

# RECENT DEVELOPMENTS IN PATENT LAW (Fall 2025)

UPDATED THROUGH 12/01/2025

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## PATENTABLE SUBJECT MATTER

### Software and Business Method Cases

#### *Unpatentable*

*Rideshare Displays, Inc. v. Lyft, Inc.*, 2025 WL 2751580 (Fed. Cir. Sept. 29, 2025)

In this cross-appeal from the PTAB’s partial grant of motions to amend several patent claims, the Federal Circuit reversed the Board’s decision based on its analysis at *Alice* step two.<sup>4</sup> The Board found Rideshare’s initial patent claims related to helping rideshare passengers and drivers identify each other in crowded areas like airports were unpatentable, but granted Rideshare’s motions to amend some of the claims, finding that the substitute claims were patent-eligible.

At *Alice* step one, both the Board and the Federal Circuit agreed that Rideshare’s substitute claims were “directed to an abstract idea, a patent-ineligible concept.”<sup>5</sup> However, the court differed in its approach to reaching this conclusion, declining to adopt the Board’s Patent Subject Matter Eligibility Guidance and its three-pronged approach.<sup>6</sup> The court explained that this framework was “not binding on this court,” and it would instead “evaluate the Board’s decision under our precedent, which follows the two-step test set out in *Alice*.”<sup>7</sup>

At *Alice* step two, the court “disagree[d] with the Board’s conclusion” that the claims were “directed to a technological solution.”<sup>8</sup> Instead, the court found that the technology was ineligible because it did not “fundamentally alter or improve the way the technology itself functions.”<sup>9</sup> The court explained that the technology was simply streamlining a physical process by “invoking a computer merely as a tool,” rendering the Board’s decision “legal error warranting reversal.”<sup>10</sup>

*United Services Automobile Association v. PNC Bank N.A.*, 139 F.4th 1332 (Fed. Cir. June 12, 2025)

In this appeal from the Eastern District of Texas, the Federal Circuit reversed a finding that USAA’s patent for a “Digital Camera Processing System” for remote check deposits was valid, concluding the asserted claim was not patent eligible.<sup>11</sup>

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<sup>4</sup> *Rideshare Displays, Inc. v. Lyft, Inc.*, 2025 WL 2751580, at \*6 n.2 (Fed. Cir. Sept. 29, 2025).

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

<sup>6</sup> *Id.* at n.2.

<sup>7</sup> *Id.*

<sup>8</sup> *Id.* at \*6.

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

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

<sup>11</sup> *United Services Automobile Association v. PNC Bank N.A.*, 139 F.4th 1332, 1334 (Fed. Cir. June 12, 2025)

At *Alice* step one, the Federal Circuit found that “the asserted claim is directed to the abstract idea of depositing a check using a handheld mobile device” rather than specialized equipment.<sup>12</sup> The court found that the described multi-step process was insufficient to establish patentability at step one because it constituted merely “routine processes implemented by a general-purpose device . . . in a conventional way.”<sup>13</sup> USAA’s purported use of non-obvious algorithms did not change the analysis because “those algorithms are not found within the claim or the specification.”<sup>14</sup> Moreover, the claim lacked “any clear description of how these processes are performed,” instead providing only “a *concept* of improving the check deposit process.”<sup>15</sup>

At *Alice* step two, the court concluded there was “no inventive concept that would support patent eligibility.”<sup>16</sup> In doing so, the court rejected USAA’s argument to read the claim “as a whole, considering the ordered combination of elements,” because The court found all of these elements “well-known and routine.”<sup>17</sup> Nor did the claim fundamentally improve how the computer functioned, because the technology was “all operating in a conventional way” and there was no “disclosure of technology for depositing a check using a handheld mobile device.” Finally, the court rejected USAA’s argument that disputed issues of fact remained, because technologies like OCR were “known” and USAA’s patent had originally touted “as a key advantage” the fact that it operated in conjunction with easily available general-purpose electronics.<sup>18</sup>

*Recentive Analytics, Inc. v. Fox Corp., 2025 WL 1142021 (Fed. Cir. Apr. 18, 2025)*

In this appeal from the District of Delaware, the Federal Circuit affirmed a finding that Recentive’s four machine learning patents were subject matter ineligible.<sup>19</sup>

At *Alice* step one, the Federal Circuit observed that “[b]oth sets of patents rely on the use of generic machine learning technology in carrying out the claimed methods for generating event schedules and network maps,” while the machine learning technology itself was not claimed by the patentee, was entirely “conventional” and lacked any improvements on the existing technology, according to concessions made by Recentive.<sup>20</sup> And even had Recentive argued that the claims improved on prior technology, the claims did not “delineate steps through which the machine learning technology achieves an improvement.”<sup>21</sup> Instead, “the only thing the claims disclose about the use of machine learning is that machine learning is used in a new environment.”<sup>22</sup> Finally, it was

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<sup>12</sup> *Id.* at 1337.

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

<sup>14</sup> *Id.* at 1337-38.

<sup>15</sup> *Id.* at 1338 (emphasis in original).

<sup>16</sup> *Id.* at 1339.

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

<sup>18</sup> *Id.* at 1339-40.

<sup>19</sup> *Recentive Analytics, Inc. v. Fox Corp., 2025 WL 1142021, at \*1 (Fed. Cir. Apr. 18, 2025).*

<sup>20</sup> *Id.* at \*4.

<sup>21</sup> *Id.* at \*5.

<sup>22</sup> *Id.* at \*6.

irrelevant at *Alice* step one that the claims performed “a task previously undertaken by humans with greater speed and efficiency than could previously be achieved.”<sup>23</sup>

At *Alice* step two, the Federal Circuit found that Recentive had claimed “the abstract idea” of applying machine learning to a certain context itself, without any inventive concept.<sup>24</sup> Thus, the court concluded “patents that do no more than claim the application of generic machine learning to new data environments, without disclosing improvements to the machine learning models to be applied, are patent ineligible.”<sup>25</sup>

## Other Technologies

*US Synthetic Corp. v. Int’l Trade Comm’n*, 128 F.4th 1272, 1275 (Fed. Cir. Feb. 13, 2025)

In this appeal from the ITC, the Federal Circuit reversed the ITC’s finding that the claims concerning polycrystalline diamond compact (“PDC”) were subject matter ineligible.<sup>26</sup>

At *Alice* step one, the Federal Circuit held that the claims were directed to a specific composition of matter, PDC, defined by its constituent parts and various other chemical and physical properties, rather than an abstract idea.<sup>27</sup> In contrast, the ITC had found that the magnetic properties claimed in the patent were “so loose and generalized” and untethered to the structure of the composition as to constitute an abstract idea.<sup>28</sup> The Federal Circuit rejected this notion, holding that any “expectation of precision between the recited properties and structural details of the claimed composition is too exacting” for section 101.<sup>29</sup> Indeed, the court affirmed that “no perfect proxy is required between the recited material properties and the structure of the” claimed composition.<sup>30</sup> Because the correlations between the properties and the structure were sufficiently concrete and not unduly “speculative”—despite the presence of conditional language in the specification, like that the composition “may” correlate to certain properties—the court found that the claims were patentable subject matter.<sup>31</sup>

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<sup>23</sup> *Id.*

<sup>24</sup> *Id.* at \*7.

<sup>25</sup> *Id.* at \*8.

<sup>26</sup> *US Synthetic Corp. v. Int’l Trade Comm’n*, 128 F.4th 1272, 1275 (Fed. Cir. 2025).

<sup>27</sup> *Id.* at 1282.

<sup>28</sup> *Id.* at 1283 (quoting ITC order).

<sup>29</sup> *Id.* at 1283.

<sup>30</sup> *Id.*

<sup>31</sup> *Id.* at 1283-85.

## DISCLOSURE

### Definiteness

*Sierra Wireless, ULC v. Sisvel S.p.A.*, 130 F.4th 1019 (Fed. Cir. Mar. 10, 2025)

In this appeal from the PTAB, the Federal Circuit reversed the PTAB’s finding that various claims in a method patent were indefinite because the PTAB had erroneously construed the claims.<sup>32</sup> While the PTAB had found that two limitations in the claim could not both occur in response to the same stimuli, and thus, the two limitations were “mutually exclusive,” the Federal Circuit held this to be legal error.<sup>33</sup> Instead, based on the “plain and unambiguous language” of the claim, the Federal Circuit held that, to fall with the claim, the practiced method must include both limitations.<sup>34</sup>

*Fintiv, Inc. v. PayPal Holdings, Inc.*, 2025 WL 1240879 (Fed. Cir. Apr. 30, 2025)

In this appeal from the Western District of Texas, the Federal Circuit affirmed the district court’s finding of invalidity on indefiniteness grounds.<sup>35</sup>

The claims related to “cloud-based transaction systems” with the term “payment-handler” appearing throughout the claims.<sup>36</sup> Though the claims did not use the word “means,” the Federal Circuit held that they still invoked § 112 6 because the “payment-handler” term recited function without any definite structure.<sup>37</sup> “Payment-handler” was construed as a nonce term that could have referred to many different kinds of structures.<sup>38</sup> And finally, the court rejected Fintiv’s argument that “payment-handler” is a class of software structures, since it was uncontested that a PHOSITA would not have understood what structure could implement the function.<sup>39</sup>

Next, at the second step of the § 112 6 analysis, the Federal Circuit held that the claims were indefinite for failing to disclose adequate structure to perform the claimed function.<sup>40</sup> The court rejected Fintiv’s argument that an algorithm was disclosed, holding that merely “describing the results of the operation of an unspecified algorithm is not sufficient to transform the disclosure of a general-purpose computer into the disclosure of sufficient structure to satisfy § 112 6.”<sup>41</sup>

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<sup>32</sup> *Sierra Wireless, ULC v. Sisvel S.p.A.*, 130 F.4th 1019, 1021 (Fed. Cir. 2025).

<sup>33</sup> *Id.* at 1022.

<sup>34</sup> *Id.*

<sup>35</sup> *Fintiv, Inc. v. PayPal Holdings, Inc.*, 2025 WL 1240879, at \*1 (Fed. Cir. Apr. 30, 2025).

<sup>36</sup> *Id.* at \*1.

<sup>37</sup> *Id.* at \*3.

<sup>38</sup> *Id.*

<sup>39</sup> *Id.* at \*4.

<sup>40</sup> *Id.* at \*5.

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

## Written Description

*Duke University v. Sandoz, Inc.*, 2024-1078, 2025 WL 3210322 (Fed. Cir. Nov. 18, 2025)

In this appeal from the District Court for the District of Colorado, the Federal Circuit reversed the lower court’s denial of defendant’s motion for JMOL, holding that the asserted patent claim lacked adequate written description.<sup>42</sup>

Duke and Allergan Sales, LLC sued Sandoz for infringing their ‘270 patent related to “treating hair loss using compositions containing prostaglandin F (‘PFG’) analogs.”<sup>43</sup> At trial, Sandoz presented expert testimony arguing that Claim 30 lacked sufficient written description because it “describes over 4,000 compounds that can cause hair to grow’ but does not identify ‘a single’ specific embodiment of the claim in the specification or disclose sufficient common structural features of the compounds encompassed in the claim.”<sup>44</sup> However, the jury found Sandoz had failed to prove that claim 30 was invalid, and the district court denied Sandoz’s motion for a new trial and for JMOL.<sup>45</sup>

The Federal Circuit reversed, finding that “no reasonable juror could find anything other than clear and convincing evidence that the ‘270 patent fails to describe either (i) a representative number of species of claim 30’s subgenus or (ii) structural features common to all members of that subgenus.”<sup>46</sup> Duke effectively conceded the first point because “the ‘270 patent does not expressly disclose even a single embodiment of claim 30.”<sup>47</sup> Instead, Duke relied on the second theory, claiming that the specification disclosed “three features that are common to all members of the claimed subgenus,” namely a “prostaglandin hairpin,” “with amides at the C1 position,” “connected to the unsubstituted phenyl ring at the omega [action] end.”<sup>48</sup> The court rejected this argument, finding that the patent “at best, discloses two prostaglandin hairpin structures and a menu of available atoms, moieties, and functional groups from which a skilled artisan could populate” numerous positions of the structures.<sup>49</sup>

Specifically, the court pointed out it was undisputed at trial that the hairpin structure is generic, and would not itself enable the ordinary artisan “to ‘visualize’ the thousands of compounds claimed in claim 30, from among the billions” of such compounds described in the specification.<sup>50</sup> Moreover, “a reasonable juror would necessarily have found that the specification fails to provide sufficient blaze marks with respect to the C1 position,” since the specification disclosed 13 broad categories

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<sup>42</sup> *Duke University v. Sandoz, Inc.* 2024-1078, 2025 WL 3210322, at \*1. (Fed. Cir. Nov. 18, 2025).

<sup>43</sup> *Id.*

<sup>44</sup> *Id.* at \*2.

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

<sup>46</sup> *Id.* at \*3-4.

<sup>47</sup> *Id.* at \*4.

<sup>48</sup> *Id.*

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

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

encompassing “a vast number of options for C1.”<sup>51</sup> Similarly, the eight categories of options at the Z position contained further “embedded choices.”<sup>52</sup> In sum, the court found the specification did not provide sufficient blaze marks to “direct one to the proposed tree in particular, and does not teach the point at which one should leave the trail to find it.”<sup>53</sup> Instead, the court found it “may only reasonably be viewed as a mere ‘laundry list disclosure of every possible moiety for every possible position,’ making it inadequate to satisfy the written description requirement.”<sup>54</sup> As such, Sandoz overcame “the doubly high burden of persuading us to overturn a jury verdict of no invalidity.”<sup>55</sup>

*Brita LP v. International Trade Commission*, 156 F.4th 1326 (Fed Cir. Oct. 15, 2025)

In this appeal from an ITC determination that Brita’s asserted claims were invalid, the Federal Circuit affirmed the patent was invalid for lack of written description and enablement.<sup>56</sup> Brita sought ITC enforcement against products that allegedly infringed its patent (‘141), directed to “Gravity Flow Filter” technology that achieves a specified Filter Rate and Performance (FRAP) ratio via “various types of filter media, including carbon blocks” and various other types.<sup>57</sup> Brita won initial approval from the ALJ, but the Commission reversed, finding that ‘141 was invalid with regard to non-carbon-block filters for “lack of written description, lack of enablement, and indefiniteness.”<sup>58</sup> The court declined to reach the issue of indefiniteness.<sup>59</sup>

The Federal Circuit affirmed the Commission’s written description analysis. The specification did not describe or provide working examples of non-carbon-block filters.<sup>60</sup> The inventors acknowledged that they had not invented and did not possess non-carbon-block filters that “would meet the claimed FRAP factor,” and they anticipated that making a different filter would be “a ‘very difficult task’” involving “new technology.”<sup>61</sup> Brita argued on appeal that it met the written description requirement via generic statements suggesting the invention is “applicable to all embodiments” and adequate disclosures of “representative examples and common structural features supporting its possession of the ‘genus’ of filters covered by claim 1.”<sup>62</sup> The court rejected these arguments, explaining that Brita had defined the genus functionally—with reference to the FRAP ratio—but failed to disclose species that could meet this factor or to explain characteristics shared between carbon and non-carbon filters in this claimed genus.<sup>63</sup> Similarly, inventing a non-carbon filter meeting the FRAP requirements would

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<sup>51</sup> *Id.* at \*5.

<sup>52</sup> *Id.* at \*6.

<sup>53</sup> *Id.* at \*7 (quoting *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571 (Fed. Cir. 1996)).

<sup>54</sup> *Id.* (quoting *Fujikawa*, 93 F.3d at 1571).

<sup>55</sup> *Id.* at \*7.

<sup>56</sup> *Brita LP v. International Trade Commission*, 156 F.4th 1326, 1328 (Fed. Cir. 2025).

<sup>57</sup> *Id.* at 1329.

<sup>58</sup> *Id.* at 1331.

<sup>59</sup> *Id.* at 1339.

<sup>60</sup> *Id.* at 1332-33.

<sup>61</sup> *Id.* at 1333-34.

<sup>62</sup> *Id.* at 1334.

<sup>63</sup> *Id.* at 1335-36.

require adjusting interrelated variables with unpredictable effects, so the court rejected Brita’s argument that less detail was required to adequately disclose this “predictable art.”<sup>64</sup>

The court also affirmed on enablement because the patent failed to provide a road map for non-carbon filters to meet the FRAP requirement.<sup>65</sup> Contrary to Brita’s claims that the art was predictable, lowering the bar for enablement, the court reiterated that the interrelatedness of the FRAP factors made adjustments inherently unpredictable.<sup>66</sup> In sum, the patent put the burden of invention on the ordinary artisan rather than the patentee, violating “the very quid pro quo central to the enablement requirement.”<sup>67</sup>

*Mondis v. LG Elecs.* \_\_\_ F.4th \_\_\_, 2025 WL 2264077 (Fed. Cir. Aug. 8, 2025)

In this cross-appeal from the District of New Jersey, the Federal Circuit reversed the denial of the alleged infringer’s motion for JMOL, holding that the patentee’s asserted claims were invalid for lack of an adequate written description.<sup>68</sup>

Mondis won a jury verdict for infringement of claims 14 and 15 of its patent direct to a system allowing a computer to recognize and control a connected display unit if it had a recognized identification number.<sup>69</sup> Claim 14 explained the identification number system for identifying “at least a type of said display unit”—although the original application omitted “at least a type of,” and these words were added to avoid prior art rejection.<sup>70</sup>

The Federal Circuit agreed with LG that the written description did not support the claim limitation of an “identification number for identifying at least a type of said display unit,” rather than identifying a specific display unit model.<sup>71</sup> Rejecting Mondis’s reliance on the presumption of validity, the court found the patent clearly lacked adequate written disclosure of the “type” limitation.<sup>72</sup> The court similarly rejected Mondis’s argument that each parties’ expert testimony and the prosecution history provided substantial evidence, because the specification was “silent about the type limitation” and the experts’ testimony was not on point.<sup>73</sup>

Finally, the court rejected Mondis’s claim that the patent was entitled to “an especially weighty presumption of correctness” because the “type of device” amendment was permitted by an examiner.<sup>74</sup> The court rejected the argument that allowance of amendments “by itself provides substantial evidence that the claims comply with the requirements of § 112,” explaining that if it did, “there would rarely be a situation where

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<sup>64</sup> *Id.* at 1336.

<sup>65</sup> *Id.* at 1337.

<sup>66</sup> *Id.* at 1338.

<sup>67</sup> *Id.* at 1338-39.

<sup>68</sup> *Mondis Tech. Ltd. v. LG Elecs., Inc.*, 2025 WL 2264077, at \*4 (Fed. Cir. Aug. 8, 2025).

<sup>69</sup> *Id.* at \*1.

<sup>70</sup> *Id.* at \*2.

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

<sup>72</sup> *Id.* at \*5-6.

<sup>73</sup> *Id.*

<sup>74</sup> *Id.* at \*7

an issued patent could later be invalidated for lack of written description.”<sup>75</sup> Moreover, here, there was no evidence the examiner considered validity under § 112, as “the evidence only shows the examiner allowed the claim as amended because it included a feature that was not in the identified prior art.”<sup>76</sup>

*Regents of UC v. Broad Institute*, 136 F.4th 1367 (Fed. Cir. May 2025)

In this appeal from a PTAB patent interference proceeding, the Federal Circuit vacated the PTAB’s decision that Regents failed to establish conception and therefore Broad had priority with respect to a particular invention “relating to the adaptation of ‘CRISPR’ systems to edit eukaryotic DNA.”<sup>77</sup>

The court explained that the PTAB applied the wrong legal standard by “requiring Regents’ scientists to know that their invention would work,” thus erroneously conflating the standards for conception and reduction to practice.<sup>78</sup> Although Regents’ scientists expressed uncertainty and proposed changes, the PTAB did not consider whether Regents actually made those changes.<sup>79</sup> Moreover, the PTAB failed to consider relevant evidence about whether the idea was sufficiently fixed that persons of ordinary skill in the art could have reasonably expected the idea to be reducible to practice via the exercise of ordinary skill.<sup>80</sup> The PTAB erroneously focused on the lack of an “operative invention” and on “perceived failures and doubts” during experimentation.<sup>81</sup> And the PTAB failed to consider record evidence of purported experimental success by others or to determine whether Regents’ scientists used “routine methods or skill” in subsequent experiments.<sup>82</sup>

However, the Federal Circuit affirmed the Board’s determination that Regents’ applications lacked written description support for their Count 1, covering “a single RNA CRISPR-Cas9 system that functions in eukaryotic cells.”<sup>83</sup> Regents argued that the Board applied the wrong legal standard—“requiring the P1 application to ‘convince’ a person of ordinary skill in the art that the invention will work” rather than merely conveying possession of such an invention—and improperly considered the lack of successful working examples.<sup>84</sup> The court disagreed, pointing out that the Board properly applied Federal Circuit precedent by requiring greater detail for technology that was “‘complex’ and ‘highly unpredictable,’” and that the Board looked to working examples as “but one indication, in addition to others,” of whether the written description conveyed possession of the invention.<sup>85</sup> Finally, the court rejected Regents’ challenge under the Administrative Procedure Act (APA), affirming that the Board “thoroughly considered both parties’

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

<sup>76</sup> *Id.*

<sup>77</sup> *Regents of UC v. Broad Institute*, 136 F.4th 1367, 1371 (Fed. Cir. May 2025).

<sup>78</sup> *Id.* at 1378-79.

<sup>79</sup> *Id.* at 1379.

<sup>80</sup> *Id.* at 1379-80.

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

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

<sup>83</sup> *Id.* at 1382-83.

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

<sup>85</sup> *Id.* at 1383-84.

arguments and the evidence supporting those arguments” and thus was not arbitrary and capricious.<sup>86</sup>

The court remanded for the PTAB to decide on conception under the proper legal framework and to determine whether the later party to reduce the invention to practice either was first to conceive of the invention and exercised reasonable diligence in reducing it to practice or, alternatively, had prior conception of the claimed subject matter and communicated that conception to the adverse claimant.<sup>87</sup>

*In re Xencor, Inc., 130 F.4th 1350 (Fed. Cir. Mar. 13, 2025)*

In this appeal from the PTAB, the Federal Circuit affirmed the PTAB’s finding that the claims lacked written description.<sup>88</sup>

Claim 9 was a means-plus-function claim, directed to a method for treating patients with a certain antibody.<sup>89</sup> After construing the preamble term “treating a patient,” the Federal Circuit held that this was a claim limitation that was not adequately described.<sup>90</sup> While Xencor argued that “treating” did not require a particular effectiveness or result, the court still found that the specification failed to describe this claim limitation, as it did not include *any* examples of treatment of *any* conditions with the antibodies.<sup>91</sup>

Next, the Federal Circuit turn to claim 8, which was a Jepson claim that included a similar preamble directed at a “method of treating a patient” by administering a certain antibody.<sup>92</sup> On appeal, Xencor argued that, since the “‘invention’ in a Jepson claim is the improvement, it needed only to have written description for that improvement.”<sup>93</sup> The Federal Circuit disagreed, holding that written description must be satisfied with respect to the “entirety” of the claim, including that which is in the prior art. In a Jepson claim, the court clarified, the invention is not merely the improvement, but also “*the claimed improvement as applied to the prior art*, so that [the] inventor must provide written description sufficient to show possession of *the claimed improvement to what was known in the prior art*.”<sup>94</sup> Indeed, if “an inventor were permitted to simply assert, without showing, that she possessed what is claimed to be in the prior art, she might be able, improperly, to obtain a patent on something she does not actually possess.”<sup>95</sup> The court clarified, however, that the “amount and content of the disclosure that is necessary to supply an adequate written description will vary depending on factors including the level of knowledge of the person of ordinary skill in the art, the unpredictability of the art, and the newness of the technology.”<sup>96</sup>

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<sup>86</sup> *Id.* at 1384-85.

<sup>87</sup> *Id.* at 1382.

<sup>88</sup> *In re Xencor, Inc.*, 130 F.4th 1350, 1354 (Fed. Cir. 2025)

<sup>89</sup> *Id.* at 1357.

<sup>90</sup> *Id.* at 1359.

<sup>91</sup> *Id.* at 1360.

<sup>92</sup> *Id.* at 1360-61.

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

<sup>94</sup> *Id.* at 1361.

<sup>95</sup> *Id.* at 1362.

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

Applying these standards to claim 8, the court found that that written description was lacking because the antibodies specified in the preamble were not sufficiently known in the prior art and were not disclosed by the specification.<sup>97</sup>

*In re Entresto*, \_\_\_ F.4th \_\_\_, 2025 WL 63577 (Fed. Cir. Jan. 10, 2025)

In this appeal from the District of Delaware, the Federal Circuit reversed the district court’s finding that the claimed combination of two drug therapies lacked written description.<sup>98</sup>

At claim construction before the district court, the parties disputed a single limitation: “wherein [the two drugs] are administered *in combination*.”<sup>99</sup> The district court, considering the “plain and ordinary meaning” of the terms, construed the limitation to include *any* combination of the drugs—including a physical mixture, or a “complexed” chemical mixture of the drugs.<sup>100</sup> Based on that construction, the district court found the claims invalid for lack of written description, since it was undisputed that complexed mixtures were unknown to persons of ordinary skill in the art at the time of the patent application.<sup>101</sup>

On appeal, the Federal Circuit first clarified that the issue was whether the patent described what was claimed—a composition of the two drugs *in combination*.<sup>102</sup> The court emphasized that the patent *did not* claim a complexed mixture, and thus, “those complexes need not have been described.”<sup>103</sup> In holding otherwise, “the district court erroneously conflated the distinct issues of patentability and infringement, which led it astray in evaluating written description.”<sup>104</sup> On the proper analysis, the Federal Circuit found that the invention—any combination of the two drugs—was “plainly described” throughout the specification, which was also conceded by MSN’s expert.<sup>105</sup> Though not addressed by the court, the Federal Circuit’s holding is in tension with *Chiron Corp. v. Genentech, Inc.*, which held that a patentee cannot satisfy the written description requirement for subject matter “that did not exist” at the time of the publication.<sup>106</sup>

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<sup>97</sup> *Id.*

<sup>98</sup> *In re Entresto*, 2025 WL 63577, at \*1 (Fed. Cir. Jan. 10, 2025).

<sup>99</sup> *Id.* at \*2.

<sup>100</sup> *Id.* at \*2-3.

<sup>101</sup> *Id.* at \*4.

<sup>102</sup> *Id.* at \*5.

<sup>103</sup> *Id.*

<sup>104</sup> *Id.* at \*6.

<sup>105</sup> *Id.* at \*5.

<sup>106</sup> *Chiron Corp. v. Genentech, Inc.*, 363 F.3d 1247, 1255 (Fed. Cir. 2004).

## Enablement

*Agilent v. Synthego*, 139 F.4th 1319 (Fed. Cir. June 2025)<sup>107</sup>

In this appeal from two written decisions of the PTAB on inter partes review, the federal circuit affirmed that all claims of two patents related to CRISPR-Cas systems for gene editing were unpatentable because they were anticipated by prior art.<sup>108</sup> In doing so, the court affirmed the PTAB’s conclusion that certain prior art—Pioneer Hi-Bred—was enabling.<sup>109</sup>

The court generally affirmed the PTAB’s conclusions that a person of ordinary skill in the art in 2014 would have been enabled without undue experimentation, despite what Agilent argued was a “nascent state of the art” at the time. The panel found the disclosures in Pioneer Hi-Bred to be distinguishable from those in *Impax Labs v. Aventis Pharms, Inc.*, because they provided more specific detail for enablement, even though they were prophetic and did not ultimately work.<sup>110</sup> Likewise, the panel distinguished *Amgen Inc v. Sanofi*, 598 U.S. 594 (2023), for two reasons. First, *Amgen* dealt with enablement under 35 U.S.C. § 112, “not whether a prior-art reference was enabling and could thus support anticipation,” and explained that the latter inquiry does not require the specification to enable one skilled in the art to “use” the invention under 35 U.S.C. § 102.<sup>111</sup> The court explained that *Amgen*’s concerns about a monopoly broader than what the specification teaches were not implicated in the prior-art anticipation context, where the prior-art reference need only enable a single embodiment of the claim at issue. Second, the patent in *Amgen* required “painstaking experimentation to see what works,” but the panel here agreed with the PTAB that substantial evidence supported that Pioneer Hi-Bred would enable persons with ordinary skill in the art.<sup>112</sup>

The court rejected Agilent’s third argument that Pioneer Hi-Bred disclosed many inoperable guides, because the cited testing data was only applicable to synthetic DNA, “not to the modified RNA sequences at issue in the challenged claims.”<sup>113</sup> And the court similarly rebuffed Agilent’s fourth argument that Pioneer Hi-Bred did not enable “single-guide RNA,” having affirmed the PTAB’s finding that the prior-art patent disclosed and enabled single-guide RNA.

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<sup>107</sup> Full disclosure: Lemley represented Agilent in this appeal.

<sup>108</sup> *Agilent v. Synthego*, 139 F.4th 1319, 1321 (Fed. Cir. June 2025).

<sup>109</sup> *Id.* at 1327.

<sup>110</sup> *Id.* at 1328.

<sup>111</sup> *Id.* at 1328-29 (quotations and citations omitted).

<sup>112</sup> *Id.* at 1329.

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

## NOVELTY

*Sigray, Inc. v. Carl Zeiss X-Ray Microscopy, Inc.*, 137 F.4th 1372 (Fed. Cir. May 23, 2025)

In this appeal from the PTAB, the Federal Circuit held that several of Zeiss’s patent claims were anticipated by prior art that inherently contained the primary claim’s key limitation.<sup>114</sup>

In an IPR following Sigray’s petition, the PTAB declined to hold any of the asserted claims for a projection x-ray imaging system to be unpatentable. Sigray appealed solely as to whether claims 1 through 6 were unpatentable based on a prior art scientific paper, which described using a collimator to “reduce” divergence of the x-ray beam.<sup>115</sup> The parties disputed only whether this paper inherently disclosed the projection magnification limitation found in claim 1, which described using a diverging beam to generate magnification “between 1 and 10 times.”<sup>116</sup> The Federal Circuit found that the PTAB had erred by improperly construing Zeiss’s claim to exclude small amounts of magnification, rather than basing its order on whether the paper inherently anticipated diverging beam magnification.<sup>117</sup> The court rejected the PTAB’s reliance on the prior art paper’s stated purpose that it was “not attempting to achieve magnification,” since this aspirational statement did not bear on “whether magnification is inherently present.”<sup>118</sup> The court therefore reversed the PTAB’s findings on claim 1 and several dependent claims, finding that “the evidence relied on by the Board compels a singular conclusion—that [the prior art] inherently contains projection magnification.”<sup>119</sup>

*Restem, LLC v. Jadi Cell, LLC*, 130 F.4th 941 (Fed. Cir. Mar. 4, 2025)

In this appeal from the PTAB, the Federal Circuit affirmed the PTAB’s decision finding that Restem had failed to show that Jadi Cell’s claims were unpatentable on novelty grounds.<sup>120</sup>

The claims at issue were product-by-process claims directed at stem cells with particular cell marker expressions, where the products claimed are defined in part in terms of the process used to create the products.<sup>121</sup> On appeal, Restem argued that, since the stem cell products are “necessarily present” once the process is satisfied—a process that was part of the prior art—the resulting product is inherently anticipated by the prior art.<sup>122</sup> The Federal Circuit rejected this argument, emphasizing that product-by-process

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<sup>114</sup> *Sigray, Inc. v. Carl Zeiss X-Ray Microscopy, Inc.*, 137 F.4th 1372, 1374-75 (Fed. Cir. May 23, 2025).

<sup>115</sup> *Id.* at 1375.

<sup>116</sup> *Id.* at 1376-77.

<sup>117</sup> *Id.* at 1377-78.

<sup>118</sup> *Id.* at 1379.

<sup>119</sup> *Id.* at 1380.

<sup>120</sup> *Restem, LLC v. Jadi Cell, LLC*, 130 F.4th 941, 943 (Fed. Cir. 2025).

<sup>121</sup> *Id.* at 947.

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

claims focus on the product itself, rather than the process.<sup>123</sup> Nothing in the patent addressed whether the claimed product (with a particular cell marker expression) would *always* result from following the process known in the prior art, and expert testimony and the prior art suggested that the cell marker expression profiles regularly varied.<sup>124</sup> And Restem had provided no empirical evidence that the prior art process would “inevitably” result in the products claimed by Jadi Cell.<sup>125</sup> Thus, the court affirmed the PTAB’s finding that the product-by-process claims were not inherently anticipated by the prior art.<sup>126</sup>

*In re Riggs*, 131 F.4th 1377 (Fed. Cir. Mar. 24, 2025)

In this appeal from the PTAB’s order affirming the examiner’s rejection of a patent, the Federal Circuit reversed and remanded for the PTAB to correctly conduct an analysis under pre-AIA § 102(e).<sup>127</sup>

At issue was a prior art published patent application (Lettich); the application was filed on April 26, 2001, claiming priority to an April 27, 2000 provisional application, whereas the application for the patent-in-suit was filed on December 7, 2004, claiming priority to July 28, 2000.<sup>128</sup> The PTAB had found that Lettich was prior art against the claims at issue, since “*at least one*” claim in the Lettich published application was sufficiently covered by a written description in the provisional application, applying the Federal Circuit’s bizarre requirement from *Dynamic Drinkware* that disclosures in provisional applications don’t qualify as prior art unless they support the claims of the later patent.<sup>129</sup>

The Federal Circuit rejected the PTAB’s reasoning, holding that “[e]ven if one demonstrates that a provisional application provides written description support for one claim of the non-provisional application or patent, the provisional application must also provide written description support for the specific portions of the patent specification identified and relied on in the prior art rejection.”<sup>130</sup> The court explained that, in order to claim priority to a provision application filing date, “the portion of the application relied on by the examiner as prior art must be supported by the provisional application.”<sup>131</sup> The Federal Circuit thus remanded to the PTAB to evaluate which portions of Lettich were adequately supported by the provision application, and whether those portions were prior art as to the claims at issue.<sup>132</sup>

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

<sup>124</sup> *Id.*

<sup>125</sup> *Id.*

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

<sup>127</sup> *In re Riggs*, 131 F.4th 1377, 1379 (Fed. Cir. 2025).

<sup>128</sup> *Id.* at 1384

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

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

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

<sup>132</sup> *Id.* at 1385-86.

*Lynk Labs, Inc. v. Samsung Electronics Co., Ltd.*, \_\_\_ F.4th \_\_\_ (Fed. Cir. Jan. 14, 2025)

In this appeal from the PTAB, the Federal Circuit affirmed the PTAB’s holding that a patent application is deemed prior art in inter partes review as of the date of its filing, not its publication.<sup>133</sup> The prior art patent application (“Martin”) was *filed* before the priority date of the patent in suit, but had been published after that date and subsequently abandoned.<sup>134</sup> On appeal, the Federal Circuit rejected Lynk Labs’ argument that Martin could not serve as prior art since it was only publicly accessible after the patent in suit’s priority date.<sup>135</sup>

The Federal Circuit first emphasized that, under § 102(d)(1), “even if a patent application was *published* after a claimed invention, it may serve as prior art to the invention if the application was *filed* before the invention.”<sup>136</sup> Thus, the court held, a published patent application is prior art “as of its filing date,” rather than the date of public accessibility.<sup>137</sup> And because a published patent application is a “printed publication,” the Federal Circuit held that it may serve as prior art in IPR as of the filing date pursuant to § 311(b).<sup>138</sup> The court pointed to the legislative history of § 102 and § 311(b), which demonstrated that “printed publications” under § 311(b) encompassed patent applications as of the filing, not publication, date.<sup>139</sup>

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<sup>133</sup> *Lynk Labs, Inc. v. Samsung Electronics Co., Ltd.*, 2025 WL 85559 (Fed. Cir. Jan. 14, 2025).

<sup>134</sup> *Id.* at \*2.

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

<sup>136</sup> *Id.* at \*3.

<sup>137</sup> *Id.*

<sup>138</sup> *Id.* at \*4.

<sup>139</sup> *Id.* at \*4-8.

## OBVIOUSNESS

*Merck Serono S.A. v. Hopewell Pharma Ventures, Inc.*, --- F.4th ----, 2025 WL 3030020 (Fed. Cir. Oct. 30, 2025)

In this appeal from the PTAB’s consolidated IPR of patents related to treating multiple sclerosis by orally administering medications, the Federal Circuit affirmed that Merck’s claimed patents were unpatentable as obvious over a combination of prior art under pre-AIA rules.<sup>140</sup>

The patents at issue were directed to a regimen for administering medications orally for multiple sclerosis.<sup>141</sup> Merck conducted clinical trials in partnership with a manufacturer, Ivax, who was responsible for developing an oral dosage formulation for use in those trials.<sup>142</sup> Merck shared confidential information, including a dosing regimen, in December 2003.<sup>143</sup> Two Ivax employees filed for an international patent (“the Bodor patent”) disclosing a particular dosing regimen; the application was published in October 2004.<sup>144</sup> Merck filed the applications for the at-issue patents two months later, listing four Serono employees as the inventors.<sup>145</sup> Reviewing Hopewell’s IPRs, the Board found Merck’s claims unpatentable as obvious over prior art. It counted the Bodor patent as prior art because there was “no facial overlap in the named inventors or assignees of Bodor and the ‘947 patent.”<sup>146</sup> Merck argued that the Bodor patent should be precluded as prior art because one of its employees, De Luca, was an unlisted co-inventor.<sup>147</sup> But the Board rejected this argument on both legal and factual grounds.<sup>148</sup>

The Federal Circuit affirmed, reiterating its rule that “when the patented invention is the result of the work of joint inventors, the portions of the reference disclosure relied upon must reflect the collective work of the same inventive entity identified in the patent to be excluded as prior art.”<sup>149</sup> Incongruity of identity “renders the prior disclosure ‘by another,’ regardless of whether inventors are subtracted from or added to the patent.”<sup>150</sup> The court rejected Merck’s reliance on *Applied Materials, Inc. v. Gemini Res. Corp.*, where the court rejected treating a prior patent was “by another” despite the addition of an inventor on the second application.<sup>151</sup> The court clarified that in *Applied Materials*, “the key question was whether the earlier reference . . . evidenced knowledge by ‘another’ before the patented invention,” answered negatively in that case because both

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<sup>140</sup> *Merck Serono S.A. v. Hopewell Pharma Ventures, Inc.*, 2025 WL 3030020, at \*1 (Oct. 30, 2025).

<sup>141</sup> *Id.* at \*1-2.

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

<sup>143</sup> *Id.* at \*2.

<sup>144</sup> *Id.*

<sup>145</sup> *Id.* at \*3.

<sup>146</sup> *Id.* at \*3-4.

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

<sup>148</sup> *Id.* at \*4.

<sup>149</sup> *Id.* at \*10.

<sup>150</sup> *Id.*

<sup>151</sup> *Id.* at \*7.

patents had emerged from the same application.<sup>152</sup> In other words, “an invention made by a subset of named inventors” is “a disclosure ‘by another.’”<sup>153</sup>

*Bayer Pharma Aktiengesellschaft v. Mylan Pharms. Inc.*, 152 F.4th 1400 (Fed. Cir. Sept. 23, 2025)

In this appeal from an IPR, the Federal Circuit affirmed that several claims were unpatentable as obvious.<sup>154</sup> In doing so, the court affirmed the Board’s finding that the phrase “clinically proven effective” was non-limiting because it lacked any new and unobvious functional relationship with the known method of treatment.<sup>155</sup>

Bayer’s patent claimed a method for reducing medical risks by administering rivaroxaban and aspirin “in amounts that are clinically proven effective” in reducing those risks and then specified the daily dosages. The court analogized to *King Pharms. v. Eon Labs, Inc.*, highlighting the underlying rationale of “preventing the indefinite patenting of known products [and methods] by the simple inclusion of novel, yet functionally unrelated limitations.”<sup>156</sup> The court explained this policy prevents the “troubling” outcome where “one could claw back from the public domain an anticipated method of treatment merely by adding a limitation that the method subsequently performed well in a clinical trial.”<sup>157</sup>

The court distinguished this case from *Allergan Sales, LLC v. Sandoz, Inc.*, 935 F.3d 1370 (Fed. Cir. 2019) because here the patent claims “already specify the exact dosages” such that “the additional limitation that the amounts be ‘clinically proven effective’ does not further define the dosages that are administered.”<sup>158</sup>

*Ancora Techs, Inc. v. Roku, Inc.*, 140 F.4th 1351 (Fed. Cir. June 16, 2025)

In this appeal from the PTAB, the Federal Circuit vacated and remanded the Board’s conclusion that Ancora’s patent for a method of restricting unauthorized use of licensed software was unpatentable as obvious.<sup>159</sup> The court affirmed the Board’s construction of Ancora’s claims and its prima facie determination of obviousness based on prior art. Turning to Ancora’s attempts to rebut this prima facie showing, the court found no error in the Board’s analysis of industry praise directed to the patent as a whole rather than the challenged claims.<sup>160</sup>

However, the court found the Board had “erred in applying our precedent on nexus to the license evidence.”<sup>161</sup> The Board found that Ancora failed to establish

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<sup>152</sup> *Id.* at \*7-8.

<sup>153</sup> *Id.* at \*11.

<sup>154</sup> *Bayer Pharma Aktiengesellschaft v. Mylan Pharms. Inc.*, 152 F.4th 1400, 1403 (Fed. Cir. 2025).

<sup>155</sup> *Id.* at 1404.

<sup>156</sup> *Id.* at 1404 (quoting *King Pharms. v. Eon Labs, Inc.*, 616 F.3d 1267, 1277-79 (Fed. Cir. 2010)).

<sup>157</sup> *Id.* at 1404-1405.

<sup>158</sup> *Id.* at 1405.

<sup>159</sup> *Ancora Techs., Inc. v. Roku, Inc.*, 140 F.4th 1351, 1354 (Fed. Cir. June 16, 2025).

<sup>160</sup> *Id.* at 1361.

<sup>161</sup> *Id.* at 1354.

whether third-party license agreements “resulted directly from the unique characteristics of the claimed subject matter” of the patent. The Federal Circuit reversed this conclusion because “the Board applied a more exacting nexus standard than our case law requires for license evidence,” which merit lower scrutiny than products because “actual licenses to the subject patent” are “by their nature, directly tied to the patented technology.”<sup>162</sup> The court explained that nexus law for licenses to the challenged patent does not require that it be “the only patent being licensed or sole motivation for entering into a license.”<sup>163</sup> The court also found it significant that the licenses were reached either after litigation or shortly before trial and that they “far exceeded the cost of litigation,” even though defendants were fully aware of the relevant prior art.<sup>164</sup> Similarly, the court rejected the Board’s use of potential damages—rather than litigation costs—to determine the patent’s strength, since “damages figures are a function of an infringer’s *usage*, not a patent’s strength.”<sup>165</sup> The court therefore remanded the issue, instructing that the licenses, “taken by substantial parties paying substantial royalties to secure the right to practice the ‘941 patent, should have been given more, if not controlling, weight in the Board’s obviousness determination.”<sup>166</sup> But the court also directed the Board to consider the probative value of other licenses “for much less than anticipated litigation costs” and “weigh that against” the higher value licenses.<sup>167</sup>

*Palo Alto Networks, Inc. v. Centripetal Networks, LLC*, 122 F.4th 1378 (Fed. Cir. December 10, 2024)

In this appeal from the PTAB, the Federal Circuit vacated and remanded the Board’s conclusion that Palo Alto Networks had not established that Centripetal’s claims were obvious over the relevant prior art.<sup>168</sup> The patent in suit was directed at identifying packets from a host in a first network, and correlating those packets with packets sent to a host in a second network.<sup>169</sup> This “packet correlation technique de-obfuscates the identity of an obfuscated host,” which can help networks detect unauthorized entry by malicious entities.<sup>170</sup>

The PTAB, in analyzing Palo Alto Network’s obviousness challenge, considered two prior art references (Sutton and Paxton).<sup>171</sup> Palo Alto Network relied on Paxton for most of the limitations in the challenged claim, but relied on Sutton for the final claim limitation (“transmitting an indication of the first host responsive to the correlating”).<sup>172</sup> According to Palo Alto Networks, a person of ordinary skill in the art would have been motivated to combine Paxton’s technique—which taught packet-correlation—with

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<sup>162</sup> *Id.* at 1362.

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

<sup>164</sup> *Id.* at 1363.

<sup>165</sup> *Id.* (emphasis in original)

<sup>166</sup> *Id.* at 1364.

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

<sup>168</sup> *Palo Alto Networks, Inc. v. Centripetal Networks, LLC*, 122 F.4th 1378 (Fed. Cir. 2024).

<sup>169</sup> *Id.* at 1380-81.

<sup>170</sup> *Id.* at 1381.

<sup>171</sup> *Id.* at 1382.

<sup>172</sup> *Id.*

Sutton’s method of notifying “administrators . . . to identify or drop future packets to prevent future malicious communications.”<sup>173</sup> In other words, Paxton explained the correlation technique but “leaves, to a [person of ordinary skill in the art], remedial steps (e.g., uses of the correlation results), which are taught by Sutton.”<sup>174</sup> The PTAB disagreed, however, holding that Palo Alto Networks did not sufficiently explain the motivation to combine the two references. While Paxton provided the correlation technique, it did not provide “specific actions taken post-correlation.” Sutton provided a “transmission . . . unrelated to any correlation,” and Palo Alto Networks lacked the “necessary bridge showing that one of ordinary skill in the art would have appreciated that the transmission would be responsive to the correlation.”<sup>175</sup>

On appeal, the Federal Circuit vacated and remanded the PTAB’s decision on two grounds. First, the court held that the PTAB erred in failing to expressly find whether there was a motivation to combine.<sup>176</sup> The court could not “discern with any confidence” what the PTAB’s “necessary bridge” language even meant.<sup>177</sup> Moreover, to the extent the Board intended to find no motivation to combine, that finding would be error, as it failed to address the evidence raised by Palo Alto Networks.<sup>178</sup> Second, the Federal Circuit held that the PTAB erred in viewing the references individually, rather than in combination from the view of a skilled artisan.<sup>179</sup> On remand, the Federal Circuit emphasized that the PTAB must evaluate obviousness in terms of the combined prior art references, clearly articulate its findings on motivation to combine, and provide an adequate explanation of those findings.<sup>180</sup>

*Cytiva BioProcess R&D AB v. JSR Corp.*, 122 F.4th 876 (Fed. Cir. December 24, 2024)

In this appeal from the PTAB, the Federal Circuit affirmed the PTAB’s finding of obviousness regarding composition claims directed at chromatography compounds to isolate target compounds, particularly antibodies, and reversed the PTAB’s finding of nonobviousness on four process claims.<sup>181</sup>

At IPR, the PTAB found the composition claims obvious because the chemical modifications claimed by Cytiva had been “express[ly] suggest[ed]” in the prior art.<sup>182</sup> Certain other dependent claims were obvious because they claimed an “inherent property” of the composition.<sup>183</sup> But, for Cytiva’s parallel process claims, the PTAB declined to find obviousness despite the claiming of an inherent property; instead,

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<sup>173</sup> *Id.*

<sup>174</sup> *Id.* at 1383.

<sup>175</sup> *Id.* at 1384-85.

<sup>176</sup> *Id.*

<sup>177</sup> *Id.* at 1385.

<sup>178</sup> *Id.*

<sup>179</sup> *Id.* at 1386.

<sup>180</sup> *Id.* at 1385-86.

<sup>181</sup> *Cytiva BioProcess R&D AB v. JSR Corp.*, 122 F.4th 876 (Fed. Cir. 2024).

<sup>182</sup> *Id.* at 883.

<sup>183</sup> *Id.*

because JSR had failed to show an expectation of success, the process claims were nonobvious.<sup>184</sup>

On appeal, Cytiva's primary contention with regard to the invalidated composition claims was that the PTAB erred in failing to conduct a "lead-compound" analysis. A lead-compound analysis is a two-part test that assesses first, "whether a chemist of ordinary skill would have selected the asserted prior art compounds as lead compounds, or starting points, for further development efforts," and second, "whether the prior art would have supplied one of ordinary skill in the art with a reason or motivation to modify a lead compound to make the claimed compound with a reasonable expectation of success."<sup>185</sup> The court rejected Cytiva's argument, holding that such an analysis "is not required where the prior art references expressly suggest" the proposed modification."<sup>186</sup> In such circumstances, the Federal Circuit indicated that *KSR*'s obvious-to-try test would suffice.<sup>187</sup>

Even applying the lead-compound test, the Federal Circuit held that Cytiva's composition claims were still obvious.<sup>188</sup> At the first step, the court observed that the prior art sufficiently disclosed the lead compounds for further development; and, at the second step, that there would be sufficient motivation to modify the compound once the lead compound was selected, especially in light of the prior art's express modification teachings.<sup>189</sup>

Finally, the court turned to the merits of the *KSR* analysis for the process claims.<sup>190</sup> The Federal Circuit held that Cytiva's claims were obvious, since the only disputed claim limitation was "an inherent property" of the compositions and processes that had already determined to be obvious.<sup>191</sup> In such circumstances, a challenger need not even demonstrate a reasonable expectation of success under *KSR*.<sup>192</sup> Only where the "claims require prior knowledge of the inherent property" would a challenger "still generally need to demonstrate a reasonable expectation of success."<sup>193</sup> Thus, affirming in part and reversing in part the PTAB, the Federal Circuit concluded that all of Cytiva's claims were obvious.<sup>194</sup>

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

<sup>185</sup> *Id.* at 884 (quotations omitted).

<sup>186</sup> *Id.* at 884-85.

<sup>187</sup> *Id.* at 885.

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

<sup>189</sup> *Id.* at 886.

<sup>190</sup> *Id.* at 888.

<sup>191</sup> *Id.* at 890-91.

<sup>192</sup> *Id.* at 890.

<sup>193</sup> *Id.*

<sup>194</sup> *Id.* at 891-92.

## CLAIM CONSTRUCTION

*Aortic Innovations LLC v. Edwards Lifesciences Corp.*, --- F.4th ----, 2025 WL 2999367 (Fed. Cir. Oct. 27, 2025)

In this appeal from the District Court for the District of Delaware, the Federal Circuit affirmed the district court’s claim construction of the term “outer frame,” and affirmed the stipulated judgments of non-infringement as to three of the asserted patents.<sup>195</sup>

Aortic’s patents—directed to transcatheter aortic valve replacement devices and sharing a common specification—defined “outer frame” to include both “serial” and “dual-frame” embodiments.<sup>196</sup> The specification referred to the “outer frame” of the dual-frame embodiment as a “self-expanding frame” or “self-expanding outer frame” several times.<sup>197</sup> The District Court agreed with Edwards that “patentee acted as his own lexicographer” by using these terms interchangeably to refer to the same structure in both embodiments, effectively redefining “outer frame” from its plain meaning to instead mean “self-expanding frame.”<sup>198</sup>

The Federal Circuit reiterated the rule that “consistent and clear interchangeable use of two terms can result in a definition equating the two terms.”<sup>199</sup> Applying it here, the court found “a skilled artisan would understand that the claimed term ‘outer frame’ is a ‘self-expanding frame,’” because the specification used those terms interchangeably to explain figures and consistently indicated that the “outer frame” was a “self-expanding frame.”<sup>200</sup>

*Barrette Outdoor Living, Inc. v. Fortress Iron, LP*, 156 F.4th 1353 (Fed. Cir. Oct. 17, 2025)

In this appeal from the Northern District of Texas, the Federal Circuit affirmed the lower court’s stipulated judgment of non-infringement. Despite some differences in the underlying claim construction analysis, the court affirmed the holding that Barrette had disclaimed non-integral bosses during the prosecution of the third in a series of related patents and that this disclaimer limited the scope of the earlier patents.<sup>201</sup>

Barrette accused Fortress Iron of infringing its patents related to fencing assemblies “featuring pivoting, sliding connectors that connect pickets to rails.”<sup>202</sup> The patents shared a common specification and parent application that issued as the ‘075 patent.<sup>203</sup> The district court determined that “the terms ‘boss,’ ‘nub,’ and ‘projection’ are

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<sup>195</sup> *Aortic Innovations LLC v. Edwards Lifesciences Corp.*, --- F.4th ----, 2025 WL 2999367, at \*1 (Fed. Cir. Oct 27, 2025).

<sup>196</sup> *Id.* at \*1-3.

<sup>197</sup> *Id.* at \*3.

<sup>198</sup> *Id.* at \*4.

<sup>199</sup> *Id.* at \*5.

<sup>200</sup> *Id.* at \*5-6.

<sup>201</sup> *Barrette Outdoor Living, Inc. v. Fortress Iron, LP*, 156 F.4th 1353, 1356 (Fed. Cir. 2025).

<sup>202</sup> *Id.* at 1357-58.

<sup>203</sup> *Id.* at 1357.

used interchangeably” and that these terms limited the claims to fastener-less connections.<sup>204</sup> The district court based this holding on both the specification—which “disparaged prior art systems requiring fasteners”—and on part of the prosecution history of the ‘075 patent that occurred after two of the related patents had already issued.<sup>205</sup>

The Federal Circuit first held that the district court “erred in limiting the claims to fastener-less bosses.”<sup>206</sup> The court agreed “with Barrette that the specification does not clearly and unmistakably disclaim bosses with fasteners,” and that even if a patent presents “multiple advantages over the prior art, not every embodiment of the invention will embody every advancement.”<sup>207</sup>

However, the court agreed with the district court that Barrette had “disclaimed non-integral bosses during prosecution” when it “clearly distinguished” certain prior art, and thus “expressly clarified the scope of its claims.”<sup>208</sup> Barrette argued that “its subsequent communications with the patent office rendered any purported disclaimer ambiguous,” relying on cases where “the examiner rejected the applicant’s characterization of the scope of its invention, the applicant never raised the disclaimer again,” and it subsequently “overcame the examiner’s rejections on other grounds.”<sup>209</sup> However, the court distinguished the cases upon which Barrette relied, because the examiner here did not disagree with “Barrette’s assessment of the scope of its claims,” but rather its view of the scope of a prior art disclosure.<sup>210</sup>

Finally, the court rejected Barrette’s argument that “the disclaimer in the ‘075 patent’s prosecution history cannot apply to the claims of the already issued” patents, holding that courts may consider statements made during prosecution of related patents in construing shared terms, “regardless of whether the statement pre- or post-dates the issuance of the particular patent at issue.”<sup>211</sup> Nor did it matter that Barrette ultimately “cancelled the claims to which the disclaimer applied and filed new claims similar to those previously allowed in the other patents,” because a refiling applicant “cannot recapture claim scope that was surrendered.”<sup>212</sup>

*FMC Corp. v. Sharda USA, LLC, 145 F.4th 1326 (Fed. Cir. Aug. 1, 2025)*

In this appeal from the Eastern District of Pennsylvania, the Federal Circuit vacated and remanded an order granting FMC’s motion for a preliminary injunction.<sup>213</sup> The Federal Circuit held that the district court improperly construed the word

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<sup>204</sup> *Id.* at 1358-59.

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

<sup>206</sup> *Id.* at 1361.

<sup>207</sup> *Id.* at 1360.

<sup>208</sup> *Id.* at 1363.

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

<sup>210</sup> *Id.* at 1363-64.

<sup>211</sup> *Id.* at 1364 (quoting *Teva Pharms. USA, Inc. v. Sandoz, Inc.* 789 F.3d 1339, 1343 (Fed. Cir. 2015)).

<sup>212</sup> *Id.* at 1364 (quoting *Hakim v. Cannon Avent Grp., PLC*, 479 F.3d 1313, 1317-18 (Fed. Cir. 2007)).

<sup>213</sup> *FMC Corp. v. Sharda USA, LLC*, 145 F.4th 1326, 1328 (Fed. Cir. 2025).

“composition” to mean stable compositions only; it therefore vacated the district court’s derivative holdings on obviousness and anticipation.<sup>214</sup>

FMC’s case relied on a family of insecticide and miticide patents—two asserted patents and a related provisional application (‘979)—sharing a common specification.<sup>215</sup> The district court’s order relied on construing “composition” as limited to “stable compositions, rather than the well-known unstable compositions that produce ineffective results as discussed throughout the prosecution history.”<sup>216</sup>

The Federal Circuit rejected this construction for three reasons. First, the district court improperly relied on disclosures about the importance of physical stability that were present only in the provisional application, not in the asserted patents. The Federal Circuit analogized to its decision in *DDR Holdings, LLC v. Priceline.com*, 122 F.4th 911 (Fed. Cir. 2024), holding that the alteration of terms was “highly significant” where “a skilled artisan would understand” those changes to “indicate an evolution of the applicant’s intended meaning of the claim term.”<sup>217</sup> It did not matter whether the alterations broadened or narrowed the scope of the claim term.<sup>218</sup> Second, the district court erred by relying on a separate FMC patent derived from ‘979 preserved statements about stability. The Federal Circuit held that the principle of interpreting claim terms consistently across a patent family “does not hold true” when the patentee “materially alters the specification” of some members “in a manner that directs a skilled artisan to interpret the claim differently.”<sup>219</sup> Finally, the Federal Circuit rejected FMC’s contentions that “homogeneous” and “unexpected insecticidal activity” implied stability, holding that those terms already had distinct meanings in the prosecution history and that FMC had not explained why that distinction no longer held.<sup>220</sup>

*Lab Corp v. Qiagen*, \_\_\_ F.4th \_\_\_, 2025 WL 2327197 (Fed. Cir. Aug. 13, 2025)

In this appeal from the District of Delaware, the Federal Circuit reversed and remanded an order denying Qiagen’s motion for judgment as a matter of law (JMOL) after a jury determined Qiagen infringed two Lab Corp. patents directed to methods of preparing DNA samples for sequencing.<sup>221</sup>

On Lab Corp’s ‘810 patent, the Federal Circuit reversed the denial of JMOL on two separate grounds. First, the district court “erred in allowing the jury to consider that ‘identical’ can mean ‘identical to a portion,’ and in further denying JMOL to Qiagen on this issue.” Lab Corp’s patent described the “second target-specific primer” as including “a 5’ portion comprising a nucleic acid sequence that is identical to a second sequencing primer.”<sup>222</sup> In Qiagen’s allegedly infringing kits, the counterparts to the target-specific

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<sup>214</sup> *Id.* at 1333-34.

<sup>215</sup> *Id.* at 1329.

<sup>216</sup> *Id.*

<sup>217</sup> *Id.* at 1331.

<sup>218</sup> *Id.* at 1332.

<sup>219</sup> *Id.*

<sup>220</sup> *Id.* at 1333.

<sup>221</sup> *Lab Corp. of Am. Holdings v. Qiagen Sciences, LLC*, \_\_\_ F.4th \_\_\_, 2025 WL 237197 (Fed. Cir. Aug. 13, 2025).

<sup>222</sup> *Id.* at \*2.

and sequencing primers were of different lengths, with the former being identical only to a portion of the latter.<sup>223</sup> The Federal Circuit held that the district court erred by allowing the jury to decide the construction of “identical,” and by instructing that the jury “was not precluded from finding that ‘identical’ may mean identical to a portion.”<sup>224</sup> The Federal Circuit explained that “identical” means “the same,” and thus cannot mean “identical to a portion.”<sup>225</sup> This was especially true because another part of the claim at issue defined “adaptor primer” as only “*identical to a portion* of the first sequencing primer.”<sup>226</sup> Reading both limitations the same way would fail to give effect to the specification’s differentiation of those terms “according to their degree” of identity.<sup>227</sup>

*Egenera v. Cisco*, 141 F.4th 1350 (Fed. Cir. July 7, 2025)

In this appeal from the District of Massachusetts, the Federal Circuit affirmed a judgment of non-infringement of four claims of Egenera’s patent for deployment of a virtualized processing area network.<sup>228</sup> The district court granted summary judgment to Cisco on claims 1 and 5 based on undisputed facts that Cisco’s CPU’s only *used* Ethernet functionality and did not emulate it, distinguishing it from Egenera’s patent claims.<sup>229</sup>

Egenera appealed, arguing that the district court had made improper factual findings on summary judgment.<sup>230</sup> The Federal Circuit explained that in this light, “there is little doubt that the district court should be affirmed.”<sup>231</sup> However, the Federal Circuit determined during oral argument that the actual dispute between the parties “was actually about the proper construction of ‘emulate,’ and whether, as used in the asserted claims, it encompasses the CPUs’ mere ‘use’ of Ethernet functionality.”<sup>232</sup>

The court declined to consider the construction of “emulate” because Egenera had “waived the ability to argue for an alternative claim construction” by failing to properly raise the issue, either during summary judgment briefings or on appeal.<sup>233</sup> Neither party indicated a dispute over the definition of “emulate Ethernet functionality” standing alone, either during initial claim construction or in motions for summary judgment.<sup>234</sup> And the Federal Circuit did not consider the issue properly raised on appeal, because Egenera “merely allude[d] to the possibility” that the construction was wrong and did not raise the issue in the “statement of the issues,” cite any legal support for the argument, or recite the relevant legal standard.<sup>235</sup> Moreover, during oral argument, Egenera denied that it had

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<sup>223</sup> *Id.* at \*5.

<sup>224</sup> *Id.*

<sup>225</sup> *Id.*

<sup>226</sup> *Id.* (emphasis in original)

<sup>227</sup> *Id.*

<sup>228</sup> *Egenera, Inc. v. Cisco Systems, Inc.*, 141 F.4th 1350, 1355 (Fed. Cir. 2025).

<sup>229</sup> *Id.* at 1357-59.

<sup>230</sup> *Id.* at 1359.

<sup>231</sup> *Id.*

<sup>232</sup> *Id.* at 1359-60.

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

<sup>234</sup> *Id.* at 1357.

<sup>235</sup> *Id.* at 1361-62.

appealed the construction of “emulate.”<sup>236</sup> As such, the court affirmed summary judgment of noninfringement on claims 1 and 5.<sup>237</sup>

*Eye Therapies v. Slayback*, 141 F.4th 1264 (Fed. Cir. June 30, 2025)

The Federal Circuit reversed a PTAB determination in an IPR proceeding that patentee’s claims were unpatentable as obvious.<sup>238</sup> The Federal Circuit held that the intended meaning of the phrase “consisting essentially of” in this patent differed from its ordinary meaning.<sup>239</sup>

Patentee Eye Therapies owned a patent teaching a method of reducing eye redness via topical application of a solution “consisting essentially of” brimonidine.<sup>240</sup> Eye Therapies adopted this phrase—replacing “comprising”—during patent prosecution to avoid anticipation by an earlier patent that used brimonidine alongside another active ingredient.<sup>241</sup> In the IPR proceeding, the Board construed this phrase per its ordinary meaning to indicate that the invention “necessarily includes the listed ingredients [but] is open to unlisted ingredients that do not materially affect the basic and novel properties of the invention,” so the claims would not prohibit the use of additional active ingredients.<sup>242</sup> As such, the Board held the patent was obvious.<sup>243</sup>

The Federal Circuit held that the prosecution history “strongly evince[d] a restrictive meaning” of the phrase “consisting essentially of.”<sup>244</sup> Eye Therapies “persuaded the examiner of the novelty of the claims by underscoring the *absence* of other active ingredients in the claimed methods.”<sup>245</sup> The court explained that “arguments advanced in prosecution to convince the examiner” that the invention meets statutory requirements “can limit claim interpretation.”<sup>246</sup>

*Alnylam Pharm v. Moderna*, 138 F.4th 1326 (Fed. Cir. June 4, 2025)

In this appeal from the District of Delaware, the Federal Circuit affirmed the trial court’s construction of “branched alkyl,” which was the central issue on appeal of the final judgment of non-infringement.<sup>247</sup> The district court held that “Alnylam had acted as a lexicographer regarding the claim term ‘branched alkyl,’” defining it “unless otherwise specified” as “an alkyl ... group in which one carbon atom in the group (1) is bound to at least three other carbon atoms and (2) is not a ring atom of a cyclic group.”<sup>248</sup> The parties

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<sup>236</sup> *Id.* at 1361.

<sup>237</sup> *Id.* at 1362.

<sup>238</sup> *Eye Therapies, LLC v. Slayback Pharma, LLC*, 141 F.4th 1264, 1266 (Fed. Cir. 2025).

<sup>239</sup> *Id.*

<sup>240</sup> *Id.* at 1266-67.

<sup>241</sup> *Id.* at 1267.

<sup>242</sup> *Id.* at 1267-68.

<sup>243</sup> *Id.* at 1268.

<sup>244</sup> *Id.* at 1268-1270.

<sup>245</sup> *Id.* at 1270 (emphasis in original).

<sup>246</sup> *Id.* at 1269.

<sup>247</sup> *Alnylam Pharms., Inc. v. Moderna, Inc.*, 138 F.4th 1326, 1329 (Fed. Cir. 2025).

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

“stipulated that Moderna did not infringe the asserted patent claims under that claim construction, because Moderna’s” mRNA-based COVID-19 vaccine did not meet the first “branched alkyl” requirement.<sup>249</sup>

On appeal, Alnylam argued it had not acted as a lexicographer because “the intrinsic record shows it did not intend to so limit the ‘branched alkyl’ terms and that the district court’s construction excludes disclosed embodiments.”<sup>250</sup> The Federal Circuit disagreed, affirming the district court’s determination that the relevant passage was “definitional” for several reasons, including that it appeared under the title “Definitions,” and the term to be defined was set off in quotation marks.<sup>251</sup> Moreover, the sentence used the term “refer to,” which usually conveys definitional intent, in contrast to the non-limiting language Alnylam used elsewhere.<sup>252</sup> Finally, the phrase “unless otherwise specified” in this context suggested that the rest of the sentence articulated “a generally applicable rule or definition.”<sup>253</sup>

In the alternative, Alnylam argued that the “unless otherwise specified” part of the definition would cover “a secondary carbon at the alpha position,” thus rendering Moderna’s vaccine infringing.<sup>254</sup> But the Federal Circuit agreed with the district court that “a high threshold would have to be met before finding a departure from” the controlling definition.<sup>255</sup> The court reviewed the face of the asserted claims, other parts of the specification, and the prosecution history, but did not find any “clear reason” to conclude that the asserted claims intended to contradict the general definition.<sup>256</sup>

*Azurity Pharms., Inc. v. Alkem Lab’ys Ltd., 133 F.4th 1359 (Fed. Cir. Apr. 8, 2025)*

In this appeal from the District of Delaware, the Federal Circuit affirmed the district court’s finding of non-infringement based on Azurity’s disclaimer of propylene glycol in its prosecution of the patent, which related to a liquid antibiotic formulation.<sup>257</sup>

After the initial claims were rejected over prior art (including Palepu), Azurity had proposed several amendments, which included negative limitations like “does not comprise a propylene glycol,” since propylene glycol had been disclosed by Palepu.<sup>258</sup> After additional back-and-forth, Azurity proposed a limitation of both propylene and polyethylene glycol with “consisting of” language; that was sufficient, according to the Examiner’s reasoning, to distinguish the claims from the prior art and grant an allowance.<sup>259</sup>

On appeal, the issue was whether Azurity had disclaimed the use of propylene glycol *in total*, or whether its prosecution conduct disclaims propylene glycol “only as a

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

<sup>250</sup> *Id.* at 1332.

<sup>251</sup> *Id.* at 1333.

<sup>252</sup> *Id.*

<sup>253</sup> *Id.*

<sup>254</sup> *Id.* at 1332-33.

<sup>255</sup> *Id.* at 1334.

<sup>256</sup> *Id.* at 1335-1338.

<sup>257</sup> *Azurity Pharms., Inc. v. Alkem Lab’ys Ltd., 133 F.4th 1359, 1363 (Fed. Cir. 2025).*

<sup>258</sup> *Id.* at 1364.

<sup>259</sup> *Id.* at 1364-65.

carrier” and not as a “flavoring agent.”<sup>260</sup> Here, the Federal Circuit held that Alkem had identified “clear and unmistakable statements” that disclaimed propylene glycol in *all* of Azurity’s claims.<sup>261</sup>

First, the court clarified that, when applying prosecution disclaimer to a family of patents, the touchstone is “public notice.”<sup>262</sup> Thus, while “statements in the prosecution histories of patents descended from a common ancestor application may be relevant for interpreting the claims” of later-issued patents, those statements are not relevant to interpreting *earlier*-issued patents, which was the circumstance here.<sup>263</sup>

Second, the court found that Azurity’s statements throughout the prosecution left “no room to doubt” that it narrowed its claims in order to disclaim propylene glycol to overcome the prior art.<sup>264</sup> Azurity’s argument—that its disclaimer was limited only to carriers using propylene glycol, but not “flavoring agents,” since the prior art disclosed propylene glycol as a carrier—failed because what matters “most is the broad language” used by the patentee to get around the prior art, rather than the reach of the prior art itself.<sup>265</sup> Finally, the court affirmed the finding of non-infringement, since the accused products contained propylene glycol, which had been disclaimed by Azurity.<sup>266</sup>

*Maquet Cardiovascular LLC v. Abiomed Inc.*, 131 F.4th 1330 (Fed. Cir. Mar. 21, 2025)

In this appeal from the District of Massachusetts, the Federal Circuit reversed the district court’s claim construction for improperly importing a negative limitation by disclaimer from the parent patent’s prosecution history, among other errors.<sup>267</sup>

While the court recognized that the prosecution history of related patents can be relevant to disclaimer, the Federal Circuit emphasized that, if the limitations are dissimilar, “we generally cannot accept, without more support, “that an applicant’s disclaimer with respect to one claim would be equally applicable to another claim.”<sup>268</sup> Here, the claim term at issue was “guidewire mechanism comprising a lumen,” whereas the parent patent’s terms “did not even claim a guide mechanism.”<sup>269</sup> There were additional differences, including as to location of the lumen.<sup>270</sup> In refusing to apply prosecution disclaimer in light of these differences, the Federal Circuit emphasized that the “law of prosecution disclaimer” does not extend to the subject matter of the claims, but rather, the court must “focus on the claim language, and differences in such language,

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<sup>260</sup> *Id.* at 1366.

<sup>261</sup> *Id.*

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

<sup>263</sup> *Id.* at 1367.

<sup>264</sup> *Id.* at 1367-68.

<sup>265</sup> *Id.* at 1368.

<sup>266</sup> *Id.* at 1370.

<sup>267</sup> *Maquet Cardiovascular LLC v. Abiomed Inc.*, 131 F.4th 1330, 1333 (Fed. Cir. 2025).

<sup>268</sup> *Id.* at 1339.

<sup>269</sup> *Id.* at 1340.

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

when determining whether the prosecution history of an earlier, related patent is relevant for construing a later claim.”<sup>271</sup>

In contrast, however, the Federal Circuit held that the prosecution history of the great-great-grandparent of the patent-in-suit *was* relevant to a disclaimer argument, since the claim limitations in both patents were “virtually identical” with only minor differences.”<sup>272</sup> But the court rejected disclaimer on the merits, finding that there was no “clear and unmistakable” disavowal.<sup>273</sup>

*In re Xencor, Inc.*, 130 F.4th 1350 (Fed. Cir. Mar. 13, 2025)

In this appeal from the PTAB’s Appeals Review Panel (ARP), the Federal Circuit affirmed the ARP’s limiting construction of the term “treating a patient” in the preamble of a method claim.<sup>274</sup>

The preamble of the claim at issue recited “a method of treating a patient by administering” a certain antibody comprising the claimed elements.<sup>275</sup> Xencor contended that this language should be considered independently, construing “administering” as a limiting element but construing “treating a patient” to only state a purpose, and not to limit the claim.<sup>276</sup>

On appeal, the Federal Circuit disagreed, holding that the preambular language was limiting.<sup>277</sup> First, the court observed that the claim language referred back to the preamble, which means that the preamble was limiting, at least in part.<sup>278</sup> And though courts may “split a preamble into limiting and non-limiting parts,” that was not appropriate here, since the “treating a patient” phrase was “directly connected” to the rest of the preambular language.<sup>279</sup> Second, the Federal Circuit held that “treating a patient” was an essential part of the preamble, since it gave “color and meaning” to the “administering” limitation; and thus, “treating a patient” was more than merely a “statement of intended result” that might be non-limiting.<sup>280</sup> Third, the “treating a patient” term provided a “*raison d’être*” for the claim, which referred to “in vivo half-life” of the antibodies (which only “makes sense” with respect to living beings), since performing that claim *without* any human treatment would be a mere academic exercise. Finally, the court looked to the specification, which had repeatedly referred to the use of the invention as applied to humans in clinical trials or in treatment, as evidence that the preamble was limiting.<sup>281</sup>

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

<sup>272</sup> *Id.* at 1341-42.

<sup>273</sup> *Id.* at 1343-44.

<sup>274</sup> *In re Xencor, Inc.*, 130 F.4th 1350, 1354 (Fed. Cir. 2025)

<sup>275</sup> *Id.* at 1357.

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

<sup>277</sup> *Id.* at 1358.

<sup>278</sup> *Id.*

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

<sup>280</sup> *Id.* at 1359.

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

Having found that “treating a patient” was limiting, the court went on to hold that the limitation was inadequately described.<sup>282</sup>

*DDR Holdings, LLC v. Priceline.com LLC*, 122 F.4th 911 (Fed. Cir. December 21, 2024)

In this appeal from the District of Delaware, the Federal Circuit affirmed the district court’s construction of the terms “merchants” and “commerce object” in claims directed to a composite web page that combine visual objects from the host of the site with content from third-party merchants.<sup>283</sup> DDR sought a construction of the terms that would include both goods *and* services, while Priceline.com pressed for a goods-only construction.<sup>284</sup> The Federal Circuit agreed with Priceline.com based on the patent’s specification and prosecution history.<sup>285</sup> First, the patent’s specification failed to mention *services* in relation to merchants and commerce objects.<sup>286</sup> Even though the provisional application referred to “products or services,” that counted against DDR since “the deletion made by the patent drafter between the provisional application and the patent specification” would indicate to a skilled artisan an “evolution of the applicant’s intended meaning of the claim term.”<sup>287</sup> It was immaterial that the patent purported to incorporate by reference the provisional application.<sup>288</sup> Finally, the Federal Circuit held that it was not bound by prior claim construction during IPR because the PTAB applies the broadest reasonable interpretation standard, rather than the *Phillips* standard.<sup>289</sup>

*Kids2, LLC v. TOMY Int’l, Inc.*, 2025 WL 87335 (Fed. Cir. Jan. 14, 2025)

In this appeal from the District of Rhode Island, the Federal Circuit reversed the district court’s entry of summary judgment of non-infringement in Kids2’s favor and remanded for further proceedings.<sup>290</sup>

At claim construction, the district court construed a key claim limitation, “distal edges joined at a bottom surface apex,” to mean “edges of the seating surfaces situated farthest away from their respective back rests *joined to each other* at the area of a high point of the bottom surface of the body between the seating surfaces.”<sup>291</sup> In other words, the district court’s construction required the two edges to be directly joined to each other, rather than indirectly joined to either side of an intervening structure.<sup>292</sup> Based on that

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<sup>282</sup> *Id.* at 1359-60.

<sup>283</sup> *DDR Holdings, LLC v. Priceline.com LLC*, 122 F.4th 911, 913 (Fed. Cir. 2024).

<sup>284</sup> *Id.* at 915.

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

<sup>286</sup> *Id.* at 916.

<sup>287</sup> *Id.* at 916.

<sup>288</sup> *Id.* at 917-18.

<sup>289</sup> *Id.* at 918-19.

<sup>290</sup> *Kids2, LLC v. TOMY Int’l, Inc.*, 2025 WL 87335 (Fed. Cir. Jan. 14, 2025).

<sup>291</sup> *Id.* at \*2.

<sup>292</sup> *Id.* at \*4.

construction, the district court entered summary judgment in favor of Kids2 of non-infringement.<sup>293</sup>

On appeal, the Federal Circuit held that the term “at a bottom surface apex” indicated “*where* the distal edges of the two seating surfaces joined, but does not limit *how* those distal edges must be joined.”<sup>294</sup> That conclusion was supported by the “plain and ordinary” meaning of “joined,” which includes both direct joining and indirect joining.<sup>295</sup> What’s more, the Federal Circuit construed one of the dependent claims as including indirect joiner; and since an independent claim “must be broad enough to contain the full scope of its independent claim,” that provided evidence for the broader reading of “joined.”<sup>296</sup> That conclusion found further support in the specification and prosecution history, which disclosed embodiments with only indirect joiner.<sup>297</sup> The court, however, rejected TOMY’s other claim construction arguments, affirming the district court’s construction of the terms “bottom surface” and “seating surfaces.”<sup>298</sup> Judge Chen dissented from the majority’s claim construction disposition and would have affirmed the district court’s claim construction in full.<sup>299</sup>

The court further opined on TOMY’s infringement theories, finding that Kids2’s product documentation and witness testimony could support a finding that a certain feature of the accused product—a raised portion of the bottom surface that prevents a child from sliding down—could constitute a “seating surface.”<sup>300</sup> On this theory of infringement, Judge Chen disagreed in dissent.<sup>301</sup> Judge Chen explained that a “seating surface” is something that one “sits *on*, not something that one sits *against*”; and since the feature of the accused product was merely an intervening *rest* that restrained movement, it did not constitute a “seating surface.”<sup>302</sup>

On TOMY’s second theory of infringement—which ignored the resting point and treated the two surrounding surfaces as the “seating structures”—the majority held that a reasonable factfinder could find that Kids2 product had “two seating surfaces disposed at differing inclinations” because one of the surfaces was horizontal (i.e., of zero inclination) and the other was steeper.<sup>303</sup> Judge Chen dissented from this point too, arguing that a horizontal surface lacks any inclination at all, that TOMY had forfeited the argument in failing to assert that the “inclination” claim included zero incline, and that the prosecution history suggested that the claim required both seating surfaces to be inclined at a greater-than-zero angle.<sup>304</sup>

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<sup>293</sup> *Id.* at \*2.

<sup>294</sup> *Id.* at \*4.

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

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

<sup>297</sup> *Id.* at \*5.

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

<sup>299</sup> *Id.* at \*8 (Chen, J., dissenting in part).

<sup>300</sup> *Id.* at \*6.

<sup>301</sup> *Id.* at \*8 (Chen, J., dissenting in part).

<sup>302</sup> *Id.*

<sup>303</sup> *Id.* at \*6 (majority opinion).

<sup>304</sup> *Id.* at \*10 (Chen, J., dissenting in part).

In this appeal from the Southern District of Florida, the Federal Circuit reversed the district court’s grant of summary judgment to Point Blank based on the district court’s erroneous construction of the claim term “pull cord.”<sup>305</sup>

The asserted patents related to quick release system on tactical vest worn by military and public safety personnel.<sup>306</sup> Instead of requiring fasteners (like buckles) to be individually removed, the claims provided for a “pull cord,” which would simultaneously disengage all of the vest’s fasteners, and allow the front portion of the vest to completely detach from the rear.<sup>307</sup> The accused devices included a trigger that, when activated, caused the mechanical movement of cables which caused the vest’s fasteners to release.<sup>308</sup>

Following the *Markman* hearing, the district court construed “pull cord” as a cord that can be “directly pulled by a user to disengage a releasable fastener [or hook]” and declined the parties’ suggestion to define “pull cord” in terms of whether it was located inside the vest or outside of the vest.<sup>309</sup> And, based on that construction, the court granted summary judgment of noninfringement to Point Blank, since its mechanism involved a “trigger” that could not be pulled (and the internal wires involved in the mechanism also could not be pulled without opening up the vest.”<sup>310</sup> The district court also declined to apply the doctrine of equivalents to find infringement, noting that the accused products operated in a different way than the “pull cord” since the trigger “reduce[d] the amount of force” required to activate the mechanism.<sup>311</sup>

On appeal, the Federal Circuit first held that the district court erred in limiting “pull cord” to cords *directly* pulled by users.<sup>312</sup> Because the claim did not include such a limitation, the Federal Circuit declined to read in that limitation, even though the embodiments in the specifications all involved cords that were directly pulled.<sup>313</sup> Next, the court held that “pull cord” could not be construed to exclude handles.<sup>314</sup> While the claim language was silent, the court found probative the specification, which included figures with pull cords with handles.<sup>315</sup> Moreover, the court found that the patent had not “disavowed” handles, even though it criticized some vest designs that had handles, since that criticism did not “particularly criticize” the handles themselves, rather than other features in the prior art.<sup>316</sup> The Federal Circuit thus remanded to the district court to apply the correct construction at summary judgment.<sup>317</sup>

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<sup>305</sup> *IQRIS Techs. LLC v. Point Blank Enters., Inc.*, 130 F.4th 998, 999 (Fed. Cir. 2025).

<sup>306</sup> *Id.* at 1000.

<sup>307</sup> *Id.*

<sup>308</sup> *Id.* at 1001.

<sup>309</sup> *Id.*

<sup>310</sup> *Id.* at 1002.

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

<sup>312</sup> *Id.* at 1003.

<sup>313</sup> *Id.* at 1003-04.

<sup>314</sup> *Id.* at 1004.

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

<sup>316</sup> *Id.*

<sup>317</sup> *Id.* at 1005.

## INFRINGEMENT

*Regeneron Pharms., Inc. v. Mylan Pharms. Inc.*, 130 F.4th 1372 (Fed. Cir. Mar. 14, 2025)

In this appeal from the Northern District of West Virginia, the Federal Circuit affirmed the district court’s denial of Regeneron’s motion for a preliminary injunction to stop a competitor from marketing a biosimilar.<sup>318</sup>

The patent is directed at formulations of aflibercept (brand name, Eylea), a fusion protein used to treat angiogenic eye disorders.<sup>319</sup> Amgen is approved to market a biosimilar, branded as Pavblu, which has a different formulation from Eylea.<sup>320</sup> While Eylea’s formulation includes a buffer to stabilize the protein, Amgen’s Pavblu does not contain a separate buffer component, and rather, involves self-buffering aflibercept.<sup>321</sup>

First, construing the claims, the Federal Circuit applied *Becton*<sup>322</sup> to hold that, since Regeneron’s claim listed the fusion protein and the buffer as separate elements (along with two additional components), those two elements are “distinct components” of the claimed invention.<sup>323</sup>

Next, evaluating whether Regeneron could show a likelihood of succeeding in proving that Amgen’s self-buffering product would infringe, the Federal Circuit asked whether the *Becton* presumption could be overcome by a showing that “impliedly distinct components” can be “satisfied by a single component.”<sup>324</sup> Based on the intrinsic evidence, the court held that, since the claims had used different units of measurement for the protein and the buffer, that “reinforce[d]” that the two components must be different.<sup>325</sup> The same was true of the specification, which described only a “distinct buffer component” consistently throughout.<sup>326</sup> In so holding, the Federal Circuit rejected Regeneron’s argument that a single component might be sufficient because the specification did not expressly disclaim that.<sup>327</sup> And, in reviewing the extrinsic evidence—which did not even need to be “consider[ed] . . . given the overwhelming evidence in the intrinsic record”—the court nonetheless affirmed the district court’s finding that, at the time of the filing date, proteins were not generally known to have buffering properties.<sup>328</sup>

Thus, since it was undisputed that Amgen’s product lacked a separate buffer, the Federal Circuit held that there was “at least a substantial question of noninfringement” that precluded the issuance of a preliminary injunction against Amgen.<sup>329</sup>

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<sup>318</sup> *Regeneron Pharms., Inc. v. Mylan Pharms. Inc.*, 130 F.4th 1372, 1375 (Fed. Cir. 2025).

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

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

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

<sup>322</sup> *Becton, Dickinson & Co. v. Tyco Healthcare Grp., LP*, 616 F.3d 1249 (Fed. Cir. 2010).

<sup>323</sup> *Regeneron*, 130 F.4th at 1378-80.

<sup>324</sup> *Id.* at 1380.

<sup>325</sup> *Id.* at 1381.

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

<sup>327</sup> *Id.* at 1383.

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

<sup>329</sup> *Id.* at 1384.

## Doctrine of Equivalents

*Colibri Heart Valve LLC v. Medtronic Corevalve LLC*, 143 F.4th 1367 (Fed. Cir. July 18, 2025)

In this appeal from the Central District of California, the Federal Circuit reversed a finding of infringement, holding that prosecution history estoppel barred application of the doctrine of equivalents because the asserted equivalent was not distinct from a cancelled claim.<sup>330</sup>

Colibri accused Medtronic of inducing infringement of its patent claiming a method for furnishing a “do-over opportunity” in the placement of artificial heart valves. Colibri originally sought to patent two methods of doing so: claim 34 did so by “pushing out the valve from an outer sheath of the delivery apparatus,” and claim 39 did so by “retracting the outer sheath to expose the valve.”<sup>331</sup> However, Colibri cancelled the latter claim after the examiner rejected it for lack of written description.<sup>332</sup> At trial, Colibri claimed that Medtronic’s retraction-based method was infringing of claim 34 under the doctrine of equivalents.<sup>333</sup> Colibri argued that Medtronic’s method of “applying a force to hold the stent in place while retracting the movable sheath” was equivalent to the claimed method of “applying a force to push the stent out of the moveable sheath.”<sup>334</sup> The court agreed and rejected Medtronic’s motions for JMOL.<sup>335</sup>

The Federal Circuit reversed on two related grounds, focusing on substance over form. First, it held that the district court erred in finding the asserted equivalent to be distinct from the cancelled claim.<sup>336</sup> The district court had distinguished the cancelled claim 39—which described only “retracting the moveable sheath” and not “pushing”—from Medtronic’s devices, which “require both pushing and retracting.”<sup>337</sup> The Federal Circuit rejected this interpretation, because for retraction to work in either case, “a countervailing pushing force” was necessary.<sup>338</sup> Second, the Federal Circuit held that Colibri’s cancellation of claim 39 “was a narrowing amendment giving rise to prosecution history estoppel.”<sup>339</sup> The court explained that even though claims 34 and 39 were separate, independent claims, narrowing could still occur “based on cancelling a closely related claim involving such intertwined terminology that cancelling one claim necessarily communicated that the scope of the other claim had narrowed.”<sup>340</sup> The court therefore reversed the denial of JMOL, which mooted the remaining aspects of the appeal over Colibri’s expired patent.<sup>341</sup>

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<sup>330</sup> *Colibri Heart Valve LLC v. Medtronic Corevalve LLC*, 143 F.4th 1367, 1369 (Fed. Cir. 2025).

<sup>331</sup> *Id.* at 1369-70.

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

<sup>333</sup> *Id.* at 1375.

<sup>334</sup> *Id.*

<sup>335</sup> *Id.*

<sup>336</sup> *Id.* at 1377, 1380.

<sup>337</sup> *Id.* at 1377-78.

<sup>338</sup> *Id.* at 1378.

<sup>339</sup> *Id.* at 1378.

<sup>340</sup> *Id.* at 1378-79.

<sup>341</sup> *Id.* at 1381-82.

## Reverse Doctrine of Equivalents

*Steuben Foods, Inc. v. Shibuya Hoppmann Corp.*, 2025 WL 285173 (Fed. Cir. Jan. 24, 2025)

In this appeal from the District of Delaware, the Federal Circuit reversed the district court’s granting judgment as a matter of law (“JMOL”) of noninfringement on two patents (‘591 and ‘188), and affirmed JMOL of noninfringement on a third patent (‘685).<sup>342</sup> The patents at issue concerned systems for aseptic packaging of food.<sup>343</sup>

With respect to ‘591, the jury’s infringement verdict was overturned by the district court because it found that Shibuya had satisfied its burden to prove the reverse doctrine of equivalents (“RDOE”), entitling it to judgment as a matter of law.<sup>344</sup> On appeal, Steuben first argued that the 1952 Patent Act eliminated RDOE. In support of its contention, Steuben pointed to § 271(a), which requires that all exceptions to infringement must be enumerated by statute, and to § 112, arguing that this section was intended to cover similar ground to the common law RDOE.<sup>345</sup> While the Federal Circuit found these arguments “compelling,” it declined to hold that RDOE had been abrogated by statute.<sup>346</sup> Instead, the court found that JMOL based on RDOE was inappropriate in this case because, considering Steuben’s expert’s rebuttal testimony (which had been improperly excluded by the district court), a reasonable jury could have found that the operation of the devices were sufficiently similar to overcome RDOE.<sup>347</sup>

With respect to ‘188, the district court concluded that Steuben’s claimed structures, including a conveyor and conveyor plates, did not function equivalently to Shibuya’s rotary wheels and neck grippers, which entitled Shibuya to a finding of noninfringement as a matter of law because the doctrine of equivalents (“DOE”) had not been satisfied.<sup>348</sup> The Federal Circuit reversed, again based in large part on Steuben’s expert’s testimony.<sup>349</sup> Because Steuben’s expert testified that the systems differed in form, but still performed the same function (filling bottles at a certain rate) in substantially the same way (by holding bottles as they move down a conveyor, albeit by different mechanisms), the Federal Circuit held that a reasonable jury could have applied the DOE to find infringement, thereby reversing the grant of JMOL.<sup>350</sup>

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<sup>342</sup> *Steuben Foods, Inc. v. Shibuya Hoppmann Corp.*, 2025 WL 285173, at \*1 (Fed. Cir. Jan. 24, 2025)

<sup>343</sup> *Id.* at \*2.

<sup>344</sup> *Id.* at \*3.

<sup>345</sup> *Id.* at \*4.

<sup>346</sup> *Id.*

<sup>347</sup> *Id.* at \*5.

<sup>348</sup> *Id.* at \*6.

<sup>349</sup> *Id.* at \*6.

<sup>350</sup> *Id.* at \*6.

Finally, with respect to ‘985, the key claim limitation required sterilant to be “intermittently” added to the system, which the parties stipulated to mean “added in a non-continuous manner.”<sup>351</sup> And because Shibuya’s system *continuously* added sterilant, the district court granted a JMOL of noninfringement, since “intermittently” and “continuously” are “antonyms,” and therefore cannot serve as “equivalents” in a DOE analysis.<sup>352</sup> The Federal Circuit affirmed, observing that, to apply DOE in this case would “vitiating the claim limitation.”<sup>353</sup> “Something that is done non-continuously cannot be the equivalent of something done continuously.”<sup>354</sup> Thus, because no reasonable jury could find equivalence, JMOL of noninfringement was warranted.<sup>355</sup>

### **Secondary Infringement**

*CloudofChange, LLC v. NCR Corp.*, 123 F.4th 1333, 1335 (Fed. Cir. Dec. 18, 2024)

In this appeal from the Western District of Texas, the Federal Circuit reversed the district court’s denial of judgment as a matter of law and held that NCR Corporation could not be liable under either a divided or vicarious liability theory of infringement.<sup>356</sup>

The claimed system in the asserted patents required both vendor-operated web servers and subscriber-operated point-of-sale (“POS”) terminals that connected to those servers.<sup>357</sup> That system implicated the *Centillion*<sup>358</sup> doctrine, which allows for direct liability for infringement of claims that require different actors to perform different components of the claim (known as divided infringement), so long as the defendant put the system to use and derived benefit from that use.<sup>359</sup>

Applying *Centillion*, the Federal Circuit agreed with the district court that it was NCR’s subscribers that “used” the claimed system, rather than NCR itself, even though the hardware used by subscribers was occasionally provided by NCR.<sup>360</sup> And even though NCR “benefitted” from its subscribers infringing uses (from, e.g., monthly subscription fees), the benefits required by *Centillion* are those derived from use of the entire claimed system, rather than general commercial benefits from infringement.<sup>361</sup>

Next, turning to a vicarious liability theory of infringement, the Federal Circuit reversed the district court’s refusal to enter judgment for NCR of non-infringement as a matter of law.<sup>362</sup> While the district court had found vicarious liability based on NCR’s requirement that merchants maintain Internet access—which was one of the claimed

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<sup>351</sup> *Id.* at \*7.

<sup>352</sup> *Id.*

<sup>353</sup> *Id.* at \*8.

<sup>354</sup> *Id.*

<sup>355</sup> *Id.*

<sup>356</sup> *CloudofChange, LLC v. NCR Corp.*, 123 F.4th 1333, 1335 (Fed. Cir. 2024), *cert. denied*, No. 24-1058, 2025 WL 1287089 (U.S. May 5, 2025).

<sup>357</sup> *Id.* at 1335-37.

<sup>358</sup> *Centillion Data Sys., LLC v. Qwest Comm’ns Int’l, Inc.*, 631 F.3d 1279 (Fed. Cir. 2011).

<sup>359</sup> *CloudofChange*, 123 F.4th at 1337.

<sup>360</sup> *Id.* at 1340.

<sup>361</sup> *Id.* at 1341.

<sup>362</sup> *Id.*

elements—the Federal Circuit found this was error, as directing users “to perform one element of a system claim is not the proper test.”<sup>363</sup> The court distinguished between system and methods claims in the vicarious liability context. In a method claim, since each step of the claim must be performed in a sequence, it is appropriate to ask whether a defendant exercised sufficient control over each and every step.<sup>364</sup> Whereas in a system claim, vicarious liability requires *control over the system as a whole*; thus, the Court held that NCR’s mere control over one element of the system failed to show sufficient control over “the entire claimed system.”<sup>365</sup>

## International Trade Commission

*Lashify, Inc. v. International Trade Commission*, 130 F.4th 948 (Fed. Cir. Mar. 5, 2025)

In this appeal from the International Trade Commission, the Federal Circuit vacated the Commission’s finding that Section 337 of the Tariff Act had not been violated because the economic prong of the “domestic industry” requirement failed.<sup>366</sup> In so holding, the court clarified that the “employment of labor or capital” required by Section 337 includes sales, marketing, warehousing, distribution, and quality control expenses, not just expenses related to domestic manufacture.<sup>367</sup>

The Commission had found that Lashify failed the economic-prong requirement—in particular, with respect to subsection (b), which requires “significant employment of labor or capital”—because, on its view, Lashify’s sales, marketing, warehousing, quality control, and distribution expenditures were not cognizable expenditures under the economic prong of the test.<sup>368</sup> The Commission held that domestic manufacturing activities may be required to satisfy the economic prong.<sup>369</sup>

On appeal, the Federal Circuit emphasized that the statute’s use of “labor” and “capital” did not include *any* “limitation on the use within an enterprise to which those items are put.”<sup>370</sup> Thus, the Commission’s distinction between domestic manufacturing and other domestic business functions (like marketing) was “not found” in the text of the statute itself, and thus, the Commission’s approach was held “counter to the statutory text.”<sup>371</sup> Finally, the Federal Circuit addressed and rejected the Commission’s legislative history arguments.<sup>372</sup>

Having found that Lashify’s expenditures qualified under the economic prong, the court remanded to the Commission to “count Lashify’s employment of labor and capital

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<sup>363</sup> *Id.*

<sup>364</sup> *Id.*

<sup>365</sup> *Id.* at 1341-42.

<sup>366</sup> *Lashify, Inc. v. International Trade Commission*, 130 F.4th 948, 951 (Fed. Cir. 2025).

<sup>367</sup> *Id.* at 963.

<sup>368</sup> *Id.* at 956, 958.

<sup>369</sup> *Id.* at 958.

<sup>370</sup> *Id.* at 958.

<sup>371</sup> *Id.* at 959-60.

<sup>372</sup> *Id.* at 960.

even when they are used in sales, marketing, warehousing, quality control, or distribution” and then determine whether these “qualifying expenses are significant or substantial based on” a holistic review of all relevant considerations.<sup>373</sup>

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<sup>373</sup> *Id.*

## DEFENSES

### Equitable Estoppel

*Fraunhofer-Gesellschaft v. Sirius XM Radio Inc.*, 138 F.4th 1373 (Fed. Cir. June 9, 2025)

In this appeal from the District of Delaware, the Federal Circuit reversed a summary judgment order for the defendant granted on the basis of equitable estoppel, finding that genuine issues of material fact remained on the second and third requirements of this equitable defense.<sup>374</sup>

Fraunhofer sued Sirius XM (SXM) in 2015, claiming SXM was infringing Fraunhofer’s patents related to satellite radio systems by continuing to use them after its original license was terminated in 2010.<sup>375</sup> The Federal Circuit first affirmed the district court’s conclusion that there was no genuine dispute as to the first prong.<sup>376</sup> Fraunhofer’s five-year silence before asserting infringement—despite its clear knowledge of that infringement—“rose to the level of misleading conduct.”<sup>377</sup>

On the second prong, SXM claimed it relied on Fraunhofer’s silence, which lulled the company into investing in the infringing high-band system rather than an alternative non-infringing low-band system.<sup>378</sup> But the Federal Circuit held this was insufficient to establish for purposes of summary judgment that SXM had made these decisions “in reliance on Fraunhofer’s silence,” rather than basing them on other business factors.<sup>379</sup> And SXM’s claims that it would have taken steps to limit liability were similarly insufficient to warrant summary judgment.<sup>380</sup> As a result, the court held that SXM could not prevail on the third prong, because the lack of reliance meant SXM could not establish a lack of genuine dispute over prejudice caused by said reliance.<sup>381</sup>

The court declined Fraunhofer’s request to grant summary judgment in its favor, instead remanding the case for further determinations on the issue.<sup>382</sup>

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<sup>374</sup> *Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V. v. Sirius XM Radio Inc.*, 138 F.4th 1373, 1375 (Fed. Cir. 2025).

<sup>375</sup> *Id.* at 1376-77.

<sup>376</sup> *Id.* at 1379-80.

<sup>377</sup> *Id.*

<sup>378</sup> *Id.* at 1380.

<sup>379</sup> *Id.* at 1380-81.

<sup>380</sup> *Id.* at 1381.

<sup>381</sup> *Id.* at 1382.

<sup>382</sup> *Id.* at 1383.

## Prosecution Laches

*Google LLC v. Sonos, Inc.*, 2024-1097, 2025 WL 2473258 (Fed. Cir. Aug. 28, 2025)

In this appeal from the District Court for the Northern District of California, the Federal Circuit reversed the lower court’s judgment that several patents were unenforceable against Google based on the equitable defense of prosecution laches.<sup>383</sup>

Google sued Sonos for a declaratory judgment of non-infringement of two sets of patents related to playing media via pre-defined groups of speakers, arguing that Sonos’s claims were invalid.<sup>384</sup> Sonos prevailed at the ensuing jury trial, but the district court in a post-trial decision held that Google succeeded in its affirmative defense of prosecution laches.<sup>385</sup> The district court found “that Sonos ‘was guilty of unreasonable and inexcusable delay in its prosecution of’” one set of patents “because Sonos filed the provisional application from which those patents claim priority in September 2006, but did not seek to claim overlapping zone scenes until thirteen years later, in April 2019.”<sup>386</sup> Since Google had begun “investing in the accused product by at least 2015,” the district court held the patents “unenforceable against Google.”<sup>387</sup>

On appeal, the Federal Circuit held that the publication in 2013 of Sonos’s 2007 nonprovisional application barred a finding of prejudice against Google.<sup>388</sup> The court concluded that “no reasonable factfinder could conclude that the specification—which was published in 2013, before any of Google’s asserted investments—does not reasonably disclose overlapping zone scenes.”<sup>389</sup> Moreover, Google had presented no evidence substantiating its claim that it began investing in the infringing products in 2015, and thus could not meet its burden to show “that it suffered prejudice attributable to Sonos’s delay in claiming, but not disclosing, overlapping zone scenes.”<sup>390</sup>

The practical effect of this decision is to render prosecution laches a nullity as a litigation defense except in the extremely rare cases where applicants keep their applications secret, since it will be virtually impossible to show prejudice in any case in which an application has been published, even if patents don’t issue for more than a decade after publication.

*Hyatt v. Stewart*, 148 F.4th 1376 (Fed. Cir. Aug. 29, 2025)

In this appeal from the District Court for the District of Columbia, the Federal Circuit affirmed a bench trial judgment for the PTO on prosecution laches.<sup>391</sup>

Hyatt initiated the four underlying actions in 2004 and 2008, appealing the rejection of patent applications filed in 1995 in the months leading up to the effective date

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<sup>383</sup> *Google LLC v. Sonos, Inc.*, 2024-1097, 2025 WL 2473258, at \*6-7.

<sup>384</sup> *Id.* at \*1-2.

<sup>385</sup> *Id.* at \*3.

<sup>386</sup> *Id.*

<sup>387</sup> *Id.*

<sup>388</sup> *Id.* at \*7.

<sup>389</sup> *Id.*

<sup>390</sup> *Id.* at \*6-7.

<sup>391</sup> *Hyatt v. Stewart*, 148 F.4th 1376, 1379 (Fed. Cir. 2025).

for obligations undertaken under the General Agreement on Tariffs and Trade (GATT).<sup>392</sup> The district court initially rejected the PTO's defenses of prosecution laches and invalidity, but the Federal Circuit in 2021 (*Hyatt I*) vacated those judgments, "concluding that the court had misapplied the standard for prosecution laches and that under the correct legal standard, the PTO satisfied its burden of showing that Mr. Hyatt engaged in unreasonable and unexplainable delay in prosecuting his applications at issue."<sup>393</sup> The panel remanded the case "to allow Hyatt to present evidence on whether the delay was prejudicial."<sup>394</sup> On remand, the district court concluded that the delay was prejudicial, and "[n]o other result is even colorable."<sup>395</sup>

On appeal, Hyatt argued first that "the defense of prosecution laches is unavailable in a § 145 action," based on the Patent Act of 1952 and recent Supreme Court cases.<sup>396</sup> Alternatively, he argued the defense should at least not be available in "the narrow circumstances presented here, a § 145 action involving transitional applications."<sup>397</sup> The court rejected these arguments as "foreclosed by the law-of-the-case doctrine," since the court had "already considered and rejected these same arguments in *Hyatt I*."<sup>398</sup>

Hyatt next argued that the district court "abused its discretion in ruling in the PTO's favor on prosecution laches."<sup>399</sup> Specifically, he claimed that "his prosecution conduct from 1992 to 2002 was justified by a 1992 decision from the Board on one of his applications" and he "had no reason to change the manner in which he prosecuted his applications until" the Federal Circuit decided "that prosecution laches was an available defense in district court infringement actions" in 2002.<sup>400</sup> The Federal Circuit rejected this argument as forfeited, since Hyatt did not raise it at the district court. The panel also cited the district court's exhaustive fact finding—which Hyatt did not contest—in holding that there was no abuse of discretion.<sup>401</sup>

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<sup>392</sup> *Id.* at 1379-80.

<sup>393</sup> *Id.* at 1380.

<sup>394</sup> *Id.*

<sup>395</sup> *Id.* at 1381.

<sup>396</sup> *Id.* at 1381-82.

<sup>397</sup> *Id.* at 1382.

<sup>398</sup> *Id.*

<sup>399</sup> *Id.*

<sup>400</sup> *Id.* at 1382-83.

<sup>401</sup> *Id.* at 1383.

## REMEDIES

### Attorney's Fees

*EscapeX IP, LLC v. Google LLC*, --- F.4th ----, 2024-1201, 2025 WL 3274847 (Fed. Cir. Nov. 25, 2025)

In this appeal from the District Court for the Northern District of California, the Federal Circuit affirmed the district court's grant of attorney's fees and costs to the alleged infringer.<sup>402</sup>

EscapeX sued Google for infringing its '113 patent directed to a method for "Generating Artist-Specified Dynamic Albums."<sup>403</sup> EscapeX initially identified YouTube Music as the infringing product but amended its complaint to identify "YouTube Video with Auto-Add" after Google pointed out that the former product did not include the claimed features.<sup>404</sup> Google then explained that the latter product predated the priority date of the asserted patent, and requested "that EscapeX voluntarily dismiss the lawsuit."<sup>405</sup> After a separate case in the Southern District of New York found that the '113 patent was directed to unpatentable subject matter, EscapeX erroneously filed a "joint stipulation of dismissal" to which Google had not agreed, in which each party would bear its own fees and costs.<sup>406</sup> After an amended stipulation was filed, the district court granted Google's motion for attorney's fees based on its argument that "EscapeX had advanced frivolous claims and unreasonably prolonged the litigation."<sup>407</sup> EscapeX filed a Rule 59(e) motion to amend the judgment based on new evidence—two short declarations by its employees showing its "meticulous steps" prior to filing suit—but the district court rejected the motion and granted Google additional attorney's fees for the costs of the "frivolous" motion.<sup>408</sup>

Applying its own case law, the Federal Circuit reviewed the award of fees for abuse of discretion.<sup>409</sup> The court rejected EscapeX's argument that the district court's short period of presiding over the case called for a less deferential standard.<sup>410</sup> On the merits, the court found no abuse of discretion in the district court's finding that the case was "exceptional."<sup>411</sup> The panel found no issue with the district court's finding that "it was 'obvious that EscapeX conducted no serious pre-suit investigation and that this case

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<sup>402</sup> *EscapeX IP, LLC v. Google LLC*, 2024-1201, 2025 WL 3274847, at \*1 (Fed. Cir. Nov. 25, 2025).

<sup>403</sup> *Id.*

<sup>404</sup> *Id.*

<sup>405</sup> *Id.*

<sup>406</sup> *Id.*

<sup>407</sup> *Id.* at \*2.

<sup>408</sup> *Id.*

<sup>409</sup> *Id.* at \*3.

<sup>410</sup> *Id.*

<sup>411</sup> *Id.* at \*3-4.

was frivolous from the start.”<sup>412</sup> EscapeX argued that its claims were not frivolous because “Google’s accused ‘Auto Add’ feature did not include an ‘artist specific application’ until after the priority date of the ‘113 patent,” but the court found this argument was waived because EscapeX did not raise it at the district court and its “claim charts make no allegations about ‘artist specific application’ as part of its ‘Auto Add’ allegations.”<sup>413</sup> Next, EscapeX argued the district court put improper weight on “correspondence between the parties, and EscapeX’s general non-responsiveness to Google’s efforts to meet and confer.”<sup>414</sup> But the court countered that such communications are relevant “when they show that ‘the lawsuit appears to have been baseless.’”<sup>415</sup> Finally, the court rejected EscapeX’s suggestion “that the district court acted to punish it for being a non-practicing entity” because the record showed “no evidence of such animus.”<sup>416</sup>

The Federal Circuit also affirmed the district court’s denial of the “frivolous” Rule 59(e) motion and related award of additional attorney’s fees, for which EscapeX and its attorneys were jointly and severally liable.<sup>417</sup> The panel reiterated that the attorneys “acted recklessly by filing a frivolous Rule 59(e) motion that unreasonably multiplied the proceedings of this case,” and pointed out that they “could have avoided sanction by simply not filing such a motion, which would not by any means have constituted abandonment of their client.”<sup>418</sup>

*Future Link Systems, LLC v. Realtek Semiconductor Corp.*, 154 F.4th 1370 (Fed. Cir. Sept. 9, 2025)

In this appeal from the District Court for the Western District of Texas, the Federal Circuit reversed the denial of attorney’s fees under 35 U.S.C. § 285 and costs under Federal Rule of Civil Procedure 54(d)(1).<sup>419</sup>

Future Link initiated two patent infringement suits against Realtek for infringement of its patents related to electronic circuitry in 2021.<sup>420</sup> However, in March 2022, Future Link produced a 2019 licensing agreement it had entered earlier with a third company, MediaTek, promising to provide Future Link with lump sum if Future Link filed a lawsuit against Realtek.<sup>421</sup> Future Link entered a new licensing agreement with Realtek covering the accused products and voluntarily dismissed both cases without prejudice.<sup>422</sup> Realtek then requested attorney’s fees and costs in both cases, which it

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<sup>412</sup> *Id.* at \*4.

<sup>413</sup> *Id.*

<sup>414</sup> *Id.* at \*5.

<sup>415</sup> *Id.* (citation omitted).

<sup>416</sup> *Id.*

<sup>417</sup> *Id.* at \*6.

<sup>418</sup> *Id.* at \*6-7.

<sup>419</sup> *Future Link Systems, LLC v. Realtek Semiconductor Corp.*, 154 F.4th 1370, 1373 (Fed. Cir. 2025).

<sup>420</sup> *Id.* at 1374.

<sup>421</sup> *Id.*

<sup>422</sup> *Id.*

asserted were “objectively baseless suits.”<sup>423</sup> The district court denied Realtek’s motions for fees and costs, but granted its motions to modify both cases to be dismissed with prejudice.<sup>424</sup>

On appeal, the Federal Circuit vacated the judgment, holding that Realtek was a “prevailing party” under § 285 and Rule 54(d)(1).<sup>425</sup> The court agreed with Realtek that the district court “sanctioned Future Link by converting its voluntary dismissal into a dismissal with prejudice,” thus materially altering the legal relationship of the parties.<sup>426</sup> The court explained its precedents holding that a dismissal with prejudice “is tantamount to a judgment on the merits” for because it precludes future lawsuits based on the same claims.<sup>427</sup> The court thus vacated the district court’s decision on § 285 and remanded it for consideration of “whether this case is exceptional and whether fees are appropriate.”<sup>428</sup> The court also held that the district court abused its discretion by failing to address at all whether Realtek was entitled to costs under Rule 54, remanding “for the district court to address Rule 54 costs and explain its decision.”<sup>429</sup>

## Sanctions

*PS Products Inc. v. Panther Trading Co. Inc.*, 122 F.4th 893 (Fed. Cir. December 15, 2024)

In this appeal from the Eastern District of Arkansas, the Federal Circuit affirmed the district court’s award of sanctions to Panther both under 35 U.S.C. § 285 and the court’s inherent powers.<sup>430</sup> After finding that PS Products’ infringement allegations were frivolous, the district court deemed the case “exceptional” under § 285, and further ordered inherent sanctions to “deter” future misconduct.<sup>431</sup>

Applying Eighth Circuit law, the Federal Circuit affirmed the award of deterrence sanctions. First, rejecting PS Products’ argument to the contrary, the court noted that it was “well-settled” that § 285 sanctions do not preclude the issuance of deterrence sanctions under the court’s inherent authority.<sup>432</sup> And the court found that there was sufficient evidence of bad faith to justify deterrence sanctions.<sup>433</sup> The Federal Circuit first observed that PS Products’ claim was utterly baseless—so much so that it could be characterized as a “nuisance suit”—and procedurally flawed since venue was not proper in the Eastern District of Arkansas.<sup>434</sup> And because PS Products had filed dozens of

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<sup>423</sup> *Id.*

<sup>424</sup> *Id.*

<sup>425</sup> *Id.* at 1375.

<sup>426</sup> *Id.* at 1375-76.

<sup>427</sup> *Id.* at 1376-77 (quoting *Raniere v. Microsoft Corp.*, 887 F.3d 1298, 1303 (Fed. Cir. 2018)).

<sup>428</sup> *Id.* at 1377.

<sup>429</sup> *Id.*

<sup>430</sup> *PS Products Inc. v. Panther Trading Co. Inc.*, 122 F.4th 893 (Fed. Cir. 2024).

<sup>431</sup> *Id.* at 897.

<sup>432</sup> *Id.* at 898.

<sup>433</sup> *Id.*

<sup>434</sup> *Id.* at 899.

similarly flawed lawsuits, the Federal Circuit found that the district court's issuance of sanctions was not an abuse of discretion.<sup>435</sup>

## Damages

*Rex Medical, L.P. v. Intuitive Surgical, Inc.*, 156 F.4th 1289 (Fed. Cir. Oct. 2, 2025)

In this appeal from District Court for the District of Delaware, the Federal Circuit affirmed the district court's exclusion of Rex's expert testimony on damages for failure to apportion and reduction of the jury's damages award "from \$10 million to \$1 nominal damages."<sup>436</sup>

At trial, the jury determined that Intuitive had infringed Rex's '650 patent "directed to systems for stapling tissue during surgery."<sup>437</sup> The parties had earlier agreed to drop the related '892 patent from the litigation.<sup>438</sup> However, days before the trial, the district court granted in part Intuitive's motion to exclude certain testimony from Mr. Kidder, Rex's damages expert.<sup>439</sup> Kidder claimed that a hypothetical license negotiation "would have resulted in a lump sum payment of \$20 million," based on comparisons to a litigation settlement agreement between Rex and Covidien that granted the latter access to a wide array of Rex's patents.<sup>440</sup> The district court held that Kidder's estimate was based on unreliable methods because he had failed to determine the extent to which those other patents affected the value of the license agreement with Covidien.<sup>441</sup> As a result, neither party had a damages expert testify at trial.<sup>442</sup> After trial, Intuitive filed for JMOL on several issues; on damages, the district court agreed that "Rex failed to prove its damages and thus reduced the damages award to nominal damages of \$1 and denied a new damages trial."<sup>443</sup>

On appeal, the Federal Circuit affirmed the decision to exclude Kidder's testimony. Citing several earlier decisions, the court explained that expert testimony using patent license agreements for portfolios as a basis for comparison must "allocate license fees among the licensed patents covered by an agreement."<sup>444</sup> Kidder opined that "nearly all the value of the Covidien license derives from either" the '650 or the '892 patent.<sup>445</sup> But the court rejected this opinion as "untethered to the facts of this case," because Kidder did not apportion between the '650 and '892 patents in the Covidien settlement, let alone the remaining portfolio of US and foreign patents.<sup>446</sup>

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<sup>435</sup> *Id.* at 900-901.

<sup>436</sup> *Rex Medical, L.P. v. Intuitive Surgical, Inc.*, 156 F.4th 1289, 1293 (Fed. Cir. 2025).

<sup>437</sup> *Id.*

<sup>438</sup> *Id.*

<sup>439</sup> *Id.* at 1295.

<sup>440</sup> *Id.*

<sup>441</sup> *Id.*

<sup>442</sup> *Id.*

<sup>443</sup> *Id.* at 1296.

<sup>444</sup> *Id.* at 1296-97 (quoting *Jiaxing Super Lighting Elec. Appliance, Co. v. CH Lighting Tech. Co.*, 146 F.4th 1098, 1112 (Fed. Cir. 2025)).

<sup>445</sup> *Id.* at 1297.

<sup>446</sup> *Id.* at 1297-98.

On the reduction of damages, the Federal Circuit agreed with Rex that the district court’s action constituted “a grant of JMOL of no damages, not a remittitur.”<sup>447</sup> Nevertheless, the Federal Circuit affirmed the district court’s ruling because “the jury received insufficient evidence from which it could apportion the lump sum payment in the Covidien license or otherwise reasonably infer a reasonable royalty award for the ‘650 patent alone.”<sup>448</sup> The court underscored that the patent damages statute does not require awarding damages if they are not proved.<sup>449</sup> But the court cautioned that the outcome here was “fact-specific,” and “JMOL of no damages would be inappropriate” if Rex had “put forth other evidence from which a jury could reasonably determine damages for infringement of the ‘650 patent.”<sup>450</sup>

*EcoFactor, Inc. v. Google LLC*, 137 F.4th 1333 (Fed. Cir. May 21, 2025) (en banc)

In this en banc review of an appeal from the Western District of Texas, the Federal Circuit held that the trial court had abused its discretion and prejudicially erred by failing to exclude as unreliable the patentee’s expert testimony on damages.<sup>451</sup> EcoFactor docketed a petition for certiorari to the Supreme Court on September 18, 2025.<sup>452</sup>

The court emphasized district courts’ gatekeeping function under *Daubert* and Federal Rule of Evidence 702. In particular, the court highlighted the advisory’s committee’s notes on the 2023 amendments to Rule 702, which explained that many courts had misinterpreted this rule by treating “the sufficiency of an expert’s basis, and the application of the expert’s methodology” as “questions of weight and not admissibility.”<sup>453</sup> In that light, the court concluded that patentee’s expert report should have been excluded as unreliable because it lacked sufficient basis. Patentee’s expert, Mr. Kennedy, asserted “with the imprimatur of his expertise” that past lump-sum royalty payments reflected a per-unit, running-royalty rate, based on which the jury could calculate damages.<sup>454</sup> But the court pointed out that lump-sum and running-royalty licenses are not necessarily equivalent, explaining that the analysis of each “involves significantly different considerations, from the perspective of both the licensee and the licensor.”<sup>455</sup>

Looking at EcoFactor’s evidence, the court concluded that the licenses Mr. Kennedy cited “were insufficient, individually or in combination, to support his conclusion that prior licensees agreed to the \$X royalty rate” when they agreed to lump-sum payment amounts.<sup>456</sup> The court characterized EcoFactor’s “preliminary recitals” in each contract—stating EcoFactor’s belief that the agreed payment reflected a

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<sup>447</sup> *Id.* at 1298.

<sup>448</sup> *Id.*

<sup>449</sup> *Id.* at 1298-1300.

<sup>450</sup> *Id.* at 1301.

<sup>451</sup> *EcoFactor, Inc. v. Google LLC*, 137 F.4th 1333, 1336-37 (Fed. Cir. 2025) (en banc).

<sup>452</sup> *EcoFactor, Inc. v. Google, LLC*, No. 25-341 (2025).

<sup>453</sup> *EcoFactor*, 137 F.4th at 1339.

<sup>454</sup> *Id.* at 1340-41.

<sup>455</sup> *Id.* at 1341.

<sup>456</sup> *Id.* at 1341-42.

per-unit royalty—as merely unilateral statements of belief.<sup>457</sup> None of the contracts repeated this language in operative payment provisions, and two of the contracts explicitly stated that the lump sum did not reflect a royalty.<sup>458</sup> These licenses could be relevant to show what EcoFactor would have accepted as a willing licensor, but they could not support Mr. Kennedy’s claims about what a willing licensee would pay.<sup>459</sup> Since EcoFactor lacked other reliable evidence to support Mr. Kennedy’s testimony or his asserted royalty rate, the court’s decision to admit his testimony was prejudicial, and the Federal Circuit remanded the case for a new trial on damages.<sup>460</sup>

Judge Reyna dissented from the majority’s substantive holdings, arguing that the court improperly decided issues of contract interpretation that were outside the scope of the appeal, overstepped its appellate role by weighing the credibility of evidence, and failed to conduct harmless error analysis.<sup>461</sup> Judge Reyna argued that Mr. Kennedy’s testimony was supported by sufficient evidence, such that—even if the court interpreted the contracts correctly—there were “sufficient facts or data to support [his] testimony that \$X is a reasonable royalty rate.”<sup>462</sup>

Similarly, Judge Stark dissented in part.<sup>463</sup> Although he read the majority’s holdings on Rule 702 and *Daubert* “as so narrow as to have almost no applicability beyond this case,” Judge Stark expressed concern that the holding “will be misinterpreted as constraining damages experts in a manner not called for by either Rule 702 or *Daubert*.”<sup>464</sup> Judge Stark would have affirmed the district court, and further argued that the majority should have, if anything, vacated the judgment and remanded for more explanation rather than ordering a new trial.<sup>465</sup>

*Optis Cellular Tech., LLC v. Apple Inc., 139 F.4th 1363 (Fed. Cir. June 16, 2025)*

In this appeal from the Eastern District of Texas, the Federal Circuit vacated and remanded findings of patent infringement and resulting damages because the verdict forms and associated jury instructions constituted an abuse of discretion.<sup>466</sup>

Optis alleged that several Apple devices infringed upon one or more of its five standard essential patents covering technology essential to the cellular “Long-Term Evolution” (LTE) standard.<sup>467</sup> The district court’s verdict form instructed the jury to decide whether Apple had infringed “any of the asserted claims,” without distinguishing among the five separate patents.<sup>468</sup> The Federal Circuit concluded this was an abuse of discretion that violated Apple’s right to a unanimous verdict on each claim—each of

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<sup>457</sup> *Id.*

<sup>458</sup> *Id.* at 1341-43.

<sup>459</sup> *Id.* at 1343.

<sup>460</sup> *Id.* at 1346-47.

<sup>461</sup> *Id.* at 1348 (Reyna, J., concurring in part and dissenting in part).

<sup>462</sup> *Id.* at 1351 (Reyna, J., concurring in part and dissenting in part).

<sup>463</sup> *Id.* at 1354 (Stark, J., concurring in part and dissenting part).

<sup>464</sup> *Id.*

<sup>465</sup> *Id.*

<sup>466</sup> *Optis Cellular Tech., LLC v. Apple Inc., 139 F.4th 1363, 1368 (Fed. Cir. 2025).*

<sup>467</sup> *Id.* at 1368-69.

<sup>468</sup> *Id.* at 1374-75.

which represented a distinct cause of action.<sup>469</sup> Jury instructions to reach “unanimous determinations” did not remedy the issue, because nothing in the instructions for the first question indicated that “all jurors had to unanimously agree that the *same* patent was infringed.”<sup>470</sup> Having vacated the infringement judgment, the Federal Circuit similarly vacated the damages retrial judgment, since the lack of individualized findings on the patents meant that Optis had “been awarded damages for a scope of infringement that it has not proven and that the jury had not unanimously found.”<sup>471</sup> The Federal Circuit also instructed the district court to reconsider the validity of several of the patents on grounds of patentable subject matter and definiteness.<sup>472</sup>

*Wash World Inc. v. Belanger Inc.*, 131 F.4th 1360 (Fed. Cir. Mar. 24, 2025)

In this appeal from the Eastern District of Wisconsin, the Federal Circuit reversed the jury’s conveyed damages award and remanded with instructions to remit damages.<sup>473</sup>

First, the Federal Circuit held that Wash World had not forfeited its remittitur argument, finding that Wash World had pressed the argument in *Daubert* briefing, as well as its post-trial briefing.<sup>474</sup> And the Federal Circuit noted that, even had Wash World forfeited the issue, the case presented “exceptional circumstances” that would have compelled the court to reach the merits in any event.<sup>475</sup>

Turning to the merits, the Federal Circuit held that the jury’s conveyed damages award was not supported by the record.<sup>476</sup> While Belanger submitted evidence showing that many of Belanger’s customers bought auxiliary products (like a car wash dryer), the court held that was insufficient as a matter of law.<sup>477</sup> “That these additional components were sold as a ‘package’ with the patented car wash system does not demonstrate the requisite functional relationship necessary to establish Belanger’s entitlement to the additional lost profits.”<sup>478</sup> And, even though the jury returned a general verdict that did not explicitly credit the expert’s damages estimates, the Federal Circuit held that the damages award was unsupported by other evidence, since the jury was not presented with any evidence other than the expert’s erroneous conveyed damages estimates, and it was unlikely that the jury “coincidentally reach[ed] the same figure as [the expert] did by some alternative, independent calculation.”<sup>479</sup> Finally, Belanger was estopped from disputing that the jury relied on the expert’s erroneous testimony, since Belanger had repeatedly represented to the district court that the jury relied on the expert.<sup>480</sup>

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<sup>469</sup> *Id.* at 1374-76.

<sup>470</sup> *Id.* at 1376.

<sup>471</sup> *Id.* at 1377.

<sup>472</sup> *Id.* at 1378, 1382.

<sup>473</sup> *Wash World Inc. v. Belanger Inc.*, 131 F.4th 1360, 1372 (Fed. Cir. 2025).

<sup>474</sup> *Id.* at 1372-74.

<sup>475</sup> *Id.* at 1374.

<sup>476</sup> *Id.* at 1375.

<sup>477</sup> *Id.* at 1375-76.

<sup>478</sup> *Id.* at 1376.

<sup>479</sup> *Id.*

<sup>480</sup> *Id.*

## PRACTICE AND PROCEDURE

### Discovery

*Magema Tech. LLC v. Phillips* 66, 153 F.4th 1248 (Fed. Cir. Sept. 8, 2025)

In this appeal from the District Court for the Southern District of Texas, the Federal Circuit ordered a new trial because it could not “discern the basis for the jury’s noninfringement verdict” and because defendant Phillips introduced an improper and prejudicial noninfringement theory that may have infected that verdict.<sup>481</sup>

Magēmā sued Phillips for infringement of its ‘884 patent explaining a two-step method of desulfurizing heavy marine fuel oil (HMFO) to comply with two sets of international standards.<sup>482</sup> During discovery, Magēmā sought specific sampling and testing information about the flashpoint of Phillips’s HMFO at a specific point in the process; finding that it was above 140 degrees would demonstrate that it fell within the ‘884 patent’s limitations, supporting infringement.<sup>483</sup> Phillips objected, and the magistrate judge ultimately agreed, that such sampling was too dangerous and unnecessary, because Magēmā could instead mathematically estimate the flashpoint.<sup>484</sup> In the lead-up to trial, however, it became clear that the testing was neither dangerous nor unnecessary.<sup>485</sup> Phillips constructed a new sampling station and sought to supplement the summary judgment record with the relevant samples after the close of discovery.<sup>486</sup> And shortly before jury selection, Magēmā learned that Phillips planned to argue that only actual samples, not mathematical estimates, could establish infringement.<sup>487</sup> The court excluded the new samples, but allowed Phillips to make its new noninfringement argument to the jury over Magema’s objections.<sup>488</sup> The jury found noninfringement based on general verdict forms that did not ask to specify the basis of the finding or ask specific questions about the individual claim limitations.<sup>489</sup> The court denied Magema’s motion for a new trial, determining that Phillips’ “actual-testing theory” was improper and prejudicial but nonetheless constituted only harmless error.<sup>490</sup>

The Federal Circuit reversed. Noting that “Phillips sandbagged Magema right before trial with a bait-and-switch,” the court agreed with the district court that Phillips’ actual-testing theory “should never have been argued to the jury.” The court explained that, “when a case is submitted to a jury on a general verdict, the failure of evidence or a legal mistake under one theory of the case generally requires reversal for a new trial is generally required,” since the court cannot know the basis of the jury’s decision.<sup>491</sup> Given

<sup>481</sup> *Magema Tech. LLC v. Phillips* 66, 153 F.4th 1248, 1251 (Fed. Cir. 2025).

<sup>482</sup> *Id.* at 1251-52.

<sup>483</sup> *Id.* at 1253.

<sup>484</sup> *Id.* at 1253-4.

<sup>485</sup> *Id.* at 1253-54.

<sup>486</sup> *Id.* at 1254.

<sup>487</sup> *Id.* at 1254-55.

<sup>488</sup> *Id.*

<sup>489</sup> *Id.* at 1256.

<sup>490</sup> *Id.*

<sup>491</sup> *Id.* at 1258 (quoting *Muth v. Ford Motor Co.*, 461 F.3d 557, 564 (5th Cir. 2006)).

the general verdict forms and the pervasiveness of Phillips’ actual-testing arguments, the court had “little confidence that these arguments did not affect the outcome of the trial.”<sup>492</sup> The court therefore reversed and ordered a new trial.<sup>493</sup>

## Pleading

*Nexus Pharms., Inc. v. Exela Pharma Sciences, LLC, No. 22-1233-GBW, 2025 WL 2972277 (D. Del. Oct. 21, 2025)*

Resolving post-trial motions after a jury verdict finding no patent infringement, the court held that “claims that Nexus dismissed prior to trial are dismissed with prejudice.”<sup>494</sup>

Nexus asserted 34 claims—encompassing every claim of three asserted patents—in a patent infringement lawsuit against Exela.<sup>495</sup> The parties recognized claim narrowing would be required, and after the court resolved their motions for summary judgment, Nexus agreed to narrow the lawsuit to just seven claims across the three patents.<sup>496</sup> The parties disputed the extent to which Exela should have to narrow its defenses, and asked the court to rule on the issue.<sup>497</sup> The court ordered Nexus to narrow to seven asserted claims and similarly limited the number of obvious combinations and prior art references Exela could introduce.<sup>498</sup>

The court recognized that courts in the district were “divided as to whether Court-ordered claim narrowing should result in dismissal with prejudice or without prejudice.”<sup>499</sup> The court adopted the former position for three reasons. First, the court contrasted the “even-handed and fair” narrowing with the unfairness of allowing plaintiffs to “bring more lawsuits based on the claims they dropped.”<sup>500</sup> The court pointed out that the latter would be unfair unless defendants can also “resurrect the defenses they dropped at roughly the same time.”<sup>501</sup> Second, the court explained that “trial should function to provide certainty to the parties with respect to disputed claims and issues,” and allowing parties to revive dropped arguments would undermine certainty.<sup>502</sup> Third, building on the earlier points, the court argued that allowing the parties to bring back dropped claims would undermine judicial economy, allowing parties “to engage in essentially endless litigation.”<sup>503</sup> As such, the court held that both “the claims that Nexus

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<sup>492</sup> *Id.* at 1259.

<sup>493</sup> *Id.* at 1260.

<sup>494</sup> *Nexus Pharms., Inc. v. Exela Pharma Sciences, LLC, No. 22-1233-GBW, 2025 WL 2972277 at \*1-2 (D. Del. Oct. 21, 2025).*

<sup>495</sup> *Id.* at \*1.

<sup>496</sup> *Id.*

<sup>497</sup> *Id.*

<sup>498</sup> *Id.*

<sup>499</sup> *Id.* at \*2.

<sup>500</sup> *Id.* at \*3-4.

<sup>501</sup> *Id.* at \*3.

<sup>502</sup> *Id.*

<sup>503</sup> *Id.* (quoting *Bial-Portela & Ca. S.A. v. Alkeem Lab’ys Ltd., No. CV 18-304-CFC-CJB, 2022 WL 13944612, at \*2 (D.Del. Oct 24, 2022)*).

dismissed prior to trial and the defenses and counterclaims that [Exela] dismissed prior to trial were dismissed with prejudice.”<sup>504</sup>

*Inari Med., Inc. v. Inquis Med., Inc., No. 24-1023-CFC, 2025 WL 2912857 (D. Del. Oct. 14, 2025)*

In this opinion addressing Inquis’s motion to dismiss Inari’s claims, including patent infringement, the District Court for the District of Delaware denied the motion in part and clarified two points about the pleading standards for seeking enhanced damages under 35 U.S.C. § 284.<sup>505</sup>

The court first held that the complaint filed in a lawsuit cannot “provide the required knowledge for claims asserted in the lawsuit of post-suit direct infringement and demands for willfulness-based enhanced damages.”<sup>506</sup> Acknowledging a split among district courts on this issue, Chief Judge Connolly explained two reasons for this holding. First, allowing parties to use court dockets as “notice boards for future legal claims for indirect infringement and enhanced damages” violated principles of judicial economy.<sup>507</sup> Judge Connolly argued parties should instead send pre-suit notice letters, which may resolve the conflict without a lawsuit and thus provide “a benefit to society.”<sup>508</sup> Second, the court cited the policies governing patent damages, explaining that enhanced damages exist “to punish and deter bad actors from egregious conduct,” rather than to enable “opportunistic plaintiffs to spring suits for patent infringement on innocent actors who have no knowledge of the existence of the asserted patents.”<sup>509</sup> The court pointed out that plaintiffs could always file a new lawsuit in the future “based on defendant’s awareness of the previous lawsuit” and that such lawsuit would move more quickly based on the results of the first suit.<sup>510</sup> And the court downplayed the potential unfairness of enabling defendants to file preemptive declaratory lawsuits in their chosen venue, saying this consequence was not “unfair or unwise.”<sup>511</sup>

The court also held that demands for enhanced damages under § 284 are not “claims” and thus courts lack authority to “dismiss, or otherwise preclude a plaintiff from seeking,” such damages at the motion to dismiss stage.<sup>512</sup> Judge Connolly explained that “neither a demand for enhanced damages under § 284 nor an accusation of willful infringement is a claim for relief subject to dismissal under Rule 12(b)(6),” even though parties often refer to accusations of willful infringement as “claims.”<sup>513</sup>

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<sup>504</sup> *Id.* at \*4.

<sup>505</sup> *Inari Med., Inc. v. Inquis Med., Inc., No. 24-1023-CFC, 2025 WL 2912857, at \*1 (D. Del. Oct 14, 2025).*

<sup>506</sup> *Id.*

<sup>507</sup> *Id.*

<sup>508</sup> *Id.*

<sup>509</sup> *Id.* at \*2.

<sup>510</sup> *Id.* at \*2-3.

<sup>511</sup> *Id.* at \*3.

<sup>512</sup> *Id.* at \*3-4.

<sup>513</sup> *Id.* at \*4.

*Focus Products Group Int’l, LLC v. Kartri Sales Co., Inc.*, 156 F.4th 1259 (Fed. Cir. Sept. 30, 2025)

In this appeal from the District Court for the Southern District of New York, the Federal Circuit vacated many of the court’s findings of infringement but also held that co-appellants each waived several arguments and thus only vacated some of the findings for one party or the other.<sup>514</sup>

Focus sued both Kartri Sales and Marquis Mills, claiming the defendants infringed its trade dress, two trademarks, and three patents related to hookless shower curtains.<sup>515</sup> The court granted summary judgment to Focus as to three of the patent claims.<sup>516</sup> After a bench trial, the district court found for Focus on the trademark claims and awarded trebled damages for willful infringement, plus attorney’s fees.<sup>517</sup>

On appeal, the Federal Circuit vacated the grants of summary judgment on the patents as well as the trademark and trade dress infringement holdings.<sup>518</sup> However, the court also held that each of the appellants had waived certain arguments by failing to adequately present them in their appellate briefs.<sup>519</sup> The court rejected each party’s initial briefs, which “divided the issues on appeal and attempted to incorporate by reference each other’s briefs.”<sup>520</sup> The parties modified their briefs by removing those incorporation statements, disclaiming that they sought “to benefit from successful arguments made by the other that they themselves did not adequately raise.”<sup>521</sup> The court found that Kartri—whose brief focused on trademark issues—waived its patent non-infringement arguments by spending “less than one page on all patent issues,” and accordingly affirmed the patent infringement findings against it.<sup>522</sup> On the other hand, the court held that Marquis’s patent-focused brief still “did enough to preserve its arguments” on trade dress infringement and one of the trademarks.<sup>523</sup>

## Venue and Transfer

*In re SAP Am., Inc.*, 133 F.4th 1370 (Fed. Cir. Apr. 10, 2025)

In this petition for Writ of Mandamus from the Eastern District of Texas (EDTX), the Federal Circuit denied SAP’s request for an intradivision transfer within EDTX.<sup>524</sup> The Federal Circuit first observed that the district court, in denying the request for

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<sup>514</sup> *Focus Products Group Int’l, LLC v. Kartri Sales Co., Inc.*, 156 F.4th 1259, 1265-66 (Fed. Cir. 2025).

<sup>515</sup> *Id.* at 1266.

<sup>516</sup> *Id.*

<sup>517</sup> *Id.* at 1270-71.

<sup>518</sup> *Id.* at 1279, 1280-81, 1285.

<sup>519</sup> *Id.* at 1285-86.

<sup>520</sup> *Id.* at 1285.

<sup>521</sup> *Id.*

<sup>522</sup> *Id.* at 1286.

<sup>523</sup> *Id.* at 1286-87.

<sup>524</sup> *In re SAP Am., Inc.*, 133 F.4th 1370, 1373 (Fed. Cir. 2025) (per curiam).

transfer, had erred in several respects.<sup>525</sup> First, the lower court had erroneously cited parallel litigation brought by Valtrus, the patentee, in the transferor district, when, in reality, that litigation had concluded at the time of the transfer motion.<sup>526</sup> Second, the district court had erroneously considered the case’s progress as weighing against transfer as part of the public interest factor in the transfer inquiry; the Federal Circuit clarified that the inquiry is focused on the *relative* volume of the transferor and transferee courts, and whether a transfer would relieve court congestion.<sup>527</sup> Nonetheless, the Federal Circuit held that SAP had failed to meet its burden of showing that the transferee forum was “clearly convenient” because it did not show the availability of specific evidence in the transferee district.<sup>528</sup> The mere fact that SAP’s offices were in the transferee district was not dispositive.<sup>529</sup>

## Infringement Contentions

*Taction Technology, Inc. v. Apple Inc.*, 2025 WL 2336950 (Fed. Cir. Aug. 13, 2025)

In this appeal from the Southern District of California, the Federal Circuit reversed the grant of summary judgment for defendant, holding that the district court abused its discretion by striking plaintiff’s expert testimony based on an arbitrary reading of local patent rules on infringement contentions.<sup>530</sup> Taction accused Apple of infringing its patent for haptics technologies and relied on the expert testimony of Dr. Oliver.<sup>531</sup> However, the district court struck Dr. Oliver’s testimony and granted summary judgment after concluding that “without the stricken testimony Taction had no viable claim of infringement.”<sup>532</sup>

The district court struck Dr. Oliver’s opinion in part because it was “based on a new infringement theory Taction had not disclosed in its infringement contentions.”<sup>533</sup> The district court claimed this violated Local Patent Rule 3.1(c), which requires a chart “identifying specifically where each element of each asserted claim is to be found within each Accused Instrumentality.”<sup>534</sup> The district court explained that this rule included an unwritten requirement to explain “how” the allegedly infringing products satisfied the patent limitations.<sup>535</sup>

The Federal Circuit rejected this requirement as arbitrary, lacking support either in “the plain language of the rule” or the “common practice” in the Southern District of California.<sup>536</sup> Moreover, the parties lacked notice of such a requirement, for which the

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<sup>525</sup> *Id.* at 1374-75.

<sup>526</sup> *Id.* at 1374.

<sup>527</sup> *Id.* at 1375.

<sup>528</sup> *Id.*

<sup>529</sup> *Id.*

<sup>530</sup> *Taction Tech., Inc. v. Apple Inc.*, 2023-2349, 2025 WL 2336950 (Fed. Cir. Aug. 13, 2025).

<sup>531</sup> *Id.* at \*1-3.

<sup>532</sup> *Id.* at \*1.

<sup>533</sup> *Id.*

<sup>534</sup> *Id.* at \*2.

<sup>535</sup> *Id.*

<sup>536</sup> *Id.* at \*3.

district court's only citation was an unpublished and non-binding order from a magistrate judge.<sup>537</sup> The Federal Circuit concluded "it was an abuse of discretion" to strike Dr. Oliver's opinion on this basis.<sup>538</sup>

## Expert Qualifications

*Jiaxing Super Lighting Electric Appliance Co., Ltd. v. CH Lighting Tech. Co., Ltd.*, 146 F.4th 1098 (Fed. Cir. July 28, 2025)

In this appeal from the Western District of Texas, the Federal Circuit vacated a JMOL finding of patent validity for two of three asserted patents.<sup>539</sup> The panel also ordered a new trial on damages because "the jury rendered a single verdict on damages" without apportioning among the different patents.<sup>540</sup> This disposition mooted CH Lighting's arguments to exclude testimony from Super Lighting's damages expert under *Daubert*, but the panel "briefly address[ed]" those arguments to guide the district court on remand in light of the Federal Circuit's en banc decision in *EcoFactor v. Google*.<sup>541</sup>

The panel highlighted concerns that "may form the basis for a *Daubert* motion" on remand. First, Super Lighting's expert, Ms. Kindler, relied on past portfolio licenses—covering Super Lighting's entire patent portfolio—to calculate a per-unit royalty rate for a hypothetical negotiation for only the three patents at issue.<sup>542</sup> Citing the en banc decision in *EcoFactor*, the panel ordered the district court to evaluate the reliability of Ms. Kindler's testimony, with "a particular focus" on the facts and data underlying her opinion.<sup>543</sup> Second, the court underscored that damages experts must apportion licenses fees "among the licensed patents covered by an agreement."<sup>544</sup> The panel ordered the district court to "consider whether Super Lighting properly apportioned damages."<sup>545</sup> Finally, the panel explained that "blanket upward and downward adjustments based on such factors as the level of competition between the parties and changes in the price of LED tubes" would not suffice to cure testimony that otherwise lacked a reliable basis.<sup>546</sup>

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<sup>537</sup> *Id.*

<sup>538</sup> *Id.*

<sup>539</sup> *Jiaxing Super Lighting Electric Appliance Co, Ltd. v. CH Lighting Tech. Co., Ltd.*, 146 F.4th 1098, 1102 (Fed. Cir. 2025).

<sup>540</sup> *Id.* at 1110 (quotation and citation omitted).

<sup>541</sup> *Id.* at 1110-11.

<sup>542</sup> *Id.* at 1111-1112.

<sup>543</sup> *Id.* at 1112.

<sup>544</sup> *Id.*

<sup>545</sup> *Id.*

<sup>546</sup> *Id.*

*Trudell Med. Int'l Inc. v. D R Burton Healthcare, LLC*, 127 F.4th 1340 (Fed. Cir. Feb. 7, 2025)

In this appeal from the Eastern District of North Carolina, the Federal Circuit reversed the district court's denial of a new trial, holding that the district court had erroneously admitted expert testimony that was untimely disclosed.<sup>547</sup> Applying Fourth Circuit law, the Federal Circuit first held that, because the defense expert's report was not timely disclosed under Rule 26, the district court should have excluded it.<sup>548</sup> The district court's refusal to do so was an abuse of discretion, according to the Federal Circuit, because D R Burton lacked any justification for its untimely submission and admission of the expert testimony would be prejudicial, since Trudell had no opportunity to depose the expert and the opportunity to cross-examine at trial, without a prior deposition, was insufficient.<sup>549</sup> And since the expert's testimony was "harmful and prejudicial," the Federal Circuit ruled that a new trial was warranted.<sup>550</sup> On retrial, the Federal Circuit agreed with Trudell that the matter should be re-assigned to a new judge based on prejudicial statements made by the district court in the presence of the jury.<sup>551</sup>

### **Preemption of State Tort Claims**

*BearBox LLC v. Lancium LLC*, \_\_ F. 4th \_\_, 2025 WL 77755 (Fed. Cir. Jan. 13, 2025)

In this appeal from the District of Delaware, the Federal Circuit affirmed the district court's holding that BearBox's conversion claim was preempted.<sup>552</sup> The Federal Circuit framed the inquiry as whether Bearbox's claims, "as pled," stand "as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress."<sup>553</sup> And because Bearbox's conversion claim used "patent-like" language, sought remedies akin to those awarded under patent law, and sought to recover for the use of information by Lancium that was in the public domain under the patent laws, the Federal Circuit held that recognizing BearBox's claim would "offer patent-like protection to intellectual creations [under state law] which would otherwise remain unprotected as a matter of federal law."<sup>554</sup> Thus, Bearbox's conversion claim was preempted.<sup>555</sup>

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<sup>547</sup> *Trudell Med. Int'l Inc. v. D R Burton Healthcare, LLC*, 127 F.4th 1340, 1346-47 (Fed. Cir. 2025).

<sup>548</sup> *Id.* at 1347-48.

<sup>549</sup> *Id.* at 1348.

<sup>550</sup> *Id.* at 1351.

<sup>551</sup> *Id.* at 1352-53.

<sup>552</sup> *BearBox LLC v. Lancium LLC*, 2025 WL 77755, at \*1 (Fed. Cir. Jan. 13, 2025).

<sup>553</sup> *Id.* at \*5 (citation omitted).

<sup>554</sup> *Id.* at \*5-7 (quoting *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 156 (1989)).

<sup>555</sup> *Id.*

## Assignment

*Causam Enterprises, Inc. v. International Trade Commission*, 155 F.4th 1338 (Fed. Cir. Oct 15, 2025)

In this appeal from an ITC investigation, the Federal Circuit held that Causam owned the asserted patent, but the court nevertheless dismissed the appeal as moot because it separately affirmed a PTO determination that the asserted claims were unpatentable.<sup>556</sup>

Causam initiated an ITC investigation over alleged infringement of its ‘268 patent related to “demand response” functionality for electronic utilities.<sup>557</sup> The ALJ’s initial determination held that Causam did not own the patent, because a 2007 assignment of its ancestor ‘909 application assigned not only the invention disclosed there, but also “all divisions, reissues, continuations and extensions thereof.”<sup>558</sup> Therefore, the inventor Forbes’s purported assignment of the ‘268 patent—a descendant of the ‘909 application—was invalid.<sup>559</sup> The ITC did not reach the issue, instead affirming based on the ALJ’s finding of noninfringement.<sup>560</sup>

The Federal Circuit first held that Causam’s only route to Article III standing was “its interest as owner the ‘268 patent,” which itself reduced “to a legal question of contract interpretation.”<sup>561</sup> The court rejected arguments from the Commission that general allegations of ownership or the statutory right to appeal an adverse decision were sufficient to create standing, citing *TransUnion LLC v. Ramirez*.<sup>562</sup>

The court then concluded that Causam had standing because it was the owner of the ‘268 patent.<sup>563</sup> The issue turned on whether the 2007 assignment included the ‘761 continuation-in-part application, derived from the original ‘909 application.<sup>564</sup> Looking to the language of that contract, the court concluded that “continuations” should not be read to include “continuations-in-part,” since “the two are widely understood to be different.”<sup>565</sup> The court pointed out that inventors might wish to assign the former but not the latter in order to keep the rights to the “new matter” that may be added to a continuation-in-part.<sup>566</sup> And the court noted the legal consequences of the distinction for assignments, since “recordation of assignment of the parent is effective as to the child, while the same is not true of a continuation-in-part.”<sup>567</sup> The court also declined to extend the rule from *Regents of Univ. of New Mexico v. Knight*—holding that “assignment of an

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<sup>556</sup> *Causam Enterprises, Inc. v. International Trade Commission*, 155 F.4th 1338, 1340 (Fed. Cir. 2025).

<sup>557</sup> *Id.*

<sup>558</sup> *Id.* at 1341-42.

<sup>559</sup> *Id.* at 1342.

<sup>560</sup> *Id.*

<sup>561</sup> *Id.* at 1343.

<sup>562</sup> *Id.* (citing *TransUnion LLC v. Ramirez*, 594 U.S. 413, 426 (2021)).

<sup>563</sup> *Id.* at 1346.

<sup>564</sup> *Id.* at 1345.

<sup>565</sup> *Id.*

<sup>566</sup> *Id.*

<sup>567</sup> *Id.* at 1346.

invention and certain types of descendants reached continuations-in-part even though the assignment mentioned only ‘continuations’—after distinguishing the unique facts of that case that justified reading invention “expansively.”<sup>568</sup> Since the 2007 assignment “unambiguously excludes the ‘761 application,” it did not affect the inventor’s title to the ‘268 patent, and his assignment to Causam was valid.<sup>569</sup>

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<sup>568</sup> *Id.* (distinguishing *Regents of University of New Mexico v. Knight*, 321 F.3d 1111, 1119-20 (Fed. Cir. 2003)).

<sup>569</sup> *Id.*

## PTO AND PTAB PROCEDURE

### AIA Derivation Proceedings

*Global Health Solutions LLC v. Selner*, 2023-2009, 2025 WL 2446374 (Fed. Cir. Aug 26, 2025)

This case marked the Federal Circuit’s first review of an appeal from a PTAB derivation proceeding under the America Invents Act (AIA).<sup>570</sup> The Federal Circuit affirmed the PTAB’s finding that Selner’s patent application for a method to prepare emulsifier-free ointments was not derived from Burnam’s invention for Global Health Solutions (GHS).<sup>571</sup>

The PTAB found that both Selner and Burnam—who applied for a patent four days after Selner—had separately conceived of the invention, but that Selner’s invention was not derivative because he had conceived of it shortly before Burnam did so and communicated it to him.<sup>572</sup>

On appeal, GHS argued that the PTAB had committed multiple reversible errors and should have considered naming GHS as a co-inventor.<sup>573</sup> The court clarified that AIA derivation proceedings are distinct from pre-AIA interference proceedings because the inquiry no longer focuses on who is first to invent, but rather “centers on whether the petitioner conceived and communicated the invention before the respondent filed his application.”<sup>574</sup> The first-filer “can overcome this showing by proving independent conception prior to receiving relevant communications from the petitioner.”<sup>575</sup> Thus, the PTAB’s focus on who conceived the invention first was harmless error because finding that Selner conceived the invention first also indirectly meant that Selner independently conceived the invention, overcoming GHS’s prima facie showing.<sup>576</sup> Rejecting GHS’s other claims, the court found the PTAB supported its findings with adequate evidence and used the proper legal standards, and that GHS had failed to preserve its claim for co-inventor status.<sup>577</sup>

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<sup>570</sup> *Global Health Solutions LLC v. Selner*, \_\_\_ F.4th \_\_\_, 2025 WL 2446374, at \*1 (Fed. Cir. Aug. 26, 2025).

<sup>571</sup> *Id.*

<sup>572</sup> *Id.* at \*1-2.

<sup>573</sup> *Id.* at \*4.

<sup>574</sup> *Id.* at \*5.

<sup>575</sup> *Id.*

<sup>576</sup> *Id.*

<sup>577</sup> *Id.* at \*7-8.

## Inter Partes Review Procedure

*In re Motorola Solutions, Inc.*, --- F.4th ----, 2025-134, 2025 WL 3096514 (Fed. Cir. Nov. 6, 2025)

In this appeal of a PTO decision to cancel an ongoing IPR, the Federal Circuit denied the petition, rejecting Motorola’s arguments relying on the Due Process Clause and the Administrative Procedure Act (APA).<sup>578</sup>

The Board instituted IPR of Steller, LLC’s patents at Motorola’s request, but the acting Director deinstitutioned the IPRs after “concluding such review would not be an efficient use of resources given the ongoing parallel district court proceedings between the parties involving the patents.”<sup>579</sup> Motorola petitioned for mandamus relief, arguing that the Director violated APA procedural protections and the Fifth Amendment’s Due Process Clause.<sup>580</sup> Specifically, Motorola challenged the Board’s rescission of the Vidal Memorandum—guidance issued in 2022 instructing the Board “on how to apply the *Fintiv* factors” in “determining whether to deny institution of IPR in situations where there are pending parallel proceedings”—and its retroactive application of that rescission.<sup>581</sup>

The Federal Circuit first reiterated its rule that “mandamus is ordinarily unavailable for review of institution decisions,” since they were committed to the Director’s discretion and protected from judicial review because the statute makes them “final and nonappealable.”<sup>582</sup> Although the court “noted possible exceptions for ‘colorable constitutional claims’ and certain statutory challenges,” it concluded that “no such claims have been presented here.”<sup>583</sup>

On the Due Process arguments, the court held that the Vidal Memorandum did not create a “constitutionally protected interest” to support a violation of Due Process.<sup>584</sup> Motorola argued the Memorandum “imposed ‘substantive limits’ on the PTO’s ‘officials discretion’ to deny an IPR.”<sup>585</sup> The court rejected this argument because the Memorandum merely provided guidance in the application of discretionary review, rather than mandating a particular outcome upon a showing of eligibility.<sup>586</sup> And even if Motorola had such a property right, it was not protected by the Due Process Clause because it amounted to a right to receive “the desired process” rather than “any separate property interest.”<sup>587</sup> Nor did the retroactive application of the rescission create “the kind of unfair surprise that might raise a due process violation,” because Motorola was on

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<sup>578</sup> *In re Motorola Solutions, Inc.*, --- F.4th ----, 2025-134, 2025 WL 3096514, at \*1 (Fed. Cir. Nov. 6, 2025).

<sup>579</sup> *Id.*

<sup>580</sup> *Id.*

<sup>581</sup> *Id.* at \*1-3.

<sup>582</sup> *Id.* at \*3.

<sup>583</sup> *Id.* (citation omitted).

<sup>584</sup> *Id.* at \*4.

<sup>585</sup> *Id.*

<sup>586</sup> *Id.*

<sup>587</sup> *Id.*

notice that the interim guidance could change and it still retained the ability to raise its patentability arguments elsewhere—just not in an IPR.<sup>588</sup>

On the APA, Motorola argued that the “rescission of the Memorandum effected a change in law requiring notice-and-comment rulemaking.” But the court rejected this argument because Motorola had separate recourse via “an APA action in federal district court.”<sup>589</sup> Given that option, Motorola’s request for a writ of mandamus was “nothing but an attempted end run around § 314(d)’s bar on review.”<sup>590</sup> The court distinguished *Apple v. Vidal*, because in that case the challenge involved the PTO’s compliance with APA “notice-and-comment rulemaking requirements ‘apart from the reviewability of’ a specific institution decision.”<sup>591</sup> Likewise, the court rejected Motorola’s argument that the Director “acted arbitrarily and capriciously in applying the rescission” by failing to explain the reasons for the change or consider reliance interests.<sup>592</sup> The court reiterated that such arguments are not reviewable in light of § 314(d) because they amount to challenging the Director’s discretion.<sup>593</sup>

*PTO Director Memo, “Enforcement and Non-Waiver of 37 C.F.R. § 42.104(b)(4) and Permissible Uses of General Knowledge in Inter Partes Reviews,” July 31, 2025.*

In this memo, the PTO mandated that the USPTO will “enforce and no longer waive” the requirement under Rule 104(b)(4) that a petitioner for IPR “must specify where each element of the claim is found in the prior art patents or printed publications relied upon.”<sup>594</sup> As a practical matter under that rule, general knowledge expressed through “applicant admitted prior art (AAPA), expert testimony, common sense, and other evidence . . . may not be used to supply a missing claim limitation.” However, “general knowledge may still be used in an IPR to support a motivation to combine or to demonstrate the knowledge of a person having ordinary skill in the art.”

The PTO explained that this memorandum superseded prior memoranda from 2020 and 2022, which were “no longer consistent with Federal Circuit precedent concerning the use of AAPA to supply a missing claim limitation” under *Qualcomm I* and *Qualcomm II*. The PTO acknowledged that Rule 104(b)(4) may be stricter than 35 U.S.C. § 311(b), referencing *Shockwave Medical, Inc. v. Cardiovascular Systems, Inc.*, 142 F.4th 1371 (Fed. Cir. July 14, 2025). But the PTO argued that enforcing the rule would “provide certainty to the parties, the Board, and the public, and [] allow for the efficient administration of the office.”

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<sup>588</sup> *Id.*

<sup>589</sup> *Id.* at \*5.

<sup>590</sup> *Id.*

<sup>591</sup> *Id.* (quoting *Apple v. Vidal*, 63 F.4th 1, 14 (Fed. Cir. 2023)).

<sup>592</sup> *Id.* at \*5.

<sup>593</sup> *Id.*

<sup>594</sup> PTO Director Memo, “Enforcement and Non-Waiver of 37 C.F.R. § 42.104(b)(4) and Permissible Uses of General Knowledge in Inter Partes Reviews,” July 31, 2025.

*Shockwave Medical, Inc. v. Cardiovascular Systems, Inc.*, 142 F.4th 1371 (Fed. Cir. July 2025)

In this appeal from the PTAB, the Federal Circuit held that the IPR petition properly used applicant admitted prior art (AAPA) and did not violate 35 U.S.C. § 311(b).

The court explained that its decisions in *Qualcomm I* and *Qualcomm II* required that “only patents and printed publications [may] form the basis of an IPR petition’s unpatentability grounds.”<sup>595</sup> But the PTAB should not ignore “the skilled artisan’s knowledge” in determining obviousness, and AAPA can be provide evidence of that general knowledge.<sup>596</sup>

The court distinguished this case from *Qualcomm II* because Cardiovascular Systems only used AAPA to show that one aspect of the patent’s claim limitations was “well known in the prior art,” consistent with the court’s precedent allowing use of AAPA as “general knowledge ‘supplying a missing claim limitation.’”<sup>597</sup> It was immaterial that the PTAB, in its Final Written Decision, included AAPA under a column labeled “Reference(s)/Basis,” because only the grounds raised in the petition matter for purposes of § 311(b), and the petition never phrased AAPA as providing a “basis” for its obviousness arguments.<sup>598</sup> And the petition did not violate § 311(b) by relying on general background knowledge to supply missing claim limitations that Shockwave did not argue were novel to the invention.<sup>599</sup>

*Dabico Airport Solutions Inc. v. AXA Power ApS, No. IPR2025-00408, 2025 WL 1710080 (PTO Director, June 18, 2025)*

In this IPR petition, the Board granted patentee AXA Power ApS’s motion for discretionary denial of review.<sup>600</sup> Upon a “holistic assessment of all of the evidence and arguments presented,” the Board determined that “the considerations favoring discretionary denial outweigh those that counsel against it.”<sup>601</sup>

In particular, the Board emphasized that the patent had “been in force almost eight years, creating settled expectations” and giving sufficient notice to “the public, other inventors, competitors, and commercial interests.”<sup>602</sup> The Board analogized to the logic of time-limitations on infringement lawsuits.<sup>603</sup> On the other side of the ledger, the Board observed that petitioner had failed to provide persuasive reasoning why an IPR would be

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<sup>595</sup> *Shockwave Medical, Inc. v. Cardiovascular Systems, Inc.*, 142 F.4th 1371, 1377-78 (Fed. Cir. 2025)

<sup>596</sup> *Id.* at 1378.

<sup>597</sup> *Id.* at 1379 (citing *Qualcomm I*, 24 F.4th 1367, 1376 (Fed. Cir. 2022)).

<sup>598</sup> *Id.* at 1379.

<sup>599</sup> *Id.* at 1380.

<sup>600</sup> *Dabico Airport Solutions Inc. v. AXA Power ApS, No. IPR2025-00408, 2025 WL 1710080 (PTO Director, June 18, 2025).*

<sup>601</sup> *Id.*

<sup>602</sup> *Id.*

<sup>603</sup> *Id.*

“an appropriate use of Office resources.”<sup>604</sup> Without such reasoning, “the Office is disinclined to upset the settled expectations of Patent Owner in this instance.”<sup>605</sup>

*Apple Inc. v. Gesture Tech. Partners, LLC*, 127 F.4th 364, 367 (Fed. Cir. Jan. 27, 2025)

In this appeal from the PTAB, the Federal Circuit held that the PTAB maintained jurisdiction to cancel an expired patent.<sup>606</sup>

After Apple filed for an IPR a year after the patent at issue expired, the PTAB concluded that Apple had proven, in part, that the claims were unpatentable.<sup>607</sup> On the issue of the PTAB’s jurisdiction to do so, Gesture argued on appeal that, under *Oil States*,<sup>608</sup> an expired patent may only be enforced in the Article III courts, since, at that time, the “public franchise” recognized in *Oil States* has ceased to exist.<sup>609</sup> The Federal Circuit disagreed, observing that IPR is merely a “second look” at the earlier determination to grant a public right: “The review of an earlier grant of a patent thus inherently involves the adjudication of a public right, and it is irrelevant whether the patent has expired, since the patent itself continues to confer a limited set of rights to the patentee.”<sup>610</sup> And even though the patentee’s “prospective” right to exclude is foreclosed after the patent expires, the Federal Circuit observed that expired patents “maintain[] some rights, such as bringing an action for past damages,” which fell within the public-rights doctrine.<sup>611</sup>

## Collateral Estoppel

*IGT v. Zynga Inc.*, 144 F.4th 1357 (Fed. Cir. July 22, 2025)

In this appeal from the PTAB, the Federal Circuit affirmed the Board’s decision not to apply interference estoppel, holding that the decision constituted an unreviewable decision to institute IPR review and, moreover, did not constitute reversible error.<sup>612</sup>

Zynga petitioned for IPR in 2021, alleging that several claims of IGT’s ‘089 patent were unpatentable as obvious. The PTO had declared an interference between the ‘089 patent and Zynga’s earlier patent application in 2010, but it mooted Zynga’s similar motions for unpatentability then because Zynga’s patent claims lacked sufficient written description. IGT moved to deny the petition under interference estoppel because it relied on new prior art that Zynga “could have, but chose not to, raise” in its 2010 motions.<sup>613</sup>

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<sup>604</sup> *Id.*

<sup>605</sup> *Id.*

<sup>606</sup> *Apple Inc. v. Gesture Tech. Partners, LLC*, 127 F.4th 364, 366-67 (Fed. Cir. 2025).

<sup>607</sup> *Id.* at 367.

<sup>608</sup> *Oil States Energy Services, LLC v. Greene's Energy Group, LLC*, 584 U.S. 325 (2018).

<sup>609</sup> *Apple*, 137 F.4th at 368.

<sup>610</sup> *Id.* at 369.

<sup>611</sup> *Id.*

<sup>612</sup> *IGT v. Zynga Inc.*, 144 F.4th 1357, 1360 (Fed. Cir. 2025).

<sup>613</sup> *Id.* at 1363-64.

The Board “declined to apply interference estoppel” because it had terminated the interference proceeding on a “threshold issue” and the Board had thus not analyzed or decided unpatentability.<sup>614</sup> The PTO director affirmed that decision, and the Board ultimately concluded that IGT’s claims were unpatentable under § 103.<sup>615</sup>

On appeal, the Federal Circuit held that IGT’s contention “that interference estoppel bars review of Zynga’s IPR petition is within the general unreviewability principle,” because the challenge “has institution as its direct, immediate, express subject.”<sup>616</sup> This was the case for two reasons. First, IGT “presented the challenge as a reason to deny institution” and “immediately sought review . . . before patentability was ultimately adjudicated by the Board.”<sup>617</sup> Second, the challenge would necessarily “entail non-institution” if successful, because interference estoppel would have left “no remaining ground for unpatentability” in the petition to justify IPR.<sup>618</sup> IGT argued that its motion relied on a PTO regulation rather than a statutory provision, but the Federal Circuit held that this made no difference for purposes of reviewability under § 314(d).<sup>619</sup>

*Kroy IP Holdings, LLC v. Groupon, Inc.*, 146 F.4th 1360 (Fed. Cir. August 1, 2025)  
(denying rehearing en banc)

The Federal Circuit denied Groupon’s petition for panel rehearing and rehearing en banc, upholding the panel’s decision to reverse and remand the patent infringement case.<sup>620</sup> The panel rejected the application of collateral estoppel from a PTAB proceeding to a court decision. In a concurrence with the denial, Chief Judge Moore and Judge Stoll argued that it would be wrong and contrary to the Supreme Court’s guidance to adopt patent-specific departures from the “well-established” doctrine of collateral estoppel.<sup>621</sup> In line with the panel’s decision, the concurrence explained that collateral estoppel does not apply where “the different standard of proof . . . materially alters the question of invalidity.”<sup>622</sup>

Judges Dyk and Hughes dissented, arguing that the panel’s holding conflicted with the Federal Circuit’s previous decision in *XY, LLC v. Trans Ova Genetics, L.C.*<sup>623</sup> The dissent distinguished the Supreme Court’s decision in *Grogan v. Garner*<sup>624</sup>, pointing out that “the burden-of-proof rule is not absolute” and that the rule should not be applied where it was “incompatible with the statutory structure and purpose” of “avoiding duplicative litigation as to patent invalidity.”<sup>625</sup>

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<sup>614</sup> *Id.* at 1364.

<sup>615</sup> *Id.* at 1364-65.

<sup>616</sup> *Id.* at 1365 (quotation and citation omitted).

<sup>617</sup> *Id.* at 1366.

<sup>618</sup> *Id.*

<sup>619</sup> *Id.*

<sup>620</sup> *Kroy IP Holdings, LLC v. Groupon, Inc.*, 146 F.4th 1360, 1361 (Fed. Cir. 2025).

<sup>621</sup> *Id.* at 1361.

<sup>622</sup> *Id.* at 1362.

<sup>623</sup> *Id.* at 1362; 890 F.3d 1282, 1294 (Fed. Cir. 2018).

<sup>624</sup> 498 U.S. 279 (1991).

<sup>625</sup> *Kroy*, 146 F.4th at 1362-64.

*Ingenico Inc v. IOEngine, LLC, 136 F.4th 1354 (Fed. Cir. May 7, 2025)*

In this appeal from the District of Delaware, the Federal Circuit affirmed a jury verdict of patent invalidity, holding that the verdict was supported by substantial evidence and that the district court had not abused its discretion in denying a new trial.<sup>626</sup>

Patentee IOENGINE argued on appeal that it was entitled to a new trial on several grounds, including that “IPR estoppel should have prevented Ingenico from introducing” certain prior art.<sup>627</sup> In particular, IOENGINE contended that Ingenico was relying on what the district court had deemed to be “device art,” but which should have been excluded as “printed publications that reasonably could have been raised during the IPR.”<sup>628</sup>

The Federal Circuit noted it had not previously decided the key legal question underlying the dispute: the “proper interpretation of the word ‘ground’ used in 35 U.S.C. § 315(e)(2).”<sup>629</sup> The court defined “grounds” as “the theories of invalidity available to challenge a claim under §§ 102 and 103,” relying on the plain language of the statutory provision and its underlying purpose of avoiding harder forms of prior art adjudication in IPR proceedings.<sup>630</sup> The court found this interpretation consistent with the statute’s other provisions and its own prior interpretations.<sup>631</sup> Based on this definition, the court held that IPR estoppel applied only to assertions of novelty or non-obviousness based on prior patents or printed publications, and would not preclude claims that the invention was “known or used by others, on sale, or in public use” as those were “different grounds that could not be raised during an IPR.”<sup>632</sup> Thus a new trial was not required, because even if Ingenico’s evidence constituted “printed publications,” it was not estopped from using it to support theories of invalidity that were not available in the IPR.<sup>633</sup>

*Kroy IP Holdings, LLC v. Groupon, Inc., 127 F.4th 1376 (Fed. Cir. Feb. 10, 2025)*

In this appeal from the District of Delaware, the Federal Circuit reversed the district court’s dismissal of Kroy’s complaint, holding that the district court had mistakenly given collateral estoppel effect to two prior IPR decisions of the PTAB.<sup>634</sup> Applying Third Circuit law, the Federal Circuit framed the issue as follows: “whether a prior final written decision of the Board that certain patent claims are unpatentable precludes a patentee from asserting other claims from the same patent, even assuming the asserted claims are immaterially different from the unpatentable claims for purposes of invalidity.”<sup>635</sup> The Federal Circuit answered no, holding that applying collateral estoppel to a case involving a different legal standard than the first case would “deprive patent owners of their property right without first requiring proof of patent invalidity that

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<sup>626</sup> *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1359.

<sup>627</sup> *Id.* at 1364.

<sup>628</sup> *Id.*

<sup>629</sup> *Id.* at 1365.

<sup>630</sup> *Id.* at 1365-66.

<sup>631</sup> *Id.*

<sup>632</sup> *Id.* at 1366.

<sup>633</sup> *Id.* at 1366-67.

<sup>634</sup> *Kroy IP Holdings, LLC v. Groupon, Inc.*, 127 F.4th 1376, 1378 (Fed. Cir. 2025).

<sup>635</sup> *Id.* at 1380.

satisfies the statutorily-prescribed clear and convincing evidence standard.”<sup>636</sup> Since Groupon had proved the unpatentability of certain claims before the PTAB only by a preponderance, that finding did not collaterally estop Kroy from asserting related claims—which would have to be defeated by a showing of “clear and convincing evidence,” not a mere preponderance.<sup>637</sup>

This decision seems in tension with the Supreme Court’s ruling in *B&B Hardware v. Hargis Industries*, which held that decisions of the TTAB in trademark cases *are* given preclusive effect.<sup>638</sup> The court distinguished the two based on the differing burdens of proof.

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<sup>636</sup> *Id.* at 1380-81.

<sup>637</sup> *Id.* at 1380-81.

<sup>638</sup> 575 U.S. 138 (2015).

## DESIGN PATENTS

*Top Brand LLC v. Cozy Comfort Co. LLC, 143 F.4th 1349 (Fed. Cir. July 17, 2025)*

In this appeal from the District of Arizona, the Federal Circuit reversed a denial of JMOL, holding that the principles of prosecution history disclaimer apply to design patents.<sup>639</sup>

Top Brand sought a declaratory of noninfringement of Cozy Comfort’s design patent for oversized hooded sweatshirts, and Cozy Comfort counterclaimed for infringement. Applying a principle from utility patents, the court first held that Top Brand did not waive its claim construction arguments by failing to object to jury instructions, because its argument on appeal was “the same construction proposed during earlier claim construction proceedings” and the district court had thus already rejected it repeatedly.<sup>640</sup> The court next held that the utility patent doctrine of prosecution history disclaimer applies to design patents, such that a patentee could “surrender claim scope of a design patent” either by amendment or by argument.<sup>641</sup> The court explained that this was consistent with Federal Circuit precedents and consistent with the purpose of design patent prosecution, since it would be incongruous to “allow the patentee to make arguments in litigation contrary to the representations which led to the grant of the patent in the first place, and thereby recapture surrendered claim scope.”<sup>642</sup>

Applying this doctrine, the court found that Cozy Comfort’s arguments to the examiner distinguishing its claimed design from prior art constituted “unambiguous disavowal” of identified features.<sup>643</sup> Since those disclaimed features were the only ones Cozy Comfort relied on to show design similarity in Top Brand’s product, “a hypothetical ordinary observer” could not have found infringement, so the district court erred in denying JMOL.<sup>644</sup>

*In re Floyd, No. 2023-2395, 2025 WL 1163561 (Fed. Cir. April 22, 2025)*

In this appeal from the PTAB, the Federal Circuit affirmed the Board’s rejection of a design patent application directed to a cooling blanket.<sup>645</sup> The court held that the applicant’s earlier utility patent application did not provide adequate written description to afford priority to the subsequent design patent, such that the latter was anticipated by the former.<sup>646</sup>

On appeal, the court rejected Floyd’s arguments that the ‘938 utility patent application disclosed a broad range of potential configurations that included her ‘345 design patent’s six-by-five grid.<sup>647</sup> The court affirmed the Board’s contrary findings on

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<sup>639</sup> *Top Brand LLC v. Cozy Comfort Co. LLC, 143 F.4th 1349, 1353 (Fed. Cir. July 17, 2025)*

<sup>640</sup> *Id.* at 1356.

<sup>641</sup> *Id.* at 1357.

<sup>642</sup> *Id.*

<sup>643</sup> *Id.* at 1357-58.

<sup>644</sup> *Id.* at 1362.

<sup>645</sup> *In re Floyd, No. 2023-2395, 2025 WL 1163561 (Fed. Cir. April 22, 2025)*

<sup>646</sup> *Id.* at \*1.

<sup>647</sup> *Id.* at \*2.

substantial evidence review.<sup>648</sup> First, the court affirmed that the undepicted six-by-five design was not necessarily disclosed even if the '938 patent specification stated that the invention could "be made in any size."<sup>649</sup> The Board reasonably interpreted this as indicating that the individual rectangular compartments might vary in size, rather than disclosing different grid configurations.<sup>650</sup> Second, the disclosure of six-by-six and six-by-four embodiments did not sufficiently disclose that Floyd possessed the six-by-five array.<sup>651</sup> The court held the Board reasonably interpreted the '938 patent as disclosing two standalone embodiments, and even if they represented a range, they did not necessarily indicate possession of a six-by-five grid rather than other possibilities.<sup>652</sup> Finally, the court affirmed that the '938 patent's specification of arrays with a "plurality of individualized compartments" did not inherently disclose a six-by-five array, because there was "nothing in the specification" to "suggest that a skilled designer would necessarily do so."<sup>653</sup>

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<sup>648</sup> *Id.*

<sup>649</sup> *Id.* at \*3.

<sup>650</sup> *Id.*

<sup>651</sup> *Id.* at \*3-4.

<sup>652</sup> *Id.* at \*4.

<sup>653</sup> *Id.* at \*4-5.