**RECENT DEVELOPMENTS IN PATENT LAW (Fall 2022)**

UPDATED THROUGH 11/21/2022

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# PATENTABLE SUBJECT MATTER

## Software and Business Method Cases

### Unpatentable

#### *In re Killian*, 45 F.4th 1373 (Fed. Cir. Aug. 23, 2022)

In this appeal from the PTAB, the Federal Circuit affirmed the rejection of a method to determine eligibility for social security disability insurance on 101 grounds.[[3]](#footnote-4) The patent application claimed a computerized method of providing access to Federal and state databases through a network, creating an electronic data record of someone in the state database who was receiving treatment for developmental disabilities, matching it with the federal database on social security number, gathering information from a caseworker, and seeing if the person was receiving SSDI benefits.[[4]](#footnote-5) The examiner rejected on 101, the inventor appealed to the PTAB, the PTAB affirmed.[[5]](#footnote-6)

The Federal Circuit affirmed the denial, noting that this case “does not present such a close case.”[[6]](#footnote-7) At step one of *Alice* the Court held that since the identification of an individual and determination of if they were receiving proper benefits could be performed in the human mind, the application was directed at an abstract idea.[[7]](#footnote-8) All the steps were performed on a generic computer, which did not save the invention at *Alice* step two.[[8]](#footnote-9)

The appellant made several arguments directed at 101 overall. First, he argued that the *Alice/Mayo* standard is inherently indefinite, rendering all decisions under the standard arbitrary and capricious.[[9]](#footnote-10) The Federal Circuit rejected this, noting that the APA does not apply to courts.[[10]](#footnote-11) The Court also rejected the request for a single definition or limiting principle for abstract idea and inventive concept, noting that there is no single inflexible rule, and that the Court had provided considerable guidance.[[11]](#footnote-12)

The appellant next argued that comparing this case to other cases in which the Court considered patent eligibility under 101 violates his due process rights. This was rejected, as to repudiate it would be to repudiate the common law system itself.[[12]](#footnote-13)

Killian next argued that *Alice* step two’s inventive concept doctrine was improper because Congress did away with the “invention” requirement in the Patent Act of 1952.[[13]](#footnote-14) The Court rejected this, on the grounds that the Supreme Court has told the Federal Circuit they are required to look for an inventive concept in *Alice*.[[14]](#footnote-15) The same rebuttal answered the appellant’s argument that the mental steps doctrine was abolished in modern patent law, with a cite to *Mayo*.[[15]](#footnote-16) Lastly, Killian argued that the PTO failed to provide any evidence that the computer usage was routine and conventional.[[16]](#footnote-17) The Federal Circuit pointed to the claim in the specification that the method could be done on any computer system.[[17]](#footnote-18) Thus, the Court affirmed the 101 denial.[[18]](#footnote-19)

#### *Int'l Bus. Machines Corp. v. Zillow Grp., Inc.*, 50 F.4th 1371 (Fed. Cir. Oct. 17, 2022)

In this appeal from the Western District of Washington, the Federal Circuit affirmed the rejection of patents relating to graphical display technology on 101 grounds.[[19]](#footnote-20) There were two of IBM’s patents in suit: the ’789 and the ’389 patents.[[20]](#footnote-21) The ’789 patent claims a method of geospatial selection—a user draws a shape on a map, and the system filters and displays data relating to the selected area.[[21]](#footnote-22) The ’389 patent claims a method of displaying objects in layers, such that layers of interest can be emphasized or deemphasized by changing which are on top.[[22]](#footnote-23) The Court held that all of the claims of each of these patents were abstract.[[23]](#footnote-24) On the ’789 patent at *Alice* step one, the Court held that the patent was directed to the abstract idea of responding to a user’s selection of an area of a map, and updating the map.[[24]](#footnote-25) It noted that the process could be performed by hand, by putting a transparent overlay over a paper map, then block out the unselected portion of the map with opaque paper.[[25]](#footnote-26) The Court noted that this patent was merely selecting and manipulating information, without more, and was an effect disassociated from any method.[[26]](#footnote-27) At *Alice* step two, the Federal Circuit held that IBM did not make plausible and specific allegations of an inventive concept, and instead merely described the abstract method.[[27]](#footnote-28) While there was a “synchronization” limitation, that was insignificant absent instructions on how to perform said synchronization beyond the use of standard computer components.[[28]](#footnote-29) As such, the Court invalidated the ’789 patent under 101.[[29]](#footnote-30)

For the ’389 patent at *Alice* step one, the Court held the patent was directed to the abstract idea of organizing and displaying visual information and noted that the claimed method could be performed by hand using translucent materials and changing the order of stacking.[[30]](#footnote-31) The Court held that while the claimed invention may speed up the process of arranging layers, it did not improve the functioning of the computer, nor did they explain a specific method to accomplish the tasks.[[31]](#footnote-32) The Federal Circuit distinguished *Core Wireless*, which held patentable a method for displaying information on a small screen, by noting that the small screen problem is unique to computers but the problem of displaying lots of information is not.[[32]](#footnote-33) At *Alice* step two, the Court held there was no computer-specific problem and that it merely used routine technology to perform its method.[[33]](#footnote-34) Contrary to IBM’s assertion that dynamically changing visual characteristics to reduce the impact of screen clutter was inventive, the Court pointed again to the fact that this relayering could be done by hand and stated that any improvement is due to the existence of the computer, not the invention itself.[[34]](#footnote-35)

Judge Stoll dissented with respect to the ’389 patent.[[35]](#footnote-36) Judge Stoll pointed to allegations in the complaint and IBM’s expert declaration that alleged rearranging and rematching logic in one of the dependent claims of the ’389 patent.[[36]](#footnote-37) She would have held that the patent solved an important problem of occlusion, and created a technical improvement in how a user interacts with a computer via a GUI.[[37]](#footnote-38) Judge Stoll critiqued the majority as viewing the claims at too high a level—in her view, while paper maps can use layers, computer displays are limited in size and this problem was specifically present in the prior art.[[38]](#footnote-39)

### Patentable

#### *Coop. Ent., Inc. v. Kollective Tech., Inc.*, 2022 WL 4488902 (Fed. Cir. Sept. 28, 2022)

In this appeal from the Northern District of California, the Federal Circuit reversed a dismissal for failure to state a claim on patent-eligible subject matter grounds.[[39]](#footnote-40) The ‘452 patent relates to systems and methods of structuring a peer-to-peer network for distributing files.[[40]](#footnote-41) The N.D. Cal. at *Alice* step one held that the focus of the ‘452 patent was directed at the abstract idea of the preparation and transmission of content to peers through a network.[[41]](#footnote-42) At step two, the district court characterized the patent as merely implementing that abstract idea with generic computer components.[[42]](#footnote-43)

The Federal Circuit reversed, holding at *Alice* step two that there were two inventive concepts.[[43]](#footnote-44) First was a required dynamic peer-to-peer network configured to communicate outside of centralized content distribution networks.[[44]](#footnote-45) This inventive concept was adequately alleged in the written description and the complaint, which articulated how the structure improved on the prior art and the structural limitation.[[45]](#footnote-46) The specification described improvements on time, redundance, and costs, and the complaint reiterated the benefits and the difference from the prior art.[[46]](#footnote-47) The Court noted that determining if the claimed network is well-understood is a question of fact that cannot be determined at the 12(b)(6) stage.[[47]](#footnote-48)

The second inventive concept the Federal Circuit saw was the requirement of trace routes in content segmentation to prepare data transmission.[[48]](#footnote-49) The patentee alleged the specific advance was that using these trace routes allowed further segmentation of data, and the Court held that was sufficient.[[49]](#footnote-50) The defendant’s argument that the networks involved were conventional was off base, as improvements to network systems are patentable.[[50]](#footnote-51) Finding two inventive concepts, the Federal Circuit reversed at *Alice* step two.[[51]](#footnote-52)

#### Weisner v. Google LLC, 51 F.4th 1073 (Fed. Cir. Oct. 13, 2022)

In this appeal from the Southern District of New York, the Federal Circuit held that patent claims directed to the idea of creating a digital travel log were ineligible, but that claims directed to the idea of using a travel history to improve search results were patent eligible.[[52]](#footnote-53) The asserted patents all share the idea of an individual signing up to save certain locations they’ve been as they go about their day, creating a “leg history” as they go.[[53]](#footnote-54) Some of the patents also describe using this leg history to improve search results.[[54]](#footnote-55) The district court held that both creating the history and using it to improve search results were patent ineligible—the Federal Circuit affirmed as to the creation of the history, but reversed as to the improving search results.[[55]](#footnote-56)

For the creation of the history, at *Alice* step one, the Court held that the patent was directed to the idea of a digital travel log, and did not improve the functioning of the computer itself.[[56]](#footnote-57) Travel logs are not new, and this patent merely digitized them.[[57]](#footnote-58) At *Alice* step two, the Court held that there was no inventive concept.[[58]](#footnote-59) The patent merely called for the use of routine technology, and had nothing more. As such, the Court held that the patents relating to the creation of the digital travel log were abstract.[[59]](#footnote-60)

For the use to improve search results, at *Alice* step one, the Court held that the patents were related to the abstract idea of using travel data to improve search results.[[60]](#footnote-61) However, at *Alice* step two, the Court held that there was plausibly an inventive concept: a specific technique to use physical location data to improve search results.[[61]](#footnote-62) The Court noted this was a problem specific to the internet, as it required search results to be effective.[[62]](#footnote-63) It also improved the prior art by personalizing searches more, which is also indicative of an inventive concept.[[63]](#footnote-64)

Judge Hughes dissented as to the search results improvement patents and would have held them unpatentable.[[64]](#footnote-65) He emphasized that the only thing added to the existing knowledge of search algorithms was the use of location data, which is the abstract idea itself.[[65]](#footnote-66) In his view, the issue of overly generic recommendations predates the internet, and asking people near a location for recommendations is a physical analogue to the patented invention.[[66]](#footnote-67)

# DISCLOSURE

## Definiteness

#### *Nature Simulation Systems, Inc. v. Autodesk, Inc.*, 23 F.4th 1334 (Fed. Cir. Jan. 27, 2022)

In this appeal from the Northern District of California, the Federal Circuit reversed a finding of invalidity for indefiniteness, holding that the lower court erroneously applied an overly stringent standard of “unanswered questions.”[[67]](#footnote-68)

Nature Simulation Systems’s ‘961 and ‘105 patents are directed to packaging computational data for 3D objects.[[68]](#footnote-69) At issue were two terms: “searching neighboring triangles of the last triangle pair that holds the last intersection point” and “modified Watson method.”[[69]](#footnote-70) Autodesk had requested construction of these terms, and NSS had claimed they do not require construction and instead should be given their ordinary meaning.[[70]](#footnote-71) The district court ruled, after a *Markman* hearing, that the terms were indefinite as there were “unanswered questions” about the term, stating that when the PTO issues a patent after amendment to clarify a term, but a PHOSITA would not understand the term, the Court should look to whether the challenger could point to unanswered questions.[[71]](#footnote-72) For the first term, Autodesk and the Court pointed to a lack of clarity as to whether searching requires a repeated search or just one, what a “last triangle pair” and “last intersection point” were, and that it was sometimes impossible to “extend an intersection line.”[[72]](#footnote-73) The Court pointed to similar flaws in the modified Watson method term, and held that definiteness required the questions to be answered in the claim language alone, in response to NSS’s claim that the questions were answered in the specification.[[73]](#footnote-74)

The Federal Circuit reversed.[[74]](#footnote-75) The Court noted that patent claims must be interpreted in light of the specification and held that the district court had failed to do the standard intrinsic/extrinsic evidence analysis.[[75]](#footnote-76) Applying said analysis, the Court noted multiple places in the specification that describe the decomposition and intersection method, and pointed to the challenger’s expert stating their familiarity with the Watson method.[[76]](#footnote-77) The Court then went to the prosecution history, where the examiner had originally rejected for indefiniteness and withdrew after an amendment that added some of the challenged language.[[77]](#footnote-78) The Court held that the district court erred by not giving deference to the examiner’s finding of definiteness, especially when they requested the language to be added in the first place.[[78]](#footnote-79)

Judge Dyk dissented, objecting both to the characterization of the district court opinion (noting that it included analysis of the specification), and to the holding of definiteness.[[79]](#footnote-80) He noted that the term “modified Watson method” does not and did not have an ordinary meaning in the art, and that the claim language includes ambiguous limitations not defined in the specification nor addressed by the majority.[[80]](#footnote-81) On the issue of deference, he argued that despite the examiner’s consideration, there was not a reasonable basis for the test of informing a PHOSITA with reasonable certainty being met, given the lack of explanation of the challenged terms.[[81]](#footnote-82)

#### *Niazi Licensing Corp. v. St. Jude Medical S.C., Inc.*, 30 F. 4th 1339 (Fed. Cir. Apr. 11, 2022)

On this appeal from the District of Minnesota, the Federal Circuit reversed the lower court’s finding of indefiniteness.[[82]](#footnote-83) The ’268 patent recites an “outer, resilient catheter” and an “inner, pliable catheter,” and the lower court found that the terms resilient and pliable were indefinite.[[83]](#footnote-84) The Federal Circuit disagreed, and after a lengthy recitation of past examples, held that resilience was given reasonable certainty by the claim language itself (“shape memory” and “sufficient stiffness”), while dependent claims provided examples.[[84]](#footnote-85) The Court also noted guidance in the written description about the design and materials, and that there was “torque control and stiffness.”[[85]](#footnote-86) For “pliable,” the Federal Circuit noted that while the claim language did not provide guidance, the written description gave examples, and that it was “extremely flexible and able to conform to various shapes.”[[86]](#footnote-87) The Court broadly held that each term was not purely subjective, and provided sufficient guidance to PHOSITAs, and that extrinsic evidence in the form of dictionary definitions comported with this.[[87]](#footnote-88) While one sentence in the specification stated that both the inner and outer catheters have a “predetermined shape and a certain degree of stiffness to maintain such shape during manipulation in the heart,” the Court dismissed this argument, noting that while both must be flexible, the patent overall made clear that the degree of stiffness for each was different between the two.[[88]](#footnote-89)

## Means-Plus-Function Claiming – Definiteness

#### *Dyfan, LLC v. Target Corp.*, 28 F.4th 1360 (Fed. Cir. Mar. 24, 2022)

On this appeal from the Western District of Texas, the Federal Circuit held that disputed claim language was not drafted in means-plus-function format and reversed the district court's finding of invalidity on that ground.[[89]](#footnote-90) Two pieces of claim language were disputed: “said code, when executed, further configured to [list of things the code does]” and “wherein the system is configured such that [list of system configurations].”[[90]](#footnote-91) For each limitation, the Court started by noting that the word “means” was not present so there was a presumption that 112 ¶ 6 did not apply.[[91]](#footnote-92) For the “code” limitation, the Court held that the lower court erred by ignoring unrebutted testimony from the defendant’s own expert that “code” and the similarly situated “application” were understood as structures to people of ordinary skill in the art (“a bunch of software instructions” and “a computer program intended to provide some service to a user,” respectively).[[92]](#footnote-93) The Federal Circuit referenced its decision in *Zeroclick*, where it held that “program” and “user interface code” were not black box recitations subject to 112 ¶ 6.[[93]](#footnote-94) It continued to describe that software is in many ways special: code is partly defined by its function, so courts must look beyond the initial term to see if a person of ordinary skill would understand the claim limitation as a whole to sufficiently describe a definite structure.[[94]](#footnote-95) For both limitations present here, there were descriptions of operations and enough functional language that a PHOSITA would understand the terms to connote structure.[[95]](#footnote-96) These cases are pretty clearly inconsistent with the Federal Circuit’s en banc decision in *Williamson v. Citrix*, which held that “nonce words” like “mechanism” can’t satisfy the structure requirement.

On the “systems” limitation, the Federal Circuit recognized that “system” in a vacuum can be a nonce word, but held that here the claim language itself defined the system to include sufficient structure to be definite.[[96]](#footnote-97) While Target argued that the claims failed to specify which components performed which functions, so the components were treated as a black box, the Court held that the language at issue referenced specific functions attributable to specific buildings, communication units, a mobile device, and a server.[[97]](#footnote-98) While noting the language was not a “model[] of clarity,” the Court reminded litigants and the lower court that the onus is on the defendant to prove indefiniteness, and held that this burden was unmet.[[98]](#footnote-99)

#### *VDPP LLC v. Vizio, Inc.*, 2022 WL 885771 (Fed. Cir. Mar. 25, 2022)

In this appeal from the Central District of California, the Federal Circuit reversed the district court’s finding of invalidity for indefiniteness, holding that the disputed language was not a means-plus-function limitation.[[99]](#footnote-100) The claim language at issue read “a storage adapted to: store one or more image frames; and a processor adapted to: [perform functions].”[[100]](#footnote-101) The lower court had held that storage and processor were nonce words, but the Federal Circuit held that they had paid inadequate attention to the presumption against 112(f) when the word “means” is absent.[[101]](#footnote-102) The Court continued to note that “processor” and “storage” are well-known terms to skilled artisans, rather than mere black boxes.[[102]](#footnote-103) The Court rejected Vizio’s argument that processor and storage inherently connoted function, noting that many devices (e.g. filter) are functionally named, and that *Dyfan* precluded this argument.[[103]](#footnote-104) Once again, the Federal Circuit urged lower courts to consider the claim as a whole when applying 112(f).[[104]](#footnote-105) But as in *Dyfan*, the court actually looked to the specification, *not* the claims, in making its structure determination.

## Enablement

***Amgen Inc. v. Sanofi*, 987 F.3d 1080 (Fed. Cir. Feb 11, 2021)**

In this appeal from the District of Delaware, the Federal Circuit affirmed the disputed claims were invalid under the enablement requirement because they were broad functional claims with little guidance on how to recreate the invention without undue experimentation.[[105]](#footnote-106)

Amgen’s ‘165 and ‘741 patents describe antibodies which bind to proprotein convertase subtilisin/kexin type 9 enzymes (“PCSK9”) and prevent them from binding to low-density lipoprotein (“LDL”) receptors with the goal of lowering LDL cholesterol levels.[[106]](#footnote-107) The specification lists amino acid sequences for twenty-six antibodies and claims antibodies that bind at least one of fifteen amino acids on the PCSK9 protein.[[107]](#footnote-108) At trial, the jury found Sanofi had not proven the patents invalid.[[108]](#footnote-109) The court, however, ultimately granted Sanofi’s motion for judgment as a matter of law for lack of enablement.[[109]](#footnote-110)

On appeal, the Federal Circuit upheld the district court’s ruling.[[110]](#footnote-111) Amgen argued that a person of ordinary skill in the art could make “make all antibodies within the scope of the claims by following a roadmap using anchor antibodies and well-known screening techniques as described in the specification or by making conservative amino acid substitutions in the twenty-six examples.”[[111]](#footnote-112) Thus, under the *Wands* factors, Amgen argued its claimed invention did not require “undue experimentation.”[[112]](#footnote-113) The court, however, disagreed.[[113]](#footnote-114) The court noted “although *Wands* gave birth to its eponymous factors, *Wands* did not proclaim that all broad claims to antibodies are necessarily enabled.”[[114]](#footnote-115) The functional claim limitations here “did not enable preparation of the full scope of these double-function claims without undue experimentation.”[[115]](#footnote-116) The claims were “far broader in functional diversity than the disclosed examples” and were in a “unpredictable field of science.”[[116]](#footnote-117) The court found a person of ordinary skill in the art could only discover the claimed embodiments through trial and error or just discovering a new one themselves.[[117]](#footnote-118) With such broad functional claims and narrow guidance, the court held no reasonable jury could conclude “anything but ‘substantial time and effort’ would be required to reach the full scope of claimed embodiments.”[[118]](#footnote-119)

The Supreme Court granted certiorari in October 2022. A decision is expected by June 2023.

# INVENTORSHIP

#### *Thaler v. Vidal*, 43 F.4th 1207 (Fed. Cir. October 27, 2022)

In this summary judgement decision, the Eastern District of Virginia held that an artificial intelligence machine may not be an inventor under the Patent Act.[[119]](#footnote-120) Stephen Thaler filed two patent applications, identifying the inventor’s given name as DABUS (an AI Thaler claims to own) and the family name as “invention generated by Artificial Intelligence.”[[120]](#footnote-121) The application also included a substitute statement in lieu of the oath required of patentees indicating that DABUS had no legal capability to execute an oath, so Thaler signed a declaration on its behalf.[[121]](#footnote-122) The Patent Office refused to process the applications so Thaler brought this case under the Administrative Procedure Act.[[122]](#footnote-123)

The Court noted that the PTO is entitled to *Skidmore* deference as it had carefully considered the law.[[123]](#footnote-124) Continuing to statutory construction, the Court held that the plain language definition of “inventor” in the Patent Act referenced “individuals,” and that individuals had been previously construed by the Supreme Court in the Torture Victim Protection Act to refer to “natural persons.”[[124]](#footnote-125) The Court further noted that the plain meaning of individual means a person, and cited several dictionaries.[[125]](#footnote-126) This conclusion was further buttressed by the statement in the act that an inventor must include a statement that “such individual believes himself or herself to be the original inventor,” which indicate natural personhood via personal pronoun use, and Federal Circuit precedent that inventors must be natural persons.[[126]](#footnote-127)

The plaintiff relied on policy considerations and the idea that the Constitution must protect innovation.[[127]](#footnote-128) The Court rejected this argument as insufficient to overcome that statutory plain language and noted the PTO’s ongoing studies of AI and innovation as evidence that the PTO had seriously considered the issue.[[128]](#footnote-129)

The Federal Circuit affirmed the E.D. Va. decision that an AI may not be an inventor for largely the same reasons.[[129]](#footnote-130) The Court interpreted the Patent Act’s requirement that an inventor be an “individual” to mean that an inventor must be a person.[[130]](#footnote-131) The Federal Circuit cited the same Supreme Court case, *Mohamad*, as the E.D. Va., in support of this interpretation, and noted the Patent Act uses personal pronouns (“himself” and “herself”) to refer to an “individual.”[[131]](#footnote-132) Lastly, it noted that an inventor must submit an oath indicating its “belief” that it is the original inventor, and noted that the ability of an AI to form or attest to those beliefs was not attested to in this case.[[132]](#footnote-133) Thaler argued that the use of “whoever” in section 101 and 271 indicates that the conception of an inventor should be broader, but the Court rejected each.[[133]](#footnote-134) The use in 101 is circumscribed by the requirement that patents satisfy the conditions of Title 35, including the inventorship definition, and 271 is referring to infringers, not inventors.[[134]](#footnote-135) Thaler again relied largely on policy arguments, which the Court rejected given its holding that the statutory language was clear.[[135]](#footnote-136)

# NOVELTY

#### *LG Elecs. Inc. v. ImmerVision, Inc.*, 39 F.4th 1364 (Fed. Cir. July 11, 2022)

In this appeal from the PTAB, the Federal Circuit affirmed the PTAB’s decision not to credit a piece of prior art, as a person of ordinary skill in the art would have treated the disclosure in the art as an apparent error.[[136]](#footnote-137) ImmerVision’s patent relates to capturing panoramic images, and the challenged claim includes the language “wherein the objective lens compresses the center of the image and the edges of the image and expands an intermediate zone of the image located between the center and the edges of the image.”[[137]](#footnote-138) LG, in its IPR petition, claimed this was anticipated by a Japanese patent application that has an embodiment that produces a compressed center and edges and an expanded intermediate zone, relying on a reconstruction from a table in the application.[[138]](#footnote-139) ImmerVision’s expert reconstructed the work, and found that the lens generated from the table in the application did not match the lens depicted in the rest of the patent.[[139]](#footnote-140) Further investigation revealed this was likely a transcription error in the application, and the PTAB so found.[[140]](#footnote-141) The question on appeal was whether a PHOSITA would have found the error apparent and would have disregarded it.[[141]](#footnote-142)

The Federal Circuit affirmed the PTAB’s decision.[[142]](#footnote-143) A few key pieces of evidence led to the conclusion that a PHOSITA would notice the table was an error. First, the table was corrected in the issued patent.[[143]](#footnote-144) Second, one column of the table was inadvertently copied from another table where the context was plainly different.[[144]](#footnote-145) Third, the table was out of step with the anticipated values from other tables in the application.[[145]](#footnote-146) These facts together were sufficient to find that a PHOSITA would have seen the table as incorrect information and disregarded it.[[146]](#footnote-147)

LG argued that precedent from *In re Yale* set forth an “immediately disregard or correct” temporal urgency standard for identifying errors, and that the process to determine the incorrectness of the information took ten to twelve hours.[[147]](#footnote-148) The Federal Circuit rejected the argument that a PHOSITA must immediately recognize the apparent error, as long as it is obvious.[[148]](#footnote-149) As such, the Federal Circuit held that a PHOSITA would have recognized the error, and as such affirmed the PTAB’s denial of IPR.[[149]](#footnote-150)

**Google LLC v. IPA Techs. Inc., 34 F.4th 1081 (Fed. Cir. May 19, 2022)**

In this appeal from the PTAB, the Federal Circuit held that the PTAB had not engaged in sufficient findings of fact and failed to resolve an evidentary conflict in an inventorship dispute.[[150]](#footnote-151) The patents in suit listed Martin and Cheyer as inventors, and were based on a paper by Martin, Cheyer, and a Dr. Moran.[[151]](#footnote-152) The PTO cited this paper as prior art, and the patentee submitted inventor declarations asserting that Moran was not a coinventor of the subject matter described and claimed in the paper so the reference was not prior art (as it was not “by others”).[[152]](#footnote-153) The PTO withdrew the challenge and granted the patent.[[153]](#footnote-154)

Google petitioned for IPR relying on the Martin reference, claiming that it described the work of an inventive entity (Martin, Cheyer, and Moran) different from the inventive entity of the patents (Martin and Cheyer).[[154]](#footnote-155) The PTAB concluded that Google had not provided sufficeint support to establish that Moran was an inventor, and Google appealed.[[155]](#footnote-156)

Martin and Cheyer testified that Moran was not an inventor, as he was in an administrative role and did not make core contributions to architecture.[[156]](#footnote-157) Moran testified, but the PTAB held that his testimony was insufficiently corrobrated.[[157]](#footnote-158) However, the Federal Circuit rejected this, noting that the standard for corroboration of evidence is not high, and that coauthorship is significant corroborating evidence.[[158]](#footnote-159) Further corroborating evidence included his role on the proejct, Cheyer’s acknowledgement of Moran’s technical contributions, and Moran being named on a related patent.[[159]](#footnote-160) As the PTAB did not resolve the dispute over whose testimony to credit, but merely stated they found all the witnesses credible, the Federal Circuit vacated and remanded for further fact-finding.[[160]](#footnote-161)

#### Sunoco Partners Mktg. & Terminals L.P. v. U.S. Venture, Inc., 32 F.4th 1161 (Fed. Cir. April 29, 2022)

In this appeal from the Northern District of Illinois, the Federal Circuit held that the experimental use doctrine did not insulate the patent from the on-sale bar.[[161]](#footnote-162) Sunoco had made a sale of the patented device, but claimed it was experimental based on a provision in the contract (which itself referred to the transaction as a sale) for pre-installation and post-installation testing.[[162]](#footnote-163) The buyer was required to conduct testing to demonstrate that the equipment satisfied minimum operating standards.[[163]](#footnote-164) The Federal Circuit held this provision to be inconclusive—it appeared to state merely that testing was being done to ensure satisfactory operation, not experimentation with design.[[164]](#footnote-165) The testing itself bore this out, as it was done by a third party and could have been done without the sale—hence, the experiment could not have been the motive behind the sale.[[165]](#footnote-166) The district court had improperly relied on the fact that the payment was via an agreement to buy butane, characterizing it as giving the patented technology for free.[[166]](#footnote-167) The Federal Circuit held that the overall testing was best read as acceptance tests on a sale, not true experimentation, notwithstanding testimony of the subjective intent of the inventors.[[167]](#footnote-168) As such, the Court rejected application of the experimental use exception.[[168]](#footnote-169)

# OBVIOUSNESS

#### *Adapt Pharma Operations Ltd. v. Teva Pharmaceuticals USA, Inc.*, --- F.4th ---, 2022 WL 402133 (Fed. Cir. Feb. 10, 2022)

In this appeal from the District of New Jersey, the Federal Circuit affirmed a finding of invalidity for obviousness.[[169]](#footnote-170) Adapt’s patents in suit relate to methods of treating opioid overdoses via intranasal administration of naloxone, using a higher dose for an intranasal administration than was used for intramuscular applications.[[170]](#footnote-171) Teva challenged the patent with two combinations of prior art references, each consisting of three unique references that independently taught higher doses, the spray applicator, and the other components used in the solution.[[171]](#footnote-172) The district court found a motivation to combine, that the prior art did not teach away, and that the offered objective indicia of nonobviousness were not sufficient.[[172]](#footnote-173)

The Federal Circuit affirmed. First, on motivation to combine, the Court held that a skilled artisan would have been motivated to formulate an improved product, select the necessary components and delivery vehicle, and raise the dose.[[173]](#footnote-174) Each step of this analysis had significant analysis in the factual record, including the prior art’s analysis of how intranasal naloxone was superior, that the formulation of including pH-limiting, chelating, and preserving agents was normal when formulating an intranasal solution, and that the FDA had already said publicly that a higher dose may be necessary for intranasal application.[[174]](#footnote-175) While the Court noted that the expert did not expressly provide a reason to combine, the documentary evidence was sufficient for the majority given the known drawbacks, the teachings, and the guidance from the FDA.[[175]](#footnote-176)

Adapt argued that a reference which Teva did not rely upon taught away from using the specific preservative that Adapt used in its patent.[[176]](#footnote-177) The Court disagreed, holding that a skilled artisan would not have been dissuaded from using the preservative, just from using it in high concentrations.[[177]](#footnote-178) While the Court noted that the district court may have erred in not analyzing the teach away standard explicitly, the judgment itself was proper and it cited the relevant cases.[[178]](#footnote-179)

Lastly, on the objective indicia of nonboviousness, the Court held that district court’s holding that the results were not particularly surprising was not clearly erroneous.[[179]](#footnote-180) Next, the Court held that the district court did not err in discounting evidence of copying, as in the ANDA context this may just reflect desire to be approved.[[180]](#footnote-181) The majority held that the patentee’s expert’s testimony that the industry was skeptical of the dose size because of the potential for withdrawal was not a sufficient concern to provide evidence of nonobviousness in light of the FDA’s calls for higher doses.[[181]](#footnote-182) Lastly, the Court held that although the district court erred in finding there was no long felt but unmet need for the product, the error was harmless because of the strong case of obviousness as a matter of law, given that the “long” need was only 3 years.[[182]](#footnote-183) The majority concluded by noting that it was a close case and giving deference to the district court’s ability to interrogate the factual record.[[183]](#footnote-184)

Judge Newman dissented, and would have held that there was no motivation to combine.[[184]](#footnote-185) She noted that neither the defendant’s expert nor any reference pointed to combining the specific components and concentrations claimed in the patent, that the extent of improvement was striking, and that the prior art warned that the preservative used caused unacceptable degradation.[[185]](#footnote-186) She also noted the multiple attempts by other countries to create nasal delivery systems that were inadequate as a persuasive objective indicator of nonobviousness, and cited the significant lifesaving benefits in an area of public concern.[[186]](#footnote-187)

#### *Teva v. Corcept*, 18 F.4th 1377 (Fed. Cir. Dec. 7, 2021)

In this appeal from the PTAB, the Federal Circuit affirmed a finding that Teva had failed to show obviousness of the claims.[[187]](#footnote-188) Corcept engaged in a clinical trial testing the use of mifepristone to treat hyperglycemia secondary to hypercortisolism in certain Cushing’s patients, and the FDA approved it while requiring Corcept to engage in a drug-drug interaction clinical trial to examine what occurs with the coadministration of CYP3A4 inhibitors, fearing safety concerns.[[188]](#footnote-189) The approved label warned against using the drug with strong CYP3A inhibitors, and advised limiting the dose to 300mg when doing so.[[189]](#footnote-190) Upon the completion of the clinical trial, Corcept discovered that the coadministration had positive effects and filed for the ‘214 patent, which disclosed a 600mg dose and the use of a strong CYP3A inhibitor.[[190]](#footnote-191)

Teva argued that the PTAB erred in requiring precise predictability rather than a reasonable expectation of success to show that an invention was obvious to try, and that the Board improperly required it to show the specific dose was safe rather than permitting a range.[[191]](#footnote-192) The Federal Circuit disagreed on both counts, holding that the Board only required a reasonable expectation of success around that specific dosage, which was crucial as it was the invention at stake.[[192]](#footnote-193) Given the warning on the label and the prior art, the PTAB and the Federal Circuit went further to note there was *no* expectation of success at higher dosages.[[193]](#footnote-194) Applying the standard for a claimed range of values, the Court agreed with the PTAB that the prior art did not have an overlap in ranges, as the prior art disclosed dosages of less than 300 mg.[[194]](#footnote-195)

#### *Auris Health, Inc. v. Intuitive Surgical Operations, Inc.*, 32 F.4th 1154 (Fed. Cir. Apr. 29, 2022)

In this appeal from the PTAB, the Federal Circuit held that the PTAB impermissibly rested its motivation to combine finding on general skepticism about the field of robotic surgery rather than specific skepticism about the improvement.[[195]](#footnote-196) The patent-in-suit related to robotic surgery systems using a controller to manipulate surgical tools.[[196]](#footnote-197) Auris petitioned for IPR, and the PTAB held that Auris failed to demonstrate the claims were obvious, as while the combination of the references disclosed each limitation of the challenged claims, a skilled artisan would not have been motivated to combine.[[197]](#footnote-198)

The Federal Circuit vacated and remanded, holding that the PTAB’s motivation to combine rationale was based just on generic skepticism of the industry, not industry skepticism related to a specific improvement.[[198]](#footnote-199) While there was general skepticism about the field of robotic surgery, this was insufficient.[[199]](#footnote-200) The Court did not analyze whether there was a motivation to combine in the rest of the record, and instead vacated and remanded for further consideration.[[200]](#footnote-201)

#### *Best Med. Int'l, Inc. v. Elekta Inc*., 46 F.4th 1346 (Fed. Cir. Aug. 29, 2022)

In this appeal from the PTAB, the Federal Circuit affirmed the PTAB’s findings on a PHOSITA’s level of skill and affirmed its finding of obviousness.[[201]](#footnote-202) The patent-in-suit is directed to a method of conformal radiation therapy of tumors, using the computation of an optimal radiation beam arrangement.[[202]](#footnote-203) The PTAB found that PHOSITA would have formal computer programming experience, and discounted the patentee’s expert for lacking such experience.[[203]](#footnote-204) Relying on this, the PTAB held for the challenger, finding the invention obvious.

The Federal Circuit started by examining the sparse record on the proper level of skill of a PHOSITA—the challenger relied primarily on its expert’s declaration, which opined that computer programming experience was necessary, as all the inventors were well-versed in writing computer programs.[[204]](#footnote-205) The patentee relied on its own expert’s opinion, which included no explanation for the rejection of the programming experience requirement beyond vagueness.[[205]](#footnote-206) The PTAB also relied on the specification and the patent itself, given the sparseness of the expert testimony—the invention is implemented on a computer and the specification has multiple references to programming.[[206]](#footnote-207) As such, the Federal Circuit held that the PTAB was supported by substantial evidence in its conclusion that a PHOSITA would have formal computer programming experience.[[207]](#footnote-208) The Court rejected the patentee’s other arguments, affirming the PTAB’s claim construction and motivation to combine analysis.[[208]](#footnote-209) As such, the Court affirmed the PTAB’s determination of obviousness.[[209]](#footnote-210)

# CLAIM CONSTRUCTION

#### *Astrazenca AB v. Mylan Pharmaceuticals Inc.*, 19 F.4th 1325 (Fed. Cir. Dec. 8, 2021)

In this appeal from the Northern District of West Virgina, the Federal Circuit vacated the District Court’s claim construction of “0.001%” and remanded, holding that rather than construing the term in its conventional significant figure manner, it should be construed to mean only that precise number with minor variations.[[210]](#footnote-211) The Court agreed with the lower court that the conventional meaning would be 0.0005%-0.0014%, relying on standard scientific convention and significant figures.[[211]](#footnote-212) However, the Court noted that the ordinary meaning in the abstract is not the same as the ordinary meaning after reading the entire patent, and held that as the written description and prosecution history place emphasis on the particular value of 0.001%’s stability, contrasted with slightly higher or lower concentrations, the proper claim construction was to narrow the range.[[212]](#footnote-213)

From the specification the Court notes that the application favorably compares efficacy at 0.001% with 0.0005%, which would be odd if when they wrote 0.001% they meant 0.0005%.[[213]](#footnote-214) The Court held this indicated that slight differences in this number could matter, down to the fourth decimal place.[[214]](#footnote-215) As such, the Court adopted a construction that adds a significant figure, allowing variations only from 0.00095% to 0.00104%.[[215]](#footnote-216)

The Court continued to note this was supported by the prosecution history, where the examiner required the inventors to show criticality of the 0.001% value compared to values slightly higher and lower, indicating again the sensitivity of this value.[[216]](#footnote-217) Throughout prosecution, the claimed concentration was narrowed without the qualifier of about, again indicating support for a narrow construction.[[217]](#footnote-218)

The Federal Circuit dismissed AstraZeneca’s argument that some other concentrations being expressed with additional significant figures indicates the particularity of this value, noting that elsewhere in the specification it discusses this concentration with a greater degree of precision.[[218]](#footnote-219) The Court also rejected AstraZeneca’s characterization of Mylan’s construction as limiting the scope of the claims to the preferred embodiment, relying on the analysis they undertook earlier.[[219]](#footnote-220)

Judge Taranto dissented, and would have construed the term in the ordinary significant figures manner, or perhaps limited it to 0.00054%-0.0014%, due to the inclusion of the significant figures on the lower bound at 0.0005%.[[220]](#footnote-221) He noted that there was no support in the record for the minor variations interpretation, which only adds to uncertainty.[[221]](#footnote-222) He argues that when AstraZeneca took out the word “about” from its claim language, it foreclosed this approach in favor of one relying on significant figures.[[222]](#footnote-223) He also strongly rejected the analysis of decimal points, emphasizing that the reason four decimal precision was used elsewhere was to obtain the same number of significant figures.[[223]](#footnote-224) Given the only argument he found persuasive from Mylan was the one on overlap, he would have at most accepted the construction limiting the bounds of the 0.001% limitation at the bounds of the 0.0005% limitation.[[224]](#footnote-225)

#### Pavo Sols. LLC v. Kingston Tech. Co., Inc., 35 F.4th 1367 (Fed. Cir. June 3, 2022)

In this appeal from the C.D. Cal., the Federal Circuit affirmed a District Court’s judicial correction of a phrase during claim construction.[[225]](#footnote-226) The patent contained the phrase “pivoting the case with respect to the flash memory main body.”[[226]](#footnote-227) Both the district court and the Federal Circuit, upon reading the full context of the claim language, read the claim to actually be referring to the pivoting of a case with respect to a cover, not the main body.[[227]](#footnote-228) The language of the claims actually required that the main body include a case and that that the main body and case be fixed with respect to each other.[[228]](#footnote-229) As such, the Court held that the “for pivoting” language had a minor clerical error.[[229]](#footnote-230)

The defendant argued that the error could not be minor because it replaced one structural element with another, and broadened the claim.[[230]](#footnote-231) The Court rebutted this by recognizing that refusing to substitute claim elements would lead to a nonsensical claim term, and that prior precedent had corrected minor errors that altered the structure (e.g. trackway became trackway toy).[[231]](#footnote-232) The Court also distinguished the *Chef America* 400-degree pizza case, as while in *Chef America* the claim language was clear but undesirable, here the claim language was on face incomprehensible and incompatible with the specification absent correction.[[232]](#footnote-233)

Having held that there was an obvious minor clerical error, the Court proceeded to determine that the correction was not subject to reasonable debate, since any proposed correction would result in the same claim scope (changing “case” to “cover” in the contested language).[[233]](#footnote-234) Once the proposed corrections were interpreted in light of the specification, there were no significant differences, so the correction was not subject to reasonable debate.[[234]](#footnote-235) Lastly, the Court examined the prosecution history, and held that nothing in the prosecution history militated against the construction.[[235]](#footnote-236)

#### *Kaufman v. Microsoft Corp.*, 34 F.4th 1360 (Fed. Cir. May 20, 2022)

In this appeal from the Sothern District of New York, the Federal Circuit held that Microsoft forfeited its *O2 Micro* challenge.[[236]](#footnote-237) Microsoft wanted to challenge the district court’s failure to clarify the reach of an “automatically” claim limitation for the jury, but Microsoft did not include a definition of the scope of the limitation in its proposed jury instructions, nor did it raise it in the charging conference.[[237]](#footnote-238) While *O2 Micro* has an exception if the issue was specifically made clear earlier, there was no evidence that was true here—indeed, the parties did not even request a construction of the word automatically at the *Markman* hearing or pre-trial hearing.[[238]](#footnote-239) As such, the Court held that Microsoft failed to preserve its *O2 Micro* challenge.[[239]](#footnote-240)

# INFRINGEMENT

## Inducement

#### *GlaxoSmithKline LLC v. Teva Pharmaceuticals UA, Inc*., 7 F.4th 1320 (Fed. Cir. Aug 5, 2021)

On this appeal from the District of Delaware, the Federal Circuit reinstated a jury finding of induced infringement for a generic drug, reversing a Judgment as a Matter of Law.[[240]](#footnote-241) GSK has sold carvedilol as a beta-blocker since 1997, originally to treat hypertension and heart failure.[[241]](#footnote-242) In 2003 the FDA approved it to reduce mortality in patients suffering from left ventricular dysfunction following myocardial infections.[[242]](#footnote-243) The compound was patented in 1985 (‘067), and in 1998 the ‘069 patent claiming a method to use carvedilol and one other compound to decrease mortality from heart failure was issued.[[243]](#footnote-244) In 2002 Teva filed an ANDA for generic carvedilol for all three purposes, claiming that the ‘069 patent was anticipated or obvious, and in 2007 launched with a “skinny” label that covered the non-heart failure uses.[[244]](#footnote-245) In 2008 the PTO issued a reissue patent (‘000) for decreasing mortality from heart failure, and in 2011 Teva, under instruction from the FDA, amended its label to include the heart failure use. Teva told the FDA it did not need to provide certification to the ‘000 patent because it received final approval of its ANDA before the patent issued.[[245]](#footnote-246) GSK sued on an inducement theory, and Teva argued that prior to 2011 it had carved out the relevant treatment (“partial label period”), and that it could not be liable at all because it did not cause others to infringe the method (“full label period”), but the jury found willful induced infringement in both periods.[[246]](#footnote-247)

The district court granted a JMOL because GSK failed to prove that Teva’s inducement actually caused physicians to prescribe generic carvedilol for treatment of heart failure, and that the left ventricular distress instruction, while it served an overlapping population, was distinct.[[247]](#footnote-248) The Federal Circuit reversed, Teva petitioned for en banc rehearing, and the Court granted them a panel rehearing because multiple *amici* were concerned that the prior opinion was unclear as to how ANDA filers could carve out uses.[[248]](#footnote-249) The Court clarified that generics can be held liable if they marketed a drug with a label describing therapeutic use, but not for merely marketing a skinny label omitting patented indications or merely noting equivalence to a brand name drug.[[249]](#footnote-250) However, the Federal Circuit still held that there was inducement, as post-myocardial infection, left ventricular distress, and congestive heart failure are so intertwined, and this is a fact question where the jury’s decision needs to be given deference.[[250]](#footnote-251)

While Teva argued that GSK’s submissions to the FDA for the Orange Book did not include left ventricular distress, the Federal Circuit affirmed that the jury’s holding could reasonably mean that they believed this filing included left ventricular distress in its general statements about heart failure.[[251]](#footnote-252) Teva and the dissent also emphasized the lack of evidence that doctors read labels to prescribe according to it, but the majority emphasized expert testimony indicating doctors read labels (although none of the doctors that testified had read labels, they claimed other doctors do) and boilerplate in Teva’s prescribing references indicating that doctors are supposed to be up to date on full product labelling.[[252]](#footnote-253) The majority also emphasized press releases from Teva that indicated the drug could be used as an equivalent to GSK’s product and to treat heart failure, and while these were before the ‘000 patent issued, they remained on the website later.[[253]](#footnote-254) The majority also found causation, because although Teva could point to other guidelines showing knowledge of how to use carvedilol, the jury had the relevant evidence in front of it and found that doctors were lead to prescribe it by Teva’s actions.[[254]](#footnote-255)

Judge Prost issued a lengthy dissent arguing that Teva’s carve out merely described an infringing use rather than encouraging it, that no expert testified that they themselves read the label/causation was incredibly tenuous, and that finding as the majority did leads to significant uncertainty for generic manufacturers.[[255]](#footnote-256)

The Supreme Court has asked for the views of the Solicitor General on whether to take the case.

#### *Roche Diagnostics Corp. v. Meso Scale Diagnostics, LLC*, 30 F.4th 1109 (Fed. Cir. Apr. 8, 2022)

In this appeal from the District of Delaware, the Federal Circuit reversed the district court's finding of induced infringement, holding that the scienter requirement was unmet and that Meso failed to prove that Roche committed in act of inducement within the six-year patent damages limitation period.[[256]](#footnote-257)

First, the Federal Circuit noted that the lower court improperly applied a lower “knew or should have known” standard, instead of the more stringent willful blindness/knowledge standard.[[257]](#footnote-258) It then cross-applied the district court’s finding from Roche’s JMOL motion on willfulness that “at no time did Roche have a subjective intent to infringe” to note that Roche couldn’t have either acted with knowledge that their actions constituted patent infringement or taken deliberate action to avoid confirming a high probability of wrongdoing.[[258]](#footnote-259) It therefore couldn’t have the requisite intent to induce infringement.

For the limitation period, Meso unsuccessfully argued that actions before the limitations period could support a finding of inducement if they continued to have an impact after the critical date.[[259]](#footnote-260) The Federal Circuit rejected this argument, successful at the district court, as inconsistent with *Standard Oil* and in any event lacking evidence of causation between the acts and the infringement.[[260]](#footnote-261) The court held that the act of inducement must occur within the six-year limitations period.

#### *Niazi Licensing Corp. v. St. Jude Medical S.C., Inc.*, 30 F. 4th 1339 (Fed. Cir. Apr. 11, 2022)

In this appeal from the District of Minnesota, the Federal Circuit affirmed the district court’s exclusion of Niazi’s expert testimony on inducement. St. Jude was arguing that Niazi’s induced infringement claim failed for lack of a direct infringer.[[261]](#footnote-262) Niazi’s expert report, which was served after the close of fact discovery, included the expert explaining that he himself had infringed the patent while using St. Jude’s products.[[262]](#footnote-263) Niazi failed to disclose this to St. Jude during fact discovery, and did not identify their expert as a potential fact witness under FRCP 26(a).[[263]](#footnote-264) The lower court, on motion from St. Jude, struck this fact from the report.[[264]](#footnote-265) Niazi on appeal argued that the district court improperly applied the four factor test for exclusion of undisclosed evidence from *Citizens Bank*, but the Federal Circuit noted that the *Citizens Bank* test is for violations predating FRCP 37(c)(1), and was not the test the district court applied here.[[265]](#footnote-266) Because Niazi failed to challenge the actual basis (whether the failure to disclose was “substantially justified or harmless”) for the exclusion, the Federal Circuit affirmed the exclusion.[[266]](#footnote-267)

# DEFENSES

## Assignor Estoppel

#### *Hologic, Inc. v. Minerva Surgical, Inc.*, 44 F.4th 1358 (Fed. Cir. Aug. 11, 2022)

On remand from the Supreme Court, the Federal Circuit held that assignor estoppel still applied despite the Supreme Court’s dramatic narrowing of the doctrine.[[267]](#footnote-268) Applying the new test’s second exception, the Court had to investigate whether claim 1 was “materially broader” than the claims assigned to Hologic originally.[[268]](#footnote-269) The Court held that the claim was not materially broader than the claims assigned to Hologic, so affirmed its original decision and held that assignor estoppel still applied.[[269]](#footnote-270)

The primary dispute was whether claim 1 of the ‘348 patent was materially broader than claim 31 of the ‘072 application. To resolve this, the Court first had to decide whether claim 31, which was cancelled well before the assignment, was assigned and warranted to be valid at the time of assignment.[[270]](#footnote-271) The Court started by holding that the assignor’s cancellation of claim 31 said nothing about its invalidity—an assignee would have understood that they could have prosecuted it later.[[271]](#footnote-272) The Federal Circuit thus held that it was properly assigned, as the claim remained viable and the assignment gave the rights to any continuations.[[272]](#footnote-273)

In determining whether claim 1 of the patent is materially broader than claim 31 of the application, the Court construed each claim and compared their material aspects.[[273]](#footnote-274) This dispute came down to the difference between moisture impermeable and moisture permeable devices.[[274]](#footnote-275) Claim 1 was construed to cover moisture-impermeable devices in a previous case, and the Court construed claim 31 to do the same.[[275]](#footnote-276) The court relied on the lack of an express limitation, and rejected Minerva’s counterarguments on claim construction.[[276]](#footnote-277) As such, the Court found that assignor estoppel applied, as an assigned claim that was warranted to be valid was not materially broader than the claim that was later asserted.[[277]](#footnote-278)

# REMEDIES

## Damages

#### *California Institute of Technology v. Broadcom Ltd*., 25 F.4th 976 (Fed. Cir. Feb. 4, 2022)

In this appeal from the Central District of California, the Federal Circuit held that the district court’s jury instructions on extraterritoriality were not erroneous, but that Caltech’s two-tier damages theory was not supportable, and vacated the award.[[278]](#footnote-279) The district court did not give a jury instruction indicating a presumption against extraterritoriality.[[279]](#footnote-280) The Federal Circuit held that this presumption was inapplicable, as the dispute between the parties was not about the extraterritorial application of laws, but merely whether the transactions at issue occurred domestically.[[280]](#footnote-281) The Court noted that the jury instructions included an instruction requiring the jury to find that the infringement occurred in the United States.[[281]](#footnote-282) The Court also held that the district court’s jury instruction that a “sales cycle leading to design wins” can trigger a U.S. sale was not erroneous, as the lower court properly noted that when there were substantial activities entirely outside the U.S. it would not constitute a domestic sale. [[282]](#footnote-283)

Caltech’s damages theory relied on two simultaneous hypothetical negotiations, one with Broadcom at the chip level and one with Apple at the device level, excluding from Broadcom’s hypothetical chip license any Broadcom chips incorporated into Apple products sold in the U.S. and treating those at a different royalty rate.[[283]](#footnote-284) The district court relied on Caltech’s experts stating that there would be no cross talk and there would be separate infringers, seeing no concern of double recovery because they were carved out.[[284]](#footnote-285) The Federal Circuit held this was erroneous, as the mere fact of the two being separate infringers does not support treating the chips differently or submitting a two-tier damage theory without more evidence that the companies would engage in separate negotiations. The Court held that the exclusion of chips sold to Apple from the Broadcom license was contrived and contrary to custom, leading to error and vacating the award.[[285]](#footnote-286)

#### *Apple Inc. v. Wi-LAN Inc.*, 25 F.4th 960 (Fed Cir. Feb. 4, 2022)

In this appeal from the Southern District of California, the Federal Circuit vacated the lower court’s denial of a motion for a new trial on damages, agreeing with Apple that the expert testimony from the plaintiff was fatally flawed.[[286]](#footnote-287) Wi-LAN’s expert culled 150 license agreements from Wi-LAN down to the three most similar on the grounds that they involved phones, became effective in 2013 or later, licensed patents covering LTE or related technology, and were executed after the asserted patents issued.[[287]](#footnote-288) Each agreement also licensed other patents.[[288]](#footnote-289) Wi-LAN’s expert then set out to adjust for this difference, arguing that in practice only a handful of valuable patents determine the royalty rate, and that the patents-in-suit were the key ones, based on them being focused on in negotiations, that one licensor reupped, and that Apple chose to infringe rather than design around.[[289]](#footnote-290) The Court held that this was untethered to the case. The licensees did not continue to use the technology after infringing, there was no evidence that the patents-in-suit were discussed during negotiations for comparable licenses, and were treated as an add-in (being in the non-asserted patents for the agreements).[[290]](#footnote-291) Two of the three licenses did not include the ‘757 patent, one of the patents-in-suit here, at all, and the one that did included it only as a non-asserted patent in an appendix.[[291]](#footnote-292) Only one of the two patents was discussed in a single one of the three licenses used as examples, and there it was among five more asserted patents that the expert did not compare its value to.[[292]](#footnote-293) Given these methodological errors, the Court held that the expert’s opinion was unreliable and should have been excluded, and Apple should have been granted a new trial on damages.[[293]](#footnote-294)

#### *Roche Diagnostics Corp. v. Meso Scale Diagnostics, LLC*, 30 F.4th 1109 (Fed. Cir. Apr. 8, 2022)

After vacating the inducement judgement, the Federal Circuit vacated the damages award and remanded for a new trial on damages.[[294]](#footnote-295) In doing so, the Court cautioned the district court and the parties to pay careful attention to apportionment, and strongly implied that the prior damages award was improper.[[295]](#footnote-296) The jury awarded 75% of Roche’s profits on the infringing product to the plaintiff, and Meso’s expert did not seek to distinguish between damages attributable to infringing and non-infringing components.[[296]](#footnote-297) While Meso and the district court argued that an alternative theory, referring to a 2003 license agreement, could support the damages award, the Federal Circuit cautioned that Meso would need to do more to demonstrate comparability between a license to 100 patents and the three at issue here.[[297]](#footnote-298) In any event, because the inducement verdict was reversed but not the direct infringement verdict, everyone agreed a new trial on damages was necessary.[[298]](#footnote-299)

#### *Pavo Sols. LLC v. Kingston Tech. Co., Inc.*, 35 F.4th 1367 (Fed. Cir. June 3, 2022)

In this appeal from the C.D. Cal., the Federal Circuit held that the district court did not abuse its discretion in declining to exclude damages testimony that relied on a non-payment term in a competing license.[[299]](#footnote-300) The plaintiff presented a reasonable royalty theory with a 40 cent per unit rate, using the negotiations between the prior patent holder, CATR, and a company called IPMedia.[[300]](#footnote-301) Both parties agreed this license was comparable, and it included a 1 cent running royalty for sales of the product and a representation that this was 25% of the profits.[[301]](#footnote-302) The plaintiff’s expert opined that a profit-split model was appropriate to use as a factor in determining damages, and reduced it to 18.75% because of differences in profitability.[[302]](#footnote-303) The defendant argued this relied not on the payment term, but on a nonbinding representation.[[303]](#footnote-304) The Court held this was not unduly speculative, as the representation merely provided context for the royalty and was not a separate payment provision, contrasting it with a punitive damages provision which might not ever be triggered.[[304]](#footnote-305)

The defendant next argued that the plaintiff’s expert failed to apportion for non-infringing features, as its total cost for the product materials were less than the proposed royalty.[[305]](#footnote-306) The court rejected this, noting that the further apportionment is not required when a sufficiently comparable license is used, and that material costs are not the same as the value of the feature.[[306]](#footnote-307) The Court thus denied the defendant’s challenges to the plaintiff’s damages testimony and affirmed the jury award.

## Attorneys’ Fees

#### *Realtime Adaptive Streaming LLC v. Netflix, Inc.*, 41 F.4th 1372 (Fed. Cir. July 27, 2022)

In this appeal from the C.D. Cal., the Federal Circuit affirmed the district court’s fee award against the patentee for proceedings in the C.D. Cal. and affirmed the district court's refusal to award fees against the patentee for proceedings in the D. Del. and the PTAB.[[307]](#footnote-308) The plaintiff filed for infringement originally in the D. Del., Netflix filed a motion to dismiss for 101 and petitioned for IPR (which was instituted).[[308]](#footnote-309) A magistrate judge recommended dismissing on 101, and the judge found related cases ineligible under 101, but Realtime voluntarily dismissed before the district court could rule.[[309]](#footnote-310) The next day the plaintiff sued in the C.D. Cal., despite having earlier stated that transferring to the N.D. Cal. would be inconvenient.[[310]](#footnote-311) Netflix moved for fees and to transfer back to Delaware, and Realtime again voluntarily dismissed.[[311]](#footnote-312) Netflix renewed its motion for fees for all three disputes, and the district court granted fees for the California actions but not for the Delaware or PTAB actions.[[312]](#footnote-313)

The Federal Circuit affirmed, applying Ninth Circuit law.[[313]](#footnote-314) The Court held that Realtime’s actions in refiling were improper and unjustified—between the magistrate judge’s report recommending the court find the claims ineligible and the Delaware judge’s ruling in a parallel action that related patents were ineligible, Realtime was trying to dodge an impending unfavorable outcome.[[314]](#footnote-315) Resisting transfer back to the forum it originally chose and argued was more convenient was a further mark of impropriety and forum shopping.[[315]](#footnote-316) However, the Court held that there was no evidence that the initial filing of the Delaware action was untenable, and the impropriety did not begin until the refiling in California.[[316]](#footnote-317)

# PRACTICE AND PROCEDURE

## Personal Jurisdiction

#### *Apple Inc. v. Zipit Wireless, Inc.*, 30 F. 4th 1368 (Fed. Cir. Apr. 18, 2022)

In this appeal from the Northern District of California, the Federal Circuit reversed a dismissal of a declaratory judgment action for lack of personal jurisdiction.[[317]](#footnote-318) Zipit, a Delaware corporation located in South Carolina, communicated with Apple over some wireless instant messaging patents. They met at Apple’s headquarters in Cupertino (in the Northern District), and exchanged several rounds of correspondence.[[318]](#footnote-319) Negotiations failed, and four years later Zipit sued Apple in the Northern District of Georgia.[[319]](#footnote-320) It’s not entirely clear why, but Zipit voluntarily dismissed the case without prejudice two weeks later. Apple then filed a declaratory judgement action in the Northern District of California.[[320]](#footnote-321) The district court dismissed for lack of personal jurisdiction, holding that while there were sufficient minimum contacts, and the jurisdiction would not be unreasonable, it saw the Federal Circuit’s opinion in *Breckenridge Pharm. v. Metabolite Labs* as establishing a bright-line rule that when contacts were in the form of a demand letter, they were insufficient to establish personal jurisdiction.[[321]](#footnote-322)

The Federal Circuit reversed and held that minimum contacts were satisfied via the notice letters directed to California.[[322]](#footnote-323) The Court favorably cited *Xilinx*, where two notice letters and travelling to the forum state to discuss allegations of infringement were sufficient to establish minimum contacts, and distinguished *Autogenomics*, where a notice letter and flying to the forum state to discuss allegations of infringement were insufficient to establish minimum contacts.[[323]](#footnote-324) The factual distinctions from *Autogenomics* included that Zipit kept Apple apprised of the status of IPRs, and that it escalated threats of infringement as willful, but more importantly held that the totality of the precedent argued that cease and desist letters alone can provide minimum contacts.[[324]](#footnote-325)

After finding minimum contacts, the Court held that exercising jurisdiction was not unreasonable, noting there is no bright-line rule that demand letters cannot create specific jurisdiction.[[325]](#footnote-326) While there is a policy consideration to encourage settlement by allowing patentees to not subject themselves to a wide variety of jurisdictions by merely sending demand letters, that is but one factor to consider under *Burger King*.[[326]](#footnote-327) Applying those other factors, the burden on Zipit of litigating in California was inconvenient, but not unconstitutionally so, given that Zipit was able to travel to California to discuss infringement earlier.[[327]](#footnote-328) The Court also held California has defined interests in protecting its companies and advancing science, and that Apple had an interest in convenient relief.[[328]](#footnote-329) The fourth factor, the judicial system’s interest in efficient resolution of controversies, is where the settlement-promoting factor arises, and weighed for Zipit.[[329]](#footnote-330) Lastly, there was no conflict between states.[[330]](#footnote-331) In total, California’s and Apple’s interests were sufficient for jurisdiction to not be unreasonable, irrespective of the settlement-promoting rationale and the burden on Zipit.[[331]](#footnote-332)

## Venue and Transfer

#### *In re: Volkswagen Group of America*, 28 F.4th 1023 (Fed. Cir. Mar. 9, 2022)

The Federal Circuit granted Volkswagen’s and Hyundai’s writs of mandamus to dismiss or transfer for lack of venue in the Western District of Texas.[[332]](#footnote-333) The district court had found proper venue by finding that independent car dealerships in the Western District gave petitioners sufficient control to establish a regular and established place of business despite a Texas law prohibiting auto manufacturers from directly operating or controlling a dealership, as the dealerships were agents of the manufacturers.[[333]](#footnote-334)

The Federal Circuit reversed, holding that Stratos failed to demonstrate the dealerships were agents.[[334]](#footnote-335) First, the court noted that there is a distinction between interim control that evidences agency (e.g. step by step directions for maintenance and installation), and control that provides constraints and standards.[[335]](#footnote-336) Second, agency in one aspect of activity does not create an agency relationship for all purposes.[[336]](#footnote-337) The Federal Circuit held that the manufacturers lacked interim control over car sales or warranty work, as once the cars leave their possession they have no authority over the manner in, or price for, cars are sold.[[337]](#footnote-338) While there are constraints of displaying the logo, providing sales reports, and keeping minimum inventory, these didn’t rise to the level of control creating an agency relationship.[[338]](#footnote-339) The Court also noted the parties themselves, in their franchise agreements, disclaimed an agency relationship, and cited to other circuits agreeing that dealerships are not agents.[[339]](#footnote-340) As such, the Court held that the Western District’s declining to dismiss or transfer based on these dealerships was an abuse of discretion.[[340]](#footnote-341)

#### *In re Monolithic Power Sys., Inc.*, 50 F.4th 157 (Fed. Cir. Sept. 30, 2022)

The Federal Circuit denied a petition for a writ of mandamus to transfer the case from the Western District of Texas to the Northern District of California.[[341]](#footnote-342) The district court had found venue proper due to Monolithic’s hiring of employees to service Austin clients, the living of several employees in the district, and its giving of lab equipment and products to employees in the district.[[342]](#footnote-343) It then rejected transfer.[[343]](#footnote-344)

The Federal Circuit refused to grant a writ of mandamus, holding that the district court’s venue ruling did not implicate a basic unsettled legal issue or require immediate intervention.[[344]](#footnote-345) While Monolithic argued that the question of using the residences of employees to determine venue was becoming more relevant due to the rise of remote work, the Court did not believe that question was broad enough on this set of facts—the shipping of highly technical equipment to employees in the district was enough in this case to make it idiosyncratic and not fit for the creation of a broad rule.[[345]](#footnote-346) On the transfer motion, the Court held that there was not a clear abuse of discretion—the district court had weighed the proper factors, and given that the events underlying the suit largely took place outside either the N.D. Cal. or the W.D. Tex., there was little reason to disturb the district court’s findings.[[346]](#footnote-347)

#### *In re Apple Inc.*, 52 F.4th 1359, 2022 WL 16753325 (Fed. Cir. Nov. 8, 2022)

The Federal Circuit granted Apple’s petition for writ of mandamus and directed Judge Albright to promptly rule on Apple’s pending transfer motion and stay all proceedings until the transfer is resolved.[[347]](#footnote-348) Aire sued Apple in October 2021, Apple moved to transfer in April 2022, and Judge Albright ordered that he would not rule on the transfer motion until the close of fact discovery (30 weeks from then) and six more weeks of re-briefing.[[348]](#footnote-349) Apple filed a petition for a writ of mandamus, and the Federal Circuit granted it.[[349]](#footnote-350) The Court noted that while a district court has discretion in managing its docket, an appellate court can correct a clearly arbitrary refusal to act on a longstanding pending transfer motion.[[350]](#footnote-351) It further emphasized that venue motions should be prioritized, and that by the time the motion would be considered here it would have been a full year, with invalidity and infringement contentions having already been served after the close of discovery.[[351]](#footnote-352) It also noted that both parties here agreed that no additional discovery or briefing was necessary, and that Aire consented to resolving the motion at any time.[[352]](#footnote-353) Because transfer motions are the first order of business, the Court granted Apple’s petition and ordered Judge Albright to promptly rule.[[353]](#footnote-354)

# PTO AND PTAB PROCEDURE

## Patent Extensions and Continuations

#### *Hyatt v. United States Pat. & Trademark Off.*, 48 F.4th 1347 (Fed. Cir. Sept. 8, 2022)

In this appeal from the Eastern District of Virginia, the Federal Circuit affirmed the lower court’s holding that the Patent Office was not arbitrary and capricious in applying a restriction requirement on a GATT Bubble transitional application.[[354]](#footnote-355) Mr. Hyatt had a GATT Bubble patent application pending since 1995, so the term would be 17 years from granting, rather than 20 years from filing.[[355]](#footnote-356) The Urugay Round Agreements Act authorized the PTO to prescribe regulations to provide further limited reexamination of GATT Bubble transitional applications that had been pending for two years or longer, and for those pending for three years or longer, to provide for examination of more than one independent invention.[[356]](#footnote-357) The PTO promulgated Rule 129, which stated that “no requirement for restriction shall be made or maintained,” except where “due to actions by the applicant” the examiner has not made a requirement for restriction yet.[[357]](#footnote-358)

An examiner instructed Hyatt to select a subset of his 200 claims in one application.[[358]](#footnote-359) The examiner issued a non-final rejection, and Mr. Hyatt entirely rewrote the claims.[[359]](#footnote-360) The examiner found that the amendments shifted seven of the eight claims to a different species of computer systems and processes and issued a restriction requirement between the originally selected claims and the amended claims.[[360]](#footnote-361) Hyatt, not wanting to have to file a new application and lose the GATT Bubble benefits, sued in the E.D. Va. under the Administrative Procedure act, alleging arbitrary and capricious behavior.[[361]](#footnote-362) The Court rejected the challenge, holding that failing to disclose claims to a separate invention and filing years later fell within Rule 129’s applicant-action exception to the bar on transitional applications.[[362]](#footnote-363)

On appeal to the Federal Circuit, Hyatt argued that the applicant-action exception cannot apply because he was not undertaking an “action” but an “inaction” by failing to disclose the claims.[[363]](#footnote-364) This was not successful, as failing to disclose is an act of withholding.[[364]](#footnote-365) The Federal Circuit also pointed to the MPEP as providing notice that inaction fell within this provision and distinguished some cases from outside the patent context.[[365]](#footnote-366)

Hyatt next tried to argue that the exception conflicted with other portions of Rule 129. Specifically, he argued that 129(a), which provided that an applicant is entitled to have a submission considered on the merits after final rejection, including claim amendments, would be swallowed by the applicant-action exception.[[366]](#footnote-367) He also argued that Rule 129(b)(2) recognized that transition applications can have multiple inventions. [[367]](#footnote-368) The Federal Circuit rejected both arguments. Section 129(a) does not reference restriction practice or override the more specific provision, and section 129(b)(2) on its terms only applies when a requirement for restriction cannot be made.[[368]](#footnote-369) Finding all of Hyatt’s arguments unpersuasive, the Federal Circuit affirmed the restriction requirement.[[369]](#footnote-370)

#### *SawStop Holding LLC v. Vidal*, 48 F.4th 1355 (Fed. Cir. Sept. 14, 2022)

In this appeal from the Eastern District of Virgina, the Federal Circuit affirmed a denial of a patent term extension when the patents required further amendment after the PTAB appeal.[[370]](#footnote-371) The ’476 patent in this case was rejected as obvious, had this rejection affirmed on appeal on a new ground, had a RCE filed, and eventually got a claim allowed.[[371]](#footnote-372) The PTO rejected a patent term extension.[[372]](#footnote-373) For the ’796 patent, the examiner rejected claim 1 on anticipation and double patenting and claim 2 for anticipation.[[373]](#footnote-374) On appeal, the PTAB allowed claim 2, but affirmed both rejections of claim 1.[[374]](#footnote-375) The patentee sued challenging the anticipation rejection of claim 1, and won a reversal in the D.D.C.[[375]](#footnote-376) The PTAB saw the outstanding double patenting rejection, and gave the patentee two choices: file a terminal disclaimer or cancel claim 1 and rewrite claim 2 as independent—the patentee chose the latter.[[376]](#footnote-377) Finally, the patentee filed an RCE and continued prosecution, and the patent was allowed.[[377]](#footnote-378) The PTO granted a patent term adjustment for delay caused by the reversal of the rejection of claim 2 but rejected any additional extension for the delay caused by the appeal of claim 1 to the D.D.C.[[378]](#footnote-379) The E.D. Va. granted summary judgment to the PTO.[[379]](#footnote-380)

The Federal Circuit started by noting two requirements from 35 U.S.C. § 154(b)(1)(C): that an adverse determination of patentability be reversed, and that the application reviewed in that appeal issue as a patent as a result of that reversal.[[380]](#footnote-381) For the ‘476 patent, the patentee argued that any rejection overturned on appeal is a reversal as of a determination of patentability, regardless of any new grounds of rejection.[[381]](#footnote-382) The PTO countered that the claim was unpatentable both before and after the appeal. The Federal Circuit agreed, holding that new grounds for rejection in an appeal do not mean the decision of unpatentability was reversed.[[382]](#footnote-383) Independently, the Federal Circuit held that the claim did not “issue under a decision in the review” because after the appeal there was another year of prosecution and amendments that substantively changed the claim.[[383]](#footnote-384)

On the ‘796 patent, the patentee argued that the statue only requires the reversal of “an” adverse determination of patentability.[[384]](#footnote-385) The Federal Circuit rejected this argument, noting that the singular applied to the determination of *patentability*, not the basis for *rejection*.[[385]](#footnote-386) The Court held again that claim 1 of the patent was unpatentable both before and after the appeal, precluding a patent term adjustment.[[386]](#footnote-387) Once again, the Court independently held that the patent did not issue under the decision in the review because of substantive amendments.[[387]](#footnote-388)

## Amendments

#### *Am. Nat'l Mfg. Inc. v. Sleep No. Corp.*, 52 F.4th 1370 (Fed. Cir. Nov. 14, 2022)

In this appeal from the PTAB, the Federal Circuit held that it was not an error for the PTAB to permit the patent owner to present amendments that did not respond to an unpatentability ground.[[388]](#footnote-389) Sleep Number admitted that some of its proposed changes were to achieve consistency in terminology across the patent family (although they also appear to have resolved a 112 problem), and American National argued this was in violation of 37 C.F.R. 42.121’s requirement that amendments be aimed at responding to a ground of unpatentability at issue.[[389]](#footnote-390) The PTAB held that the regulation does not require each word to be amended solely to overcome an instituted ground, and that as long as a change to the claim is made to overcome an instituted ground, the patentee is free to include other limitations.[[390]](#footnote-391)

The Federal Circuit affirmed, noting that nothing in the AIA precluded this behavior, and that the regulation was intended to merely require a minimal level of relevance to the IPR.[[391]](#footnote-392) American National raised a due process concern, arguing that it is unfair to allow an amendment to resolve 112 problems, since the IPR may not challenge those problems.[[392]](#footnote-393) The Court rejected this argument, noting that petitioners can challenge new claims on 112 grounds.[[393]](#footnote-394) This seems somewhat non-responsive—the issue isn’t that the new claims have 112 issues, but that the petitioner is allowed to resolve a 112 problem in the original patent via an amendment. Nevertheless, the Court noted the public interest in ensuring patentable claims and, because each claim here had an amendment relating to the instituted ground, found that the PTAB did not err in allowing the amendments to be presented.[[394]](#footnote-395)

## Reissue

#### *In re McDonald*, 43 F.4th 1340 (Fed. Cir. Aug. 10, 2022)

In this appeal from the PTAB, the Federal Circuit held that the recapture rule precluded the patent applicant from reclaiming claim scope deliberately suspended during prosecution for subject matter eligibility reasons, and that the reissue declaration failed to identify an error correctable by reissue.[[395]](#footnote-396) In the application leading to the ‘901 patent, McDonald amended his claims by adding a “processor” to certain limitations to avoid a 101 challenge.[[396]](#footnote-397) While this application was pending, he filed a continuation that issued as the ‘111 patent, which also included processor limitations.[[397]](#footnote-398) McDonald filed a reissue application seeking to broaden the claims of the ‘111 patent, removing the processor limitations.[[398]](#footnote-399) His reissue declaration claimed there was a correctable error, as the patentee had claimed less than he had the right to.[[399]](#footnote-400) The PTO rejected the amendment as obvious, and on appeal the PTAB affirmed and added rejections for improper reissue and impermissibly attempting to recapture the subject matter intentionally surrendered.[[400]](#footnote-401)

The Federal Circuit first affirmed the recapture rejection.[[401]](#footnote-402) By first adding the processor limitation to overcome a rejection then removing them, he had clearly recaptured scope.[[402]](#footnote-403) While McDonald argued that an amendment to overcome a 101 rejection was not a prior art rejection under *Cubist*, the Court held that it need not be, so long as the amendment is an intentional surrender of claim scope.[[403]](#footnote-404) Based on policy considerations and the purpose of the recapture rule, the Court held that 101 rejections are more like 102 or 103 rejections than 112 rejections for the purposes of the recapture rule, insofar as if the applicant disclaims scope to overcome the rejection, they may not recapture the scope later.[[404]](#footnote-405) The Court then affirmed the defective reissue declaration rejection, as the statement of error was uncorrectable by reissue since doing so would violate the recapture rule.[[405]](#footnote-406)

## Inter Partes Review Procedure

#### *California Institute of Technology v. Broadcom Ltd.,* 25 F.4th 976 (Fed. Cir. Feb. 4, 2022)

In this appeal from the Central District of California, the Federal Circuit overruled its precedent from *Shaw*, holding that now IPR estoppel applies not just to claims and grounds asserted in the petition and instituted for consideration, but to all grounds not stated in the petition but which reasonably could have been asserted against the claims included in the petition.[[406]](#footnote-407)

The main consideration for this change was that *Shaw* relied on the assumption, overturned by the Supreme Court in *SAS*, that the PTAB could institute review on only some grounds in a petition.[[407]](#footnote-408) The Court noted that at the time of *Shaw*, the institution decision decided the scope of review, while now it is more accurate to say a claim is raised “during” IPR if it is in the petition, not the institution decision, as the petition defines the scope of the review.[[408]](#footnote-409) Given that it was undisputed that Apple and Broadcom were aware of the prior art references they sought to raise in the district court when Apple filed its IPR petitions, the Court held that they were barred from raising challenges based on them.[[409]](#footnote-410)

#### *Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367 (Fed. Cir. Feb. 1, 2022)

In this appeal from the PTAB, the Federal Circuit reversed the Board and held that Applicant Admitted Prior Art (AAPA) does not constitute a printed publication eligible to serve as the basis of an IPR claim under 35 U.S.C. § 311(b).[[410]](#footnote-411) The PTAB found several claims of Qualcomm’s ‘674 patent unpatentable, relying on statements in the challenged patent acknowledging that most of the limitations were already known.[[411]](#footnote-412) Qualcomm appealed, arguing that 35 U.S.C. § 311(b)’s requirement that IPRs be filed “only on the basis of prior art consisting of patents or printed publications” precluded relying on AAPA.[[412]](#footnote-413) Qualcomm’s interpretation was that AAPA is not prior art consisting of patents, nor of prior art consisting of a printed publication, so cannot be used as the basis for an IPR.[[413]](#footnote-414) Apple interpreted this as a misreading of 311(b), and would permit the use of any prior art consisting of patents or printed publications, including AAPA.[[414]](#footnote-415) The PTO asked for a remand, agreeing with Qualcomm’s interpretation that AAPA does not fall within the ambit of 311(b), but would permit the use of AAPA as evidence of general knowledge instead of as the basis of claims.[[415]](#footnote-416)

The Federal Circuit agreed with Qualcomm and the PTO that the patents or printed publications that form the basis of an IPR must themselves be prior art based on the text of the statute, excluding any descriptions in the challenged patent.[[416]](#footnote-417) The Court started with the text, then noted wording in the Supreme Court’s *Return Mail* decision that implied that the patents or printed publications had to exist at the time of the application, and in the Federal Circuit’s *LSI Corp.* decision that implied the same.[[417]](#footnote-418) It continued to argue that this best aligned with the interpretation of 35 U.S.C. § 301(a) in *Lonardo*, which distinguished “consideration of other patents or printed publications” from “prior art patents or printed publications.”[[418]](#footnote-419) The Court did soften its decision by noting that a petitioner may rely on evidence beyond prior art documents in IPRs, even though it may not qualify as the basis for a ground in the petition.[[419]](#footnote-420) The Court remanded to determine if the AAPA in this case was the “basis” of Apple’s challenge.[[420]](#footnote-421)

#### *Hunting Titan, Inc. v. DynaEnergetics Europe GmbH*, 28 F.4th 1371 (Fed. Cir. Mar. 24, 2022)

In this appeal from the Precedential Opinion Panel, the Federal Circuit narrowly affirmed the Panel’s decision that while the PTAB may advance a ground of unpatentability that a petitioner does not advance, they should only need to do so in rare situations, on the grounds that the challenge was improperly preserved.[[421]](#footnote-422) Hunting Titan petitioned for IPR of DynaEnergetics’s patent, including on grounds of anticipation by a Schacherer reference.[[422]](#footnote-423) The PTAB instituted and found the claims unpatentable.[[423]](#footnote-424) DynaEnergetics moved to amend and add substitute claims.[[424]](#footnote-425) Hunting Titan opposed the motion to amend, advancing only obviousness grounds, and not asserting Schacherer.[[425]](#footnote-426) Nevertheless, the PTAB determined the original and substitute claims were unpatentable as anticipated by Schacherer.[[426]](#footnote-427) DynaEnergetics requested and received rehearing from the Precedential Opinion Panel, which reversed the PTAB’s decision to deny the motion to amend.[[427]](#footnote-428) The Panel held that the Board could raise a sua sponte ground of unpatentability only in rare circumstances (e.g. the petitioner ceases to participate, or the record establishes that substitute claims are unpatentable for the same reasons as the original claims and the original reason why is readily identifiable and persuasive), that Hunting Titan had not raised Schacherer against the substitute claims, and that asserting it against the original claims was insufficient, and that therefore this was not one of those special cases.[[428]](#footnote-429)

The Federal Circuit affirmed the Panel’s decision because Hunting Titan failed to challenge the Panel’s decision as an abuse of discretion and didn’t argue that the same reasons exception was misapplied.[[429]](#footnote-430) As such, the Federal Circuit narrowly affirmed, but noted it did not determine the patentability of the substitute claims, or whether than Panel abused its discretion in determining Schacherer was not readily identifiable and persuasive, or whether the Panel’s other restrictions were consistent with 318.[[430]](#footnote-431) But the Court rejected the Panel’s reasoning that raising new grounds of unpatentability should be rare. The Court noted that the Panel’s reasoning was problematic, and relied too heavily on the adversarial system to the detriment of agency expertise.[[431]](#footnote-432)

Judge Prost concurred, writing that had Hunting Titan properly preserved its challenge, it should have succeeded.[[432]](#footnote-433)

## PTAB and Choice of Forum

#### *Nippon Shinyaku Co., Ltd. v. Sarepta Therapeutics, Inc.*, 25 F.4th 998 (Fed. Cir. Feb. 8, 2022)

In this appeal from the District of Delaware, the Federal Circuit reversed the district court, and granted a preliminary injunction enjoining Sarepta from proceeding with IPRs on breach of contract grounds.[[433]](#footnote-434) The parties had signed a confidentiality agreement that included a forum selection clause for IP disputes after the contract term, specifying the District of Delaware and including administrative proceedings as an action.[[434]](#footnote-435) The agreement also included a time-limited no-suit clause, which included administrative proceedings and specifically precluded patent validity challenges before the PTO.[[435]](#footnote-436) Sarepta filed an IPR, and Nippon Shinyaku filed suit in Delaware, seeking to enjoin them from continuing the challenge.[[436]](#footnote-437)

The lower court held that Nippon Shinyaku had not shown a reasonable probability of succeeding on the argument that the agreement barred IPRs after the no-suit clause expired.[[437]](#footnote-438) The district court found that interpreting the forum selection clause to preclude IPRs would put it in tension with the no-suit clause, as it would be odd for one clause to expressly bar something for a shorter period of time than a different clause impliedly barred for a longer period.[[438]](#footnote-439) The district court noted that the forum selection clause mentioned forum non conveniens, venue, and personal jurisdiction, indicating its intent to apply to district court proceedings, notwithstanding the inclusion of administrative proceedings in the definition of action.[[439]](#footnote-440) Lastly, the district court was concerned about the practical implication, noting that if Sarepta was forced to wait out the forum selection clause its IPR petitions would be time barred.[[440]](#footnote-441)

Applying Delaware law to interpret the contract, the Federal Circuit held that the plain language of the contract overwhelmed these arguments, as administrative agency actions include IPRs.[[441]](#footnote-442) The Court dismissed the tension of the forum-selection and no-suit clause by simply noting that they were harmonious, as the no-suit clause completely barred all disputes, while the forum selection clause just funneled them into the District of Delaware once the no-suit provision expired.[[442]](#footnote-443) The mentions of FNC/venue/personal jurisdiction were dispatched as not dipositive that the parties meant to exclude IPRs, merely as lists of actions they shall not do in district courts.[[443]](#footnote-444) Lastly, on the argument that the parties didn’t intend to bargain away their right to file IPRs, the Court noted parties are entitled to bargain it away including via forum selection clauses.[[444]](#footnote-445) Considering this and the equitable factors, the Court reversed the district court and ordered the entry of a preliminary injunction.[[445]](#footnote-446)

## Constitutionality and Jurisdiction

#### *Arthrex, Inc. v. Smith & Nephew*, Inc., 35 F.4th 1328 (Fed. Cir. May 27, 2022)

The Supreme Court held 5-4 that Administrative Patent Judges exercise sufficient unreviewable authority via IPRs that their appointment by the Commerce Secretary was unconstitutional.[[446]](#footnote-447) A different 7-2 majority fashioned the remedy: the USPTO director “may review final PTAB decisions and, upon review may issue decisions himself on behalf of the Board.”[[447]](#footnote-448) Prior rulings of Administrative Patent Judges were not overturned, but discretionary review by the PTO director is now an option.[[448]](#footnote-449)

On remand from the Supreme Court, the Federal Circuit held that the Commissioner for Patents may review rehearing requests when the offices of the Director and Deputy Director of the PTO are vacant, and rejected Arthrex’s request for rehearing.[[449]](#footnote-450) Arthrex argued that the Commissioner exercising executive power violated the appointments clause as they are not presidentially appointed and Senate-confirmed.[[450]](#footnote-451) The Federal Circuit rejected this argument, following the Supreme Court’s precedent in *Eaton*.[[451]](#footnote-452) An inferior officer may be charged with the performance of the duty of a superior officer for a limited time, and the Supreme Court’s *Arthrex* decisionitself actually cited *Eaton* and recognized this principle.[[452]](#footnote-453) The Commissioner is granted the duties of the Director by a standing directive if the offices are vacant.[[453]](#footnote-454)

Next Arthrex argued that the Federal Vacancy Reform Act precluded the Commissioner form exercising this power.[[454]](#footnote-455) The Federal Circuit held that the FVRA applies only to non-delegable duties, and that reviewing rehearing requests is delegable, the FVRA did not apply.[[455]](#footnote-456) In deciding that the FVRA only applies to non-delegable duties, the Federal Circuit relied on the text of the act, the committee report explicitly saying so, and other Circuit precedent agreeing.[[456]](#footnote-457) In deciding whether rehearing was delegable, the Court noted the lack of any specific statutory provision requiring only the Director to be able to decide rehearing requests, while the Director has broad power to delegate their authority under 35 U.S.C. § 3(b)(3)(B).[[457]](#footnote-458) As such, the Court held the FVRA did not prevent the Commissioner from reviewing rehearing requests.[[458]](#footnote-459)

Lastly, the Court rejected a separation of powers challenge based on the removal clause.[[459]](#footnote-460) Arthrex argued that because the Commissioner was removable only for cause, the separation of powers prevented him from performing the duties of the Director.[[460]](#footnote-461) The Federal Circuit held that while this was true in general, the President needed no cause to remove the Commissioner from the role of the temporary stand-in by appointing an Acting Director.[[461]](#footnote-462) As such, the Federal Circuit rejected all of Arthrex’s challenges to the Commissioner reviewing rehearing requests while the Director and Deputy positions were vacant.[[462]](#footnote-463)

#### *Polaris Innovations Ltd. v. Brent*, 48 F.4th 1365 (Fed. Cir. Sept. 15, 2022)

In this appeal from the PTAB, the Federal Circuit held that the PTAB has the power to invalidate patents even after the parties settle.[[463]](#footnote-464) Nvidia filed IPRs against Polaris’s patents, and the PTAB determined all challenged claims were unpatentable.[[464]](#footnote-465) Polaris appealed, the parties settled, and the PTO intervened to defend the PTAB’s decision.[[465]](#footnote-466) The Federal Circuit initially vacated and remanded in light of its *Arthrex* decision, and the PTAB suspended the IPRs pending the Supreme Court weighing in.[[466]](#footnote-467) This Supreme Court decision ultimately vacated the vacatur of the PTAB’s final decision, reinstating it.[[467]](#footnote-468) The Federal Circuit reinstated the appeals and asked Polaris how to proceed—Polaris asked to vacate and remand for termination, the PTO wanted the case remanded for limited Director review.[[468]](#footnote-469) The Federal Circuit took the PTO’s side, and on remand Polaris asked the PTAB to grant its still-pending motion to terminate.[[469]](#footnote-470) The PTAB determined that termination was not appropriate because the final written decision was not vacated, and only allowed Director review.[[470]](#footnote-471) Polaris appealed this denial.[[471]](#footnote-472)

The Federal Circuit reviewed *de novo*, and affirmed the PTAB’s denial of the motion.[[472]](#footnote-473) The case turned on the interpretation of 35 U.S.C. § 317, which states that an IPR “shall be terminated with respect to any petitioner” upon the joint request of the parties “unless the Office has decided the merits of the proceeding before the request for termination is filed.”[[473]](#footnote-474) It also states that “[i]f no petitioner remains” the PTAB “may terminate the review or proceed to a final written decision.”[[474]](#footnote-475)

As such, the Federal Circuit denied the termination motion for two independent reasons: First, the Court held that the statute does not provide a mandatory right to termination of the proceeding and the PTAB is expressly authorized to proceed to a final written decision without a petitioner.[[475]](#footnote-476) Second, the Court held that the PTAB had already decided the merits at the time of the motion, as the final written decision had already been issued.[[476]](#footnote-477) While they had been vacated, the Supreme Court vacated that vacatur, and the decisions were not vacated at the time the motion was considered.[[477]](#footnote-478) This case’s posture was complex, but the bottom line is that the PTAB can invalidate patents even after settlement.

***In re Palo Alto Networks, Inc.*, 44 F.4th 1369 (Fed. Cir. Aug. 16, 2022)**

In this mandamus action from the PTAB, the Federal Circuit held that the Director of the PTO’s refusal to accept requests for rehearing of of a decision by the PTAB to deny institution of IPR proceedings does not violate the Appointments Clause.[[478]](#footnote-479) Post-*Arthrex* APJ decisions must be reviewable by the Director, although the Director has discretion to decide which decisions to review.[[479]](#footnote-480) However, this case is not about final decisions but institution decisions.[[480]](#footnote-481) Statutorily the Director has the authority to determine whether inistitute an IPR or PGR under § 314 and § 324.[[481]](#footnote-482) However, the Director has delegated this authority to the PTAB by regulation.[[482]](#footnote-483) The Federal Circuit held this was sufficiently different from *Arthrex* because here the Director was not barred from exercising their discretion by statute, but has instead barred herself.[[483]](#footnote-484) The Court held this was well within the bounds of the appointments clause, as the accountable officer was ultimately still a removable superior officer of the executive branch.[[484]](#footnote-485)

## Abuse of Process

#### *OpenSky Industries, LLC v. VLSI Technology LLC*, IPR2021-01064, Paper 102, 2022 WL 5240856 (PTAB Oct. 4, 2022) (Director Decision)

In this Director review decision, Director Vidal determined that OpenSky abused the IPR process by filing an IPR in an attempt to extract payment from VLSI and Intel (who was joined as a second petitioner).[[485]](#footnote-486) VLSI had previously won a suit against Intel, and Intel’s IPRs on the at-issue patent were discretionarily denied under *NHK/Fintiv*.[[486]](#footnote-487) OpenSky, after the conclusion of the trial, effectively re-filed the same IPRs, citing the integrity of the patent system to avoid a discretionary denial, and noting that the district court trial did not end up resolving the invalidity challenges.[[487]](#footnote-488) The PTAB instituted, and Intel was joined.[[488]](#footnote-489)

After ordering Director review, Director Vidal determined that OpenSky was using the IPR process to extract payment from VLSI or Intel without meaningfully pursuing unpatentability goals.[[489]](#footnote-490) She held that using IPRs or other post-grant review for the sole purpose of extracting payment was an abuse of process, and instituted sanctions.[[490]](#footnote-491) OpenSky was the one to initiate settlement agreements, and sent letters to Intel requesting money in exchange for not settling the IPR.[[491]](#footnote-492) When Intel rejected this deal, OpenSky offered VLSI a deal: OpenSky would not negotiate with Intel, it would refuse to pay for expert time at a deposition, and it would file a joint motion to dismiss with VLSI and sabotage the IPR.[[492]](#footnote-493) VSLI reported this to the PTAB, while OpenSky started negotiating with Intel—Intel could have the lead role in exchange for money, and if Intel didn’t pay, OpenSky may not depose VLSI’s expert or file a reply.[[493]](#footnote-494)

In holding that this behavior constituted an abuse of process, Director Vidal noted several factors: that OpenSky had no direct interest in the patent (while noting this is not per se improper), that there was a recent large jury verdict on the patent shortly before OpenSky was formed and filed the IPR, that OpenSky sought compensation from both VLSI and Intel, that OpenSky did not meaningfully pursue the merits, and that its petition was a copycat.[[494]](#footnote-495) Director Vidal noted that most of these are not per se improper, but furthered the impropriety of seeking compensation from both parties and failing to meaningfully litigate invalidity.[[495]](#footnote-496) She blocked OpenSky from participating in the IPR, issued a show cause order to avoid monetary sanctions, and noted that OpenSky’s counsel may have committed ethics violations.[[496]](#footnote-497)

1. William H. Neukom Professor, Stanford Law School; Partner, Durie Tangri LLP. [↑](#footnote-ref-2)
2. J.D. expected 2023, Stanford Law School. [↑](#footnote-ref-3)
3. In re Killian, 45 F.4th 1373 (Fed. Cir. 2022). [↑](#footnote-ref-4)
4. *Id.* at 1377-78. [↑](#footnote-ref-5)
5. *Id.* [↑](#footnote-ref-6)
6. *Id.* at 1381. [↑](#footnote-ref-7)
7. *Id.* at 1379. [↑](#footnote-ref-8)
8. *Id.* at 1380. [↑](#footnote-ref-9)
9. *Id.* at 1380. [↑](#footnote-ref-10)
10. *Id.* at 1381. This is a curious response since the appeal was from a PTO decision. [↑](#footnote-ref-11)
11. *Id.* at 1381-83. [↑](#footnote-ref-12)
12. *Id.* at 1383. [↑](#footnote-ref-13)
13. *Id.*  [↑](#footnote-ref-14)
14. *Id.* [↑](#footnote-ref-15)
15. *Id.* at 1384. [↑](#footnote-ref-16)
16. *Id.* at 1384-86. [↑](#footnote-ref-17)
17. *Id.* at 1385. [↑](#footnote-ref-18)
18. *Id.* at 1386. [↑](#footnote-ref-19)
19. Int'l Bus. Machines Corp. v. Zillow Grp., Inc., 50 F.4th 1371 (Fed. Cir. 2022). [↑](#footnote-ref-20)
20. *Id.* at 1374-76. [↑](#footnote-ref-21)
21. *Id.* at 1374-75. [↑](#footnote-ref-22)
22. *Id.* at 1375-76. [↑](#footnote-ref-23)
23. *Id.* at 1383. [↑](#footnote-ref-24)
24. *Id.* at 1377. [↑](#footnote-ref-25)
25. *Id.*  [↑](#footnote-ref-26)
26. *Id.* at 1377-78. [↑](#footnote-ref-27)
27. *Id.* at 1379-80. [↑](#footnote-ref-28)
28. *Id.*  [↑](#footnote-ref-29)
29. *Id.* at 1380. [↑](#footnote-ref-30)
30. *Id.* at 1380. [↑](#footnote-ref-31)
31. *Id.*  [↑](#footnote-ref-32)
32. *Id.* at 1381. [↑](#footnote-ref-33)
33. *Id.* at 1382. [↑](#footnote-ref-34)
34. *Id.* at 1382-83. [↑](#footnote-ref-35)
35. *Id.* at 1383. [↑](#footnote-ref-36)
36. *Id.*  [↑](#footnote-ref-37)
37. *Id.* at 1384. [↑](#footnote-ref-38)
38. *Id.* at 1385. [↑](#footnote-ref-39)
39. Coop. Ent., Inc. v. Kollective Tech., Inc., 2022 WL 4488902 (Fed. Cir. 2022) [↑](#footnote-ref-40)
40. *Id.* at \*1. [↑](#footnote-ref-41)
41. *Id.* at \*3. [↑](#footnote-ref-42)
42. *Id.*  [↑](#footnote-ref-43)
43. *Id.* [↑](#footnote-ref-44)
44. *Id.* [↑](#footnote-ref-45)
45. *Id.*  [↑](#footnote-ref-46)
46. *Id.* at \*3-4. [↑](#footnote-ref-47)
47. *Id.* at \*4. [↑](#footnote-ref-48)
48. *Id.* at \*5. [↑](#footnote-ref-49)
49. *Id.* [↑](#footnote-ref-50)
50. *Id.* at \*6. [↑](#footnote-ref-51)
51. *Id.* [↑](#footnote-ref-52)
52. Weisner v. Google LLC, 51 F.4th 1073 (Fed. Cir. 2022). [↑](#footnote-ref-53)
53. *Id.* at 1075. [↑](#footnote-ref-54)
54. *Id.* at 1076. [↑](#footnote-ref-55)
55. *Id.* 1088. [↑](#footnote-ref-56)
56. *Id.* at 1082-83. [↑](#footnote-ref-57)
57. *Id.* [↑](#footnote-ref-58)
58. *Id.* at 1084. [↑](#footnote-ref-59)
59. *Id.* [↑](#footnote-ref-60)
60. *Id.* at 1084-85. [↑](#footnote-ref-61)
61. *Id.* at 1085-88. [↑](#footnote-ref-62)
62. *Id.* at 1086. [↑](#footnote-ref-63)
63. *Id.* at 1087. [↑](#footnote-ref-64)
64. *Id.* at 1088-90. [↑](#footnote-ref-65)
65. *Id.* [↑](#footnote-ref-66)
66. *Id.* at 1091. [↑](#footnote-ref-67)
67. Nature Simulation Sys., Inc. v. Autodesk, Inc., 23 F.4th 1334 (Fed. Cir. 2022) [↑](#footnote-ref-68)
68. *Id.* at 1337. [↑](#footnote-ref-69)
69. *Id.* at 1338. [↑](#footnote-ref-70)
70. *Id.* at 1337-38. [↑](#footnote-ref-71)
71. *Id.* at 1338. [↑](#footnote-ref-72)
72. *Id.* at 1340. [↑](#footnote-ref-73)
73. *Id.*  [↑](#footnote-ref-74)
74. *Id.* at 1344. [↑](#footnote-ref-75)
75. *Id.* at 1340. [↑](#footnote-ref-76)
76. *Id.* at 1340-41. [↑](#footnote-ref-77)
77. *Id.* at 1342. [↑](#footnote-ref-78)
78. *Id.* at 1343. [↑](#footnote-ref-79)
79. *Id.* at 1344. [↑](#footnote-ref-80)
80. *Id.*  [↑](#footnote-ref-81)
81. *Id.* at 1345. [↑](#footnote-ref-82)
82. Niazi Licensing Corp. v. St. Jude Medical S.C., Inc., 30 F. 4th 1339 (Fed. Cir. 2022) [↑](#footnote-ref-83)
83. *Id.* at 1343-44. [↑](#footnote-ref-84)
84. *Id.* at 1349. [↑](#footnote-ref-85)
85. *Id.*  [↑](#footnote-ref-86)
86. *Id.* [↑](#footnote-ref-87)
87. *Id.* at 1350. [↑](#footnote-ref-88)
88. *Id.* [↑](#footnote-ref-89)
89. Dyfan, LLC v. Target Corp., 28 F.4th 1360 (Fed. Cir. 2022) [↑](#footnote-ref-90)
90. *Id.* at 1363. [↑](#footnote-ref-91)
91. *Id*. at 1365. [↑](#footnote-ref-92)
92. *Id.* at 1367-68. [↑](#footnote-ref-93)
93. *Id.* at 1368. [↑](#footnote-ref-94)
94. *Id.* [↑](#footnote-ref-95)
95. *Id.* at 1369. [↑](#footnote-ref-96)
96. *Id.* at 1370. [↑](#footnote-ref-97)
97. *Id.* at 1370-71. [↑](#footnote-ref-98)
98. *Id.* at 1371. [↑](#footnote-ref-99)
99. VDPP LLC v. Vizio, Inc., 2022 WL 885771 (Fed. Cir. Mar. 25, 2022) [↑](#footnote-ref-100)
100. *Id.* at \*1. [↑](#footnote-ref-101)
101. *Id.* at \*2. [↑](#footnote-ref-102)
102. *Id.* at \*3. [↑](#footnote-ref-103)
103. *Id.* at \*4. [↑](#footnote-ref-104)
104. *Id.*  [↑](#footnote-ref-105)
105. *Amgen Inc. v. Sanofi*, 987 F.3d 1080 (Fed. Cir. 2021). [↑](#footnote-ref-106)
106. *Id.* at 1083 (citing U.S. Patent Nos. 8,859,741 and 8,829,165). [↑](#footnote-ref-107)
107. *Id* [↑](#footnote-ref-108)
108. *Id*. [↑](#footnote-ref-109)
109. Id. [↑](#footnote-ref-110)
110. *Id.*at 1088. [↑](#footnote-ref-111)
111. *Id.* at 1085. [↑](#footnote-ref-112)
112. Id. [↑](#footnote-ref-113)
113. *Id.* [↑](#footnote-ref-114)
114. *Id.* at 1086. [↑](#footnote-ref-115)
115. Id. [↑](#footnote-ref-116)
116. Id. [↑](#footnote-ref-117)
117. *Id.* at 1088. [↑](#footnote-ref-118)
118. Id. [↑](#footnote-ref-119)
119. Thaler v. Hirshfeld, 2021 WL 3934803 (E.D. Va. Sept. 2, 2021) [↑](#footnote-ref-120)
120. *Id.* at \*2. [↑](#footnote-ref-121)
121. *Id.*  [↑](#footnote-ref-122)
122. *Id.* at \*1. [↑](#footnote-ref-123)
123. *Id.* at \*4. [↑](#footnote-ref-124)
124. *Id.* at \*4-5 (citing Mohamad v. Palestinian Auth., 566 U.S. 449, 453-54 (2012)). [↑](#footnote-ref-125)
125. *Id.* at \*5-6. [↑](#footnote-ref-126)
126. *Id.* at \*6 (citing Univ. of Utah v. Max-Planck-Gesellschaft, 734 F.3d 1315, 1323 (Fed. Cir. 2013)). [↑](#footnote-ref-127)
127. *Id.* at \*7. [↑](#footnote-ref-128)
128. *Id.* at \*7-8. [↑](#footnote-ref-129)
129. Thaler v. Vidal, 43 F.4th 1207 (Fed. Cir. 2022). [↑](#footnote-ref-130)
130. *Id.* at 1209. [↑](#footnote-ref-131)
131. *Id.* at 1211. [↑](#footnote-ref-132)
132. *Id.*  [↑](#footnote-ref-133)
133. *Id.* at 1212. [↑](#footnote-ref-134)
134. *Id.*  [↑](#footnote-ref-135)
135. *Id.* at 1213. [↑](#footnote-ref-136)
136. LG Elecs. Inc. v. ImmerVision, Inc., 39 F.4th 1364 (Fed. Cir. 2022). [↑](#footnote-ref-137)
137. *Id.* at 1365-66. [↑](#footnote-ref-138)
138. *Id.* at 1367. [↑](#footnote-ref-139)
139. *Id.* [↑](#footnote-ref-140)
140. *Id.* at 1368-71. [↑](#footnote-ref-141)
141. *Id.* at 1371. [↑](#footnote-ref-142)
142. *Id.* at 1372. [↑](#footnote-ref-143)
143. *Id.*  [↑](#footnote-ref-144)
144. *Id.* at 1373. [↑](#footnote-ref-145)
145. *Id.* [↑](#footnote-ref-146)
146. *Id.* [↑](#footnote-ref-147)
147. *Id.*  [↑](#footnote-ref-148)
148. *Id.* at 1374. [↑](#footnote-ref-149)
149. *Id.* [↑](#footnote-ref-150)
150. Google LLC v. IPA Techs. Inc., 34 F.4th 1081 (Fed. Cir. 2022). [↑](#footnote-ref-151)
151. *Id.* at 1084. [↑](#footnote-ref-152)
152. *Id.*  [↑](#footnote-ref-153)
153. *Id.* [↑](#footnote-ref-154)
154. *Id.*  [↑](#footnote-ref-155)
155. *Id.* at 1085. [↑](#footnote-ref-156)
156. *Id.* at 1087. [↑](#footnote-ref-157)
157. *Id.*  [↑](#footnote-ref-158)
158. *Id.* at 1087-88. [↑](#footnote-ref-159)
159. *Id.* at 1088. [↑](#footnote-ref-160)
160. *Id.* [↑](#footnote-ref-161)
161. Sunoco Partners Mktg. & Terminals L.P. v. U.S. Venture, Inc., 32 F.4th 1161 (Fed. Cir. 2022) [↑](#footnote-ref-162)
162. *Id.* at 1169-71. [↑](#footnote-ref-163)
163. *Id.* at 1171. [↑](#footnote-ref-164)
164. *Id.*  [↑](#footnote-ref-165)
165. *Id.* [↑](#footnote-ref-166)
166. *Id.* at 1170. [↑](#footnote-ref-167)
167. *Id.* at 1173. [↑](#footnote-ref-168)
168. *Id.* at 1174. [↑](#footnote-ref-169)
169. Adapt Pharma Operations Ltd. v. Teva Pharmaceuticals USA, Inc., --- F.4th ---, 2022 WL 402133 (Fed. Cir. 2022). [↑](#footnote-ref-170)
170. *Id.* at \*1. [↑](#footnote-ref-171)
171. *Id.* at \*2-3. [↑](#footnote-ref-172)
172. *Id.* at \*4. [↑](#footnote-ref-173)
173. *Id.* at \*5. [↑](#footnote-ref-174)
174. *Id.* at \*5-8. [↑](#footnote-ref-175)
175. *Id.* at \*8. [↑](#footnote-ref-176)
176. *Id.* at \*9. [↑](#footnote-ref-177)
177. *Id.*  [↑](#footnote-ref-178)
178. *Id.* at \*10. [↑](#footnote-ref-179)
179. *Id.* at \*11. [↑](#footnote-ref-180)
180. *Id.* at \*12. [↑](#footnote-ref-181)
181. *Id.* at \*13. [↑](#footnote-ref-182)
182. *Id.* at \*13-14. [↑](#footnote-ref-183)
183. *Id.* at \*14. [↑](#footnote-ref-184)
184. *Id.* at \*15-19. [↑](#footnote-ref-185)
185. *Id.*  [↑](#footnote-ref-186)
186. *Id.* at \*20-21. [↑](#footnote-ref-187)
187. Teva v. Corcept, 18 F.4th 1377 (Fed. Cir. 2021) [↑](#footnote-ref-188)
188. *Id.* at 1370. [↑](#footnote-ref-189)
189. *Id.*  [↑](#footnote-ref-190)
190. *Id.* at 1380. [↑](#footnote-ref-191)
191. *Id.* at 1380-81. [↑](#footnote-ref-192)
192. *Id.*  [↑](#footnote-ref-193)
193. *Id.*  [↑](#footnote-ref-194)
194. *Id.* at 1381-83. [↑](#footnote-ref-195)
195. Auris Health, Inc. v. Intuitive Surgical Operations, Inc., 32 F.4th 1154 (Fed. Cir. 2022). [↑](#footnote-ref-196)
196. *Id.* at 1156. [↑](#footnote-ref-197)
197. *Id.* at 1158. [↑](#footnote-ref-198)
198. *Id.* at 1159. [↑](#footnote-ref-199)
199. *Id.*  [↑](#footnote-ref-200)
200. *Id.* [↑](#footnote-ref-201)
201. Best Med. Int'l, Inc. v. Elekta Inc., 46 F.4th 1346 (Fed. Cir. 2022) [↑](#footnote-ref-202)
202. *Id.* at 1349-50. [↑](#footnote-ref-203)
203. *Id.* at 1349. [↑](#footnote-ref-204)
204. *Id.* at 1353-54. [↑](#footnote-ref-205)
205. *Id.* at 1354. [↑](#footnote-ref-206)
206. *Id.* [↑](#footnote-ref-207)
207. *Id.* at 1355. [↑](#footnote-ref-208)
208. *Id.* at 1355-56. [↑](#footnote-ref-209)
209. *Id.* at 1356. [↑](#footnote-ref-210)
210. Astrazenca AB v. Mylan Pharmaceuticals Inc., 19 F.4th 1325 (Fed. Cir. 2021) [↑](#footnote-ref-211)
211. *Id.* at 1329. [↑](#footnote-ref-212)
212. *Id.* at 1330. [↑](#footnote-ref-213)
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214. *Id.* [↑](#footnote-ref-215)
215. *Id.* at 1332. [↑](#footnote-ref-216)
216. *Id.* at 1332-34. [↑](#footnote-ref-217)
217. *Id.*  [↑](#footnote-ref-218)
218. *Id.* at 1334. [↑](#footnote-ref-219)
219. *Id.*  [↑](#footnote-ref-220)
220. *Id.* at 1338. [↑](#footnote-ref-221)
221. *Id.* at 1342. [↑](#footnote-ref-222)
222. *Id.* at 1343. [↑](#footnote-ref-223)
223. *Id.* at 1344. [↑](#footnote-ref-224)
224. *Id.* at 1345. [↑](#footnote-ref-225)
225. Pavo Sols. LLC v. Kingston Tech. Co., Inc., 35 F.4th 1367 (Fed. Cir. 2022). [↑](#footnote-ref-226)
226. *Id.* at 1372. [↑](#footnote-ref-227)
227. *Id.* at [↑](#footnote-ref-228)
228. *Id.* at 1374. [↑](#footnote-ref-229)
229. *Id.* [↑](#footnote-ref-230)
230. *Id.* at 1375. [↑](#footnote-ref-231)
231. *Id.* [↑](#footnote-ref-232)
232. *Id.* [↑](#footnote-ref-233)
233. *Id.* at 1376-77. [↑](#footnote-ref-234)
234. *Id.* [↑](#footnote-ref-235)
235. *Id.* at 1377. [↑](#footnote-ref-236)
236. Kaufman v. Microsoft Corp., 34 F.4th 1360 (Fed. Cir. 2022). [↑](#footnote-ref-237)
237. *Id.* at 1369-70. [↑](#footnote-ref-238)
238. *Id.* at 1369-71. [↑](#footnote-ref-239)
239. *Id.* [↑](#footnote-ref-240)
240. GlaxoSmithKline LLC v. Teva Pharmaceuticals UA, Inc., 7 F.4th 1320 (Fed. Cir. 2021). [↑](#footnote-ref-241)
241. *Id.* at 1323. [↑](#footnote-ref-242)
242. *Id.* [↑](#footnote-ref-243)
243. *Id.* [↑](#footnote-ref-244)
244. *Id.* at 1323-24. [↑](#footnote-ref-245)
245. *Id.* at 1324-25. [↑](#footnote-ref-246)
246. *Id.* at 1325. [↑](#footnote-ref-247)
247. *Id.* [↑](#footnote-ref-248)
248. *Id.* at 1326. [↑](#footnote-ref-249)
249. *Id.* [↑](#footnote-ref-250)
250. *Id.* at 1328-30. [↑](#footnote-ref-251)
251. *Id.* at 1331. [↑](#footnote-ref-252)
252. *Id.* at 1334-35. [↑](#footnote-ref-253)
253. *Id.* at 1335-37. [↑](#footnote-ref-254)
254. *Id.* at 1339-40. [↑](#footnote-ref-255)
255. *Id.* at 1343. [↑](#footnote-ref-256)
256. Roche Diagnostics Corp. v. Meso Scale Diagnostics, LLC, 30 F.4th 1109 (Fed. Cir. 2022) [↑](#footnote-ref-257)
257. *Id.* at 1118. [↑](#footnote-ref-258)
258. *Id.* at 1119. [↑](#footnote-ref-259)
259. *Id.* [↑](#footnote-ref-260)
260. *Id.* at 1120-21. [↑](#footnote-ref-261)
261. Niazi Licensing Corp. v. St. Jude Medical S.C., Inc., 30 F. 4th 1339 (Fed. Cir. 2022) [↑](#footnote-ref-262)
262. *Id.* at 1354. [↑](#footnote-ref-263)
263. *Id.* [↑](#footnote-ref-264)
264. *Id.* [↑](#footnote-ref-265)
265. *Id.* [↑](#footnote-ref-266)
266. *Id.* [↑](#footnote-ref-267)
267. Hologic, Inc. v. Minerva Surgical, Inc., 44 F.4th 1358 (Fed. Cir. 2022). [↑](#footnote-ref-268)
268. *Id.* at 1360. [↑](#footnote-ref-269)
269. *Id.*  [↑](#footnote-ref-270)
270. *Id.* at 1363. [↑](#footnote-ref-271)
271. *Id.* at 1364. [↑](#footnote-ref-272)
272. *Id.* at 1365. [↑](#footnote-ref-273)
273. *Id.*  [↑](#footnote-ref-274)
274. *Id.* at 1366. [↑](#footnote-ref-275)
275. *Id.* [↑](#footnote-ref-276)
276. *Id.* at 1367-69. [↑](#footnote-ref-277)
277. *Id.*  [↑](#footnote-ref-278)
278. Cal. Inst. of Tech. v. Broadcom Ltd., 25 F.4th 976 (Fed. Cir. 2022). [↑](#footnote-ref-279)
279. *Id.* at 992. [↑](#footnote-ref-280)
280. *Id.* [↑](#footnote-ref-281)
281. *Id.* [↑](#footnote-ref-282)
282. *Id.* at 993. [↑](#footnote-ref-283)
283. *Id.*  [↑](#footnote-ref-284)
284. *Id.*  [↑](#footnote-ref-285)
285. *Id.* at 994. [↑](#footnote-ref-286)
286. Apple Inc. v. Wi-LAN Inc., 25 F.4th 960 (Fed Cir. 2022) [↑](#footnote-ref-287)
287. *Id.* at 972. [↑](#footnote-ref-288)
288. *Id.*  [↑](#footnote-ref-289)
289. *Id.* at 972-73. [↑](#footnote-ref-290)
290. *Id.* at 973. [↑](#footnote-ref-291)
291. *Id.* [↑](#footnote-ref-292)
292. *Id.* at 973-74. [↑](#footnote-ref-293)
293. *Id.* at 974. [↑](#footnote-ref-294)
294. Roche Diagnostics Corp. v. Meso Scale Diagnostics, LLC, 30 F.4th 1109 (Fed. Cir. 2022) [↑](#footnote-ref-295)
295. *Id.* at 1123. [↑](#footnote-ref-296)
296. *Id.* at 1122. [↑](#footnote-ref-297)
297. *Id.* at 112. [↑](#footnote-ref-298)
298. *Id.* [↑](#footnote-ref-299)
299. Pavo Sols. LLC v. Kingston Tech. Co., Inc., 35 F.4th 1367 (Fed. Cir. 2022) [↑](#footnote-ref-300)
300. *Id.* at 1379. [↑](#footnote-ref-301)
301. *Id.* [↑](#footnote-ref-302)
302. *Id.* [↑](#footnote-ref-303)
303. *Id.*  [↑](#footnote-ref-304)
304. *Id.* [↑](#footnote-ref-305)
305. *Id.*  [↑](#footnote-ref-306)
306. *Id.* at 1379-80. [↑](#footnote-ref-307)
307. Realtime Adaptive Streaming LLC v. Netflix, Inc., 41 F.4th 1372 (Fed. Cir. 2022). [↑](#footnote-ref-308)
308. *Id.* at 1374. [↑](#footnote-ref-309)
309. *Id.*  [↑](#footnote-ref-310)
310. *Id.* at 1374-75. [↑](#footnote-ref-311)
311. *Id.* at 1375. [↑](#footnote-ref-312)
312. *Id.* [↑](#footnote-ref-313)
313. *Id.* at 1377-78. [↑](#footnote-ref-314)
314. *Id.* at 1378-79. [↑](#footnote-ref-315)
315. *Id.* at 1379. [↑](#footnote-ref-316)
316. *Id.* at 1380. [↑](#footnote-ref-317)
317. Apple Inc. v. Zipit Wireless, Inc., 30 F. 4th 1368 (Fed. Cir. 2022) [↑](#footnote-ref-318)
318. *Id.* at 1375. [↑](#footnote-ref-319)
319. *Id.* at 1373. [↑](#footnote-ref-320)
320. *Id.* [↑](#footnote-ref-321)
321. *Id.* at 1374. [↑](#footnote-ref-322)
322. *Id.* at 1376. [↑](#footnote-ref-323)
323. *Id.* [↑](#footnote-ref-324)
324. *Id.* at 1376, n. 3. [↑](#footnote-ref-325)
325. *Id.* at 1378. [↑](#footnote-ref-326)
326. *Id.* [↑](#footnote-ref-327)
327. *Id.* at 1379-80. [↑](#footnote-ref-328)
328. *Id.* at 1380. [↑](#footnote-ref-329)
329. *Id.* at 1380-81. [↑](#footnote-ref-330)
330. *Id.* at 1381. [↑](#footnote-ref-331)
331. *Id.* [↑](#footnote-ref-332)
332. In re: Volkswagen Group of America, 28 F.4th 1023 (Fed. Cir. 2022) [↑](#footnote-ref-333)
333. *Id.* at 1206. [↑](#footnote-ref-334)
334. *Id.* at 1205. [↑](#footnote-ref-335)
335. *Id.* at 1209. [↑](#footnote-ref-336)
336. *Id.* at 1210. [↑](#footnote-ref-337)
337. *Id.* at 1211. [↑](#footnote-ref-338)
338. *Id.* [↑](#footnote-ref-339)
339. *Id.* at 1212-14. [↑](#footnote-ref-340)
340. *Id.* at 1214. [↑](#footnote-ref-341)
341. In re Monolithic Power Sys., Inc., 50 F.4th 157 (Fed. Cir. 2022). [↑](#footnote-ref-342)
342. *Id.* at 159. [↑](#footnote-ref-343)
343. *Id.* [↑](#footnote-ref-344)
344. *Id.* at 159-60. [↑](#footnote-ref-345)
345. *Id.* at 160-61. [↑](#footnote-ref-346)
346. *Id.* at 161. [↑](#footnote-ref-347)
347. In re Apple Inc., 52 F.4th 1359 (Fed. Cir. 2022). [↑](#footnote-ref-348)
348. *Id.* at \*1. [↑](#footnote-ref-349)
349. *Id.*  [↑](#footnote-ref-350)
350. *Id.*  [↑](#footnote-ref-351)
351. *Id.* [↑](#footnote-ref-352)
352. *Id.* at \*2. [↑](#footnote-ref-353)
353. *Id.* at \*3. [↑](#footnote-ref-354)
354. Hyatt v. United States Pat. & Trademark Off., 48 F.4th 1347 (Fed. Cir. 2022) [↑](#footnote-ref-355)
355. *Id.* at 1349. [↑](#footnote-ref-356)
356. *Id.* [↑](#footnote-ref-357)
357. *Id.* at 1350. [↑](#footnote-ref-358)
358. *Id.* [↑](#footnote-ref-359)
359. *Id.* [↑](#footnote-ref-360)
360. *Id.* [↑](#footnote-ref-361)
361. *Id.* [↑](#footnote-ref-362)
362. *Id.* [↑](#footnote-ref-363)
363. *Id.* at 1351. [↑](#footnote-ref-364)
364. *Id.* [↑](#footnote-ref-365)
365. *Id.* at 1352-53. [↑](#footnote-ref-366)
366. *Id.* at 1354. [↑](#footnote-ref-367)
367. *Id.* [↑](#footnote-ref-368)
368. *Id.* [↑](#footnote-ref-369)
369. *Id.* at 1355. [↑](#footnote-ref-370)
370. SawStop Holding LLC v. Vidal, 48 F.4th 1355 (Fed. Cir. 2022). [↑](#footnote-ref-371)
371. *Id.* at 1358. [↑](#footnote-ref-372)
372. *Id.* [↑](#footnote-ref-373)
373. *Id.* [↑](#footnote-ref-374)
374. *Id.* at 1359. [↑](#footnote-ref-375)
375. *Id.*  [↑](#footnote-ref-376)
376. *Id.* [↑](#footnote-ref-377)
377. *Id.* [↑](#footnote-ref-378)
378. *Id.* [↑](#footnote-ref-379)
379. *Id.* [↑](#footnote-ref-380)
380. *Id.* at 1360. [↑](#footnote-ref-381)
381. *Id.*  [↑](#footnote-ref-382)
382. *Id.* at 1360-61. [↑](#footnote-ref-383)
383. *Id.* at 1361-62. [↑](#footnote-ref-384)
384. *Id.* at 1363. [↑](#footnote-ref-385)
385. *Id.*  [↑](#footnote-ref-386)
386. *Id.* at 1364. [↑](#footnote-ref-387)
387. *Id.* [↑](#footnote-ref-388)
388. Am. Nat'l Mfg. Inc. v. Sleep No. Corp., 52 F.4th 1370 (Fed. Cir. 2022). [↑](#footnote-ref-389)
389. *Id.* at \*5-6. [↑](#footnote-ref-390)
390. *Id.* at \*6. [↑](#footnote-ref-391)
391. *Id.*  [↑](#footnote-ref-392)
392. *Id.* [↑](#footnote-ref-393)
393. *Id.* [↑](#footnote-ref-394)
394. *Id.* at \*5-6. [↑](#footnote-ref-395)
395. In re McDonald, 43 F.4th 1340 (Fed. Cir. 2022). [↑](#footnote-ref-396)
396. *Id.* at 1343. [↑](#footnote-ref-397)
397. *Id.*  [↑](#footnote-ref-398)
398. *Id.* at 1343-44. [↑](#footnote-ref-399)
399. *Id.* at 1344. [↑](#footnote-ref-400)
400. *Id.*  [↑](#footnote-ref-401)
401. *Id.* at 1345. [↑](#footnote-ref-402)
402. *Id.* at 1347. [↑](#footnote-ref-403)
403. *Id.* at 1347-48. [↑](#footnote-ref-404)
404. *Id.* at 1348. [↑](#footnote-ref-405)
405. *Id.* at 1348-49. [↑](#footnote-ref-406)
406. Cal. Inst. of Tech. v. Broadcom Ltd., 25 F.4th 976 (Fed. Cir. 2022) [↑](#footnote-ref-407)
407. *Id.* at 990-91. [↑](#footnote-ref-408)
408. *Id.*  [↑](#footnote-ref-409)
409. *Id.* at 991. [↑](#footnote-ref-410)
410. Qualcomm Inc. v. Apple Inc., 24 F.4th 1367 (Fed. Cir. 2022) [↑](#footnote-ref-411)
411. *Id.* at 1369. [↑](#footnote-ref-412)
412. *Id.* [↑](#footnote-ref-413)
413. *Id.* at 1373. [↑](#footnote-ref-414)
414. *Id.* [↑](#footnote-ref-415)
415. *Id.* [↑](#footnote-ref-416)
416. *Id.* at 1375. [↑](#footnote-ref-417)
417. *Id.* at 1374. [↑](#footnote-ref-418)
418. *Id.* [↑](#footnote-ref-419)
419. *Id.* at 1375-76. [↑](#footnote-ref-420)
420. *Id.* at 1377. [↑](#footnote-ref-421)
421. Hunting Titan, Inc. v. DynaEnergetics Europe GmbH, 28 F.4th 1371 (Fed. Cir. 2022) [↑](#footnote-ref-422)
422. *Id.* at 1374. [↑](#footnote-ref-423)
423. *Id.* at 1373. [↑](#footnote-ref-424)
424. *Id.* [↑](#footnote-ref-425)
425. *Id.* [↑](#footnote-ref-426)
426. *Id.* at 1373-74. [↑](#footnote-ref-427)
427. *Id.* at 1374. [↑](#footnote-ref-428)
428. *Id.* at 1377. [↑](#footnote-ref-429)
429. *Id.* at 1382. [↑](#footnote-ref-430)
430. *Id.* [↑](#footnote-ref-431)
431. *Id.* [↑](#footnote-ref-432)
432. *Id.* at 1382-86. [↑](#footnote-ref-433)
433. Nippon Shinyaku Co., Ltd. v. Sarepta Therapeutics, Inc., 25 F.4th 998 (Fed. Cir. 2022) [↑](#footnote-ref-434)
434. *Id.* at 1002. [↑](#footnote-ref-435)
435. *Id.*  [↑](#footnote-ref-436)
436. *Id.* at 1002-03. [↑](#footnote-ref-437)
437. *Id.* at 1003. [↑](#footnote-ref-438)
438. *Id.* [↑](#footnote-ref-439)
439. *Id.*  [↑](#footnote-ref-440)
440. *Id.* [↑](#footnote-ref-441)
441. *Id.* at 1005. [↑](#footnote-ref-442)
442. *Id.* at 1006-07. [↑](#footnote-ref-443)
443. *Id.* at 1007. [↑](#footnote-ref-444)
444. *Id.* at 1007-08. [↑](#footnote-ref-445)
445. *Id.* at 1009. [↑](#footnote-ref-446)
446. *Id.* at 1985. [↑](#footnote-ref-447)
447. *Id.* at 1987. [↑](#footnote-ref-448)
448. *Id.* [↑](#footnote-ref-449)
449. Arthrex, Inc. v. Smith & Nephew, Inc., 35 F.4th 1328 (Fed. Cir. 2022) [↑](#footnote-ref-450)
450. *Id.* at 1333. [↑](#footnote-ref-451)
451. *Id.*  [↑](#footnote-ref-452)
452. *Id.* at 1334-35. [↑](#footnote-ref-453)
453. *Id.* at 1332. [↑](#footnote-ref-454)
454. *Id.* at 1335. [↑](#footnote-ref-455)
455. *Id.*  [↑](#footnote-ref-456)
456. *Id.* at 1336. [↑](#footnote-ref-457)
457. *Id.* at 1338-39. [↑](#footnote-ref-458)
458. *Id.* at 1339. [↑](#footnote-ref-459)
459. *Id.* at 1340. [↑](#footnote-ref-460)
460. *Id.* [↑](#footnote-ref-461)
461. *Id.* [↑](#footnote-ref-462)
462. *Id.* [↑](#footnote-ref-463)
463. Polaris Innovations Ltd. v. Brent, 48 F.4th 1365 (Fed. Cir. 2022). [↑](#footnote-ref-464)
464. *Id.* at 1371. [↑](#footnote-ref-465)
465. *Id.*  [↑](#footnote-ref-466)
466. *Id.* [↑](#footnote-ref-467)
467. *Id.* [↑](#footnote-ref-468)
468. *Id.* [↑](#footnote-ref-469)
469. *Id.* [↑](#footnote-ref-470)
470. *Id.* at 1373. [↑](#footnote-ref-471)
471. *Id.* [↑](#footnote-ref-472)
472. *Id.* [↑](#footnote-ref-473)
473. *Id.* [↑](#footnote-ref-474)
474. *Id.* [↑](#footnote-ref-475)
475. *Id.*  [↑](#footnote-ref-476)
476. *Id.* at 1374. [↑](#footnote-ref-477)
477. *Id.* [↑](#footnote-ref-478)
478. In re Palo Alto Networks, Inc., 44 F.4th 1369 (Fed. Cir. 2022). [↑](#footnote-ref-479)
479. *Id.* at 1372-73. [↑](#footnote-ref-480)
480. *Id.* at 1375. [↑](#footnote-ref-481)
481. *Id.* at 1373. *C.f.* § 6 (denying the director the discretion to review final PTAB decisions, struck down in *Arthrex*). [↑](#footnote-ref-482)
482. *Id.* at 1373. [↑](#footnote-ref-483)
483. *Id.* at 1375. [↑](#footnote-ref-484)
484. *Id.* at 1376-78. [↑](#footnote-ref-485)
485. OpenSky Industries, LLC v. VLSI Technology LLC, IPR2021-01064, Paper 102, 2022 WL 5240856 (PTAB Oct. 4, 2022) (Director Decision). [↑](#footnote-ref-486)
486. *Id.* at \*3. [↑](#footnote-ref-487)
487. *Id.* at \*4-5. [↑](#footnote-ref-488)
488. *Id.* at \*6. [↑](#footnote-ref-489)
489. *Id.* at \*15. [↑](#footnote-ref-490)
490. *Id.* at \*16. [↑](#footnote-ref-491)
491. *Id.* at \*16. [↑](#footnote-ref-492)
492. *Id.* at \*17. [↑](#footnote-ref-493)
493. *Id.* at \*18. [↑](#footnote-ref-494)
494. *Id.* at \*19-23. [↑](#footnote-ref-495)
495. *Id.*  [↑](#footnote-ref-496)
496. *Id.* at \*2. [↑](#footnote-ref-497)