

# RECENT DEVELOPMENTS IN PATENT LAW (Fall 2023)

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## PATENTABLE SUBJECT MATTER

### Software and Business Method Cases

#### Unpatentable

#### **Hawk Tech. Sys., LLC v. Castle Retail, LLC, 60 F.4th 1349 (Fed. Cir. Feb. 17, 2023)**

In this appeal from the Western District of Tennessee, the Federal Circuit affirmed a dismissal for failure to state a claim on patent-eligible subject matter grounds.<sup>4</sup> The patent at issue related to a method of viewing multiple pieces of surveillance footage remotely at the same time.<sup>5</sup> The essential idea was to transmit the signals at low data rates to lower storage and bandwidth requirements, using existing infrastructure and a generic server.<sup>6</sup> The Court held that this failed the *Alice* test. At step one, it agreed with the W.D. Tenn. that the patent was directed to the abstract idea of storing and displaying video.<sup>7</sup> The claims used only functional language.<sup>8</sup> It rejected Hawk's argument that it was directed to the technical problem of conserving bandwidth while preserving data, since even though the specification disclosed such technical information, the claims themselves did not.<sup>9</sup> At step two the Court held that the invention was implemented using generic computer elements and did not explain how the functioning of the computer was improved.<sup>10</sup> While the claims included parameters, they failed to specify what the parameters represented or how they should be tuned.<sup>11</sup>

#### **Sanderling Management Ltd. v. Snap Inc., 65 F.4th 698 (Fed. Cir. Apr. 12, 2023)**

In this appeal from the Central District of California, the Federal Circuit affirmed a dismissal for failure to state a claim on the grounds that Sanderling's

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<sup>4</sup> Hawk Tech. Sys., LLC v. Castle Retail, LLC, 60 F.4th 1349 (Fed. Cir. 2023).

<sup>5</sup> *Id.* at 1353.

<sup>6</sup> *Id.*

<sup>7</sup> *Id.* at 1356-58.

<sup>8</sup> *Id.* at 1357.

<sup>9</sup> *Id.*

<sup>10</sup> *Id.* at 1358-59.

<sup>11</sup> *Id.*

software patents were subject matter ineligible.<sup>12</sup> These patents were directed towards a method of using distribution rules to load digital images for users when certain conditions were met.<sup>13</sup> The court held that these patents failed the first part of the *Alice* test because their claims were directed towards the abstract idea of “providing information . . . based on meeting a condition.”<sup>14</sup> Even though this information was of a particular variety – digital images – this “minimal tailoring” was found to still be an abstract idea.<sup>15</sup> Although Sanderling argued the district court had erred by failing to construe claims before engaging in this step one analysis, the Federal Circuit clarified that “[i]f claims are directed to ineligible (or eligible) subject matter under all plausible constructions, then the court need not engage in claim construction before resolving a Section 101 motion.”<sup>16</sup>

Sanderling’s patents also failed the second part of the *Alice* test because the only “additional feature” added to the abstract idea of the claims was using common computer components to implement the method.<sup>17</sup> The court found that addition was merely a “recitation of what is a well-understood, routine, and conventional” activity and did not amount to the “inventive concept” required under *Alice*, therefore rendering the claims patent ineligible.<sup>18</sup>

***Realtime Data LLC v. Array Networks Inc.*, 2023 WL 4924814 (Fed. Cir. Aug. 2, 2023)**

In this appeal from the District of Delaware, the Federal Circuit affirmed a finding that appellant Realtime’s patents directed “to methods and systems for data compression” were subject matter ineligible.<sup>19</sup> The court held that these patents failed the first part of the *Alice* test because their claims did not specify a particular compression technique and merely recited the abstract idea of choosing to use a compression algorithm for general computing goals.<sup>20</sup>

Realtime’s patents also failed the second part of the *Alice* test because they did not recite an “inventive concept” to expand on the abstract idea of data compression.<sup>21</sup> The court found instead that the patents merely instructed the

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<sup>12</sup> Sanderling Management Ltd. v. Snap Inc., 65 F.4th 698 (Fed. Cir. 2023)

<sup>13</sup> *Id.* at 701.

<sup>14</sup> *Id.* at 703.

<sup>15</sup> *Id.* (quoting *Intell. Ventures I LLC v. Cap. One Bank*, 792 F.3d 1363, 1369 (Fed. Cir. 2015)).

<sup>16</sup> *Id.* at 704.

<sup>17</sup> *Id.*

<sup>18</sup> *Id.* at 705 (quoting *Customedia Techs., LLC v. Dish Network Corp.*, 951 F.3d 1359, 1366 (Fed. Cir. 2020)).

<sup>19</sup> *Realtime Data LLC v. Array Networks Inc.*, 2023 WL 4924814 (Fed. Cir. 2023).

<sup>20</sup> *Id.* at \*8.

<sup>21</sup> *Id.* at \*10.

application of “an abstract idea on generic computers with generic techniques,” and were therefore directed to patent-ineligible subject matter.<sup>22</sup>

Judge Newman dissented based on a principled objection that §101 was not intended to put limitations on functional claiming of patentable subject matter.<sup>23</sup> Instead, she argued the case was properly an enablement dispute, and should be remanded for a determination of validity under §112.<sup>24</sup>

## Patentable

### *Adasa Inc. v. Avery Dennison Corp.*, 55 F.4th 900 (Fed. Cir. Dec. 16, 2022)

In this appeal from the District of Oregon, the Federal Circuit affirmed a motion of summary judgment for eligibility under 101.<sup>25</sup> The patent related to a method for commissioning RFID tags without using a central database or external authorization by pre-authorizing serial number ranges and allocating them to a lower level in the hierarchy.<sup>26</sup> The Court held that the patent was not directed to an abstract idea, as it was directed to a specific hardware-based data structure that improved an existing process.<sup>27</sup> Avery Dennison claimed that the claimed invention was nothing more than mentally ascribing meaning to a pre-existing block of numbers, but the Court rejected this argument on the grounds that the improvements flowed from the unique correspondence between the physical data and the pre-authorized blocks.<sup>28</sup> The Federal Circuit emphasized that uniqueness of the data structure and the technological consequences that flowed from it made it hardware-based and non-abstract.<sup>29</sup>

## Non-Software Cases

### *ChromaDex, Inc. v. Elysium Health, Inc.*, 59 F.4th 1280 (Fed. Cir. Feb. 13, 2023)

In this appeal from the District of Delaware, the Federal Circuit affirmed a motion of summary judgment holding that the asserted claims of a dietary supplement patent were invalid as directed to a law of nature.<sup>30</sup> The asserted

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<sup>22</sup> *Id.* (quoting *Realtime Data LLC v. Array Networks Inc.*, 537 F.Supp.3d 591, 616 (D. Del., 2021)).

<sup>23</sup> *Id.* at \*12.

<sup>24</sup> *Id.*

<sup>25</sup> *Adasa Inc. v. Avery Dennison Corp.*, 55 F.4th 900 (Fed. Cir. 2022)

<sup>26</sup> *Id.* at 905.

<sup>27</sup> *Id.* at 908-09.

<sup>28</sup> *Id.*

<sup>29</sup> *Id.*

<sup>30</sup> *ChromaDex, Inc. v. Elysium Health, Inc.*, 59 F.4th 1280 (Fed. Cir. 2023)

patent related to dietary supplements containing nicotinamide riboside (NR), a vitamin naturally present in non-isolated form in cow’s milk.<sup>31</sup> The claims read on milk, with the only difference being whether the NR was isolated.<sup>32</sup> Applying *Myriad* and *Chakrabarty*’s “markedly different characteristics” framework instead of *Alice/Mayo*, the Federal Circuit held that the isolated NR is no different structurally or functionally from its natural counterpart, and that milk performs the same supplementary benefits as the patented invention.<sup>33</sup> The Court distinguished *Natural Alternatives* on the latter ground, since the NR in milk still worked the same way when not isolated, whereas the beta-alanine in *Natural Alternatives* required specific other characteristics.<sup>34</sup> The patentee argued that NR was present in milk in only trace amounts, and was not bioavailable.<sup>35</sup> The Court rebutted this argument by noting that milk (for a different reason) fulfilled the therapeutic effect that the claims required, and that the claims did not require any specific quantity of isolated NR.<sup>36</sup> The Federal Circuit applied *Alice/Mayo* as an alternative, holding that the above meant it failed step one, and that nothing in the claims was more than recognizing the natural law that NR promoted health.<sup>37</sup>

## DISCLOSURE

### Definiteness

#### **Grace Instrument Indus., LLC v. Chandler Instruments Co., LLC, 57 F.4th 1001 (Fed. Cir. Jan. 12, 2023)**

In this appeal from the Southern District of Texas, the Federal Circuit held that the district court improperly construed the term “enlarged chamber” as indefinite.<sup>38</sup> The patent at issue is a viscometer that limits measuring errors by using an enlarged chamber such that when pressurized, the sample fluid stays within said chamber and does not fall to a lower chamber.<sup>39</sup> This prevents fluid mixing between the sample fluid and the pressurization fluid, and thereby limits measurement error.<sup>40</sup> The patentee had argued that “enlarged chamber” should

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<sup>31</sup> *Id.* at 1282.

<sup>32</sup> *Id.* at 1283.

<sup>33</sup> *Id.* at 1284.

<sup>34</sup> *Id.* at 1284-85.

<sup>35</sup> *Id.* at 1285.

<sup>36</sup> *Id.*

<sup>37</sup> *Id.* at 1285-86.

<sup>38</sup> *Grace Instrument Indus., LLC v. Chandler Instruments Co., LLC, 57 F.4th 1001 (Fed. Cir. Jan. 12, 2023).*

<sup>39</sup> *Id.* at 1004.

<sup>40</sup> *Id.*



be construed as an area large enough to hold excess test fluid to prevent mixing, but the district court rejected that construction on the grounds that there were no objective boundaries to know what the enlarged chamber needed to be larger than.<sup>41</sup> The Federal Circuit reversed, noting that the intrinsic record directed a PHOSITA to a chamber large enough to prevent fluid mixing during elevated pressurization – not “larger than” but “large enough.”<sup>42</sup> While enlarged chamber was mentioned only twice in the specification, it was defined in this functional manner and the definition was supported by the prosecution history.<sup>43</sup> This created an “objective boundary” sufficient to guide a PHOSITA.<sup>44</sup>

The court noted that there still may be an indefiniteness question on remand.<sup>45</sup> The claims recited an additional limitation relying on density difference, not the enlarged chamber, to prevent mixing, and that different fluids will compress in different amounts under the same pressure, so a PHOSITA could not determine a single “enlarged chamber” definition without knowledge of specific sample fluid density.<sup>46</sup> The Court remanded this issue for further fact-finding.<sup>47</sup>

### **Ironburg Inventions Ltd. v. Valve Corporation, 64 F.4th 1274 (Fed. Cir. Apr. 3, 2023)**

In this appeal from the Western District of Washington, the Federal Circuit found that neither of the terms “elongate member” and “substantially the full distance between the top edge and the bottom edge” were indefinite in Ironburg’s patent on a video game controller.<sup>48</sup> The patent’s specification made clear to a PHOSITA that the “elongated member” must be sufficiently long to accommodate users with a wide range of hand sizes and allow users to engage the controller’s paddles using any of their ring, middle, or little fingers.<sup>49</sup> Disclosing this purpose of the claimed invention sufficiently described the required length of the “elongated member” and therefore also how “substantially” the distance between the top and bottom edges must be covered.<sup>50</sup> Additionally, the Federal Circuit rejected Valve’s argument that the parties’ infringement experts’ disagreement over the location of the top and bottom edges proved there was indefiniteness in the meaning of “substantially

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<sup>41</sup> *Id.* at 1008.

<sup>42</sup> *Id.* at 1009.

<sup>43</sup> *Id.* at 1009-10.

<sup>44</sup> *Id.* at 1010-11.

<sup>45</sup> *Id.* at 1011.

<sup>46</sup> *Id.*

<sup>47</sup> *Id.*

<sup>48</sup> *Ironburg Inventions Ltd. v. Valve Corporation*, 64 F.4th 1274 (Fed. Cir. 2023).

<sup>49</sup> *Id.* at 1285.

<sup>50</sup> *Id.* at 1288.

the full distance,” concluding that this disagreement speaks to the existence of a material question of infringement but not to indefiniteness.

Judge Clevenger dissented, arguing the claims should have been deemed indefinite as to the top and bottom edge issue.<sup>51</sup> Clevenger explained that “claims that require measurements” are indefinite when “the patent lacks reasonable certainty in sufficiently teaching how to make the measurement” and argued that the majority created an improper distinction between uncertainty in “how” versus “where” to measure an object. He argued that the majority improperly considered uncertainty regarding from “where” the controller should be measured to determine the “full distance” between its edges to be an infringement concern, when, in fact, it belonged as part of the “how to measure” indefiniteness inquiry.<sup>52</sup> Thus, since there was substantial disagreement over the measurement question, the claims should have been deemed indefinite.<sup>53</sup>

***WSOU Investments LLC v. Google LLC*, 2023 WL 6210607 (Fed. Cir. Sept. 25, 2023)**

In this appeal from the Western District of Texas, the Federal Circuit affirmed a finding of indefiniteness of claims in two patents held by WSOU Investments.<sup>54</sup> The first patent at issue is directed to a mobile communications terminal with an alarm clock feature.<sup>55</sup> The court found that language claiming an “alert unit” should be evaluated using a means-plus-function analysis, despite a presumption against using this analysis when the term “means” is not used explicitly.<sup>56</sup> It reasoned that the term “unit,” like “means,” is “defined only by the function it performs” and is therefore a purely functional term unless surrounding context provides it with structure.<sup>57</sup> In this instance, describing the unit as an “alerting” unit simply added more “functional language” rather than structural context.<sup>58</sup> The Federal Circuit then determined that the patent specification did not provide sufficient structure to define either the “alert unit” or an “issuing means for issuing an alert,” another portion of the claims that the parties agreed fell under a means-plus-function analysis.

The second patent is “directed to an autofocus feature in a digital camera.”<sup>59</sup> This patent included apparently nonsensical claim language referring to a “second part in between the first part and the second part.”<sup>60</sup> The court

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<sup>51</sup> *Id.* at 1301.

<sup>52</sup> *Id.* at 1305.

<sup>53</sup> *Id.*

<sup>54</sup> *WSOU Investments LLC v. Google LLC*, 2023 WL 6210607 (Fed. Cir. 2023).

<sup>55</sup> *Id.* at \*1-2.

<sup>56</sup> *Id.* at \*4.

<sup>57</sup> *Id.*

<sup>58</sup> *Id.*

<sup>59</sup> *Id.* at \*2.

<sup>60</sup> *Id.* at \*7.

found no language in the specification that was able to resolve the self-contradictory nature of this language, rendering it indefinite on grounds that “it ‘does not allow a reader to differentiate the first instance of “a second part” from the second.’”<sup>61</sup>

***WSOU Investments LLC v. Google LLC*, 2023 WL 6531525 (Fed. Cir. Oct. 6, 2023)**

In this appeal from the Western District of Texas, the Federal Circuit affirmed the district court’s finding that the claim limitation “a collaborative application management processor configured to manage collaborative applications” was in means-plus-function form and indefinite.<sup>62</sup> Despite the presumption against applying a means-plus-function analysis to language that does not use the term “means” explicitly, the Federal Circuit held that “processor” was a generic equivalent to “means” in this case.<sup>63</sup> It reasoned that the surrounding language in the claim merely “refer[s] to the overarching functions” of the processor rather than providing the term with structure.

The court then affirmed the district court’s finding that the specification failed to provide sufficient structure to the “collaborative application management processor” limitation.<sup>64</sup> It found that the specification only disclosed “means for managing collaborative applications,” rather than a specific structure or algorithm for doing so, and therefore concluded the claim was indefinite.<sup>65</sup>

***WSOU Investments LLC v. Google LLC*, 2023 WL 6889033 (Fed. Cir. Oct. 19, 2023)**

In this appeal from the Western District of Texas, the Federal Circuit affirmed one finding of indefiniteness and reversed another for patents held by appellant WSOU.<sup>66</sup> The first patent at issue related to image tracking and appellee Google argued its claim of a “processor” was in means-plus-function form because the specification did not provide structure for what the claimed “processor” was.<sup>67</sup> The court agreed, finding that, although in some circumstances the term “processor” could connote sufficient structure, it did not do so here since the patent left open the possibility that the “processor” could be “any structure that manipulates data.”<sup>68</sup> Having found the claim to be in means-plus-function form, the court held it was indefinite because WSOU had not

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<sup>61</sup> *Id.*

<sup>62</sup> *WSOU Investments LLC v. Google LLC*, 2023 WL 6531525 (Fed. Cir. 2023).

<sup>63</sup> *Id.* at \*3.

<sup>64</sup> *Id.* at \*7.

<sup>65</sup> *Id.* at \*6-7.

<sup>66</sup> *WSOU Investments LLC v. Google LLC*, 2023 WL 6889033 (Fed. Cir. 2023).

<sup>67</sup> *Id.* at \*1, \*3.

<sup>68</sup> *Id.*

raised any arguments before the district court that the specification disclosed corresponding structure.<sup>69</sup>

The second patent at issue was directed to the control of a device using gestures and contained the following disputed claim language: “at least one memory and the computer program code are configured, with the at least one processor, to cause the apparatus to accomplish various functions.”<sup>70</sup> For this language, the court held that Google was unable to overcome the presumption that it was not in means-plus-function form, which applies when the word “means” is not used explicitly, because this claim and specification provided “structural guidance” that the recited computer code would be stored in a memory structure and ran on a hardware processor.<sup>71</sup> The Federal Circuit therefore concluded this claim was not indefinite and reversed the district court’s ruling.<sup>72</sup>

**Sisvel International S.A. v. Sierra Wireless, Inc., 2023 WL 6522182 (Fed. Cir. Oct. 6, 2023)**

In this appeal from the PTAB, the Federal Circuit vacated the PTAB’s finding that the claim language “means for detecting a need for retransmission of the received coded data block” was indefinite.<sup>73</sup> This appeal centered around how the analysis from *Noah Systems, Inc. v. Intuit Inc.*, a case outlining a special framework for “computer-implemented means-plus-functions claims,” should be applied to the claim language at issue.<sup>74</sup>

Sierra and fellow cross-appellant Telit Cinterion Deutschland GmbH argued that references in the specification to specific software protocols were sufficient corresponding structure such that the language should have been interpreted under the *Noah* group two framework (used when there is “some disclosure” of an algorithm) rather than the *Noah* group one framework (used when there is “absolutely no disclosure” of an algorithm) used by the PTAB.<sup>75</sup> The court explained that “the specification need not disclose all the details of the algorithm . . . so long as what is disclosed would be sufficiently definite to a skilled artisan.”<sup>76</sup> Therefore, it agreed with cross-appellants that the references to the protocols in the specification were enough to qualify for a *Noah* group two analysis, which should involve expert testimony on the adequacy of the

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<sup>69</sup> *Id.* at \*4.

<sup>70</sup> *Id.* at \*1, \*4.

<sup>71</sup> *Id.* at \*4-5.

<sup>72</sup> *Id.* at \*5.

<sup>73</sup> *Sisvel International S.A. v. Sierra Wireless, Inc.*, 2023 WL 6522182 (Fed. Cir. 2023).

<sup>74</sup> *Id.* at 6.

<sup>75</sup> *Id.*

<sup>76</sup> *Id.* at \*9.

disclosures.<sup>77</sup> Given the PTAB did not conduct such an analysis, its ruling on indefiniteness was vacated and the case was remanded.<sup>78</sup>

## **Enablement**

### ***Amgen Inc. v. Sanofi*, 598 U.S. 594 (May 18, 2023)**

In this appeal from the District of Delaware, the Federal Circuit affirmed that 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.<sup>79</sup> The Supreme Court affirmed.

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.<sup>80</sup> 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.<sup>81</sup> At trial, the jury found Sanofi had not proven the patents invalid.<sup>82</sup> The court, however, ultimately granted Sanofi’s motion for judgment as a matter of law for lack of enablement.<sup>83</sup> The Federal Circuit affirmed.

The Supreme Court unanimously affirmed the Federal Circuit’s requirement that a genus claim must enable the full scope of the genus. While Amgen had disclosed several hundred working examples, the claim potentially covered millions of antibodies. The Court found that the disclosed methods for making unspecified antibodies were nothing more than “research assignments” which would force scientists to engage in lengthy trial-and-error to discover working alternatives beyond the twenty-six disclosed examples.<sup>84</sup> The Court concluded that these trial-and-error methods posed too heavy an experimentation burden to enable Amgen’s genus claim.<sup>85</sup>

### ***FS.com Inc. v. International Trade Commission*, 65 F.4th 1373 (Fed. Cir. Apr. 20, 2023)**

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<sup>77</sup> *Id.* at 10.

<sup>78</sup> *Id.*

<sup>79</sup> *Amgen Inc. v. Sanofi*, 987 F.3d 1080 (Fed. Cir. 2021).

<sup>80</sup> *Id.* at 1083 (citing U.S. Patent Nos. 8,859,741 and 8,829,165).

<sup>81</sup> *Id.*

<sup>82</sup> *Id.*

<sup>83</sup> *Id.*

<sup>84</sup> *Id.* at 614.

<sup>85</sup> *Id.*

In this appeal from the International Trade Commission (ITC), the federal Circuit affirmed a finding that the claims in several high-density fiber optic equipment patents were enabled by their specifications.<sup>86</sup> These claims recited “a fiber optic connection density of at least ninety-eight (98)” and “at least one hundred forty-four (144) fiber optic connections per U space.” FS argued these claims were not enabled because the specifications did not disclose to one skilled in the art what the upper limit on the density of connections would be.<sup>87</sup> However, the Court found that there was “substantial evidence” indicating a skilled artisan would have understood that “densities substantially above 144 connections per U space were technologically infeasible.”<sup>88</sup> Given that an upper limit need not be precise to be enabling, and that FS conceded the claims were enabled if they “did not encompass densities above about 144 connections per U space,” the ITC’s judgement was affirmed.<sup>89</sup>

**United Therapeutics Corporation v. Liquidia Technologies, Inc., 74 F.4th 1360 (Fed. Cir. July 24, 2023)**

In this appeal from the District of Delaware, the Federal Circuit affirmed a finding that several claims in United Therapeutics’ patent directed to an inhaled solution for the treatment of pulmonary hypertension (“PH”) were enabled by the patent’s specification.<sup>90</sup> Medical experts consider there to be five subgroups of PH, and Liquidia contended that the specification did not explain how Group 2 PH patients would benefit from the disclosed treatment and even indicated the treatment would be unsafe for this group, therefore forcing a skilled artisan to engage in undue experimentation to properly treat Group 2 PH patients.<sup>91</sup> However, the court found sufficient evidence to conclude that, despite safety concerns, Group 2 PH patients could have their blood pressure reduced by the treatment.<sup>92</sup> The Federal Circuit concluded this was enough to affirm the finding of enablement, given that the parties had agreed that “an improvement in a patient’s hemodynamics (reduced PAP or PVP)” was all that was required of an effective dose and that any safety concerns were irrelevant to the patent analysis, although they may be important for the FDA.<sup>93</sup>

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<sup>86</sup> FS.com Inc. v. International Trade Commission, 65 F.4th 1373 (Fed. Cir. 2023).

<sup>87</sup> *Id.* at 1376.

<sup>88</sup> *Id.*

<sup>89</sup> *Id.* at 1376-77.

<sup>90</sup> United Therapeutics Corporation v. Liquidia Technologies, Inc., 74 F.4th 1360 (Fed. Cir. 2023).

<sup>91</sup> *Id.* at 1368-69.

<sup>92</sup> *Id.* at 1270.

<sup>93</sup> *Id.*

The court also rejected the written description argument, finding both that safety and efficacy were not recited in the claims, and that the claims were not directed to the specific Group 2 PH subset of patients.<sup>94</sup> Given that the claims were directed to treatment of PH more generally, the Federal Circuit determined that “a separate disclosure in the specification for each individual variant of the condition” was not required and that safety and efficacy concerns were “matters for the FDA and medical practitioners,” not relevant considerations for a patent analysis.<sup>95</sup> Therefore, it held that the claims has sufficient written description support, given that the specification did disclose means to achieve “improved hemodynamics” in PH patients.<sup>96</sup>

***Baxalta Incorporated v. Genentech, Inc.*, 81 F.4th 1362 (Fed. Cir. Sept. 20, 2023)**

In this appeal from the District of Delaware, the Federal Circuit affirmed a finding that several claims in appellant Baxalta’s patent directed to a treatment for Hemophilia A were not enabled.<sup>97</sup> The district court had granted summary judgment of invalidity due to lack of enablement because it found the specification would require a skilled artisan to undergo undue experimentation to obtain the full scope of claimed antibodies.<sup>98</sup> Baxalta argued its claims were enabled because it had disclosed screening techniques for “mak[ing] and identify[ing] new claimed antibodies.”<sup>99</sup> However, the court relied on the recent Supreme Court decision in *Amgen Inc. v. Sanofi*, 598 U.S. 594 (2023), which held that merely outlining a trial-and-error method for discovering new antibodies does not enable a genus claim of all antibodies with the desired purpose, to reject Baxalta’s argument.<sup>100</sup> It found that, just as in *Amgen*, Baxalta had merely described a trial-and-error screening process without identifying any commonalities between functional antibodies that could help narrow down the screening search.<sup>101</sup> Therefore, the district court’s finding that Baxalta’s patent failed to teach a skilled artisan how to use the full scope of the claimed antibodies was affirmed.<sup>102</sup>

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<sup>94</sup> *Id.*

<sup>95</sup> *Id.*

<sup>96</sup> *Id.* at 1365.

<sup>97</sup> *Baxalta Incorporated v. Genentech, Inc.*, 81 F.4th 1362 (Fed. Cir. 2023).

<sup>98</sup> *Id.* at 1365.

<sup>99</sup> *Id.*

<sup>100</sup> *Id.*

<sup>101</sup> *Id.* at 1366.

<sup>102</sup> *Id.* at 1367.

## Written Description

### **Regents of the Univ. of Minnesota v. Gilead Scis., Inc., 61 F.4th 1350 (Fed. Cir. Mar. 6, 2023)**

In this appeal from the PTAB, the Federal Circuit affirmed the PTAB's finding that the patentee failed to provide adequate written description of a subgenus.<sup>103</sup> The Court first held that the application upon which Minnesota staked its filing date did not make an *ipsis verbis* disclosure of the subgenus.<sup>104</sup> Minnesota argued it had, highlighting the claim "the compound of any one of claims 1-46 wherein R7 is hydrogen or (C1-C6)alkyl."<sup>105</sup> Minnesota argued that combining that with the disclosure of other compounds that can be substituted for each of the other 6 R groups in claims 45, 33, 13, 2, and 1, it had adequately disclosed the subgenus.<sup>106</sup> The PTAB and the Federal Circuit disagreed, since this description is not what would have been written if each of the optional steps had been set forth as the only option, rejecting this permutation strategy.<sup>107</sup>

The Court rejected Minnesota's blaze marks claim, as even if the claim blazed a trail, it did not point to one in particular or teach when to leave the trail.<sup>108</sup> While all of the elements were identified in the patent, they were not adequately identified with sufficient clarity to satisfy the written description requirement.<sup>109</sup>

### **Columbia Insurance Company v. Simpson Strong-Tie Company Inc., 2023 WL 2733427 (Fed. Cir. Mar. 31, 2023)**

In this appeal from the PTAB, the Federal Circuit affirmed a finding that all but one claim of Columbia's patent on a construction product called a "truss hanger" failed the written description requirement.<sup>110</sup> This requirement is necessary to ensure the patent application "reasonably convey[s] to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date."<sup>111</sup>

The claims at issue required an extension portion of the hanger that was "large enough to fit two layers of 5/8-inch-thick sheathing" but "too small to fit

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<sup>103</sup> Regents of the Univ. of Minnesota v. Gilead Scis., Inc., 61 F.4th 1350 (Fed. Cir. 2023)

<sup>104</sup> *Id.* at 1356-57.

<sup>105</sup> *Id.*

<sup>106</sup> *Id.*

<sup>107</sup> *Id.*

<sup>108</sup> *Id.* at 1357-58.

<sup>109</sup> *Id.*

<sup>110</sup> Columbia Insurance Company v. Simpson Strong-Tie Company Inc., 2023 WL 2733427 (Fed. Cir. 2023)

<sup>111</sup> *Id.* at \*3 (quoting Ariad Pharms., Inc. v. Eli Lilly and Co., 598 F.3d 1336, 1351 (Fed. Cir. 2010)).



three layers of 5/8-inch-thick sheathing,” setting both a lower and upper bound on its size.<sup>112</sup> However, the PTAB found that the specification only disclosed the lower bound, since it described “an extension portion sized to fit exactly two layers of 5/8 inch drywall” and nothing more.<sup>113</sup> Columbia argued that the claims should be construed as requiring only this exact lower bound, but the Federal Circuit concluded this proposed construction would be “re-writ[ing] the claims,” which by its plain language establishes a precise upper bound.<sup>114</sup> It therefore agreed with the PTAB that the claims as written “cover[ ] a range that a skilled artisan could not ‘reasonably discern’ from the specification” and affirmed.

Judge Moore dissented, arguing that the figures in the specification made clear that the hanger could be made “with an extension portion designed to create a spacing to receive two but not three sheets of 5/8”-thick drywall.”<sup>115</sup> Moore explained that, because the invention was relatively simple and not “unpredictable” like a chemical composition, the majority applied a standard for disclosure that was too high.<sup>116</sup>

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<sup>112</sup> *Id.*

<sup>113</sup> *Id.*

<sup>114</sup> *Id.* at \*4.

<sup>115</sup> *Id.* at \*7.

<sup>116</sup> *Id.* at \*7-8.

## INVENTORSHIP

### **Blue Gentian, LLC v. Tristar Products, Inc., 70 F.4th 1351 (Fed. Cir. June 9, 2023)**

In this appeal from the District of New Jersey, the Federal Circuit affirmed a finding that a nonparty, Gary Ragner, should have been named a co-inventor on the patents directed to an expandable hose that Blue Gentian had asserted against appellee Tristar.<sup>117</sup> Michael Berardi, the sole listed inventor on the patents, came up with the idea after attending a meeting in which Ragner demonstrated a similar expandable hose product, designing his first prototype mere hours after the meeting and obtaining his patents less than three months later.<sup>118</sup>

The district court concluded that Ragner disclosed three key elements of the hose to Berardi: “(1) inner and outer tubes attached only at the ends, (2) a fabric outer tube, and (3) an elastic inner tube that can provide force to retract the hose without a metal spring.”<sup>119</sup> Blue Gentian argued that these were not, in fact, elements of specific claims in its patents and therefore did not amount to contributions deserving of inventorship.<sup>120</sup> However, the Federal Circuit disagreed, pointing to the claim language and Blue Gentian’s own arguments that these same features distinguished its invention from the prior art to conclude that they were indeed key features of the invention.<sup>121</sup>

Blue Gentian also made several arguments along the lines that Ragner’s “contributions” were simply explanations of the state of the art and thus did not warrant inventorship.<sup>122</sup> The court rejected these arguments as well, concluding that Ragner’s description of how the three elements could be used in combination amounted to a contribution even if the individual elements were known in the art.<sup>123</sup> Finally, the Federal Circuit accepted the district court’s factual findings that Berardi had not conceived of these elements before meeting with Ragner and that the elements above were fully disclosed in said meeting, leading it to affirm the district court’s ruling.<sup>124</sup>

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<sup>117</sup> Blue Gentian, LLC v. Tristar Products, Inc., 70 F.4th 1351 (Fed. Cir. 2023).

<sup>118</sup> *Id.* at 1356-57.

<sup>119</sup> *Id.* at 1358.

<sup>120</sup> *Id.* at 1359.

<sup>121</sup> *Id.* at 1360-61.

<sup>122</sup> *Id.* at 1362.

<sup>123</sup> *Id.*

<sup>124</sup> *Id.* at 1362-63.

## NOVELTY

### **Dionex Softron GmbH v. Agilent Techs., Inc., 56 F.4th 1353 (Fed. Cir. Jan. 6, 2023)**

In this appeal from the PTAB, the Federal Circuit held that substantial evidence supported a finding that the defendant's earlier actual reduction to practice was sufficiently corroborated.<sup>125</sup> Agilent provided testimony from an inventor and two people who worked near him, as well as an exhibit that was marked with a last modified date as later than the reduction to practice, but with testimonial evidence that it was created before.<sup>126</sup> Dionex argued that the testimony from the first person working near the inventor was not independent since the witness did not have sufficient knowledge of the specific technology without documentary evidence from the inventor.<sup>127</sup> The Court held that the PTAB was reasonable in accepting the testimony anyways, as the witness had understood enough to know that it performed all steps of the invention.<sup>128</sup> It held that the testimony from the second person working nearby was not particularly useful, as it merely stated others considered the invention a success, but was sufficiently independent for the minimal weight it was given.<sup>129</sup> The Federal Circuit also held that the PTAB was reasonable in considering that the exhibit depicted the invention at the pertinent date, based on the aforementioned witness testimony, despite a later modification date.<sup>130</sup>

The Court rejected a requirement of negative inferences for lack of co-inventor testimony and certain documentary evidence.<sup>131</sup> The Court noted that the PTAB has discretion whether to apply a negative inference based on the totality of the circumstances, and here not drawing that negative inference was reasonable based on the representations that the co-inventor testimony would have been cumulative.<sup>132</sup>

### **Minerva Surgical, Inc. v. Hologic, Inc., 59 F.4th 1371 (Fed. Cir. Feb. 15, 2023)**

In this appeal from the District of Delaware, the Federal Circuit affirmed that the patented technology was in public use more than a year before the critical date when the device was demonstrated at a conference under pre-AIA 102(b).<sup>133</sup> First, the Court held that the conference was public – it was open to the

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<sup>125</sup> *Dionex Softron GmbH v. Agilent Techs., Inc.*, 56 F.4th 1353 (Fed. Cir. 2023).

<sup>126</sup> *Id.* at 1361.

<sup>127</sup> *Id.*

<sup>128</sup> *Id.*

<sup>129</sup> *Id.*

<sup>130</sup> *Id.*

<sup>131</sup> *Id.* at 1362.

<sup>132</sup> *Id.*

<sup>133</sup> *Minerva Surgical, Inc. v. Hologic, Inc.*, 59 F.4th 1371 (Fed. Cir. 2023).

public and well-attended by industry figures, and Minerva showcased the devices at a booth, in meetings with parties, and in a technical presentation.<sup>134</sup> The Court noted this was more than the “mere display” inadequate in *Motionless Keyboard*, as Minerva pitched the device, allowed members to scrutinize it, and received detailed feedback that demonstrated that attendees could understand the device, whether or not members of the public physically handled it.<sup>135</sup> Second, the Court held there were no confidentiality agreements, and that while Minerva argued it generally refused to disclose proprietary information prior to filing a patent, that was not followed at this conference.<sup>136</sup> Lastly, the Court held that the device disclosed at the conference included all the claimed limitations, and was ready for patenting – while it was not yet ready for use on live humans, the claims were not limited to humans and all later changes were minor at most.<sup>137</sup>

### **UCB, Inc. v. Actavis Laboratories UT, Inc., 65 F.4th 679 (Fed. Cir. Apr. 12, 2023)**

In this appeal from the District of Delaware, the Federal Circuit discussed the proper standard for anticipation of a claim with a range of values.<sup>138</sup> UCB sued Actavis and Mylan Technologies on grounds that these companies had infringed UCB’s patent relating to a transdermal therapeutic system (TTS) used to treat Parkinson’s disease.<sup>139</sup> Actavis defended by arguing the patent was invalid for anticipation because of prior art disclosing a range of TTS weight ratios that overlapped with its claimed range.<sup>140</sup> The District Court agreed, but the Federal Circuit explained that, if prior art discloses a point within a claimed range, it anticipates that claim, whereas if the prior art discloses an overlapping range, it only anticipates the claimed range if “it describes the claimed range with sufficient specificity such that a reasonable fact finder could conclude that there is no reasonable difference in how the invention operates over the ranges.”<sup>141</sup> The Federal Circuit concluded that the District Court erred in treating this as a “point-within-a-range case” rather than an overlapping ranges case.<sup>142</sup> However, it ultimately did not rule on the question of anticipation because it

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<sup>134</sup> *Id.* at 1378.

<sup>135</sup> *Id.* at 1379.

<sup>136</sup> *Id.* at 1380.

<sup>137</sup> *Id.* at 1380-81.

<sup>138</sup> UCB, Inc. v. Actavis Laboratories UT, Inc., 65 F.4th 679 (Fed. Cir. 2023)

<sup>139</sup> *Id.* at 684.

<sup>140</sup> *Id.* at 687-88.

<sup>141</sup> *Id.* at 687.

<sup>142</sup> *Id.* at 688.

found that the District Court was correct in deeming the patent invalid for obviousness.<sup>143</sup>

**Medtronic, Inc. v. Teleflex Innovations S.À.R.L., 68 F.4th 1298 (Fed. Cir. May 24, 2023)**

In this appeal from a PTAB decision in a priority case involving a pre-AIA patent, the Federal Circuit affirmed a finding that appellee Teleflex’s patents were reduced to practice before the publication of an allegedly invalidating reference.<sup>144</sup> Appellant Medtronic identified what it claimed was a prior art reference (“Itou,” dated September 23, 2005), but Teleflex argued that it did not qualify as prior art under pre-AIA rules, because the claimed inventions were either reduced to practice before Itou’s publication or pursued diligently “until their constructive reduction to practice” via filing in 2006.<sup>145</sup>

The Federal Circuit found that the claimed invention had the broad purpose of “performing the functions of a guide extension catheter” and found that inventors’ testimony and documentary evidence corroborated that this purpose was achieved prior to August 24, 2005, meaning the invention was reduced to practice before publication of Itou.<sup>146</sup> Based on this finding, it was unnecessary to reach the question of continuous diligence and the Federal Circuit affirmed the PTAB’s ruling.<sup>147</sup>

Judge Dyk dissented, arguing that testing of prototypes for the patented technologies had not shown them to work prior to Itou’s publication.<sup>148</sup> Unlike the majority, he found that Teleflex did not provide any credible evidence that the relevant invention prototypes were successfully tested before the critical date, even if the invention had been fully conceived.<sup>149</sup>

**SNIPR Technologies Limited v. Rockefeller University, 72 F.4th 1372 (Fed. Cir. July 14, 2023)**

In this appeal from the PTAB, the Federal Circuit reversed the PTAB’s finding of an interference between five post-AIA patents owned by appellant SNIPR and a pre-AIA patent application assigned to appellee Rockefeller University on grounds that patents exclusively governed by the AIA cannot be subject to an interference.<sup>150</sup> The PTAB had determined that Rockefeller was first

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<sup>143</sup> *Id.* at 689.

<sup>144</sup> *Medtronic, Inc. v. Teleflex Innovations S.À.R.L.*, 68 F.4th 1298 (Fed. Cir. 2023).

<sup>145</sup> *Id.* at 1302.

<sup>146</sup> *Id.* at 1304-1306.

<sup>147</sup> *Id.* at 1308.

<sup>148</sup> *Id.* at 1308.

<sup>149</sup> *Id.* at 1309-11.

<sup>150</sup> *SNIPR Technologies Limited v. Rockefeller University*, 72 F.4th 1372 (Fed. Cir. 2023).

to invent the claimed invention, based on its pre-AIA benefit date of February 7, 2013 and SNIPR's failure to assert an earlier invention date.<sup>151</sup> However, the court interpreted §3(n) of the AIA to say that pure pre-AIA and mixed patents are subject to interferences, while pure post-AIA patents are not.<sup>152</sup> It was not persuaded by Rockefeller's argument that without an interference, the Patent Office would have to issue two patents to the same invention because pure pre-AIA patents will always be prior art to post-AIA patents that should invalidate any duplicate patent attempts.<sup>153</sup> The court admitted that there is one extremely obscure scenario in which "a pure pre-AIA application would not be prior art to a pure AIA patent," but found this was too remote a concern to affect its ruling.<sup>154</sup> Therefore, the Federal Circuit reversed the PTAB's decision since SNIPR's patent was a pure post-AIA patent not subject to interferences.<sup>155</sup>

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<sup>151</sup> *Id.* at 1377.

<sup>152</sup> *Id.* at 1380.

<sup>153</sup> *Id.* at 1382.

<sup>154</sup> *Id.*

<sup>155</sup> *Id.*

## OBVIOUSNESS

### *Genentech, Inc. v. Sandoz Inc.*, 55 F.4th 1368 (Fed. Cir. Dec. 22, 2022)

In this appeal from the District of Delaware, the Federal Circuit affirmed a finding of unpatentability for obviousness.<sup>156</sup> The patents at issue related to dose modification of Pirfenidone, a drug to treat idiopathic pulmonary fibrosis.<sup>157</sup> Sandoz argued, and both the District Court and the Federal Circuit agreed, that the patent was obvious over a combination of a paper (Azuma), another drug's label (Pirespa), and standard medical practice.<sup>158</sup> Genentech contended that the district court improperly supplied a missing claim limitation by including varying doses in response to the occurrence of side effects from elevated liver enzymes.<sup>159</sup> The Court noted that claiming a reduction in dose in response to the occurrence of side effects is generally a well-established practice, and held that the dose modifications at issue here were obvious.<sup>160</sup> The Federal Circuit noted that the Pirespa label suggested discontinuing administration if abnormalities are observed, and the Genentech's interpretation of that excluding jaundice (the chief side effect) was not persuasive.<sup>161</sup> The Court also noted that Azuma disclosed relevant reescalation and dose reduction techniques, which in combination with Pirespa would render it obvious to alter the treatment.<sup>162</sup>

Genentech argued that secondary considerations should outweigh, as there was skepticism as to the drug's efficacy and safety and an unmet need of treating patients with elevated liver enzymes.<sup>163</sup> The Court held that Genentech failed to establish a long felt need to treat patients with this particular drug, and that Genentech's evidence of skepticism did not relate to using the at issue methods of dose modification.<sup>164</sup> As such, the Court affirmed the finding of obviousness.

### *Roku, Inc. v. Universal Electronics, Inc.*, 63 F.4th 1319 (Fed. Cir. Mar. 31, 2023)

In this appeal from the PTAB, the Federal Circuit affirmed a finding that several claims in Universal's patent for a universal remote were nonobvious.<sup>165</sup> These claims required "a listing comprised of at least a first communication method and a second communication method different than the first

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<sup>156</sup> *Genentech, Inc. v. Sandoz Inc.*, 55 F.4th 1368 (Fed. Cir. 2022)

<sup>157</sup> *Id.* at 1371.

<sup>158</sup> *Id.* at 1373.

<sup>159</sup> *Id.* at 1376.

<sup>160</sup> *Id.* at 1377.

<sup>161</sup> *Id.*

<sup>162</sup> *Id.*

<sup>163</sup> *Id.* at 1378.

<sup>164</sup> *Id.*

<sup>165</sup> *Roku, Inc. v. Universal Electronics, Inc.*, 63 F.4th 1319 (Fed. Cir. 2023).

communication method” and the parties disputed whether a patent in the prior art (Chardon) disclosed the same.<sup>166</sup> Chardon describes a process for creating a database of command codes and included at least two different types of code (IR and CEC).<sup>167</sup> Roku argued that a PHOSITA would see a list of multiple command codes as equivalent to the list of multiple communication methods in Universal’s patent.<sup>168</sup> The Federal Circuit, however, declined to overrule the PTAB’s finding of nonobviousness, concluding that the issue was a “highly contested and closely decided” finding of fact for which it was not entitled to reweigh the evidence.<sup>169</sup>

Judge Newman dissented, claiming that the majority incorrectly declined “to review the ultimate legal question of validity” just because the PTAB’s factual findings were “supported by substantial evidence.”<sup>170</sup> Newman argued that a *de novo* review was appropriate and that Chardon did, in fact, teach “at least two different communication methods” by listing both IR and CEC command codes.<sup>171</sup> Although Chardon differed from Universal’s patent in some respects, including how it approached selecting the communication method, Newman concluded that these differences did not appear in Universal’s claims, therefore making them obvious in view of Chardon nonetheless.<sup>172</sup>

#### **UCB, Inc. v. Actavis Laboratories UT, Inc., 65 F.4th 679 (Fed. Cir. Apr. 12, 2023)**

In this appeal from the District of Delaware, the Federal Circuit affirmed a finding of invalidity for obviousness.<sup>173</sup> UCB sued Actavis and Mylan Technologies on grounds that these companies had infringed UCB’s patent relating to a transdermal therapeutic system (TTS) used to treat Parkinson’s disease.<sup>174</sup> Actavis defended by arguing the patent was invalid and established a prima facie case of obviousness based on the overlap between the claimed TTS weight ratio range in UCB’s patent and a range disclosed in the prior art.<sup>175</sup> UCB argued that its range was non-obvious nevertheless, because the prior art “taught away” from its claimed weight ratio range, and because the discovery of “Form II” crystallization in its drug rendered all pre-Form II prior art irrelevant.<sup>176</sup> The Federal Circuit affirmed the rejection of both of these arguments because the

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<sup>166</sup> *Id.* at 1322.

<sup>167</sup> *Id.*

<sup>168</sup> *Id.* at 1322-24.

<sup>169</sup> *Id.* at 1325-26.

<sup>170</sup> *Id.* at 1326.

<sup>171</sup> *Id.* at 1327.

<sup>172</sup> *Id.* at 1327-28.

<sup>173</sup> UCB, Inc. v. Actavis Laboratories UT, Inc., 65 F.4th 679 (Fed. Cir. 2023)

<sup>174</sup> *Id.* at 684.

<sup>175</sup> *Id.* at 690.

<sup>176</sup> *Id.* at 690-91.



prior art merely expressed a preference for a value outside the claimed range without specifically discouraging investigation of the claimed range itself, and because Form II was similar enough to the previously-known Form I crystallization that it did not represent a change in the state of the art.<sup>177</sup>

UCB also argued it had overcome the obviousness hurdle because it had demonstrated unexpected results and commercial success.<sup>178</sup> The Federal Circuit first affirmed the District Court's finding that there were no unexpected results, primarily because the difference in stability between UCB's claimed range and the range disclosed in the prior art was only a matter of degree, rather than a difference in kind.<sup>179</sup> It then explained that an inference from commercial success to non-obviousness is weakened when there are blocking patents preventing other entrants into the market, as there were in this case.<sup>180</sup> Thus, the Federal Circuit found that it could not overrule the District Court's weighing of the commercial success evidence either, and ultimately affirmed the judgment that UCB's asserted claims were invalid as obvious.<sup>181</sup>

***Amgen Inc. v. Sandoz Inc.*, 66 F.4th 952 (Fed. Cir. Apr. 19, 2023)**

In this cross-appeal from the District of New Jersey, the Federal Circuit affirmed the District Court's findings regarding the obviousness of several claims in patents owned by Amgen directed towards the treatment of psoriasis and related conditions.<sup>182</sup> The obviousness of many claims came down to a "battle of the experts" and the Federal Circuit did not find any clear error in the lower court's weighing of the evidence.<sup>183</sup> The evaluation of two claims, however, turned on an evaluation of the "objective indicia of nonobviousness."<sup>184</sup>

Although nonobviousness is an "expansive and flexible" test that can consider a variety of indicia, this inquiry focused specifically on unexpected results, long-felt need, and the failure of others.<sup>185</sup> The Federal Circuit affirmed a finding of unexpected results based on prior art suggesting that the compound disclosed in Amgen's patent would achieve a two-fold increase in potency, when it in fact achieved a twenty-fold increase in potency.<sup>186</sup> This unexpected result was found to have a nexus to Amgen's claims because "the unexpected

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<sup>177</sup> *Id.* at 691-93.

<sup>178</sup> *Id.* at 693-95.

<sup>179</sup> *Id.*

<sup>180</sup> *Id.* at 696-97.

<sup>181</sup> *Id.* at 697.

<sup>182</sup> *Amgen Inc. v. Sandoz Inc.*, 66 F.4th 952 (Fed. Cir. 2023).

<sup>183</sup> *Id.* at 962-968.

<sup>184</sup> *Id.* at 963.

<sup>185</sup> *Id.* at 963-64.

<sup>186</sup> *Id.*

properties of a compound necessarily have a nexus to that compound.”<sup>187</sup> The findings of long-felt need and failure of others were also affirmed, based on credible evidence that there was a long-felt need for a psoriasis treatment that was suitable for oral administration and several attempts by others to develop a similar product to Amgen’s that had failed during development or were not sufficiently effective at tolerable doses.<sup>188</sup>

***Yita LLC v. MacNeil IP LLC*, 69 F.4th 1356 (Fed. Cir. June 6, 2023)**

In this appeal from the PTAB, the Federal Circuit reversed one finding of non-obviousness and upheld another for claims in two of appellee MacNeil’s patents, both directed to a vehicle floor tray.<sup>189</sup> The PTAB found the first claim set non-obvious because MacNeil presented secondary-consideration evidence it found convincing.<sup>190</sup> However, the Federal Circuit found reliance on this secondary evidence improper because it lacked a nexus to the invention’s success.<sup>191</sup> First, although the PTAB concluded the evidence was valid because it was related to a feature of the invention that was not “well-known” in the prior art, the Federal Circuit determined that if the feature is merely *known* in the prior art, the evidence lacks a nexus to nonobviousness.<sup>192</sup> Second, it found that the PTAB incorrectly relied on precedent allowing for a nexus when evidence is tied to a combination of elements, because the evidence at issue was only directed to a single element of the invention.<sup>193</sup>

The Federal Circuit then upheld the PTAB’s finding that MacNeil’s second claim set was nonobvious.<sup>194</sup> Appellant Yita only challenged this finding on grounds that the PTAB declined to consider an argument in made in a footnote of a reply brief.<sup>195</sup> The court determined that it was within the PTAB’s discretion not to consider such an argument and thus affirmed.<sup>196</sup>

***In re Couvaras*, 70 F.4th 1374 (Fed. Cir. June 14, 2023)**

In this appeal from the PTAB, the Federal Circuit affirmed the PTAB’s finding of obviousness for Couvaras’ patent directed to treating hypertension using two different active agents, both of which had been known for “decades”

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<sup>187</sup> *Id.* at 964.

<sup>188</sup> *Id.*

<sup>189</sup> *Yita LLC v. MacNeil IP LLC*, 69 F.4th 1356 (Fed. Cir. 2023).

<sup>190</sup> *Id.* at 1364.

<sup>191</sup> *Id.*

<sup>192</sup> *Id.*

<sup>193</sup> *Id.* at 1364-65.

<sup>194</sup> *Id.* at 1365.

<sup>195</sup> *Id.*

<sup>196</sup> *Id.*

to be effective for lowering blood pressure.<sup>197</sup> Although these agents were already well-known, Couvaras argued his invention was not obvious because it produced effective results through the unexpected mechanism of increased prostacyclin release in patients.<sup>198</sup> However, the court explained that, even when the mechanism for achieving a result is unexpected, a prima facie case of obviousness cannot be overcome unless the *result* itself is unexpected.<sup>199</sup> It then concluded that the reduction in blood pressure levels Couvaras had achieved was merely “the same ultimate result as the two separate compounds were known to effect” and therefore not surprising.<sup>200</sup> The court therefore affirmed the PTAB’s decision that Couvaras’ recitation of “the mechanism for known compounds to yield a known result” could not overcome the prima facie obviousness of his claims.<sup>201</sup>

**Volvo Penta of the Americas, LLC v. Brunswick Corporation, 81 F.4th 1202 (Fed. Cir. Aug. 24, 2023)**

In this appeal from the PTAB, the Federal Circuit vacated and remanded the PTAB’s finding of obviousness for appellant Volvo’s patent directed to “a tractor-type stern drive for a boat.”<sup>202</sup> Volvo argued that the PTAB had failed to give proper weight to its evidence of secondary considerations indicating that its patent was not obvious in light of several prior art references raised by appellee Brunswick.<sup>203</sup> The court agreed, holding the PTAB failed to properly consider these objective indicia of nonobviousness for several reasons.<sup>204</sup>

First, the PTAB only accorded its finding that Brunswick had copied Volvo’s invention “some weight,” whereas precedent dictates that a determination of copying is one of the strongest possible objective indicia of nonobviousness.<sup>205</sup> Second, it likewise only gave its finding of commercial success “some weight,” which seemed insubstantial given that Brunswick did not contest this finding in any meaningful way.<sup>206</sup> Third, the PTAB also gave evidence of industry praise “some weight,” without explaining whether this means all three of copying, commercial success, and industry praise are given equal weight or whether “some weight” meant a different weight in all three

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<sup>197</sup> *In re Couvaras*, 70 F.4th 1374 (Fed. Cir. 2023).

<sup>198</sup> *Id.* at 1378-79.

<sup>199</sup> *Id.* at 1380.

<sup>200</sup> *Id.*

<sup>201</sup> *Id.*

<sup>202</sup> *Volvo Penta of the Americas, LLC v. Brunswick Corporation*, 81 F.4th 1202 (Fed. Cir. 2023).

<sup>203</sup> *Id.* at 1213.

<sup>204</sup> *Id.*

<sup>205</sup> *Id.*

<sup>206</sup> *Id.* at 1213-14.

contexts.<sup>207</sup> Fourth, the Federal Circuit found that the PTAB neglected substantial evidence that indicated long-felt but unresolved need for Volvo’s product.<sup>208</sup> Fifth, the fact that the prior art references had been issued fifty years ago was improperly overlooked because there was evidence of unmet market demand for the product during that time period, implying nonobviousness due to failure of others who might have commercialized the product to do so.<sup>209</sup> Sixth and finally, the PTAB provided no explanation for its finding that the summation of all the above factors still added up being less credible than Brunswick’s evidence of obviousness, resulting in its decision being vacated and remanded by the Federal Circuit.<sup>210</sup>

***Netflix, Inc. v. DivX, LLC*, 80 F.4th 1352 (Fed. Cir. Sept. 11, 2023)**

In this appeal from the PTAB, the Federal Circuit found that the PTAB abused its discretion in determining that appellant Netflix failed to identify a “field of endeavor” when identifying analogous prior art but affirmed its finding that the prior art was not “reasonably pertinent” to the patent at hand.<sup>211</sup> P

Precedent for determining whether prior art renders a claimed invention obvious requires a determination that a PHOSITA would consider the prior art part of the “field of his endeavor.”<sup>212</sup> The PTAB found that Netflix did not identify a field of endeavor and therefore could not prove the patent’s obviousness.<sup>213</sup> The Federal Circuit disagreed, holding that, even though Netflix did not specifically use the words “field of endeavor,” it had identified at least two potential fields of endeavor in its reply brief.<sup>214</sup> Given that the use of “magic words” is not required and that the PTAB itself identified two potential fields of endeavor the patent and prior art might share, the court concluded that the PTAB’s decision on the matter should be vacated.<sup>215</sup>

However, the Federal Circuit affirmed the PTAB’s finding that the proffered prior art was not “reasonably pertinent to the particular problem with which the inventor was involved.”<sup>216</sup> While the patent was directed to the “trick play” of videos and streaming multimedia, the prior art addressed the issue of image compression in a camera’s internal memory.<sup>217</sup> The court held that there

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<sup>207</sup> *Id.* at 1214.

<sup>208</sup> *Id.* at 1214-15.

<sup>209</sup> *Id.* at 1215.

<sup>210</sup> *Id.*

<sup>211</sup> *Netflix, Inc. v. DivX, LLC*, 80 F.4th 1352 (Fed. Cir. 2023).

<sup>212</sup> *Id.* at 1358.

<sup>213</sup> *Id.* at 1359.

<sup>214</sup> *Id.* at 1359-60.

<sup>215</sup> *Id.* at 1360-61.

<sup>216</sup> *Id.* at 1362 (quoting *Airbus S.A.S. v. Firepass Corporation*, 941 F.3d 1374, 1381 (Fed. Cir. 2019)).

<sup>217</sup> *Id.* at 1363.

was substantial evidence on the record to uphold the PTAB's findings that these were distinct problems and therefore the prior art was not reasonably pertinent.<sup>218</sup>

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<sup>218</sup> *Id.*

## CLAIM CONSTRUCTION

### *Salazar v. AT&T Mobility LLC*, 64 F.4th 1311 (Fed. Cir. Apr. 5, 2023)

In this appeal from the Eastern District of Texas, the Federal Circuit upheld the District Court’s construction of a claim in Salazar’s patent describing wireless and wired communication technology.<sup>219</sup> The claim required “a microprocessor for generating ..., said microprocessor creating ..., a plurality of parameter sets retrieved by said microprocessor ..., [and] said microprocessor generating,” which was construed to mean at least one microprocessor must be configured to perform all three of the generating, creating, and retrieving functions.<sup>220</sup>

While “the indefinite article ‘a’ means ‘one or more’ in open-ended claims . . .,” subsequent language which is singular can limit a claim such that a single device must be capable of several functions.<sup>221</sup> The Federal Circuit found that, here, the claim language referring back to “said microprocessor” limited the claim such that “at least one microprocessor capable of performing each of the recited functions” is required, rather than multiple microprocessors each able to perform just one of the functions.<sup>222</sup> Therefore, the District Court’s claim construction was affirmed.

*Finjan LLC v. SonicWall, Inc.*, 2023 WL 6775035 (Fed. Cir. Oct. 13, 2023) In this appeal from the Northern District of California, the Federal Circuit affirmed the district court’s grant of summary judgment of noninfringement of Finjan’s patent directed towards computer-based systems and methods for facilitating network security.<sup>223</sup> The infringement analysis centered around claim construction for the term “a computer,” which was construed to refer to “one or more” computers, and the term “the computer,” which was construed to refer to the “same ‘one or more computers’ from the first limitation.”<sup>224</sup> The court explained that, as a matter of plain language, use of the definite article “the” refers back to a previously claimed limitation, meaning that each use of “the computer” adds another step that the same computer must perform.<sup>225</sup> Therefore, it concluded that a system using one or more computers can be infringing on a claim referring to “a computer,” but only if at least one of those computers performs all the functions listed in the claim.<sup>226</sup> Given this claim construction, the Federal Circuit

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<sup>219</sup> *Salazar v. AT&T Mobility LLC*, 64 F.4th 1311 (Fed. Cir. 2023).

<sup>220</sup> *Id.* at 1315.

<sup>221</sup> *Id.* at 1315-17 (internal citations omitted).

<sup>222</sup> *Id.* at 1318.

<sup>223</sup> *Finjan LLC v. SonicWall, Inc.*, 2023 WL 6775035 (Fed. Cir. 2023).

<sup>224</sup> *Id.* at \*7.

<sup>225</sup> *Id.* at \*7-8.

<sup>226</sup> *Id.* at \*8.

affirmed the district court's finding of noninfringement because accused infringer SonicWall did not perform every claim limitation on the same computer.<sup>227</sup>

***Sisvel International S.A. v. Sierra Wireless, Inc.*, 81 F.4th 1231 (Fed. Cir. Sept. 1, 2023)**

In this appeal from the PTAB, the Federal Circuit affirmed the PTAB's decision that the claim language "'connection rejection message' should be given its plain and ordinary meaning of 'a message that rejects a connection,'" rendering the claim anticipated and/or obvious.<sup>228</sup> Appellant Sisvel challenged this construction on grounds the specification should limit the claim's scope to only "GSM and UMTS networks," as these were the only networks expressly mentioned in the specification.<sup>229</sup> However, the court found that the specification was sufficiently clear that the invention was applicable to any cellular telecommunications system in which the network could send a rejection message.<sup>230</sup> Therefore, it concluded that the GSM and UMTS networks were merely exemplary and not mandatory, validating the PTAB's claim construction and its conclusion the claim was too broad to be patentable.<sup>231</sup>

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<sup>227</sup> *Id.* at \*7,\*9.

<sup>228</sup> *Sisvel International S.A. v. Sierra Wireless, Inc.*, 81 F.4th 1231 (Fed. Cir. 2023).

<sup>229</sup> *Id.* at 1237.

<sup>230</sup> *Id.* at 1236.

<sup>231</sup> *Id.* at 1236-37.

## INFRINGEMENT

### Inducement

#### *Genentech, Inc. v. Sandoz Inc.*, 55 F.4th 1368 (Fed. Cir. Dec. 22, 2022)

In this appeal from the District of Delaware, the Federal Circuit affirmed a finding of non-infringement, holding that the direct infringement necessary for inducement did not necessarily occur.<sup>232</sup> The patent at issue required prescribing pirfenidone along with fluvoxamine.<sup>233</sup> The defendant provided evidence that physicians would not prescribe pirfenidone to a patient taking fluvoxamine, and that they would choose the non-infringing alternative of nintedanib.<sup>234</sup> While the label included a suggestion to prescribe the drugs together, the Court held that the district court did not err by considering the physician evidence and weighing it against the label.<sup>235</sup> The Federal Circuit held the argument that at least one patient was treated with both as overly speculative, since there were always alternatives and evidence in the record that doctors would use those alternatives.<sup>236</sup>

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<sup>232</sup> *Genentech, Inc. v. Sandoz Inc.*, 55 F.4th 1368 (Fed. Cir. 2022).

<sup>233</sup> *Id.* at 1379.

<sup>234</sup> *Id.* at 1380.

<sup>235</sup> *Id.*

<sup>236</sup> *Id.*



## DEFENSES

### Prosecution Laches

#### **Personalized Media Commc'ns, LLC v. Apple Inc., 57 F.4th 1346 (Fed. Cir. Jan. 20, 2023)**

In this appeal from the Eastern District of Texas, the Federal Circuit affirmed a finding of prosecution laches.<sup>237</sup> The patentee waited eight to fourteen years to file and sixteen years to present the claims for examination, filed 300 GATT bubble applications, each of its applications had over 500 pages of text and figures, and expanded its claims from one in the original to 20,000 by the end.<sup>238</sup> The Court affirmed the finding of unreasonable and inexcusable delay under these circumstances.<sup>239</sup> While the patentee complied with an agreement it made with the PTO, the patentee's conduct was still burdensome and dilatory, and was not equitable.<sup>240</sup> No expert on PTO proceedings was required, the fact that the patentee was successfully issued 100 patents did not demonstrate that the PTO was not hampered, the district court was within its rights to consider the examiners' statements condemning the prosecution strategy, and the district court was within its discretion to interpret a document stating that the patentee intended to use IP to exercise market control for 50 years as referring to patents, rather than just copyright.<sup>241</sup>

On prejudice, the Court held that there was dilatory conduct even after Apple began developing its product, and that the patentee was still implementing its strategy of delay.<sup>242</sup> The patentee also benefited from the chance to lengthen the examination process and get a second bite at the apple in the at issue period, creating prejudice.<sup>243</sup> Judge Stark dissented on this point.<sup>244</sup>

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<sup>237</sup> Personalized Media Commc'ns, LLC v. Apple Inc., 57 F.4th 1346 (Fed. Cir. 2023)

<sup>238</sup> *Id.* at 1350-51.

<sup>239</sup> *Id.* at 1354-57.

<sup>240</sup> *Id.* at 1354.

<sup>241</sup> *Id.* at 1356.

<sup>242</sup> *Id.* at 1357-58.

<sup>243</sup> *Id.*

<sup>244</sup> *Id.* at 1358.

## REMEDIES

### Damages

#### *Adasa Inc. v. Avery Dennison Corp.*, 55 F.4th 900 (Fed. Cir. Dec. 16, 2022)

In this appeal from the District of Oregon, the Federal Circuit affirmed the District Court's decision not to present a lump sum instruction to the jury, and its decision to exclude the defendant's damages witness from testifying to certain licenses.<sup>245</sup> Neither party presented a lump sum damages theory before the jury, but the defendant argued that the licenses standing alone supported that instruction.<sup>246</sup> The Federal Circuit rejected this, noting that the defendant repeatedly argued against the relevancy of those very licenses, and actively undermined the lump sum theory they now relied upon.<sup>247</sup>

The Court upheld the exclusion of certain licenses for defendant's failure to adequately establish economic and technological comparability.<sup>248</sup> The licenses at issue involved hundreds or thousands of patents, and there was no meaningful comparison other than that the license included patents covering RFID technology.<sup>249</sup> This was too vague for the Court, and exclusion was warranted.<sup>250</sup>

#### *Cyntec Company, Ltd. v. Chilisin Electronics Corp.*, 2023 WL 6798376 (Fed. Cir. Oct 16, 2023)

In this appeal from the Northern District of California, the Federal Circuit vacated and remanded a damages award on grounds that the district court abused its discretion in denying appellant Chilisin's *Daubert* motion to exclude testimony of appellee Cyntec's damages expert.<sup>251</sup> *Daubert* motions are intended to exclude irrelevant or unreliable scientific testimony, and have been used in the damages context to exclude expert testimony containing conclusions unsupported by the record.<sup>252</sup> In this case, the court found that the expert's estimates of Chilisin's indirect sales to the United States were unreliable, given that he relied on "sales of irrelevant products and services" that did not contain the accused invention to make his projections.<sup>253</sup> It therefore vacated the

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<sup>245</sup> *Adasa Inc. v. Avery Dennison Corp.*, 55 F.4th 900 (Fed. Cir. Dec. 16, 2022)

<sup>246</sup> *Id.* at 914.

<sup>247</sup> *Id.*

<sup>248</sup> *Id.* at 915.

<sup>249</sup> *Id.*

<sup>250</sup> *Id.*

<sup>251</sup> *Cyntec Company, Ltd. v. Chilisin Electronics Corp.*, 2023 WL 6798376 (Fed. Cir. 2023).

<sup>252</sup> *Id.* at \*6.

<sup>253</sup> *Id.* at \*6-7.

damages award, holding that this expert testimony was “unreliable and speculative” and should not have been admitted by the district court.<sup>254</sup>

## **ITC Exclusion Orders**

### **Philip Morris Products S.A. v. International Trade Commission, 63 F.4th 1328 (Fed. Cir. Mar. 31, 2023)**

In this appeal from the International Trade Commission (ITC), the Federal Circuit held that the ITC satisfied its duty to consider the public interest before enjoining the production of “IQOS” vapor nicotine products manufactured by Philip Morris, which were infringing on patents held by Reynolds Tobacco.<sup>255</sup> Philip Morris argued that the FDA is the only agency competent to oversee tobacco regulation, at that it had deemed IQOS products in the public interest by issuing Philip Morris “marketing orders available for products ‘appropriate for the protection of public health’” and allowing the products to be marketed as “reduced risk.”<sup>256</sup> However, the Court explained the ITC had reasonably relied on FDA documents indicating that enjoining IQOS products would not “adversely impact the public health and welfare, particularly given the existence of other non-tobacco therapies that reduce tobacco use.”<sup>257</sup> Given that the ITC’s decision could only be overturned for an “arbitrary and capricious” abuse of discretion, the Court decided to affirm.<sup>258</sup>

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<sup>254</sup> *Id.* at \*8.

<sup>255</sup> Philip Morris Products S.A. v. International Trade Commission, 63 F.4th 1328 (Fed. Cir. 2023).

<sup>256</sup> *Id.* at 1339.

<sup>257</sup> *Id.* at 1340.

<sup>258</sup> *Id.*

## PRACTICE AND PROCEDURE

### Venue and Transfer

#### *In re Amazon.com, Inc.*, No. 2022-157, 2022 WL 17688072 (Fed. Cir. Dec. 15, 2022)

The Federal Circuit granted Amazon's petition for a writ of mandamus directing Judge Albright to sever Amazon's claims from those of CFE, a small business in the Western District of Texas, and to transfer the claims against Amazon to the District of Colorado.<sup>259</sup> Judge Albright had originally denied the motions, holding that CFE was not a peripheral party to the case as it sold infringing products on Amazon's website, denied the motion to sever, and then held that the action could not have been brought over CFE in Colorado.<sup>260</sup>

The Federal Circuit granted the petition, holding that the district court erred by failing to recognize that the plaintiff added CFE only after Amazon filed a motion to transfer.<sup>261</sup> The Court also noted that CFE was the only W.D. Tex. Online reseller out of 150, highlighting that this was likely an attempt to influence the transfer process.<sup>262</sup> Even without that, the Court held severance was appropriate given the size of the claims against CFE were maximum \$3,000, making them peripheral to the much larger claims against Amazon.<sup>263</sup> There were significant benefits to transferring to Colorado that needed to be weighed, as much more of the relevant evidence was in Colorado.<sup>264</sup> As such, the Federal Circuit ordered the severance and transfer motion be granted.<sup>265</sup>

#### *In re Google LLC*, 58 F.4th 1379 (Fed. Cir. Feb. 1, 2023)

The Federal Circuit granted Google's petition for writ of mandamus to transfer from the Western District of Texas to the Northern District of California.<sup>266</sup> The district court had found venue proper, arguing that a co-pending case in the Western District of Texas made it expeditious, that the case would be faster in the Western District, that the cost of willing witnesses was only slightly different (after discounting a declaration from a Google PM identifying key witnesses), that local interest was neutral since Jawbone had a corporate residence in Waco, and that ease of access to proof was neutral.<sup>267</sup>

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<sup>259</sup> *In re Amazon.com, Inc.*, No. 2022-157, 2022 WL 17688072 (Fed. Cir. Dec. 15, 2022).

<sup>260</sup> *Id.* at \*1.

<sup>261</sup> *Id.* at \*3.

<sup>262</sup> *Id.*

<sup>263</sup> *Id.*

<sup>264</sup> *Id.* at \*4.

<sup>265</sup> *Id.*

<sup>266</sup> *In re Google LLC*, 58 F.4th 1379 (Fed. Cir. 2023).

<sup>267</sup> *Id.* at 1383-85.

The Federal Circuit reversed. On the co-pending case, the Court noted that that case also had a pending transfer motion which would make it just as efficient to transfer both.<sup>268</sup> The Federal Circuit deferred on the court congestion factor, but held that it should not be given much weight since the plaintiff is a NPE.<sup>269</sup> The Court held that it was clearly erroneous to give such little weight to the cost of attendance for willing witnesses factor, as the evidence from declarations was clear that key employees who worked on the product were in California.<sup>270</sup> It held that weighing Jawbone’s office location in local interest was an abuse of discretion, since Jawbone had no meaningful presence there, especially when compared to the facts tying the litigation to California.<sup>271</sup> It also held that the relative ease of access factor weighed in favor of transfer, as physical prototypes were all in the N.D. Cal.<sup>272</sup> Given no factor weighed against transfer and many favored transfer, the Court ordered transfer.

***In re Microsoft Corporation*, 2023 WL 3861078 (Fed. Cir. June 7, 2023)**

In this petition for a writ of mandamus from the Western District of Texas (“WDTX”), the Federal Circuit granted Microsoft’s petition to transfer the case to the Western District of Washington (“WDWA”).<sup>273</sup> The central dispute was whether WDWA would be more convenient for potential witnesses.<sup>274</sup> The district court found no difference between the locations because, although at least 27 potential witnesses were recognized in WDWA, the two Microsoft employees who worked on the product team at issue resided in Texas. The Federal Circuit deemed this a clear abuse of discretion, as “[s]uch a substantial imbalance in witness convenience cannot be negated” absent specific findings that the convenience of the minority of witnesses was more important, which did not exist here.<sup>275</sup> It then found that WDWA also had the edge in terms of access to sources of proof and local interest, given that many of the events giving rise to the suit took place there, concluding the denial of transfer was improper overall.<sup>276</sup>

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<sup>268</sup> *Id.* at 1383.

<sup>269</sup> *Id.*

<sup>270</sup> *Id.* at 1384.

<sup>271</sup> *Id.*

<sup>272</sup> *Id.* at 1385.

<sup>273</sup> *In re Microsoft Corporation*, 2023 WL 3861078 (Fed. Cir. 2023).

<sup>274</sup> *Id.* at \*1.

<sup>275</sup> *Id.* at \*2.

<sup>276</sup> *Id.*

## Disclosure of Controlling Entities

*In re Nimitz Techs. LLC*, No. 2023-103, 2022 WL 17494845 (Fed. Cir. Dec. 8, 2022)

The Federal Circuit denied Nimitz’s petition for a writ of mandamus directing Judge Connolly to vacate his order directing Nimitz to turn over certain disclosure information.<sup>277</sup> Judge Connolly has two relevant standing orders: one requiring disclosure of the name of every owner/member/party proceeding up the chain of ownership until the name of every individual or corporation with an interest in the party has been identified, and an order ordering disclosure of third party litigation funding.<sup>278</sup> Nimitz failed to comply, so Judge Connolly issued a show cause order.<sup>279</sup> Nimitz then claimed it had a single owner and no third party funding.<sup>280</sup> The district court learned from a separate case that IP Edge LLC was arranging assignment to LLCs and that the owner of Nimitz seemed connected with IP Edge.<sup>281</sup> Judge Connolly ordered a hearing and production of various correspondence between Nimitz, IP Edge, and another entity named Mavexar, as well as bank statements.<sup>282</sup>

Nimitz argued that the order would force it to turn over attorney-client privileged information, but the Court did not require the records to be docketed or public, so mandamus was not the only recourse to protect privileged materials.<sup>283</sup> As such, the Federal Circuit denied mandamus.<sup>284</sup> It also noted that the district court has wide discretion to handle this matter, and that the issues it identified were related to proper practice before the court and were not solely for public awareness.<sup>285</sup>

## Anti-Speech Injunction

*Lite-Netics, LLC v. Nu Tsai Cap. LLC*, 60 F.4th 1335 (Fed. Cir. Feb. 17, 2023)

In this appeal from the District of Nebraska, the Federal Circuit vacated a preliminary injunction restricting patent-related speech.<sup>286</sup> The defendant filed a counterclaim on defamation and tortious interference and sought a TRO and a preliminary injunction barring the plaintiff from making statements accusing the

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<sup>277</sup> *In re Nimitz Techs. LLC*, No. 2023-103, 2022 WL 17494845 (Fed. Cir. Dec. 8, 2022)

<sup>278</sup> *Id.* at \*1.

<sup>279</sup> *Id.*

<sup>280</sup> *Id.*

<sup>281</sup> *Id.*

<sup>282</sup> *Id.*

<sup>283</sup> *Id.* at \*2.

<sup>284</sup> *Id.*

<sup>285</sup> *Id.*

<sup>286</sup> *Lite-Netics, LLC v. Nu Tsai Cap. LLC*, 60 F.4th 1335 (Fed. Cir. 2023).

defendant of copying the products and from suggesting to defendant's customers that they could be subject to a suit.<sup>287</sup> The district court granted the TRO, then continued to grant the preliminary injunction.<sup>288</sup> It held that the claims were not preempted since the plaintiff's claims were clearly meritless and in bad faith, so the defendant was likely to succeed, and that the non-merits factors favored issuance.<sup>289</sup>

The Federal Circuit vacated the injunction, holding that the district court had abused its discretion in finding that the infringement allegations were objectively baseless.<sup>290</sup> While the Court was skeptical of the plaintiff's arguments, they were at least somewhat reasonable at the pre-claim construction stage and could be extended through the doctrine of equivalents.<sup>291</sup> Given this, and the strong free speech interests against these preliminary injunctions, the Court vacated the preliminary injunction.<sup>292</sup>

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<sup>287</sup> *Id.* at 1341.

<sup>288</sup> *Id.*

<sup>289</sup> *Id.* at 1342.

<sup>290</sup> *Id.* at 1344.

<sup>291</sup> *Id.* at 1344-49.

<sup>292</sup> *Id.*

## PTO AND PTAB PROCEDURE

### Patent Extensions and Continuations

#### *In re: Collect, LLC*, 81 F.4th 1216 (Fed. Cir. Aug. 28, 2023)

In this appeal from the PTAB, the Federal Circuit affirmed the PTAB's ruling that claims in Collect's patents were unpatentable on obviousness-type double patenting ("OTDP") grounds. This dispute arose because each of the patents at issue had received patent-term adjustment ("PTA") for USPTO delays and therefore were assigned different expiration dates from one another and a family member (the '036 patent) that did not receive PTA.<sup>293</sup> When Collect sued Samsung for infringement of these patents, Samsung defended that the patents were unpatentable based on OTDP, due to these staggered expiration dates.<sup>294</sup> The PTAB agreed and sustained a finding of unpatentability.<sup>295</sup>

Collect appealed the PTAB's decision on grounds the OTDP analysis should not be based on an expiration date that includes any duly granted PTA, given that OTDP does not invalidate patent term extensions ("PTEs"), which it argued are analogous to PTAs.<sup>296</sup> However, the court found that PTE and PTA have distinct purposes, with the former being designed to "extend the overall patent term for a single invention due to regulatory delays in product approval," while the latter is designed to compensate for "delays in the processing of [the] patent."<sup>297</sup> PTA is also distinct from PTE in that, by statute, it may not extend a term past any date in a filed terminal disclaimer.<sup>298</sup> Given that terminal disclaimers and OTDP are designed to solve the same issue and are seen as "two sides of the same coin," the Federal Circuit found the "statutory recognition of the binding power of terminal disclaimers" over PTAs to be convincing evidence that OTDP concerns have the same power.<sup>299</sup> Therefore, the court concluded OTDP must be based on the expiration date of a patent after any PTA has been added and affirmed the PTAB's decision.<sup>300</sup>

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<sup>293</sup> *Id.* at 1219-20.

<sup>294</sup> *Id.* at 1220.

<sup>295</sup> *Id.* at 1222.

<sup>296</sup> *Id.* at 1223.

<sup>297</sup> *Id.* at 1227.

<sup>298</sup> *Id.* at 1228.

<sup>299</sup> *Id.*

<sup>300</sup> *Id.* at 1229.



## Reissue

### *In re Float'N'Grill LLC*, 72 F.4th 1347 (Fed. Cir. July 12, 2023)

In this appeal from the PTAB, the Federal Circuit affirmed the PTAB's finding that claims in Float'N'Grill's reissue application were not directed to the invention disclosed in the original patent.<sup>301</sup> The original patent was directed to a float designed to allow a grill to be floated on a body of water.<sup>302</sup> Once a patent is granted, a patentee seeking to change the scope of its claims through reissue is limited to claims "directed to 'the invention disclosed in the original patent.'"<sup>303</sup> To satisfy this requirement, the reissue patent must, on its face, fully describe and claim the same invention secured by the original patent.<sup>304</sup> In this case, the court found this requirement was not met because the original specification describes "a float apparatus having a grill support including a plurality of magnets for safely and removably securing the grill to the float."<sup>305</sup> The magnet component of the support structure, however, was absent from the reissue claim, and the original specification did not disclose any other means of providing support.<sup>306</sup> Therefore, the court held that the magnets were an essential part of the invention that was left out of the reissue claims, meaning the claims were properly rejected by the PTAB.<sup>307</sup>

## Inter Partes Review Procedure

### *Apple Inc. v. Vidal*, 63 F.4th 1, 2023 WL 2469635 (Fed. Cir. Mar. 13, 2023)

In this appeal from the Northern District of California, the Federal Circuit held that challenges to the PTO director's instructions to the PTAB on how to handle discretionary denials were not reviewable, but that a challenge to the lack of notice and comment was reviewable.<sup>308</sup> The challengers here sought to challenge the instructions from *Fintiv* and Director Vidal's updated instructions as contrary to the statute, arbitrary and capricious, and as having been issued without notice and comment.<sup>309</sup>

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<sup>301</sup> *In re Float'N'Grill LLC*, 72 F.4th 1347 (Fed. Cir. 2023).

<sup>302</sup> *Id.* at 1348-49.

<sup>303</sup> *Id.* at 1350 (quoting *Antares Pharma, Inc. v. Medac Pharma Inc.*, 771 F.3d 1354, 1358 (Fed. Cir. 2014)).

<sup>304</sup> *Id.* at 1351.

<sup>305</sup> *Id.* at 1353.

<sup>306</sup> *Id.*

<sup>307</sup> *Id.* at 1353-55.

<sup>308</sup> *Apple Inc. v. Vidal*, 63 F.4th 1, 2023 WL 2469635 (Fed. Cir. 2023)

<sup>309</sup> *Id.* at \*5.

On the first two elements the Court held that 314(d) precludes judicial review of challenged agency actions, bringing the case under the APA 701(a)(1) exception.<sup>310</sup> The Federal Circuit distinguished *SAS*, where the subject was the interpretation of the scope of the final written decision, as not having been about institution decisions which are unreviewable under *Cuozzo*.<sup>311</sup> While this case was not seeking review of a single decision, but rather broad instructions, the Court still held that the subject matter was that which Congress decided was unreviewable.<sup>312</sup> The Court noted that for the system to function, the PTO director must be able to delegate their discretion with instructions, and precluded the challenge under the APA.<sup>313</sup>

The Court allowed the notice and comment challenge to proceed, as notice and comment challenges are separate from substantive rulemaking.<sup>314</sup> Nor did the statute commit this discretion to law, so neither APA exception applied and the notice and comment rulemaking challenge was permissible.<sup>315</sup> The Court held Apple had standing to press it, as it is a repeat player and has had petitions denied on *Fintiv* (and indeed in *Fintiv*) repeatedly, so it is not speculative to assume it will happen again.<sup>316</sup> Similarly, it was possible that through notice and comment rulemaking the instructions could end up more favorable to Apple, so redressability was satisfied.<sup>317</sup>

***Google LLC v. Valtrus Innovations Limited, IPR2022-01197, Paper 12, (PTAB Mar. 29, 2023) (Director Decision)***

In this Director review decision, Director Vidal held that the PTAB erred in denying Google’s request to file a reply on the §325(d) issues raised in Valtrus’ preliminary response.<sup>318</sup> Google petitioned that several claims of Valtrus’ patent were obvious over the *Vea* patent, but Valtrus urged the PTAB to exercise its discretion to deny Google’s petition under §325(d) because the PTAB had already reviewed the European equivalent of *Vea* and therefore considered its “substance.”<sup>319</sup> The PTAB denied Google’s request to file a reply to this

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<sup>310</sup> *Id.* at \*7.

<sup>311</sup> *Id.*

<sup>312</sup> *Id.* at \*8.

<sup>313</sup> *Id.*

<sup>314</sup> *Id.* at \*9.

<sup>315</sup> *Id.*

<sup>316</sup> *Id.* at \*11.

<sup>317</sup> *Id.*

<sup>318</sup> *Google LLC v. Valtrus Innovations Limited, IPR2022-01197, Paper 12, (PTAB Mar. 29, 2023) (Director Decision).*

<sup>319</sup> *Id.*

argument, finding Google failed to demonstrate good cause since it should have developed a reply to this argument in its earlier petition.<sup>320</sup>

However, Director Vidal explained that a petitioner “cannot be expected to anticipate every argument that may be raised by a patent owner” in its petition.<sup>321</sup> She concluded that it was not reasonably foreseeable for Google to anticipate a §325(d) argument given that it had no way of knowing the European equivalent of *Veal* had been reviewed during prosecution.<sup>322</sup> Thus, Director Vidal vacated the PTAB’s decision and remanded the case for consideration of both parties’ §325(d) arguments.<sup>323</sup>

## Constitutionality and Jurisdiction

### *Shamoon v. Resideo Technologies, Inc.*, 2023 WL 5031508 (Fed. Cir. Aug. 8, 2023)

In this appeal from the PTAB, the Federal Circuit held that it was not an unconstitutional taking to apply post-grant proceedings created by the AIA to a pre-AIA patent.<sup>324</sup> When two IPR proceedings found many of the claims in his pre-AIA patent unpatentable, Mr. Shamoon argued this was an impermissible taking without just compensation, given that “pre-AIA patent applicants had no way of knowing that their duly granted patents would be subject to this new post-grant agency proceeding.”<sup>325</sup> However, the court rejected this argument, citing precedent in which it had already “ruled that ‘the retroactive application of IPR proceedings to pre-AIA patents is not an unconstitutional taking under the Fifth Amendment.’”<sup>326</sup> The court did not reconsider this precedent or explain it any further.

## Collateral Estoppel Effect of IPR

### *Google LLC v. Hammond Dev. Int'l, Inc.*, 54 F.4th 1377 (Fed. Cir. Dec. 8, 2022)

In this appeal from the PTAB, the Federal Circuit held that the collateral estoppel effect of an IPR extended to a parallel patent claim.<sup>327</sup> The IPR’d patent

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<sup>320</sup> *Id.*

<sup>321</sup> *Id.*

<sup>322</sup> *Id.*

<sup>323</sup> *Id.*

<sup>324</sup> *Shamoon v. Resideo Technologies, Inc.*, 2023 WL 5031508 (Fed. Cir. 2023).

<sup>325</sup> *Id.* at \*7.

<sup>326</sup> *Id.*

<sup>327</sup> *Google LLC v. Hammond Dev. Int'l, Inc.*, 54 F.4th 1377 (Fed. Cir. 2022).

and the patent at issue had nearly identical language, with the only difference being that the IPR'd patent required "one or more application servers" and that "at least one application server" is operable to do functionality, while the patent in suit required a first and a second of a plurality of application servers.<sup>328</sup> This limitation was immaterial to patentability, as distributing software applications across multiple servers was well-known, so the overall claims were materially identical, and collateral estoppel applied.<sup>329</sup>

**Ironburg Inventions Ltd. v. Valve Corporation, 64 F.4th 1274 (Fed. Cir. Apr. 3, 2023)**

In this appeal from the Western District of Washington, the Federal Circuit held that "any ground that could have been raised in a petition is a ground that could have been reasonably raised" during that IPR.<sup>330</sup> Therefore, it held that Valve was estopped from litigating the Non-Instituted Grounds, as it had the chance to seek remand of its IPR to the PTAB and chose not to.<sup>331</sup> However, the Federal Circuit vacated the District Court's finding that Valve was also estopped from litigating the Non-Petitioned Grounds because the District Court had improperly placed the burden on Valve to show it could not reasonably have raised the Non-Petitioned Grounds in its petition.<sup>332</sup> It explained that "the burden of proving, by a preponderance of the evidence, that a skilled searcher exercising reasonable diligence would have identified an invalidity ground rests on the patent holder," meaning the burden properly rested with Ironburg.<sup>333</sup>

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<sup>328</sup> *Id.* at 1381.

<sup>329</sup> *Id.* at 1382.

<sup>330</sup> *Ironburg Inventions Ltd. v. Valve Corporation, 64 F.4th 1274 (Fed. Cir. 2023).*

<sup>331</sup> *Id.* at 1297.

<sup>332</sup> *Id.*

<sup>333</sup> *Id.* at 1299.