and statute at issue in this case) did not cover attorney’s fees. While the Court acknowledged that this case was closer than *NantKwest*, it ultimately found that the reasons provided in that case—first, that the definition of expenses does not provide specific guidance, second, that the Latin phrase that is similar to the phrase “expenses of the proceeding” would not have included attorney’s fees, and, third, that Congress in other statutes referred to attorney’s fees explicitly when it wanted to shift them—applied to expert fees as well. The Court discussed and rejected multiple arguments made by the PTO, including those based on (1) dicta in other cases implying that the term “expenses” could overcome the American Rule for expert fees, (2) the district courts’ historical practice of awarding witness fees under the statute, (3) cases in which the term “expenses” was interpreted to include expert fees for other statutes, (4) legislative history implying that Congress meant different things by the terms “expenses” and “costs” in this statute specifically, and (5) the potential negative ramifications of denying expert witness fees under the statute. Ultimately, the Court refocused on the fact that the inquiry is only about the specificity and explicitness of the statute as it relates to expert fees and reiterated that “the statutory text is not sufficiently specific and explicit to overcome the presumption against shifting fees.”

In re Juniper Networks, Inc.

14 F.4th 1313 (Fed. Cir. 2021)

Juniper Networks petitioned for a writ of mandamus directing the District Court for the Western District of Texas to transfer six consolidated actions to the Northern District of California pursuant to 28 U.S.C. § 1404(a). This case does not deal with the underlying claims between the litigants--alleged patent infringements--but rather with the narrow question of whether the case should have been transferred from Western District of Texas to the Northern District of California. The district court denied the transfer motion because it was not established that the Northern District of California was clearly the more convenient forum.

The Federal Circuit reversed the district court's decision in a per curiam opinion and granted Juniper's transfer petition by issuing the writ of mandamus. The Northern District of California was "a clearly more convenient forum than the Western District of Texas" for four specific reasons.

First, Juniper's products were designed and developed from their headquarters in California's Northern District. 11 witnesses were located in that area compared to only one in the Western District of Texas. The Federal Circuit took specific aim at the district court's assertion that only a few of the witnesses were likely to testify, and that the ease of accessing witnesses should thus be accorded less weight in the transfer analysis. As to this argument, the Federal Circuit remarked that "we have previously rejected the district court's reliance on the proposition that the convenience-to-the-witnesses factor is attenuated when the witnesses are employees of the party calling them."

Second, the local interest factor weighed in favor of the Northern District of California. None of the events giving rise to the patent infringement occurred in the Western District of Texas; rather, they occurred in the Northern District of California. That Juniper had a general presence in the Western District of Texas was not enough to establish a local interest sufficient to have the case remain located therein. Moreover, the party that lodged the suit and opposed the transfer motion--Brazos--had an insubstantial presence in the Western District of Texas.

Third, the Federal Circuit held that the lower court erred in finding that the potential need for recourse to compulsory process weighed against transfer, particularly in light of the significant number of witnesses existing in the Northern District of California, and none in the Western District of Texas.

Fourth and final, the Federal Circuit concluded that the lower court's weighing of the "court-congestion" factor, holding it in favor of the Western District of Texas, was inadequate. Indeed, the Federal Circuit did "not regard the relative speed with which this case might be brought to trial . . . to be of particular significance."

In re Maxpower Semiconductor, Inc.

13 F.4th 1348 (Fed. Cir. 2021)

In 2007, MaxPower and ROHM Semiconductor entered into a technology license agreement that included a provision that the parties would arbitrate any dispute arising out of it. When MaxPower notified ROHM of their intent to arbitrate an allegation of patent infringement, ROHM filed a motion for declaratory judgment of noninfringement of the four patents and four *inter partes* review petitions concerning those patents in the Northern District of California. The Northern District of California proceeded to compel arbitration and dismissed the case. Months later, the Board instituted ROHM's four *inter partes* review petitions, holding that "the arbitration clause is not a reason to decline institution."

MaxPower appealed the PTAB's determination to institute *inter partes* review proceedings, rather than arbitrate a dispute involving four MaxPower patents. Alternatively, MaxPower sought a writ of mandamus to review the decisions. However, the majority held that determinations to institute *inter partes* review are nonappealable under 35 U.S.C. § 314(d). The majority likewise held that MaxPower did not adequately show that the collateral order doctrine nor 9 U.S.C. § 16(a)(1) granted the Federal Circuit jurisdiction to hear an appeal on the matter either. Finally, the majority concluded that MaxPower had not sufficiently shown that the mandamus petition was "not merely a means of avoiding the statutory prohibition on appellate review of agency institution decisions." Since MaxPower did not demonstrate that the Board had "clearly and indisputably exceeded its authority," the matter was not eligible to be subject to a writ of mandamus.

Judge O'Malley concurred in the majority's judgment of nonappealability but dissented from denying the writ of mandamus. In dissenting from the denial of mandamus relief, Judge O'Malley focused on 35 U.S.C. § 294, a section ignored by the majority. In dissent, she noted that denying the writ constituted "a new caveat to Congress's clear instruction that agreements to arbitrate patent validity shall be 'valid, irrevocable, and enforceable'— i.e., except during *inter partes* review."

In Re SurgiSil, L.L.P.

14 F.4th 1380 (Fed. Cir. 2021)

In *In re SurgiSil*, SurgiSil appealed the decision of the PTAB affirming the rejection of SurgiSil's design patent application, No. 29/491,550. On appeal, the Federal Circuit reversed the PTAB and held that a claimed design is limited to the particular article of manufacture identified in the claim. The Court held that the design of an earlier tool (a "stump" designed for smoothing pastel and charcoal) did not anticipate SurgiSil's lip implant, even though the shape of the stump and SurgiSil's implant were nearly identical, because "a design claim is limited to the article of manufacture identified in the claim; it does not broadly cover a design in the abstract." Because the patent for the stump depicts and describes a stump to be used by artists, and not a lip implant to be used by cosmetologists like that depicted and described in SurgiSil's patent filing, the Board's anticipation finding rested on an erroneous interpretation of the claim's scope.

In re Violation of the Revised Protocols for In-Person Arguments & Related Order
26 F.4th 1270 (Fed. Cir. 2022)

The Court found that three members of the Federal Circuit bar violated the Court’s Revised Protocols for In-Person Arguments (August 12, 2021) limiting in-person appearances due to COVID-19, which state that only one arguing attorney and one assisting attorney can enter the Court’s premises for oral argument on behalf of a party. The Respondents (two partners and a special counsel) had filed a petition seeking leave to bring additional attorneys to the oral argument. Despite this Court’s denial of leave, on the day of the argument, the Respondents entered the courthouse to seek verbal permission. The Court found that the attorneys’ actions were unreasonable given that their earlier written petition had been denied but declined to impose sanctions in light of Respondents’ “earnest remorse.” The Court concluded that “the bar is on notice that this court takes compliance with these protocols very seriously and that sanctions will likely be imposed if a future violation of the protocols takes place.”

In re VIVINT, INC.

14 F.4th 1342 (Fed. Cir. 2021)

After the Patent Office denied Alarm.com’s IPR petition under Section 325(d) as “undesirable, incremental petitioning,” Alarm.com repackaged the same invalidity grounds into a request for ex parte reexamination, which was granted. The Patent Office denied patentee Vivint’s petitions to terminate the ex parte reexamination proceedings and ultimately held the challenged claims of Vivint’s patent invalid. Vivint appealed to the Federal Circuit.

Vivint offered two arguments on appeal. First, Vivint argued that because Alarm.com’s ex parte reexamination request was duplicative of its previously denied IPR petition, the grounds could not present a “new” question of patentability as required by the statute governing ex parte reexamination. The Federal Circuit rejected this argument, noting that although the text of 35 U.S.C. § 303(a) “provides little guidance on the meaning of the word new in the phrase ‘substantial new question of patentability,’” and that the broader statutory text, like the Manual of Patent Examining Procedure, clarifies that a question of patentability is new until the merits have been considered. Because the question of patentability had never been decided on the merits, the Federal Circuit rejected Vivint’s argument.

Vivint also argued that the Patent Office abused its discretion and acted arbitrarily and capriciously by ordering and refusing to terminate ex parte reexamination on the same grounds it had previously identified as duplicative under Section 325(d). The Federal Circuit agreed, finding that because Section 325(d) applies equally to IPR petitions and requests for ex parte reexamination, there was no rational basis for refusing to institute the grounds in one proceeding but granting the same request under the same standard in another. The Federal Circuit also disagreed with the Patent Office that it lacked the power to terminate the reexamination proceeding under Section 325(d) after institution,

concluding that denial of Vivint’s petition to terminate on this supposed procedural ground was thus arbitrary as well.

The Federal Circuit highlighted that its ruling was “limited.” The Court noted that the Director still had the authority to launch an ex parte reexamination “[o]n his own initiative” under § 303(a), even if the behavior of a particular challenger—like Alarm.com—suggests the Patent Office should reject the reexamination petition. Thus, the Court’s opinion leaves open the possibility that in the future, the Director may independently find that the public interest supports granting ex parte reexamination of a patent under identical circumstances.

In re Volkswagen Grp. of Am., Inc.
28 F.4th 1203 (Fed. Cir. 2022)

In two separate actions, Plaintiff sued Defendants in the United States District Court for the Western District of Texas before Judge Alan Albright, alleging that “infotainment” features in Defendants’ vehicles infringed claims of seven asserted patents. Defendants motioned to dismiss or transfer based on improper venue. The District Court denied Defendants’ motion, finding that the existence of independently owned and operated dealerships selling Defendants’ vehicles were located in the district, which was sufficient to establish that Defendants had a “regular and established place of business” in the District. Defendants petitioned the Federal Circuit for mandamus relief to dismiss or transfer the cases.

The Federal Circuit determined that the presence of independent dealerships in the District did not compel the conclusion that Defendants had a “regular and established place of business” in the District, where Plaintiff had not shown that the independent dealerships were acting as agents of defendants. The Federal Circuit focused on the absence of contractual relationships between Defendants the independent dealerships granting Defendants “interim control” over the provision of services by the dealerships, as opposed to contracts which “merely provide constraints on how a service is provided.” The Federal Circuit concluded that, because Defendants “do not have the right to control the day-to-day operations of the dealerships,” their presence in the District was insufficient to establish that proper venue for Defendants themselves in the District.

Plaintiff argued that the dealerships served as the agents of Defendants for the purpose of selling their vehicles to consumers in the area. However, the Circuit Court challenged this assertion questioning whether the Defendants possessed the requisite control over the dealerships, namely the right to provide interim instructions. The Circuit Court held that the contractual agreement between the Defendants and dealerships in which the Defendants made demands that assured basic quality assurance did not rise the level of giving instructions. The Court found that the corporation’s were not permitted to make instructions regarding the day-to-day operations of the dealerships and therefore could not be said to be their principle.

Accordingly, the Circuit Court vacated the determination of the lower court and remanded the case for further proceedings.

Intel Corp. v. Qualcomm Inc.

21 F.4th 784 (Fed. Cir. 2021)

Intel petitioned for IPR of Qualcomm’s ’043 patent, which concerns the receiving end of radio frequency communication systems. At the PTAB, Intel proved unpatentable some of the challenged claims, including some Qualcomm conditionally proposed as amended claims. Intel appealed the PTAB’s determinations regarding the surviving claims.

The Federal Circuit held that Intel had standing under the Constitution to appeal, despite the fact that Intel had not actually been sued by Qualcomm, because Qualcomm had mapped the patent claims to an Intel product in a prior suit against Apple. The Federal Circuit upheld the PTAB’s claim construction of “radio frequency input signal” as referring only to the radio frequency that is received before down conversion, based on the context of the claims and specification.

The Federal Circuit rejected one of Intel’s challenges to the PTAB’s obviousness determination, and accepted the second. The first challenge, based on the originally challenged claims, was that the Board had not satisfactorily explained why a skilled artisan would not have combined two prior art references. The Federal Circuit rejected this argument, stating that the Board had satisfactorily explained that combining the two technologies would have impaired one of the technologies for “the majority of operation.”

The second challenge, which was based on the substitute claims, was that substantial evidence did not support the Board’s determination that a skilled artisan would have lacked reason to combine two other prior art references. The Federal Circuit accepted this challenge. The Court disagreed with the Board’s conclusion that increased energy efficiency was too generic of a motive to encourage combination. The Court disagreed with the Board’s conclusion that Intel relied on “impermissible hindsight” to read a solution to an existing problem into prior art. Finally, the Court disagreed with the Board’s conclusion that using prior art in the way that Intel suggested would render it “unsuitable for its intended purpose.” The Court remanded for further proceedings.

Intel Corp. v. Qualcomm Inc.

21 F.4th 801 (Fed. Cir. 2021)

Intel challenged Qualcomm’s ’949 patent, which claims a system that retrieves an executable software image from one processor and loads it for use by a second processor, as obvious in three IPRs. The PTAB consolidated all three IPRs and held that Intel successfully proved some claims of the ’949 patent were invalid. Intel appealed, seeking to prove that the remaining claims were also invalid. For some of the claims, Intel disputed the PTAB’s claim construction, and for other claims, Intel argued that the PTAB erred by finding the claims not indefinite.

The PTAB held that some of the claims of the ’949 patent were valid based on its claim construction of “hardware buffer,” which the PTAB interpreted to exclude temporary buffers over Intel’s arguments for a broader claim construction. The hardware buffer refers

to an element of the second processor from which an image is loaded for use. For other claims, the PTAB rejected Intel's obviousness challenge based on its understanding that the terms of the claims were indefinite, precluding the PTAB from making a validity determination.

On appeal, the Federal Circuit vacated and remanded for reconsideration of all of the remaining claims of the '949 patent. The Federal Circuit first ruled that the PTAB failed to sufficiently analyze the '949 patent specification to reach a confident claim construction of "hardware buffer" and did not adequately articulate its decision to exclude temporary buffers from its claim construction. The PTAB failed to explain why it specifically distinguished the prior-art buffers by their temporal nature rather than by other significant characteristics. On these grounds, the Federal Circuit vacated and remanded for reconsideration of these claims. For the other claims, the Federal Circuit found that the PTAB erred by failing to sufficiently determine indefiniteness before rejecting the invalidity claims. A determination of invalidity is only precluded by indefiniteness when the indefiniteness renders it impossible for the PTAB to make such a determination. Thus, the Federal Circuit vacated and remanded for the PTAB's reconsideration, requiring the PTAB to first determine if these claims are actually indefinite and second, if their indefiniteness precludes a validity determination.

Intuitive Surgical, Inc. v. Ethicon LLC
25 F.4th 1035 (Fed. Cir. 2022)

Intuitive challenged the '969 patent in three *inter partes* reviews (IPRs) filed on the same day, each based on different prior art references: the Timm/Anderson IPR, the Giordano/Wallace IPR, and the Prisco/Cooper IPR. The PTAB instituted all three IPRs, but the Prisco/Cooper IPR was instituted a month after the others. As such, the Timm/Anderson IPR and Giordano/Wallace IPR reached final written decisions first, in which the PTAB upheld the claims as patentable. After the first two final written decisions, the patentee Ethicon moved to terminate Intuitive as a party in the Prisco/Cooper IPR, arguing that Intuitive was now estopped from challenging the '969 patent under Section 315(e)(1). The PTAB agreed that Intuitive was estopped, but also issued a decision on the merits upholding the claims. Intuitive appealed to the Federal Circuit, which affirmed the PTAB.

The estoppel provision provides that "[t]he petitioner in an *inter partes* review of a claim in a patent under this chapter that results in a final written decision.. may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that *inter partes* review." 35 U.S.C. § 315(e)(1). Intuitive argued that this provision does not apply to simultaneous proceedings by the same petitioner on the same patent claims, and that "the 14,000-word limit imposed on petitions necessitated three separate petitions" to fully convey all the possible arguments. The Court rejected this argument, saying it could not ignore the fact that per the text of § 315(e)(1) a petitioner is estopped after a final written decision, irrespective of when the appeal was filed. As the "master of its own petition," Intuitive could have been more concise or tried to consolidate multiple proceedings into a single

challenge. The Court also found that Intuitive did not have the right to maintain its appeal to the Federal Circuit on the merits of patentability after being properly terminated from the Prisco/Cooper IPR.

Invidior UK Ltd. v. Dr. Reddy's Lab'ys S.A.

18 F.4th 1323 (Fed. Cir. 2021)

The Federal Circuit affirmed the PTAB's decision that certain claims in Invidior's '454 patent, which was the fifth continuation to the '571 application, lacked written description support in the '571 application, and therefore, could not claim priority to the '571 application. As a result, Myers qualified as a prior art reference and anticipated certain claims of the '454 patent. The Court also affirmed the PTAB's decision that claim 8 of the '454 patent did have written description support in the '571 application.

The Federal Circuit agreed that claims 1-5, 7, and 9-14 of the '454 patent lacked written description support in the '571 application. The claims disclosed a range of the composition of film forming polymers. The Federal Circuit determined that there was no written description support in the '571 application for these ranges, because the specific, particular examples provided in the '571 application did not constitute ranges. The Court stated that "written description requires a statement of an invention, not an invitation to go on a hunting expedition to patch together after the fact a synthetic definition of an invention." The Court thus concluded that the PTAB's determination of no written description support was supported by substantial evidence.

DRL cross-appealed the finding that claim 8 of the '454 patent did have written description support in the '571 application. Although the single weight percentage was not set forth explicitly in the '571 application, the PTAB determined a POSITA could calculate the polymer weight. The Court affirmed the PTAB out of deference for its fact finding, despite the slight inconsistency between this determination and the determination the range claims were invalid. According to the Court, the slight inconsistency could be resolved because the valid claim described a single number rather than a range, and although there might be some inconsistency between this result and the above holding, the Court determined that substantial evidence supported the Board's decision.

Judge Linn partially dissented and argued that the claimed ranges in the '454 patent did in fact satisfy the written description requirement. He contended that the majority misread part of the '571 application, applied an "overly demanding standard" for ranges, and failed to follow indistinguishable precedent. He further argued that summing up values in a table and dividing the aggregate values by total weight is "well within the mathematical capabilities" of a person with a Master's or Ph.D. in pharmaceutical sciences determined to be the POSITA in the case.

Junker v. Med. Components, Inc.

25 F.4th 1027 (Fed. Cir. 2022)

Larry Junker, the inventor behind the D'839 patent, sued Medical Components, Inc. and Martech Medical Products, Inc for infringement. Medical Components argued that the claim was invalid under the on-sale bar created by 35 U.S.C. § 102(b) because a letter sent by Eddings, Mr. Junker's business partner, to Boston Scientific constituted a commercial offer for sale before the critical date. The district court for the Eastern District of Pennsylvania rejected the invalidity argument and found that Medical Components infringed Mr. Junker's D'839 patent claim, awarding him \$1,247,910 in damages. Medical Components appealed the damages award, the judgment of infringement, and the judgment of no invalidity. The Federal Circuit reversed the district court's finding of no invalidity and accordingly did not reach the other issues.

Mr. Junker began developing his introducer sheath (the subject of the D'839 patent) in the mid-1980s, eventually filing his patent application on February 7, 2000. As he could not manufacture the product himself, he partnered with Galt Medical to produce the sheath. Mr. Junker signed a nondisclosure agreement with Galt Medical's founder, James Eddings, in August 1998. On January 8, 1999 (almost one month before the critical date of February 7, 1999), Mr. Eddings sent a letter to Boston Scientific describing a "quotation" with prices and quantities for bulk shipment of the sheath. Both parties agreed that the sheath described in the later embodied the claimed design in the D'839 patent and that the design was ready for patenting. Hence, the only question left to resolve was whether the letter constituted a commercial offer for sale more than one year before the patent was filed. The district court held that this letter was merely a preliminary negotiation and not an offer because it included an invitation for the recipient to specify custom requirements for the product tailored to their particular needs.

Applying "traditional contract law principles," the Federal Circuit held that the letter did constitute an offer because it contained several necessary terms which are typical of commercial contracts, such as specific delivery conditions (here, "in bulk" and "non-sterile"), payment terms (a "net 30-day basis"), and payment options (a table laying out different price discounts if the order quantity is increased). If Boston Scientific had accepted any of these options, there would have been a binding contract. The Federal Circuit found that the invitation for custom sheath elements merely reflected a desire to do business in the future on different terms if necessary. Although the use of the word "quote" was an important factor cutting against invalidity, the Court reasoned that the precise label used for a communication is not controlling. A letter described as a "quote" can still be an "offer" if it has all the other necessary commercial terms.

Juno Therapeutics, Inc. v. Kite Pharma, Inc.

10 F.4th 1330 (Fed. Cir. 2021)

Juno Therapeutics sued Kite Pharma, arguing that Kite's cancer therapy using chimeric antigen receptor T cells (CAR-Ts) infringes Juno's '190 patent, which claims a nucleic acid polymer encoding a chimeric T cell receptor. After trial in district court, the jury

found that the '190 patent was valid and infringed. Kite moved for judgment as a matter of law (JMOL), which the district court denied. Kite appealed the district court's denial of its motion for JMOL.

On appeal, the Federal Circuit reversed the district court's denial of JMOL, finding that "no reasonable jury could find the '190 patent's written description sufficiently demonstrates that the inventors possessed the full scope of the claimed invention."

The Federal Circuit found that the '190 patent specification does not demonstrate that the inventors possessed the full scope of the claimed invention. The specification only disclosed *two* examples of targets and single-chain antibody variable fragments (scFv), which are part of the claimed chimeric T cell receptor, but the claims covered *any* scFv for *any* target. The Federal Circuit found that the '190 patent claimed a genus of scFvs without disclosing structural features common to the members of the genus or a representative sample of species within the genus. Without more, a person of skill would not be able to identify the species of scFvs capable of binding to the limitless number of targets as required by the claims. On that basis, the Federal Circuit reversed the district court's denial of JMOL. Juno filed a petition for a writ of certiorari to the Supreme Court, which remains pending.

Kannuu Pty Ltd. v. Samsung Elecs. Co.

15 F.4th 1101 (Fed. Cir. 2021)

The parties in this case entered into a nondisclosure agreement as part of business discussions regarding Kannuu's remote control search and navigation technology. This NDA contained a forum selection clause that required any legal action arising out of the business transaction to be docketed in state or federal court in Manhattan. The deal fell through, but years later, Kannuu sued Samsung for patent infringement. Samsung moved for *inter partes* review, but Kannuu filed a preliminary injunction motion compelling Samsung to withdraw the *inter partes* petition in light of the NDA's forum selection clause.

The Federal Circuit affirmed the district court's denial of Kannuu's motion for a preliminary injunction. Although Kannuu argued that the NDA should apply to Samsung's *inter partes* petitions because the petitions related to Samsung's misuse of Kannuu's confidential information and failure to license Kannuu's patents, neither the district court nor Federal Circuit were persuaded. Writing for the majority, Judge Chen wrote that they affirmed because "the connection between the two—the *inter partes* review proceedings and the NDA—is too tenuous for the *inter partes* review proceedings to be precluded by the forum selection clause." In essence, *inter partes* review was beyond the scope of the forum selection clause that both parties had originally agreed to.

Judge Newman dissented. She argued that the *inter partes* proceedings should still be subject to the forum selection clause because the NDA did not require that there be a patent license for the clause to apply. Rather, "the clause applies to 'any legal action . . . arising out of . . . this Agreement.'" Such broad contractual terms, Judge Newman insisted, clearly apply to "issues of validity of the patents on technology disclosed under the [NDA.]"

Kaufman v. Microsoft Corp.

34 F.4th 1360 (Fed. Cir. 2022)

Kaufman alleged Microsoft Corporation (“Microsoft”) infringed the ’981 patent. At the hearing on Microsoft’s summary judgment motion on noninfringement, Microsoft argued that the district court needed to resolve a claim construction dispute over “automatic” under *O2 Micro*. The district court believed the issue had been resolved and denied Microsoft’s motion for summary judgment, and the parties proceeded to trial. At trial, a jury awarded Kaufmann \$7 million in damages. After trial, the district court denied Microsoft’s motion for a new trial. The district court denied Kaufman’s motion to include pre-judgement interest because the jury verdict subsumed interest and Kaufman unduly delayed in bringing suit. Both parties appealed.

The Federal Circuit affirmed the district court’s denial of Microsoft’s motion for new trial. The Court found that Microsoft did not preserve its *O2 Micro* challenge because Microsoft did not request a construction of the disputed term during the *Markman* proceeding, did not include the dispute in its proposed jury instructions, and did not say anything in the charging conference that raised the issue. The Court also rejected Microsoft’s argument that there was insufficient evidence to support the jury’s verdict. The Court, however, reversed the district court’s denial of Kaufman’s motion for prejudgment interest. The Court explained that there was not a basis to believe the jury’s verdict included interest because the parties did not present any testimony on how to include interest to the jury. The Court also found that Kaufman did not unduly delay in bringing suit because a finding of undue delay cannot be based solely on the fact that Kaufman waited five years to bring suit. The Court also rejected Microsoft’s argument that it was prejudice because Microsoft presented evidence that it could have altered the infringing functionality, but not any evidence that it would have.

Koninklijke Philips N.V. v. Thales USA, Inc.

39 F.4th 1377 (Fed. Cir. 2022)

Philips sued Thales for infringement of four of its patents in the United States District Court for the District of Delaware. Defendant Thales sought a preliminary injunction enjoining Philips from seeking an exclusion order from the International Trade Commission. The district court found that Thales had failed to show that it was likely to suffer irreparable harm in support of the injunction because Thales presented no evidence of lost customers or delayed purchases, merely presenting conclusory affidavits alleging that some customers had “voiced concerns” about the ongoing investigation. The Federal Circuit found that this type of speculative harm does not justify the rare and extraordinary relief of a preliminary injunction, and affirmed the district court’s ruling.

Kyocera Senco Indus. Tools Inc. v. Int’l Trade Comm’n

22 F.4th 1369 (Fed. Cir. 2022)

In 2017, Kyocera Senco Industrial Tools Inc. (“Kyocera”) filed a complaint with the ITC alleging that Koki Holdings America Ltd. (“Koki”) was importing gas spring nailers that

infringed, or were made using methods that infringed, claims in five patents relating to linear fastener driving tools. During claim construction, Koki had proposed a definition of a POSITA that required a Master's Degree in Mechanical Engineering with at least two years of experience in power nailer design; a definition which Kyocera did not object to. Following the administrative law judge's ("ALJ's") adoption of Koki's definition, Koki moved to exclude Dr. Pratt's testimony because he did not qualify as a skilled artisan under the adopted definition in that he lacked the two years of experience in power nailer design. Following an evidentiary hearing, the ALJ only excluded Dr. Pratt's testimony relating to infringement under the doctrine of equivalents, but did not exclude his testimony regarding literal infringement. Both parties appealed the Commission's opinion concerning Dr. Pratt's testimony.

The Federal Circuit held that, in allowing Kyocera's technical expert to testify on the issue of literal infringement in view of the agreed-upon definition of a POSITA, the ALJ abused his discretion. Specifically, the Federal Circuit stated that, because a POSITA was required to have at least two years of experience in power nailer design, and did not, the expert was not qualified to testify as to literal infringement or infringement by the doctrine of equivalents. Specifically, the Federal Circuit explained that any expert that offers testimony in a patent case must "at least have ordinary skill in the art[,] [w]ithout that skill, the witness' opinions are neither relevant nor reliable." The Federal Circuit explained that this fundamental precept holds regardless of the type of testimony being proffered; "[n]othing about literal infringement makes an unqualified witness' testimony more relevant or more reliable. And the same goes for infringement under the doctrine of equivalents. The absence of relevant knowledge and the risk for abuse apply equally to both situations."

As such, the Federal Circuit vacated the Commission's opinion in-part based on this holding and remanded for further proceedings. This case serves as a reminder that parties should always closely consider the scope of the definition of a POSITA to ensure that the definition is not unduly narrow, and also confirm that the ordinary level of skill of any experts retained by a party align with the agreed-upon definition to avoid having an otherwise qualified expert's testimony excluded.

LG Elecs. Inc. v. ImmerVision, Inc.

39 F.4th 1364 (Fed. Cir. 2022)

In two *inter partes* review proceedings, LG challenged the claims of ImmerVision's '990 patent, which is directed to capturing an initial digital panoramic image using an objective lens having a nonlinear image point distribution function that expands certain zones of the image and compresses other zones of the image. LG argued that this nonlinear function was described in one embodiment of a prior art patent to "Tada." After a deep-dive analysis into the Tada patent, ImmerVision's expert discovered that the embodiment relied on by LG in its petition had a copy-and-paste error, and that the allegedly invalidating disclosure was unintentional. The Board accepted ImmerVision's arguments that a POSITA would have recognized this error and corrected it and thus would not have relied on it in finding the '990 patent claims obvious. LG appealed to the Federal Circuit.

The Federal Circuit affirmed, applying *In re Yale* to determine that a prior art reference that includes an obvious error that would be apparent to a POSITA cannot be said to disclose the claimed subject matter in the errant information. The Court rejected LG's position that *In re Yale* requires a POSITA to "immediately" recognize the error, holding that the length of time and the manner in which an error was actually discovered does not diminish whether that error would be obvious to a POSITA. The Court likewise rejected LG's position that *In re Yale* is limited to typographical errors.

Judge Newman dissented in part, finding that the error in Tada did not constitute an "obvious" error of the type contemplated by *In re Yale*. Judge Newman found that the complexity and duration of the analysis ImmerVision's expert required to uncover the error, in addition to the length of time during which the error had gone unnoticed, precluded it from being considered obvious or readily apparent to a POSITA.

Littelfuse, Inc. v. Mersen USA EP Corp.

29 F.4th 1376 (Fed. Cir. 2022)

Littelfuse alleged that Mersen infringed on its '281 patent, which is directed to a "fuse end cap for providing an electrical connection between a fuse and an electrical conductor." The district court accepted Mersen's argument that the fuse end cap is of multipiece construction; it does not cover a single-piece apparatus. The court therefore rejected the argument that the claims cover both unitary and multipiece embodiments. The parties accordingly stipulated judgement of non-infringement based on the district court's construction of the claims. Littelfuse appealed the district court's claim constructions. The Federal Circuit vacated the lower court's judgment of non-infringement and remanded the case for the district court to adopt a new construction of the "fastening stems" limitation that allows the independent claims to cover both single-piece and multipiece embodiments. The Federal Circuit reasoned that an independent claim is broader than a claim that depends from it, therefore if a dependent claim reads on a particular embodiment of the claimed invention, the corresponding independent claim must cover that embodiment as well. Otherwise, the dependent claims would be meaningless; claim construction that leads to such a result is generally disfavored. The Court found that here, Mersen's construction would not only render the dependent claims superfluous, but would mean that those claims have no scope at all. Although the detailed description of the claims refer to a multipiece apparatus, courts ordinarily should not limit the claimed invention to preferred embodiments or specific examples provided in the specification. Nothing in the specification states that a fastening stem cannot be present in a single-piece apparatus. The Federal Circuit therefore disagreed with the district court's conclusion that the claims do not cover single-piece embodiments.

Lubby Holdings, LLC v. Chung

11 F.4th 1355 (Fed. Cir. 2021)

Appellee Lubby Holdings LLC sued Appellant Henry Chung in district court alleging Chung infringed Lubby's patent '284, relating to handheld personal vaporizers. After a jury trial in the Central District of California, the jury returned a verdict finding Chung

liable for direct infringement and awarded Lubby \$863,926.10 in reasonable royalty damages. The award included damages for the sales of infringing products prior to the commencement of the suit. Chung moved for judgment as a matter of law. The court denied the motion, finding that there was sufficient evidence to support the jury's verdict. Chung also moved for a new trial. The court denied the motion with minimal explanation. Chung appealed both denials. The Federal Circuit affirmed the court's finding as to the jury's infringement verdict and the denial of a new trial, but reversed and remanded as to the damages awarded.

First, the Federal Circuit affirmed the jury's infringement verdict. The Court found evidence that Chung designed and sold the allegedly infringing products. The Court also found that, per *Wordtech Systems, Inc. v. Integrated Network Solutions, Inc.*, 609 F.3d 1308 (Fed. Cir. 2010), Chung could be found personally liable for infringement without the need to pierce the corporate veil.

Second, the Circuit reversed the jury's damages award as to damages awarded for infringing sales that occurred before service of Lubby's complaint on Chung. The Court held that 35 U.S.C. § 287(a)'s requirement that a patentee notify infringers in order to recover damages was not met until Lubby served Chung. It found that Chung presented evidence that Lubby's vaporizers were not properly marked as patented pursuant to Section 287. The Court held that Section 287 notice required an affirmative communication of a specific charge of infringement by a specific device per *Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 876 F.3d 1350 (Fed. Cir. 2017). The Court found that Lubby's evidence that Chung had generalized notice that he *would* be infringing in the future—based on his collaboration in creating the patent and signed nondisclosure agreements not to infringe—was insufficient because it did not allege a specific instance of infringement. Therefore, since actual notice only began after service of the complaint, the jury erred in awarding damages for sales before service, and the Court remanded.

Judge Newman dissented from the reversal of the damages award, arguing there was evidence to support a finding of notice before service of the complaint. Without addressing *Arctic Cat*, Judge Newman argued that the fact that Chung and Lubby had collaborated on the invention, and that Lubby explicitly instructed Chung not to infringe, constituted sufficient notice under Section 287. Judge Newman also asserted that motions to alter a jury verdict require affirmative evidence such that would permit only one contrary conclusion. Since Chung did not present affirmative evidence that he lacked knowledge of his infringement, Judge Newman would have sustained the jury's damages.

Mitek Sys., Inc. v. United Services Auto. Ass'n
34 F.4th 1334 (Fed. Cir. 2022)

Mitek Systems ("Mitek") brought a suit in the United States District Court for the Northern District of California against United Services Automobile Association ("USAA") seeking a declaratory judgment that Mitek had not infringed USAA's '779, '517, '571, and '090 patents. USAA filed a motion to dismiss for lack of subject matter jurisdiction, alleging that there was no case or controversy as required by Article III of the Constitution. USAA

also argued that the court should exercise discretion not to hear Mitek’s claim, and asked that the case be transferred to the United States District Court for the Eastern District of Texas. The California court transferred the case to the Texas forum, which dismissed the case for lack of subject matter jurisdiction and ruled that, even if it had jurisdiction, “it would exercise its discretion to decline to entertain the declaratory-judgment action.” Mitek appealed to the Federal Circuit.

The Federal Circuit reviewed the subject matter jurisdiction issue de novo, based upon the particular facts of the case. The court determined that the district court’s dismissal was based on incomplete fact-finding. It noted that the district court failed: (a) to clarify whether it was treating the Rule 12(b)(1) motion as a facial challenge or as a factual challenge; (b) to evaluate any allegations “by the patentee or other record evidence that establish at least a reasonable potential that [infringement claims against Mitek] could be brought;” and (c) to separately consider the separate types of infringement, specifically direct infringement, inducement of infringement, and contributory infringement. Because the district court “did not conduct an analysis at this level of specificity,” the Federal Circuit vacated the subject matter jurisdiction dismissal and remanded for further fact-finding.

The Federal Circuit reviewed the discretionary dismissal for abuse of discretion. The court found that “the district court did not give reasons independent of its reasons for its jurisdictional dismissal.” Because of this, along with the court’s determination that the same reasons alone could not support the jurisdictional dismissal, the Federal Circuit ruled that the district court’s discretion ruling could not stand. Thus, the Federal Circuit vacated the discretionary dismissal and remanded to the Eastern District of Texas because Mitek failed to demonstrate an abuse of discretion in the transfer order issued by the California court.

MLC Intell. Prop., LLC v. Micron Tech., Inc.

10 F.4th 1358 (Fed. Cir. 2021)

MLC sued Micron for allegedly infringing the ’571 patent, which claims methods of programming multilevel electronic memory cells. MLC’s damages expert—Mr. Milani—opined on a reasonable royalty rate, arguing that previous license agreements between the patentee and companies Hynix and Toshiba that provided for lump-sum payments reflected a reasonable royalty. Micron filed three motions (1) a motion in limine to preclude Mr. Milani from mischaracterized the previous license agreements; (2) a motion to strike portions of Mr. Milani’s expert report that was based on facts, evidence, and theories MLC failed to disclose pursuant to Federal Rule of Civil Procedure 37; and (3) a *Daubert* motion to exclude Mr. Milani’s opinions for failure to apportion the value between patented and non-patented features. The district court granted all three motions, and MLC appealed.

The Federal Circuit affirmed the district court’s decision on all three motions.

First, the Court affirmed the district court’s order precluding Mr. Milani from inappropriately representing that the Hynix and Toshiba agreements included a royalty rate. The Court noted that previous lump-sum agreements are not a sufficient basis to infer

royalty rates, especially since Mr. Milani provided no accompanying mathematical analysis. Additionally, the Court found that the plain text of the agreement did not address royalty rates even by inference.

Second, the Court affirmed the striking of parts of Mr. Milani's expert report due to failure to comply with the disclosure requirements of Federal Rule 37. Although MLC provided 93 documents in discovery, including the Hynix and Toshiba agreements, it failed to disclose that it would rely on them to calculate the royalty rate—despite being asked for the source of the calculations in interrogatories. Absent a specific disclosure by MLC, the Court found there was no way Micron could have derived from the vague interrogatory responses and multitude of discovery documents that MLC would rely on the Hynix and Toshiba agreements.

Third, the Court affirmed the exclusion of Mr. Milani's testimony under *Daubert* as unreliable because he did not apportion the royalty rate to account for the non-patented aspects of the accused products, as required by Federal Circuit precedent. The Court noted that there is an exception to apportionment when a comparable license has already done so, but found that the exception was not applicable here because the Hynix and Toshiba agreements were factually distinct.

Mobility Workx, LLC v. Unified Patents, LLC
15 F.4th 1136 (Fed. Cir. 2021)

In this case, the Federal Circuit addressed, and ultimately rejected, constitutional challenges to the U.S. Patent and Trademark Office's (USPTO) structure and delegation powers. Mobility Workx LLC appealed the PTAB's decision finding that certain claims of the '417 patent were obvious. In addition to challenging the PTAB's decision regarding the patent and requesting remand, Mobility Workx argued the following constitutional challenges to USPTO's structure under the Leahy-Smith America Invents Act (AIA) and the Administrative Procedure Act (APA): (1) the PTAB members have an interest in instituting AIA proceedings, and (2) individual PTAB judges have a personal financial interest in instituting the AIA proceedings. Despite the government's arguments that these challenges were forfeited, the Court exercised its discretion to consider new arguments for the first time on appeal. The Court rejected Mobility's arguments that PTAB board members and administrative patent judges had significant and impermissible financial interests in instituting AIA proceedings under *Tumey v. Ohio*, 273 U.S. 510 (1927). The Court, first, distinguished *Tumey* from the presents facts because "unlike the mayors in *Tumey*...the Chief APJ, deputy Chief APJ, and Vice Chief APJs do not have responsibility for the agency's finances." The Court held that Mobility's challenge could not succeed as the USPTO has no control over its budget, instead the President holds this power, and similarly, it does not control whether access to the funds collected from the fees paid in the course of AIA proceedings. Rejecting Mobility's argument with respect to individual APJs personal financial interest, the Court found that "[e]ven accepting Mobility's characterization of APJ compensation, however, we conclude that APJs do not have a significant financial interest in instituting AIA proceedings to earn a bonus." The number of decisional unites earned by an APJ does not depend the outcome of those decisions.

Relying on two prior Circuit opinions on nearly the identical issue, the Court also rejected Mobility's argument that the Director's delegation of his authority to institute AIA proceedings violates the AIA. Lastly, the Court rejected Mobility's Appointments Clause arguments. Mobility argued that it was entitled to more than a remand to the Acting Director to review the final written decision of the APJ panel. Instead, Mobility argued that the Court "should instruct the Acting Director 'to issue a certificate under 35 U.S.C. § 318(b) confirmed the challenged claims, or, in the alternative, dismissing [Unified Patent's] petition for failing to reach a final determination within the' 12-month statutory period for final determination in an inter partes review under 35 U.S.C. § 316(a)(11)." The Court held that this argument, and any other challenges pertaining to the USPTO's implementation of Director review under *United States v. Arthrex*, should be raised before the agency. The Court thus remanded the case "for the limited purpose of allowing Mobility the opportunity to request Director rehearing of the final written decision." On the remand, Mobility did not request Director rehearing, and the Circuit affirmed the PTAB's findings that the claims of the '417 patent were unpatentable.

ModernaTx, Inc. v. Arbutus Biopharma Corp.

18 F.4th 1364 (Fed. Cir. 2021)

The Federal Circuit held Moderna had standing to appeal the loss of its *inter partes* review petition and affirmed the PTAB's ruling that the claims in Arbutus's '069 patent were nonobvious. The '069 patent involved a combination of four nucleic acid-lipid particles comprising ranged proportions of the overall particle. The prior art expressly disclosed ranges for three of the four lipids, but did not expressly disclose a range for the phospholipid portion of the fourth lipid.

Although Moderna's participation in the *inter partes* review was not itself sufficient to confer standing, the Federal Circuit concluded that the substantial risk that Arbutus would sue Moderna for infringement was enough to confer standing. In its analysis, the Court first noted that standing is not necessary to institute *inter partes* proceedings before the PTAB. However, an appellant seeking Federal Circuit review of a PTAB decision must demonstrate it meets the elements of standing. Mere participation in an *inter partes* review is not enough—the party must also have been injured. The Court held that the "substantial risk" that Arbutus would bring an infringement action against Moderna in relation to its COVID-19 vaccine was sufficient to confer standing.

The Federal Circuit affirmed the PTAB's determination of nonobviousness. There is a presumption of obviousness when the ranges of a claimed composition overlaps the ranges disclosed in the prior art. Here, Moderna failed to make the threshold showing that a POSITA would have understood the prior art suggested a range for the phospholipid portion of the fourth lipid that overlaps for the '069 patent's claimed range. Although the prior art did not expressly disclose a range for this portion, Moderna argued that because the prior art disclosed a range for the other three lipids, a POSITA could easily derive a range for the phospholipid using "simple subtraction." The Court rejected this argument as an oversimplification, because it relied on arbitrarily setting minimums and maximums

for the other lipids and did not take into account the interdependence and unpredictability of the lipid interactions.

The Court further rejected Moderna's argument that even if the presumption of obviousness did not apply, Moderna had still presented evidence sufficient to demonstrate obviousness. Although the general conditions for the nucleic acid-lipid particle were disclosed in the prior art, a POSITA could not have arrived at the claimed invention through routine optimization because of the interdependence of the claimed lipids components and how adjustments would affect the nucleic acid-lipid particle as a whole.

ModernaTx, Inc. v. Arbutus Biopharma Corp.

18 F.4th 1352 (Fed. Cir. 2021)

Arbutus owns the '435 patent, which covers lipid formulations for nucleic acid delivery. Moderna petitioned for IPR of the '435 patent, alleging obviousness and anticipation. The PTAB found that some of the claims were anticipated, but that Moderna had failed to prove that the remaining claims were obvious and/or anticipated. Moderna appealed.

The Federal Circuit held that Moderna did not have standing to pursue an appeal from the IPR, and therefore dismissed its appeal. The Court rejected Moderna's argument that Moderna's status as a sublicensee of the '435 patent was enough to confer standing. The Court reasoned that Moderna's evidence of financial burdens that would stem if the patent was determined not invalid was too speculative. Moderna's last milestone payment under its licensing agreement was approximately five years ago, and Moderna could not state when it would have to make the next milestone payment. Moreover, Moderna failed to provide evidence showing how its obligations under its sublicenses would change if it is successful in its attempts to invalidate the '435 patent.

Arbutus cross-appeal that certain claims of the '435 patent are unpatentable. The Court affirmed the PTAB's finding that the claims were anticipated. "When a patent claims a range.. that range is anticipated by a prior art reference if the reference discloses a point within the range." *Ineos USA LLC v. Berry Plastics Corp.*, 783 F.3d 865, 869 (Fed. Cir. 2015). Here, the Board determined that the '554 publication disclosed at least one composition that fell within the claimed ranges and therefore, anticipated the claims. The Court determined the PTAB's decision was supported by substantial evidence.

Mondis Tech. Ltd. v. LG Elecs. Inc.

6 F.4th 1379 (Fed. Cir. 2021)

Mondis Technology sued LG in the District of New Jersey for infringement of a patent related to a display unit configured to receive video signals from an external video source. After a jury found LG liable for infringement and awarded damages to Mondis, LG filed several motions for judgment as a matter of law. The district court disposed of the motions in two separate orders, denying in September 2019 LG's motions regarding infringement, invalidity, and willfulness ("the September Order") and granting in April 2020 its motion for a new trial on damages ("the April Order"). Following the April Order, LG filed notice

of an interlocutory appeal, seeking to challenge the district court's decision denying LG's post-trial motions regarding infringement, invalidity, and willfulness. Mondis moved to dismiss the appeal as untimely, arguing that LG needed to file a notice of appeal within thirty days of the September Order.

The Federal Circuit held that LG's appeal was untimely, and dismissed the case for lack of jurisdiction. The Court noted its prior holding that, "under [28 U.S.C.] § 1292(c)(2), a judgment is final except for an accounting when all liability issues have been resolved, and only a determination of damages remains." The Court then concluded that, because "all liability issues were resolved with the district court's September Order which ... left only damages-related motions outstanding," "this case was final except for an accounting after the September Order." The Court explained that the outstanding damages determination did not toll the time for LG to appeal. The Court rejected LG's argument that "the text of FRAP 4(a)(4) requires that the timeframe for an interlocutory appeal must be tolled even for motions unrelated to the judgment being appealed." The Court closed by "not[ing] that interlocutory appeals are voluntary, and LG is not precluded from challenging the liability determinations of the district court under [the Federal Circuit's] § 1295 jurisdiction once the damages determination is completed."

Nature Simulation Sys. Inc. v. Autodesk, Inc.

23 F.4th 1334 (Fed. Cir. 2022)

Nature Simulation Systems, Inc. ("NSS") sued Autodesk, Inc. ("Autodesk") in the United States District Court for the Northern District of California for infringement of two patents relating to methods of packaging computer-aided data for three-dimensional objects. Following a claim construction hearing, the court held that eight claims were invalid for indefiniteness. Following an appeal by NSS, the Federal Circuit reversed and remanded the district court's claim construction opinion.

In reversing the district court's indefiniteness opinion, the Federal Circuit held that that the district court erred by applying the incorrect legal standard for determining indefiniteness. Specifically, the Federal Circuit noted that the district court incorrectly relied on the "claim language, standing alone" in determining whether the claim elements were indefinite. This was error because patent claims are to be understood not only in view of the claim language, but in view of the specification, the prosecution history, and other relevant evidence as "would have allowed a skilled artisan to know the scope of the claimed invention with reasonable certainty." The Federal Circuit explained that the district court here had failed to "construe the claims, ... apply the protocols of intrinsic and extrinsic evidence, [or] resolve the meaning and scope of the challenged claims."

Applying the foregoing, the Federal Circuit held that, contrary to the district court's opinion that Autodesk had identified "unanswered questions" concerning the meaning of the disputed claim terms, the specification and prosecution history answered these questions, in that the specification provided meaning and support to the disputed claim terms, and the patent prosecution histories demonstrated that NSS had overcome the examiner's indefiniteness rejections by amending the claims to provide additional limitations.

Judge Dyk dissented, explaining that the claim terms were not indefinite; holding that the patent specification did not define the claim terms, and that merely because a “a patent examiner introduced the indefinite language does not absolve the claims from the requirements of 35 U.S.C. § 112.” Moreover, Judge Dyk stated that he thought the district court had in fact conducted a thorough analysis, and that the majority’s definition of the disputed claim terms resulted in an inconsistency with the overall claim language.

Niazi Licensing Corp. v. St. Jude Med. SC, Inc.
30 F.4th 1339 (Fed. Cir. 2022)

Niazi appealed from judgment of the district court for the District of Minnesota in favor of defendant St. Jude Medical in Niazi’s patent infringement action. At issue was the ’268 patent, which disclosed a “double catheter for cannulating the coronary sinus,” composed of “an outer, *resilient* catheter” and “an inner, *pliable* catheter.” The double catheter is used to place “an electrical lead in a lateral branch of a coronary sinus vein” in a five-step sequential process. Niazi claimed that St. Jude both directly infringed and induced infringement of the ’268 patent claims.

On appeal at the Federal Circuit, Niazi challenged the district court’s claim construction for the terms “resilient” and “pliable.” The Federal Circuit notes that certain language can have “inherent limitation” that can provide reasonable certainty about the scope of the invention. The Court pointed out that they had previously used intrinsic evidence, such as the claim language and the written description to determine the scope of the claims, to determine whether the claimed term was purely subjective. Using the same type of analysis here, the Federal Circuit held that the term “resilient” was definite because the claim itself referred to “shape memory” and “sufficient stiffness” to describe the term. The Court also turned to the dependent claims and the written description, which included the appropriate type of material for the catheters. The Federal Circuit then turned to the term “pliable” and held that the term was definite as well. Here, the Federal Circuit relied on the written description, which focused on the type of material that could be used for the catheter. In deciding this case, the Federal Circuit drew a distinction between a term of degree and “purely subjective terms” by stating that the former can have sufficient intrinsic or extrinsic evidence to provide guidance as to the bounds of the claim.

The court then considered Niazi’s induced infringement claim. The district court held that St. Jude’s instructions for use (IFUs) did not establish infringement since the IFUs did not instruct simultaneous insertion. However, the Federal Circuit held that the certain method steps of “inserting” and “withdrawing” the catheter were broad enough to include both the sequential insertion and the simultaneous insertion of the inner and outer catheters, contrary to the district court’s construction, and therefore could not affirm summary judgment on that basis. Nevertheless, the Federal Circuit agreed with the district court’s determination that steps 2 and 3 of claim 11 were necessarily sequential. Accordingly, summary judgment was affirmed, since St. Jude’s IFUs describe the opposite sequence.

Next, the Court considered whether the district court abused its discretion in excluding portions of Niazi’s expert’s reports under Federal Rule of Civil Procedure 37 and in levying

monetary sanctions against Niazi. Niazi had utilized these expert reports despite failing to disclose the underlying evidence to St. Jude during fact discovery. As a result, the Federal Circuit found the district court did not abuse its discretion in excluding the reports. The sanctions against Niazi were affirmed since the monetary amount awarded was “specifically keyed to St. Jude’s expenses in moving to strike the already-excluded evidence.” Finally, the Court found no abuse of discretion in the district court’s order to exclude Niazi’s expert report on damages for infringement of claim 11 as unreliable. Though the rule is to limit damages to “products that were actually used to perform the claimed method,” Niazi’s expert report “failed to ‘apportion’ between infringing and noninfringing uses.”

Nippon Shinyaku Co., Ltd. v. Sarepta Therapeutics, Inc.
25 F.4th 998 (Fed. Cir. 2022)

This case concerns whether a party may contract away the right to file for an IPR. Nippon entered into a Mutual Confidentiality Agreement (MCA) with Sarepta to discuss a potential business relationship relating to therapies for the treatment of Duchenne Muscular Dystrophy. The MCA created a mutual covenant not to sue for any legal or equitable cause of action in any legal or administrative proceeding in the United States or Japan during the one year covenant term. Additionally, the MCA contained a forum selection clause that required “all potential actions arising” under U.S. law relating to patent infringement or invalidity and filed within two years of the expiration of the covenant term to be filed in the United States District Court for the District of Delaware.

When the mutual covenant not to sue expired, Sarepta filed seven IPR petitions challenging the validity of Nippon’s patents. In response to the IPR petitions, Nippon filed a patent infringement and breach of contract lawsuit against Sarepta in the District Court of Delaware. Nippon moved for a preliminary injunction to force Sarepta to withdraw its IPR petitions on the basis that the forum selection clause precluded them. The district court denied the application, interpreting the forum selection clause to permit a party to file an IPR in the U.S. Patent and Trademark Office immediately after the covenant term expired. Specifically, the district court found that the forum selection clause’s phrasing of “all potential actions” did not encompass IPR petitions in the U.S. Patent and Trademark Office. Nippon appealed the district court’s order. During the pendency of the appeal, the PTAB granted institution in all seven of Sarepta’s IPR petitions.

On *de novo review*, the Federal Circuit held that Sarepta waived its right to file an IPR under the forum selection clause. The Federal Circuit reasoned that parties are entitled to bargain away their rights to file IPR petitions through forum selection clauses. The plain language of the forum selection clause required Sarepta to bring all disputes regarding the invalidity of patents, including the allegations contained in Sarepta’s IPRs, in the District Court of Delaware. The Court rejected the district court’s reasoning that there was an implied tension between the covenant not to sue, which prohibited IPRs only for the covenant term, and the forum selection clause, which extended that prohibition for another two years. The Court explained that the two provisions served different purposes and the plain language of both provisions controlled. Given its interpretation of the MCA, the

Federal Circuit found that Nippon satisfied the factors for a preliminary injunction as a matter of law and remanded the case to the district court for entry of a preliminary injunction.

Omega Pats., LLC v. CalAmp Corp.

13 F.4th 1361 (Fed. Cir. 2021)

Appellee Omega is the assignee of patents '278 and '885, both of which relate to multi-vehicle-compatible systems that can remotely control and communicate with various vehicle functions. Appellant CalAmp sells Location Messaging Unit (LMU) products, which connect to a vehicle's communication bus and remotely monitor the vehicles. Omega sued CalAmp in the Middle District of Florida, claiming the LMUs infringed on its patents. After a first jury trial and appeal, a second jury trial found that CalAmp's LMUs directly infringed the '278 patent, and awarded a \$5.00-per-unit royalty. The jury found that CalAmp did not infringe or induce infringement of the '885 patent, but nevertheless that CalAmp's customers directly infringed the '885 patent. After the court denied CalAmp's motion for judgment as a matter of law on the jury's verdict, CalAmp appealed.

The Federal Circuit affirmed the judgement of infringement of the '278 patent. First, it rejected CalAmp's challenge that the verdict should be overturned because Omega's technical expert testified beyond the scope of his expert report. The Court disagreed, holding that language in the expert's report and his pretrial depositions provided enough notice to CalAmp to prepare its case adequately. Second, the Court held that there was sufficient evidence—including admissions by CalAmp employees and testimony by Omega's expert—to find that the LMUs met the "vehicle device code" limitation included in Omega's patent. The Court also found that CalAmp had waived any arguments that Omega had presented improper theories to the jury because it did not object at trial.

Despite finding infringement of the '278 patent, the Court found that the district court abused its discretion in denying CalAmp's motion for a new trial on damages. It reversed and remanded for a new trial on damages and the royalty rate. The Court found that the district court erroneously excluded CalAmp's damages expert on the grounds that it was bound by a previous exclusion of that expert in the first trial. However, the Court explained that per its initial remand order in *Omega Pats., LLC v. CalAmp Corp.*, 920 F.3d 1337 (2019) which instructed parties to clearly present evidence, the district court should have overruled its previous exclusion order. The Court also found that Omega's royalty rate calculations failed to account for apportioning the value of the noninfringing features of the LMUs.

Third, the Court vacated the finding of direct infringement by CalAmp's customers of the '885 patent. The Court reasoned that because Omega declined to appeal the jury's finding that CalAmp did not induce its customers to infringe, the predicate question of whether the customers did so was moot, and non-appealable by CalAmp. The Court noted that the finding of direct infringement by CalAmp's customers could nevertheless expose it to indemnification claims, reputational harms, and attorneys' fees. To prevent CalAmp from suffering those harms, the Court used its equitable powers to vacate the jury's finding.

Judge Hughes dissented from the grant of a new trial on damages. Judge Hughes reasoned that the Court's earlier decision had not clearly instructed the district court to reassess its earlier *Daubert* exclusion of CalAmp's damages expert, and that the court acted within its discretion to continue to exclude the expert. On the apportionment issue, Judge Hughes would have held that Omega produced sufficient evidence in the form of "hypothetical negotiation" estimates for a jury to conclude that a \$5.00 royalty rate was reasonable. Judge Hughes also would have held that because CalAmp did not object with *Daubert* or other motions to Omega's damages testimony, the jury properly could have considered that information.

Omni MedSci, Inc. v. Apple Inc.

7 F.4th 1148 (Fed. Cir. 2021)

Omni MedSci sued Apple in the Eastern District of Texas for infringing two patents. Both patents shared "an ancestor" in a patent whose rights Dr. Islam, a professor at the University of Michigan ("UM"), assigned to Omni. After Dr. Islam sought to confirm with UM that the university did not assert ownership of the patent, UM informed him that it did believe itself the owner of the patent.

Apple moved to dismiss the complaint for lack of standing, alleging that UM, not Omni, owned the asserted patents. Apple argued that Dr. Islam agreed in his employment agreement with UM to abide by a paragraph of a UM bylaw that automatically transferred legal title to the patents at issue. The district court in the Eastern District of Texas denied Apple's motion, concluding that the bylaw paragraph at issue was not a present automatic assignment of title and was, at most, a statement of a future intention to assign. The case was then transferred to the Northern District of California. The court in the Northern District of California denied Apple's motion for reconsideration and granted Apple's unopposed motion for certification of the standing question to the Federal Circuit.

A panel majority of the Federal Circuit affirmed. The majority agreed that the bylaw paragraph at issue—with the operative language, "shall be the property of"—was most naturally read as a statement of intended disposition and a promise of a potential future assignment, not as a present automatic transfer. The majority held that the same and similar operative language in two other paragraphs, respectively, of the same bylaw could not reasonably be read as a present automatic assignment. The majority noted that the bylaw paragraph did not use present-tense verbs of execution. The majority contrasted the language of the bylaw paragraph with the "distinct unambiguous language of present assignment" used in UM's Invention Report. The majority also rejected Apple's argument that the UM Technology Transfer Policy's section titled "Granting Rights Back to Inventors" confirmed that the bylaw was meant to effect a present automatic transfer, noting that the Policy says nothing about how UM obtains its intellectual property. Finally, the majority explained that the parties' past conduct did not change its interpretation of the language at issue.

Judge Newman dissented, stating that Omni lacked standing because "plain meaning and long-understood interpretation" indicated that the patents were owned by UM. Judge

Newman emphasized that the parties' intent and the purpose of the bylaw were "to establish University ownership of inventions made with University support." Finally, Judge Newman argued that even the majority's conclusion—that the bylaw paragraph was most naturally read as a statement of intended disposition—precluded Dr. Islam from validly assigning the patent to a non-UM entity like Omni.

Pavo Sols. LLC v. Kingston Tech. Co.
35 F.4th 1367 (Fed. Cir. 2022)

CATR Co., which was later substituted for Pavo Solutions LLC ("Pavo"), filed suit against Kingston in the Central District of California for alleged infringement of its '544 patent. The patent relates to an attached cover for a flash memory device. During claim construction, the district court judicially corrected the language by replacing the word "case" with "cover." The court determined that the error was evident from the face of the patent. At trial, Pavo's damages expert relied on an earlier settlement agreement between CATR and IPMedia to conclude that the parties would have agreed to a profit split amounting to 40 cents per unit. The jury returned a verdict of willful infringement and awarded a 20-cent reasonable royalty. After trial, the district court denied Kingston's JMOL motion. Kingston appealed.

The Federal Circuit found that claim 1 contained an obvious minor clerical error, which was clear from the full context of the claim language. The Court emphasized that district courts are not precluded from correcting obvious minor errors that alter the claimed structure, nor are courts limited to correcting errors that result in linguistic incorrectness. The Federal Circuit also affirmed the district court's judgement that Kingston willfully infringed the '544 patent, holding that "reliance on an obvious minor clerical error in the claim language is not a defense to willful infringement." Finally, the Court rejected Kingston's challenge to Pavo's damages expert's testimony and affirmed the jury's damages award. The Court found that the license upon which the expert relied was acceptable because it was comparable to the situation at hand and "plainly reflected the value that the contracting parties settled on for the patent." Furthermore, the expert's analysis correctly apportioned for non-infringing features. For these reasons, the Federal Circuit held that the district court did not abuse its discretion in declining to exclude the testimony.

PersonalWeb Techs. LLC v. Google LLC
8 F.4th 1310 (Fed. Cir. 2021)

PersonalWeb Technologies ("PersonalWeb") appealed the District Court for the Northern District of California's judgment that certain claims of the '310, '280, and '662 patents were ineligible for patenting, and therefore invalid. The Federal Circuit affirmed the district court judgment.

PersonalWeb's asserted patents relate to a content-based identifier, wherein the identifiers are generated by an algorithm. The patents claim using such identifiers to perform certain data-management functions: to control access to data (the '310 patent), to retrieve data

items (the '280 patent), and to mark duplicate data items for deletion (the '662 patent). PersonalWeb sued Google LLC and several other entities for patent infringement in the Eastern District of Texas. The claims were later transferred to the Northern District of California. After an initial stay while related claims awaited IPR decisions, the district court granted appellees' motion for judgment on the pleadings that the remaining asserted claims were ineligible for patenting under 35 U.S.C. § 101. PersonalWeb appealed.

The Federal Circuit applied the two-prong test established in *Alice* and *Mayo*, and affirmed the district court judgment of patent ineligibility. Using the first prong of the test, the Court found that the relevant claims were directed to an abstract idea. The Court adopted the district court's conclusion that the patents were directed to a three-step process: "(1) using a content-based identifier generated from a 'hash or message digest function,' (2) comparing that content-based identifier against something else, [that is,] another content-based identifier or a request for data; and (3) providing access to, denying access to, or deleting data." The Court concluded that each of these elements were mental processes that could otherwise be performed without the use of a computer and that, when taken together, the claims "amount[ed] only to a multistep mental process." Moreover, the Court noted that the claims focused on "mere automation of manual processes using generic computers" rather than solutions to a computer network problem, which further indicated the claims were directed to an abstract idea.

On the second prong of the *Alice/Mayo* test, the Federal Circuit agreed that PersonalWeb's claims failed to meet the "inventive concept" requirement. The Court determined that PersonalWeb's asserted "inventive use of cryptographic hashes" was not significantly more than the abstract idea itself: the purported improvements merely restated the abstract idea. Additionally, the Court concluded that the district court was correct in finding that the patent claims did not contain inventive concepts that were not themselves abstract ideas. The Federal Circuit was not swayed by the Plaintiff's argument that the patents disclosed an unique, and patentable, algorithmic content identifier that improved computer functionality.

The Court thus held that the claims were ineligible for patenting under Section 101, and affirmed the lower court judgment of invalidity.

PlasmaCAM, INC. v. Cncelectronics, LLC
24 F.4th 1378 (Fed. Cir. 2022)

PlasmaCAM, Inc. ("Plasmacam") sued CNCElectronics, LLC, Fourhills Designs, LLC, and Thomas and Martha Caudle (collectively, "CNC") in the Eastern District of Texas for patent infringement. The parties reached a settlement agreement, and the district court granted Plasmacam's motion to enforce its version of that agreement. CNC appealed, and the Federal Circuit held that it had jurisdiction over CNC's appeal and reversed the district court's judgment ordering CNC to execute the settlement agreement.

The Federal Circuit concluded that the district court's order constituted either an appealable injunction or a final judgment. The order was appealable as an injunction because it

required that CNC execute the settlement agreement, which effectually mandated specific performance. The order was also appealable as a final judgement because the record revealed that the parties did not contemplate further substantive proceedings, and the order evinced the district court's clear intent to end the case.

The Federal Circuit also concluded that CNC's version of the agreement accurately reflected the parties' mutual understanding. The district court committed clear error when it adopted the definition of "Covered Products" proposed by Plasmacam. The Court found that the record definitively established that Plasmacam agreed to CNC's proposed definition of Covered Products. Judge Newman dissented on the grounds that a binding contract requires a "meeting of the minds," and the parties never reached a final understanding or signed a written agreement.

Qualcomm Inc. v. Apple Inc.

24 F.4th 1367 (Fed. Cir. 2022)

This case concerns whether applicant admitted prior art (AAPA) can be the basis of an IPR challenge. Apple filed two IPR petitions challenging the validity of the '674 patent. Apple argued that the AAPA described in the Background section of the '674 patent rendered the claims obvious when combined with other prior art. Patentee Qualcomm conceded that combining the AAPA and other prior art teaches each element of the challenged claims. However, Qualcomm argued that AAPA cannot be used in IPRs under Section 311(b), which requires that an IPR be "only on the basis of prior art consisting of patents or printed publications." The PTAB relied on the AAPA, reasoning that it was printed within the patent itself, and found the '674 patent obvious. Qualcomm appealed to the Federal Circuit, and the PTO intervened to argue that AAPA can be relied upon to show general knowledge in the art, but not as a basis for invalidity grounds in an IPR. The Federal Circuit agreed with the PTO, and vacated the PTAB's decision.

Specifically, the Federal Circuit held that the PTAB erroneously included AAPA as "patents or printed publications" because the AAPA is contained within the patent itself, and therefore not prior art to the patent. The Court cited prior Supreme Court and Federal Circuit decisions which "understood the 'patent and printed publications' referenced in § 311(b) to themselves be prior art." The Federal Circuit also relied on judicial interpretations of a statute with identical language, 35 U.S.C. § 301(a), that excludes "patents which themselves are not prior art." Although AAPA cannot be a basis for an IPR challenge, the Court stated that AAPA is not "categorically excluded from an *inter partes* review." AAPA may be considered in an IPR to "provide a factual foundation as to what a skilled artisan would have known at the time of the invention" or may be used to demonstrate "a motivation to combine or supply[] a missing claim limitation." The Federal Circuit remanded the case to the PTAB to address whether the AAPA in Apple's IPR improperly formed the "basis" of the challenge.

Quanergy Sys., Inc. v. Velodyne Lidar USA, Inc.

24 F.4th 1406 (Fed. Cir. 2022)

This case concerns a patent directed to a laser-based system for measuring distances, often used in the autonomous vehicle industry. Quanergy filed two petitions for IPR, claiming that Velodyne's patent is obvious over Mizuno and two other references. During the IPR, applying the broadest reasonable interpretation standard, the PTAB construed the claim term "lidar" to mean "pulsed time-of-flight lidar." Based on the PTAB's construction of "lidar," the PTAB found that Mizuno was not a "lidar" system as claimed because Mizuno is directed to measuring an object's shape with light beams using triangulation techniques. The PTAB also concluded that a POSITA would not have been motivated to modify Mizuno's system using pulsed time-of-flight lidar because Mizuno's system is designed to work at short ranges and one of Quanergy's other references taught that pulsed time-of-flight lidar was less accurate at short ranges. The PTAB also presumed a nexus between the claimed invention and Velodyne's evidence of commercial success. The PTAB held Quanergy did not show that the challenged claims were unpatentable, and Quanergy appealed to the Federal Circuit.

Quanergy argued two issues on appeal: (1) that the PTAB erred in the construction of the term "lidar" and (2) that the PTAB erred in its analysis of objective indicia of obviousness.

First, Quanergy argued that the PTAB erred in the construction of the term "lidar" because it did not use the broadest reasonable interpretation of the term, which should include techniques described in Mizuno. The Federal Circuit rejected that argument and held that the PTAB did not err in constructing the term "lidar" because the "written description focuses exclusively on pulsed time-of-flight lidar." Specifically, the Federal Circuit reasoned that the specification "fairly implied that the term 'lidar' only means pulsed time-of-flight lidar" because "pulsed time-of-flight technique is also foundational to the claimed invention."

Second, Quanergy argued that in its objective indicia of obviousness analysis, the PTAB failed to consider the issue of unclaimed features before presuming nexus between the claimed invention and Velodyne's commercial product. Quanergy argued that Velodyne's evidence of commercial success related to the unclaimed features was critical and materially impacted the functionality of Velodyne's products. The Federal Circuit rejected this argument also, concluding that substantial evidence supported the PTAB's conclusion that the unclaimed features were derived from the claim limitations. The Court also rejected Quanergy's argument that the PTAB failed to provide an adequate reasoned explanation for its rejection of the unclaimed features identified by Quanergy. The Court explained that the PTAB's "analysis of those unclaimed features is commensurate with Quanergy's presentation of the issue," which amounted to only one paragraph. The Federal Circuit affirmed the PTAB's decisions that the challenged claims of Velodyne's patent were not unpatentable as obvious.

Realtime Adaptive Streaming LLC v. Netflix, Inc.

41 F.4th 1372 (Fed. Cir. 2022)

Realtime asserted six patents against Netflix in the District of Delaware. In response, Netflix filed *inter partes* reviews (IPR) against each of the patents and moved to dismiss four of the six for failure to state a claim, arguing that the patents were directed to patent-ineligible subject matter. The PTAB instituted IPRs of all six patents and the magistrate judge found that the four patents were patent ineligible under § 101, at which point Realtime dismissed its suit before the district court could rule on the magistrate's ineligibility findings. Realtime then refiled its complaint of infringement of the six patents in the Central District of California. After Netflix moved for attorneys' fees and to transfer the California action back to Delaware, Realtime once again voluntarily dismissed its case.

Netflix moved for attorneys' fees in conjunction with the California action, the Delaware action, and the IPR proceedings. The district court granted attorneys' fees in connection with the California action but not the other two actions. Realtime appealed the award of attorneys' fees and Netflix cross-appealed for the denial of fees in the related proceedings.

The majority affirmed the district court's decision to award fees under its inherent equitable powers in connection with the California action, but not the related proceedings, finding no abuse of discretion by the district court in rendering its opinion. Judge Reyna concurred-in-part and dissented-in-part, finding that sanctions were likewise permissible under 35 U.S.C. § 285, which was an issue the majority did not reach.

Roche Diagnostics Corp. v. Meso Scale Diagnostics, LLC

30 F.4th 1109 (Fed. Cir. 2022)

Meso was founded as part of a research agreement with Igen international. As part of the agreement, Meso was granted an exclusive license to all technology developed during research. 53 years after the initial agreement, Roche got a license from Igen to operate in the field of human diagnostics. At the same time, BioVeris received ownership of the patents-in-suit from Igen. A few years later, Roche acquired Bioveris and started informing its clients to ignore any field of restriction limitations for their products. Roche sought a declaratory judgment that it didn't infringe on Meso's patent rights and Meso counterclaimed for patent infringement. The case went to a jury trial where the jury found that Meso had an exclusive right to the asserted patents and that Roche directly infringed and induced infringement of the patents. The district court also held that because Meso did not assert three of the patents that Roche listed in the declaratory judgment, they were precluded from doing so in the future and the patents would not infringe on Roche's products. Post-trial, the district court denied Roche's motion for judgment as a matter of law (JMOL) on "willfulness."

The Federal Circuit stated that the district court used the wrong standard for willfulness and reversed the claim of induced infringement. The Federal Circuit agreed with Roche that the district court incorrectly applied a negligence standard for willfulness instead of a specific intent standard. The Court points out that the jury instruction language "knew or

should have known his actions would induce actual infringement” was no longer adequate language for willfulness. Furthermore, the Federal Circuit also noted a similar intent standard in inducement and stated that the district court was contradicting itself by stating that Roche didn’t have a subjective intent to infringe or induce infringement in its JMOL decision.

The Federal Circuit also held that the district court erred in denying a motion for a new trial on damages. Roche noted that the jury award did not reflect apportionment of the value attributable to the infringing product. The district court stated that the asserted claims covered the core aspects of Roche’s technology that Roche couldn’t work without and that technology was a key driver of demand. The Federal Circuit was not persuaded by this argument and said that Meso did not show a continuation between Roche’s initial license to the patents and the hypothetical negotiations the jury relied on.

The Federal Circuit also vacated the district court’s noninfringement judgment of the three patents Meso didn’t assert. The Federal Circuit disagreed with the district court that Meso was compelled to assert those patents in response to Roche’s declaratory judgment. The Federal Circuit notes that the compulsory counterclaim rule bars future claims but doesn’t allow courts to enter adverse judgments for any potential claims.

Seabed Geosolutions (US) Inc. v. Magseis FF LLC

8 F.4th 1285 (Fed. Cir. 2021)

After Magseis sued Seabed in the Southern District of Texas for infringement of a patent directed to seismometers for use in seismic exploration, Seabed petitioned for IPR of the patent. The PTAB found, based entirely on extrinsic evidence, that the word “fixed” within the claim term “geophone internally fixed within [the] housing” had a special meaning in the relevant art at the time of the invention: “not gimbaled.” Based on that finding, the Board determined Seabed failed to prove the challenged claims were unpatentable. Seabed appealed, arguing that the PTAB erred in its construction of the geophone limitation.

On appeal, the Federal Circuit noted that, “[i]f the meaning of a claim term is clear from the intrinsic evidence, there is no reason to resort to extrinsic evidence.” It then found, based upon the intrinsic evidence, that the word “fixed” in context means “attached” or “fastened.” This construction was consistent with the specification, which describes mounting the geophone inside the housing as a key feature of the invention. By contrast and says nothing about the geophone being gimbaled or non-gimbaled. The Court therefore concluded that the Board erred in relying on extrinsic evidence. The Court also rejected Magseis’s contention that Seabed waived certain arguments concerning the prosecution history by failing to raise them below. “The doctrine of waiver,” the Court explained, “does not preclude a party from supporting its original claim construction with new citations to intrinsic evidence of record.”

Sound View Innovations, LLC v. Hulu, LLC

33 F.4th 1326 (Fed. Cir. 2022)

Sound View Innovations, LLC (“Sound View”) alleged Hulu, LLC (“Hulu”) infringed the ’213 patent. The district court construed the asserted claim to require concurrent downloading from and filling of a single buffer. The district court granted Hulu’s motion for summary judgment of noninfringement, finding that the accused servers do not download and retrieve from the same buffer. The district court also granted Hulu’s to exclude portions of Sound View’s damages expert opinion that relied on a Yao study and a press release by Coniva that described a different study. According to the district court, Sound View’s expert did not provide a sufficient basis to rely on the Yao study, and Sound View’s expert did not review or assess the methodology of the underlying Coniva study.

The Federal Circuit affirmed the district court’s claim construction and its exclusion of the damages testimony and vacated the district court’s summary judgment ruling. The Court found that the prosecution history supports the district court’s claim construction that the same buffer must be used for the downloading and retrieving. However, the Court found that the district court’s opinion only looked at the difference in name between the accused-component’s “cache” and the claim’s requirement of a “buffer,” instead of determining whether the “cache” could meet the requirements of a “buffer.” The Court remanded the case to the district court to provide an affirmative construction of “buffer.” Because the Court remanded the case for further proceedings, the Court also addressed the district court’s damages rulings. The Court affirmed the exclusion of the Yao study because the Sound View’s expert did not account for substantial differences between the circumstances in the Yao study and the circumstances of the accused products. The Court also affirmed the exclusion of the Coniva press release because Sound View’s expert did not see the report underlying the press release and could not characterize the participants in the study or the study’s methodology, and because Sound View’s expert did not have a basis for treating the Coniva study as sufficiently tied to the claimed invention.

SRI Int’l, Inc. v. Cisco Sys. Inc.

14 F.4th 1323 (Fed. Cir. 2021)

The Federal Circuit reversed a district court’s judgment as a matter of law (JMOL), reinstated a jury’s verdict of Cisco’s willful infringement, and affirmed the court’s grant of enhanced damages and attorney fees.

SRI sued in the District of Delaware alleging that Cisco infringed certain claims of the ’615 and ’203 patents, relating to a computer-automated method of hierarchical event monitoring within a computer network. In an initial jury trial, the jury found Cisco willfully infringed SRI’s patents, and the district court granted enhanced damages and attorney fees to SRI. On an initial appeal, the Federal Circuit vacated the finding of willfulness and remanded, finding that Cisco could not have willfully infringed before May 8, 2012, but remanded for a new trial as to willful infringement after that date. In the second trial, the jury found again that Cisco had willfully infringed. Cisco moved for JMOL asking the court to set aside the willfulness verdict and enhanced damages, which

the court granted. SRI appealed. Cisco cross-appealed the court's grant of attorney fees to SRI.

The Federal Circuit reversed the district court and reinstated the jury's finding of willfulness, holding that it was supported by substantial evidence. The Court cited evidence that Cisco's invalidity defenses were unreasonable, that Cisco's noninfringement defenses were untethered to the district court's claim construction, and the fact that Cisco was found to have induced its customers to infringe. The Court also rebuked the district court for applying a stricter "wanton and malicious" standard for willful infringement. It clarified that per *Eko Brands, LLC v. Adrian Rivera Maynez Enters., Inc.*, 946 F.3d 1367 (Fed. Cir. 2020), willfulness requires "no more than" deliberate or intentional infringement.

The Court also reinstated the award of double damages under the factors in *Read Corp. v. Portec, Inc.*, 970 F.2d 816 (Fed. Cir. 1992) because of Cisco's large size, its apparent disdain for SRI, and its otherwise aggressive behavior throughout the litigation. Finally, the Court affirmed the award of attorney fees to SRI. It found this case "exceptional" because Cisco pursued litigation in a way that was aggressive, repetitive, and frivolous, including maintaining 19 invalidity theories but only presenting two at trial, and presenting noninfringement theories contrary to the district court's claim construction.

Sunoco Partners Marketing v. U.S. Venture, Inc.

32 F.4th 1161 (Fed. Cir. 2022)

Both parties appeal from the judgment of the Northern District of Illinois finding that Venture infringed Sunoco's patents, and awarding Sunoco \$6 million in treble damages. Sunoco's patents relate to the mixing of butane with gasoline so as to maximize the amount of butane in the mixture, while complying with EPA regulations. Venture brought four challenges on appeal, and Sunoco cross-appealed based on the district court's denial of additional damages.

First, the Federal Circuit considered the district court's determination that the "experimental-use doctrine" applied and its decision, therefore, not to reach Venture's on-sale bar defense. To succeed on this defense, Venture was required to show by clear and convincing evidence that "before the critical date, Sunoco's patented invention was both (1) 'the subject of a commercial offer for sale' and (2) 'ready for patenting.'" Two days prior to the critical date, the inventor's company entered into an agreement "to sell an automated butane-blending system to [another] company.. 'in consideration for' [the purchase of] at least 500,000 barrels of butane." Finding this agreement to fall within the scope of the "experimental-use doctrine," the district court never reached Venture's on-sale-bar defense since the experimental use negated prong (1) of the defense.

The Federal Circuit reversed the district court's conclusion that the experimental-use doctrine negated Venture's on-sale-bar defense and remanded for the district court to analyze the "ready for patenting" prong of the on sale use defense. The Federal Circuit found that the transaction between the inventor's company and the other company bore "all

the hallmarks of a commercial contract for sale,” and therefore did not meet the requirement under the experimental-use doctrine that the objective evidence “show that a precritical date sale was primarily for experimentation.” Since allowing such sales would allow inventors to “commercialize his invention beyond the statutory term,” the Federal Circuit reversed the district court’s determination that the experimental-use doctrine applied, and remanded for the consideration of the second prong of Venture’s on-sale-bar defense.

The Federal Circuit then addressed the district court’s claim construction and determination of Venture’s infringement of ’302 and ’629 patents. The Federal Circuit vacated the district court’s infringement judgment of claim 16 of the ’302 patent based on the on-sale-bar issue. The on-sale-bar issue did not apply, however, to claim 17 of the 302 patent or claim 31 of the ’629 patent. With respect to claim 17 of the ’302 patent, the Federal Circuit adopted the district court’s construction of the phrase “vapor pressure of the butane stream,” which does not require an actual vapor-pressure measurement, and on that basis, affirmed the district court’s judgment that Venture infringed ’302 patent claim 17. With respect to claim 31 of the ’629 patent, the Federal Circuit again adopted the district court’s claim construction and affirmed the district court’s judgment that Venture infringed ’629 patent claim 31.

The Federal Circuit found the district court abused its discretion in finding Venture liable for treble damages. In opposition to Sunoco’s request for enhanced damages, Venture presented an opinion of counsel (the Manion Opinion) that opined Venture’s product did not infringe the asserted patents. The district court had discounted the Manion Opinion, finding Manion did not understand the technology. The Federal Circuit disagreed, and on that basis vacated the district court’s enhanced damages determination and remanded for the district court to reassess enhancement.

Finally, the Federal Circuit reviewed Sunoco’s cross-appeal challenging the district court’s refusal to award lost profits damages and its reasonable royalty award. The Federal Circuit found no clear error in the district court’s decisions on either of these points, and therefore affirmed those decisions.

Teva Pharms. Int’l GmbH v. Eli Lilly & Co.

8 F.4th 1349 (Fed. Cir. 2021)

Teva Pharmaceuticals International GmbH (“Teva”) appealed from the PTAB’s decision that the claims of Teva’s ’614, ’951, and ’210 patents were unpatentable because they would have been obvious over the cited prior art. The Federal Circuit affirmed the PTAB decision.

Teva owns the ’614, ’951, and ’210 patents, which relate to humanized antagonist antibodies that inhibit CGRP activity. The claims at issue were directed to the antibodies themselves, rather than the methods of using those antibodies for treating certain symptoms. Eli Lilly & Company (“Eli Lilly”) petitioned for IPR of claims in Teva’s patents, arguing that the patents would have been obvious over a combination of three prior

art references. The PTAB found the claims unpatentable for obviousness. Teva appealed. On appeal, Teva did not contest the PTAB's finding that the prior art taught every element of the challenged claims. Instead, Teva raised three challenges: (1) that the PTAB erred as a matter of law in its motivation to combine analysis by deviating from the motivation asserted by Eli Lilly; (2) that substantial evidence did not support the PTAB's factual findings in its motivation to combine analysis; and (3) that the PTAB erred in its analysis of secondary considerations of nonobviousness.

The Federal Circuit concluded that the PTAB properly assessed Eli Lilly's asserted motivation to combine. The Court explained that the prior art supported a motivation to humanize antibodies with the goal of treating human disease, not merely to study or use the antibodies for lab purposes. The Court found that the PTAB extensively analyzed the relevant issue of whether safety and efficacy concerns would have dissuaded a POSITA from making the claimed antibodies to study their therapeutic effects—the PTAB was not required to assess whether one would be dissuaded from *using* the antibodies to treat humans. Applying the substantial evidence standard of review, the Court held that the PTAB did not commit reversible error with respect to its analysis of the motivations to combine the teachings of the prior art references.

With respect to the secondary considerations, the Court first clarified the effect of its earlier ruling in *Fox Factory, Inc. v. SRAM, LLC*. *Fox Factory* provides that there is a presumption of nexus between the asserted evidence of secondary considerations and a patent claim if the patentee shows that the asserted evidence is tied to a specific product and that the product is the invention disclosed and claimed. The Court found that the PTAB erred in declaring a bright-line rule that the presumption of nexus does not apply if any “unclaimed features” materially affect the functioning of a product that is alleged to be coextensive. The Court agreed with Teva's assertion that such a rule would be “unsound.”

The Federal Circuit nevertheless affirmed the PTAB's ultimate conclusion that the secondary considerations Teva cited lacked sufficient nexus to the challenged claims. The Court explained that because the functional claims at issue “have a broad scope due to their lack of structural limitations, the unclaimed features in the commercial products cited [were] of particular importance to the coextensiveness analysis.” Given the “extremely broad scope of the functionally claimed antibodies in the challenged claims and the unclaimed features that undisputedly materially affect” how the cited commercial products function, the Court determined that a nexus could not be presumed. As Teva did not provide justification for asserting a nexus beyond the presumption, the Court held that there was no nexus between the challenged claims and the secondary considerations with respect to the commercial products.

The Court also agreed with the PTAB's conclusion that the cited license lacked nexus to the challenged claims. The licensing of 188 patents made a claim of nexus between the license and any one claim “rather tenuous.” Without additional evidence, a fact finder could not infer that the licensing arose out of recognition of the subject matter claimed in the patent. As a result, the Court held that substantial evidence supported the PTAB's

decision that there was a lack of nexus between the challenged claims and the secondary consideration of licensing.

Teva Pharms. USA, Inc. v. Corcept Therapeutics, Inc.

18 F.4th 1377 (Fed. Cir. 2021)

Corcept owns the '214 patent, which concerns treatments for Cushing's syndrome that involve co-administering mifepristone and a strong CYP3A inhibitor. Corcept asserted the '214 patent against Teva, and Teva responded by arguing that the asserted claims were obvious. The PTAB held that Teva failed to prove its obviousness claim. On appeal, Teva first claimed that the Board erroneously required precise predictability of success, rather than a reasonable expectation of success, by requiring that Teva show an expectation of success for a specific dosage of mifepristone. The Circuit Court disagreed and held that the Board had applied the correct standard, which was correctly tied to the scope of the claimed invention. The Court also rejected Teva's argument that the '214 patent was obvious based on prior art. The Court upheld the Board's finding that there was not enough overlap between the prior art ranges and the claimed range.

Traxcell Tech., LLC v. Nokia Sols. & Networks

15 F.4th 1136 (Fed. Cir. 2021)

Traxcell Technologies, LLC, accused Nokia's Eden-ENT product of infringing three patents related to a self-optimizing wireless network technology. The parties disputed whether Traxcell disclaimed certain constructions of the terms "location," "computer," and "first computer" during patent prosecution. Following claim construction and discovery, the Eastern District of Texas granted Nokia's motion for summary judgment on noninfringement. Traxcell appealed both the district court's claim construction and grant of summary judgment. The Federal Circuit reviewed the district court's claim construction de novo. Regarding "location," the Federal Circuit relied on Traxcell's patent prosecution history. In order to distinguish its invention from prior art references, Traxcell emphasized that the term "location" was not to be limited to a specific position in the grid pattern. Agreeing with the district court, the Court found that, by making this distinction to get around prior art, Traxcell was foreclosed from asserting a different meaning for "location," and therefore Nokia's Eden-ENT did not literally infringe Traxcell's patent, as the location of Nokia's product was limited to a specific grid pattern. The Court then addressed the interpretation of "computer" and "first computer." Looking to the language of the '024 and '284 patents, which attribute a multitude of functions to a "computer" or "said first computer," the Court agreed with the district court's finding that all of the functions must be attributed to a single computer. The Court again relied on the patent prosecution history, as Traxcell distinguished its invention from prior art "in part because that prior reference used multiple computers, whereas its claim invention . . . only used one." In light of this claim construction, the Court found that Nokia's Eden-ENT product did not literally infringe Traxcell's patent as Nokia's product not only uses multiple computers, but requires multiple computers to be functional. Finally, the Court agreed with the district court that Traxcell could not succeed on a multiple-computer theory of

infringement because prosecution-history estoppel forecloses the assertion of such a theory where Traxcell had surrendered that scope during patent prosecution.

Traxcell Techs., LLC v. Sprint Commc'ns Co.

15 F.4th 1121 (Fed. Cir. 2021)

In this case, the Court addressed the issues of claim construction and infringement for self-optimizing technology and navigation patents. Traxcell Technologies, LLC, brought an infringement suit against Sprint Communications and Verizon. Traxcell accused Sprint of infringing on four patents: three patents related to a self-optimizing wireless network technology, herein referred to as the “SON patents” and one patent related to a navigation system, herein referred to as the “navigation patent.” According to Traxcell, Sprint’s Samsung dSON infringed on the SON patents and Sprint’s mobile devices loaded with Google maps infringed on the navigation patent. Traxcell accused Verizon of infringing on three patents: two of the SON patents and the navigation patent. According to Traxcell, Verizon’s Ericsson C-SON infringed upon two of the SON patents and Verizon mobile devices loaded with Google Maps or VZ Navigator infringed on the navigation patent. Following claim construction and discovery, the Eastern District of Texas granted Sprint’s motion for summary judgement on noninfringement. Traxcell appealed both the district court’s claim construction and grant of summary judgement.

Reviewing *de novo*, the Federal Circuit reviewed the following: whether Sprint’s accused device met the “way” prong of the function-way-result test, whether SON patents’ “first computer” and “computer” terms were limited to a single computer, whether “location” meant a “location that is not merely a position in a grid pattern,” whether claim 1 of the ’284 patent was indefinite for failure to disclose sufficient structure for a means-plus-function limitation, and whether the accused devices infringed on the navigation patent. The Federal Circuit affirmed the district court’s finding on all issues.

Agreeing with the district court, the Federal Circuit found that Traxcell failed to produce sufficient evidence to support the argument that accused systems contained the structure required for the means-plus-function element of the asserted patent. Accordingly, the Federal Circuit found that Sprint’s accused technology does not operate in substantially the same way as the disclosure structure. The district court rejected argument that the stipulated construction of the term “location” was an issue that could be raised or changed on appeal. At trial, the parties stipulated that the term “location” meant a “location that is not merely a position in a grid pattern.” Before the Federal Circuit, Traxcell insisted that this construction was wrong. Having stipulated to it, the Federal Circuit found that Traxcell could not “pull an about-face.” The Federal Circuit then held that neither of the accused technologies do not use a “location” as constructed.

The Federal Circuit again affirmed the lower court’s interpretation of “computer” and “first computer.” The Federal Circuit, citing *Traxcell Tech. LLC v. Nokia*, agreed with the district court’s finding that all of the functions must be attributed to a single computer. In light of this claim construction, the Federal Circuit found that Traxcell failed to show that accused technologies used a *single* computer to perform the required functions.

Additionally, the Federal Circuit rejected Traxcell's argument that Sprint's LSM server system and Verizon's SON portal, an interface, constitute a single computer.

Turning to the validity of claim 1 of the '284 patent, the Federal Circuit affirmed the district court's indefiniteness finding as "the specification lacks the necessary structure for claim 1's mean-plus-function limitation." The Federal Circuit agreed with the district court's statement that "Traxcell had not explained how that structure in the specification actually provides location-based corrective actions but had instead offered speculation about how location data might be used."

Finally, the Federal Circuit addressed the district court's judgment of noninfringement of the navigation patent. On this issue, the accused products are Sprint's mobile devices loaded with Google Maps and Verizon's mobile devices loaded with Google Maps or VZ Navigator. Traxcell argued that the network determined the devices' location because Google Maps and VZ Navigator both need to use data from the network to determine the location of the device. Agreeing with the district court, the Federal Circuit rejected this argument and instead found that Traxcell failed to show the networks, as opposed to the devices, determined the devices location.

Uniloc USA, Inc. v. Apple Inc.

25 F.4th 1018 (Fed. Cir. 2022)

This case concerns the standard for sealing filings in district court. In a previous appeal, the Federal Circuit upheld the district court's decision to unseal certain redactions involving public records, but instructed the district court to consider whether information regarding third-party licenses was properly sealed. *Uniloc 2017 LLC v. Apple, Inc.*, 964 F.3d 1351, 1363-64 (Fed. Cir. 2020). On remand from the first appeal, Uniloc moved to seal documents disclosing licensing terms, counterparties, and amounts, including an investment memorandum that contained a third party's investment criteria and licensing information from Fortress Credit Co. LLC. Apple did not oppose Uniloc's motion to seal, but Electronic Frontier Foundation intervened to argue against sealing. Reasoning that the public had a right to information about the valuation of patent rights and licensing terms, the district court denied the motion to seal. With respect to the Fortress memorandum, the district court held that Fortress should have filed the motion, not Uniloc, and therefore unsealed the memorandum for failure to comply with local rules. Uniloc appealed to the Federal Circuit, and the Electronic Frontier Foundation intervened.

Applying Ninth Circuit law, the Federal Circuit found that the district court abused its discretion by failing to make particularized sealing decisions as to the information in each document and remanded the case to perform this analysis. The Federal Circuit went on to state that the district court "made an error of law in making a blanket ruling that the public has a broad right to licensing information relating to patents." Instead, the Federal Circuit found that the public is not necessarily entitled to know details about licensing terms or consideration absent some issue raised by the parties about license rights. Finally, regarding the Fortress memorandum, the Federal Circuit held that a procedural failure to follow local rules should not result in unsealing confidential information of third parties

without a specific determination that the public interest in seeing that confidential information outweighs the third party's interest in keeping it confidential.

Judge Mayer dissented, stating that the district court adhered to the Federal Circuit's remand instructions and was best positioned to evaluate whether there is a compelling reason to seal documents. The dissent also found that declarations submitted by Uniloc's licensees were conclusory and did not show a compelling reason to seal. Judge Mayer further stated that the public presumptively has a broad right of access to all information filed with a court in connection with a dispositive motion, which includes patent licensing information.

Univ. of Mass. v. L'Oréal S.A.

36 F.4th 1374 (Fed. Cir. 2022)

The University of Massachusetts ("UMass") appealed the District Court for the District of Delaware's judgment that UMass's '327 and '513 patents were invalid for indefiniteness, based on the District Court's earlier claim construction ruling. UMass also appealed the district court's dismissal of a foreign party without jurisdictional discovery. The Federal Circuit reversed the underlying claim construction ruling, vacated the indefiniteness and personal jurisdiction rulings, and remanded the case for further proceedings.

The asserted patents relate to methods for enhancing the condition of the skin by topical application of a composition containing adenosine. Claim 1 in both patents described the method of application "comprising topically applying to the skin a composition comprising a concentration of adenosine in an amount effective to enhance the condition of the skin.. wherein the adenosine concentration applied to the dermal cells is 10^{-4} M to 10^{-7} M" (where M conveys molar concentration). UMass filed a patent infringement suit against L'Oréal S.A., and its American subsidiary, L'Oréal USA. The district court granted L'Oréal S.A. 12(b) motion to dismiss for lack of personal jurisdiction.

Prior to trial in the district court, L'Oréal USA petitioned for IPR of the patents at issue. The PTAB adopted UMass's construction of the wherein clause in claim 1, finding that the concentration range referred to the adenosine concentration applied to the dermal cells in the subsurface dermis. During claim construction, the district court reached the same conclusion as the PTAB. L'Oréal USA moved for summary judgment, arguing that the language preceding the wherein clause in claim 1 would be indefinite under the court's claim construction ruling if the court also concluded that the concentration range in the wherein clause did not establish the adenosine concentration in the composition topically applied to the skin. The district court granted the summary judgment motion and, finding the claims indefinite, entered a final judgment of invalidity. UMass appealed.

On appeal, UMass challenged the district court's indefiniteness determination, arguing that the lower court's initial claim construction was incorrect. UMass further challenged the lower court's decision to dismiss L'Oréal S.A. from the suit without jurisdictional discovery.

The Federal Circuit rejected UMass’s claim construction. The Court found that because the claim language was not plain on its face, the proper interpretation must be drawn from the specification and the prosecution history. The Court concluded that none of the embodiments in the specification provided a measurement of the concentration of adenosine that must reach the subsurface dermis. Additionally, there was no indication that the inventors contemplated measuring the adenosine concentration after exposure to the cells. The Federal Circuit also noted that during prosecution, UMass imported language into the wherein clause from dependent clauses that made no reference to subsurface dermal cells. Moreover, UMass did not directly correct the patent examiner’s statement that the method comprised “administering adenosine.. to the skin.” For these reasons, the Court held that the prosecution history required the wherein clause to be read to refer to concentrations of the composition applied to the skin’s surface.

As a result of this new claim construction, the Court vacated the indefiniteness ruling and remanded the issue for further proceedings in the district court. Additionally, the Court found that the district court had abused its discretion in declining to allow jurisdictional discovery before dismissing L’Oréal S.A. as a party in the case. As such, the Federal Circuit vacated the jurisdictional determinations and remanded for further proceedings.

Univ. of S. Fla. Rsch. Found., Inc. v. Fujifilm Med. Sys. U.S.A., Inc.
19 F.4th 1315 (Fed. Cir. 2021)

The University of South Florida Research Foundation (USFRF) filed a patent infringement suit against Fujifilm Medical Systems (Fujifilm). Fujifilm moved for summary judgment, arguing that USFRF lacked statutory standing because the patent license agreement between the original inventors, USF, and USFRF (which transferred all rights from the inventors to USF) did not transfer sufficient rights to USFRF such that USFRF could bring suit without USF’s participation. The United States District Court for the District of Connecticut dismissed the case without prejudice based on Federal Rule of Civil Procedure 12(h)(3) for lack of both statutory and constitutional standing. USFRF appealed the dismissal to the Federal Circuit.

The Federal Circuit noted that the district court followed some of the Federal Circuit’s “older cases in which [the Court] referred to whether a plaintiff may bring suit under 35 U.S.C. § 281 as ‘statutory standing’”—the Court has since clarified that Section 281 is “simply a statutory requirement” confining the ability to bring a civil action for infringement to a patentee, and “does not ‘implicate standing or subject-matter jurisdiction.’” See *Lone Star Silicon Innovations LLC v. Nanya Tech. Corp.*, 925 F.3d 1225, 1235–36 (Fed. Cir. 2019). The district court found that USFRF was not the patentee under the terms of the license agreement. The Federal Circuit agreed, as the license agreement did not transfer enough substantial rights from USF to USFRF to render USFRF the patentee. Crucially, the agreement did not transfer USF’s right to sue to USFRF, supporting the district court’s conclusion that USFRF could not sue without USF’s participation. Although the license agreement’s duration was substantial, USF “retained enough important rights to conclude that USF did not transfer all substantial rights in the

patent,” and the Federal Circuit agreed that USFRF failed to meet the statutory requirements of Section 281.

As far as constitutional standing, the Federal Circuit disagreed with the district court’s finding that the only way USFRF could establish that the license agreement covered the patent in question was by producing the invention disclosure form, which USFRF refused to produce. The Federal Circuit found that the “correlation of the patent application serial number listed on the assignment and the face of the patent should have been sufficient in this case to prove that the license agreement covered” the patent at issue. The district court had also determined that USFRF lacked constitutional standing because the license agreement was undated and retroactive to 1997, and USFRF “failed to show when the document was signed.” The Federal Circuit disagreed, finding that even if the license agreement was signed after the complaint was filed, USFRF “would have held at least one exclusionary right in the patent under the Revenue Allocation Agreement,” which was signed prior to the filing of the complaint, and which would be sufficient to satisfy constitutional standing. Because “the district court’s holding that USFRF lacked constitutional standing rest[ed] on two clearly erroneous findings of fact,” the district court’s dismissal was in error.

Univ. of Strathclyde v. Clear-Vu Lighting LLC

17 F.4th 155 (Fed. Cir. 2021)

The Federal Circuit reversed the PTAB’s determination that certain claims of the University of Strathclyde (“Strathclyde”)’s ’706 patent were unpatentable as obvious. Clear-Vu Lighting LLC (“Clear-Vu”) filed petitions for inter partes review of the ’706 patent, asserting that various claims were obvious in view of prior art references. The PTAB agreed that claims 1 and 3 would have been obvious over prior art references Ashkenazi and Nitzan. On appeal, the Federal Circuit found that the prior art did not disclose all of the claim limitations and that there was no support for the Board’s finding that a POSITA would have had a reasonable expectation of success when combining the prior art references.

The Court saw no reason why a POSITA would omit a photosensitizer when combining the two references, and found that the PTAB’s finding to the contrary was not supported by substantial evidence. The ’706 patent describes a method for killing harmful, antibiotic-resistant bacteria like MRSA via photoinactivation by exposure to blue light with a wavelength of 400–500 nm without first applying a photosensitizing agent. The primary dispute was whether the prior art references taught inactivating bacteria such as MRSA without the use of a photosensitizer. The Ashkenazi reference discloses inactivating bacteria after exposure to 407–420 nm blue light, but all of Ashkenazi’s bacteria cultures were grown in the presence of some form of photosensitizer. The Court found nothing in the article disclosed or suggested inactivating any bacteria without applying a photosensitizer. The Nitzan reference provided an example in which bacteria were exposed to blue light without a photosensitizer but did not demonstrate successful inactivation under such conditions.

The Court similarly reversed the PTAB's finding that a POSITA would have expected the successful inactivation of MRSA without using a photosensitizer. Between the Nitzan prior art reference and an earlier publication authored by Dr. Nitzan, the experimental record demonstrated not only a lack of evidence showing inactivation of bacteria after exposure to 407–420 nm blue light in the absence of a photosensitizer, but a number of failed experiments in inactivating MRSA without a photosensitizer, even using a range of light doses and wavelengths. Such failures, the Court found, undermine a finding of reasonable expectation of success, and the PTAB's finding to the contrary was thus not supported by substantial evidence. The Court clarified that “absolute predictability of success is not required, only a reasonable expectation.”

Universal Secure Registry LLC v. Apple Inc.

10 F.4th 1342 (Fed. Cir. 2021)

Universal Secure Registry (USR) sued Apple for allegedly infringing all claims of its '859, '813, '826, and '137 patent, which describe processes for securing electronic payment transactions without disclosing financial information to the merchant. Apple moved to dismiss under Federal Rule 12(b)(6), arguing that the claims were patent-ineligible subject matter under 35 U.S.C. § 101. The district court dismissed all claims, concluding that the patents were aimed at “abstract ideas” and, since the patents failed steps one and two of the Supreme Court's *Alice* test, the claims were not patent-eligible under Section 101 and were thus invalid. USR appealed.

The Federal Circuit affirmed. The Court held that in cases involving “authentication technology,” in order to pass the *Alice* test's second step, claims must “provide sufficient specificity and constitute an improvement in computer functioning.” The Court found that all four patents did not pass either step of the test. At step one, it found that USR's patents were “abstract” because they merely described combinations of existing conventional or long-standing technology (like computer processors, biometric scans, and handheld devices) or authentication techniques (like two-factor authentication, third-party payment processing, and data retrieval).

At step two, the Court found that the abstract idea was not sufficiently transformed because there was no evidence that the “claimed combination of these conventional authentication techniques achieves more than the expected sum of the security provided by each technique.” The Court distinguished USR's claims from patent-eligible specific technological innovations—such as storing authentication information in a novel type of computer memory file not previously used for that purpose—that improved computer functioning or yielded some other “unexpected improvement.” Because USR's patents described only “generic, well-known components” performing “routine functions,” it failed *Alice*'s second step and the claims were not patent-eligible under Section 101.

Valve Corp. v. Ironburg Inventions Ltd.

8 F.4th 1364 (Fed. Cir. 2021)

Valve Corporation petitioned for *inter partes* review (IPR) of two patents, '688 and '229, owned by Ironburg Inventions directed to hand held controllers for game consoles. The PTAB found certain claims anticipated, certain others not anticipated, and further certain others that might have been rendered obvious by the "Burns article," but for it not being established as prior art. Both parties appealed.

The Burns article was a printed copy of an online review of an Xbox 360 controller, published on October 20, 2010. It had been cited as prior art during prosecution of both patents involved in the IPRs, as well as an unrelated application (which issued as the '525 patent) by the same inventor. Despite its use in prosecution, the PTAB found that the IPR exhibit was not authenticated. The Federal Circuit disagreed, finding the record was sufficient to establish that the exhibit proffered in the IPR was substantively the same as the Burns article cited and lodged during prosecution because the Board was obligated to compare the Burns article with the file histories of the patents, notwithstanding that no authentication testimony was provided, which the Federal Circuit did on its own. The Federal Circuit then determined that the Burns Article was prior art that was available to the public, as evidenced by (i) its use in prosecution of the '525 patent and a subsequent deposition where a co-inventor testified that the purpose of the Burns article was promotion, (ii) statements by the examiners in the prosecution histories categorizing it as having been "published," (iii) its inclusion in an Information Disclosure Statement, and (iv) the fact that an examiner found it on the Wayback Machine after an independent search. The Court reversed and remanded to consider invalidity in light of the Burns article.

The Court also affirmed certain claim construction arguments on both sides, and rejected petitioner's argument (opposed by the intervening USPTO) under *United States v. Arthrex, Inc.*, 141 S. Ct. 1970 (2021) (holding that PTAB judges are not Officers) that it was entitled to Director review because by invoking the PTAB's authority it had forfeited its Appointment Clause challenge.

ALPHABETICAL INDEX OF ALL CASES

	<u>Page</u>
<i>Acceleration Bay LLC v. 2K Sports, Inc.</i> 15 F.4th 1069 (Fed. Cir. 2021)	37
<i>Adapt Pharma Ops. Ltd. v. Teva Pharms. USA, Inc.</i> 25 F.4th 1354 (Fed. Cir. 2022)	38
<i>Alarm.com Inc. v. Hirshfeld</i> 26 F.4th 1348 (Fed. Cir. 2022)	38
<i>Almirall, LLC v. Amneal Pharm. LLC</i> 28 F.4th 265 (Fed. Cir. 2022)	39
<i>Andra Grp., LP v. Victoria's Secret Stores, LLC</i> 6 F.4th 1283 (Fed. Cir. 2021)	40
<i>Apple Inc. v. MPH Tech. Oy</i> 28 F.4th 254 (Fed. Cir. 2022)	41
<i>Apple Inc. v. Qualcomm Inc.</i> 17 F.4th 1131 (Fed. Cir. 2021)	42
<i>Apple Inc. v. Wi-LAN Inc.</i> 25 F.4th 960 (Fed. Cir. 2022)	43
<i>Apple Inc. v. Zipit Wireless, Inc.</i> 30 F.3th 1368 (Fed. Cir. 2022)	43
<i>Arthrex, Inc. v. Smith & Nephew, Inc.</i> 35 F.4th 1328 (Fed. Cir. 2022)	44
<i>AstraZeneca AB v. Mylan Pharms. Inc.</i> 19 F.4th 1325 (Fed. Cir. 2021)	45
<i>Atlanta Gas Light Co. v. Bennett Regulator Guards, Inc.</i> 33 F.4th 1348 (Fed. Cir. 2022)	46
<i>Auris Health, Inc. v. Intuitive Surgical Operations, Inc.</i> 32 F.4th 1154 (Fed. Cir. 2022)	47
<i>BASF Plant Sci., LP v. Commonwealth Sci. Indus. Rsch. Org.</i> 28 F.4th 1247 (Fed. Cir. 2022)	47
<i>Belcher Pharms., LLC v. Hospira, Inc.</i> 11 F.4th 1345 (Fed. Cir. 2021)	49

Biogen Int’l GmbH v. Mylan Pharms. Inc.
28 F.4th 1194 (Fed. Cir. 2021)50

Biogen Int’l GmbH v. Mylan Pharms. Inc.
18 F.4th 1333 (Fed. Cir. 2021)51

BlephEx, LLC v. Myco Indus., Inc.
24 F.4th 1391 (Fed. Cir. 2022)52

Broadcom Corp. v. Int’l Trade Comm’n
28 F.4th 240 (Fed. Cir. 2022)53

Cal. Inst. of Tech. v. Broadcom Ltd.
25 F.4th 976 (Fed. Cir. 2022)54

Campbell Soup Co. v. Gamon Plus, Inc.
10 F.4th 1268 (Fed. Cir. 2021)55

CareDx, Inc. v. Natera, Inc.
40 F.4th 1371 (Fed. Cir. 2022)56

Celgene Corp. v. Mylan Pharms. Inc.
17 F.4th 1111 (Fed. Cir. 2021)56

Centripetal Networks, Inc. v. Cisco Sys., Inc.
38 F.4th 1025 (Fed. Cir. 2022)57

ClearOne, Inc. v. Shure Acquisition Holdings
35 F.4th 1345 (Fed. Cir. 2022)58

CommScope Techs. LLC v. Dali Wireless Inc.
10 F.4th 1289 (Fed. Cir. 2021)59

CosmoKey Sols. GmbH & Co. KG v. Duo Security LLC
15 F.4th 1091 (Fed. Cir. 2021)60

Data Engine Techs. LLC v. Google LLC
10 F.4th 1375 (Fed. Cir. 2021)61

DBN Holding, Inc. v. Int’l Trade Comm’n
26 F.4th 1363 (Fed. Cir. 2022)61

Eli Lilly & Co. v. Teva Pharms. Int’l GmbH
8 F.4th 1331 (Fed. Cir. 2021)62

Energy Heating, LLC v. Heat On-The-Fly, LLC
15 F.4th 1348 (Fed. Cir. 2021)63

<i>Evolution Concepts, Inc. v. HOC Events, Inc.</i> 22 F.4th 1361 (Fed. Cir. 2022)	64
<i>Fleming v. Cirrus Design Corp.</i> 28 F.4th 1214 (Fed. Cir. 2022)	64
<i>Genuine Enabling Tech. v. Nintendo Co., Ltd.</i> 29 F.4th 1365 (Fed. Cir. 2022)	65
<i>GlaxoSmithKline LLC v. Teva Pharms. USA, Inc.</i> 7 F.4th 1320 (Fed. Cir. 2021)	65
<i>GlaxoSmithKline LLC v. Teva Pharms. USA, Inc.</i> 25 F.4th 949 (Fed. Cir. 2022)	67
<i>Google LLC v. IPA Techs. Inc.</i> 34 F.4th 1081 (Fed. Cir. 2022)	67
<i>Hunting Titan, Inc. v. DynaEnergetics Europe GmbH</i> 28 F.4th 1371 (Fed. Cir. 2022)	68
<i>Hyatt v. Hirshfeld</i> 16 F.4th 855 (Fed. Cir. 2021)	69
<i>In re Juniper Networks, Inc.</i> 14 F.4th 1313 (Fed. Cir. 2021)	70
<i>In re Maxpower Semiconductor, Inc.</i> 13 F.4th 1348 (Fed. Cir. 2021)	71
<i>In re SurgiSil, L.L.P.</i> 14 F.4th 1380 (Fed. Cir. 2021)	71
<i>In re Violation of the Revised Protocols for In-Person Arguments & Related Order</i> 26 F.4th 1270 (Fed. Cir. 2022)	72
<i>In re VIVINT, Inc.</i> 14 F.4th 1342 (Fed. Cir. 2021)	72
<i>In re Volkswagen Grp. of Am., Inc.</i> 28 F.4th 1203 (Fed. Cir. 2022)	73
<i>Intel Corp. v. Qualcomm Inc.</i> 21 F.4th 784 (Fed. Cir. 2021)	74
<i>Intel Corp. v. Qualcomm Inc.</i> 21 F.4th 801 (Fed. Cir. 2021)	74

<i>Intuitive Surgical, Inc. v. Ethicon LLC</i> 25 F.4th 1035 (Fed. Cir. 2022)	75
<i>Invidior UK Ltd. v. Dr. Reddy’s Lab’ys S.A.</i> 18 F.4th 1323 (Fed. Cir. 2021)	76
<i>Junker v. Med. Components, Inc.</i> 25 F.4th 1027 (Fed. Cir. 2022)	77
<i>Juno Therapeutics, Inc. v. Kite Pharma, Inc.</i> 10 F.4th 1330 (Fed. Cir. 2021)	77
<i>Kannuu Pty Ltd. v. Samsung Elecs. Co.</i> 15 F.4th 1101 (Fed. Cir. 2021)	78
<i>Kaufman v. Microsoft Corp.</i> 34 F.4th 1360 (Fed. Cir. 2022)	79
<i>Koninklijke Philips N.V. v. Thales USA, Inc.</i> 39 F.4th 1377 (Fed. Cir. 2022)	79
<i>Kyocera Senco Indus. Tools Inc. v. Int’l Trade Comm’n</i> 22 F.4th 1369 (Fed. Cir. 2022)	79
<i>LG Elecs. Inc. v. Immervision, Inc.</i> 39 F.4th 1364 (Fed. Cir. 2022)	80
<i>Littelfuse, Inc. v. Mersen USA EP Corp.</i> 29 F.4th 1376 (Fed. Cir. 2022)	81
<i>Lubby Holdings, LLC v. Chung</i> 11 F.4th 1355 (Fed. Cir. 2021)	81
<i>Mitek Sys., Inc. v. United Services Auto. Ass’n</i> 34 F.4th 1334 (Fed. Cir. 2022)	82
<i>MLC Intell. Prop., LLC v. Micron Tech., Inc.</i> 10 F.4th 1358 (Fed. Cir. 2021)	83
<i>Mobility Workx, LLC v. Unified Patents, LLC</i> 15 F.4th 1136 (Fed. Cir. 2021)	84
<i>ModernaTx, Inc. v. Arbutus Biopharma Corp.</i> 18 F.4th 1364 (Fed. Cir. 2021)	85
<i>ModernaTx, Inc. v. Arbutus Biopharma Corp.</i> 18 F.4th 1352 (Fed. Cir. 2021)	86

<i>Mondis Tech. Ltd. v. LG Elecs. Inc.</i> 6 F.4th 1379 (Fed. Cir. 2021).....	86
<i>Nature Simulation Sys. Inc. v. Autodesk, Inc.</i> 23 F.4th 1334 (Fed. Cir. 2022).....	87
<i>Niazi Licensing Corp. v. St. Jude Med. SC, Inc.</i> 30 F.4th 1339 (Fed. Cir. 2022).....	88
<i>Nippon Shinyaku Co., Ltd. v. Sarepta Therapeutics, Inc.</i> 25 F.4th 998 (Fed. Cir. 2022).....	89
<i>Omega Pats., LLC v. CalAmp Corp.</i> 13 F.4th 1361 (Fed. Cir. 2021).....	90
<i>Omni MedSci, Inc. v. Apple Inc.</i> 7 F.4th 1148 (Fed. Cir. 2021).....	91
<i>Pavo Sols. LLC v. Kingston Tech. Co.</i> 35 F.4th 1367 (Fed. Cir. 2022).....	92
<i>PersonalWeb Techs. LLC v. Google LLC</i> 8 F.4th 1310 (Fed. Cir. 2021).....	92
<i>PlasmaCAM, INC. v. Cncelectronics, LLC</i> 24 F.4th 1378 (Fed. Cir. 2022).....	93
<i>Qualcomm Inc. v. Apple Inc.</i> 24 F.4th 1367 (Fed. Cir. 2022).....	94
<i>Quanergy Sys., Inc. v. Velodyne Lidar USA, Inc.</i> 24 F.4th 1406 (Fed. Cir. 2022).....	95
<i>Realtime Adaptive Streaming LLC v. Netflix, Inc.</i> 41 F.4th 1372 (Fed. Cir. 2022).....	96
<i>Roche Diagnostics Corp. v. Meso Scale Diagnostics, LLC</i> 30 F.4th 1109 (Fed. Cir. 2022).....	96
<i>Seabed Geosolutions (US) Inc. v. Magseis FF LLC</i> 8 F.4th 1285 (Fed. Cir. 2021).....	97
<i>Sound View Innovations, LLC v. Hulu, LLC</i> 33 F.4th 1326 (Fed. Cir. 2022).....	98
<i>SRI Int'l, Inc. v. Cisco Sys. Inc.</i> 14 F.4th 1323 (Fed. Cir. 2021).....	98

<i>Sunoco Partners Marketing v. U.S. Venture, Inc.</i> 32 F.4th 1161 (Fed. Cir. 2022)	99
<i>Teva Pharms. Int’l GmbH v. Eli Lilly & Co.</i> 8 F.4th 1349 (Fed. Cir. 2021)	100
<i>Teva Pharms. USA, Inc. v. Corcept Therapeutics, Inc.</i> 18 F.4th 1377 (Fed. Cir. 2021)	102
<i>Traxcell Tech., LLC v. Nokia Sols. & Networks</i> 15 F.4th 1136 (Fed. Cir. 2021)	102
<i>Traxcell Techs., LLC v. Sprint Commc’ns Co.</i> 15 F.4th 1121 (Fed. Cir. 2021)	103
<i>Uniloc USA, Inc. v. Apple Inc.</i> 25 F.4th 1018 (Fed. Cir. 2022)	104
<i>Univ. of Mass. v. L’Oréal S.A.</i> 36 F.4th 1374 (Fed. Cir. 2022)	105
<i>Univ. of S. Fla. Rsch. Found., Inc. v. Fujifilm Med. Sys. U.S.A., Inc.</i> 19 F.4th 1315 (Fed. Cir. 2021)	106
<i>Univ. of Strathclyde v. Clear-Vu Lighting LLC</i> 17 F.4th 155 (Fed. Cir. 2021)	107
<i>Universal Secure Registry LLC v. Apple Inc.</i> 10 F.4th 1342 (Fed. Cir. 2021)	108
<i>Valve Corp. v. Ironburg Inventions Ltd.</i> 8 F.4th 1364 (Fed. Cir. 2021)	109