

GIBSON DUNN

Federal Circuit Year in Review 2019/2020

Intellectual Property and Appellate Practice Groups



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INTRODUCTION

The Federal Circuit's 2019–2020 term saw a number of important developments in patent law. The Court issued 130 published opinions. This term included significant panel decisions in patent law jurisprudence with regard to the constitutionality of the PTAB and its jurisdiction and procedures (*Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019), *Samsung Electronics America, Inc. v. Prisia Engineering Corp.*, 948 F.3d 1342 (Fed. Cir. 2020), and *Nike, Inc. v. Adidas AG*, 955 F.3d 45 (Fed. Cir. 2020)), subject matter eligibility (*American Axle & Manufacturing, Inc. v. Neapco Holdings LLC*, 967 F.3d 1285 (Fed. Cir. 2020), and *Illumina, Inc. v. Ariosa Diagnostics, Inc.*, 952 F.3d 1367 (Fed. Cir. 2020)), and venue (*In re Google LLC*). Each of these decisions, as well as all other precedential decisions issued by the Federal Circuit in the 2019–2020 term, is summarized in the pages that follow.

There are several notable trends borne out by the statistics this year. For example, the trend of decreasing time from oral argument to written decision continued, down to 118 days on average this term. It was at 135 days, 157 days, and 182 days in the three prior terms, respectively. The number of appeals per district court was more balanced this term. For example, last term the top three district courts accounted for around 70% of all precedential decisions, whereas this term the top three district courts accounted for only around 35% of precedential decisions. Finally, the percentage of appeals from the PTO compared to those from district courts has remained steady at around 40%. A few years ago, the percentage of appeals from the PTO was closer to 30%.

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



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GIBSON DUNN'S FEDERAL CIRCUIT CLERKS

Gibson Dunn is proud to have as key members of its Appellate and Intellectual Property practices 13 former clerks from the U.S. Court of Appeals for the Federal Circuit:



William C. Rooklidge (Former Chief Judge Nies, 1985–1987), a partner in the Orange County office of Gibson Dunn, joined the firm in 2015. A member of the firm's Litigation Department and Intellectual Property Practice Group, he has extensive experience in patent and trademark infringement litigation in the federal district courts and before the United States Court of Appeals for the Federal Circuit, as well as arbitration of patent disputes.



Brian Buroker (Judge Bryson, 1996–1997) is a partner in Gibson Dunn's Washington, D.C. office and is a member of the firm's Intellectual Property Practice, focusing on patent litigation, appeals and complex patent issues, having tried patent cases, litigated many patent cases to resolution, argued cases at the Federal Circuit and handled complex patent reexaminations, covered business method review and *inter partes* review proceedings at the U.S. Patent Office.



Stuart M. Rosenberg (Former Chief Judge Michel, 2007–2008) is a partner in the Palo Alto office of Gibson Dunn, where his practice focuses on intellectual property litigation. He has represented clients in a variety of industries and technologies, including software, consumer electronics, medical devices, sporting goods, and automotive design.



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.



Nathan R. Curtis (Judge Dyk, 2011–2012) is an associate 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.



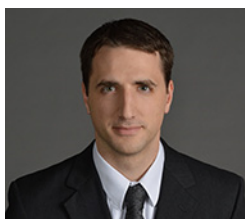
Jaysen Chung (Former Chief Judge Rader, 2014) is an associate in the San Francisco office of Gibson Dunn and is a member of the firm's Litigation department. He focuses on patent and appellate litigation, and has experience in a range of arts and practices, including pharmaceuticals, DNA sequencing applications,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



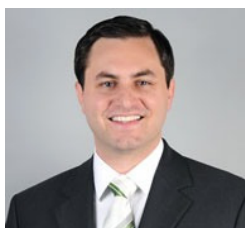
Omar Amin (Judge Reyna, 2014–2015) is an associate in the Washington, D.C. office of Gibson Dunn and is a member of the firm's Litigation department. His practice focuses on patent litigation, and he has experience in a range of technologies, including consumer electronics, analog and digital circuits, software, medical devices, and telecommunication networks.



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.



Taylor King (Judge O'Malley, 2016–2017) is an associate in the Orange County office of Gibson Dunn. Taylor is a member of the firm's Litigation department and his practice focuses on intellectual property litigation and appeals. He has represented clients in a variety of industries and technologies, including electronics, medical devices, vehicle emissions, sporting goods, e-commerce, and pharmaceuticals.



Andrew Wilhelm (Judge Reyna, 2016–2017) is an associate in the Washington, D.C. office of Gibson Dunn. Andrew is a member of the firm's Litigation department. His work focuses on appellate litigation and dispositive trial briefing. He is active in several federal courts of appeals, including the Federal Circuit and United States Supreme Court.



Jessica Hudak (Chief Judge Prost, 2016–2018) is an associate in the Orange County office of Gibson Dunn. Jessica is a member of the firm’s Litigation Department and her practice focuses on intellectual property litigation at both the trial and appellate levels. Jessica has experience in a range of technologies, including medical devices, pharmaceuticals, and consumer electronics. Jessica brings with her to Gibson Dunn over a decade of patent prosecution experience.



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.

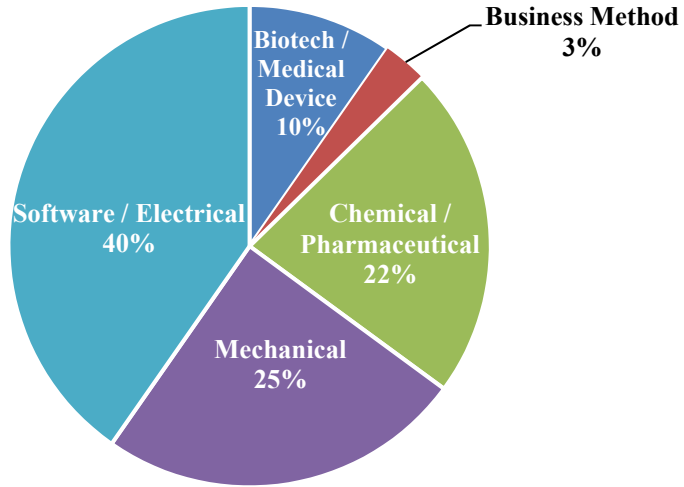
STATISTICAL ANALYSIS
 (August 1, 2019 – July 31, 2020)

| Overview | |
|---|---|
| Precedential Patent Cases | 130 |
| District Court (% of cases) | 55% |
| PTO (% of cases) | 39% |
| ITC (% of cases) | 4% |
| CFC (% of cases) | 2% |
| Top 5 District Courts | District of Delaware (31) District of New Jersey (14) Northern District of California (12) Eastern District of Texas (11) Central District of California (10) |
| Final Decisions on Validity of the Patent | Valid 15 / Invalid 28 / Both 5 |
| Cases With Amicus Briefs | 17 |
| <i>En Banc</i> Cases Decided | 0 |
| Average Times | |
| Lower Tribunal Decision to Federal Circuit Oral Argument* | 466 Days |
| Lower Tribunal Decision to Federal Circuit Decision | 560 Days |
| Docketing to Federal Circuit Oral Argument* | 389 Days |
| Docketing to Federal Circuit Decision | 483 Days |
| Oral Argument* to Federal Circuit Decision | 118 Days |
| * Only cases where oral argument held | |
| Opinion Authorship | |
| Most Opinions | Reyna (24) |
| Most Majority Opinions | Lourie (22) |
| Fewest Majority Opinions | Clevenger, Linn, Schall (0 each) |
| Most Concurring Opinions | Newman (5) |
| Most Dissenting Opinions | Newman (12) |
| Fewest Dissenting Opinions | Bryson, Chen, Hughes, Linn, Mayer, Plager, Schall, Stoll, Wallach (0 each) |
| Most Unanimous Decisions | Lourie (17) |

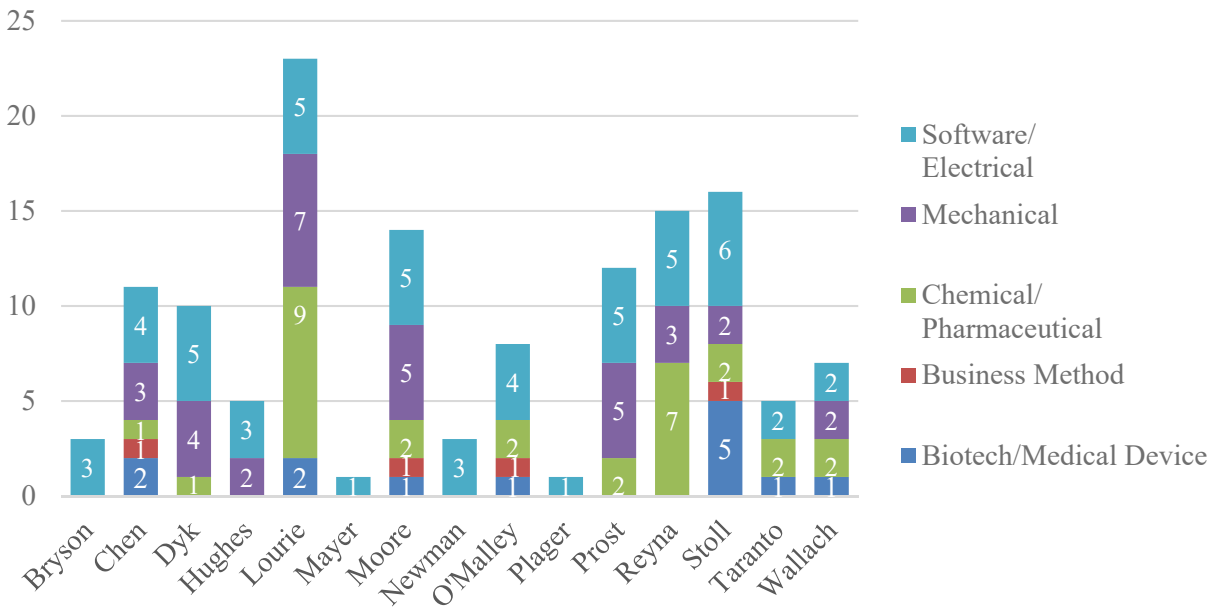


| Cases by Subject Matter | |
|--------------------------------|-----|
| Chemical/Pharmaceutical | 22% |
| Biotech/Medical Device | 10% |
| Software/Electrical | 40% |
| Business Method | 3% |
| Mechanical | 25% |

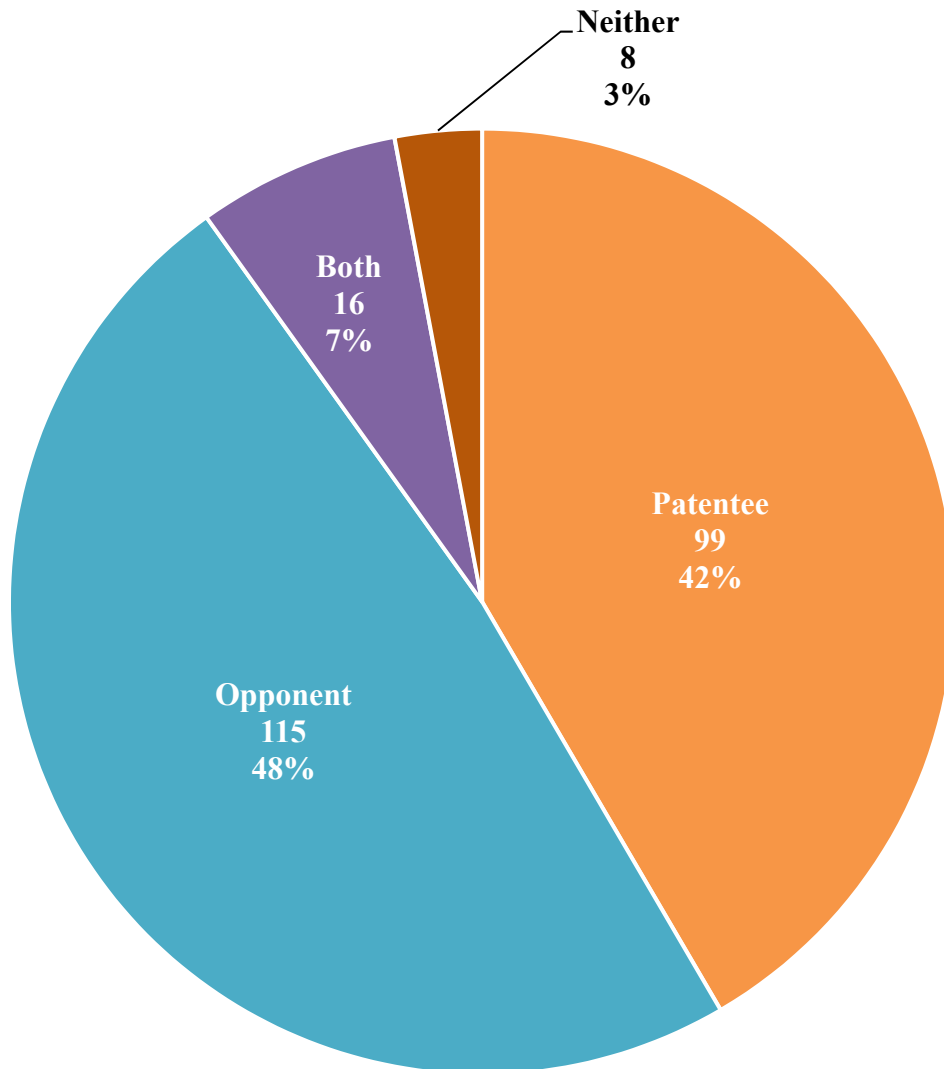
Decisions by Patent Subject Matter



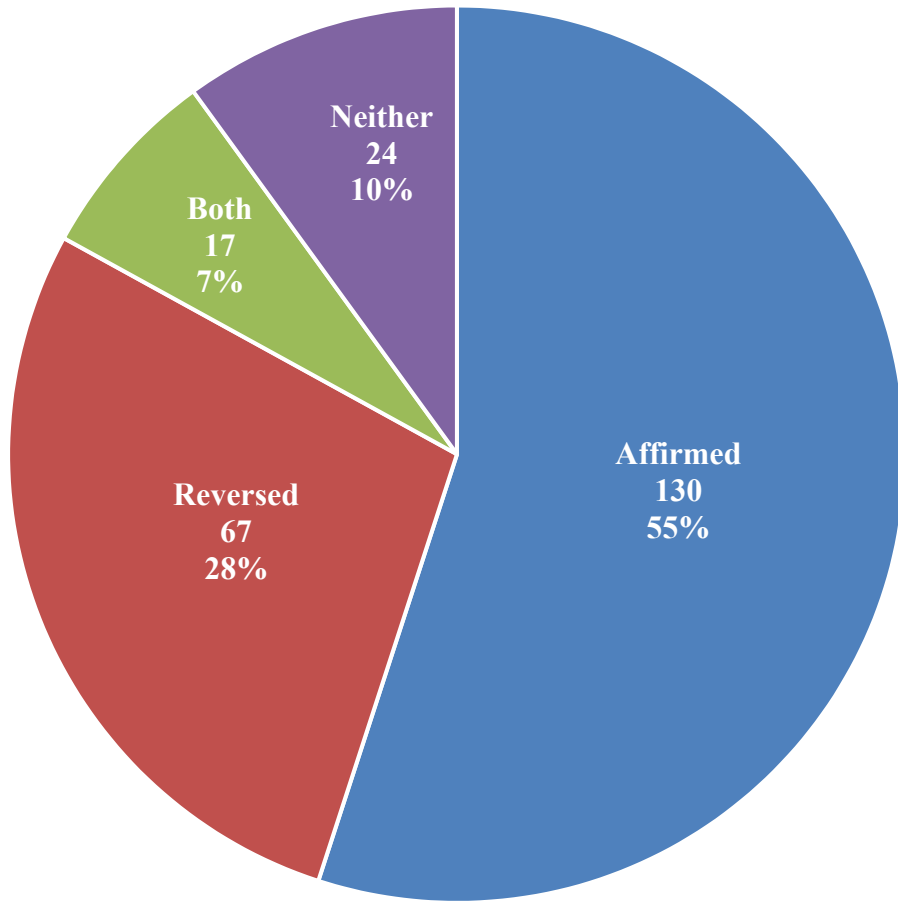
Patent Subject Matter by Author



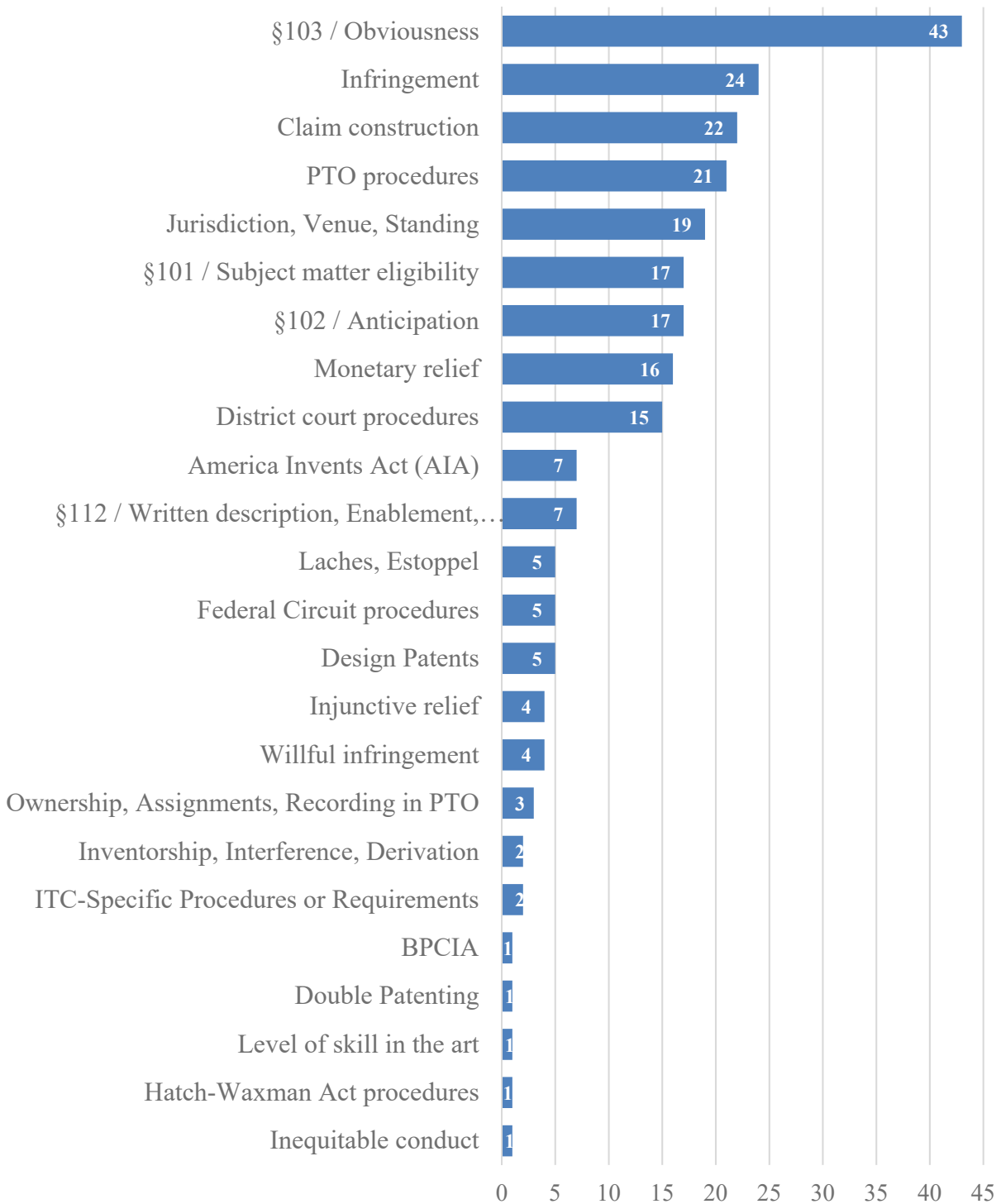
Overall Outcomes: Party Win Rate



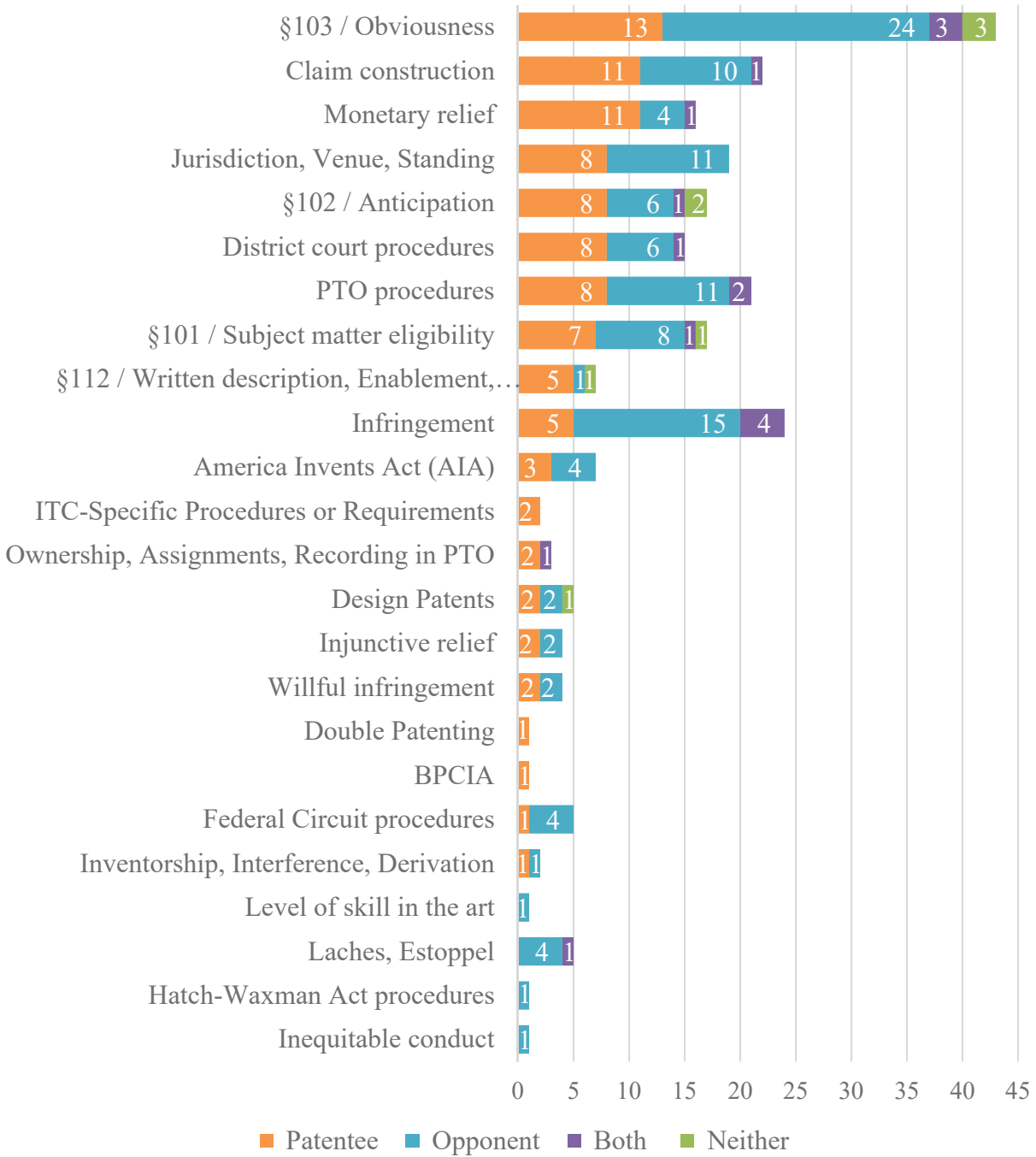
Overall Outcomes: Affirmance/Reversal



Top Issues

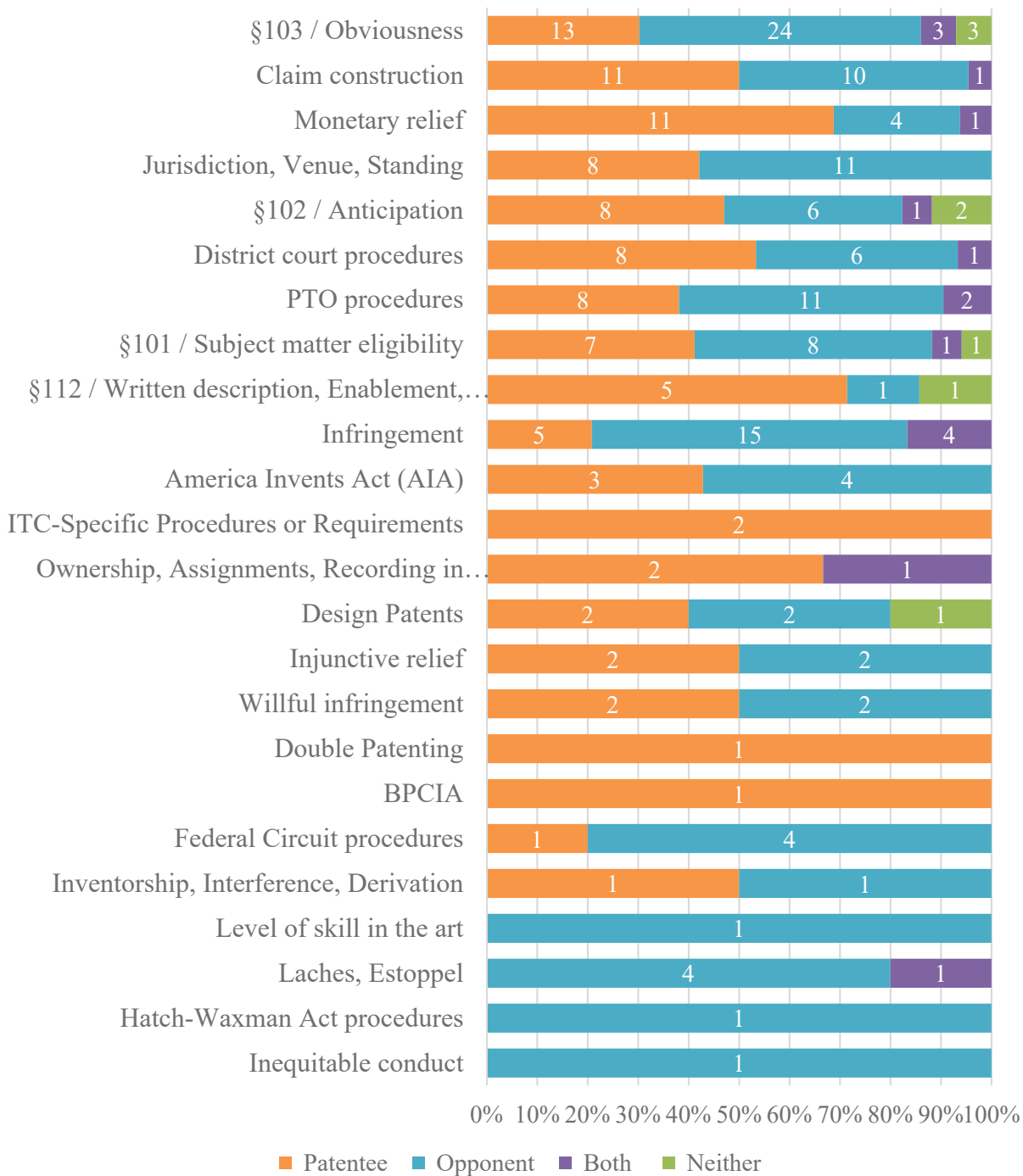


Winning Side by Issue

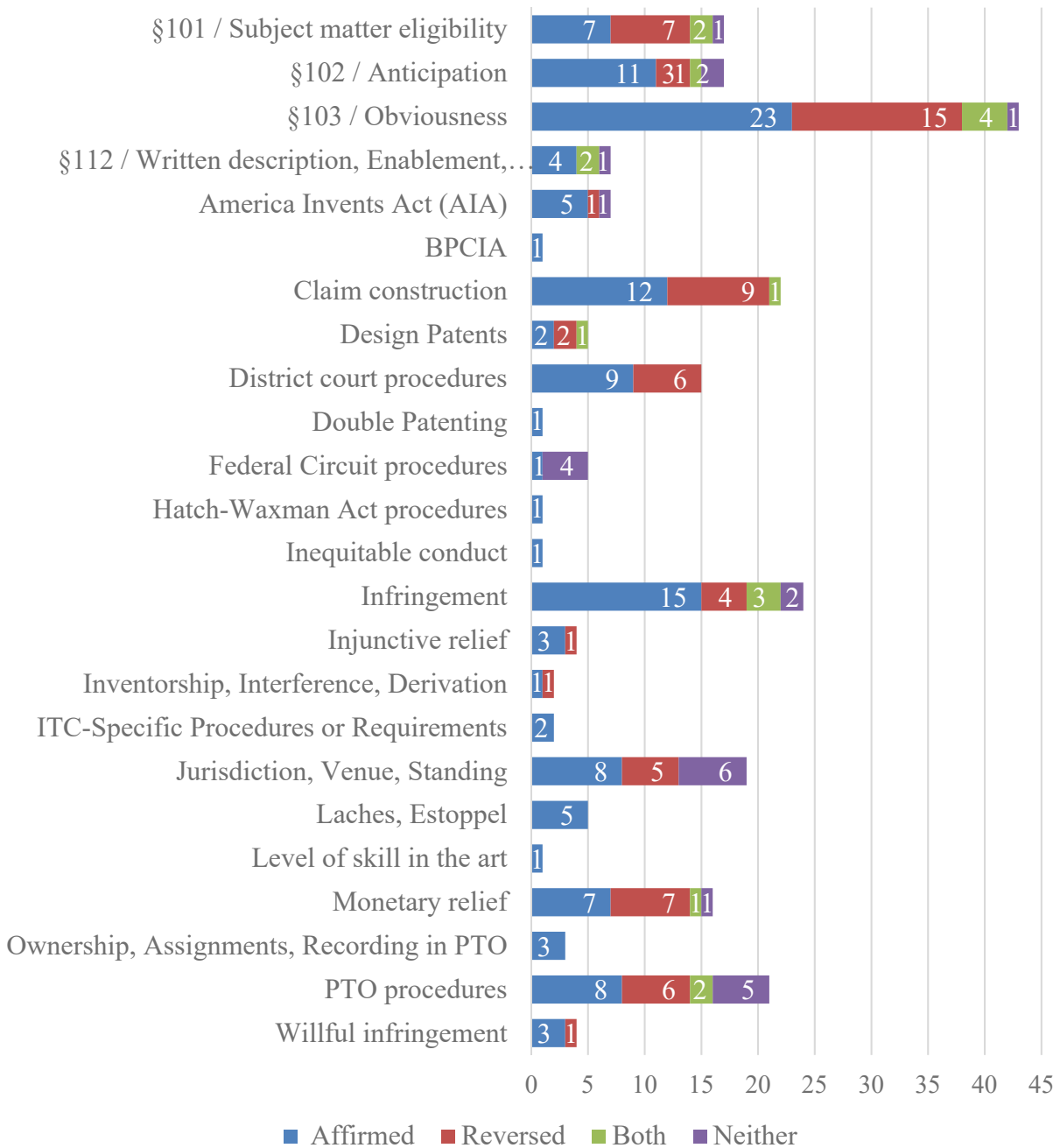


Winning Side Rates by Issue

(Decision Counts Shown in Bar Graph)

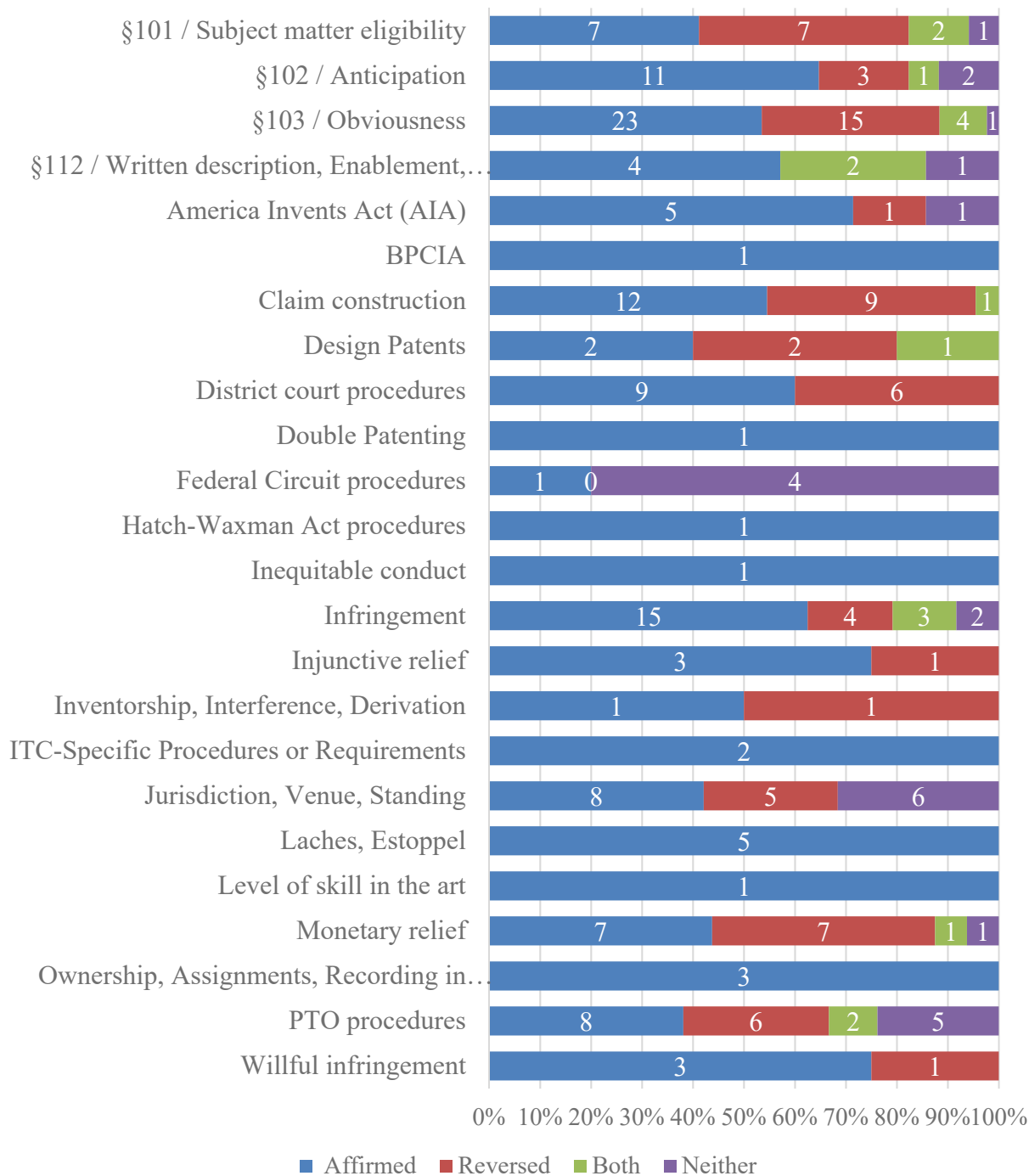


Outcome by Issue

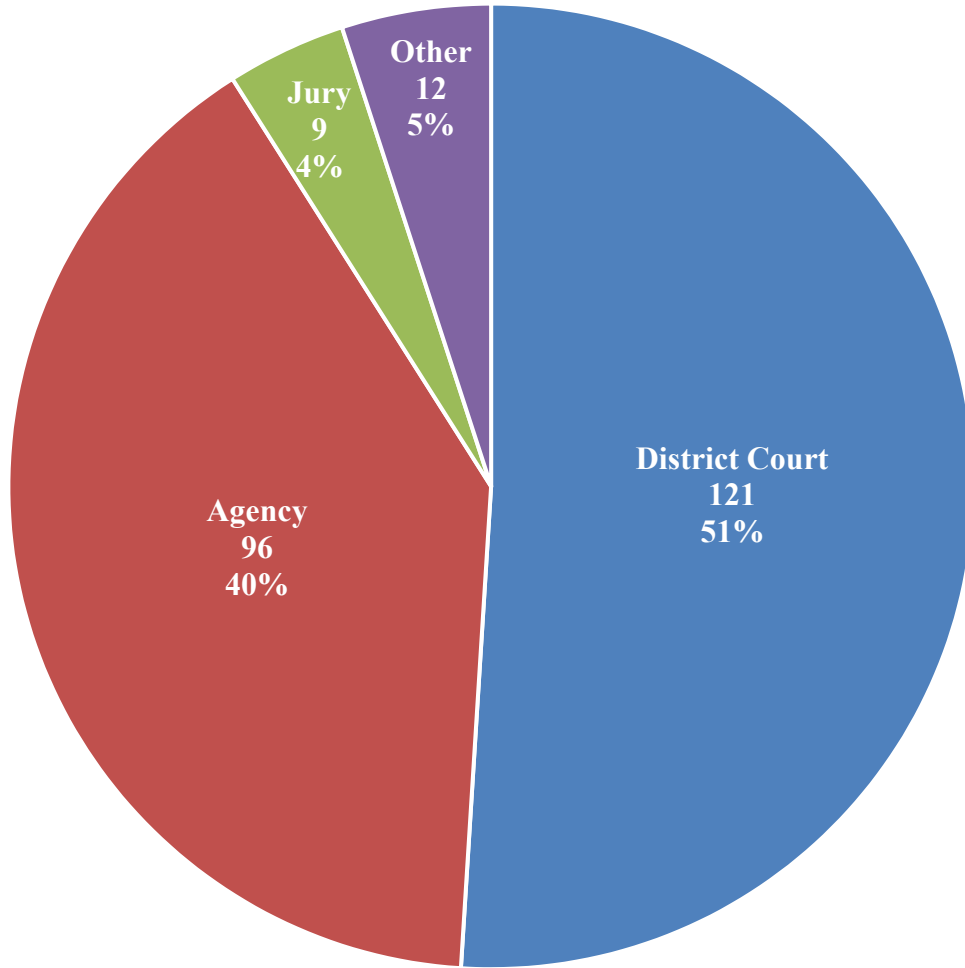


Outcome Rates by Issue

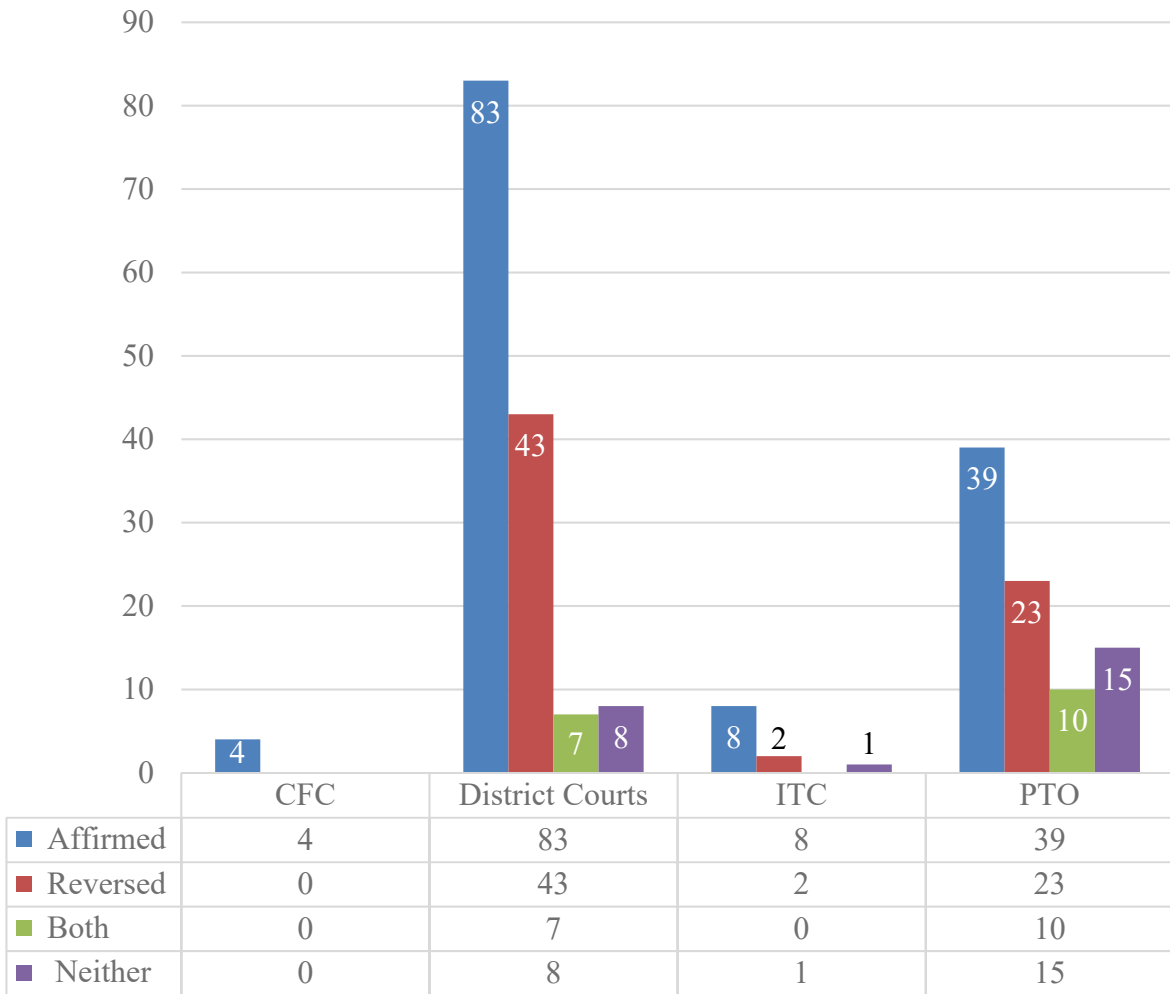
(Decision Counts Shown in Bar Graph)



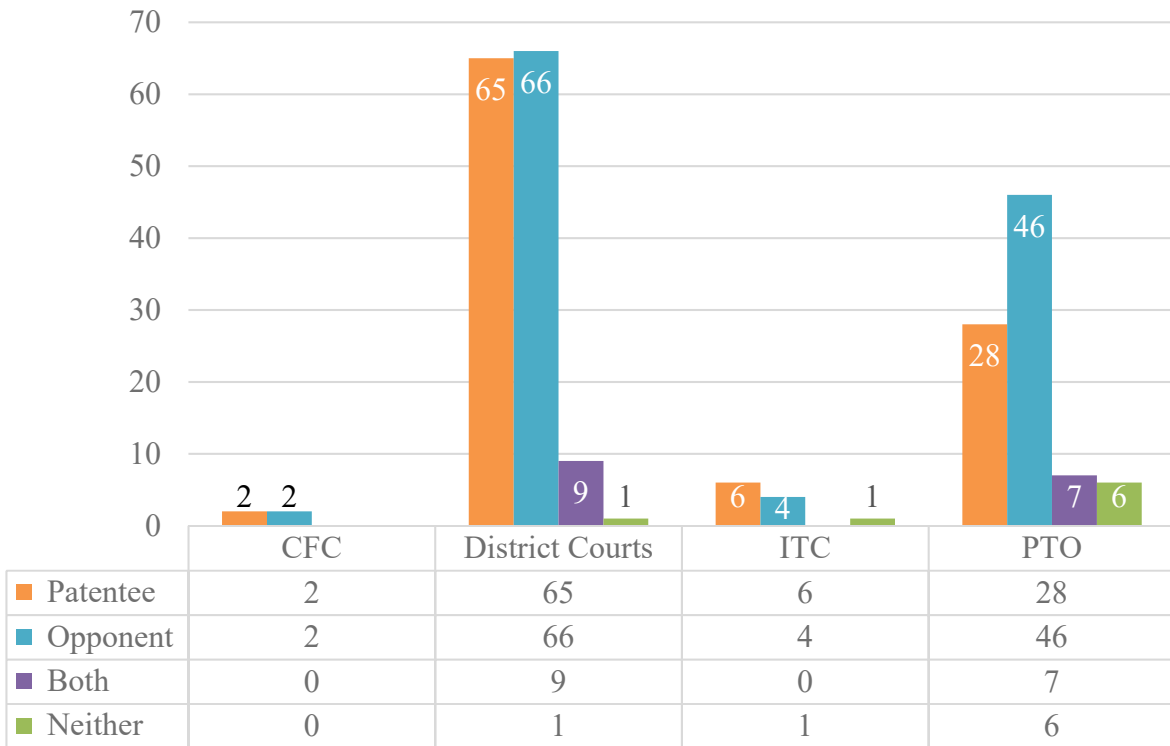
Appealed Decisions by Source



Outcome by Source

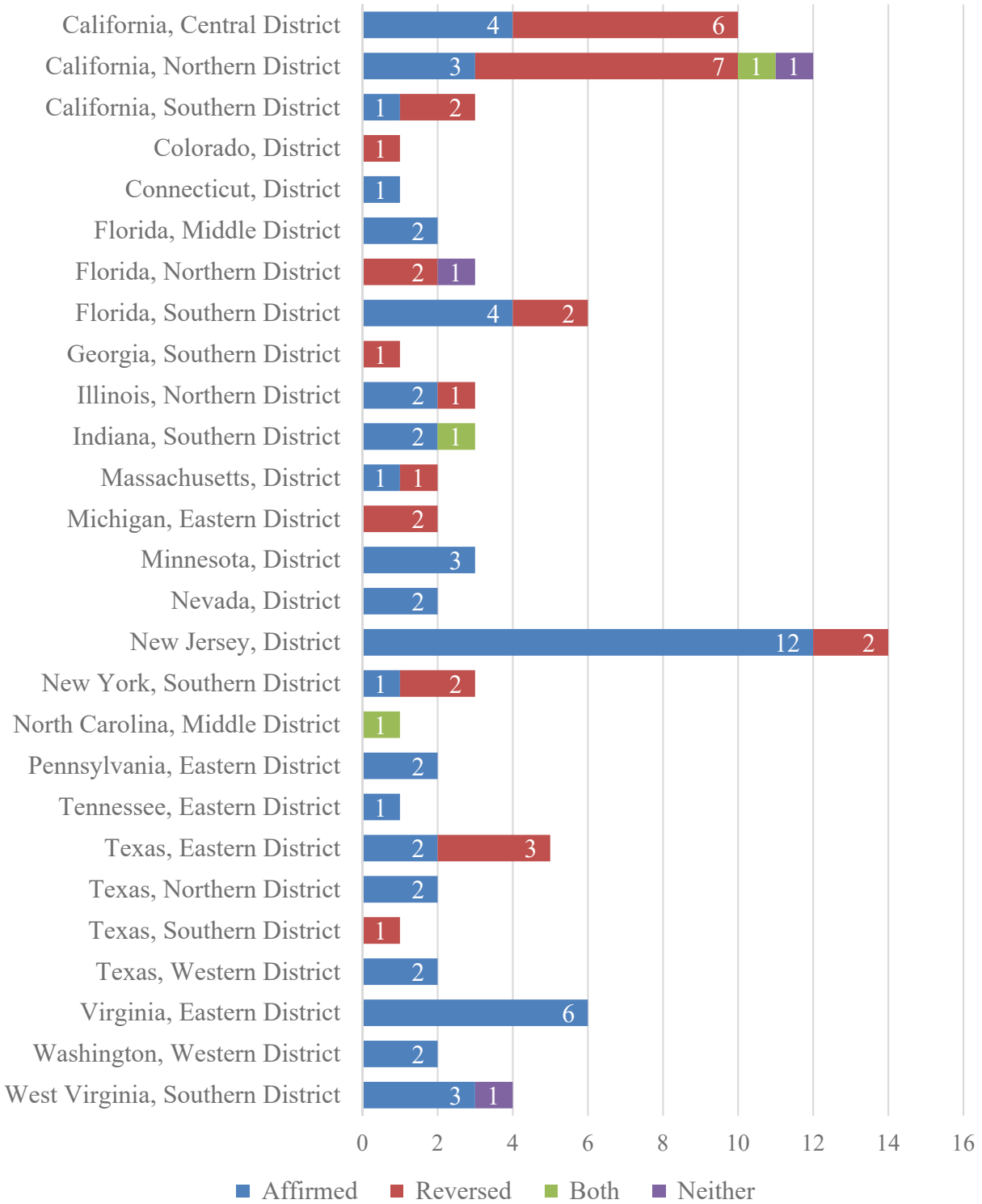


Winner by Source



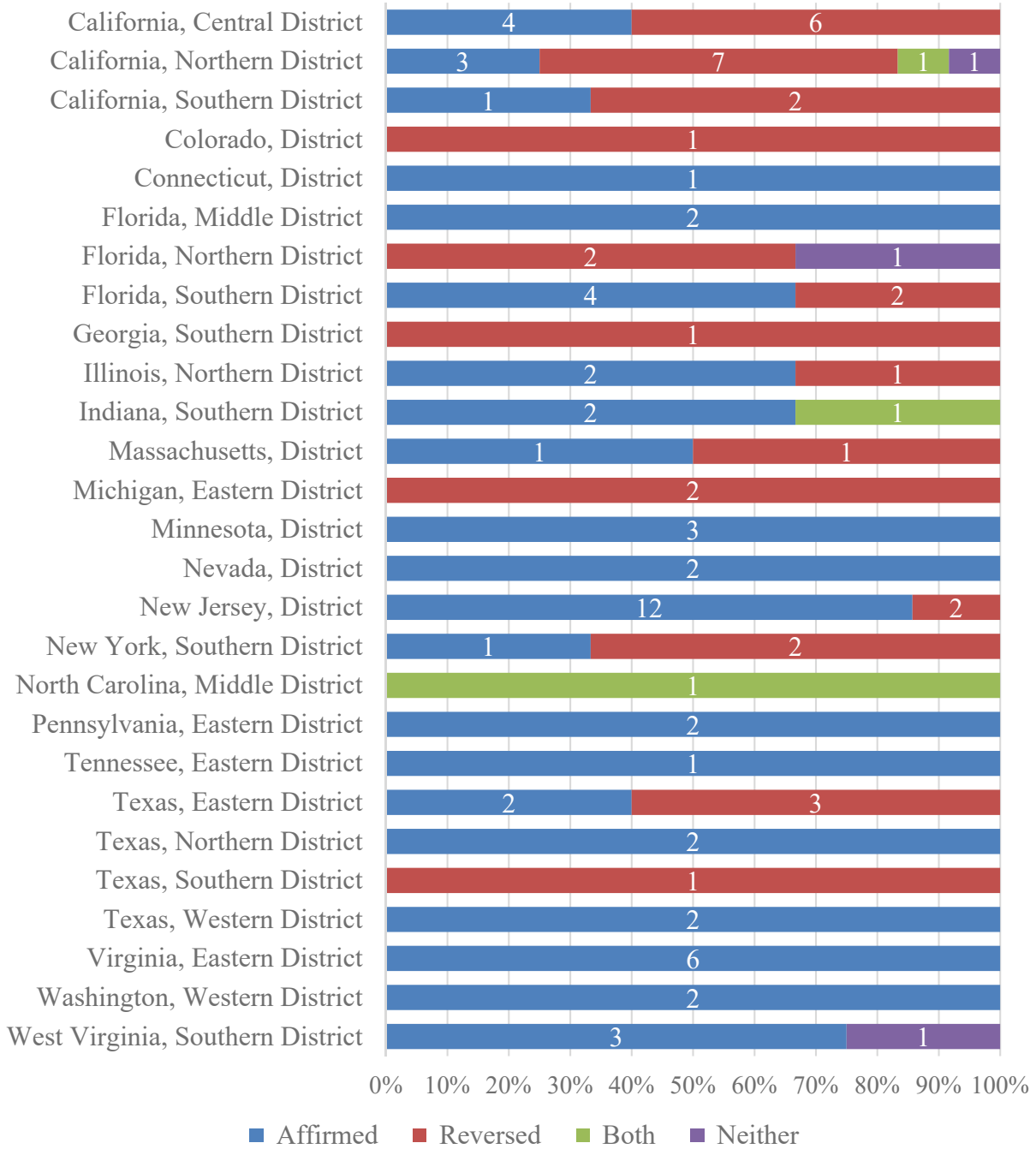
Outcome by District Court

(District Courts with 0 Decisions Not Shown)

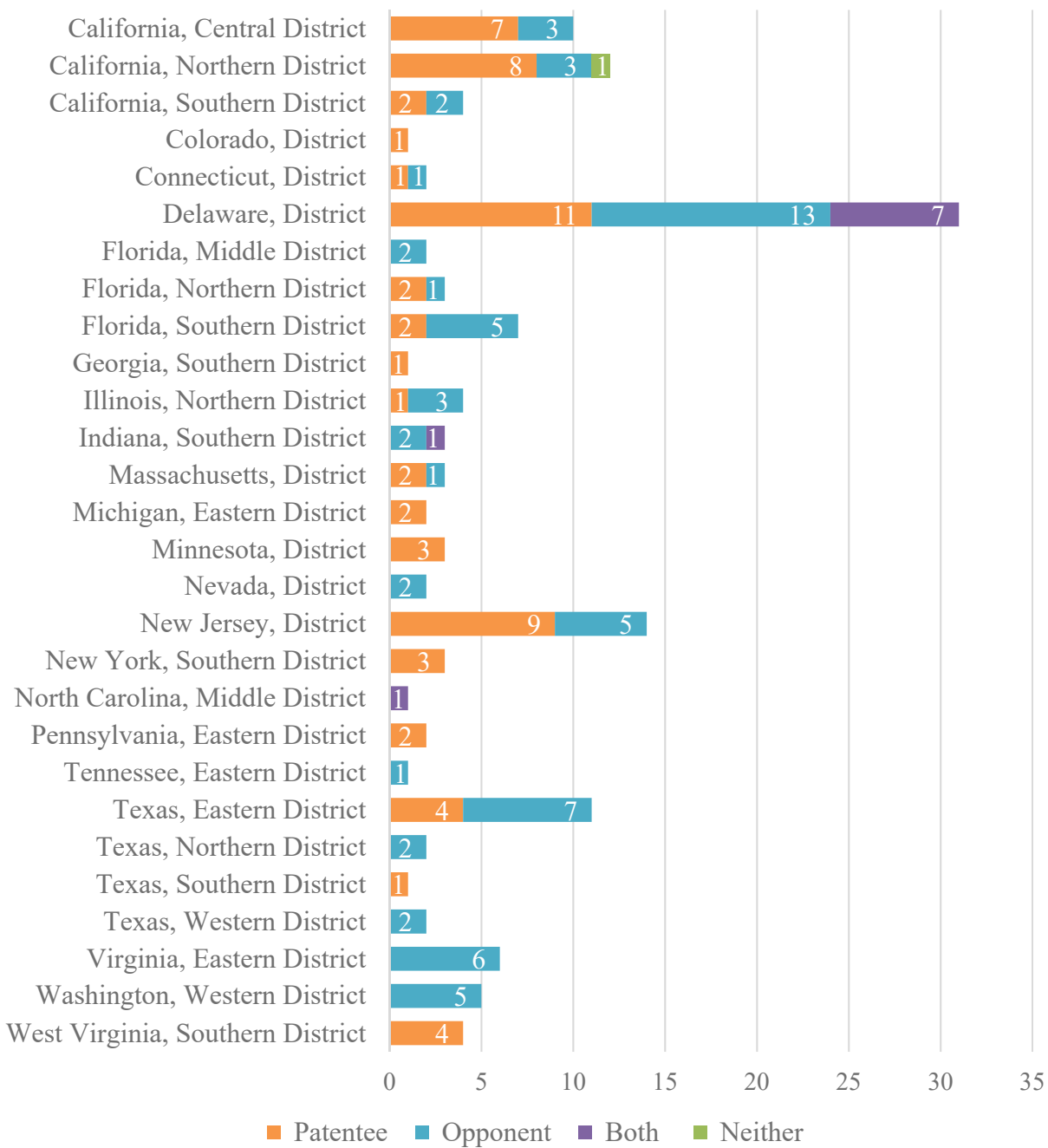


Outcome Rates by District Court

Decision Counts Shown in Bar Graph
(District Courts with 0 Decisions Not Shown)

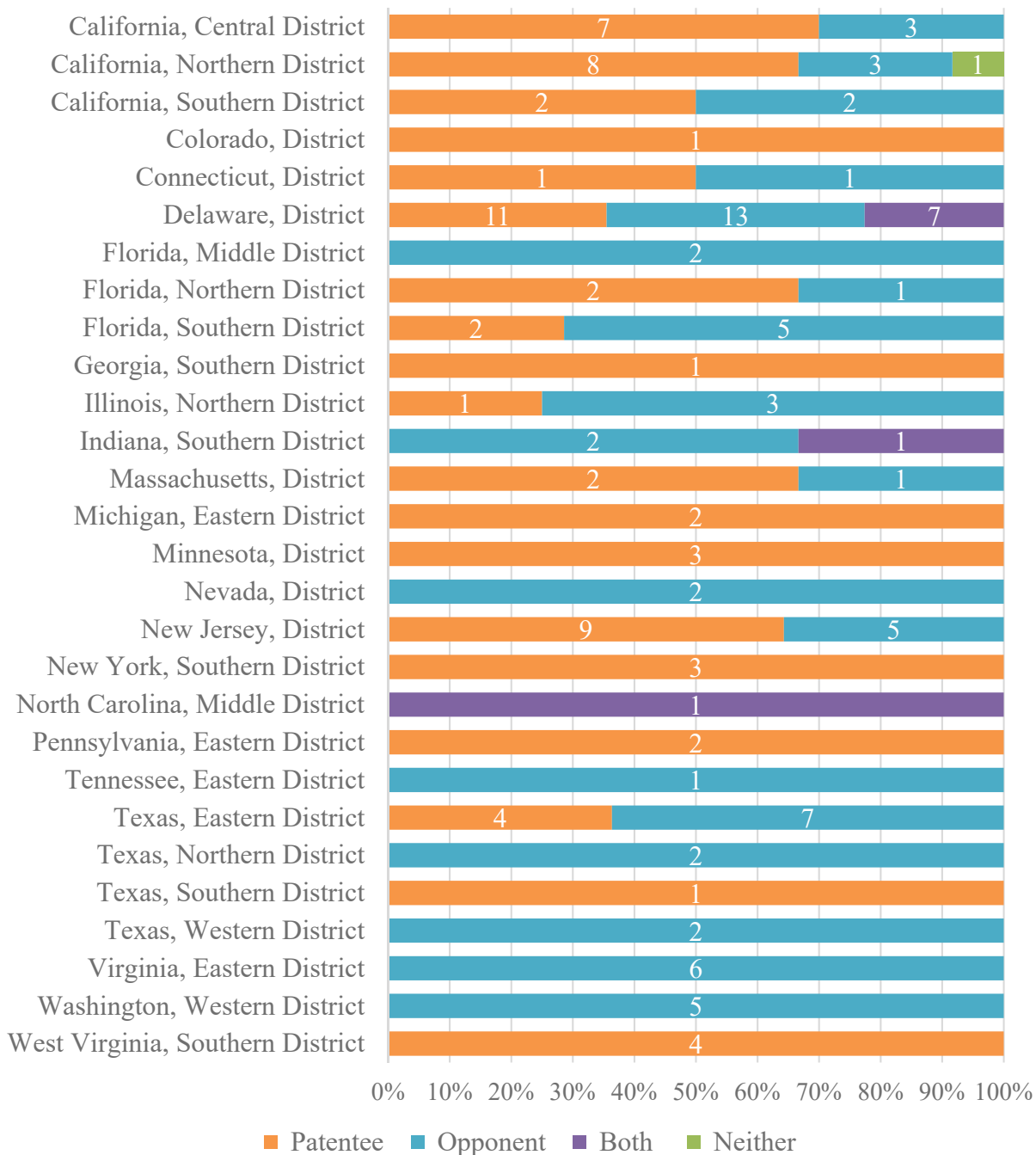


Winner by District Court (District Courts With 0 Decisions Not Shown)



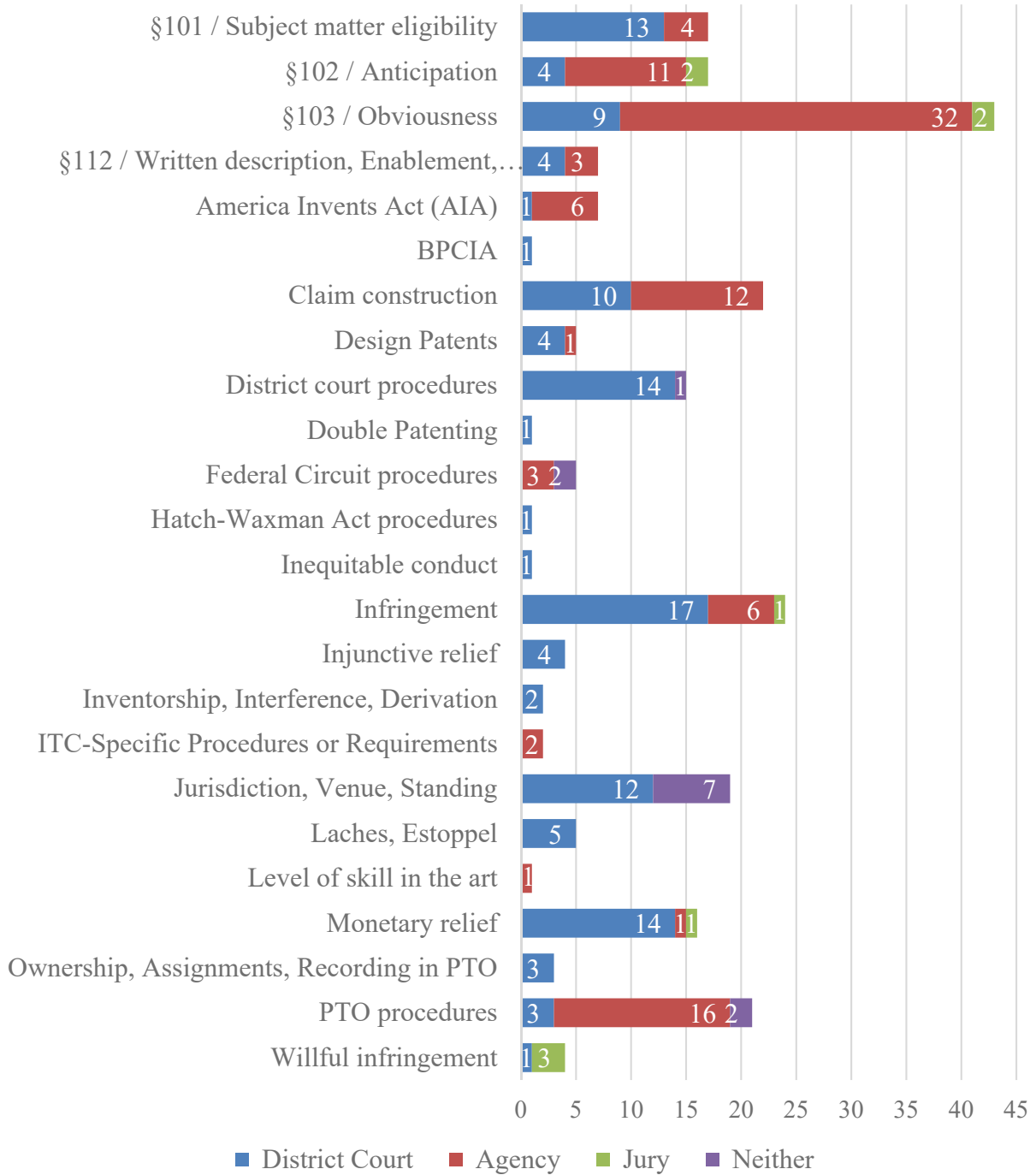
Winner Rate by District Court

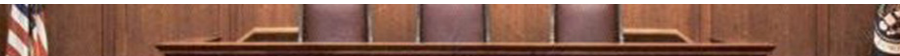
Decision Counts Shown in Bar Graph
(District Courts With 0 Decisions Not Shown)



Breakdown by Issue

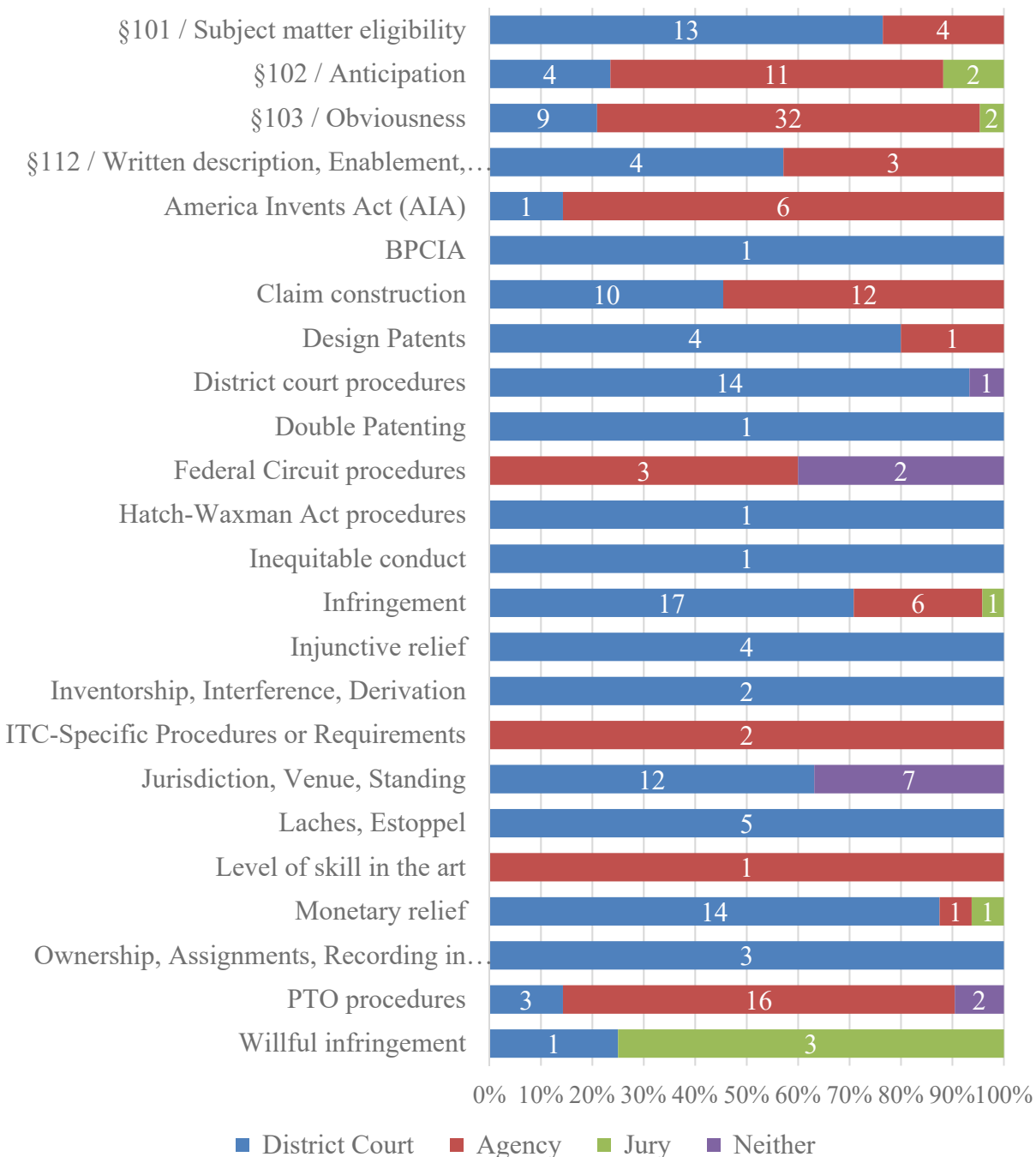
Whether Court, Agency, or Jury Decided Issue Below
(Issues With 0 Counts Not Shown)





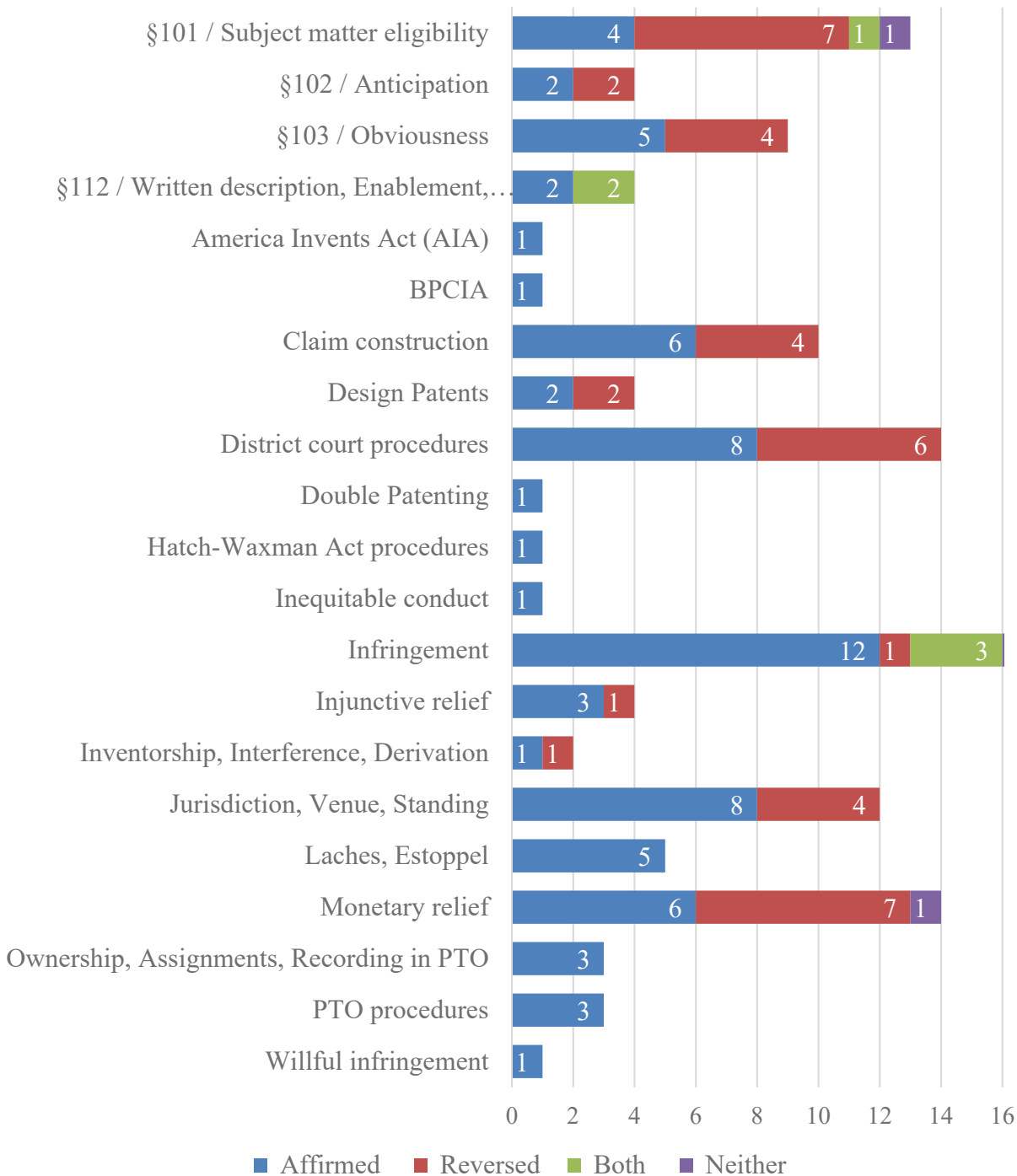
Breakdown by Issue, Rates

Whether Court, Agency, or Jury Decided Issue Below
(Issues With 0 Counts Not Shown)



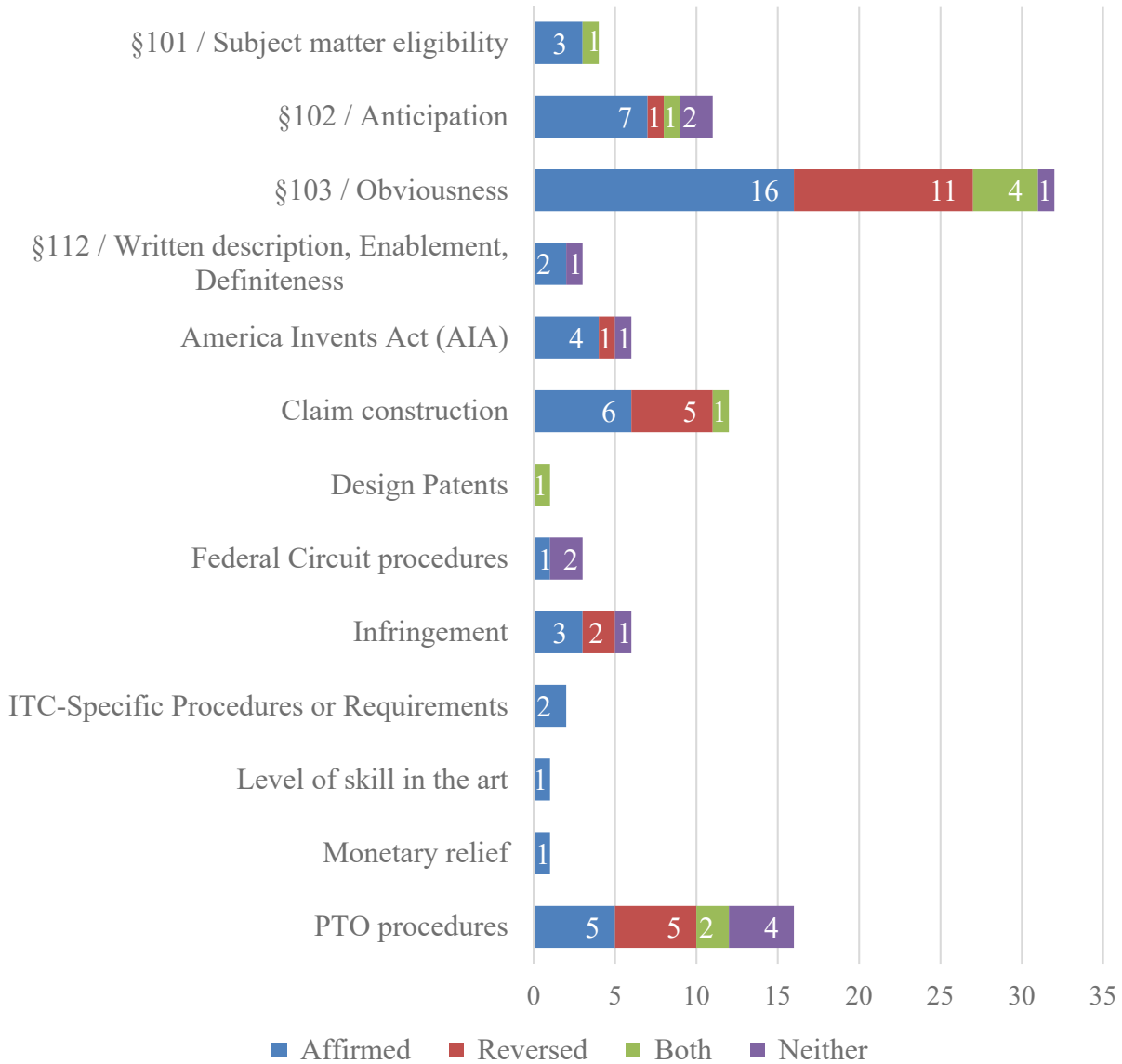
Affirmance/Reversal of Issues Decided by a Court

(Issues With 0 Counts Not Shown)



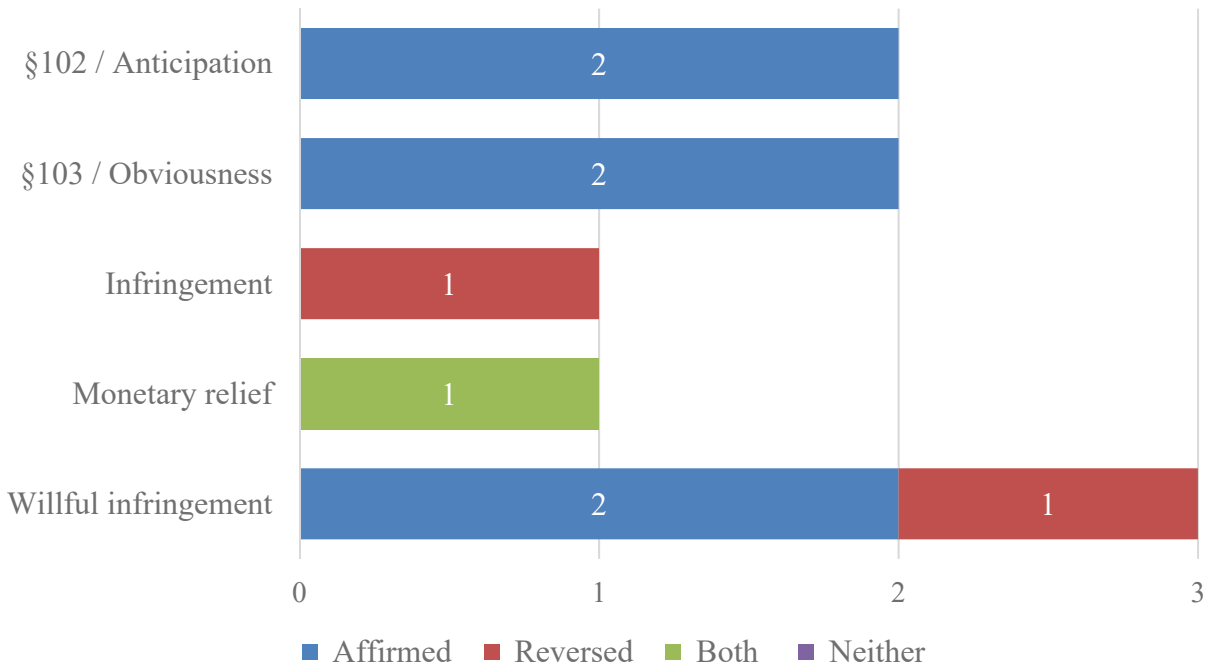
Affirmance/Reversal of Issues Decided by an Agency

(Issues With 0 Counts Not Shown)



Affirmance/Reversal of Issues Decided by a Jury

(Issues With 0 Counts Not Shown)



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CASE SUMMARIES

Acoustic Tech., Inc. v. Itron Networked Sols., Inc.

949 F.3d 1360 (Fed. Cir. 2020)

On appeal from the PTAB, the Federal Circuit affirmed a Final Written Decision in an IPR determining that the challenged claims in Acoustic Technology's '574 patent relating to electricity monitors for a communication system patent were unpatentable as obvious. Specifically, Acoustic argued that the IPRs were time-barred due to patent challenger Silver Spring's merger-related activity with Itron, Inc., an entity undisputedly time-barred under 35 U.S.C. § 315(b). Acoustic also challenged the PTAB's obviousness findings. Because the Federal Circuit found that Acoustic waived its time-bar and obviousness arguments, it affirmed the PTAB's decisions.

In March 2010, Acoustic sued Itron for infringement of the '574 patent. Acoustic and Itron later agreed to settle the suit, and Acoustic licensed the '574 patent to Itron. As a result of the lawsuit, Itron was time-barred under 35 U.S.C. § 315(b) from seeking IPR of the '574 patent. Six years later, Acoustic sued Silver Spring for infringement of the same patent. In response, Silver Spring filed two IPR petitions that challenged the '574 patent. The PTAB granted the petition, but during the IPR Silver Spring merged with Itron. The PTAB entered final written decisions finding the challenged claims unpatentable on all three asserted grounds: obvious in view of *Argyroudis*, obvious in view of *Argyroudis* and *Selph*, and obvious in view of *Mayo* and *Roach*. Acoustic never raised a time-bar challenge to the PTAB. Acoustic appealed the PTAB's Final Written Decision, arguing that the IPRs were time-barred because Itron was a real party in interest "both before and after the IPRs were instituted" under Section 315(b). Acoustic also argued that the PTAB erred in finding that the challenged claims were obvious.

In affirming the PTAB's decisions, the Federal Circuit held that Acoustic waived its time-bar challenge to the IPRs because it failed to present those arguments before the PTAB. The Court rejected Acoustic's argument that time-bars are "jurisdictional" and thus can be raised at any time. Instead, the Court ruled that time-bar challenges under Section 315(b) differ from agency "jurisdiction" challenges, and held that time-bar challenges under Section 315(b) are not immune from waiver.

With respect to the obviousness challenges, during the IPR proceedings, Acoustic argued that the prior art did not teach a conventional WAN radio capable of transmitting over publicly available Wide Area Networks, and thus, the challenged claims were nonobvious. On appeal, Acoustic raised a new argument that the prior art failed to disclose *any* conventional WAN radio. The Court found that Acoustic waived this argument by failing to raise it before the PTAB during the IPRs. As such, the Federal Circuit affirmed the PTAB's decisions.

Acoustic Tech., Inc. v. Itron Networked Sols., Inc.

949 F.3d 1366 (Fed. Cir. 2020)

On appeal from the PTAB, the Federal Circuit affirmed a Final Written Decision in an IPR determining that the challenged claim 8 in Acoustic Technology's '841 patent relating to communications systems for utility providers to remotely monitor groups of utility meters (e.g., electricity meters) was unpatentable on all three asserted grounds: anticipated by NetComm; anticipated by Gastouniotis; and obvious in view of Nelson and Roach. Specifically, Acoustic argued that the IPR was time-barred due to patent challenger Silver Spring's merger-related activity with Itron, Inc., an entity undisputedly time-barred under 35 U.S.C. § 315(b). Acoustic also challenged the PTAB's unpatentability findings. Because the Federal Circuit found that Acoustic waived its time-bar argument and further rejected its challenges to the PTAB's unpatentability findings, it affirmed the PTAB's decision.

In March 2010, Acoustic sued Itron for infringement of the '841 patent. Acoustic and Itron later agreed to settle the suit, and Acoustic licensed the '841 patent to Itron, resulting in Itron being time-barred under 35 U.S.C. § 315(b) from seeking IPR of the '841 patent. Six years later, Acoustic sued Silver Spring for infringement of the same patent. In response, Silver Spring filed an IPR petition that challenged the '841 patent. The PTAB granted the petition, but during the IPR, Silver Spring merged with Itron. The PTAB entered a final written decision finding the challenged claim unpatentable on all three asserted grounds: (A) anticipation by NetComm; (B) anticipation by Gastouniotis; and (C) obviousness in view Nelson and Roach. Acoustic appealed the PTAB's Final Written Decision. In affirming the PTAB's decision, the Federal Circuit held that Acoustic waived its time-bar challenge to the IPRs because it failed to present those arguments before the PTAB. The Court rejected Acoustic's argument that time-bars are "jurisdictional" and thus can be raised at any time. Instead, the Court ruled that time-bar challenges under Section 315(b) differ from agency "jurisdiction" challenges, and held that time-bar challenges under Section 315(b) are not immune from waiver.

Acoustic also argued that the PTAB erred by finding that NetComm disclosed the claimed CDMA communication limitation in claim 8 because the PTAB's finding was not supported by substantial evidence. Acoustic argued that Silver Spring's expert's use of the word "recognize" went to obviousness, not anticipation. In rejecting this argument, the Court determined that Silver Spring's expert conducted a detailed analysis of how a skilled artisan would reasonably understand that NetComm's disclosure of radio wave communication was the same as CDMA. Therefore, substantial evidence supported the PTAB's finding that NetComm disclosed CDMA and anticipated claim 8.

Next, Acoustic asserted that the PTAB's finding that Gastouniotis anticipated claim 8 was erroneous because the PTAB relied on "the same structures to satisfy separate claim limitations." *Id.* at 1374. The Court analyzed Silver Spring's expert testimony and concluded that the PTAB did not improperly rely on the same structure in Gastouniotis to meet the "control" and "relay" limitations of claim 8. Thus, Gastouniotis anticipated claim 8.

Finally, Acoustic argued that the PTAB erred in its obviousness analysis because it erroneously mapped Nelson onto the elements of claim 8, and because the PTAB's motivation-to-combine finding was not supported by substantial evidence. Because Silver Spring provided un rebutted testimony that a skilled artisan would recognize that the intermediate EMR devices of Nelson met the "relay" limitation of claim 8, the Court ruled that PTAB's obviousness analysis was not erroneous. The Court also rejected Acoustic's argument that the PTAB erred in finding that a skilled artisan would be motivated to combine Nelson and Roach. As such, the Court affirmed the PTAB's Final Written Decision.

Adidas AG v. Nike, Inc.

963 F.3d 1355 (Fed. Cir. 2020)

This appeal arose from the PTAB's decision that Adidas had not demonstrated that the claims challenged in Nike's '598 and '749 patents were obvious. The Federal Circuit affirmed the PTAB's holding because the PTAB did not err in its obviousness analysis and substantial evidence supported its underlying factual findings.

The Federal Circuit rejected Nike's argument that Adidas did not suffer an injury in fact and as a result lacked standing to sue. The Federal Circuit explained that the risk of infringement to Adidas was concrete and substantial because it had developed plans to make a potentially infringing product and Nike, a direct competitor, refused to grant Adidas a covenant not to sue.

The Court further explained that Adidas failed to show that a POSITA would have been motivated to combine the two references. Rejecting Adidas's argument that a POSITA could have combined the two references, the Federal Circuit stated that it was not a matter of whether the combination is possible, but whether a POSITA would have been motivated to do so. Further, the Federal Circuit found that the PTAB's determinations were supported by the fact that there were fundamental differences between the references, which Adidas did not address.

Airbus S.A.S. v. Firepass Corp.

941 F.3d 1374 (Fed. Cir. 2019)

In this case, Airbus challenged the PTAB's finding that an asserted prior art reference failed to qualify as relevant because it was not analogous to the claimed invention of the '752 patent. The Federal Circuit vacated and remanded the PTAB's decision. Firepass owned the '752 patent, which claimed a fire prevention and suppression system that used breathable air to create a hypoxic atmosphere that suppresses fire. The original patent examiner rejected claims 91–94 from the '752 patent as being obvious over the prior art. The asserted prior art included an earlier patent (referred to as "Kotliar") by the same inventor, along with four other references (Gustaffson, the 1167 report, Luria, and Carhart). Firepass appealed the examiner's rejection to the PTAB, arguing that Kotliar was not analogous art. The PTAB agreed and reversed the examiner's rejections of claims 91–94,

finding that there was no articulated rational underpinning that linked the problem of fire suppression to that of human therapy disclosed in Kotliar.

On appeal to the Federal Circuit, Airbus challenged the PTAB's finding that the Kotliar reference is not analogous to the claimed invention. The Federal Circuit examined the scope of analogous prior art using two tests: (1) whether the art is from the same field of endeavor regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. Under the "field of endeavor" test, the PTAB found that Kotliar was not within the same field of endeavor, as it does not discuss fire at all, whereas the '752 patent is focused on fire prevention. The Court found the PTAB's determination was not unreasonable, and supported by substantial evidence. Turning to the "reasonably pertinent" test, the Court explained that a reference outside an inventor's field of endeavor is "reasonably pertinent" only if its subject matter logically would have come to an inventor's attention in considering the problem. In finding that Kotliar had no requisite correlation to the '752 patent, the PTAB declined to consider multiple references in the record that Airbus claimed a POSITA would have consulted when studying hypoxic environments. Following *Randall Manufacturing v. Rea*, 733 F.3d 1355 (Fed. Cir. 2013), the Court found that a reasonable factfinder evaluating reasonable pertinence should consider record evidence cited by the parties to demonstrate the knowledge and perspective of a POSITA. The Court therefore vacated the PTAB's reversal of the examiner's rejection and remanded to consider whether Kotliar is analogous art in view of the prior art references relied on by Airbus to demonstrate the knowledge and perspective of a POSITA at the time of the invention.

Ajinomoto Co., Inc. v. Int'l Trade Comm'n
932 F.3d 1342 (Fed. Cir. 2019)

Patentee, Ajinomoto Co., Inc. and Ajinomoto Heartland Inc. (collectively, "Ajinomoto") filed a complaint against CJ CheilJedang Corp., CJ America, Inc., and PT CheilKedang Indonesia (collectively, "CJ"), alleging that CJ was importing certain products that infringed Ajinomoto's '655 patent. CJ used different strains of E. coli bacteria to produce L-tryptophan products, which it then imported into the United States. The ITC found that CJ's earlier strains did not infringe but that CJ's two later strains did infringe. Additionally, the ITC determined that the relevant claim of the '655 patent was not invalid for lack of an adequate written description. Both parties appealed.

Ajinomoto appealed the ITC's claim construction underlying the determination of no infringement by earlier strains. Noting that the ordinary and customary meaning of the claim language and the prosecution history provide support for the ITC's determination, the Court agreed with the ITC's claim construction—namely that "replacing the native promotor . . . with a more potent promotor" required more than selectively mutating a single nucleotide in the native promotor—and affirmed the finding of noninfringement.

CJ cross-appealed the ITC's determination of infringement by later strains and its rejection of CJ's written description challenge. Regarding infringement, CJ argued that prosecution

history estoppel barred Ajinomoto from relying on the doctrine of equivalents and that CJ's second later strain could not reasonably be found to be an equivalent under the function-way-result test for equivalence. The Federal Circuit found that the "tangential relation" exception to prosecution history estoppel applied in this case because the reason for the narrowing amendment was unrelated to differences among the several DNA sequences that encode a given protein. Judge Dyk dissented only as to this holding. According to Judge Dyk, the "tangential relation" exception is "very narrow," and in fact patentee's reason for narrowing its claims, *i.e.*, to avoid anticipation by a protein with a different encoding nucleotide sequence, is exactly related to the difference between the claims and the accused instrumentality. Finally, the Federal Circuit affirmed the ITC's rejection of CJ's invalidity challenge, holding that substantial evidence supported the finding that CJ did not prove lack of an adequate written description.

Alacritech, Inc. v. Intel Corp.

966 F.3d 1367 (Fed. Cir. 2020)

The Federal Circuit vacated and remanded the PTAB's decision finding the challenged claims obvious over two prior art references. The challenged claims related to the reassembly of data from packets received by the host computer from a network. One of the limitations required the reassembly to be done "in the network interface." Although the PTAB found that the prior art disclosed reassembly, it did not address where the reassembly would take place, which is what the parties disputed. The Federal Circuit explained that the PTAB's reasoning was untethered to either party's positions and it could not reasonably infer whether the PTAB had adopted the challenger's position.

The Federal Circuit, however, affirmed the PTAB's motivation to combine analysis and its analysis with respect to a different limitation.

Allergan Sales, LLC v. Sandoz, Inc.

935 F.3d 1370 (Fed. Cir. 2019)

In this case, the Federal Circuit affirmed the district court, holding that "wherein" clauses in patents were material to patentability and therefore limiting.

Allergan had asserted that Sandoz's Abbreviated New Drug Application for a generic version of an Allergan drug infringed three patents related to the ophthalmic use of brimonidine in combination with timolol to treat glaucoma or ocular hypertension. In granting Allergan's motion for a preliminary injunction, the district court found a series of "wherein" clauses in the patents-in-suit limiting since they were material to patentability and expressed the inventive aspect of the claimed invention.

On appeal, the Federal Circuit rejected Sandoz's arguments that the "wherein" clauses merely stated the intended results of administering the drug twice daily, which was not material to patentability. In doing so, the Court emphasized that, "consistent with claim construction principles, we look first to the language of the claims, followed by the language of the specification and prosecution history." Although the Court found overlap

between the language of the “wherein” clauses and the results of administering the drug in the specification, it emphasized that the claims must be read in view of the entire specification, and that this specification and the prosecution history demonstrated that the “wherein” clauses were material to patentability and thereby limiting. In Judge Prost’s concurring opinion, she agreed that the “wherein” clauses were limiting and that the specification and prosecution history confirmed this result, but she felt the majority did not address the plain language of the claim, which was primary and also did not support Sandoz’s position.

Am. Axle & Mfg., Inc. v. Neapco Holdings LLC
967 F.3d 1285 (Fed. Cir. 2020)

In this appeal, the panel majority (Judges Dyk and Taranto) vacated a district court’s judgment that one independent claim and its dependent claims are ineligible under 35 U.S.C. § 101, but affirmed that the other claims were ineligible for being directed to a law of nature. In its analysis, the panel distinguished between the eligibility requirements of Section 101 and enablement requirements of Section 112. Judge Moore dissented.

American Axle & Manufacturing, Inc. (“AAM”) sued Neapco Holdings LLC (“Neapco”) alleging infringement of claims of U.S. Patent No. 7,774,911 (“the ’911 patent”). The claims at issue are directed to methods of manufacturing driveline propeller shafts (used to transfer rotary power in automobiles) with liners to dampen two different types of vibrations simultaneously. Claim 1 of the ’911 patent recites in part “tuning at least one liner to attenuate at least two types of vibration” and “positioning [the liner] within the shaft member.” Claim 22 recites in part “tuning a mass and a stiffness of at least one liner,” and “inserting” it into the shaft to attenuate at least two types of vibrations. Claim 36 is not materially different from claim 22. After cross-motions for summary judgment, the district court found all claims patent ineligible.

The panel majority, over Judge Moore’s dissent, originally affirmed the district court as to all claims. AAM petitioned for panel and en banc rehearing. The panel chose to modify the original opinion, and affirmed that claims 22 and 36 and their dependent claims are ineligible, but vacated with respect to claim 1 and its dependent claims. The Federal Circuit denied en banc rehearing by a split 6-6 vote.

Under Step 1 of the *Alice/Mayo* test, the majority held that claims 22 and 36 “simply require[] the application of Hooke’s law” (a law of nature that describes the relationship between an object’s mass, its stiffness, and the frequency at which the object vibrates) “to tune a propshaft liner to dampen certain vibrations.” The majority explained that this was no more than claiming a “desired result” of “tuning a liner’ to achieve certain types of vibration attenuation” without any specific way of achieving that result, which was ineligible under a long line of Supreme Court and Federal Circuit precedent. With respect to Step 2, the majority rejected AAM’s argument that its claimed methods were inventive because they were previously unknown, pointing out that the ineligible law of nature itself “cannot supply the inventive concept, ‘no matter how groundbreaking the advance.’” The

majority also held that AAM waived any argument that the dependent claims should be analyzed separately by not raising it below.

With respect to independent claim 1 and its dependent claims, the majority noted that under the district court’s claim construction, the specification “may suggest that the ‘characteristics’ that can be ‘tuned’ in claim 1 include variables other than mass and stiffness,” and may therefore go beyond simply applying Hooke’s law. The majority also noted that claim 1 “has an additional limitation of ‘positioning . . . at least one liner,’” which the majority distinguished from the “inserting” limitation of claim 22. The majority therefore vacated and remanded to the district court to determine in the first instance eligibility under these alternative theories.

Responding to Judge Moore’s dissent, the majority provided a notable explanation of the distinction between eligibility under Section 101 and enablement under Section 112—the “two different ‘how’ requirements in patent law.” The majority explained that eligibility requires that “the claim itself . . . must go beyond stating a functional result; it must identify ‘how’ that functional result is achieved by limiting the claim scope to structures specified at some level of concreteness . . . or to concrete action.” By contrast, enablement “applies to the specification, not the claim: once the required concrete physical structures or actions are set out in the claim, the specification must set forth enough information for a relevant skilled artisan to be able to make and use the claimed structures or perform the claimed actions.”

Judge Moore dissented, primarily arguing that the majority erred by expanding the eligibility analysis by creating a new “Nothing More” test (*i.e.*, determining whether “a claim on its face clearly invokes a natural law, and nothing more, to achieve the claimed result”). Judge Moore contended that where the claims and the specification did not recite Hooke’s law, the determination of whether the claims were directed to this law of nature should be a factual inquiry that cannot be decided on appeal (or summary judgment). Judge Moore also criticized the majority for “*sua sponte*” holding that “claim 22’s *inserting* limitation is not equivalent to claim 1’s *positioning* limitation” when no party argued that distinction on appeal, and treating claims 1 and 22 as representative when AAM argued (only at oral argument) that they were not. Lastly, Judge Moore took issue with the majority’s analysis for blending eligibility with enablement, stating that the “majority’s concern is not preemption of a natural law . . . but rather that the *claims* do not teach a skilled artisan *how* to tune a liner without trial and error.”

Amgen Inc. v. Amneal Pharms. LLC
945 F.3d 1368 (Fed. Cir. 2020)

In this cross-appeal from the District of Delaware, the Federal Circuit considered jurisdictional defects, the claim construction of Markush groups, and prosecution history estoppel.

Amgen holds the ’405 patent, which is directed to “a rapid dissolution formulation of cinacalcet.” Amgen markets the ’405 patent as Sensipar, a formulation of cinacalcet

hydrochloride used to treat secondary hyperparathyroidism and hypercalcemia in patients with kidney failure. Amgen sued Amneal, Piramal, and Zydus, three companies who each filed ANDAs seeking to develop generic versions of Sensipar, for infringement of different claims of the '405 patent.

After a bench trial, the district court concluded that Amneal and Piramal did not infringe, but that Zydus infringed the asserted claims. A jurisdictional issue arose because the Federal Circuit can only review a district court's final judgment, and the district court had made its infringement judgment contingent on the asserted claims being found valid and enforceable. However, at oral argument, Zydus represented that it would give up its invalidity arguments, so the Court found that any jurisdictional defect over the appeal was effectively cured. In other words, Zydus's representation effectively nullified the district court's conditional judgment and gave the Federal Circuit jurisdiction over the appeal.

The primary merits issue was the claim construction of the binder and disintegrant Markush groups. For example, claim 1 recites: "A pharmaceutical composition comprising . . . (c) from about 1% to about 5% by weight of at least one binder selected from the group consisting of povidone, hydroxypropyl methylcellulose, hydroxypropyl cellulose, sodium carboxymethylcellulose, and mixtures thereof." The district court construed the Markush group claims as closed because the use of "consisting of" has a very strong presumption that the Markush groups were closed. The Federal Circuit vacated the district court's claim construction and held that optional additional Markush group components could be included in the claimed formulation. The Court reasoned that when "a claim that uses a 'comprising' transition phrase and one of the following limitations requires a component that 'consists of' items listed in a Markush group and that meets the limitation's requirements for the component," the language is satisfied when the accused product contains a Markush group component and meets the limitation's requirements for the component. The Court further stated that without further basis or other evidence of preclusion, the claim does not forbid infringement if an additional component is functionally similar to a component from the Markush group limitation.

Based on this claim construction holding, the Court also vacated the district court's ruling that Amneal's product did not infringe.

Regarding Piramal's product, the Federal Circuit affirmed the district court's finding that prosecution history estoppel barred a finding of infringement. The Court reasoned that the patentee has the burden to demonstrate that an Examiner's Amendment was made for a reason unrelated to patentability. If the patentee is unable to carry their burden, then the court should presume that purpose behind the amendment would cause prosecution history estoppel to apply.

Regarding Zydus's product, the district court's finding of infringement did not depend directly on its claim construction or the estoppel issue, and was simply challenged on substantial evidence grounds. The Court found that the lower court did not clearly err and affirmed.

Amgen Inc. v. Hospira, Inc.

944 F.3d 1327 (Fed. Cir. 2019)

Amgen sued Hospira for patent infringement for submitting a Biologics License Application for FDA approval of an erythropoietin (“EPO”) biosimilar drug product, which Amgen alleged involved the manufacture of EPO that violated its patents relating to EPO production and isoforms. Following a jury verdict and damages award in Amgen’s favor, both parties appealed, and the Federal Circuit affirmed on all issues.

With regard to the district court’s claim construction, the Federal Circuit affirmed the district court’s decision to construe claim 27 of the ’298 patent as not requiring the individual isoforms of claim 1 to be separately prepared prior to making the mixture because claim 27 does not require a particular preparation, and the specification contemplates the preparation of isoform mixtures in more than one way. Under this claim construction, the Federal Circuit found that substantial evidence supported the jury’s infringement verdict because the jury heard Amgen’s expert testify that all EPO isoforms have biological activity, that Hospira’s EPO contains EPO isoforms in accord with claim 1, and that Hospira’s EPO batches had *in vivo* specific activity as required by claim 27. Further, Hospira argued that claim 27 was anticipated by Lai, and Amgen argued that Hospira failed to show that Lai “necessarily and inevitably” disclosed producing EPO with a predetermined *in vivo* specific activity. The Federal Circuit agreed with Amgen and affirmed the district court’s denial of Hospira’s JMOL as to anticipation.

Hospira also challenged the district court’s jury instructions regarding its Safe Harbor defense and the jury’s findings that some batches of EPO were not protected by the Safe Harbor. Since the accused activity was Hospira’s use of Amgen’s claimed methods of manufacture, the Federal Circuit held that the relevant inquiry is therefore not how Hospira used each batch it manufactured, but whether each accused activity, *i.e.*, act of manufacture, was for uses reasonably related to submitting information to the FDA. This inquiry was reflected in the jury instructions, and accordingly the Federal Circuit affirmed the district court’s denial of Hospira’s motion for a new trial on Safe Harbor grounds.

With regard to the jury’s findings, the Federal Circuit found there was substantial evidence to support that some batches were manufactured for FDA purposes and other batches were manufactured for commercial inventory. As such, the Federal Circuit affirmed the district court’s denial of JMOL on Hospira’s Safe Harbor defense.

Amgen cross-appealed the district court’s denial of its motion for JMOL that Hospira infringed claims of the ’349 Patent. Amgen argued that as part of its BLA submission, Hospira reported to the FDA that its cells were capable of producing EPO at certain rates as measured by the dot-blot immunoassay. However, Hospira’s expert explained why the dot-blot assay results could not be correlated to EPO production rates as determined by radioimmunoassay (“RIA”), and Amgen’s experts did not provide any testimony that the dot-blot assay results are similar or comparable to RIA results. The Federal Circuit agreed with Hospira and found the jury’s verdict supported by substantial evidence, and thus affirmed the district court’s denial of Amgen’s JMOL motion.

Amneal Pharm. LLC v. Almirall, LLC

960 F.3d 1368 (Fed. Cir. 2020)

The Federal Circuit rejected Almirall's request for attorneys' fees because 35 U.S.C. § 285 does not authorize awarding fees for work that was done before the agency on appeal from an IPR proceeding. Amneal filed a petition for IPR. While it was pending, Almirall offered a covenant not to sue contingent on the dismissal of the IPR. The PTAB issued a final written decision finding the claims not unpatentable, which Amneal initially appealed, but subsequently withdrew. Almirall moved for attorneys' fees, specifically seeking attorneys' fees that were incurred for work on the IPR after the covenant not to sue was offered.

The Federal Circuit explained that even if Section 285 was not limited to district court proceedings, awarding fees under Section 285 required that the fee was incurred during, in close relation to, or as a direct result of, judicial proceedings.

Anza Tech., Inc. v. Mushkin, Inc.

934 F.3d 1359 (Fed. Cir. 2019)

In this appeal from a district court, the Federal Circuit adopted a notice-based interpretation for determining whether claims in a plaintiff's second amended complaint "relate back" to the date of the plaintiff's original complaint, and thus avoided being time-barred by the six-year statute of limitations under 35 U.S.C. § 286.

In the district court, plaintiff Anza Technology had filed a second amended complaint after learning in mediation that its claims were no longer viable against defendant Mushkin, Inc. In the second amended complaint, Anza alleged infringement of two new patents, and removed the infringement allegations against the patent in the original complaint. Anza also omitted ten of the sixteen products that had been accused in the original complaint and added two new accused products. The district court held that the new infringement claims did not relate back to the date of the original complaint in accordance with Fed. R. Civ. P. 15(c)(1)(B), because "proving infringement of the initial and new claims would not involve substantially the same evidence." Consequently, the six-year statute of limitations barred the claims because the alleged infringing activity took place more than six years before the filing date of the second amended complaint.

The Federal Circuit reversed holding that the district court erred by employing an "overly restrictive" application of the relation back doctrine. The Federal Circuit adopted a "notice" standard for conducting the relation back analysis. Under a notice standard, the core question is "whether the general factual situation or the aggregate of operative facts underlying the original claim for relief gave notice to [the defendant] of the nature of the allegations it was being called upon to answer." Relevant factors to this analysis include "the overlap of parties, the overlap in the accused products, the underlying science and technology, time periods, and any additional factors that might suggest a commonality or lack of commonality between the two sets of claims."

With respect to the six originally accused products, the Federal Circuit found that while the patents employed different bonding technologies, “they all share the same underlying technology” and “are focused on solving the same problem by the same solution, [namely,] using a bonding tool tip made of a dissipative material having a resistance low enough to prevent the discharge of a charge to a device being bonded and high enough to avoid current flow to that device.” The Federal Circuit thus concluded that it “would not be likely to result in a substantially different evidentiary showing,” and thus the claims related back.

With respect to the two new accused products added to the second amended complaint, the Federal Circuit determined that was an open question, which required an analysis of whether the two newly accused products were “too far afield from the original complaint to put Mushkin on notice of the allegations against it.” The Court thus vacated the district court’s decision on the issue and remanded to the district court to determine whether the allegations regarding those two products relate back to the original complaint, which “requires an analysis of facts that are not before us and as to which the district court is uniquely situated to rule.”

Apple Inc. v. Andrea Elecs. Corp.
949 F.3d 697 (Fed. Cir. 2020)

In 2016, Andrea Electronics Corp. sued Apple Inc. for infringement of its ’345 patent which relates to digital audio processing and noise cancellation technologies. Apple then filed two IPR petitions contesting the validity of claims 1–25 and 38–47 of the patent. The PTAB consolidated the proceedings and found that all of the challenged claims except claims 4–11 and 39–47 of the patent were unpatentable. In its final written decision, the PTAB refused to consider Apple’s arguments with respect to one of the IPRs because it found that the arguments raised a new theory of unpatentability which first appeared only in the reply brief. In the other IPR, the PTAB adopted Andrea’s proposed claim construction for the term, “periodically,” meaning “at regular intervals of time” rather than Apple’s proposed construction which interpreted it as meaning “from time to time.”

On appeal, the Federal Circuit held that the PTAB erred by not considering Apple’s argument in its reply brief because it was not a new theory of unpatentability. Apple did not cite new evidence or not previously identified portions of the prior art, and the Court held that it would be unreasonable to expect petitioners to discuss “all potential permutations” of variables in order to avoid waiving the opportunity to discuss other examples to support their positions in supplemental briefing. Parties may elaborate on their arguments if the issues were previously raised. The Court further found that even if it was ambiguous whether Apple raised a new theory of unpatentability, Apple was still permitted to present that argument as a response to Andrea’s Patent Owner Response, and the PTAB erred by not analyzing this issue. Apple directly replied to Andrea’s Patent Owner Response, thus warranting reversal on the issue. Finally, the Court found that there was substantial evidence that a POSITA would have understood the term, “periodically” to mean “at regular intervals of time” and not “from time to time,” and thereby affirmed the PTAB’s findings on this issue.

Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.

950 F.3d 860 (Fed. Cir. 2020)

In this appeal regarding the marking statute, the district court found that Arctic was not entitled to recover pre-suit damages for failure to mark personal watercrafts (“PWCs”). The Federal Circuit agreed that 35 U.S.C. § 287 “continues to limit damages after a patentee or licensee ceases sales of unmarked products.”

Arctic owned the ’545 and ’969 patents, which were related to steering systems for PWCs. In 2002, Arctic entered into a license agreement with Honda that included both patents. The final version of the agreement expressly stated that Honda had no obligation to mark the licensed products with applicable patent numbers. Subsequently, Honda made and sold unmarked PWCs, and Arctic made no effort to ensure these PWCs were marked. Eventually, Honda ceased their sales of licensed but unmarked PWCs sometime between 2013 and 2018.

The Federal Circuit addressed the question of whether the “cessation of sales of unmarked products excuses noncompliance with the notice requirement of Section 287 such that a patentee may recover damages for the period after sales of unmarked products ceased but before the filing of a suit for infringement.” The Court held that after cessation of sales of unmarked products, a patentee would have to either start marking products or provide actual notice to the alleged infringer in order to begin recovering damages after a period of time where sales of unmarked products occurred. The Federal Circuit noted that an obligation to mark began once Arctic’s licensee began selling patented articles, and cessation of sales did not fulfill Arctic’s notice obligations under Section 287. As a practical matter, “unmarked products remain on the market” and “incorrectly indicat[e] to the public that there is no patent [if] no corrective action has been taken by the patentee.” As a result, Arctic was not eligible to recover pre-complaint damages due to its failure to comply with the marking statute.

Argentum Pharm. LLC v. Novartis Pharm. Corp.

956 F.3d 1374 (Fed. Cir. 2020)

In this appeal, the Federal Circuit dismissed on the basis that the petitioner lacked standing to challenge a PTAB decision. Several parties, including Argentum Pharmaceuticals LLC, filed a petition for IPR of a Novartis patent related to the drug Gilenya. The PTAB ultimately determined that the challengers failed to establish the unpatentability of the claims. The parties appealed, but during the pendency of the appeals, every challenger but Argentum settled with Novartis. Novartis then filed a motion to dismiss.

The Federal Circuit held that Argentum lacked Article III standing to file the appeal because it failed to demonstrate that it had “suffered injury in fact.” In doing so, the Court rejected three of Argentum’s arguments. First, the Court held that Argentum did not face a real or imminent threat of litigation. Argentum’s marketing partner was in the process of filing an ANDA for a generic form of Gilenya. However, the application was not yet filed, and it was Argentum’s marketing partner, not Argentum, that bore the risk of an

infringement lawsuit. Second, the Court held that potential injuries to Argentum's investments from a potential infringement suit were "conjectural and speculative," and neither "concrete and particularized," nor "actual or imminent." Here, Argentum failed to demonstrate that it specifically invested in its marketing partner's work on a generic version of Gilenya. Prospective economic injury to Argentum was therefore "conclusory and speculative." Third, the Court held that estoppel under 35 U.S.C. § 315(e) did not constitute an injury in fact for purposes of Argentum's standing. Though Argentum contended that the provision would preclude it from "raising patentability and validity issues in a future infringement action," Argentum had not "engaged in activity that would give rise to a possible infringement suit." The Federal Circuit held that the company therefore had not demonstrated that it would be harmed by estoppel.

Arthrex, Inc. v. Smith & Nephew, Inc.
941 F.3d 1320 (Fed. Cir. 2019)

In this case, Arthrex appealed a PTAB decision holding certain claims from their '907 patent unpatentable as anticipated. After Smith & Nephew asked the PTAB for IPR of Arthrex's '907 patent for a knotless suture securing assembly, a panel of three Administrative Patent Judges ("APJs") declared some claims unpatentable. Arthrex contended that the appointment of PTAB's APJs was unconstitutional because APJs are principal officers who must be appointed by the President with the advice and consent of the Senate. On appeal, the Federal Circuit severed the removal restriction for APJs in the Patent Act in order to remedy the constitutional appointment problem.

In its opinion, the Federal Circuit first concluded that Arthrex had not waived their Appointments Clause challenge even though they had not brought it before the PTAB. The federal appellate court has discretion to decide issues not passed on by the lower courts, including Appointments Clause challenges. While it was undisputed that APJs are officers of the United States rather than employees, the question remained of whether they are principal or inferior officers. Following *Edmond v. United States*, the Court determined the APJs' status by looking to see if they had a superior. To do so, the Court reviewed the PTAB Director's review power, supervisory power, and removal power.

The Court concluded that the Director has no direct review power because he has no *sua sponte* power to vacate or review APJ panel decisions. The Court did find that the Director has supervisory power, as he may direct policy priorities, issue regulations for IPR proceedings, and control the APJs' salaries. However, the Court found that the Director also lacks true removal power. Under 35 U.S.C. § 3(c), the Director may only remove an APJ "for such cause as will promote the efficiency of the service," as written in Title 5.

To remedy the unconstitutional provision, the Court chose to partially sever the application of 35 U.S.C. § 3(c) to APJs. By severing the for-cause limitation on removal for APJs, the Court rendered them inferior officers, making their appointment constitutional. The Court then vacated the PTAB judgement and remanded the matter for a new panel of APJs to decide.

Arthrex, Inc. v. Smith & Nephew, Inc.

935 F.3d 1319 (Fed. Cir. 2019)

In this case, the Federal Circuit held that the PTAB’s use of slightly different language than that used in Smith & Nephew’s petition to explain why a person of ordinary skill in the art would have been motivated to combine prior art teachings did not violate the patent owner’s procedural rights.

Smith & Nephew sought IPR of claims 10 and 11 of Arthrex’s ’541 patent, which described a surgical suture anchor used to reattach soft tissue to bone. According to Smith & Nephew, two prior art references—Gordon and West—rendered both claims obvious. Meanwhile, Smith & Nephew also alleged that claim 11 was anticipated by Curtis, which described another bone anchor. After the PTAB ruled that Smith & Nephew had shown both claims unpatentable, Arthrex appealed, arguing that by casting West’s method as “preferred”—a characterization not found in Smith & Nephew’s petition—the PTAB crafted a new reason for combining the patents in violation of its procedural rights under the APA. However, the Federal Circuit held that “the mere fact that the PTAB did not use the exact language of the petition in the final written decision does not mean it changed theories in a manner inconsistent with the APA and our case law.” The Court also held that the PTAB’s determination that a skilled artisan would have found Arthrex’s invention obvious was supported by substantial evidence, that the PTAB’s construction of “helical thread” was adequate, and that the IPR process was not unconstitutional when applied retroactively to pre-AIA patents.

ATEN Int’l Co., Ltd. v. Uniclass Tech. Co., Ltd.

932 F.3d 1364 (Fed. Cir. 2019)

ATEN International Co., Ltd. brought an infringement action against Uniclass Technology Co., Ltd. and other competitors for infringement of two patents related to keyboard-video-mouse (KVM) switches. At trial, the jury found that Uniclass did not infringe the asserted claims of the patents and found the asserted claims of ATEN’s ’141 patent invalid as anticipated. ATEN moved for judgment as a matter of law (“JMOL”) on both issues, which the district court denied. On appeal, the Federal Circuit reversed as to invalidity and affirmed as to non-infringement.

On the issue of invalidity, the Federal Circuit held that the district court erred in denying JMOL because substantial evidence did not support the jury’s finding of anticipation for either of the two grounds presented by Uniclass. The undisputed critical date for the relevant patent was July 24, 2006. Uniclass argued that the testing of a 2009 specimen qualified as prior art because it used firmware that was released in 2006; however, Uniclass’s expert did not specify as to a date or month. Likewise, the Federal Circuit found that a second reference failed to teach one of the elements of the ’141 patent. Therefore, the jury’s finding of anticipation lacked substantial evidence. However, the Federal Circuit affirmed the lower court’s denial of JMOL as to non-infringement. ATEN argued that the jury was confused regarding Uniclass’s expert testimony on the scope of the claim terms. The Federal Circuit held that by failing to object to the expert’s testimony during trial,

ATEN waived any challenge to the jury's finding of infringement based on the testimony at issue, noting that the parties are obligated to raise a dispute regarding the proper scope of claims to the court.

ATEN Int'l Co., Ltd. v. Uniclass Tech. Co., Ltd.
932 F.3d 1371 (Fed. Cir. 2019)

This appeal arose from a district court's denial of a motion to award attorneys' fees under 35 U.S.C. § 285 after a jury verdict found that Uniclass Technology Co., Ltd. did not infringe patents of ATEN International Co. The Federal Circuit upheld the lower court decision.

Uniclass argued that this case was exceptional under Section 285 because ATEN disregarded the "foundational policy" of proportionate litigation by incurring litigation expenses greater than what was reasonably recoverable in royalty damages. Uniclass also argued that the district court erred by failing to weigh ATEN's frivolous damages methodology in its analysis, contending that ATEN's lost profits theory, which was rejected at the summary judgment stage, was baseless and brought in bad faith. The Federal Circuit rejected both arguments, holding that the district court did not abuse its discretion when it found that under the totality of the circumstances the litigation was not exceptional.

B.E. Technology, L.L.C. v. Facebook, Inc.
940 F.3d 675 (Fed. Cir. 2019)

In this case, B.E. sued Facebook for infringement. About a year into the infringement case, Facebook and two other accused parties filed multiple petitions for IPR of the asserted claims. The PTO instituted review of the asserted claims and found them unpatentable. Facebook subsequently moved for judgment on the pleadings in the infringement case, seeking dismissal with prejudice and costs. The district court dismissed for mootness and declined to award Facebook costs. Facebook renewed its motion for costs after the judgment was entered, and this time, the district court awarded costs. B.E. sought review by the Court. The Court affirmed the decision, holding that Facebook "obtained the outcome it sought: rebuffing B.E.'s attempt to alter the parties' legal relationship" and was the prevailing party in B.E.'s lawsuit.

The Federal Circuit affirmed the district court's award of costs to Facebook. The Federal Circuit agreed with Facebook that it was the prevailing party, even though the case was dismissed as moot. The Federal Circuit relied on the Supreme Court's decision in *CRST Van Expedited, Inc. v. E.E.O.C.*, — U.S. —, 136 S. Ct. 1642 (2016), which held that a defendant could be declared the prevailing party absent a judgment on the merits, and its decision in *Raniere v. Microsoft Corp.*, 887 F.3d 1298 (Fed. Cir. 2018), which affirmed the district court's holding that defendants were the prevailing parties because they expended "significant time and resources," "prevented Raniere from achieving a material alteration of the relationship between them" with a "decision marked by judicial *imprimatur*," and "received all relief to which they were entitled." Here, even though the mootness decision depended on the cancellation of claims from the PTO rather than the

district court, Facebook obtained the outcome it sought and rebuffed B.E.’s attempt to alter the parties’ legal relationship in an infringement suit, with a decision that placed a judicial *imprimatur* upon B.E.’s claim for patent infringement.

B/E Aerospace, Inc. v. C&D Zodiac, Inc.

962 F.3d 1373 (Fed. Cir. 2020)

This appeal arose from a final written decision from the PTAB that found certain claims of B/E Aerospace’s (“B/E”) aircraft lavatory-related patents obvious. B/E appealed, arguing that there was a claim limitation that was not present in the prior art. The patents at issue were directed to space-saving modifications to the walls of aircraft enclosures. Specifically under review were two recess limitations configured to add space in aircraft cabins.

There was no dispute that the admitted art containing a contoured wall design met the “first recess” claim limitation. As for the “second recess” claim limitation, the Federal Circuit held there was no error in the PTAB’s conclusion that it would have been obvious under the admitted prior art to include the claimed “second recess.” The PTAB concluded that the challenged claims would have been obvious because modifying the combination of the admitted prior art to include a second recess was a predictable result and was also the result of common sense. Finally, the Federal Circuit held that substantial evidence supported the PTAB’s determination of obviousness independent of the design drawings that were neither patents nor printed publications.

BASF Corp. v. SNF Holding Co.

955 F.3d 958 (Fed. Cir. 2020)

In this appeal, the Federal Circuit held that the district court erred in granting summary judgment holding certain claims as invalid under 35 U.S.C. § 102. The patent-in-suit involved a process for preparing certain high molecular weight polymers. The alleged prior art involved a license to make, use, and sell certain superabsorbent polymers, and in connection with the license the licensor provided the licensee with extensive technical information and assistance in performing the process to prepare the polymers. The district court found the claims at issue anticipated under Section 102(a) due to prior knowledge or use, Section 102(b) due to public use, and Section 102(b) under the on-sale bar.

The Federal Circuit reversed. First, the Court held that the licensed process that was purportedly prior art was not “known or used” under Section 102(a) because the knowledge or use was not accessible to the public, and factual issues regarding the extent of confidentiality restrictions in place precluded summary judgment. Next, the Court concluded that use is not “public use” under Section 102(b) if it is successfully concealed or hidden from those not required in some way to keep it secret, and factual disputes regarding the level of concealment and secrecy precluded summary judgment. Finally, the Court concluded that the district court erred as a matter of law in its on-sale bar analysis, reaffirming that for a process to be “on sale” under Section 102(b) where a product made using that process was sold, the essential features of the claimed process must be embodied in the product sold or offered for sale before the critical date, which was not the case for

the licensed product and related process alleged as prior art. Likewise, acquisition of the licensor by a third party was not a sale of the process because there was no product sold as part of the transaction that embodied the essential features of the manufacturing process.

BioDelivery Sciences Int'l, Inc. v. Aquestive Therapeutics, Inc.

935 F.3d 1362 (Fed. Cir. 2019)

In this case, the Federal Circuit granted a motion dismissing BioDelivery Sciences International, Inc.'s ("BioDelivery") appeal from the PTAB, holding that the PTAB's decision not to institute—even after previously instituting and issuing final written decisions that were ultimately vacated by the Federal Circuit—was not reviewable.

The PTAB instituted review on a single ground from each of BioDelivery's multi-ground petitions for IPR. For each petition, the PTAB sustained the patentability of all claims subject to the challenges. However, after oral argument on the appeals, the Supreme Court decided *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018), which established that IPR proceedings must be "in accordance with" or "in conformance to" the petition." The Federal Circuit vacated the PTAB's written decisions and remanded to the PTAB. On remand, the PTAB requested briefing on the parties' positions as to whether the petitions could be denied in their entirety. After considering whether BioDelivery had shown a reasonable likelihood of prevailing on all of the grounds, the PTAB—relying on its discretion under 35 U.S.C. § 314(a)—denied the petitions and terminated the proceedings.

On appeal of this decision on remand, the Federal Circuit emphasized that the Director of the PTO had discretion not to institute review even when the threshold was met under Section 314(a) of the America Invents Act. The Court found that there was no requirement that IPR must proceed through final written decisions once implemented. Moreover, the Court explained that the PTAB corrected its partial institution errors under *SAS* by revisiting its decisions and exercising its discretion not to institute review. Judge Newman wrote a dissent articulating that the action departed from the principles of appellate review since the PTAB declined to execute the Federal Circuit's remand order.

Biogen Int'l GmbH v. Banner Life Scis. LLC

956 F.3d 1351 (Fed. Cir. 2020)

The Federal Circuit affirmed the district court's dismissal of an infringement action against a manufacturer of a generic drug. Biogen International GmbH alleged that Banner Life Sciences infringed Biogen's '001 patent by producing a generic drug that supplied the metabolite of the active ingredient of the patented drug. The Court held that Banner's generic drug did not infringe because the scope of the extension of the '001 patent under 35 U.S.C. § 156—the Hatch-Waxman Act—only included the active ingredient, not the metabolite.

The Federal Circuit relied on the definition of "product" in Section 156(f) to resolve the issue. That section defines "product" as "the active ingredient of . . . a new drug . . . including any salt or ester of the active ingredient." The Hatch-Waxman Act allowed

Biogen to extend the '001 patent to compensate for the FDA approval process. However, that extension only covered the “product.” Accordingly, because the metabolite was not the active ingredient—or a salt or ester of it—and therefore was not the “product,” the extension did not apply to the metabolite. Thus, the generic drug could not, as a matter of law, infringe upon the '001 patent.

Blackbird Tech LLC v. Health In Motion LLC
944 F.3d 910 (Fed. Cir. 2019)

Appellant Blackbird Tech LLC sued Appellees Health in Motion LLC (“HIM”) and Leisure Fitness Equipment LLC (together, “Appellees”) for infringement of Blackbird’s ’976 patent, which relates to exercise equipment. After offering a series of decreasing settlement offers that Appellees rejected, Blackbird voluntarily dismissed its suit with prejudice, after which Appellees were granted attorneys’ fees and expenses for the total requested amount. In this appeal from the Central District of California, the Federal Circuit held that the district court did not abuse its discretion in concluding that this case is exceptional under 35 U.S.C. § 285 and in determining that Appellees are entitled to the total requested amount of attorney fees and expenses.

First, the Federal Circuit agreed with the district court’s finding that Blackbird’s litigation position was meritless, frivolous, and raised flawed claim construction and infringement contentions. For example, independent claim 1 of the ’976 patent requires a “housing” that includes a structure where cables are passed through from within the housing to outside the housing. However, the accused device’s cables are arranged outside of the alleged “housing.” The Federal Circuit also rejected Blackbird’s arguments that the district court erred by not finding Blackbird’s claims objectively baseless as opposed to merely flawed, and that they had no adequate notice from Appellees or the district court that their litigation position was weak.

Second, the Federal Circuit agreed with the district court’s determination that Blackbird’s case was exceptional because Blackbird litigated in an unreasonable manner by making nuisance value settlement offers, unreasonably delaying document production, and unreasonably filing a notice of dismissal, covenant not to sue, and motion to dismiss on the eve of trial without first notifying Appellee’s counsel.

Lastly, the Federal Circuit affirmed the district court’s grant of the total requested amount of attorneys’ fees and expenses because it was reasonable considering the attorney’s “comparable skill, experience, and reputation” and the extensive record supports that this case was subject to extensive motion practice and trial preparation. Moreover, the Federal Circuit found that the record supports the conclusion that Blackbird’s misconduct was severe enough to warrant a full award of attorneys’ fees and expenses. As such, the Federal Circuit affirmed the district court’s finding of exceptionality and fee award.

Bd. of Regents of the Univ. of Tex. Sys. v. Boston Sci. Corp.

936 F.3d 1365 (Fed. Cir. 2019)

In this case, the Federal Circuit affirmed the district court's transfer for improper venue of an infringement action to the District of Delaware. The Court held that state sovereignty principles did not grant the Board of Regents of the University of Texas System ("UT") the right to bring suit in an improper venue according to the patent venue statute, 28 U.S.C. § 1400(b).

UT sued Boston Scientific Corporation for patent infringement in the Western District of Texas. The district court transferred the case to the District of Delaware due to improper venue. On appeal of the transfer order, the Federal Circuit first explained that it had jurisdiction because UT's challenge was based on state sovereignty and the case was therefore excepted to the final judgment rule by the collateral order doctrine according to the Supreme Court's reasoning and analysis in *Puerto Rico Aqueduct & Sewer Authority v. Metcalf & Eddy, Inc.*, 113 S. Ct. 684 (1993). Having established that the district court's order satisfied all three elements of the collateral order doctrine, the Federal Circuit ruled that the state sovereignty principles asserted by UT did not grant it the right to bring a patent infringement lawsuit in Texas since state sovereign immunity did not apply where a state acted solely as a plaintiff. The Federal Circuit rejected UT's original jurisdiction arguments because the cases it cited were inapposite and UT never sought to invoke original jurisdiction. The Court also rejected UT's claim that the District of Delaware lacked jurisdiction since Texas had not consented to the suit and waived sovereign immunity, as sovereign immunity did not apply when the state proceeded as a plaintiff and the authorities cited by UT were inapposite.

Bozeman Fin. LLC v. Fed. Reserve Bank of Atlanta

955 F.3d 971 (Fed. Cir. 2020)

On post-issuance review brought by Federal Reserve Banks, the PTAB held that business method claims directed to authorizing and clearing financial transactions while detecting and preventing fraud were not patent eligible. The Federal Circuit affirmed.

The Court first determined that Federal Reserve Banks "are 'persons' capable of petitioning for post-issuance review under the AIA." The patentee, Bozeman Financial ("Bozeman"), contended that the banks were "government entities" that lacked authority to "petition for post-issuance review under the AIA" following the Supreme Court's decision in *Return Mail, Inc. v. U.S. Postal Service*, 139 S. Ct. 1853 (2019). Here, the Court found that the banks were not government entities and were instead corporations that could "sue or be sued in 'any court of law or equity.'" Accordingly, Federal Reserve Banks are "persons" that can challenge patents under the AIA.

The Court then found the patents' method for "[v]erifying financial documents to reduce transactional fraud is a fundamental business practice that, without more, is not eligible for patent protection." The Court found the patents' claims were "directed to the abstract idea of 'collecting and analyzing information for financial transaction fraud or error detection'"

and failed to “include an inventive concept that would otherwise render the claims eligible.” The Court held that steps directed to “recording or extracting data from physical documents” did not make the claims not abstract. Further, the Court held that the “use of a digital-image scanner to create a digital electronic record” was not an inventive concept sufficient to transform the abstract idea into patent-eligible subject matter.

Campbell Soup Co. v. Gamon Plus, Inc.
939 F.3d 1335 (Fed. Cir. 2019)

In this appeal from the PTAB’s decision during an IPR proceeding that Gamon Plus’s design patents, directed to a specific element of a gravity feed display for soup cans, were not unpatentable. The central issue was whether the appellant’s two prior art references were similar enough to the claimed design to constitute a proper primary reference, as required for a design patent obviousness inquiry. The PTAB found that none of the references were proper primary references. On appeal, the Federal Circuit found that the PTAB erred in its factual finding that one of the references (Linz) did not constitute a proper primary reference, and vacated and remanded the case for further proceedings.

Regarding the Linz reference, the Federal Circuit disagreed with the PTAB’s finding that the design failed to disclose a cylindrical object, like a soup can, below the display area. During the IPR proceeding, Campbell argued that it was clear that the Linz design was meant to hold cylindrical objects in its display, even though no cylindrical object is pictured below the display. The Court agreed with Campbell, finding that Linz—with the small, added modification of a cylindrical object, like a soup can—substantially resembled the challenged design.

Judge Newman dissented, finding that the Linz reference constitutes an improper primary reference. Specifically, Judge Newman found that the majority erred in proposing that because the Linz design is made to hold a cylindrical object in its display area, the design must be viewed with the “judicial insertion” of a missing, cylindrical object. By making such a “judicial insertion,” Judge Newman found that the majority misapplied patent and design law by conducting an analysis of a design not currently in existence.

CardioNet, LLC v. InfoBionic, Inc.
955 F.3d 1358 (Fed. Cir. 2020)

A court in the District of Massachusetts granted InfoBionic’s motion to dismiss on the basis that CardioNet’s ’207 patent claims were patent ineligible. On appeal, the Federal Circuit reversed and remanded, holding that “the asserted claims of the ’207 patent are directed to a patent-eligible improvement . . . and are not directed to an abstract idea.”

The panel majority held that the ’207 patent claims improved upon cardiac monitoring technology to more accurately “detect[] and distinguish[] atrial fibrillation and atrial flutter from other various forms of cardiac arrhythmia.” The majority found that the district court had oversimplified the ’207 patent claims as “directed to the abstract idea that atrial fibrillation and atrial flutter ‘can be distinguished by focusing on the variability of the

irregular heartbeat.” The majority held that, instead, the claims “are directed to a specific technological improvement—an improved medical device that achieves speedier, more accurate, and clinically significant detection of two specific medical conditions out of a host of possible heart conditions.”

The majority then determined it could decide the eligibility issue as a legal question “without remanding to assess the state of the art as of the invention date to determine whether the asserted claims are directed to automating a practice long used by doctors.” The majority held that courts need not examine extrinsic evidence of the prior art in cases, as here, where “review of the intrinsic record [demonstrates that a] patent[’s] claims are not directed to a patent-ineligible abstract idea.” Nonetheless, the majority stated that extrinsic evidence may still play an integral part in the Section 101 analysis of prior art in many cases, which was a point emphasized by Judge Dyk in dissent.

Caterpillar Paving Prod. Inc. v. Wirtgen Am., Inc.

957 F.3d 1342 (Fed. Cir. 2020)

Caterpillar appealed the PTAB’s final written decision in an IPR challenging its patent. After filing its appeal, Caterpillar moved to vacate and remand for a new hearing before a differently constituted panel in light of *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019), which held that the appointment of the PTAB’s Administrative Patent Judges violated the Appointments Clause of the U.S. Constitution. The Federal Circuit denied Caterpillar’s motion, noting that *Arthrex* issued before the PTAB issued its final written decision in the underlying IPR. Accordingly, the Court found that the decision was not rendered by an unconstitutional panel and no remand was necessary.

Chamberlain Group, Inc. v. Techtronic Indus. Co

935 F.3d 1341 (Fed. Cir. 2019)

This appeal from a district court concerned Techtronic Industries Co.’s (“TTI”) challenge of two patents held by the Chamberlain Group, Inc. (“CGI”): a patent relating to an apparatus and method for the wireless communication of information about the status of a movable barrier such as a garage door (“the ’275 patent”); and a patent relating to a rechargeable battery backup system for a barrier movement operator, such as a garage door opener, that can also be used to charge other equipment, such as cordless power tools (“the ’966 patent”).

First, the panel considered CGI’s ’275 patent. Applying the two-step *Alice* framework, the Court held that the asserted claims are “drawn to the abstract idea of wirelessly communicating status information about a system.” Citing two recent precedents—*Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253 (Fed. Cir. 2016), and *Affinity Labs of Texas, LLC v. Amazon.com Inc.*, 838 F.3d 1266 (Fed. Cir. 2016)—the Court held that “the broad concept of communicating information wirelessly, without more, is an abstract idea.” At the second step of the *Alice* framework, the Court found that, because “wireless transmission is the only aspect of the claims that CGI points to as allegedly inventive[,]”

the claims do not identify an “inventive concept” sufficient to transform the claimed abstract idea into a patent-eligible application of that idea.

Next, the Court considered the validity of CGI’s ’966 patent. The district court denied TTI’s motion for JMOL on the issue of anticipation, based in part on the theory that combinations of adjacently disclosed embodiments may not be considered under the anticipation analysis. The Federal Circuit disagreed, finding that the district court was incorrect to suggest that two embodiments in a reference can never be considered in combination to make a finding of anticipation. Instead, “the relevant question is whether the reference is sufficiently clear in disclosing the combinability” of the relevant elements “such that a skilled artisan would ‘at once envisage’ the claimed combination.” In the end, however, the Federal Circuit found this error to be harmless, given that TTI did not allege that the jury received the district court’s recitation of the law from the JMOL, and TTI did not appeal any portion of the jury instructions. The Federal Circuit thus affirmed the jury’s no-anticipation verdict.

The Federal Circuit also affirmed the district court’s denial of TTI’s motion to transfer venue after the *TC Heartland* decision, agreeing with the district court that TTI waited too long—almost thirty days after *TC Heartland* and two months before trial—to make the motion.

Finally, the Federal Circuit affirmed the district court’s decision to admit into the record as evidence the PTAB’s non-institution decision with respect to TTI’s petition for IPR of the ’966 patent. The Federal Circuit found that the district court’s provision of a limiting instruction to the jury explaining the different legal standards applied by the PTAB did not amount to an abuse of discretion. However, the panel cautioned that “both ongoing proceedings and denials of institution provide limited probative value that is likely to be outweighed by the prejudice to the opposing party, and limiting instructions to the jury do not necessarily cure the prejudice.” Furthermore, the panel warned that “district courts should still exercise caution when admitting evidence of a denial of institution because it may be confusing to the jury and prejudicial.”

Chamberlain Grp., Inc. v. One World Techs., Inc.
944 F.3d 919 (Fed. Cir. 2019)

On appeal from the PTAB, the Federal Circuit affirmed a Final Written Decision determining that the challenged claims in Chamberlain’s ’611 patent were anticipated by another patent, Schindler. The ’611 patent is directed to improve methods of human interaction with barrier movement operators, such as garage door operator systems. The Schindler patent is directed to a garage door operator system.

One World Technologies, Inc. petitioned for IPR of claims 18–25 of the ’611 patent, asserting that they were anticipated by the Schindler patent, and that claims 23 and 24 were rendered obvious by a combination of Schindler and an owner’s manual for an industrial duty door operator. Chamberlain only challenged the PTAB’s finding on Schindler. At the oral hearing, Chamberlain argued for the first time that Schindler fails to anticipate

claim 18 because claim 18 requires identifying *multiple activities* before transmitting any guidance “responsive to” the first and second identifying steps, whereas Schindler only identifies a *single activity* before transmitting a guidance signal for that single activity.

Chamberlain appealed the PTAB’s finding that (1) Chamberlain waived its “responsive to” argument because Chamberlain raised it for the first time at the oral hearing, and (2) that Schindler anticipates claim 18 of the ’611 patent.

First, the Federal Circuit held that the PTAB erred in finding Chamberlain waived its “responsive to” argument. Chamberlain argued that the PTAB’s waiver finding was erroneous because (1) its “responsive to” argument responded to new arguments made in One World’s reply, and (2) its “responsive to” argument was consistent with its position throughout the IPR and was merely a clarification. The Federal Circuit agreed with Chamberlain that a finding of waiver was inappropriate in this situation because the “responsive to” argument did not raise a new issue but rather clarified Chamberlain’s previous position. However, the Federal Circuit did not find that the PTAB’s error changes a finding of anticipation because the Court agrees with the PTAB that the “responsive to” argument is unpersuasive on its merits.

Second, the Federal Circuit affirmed the PTAB’s finding that Schindler anticipates claim 18 of the ’611 patent. The PTAB rejected Chamberlain’s argument that Schindler only identifies a single activity because there is no timing requirement or limitation in claim 18 as to when each of the multiple activities needs to be identified. The PTAB agreed with One World’s argument that Schindler’s disclosure of transmitting signals sequentially in response to previous steps, rather than simultaneously, teaches claim 18’s “responsive to” step and thus anticipates it. The Federal Circuit concluded that the PTAB’s finding of anticipation is supported by substantial evidence, and therefore affirmed the PTAB’s decision.

Cheetah Omni, LLC v. AT&T Servs., Inc.

949 F.3d 691 (Fed. Cir. 2020)

The Federal Circuit affirmed the decision of the District Court for the Northern District of Texas, which granted summary judgment in favor of AT&T and Ciena Communications, Inc. Cheetah Omni, LLC (“Cheetah”) sued AT&T for infringement of the ’836 patent, which is directed to optical communication networks. Ciena, as a manufacturer and supplier of some of the components at issue, moved to intervene in the suit and the motion was granted. AT&T and Ciena then moved for summary judgment, arguing that Cheetah’s claim was barred by a licensing agreement between Cheetah and Ciena which arose from the settlement of prior litigation. The district court granted the motion for summary judgment and dismissed the case with prejudice. Cheetah appealed.

The license agreement arose from a settlement between Cheetah, Ciena, and Fujitsu Network Communications, in which Cheetah agreed not to sue either Ciena or Fujitsu for infringement of “Licensed Products,” which include “all past, present, or future Ciena or Ciena Affiliate products . . . that could themselves or in combination with other products,

services, components or systems, be alleged to infringe at least one claim of at least one licensed patent.” On appeal, Cheetah argued that the licensing agreement in question did not include the ’836 patent because, while the licensing agreement included continuations of the original ’925 patent, the ’836 patent was a continuation of a continuation—in other words, a grandchild patent. Cheetah further argued that the ’836 patent existed at the time of the settlement and that if the parties had intended to expressly include the patent in license, they would have done so, particularly because other patents were expressly included in the agreement. AT&T and Ciena responded that neither agreement contained patents listed by number, and the agreement did specifically exclude some other patents, thereby showing that if Cheetah had wanted to exclude the ’836 patent from the agreement, it could have done so.

The Court agreed with AT&T and Ciena. Relying on its prior decision in *General Protecht Group Inc., v. Leviton Manufacturing Co.*, 651 F.3d 1355, 1361 (Fed. Cir. 2011), the Court reaffirmed that an express license to a patent includes an implied license to any continuations and that it is up to the parties to rebut this presumption by express terms should they choose to do so. The Court rejected Cheetah’s argument that the decision in *General Protecht* should only be applicable where the patent in question was issued after the license was agreed to, and held that the timing of patent issuance had no bearing on the decision. The fact that the ’836 patent was a grandchild patent did not factor into the analysis, because a grandchild patent was still properly considered a continuation of the original patent.

Ciena Corp. v. Oyster Optics, LLC
958 F.3d 1157 (Fed. Cir. 2020)

After being sued for infringement in district court, Ciena petitioned the PTAB for IPR of the asserted patents. The PTAB conducted proceedings and issued a final written decision, concluding that Ciena had failed to demonstrate that any of the challenged claims was unpatentable.

Then, Ciena appealed to the Federal Circuit, arguing that under *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019), the PTAB’s decision must be vacated and remanded for a new hearing before a differently constituted panel because the members of the PTAB panel that issued the decision were not appointed in compliance with the Appointments Clause of the U.S. Constitution.

The Federal Circuit rejected Ciena’s appeal. The Court held that Ciena had forfeited its Appointment Clause challenge because, “unlike the patent owner in *Arthrex*, Ciena requested that the Board panel adjudicate its petition.” Ciena, thus, “affirmatively sought a ruling from the Board members, regardless of how they were appointed.” The Court further noted that “Ciena was content to have the assigned Board judges adjudicate its invalidity challenges until the Board ruled against it.”

The Court held that while courts of appeals have discretion to “forgive waiver or forfeiture of claims that implicate structural constitutional concerns,” they are not “bound to do so.”

Here, the Court exercised its discretion in declining to take up Ciena’s Appointments Clause challenge, while noting that “[a]ny constitutional concern regarding the appointment of the Board judges in this case is negated by Ciena’s forfeiture.”

Cochlear Bone Anchored Solutions AB v. Oticon Medical AB Eyeglasses
958 F.3d 1348 (Fed. Cir. 2020)

This case concerned a cochlear hearing aid device designed for use in patients that are deaf in only one ear. Oticon filed two IPR petitions, which collectively challenged the validity of all of the claims of Cochlear’s ’040 patent. The PTAB determined that claims 4–6 and 11–12 of the ’040 patent were unpatentable, and Cochlear appealed. The PTAB also determined that claims 7–10 could not be shown to be unpatentable, because these claims contained means-plus-function limitations without a corresponding structure disclosed in the specification. Therefore, the PTAB determined that it could not compare the claims with the prior art. Oticon cross-appealed this ruling. The Federal Circuit affirmed with respect to all claims, except claim 10. For claim 10, the Court vacated and remanded.

The Court affirmed the PTAB’s conclusion that claims 4–6 and 11–12 were unpatentable due to obviousness or anticipation. The Court agreed with the PTAB’s claim construction that the preamble phrase “for rehabilitation of unilateral hearing loss” was not limiting because it was merely a statement of intended use. The Court then determined that the PTAB’s factual findings on the motivation to combine the prior art and anticipation were supported by substantial evidence.

For claims 7–10, the issue was whether the PTAB could conduct a prior art analysis for those claims, or if under *Samsung Elecs. Am., Inc. v. Prisia Eng’g Corp.*, 948 F.3d 1342 (Fed. Cir. 2020), the claims were indefinite and thus the PTAB could not to compare them to the prior art during an IPR. For claims 7–9, the Court held that because each claim “plainly contains at least one required means-plus-function claim element for which the specification provides no corresponding structure,” the PTAB correctly determined that the “unpatentability of claims 7–9 could not be shown” because no prior art analysis could be conducted. With respect to these claims, the Court also reaffirmed its holding from *Samsung* that the petitioner “would not be estopped by 35 U.S.C. § 315(e) from challenging those claims under sections 102 or 103 in other proceedings.” For claim 10, the Court vacated and remanded, instructing the PTAB to consider whether the “directivity dependent microphone” element of claim 10 could be analyzed within the scope of Section 112, because that portion of the claim, unlike the others, recited a structure that corresponded to the claimed means. The Court noted that because claim 10 potentially covered an alternative that does not require a mean-plus-function element, the PTAB may be able to compare that alternative to the prior art, even though the claim as a whole may be indefinite.

Judge Newman, writing in dissent, disagreed with the majority’s decision with respect to the PTAB’s invalidation of claims 4–6, 11, and 12. The dissent argued that the majority erred by finding that the introductory clause did not limit the claims because “[i]t is incorrect to remove such claim limitations when they describe substantive aspects of the

invention,” particularly when removing the limitations “broadens the residue of the claim into obviousness.”

Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.

942 F.3d 1119 (Fed. Cir. 2019)

At issue in this appeal were two patents: the '270 patent and the '093 patent. The '270 patent is a utility patent directed to materials that couple heat-directing elements with a base fabric. The '093 patent is a design patent drawn to the ornamental design of a heat-reflective material. Due to venue issues, separate courts ruled on the '270 and '093 patents. The District of Oregon granted summary judgment that the defendant infringed the '093 patent while a jury in the District of California determined that claims 2 and 23 of the '270 patent were invalid as both anticipated and obvious. Both parties appealed.

The Federal Circuit affirmed the invalidity of the '270 patent, and reversed the grant of summary judgment of infringement for the '093 patent. For the '270 patent, the Federal Circuit affirmed the jury's determination that the patent was obvious, since the finding was sufficiently supported by the record and did not require expert testimony. Additionally, the court rejected the patentee's argument that the district court should have instructed the jury with the patentee's proposed instruction on anticipatory ranges, as the given instructions were not misleading nor incorrect statements of law—more so, they constituted harmless error because the jury also found the claims to be obvious under other unchallenged jury instructions. Because the court found substantial evidence supports obviousness, it did not reach the patentee's anticipation arguments. Regarding the '093 patent, the Federal Circuit found that the district court erred in granting summary judgment of infringement for two reasons: (1) the court improperly declined to consider the effect of the alleged infringer's logo in its infringement analysis, and (2) the court resolved a series of factual disputes, in some instances relying on an incorrect standards, that should have been tried to a jury. Thus, the case was remanded for further proceedings concerning the '093 patent.

The Federal Circuit also found that the district court did not abuse its discretion in excusing the alleged infringer's waiver of its venue defenses in seeking transfer from Oregon to California. The court found that *TC Heartland* constituted an intervening change in the law such that the district court could excuse the such a waiver.

Comcast Corp. v. Int'l Trade Comm'n

951 F.3d 1301 (Fed. Cir. 2020)

In this case, Rovi Corporation filed a complaint with the ITC alleging that customers of Comcast Corporation infringed certain patents claiming an interactive television program guide by importing its XI system set-top television boxes in violation of Section 337 of the Tariff Act of 1930. The ITC found that Comcast induced infringement by its customers of the asserted patents, and Comcast sought review by the Federal Circuit.

On appeal, Comcast argued that the X1 set-top boxes were not “articles that infringe” within the meaning of Section 337 because they do not infringe the asserted patents at the time of importation, but rather only when they were subsequently combined, domestically, with customers’ mobile devices. The ITC argued that Section 337, which prohibits importation, sale for importation, or “sale within the United States after importation by the owner” of an infringing good, includes goods that were used by an importer to directly infringe post-importation as a result of the seller’s inducement.

The Federal Circuit held that Section 337 includes articles that infringe after importation. In particular, the Court agreed that Comcast had designed the X1 set-top boxes to be used in an infringing manner, directed importation of the boxes, and retained sufficient control over the boxes after importation. The X1 boxes were thus “articles that infringe” both before and after their importation into the United States. Because Comcast did not dispute that it induced infringement of the asserted patents after importation, the Court affirmed the ITC’s holding of infringement under Section 337.

Commc’ns Test Design, Inc. v. Contec, LLC
952 F.3d 1356 (Fed. Cir. 2020)

CTDI brought action seeking declaratory judgment that its system for testing set-top boxes and multimedia devices did not infringe two of Contec’s patents in the United States District Court for the Eastern District of Pennsylvania (“the Pennsylvania action”). The Eastern District of Pennsylvania declined jurisdiction over the declaratory judgment action once Contec filed an infringement action in the United States District Court for the Northern District of New York. CTDI appealed to the Federal Circuit. The Federal Circuit held that the district court did not abuse its discretion and affirmed the lower court’s ruling.

Even though CTDI filed its action first, Contec moved to dismiss the Pennsylvania action because CTDI’s declaratory judgment filing was made “in bad faith during active licensing discussions, only after inducing Contec to refrain from filing its own complaint against CTDI in a different forum.”

The Federal Circuit agreed with the district court’s analysis of the several factors that warranted departure from the first-to-file rule. These factors include “(1) CTDI filed its declaratory judgment complaint in anticipation of Contec’s patent infringement complaint; (2) CTDI’s suit interfered with ongoing negotiations between the parties and did not serve the objectives of the Declaratory Judgment Act; and (3) on balance, the Northern District of New York is a more convenient forum.” The Federal Circuit held that these factors, coupled with the district court’s findings that CTDI’s complaint interfered with ongoing negotiations and was filed in anticipation of Contec’s infringement suit, support the district court’s decision to depart from the first-to-file rule and dismiss CTDI’s complaint. The Court declined to remand for an evidentiary hearing.

Curver Luxembourg, SARL v. Home Expressions Inc.

938 F.3d 1334 (Fed. Cir. 2019)

In this appeal from a district court, the Federal Circuit held, as a matter of first impression, that claim language of a design patent indicating a particular article of manufacture can limit the scope of a design patent to that particular article of manufacture even when the article of manufacture does not appear in the figures.

Plaintiff Curver Luxembourg, SARL (“Curver”) is the assignee of a design patent for an overlapping “Y”-shaped design. The patent is entitled “Pattern for a Chair” and the claim language states, “ornamental design for a pattern for a chair.” However, the figures “merely illustrate the design pattern disembodied from any article of manufacture.” Curver sued defendant Home Expressions Inc., arguing that Home Expressions manufactured and sold baskets that infringed Curver’s patent by incorporating its “Y”-shaped design. The district court dismissed the case under Rule 12(b)(6), finding that the patent was limited to chairs only.

The Federal Circuit affirmed, holding that claim language can limit the scope of a design patent where the claim language supplies the only instance of an article of manufacture that appears nowhere in the figures. In reaching that conclusion, the Court found that “long-standing precedent, unchallenged regulation, and agency practice all consistently support the view that design patents are granted only for a design applied to an article of manufacture, and not a design *per se*.” The claim language “ornamental design for a pattern for a chair” therefore limited the scope of the design to chairs.

Customedia Techs., LLC v. Dish Network Corp.

941 F.3d 1173 (Fed. Cir. 2019)

In this per curiam order, the Federal Circuit denied Customedia’s notice of supplemental authority, which the Court construed as a motion to vacate and remand the PTAB’s decision in accordance with the Federal Circuit’s decision in *Arthrex, Inc. v. Smith & Nephew, Inc.* Customedia’s motion sought to assert the same Appointments Clause challenge as was raised in *Arthrex*. The merits panel denied the motion, holding that Customedia had forfeited its Appointments Clause challenge because it did not raise the issue in, or prior to, its opening brief on appeal.

Customedia Techs., LLC v. Dish Network Corp.

941 F.3d 1174 (Fed. Cir. 2019)

In this per curiam order, the Federal Circuit denied Customedia’s motion to vacate and remand the PTAB’s decision in accordance with the Federal Circuit’s decision in *Arthrex, Inc. v. Smith & Nephew, Inc.* Customedia’s motion sought to assert the same Appointments Clause challenge as was raised in *Arthrex*. The merits panel denied the motion, holding that Customedia had forfeited its Appointments Clause challenge because it did not raise the issue in, or prior to, its opening brief on appeal.

Customedia Techs., LLC v. Dish Network Corp

951 F.3d 1359 (Fed. Cir. 2020)

The Federal Circuit affirmed the PTAB’s decision in CBM proceedings that certain claims of two patents with the same specification were ineligible under Section 101. The specification generally disclosed broadcasters or other content providers transmitting advertising data to a customer’s set-top box and the advertising data being selectively recorded in programmable storage sections in the set-top box.

Regarding the first step of the *Alice* test, the Federal Circuit held that, at most, the “claimed invention merely improved the abstract idea of delivering targeted advertising using a computer only as a tool.” While the claims did recite reserving memory to ensure storage space for advertising data, doing so did not improve the functionality of the computer itself.

Regarding the second step of the *Alice* test, the Federal Circuit held that “the claims recite only generic computer components, including a programmable receiver unit, a storage device, a remote server and a processor” and “such generic and functional hardware is insufficient to render eligible claims directed to an abstract idea.”

Dana-Farber Cancer Institute, Inc. v. Ono Pharma. Co.

964 F.3d 1365 (Fed. Cir. 2020)

The Dana-Farber Cancer Institute sued to add its employee Dr. Gordon Freeman and his colleague Dr. Clive Wood as co-inventors on six cancer immunotherapy patents, which were held by Dr. Tasuku Honjo and assigned to Ono Pharmaceutical. After a bench trial, the District of Massachusetts agreed to correct inventorship of the patents; Ono appealed.

Ono first challenged the district court’s legal analysis of conception, and the Federal Circuit rejected each of its arguments. It was not enough that Drs. Freeman and Wood did not “participate in certain experiments that led to the conception of the claimed invention,” including *in vivo* experiments, because “joint inventors need not contribute to all aspects of a conception[,]” and “*in vivo* verification is not required for a conception to be definite and permanent.” Nor did it matter that Dr. Honjo’s patents were issued over an earlier, provisional patent application by Drs. Freeman and Wood claiming related inventions, because “joint inventorship does not depend on whether a claimed invention is novel or nonobvious over a particular researcher’s contribution”—rather, it is “[c]ollaboration and concerted effort” that count. Finally, the fact that Drs. Freeman and Wood published their research in a medical journal before conception of the patented inventions did not disqualify that research from making “significant contribution[s] to conception of the total invention.” “Publication of a portion of a complex invention does not necessarily defeat joint inventorship of that invention,” the Court explained, “and it does not here.”

Ono next challenged the district court’s factual finding that Drs. Freeman and Wood made significant contributions to the invention of Dr. Honjo’s patents. The Court rejected this claim, holding that “[e]ven under Ono’s view of the facts,” Dr. Honjo’s patented methods could not have been conceived without the contributions of Drs. Freeman and Wood.

Finding no “clearly erroneous” factual determinations and no legal errors, the Court upheld the district court’s inventorship determination in full.

Dragon Intell. Prop., LLC v. DISH Network LLC
956 F.3d 1358 (Fed. Cir. 2020)

The Federal Circuit vacated the district court’s denial of a motion for attorneys’ fees following dismissal of an infringement claim. Dragon Intellectual Property had sued DISH Network for patent infringement. The district court entered judgment in favor of DISH after the parties stipulated to noninfringement. In addition, in a parallel IPR proceeding, the PTAB found the claims unpatentable. Dragon appealed both the district court’s judgment and the PTAB ruling. The Federal Circuit affirmed the PTAB ruling and dismissed the appeal of the judgment as moot; the district court then vacated its judgment. Although the district court acknowledged that DISH “‘achieved a victory’ over Dragon,” it found that DISH was not the “prevailing party because they were not granted ‘actual relief on the merits’” because “success in a different forum is not a basis for attorneys’ fees.”

The Federal Circuit overruled the district court’s ruling, holding that DISH was a prevailing party. The Court rejected Dragon’s argument that fees were only available if the district court had dismissed Dragon’s suit as moot, as opposed to vacating the judgment. The Court noted that, “[i]f anything, [DISH]’s success in obtaining a judgment of noninfringement, although later vacated in view of [DISH]’s success in invalidating the asserted claims, further supports holding that they are prevailing parties.” Accordingly, the Court vacated and remanded the district court order denying fees.

Eagle Pharm. Inc. v. Slayback Pharma LLC
958 F.3d 1171 (Fed. Cir. 2020)

Eagle sued Slayback for allegedly infringing its patents directed to formulations of bendamustine under the doctrine of equivalents. Specifically, Eagle alleged that Slayback’s use of ethanol in its generic formulations was equivalent to the claimed “pharmaceutically acceptable fluid,” which contained propylene glycol (PG). Slayback filed a motion for judgment of non-infringement on the pleadings. The district court granted the motion, holding that Eagle had surrendered ethanol as an equivalent “pharmaceutically acceptable fluid” under the disclosure-dedication doctrine because Eagle’s patents disclosed, but did not claim, ethanol as an alternative to PG. Eagle appealed.

The Federal Circuit affirmed. The Court upheld the district court’s finding that Eagle’s patents repeatedly disclosed, but did not claim, ethanol as an alternative “pharmaceutically acceptable fluid” to PG. The Court rejected Eagle’s argument that disclosures of ethanol were limited to certain unclaimed formulations, noting that “[t]he disclosure-dedication doctrine does not require the specification to disclose the allegedly dedicated subject matter in an embodiment that exactly matches the claimed embodiment.” The Court therefore

affirmed that Eagle had dedicated ethanol to the public, so Slayback’s generic formulations did not infringe Eagle’s patents under the doctrine of equivalents as a matter of law.

The Court also rejected Eagle’s procedural challenge, which claimed that the district court erred by ignoring a genuine factual dispute and granting judgment on the pleadings. The Court noted that application of the disclosure-dedication doctrine is a question of law, and it affirmed the district court’s finding that the patent disclosures themselves provided sufficient context to decide that question. Notwithstanding Eagle’s expert declaration contending otherwise, the Court concluded that “the only reasonable inference that can be made from the patent disclosures is that a skilled artisan would understand the patents to disclose ethanol as an alternative to the claimed PG.” Thus, judgement on the pleadings was proper.

Eko Brands, LLC v. Adrian Rivera Maynez Enters., Inc.
946 F.3d 1367 (Fed. Cir. 2020)

In this appeal from the Western District of Washington, the Federal Circuit affirmed the district court’s judgment of invalidity for the ’320 patent, the award of attorneys’ fees, and infringement of the ’855 patent.

Adrien Rivera Maynez Enterprises, Inc. (“ARM”) owns the ’320 patent and Eko Brands, LLC (“Eko”) owns the ’855 patent. The ’320 patent is directed to an adaptor device for single-brew coffee machines to be able to use both “pods” and “cup-shaped cartridges.” The ’855 patent describes a reusable filter cartridge device for use with single-serve beverage brewing machines.

ARM sued Eko for infringement of the ’320 patent at the ITC. The ITC found some claims of the ’320 patent invalid, but Eko defaulted in the ITC proceedings and the ITC issued a limited exclusion order and a cease and desist order on the remaining valid claims. Eko then sued in district court for a declaratory judgment of noninfringement and invalidity for the ’320 patent, and infringement of the ’855 patent. The district court granted a declaratory judgment of noninfringement of the ’320 patent to Eko, and ARM stipulated to infringement of the ’855 patent after the court issued its claim construction ruling. The jury then found that the remaining claims of the ’320 patent invalid as obvious and awarded attorneys’ fees and compensatory damages to Eko, but found that ARM did not willfully infringe the ’855 patent.

On appeal, the Federal Circuit found that the district court properly granted summary judgment based on its claim construction of the ’320 patent, and that substantial evidence supported the jury’s reasonable finding of obviousness. In determining attorneys’ fees for obviousness, the district court carefully concluded that, even though it had previously denied summary judgment on obviousness, ARM tried the issue of obviousness only to ensure that the ITC’s limited exclusion order remained valid, and that it did not seriously defend the obviousness of the claims at issue. The Federal Circuit found that the court did not abuse its discretion in granting a fee award to Eko.

On cross-appeal, Eko challenged the jury instructions for willful infringement. Before trial, the parties agreed to use the Federal Circuit Bar Association’s National Patent Jury Instructions No. 4.1 for willful infringement. The Federal Circuit found that the jury instructions contained, in isolation, inappropriate phrases, such as “egregious behavior” and “worthy of punishment.” These phrases were only relevant for a court when it determines enhanced damages after an affirmative finding of willfulness is made, or when it determines whether a case is exceptional. Despite these flaws, the Court held that the jury instructions as a whole, however, reasonably informed the jury of an adequate test for willfulness, and therefore were not legally erroneous.

Judge Reyna concurred in part and dissented in part, stating that the district court erred in its claim construction for the ’320 patent, and therefore erred in granting summary judgment and awarding attorney’s fees.

Elec. Comm’n Techs., LLC v. ShoppersChoice.com, LLC
963 F.3d 1371 (Fed. Cir. 2020)

The Federal Circuit held that the district court’s denial of attorneys’ fees was an abuse of discretion because the court failed to consider adequate evidence, including the totality of the circumstances of Electronic Communication Technologies’ (“ECT”) litigation history. Prior to ShoppersChoice’s appeal for attorneys’ fees, the District Court for the Southern District of Florida held claim 11 of ECT’s ’261 patent to be directed to ineligible subject matter. The Federal Circuit affirmed the court’s holding. As for ShoppersChoice’s attorneys’ fees motion, the district court found that awarding attorneys’ fees to ShoppersChoice was not proper because the case was not exceptional under the Lanham Act. The district court explained that the case was not exceptional because the substantive strength of the case was not completely lacking and ECT’s behavior was not unreasonable.

On appeal, the Federal Circuit vacated and remanded the district court’s denial of attorneys’ fees to ShoppersChoice. The Federal Circuit found that in the absence of evidence demonstrating that ECT engaged in reasonable conduct before the district court, the undisputed evidence demonstrating the broader context of ECT’s vexatious and abusive manner of litigation warranted an affirmative exceptional case finding. This was demonstrated by evidence of over a hundred lawsuits that ECT brought alleging infringement of the ’261 patent and other patents in the ’261 patent’s family. These lawsuits and additional pre-litigation demands were evidence that ECT was forcing low-value settlements or obtaining low-value license fees with no intention of testing the strength of its patent. In addition, before the district court ruled on the attorneys’ fee motion, a U.S. District Court for the Central District of California entered an award against ECT in another case for conduct related to one of ECT’s several ’261 patent infringement lawsuits.

The Federal Circuit also found that the district court failed to sufficiently address the objective weakness of claim 11. The strength of claim 11 was called into question by two other district court holdings, finding that no reasonable patent litigant would have believed that claim 11 was viable and that claim 11 suffered from obvious subject matter defects.

While these determinations were not binding on the district court, the Federal Circuit found that it was problematic that the court failed to consider information that was relevant to the strength of the claim.

Elec. Commc’n Techs., LLC v. ShoppersChoice.com, LLC
958 F.3d 1178 (Fed. Cir. 2020)

Electronic Communication Technologies (“ETC”) sued ShoppersChoice, alleging that ShoppersChoice infringed claim 11 of its ’261 patent. Claim 11 described a system for securely tracking the delivery or pickup of items. The district court granted ShoppersChoice’s motion for judgement on the pleadings, holding that claim 11 was ineligible under Section 101 because it was directed to an abstract idea and lacked an inventive concept. The Federal Circuit affirmed.

The Court applied the two-step test for patent eligibility from *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 217 (2014). Under step one, the Court found that claim 11 was “directed to the abstract idea of ‘providing advance notification of the pickup or delivery of a mobile thing.’” The Court rejected ETC’s argument that claim 11 was not directed at an abstract idea because it described a “unique” security feature. The Court explained that uniqueness alone is insufficient to confer patent eligibility, and “[m]oreover, the purported uniqueness of claim 11—*i.e.*, how the claims purportedly increase security—is itself abstract.” Under step two, the Court held that claim 11 did not include an inventive concept and was therefore patent ineligible. The Court distinguished *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288 (Fed. Cir. 2016), because *Amdocs* involved an “unconventional technological solution,” whereas this claim “only entails applying longstanding commercial practices using generic computer components and technology.”

Eli Lilly & Co. v. Hospira, Inc.
933 F.3d 1320 (Fed. Cir. 2019)

This case involves appeals related to patent disputes about Alimta, a drug marketed by Eli Lilly. Lilly asserted their ’209 patent against DRL and Hospira in two district court cases. In the DRL case, the district court determined that DRL infringed under the doctrine of equivalents. In the Hospira case, the lower court similarly found infringement under the doctrine of equivalents as well as literal infringement.

The Federal Circuit reversed the district court’s finding of literal infringement in the Hospira case, noting that “[i]t was clearly erroneous for the district court to hold that the ‘administration of pemetrexed disodium’ step was met because Hospira’s pemetrexed ditromethamine product will be dissolved in saline before administration.”

DRL and Hospira argued on appeal that the district court erred by refusing to apply prosecution history estoppel to bar Lilly’s doctrine of equivalents claim. Lilly relied on one exception to the presumption of prosecution history estoppel, claiming that its amendment had no more than a tangential relation to the equivalent. The Court agreed with Lilly, reasoning that the prosecution history “strongly indicates that the reason for the

amendment was to cede other, functionally identical, pemetrexed salts” in order to overcome a clear anticipation. Therefore, the particular type of salt to which pemetrexed is complexed related only tenuously to the reason for the narrowing amendment.

DRL further argued that the disclosure-dedication rule precluded Lilly’s equivalents claim and disputed the district court’s finding that administration of pemetrexed ditromethamine is equivalent to the claim element “administration of pemetrexed disodium.” The Federal Circuit nonetheless affirmed, holding (1) that the disclosure-dedication rule is inapplicable because the patent did not disclose methods of treatment using pemetrexed ditromethamine, and, as a result, Lilly could not have dedicated such a method to the public, and (2) there was no clear error in the district court’s findings that the two products are insubstantially different.

Ericsson Inc. v. TCL Commc’n Tech. Holdings Ltd.

955 F.3d 1317 (Fed. Cir. 2020)

In an infringement action, the Eastern District of Texas denied TCL Communication Technology Holdings’ (“TCL”) motion for summary judgment of ineligibility. The case proceeded to trial, resulting in a jury verdict that TCL had willfully infringed upon Ericsson’s patent (“the ’510 Patent”). The district court denied TCL’s motion for judgment as a matter of law and motion for a new trial, and TCL appealed. The Federal Circuit reversed the district court’s denial of TCL’s motion for summary judgment in a split decision, finding the claims in the ’510 patent ineligible because they were directed to an abstract idea and failed to contain an inventive concept. Judge Newman dissented.

The Court first determined that it could review the summary judgment ruling on appeal, despite TCL’s failure to sufficiently preserve the issue in a Rule 50 motion. The Court found that TCL preserved its right to appeal because the district court’s denial of TCL’s motion for summary judgment “amount[ed] to an ‘effective grant of summary judgment’” in favor of Ericsson. Even if the district court had not effectively granted summary judgment, the Court held that it has “discretion to hear issues that have been waived.” Judge Newman disagreed with the majority, noting that “[t]he majority announces new law and disrupts precedent” by finding that TCL preserved the Section 101 issues for appeal “absent [a Rule 50] post-trial motion and decision.”

The Court then conducted the two-step *Alice* eligibility analysis of the ’510 patent and found the claims ineligible to be patented under Section 101. The ’510 patent “describes ‘a system and method for controlling access to a platform for a mobile terminal for a wireless telecommunications system.’” After parsing the “technical jargon” of the claims’ language, the Court found the claims described the “bare abstract idea[] [of] controlling access to resources by receiving a request and determining if the request for access should be granted.” “Controlling access to resources via software [is] an abstract idea.” Further, the claims’ silence regarding “how access is controlled” made the claims generic because they did “no more than require a generic computer to perform generic computer functions.” Ericsson’s arguments that the ’510 patent claims contained an inventive concept also failed because support for those arguments was absent from the claims.

Judge Newman, in dissent, also disagreed with the majority’s Section 101 analysis because “the majority appear[ed] to require that all of the technologic information in the specification must be recited in the claims in order to avoid abstractness.” Judge Newman objected that this “is not the law and is not the practice” and that such a rule “not only conflicts with the opportunity to present claims of varying scope, but also conflicts with the principle that claims are intended to be concise statements of the patented invention as distinguished from the prior art.”

ESIP Series 2, LLC v. Puzhen Life USA, LLC

958 F.3d 1378 (Fed. Cir. 2020)

In this appeal, the Federal Circuit held that the PTAB’s determination regarding the real-parties-in-interest was final and nonappealable.

Puzhen filed a petition for IPR for certain claims of a patent owned by ESIP. Based on prior art and expert testimony, the PTAB ruled that the challenged claims would have been invalid as obvious; the PTAB rejected ESIP’s argument that Puzhen failed to identify two real parties in interest, ruling that Puzhen’s petition was not barred from institution.

On appeal, the Federal Circuit affirmed the PTAB’s obviousness decision as supported by substantial evidence. The Federal Circuit then held the PTAB’s real-parties-in-interest determination was final and non-appealable. The Court reasoned that appellate review was barred by 35 U.S.C. § 314(d) given that the determination raised an ordinary dispute about the application of an institution-related statute.

FanDuel, Inc. v. Interactive Games LLC

966 F.3d 1334 (Fed. Cir. 2020)

FanDuel filed an IPR challenging numerous claims of Interactive Games’ ’058 patent. The ’058 patent describes a gaming system wherein a gaming service provider wirelessly communicates with users’ mobile devices, allowing them to gamble remotely. The PTAB found unpatentable all challenged claims except claim 6, which the PTAB found FanDuel had failed to show was obvious in view of the asserted prior art. Claim 6 described the gaming system’s use of a “lookup table” to determine the “game configuration” based on the location of a user’s mobile gaming device.

On appeal, FanDuel argued that the PTAB violated the Administrative Procedure Act (APA) by basing its obviousness finding on issues that the patent owner did not raise in its responses. FanDuel also challenged the PTAB’s factual findings regarding obviousness.

The Federal Circuit affirmed, finding that the PTAB complied with the APA and that its obviousness findings were supported by substantial evidence. FanDuel claimed that the PTAB violated the APA by “adopting in its final written decision a ‘new theory’ . . . which the patent owner never raised during the proceeding.” FanDuel argued that this “change [in] theories midstream” did not give FanDuel reasonable notice as required under the APA. The Federal Circuit disagreed, finding as an initial matter that it failed to see how

the PTAB changed theories at all in this case. And to the extent the PTAB “changed theories,” the Federal Circuit held that “the Board was not required to first notify the parties in this case for two somewhat overlapping reasons”: (1) “the different standards of proof required to institute versus to invalidate permit the Board to adopt different views of the sufficiency of a petitioner’s asserted obviousness arguments in its initial versus final decisions without first alerting the parties to that possibility”; and (2) “the burden of proving invalidity in an IPR remains on the petitioner throughout the proceeding.” Accordingly, the Court held that the PTAB did not violate the APA.

FanDuel also challenged the PTAB’s factual findings, arguing that substantial evidence did not support the PTAB’s finding that the combination of three references did not render obvious claim 6’s “limitation of determining the ‘game configuration’ by accessing a lookup table which contains an ordered list of locations and associated game configurations.” Again, the Federal Circuit disagreed, finding that the PTAB properly considered the record in its entirety, including FanDuel’s expert’s declaration, and found as a factual matter that there was insufficient evidence that a person of ordinary skill in the art would have been motivated to add a lookup table to correlate location information with game configurations. The Court also rejected FanDuel’s suggestion that the PTAB was obligated to defer to its expert’s opinion of claim 6’s unpatentability just because the patent owner failed to supply opposing expert evidence. Accordingly, the Court affirmed the PTAB’s final written decision.

Judge Dyk joined the majority’s opinion rejecting FanDuel’s APA challenge but dissented from the majority’s affirmance of the PTAB’s obviousness determination. Judge Dyk would have held that the PTAB erred in its obviousness determination because the PTAB applied the incorrect legal standard. More specifically, Judge Dyk would have held that the PTAB erred by requiring FanDuel “to supply a specific motivation to use a look-up table and ordered list in this particular context when that choice would have been a simple alternative design choice to a skilled artisan.”

Fitbit, Inc. v. Valencell, Inc.

964 F.3d 1112 (Fed. Cir. 2020)

Apple petitioned for IPR of thirteen claims in a Valencell patent; the PTAB granted review of claims 1, 2, and 6–13, but denied review of claims 3–5. Fitbit also petitioned for review of claims 1, 2, and 6–13, and successfully moved for joinder. Between the PTAB trial and its Final Written Decision, the Supreme Court held that the PTAB must review *all* claims challenged when it grants an *inter partes* petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018). Accordingly, the PTAB re-instituted IPR of the joined Apple and Fitbit petitions, this time including claims 3–5, and held in Valencell’s favor.

Following the PTAB’s decision, Apple withdrew, but Fitbit appealed. Valencell challenged Fitbit’s right to appeal claims 3–5, since its initial petition did not request review of those claims; the Court disagreed, and upheld Fitbit’s right of appeal even as to claims 3–5. On the merits, the Court found errors in the PTAB’s rulings on claims 3–5, and remanded them for determinations of patentability. As to claim 3, the PTAB adopted

Valencell’s proposed construction of a term, but then neglected to review claim 3’s patentability under this construction. On appeal, the Court affirmed the PTAB’s construction, but remanded with instructions to conduct the obviousness analysis that Fitbit had requested. As to claims 4–5, the PTAB improperly treated an inadvertent error in a statement of claim dependency as a basis for a Final Written Decision of patentability, even though the parties “agree[d] as to the error and its correction.” This, the Court held, was an insufficient basis for a final determination of patentability; the PTAB should have accepted the parties’ proposed correction and proceeded with its patentability analysis on that basis.

Fox Factory, Inc. v. SRAM, LLC
944 F.3d 1366 (Fed. Cir. 2019)

Fox appealed the decisions of the PTAB in two IPRs of the challenged claims of SRAM’s ’027 patent. The PTAB found that the prior art references asserted by Fox disclose all the limitations of the ’027 patent’s independent claims and that a skilled artisan would have been motivated to combine the prior art. Nonetheless, the PTAB concluded that based on its analysis of secondary considerations, Fox had not shown that the challenged claims would have been obvious.

The ’027 patent is directed to an improved chainring structure for bicycles, and has independent claims that cover “outboard offset” and “inboard offset” structures on the body of the bicycle. SRAM sells different versions of its “X-Sync” chainrings. The PTAB determined that SRAM was entitled to a presumption of nexus between the challenged outboard offset claims and secondary considerations evidence pertaining to SRAM’s X-Sync products, and based on its analysis of secondary considerations, that Fox had not shown that the challenged claims would have been obvious. On appeal, the Federal Circuit agreed with Fox that the PTAB applied the wrong standard for their analysis.

In an obviousness analysis, the evidence of secondary considerations must have a nexus to the claims—*i.e.*, the product is coextensive with the patented invention. The PTAB interpreted the coextensiveness requirement to mean only that the claims must broadly cover the product that is the subject of the secondary considerations evidence. However, the Federal Circuit rejected this interpretation and instead held that although the patentee does not have to prove perfect correspondence to meet this requirement, the patentee must demonstrate that the product is essentially the claimed invention.

Using this standard, the Federal Circuit held that no reasonable factfinder could find that SRAM’s X-Sync chainrings are coextensive with the independent claims because the X-sync chainrings include unclaimed features that are significant. Since the PTAB erroneously presumed nexus between the evidence of secondary considerations and the independent claims, the Federal Circuit vacated the PTAB’s obviousness determination and remanded for further proceedings. On remand, SRAM will bear the burden of proving this nexus.

Further, the Federal Circuit held that SRAM did not preserve its argument that substantial evidence does not support the PTAB's conclusions that a skilled artisan would have been motivated to combine the asserted prior art to arrive at the independent claims, because SRAM did not mention this argument in its summary of the argument or argument sections of their brief. Even if the argument was properly preserved, the Federal Circuit held that it is meritless because the evidence supports the PTAB's conclusion that a skilled artisan would have recognized that the combination of prior art features would better address chain drop than either feature in isolation. Therefore, the Federal Circuit affirmed the PTAB's determination.

Lastly, the Federal Circuit held that Fox did not waive its right to an *SAS*-based remand because Fox properly preserved its objection by filing a motion to remand before its opening brief was due. Thus, the Federal Circuit remanded to the PTAB to consider the non-instituted grounds that were not reviewed in the underlying IPR proceedings.

Fraunhofer-Gesellschaft zur Förderung der Angewandten Forschung E.V. v. Sirius XM Radio Inc.

940 F.3d 1372 (Fed. Cir. 2019)

Fraunhofer sued Sirius XM Radio ("SXM") for patent infringement. The district court granted SXM's motion to dismiss for failure to state a claim because SXM claimed it had a valid license to Fraunhofer's patents. The Federal Circuit held that the SXM's "license defense" cannot be properly resolved on a motion to dismiss and thus vacated and remanded. The Federal Circuit also reversed the district court's denial of Fraunhofer's motion for leave to amend because the district court failed to consider extrinsic evidence of the parties' intent.

Game & Tech. Co., Ltd. v. Wargaming Grp. Ltd.

942 F.3d 1343 (Fed. Cir. 2019)

Game and Technology Co. ("GAT") filed a complaint accusing Wargaming on July 9, 2015, and attempted to properly serve Wargaming in the UK and in Cyprus in December 2015. On February 11, 2016, counsel for Wargaming called counsel for GAT, and subsequently indicated in a follow-up email that it would waive service in exchange for extending the time to respond to April 1, 2016. No formal waiver was filed with the district court, and on March 13, 2017, Wargaming filed its petition for IPR. The PTAB found that the IPR was not time-barred under Section 315(b), and that the claims would have been obvious over the asserted prior art. GAT appealed. The Federal Circuit affirmed.

Regarding the time-bar, the court first found that the PTAB must necessarily determine whether service was proper, and that whether the board erred depends on the merits of GAT's substantive time-bar arguments. GAT's brief devoted only one paragraph regarding the UK service with insufficient detail to properly preserve GAT's time-bar arguments on appeal. As such, the court could not conclude that the PTAB erred in determining that Wargaming's petition was not barred under Section 315(b). Turning to the merits, the Federal Circuit found that substantial evidence supported the PTAB's

finding that the claims of the '243 patent were obvious over the combination of references. Under de novo review, the court found GAT's proposed claim constructions unconvincing. GAT also argued that one of the references was directed to a dice game and, therefore, did not disclose all the necessary elements of an online game. The Federal Circuit rejected this argument because the question in an obviousness inquiry is whether it would have been obvious to a skilled artisan to combine the relevant disclosures of two references. Because a second reference disclosed all the computer processing elements of the claim, the court affirmed the Board's finding of obviousness.

Genentech, Inc. v. Hospira, Inc.

946 F.3d 1333 (Fed. Cir. 2020)

In this appeal from the PTAB, the Federal Circuit affirmed the Board's finding that the '799 patent is invalid as anticipated and obvious.

Genentech holds the '799 patent, where claim 1 recites: "[a] method of purifying a protein which comprises CH₂/CH₃ region, comprising subjecting a composition comprising said protein to protein A affinity chromatography at a temperature in the range from about 10°C to about 18°C." Hospira sought IPR of the '799 patent, and the PTAB determined that the challenged claims were unpatentable as anticipated and obvious.

The Federal Circuit found substantial evidence for the PTAB's finding that a skilled artisan would have understood that WO'389 anticipated the '799 patent. WO'389 included a step for protein A affinity chromatography conducted at a temperature range from 18°C to 25°C, which overlaps with the '799 patent's claimed temperature range of 10°C to 18°C. Since the temperature ranges overlapped, the PTAB found that Genentech failed to demonstrate that its temperature range was critical to performing the patented method, and that a skilled artisan would have understood that the prior art is within the claimed temperature range. Similarly, Genentech failed to persuade the Court that the claimed temperature range applied only to the laboratory, and not necessarily the protein mixture itself. The Court found evidence that no skilled artisan would understand that the protein mixture could be warmer than the surrounding temperature. Therefore, the Court affirmed the PTAB's finding that WO'389 anticipates the '799 patent.

The Court also found that substantial evidence supported the PTAB's determination that the '799 patent would have been obvious in view of the prior art. The Court found that Hospira made out a *prima facie* case of obviousness from the overlap in temperature range between the prior art and the '799 patent. Genentech failed to rebut the presumption of obviousness because it failed to show criticality of the claimed temperature range; that a person of skill would not recognize temperature to be a result-effective variable; that optimizing temperature would be more than routine experimentation; or that a person of skill would not be motivated to optimize the method's temperature. Similarly, Genentech raised objective indicia of nonobviousness but they were unpersuasive.

Genentech also challenged the PTAB's finding that another reference, van Sommeren, anticipated, arguing that there was error in the claim construction of the term "about 18°C."

The Court did not address this argument because anticipation by another reference was already affirmed.

Lastly, Genentech challenged the retroactive application of IPR to a patent issued prior to the passage of the AIA as a violation of the Fifth Amendment's Takings Clause. The Patent Office intervened in opposition to Genentech on this issue. The Court ruled against Genentech, applying *Celgene Corp. v. Peter*, 931 F.3d 1342 (Fed. Cir. 2019), which held that the differences between IPR, district court, and pre-AIA reexamination proceedings were not "sufficiently substantive or significant" to create a constitutional issue. The Court reasoned that patentees could reasonably expect the Patent Office to reconsider the patent or to be challenged in district court.

Judge Newman dissented, finding that the prior art did not anticipate or render the '799 patent obvious. Judge Newman would have held that the asserted references did not anticipate because the claimed temperature range of 10–18°C was different to a person of skill than the range of 18–25°C; the former is a "chilled" temperature, and the latter is "room temperature." Likewise, Judge Newman would have held that it was not obvious to lower the temperature because, though a skilled artisan would have been motivated to optimize the temperature, it was not known that cooling would have led to improved purification.

Genetic Veterinary Sci., Inc. v. LABOKLIN GmbH & Co. KG
933 F.3d 1302 (Fed. Cir. 2019)

This appeal concerns a patent directed toward an in vitro method for genotyping Labrador Retrievers in order to discover whether the dog might be a genetic carrier of a disease. LABOKLIN GmbH & Co. KG ("LABOKLIN") and patent owner the University of Bern ("the University") (together, "Appellants") appealed (1) the district court's denial of a motion to dismiss the complaint for lack of subject matter jurisdiction and personal jurisdiction, and (2) the district court's decision to hold the asserted claims patent-ineligible for failing to claim patent-eligible subject matter under 35 U.S.C. § 101. The Federal Circuit affirmed.

Appellants argued that the district court lacked personal jurisdiction over LABOKLIN because LABOKLIN lacked sufficient contacts with the forum. The district court found that personal jurisdiction existed because LABOKLIN sent a cease-and-desist letter to PPG and conducted business in the United States by entering into sublicenses in California and Michigan in accordance with an exclusive license granted to it on the disputed '114 patent. The Federal Circuit agreed, finding that LABOKLIN (1) established minimum contacts through the cease-and-desist letter taken together with the commercial sublicenses, and (2) such a determination was reasonable and fair because LABOKLIN purposefully availed itself of the benefits and protections of laws of the United States through its commercial sublicensing and its enforcement of the U.S. patent.

Appellants similarly argued that the district court lacked personal and subject matter jurisdiction over the University because the University enjoys sovereign immunity. The

Court again affirmed the lower court decision, holding that the University is not immune from the jurisdiction of courts of the United States under the Foreign Sovereign Immunities Act because the University is an agent or instrumentality of a foreign state that engaged in commercial activity, triggering an exception to immunity under Section 1605(a)(2). Because the University obtained a U.S. patent and threatened PPG with litigation through LABOKLIN, the University directly participated in the act of threatening infringement-related litigation to benefit from commercial activity.

The Federal Circuit also affirmed the district court's decision that claims 1–3 of the University's '114 patent are patent-ineligible under Section 101. Applying the two-part *Alice* test for patent eligibility, the Court found that the asserted claims are not directed to a new and useful method for discovery because claim 1 is not directed towards anything more than “observing or identifying” the natural phenomenon of the gene mutation, and claims 2 and 3 add only generic methods of detecting that natural phenomenon. Applying *Alice* step two, the Court found that “the asserted claims do not recite an inventive concept that transforms the observation of a natural phenomenon into a patentable invention” because a natural phenomenon, taken together with a well-understood, conventional activity, is not patent-eligible under Section 101.

Gensetix, Inc. v. Bd. of Regents of the Univ. of Tex.

966 F.3d 1316 (Fed. Cir. 2020)

Decker, the named inventor of the patents-in-suit, assigned his patents to the University of Texas (“UT”). UT then granted an exclusive license, to which plaintiff Gensetix succeeded. The license agreement required Gensetix to enforce the patents, with UT having a residual right to sue if Gensetix failed to uphold its obligation. In April 2017, Gensetix filed an infringement action against Baylor University (“Baylor”), and UT declined to join in the action. Gensetix sought to join UT as an involuntary plaintiff pursuant to Rule 19(a).

UT sought dismissal from the case under Rule 12(b)(1), asserting that it was a sovereign entity under Texas law and therefore immune from suit under the Eleventh Amendment, and that it had not waived such immunity either in the license agreement or otherwise. The District Court for the Southern District of Texas held that UT was entitled to sovereign immunity and that UT was an “indispensable” party under Rule 19(a), and dismissed the case.

The Federal Circuit affirmed that UT was immune from suit, holding that the Eleventh Amendment protects state sovereign entities from suit even if there are no claims asserted “against” those entities. The Court also held that coercive joinder under Rule 19(a) is not available where the party to be joined is immune from suit.

The Court also held, however, that the district court abused its discretion by dismissing the case. The Court held that the district court did not meaningfully analyze each of the Rule 19(b) factors, which require consideration of: “(1) the extent to which a judgment rendered might prejudice the missing required party or the existing parties; (2) the extent to which

any prejudice could be lessened or avoided; (3) whether a judgment rendered in the required party's absence would be adequate; and (4) whether the plaintiff would have an adequate remedy if the action were dismissed for nonjoinder." The Court found that UT was not indispensable, because: Gensetix's exclusive license to the full field of use rendered its interests in the asserted patents identical to UT's, "greatly reduc[ing]" any prejudice to UT; there was no risk of multiple suits under the terms of the UT license agreement; and that, "as an exclusive licensee with less than all substantial rights in the patents-in-suit, Gensetix cannot enforce its patent rights without the court allowing the suit to proceed in UT's absence."

Golden v. United States

955 F.3d 981 (Fed. Cir. 2020)

The Federal Circuit affirmed the decision of the Court of Federal Claims ("CFC") to dismiss an infringement action brought by a pro se patentee against the U.S. government. The Court affirmed that the CFC lacked jurisdiction to hear the infringement claims because the patentee brought the claims under Section 1491; "patent infringement claims against the government are to be pursued exclusively under [Section] 1498."

The Court also affirmed dismissal of the patentee's Fifth Amendment takings claims. The Court first rejected the government's argument that the AIA displaced the Tucker Act because "the AIA is not a statute that provides for claims against the United States." Further, the Court noted that the patentee's claims may have had merit at one point because a government agency—the Department of Homeland Security—initiated the IPR proceeding, violating the AIA under *Return Mail, Inc. v. U.S. Postal Service*, 139 S. Ct. 1853 (2019). However, the Court did not reach that issue for two reasons. First, the patentee failed to appeal the IPR decision, which became final before the Supreme Court's decision in *Return Mail*. Second, the patentee "voluntarily filed a non-contingent motion to amend the claims" at issue, thereby cancelling those claims. Thus, the patentee could not charge the U.S. government with "taking" his patent right because he voluntarily canceled the claims.

Grit Energy Sols., LLC v. Oren Techs., LLC

957 F.3d 1309 (Fed. Cir. 2020)

In this appeal, the Federal Circuit vacated and remanded a PTAB determination that Oren's '341 patent—related to a system for storing and discharging proppant used for hydraulic fracturing—was not unpatentable as obvious. In January 2017, after Grit Energy transferred ownership of the allegedly infringing products, the two parties "jointly stipulated the dismissal 'without prejudice'" of an infringement suit brought by Oren. The same month, Grit Energy filed a petition for IPR, arguing that certain of the '341 patent's claims were obvious, having been disclosed in the previous art of two other patents (Constantin and Eng Soon.) The PTAB disagreed, determining that Grit Energy failed to meet its burden of showing the '341 claims were unpatentable. Grit Energy appealed.

The Federal Circuit held that Grit Energy had standing to bring the appeal, and vacated the PTAB's decision. As a threshold matter, the Court held that Grit Energy had standing to appeal a final written decision of IPR review because its former, current, or likely future activity "would give rise to a possible infringement suit." Here, Oren was free to reassert the claims that gave rise to its previous infringement suit. Grit Energy remained liable for its previous alleged infringement under the agreement to dismiss without prejudice.

Next, the Federal Circuit held that the PTAB's determination that the '341 patent was not disclosed by prior art was unsupported by substantial evidence. First, the Court concluded that the Constantin patent did "disclose the '341 configuration." Second, the Court concluded that Grit Energy sufficiently articulated why a skilled artisan would have been motivated to combine the Eng Soon and Constantin prior art to contemplate the claimed invention in the '341 patent. Here, Grit Energy needed only to contend that doing so would require nothing more than "reorganizing known elements according to known methods to yield predictable results." Contrary to the PTAB's determination, Grit Energy did not need to point to additional motives, including economic calculus, for why a skilled artisan would be motivated to reorganize the known elements.

GS Cleantech Corp. v. Adkins Energy LLC
951 F.3d 1310 (Fed. Cir. 2020)

In this case, GS Cleantech Corporation brought an action against a number of oil producers, including Adkins Energy LLC, alleging infringement of certain patents claiming methods of recovering usable oil from by-products of a dry mill ethanol plant. Defendants moved for summary judgment on the ground that Cleantech's patents were invalid under the on-sale bar, 35 U.S.C. § 102(b). Defendants argued that a July 2003 email from the inventors to Agri-Energy LLC, which explained the patented method and offered Agri-Energy a "no-risk trial" of the invention, constituted an offer for sale that predated the August 2004 filing date of the earliest asserted patent. Cleantech claimed that the July 2003 email was a proposal to run tests and obtain data as the invention had not yet been reduced to practice. The district court granted summary judgment for defendants on a number of asserted patents, finding that the July 2003 email was an offer for sale because it described the essential components of the invention and provided a price.

In a separate bench trial, the district court also held that the asserted patents were unenforceable due to inequitable conduct. The court found that the inventors had "purposefully evaded" disclosing the July 2003 offer for sale to the USPTO, and had taken "affirmative steps" to hide that offer by filing a feasibility letter with the USPTO claiming the invention was first reduced to practice in 2004. Cleantech sought review by the Federal Circuit.

The Federal Circuit found that the District Court did not abuse its discretion in finding the asserted patents invalid under the on-sale bar. The Court determined that the July 2003 email contained all items necessary to practice the invention and the price, and that both the inventors and Agri-Tech understood it as an offer for sale. The Court also found that the district court did not abuse its discretion in finding the patents unenforceable due to

inequitable conduct. The Court first determined that the inventors sought to conceal successful testing of the invention in 2003 by filing a feasibility letter with the USPTO that claimed the invention was not reduced to practice until 2004. The Court also agreed that the inventors willfully misled the USPTO by filing a declaration that falsely claimed that the July 2003 offer for sale was not made until after the “critical date” for patent validity, and also failed to correct this misstatement in subsequent filings with the USPTO. The Court thus affirmed both findings by the District Court.

Guangdong Alison Hi-Tech Co. v. Int’l Trade Comm’n
936 F.3d 1353 (Fed. Cir. 2019)

In this case, the Federal Circuit affirmed the ITC’s determination that the asserted claims of the ’359 patent owned by a domestic manufacturer were not invalid. Specifically, the Court held that the term “lofty batting” was not indefinite and that the ITC’s anticipation determinations were supported by substantial evidence.

The Federal Circuit rejected Alison’s assertion that “lofty batting” was an indefinite term of degree without a precise boundary. According to the Court, this was in fact a term of degree, but the written description of the ’359 patent provided objective boundaries. The Federal Circuit pointed to express definitions, functional characteristics, examples and metrics, and extrinsic evidence that offered sufficient detail to inform a person of ordinary skill about the meaning of the term. The Court also affirmed the ITC’s anticipation determinations without reaching the subsidiary obviousness ground, holding that the ’359 patent’s express distinguishing of Ramamurthi, coupled with the patentee’s expert testimony, constituted substantial evidence.

Hafco Foundry & Machine Co. v. GMS Mine Repair
953 F.3d 745 (Fed. Cir. 2020)

Hafco is the owner of a design patent, which is used to “distribute rock dust in areas such as coal mines, where rock dust is applied to the mine’s interior surfaces, to control the hazards of coal dust.” Hafco contracted with GMS to serve as a distributor for Hafco’s Rock Dust Blower. After poor performance, Hafco terminated the arrangement. The district court entered judgment of willful infringement in accordance with the jury verdict. GMS raised two main issues on its appeal in the Federal Circuit: (1) whether it is entitled to JMOL on the issue of infringement and, (2) in the alternative, whether it is entitled to a new trial on the issue of infringement due to errors of law in the jury instruction. The Federal Circuit affirmed.

First, the Federal Circuit affirmed that infringement of a design patent is adjudged from the viewpoint of an “ordinary observer” when comparing a patented design with the disputed article’s overall appearance. Because GMS failed to establish that there were any errors in the jury instructions in explaining the ordinary observer standard, the Court held that both JMOL and the new trial motions were correctly denied. Second, GMS argued that the jury should have been instructed to become familiarized with “each of the prior art designs that have been brought” to their attention. However, the Court held that, given that

there was “no prior art introduced at trial, no attempt by GMS to introduce the prior art, and no proposed jury instruction on this issue, the purported exclusion of this instruction cannot be error.”

Regarding contractual damages, the Federal Circuit affirmed the district court’s judgment of \$123,650. However, Judge Newman stated that she would correct this calculation and remit the damage award to the undisputed amount of \$110,000.

Henny Penny Corp. v. Frymaster LLC

938 F.3d 1324 (Fed. Cir. 2019)

Henny Penny Corporation (“HPC”) appealed from an IPR decision holding that Frymaster LLC’s (“Frymaster”) patent for measuring the state of cooking oil degradation with a “total polar materials” (“TPM”) sensor was not unpatentable as obvious.

In determining that HPC did not establish the challenged claims were obvious, the PTAB credited Frymaster’s evidence of secondary considerations, including evidence of two industry awards. On appeal, HPC argued that Frymaster failed to prove the required nexus because the “object of praise” in the industry awards was already taught in prior art. The Federal Circuit rejected HPC’s arguments, holding that the praise was “generally directed to the claimed invention as a whole,” which involved a combination not known in prior art. Additionally, the panel held that although the identified objective indicia must be directed to what was not known in the prior art, it is also true that “industry praise is probative of nonobviousness even if it was not precisely limited to the point of novelty of the claimed combination.”

The Court also upheld the PTAB’s assessment of motivation to combine, rejecting HPC’s argument that “a skilled artisan could have ignored [prior art’s] diversion and cooling teachings, integrated only the TPM sensor into [another prior art], and just tolerated the faster degradation of the sensor.” Instead, the Court found that “a reasonable fact finder could have found these tradeoffs to yield an unappetizing combination.” In reaching that conclusion, the Court emphasized that “prior art must be considered for all its teachings, not selectively.”

Hitkansut LLC v. United States

958 F.3d 1162 (Fed. Cir. 2020)

This appeal concerns an award of fees from the United States to patentee Hitkansut in the amount of \$4,387,889.54, pursuant to 28 U.S.C. § 1498(a). Under this provision, a party meeting certain conditions in a successful infringement action against the United States is entitled to reasonable attorneys’ fees, unless “the court finds that the position of the United States was substantially justified.”

Hitkansut brought a successful infringement suit against the United States and was awarded damages in the amount of \$200,000, plus interest. The Court of Federal Claims granted in

part the company's motion for an award of attorneys' fees and costs under 28 U.S.C. § 1498(a). The United States appealed the award.

The Federal Circuit affirmed the award of attorneys' fees, but rejected the lower court's interpretation of Section 1498. First, the Court held that the "position of the United States" refers only to "positions taken by the United States in litigation," and does not encompass "prior actions or failures to act." Here, the Court was bound by its prior interpretation of the same phrase within the Equal Access to Justice Act. 28 U.S.C. § 2412(d)(1)(A). The Court had already construed the phrase "position of the United States" by the time Congress established Section 1498(a), and the Court found that relevant legislative history provides no indication that Congress intended to depart from the Court's construction.

Second, the Federal Circuit held that the lower court did not abuse its discretion in awarding attorneys' fees. Though the lower court impermissibly construed "positions of the United States" to include pre-litigation conduct, the lower court correctly determined that the United States' litigation positions (*e.g.*, its invalidity and non-infringement positions, as well as its discovery responses) were factually inconsistent with its own actions and contradicted by its own documentary evidence and deposition testimony.

Third, the Federal Circuit held that the lower court "did not abuse its discretion by declining to reduce its award of attorneys' fees," even though Hitkansut obtained only \$200,000 in damages, compared to the \$5.6 million amount originally sought. The Court reasoned that Hitkansut "succeeded on its sole claim, and proved a material amount of actual, compensable damages," therefore satisfying the lower court's "broad discretion" to craft an attorneys' fees award.

Hologic, Inc. v. Minerva Surgical, Inc.
957 F.3d 1256 (Fed. Cir. 2020)

This appeal involved two patents related to the NovaSure system, which detects perforations in the uterus. The '183 patent related to a method of detecting perforations. The '348 patent related to an ablation device. Hologic, Inc. obtained inventor and assignor Csaba Truckai's interests in the two patents. Truckai later founded Minerva Surgical, Inc. as a competitor, and Hologic sued for patent infringement. The district court granted Hologic's motion for summary judgment, holding that assignor estoppel precluded Minerva from challenging the patents' validity in district court due to Truckai's role as the company's founder and the patents' assignor. The jury found that Minerva had infringed both patents. In a parallel action, Minerva successfully challenged the '183 patent's validity before the PTAB, and the Federal Circuit affirmed. The district court held that the '183 patent's invalidity did not affect the jury's verdict or the court's application of assignor estoppel on the '348 patent.

On appeal, the Federal Circuit reaffirmed the doctrine of assignor estoppel, as well as its limitations. First, the Court affirmed that the district court did not abuse its discretion in denying Hologic relief under the invalid '183 patent. Here, the Court held that under the AIA, assignor estoppel does not bar an assignor from challenging a patent's validity before

the PTAB. Second, the Court affirmed the district court's application of assignor estoppel on the '348 patent, and its grant of summary judgment on infringement. Here, the Court held that Minerva could not raise invalidity defenses against the patent, but could otherwise defend against the infringement claims. Third, the Court upheld the jury's damages awards for infringement of the two patents despite the subsequent invalidation of the '183 patent. Here, undisputed evidence demonstrated that the awarded damages were supported by the infringement of the '348 patent independent of the infringement of the '183 patent.

Judge Stoll wrote separately to express additional views, noting that the Court's construction of the AIA allows an assignor to challenge a patent's validity before the PTAB, thereby circumventing the doctrine of assignor estoppel. Judge Stoll invited the Federal Circuit to revisit this issue en banc to determine whether assignor estoppel applies to both district courts and the PTAB.

Honeywell Int'l Inc. v. Arkema Inc.

939 F.3d 1345 (Fed. Cir. 2019)

In this appeal from an IPR proceeding, the Federal Circuit vacated and remanded the case after finding that the PTAB abused its discretion when it rejected Honeywell's request for authorization to file a motion for leave to petition the PTO Director for a Certificate of Correction. Specifically, Honeywell had sought to correct a mistake in the chain of priority listed on the face of the patent under review. The PTAB rejected Honeywell's request, finding that Honeywell's error was not "typographical or clerical" and that the correction was not "minor."

As background, during prosecution of its '017 patent, Honeywell filed a preliminary amendment that cancelled all 20 claims in its original application and added 20 new claims of a different subject matter. When doing so, Honeywell failed to make corresponding amendments to the list of priority applications. And so, when the '017 patent was issued, the list of priority applications was materially the same as the initial application, which is why Honeywell sought a Certification of Correction.

On appeal, the Federal Circuit noted the three steps that a patent owner must take in order to file a petition for a Certification of Correction: (1) seek authorization from the PTAB to file a motion; (2) if authorization is granted, file a motion with the PTAB to cede its exclusive jurisdiction; and (3) if the motion is granted, petition the Director for a Certificate of Correction under 35 U.S.C. § 255. After those three steps are completed, the Court noted that "the Director—not the Board—will evaluate the merits of the patentee's petition, including whether the mistake is of 'minor character' or 'occurred in good faith.'"

In light of these three steps, the Court noted that the PTAB abused its discretion by requiring that Honeywell show that the requirements of 35 U.S.C. § 255 have been met before authorizing Honeywell to file a motion for leave to seek a Certificate of Correction from the Director. Further, the Court noted that the PTAB also abused its discretion by "assuming that the authority of § 255 delegated to the Director and deciding the merits of

Honeywell’s petition for a Certificate of Correction.” Finally, the Court noted that the PTAB also erred by failing to provide an explanation or reasoned basis for its decision.

Hospira, Inc. v. Fresenius Kabi USA, LLC
946 F.3d 1322 (Fed. Cir. 2020)

In an appeal from the Northern District of Illinois, the Federal Circuit affirmed the district court’s invalidation of claim 6 of the ’106 patent based on the doctrine of inherent obviousness.

Hospira Inc. markets Precedex Premix, a ready-to-use dexmedetomidine product used as sedatives. After Fresenius Kabi USA LLC filed an abbreviated new drug application (“ANDA”) seeking to market a generic ready-to-use dexmedetomidine product, Hospira filed suit against Fresenius Kabi in the Northern District of Illinois for infringement of the multiple patents. The only remaining claim at issue at appeal was claim 6 of the ’106 patent, dependent on claim 1. Claim 1 is directed to a ready-to-use liquid dexmedetomidine, “wherein the liquid pharmaceutical composition when stored in the glass contained for at least five months exhibits no more than about 2% decrease in the concentration.” Claim 6 adds the limitation “wherein the dexmedetomidine . . . is at a concentration of about 4 µg/mL.” The main issue at appeal was whether the district court correctly found that a 4 µg/mL formulation stored under the claimed storage conditions would always meet the limitation of “no more than about 2% decrease” in dexmedetomidine concentration.

Following a bench trial, the district court found that the prior art expressly taught the claimed storage conditions and that the “2%” limitation was inherent in a 4 µg/mL dexmedetomidine. The court made the latter finding based on (i) expert testimony on the stability data of more than 20 samples of dexmedetomidine at the 4 µg/mL concentration preferred embodiment, and (ii) expert testimony that concentration does not impact the stability of dexmedetomidine. Further, the district court found that a person of skill would have reasonably expected dexmedetomidine to be stable under the claimed storage conditions based on the testimony that dexmedetomidine is a “rock stable molecule,” and 2% is standard industry expectation with respect to drug stability.

Hospira argued that the district court erred in considering non-prior art to evaluate inherency because all of the sample data came from the NDA and ANDA themselves, which were not part of the prior art, and that the samples were possibly manufactured using the process described in the specification. The Federal Circuit rejected this argument and held that extrinsic evidence can be considered, adding that it is irrelevant whether or not an unclaimed manufacturing process was used to prepare the samples for testing. Next, Hospira disputed the factual conclusion that the 2% limitation was inherent, because the sample studies submitted for trial were not “representative of every possible formulation” of the preferred embodiment, partly because they were prepared using the manufacturing process in the specification. The Court likewise rejected this contention, reasoning that claiming an inherent, but undisclosed, property of a composition does not make the composition patentably new. As such, the Court found no error in the factual finding,

adding that no evidence was presented to the contrary. Lastly, Hospira argued that the district court incorrectly applied the “reasonable expectation of success” standard, rather than the “necessarily present” standard, in determining inherency. While acknowledging that the district court conflated the standards and engaged in an unnecessary additional analysis of whether a person of skill would have had a reasonable expectation of stability, the Court concluded that this error was harmless.

Therefore, the Federal Circuit affirmed the district court’s finding of obviousness. Here, the discovery that premixed dexmedetomidine remains stable and active in storage was inherent in the prior art, and this rendered obvious claim 6 of the ’106 patent.

HVLPO2, LLC v. Oxygen Frog, LLC
949 F.3d 685 (Fed. Cir. 2020)

In this appeal from the Northern District of Florida, the Federal Circuit reversed the district court’s denial of a motion for a new trial based on the admittance of improper lay witness testimony. HVLPO2, LLC (“HVO”) sued Oxygen Frog, LLC and its CEO (collectively “Oxygen Frog”) for infringement of the claims of its ’941 and ’488 patents. The district court found that Oxygen Frog infringed claims 1 and 7 of both patents, but a jury later decided that those claims were obvious in light of the prior art. The patents were directed to an “oxygen-generating system” for glass blowing torches and tools. Oxygen Frog argued that the claims were obvious based on two prior art references, one of which was an online video by Tyler Piebes, a glass blowing artist. Piebes was not qualified as an expert witness, but provided deposition testimony that Oxygen Frog played for the jury at trial. In his testimony, Piebes offered his opinion that modifying the prior art to support the technology of the asserted patents would have been obvious, and HVO objected to the introduction of his opinion. The district court overruled the objection and gave the jury a limiting instruction that Piebes could provide his opinion but such testimony was “not the ultimate question of obviousness” and that the jury should still decide. After the jury determined that claims 1 and 7 were obvious, HVO filed a motion for judgment as a matter of law or for a new trial. The district court denied the motion, and HVO appealed.

On appeal, HVO argued that a new trial was necessary because the district court improperly admitted Piebes’s testimony and the testimony was substantially prejudicial to HVO. The Federal Circuit agreed, holding that it was an abuse of the district court’s discretion to admit the testimony and that the error was not harmless. The Court relied on Federal Rule of Evidence 702 which governs expert testimony and determined that Piebes’s opinion on whether the claimed modifications were obvious should not have been admitted without him being qualified as an expert because it was “directed to the central legal and technical question at trial.” In fact, because Piebes was not qualified as an expert, HVO was deprived of the opportunity to challenge the qualification and testimony. The Court found that the district court’s limiting instruction was not enough to save the decision to admit the testimony because the instruction improperly permitted the jury to consider Piebes’s lay testimony as evidence of obviousness. Because the Court held that the district court abused its discretion in admitting the testimony, it did not rule on the motion for judgment as a matter of law and reversed and remanded for a new trial.

HZNP Medicines LLC v. Actavis Labs. UT, Inc.

940 F.3d 680 (Fed. Cir. 2019)

In this Hatch-Waxman case, Actavis Laboratories UT, Inc. filed an Abbreviated New Drug Application (“ANDA”) that HZNP Medicines LLC and Horizon Pharma USA, Inc. (“Horizon”) alleged infringed on its patent. The U.S. District Court for the District of New Jersey held that the challenged claim of Horizon’s patent was invalid for indefiniteness and that Actavis’s ANDA label did not induce infringement. The court also held that Horizon’s patent was nonobvious.

The parties cross-appealed, and the Federal Circuit affirmed on all three issues.

First, the Federal Circuit found no clear error in the district court’s determination, based on extrinsic evidence, that the challenged claim was indefinite.

Second, the Federal Circuit agreed with the district court that the ANDA warning did not induce infringement of the patented method’s “three distinct steps.” It also agreed with the district court that Horizon’s expert opinion did not preclude summary judgment on this issue.

Third, the Federal Circuit agreed with the district court that, after a bench trial, Actavis did not show by clear and convincing evidence that the challenged claim was invalid as obvious.

Idenix Pharms. LLC v. Gilead Scis. Inc.

941 F.3d 1149 (Fed. Cir. 2019)

The Federal Circuit affirmed the District of Delaware’s ruling that Idenix’s patent was invalid for lack of enablement. The Federal Circuit reversed the district court’s ruling that the patent was not invalid for lack of written description.

The Federal Circuit found that, under the multi-factor analysis from *In re Wands*, 858 F.2d 731 (Fed. Cir. 1988), Indinex’s patent was non-enabled because it would require a POSITA to engage in undue experimentation to identify the compounds described by the patent. The Court found that: (i) Idenix’s specification encompassed many thousands of compounds, (ii) a POSITA would not be able to significantly narrow that number without much experimentation, (iii) the patent did not provide meaningful guidance by which to determine which 2’-methyl-up nucleosides would be effective against HCV; and (iv) the scope of the claimed invention was too broad to support enablement.

The Court also held that Indinex’s patent was invalid for failure to meet the written description requirement. The Court found that Idenix’s “blaze marks” did not adequately demonstrate which nucleosides outside the examples provided could effectively treat HCV. Further, the specification did not discuss the 2’-fluoro-down formula.

Illumina, Inc. v. Ariosa Diagnostics, Inc.

952 F.3d 1367 (Fed. Cir. 2020)

In this appeal, the Federal Circuit reversed the district court’s grant of summary judgment that the claims were directed to ineligible subject matter (*i.e.*, a natural phenomenon) under 35 U.S.C. § 101. The patents in dispute involve a solution that distinguishes between fetal DNA and maternal DNA in the mother’s bloodstream. The district court granted Roche’s motion for summary judgment, holding that the asserted claims are directed to ineligible subject matter.

In reversing, the Federal Circuit noted that this “is a method of preparation case” and the focus of the dispute “is whether the . . . claims are ‘directed to’ the natural phenomenon [that the inventors discovered], *i.e.*, whether they claim the discovered natural phenomenon itself versus eligible subject matter that exploits the discovery of the natural phenomenon.”

The Court concluded that the claims “are directed to methods for preparing a fraction of cell-free DNA that is enriched in fetal DNA[, which] include specific process steps—size discriminating and selectively removing DNA fragments that are above a specified size threshold—to increase the relative amount of fetal DNA as compared to maternal DNA in the sample.” The Court further concluded that these “process steps change the composition of the mixture, resulting in a DNA fraction that is different from the naturally-occurring fraction in the mother’s blood [so] the process achieves more than simply observing that fetal DNA is shorter than maternal DNA or detecting the presence of that phenomenon.” Ultimately, the court held, because the claimed methods are “directed to” more than merely the natural phenomenon that the inventors discovered, at step one of the *Alice/Mayo* test, the claims are not directed to a patent-ineligible concept. It did not reach step two of the test.

Judge Reyna dissented stating that a claim that merely changes the composition of a sample of naturally occurring substances, without altering the naturally occurring substances themselves, is not eligible.

Immunex Corp. v. Sandoz Inc.

964 F.3d 1049 (Fed. Cir. 2020)

Patent-owner, Hoffmann-La Roche (“Roche”) and its exclusive licensee, Immunex, brought a lawsuit against Sandoz pursuant to the Biologics Price Competition and Innovation Act. The U.S. District Court for the District of New Jersey held that Sandoz failed to prove that the ’182 and ’522 patents were invalid. On appeal, Sandoz argued that the patents-in-suit were invalid for obviousness-type double patenting, failure to meet the written description requirement, and obviousness. The Federal Circuit affirmed the district court’s decision.

At trial, Sandoz asserted that the patents-in-suit were invalid for obviousness-type double patenting over several patents filed by Immunex. The district court rejected Sandoz’s

arguments for several reasons, including that Sandoz’s proposed test for common ownership did not apply and that even if it did apply the patents-in-suit and the asserted double-patenting reference patents were not commonly owned.

The Federal Circuit found that Sandoz’s novel theory of common ownership—that an agreement conveying all substantial rights in a patent is tantamount to an assignment of ownership—could apply. The Court found that this theory was consistent with the principles underlying obviousness-type double patenting. However, the Court found that the Immunex Patents and the patents-in-suit were not commonly owned because the agreement between Roche and Immunex did not transfer all substantial rights from the assignee, Roche, to the exclusive licensee, Immunex. Accordingly, obviousness-type double patenting was inapplicable.

The Federal Circuit also rejected Sandoz’s argument that the priority application impermissibly rested on information outside of the patent and that as a result the patent lacked written description support. The fact that the patent specification did not restate known prior art concepts did not lead to the conclusion that Roche did not have possession or that the written descriptions were inadequate. Finally, the Federal Circuit rejected Sandoz’s arguments that the district court’s motivation analysis erroneously focused on the inventors’ subjective motivation rather than the claims’ objective reach and that the district court’s analysis regarding objective indicia of nonobviousness was legally erroneous.

Judge Reyna dissented, arguing that Immunex was a common owner for obviousness-type double patenting purposes because the agreement between Roche and Immunex operated as an effective assignment of the patents-in-suit to Immunex.

In re Boloro Global Ltd.

963 F.3d 1380 (Fed. Cir. 2020)

On *ex parte* appeal, the PTAB affirmed an examiner’s rejection of Boloro’s patent applications. Boloro appealed to the Federal Circuit on the grounds that the Administrative Patent Judges (“APJs”) who reviewed its applications were not constitutionally appointed, citing *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019), and *VirnetX Inc. v. Cisco Sys., Inc.*, 958 F.3d 1333 (Fed. Cir. 2020). *Arthrex* held, in an appeal of an IPR, that APJs must be appointed by the President and confirmed by the Senate. *Arthrex*, 941 F.3d at 1335. *VirnetX* clarified that that this requirement also applies to APJs’ role in reviewing appeals of *inter partes* reexaminations. *VirnetX*, 958 F.3d at 1336–37. In both cases, the Court vacated and remanded for rehearing by a new panel of APJs.

In this case, the Director of the USPTO conceded the unconstitutionality of the APJs’ appointments, but argued against extension of *Arthrex*’s vacate-and-remand remedy to the *ex parte* appeal context. In the Director’s view, his “complete control” over the *ex parte* review process obviated the need for a remand, since he “could at any time prior to the [PTAB] proceedings have directed the issuance of Boloro’s patents but did not[.]” The Court, however, sided with Boloro, finding “no principled reason to depart here from the [vacate-and-remand] remedy applied in *Arthrex* and *VirnetX*.”

In re Fought

941 F.3d 1175 (Fed. Cir. 2019)

This case concerns the '528 patent application for a multi-compartment travel trailer design, filed by David Fought and Martin Clanton. Originally, a patent examiner rejected their claims under 35 U.S.C. § 102(b), determining that the claims were anticipated by prior art. The PTAB affirmed the rejection, concluding that the preamble term “travel trailer” was a statement of intended use, rather than a claim limitation. On appeal, the appellants argued that a travel trailer is a type of recreational vehicle, and that the examiner improperly rejected their claims under 35 U.S.C. § 102(b) without addressing the level of ordinary skill in the art. The Federal Circuit reversed and remanded the PTAB’s judgment.

Reviewing de novo, the Court held that the term “travel trailer” in the preamble is a claim limitation, because it serves as antecedent basis for a term appearing in the body of a claim. The Court also found that travel trailers had distinct structural requirements which differentiated them from other types of recreational vehicles, beyond differences in intended use. Therefore, the Court found that “travel trailer” was a structural limitation, and reversed and remanded the judgement.

The Court also noted that the PTAB did not need to articulate the level of ordinary skill in the art, because the appellants did not specifically argue that the level of ordinary skill in the art would change the result of PTAB’s deliberations.

In re Google LLC

949 F.3d 1338 (Fed. Cir. 2020)

In this case, Super Interconnect Technologies, LLC brought an action for patent infringement against Google LLC in the Eastern District of Texas. Google moved to dismiss for improper venue, arguing that server hosting contracts it held with Internet service providers were inadequate to show that Google had a “regular and established place of business” in the district pursuant to the patent venue statute, 28 U.S.C. § 1400(b). The District Court denied Google’s motion, finding that the presence of Google servers hosted by Internet service providers in the district was sufficient to constitute a “regular place of business” within the meaning of the venue statute. Google then sought a writ of mandamus from the Court of Appeals for the Federal Circuit directing the district court to dismiss or transfer the case to a different venue. The two questions before the Court were (1) whether mandamus was a proper form of relief, and (2) whether Google had a “regular and established place of business” in the Eastern District of Texas.

The Court first found that mandamus was indeed a proper form of relief in this case, overruling its previous decision in *In re Google LLC*, 2018 WL 5536478 (Fed. Cir. Oct. 29, 2018), where—facing nearly identical facts—the Court denied Google’s petition for writ of mandamus. The Court found that mandamus was now proper given conflicting district court opinions on the patent venue statute and the low chance that such issues could be adequately preserved for appeal.

The Court then determined that venue was improper, finding that a “regular and established place of business” requires “the regular, physical presence of an employee or other agent of the defendant conducting the defendant’s business.” Although the rack space where the hosted services were located was a “place” within the meaning of the patent venue statute, Google did not have any employees conducting business in the district. The Court likewise found that the Internet service providers themselves were not agents of Google within the meaning of the patent statute because they merely maintained servers provided to Google as part of a one-time transaction. The Court thus remanded the case to the district court with instructions to dismiss or to transfer the case to a proper venue.

In re IPR Licensing, Inc.

942 F.3d 1363 (Fed. Cir. 2019)

The '244 patent relates to communications on cellular and local area networks. This case returned to the Federal Circuit after remand to the PTAB from a previous appeal affirming the PTAB’s finding that most of the challenged claims were obvious. The Court had remanded as to one claim (claim 8) because it found insufficient record support for the PTAB’s determination of obviousness. On remand, the PTAB again found the claim was unpatentable. The patentee appealed arguing that the only additional evidence that the PTAB relied upon was not part of the record before the PTAB. The Federal Circuit agreed, reversing the PTAB’s finding of invalidity as to that one claim.

The Federal Circuit found that under its regulations, the PTAB cannot rely on evidence relating solely to grounds on which it never instituted. The PTAB’s decision, however, referenced prior art that was not relied upon as a basis for institution, but was asserted in another non-instituted ground. The patent challenger argued that reliance on the prior art was proper because the PTAB addressed it only as evidence of what a skilled artisan would have known about certain wireless standards. The Federal Circuit rejected this argument, however, because the skilled artisan’s knowledge was a critical question for remand. Thus, the Court reversed the PTAB’s finding of invalidity as to claim 8. The Federal Circuit also found that the challenger’s failure to file a cross-appeal did not mean that the Court lacked the authority to remand as to non-instituted grounds, and turned to whether remand here was appropriate. After completion of the briefing, the patent challenger filed an unopposed motion to withdraw from the appeal pursuant to a settlement agreement, which constituted a waiver of its request to institute an IPR on the non-instituted grounds. Therefore, remand was not appropriate.

In re PersonalWeb Techs. LLC

961 F.3d 1365 (Fed. Cir. 2020)

PersonalWeb, the owner of the True Name patents, brought infringement actions against Amazon’s customers that were using Amazon’s web-based storage service, S3. The True Name patents described creating a substantially unique identifier for each data item that depended only on the content of the data itself and used a hash function to differentiate each item. Specifically, PersonalWeb alleged that S3’s use of ETags to perform conditional operations infringed the True Name patents.

On appeal, the Federal Circuit affirmed the district court’s holdings that PersonalWeb’s infringement claims were barred by claim preclusion because the prior suit was based on the use of the same product. The Federal Circuit also held that the prior with-prejudice dismissal of PersonalWeb’s action against Amazon constituted an adjudication of noninfringement and therefore protected Amazon’s S3 product from subsequent challenges. The Federal Circuit explained that the Kessler doctrine, allowing a noninfringer to avoid repeated suits, applied for several reasons. First, the with-prejudice dismissal protected the S3 product from subsequent infringement challenges directed at Amazon’s customers, rather than Amazon itself, because the limited trade right attached to the product itself. In addition, the Court held that the doctrine applies to voluntary dismissals that may not have been actually litigated.

In re Rudy

956 F.3d 1379 (Fed. Cir. 2020)

This appeal affirms a PTAB decision, which rejected as ineligible a patent application related to a method of fishing. The claimed method consisted of observing water clarity, measuring light transmittance, and then using a chart on the basis of these variables to select a colored or colorless fishing hook.

Like the PTAB, the Federal Circuit determined that the fishing method was patent-ineligible as an abstract idea. First, the claimed fishing method consisted of simply “analyzing information by steps,” which constitutes a “mental process within the abstract-idea category.” Limiting the context of the mental process to fishing did not affect this determination; the “character of the claim, as a whole, remained directed to [an] abstract idea.” The Court also rejected petitioner’s argument that the claimed method “transforms” fish by catching them. Here, the claimed method did not recite or require an attempt to catch a fish, just to select a hook. Second, the elements of the fishing method, analyzed individually or as an ordered combination, did not constitute a “patent eligible application of an abstract idea.” The patent application failed to “recite an inventive concept.” Instead, the elements of the fishing method simply applied an abstract idea to the fishing context and was therefore patent-ineligible.

Inspired Dev. Grp., LLC v. Inspired Prods. Grp., LLC

938 F.3d 1355 (Fed. Cir. 2019)

In this appeal from a district court (by way of the Eleventh Circuit, which transferred the case to the Federal Circuit), the Federal Circuit held that claims related to patent license agreements are not necessarily viable in federal court under the “slim category” of federal question subject matter jurisdiction delineated by the four-part *Gunn* test. See *Gunn v. Minton*, 568 U.S. 251, 258 (2013). In this case, the Court found that Appellant Inspired Development Group, LLC’s (“Inspired Development”) claim for unjust enrichment under Florida law did not “necessarily raise” a patent law issue.

While federal district courts have exclusive jurisdiction over patent matters like infringement or validity, even when they are embedded in state law claims, the Court held

that the existence of such issues may not necessarily be enough to create federal jurisdiction. The panel reasoned that Inspired Development could succeed on the claim by showing that it conferred a benefit on appellee “regardless of whether or not an infringing product is actually created.” For example, where the “product is possibly but not certainly infringing” the license might prevent “uncertainty and litigation.” Thus, the Federal Circuit found that “finding a federal question here merely because this contract implicates a run-of-the-mill question of infringement or validity would undoubtedly impact the wider balance between state and federal courts.”

Intellectual Ventures I LLC v. Trend Micro Inc.

944 F.3d 1380 (Fed. Cir. 2019)

The Federal Circuit vacated the district court’s finding of exceptionality and grant of attorney fees and remanded to the district court to consider under the proper legal standard whether the circumstances surrounding an expert’s changed testimony render the case exceptional under 35 U.S.C. § 285 (“Section 285”).

Intellectual Ventures I LLC (“Intellectual Ventures”) sued Trend Micro, Inc. (“Trend Micro”), Symantec Corp. (“Symantec”), and two other defendants for infringement of several patents. At trial, Intellectual Ventures’ expert changed his opinion regarding the proper construction of a claim term, materially altering its scope. After the completion of the Symantec trial, Trend Micro moved for clarification of the district court’s claim constructions in light of the expert’s changed opinion. The district court granted Trend Micro’s motion and ultimately granted Symantec and Trend Micro’s motions for judgment as a matter of law, holding the asserted claims of two of the patents invalid. The Federal Circuit affirmed, and further held the asserted claims of the remaining patent invalid as well.

Trend Micro then moved for attorneys’ fees under Section 285, requesting that the court declare the case exceptional due to the circumstances surrounding Intellectual Ventures’ expert’s changed opinion. The district court granted their motion, concluding that Intellectual Ventures’ conduct was exceptional solely with respect to the changed testimony, but not for the case overall, and further did not find their case to be objectively unreasonable. Intellectual Ventures appealed.

The Federal Circuit found that it was not clear whether the district court applied the proper legal standard when it considered whether the case was exceptional under Section 285. Instead of determining whether the case was exceptional, the district court focused on whether only one discrete portion of the case, the expert’s changed opinion, was exceptional. Under the statute, the district court should have determined whether the conduct, isolated or otherwise, is such that when considered as part of and along with the totality of circumstances, the case is exceptional—*i.e.*, the case stands out among others with respect to the substantive strength of a party’s litigating position or the unreasonable manner in which the case was litigated. The Federal Circuit rejected Intellectual Ventures’ invitation to adopt the bright-line rule that a district court may never find a case exceptional

based on a single, isolated act. Thus, the Federal Circuit vacated the district court's finding and remanded the case back to the district court to apply the proper legal standard.

Intellisoft, Ltd. v. Acer Am. Corp.

955 F.3d 927 (Fed. Cir. 2020)

This appeal arose out of Intellisoft's allegations that Acer violated two non-disclosure agreements and misappropriated Intellisoft's trade secrets in Acer's patent application. Shortly after Intellisoft filed suit, Acer sought removal under 28 U.S.C. §§ 1441 and 1454 and filed a cross-complaint seeking declaratory judgment asserting that its founder was entitled to co-inventorship of the patent in dispute. Intellisoft moved to remand for lack of federal jurisdiction. The district court denied Intellisoft's motion to remand, and ultimately granted summary judgment in favor of Acer.

On appeal, the Federal Circuit held that the claim in question did not require resolution of patent law issues, noting that Intellisoft needed to establish ownership of its trade secrets under state law, not federal law, such that removal was improper under Section 1441. Moreover, the Federal Circuit rejected Acer's alternative argument that it had pleaded a patent inventorship counterclaim and thus invoked Section 1454 because Acer was required to obtain but had not been granted leave to amend to allege the counterclaim, so the counterclaim was not contained in an operative pleading. The Court vacated and reversed the district court's order denying Intellisoft's motion to remand for lack of jurisdiction.

Intra-Cellular Therapies, Inc. v. Iancu

938 F.3d 1371 (Fed. Cir. 2019)

This appeal concerned whether an applicant's improper first response to a final Office Action constitutes applicant-caused delay for the purpose of calculating patent term adjustment ("PTA").

Appellant Intra-Cellular Therapies, Inc. ("Intra-Cellular") had filed a timely initial response to the Patent Office's final Office Action rejecting some of Intra-Cellular's claims and objecting to others. However, that initial response continued to argue the merits of the examiner's final rejections and thus failed to comply with the Patent Office's regulatory requirements for what constitutes a proper reply to a final Office Action. Accordingly, the Patent Office determined that the initial response did not prevent accrual of applicant delay for the length of time that elapsed before Intra-Cellular filed its second response.

The Federal Circuit employed the *Chevron* framework to determine whether Intra-Cellular's initial response constituted "a 'fail[ure] to engage in reasonable efforts to conclude prosecution'" under the PTA statute. At the first step of the *Chevron* framework, the panel concluded that "the language of the PTA statute does not answer the question" of what constitutes "reasonable efforts to conclude prosecution" in this context. At the second step of the *Chevron* framework, the panel found that the Patent Office's determination—*i.e.*, that Intra-Cellular's non-compliant first response was not a reasonable

effort to conclude prosecution—constituted a “permissible reading of the PTA statute.” Under the regulatory standards, Intra-Cellular’s initial response did not constitute a proper reply because “prosecution was closed and the examiner . . . was under no obligation to reconsider arguments that had already been rejected in the final Office Action.”

Iridescent Networks, Inc. v. AT&T Mobility, LLC

933 F.3d 1345 (Fed. Cir. 2019)

Iridescent Networks, Inc. appealed this patent case from the United States District Court for the Eastern District of Texas on the ground that the district court erred in its construction of the term “high quality of service connection.” The Federal Circuit affirmed, holding that the district court properly construed the term in light of the specification and the prosecution history. The Court agreed that “high quality of service connection” is a term of degree that is limited to the minimum connection parameters as disclosed in the specification, which was also relied upon during prosecution to overcome an examiner rejection.

Kaken Pharm. Co., Ltd. v. Iancu

952 F.3d 1346 (Fed. Cir. 2020)

In an appeal from an IPR proceeding, the Federal Circuit reversed the PTAB’s claim construction, vacated the PTAB’s decision that all claims of a patent were invalid as obvious, and remanded the matter to the PTAB. The PTAB had construed the term “treating onychomycosis” as including treating “superficial mycosis that involves disease of the skin or visible mucosa.” The Federal Circuit found this to be unreasonable, instead limiting the construction to “penetrating the nail plate to treat an infection inside the nail plate or in the nail bed under it,” based on the specification and prosecution history. The PTAB’s erroneous claim construction affected its obviousness determination, particularly regarding any motivation to combine certain prior art references, so the Federal Circuit remanded the matter for the PTAB to reconsider given the new claim construction.

Koninklijke KPN N.V. v. Gemalto M2M GmbH

942 F.3d 1143 (Fed. Cir. 2019)

Koninklijke KPN N.V. (“KPN”) brought an infringement suit against Gemalto M2M GmbH, Gemalto IOT, TCL Communication Technology Holdings, TCT Mobile, and Telit Wireless Solutions (collectively “Appellees”) for infringement of the ’662 patent in the District of Delaware. The ’662 patent was directed to a device for improved error checking in data transmission systems, which varies the way check data is generated by varying the permutation applied to different data blocks. The district court granted Appellees’ motion for summary judgment on the grounds that all four claims of the ’662 patent were ineligible under Section 101 as being directed to an abstract idea. On appeal, KPN only challenges the district court’s ineligibility decision with respect to dependent claims 2–4.

The Federal Circuit reversed the district court, finding that the claims were patent-eligible. The appealed claims were found to represent a non-abstract improvement in the

functionality of an existing technological process and not simply an abstract idea of manipulating data. The court found that “error checking in data transmission” constituted non-abstract improvements to existing technological processes and computer technologies, and that the requirement that the permutation applied to the original data be modified “in time” recites a specific implementation. Notably, the court rejected Appellees’ argument that this improvement is not adequately captured in the claims, as the claims do logically specify the requirement that original data be varied by permutation before being supplied as varied data. The court also rejected Appellees’ argument that the specification fails to mention the benefit of using permutations to generate check data, as the specification *as a whole* adequately does so. Additionally, the court distinguished from other software patents that merely recited “standard” methods and thus taught ineligible abstract process—while the ’662 patent also processes data, the claims specifically recite how this permutation is used and capture the specific asserted improvement in detecting systematic errors.

Koninklijke Philips N.V. v. Google LLC

948 F.3d 1330 (Fed. Cir. 2020)

In this appeal from the PTAB, the Federal Circuit affirmed the PTAB’s finding of obviousness for the ’806 patent.

Koninklijke Philips N.V. (“Philips”) owns the ’806 patent, which describes a method of creating a media presentation using a control file that “offers the media presentation in multiple alternative formats” and “provides the media presentation in multiple files so the media player can download the next file concurrently with playback of the previous file.” Google petitioned for IPR of the ’806 patent on anticipation and obviousness. The PTAB found the patent obvious in light of the prior art. Philips appealed.

The Board considered two prior art references, “SMIL 1.0” and “Hua.” SMIL 1.0 describes a computer language where a designer creates a file that specifies the relationship among media files that make up a media presentation. SMIL 1.0 has an element that can specify which file a media player should choose, out of a set of alternatives, and another element that instructs the media player to play a list of files in sequence. Hua reviews “pipelining,” a conventional scheme for dividing a media presentation into multiple segments and to play one segment while another is downloading.

On appeal, the Federal Circuit held that the PTAB erred in instituting review based on a combination of prior art references that Google did not advance in its petition, as the petition defines the bounds of an IPR. The Court, however, held that the PTAB did not err in relying on the general knowledge of a skilled artisan to supply a missing claim limitation in determining obviousness. Here, a skilled artisan would have known about pipelining and been motivated to combine it with SMIL 1.0. The Court also found that the PTAB properly relied on substantial evidence and expert evidence in its factual findings, and affirmed that the ’806 patent is unpatentable as obvious.

Lanard Toys Ltd. v. Dolgencorp LLC
958 F.3d 1337 (Fed. Cir. 2020)

This case involves a dispute over a toy chalk holder designed to look like a pencil. In 2014, Lanard sued Dolgencorp LLC, Ja-Ru, Inc., and Toys “R” Us—Delaware, Inc. (collectively, “Appellees”) for design patent infringement, copyright infringement, trade dress infringement, and statutory and common law unfair competition. On cross-motions for summary judgment the district court entered judgment in favor of Appellees on all claims. On appeal, the Federal Circuit affirmed the district court’s grant of summary judgment.

With respect to Lanard’s design patent infringement claim, the Court determined that the district court properly applied the two-step test for design patent infringement from *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995), because it first construed the claim and then applied the “ordinary observer” test to compare the correctly construed claim to the accused design. The Court found that the district court “struck the correct balance of considering the ornamental aspects of the design while remaining focused on how an ordinary observer would view the overall design” in its infringement analysis.

The Court also affirmed the district court’s ruling “that Lanard does not own a valid copyright,” because “Lanard’s ’458 copyright for a ‘Pencil/Chalk Holder’ has an intrinsic utilitarian function” and lacks sufficient separable features that are capable of existing as a work of art. In reaching this holding, the Court rejected Lanard’s argument that the design could be a sculptural work separate from its functional purpose, citing *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017), for the proposition that separable features cannot themselves be useful articles. Next, in response to Lanard’s trade dress infringement claim, the Court agreed with the district court that Lanard had failed to prove “that the Lanard Chalk Pencil has acquired secondary meaning,” because Lanard had failed to provide sufficient evidence that “when customers see the Lanard Chalk Pencil, their minds jump to the producer of the product rather than the product itself.” Finally, with respect to Lanard’s unfair competition claims, the Court held that these claims failed because they were dependent on Lanard’s other infringement claims, which had all failed.

Liqwd, Inc. v. L’Oreal USA, Inc.
941 F.3d 1133 (Fed. Cir. 2019)

This appeal arose following a PTAB ruling that certain claims in Liqwd’s ’419 patent were unpatentable as obvious. Liqwd owned the ’419 patent for a keratin treatment made with maleic acid, which bleached and strengthened hair. L’Oreal filed with the PTAB for post-grant review of the ’419 patent, and the PTAB found that claims 1–8 and 10 were obvious in view of prior art. The PTAB also found that L’Oreal had access to confidential patent information from Liqwd, and said access enabled L’Oreal to develop a similar maleic acid product. However, the PTAB concluded that because Liqwd did not show L’Oreal had copied one of Liqwd’s specific products, the factual finding was irrelevant. Liqwd appealed, and the Federal Circuit vacated and remanded the PTAB’s judgment.

The Court stated that copying by a competitor is part of the objective indicia analysis showing that a patented invention is nonobvious. The Court then explained that previous opinions which defined copying as replication of a specific product had done so to protect the distinction between infringement and copying claims. The Court clarified that these rulings indicated that something greater than mere similarity between a product and a patent is required to demonstrate copying. In this case, the fact that L’Oreal had used non-public information from the issued patent to develop their product was itself evidence of competitor copying instead of mere similarities, and the PTAB ignoring such evidence was error. As a result, the PTAB’s determination was vacated, and the matter was remanded for further analysis on obviousness.

Mayborn Grp., Ltd. v. Int’l Trade Comm’n
965 F.3d 1350 (Fed. Cir. 2020)

Mighty Mug, Inc. manufactures and sells “self-anchoring beverage containers”—coffee mugs that resist tipping over when bumped. In 2017, Mighty Mug, its affiliate Alfay Designs, Inc., and Alfay’s licensor Harry Zimmerman (“the Complainants”) petitioned the ITC for a general exclusion order (“GEO”) barring importation of products that infringed Zimmerman’s patent (“the ’850 patent”). In 2018, the ITC issued the GEO. In 2019, the Complainants notified Mayborn—who had not been a named respondent in the 2018 enforcement action—that its products infringed Zimmerman’s patent and violated the GEO. Mayborn petitioned the ITC to rescind the GEO, invoking 19 U.S.C. § 1337(k)(1), which allows rescission of a GEO when “the conditions which led to [the order] no longer exist.” The defunct underlying condition, Mayborn argued, was the validity of the ’850 patent. The ITC responded that an allegation of invalidity did not qualify as a changed condition under Section 1337(k)(1), and denied Mayborn’s petition. Mayborn appealed.

On appeal, the ITC argued that Mayborn lacked standing, because its injuries were not traceable to the ITC, which had not actually enforced the GEO against Mayborn. The Court disagreed; since the GEO posed “a real threat to [Mayborn’s] business” and had already harmed its sales, reputation, market share, and brand—and since the ITC had issued the GEO, and had the power to “enforce, modify, or rescind it”—Mayborn’s injuries were fairly traceable to the ITC.

On the merits, the Court upheld the ITC’s denial of Mayborn’s petition for rescission, for “two independent reasons.” First, the ITC lacked authority to adjudicate patent validity unless raised as a defense to an enforcement proceeding. 19 U.S.C. § 1337(c). No such proceeding had taken place here. Second, the Court agreed with the ITC that Mayborn’s invalidity *challenge*—unlike an actual *finding* of invalidity—is “not, on its face, a changed condition . . . and is thus not a proper basis for a petition to rescind” a GEO. *See* 19 C.F.R. § 210.76(a)(1) (interpreting Section 1337(k)(1) to allow rescission of a GEO when “changed conditions of fact or law, or the public interest” so require). Mayborn invoked the “public interest” in “resolving questions of patent validity”; but the Court replied that the “public interest” factors listed in Section 1337(d)(1) were not implicated, and in any event could not operate to expand the ITC’s statutory authority. Ultimately, the Court concluded, “the legal status of the ’850 patent is unaffected by Mayborn’s wish to present

an invalidity challenge”; accordingly, the ITC’s decision not to rescind the GEO was affirmed in full.

Mayo Found. for Med. Educ. & Research v. Iancu
938 F.3d 1343 (Fed. Cir. 2019)

As a matter of statutory interpretation, the Court considered whether a period of examination conducted after the termination of an interference and ending with the mailing of a notice of allowance is eligible for term adjustment under the “B Delay” provision of the American Inventors Protection Act of 1999, codified at 35 U.S.C. § 154(b)(1)(B).

During prosecution, the applicant filed an RCE and the PTO declared an interference. After the interference concluded, the PTO returned the application to the examiner, who examined the application for 194 days. The question on appeal was whether the applicant (now patentee) is entitled to PTA for those 194 days as “B Delay.” The Court held that this period does not constitute “B Delay” because it falls under the “RCE time” exception, which relates to Requests for Continued Examination (“RCE”) filed by the applicant. 35 U.S.C. § 154(b)(1)(B)(i). Although the post-interference examination was initiated *sua sponte* by the examiner here (and thus not “requested” by the applicant), the Federal Circuit held that the term ‘requested’ in the statute has “little more than clerical significance on a fair reading of the statute.” In particular, “[c]ontinued examination, like regular examination, is not limited to the issues the applicant would like to see resolved.” More broadly, “continued examination . . . simply entitles an applicant to continue examination[,]” which involves the possibility that the examiner might “issue a new ground of rejection, as was the case here.” And unlike the time between the issuance of a Notice of Allowance and issuance of the patent, which the Court previously held to be plainly attributable to the PTO and therefore not included in the “RCE time” exception for B Delay, the length of time the PTO spent examining the application between the termination of the interference and the issuance of the Notice of Allowance was attributable to the applicant’s RCE filing.

Judge Newman issued a dissenting opinion, arguing that the post-interference examination, which was instituted “at the initiative of the examiner[,]” should be eligible for PTA because it “plainly is examination delay due to PTO procedures” rather than “part of the ‘continued examination of the application requested by the applicant.’”

McRO, Inc. v. Bandai Namco Games Am. Inc.
959 F.3d 1091 (Fed. Cir. 2020)

The Federal Circuit affirmed the judgment of noninfringement, vacated the judgement of invalidity, and remanded the case to the district court to consider further proceedings.

McRO filed suit in the Central District of California against several video game developers, alleging that the Developers violated a facial animation patent owned by McRO through their use of third-party, face-modeling software applications, FaceFX and Annosoft. In a prior appeal the Federal Circuit reversed the district court’s finding that the asserted claims

were ineligible under Section 101. On remand, the district court granted the Developers' motion for summary judgment of invalidity on enablement grounds before later issuing a final judgment of noninfringement and invalidity.

The Federal Circuit affirmed the district court's noninfringement decision but reversed its invalidity decision. The Court agreed that the California district court had adopted the proper claim construction and that, under that construction, there was no infringement because the Developers' software didn't include the same "three-dimensional vectors" that were used in McRO's patented face-modeling technology. The Federal Circuit disagreed with and vacated the district court's enablement-based decision to grant the Developers' motion for summary judgment. The Court explained that the Developers had failed to identify any animation methods or techniques that fell within the scope of the patent. The Court reasoned that without specific examples of such techniques, the district court's reasoning in finding that component of the invention not enabled was conclusory. The Federal Circuit then remanded the invalidity issue back to the Central District of California for further consideration.

Molon Motor and Coil Corp. v. Nidec Motor Corp.
946 F.3d 1354 (Fed. Cir. 2020)

In this appeal from the Northern District of Illinois, the Federal Circuit affirmed the district court's finding that Molon Motor and Coil Corporation ("Molon") was barred from enforcing its '915 patent due to a prior covenant not to sue.

In 2006, during a prior infringement suit between Molon and Nidec Motor Corporation's ("Nidec") predecessor, Merkle-Korff, Molon unilaterally covenanted not to sue Merkle-Korff for infringement of Molon's patents, including the patent at issue. Later, in 2007, Molon and Merkle-Korff settled the case and Molon granted Merkle-Korff an exclusive license for Molon's patents within a narrowly defined market. The settlement agreement contained a merger clause, which stated that all prior "covenants concerning the subject matter hereof, are merged herein and shall be of no further force or effect." Merkle-Korff later merged with Nidec.

In this suit, Molon sued Nidec for practicing and inducing others to practice the '915 patent outside of the licensed market. The district court granted partial summary judgment and found that, because the covenant not to sue and settlement agreement did not cover the same subject matter, the merger clause of the settlement agreement did not render the covenant ineffective.

The Federal Circuit affirmed. In applying Illinois contract law, the Court determined that the covenant not to sue and the license agreement did not concern the same "subject matter" for the purposes of the merger clause. Thus, the merger clause did not render the covenant ineffective. The Court noted that while a covenant not to sue is equivalent to a nonexclusive license that provides "freedom from suit," an exclusive license gives an interest, "akin to an ownership interest," in the patent. The Court also pointed to other substantive differences between the covenant and the settlement agreement, such as the

fact that the covenant only applied to two patents and that it was limited to products existing at the time of its execution, while the agreement extended to other patents and future products. The Federal Circuit also found, more generally, that the merger clause did not indicate that the parties intended to revoke Molon’s covenant because the agreements contained different subject matter and terms.

Judge Reyna dissented, arguing that the prior covenant and settlement agreement addressed sufficiently related subject matter—the right to practice the ’915 patent.

MTD Prod. Inc. v. Iancu

933 F.3d 1336 (Fed. Cir. 2019)

The Federal Circuit vacated and remanded the PTAB’s determination that the challenged claims related to MTD’s ’458 patent would have been obvious, which was predicated on an incorrect claim construction of a means-plus-function term.

The ’458 patent is directed to a steering driving system for zero turn radius vehicles. The challenged claims recite the term “mechanical control assembly,” which MTD argued was a means-plus-function term, and the asserted prior art did not disclose the claim term’s corresponding structure. The Board agreed that “mechanical control assembly” was similar to other terms subject to Section 112, ¶ 6, but that the ’458 patent’s specification referred to it as a “ZTR control assembly,” which weighed against application of Section 112, ¶ 6. Additionally, the Board determined that statements made during prosecution presented strong evidence that the disputed phrase should be understood as a structural limitation rather than a means-plus-function limitation under Section 112, ¶ 6. The PTAB therefore concluded that the phrase “mechanical control assembly” is a structural limitation rather than a means-plus function term governed by Section 112, ¶ 6.

On appeal, the Federal Circuit vacated and remanded. The Court first noted that the PTAB was correct in determining that “mechanical control assembly” is similar to other generic means-plus-function terms and that there was no established meaning in the art. The Court concluded that the PTAB erred, however, when it relied on the specification’s description of a “ZTR control assembly” to conclude that the term had an established structural meaning. The Court noted, “[w]hile we agree with the Board that the specification plays a role in assessing whether particular claim language invokes [Section 112 paragraph 6], we do not agree that the patent specification at issue here renders the nonce term ‘mechanical control assembly’ sufficiently structural to a person of ordinary skill in the art.” The Court also concluded that the PTAB erred in its interpretation of the prosecution history. The Court determined that MTD’s statements during prosecution did not clearly disclaim interpreting the term as a means-plus-function term. Given that there was no clear and undisputed statement foreclosing the application of Section 112, ¶ 6, the Court held that the PTAB erred in giving dispositive weight to the equivocal statements in the prosecution history.

Munchkin, Inc. v. Luv n' Care, Ltd.

960 F.3d 1373 (Fed. Cir. 2020)

In this appeal, the Federal Circuit found that this case was not exceptional, reversing the district court's decision granting Luv n' Care's ("LNC") motion for attorneys' fees. Munchkin brought an infringement action against LNC, alleging unfair competition claims and infringement of its patents, logos, and trade dress for its spillproof drinking containers. LNC moved for attorneys' fees after Munchkin voluntarily dismissed all of its claims. Munchkin voluntarily dismissed all of its non-patent claims with prejudice. Munchkin also dismissed its patent infringement claims after the Federal Circuit affirmed the PTAB's decision that its '993 patent was unpatentable. The U.S. District Court for the Central District of California granted the motion for attorneys' fees, finding the case to be exceptional because Munchkin's claims were substantively weak.

The Federal Circuit held that the district court abused its discretion because there was insufficient evidence supporting that Munchkin's claims were so substantively meritless to render the case exceptional. The district court's determination that Munchkin's patent infringement claim was exceptional was wholly unsupported. The Federal Circuit explained that Munchkin's validity position was not unreasonable based on the fact that the district court initially denied LNC's claim construction in its *Markman* order. The district court's failure to address the facts underlying Munchkin's validity position was problematic because Munchkin's validity defense was tied to its claim construction argument—an argument that the district court itself had accepted in its *Markman* order. In addition, the Court found that LNC's argument that the trademark and trade dress claims were exceptional was defeated by the district court's earlier order granting Munchkin's motion to amend its complaint to include the claims.

Myco Indus., Inc. v. BlephEx, LLC

955 F.3d 1 (Fed. Cir. 2020)

This appeal arose from Myco's allegations that BlephEx made misleading accusations and threats of litigation to Myco's potential customers and partners, some of whom were medical practitioners. Accordingly, Myco filed suit seeking declaratory judgment of noninfringement and moved for preliminary injunction barring BlephEx from making allegations that Myco's product infringes BlephEx's patent. The Eastern District of Michigan granted Myco's motion for a preliminary injunction.

On appeal, the Federal Circuit held that the district court improperly granted a preliminary injunction barring BlephEx from making allegations of patent infringement without a finding of bad faith, and thus failing to provide an adequate basis to conclude that the allegations were false or misleading. The Court vacated and remanded the district court's decision, noting that communication to possible infringers concerning patent rights is not improper if the patent holder has a good faith belief in the accuracy of the communication.

Next, as related to the scope of the district court's injunction, the Court concluded that 35 U.S.C. § 287(c) merely immunizes medical practitioners performance of a medical

activity from a remedy, but does not render them non-infringers as the district court had improperly concluded.

Lastly, the Court held the district court had erred in its claim construction analysis in connection with analyzing the likelihood of success on the merits of infringement. Specifically, the district court improperly read into the claims an element discussed in the specification and present in certain dependent claims, thus violating the doctrine of claim differentiation, and conflated the patentee's commercial embodiment with the claims of the patent at issue.

MyMail, Ltd. v. ooVoo, LLC

934 F.3d 1373 (Fed. Cir. 2019)

In this case, the Federal Circuit vacated and remanded a decision by the district court, holding that the district court erred in failing to address an issue of claim construction before granting a motion to dismiss for lack of subject matter eligibility.

ooVoo and IAC Search & Media had filed motions for judgment on the pleadings, asserting that the MyMail patents were directed to patent-ineligible subject matter under Section 101. MyMail opposed both motions based on construction of the term "toolbar" and encouraged the district court to adopt the construction in *MyMail, Ltd. v. Yahoo! Inc.*, No. 2:16-cv-01000 (E.D. Tex. 2017). The district court did not construe the term "toolbar" before granting the motions for judgment on the pleadings and holding that the patents were ineligible under Section 101. MyMail appealed.

The majority vacated and remanded. The Court explained that, if parties raise a claim construction dispute at the Rule 12(c) stage, the district court must resolve the dispute. Not doing so is error under *Aatrix Software, Inc. v. Green Shades Software*, 882 F.3d 1121 (Fed. Cir. 2018). The Court declined to construe "toolbar" in the first instance on appeal. The Court also determined that there were factual issues in dispute regarding whether the claim elements are "well-understood, routine, and conventional" and it was improper for the Court to determine these factual issues in the first instance on appeal. The majority thus vacated and remanded.

Judge Lourie dissented because he believed that the claims at issue were clearly abstract regardless of claim construction. Additionally, there was no factual dispute on conventionality because MyMail explained that the "pinger process" worked in a conventional manner and is also an abstract idea.

Nalpropion Pharms., Inc. v. Actavis Labs. FL, Inc.

934 F.3d 1344 (Fed. Cir. 2019)

In this case, the Federal Circuit affirmed in part and reversed in part a decision by the district court. According to the Federal Circuit, the district court did not err in determining that claim 11 of the '195 patent was not invalid for lack of a written description, but did err in determining that certain claims would have been obvious.

Nalpropion had asserted three patents directed to weight management against Actavis after the company filed an Abbreviated New Drug Application for a generic version of its drug. The district court found that there was adequate written description support for claim 11 of the '195 patent even though the claimed dissolution profile was achieved using a different method than the method disclosed in the specification. The district court also determined that the challenged claims would not have been obvious finding this to be a classic case of hindsight bias.

On appeal, the Federal Circuit affirmed the district court's finding that there was adequate written description for claim 11 of the '195 patent and that inventors had possession of the invention. The Court reasoned that the claimed dissolution data only relates to the measurement of the resultant parameters and not to the operative steps of treating overweightedness or obesity. Thus, the Federal Circuit determined that the district court did not err in finding that regardless of the method of measurement used (whether it was the one claimed or the one from the specification), the specification showed that the inventors possessed the invention of treating overweightedness or obesity with naltrexone and bupropion.

The Federal Circuit reversed the district court's determination that certain challenged claims would not have been obvious to a person of ordinary skill in the art. The Court determined that the combination of prior art references taught the challenged claims and a person of ordinary skill in the art would have been motivated to combine them. The Court rejected Nalpropion's argument that the combination exhibited unexpected results. The Court determined that the clear record in this case showed that the combination of two known drugs for a known purpose yielded no unpredictable results.

Chief Judge Prost dissented on the written description issue because she reasoned that the measurement of dissolution data was a limiting clause, and the claim requires that the recited dissolution profile be measured by the claimed method and not generally measured by any method. Because the patent failed to disclose the claimed method, the written description requirement was not met.

Nevro Corp. v. Bos. Scientific Corp.
955 F.3d 35 (Fed. Cir. 1899)

The Federal Circuit vacated and remanded the Northern District Court of California's holding that certain claim limitations are indefinite, affirmed that other claim limitations are not indefinite, vacated the district court's claim constructions, and remanded for further consideration in light of the Court's identified claim constructions.

At the district court, Nevro sued Boston Scientific alleging infringement of eighteen claims across seven patents. The asserted patents are directed to high-frequency spinal cord stimulation therapy to reduce chronic pain while using waveforms with high frequencies to reduce or eliminate side effects. The district court analyzed four claim terms present in various claims and found three of the four indefinite.

The Federal Circuit vacated the district court’s findings of indefiniteness as to three of the terms and affirmed the district court’s conclusion of definiteness as to the final term while altering the district court’s construction. In analyzing the limitations, the Court reiterated the *Nautilus* standard that the test for indefiniteness is “simply whether a claim ‘inform[s] those skilled in the art about the scope of the invention with reasonable certainty.’”

The Court’s discussion of the terms reiterates system or device claims may use functional language. The Court also rejected the defendant’s argument that it is an indefiniteness problem if infringement can only be determined after using a device or performing a method; the Court explained that definiteness “does not require that a potential infringer be able to determine *ex ante* if a particular act infringes the claims.” The Federal Circuit further reiterated that a claim term is not indefinite merely because it can be susceptible to differing interpretations; instead, the *Nautilus* standard governs. The Court finally explained that a term is not indefinite merely because the claimed signal might not provide pain relief in all circumstances; a signal might provide a therapeutic result in one patient and no therapeutic result in a different patient without being rendered indefinite.

After providing proper constructions for each term addressed on appeal, the Court remanded to the district court for further proceedings.

Nike, Inc. v. Adidas AG

955 F.3d 45 (Fed. Cir. 2020)

The Federal Circuit held that the PTAB violated the notice provisions of the Administrative Procedure Act (“APA”) by raising *sua sponte* patentability challenges to Nike’s amended claims but not providing Nike with the opportunity to respond. The PTAB found Nike’s amended claims obvious in light of a prior art reference that was in the record but which was not relied on by Adidas. The Federal Circuit noted that under the APA, “persons entitled to notice of an agency hearing shall be timely informed of . . . the matters of fact and law asserted,” and the agency “shall give all interested parties opportunity for . . . the submission and consideration of facts and arguments.” 5 U.S.C. §554. It held that the PTAB violated this provision by failing to provide Nike with notice of its intent to base its decision on an argument not made by the parties, and provide an opportunity to respond. The Federal Circuit held that the PTAB is permitted to raise new grounds of unpatentability to substitute claims, but only so long as the prior art is recorded and the parties are provided with fair notice and an opportunity to respond before the PTAB issues a final decision.

O.F. Mossberg & Sons, Inc. v. Timney Triggers, LLC

955 F.3d 990 (Fed. Cir. 2020)

The Federal Circuit affirmed the District of Connecticut’s denial of an attorneys’ fee award following the voluntary dismissal of an infringement action. O.F. Mossberg & Sons (“Mossberg”) sued Timney Triggers (“Timney”) for patent infringement. In response, Timney pursued invalidation of the patent through post-grant proceedings before the PTAB. During this time, the district court proceedings were stayed. Timney ultimately prevailed, and the PTAB invalidated Mossberg’s patent for obviousness. Mossberg then

voluntarily dismissed its action, and Timney moved for attorneys' fees. The district court denied Timney's motion, finding that Timney was not a "prevailing party" because no court rendered a "decision with the necessary judicial *imprimatur*."

The Federal Circuit affirmed, holding that there had been no final decision on the action as required to grant fees under Section 285. Timney argued that the district court's five-year stay during the PTO's post-grant review proceedings and Timney's ultimate success in those proceedings provided the requisite judicial *imprimatur* to grant fees. The Court rejected those arguments, holding that although a decision on the merits is not required to "prevail," a final court decision on some grounds—even procedural grounds—is a prerequisite to fee recovery under Section 285. Here, the court proceedings "did not change the legal relationship between the parties; the Board's invalidity decisions and Mossberg's voluntary . . . dismissal did." Thus, the district court did not render a final decision, and Timney could not recover attorney's fees under Section 285.

Odyssey Logistics & Tech. Corp. v. Iancu

959 F.3d 1104 (Fed. Cir. 2020)

In an appeal from the Eastern District of Virginia, the Federal Circuit affirmed the district court's dismissal of all three of the appellant's claims. The Federal Circuit ruled that it lacked subject matter jurisdiction for the appellant's two patent rejection claims and that the appellant's third claim challenging the legality of the PTO's 2011 amendments to its rules of practice in *ex parte* appeals was time-barred.

Patent applicant, Odyssey Logistics, filed a lawsuit under the Administrative Procedure Act in the Eastern District of Virginia to challenge procedural actions taken by the PTO during the prosecution of two patents. The examiner rejected Odyssey's first patent application, but the PTAB later reversed that rejection on appeal. Arguing that the PTAB had wrongly analyzed prior art, and requesting clarification as to which claims the PTAB was reversing, the examiner requested a rehearing. Before the PTAB issued a decision on the rehearing request, Odyssey challenged the request as improper in the Eastern District of Virginia. After Odyssey's second application was rejected, it petitioned the examiner to make certain evidence part of the written record. Believing that the examiner's response included new grounds of rejection, Odyssey then petitioned the PTO to designate the examiner's response as such. The PTO dismissed the petition and, rather than respond to the examiner and wait, Odyssey challenged the dismissal in the Virginia federal court. Odyssey also challenged the legality of the PTO's 2011 amendments to its rules of practice in *ex parte* appeals.

The Federal Circuit affirmed the district court's dismissal of all three claims. The court dismissed the first two claims because the actions challenged were not "final agency actions." Accordingly, the court held that it lacked jurisdiction under the APA. As to Odyssey's third claim, the court held that the challenge was time-barred by a six-year statute of limitations.

OSI Pharms., LLC v. Apotex Inc.

939 F.3d 1375 (Fed. Cir. 2019)

In this appeal involving a treatment for non-small cell lung cancer (“NSCLC”), the Federal Circuit reversed the PTAB’s finding of obviousness, in favor of the patent owner, OSI Pharmaceuticals (“OSI”). OSI patented a compound known as erlotinib, which was determined to be an effective targeted therapy for NSCLC and had gained FDA approval. The PTAB determined that three of the ’221 patent claims would have been obvious over prior art. Specifically, the “Board found that the asserted combinations of Schnur with Gibbs and Schnur with OSI’s 10-K each would have provided a person of ordinary skill with a reasonable expectation of success in using erlotinib to treat NSCLC in a mammal.”

OSI challenged the PTAB’s determination on two grounds. First, OSI argued that the PTAB’s finding of a reasonable expectation of success is not supported by substantial evidence. Second, OSI raised a challenge to the constitutionality of IPR.

The Federal Circuit agreed with OSI that the PTAB’s finding that the asserted references provide a reasonable expectation of success is not supported by substantial evidence. The Federal Circuit found that the asserted references do not disclose *any* data or other information about erlotinib’s efficacy in treating NSCLC, either clinical (human) data or preclinical (animal data), and that it is undisputed NSCLC treatment was highly unpredictable with an over 99.5% rate of failure for drugs entering Phase II clinical studies. The Federal Circuit found that, because of this, the prior art references provide “no more than hope” of success. This mere hope, the Court noted, is not enough in a “highly unpredictable art such as this.” The Federal Circuit clarified that its ruling was on these particular facts and that “we do not hold that efficacy data is always required for a reasonable expectation of success. Nor are we requiring ‘absolute predictability of success.’” With respect to OSI’s constitutional challenge, the Federal Circuit noted that it had issued multiple decisions holding that the application of IPR to pre-America Invents Act patents does not violate the Constitution following oral argument in this case.

Packet Intelligence LLC v. NetScout Sys., Inc.

965 F.3d 1299 (Fed. Cir. 2020)

Packet Intelligence asserted six claims against NetScout products; a jury in the Eastern District of Texas “found all claims willfully infringed, rejected NetScout’s invalidity defenses, and awarded pre-suit and post-suit damages.” On appeal, the Federal Circuit upheld each element of the verdict except the pre-suit damages.

The Court held that substantial evidence supported the jury’s findings that the patents were willfully infringed and not invalid for failure to list the inventors who devised a particular feature. The Court also rejected NetScout’s argument that it was improper for the district court to have considered the claims’ *specifications* in its patent-eligibility analysis. Applying step one of the two-step analysis from *Alice*, the district court had found that Packet Intelligence’s claims, read alongside their specifications, were not “directed to an abstract idea,” and were thus not patent-ineligible. The district court then proceeded

(unnecessarily) to step two, rejecting NetScout’s attempt to paint Packet Intelligence’s claims as insufficiently inventive. On appeal, the Federal Circuit upheld the district court’s patent-eligibility analysis, explaining that *Alice* step one “consider[s] the claim as a whole . . . in light of the specification.” Because the Court found the disputed claim was not “directed to an abstract idea,” it did not reach step two of the *Alice* analysis. Accordingly, *Two-Way Media Ltd. v. Comcast Cable Communications, LLC*, 874 F.3d 1329 (Fed. Cir. 2017)—which held that at *Alice* step two, “the claim, not the specification, must include an inventive concept”—did not apply. (Even if it did, the Court added, its finding at step one was supportable without considering the specification.)

At trial, NetScout challenged the claim for pre-suit damages with an improper marking defense, which the jury rejected. Between the jury verdict and the appeal in this case, the Federal Circuit decided *Arctic Cat Inc. v. Bombardier Recreational Products, Inc.*, 876 F.3d 1350, 1368 (Fed. Cir. 2017), which held that once the alleged infringer identifies the products it claims are improperly marked, the *patentee* must prove that those products do not practice the disputed patent. *Arctic Cat*, 876 F.3d at 1368. Because Packet Intelligence had failed to carry this burden, NetScout successfully appealed for judgment as a matter of law on the issue of pre-suit damages. The Court rejected Packet Intelligence’s attempt to “circumvent” the marking defense by arguing that “NetScout’s infringement of related method claims” boosted its *sales* of infringing products. Under this approach, the Court held, the damages award was “not tailored to any alleged *internal use* of the claimed methods” (emphasis added).

Judge Reyna dissented in part, concluding at step one of the *Alice* analysis that Packet Intelligence’s claims *were* directed to an abstract idea, and that the district court’s flawed step-two analysis should be redone. Judge Reyna found it “anomalous” that the Court would “not [be] permitted to look to unclaimed details at *Alice* Step 2 . . . but could use the same details as the ‘focus’ of the claim at *Alice* Step 1 to avoid reaching Step 2.”

Persion Pharms. LLC v. Alvogen Malta Operations Ltd.
945 F.3d 1184 (Fed. Cir. 2019)

In this appeal from the District of Delaware, the Federal Circuit affirmed the district court’s obviousness determination for the asserted claims of the ’760 and ’499 patents. After a bench trial, the district court concluded that the asserted claims were invalid for obviousness and an inadequate written description.

The ’760 and ’499 patents claim “methods of treating pain in patients with mild or moderate hepatic impairment using extended-release hydrocodone-only formulations,” including Zohydro ER, Persion’s extended-release hydrocodone-only drug product, and any extended-release formula with “hydrocodone bitartrate as the only active ingredient.”

Persion challenged the district court’s obviousness finding on four grounds. First, on inherency, the Federal Circuit held that the district court did not err in determining that the “the claimed pharmacokinetic limitations of the asserted claims added no patentable weight over the combination of [the prior art].” The Court reasoned that the prior art “taught the

combination of elements that inherently result[ed] in the claimed pharmacokinetic parameters” and that a POSITA would have been “motivated, with reasonable expectation of success” to combine the prior art.

Second, the Federal Circuit found that the district court did not clearly err in any of its factual findings. The FDA found safety data for Vicoprofen, an intermediate-release combination drug with hydrocodone and ibuprofen, insufficient in determining the safety and efficacy of Zohydro ER. The district court, however, relied on the FDA’s acceptance of the Vicoprofen data to determine that the data would have been relevant to a POSITA in evaluating the prior art. The Federal Circuit found that this reliance was not clear error and that “the FDA’s approval requirements do not undermine the force of the evidence as to obviousness.”

Third, the Federal Circuit found no clear error with the district court’s assessment of objective indicia. The Court reasoned that the district did not treat the objective indicia as “a mere ‘afterthought’ relegated to ‘rebutting’ a prima facie case.”

Finally, the Court did not find any inconsistency in the district court’s findings on obviousness and written description because Persion used incomplete quotations from the court’s opinion. The Court affirmed the district court’s findings of obviousness and declined to reach the written description issues on appeal.

Personal Audio, LLC v. CBS Corp.

946 F.3d 1348 (Fed. Cir. 2020)

In this appeal from the Eastern District of Texas, the Federal Circuit considered whether it had jurisdiction to review collateral attacks on the validity and legality of the PTAB’s prior final written decision, as brought up on appeal from a district court’s final judgment.

Personal Audio sued CBS for infringement of the ’504 patent, which is directed to a system to organize audio files by subject matter into “program segments.” Later, a third party petitioned for IPR. The district court proceeded to trial, and a jury found for Personal Audio. Meanwhile, the PTAB instituted review and issued a final written decision that some claims of the ’504 patent are unpatentable. Personal Audio petitioned for a rehearing from the PTAB, arguing that the PTAB violated the Seventh Amendment by reexamining jury findings, and that IPR violates the Due Process Clause of the Fifth Amendment. The PTAB denied rehearing, and the parties agreed to stay proceedings in the district court, while Personal Audio appealed the PTAB’s decision to the Federal Circuit. The Court affirmed the PTAB’s final written decision. Afterwards, the parties agreed to a judgment in favor of CBS, and the district court entered that judgment. Personal Audio subsequently filed another appeal to the Federal Circuit, challenging the validity and constitutionality of the PTAB’s final written decision.

First, on validity, the Federal Circuit held that it does not have jurisdiction to hear challenges that directly attack the validity of the PTAB’s final written decision, unless the party directly appeals to the Federal Circuit from the PTAB’s final written decision.

Second, on constitutionality, the Court held that the district court did not have jurisdiction to consider challenges to the legality of the PTAB's decision. The Court reasoned that Congress specifically had precluded district court jurisdiction where it provided for administrative review, then appellate review in a court of appeals. Congress affirmatively granted exclusive, direct review of the PTAB's final written decision to the Federal Circuit, and therefore the Court could only review challenges of lawfulness on direct appeal from the final written decision. Finally, the Federal Circuit found that Personal Audio failed to distinguish this case from precedent, where the Court had held that district court actions had to terminate upon the Court's affirmation of a PTAB's unpatentability ruling. As the Federal Circuit had previously affirmed the PTAB's final written decision regarding the '504 patent, the district court and the parties had agreed to the correct judgment, and the Court affirmed.

Personalized Media Commc'ns, LLC v. Apple Inc.

952 F.3d 1336 (Fed. Cir. 2020)

The Federal Circuit affirmed-in-part and reversed-in-part the PTAB's decision during IPR that certain patent claims were unpatentable on anticipation and obviousness grounds because the PTAB failed to limit its claim construction of "an encrypted digital information transmission including encrypted information" to entirely digital transmissions. The Federal Circuit found that, while the claim language and specification were ambiguous, in the prosecution history, the applicant consistently and repeatedly stated that the term should be limited to a digital process, even if they did not rise to the level of a disclaimer. As to these claims, the Federal Circuit reversed the PTAB's finding of invalidity.

Certain other claims, however, recited "an information transmission including encrypted information" instead. Because the prosecution history statements did not apply to this term, the Federal Circuit affirmed the PTAB's finding of invalidity for these claims.

Pharma Tech Solutions, Inc. v. LifeScan, Inc.

942 F.3d 1372 (Fed. Cir. 2019)

Pharma Tech Solutions sued LifeScan for infringement of two of its patents concerning blood glucose monitoring systems for home use by individuals with diabetes in the District of Nevada. Pharma Tech brought claims of both literal infringement and infringement under the doctrine of equivalents. After Pharma Tech dismissed its literal infringement allegations, LifeScan filed for summary judgment of no infringement under DOE for argument-based and amendment-based prosecution history estoppel. The district court granted summary judgment, and Pharma Tech appealed.

Reviewing the grant of summary judgment de novo, the Federal Circuit affirmed. With respect to the amendment-based estoppel, the court found that a patentee's decision to narrow claims through amendment may be presumed to be a general disclaimer of the "territory between the original claim and the amended claim." This presumption can be overcome if the equivalent was unforeseeable or the rationale for the amendment bears no more than a "tangential relation" to the equivalent in question. Pharma Tech did not dispute

that the amendment was narrowing, but argued that the “tangential relation” exception applied. The Court rejected Pharma Tech’s argument because the objectively apparent reason for its amendment during prosecution was to distinguish prior art that directly related to the accused equivalent. The Court also found that Pharma Tech was estopped under argument-based prosecution history estoppel, which requires a “clear and unmistakable surrender of subject matter.”

Plastic Omnium Advanced Innovation & Research v. Donghee Am., Inc.

943 F.3d 929 (Fed. Cir. 2019)

Plastic Omnium Advanced Innovation and Research (“Plastic Omnium”) sued Donghee America, Inc. and Donghee Alabama, Inc. (collectively “Donghee”) for infringement in the District of Delaware of its patents related to manufacture of plastic fuel tanks. After claim construction, the district court relied on the construction of the “parison” terms in the patent to grant summary judgment of noninfringement for Donghee. Plastic Omnium appealed.

The Federal Circuit affirmed, finding that Donghee’s products did not literally infringe the patents and did not infringe the patents under the doctrine of equivalents. The district court correctly construed the “parison” term in accordance with Plastic Omnium’s definition, and applied that construction to the accused device. Regarding literal infringement, the court found that while Plastic Omnium argued that summary judgment was based on an erroneous claim construction, it failed to dispute the actual construction of the terms themselves. Rather, Plastic Omnium argued that the district court erred in deviating from its claim construction order. The Federal Circuit rejected Plastic Omnium’s arguments, finding that the district court’s determination was consistent with its claim construction order. Regarding infringement under the doctrine of equivalents, the court noted that Plastic Omnium’s expert admitted that Donghee’s products differed from the patented invention because Donghee’s product made improvements that went beyond an “insubstantial difference.”

Judge Cleverger dissented, writing that the majority’s analysis focuses on the wrong key factual dispute: it is not on the construction of the term “parison” but the term “die” that is crucial. The dissent found that in the Markman hearing and summary judgment briefing, Plastic Omnium presented sufficient evidence to create a material factual dispute over the structure of Donghee’s product, thereby precluding summary judgment.

Samsung Elecs. Am., Inc. v. Prisia Eng’g Corp.

948 F.3d 1342 (Fed. Cir. 2020)

Prisia owns the ’591 patent which claims technology enabling users to swap at least one pixel in a digital video with pixels from a separate image. Prisia sued Samsung in the District of Florida, arguing that Samsung’s “Best Face” feature, which allows users to take a burst of photos and replace unwanted images with better images from the burst, infringed claims 1, 3, 4, and 8 of the ’591 patent. The jury agreed and awarded Prisia \$4.3 million in damages. Samsung petitioned for IPR of claims 1-4, 8, and 11 of the ’591 patent. At

first the PTAB did not review claims 1-4 and 8 because it could not determine the scope of those claims. However, before the IPR was over, the Supreme Court held in *SAS Institute, Inc. v. Iancu* that the PTAB could not choose which claims to review and that it must review the patentability of every claim challenged by the petitioner. Following the Supreme Court's decision, the PTAB reviewed claims 1-4 and 8 and found that they were indefinite, meaning Samsung had not shown that the claims were unpatentable. The PTAB further found that the "digital processing unit" found in claim 1 and relied on in claims 2-4 and 8 is a means-plus-function limitation, and because Samsung's petition failed to identify a corresponding structure the claims could not be applied to the prior art. Finally, the PTAB found that another patent application publication, Sitrick, rendered claim 11 obvious.

Samsung appealed the PTAB's decision with respect to claims 1-4 and 8, and Prisua appealed the decision holding claim 11 to be unpatentable for obviousness. On appeal, Samsung argued that the PTAB should have canceled claims 1-4 and 8 of the '591 patent for indefiniteness or, in the alternative, that the PTAB should have applied the prior art to determine whether the claims were unpatentable for obviousness. The Court was not persuaded by Samsung's arguments, holding that under the IPR statute, the PTAB could cancel claims "only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications." The Court did, however, reverse the PTAB's finding that the "digital processing unit" invoked means-plus-function claiming under 35 U.S.C. § 112(f), instead holding that the term was synonymous with a "general purpose computer" or "central processing unit" and could be understood as a reference to structure. Since the PTAB erred on this point, the Court remanded the case so that the PTAB could determine whether claims 1-4 and 8 are unpatentable as anticipated or obvious. Finally, the Court was not persuaded by any of Prisua's arguments contesting the PTAB's finding of obviousness with respect to claim 11 and affirmed the PTAB's decision.

Sanofi-Aventis U.S., LLC v. Dr. Reddy's Labs., Inc.
933 F.3d 1367 (Fed. Cir. 2019)

In this case, the Federal Circuit affirmed in part and vacated in part a ruling from the district court. Specifically, the Court held that, because certain claims of the '592 patent had been disclaimed, there was no case or controversy when the district court rendered its decision, and vacated that decision. The Court affirmed the district court's judgment that the '170 patent is not invalid as obvious.

Dr. Reddy's Laboratories and other defendants had filed Abbreviated New Drug Applications for generic versions of cabazitaxel, a drug Sanofi marketed based on its '170 and '592 patents claiming the compound and associated methods. Sanofi sued the defendants for infringement of its patents, and the defendants counterclaimed for declaratory judgment based on the invalidity of the '592 patent. While this case was pending, the PTAB instituted IPR of the '592 patent and held many of its claims unpatentable as obvious. Sanofi filed a statutory disclaimer of the claims at issue and informed the district court. The district court concluded that a case or controversy still existed with respect to the '592 claims and that they were invalid as obvious. The district

court also held that the defendants had failed to prove the claims of the '170 patent would have been obvious over the prior art. Both parties appealed.

The Federal Circuit vacated the district court's determination with respect to the '592 patent. The Federal Circuit determined there was no case or controversy when the district court entered its final judgement, because the disclaimer of the disclaimed claims mooted any controversy over them. The Court rejected Sanofi's assertion that vacating the judgement would create an injury by eliminating the possible benefit of an issue preclusion defense.

The Federal Circuit affirmed the district court's judgment that claims involving the '170 patent were not invalid as obvious. The Court reasoned that Fresenius's obviousness theory was hindsight-driven and that a skilled artisan would not have been motivated to modify the prior art references in the way Fresenius contends would render the challenged claims obvious.

Schwendimann v. Arkwright Advanced Coating, Inc.

959 F.3d 1065 (Fed. Cir. 2020)

In 2011, Schwendimann sued Arkwright in district court, alleging infringement of various patents. After filing the complaint, Schwendimann realized that her former employer, ACT, had filed an incorrect assignment with the USPTO when attempting to transfer the patents-in-suit to her in 2002. After this realization, Schwendimann and ACT executed a satisfaction of debt agreement to perfect the assignment. Arkwright then moved to dismiss the suit, arguing that Schwendimann lacked standing because she did not own the patents-in-suit as of the filing of the complaint. Schwendimann moved for summary judgement on the standing issue. The district court granted summary judgment for Schwendimann, holding "that there was no genuine issue of material fact that ACT had assigned the '845 application to Ms. Schwendimann in 2002." The case then proceeded to a jury trial where a judgment of willful infringement was entered against Arkwright. The district court awarded Schwendimann a 10 percent prejudgment interest rate, pursuant to Minnesota law. Arkwright appealed both the standing issue and the district court's award of prejudgment interest. The Federal Circuit affirmed on both issues.

On the standing issue, the Court first determined that under *Lone Star Silicon Innovations LLC v. Nanya Tech. Corp.*, 925 F.3d 1225 (Fed. Cir. 2019), the question of "whether one qualifies as a patentee under 35 U.S.C. § 281 is a statutory prerequisite to the right to relief in a patent infringement action, but does not implicate the district court's subject matter jurisdiction." Therefore, the Court concluded that dispute did not implicate Article III standing. Instead, it only concerned (1) whether Schwendimann was a patentee at the time her action was filed; (2) if the assignment of the patents was conferred upon her by a written instrument within the meaning of 35 U.S.C. § 261; and (3) if Schwendimann had legal title to the patent under state contract law. The Court held all of these requirements were satisfied. The Court concluded that under Section 261, a court may use state contract law to reform a written instrument intended to assign an existing patent to another party, if that written instrument failed to express the parties' intended agreement due to a mutual

mistake. The Court also explained that “[b]y virtue of the reformation, the written instrument was corrected *nunc pro tunc*, to the point of the assignment,” so Schwendimann owned the patents-in-suit in 2002, well before filing the suit. With respect to the issue of prejudgment interest, the Court held that the district court did not abuse its discretion in awarding a 10 percent interest rate because precedent supported both the use of state law to determine the interest rate and the application of the prejudgment interest to the entire lump sum award beginning on the first date of infringement.

Judge Reyna, writing in dissent, disagreed with the majority’s conclusion that Article III standing was not implicated in the case. According to the dissent, *Lone Star* simply “clarified that a party that fails to satisfy the statutory standing requirements under the Patent Act— i.e., ‘all substantial rights’ in the patent—may nonetheless meet the baseline constitutional standing threshold.” The dissent would have held that Schwendimann lacked Article III standing because she did not have *any* ownership rights in the patents-in-suit when she filed her complaint. The dissent emphasized that lack of constitutional standing cannot be cured retroactively, so the district court’s correction of the erroneous 2002 written assignment could not confer standing on Schwendimann.

Serta Simmons Bedding, LLC v. Casper Sleep Inc.

950 F.3d 849 (Fed. Cir. 2020)

Serta Simmons Bedding, LLC (“Serta”) sued Casper Sleep Inc. (“Casper”) in the District Court for the Southern District of New York, asserting infringement of claims of the ’173, ’763, and ’935 patents, covering mattress technology. Casper filed a motion for summary judgment of noninfringement. While the motion was pending, the parties entered into a settlement agreement, which required Casper to pay Serta \$300,000 within 10 days and to cease manufacturing and advertising of certain Casper products. The parties informed the district court of the settlement agreement, but the district court nevertheless issued an order granting Casper’s motion for summary judgment of noninfringement. Upon receiving the district court’s order, Casper declined to proceed with the settlement agreement, and Serta filed a motion to enforce the settlement agreement and to vacate the summary judgment order. The district court denied the motion, finding that the case was not moot when the order was issued because the parties had intended to keep the action alive until both parties fulfilled their obligations under the settlement agreement. The district court also reasoned that it did not have jurisdiction to enforce the agreement. Separately, Casper filed a motion for fees under 35 U.S.C. § 285, which was denied by the district court.

On appeal, the Federal Circuit reversed the district court’s denial of Serta’s motion, holding that a binding settlement agreement will generally moot any action even if the parties have not yet fulfilled all obligations under the agreement (*i.e.*, even if the settlement contains executory terms). The Court further rejected the district court’s reasoning with respect to jurisdiction, holding that the district court had jurisdiction to enforce the agreement because the litigation had not been dismissed and the proceedings were ongoing. The Court remanded the case and directed the district court to enforce the agreement. Separately, the Court affirmed the district court’s ruling that this was “not an exceptional patent case warranting fee shifting” under Section 285.

Shoes by Firebug LLC v. Stride Rite Children's Grp.

962 F.3d 1362 (Fed. Cir. 2020)

This appeal arose from two final written decisions from the PTAB, holding that the challenged claims of Firebug's '038 and '574 patents, which were directed to light-up shoes, were unpatentable as obvious. On appeal, Firebug argued that the PTAB erred in determining that the preambles of claim 1 of both the '038 and '574 patents did not limit the claims. Firebug also argued that the PTAB erred in concluding that the challenged claims would have been obvious in light of the prior art and Firebug's evidence of secondary considerations of nonobviousness. The Federal Circuit affirmed the PTAB's holdings.

First, although the Court determined that the preamble of claim 1 of the '574 patent was essential to understanding the structural limitations of the illumination system, and thus was limiting, substantial evidence supported that the references disclosed the limitation. As for the '038 patent, on the other hand, the Court concluded that the preamble was not limiting because the body of the claim recited a structurally complete invention, whereas the preamble merely stated an intended purpose for the invention. Second, the Court found that the PTAB's conclusions that the challenged claims were obvious were supported by substantial evidence, and that Firebug's secondary considerations of nonobviousness did not demonstrate otherwise.

SIPCO, LLC v. Emerson Elec. Co.

939 F.3d 1301 (Fed. Cir. 2019)

SIPCO appealed the PTAB's written decision in a covered business method review finding that several claims of its '842 patent were ineligible for patent protection under 35 U.S.C. § 101 and unpatentable for obviousness under 35 U.S.C. § 103. SIPCO also appealed the PTAB's determination that the '842 patent was subject to CBM review.

As background, the '842 patent notes that there are some circumstances where it is helpful to communicate information from a previously unconnected, remote device to a central location. Instead of setting up a direct communication link from the remote device to the central location, the '842 patent sets up a "two-step communication path through a set of intermediate nodes that takes advantage of the nodes' already-provided communications link . . . to the central location." When implementing this two-step communication system, the investors recognized that several issues arose. For instance, one problem was that an "interloper could unlawfully intercept the electromagnetic signals carrying sensitive data." To correct this issue, among others, the '842 patent notes the use of a "low-power remote transmitter." Moreover, the specification explains that this low-power remote transmitter would "require the user to be in 'close proximity' . . . in order for the user to be able to use it."

The Federal Circuit first reviewed the PTAB's construction of a "low-power transceiver." The PTAB concluded that the challenged claims were ineligible for patent protection because they were directed to the abstract concept of "establishing a communication route

between two points to relay information and did not contain any additional inventive concept.” In making this decision, the PTAB placed significant weight on expert testimony asserting that “low-power” is not necessarily coextensive with a limited transmission range. However, the Federal Circuit noted that the record contained evidence that contradicts this testimony and supports a relationship between limited transmission range and low transmit power. For this reason, the Court reversed the PTAB’s construction of a low-power transceiver. Moreover, the Federal Circuit construed it to mean “a device that transmits and receives signals at a power level corresponding to a limited transmission range.”

Next, the Federal Circuit discussed whether the ’842 patent was even eligible for CBM review. SIPCO argued that the claimed device is only “associated with” an ATM or vending machine and the “mere possibility that certain remote devices of the ’842 patent could communicate financial data is not nearly sufficient to demonstrate that it is directed to financial products or services.” The Federal Circuit, however, noted that under AIA § 8(d), the claimed apparatus only needs to be “used in” the practice, administration, or management of a financial product of service. In light of this, the Federal Circuit upheld the PTAB’s conclusion that the ’842 patent is a CBM patent.

Lastly, the Federal Circuit reviewed the PTAB’s reasoning as to whether the ’842 patent qualifies as a “technological invention” under AIA § 18(d)(1). In determining whether a patent is for a technological invention, the PTAB must consider: (1) whether the claimed subject matter as a whole recites a technological feature that is novel and unobvious over the prior art; and (2) solves a technical problem using a technical solution. The Federal Circuit noted that because the PTAB misread and misconstrued the patent’s claims, “it did not appreciate that the claims provide a technical solution to a technical problem.” Because of this, the Federal Circuit held that the PTAB’s ruling on this issue was arbitrary and capricious.

Judge Reyna dissented in part and concurred in part. In the dissent, Judge Reyna argued that the majority’s opinion is “contrary to the basic tenants of claim construction,” and noted that the underlying facts deserved more deference under *Teva*. In the concurrence, Judge Reyna shared the majority’s concern that PTAB avoided the first prong of the definition of “technological invention,” but asserted that a remand is appropriate.

Spigen Korea Co., Ltd. v. Ultraproof, Inc.
955 F.3d 1379 (Fed. Cir. 2020)

The Federal Circuit, in a split decision, reversed the Central District of California’s grant of summary judgment in favor of Ultraproof because the Court found that fact issues regarding whether prior art was a primary reference precluded summary judgment on obviousness.

On appeal, Spigen argued that there was a material factual dispute over whether the ’218 patent was a proper primary reference to the patents at issue. The district court held as a matter of law that the patents at issue were obvious over the prior art. The Court

disagreed, finding that a reasonable factfinder could conclude that the prior art and the patents at issue “have substantial differences, and, thus, are not basically the same.” Accordingly, the Court found “that a genuine dispute of material fact exist[ed] as to whether the ’218 patent is basically the same as the Spigen Design Patents and hence, a proper primary reference.” The Court reversed the district court’s grant of summary judgment of invalidity and remanded for further proceedings.

Syngenta Crop Prot., LLC v. Willowood, LLC

944 F.3d 1344 (Fed. Cir. 2019)

Syngenta Crop Protection, LLC (“Syngenta”) sued Willowood, LLC, Willowood USA, LLC (“Willowood USA”), and Willowood Limited (“Willowood China”) (collectively, “Willowood”) in the Middle District of North Carolina for patent infringement and copyright infringement. Syngenta is the assignee of patents that are directed to a group of compounds, including the fungicide azoxystrobin, and processes for manufacturing azoxystrobin. Syngenta markets azoxystrobin under copyrighted brand names with detailed instruction labels. Syngenta asserted that Willowood infringed its patents with its generic azoxystrobin products, and further infringed Syngenta’s registered copyrights by copying those labels for their generic product labels.

Syngenta appealed the district court’s (1) dismissal of its copyright claims, (2) conclusion that 35 U.S.C. § 271(g) requires every step of a claimed process to be performed by or attributable to a single entity, and the related verdict that Willowood did not infringe the ’138 patent, and (3) the district court’s judgment that Willowood China did not infringe any of the asserted patents.

First, the district court concluded that Willowood did not infringe Syngenta’s copyrights because Congress intended a narrow exception to copyright protection for the required elements of fungicide labels since FIFRA contemplates copying a generic applicant in ways that would otherwise infringe a copyright. The Federal Circuit rejected this as premature and remanded to the district court to discern whether the Copyright Act, as interpreted under existing doctrines such as the fair-use doctrine or merger doctrine, would prohibit Willowood’s use of any portion of Syngenta’s label.

Second, concerning an issue of first impression, the Federal Circuit rejected the district court’s interpretation of Section 271(g) as having the same single-entity requirement of Sections 271(a) and (b). The Federal Circuit held that the statutory language is clear that liability under Section 271(g) is not predicated on practicing the claimed process, but rather on importing, offering for sale, selling, or using a product, and therefore whether that process is practiced by a single entity is immaterial to the infringement analysis. Since it was undisputed that Willowood USA imported an azoxystrobin compound into the United States that was manufactured abroad using the patented process in the ’138 patent, the Federal Circuit reversed the district court’s judgment that Willowood USA did not infringe the ’138 patent under Section 271(g).

Lastly, the Federal Circuit found that substantial evidence supported the jury’s verdict in favor of Willowood China. This evidence included that the shipment of azoxystrobin passed legal title from China to USA with the “f.o.b. China” marking, and that Willowood USA was responsible for clearing the shipments through U.S. customs, registering the fungicide with the EPA, reimbursing Willowood China for freight charges, and assuming entire liability for the shipment. As such, the Federal Circuit concluded that this was enough evidence to support a finding that Willowood China did not infringe Syngenta’s patents because it sold azoxystrobin in China and did not import azoxystrobin into the United States.

Takeda Pharms. U.S.A., Inc. v. Mylan Pharms. Inc.
967 F.3d 1339 (Fed. Cir. 2020)

In 2016, Takeda sued Mylan for infringement of 17 patents. The parties settled that under a License Agreement, which as relevant to the appeal, permitted Mylan to launch a generic product a specified time after “the date of a Final Court Decision . . . holding that all unexpired claims of the Licensed Patents that were asserted and adjudicated against a Third Party” are not infringed, invalid, or unenforceable. The Licensed Patents included the 17 patents Takeda asserted against Mylan.

Takeda also sued Hikma for infringement of eight of the Licensed Patents in an action termed the West-Ward Litigation. Takeda voluntarily dismissed five of those eight patents, and the district court found the remaining three patents not to be infringed. After final judgment was entered in the West-Ward Litigation, Mylan launched its generic product. Takeda then sued Mylan for breach of contract and patent infringement, moving for a preliminary injunction. The district court denied Takeda’s motion, and Takeda appealed.

On appeal, the Federal Circuit held that the district court properly interpreted the License Agreement, and thus correctly found that Takeda was unlikely to succeed on the merits. Takeda argued that the district court erred because, contrary to the district court’s interpretation, the License Agreement requires that all of Licensed Patents asserted in a particular litigation be adjudicated to be not infringed, invalid, or unenforceable. The Federal Circuit rejected that argument, holding that the plain language of the License Agreement permits Mylan’s sale of a generic product upon a determination that all of the “asserted and adjudicated” claims of the Licensed Patents are not infringed. As a result, the judgment of noninfringement in the West-Ward Litigation permitted Mylan to market its generic despite Takeda’s voluntary dismissal of five of the patents it had initially asserted.

TCL Comm’ns Tech. Holdings Ltd. v. Telefonaktiebolaget LM Ericsson
943 F.3d 1360 (Fed. Cir. 2019)

For a number of years, TCL Communication Technology Holdings Limited (“TCL”) sought to negotiate licenses with Telefonaktiebolaget LM Ericsson (“Ericsson”), the owner of a portfolio of standard-essential patents (SEPs) incorporated into 2G, 3G, and 4G mobile communications standards. As the licenses were set to expire, TCL sued Ericsson in the

District Court of California for declaratory judgment that Ericsson failed to offer “fair, reasonable and non-discriminatory” (FRAND) rates. As a member of the European Telecommunications Standards Institute (ETSI), Ericsson has an obligation to license its SEPs to promote interoperability.

The district court commenced a bench trial despite Ericsson’s objections that it had not waived its right to a jury trial. The district court determined that Ericsson’s license offers did not satisfy FRAND, imposed FRAND rates in a binding worldwide license on both parties for Ericsson’s portfolio of SEPs, granted release payments based on TCL’s past unlicensed sales, and dismissed the infringement claims and related counterclaims as moot in light of equitable relief granted in release payment. Ericsson appealed, arguing that the decisions should have been determined by a jury, not the bench.

The Federal Circuit found that Ericsson had a Seventh Amendment right to a jury on adjudication of the “release payment” term because the relief is compensatory relief—not equitable relief—for TCL’s past acts. The court focused on the substance of the relief, not the form the relief takes: simply because the release payment was ordered in the form of an injunction does not necessarily make it equitable. Most tellingly, the district court’s dismissal of Ericsson’s counterclaims of infringement as moot in light of the release payment confirm that the release payment functions are a substitute for infringement damages. Furthermore, the Federal Circuit found that Ericsson did not waive its right to jury trial on calculation of release payment, as Ericsson’s isolated statement should not be construed as a waiver of Ericsson’s constitutional right.

Tech. Consumer Prods., Inc. v. Lighting Sci. Grp. Corp.
955 F.3d 16 (Fed. Cir. 1899)

The Federal Circuit held that the PTAB wrongly upheld Lighting Science’s patent for an LED light fixture by misapplying the case law and misinterpreting the plain language in the claim. Technical Consumer petitioned for IPR, asserting that a prior art reference anticipated and rendered obvious the challenged claims. The challenged claims recite a heat spreader, heat sink, and outer optic having a particular height-to-diameter ratio. The prior art reference at issue disclosed, according to the patentee, two heat sinks that both needed to be included in the ratio calculation. The PTAB agreed and found that, because consideration of both heat sinks did not satisfy the height-to-diameter ratio, the claims were not anticipated or obvious.

In vacating the PTAB’s holding, the Federal Circuit explained that the claim language and the specification referred only to a particular type of heat sink for calculations relating to the height-to-diameter ratio; any other heat sinks did not factor into that calculation. The Court concluded that the PTAB erred in calculating the height-to-diameter ratio using both heat sinks disclosed in the prior art when only one of the heat sinks satisfied the requirements of the claims and the specification for the type of heat sink to include in the calculation. The Federal Circuit held that the PTAB thus had misconstrued and misapplied the plain language of the claim. Because the PTAB had not addressed the parties’ other

arguments relating to anticipation and obviousness, the Court vacated the PTAB's decision and remanded for consideration of the remaining arguments.

Techtronic Indus. Co. v. Int'l Trade Comm'n

944 F.3d 901 (Fed. Cir. 2019)

On appeal from the ITC, the Federal Circuit reversed the ITC's construction of a claim term and a final determination of infringement, and vacated limited exclusion and cease and desist orders.

Chamberlain filed a complaint with the ITC alleging infringement of its patent directed to controllers for garage doors. An investigation was instituted, and the Administrative Law Judge ("ALJ") issued a claim construction order over the disputed claim term "wall console," finding the specification limited the term to consoles "including a passive infrared detector." The ALJ subsequently granted Appellants' motion for summary determination of noninfringement based upon their claim term construction. The Commission reversed the ALJ's construction and vacated his finding of noninfringement, concluding that the '319 patent claims were not so limited by the written description. Under the Commission's construction, the ALJ found infringement, and the Commission entered remedial orders against the Appellants.

Upon review of the ITC's claim construction under a de novo standard, the Federal Circuit agreed with the Appellants that patentee disavowed coverage of wall consoles without a passive infrared detector. The Court noted that the '319 patent had a consistent description of the invention as a wall console with a passive infrared detector, along with multiple sections of the patent disclosing a need and solution of moving the detector to the wall console. Thus, the Court concluded that the '319 patent effected a disavowal of alternative locations of the detector.

Additionally, the Federal Circuit disagreed with the ITC's determination that the '319 patent's disparagement of prior art garage door openers that placed the detector in the head unit fell short of disavowal because "[n]owhere in the patent did it state that it was impossible or even infeasible to locate a passive infrared detector at some other location." The Court found that an express concession to that effect was not necessary, since the entire specification focused on enabling placement of the detector in the wall console, in response to a prior art deficiency.

Telefonaktiebolaget LM Ericsson v. TCL Corp.

941 F.3d 1341 (Fed. Cir. 2019)

In this case, Ericsson owned the '052 patent claiming a "direct conversion receiver" for receiving and processing wireless signals from communication systems operating at differing frequencies. The petitioner, TCL, presented a journal article (the "Jentschel reference") on multimodal wireless telephones and contended it was available as prior art by submitting the sworn declaration of Doris Michel, a librarian that attested to the Jentschel reference's public availability (the "Michel Declaration"). Ericsson objected to

the Michel Declaration as being untimely, and argued that even if timely, it failed to establish the date of public availability of the Jentschel reference. The PTAB rejected Ericsson's arguments, found that the Jentschel reference was prior art, and ruled that challenged claims 13, 15, 16, and 18 of the '052 patent are unpatentable for obviousness. Ericsson appealed, and the Federal Circuit affirmed the PTAB's rulings.

The Federal Circuit first considered Ericsson's arguments as to whether the Jentschel article was admissible or publicly accessible. The court concluded that because the Michel Declaration and Jentschel reference were reasonably viewed as material evidence and Ericsson had adequate opportunity to respond, the interest of justice weighed on the side of admitting the evidence. The Court also found that the Michel Declaration was sufficient to support the PTAB's factual finding that the prior art was publicly available. As a result, the Court concluded that the PTAB did not abuse its discretion by receiving the Jentschel article as a reference. In addition, the Court affirmed the PTAB's ruling that the Jentschel reference, alongside Japanese patent applications JP947 and JP755, rendered obvious claim 18 of the '052 patent. The Court also agreed that the Jentschel reference did not "teach away" from the patent despite citing certain disadvantages of the frequency divider system. Furthermore, the Court concluded that a POSITA would have been motivated to implement JP947 in conjunction with the Jentschel reference such that claim 18 would be obvious. As a result, the Court affirmed the PTAB's judgment that claim 18 would have been obvious.

TQ Delta, LLC v. Cisco Sys., Inc.

942 F.3d 1352 (Fed. Cir. 2019)

TQ Delta brought infringement suits against a number of telecommunications companies, including Cisco Systems, in the District of Delaware. The asserted patents related to improvements in electronic communications systems that lower the peak-to-average power ratio of the transmitted signals. Cisco then filed a pair of IPR proceedings against all claims of TQ Delta's '158 and '243 patents. The PTAB invalidated all claims of both patents, finding that they were obvious in view of the prior art asserted by Cisco. TQ Delta appealed the final decision.

The Federal Circuit reversed, finding that the PTAB's determinations that these claims were invalid as obvious were not supported by substantial evidence. Under the "substantial evidence standard," the court found that the PTAB's factfinding rested on conclusory testimony by Cisco's expert and is therefore unsupported by substantial evidence—the expert's "brief, high-level explanation" was unsupported by any contemporaneous evidence. According to the court, rejections on obviousness grounds cannot be sustained by mere conclusory statements, but instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

Judge Hughes dissented without opinion.

Uber Techs., Inc. v. X One, Inc.

957 F.3d 1334 (Fed. Cir. 2020)

In this obviousness challenge, the Federal Circuit reversed and remanded the PTAB's determination that X One's patent claims regarding mobile location sharing software were not unpatentable as obvious over prior art. X One owns the '593 patent, which is directed toward an application wherein users may obtain a map containing the plotted locations of users with whom they mutually share their geospatial positioning data.

Uber filed a petition for IPR, contending that the challenged claims were obvious in view of the combination of two prior art Japanese patent applications (Okubo and Konishi). The PTAB found in favor of X One, determining that the combination of Okubo and Konishi fails to teach or suggest the claim limitation "software . . . to transmit the map with plotted locations to the first [user]."

Uber appealed and the Federal Circuit reversed. The Court found the claims directed to the problem of transmitting maps and plotted locations, and that the record reflected only two possible methods of achieving such transmission: server-side plotting and terminal-side plotting. The Court further found that Konishi discloses server-side plotting and Okubo discloses terminal-side plotting.

The Court concluded that therefore, server-side plotting and terminal-side plotting were two known, finite, predictable solutions for achieving the claim limitation in question. Thus, because there would have been a simple design choice between server-side plotting (as described in Konishi) and terminal-side plotting (as described in Okubo), the Court held that a POSITA at the time of the invention would have been motivated to combine or substitute the teachings of Okubo and Konishi with each other to achieve the limitation.

Uniloc 2017 LLC v. Apple, Inc.

964 F.3d 1351 (Fed. Cir. 2020)

Uniloc sued Apple for patent infringement in the Northern District of California; when Apple moved to dismiss, Uniloc filed a very broad motion to seal, covering "most of the materials in the parties' underlying briefs." The information Uniloc sought to seal included "matters of public record, such as a list of Uniloc's active patent cases," and even simple recitations of Federal Circuit caselaw. On interlocutory appeal, the Federal Circuit reviewed—for abuse of discretion—the district court's wholesale denial of Uniloc's motion.

In its analysis, the Court distinguished between two kinds of purportedly confidential information: that owned by Uniloc and its related entities, and that owned by Uniloc's third-party licensees. As to the former, the district court did not abuse its discretion in rejecting Uniloc's "sweeping," "overzealous," and "astonishing" motion to seal. As to the latter, however, the district court had not provided enough information for the Federal Circuit to assess the balance of public and third-party interests implicated in motions to

seal. The Court thus remanded for more “particularized determinations” of the costs of revealing the third-party licensees’ purportedly confidential information.

Uniloc 2017 LLC v. Hulu, LLC

966 F.3d 1295 (Fed. Cir. 2020)

This case affirms PTAB’s decision that it may consider the Section 101 patent-eligibility of proposed substitute claims during an IPR. Hulu and Netflix (together, “Hulu”) petitioned for IPR of a Uniloc patent. During the proceedings, Uniloc moved to amend three of its challenged claims with substitute claims, should the PTAB find the originals unpatentable. Hulu opposed this motion on the grounds that the substitute claims were patent-ineligible under Section 101. In its Final Written Decision, the PTAB found fourteen of twenty-five challenged claims unpatentable over the prior art, and denied Uniloc’s Motion to Amend on the sole ground of the ineligibility of its proposed substitutes. In an opinion designated as precedential, the PTAB also denied Uniloc’s subsequent motion for rehearing, and in doing so reaffirmed the PTAB’s power to consider Section 101 patent eligibility in reviewing proposed substitute claims in IPR proceedings.

On appeal, Hulu argued that the case was moot because Uniloc was statutorily precluded from adding its proposed substitute claims to the patent, for two reasons. First, Hulu argued that Uniloc’s Motion to Amend was contingent on a prior finding of unpatentability, which—once made—ended the IPR. Consequently, Hulu claimed, Uniloc’s motion was not filed “during [the] inter partes review[,]” as required by Section 316(d)(1). Second, Hulu argued that a final federal-court judgment invalidating Uniloc’s original claims, which issued between the PTAB’s Final Written Decision and Uniloc’s request for rehearing, had eliminated the PTO’s authority to consider Uniloc’s proposed substitute claims.

The Court rejected Hulu’s mootness arguments as waived, and proceeded to reject their substance as well. Hulu’s contingent Motion to Amend, the Court held, was simply “a standard form of in-the-alternative pleading”—Uniloc’s proposed substitute claims were thus part of the same proceeding as the originals. In addition, these proposed substitutes were properly “an independent presence in the proceeding, not dependent on a live controversy continuing as to the original claims.” The Court rejected the dissent’s argument that the invalidation of an original claim eliminates the possibility of a “substitute” claim, finding this interpretation unwarranted by either “the ordinary meaning of ‘substitute’” or its use in IPRs.

On the merits, however, the Court affirmed the PTAB’s denial of Uniloc’s motion for rehearing, and its consideration of Section 101 eligibility in the context of an IPR. Textually, the Court noted that 35 USC §§ 311–319 “plainly and repeatedly require the PTAB to determine the ‘patentability’ of proposed substitute claims,” a determination that itself requires a Section 101 analysis. The Court explained that Section 311(b), which appears to limit the PTAB’s IPR power to Section 102 or 103 claims, “is confined to the review of existing patent claims, not proposed ones[.]” Structurally, the Court added that Section 311 is about the petition phase of IPR, and “should not therefore bind a separate

adjudication-stage provision, such as § 316.” Finally, the Court noted that the purpose of IPR (and its pre-AIA predecessor, “reexamination”) is to consider “substantial new questions of patentability”—which, in the case of a proposed substitute claim, “include all patentability questions, including §101 patent eligibility” (emphasis added). *See* 35 U.S.C. § 303(a); *In re NTP, Inc.*, 654 F.3d 1268, 1275 (Fed. Cir. 2011). A contrary rule would “allow[] patents with otherwise invalidated claims to return from the dead” as proposed substitutes.

Judge O’Malley dissented. First, she contended that the case was moot, because PTAB lacked authority to replace an invalidated original claim with a “substitute”—a term, she argued, that presupposes a surviving original. On the merits, Judge O’Malley read Section 311 to limit the scope of inter partes proceedings to challenges under Sections 102 and 103, and read *NTP* as explicitly supporting this conclusion. She also noted that, while *Aqua Products* had no majority opinion, “only one dissent questioned the opinion’s statement of the statutory scheme.” “[The majority] declares that [this] dead patent[] can walk,” O’Malley wrote—“at least as far as needed to die again on the same Section 101 sword that killed it two years ago. That sword, however, does not exist in the [IPR] context.”

Uniloc USA, Inc. v. LG Elecs. USA, Inc.
957 F.3d 1303 (Fed. Cir. 2020)

The Court reversed the district court’s dismissal of Uniloc’s complaint against LG on patent eligibility grounds. At issue was a patent directed to a communication system, which employed an extra data field allowing a fixed device to simultaneously poll a mobile device and send it inquiry messages. The district court held that Uniloc’s claims were directed to an abstract idea and were therefore not patentable. The Federal Circuit reversed.

The Federal Circuit held that Uniloc’s claims were directed to a patent-eligible concept, because they were “directed to improvements to the functionality” of the communications platform. Here, the claimed invention improved the communications platform by overcoming “a problem specifically arising in the realm of computer networks.” In particular, the relevant claims reduced latency of communication between the fixed and mobile devices within the platform. The Court further held that claims did not “merely recite generalized steps to be performed on a computer using conventional computer activity.” Instead, the claims were directed at improving the functionality of the communications system itself. Here, the claims did not need to explicitly outline the desired advantages. Furthermore, under the relevant case law, neither the claimed inventions’ compatibility with conventional systems, nor the fact that its improvements were to the technology’s nonphysical components rendered it abstract.

Valeant Pharms. Int’l, Inc. v. Mylan Pharms., Inc.
955 F.3d 25 (Fed. Cir. 2020)

In this appeal, the Federal Circuit reversed and remanded the district court’s grant of summary judgment that claim 8 of Valeant’s asserted patent was not invalid as obvious. The patent in dispute is a stabilizing pharmaceutical formulation that is used to reduce the

potential side effects of opioids by using methylnaltrexone. At the district court, Mylan argued that a POSITA would have been able to arrive at a similar formulation using other solutions, such as naloxone or naltrexone and thus it would have been obvious. The district court disagreed, stating that Mylan had failed to show that the claims are obvious.

In reversing, the Federal Circuit held that the district court erred in applying the correct test for obviousness. The Court concluded that “prior art ranges for solutions of structurally and functionally similar compounds that overlap with a claimed range can establish a prima facie case of obviousness.” The Court further explained that a POSITA can expect that compounds with common properties are likely to share other related properties as well. Thus, compounds that share significant structural and functional similarity may be likely to share other properties, such as optimal formulation for long-term stability. The Federal Circuit held that the district court erred by granting summary judgment because Mylan had raised at least a prima facie case of obviousness sufficient to overcome summary judgment.

The Court cautioned, however, that its holding does not mean that molecules with similar structure and similar function can always be expected to exhibit similar properties for formulation. The Court further clarified that the factfinder at trial should consider whether Valeant has rebutted Mylan’s prima facie case, such as by establishing that the prior art teaches away from the claimed invention, the claimed range is critical, or that the claimed compound provides unexpected beneficial properties that the prior art compounds would not provide. The Court then explained that the district court erred in its obvious-to-try analysis because a variable need not be the first variable a POSITA would alter in order for it to be obvious to try, and the district court’s mathematical analysis was incorrect.

VirnetX Inc. v. Apple Inc.

931 F.3d 1363 (Fed. Cir. 2020)

VirnetX sued Apple for infringement of several patents in 2010. Apple subsequently filed requests for inter partes reexamination of two patents with the PTO in 2011. Cisco also filed a request for inter partes reexamination in 2011, challenging claims of one of the patents. The PTO affirmed the findings of the Examiner, who found all claims of the patents invalid as anticipated or obvious.

On appeal, VirnetX first argued that Apple was estopped from maintaining its reexams under the pre-AIA version of 35 U.S.C. § 317(b) (2006). The Federal Circuit agreed, finding that because Apple had earlier presented its invalidity defenses to a jury, later affirmed by the Federal Circuit in *VirnetX, Inc. v. Cisco Sys., Inc.*, 767 F.3d 1308, 1323-24 (Fed. Cir. 2014) and remanded on other issues, the pending reexaminations should have been barred because there was a final decision on validity. The Court therefore vacated and remanded with instructions to terminate the Apple reexams with respect to claims 1-35 of the ’504 patent and claims 36-59 of the ’211 patent. Judge Reyna dissented. Because the Supreme Court’s precedent in *Mercer v. Theriot*, 377 U.S. 152, 153-54 (1964) (per curiam) had held that the Supreme Court may consider on a second appeal questions raised in a first appeal, Judge Reyna believed there was no final decision on validity while Apple still had the possibility of raising the issue of validity in a writ of certiorari from its second

appeal. The majority believed its holding under similar circumstances in *Fairchild (Taiwan) Corp. v. Power Integrations, Inc.*, 854 F.3d 1364 (Fed. Cir. 2017) was controlling, despite the possibility of raising the invalidity issue on a second appeal never explicitly having been raised in Fairchild.

VirnetX also argued that the PTO erred in its decision to uphold the Examiner's rejection of all claims of the two patents. VirnetX argued that the PTO incorrectly construed certain claims, shifted the burden to the patent owner to prove patentability, and lacked substantial evidence. However, the Court agreed with the PTO on all issues. The Court therefore affirmed the PTO's decision on all remaining claims of both patents in the Apple reexam not subject to Section 317(b) estoppel, and fully affirmed the PTO's decision regarding the claims of the '211 patent in the Cisco reexam.

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