

Day 1, Panel 1: Mark Lemley's Annual Patent Law Update

Key terms: Core Patent Law Doctrines, Patentable subject matter (§101), written description, enablement, definiteness, obviousness, claim construction, infringement, doctrine of equivalents, Procedural & Administrative, PTAB, IPR (Inter Partes Review), JMOL, Daubert, prosecution history estoppel, prosecution laches, equitable estoppel, ex parte reexam, collateral estoppel, Claim Drafting Concepts, Means-plus-function, Markush groups, Jepson format, comprising/consisting of/consisting essentially of, nonce words, lexicographer doctrine, prosecution disclaimer, Damages & Remedies, Apportionment, reasonable royalty, lump sum, attorneys' fees, deterrence sanctions, general vs. special verdict, Genus/species claims, blaze marks, polycrystalline diamond compact, CRISPR-Cas9, pharmaceutical evergreening, domestic industry, Genus claiming limits (post-Amgen), AI patentability, ITC domestic industry, abstract idea doctrine, PTO guidance vs. Federal Circuit precedent

Speaker:
Mark Lemley

[WAYNE STACY]

So I'm Wayne Stacy. I'll be helping with a lot of this morning. Uh, you'll hear with me, from me this afternoon, with Director Iancu. Uh, but our first speaker this morning as we were just talking about if you don't know, you're probably at the wrong conference, and that'll be Mark Lemley.

Um, but before I bring Mark up, what I wanted to do is make sure you see we put the QR codes on the, the sides for your CLE credit. And I wanted to let you know it's being recorded. One of the goals for the two universities is to make sure that we, you know, we retain the knowledge.

So if you're asking questions in certain sessions, just remember that. We'll get the mic to you so you can ask them so we can keep all of this. So with that in mind, I'm gonna get this started, and Professor Mark Lemley from Stanford.

(applause)

[MARK LEMLEY]

All right. Thanks everybody for coming.

So most of you, I think, have done this with me before. Uh, and so you know the deal, which is I'm gonna go through everything that happened in the Federal Circuit over the last year pretty fast because there's a lot that happened in the Federal Circuit last year.

You do not need to take notes. There is a paper that has all of these cases, with the exception of, I think, one that was decided on Tuesday.

I'm basically gonna kind of follow through in order. Um so overall uh, there's a lot of interesting stuff going on, more than in maybe in the last couple of years in the Federal Circuit, although I would say it is, for the most part, normal science, right?

Uh, there are some interesting things you need to know about, but they are basically, we are not, the Federal Circuit is not fundamentally rewriting the rules of patent law as we've seen the Federal Circuit or the Supreme Court do in, in previous years. This year, that appears to be the job of the Patent Office. More on that later this afternoon and tomorrow. So we got a lot of cases that fit in sort of what I think of the heartland of patent law.

There's a lot of written description, there's a lot of obviousness, there's a lot of claim construction, damages, so we'll talk about some interesting things.

[WAYNE STACY]

Let me start, as always, with patentable subject matter. And here, as it has for the last several years, things have settled down into a pretty predictable pattern. You might not like the pattern and the cases don't always get the results right, but they have a pretty basic feel to them that we've seen recur for each of the last several years.

Uh, so in Rideshare versus Lyft one thing the court notes and this has, it has said several times but it is worth repeating: the patentable subject matter eligibility guidance that the PTO issued in 2019, which basically tried to sort of change the law a bit of patentable subject matter, it is not the law. The court is not bound by it, it does not follow it. So you might get a patent using that guidance, that does not mean your patent is valid under 101. The Federal Circuit is not gonna give it deference.

And here in Rideshare, the court says as it has in many cases you get a, you'll, you'll survive patentable subject matter if your invention changes the way the technology functions in the computer environment. But if it just uses a computer in its ordinary way, invoking the computer as a tool then it's not patentable.

And that's what the court said here in the in the Rideshare context. It said something similar in the United Service SS-- versus PNC Bank case. Here, the invention is depositing a check using a handheld mobile device. The court said, "You know what?

That could conceivably be a new and patentable invention if you've got some novel way of improving the technology, but you don't have that novel way of improving the technology in the claims." And so here's the second thing that we see again and again in 101 cases, right? If you point me, if you wanna point me to kind of novel technology that changes the way the thing operates, you've got to actually find it in the claims.

It's not sufficient to say, "Somewhere in my specification, I came up with a novel algorithm, but I didn't limit my patent claims to that algorithm." Uh, also of note is Recentiv Analytics versus Fox.

Uh, this is of note primarily because it is the first AI case to make it to the Federal Circuit under 101. The patent fails under 101, but it doesn't fail because it's AI, and it is not an indication that AI is not going to be patentable. It fails because the inventor here doesn't actually claim that they did anything novel with AI. They claim they used existing AI technologies, and the court says, just as using existing computers as a tool, using existing machine learning algorithms as a tool is not gonna be sufficient to get you patentable subject matter.

Outside the computer context, of course, things are somewhat different. So the notable case here is US Synthetic versus International Trade Commission. And here the claim was to a

chemical a polycrystalline diamond compact, an actual material. The ITC said, "You just defined that material in broad functional terms, and so that's an abstract idea."

And the Federal Circuit said, "No, it's a physical thing. It can't be an abstract idea," right?

Abstract ideas don't apply to products of nature, right, or other physical products. There might be other challenges you could bring to that claim, but patentable subject matter is not gonna do it. All right.

Definiteness. You'll recall if you've been here before, a couple of kinda basic things that we see recurring in definiteness. One of which is the software means plus function language cases, right?

If you write your claim in means plus function format in the software world, you've got to show me an algorithm in the specification as the corresponding structure. And you might think you have not written your patent in means plus function format because you didn't use the magic words, means for doing X, but the Federal Circuit has repeatedly told us, "If you give us language that is functional, that doesn't have structure the mere existence of so-called nonce words like mechanism or means, is not gonna take it out of means plus function." That's true in *Fintiv versus PayPal*, where the patent claim term is payment handler. The court says, "A payment handler is not a thing, it's simply anything that handles payments.

Handler here is a nonce word telling you some way of handling payments, and so we got to treat it as means plus function. We gotta go look to the specification in order to find an algorithm." And there we don't find an algorithm, we find instead a description of the results of applying an algorithm. Court says, "That is not sufficient.

You've got to actually give me the algorithm itself." In *Sierra Wireless versus Sysvel*, the court confronts the interesting problem of two limitations in a patent claim that appear to be mutually exclusive.

[MARK LEMLEY]

The PTAB here said, "Claim is indefinite because it says, 'Do X and don't do X.'" Uh, Federal Circuit says, "No, that's not indefinite. It's quite clear.

It says, 'Do X and don't do X.'" Um, right? That's so we reverse the indefiniteness rejection. It's hard to imagine there's anything the patent claim actually covers, but you got your invalidity rejection reversed, so yay, I guess for the patent owner. And final point and the other sort of case that we see here in definiteness coming around a lot are value judgment terms.

So in *Akamai versus Media Pointe* the relevant uh claim language refers to the optimal or best way of doing something. Pick the optimal or best path for routing. And the court says, "I got no idea what the best path for routing is." If you just as in other cases where you've told me, sort of make something attractive, there's no way for us to judge that and therefore it's indefinite.

That's particularly true in this case, the court says, because there are multiple different possible answers to the question of what is best. And the patent itself gives us different and conflicting guidance. There are different things you could choose, and the patent claim simply doesn't choose it.

All right. Written description.

This is actually probably the sort of biggest development in the year. There is a lot of activity in written description.

Uh, it is almost all invalidating patent claims, and a remarkable number of the cases are cases where the Federal Circuit reverses the refusal of a district court to grant a JMOL after a jury had found no written description violation. Now, given that written description is nominally a question of fact, although no one actually really believes it is treated as a question of fact, this should be a truly extraordinary thing, but it happened no less than three times this year in the Federal Circuit. Uh, so we'll start with Duke University versus Sandoz, one of the reversals of the, of the jury verdict and the denial of JMOL. This fits in a category of cases that we've seen a lot since Amgen versus Sanofi, both in enablement and in written description, which is you've got a whole, you've got a, a patent claim that covers a reasonably broad genus, right?

There's a whole bunch of things. Here it's over 4,000 compounds that might cause hair to grow.

[WAYNE STACY]

You don't actually tell us which ones will work and because you haven't given us either a representative number of species that do work or a structural feature that's common to the ones that work and distinguish them from the ones that don't, you have not described the full scope of the genus and so you can't have a patent claim to the genus. The court here talks about, has talked, I've always talked about blaze marks, right? Give us kind of signposts or blaze marks along the trail that help us to find the ones that will work and the ones that don't work. Here they take that metaphor perhaps to an extreme extent saying "The patent did not provide sufficient blaze marks to direct one to the proposed tree in particular and doesn't teach the point at which one should leave the trail to find it."

Brita versus International Trade Commission. Here's a written description violation that's about the kind of reaching beyond the things you actually did effectively describe in the claim to cover some things you didn't. So this is the Brita water filter that you're probably familiar with. The gravity flow filter technology, the court it describes kind of flowing through carbon to filter out impurities in the water.

But the patent claim says, covers various types of filter media including carbon blocks. And the court says, "You absolutely enabled and described carbon blocks in your specification." Your patent lawyer got a little greedy and they said, "We don't wanna limit ourselves to carbon blocks, maybe there are other kinds of filters, but you didn't actually give us any information about those other kinds of filters." And so that broader claim fails for written description because we don't know you don't possess other kinds of filters.

In Mondis versus LG Electronics similarly kind of a reach beyond question, here there's a patent claim that originally says, "An identification number for said displayed unit." There's a rejection on prior art grounds, and they change the patent claim to say, 'At least a type of display unit.' And the court says, "Well, you've broadened the universe here, right?" So now it could cover other things besides a type of display unit. "But you haven't told us what those other things might be," because it wasn't in the specification, it was changed in prosecution. And therefore, the court says, 'Lack of written description,' because you don't tell us what else might be covered by the words, at least.

Case decided Tuesday, Seagen versus Daiichi Sankyo, another case in which the Federal Circuit reverses both a jury verdict finding no written description and a refusal to grant JMOL. Um, eh, and in the-- in the Seagen case here again, we've got a large genus, the court says covers potentially at least 47 million different pep-- uh, peptides.

"you haven't actually taught us kind of which of the 47 million different peptides are the ones that would work. You've kind of given us sort of Markush groups that you could just draw from without telling us what'll work within each. And therefore, as of the time that you did this, you can't claim priority to your invention 'cause you didn't have adequate written description."

It does not help in this case that the named inventors admitted they didn't actually contemplate the defendant's product, right, which is within the scope of the claims. And in fact the patent claim was changed in the course of prosecution only after the defendant invented the thing in question, right?

So, this is one of the cases where we've seen people try to expand their patent claims to cover what the defendant is doing. And those are, I think, particularly likely to run into written description problems. All right.

(papers rustle)

In re Xencor is an interesting one. This is a case the f-- the Patent uh, Office had originally rejected the claim as a means plus function claim on the theory that means plus function claims always fail written description because they cover the structure actually disclosed and equivalents thereof, and you didn't describe the equivalents thereof.

That can't possibly be right. And I and some other people wrote a brief on appeal on the first appeal saying, "That can't be possibly right."

Patent Office actually agreed, changed its mind, pulled it back, but it nonetheless still rejected the claims on other grounds. Uh, here, the Federal Circuit reverses uh sorry, sorry, affirms the PTAB's finding that there's lack of written description, and the reason there's lack of written description here is that the preamble for the claim which is written in Jepson format talks about treating a patient with a disease, and here's my improvement.

They actually do describe the improvement, but the court says interestingly, they don't have any possession or written description of the preamble, the stuff that's supposed to be in the prior art. You don't tell us what disease you're treating a patient for. It's the sort of kind of general treating of a patient with something and so it's a kind of very curious case where the court says, "It's not the novel part of your invention that you failed to describe, it's the stuff that supposedly everybody knew that it was in the prior art, but you gotta describe that too, even though it's in the preamble or you lose."

Final written description case, and finally a patentee win, In re Entresto. Here the patent claim says two drugs are administered in combination. The patentee sort of, you gotta puts them both in a, you know, here's a pill, here's a pill, take them both. The defendant complexes them, kind of puts them together into a single integrated form.

The court says, the patentee sues the defendant. The District Court says "Hey, you violate written description because you didn't actually talk to us about complexing the drugs, 'cause it

wasn't actually known that you could complex the drugs at the time you filed your patent application." Federal Circuit reverses, they say, 'No,' right?

What the patent says is, 'Put these things in combination. Taking two pills is putting them in combination.' That was all that was required to be described because it was all that was understood from a combination at the time you filed your patent application. And you're not required to do the impossible, which is provide written description for something that doesn't yet exist.

It's gonna be, I think, an interesting question, right, whether you can nonetheless then sue the defendant who does this different form that was later developed. In previous cases, Chiron versus Genentech, for instance, the Federal Circuit had suggested that that might violate written description.

Entresto says, no. And I think Entresto's right about that, right? So you shouldn't be required to describe something that hasn't yet been invented although it might be the case that there are other doctrines that will prevent you sort of reaching it. All right. Enablement, Agilent versus Synthego.

And here the disclosure is that I argued and lost this case on behalf of the patent owner so anything that sounds like sour grapes probably is. So here it's a patent to a CRISPR-Cas9 system for gene editing. The court invalidates it on the basis of a piece of prior art, which is an unpublished patent application that the prior art inventor never got to work but which sort of kinda gives a laundry list of, "Here are all the possible things you could do," right?

"we didn't actually, we tried it, the thing, it didn't work. We didn't actually get anything to work."

One of the sort of millions of things that you could do turns out to be the one that the patentee did. All right. Now I think if you were trying to sort of get a patent on that basis, and you would've failed all of the written description cases we just talked about.

But the court says, "Enablement for 112 purposes is different than enablement or written description for getting your own patent." First off, you don't have to enable someone to make and use.

It's enough to make it. "And you told us you could make these enormous array of chemicals, one of which turns out to be the one that the patentee figures out works.

And we also presume that written documents are enabling for 112 purposes." All right?

So the court says, in part on that basis and in part based on sort of factual findings in the PTAB, this is enabling because it told us here are things that might work even though the prior art never actually got it to work. All right. Novelty. Here I think the case I wanna focus on is Lynk Labs versus Samsung.

This is a case that's at the Supreme Court right now on cert, although the odds of it or any patent case being granted on cert are pretty low. Supreme Court has not taken a patent case in three years. Here the question is, what's the effective date of a prior art patent application in the PTAB in an IPR proceeding?

You may remember IPR proceedings. They're things we used to do to challenge patents and the. And the sort of interesting legal question is this, right? We know for in litigation that the effective date of a patent application is the date you file it as prior art.

So you file it, it is prior art as of the date you file it. The IPR process allows you to challenge on the basis of patents and printed publications. Here, the prior art application is ultimately abandoned.

It is published but it never actually turns into a patent. So it's not a patent. It is a patent application, which is not expressly listed in the list of things you can cover in IPR.

It is a printed publication, but it's published, of course, 18 months after it's filed. Nonetheless, the Federal Circuit says, right, "Patent applications in the PTAB oughta be treated as having the same prior art date as patent, as same patent applications in court which is as of the date you file the application, it's prior art."

Therefore, this is prior art, and therefore the LinkLabs patent is invalid." I mean, I think that's right.

It certainly is a policy matter. It seems weird to say we're gonna treat the same prior art differently in IPR and others, but I, you can imagine the Supreme Court looking at this and saying, "Gosh, it says patents. It doesn't say patent applications. So we're not gonna count it."

We'll see. All right. Obviousness. Let's talk about Bayer versus Mylan.

Here, interestingly, the court affirms the Board's finding that the phrase clinically proven effective was non-limiting where you didn't actually add any new and non-obvious functional relationship with an already-known method of treatment. So this is one of the class of pharmaceutical evergreening cases.

So I already have a drug. I have a patent on the drug.

The patent is expiring. I'd really like another patent on the same drug. So I file a patent that says that same drug I've already been using where it is clinically proven effective.

And the court says, "That's actually not a new real limitation. That's something that sort of could create to make your new invention non-obvious. All you've done is sort of discover or claim something that was already part of that product." You already had the chemical.

You were already using it. Adding that claim seems like really an inherency problem.

The court notes the evergreening problem, right? "we gotta prevent the indefinite patenting of known products and methods," it says, "by the simple inclusion of novel yet functionally unrelated limitations.

And we don't want you to 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." And that seems kind of right as a policy matter. All right. Ankura versus Roku.

This involves secondary considerations and the importance of the nexus evidence. So you may recall if I wanna prove secondary considerations like commercial success, I've actually got to show that the patent was the reason for the commercial success.

In *Ankura*, the court says that nexus requirement is much weaker, much more attenuated where the evidence is not commercial success but licensing. Because it says, "Look, the reason people license patents is because of the patented features and the inventive features, so we can presume that there's a nexus between the sort of patented features, the novel features of the invention and the reason you bought it."

They do note the sort of fact that sometimes people have been known to take licenses and patents in litigation like this one was to avoid nuisance value settlements. And here what they say is, "We don't think that is this case because the settlement value in the prior license far exceeds the cost of litigation even though the defendants were aware of the prior art." So the previous defendants in the case who had the same arguments and could have made it obvious were willing to pay a lot of money to license this. That seems like evidence that it is non-obvious.

At least it was non-obvious to that particular defendant. All right. Claim construction. Lots going on in the world of claim construction.

I'll start with *Aortic Innovations versus Edwards Life Sciences*. This is one of several cases where we see the patentee treated as their own lexicographer." Here the relevant claim language is outer frame and the Arctic patents define outer frame to include both serial and dual frame embodiments.

But they consistently refer to the outer frame as a self-expanding outer frame. And the court says, "By consistently using the term self-expanding to describe and define a outer frame, you have acted as your own lexicographer. People would understand this to mean only self-expanding frames, and so that's what your claim is limited to." In *Barrett versus Fortress Iron*, the patent claim term in question is non-integral bosses.

I think we've all probably had some non-integral bosses in our lives, but these non-integral bosses involve sort of fastener attachments, and the question is is the patent claim limited to fastenerless bosses? Here the court says, "You haven't clearly and unmistakably disclaimed bosses with fasteners in the patent specification itself. But in the course of patent prosecution, you ultimately do affirmatively disclaim them."

What's notable about this is that the prosecution in question is not the prosecution of this patent. It is the prosecution of another patent in the same family, and it is the prosecution of another patent in the same family that happens after this patent is already issued. So the patent is already issued with the term non-integral bosses.

Later, in another family member, you say, "Oh, no, that doesn't include ones without fasteners." And the court says, "We can apply that retroactively to this patent too," 'cause they're all part of the same family, and so they're part of the kinda same prosecution history. So important kind of prosecution safety tip, right? Anything you say can and will be used against you, not only in this case, but in your own prior cases that are part of the same family.

All right. *Fmc versus Sharda*.

Here the sort of question is is the term composition limited to stable compositions in an insecticide patent? There's a bunch of disclosures about the importance of physical stability in the provisional application but the patentee takes them out when they file the actual application.

And the court says, "The fact that you changed from the provisional to the final is highly significant in interpreting the terms. It suggests that it doesn't have to be limited to stable compositions. You affirmatively changed your patent to broaden it.

You probably lost priority in the course of doing that to your provisional application. It's a new thing, and you're adding you're broadening the scope of it, but as of the date that you file your new application, we're not gonna bind you to things you once said in the provisional, but have affirmatively walked away from later.

Uh in LabCorp versus Qiagen the uh, here is just a sort of useful reminder that the Federal Circuit tells us time and again, and as district courts seem to keep forgetting if there is a dispute about patent claim uh, meaning, it is a dispute for the court, and the court needs to resolve it even if it happens after the Markman hearing. You can't send it to the jury.

In this case, the relevant claim term was identical. Uh, the Federal Circuit says, "The jury can figure out what identical means and allows the patentee to argue that identical might mean identical to a portion rather than the whole thing." Uh, Federal Circuit says, "Identical means the same. It doesn't mean identical to a portion.

Uh, that claim construction is wrong, but more to the point, the jury shouldn't have been allowed to hear claim construction, because that's not something juries are supposed to do. All right.

Um, Eyetherapies versus Slayback. Um, this is uh, the Federal Circuit says, "This is another kind of lexicographer change your meaning." Here you changed the meaning of the phrase consisting essentially of.

This causes me personal pain, because I feel like there are only three claim terms in all of patent law that have settled established meanings, right? Comprising, consisting of, consisting essentially of. And now you said, "Well, sometimes when you say consisting essentially of, you don't actually mean what we always understand consisting essentially of to mean." The facts are a pretty good case for that, right?

So here I was supposed to exclude a particular chemical ingredient in addition to the one I was claiming. Patentee, the Patent Office said, "Hey, prior art had this one. I want to exclude the other ingredient," so the examiner and the applicant agree that we can do that by changing the claim preamble to consisting essentially of, which should get rid of non-essential ingredients. Patentee then turns around and says, "Oh, I should be able to cover this additional chemical because it's not essential."

And the court says, "No, you've essentially disclaimed any effort to reach the very chemicals that you got rid of before. All right. Um Alnylam versus Moderna.

This is the COVID vaccine patent litigation. Here's another lexicographer case. So the patentee says, "I didn't intend to limit branched alkyls to particular embodiments." It turns out if you wanna argue that you are not acting your own lex-- as your own lexicographer, you should

not in the patent write a section called Definitions, highlight the term uh, and then set it off in quotation marks with a specific quoted definition of the term uh, which is exactly what happened here.

[MARK LEMLEY]

Not surprisingly, the Federal Circuit found that you had here quite expressly acted as your own lexicographer. All right. Um, uh, versus Abiomed, just note the Federal Circuit says if I have-- If I actually engage in prosecution disclaimer with respect to one claim term, doesn't necessarily mean I have disclaimed the same con-- uh, with respect to other patent claim terms if those patent claims are different. That seems right to me here.

All right. Um, Kids2 versus TOMY.

So this is a patent on a kid's bath for like small infants and very small children. Uh, and so there are two patent claim construction issues that divide the Federal Circuit. One is distal edges joined at a bottom surface apex.

So got edges and they are joined at a bottom surface apex. Federal Circuit says, "Eh, joined, it doesn't mean they actually have to touch each other," right? There could be something in the middle. So in this case, it's a distal edges, and there's something in the middle, and the court says the something in the middle is the thing that's joining them, and so they are joined.

The second issue is a raised portion of the bottom surface that prevents a sliding child from sliding down, whether that constitutes a seating surface. There's basically a little kind of lip that prevents the kid from sliding down into the water and drowning, but it's about that big. Uh, and the Fed-- Federal Circuit says, "Yeah, that could be a seating surface."

Uh, Judge Chen in dissent says, "No, a seating surface is something you sit on." It's not something that's sort of like, kind of like a speed bump in the way of kind of sliding down. But that's the dissent.

Also, in this case, the seating structure has to be two seating surfaces disposed at differing inclinations. Uh, here, the Federal Circuit says the flat bottom of the tub can be one of those inclinations.

Judge Chen, in dissent, says, "No, inclinations are things that kind of like go up," right? There ought to be kind of two different angles of up.

Zero is not an inclination. You could go either way on that, I suppose.

All right. Uh, infringement, um, Regeneron Pharmaceuticals versus Mylan.

[WAYNE STACY]

Here, the court says if you wrote two different patent claim elements, right? You sort of listed them out.

We will presume that the infringing product must include two different things as well. I'm not sure that presumption's actually justified anywhere in prior Federal Circuit case law, right? And so defendant here does one thing that performs both of those functions. And the question is, right, can that satisfy both of those claim elements?

Court presumes that the answer is no. Now here, it turns out there's some evidence in the kind of specification that suggests that we really were thinking about two different things. Uh, but I'm not sure the court is right to say there's a, there's a presumption here.

All right. Doctrine of Equivalence Colibri versus Medtronic involves prosecution history estoppel. And here, the useful thing to note, which I think is consistent with what the court has said in the past but it is worth remembering prosecution history estoppel applies if I narrow my patent claims, all right?

One way the court says you can narrow your patent claims is to cancel a broader independent claim, all right? So that has always been true I have an independent claim and then I have a narrower dependent claim.

I cancel the independent claim, and I promote the new dependent claim. It is narrower.

I didn't actually physically narrow that claim, but I narrowed the sort of broader scope. In Colibri, the court says that can also be true of two different independent claims. So if you have two possible ways here of pushing a valve out from a syringe and one is claimed in one way, the other is claimed in another way, and you cancel a claim to one of those two ways, you can't use your patent claim to the other one to try to get back the very thing you canceled, 'cause the very principle of prosecution history estoppel is if you wanted a claim to that one, you should've actually asked for it, right, and not given up when the Patent Office challenged it.

All right. Uh, International Trade Commission Lashify versus ITC I think cements the idea that when we talk about domestic industry practicing the patented invention, we don't really mean it. Um, so we changed the law like 30 some years ago to give up on the idea that we actually manufacture things in the United States, and now it's sufficient that you have a, a patent licensing business in the United States.

Uh, here in Lashify, the court says the domestic industry doesn't actually have to include people actually working on the patented invention itself. It's enough to include a domestic industry of sales, marketing, warehousing, distribution, quality control.

Your accountants are a domestic industry. Your lawyers are, if they work in-house, a domestic industry. Uh, anything that involves kind of some expenditure of money in the United States is gonna be sufficient to satisfy the, the domestic industry requirement.

All right, defenses. So here, we actually see some really significant changes.

And we're gonna hear a little more about these kind of later on in a panel today. But I think the court has effectively eviscerated both equitable estoppel and prosecution laches this year. In equitable estoppel in the Fraunhofer-Gesellschaft versus Sirius case the patentee knows about the defendant, does nothing for five years. Court agrees that's a that is silence despite clear knowledge of infringement that rises to the level of effectively misleading conduct.

All right. We know each other.

We've talked. I know you're infringing. I haven't done anything.

But the court says that's insufficient for an equitable estoppel because you, defendant, haven't proven that you-- know you engaged in kind of investment in this technology during that five-

year period. You haven't proven that you made that investment in specific reliance on silence from the patent owner rather than for other business reasons. I don't know how you prove that, honestly.

I mean, I guess maybe you could just sort of have lawyers always try to paper it, right? But you know, the reality of the situation is, right, I know there's a patent. I know the patentee hasn't sued me over a period-- a period of years. I decide to invest in a product that I would have thought was sort of what equitable estoppel looked like.

But now I have to prove you made a decision to invest in the product solely because the patentee had chosen to be silent in choosing not to sue you. That seems like a really hard burden to me. Also in the really hard burden to meet is prosecution laches.

In Google versus Sonos the the District Court finds that Sonos was guilty of unreasonable and in-inexcusable delay in the prosecution of their patents. Um, there is in fact a substantial period of delay, the Federal Circuit agrees with that. But the Federal Circuit says, "Yeah, but the patent application was published. And if the patent application was published, you should have known about it.

And if you should have known about it, you couldn't be prejudiced by the fact that it might turn out 12 years later that they would continue in prosecution and get this patent. And the practical effect of that, I think, is to make prosecution laches almost impossible to apply as a litigation defense, except in the extremely rare cases where the patentee like withholds from publication under the kind of rules that allow you to do that, right? If the patent application is published, I think you've now got to assume, even decades later, maybe a patent will come out, and there's nothing I can do about it. That doesn't mean there's no prosecution laches, but it probably means it's going to apply essentially only if the patent office tries to apply it in-house, not as a litigation defense.

One place where they did that is Hyatt versus Stewart. Gil Hyatt is still trying to get patents through from his 1995 pre-GAT applications 'cause then he'll get 17 years of protection. The patent office here throws out a bunch of applications there that are still pending after 30 years, and the Federal Circuit affirms. All right, remedies.

So here, interesting stuff going on in attorneys' fees. A lot of grants of attorneys' fees, including some decisions reversing a refusal to grant attorneys' fees in the District Court, which is pretty rare.

EscapeX IP versus Google is a great laundry list, here's your first ethics for the day, what not to do if you're a litigator. EscapeX sues YouTube Music as an infringing product.

It turns out that YouTube Music doesn't do the thing and they wanted to sue YouTube Video instead, so they ultimately have to sort of like drop it and sue YouTube Video. Then it turns out that YouTube Video's actually been doing this since before the patent was ever issued, which is a bit of a problem for your validity theory. Then it turns out that your patent has already been held invalid under 101 in a different court in a different litigation.

So all of that seems maybe a reason to abandon and run away. So to do that, EscapeX files a 'joint stipulation of dismissal,' where each party pays their own attorneys' fees, but they forgot to ask Google to sign the joint stipulation of dismissal, and Google did not in fact agree, that it would bear its own fees and costs. So when Google files a motion, they then double down,

filing a Rule 59 Motion for Reconsideration of the fees order, coming in to try to sort of argue that really all of this was effective.

On appeal, that fails. On appeal, they actually come up with what seems like, if it were factually true, might be a plausible argument on the merits. But it turns out they didn't raise that argument at any time in the District Court, and so the Federal Circuit says it's waived. And the Court also notes that they didn't bother to respond to Google's efforts to meet and confer that might have resolved this.

Court is very clearly happy to sort of grant fees and to grant fees on the reconsideration of fees motion, which it said was frivolous, and you should have just kind of cut your losses uh, back then. In FutureLink versus Realtek, here the Court reverses the denial of attorneys' fees.

This is an interesting case which has got some antitrust implications, in which turns out in the course of litigation that FutureLink had entered into a contract with a third party, MediaLink, in which MediaLink agreed to pay it a bunch of money if it would go sue the defendant. And that's potentially problematic. The District Court sanctions them for failing to have told us of this by turning a voluntary dismissal without prejudice into a voluntary dismissal with prejudice.

The Court, Federal Circuit says that makes the defendant a prevailing party. A voluntary dismissal with prejudice, even if it's kind of now involuntary, means the defendant is a prevailing party, they can't be sued again, and so they are entitled to their fees.

The PS Products versus Panther case also involves not only the award of attorneys' fees but deterrence sanctions, that is sanctions of more than the defendant actually paid in attorneys' fees under the inherent power of the Court. Here, there's utterly baseless litigation. They filed 12 different lawsuits.

There's a bunch, again, of bad facts. But the Court says you're not actually limited to this section 285, recover attorneys' fees; you can actually get additional sanctions, punitive sanctions, as a form of deterrence. All right. Damages, Rex Medical versus Intuitive Surgical.

Patentee wins a case and the jury gets \$10 million. District Court cuts that to \$1 which is rather less than \$10 million, right? Because it throws out the plaintiff's expert pre-trial under Daubert because the plaintiff's expert failed to do apportionment. Nobody puts on any evidence of damages at all in the course of the case.

In closing, plaintiff says, "We'd like \$10 million." Jury says, 'Sure, here's \$10 million.' District Court says, 'No, there's no evidence I'm reducing this to \$1.' So, interestingly so the Federal Circuit, the patentee on appeal says, that's not just a remittder, that's really a JMALL, no damages JMALL." And the Federal Circuit says, 'Yeah, we agree.' And it was right to do that, because you don't actually have any evidence of patent damages. Now this is interesting, I think, because it is a key shift in Federal Circuit law.

The Federal Circuit has traditionally said, 'There's always some amount of money to compensate a patent owner.' But here they are willing to say, 'You know what? If you really don't have any evidence, a dollar is enough.' I will also notice as a practice matter patentee makes the wrong argument here. If it is a remittder under remedies law, you get to choose, 'Do I want to take the \$1 or do I want a retrial on damages?' By arguing that, 'Hey, you've effectively ruled against me on JMOL,' I think they give up their possibility to a retrial, and indeed they don't get one in response. The other sort of big thing in damages is that the big

thing that didn't happen in the Federal Circuit en banc decision in EcoFactor versus Google, which everybody expected was actually gonna do something of significance.

Turns out to do, frankly, not very much. It reverses a, I think, pretty clearly wrong decision from the panel and holds, I think correctly, that the fact that the patentee says "I believe that this small lump sum payment really constitutes 25% of royalty, ongoing royalty rate in a prior license." Where the defendant himself says, "I'm not agreeing to a royalty rate. I don't agree that it is, represents a 25% royalty rate."

That doesn't count as a royalty rate. It counts as a lump sum payment. Probably the bigger implication of EcoFactor, if we have one, is the court seems to take seriously the 2023 amendments to the Federal Rules of Evidence that strengthen the role of the judge in Daubert hearing.

So the courts, I think, are suggesting this is not a, 'Let it go to the jury and let them weigh the credibility question.' Federal judges need to be more involved in Daubert in deciding the merits of the kind of expert's theory. And I think that we're gonna see that happen and play out.

And we see that actually play out in some of the other cases since. All right. I do wanna flag Optus Cellular versus Apple and a couple of other cases.

There are now, in this year, there are three cases where, for various reasons, the district court, the jury trial in multiple patents part of that jury trial gets overturned or vacated. And then the Federal Circuit says, "We gotta throw out the whole thing because we don't know, since you used a general verdict, right, which was you know, what the, what the damages base was dependent on." This too is a really significant change in how the Federal Circuit has done these things.

Federal Circuit has always gone out of its way to say, "We're gonna try to find any way to sustain the jury verdict." And so, if there were three patents and one's invalidated, eh, there's still two patents and they cover the same defendant's product.

Maybe we can afford this affirm the damages award. Now we're doing the opposite. Three separate cases this year where the court says, "If it's a general verdict and we can't tell which part of it was at issue we're gonna have to throw out the whole thing and do it again."

And I think that's a strong push towards special verdicts and not general verdicts. All right.

I am running out of time, but I do wanna flag one or two additional things. Uh, so MGEIMA versus Philips, another one of those cases. The sort of final thing I wanna flag, I think, involves a series of issues.

I'm mostly not gonna talk about PTAB prosecutions 'cause we're gonna hear a lot about that later. But I wanna flag a series of issues around estoppel.

Right? So you've got Croy versus Groupon.

Uh, Croy Holdings versus Groupon where the court says well the decision of the PTAB uh, is not given collateral estoppel effect the, in the court because the standards of proof are different. All right?

The fact that there's a decision of a PTAB holding a patent invalid is made under a preponderance of the evidence. That doesn't tell us whether in court the same issue in a different patent would be invalidated under clear and convincing evidence. There's a dissent from denial of rehearing en banc by Judges Dyke and Hughes. Um, the Ingenico versus IO Engine involves the sort of scope of estoppel for IPRs.

And here the court says "The only things that are estopped, that you can't bring in litigation, are the things you could have brought in IPRs." That's what the statute says.

You could have brought only patents and printed publications. You could not have brought on sale or public use or kind of non-publication prior art. And so you are not estopped from making those arguments in court, even if you lost in the IPR, and even if it's really parallel art.

It's really the same thing. So, if you've got a publication and a sale, right, you might in fact get two bites at the apple, which I guess is probably good since you weren't gonna win your bite at the apple in the PTAB these days.

And finally there In re Juster Technologies decided on Monday. Also potentially important as we think about what happens in a post-IPR world. The Federal Circuit says, "IPR estoppel doesn't bar ex parte reexams." So even if you lost in an IPR, even if you lost in litigation, you can bring an ex parte reexam.

There's just not an estoppel effect there 'cause the statute doesn't provide for one. All right.

With that, I will stop. And I look forward to the rest of the conference.

(applause)

Letter of __ Law Professors and Public Citizen in Opposition to "USPTO's proposed rule changes for inter partes review, Docket No. PTO-P-2025-0025."

November 30, 2025

As professors and scholars of intellectual property law, we oppose the proposed changes to severely narrow the ability of the public to challenge a patent's validity through inter partes review (IPR) proceedings at the U.S. Patent and Trademark Office (PTO). Those proposed rule changes would violate the law, increase the cost of innovation, and harm the quality of patents.

The IPR process has been an extraordinary success. In the fourteen years of the program, the PTAB has resolved more than 14,000 petitions, many more disputes than have been resolved in court during that period. The IPR process is much cheaper than litigation (roughly 20% of the cost of trial), faster than litigation, and produces overall results (a 40-45% total invalidity rate depending on how one counts) that are indistinguishable from the results in court cases.¹ See Christian Helmers & Brian J. Love, *Patent Law Reform and Innovation: An Empirical Assessment of the Last 20 Years*, International Review of Law & Economics, vol. 79, article 106210 (2024), <https://www.sciencedirect.com/science/article/abs/pii/S0144818824000309> (empirical research finding that PTAB had a positive effect on innovation, as measured by R&D spending and patent filings by publicly traded companies).

Unfortunately, the new leadership of the PTO seems determined to undo this dramatic success story. The proposed rules violate the law and common sense.

The proposed addition of paragraph (d) to amend 37 CFR § 42.108 would deny IPR petitions unless a challenger waived their prerogative to challenge the patent's validity in litigation. Disturbingly, this would bar validity challenges that petitioners could not even argue in an IPR proceeding. This is inconsistent with 35 U.S.C. § 315, which provides for a significantly narrower scope of impermissible overlap. This proposed rule is also contrary to cases interpreting that statute (see *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354 (Fed. Cir. 2025)).

The proposed additions of paragraphs (e) and (g) to amend 37 CFR § 42.108 would make it almost impossible for anyone to challenge patents after one prior validity ruling in U.S. district court, the U.S. International Trade Commission, a Patent Trial and Appeal Board (PTAB) final written decision, or an ex parte reexamination. The

¹ Since the beginning of the IPR process challengers have won in whole or in part 5,181 out of 11,511 completed proceedings, or 45.0%. If we exclude patents that are partially upheld (which is arguably a patent owner win rather than a challenger win) challengers win 4,234 out of 10,564 cases, or 40.1%. Data calculated from law.lexmachina.com/ptab/ on September 20, 2025. Those numbers are essentially indistinguishable from the invalidity rate in court, which is 42.4%. John R. Allison, Mark A. Lemley & David L. Schwartz, *Understanding the Realities of Modern Patent Litigation*, 92 Tex. L. Rev. 1769 (2014) (finding 42.4% invalidity rates in cases decided 2009-2013).

proposed revision would prevent everyone else from initiating an IPR proceeding even if the decision was not final, even if new or additional prior art was discovered or if new caselaw were established, and even if the challenger could not have brought a petition earlier.

The proposed additions of paragraphs (f) and (g) to amend 37 CFR § 42.108 would completely prevent an IPR proceeding if parallel litigation (U.S. district court, U.S. International Trade Commission, or a PTAB final written decision) were likely to conclude before the "due date for the final written decision" in an IPR proceeding. There is some merit to denying late petitions filed solely in order to open a second front after losing in court. Unfortunately, as dozens of Federal Circuit mandamus petitions have already documented, timing rules like the one proposed have repeatedly been abused by a few district judges seeking to retain control over patent cases. Courts that set unrealistic schedules and refuse to stay pending an IPR even after institution end up blocking even IPR proceedings the PTO has already determined are meritorious.

The proposed rule changes are merely the latest part of that attack on the Congressionally approved IPR process:

- The PTO has adopted a new, legally-unsupported "settled expectations" rule that prevents filing a challenge at all against 2/3 of issued patents and nearly ¾ of the patents that are actually being enforced;
- The Director has refused to institute a meritorious claim – one that the Patent Trial and Appeal Board (PTAB) judges and even his own deputy found worthy of review – because while some claims were likely invalid other claims in the patent might not be. That too directly contradicts 35 U.S.C. § 314, which provides for review if at least one of the claims of the patent is likely invalid. And it undermines the Supreme Court's reading of the statute in *SAS v. Iancu*, which held that the AIA "suggests a regime where a reasonable prospect of success on a single claim justifies review of them all."
- The Director has suggested he will refuse to institute IPRs because of the nationality of the petitioner, a clear violation of the Constitution and due process.
- The Director has removed the PTAB from the role of deciding whether to institute IPRs at all. Instead, he announced that he would decide all the petitions himself, perhaps in consultation with PTAB judges in certain complex cases, while giving no explanation for the denials. It is not possible for the Director to make all the decisions in complex patent cases – unless the goal is to ignore the statute and just get rid of IPRs altogether. And indeed the Director has denied *every* one of the 91 petitions since taking review away from the PTAB.

The above proposed rule changes combined with the PTO administration's decision to disregard Congressionally enacted IPR procedures and the director's announcement that he will remove the PTAB from decisions on instituting IPR proceedings, demonstrate that the PTO administration desires to effectively eliminate IPRs by making it practically impossible to challenge a patent through initiating an IPR

proceeding. Indeed, Deputy Director Stewart quite clearly stated that that was her goal. Eliminating IPRs is against existing law. It is also terrible policy. It would reduce innovation and harm the quality of patents because fewer bad patents would be challenged, given the increase in time and money to do so. And it would significantly increase the cost and delay the owners of good patents face to resolve the validity of their rights. The only beneficiaries of this policy are the owners of invalid patents who hope to take advantage of that cost and uncertainty to extort nuisance-value settlements. That is not and should not be the purpose of the patent system, and the PTO should not encourage bad patents at the expense of good ones.

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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.⁴ 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.”⁵ 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.⁶ 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*.”⁷

At *Alice* step two, the court “disagree[d] with the Board’s conclusion” that the claims were “directed to a technological solution.”⁸ Instead, the court found that the technology was ineligible because it did not “fundamentally alter or improve the way the technology itself functions.”⁹ 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.”¹⁰

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.¹¹

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

⁵ *Id.*

⁶ *Id.* at n.2.

⁷ *Id.*

⁸ *Id.* at *6.

⁹ *Id.*

¹⁰ *Id.*

¹¹ *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.¹² 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.”¹³ 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.”¹⁴ Moreover, the claim lacked “any clear description of how these processes are performed,” instead providing only “a *concept* of improving the check deposit process.”¹⁵

At *Alice* step two, the court concluded there was “no inventive concept that would support patent eligibility.”¹⁶ 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.”¹⁷ 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.¹⁸

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.¹⁹

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.²⁰ 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.”²¹ Instead, “the only thing the claims disclose about the use of machine learning is that machine learning is used in a new environment.”²² Finally, it was

¹² *Id.* at 1337.

¹³ *Id.*

¹⁴ *Id.* at 1337-38.

¹⁵ *Id.* at 1338 (emphasis in original).

¹⁶ *Id.* at 1339.

¹⁷ *Id.*

¹⁸ *Id.* at 1339-40.

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

²⁰ *Id.* at *4.

²¹ *Id.* at *5.

²² *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.”²³

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.²⁴ 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.”²⁵

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.²⁶

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.²⁷ 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.²⁸ 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 101.²⁹ Indeed, the court affirmed that “no perfect proxy is required between the recited material properties and the structure of the” claimed composition.³⁰ 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.³¹

²³ *Id.*

²⁴ *Id.* at *7.

²⁵ *Id.* at *8.

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

²⁷ *Id.* at 1282.

²⁸ *Id.* at 1283 (quoting ITC order).

²⁹ *Id.* at 1283.

³⁰ *Id.*

³¹ *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.³² 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.³³ Instead, based on the “plain and unambiguous language” of the claim, the Federal Circuit held that, to fall within the claim, the practiced method must include both limitations.³⁴

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.³⁵

The claims related to “cloud-based transaction systems” with the term “payment-handler” appearing throughout the claims.³⁶ 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.³⁷ “Payment-handler” was construed as a nonce term that could have referred to many different kinds of structures.³⁸ 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.³⁹

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.⁴⁰ 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.”⁴¹

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

³³ *Id.* at 1022.

³⁴ *Id.*

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

³⁶ *Id.* at *1.

³⁷ *Id.* at *3.

³⁸ *Id.*

³⁹ *Id.* at *4.

⁴⁰ *Id.* at *5.

⁴¹ *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.⁴²

Duke and Allergan Sales, LLC sued Sandoz for infringing their ‘270 patent related to “treating hair loss using compositions containing prostaglandin F (‘PFG’) analogs.”⁴³ 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.”⁴⁴ 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.⁴⁵

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.”⁴⁶ Duke effectively conceded the first point because “the ‘270 patent does not expressly disclose even a single embodiment of claim 30.”⁴⁷ 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.”⁴⁸ 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.⁴⁹

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.⁵⁰ 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

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

⁴³ *Id.*

⁴⁴ *Id.* at *2.

⁴⁵ *Id.*

⁴⁶ *Id.* at *3-4.

⁴⁷ *Id.* at *4.

⁴⁸ *Id.*

⁴⁹ *Id.*

⁵⁰ *Id.*

encompassing “a vast number of options for C1.”⁵¹ Similarly, the eight categories of options at the Z position contained further “embedded choices.”⁵² 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.”⁵³ 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.”⁵⁴ As such, Sandoz overcame “the doubly high burden of persuading us to overturn a jury verdict of no invalidity.”⁵⁵

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.⁵⁶ 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.⁵⁷ 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.”⁵⁸ The court declined to reach the issue of indefiniteness.⁵⁹

The Federal Circuit affirmed the Commission’s written description analysis. The specification did not describe or provide working examples of non-carbon-block filters.⁶⁰ 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.”⁶¹ 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.”⁶² 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.⁶³ Similarly, inventing a non-carbon filter meeting the FRAP requirements would

⁵¹ *Id.* at *5.

⁵² *Id.* at *6.

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

⁵⁴ *Id.* (quoting *Fujikawa*, 93 F.3d at 1571).

⁵⁵ *Id.* at *7.

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

⁵⁷ *Id.* at 1329.

⁵⁸ *Id.* at 1331.

⁵⁹ *Id.* at 1339.

⁶⁰ *Id.* at 1332-33.

⁶¹ *Id.* at 1333-34.

⁶² *Id.* at 1334.

⁶³ *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.”⁶⁴

The court also affirmed on enablement because the patent failed to provide a road map for non-carbon filters to meet the FRAP requirement.⁶⁵ 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.⁶⁶ 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.”⁶⁷

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.⁶⁸

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.⁶⁹ 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.⁷⁰

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.⁷¹ Rejecting Mondis’s reliance on the presumption of validity, the court found the patent clearly lacked adequate written disclosure of the “type” limitation.⁷² 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.⁷³

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.⁷⁴ 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

⁶⁴ *Id.* at 1336.

⁶⁵ *Id.* at 1337.

⁶⁶ *Id.* at 1338.

⁶⁷ *Id.* at 1338-39.

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

⁶⁹ *Id.* at *1.

⁷⁰ *Id.* at *2.

⁷¹ *Id.* at *4.

⁷² *Id.* at *5-6.

⁷³ *Id.*

⁷⁴ *Id.* at *7

an issued patent could later be invalidated for lack of written description.”⁷⁵ 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.”⁷⁶

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.”⁷⁷

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.⁷⁸ Although Regents’ scientists expressed uncertainty and proposed changes, the PTAB did not consider whether Regents actually made those changes.⁷⁹ 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.⁸⁰ The PTAB erroneously focused on the lack of an “operative invention” and on “perceived failures and doubts” during experimentation.⁸¹ 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.⁸²

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.”⁸³ 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.⁸⁴ 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.⁸⁵ Finally, the court rejected Regents’ challenge under the Administrative Procedure Act (APA), affirming that the Board “thoroughly considered both parties’

⁷⁵ *Id.*

⁷⁶ *Id.*

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

⁷⁸ *Id.* at 1378-79.

⁷⁹ *Id.* at 1379.

⁸⁰ *Id.* at 1379-80.

⁸¹ *Id.* at 1380-81.

⁸² *Id.*

⁸³ *Id.* at 1382-83.

⁸⁴ *Id.*

⁸⁵ *Id.* at 1383-84.

arguments and the evidence supporting those arguments” and thus was not arbitrary and capricious.⁸⁶

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.⁸⁷

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.⁸⁸

Claim 9 was a means-plus-function claim, directed to a method for treating patients with a certain antibody.⁸⁹ After construing the preambular term “treating a patient,” the Federal Circuit held that this was a claim limitation that was not adequately described.⁹⁰ 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.⁹¹

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.⁹² 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.”⁹³ 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*.”⁹⁴ 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.”⁹⁵ 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.”⁹⁶

⁸⁶ *Id.* at 1384-85.

⁸⁷ *Id.* at 1382.

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

⁸⁹ *Id.* at 1357.

⁹⁰ *Id.* at 1359.

⁹¹ *Id.* at 1360.

⁹² *Id.* at 1360-61.

⁹³ *Id.*

⁹⁴ *Id.* at 1361.

⁹⁵ *Id.* at 1362.

⁹⁶ *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.⁹⁷

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.⁹⁸

At claim construction before the district court, the parties disputed a single limitation: “wherein [the two drugs] are administered *in combination*.”⁹⁹ 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.¹⁰⁰ 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.¹⁰¹

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*.¹⁰² The court emphasized that the patent *did not* claim a complexed mixture, and thus, “those complexes need not have been described.”¹⁰³ In holding otherwise, “the district court erroneously conflated the distinct issues of patentability and infringement, which led it astray in evaluating written description.”¹⁰⁴ 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.¹⁰⁵ 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.¹⁰⁶

⁹⁷ *Id.*

⁹⁸ *In re Entresto*, 2025 WL 63577, at *1 (Fed. Cir. Jan. 10, 2025).

⁹⁹ *Id.* at *2.

¹⁰⁰ *Id.* at *2-3.

¹⁰¹ *Id.* at *4.

¹⁰² *Id.* at *5.

¹⁰³ *Id.*

¹⁰⁴ *Id.* at *6.

¹⁰⁵ *Id.* at *5.

¹⁰⁶ *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)¹⁰⁷

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.¹⁰⁸ In doing so, the court affirmed the PTAB’s conclusion that certain prior art—Pioneer Hi-Bred—was enabling.¹⁰⁹

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.¹¹⁰ 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. § 102.¹¹¹ 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.¹¹²

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.”¹¹³ 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.

¹⁰⁷ Full disclosure: Lemley represented Agilent in this appeal.

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

¹⁰⁹ *Id.* at 1327.

¹¹⁰ *Id.* at 1328.

¹¹¹ *Id.* at 1328-29 (quotations and citations omitted).

¹¹² *Id.* at 1329.

¹¹³ *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.¹¹⁴

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.¹¹⁵ 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.”¹¹⁶ 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.¹¹⁷ 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.”¹¹⁸ 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.”¹¹⁹

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.¹²⁰

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.¹²¹ 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.¹²² The Federal Circuit rejected this argument, emphasizing that product-by-process

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

¹¹⁵ *Id.* at 1375.

¹¹⁶ *Id.* at 1376-77.

¹¹⁷ *Id.* at 1377-78.

¹¹⁸ *Id.* at 1379.

¹¹⁹ *Id.* at 1380.

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

¹²¹ *Id.* at 947.

¹²² *Id.*

claims focus on the product itself, rather than the process.¹²³ 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.¹²⁴ And Restem had provided no empirical evidence that the prior art process would “inevitably” result in the products claimed by Jadi Cell.¹²⁵ Thus, the court affirmed the PTAB’s finding that the product-by-process claims were not inherently anticipated by the prior art.¹²⁶

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).¹²⁷

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, 2000.¹²⁸ 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.¹²⁹

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.”¹³⁰ 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.”¹³¹ 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.¹³²

¹²³ *Id.*

¹²⁴ *Id.*

¹²⁵ *Id.*

¹²⁶ *Id.*

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

¹²⁸ *Id.* at 1384

¹²⁹ *Id.*

¹³⁰ *Id.*

¹³¹ *Id.*

¹³² *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.¹³³ 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.¹³⁴ 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.¹³⁵

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.”¹³⁶ Thus, the court held, a published patent application is prior art “as of its filing date,” rather than the date of public accessibility.¹³⁷ 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).¹³⁸ 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.¹³⁹

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

¹³⁴ *Id.* at *2.

¹³⁵ *Id.*

¹³⁶ *Id.* at *3.

¹³⁷ *Id.*

¹³⁸ *Id.* at *4.

¹³⁹ *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.¹⁴⁰

The patents at issue were directed to a regimen for administering medications orally for multiple sclerosis.¹⁴¹ Merck conducted clinical trials in partnership with a manufacturer, Ivax, who was responsible for developing an oral dosage formulation for use in those trials.¹⁴² Merck shared confidential information, including a dosing regimen, in December 2003.¹⁴³ Two Ivax employees filed for an international patent (“the Bodor patent”) disclosing a particular dosing regimen; the application was published in October 2004.¹⁴⁴ Merck filed the applications for the at-issue patents two months later, listing four Serono employees as the inventors.¹⁴⁵ 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.”¹⁴⁶ Merck argued that the Bodor patent should be precluded as prior art because one of its employees, De Luca, was an unlisted co-inventor.¹⁴⁷ But the Board rejected this argument on both legal and factual grounds.¹⁴⁸

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.”¹⁴⁹ Incongruity of identity “renders the prior disclosure ‘by another,’ regardless of whether inventors are subtracted from or added to the patent.”¹⁵⁰ 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.¹⁵¹ 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

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

¹⁴¹ *Id.* at *1-2.

¹⁴² *Id.*

¹⁴³ *Id.* at *2.

¹⁴⁴ *Id.*

¹⁴⁵ *Id.* at *3.

¹⁴⁶ *Id.* at *3-4.

¹⁴⁷ *Id.*

¹⁴⁸ *Id.* at *4.

¹⁴⁹ *Id.* at *10.

¹⁵⁰ *Id.*

¹⁵¹ *Id.* at *7.

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

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.¹⁵⁴ 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.¹⁵⁵

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.”¹⁵⁶ 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.”¹⁵⁷

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.”¹⁵⁸

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.¹⁵⁹ 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.¹⁶⁰

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

¹⁵² *Id.* at *7-8.

¹⁵³ *Id.* at *11.

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

¹⁵⁵ *Id.* at 1404.

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

¹⁵⁷ *Id.* at 1404-1405.

¹⁵⁸ *Id.* at 1405.

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

¹⁶⁰ *Id.* at 1361.

¹⁶¹ *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.”¹⁶² 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.”¹⁶³ 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.¹⁶⁴ 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.”¹⁶⁵ 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.”¹⁶⁶ 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.¹⁶⁷

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.¹⁶⁸ 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.¹⁶⁹ This “packet correlation technique de-obfuscates the identity of an obfuscated host,” which can help networks detect unauthorized entry by malicious entities.¹⁷⁰

The PTAB, in analyzing Palo Alto Network’s obviousness challenge, considered two prior art references (Sutton and Paxton).¹⁷¹ 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”).¹⁷² 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

¹⁶² *Id.* at 1362.

¹⁶³ *Id.*

¹⁶⁴ *Id.* at 1363.

¹⁶⁵ *Id.* (emphasis in original)

¹⁶⁶ *Id.* at 1364.

¹⁶⁷ *Id.*

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

¹⁶⁹ *Id.* at 1380-81.

¹⁷⁰ *Id.* at 1381.

¹⁷¹ *Id.* at 1382.

¹⁷² *Id.*

Sutton’s method of notifying “administrators . . . to identify or drop future packets to prevent future malicious communications.”¹⁷³ 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.”¹⁷⁴ 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.”¹⁷⁵

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.¹⁷⁶ The court could not “discern with any confidence” what the PTAB’s “necessary bridge” language even meant.¹⁷⁷ 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.¹⁷⁸ 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.¹⁷⁹ 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.¹⁸⁰

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.¹⁸¹

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.¹⁸² Certain other dependent claims were obvious because they claimed an “inherent property” of the composition.¹⁸³ But, for Cytiva’s parallel process claims, the PTAB declined to find obviousness despite the claiming of an inherent property; instead,

¹⁷³ *Id.*

¹⁷⁴ *Id.* at 1383.

¹⁷⁵ *Id.* at 1384-85.

¹⁷⁶ *Id.*

¹⁷⁷ *Id.* at 1385.

¹⁷⁸ *Id.*

¹⁷⁹ *Id.* at 1386.

¹⁸⁰ *Id.* at 1385-86.

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

¹⁸² *Id.* at 883.

¹⁸³ *Id.*

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

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."¹⁸⁵ The court rejected Cytiva's argument, holding that such an analysis "is not required where the prior art references expressly suggest" the proposed modification."¹⁸⁶ In such circumstances, the Federal Circuit indicated that *KSR*'s obvious-to-try test would suffice.¹⁸⁷

Even applying the lead-compound test, the Federal Circuit held that Cytiva's composition claims were still obvious.¹⁸⁸ 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.¹⁸⁹

Finally, the court turned to the merits of the *KSR* analysis for the process claims.¹⁹⁰ 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.¹⁹¹ In such circumstances, a challenger need not even demonstrate a reasonable expectation of success under *KSR*.¹⁹² Only where the "claims require prior knowledge of the inherent property" would a challenger "still generally need to demonstrate a reasonable expectation of success."¹⁹³ Thus, affirming in part and reversing in part the PTAB, the Federal Circuit concluded that all of Cytiva's claims were obvious.¹⁹⁴

¹⁸⁴ *Id.*

¹⁸⁵ *Id.* at 884 (quotations omitted).

¹⁸⁶ *Id.* at 884-85.

¹⁸⁷ *Id.* at 885.

¹⁸⁸ *Id.*

¹⁸⁹ *Id.* at 886.

¹⁹⁰ *Id.* at 888.

¹⁹¹ *Id.* at 890-91.

¹⁹² *Id.* at 890.

¹⁹³ *Id.*

¹⁹⁴ *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.¹⁹⁵

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.¹⁹⁶ The specification referred to the “outer frame” of the dual-frame embodiment as a “self-expanding frame” or “self-expanding outer frame” several times.¹⁹⁷ 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.”¹⁹⁸

The Federal Circuit reiterated the rule that “consistent and clear interchangeable use of two terms can result in a definition equating the two terms.”¹⁹⁹ 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.”²⁰⁰

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.²⁰¹

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

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

¹⁹⁶ *Id.* at *1-3.

¹⁹⁷ *Id.* at *3.

¹⁹⁸ *Id.* at *4.

¹⁹⁹ *Id.* at *5.

²⁰⁰ *Id.* at *5-6.

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

²⁰² *Id.* at 1357-58.

²⁰³ *Id.* at 1357.

used interchangeably” and that these terms limited the claims to fastener-less connections.²⁰⁴ 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.²⁰⁵

The Federal Circuit first held that the district court “erred in limiting the claims to fastener-less bosses.”²⁰⁶ 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.”²⁰⁷

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.”²⁰⁸ 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.”²⁰⁹ 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.²¹⁰

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.”²¹¹ 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.”²¹²

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.²¹³ The Federal Circuit held that the district court improperly construed the word

²⁰⁴ *Id.* at 1358-59.

²⁰⁵ *Id.*

²⁰⁶ *Id.* at 1361.

²⁰⁷ *Id.* at 1360.

²⁰⁸ *Id.* at 1363.

²⁰⁹ *Id.*

²¹⁰ *Id.* at 1363-64.

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

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

²¹³ *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.²¹⁴

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.²¹⁵ 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.”²¹⁶

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.”²¹⁷ It did not matter whether the alterations broadened or narrowed the scope of the claim term.²¹⁸ 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.”²¹⁹ 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.²²⁰

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.²²¹

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.”²²² In Qiagen’s allegedly infringing kits, the counterparts to the target-specific

²¹⁴ *Id.* at 1333-34.

²¹⁵ *Id.* at 1329.

²¹⁶ *Id.*

²¹⁷ *Id.* at 1331.

²¹⁸ *Id.* at 1332.

²¹⁹ *Id.*

²²⁰ *Id.* at 1333.

²²¹ *Lab Corp. of Am. Holdings v. Qiagen Sciences, LLC*, ___ F.4th ___, 2025 WL 237197 (Fed. Cir. Aug. 13, 2025).

²²² *Id.* at *2.

and sequencing primers were of different lengths, with the former being identical only to a portion of the latter.²²³ 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.”²²⁴ The Federal Circuit explained that “identical” means “the same,” and thus cannot mean “identical to a portion.”²²⁵ 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.”²²⁶ 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.²²⁷

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.²²⁸ 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.²²⁹

Egenera appealed, arguing that the district court had made improper factual findings on summary judgment.²³⁰ The Federal Circuit explained that in this light, “there is little doubt that the district court should be affirmed.”²³¹ 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.”²³²

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.²³³ 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.²³⁴ 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.²³⁵ Moreover, during oral argument, Egenera denied that it had

²²³ *Id.* at *5.

²²⁴ *Id.*

²²⁵ *Id.*

²²⁶ *Id.* (emphasis in original)

²²⁷ *Id.*

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

²²⁹ *Id.* at 1357-59.

²³⁰ *Id.* at 1359.

²³¹ *Id.*

²³² *Id.* at 1359-60.

²³³ *Id.*

²³⁴ *Id.* at 1357.

²³⁵ *Id.* at 1361-62.

appealed the construction of “emulate.”²³⁶ As such, the court affirmed summary judgment of noninfringement on claims 1 and 5.²³⁷

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.²³⁸ The Federal Circuit held that the intended meaning of the phrase “consisting essentially of” in this patent differed from its ordinary meaning.²³⁹

Patentee Eye Therapies owned a patent teaching a method of reducing eye redness via topical application of a solution “consisting essentially of” brimonidine.²⁴⁰ Eye Therapies adopted this phrase—replacing “comprising”—during patent prosecution to avoid anticipation by an earlier patent that used brimonidine alongside another active ingredient.²⁴¹ 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.²⁴² As such, the Board held the patent was obvious.²⁴³

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

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.²⁴⁷ 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.”²⁴⁸ The parties

²³⁶ *Id.* at 1361.

²³⁷ *Id.* at 1362.

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

²³⁹ *Id.*

²⁴⁰ *Id.* at 1266-67.

²⁴¹ *Id.* at 1267.

²⁴² *Id.* at 1267-68.

²⁴³ *Id.* at 1268.

²⁴⁴ *Id.* at 1268-1270.

²⁴⁵ *Id.* at 1270 (emphasis in original).

²⁴⁶ *Id.* at 1269.

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

²⁴⁸ *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.²⁴⁹

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.”²⁵⁰ 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.²⁵¹ Moreover, the sentence used the term “refer to,” which usually conveys definitional intent, in contrast to the non-limiting language Alnylam used elsewhere.²⁵² Finally, the phrase “unless otherwise specified” in this context suggested that the rest of the sentence articulated “a generally applicable rule or definition.”²⁵³

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.²⁵⁴ 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.²⁵⁵ 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.²⁵⁶

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.²⁵⁷

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.²⁵⁸ 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.²⁵⁹

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

²⁴⁹ *Id.*

²⁵⁰ *Id.* at 1332.

²⁵¹ *Id.* at 1333.

²⁵² *Id.*

²⁵³ *Id.*

²⁵⁴ *Id.* at 1332-33.

²⁵⁵ *Id.* at 1334.

²⁵⁶ *Id.* at 1335-1338.

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

²⁵⁸ *Id.* at 1364.

²⁵⁹ *Id.* at 1364-65.

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

First, the court clarified that, when applying prosecution disclaimer to a family of patents, the touchstone is “public notice.”²⁶² 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.²⁶³

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.²⁶⁴ 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.²⁶⁵ Finally, the court affirmed the finding of non-infringement, since the accused products contained propylene glycol, which had been disclaimed by Azurity.²⁶⁶

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.²⁶⁷

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.”²⁶⁸ 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.”²⁶⁹ There were additional differences, including as to location of the lumen.²⁷⁰ 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,

²⁶⁰ *Id.* at 1366.

²⁶¹ *Id.*

²⁶² *Id.*

²⁶³ *Id.* at 1367.

²⁶⁴ *Id.* at 1367-68.

²⁶⁵ *Id.* at 1368.

²⁶⁶ *Id.* at 1370.

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

²⁶⁸ *Id.* at 1339.

²⁶⁹ *Id.* at 1340.

²⁷⁰ *Id.*

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

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.”²⁷² But the court rejected disclaimer on the merits, finding that there was no “clear and unmistakable” disavowal.²⁷³

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.²⁷⁴

The preamble of the claim at issue recited “a method of treating a patient by administering” a certain antibody comprising the claimed elements.²⁷⁵ 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.²⁷⁶

On appeal, the Federal Circuit disagreed, holding that the preambular language was limiting.²⁷⁷ First, the court observed that the claim language referred back to the preamble, which means that the preamble was limiting, at least in part.²⁷⁸ 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.²⁷⁹ 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.²⁸⁰ 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.²⁸¹

²⁷¹ *Id.*

²⁷² *Id.* at 1341-42.

²⁷³ *Id.* at 1343-44.

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

²⁷⁵ *Id.* at 1357.

²⁷⁶ *Id.*

²⁷⁷ *Id.* at 1358.

²⁷⁸ *Id.*

²⁷⁹ *Id.*

²⁸⁰ *Id.* at 1359.

²⁸¹ *Id.*

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

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.²⁸³ DDR sought a construction of the terms that would include both goods *and* services, while Priceline.com pressed for a goods-only construction.²⁸⁴ The Federal Circuit agreed with Priceline.com based on the patent’s specification and prosecution history.²⁸⁵ First, the patent’s specification failed to mention *services* in relation to merchants and commerce objects.²⁸⁶ 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.”²⁸⁷ It was immaterial that the patent purported to incorporate by reference the provisional application.²⁸⁸ 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.²⁸⁹

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.²⁹⁰

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.”²⁹¹ 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.²⁹² Based on that

²⁸² *Id.* at 1359-60.

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

²⁸⁴ *Id.* at 915.

²⁸⁵ *Id.*

²⁸⁶ *Id.* at 916.

²⁸⁷ *Id.* at 916.

²⁸⁸ *Id.* at 917-18.

²⁸⁹ *Id.* at 918-19.

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

²⁹¹ *Id.* at *2.

²⁹² *Id.* at *4.

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

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.”²⁹⁴ That conclusion was supported by the “plain and ordinary” meaning of “joined,” which includes both direct joining and indirect joining.²⁹⁵ 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.”²⁹⁶ That conclusion found further support in the specification and prosecution history, which disclosed embodiments with only indirect joiner.²⁹⁷ The court, however, rejected TOMY’s other claim construction arguments, affirming the district court’s construction of the terms “bottom surface” and “seating surfaces.”²⁹⁸ Judge Chen dissented from the majority’s claim construction disposition and would have affirmed the district court’s claim construction in full.²⁹⁹

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.”³⁰⁰ On this theory of infringement, Judge Chen disagreed in dissent.³⁰¹ 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.”³⁰²

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.³⁰³ 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.³⁰⁴

²⁹³ *Id.* at *2.

²⁹⁴ *Id.* at *4.

²⁹⁵ *Id.*

²⁹⁶ *Id.*

²⁹⁷ *Id.* at *5.

²⁹⁸ *Id.*

²⁹⁹ *Id.* at *8 (Chen, J., dissenting in part).

³⁰⁰ *Id.* at *6.

³⁰¹ *Id.* at *8 (Chen, J., dissenting in part).

³⁰² *Id.*

³⁰³ *Id.* at *6 (majority opinion).

³⁰⁴ *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.”³⁰⁵

The asserted patents related to quick release system on tactical vest worn by military and public safety personnel.³⁰⁶ 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.³⁰⁷ The accused devices included a trigger that, when activated, caused the mechanical movement of cables which caused the vest’s fasteners to release.³⁰⁸

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.³⁰⁹ 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.”³¹⁰ 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.³¹¹

On appeal, the Federal Circuit first held that the district court erred in limiting “pull cord” to cords *directly* pulled by users.³¹² 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.³¹³ Next, the court held that “pull cord” could not be construed to exclude handles.³¹⁴ While the claim language was silent, the court found probative the specification, which included figures with pull cords with handles.³¹⁵ 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.³¹⁶ The Federal Circuit thus remanded to the district court to apply the correct construction at summary judgment.³¹⁷

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

³⁰⁶ *Id.* at 1000.

³⁰⁷ *Id.*

³⁰⁸ *Id.* at 1001.

³⁰⁹ *Id.*

³¹⁰ *Id.* at 1002.

³¹¹ *Id.*

³¹² *Id.* at 1003.

³¹³ *Id.* at 1003-04.

³¹⁴ *Id.* at 1004.

³¹⁵ *Id.*

³¹⁶ *Id.*

³¹⁷ *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.³¹⁸

The patent is directed at formulations of aflibercept (brand name, Eylea), a fusion protein used to treat angiogenic eye disorders.³¹⁹ Amgen is approved to market a biosimilar, branded as Pavblu, which has a different formulation from Eylea.³²⁰ 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.³²¹

First, construing the claims, the Federal Circuit applied *Becton*³²² 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.³²³

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.”³²⁴ 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.³²⁵ The same was true of the specification, which described only a “distinct buffer component” consistently throughout.³²⁶ 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.³²⁷ 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.³²⁸

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.³²⁹

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

³¹⁹ *Id.*

³²⁰ *Id.*

³²¹ *Id.*

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

³²³ *Regeneron*, 130 F.4th at 1378-80.

³²⁴ *Id.* at 1380.

³²⁵ *Id.* at 1381.

³²⁶ *Id.*

³²⁷ *Id.* at 1383.

³²⁸ *Id.*

³²⁹ *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.³³⁰

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.”³³¹ However, Colibri cancelled the latter claim after the examiner rejected it for lack of written description.³³² At trial, Colibri claimed that Medtronic’s retraction-based method was infringing of claim 34 under the doctrine of equivalents.³³³ 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.”³³⁴ The court agreed and rejected Medtronic’s motions for JMOL.³³⁵

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.³³⁶ 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.”³³⁷ The Federal Circuit rejected this interpretation, because for retraction to work in either case, “a countervailing pushing force” was necessary.³³⁸ Second, the Federal Circuit held that Colibri’s cancellation of claim 39 “was a narrowing amendment giving rise to prosecution history estoppel.”³³⁹ 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.”³⁴⁰ The court therefore reversed the denial of JMOL, which mooted the remaining aspects of the appeal over Colibri’s expired patent.³⁴¹

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

³³¹ *Id.* at 1369-70.

³³² *Id.*

³³³ *Id.* at 1375.

³³⁴ *Id.*

³³⁵ *Id.*

³³⁶ *Id.* at 1377, 1380.

³³⁷ *Id.* at 1377-78.

³³⁸ *Id.* at 1378.

³³⁹ *Id.* at 1378.

³⁴⁰ *Id.* at 1378-79.

³⁴¹ *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).³⁴² The patents at issue concerned systems for aseptic packaging of food.³⁴³

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.³⁴⁴ 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.³⁴⁵ While the Federal Circuit found these arguments "compelling," it declined to hold that RDOE had been abrogated by statute.³⁴⁶ 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.³⁴⁷

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.³⁴⁸ The Federal Circuit reversed, again based in large part on Steuben's expert's testimony.³⁴⁹ 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.³⁵⁰

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

³⁴³ *Id.* at *2.

³⁴⁴ *Id.* at *3.

³⁴⁵ *Id.* at *4.

³⁴⁶ *Id.*

³⁴⁷ *Id.* at *5.

³⁴⁸ *Id.* at *6.

³⁴⁹ *Id.* at *6.

³⁵⁰ *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.”³⁵¹ 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.³⁵² The Federal Circuit affirmed, observing that, to apply DOE in this case would “vitiating the claim limitation.”³⁵³ “Something that is done non-continuously cannot be the equivalent of something done continuously.”³⁵⁴ Thus, because no reasonable jury could find equivalence, JMOL of noninfringement was warranted.³⁵⁵

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.³⁵⁶

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.³⁵⁷ That system implicated the *Centillion*³⁵⁸ 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.³⁵⁹

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.³⁶⁰ 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.³⁶¹

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.³⁶² While the district court had found vicarious liability based on NCR’s requirement that merchants maintain Internet access—which was one of the claimed

³⁵¹ *Id.* at *7.

³⁵² *Id.*

³⁵³ *Id.* at *8.

³⁵⁴ *Id.*

³⁵⁵ *Id.*

³⁵⁶ *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).

³⁵⁷ *Id.* at 1335-37.

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

³⁵⁹ *CloudofChange*, 123 F.4th at 1337.

³⁶⁰ *Id.* at 1340.

³⁶¹ *Id.* at 1341.

³⁶² *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.”³⁶³ 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.³⁶⁴ 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.”³⁶⁵

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.³⁶⁶ 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.³⁶⁷

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.³⁶⁸ The Commission held that domestic manufacturing activities may be required to satisfy the economic prong.³⁶⁹

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.”³⁷⁰ 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.”³⁷¹ Finally, the Federal Circuit addressed and rejected the Commission’s legislative history arguments.³⁷²

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

³⁶³ *Id.*

³⁶⁴ *Id.*

³⁶⁵ *Id.* at 1341-42.

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

³⁶⁷ *Id.* at 963.

³⁶⁸ *Id.* at 956, 958.

³⁶⁹ *Id.* at 958.

³⁷⁰ *Id.* at 958.

³⁷¹ *Id.* at 959-60.

³⁷² *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.³⁷³

³⁷³ *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.³⁷⁴

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 2010.³⁷⁵ The Federal Circuit first affirmed the district court’s conclusion that there was no genuine dispute as to the first prong.³⁷⁶ Fraunhofer’s five-year silence before asserting infringement—despite its clear knowledge of that infringement—“rose to the level of misleading conduct.”³⁷⁷

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.³⁷⁸ 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.³⁷⁹ And SXM’s claims that it would have taken steps to limit liability were similarly insufficient to warrant summary judgment.³⁸⁰ 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.³⁸¹

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

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

³⁷⁵ *Id.* at 1376-77.

³⁷⁶ *Id.* at 1379-80.

³⁷⁷ *Id.*

³⁷⁸ *Id.* at 1380.

³⁷⁹ *Id.* at 1380-81.

³⁸⁰ *Id.* at 1381.

³⁸¹ *Id.* at 1382.

³⁸² *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.³⁸³

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.³⁸⁴ 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.³⁸⁵ 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.”³⁸⁶ Since Google had begun “investing in the accused product by at least 2015,” the district court held the patents “unenforceable against Google.”³⁸⁷

On appeal, the Federal Circuit held that the publication in 2013 of Sonos’s 2007 nonprovisional application barred a finding of prejudice against Google.³⁸⁸ 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.”³⁸⁹ 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.”³⁹⁰

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.³⁹¹

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

³⁸³ *Google LLC v. Sonos, Inc.*, 2024-1097, 2025 WL 2473258, at *6-7.

³⁸⁴ *Id.* at *1-2.

³⁸⁵ *Id.* at *3.

³⁸⁶ *Id.*

³⁸⁷ *Id.*

³⁸⁸ *Id.* at *7.

³⁸⁹ *Id.*

³⁹⁰ *Id.* at *6-7.

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

for obligations undertaken under the General Agreement on Tariffs and Trade (GATT).³⁹² 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."³⁹³ The panel remanded the case "to allow Hyatt to present evidence on whether the delay was prejudicial."³⁹⁴ On remand, the district court concluded that the delay was prejudicial, and "[n]o other result is even colorable."³⁹⁵

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.³⁹⁶ Alternatively, he argued the defense should at least not be available in "the narrow circumstances presented here, a § 145 action involving transitional applications."³⁹⁷ 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*."³⁹⁸

Hyatt next argued that the district court "abused its discretion in ruling in the PTO's favor on prosecution laches."³⁹⁹ 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 2002.⁴⁰⁰ 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.⁴⁰¹

³⁹² *Id.* at 1379-80.

³⁹³ *Id.* at 1380.

³⁹⁴ *Id.*

³⁹⁵ *Id.* at 1381.

³⁹⁶ *Id.* at 1381-82.

³⁹⁷ *Id.* at 1382.

³⁹⁸ *Id.*

³⁹⁹ *Id.*

⁴⁰⁰ *Id.* at 1382-83.

⁴⁰¹ *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.⁴⁰²

EscapeX sued Google for infringing its '113 patent directed to a method for "Generating Artist-Specified Dynamic Albums."⁴⁰³ 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.⁴⁰⁴ Google then explained that the latter product predated the priority date of the asserted patent, and requested "that EscapeX voluntarily dismiss the lawsuit."⁴⁰⁵ 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.⁴⁰⁶ 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."⁴⁰⁷ 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.⁴⁰⁸

Applying its own case law, the Federal Circuit reviewed the award of fees for abuse of discretion.⁴⁰⁹ The court rejected EscapeX's argument that the district court's short period of presiding over the case called for a less deferential standard.⁴¹⁰ On the merits, the court found no abuse of discretion in the district court's finding that the case was "exceptional."⁴¹¹ 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

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

⁴⁰³ *Id.*

⁴⁰⁴ *Id.*

⁴⁰⁵ *Id.*

⁴⁰⁶ *Id.*

⁴⁰⁷ *Id.* at *2.

⁴⁰⁸ *Id.*

⁴⁰⁹ *Id.* at *3.

⁴¹⁰ *Id.*

⁴¹¹ *Id.* at *3-4.

was frivolous from the start.”⁴¹² 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.”⁴¹³ 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.”⁴¹⁴ But the court countered that such communications are relevant “when they show that ‘the lawsuit appears to have been baseless.’”⁴¹⁵ 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.”⁴¹⁶

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.⁴¹⁷ 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.”⁴¹⁸

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).⁴¹⁹

Future Link initiated two patent infringement suits against Realtek for infringement of its patents related to electronic circuitry in 2021.⁴²⁰ 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.⁴²¹ Future Link entered a new licensing agreement with Realtek covering the accused products and voluntarily dismissed both cases without prejudice.⁴²² Realtek then requested attorney’s fees and costs in both cases, which it

⁴¹² *Id.* at *4.

⁴¹³ *Id.*

⁴¹⁴ *Id.* at *5.

⁴¹⁵ *Id.* (citation omitted).

⁴¹⁶ *Id.*

⁴¹⁷ *Id.* at *6.

⁴¹⁸ *Id.* at *6-7.

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

⁴²⁰ *Id.* at 1374.

⁴²¹ *Id.*

⁴²² *Id.*

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

On appeal, the Federal Circuit vacated the judgment, holding that Realtek was a “prevailing party” under § 285 and Rule 54(d)(1).⁴²⁵ 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.⁴²⁶ 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.⁴²⁷ 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.”⁴²⁸ 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.”⁴²⁹

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.⁴³⁰ 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.⁴³¹

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.⁴³² And the court found that there was sufficient evidence of bad faith to justify deterrence sanctions.⁴³³ 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.⁴³⁴ And because PS Products had filed dozens of

⁴²³ *Id.*

⁴²⁴ *Id.*

⁴²⁵ *Id.* at 1375.

⁴²⁶ *Id.* at 1375-76.

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

⁴²⁸ *Id.* at 1377.

⁴²⁹ *Id.*

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

⁴³¹ *Id.* at 897.

⁴³² *Id.* at 898.

⁴³³ *Id.*

⁴³⁴ *Id.* at 899.

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

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."⁴³⁶

At trial, the jury determined that Intuitive had infringed Rex's '650 patent "directed to systems for stapling tissue during surgery."⁴³⁷ The parties had earlier agreed to drop the related '892 patent from the litigation.⁴³⁸ 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.⁴³⁹ 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.⁴⁴⁰ 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.⁴⁴¹ As a result, neither party had a damages expert testify at trial.⁴⁴² 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."⁴⁴³

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."⁴⁴⁴ Kidder opined that "nearly all the value of the Covidien license derives from either" the '650 or the '892 patent.⁴⁴⁵ 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.⁴⁴⁶

⁴³⁵ *Id.* at 900-901.

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

⁴³⁷ *Id.*

⁴³⁸ *Id.*

⁴³⁹ *Id.* at 1295.

⁴⁴⁰ *Id.*

⁴⁴¹ *Id.*

⁴⁴² *Id.*

⁴⁴³ *Id.* at 1296.

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

⁴⁴⁵ *Id.* at 1297.

⁴⁴⁶ *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.”⁴⁴⁷ 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.”⁴⁴⁸ The court underscored that the patent damages statute does not require awarding damages if they are not proved.⁴⁴⁹ 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.”⁴⁵⁰

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.⁴⁵¹ EcoFactor docketed a petition for certiorari to the Supreme Court on September 18, 2025.⁴⁵²

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.”⁴⁵³ 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.⁴⁵⁴ 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.”⁴⁵⁵

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.⁴⁵⁶ The court characterized EcoFactor’s “preliminary recitals” in each contract—stating EcoFactor’s belief that the agreed payment reflected a

⁴⁴⁷ *Id.* at 1298.

⁴⁴⁸ *Id.*

⁴⁴⁹ *Id.* at 1298-1300.

⁴⁵⁰ *Id.* at 1301.

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

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

⁴⁵³ *EcoFactor*, 137 F.4th at 1339.

⁴⁵⁴ *Id.* at 1340-41.

⁴⁵⁵ *Id.* at 1341.

⁴⁵⁶ *Id.* at 1341-42.

per-unit royalty—as merely unilateral statements of belief.⁴⁵⁷ 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.⁴⁵⁸ 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.⁴⁵⁹ 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.⁴⁶⁰

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.⁴⁶¹ 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.”⁴⁶²

Similarly, Judge Stark dissented in part.⁴⁶³ 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*.”⁴⁶⁴ 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.⁴⁶⁵

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.⁴⁶⁶

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.⁴⁶⁷ 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.⁴⁶⁸ The Federal Circuit concluded this was an abuse of discretion that violated Apple’s right to a unanimous verdict on each claim—each of

⁴⁵⁷ *Id.*

⁴⁵⁸ *Id.* at 1341-43.

⁴⁵⁹ *Id.* at 1343.

⁴⁶⁰ *Id.* at 1346-47.

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

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

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

⁴⁶⁴ *Id.*

⁴⁶⁵ *Id.*

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

⁴⁶⁷ *Id.* at 1368-69.

⁴⁶⁸ *Id.* at 1374-75.

which represented a distinct cause of action.⁴⁶⁹ 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.”⁴⁷⁰ 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.”⁴⁷¹ 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.⁴⁷²

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.⁴⁷³

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.⁴⁷⁴ 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.⁴⁷⁵

Turning to the merits, the Federal Circuit held that the jury’s conveyed damages award was not supported by the record.⁴⁷⁶ 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.⁴⁷⁷ “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.”⁴⁷⁸ 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.”⁴⁷⁹ 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.⁴⁸⁰

⁴⁶⁹ *Id.* at 1374-76.

⁴⁷⁰ *Id.* at 1376.

⁴⁷¹ *Id.* at 1377.

⁴⁷² *Id.* at 1378, 1382.

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

⁴⁷⁴ *Id.* at 1372-74.

⁴⁷⁵ *Id.* at 1374.

⁴⁷⁶ *Id.* at 1375.

⁴⁷⁷ *Id.* at 1375-76.

⁴⁷⁸ *Id.* at 1376.

⁴⁷⁹ *Id.*

⁴⁸⁰ *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.⁴⁸¹

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.⁴⁸² 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.⁴⁸³ Phillips objected, and the magistrate judge ultimately agreed, that such sampling was too dangerous and unnecessary, because Magēmā could instead mathematically estimate the flashpoint.⁴⁸⁴ In the lead-up to trial, however, it became clear that the testing was neither dangerous nor unnecessary.⁴⁸⁵ Phillips constructed a new sampling station and sought to supplement the summary judgment record with the relevant samples after the close of discovery.⁴⁸⁶ And shortly before jury selection, Magēmā learned that Phillips planned to argue that only actual samples, not mathematical estimates, could establish infringement.⁴⁸⁷ The court excluded the new samples, but allowed Phillips to make its new noninfringement argument to the jury over Magema’s objections.⁴⁸⁸ 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.⁴⁸⁹ 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.⁴⁹⁰

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.⁴⁹¹ Given

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

⁴⁸² *Id.* at 1251-52.

⁴⁸³ *Id.* at 1253.

⁴⁸⁴ *Id.* at 1253-4.

⁴⁸⁵ *Id.* at 1253-54.

⁴⁸⁶ *Id.* at 1254.

⁴⁸⁷ *Id.* at 1254-55.

⁴⁸⁸ *Id.*

⁴⁸⁹ *Id.* at 1256.

⁴⁹⁰ *Id.*

⁴⁹¹ *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.”⁴⁹² The court therefore reversed and ordered a new trial.⁴⁹³

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.”⁴⁹⁴

Nexus asserted 34 claims—encompassing every claim of three asserted patents—in a patent infringement lawsuit against Exela.⁴⁹⁵ 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.⁴⁹⁶ The parties disputed the extent to which Exela should have to narrow its defenses, and asked the court to rule on the issue.⁴⁹⁷ 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.⁴⁹⁸

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.”⁴⁹⁹ 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.”⁵⁰⁰ The court pointed out that the latter would be unfair unless defendants can also “resurrect the defenses they dropped at roughly the same time.”⁵⁰¹ 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.⁵⁰² 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.”⁵⁰³ As such, the court held that both “the claims that Nexus

⁴⁹² *Id.* at 1259.

⁴⁹³ *Id.* at 1260.

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

⁴⁹⁵ *Id.* at *1.

⁴⁹⁶ *Id.*

⁴⁹⁷ *Id.*

⁴⁹⁸ *Id.*

⁴⁹⁹ *Id.* at *2.

⁵⁰⁰ *Id.* at *3-4.

⁵⁰¹ *Id.* at *3.

⁵⁰² *Id.*

⁵⁰³ *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.”⁵⁰⁴

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. § 284.⁵⁰⁵

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.”⁵⁰⁶ 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.⁵⁰⁷ 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.”⁵⁰⁸ 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.”⁵⁰⁹ 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.⁵¹⁰ 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.”⁵¹¹

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.⁵¹² 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.”⁵¹³

⁵⁰⁴ *Id.* at *4.

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

⁵⁰⁶ *Id.*

⁵⁰⁷ *Id.*

⁵⁰⁸ *Id.*

⁵⁰⁹ *Id.* at *2.

⁵¹⁰ *Id.* at *2-3.

⁵¹¹ *Id.* at *3.

⁵¹² *Id.* at *3-4.

⁵¹³ *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.⁵¹⁴

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.⁵¹⁵ The court granted summary judgment to Focus as to three of the patent claims.⁵¹⁶ 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.⁵¹⁷

On appeal, the Federal Circuit vacated the grants of summary judgment on the patents as well as the trademark and trade dress infringement holdings.⁵¹⁸ However, the court also held that each of the appellants had waived certain arguments by failing to adequately present them in their appellate briefs.⁵¹⁹ The court rejected each party’s initial briefs, which “divided the issues on appeal and attempted to incorporate by reference each other’s briefs.”⁵²⁰ 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.”⁵²¹ 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.⁵²² 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.⁵²³

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.⁵²⁴ The Federal Circuit first observed that the district court, in denying the request for

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

⁵¹⁵ *Id.* at 1266.

⁵¹⁶ *Id.*

⁵¹⁷ *Id.* at 1270-71.

⁵¹⁸ *Id.* at 1279, 1280-81, 1285.

⁵¹⁹ *Id.* at 1285-86.

⁵²⁰ *Id.* at 1285.

⁵²¹ *Id.*

⁵²² *Id.* at 1286.

⁵²³ *Id.* at 1286-87.

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

transfer, had erred in several respects.⁵²⁵ 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.⁵²⁶ 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.⁵²⁷ 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.⁵²⁸ The mere fact that SAP’s offices were in the transferee district was not dispositive.⁵²⁹

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.⁵³⁰ Taction accused Apple of infringing its patent for haptics technologies and relied on the expert testimony of Dr. Oliver.⁵³¹ 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.”⁵³²

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.”⁵³³ 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.”⁵³⁴ The district court explained that this rule included an unwritten requirement to explain “how” the allegedly infringing products satisfied the patent limitations.⁵³⁵

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.⁵³⁶ Moreover, the parties lacked notice of such a requirement, for which the

⁵²⁵ *Id.* at 1374-75.

⁵²⁶ *Id.* at 1374.

⁵²⁷ *Id.* at 1375.

⁵²⁸ *Id.*

⁵²⁹ *Id.*

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

⁵³¹ *Id.* at *1-3.

⁵³² *Id.* at *1.

⁵³³ *Id.*

⁵³⁴ *Id.* at *2.

⁵³⁵ *Id.*

⁵³⁶ *Id.* at *3.

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

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.⁵³⁹ The panel also ordered a new trial on damages because “the jury rendered a single verdict on damages” without apportioning among the different patents.⁵⁴⁰ 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*.⁵⁴¹

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.⁵⁴² 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.⁵⁴³ Second, the court underscored that damages experts must apportion licenses fees “among the licensed patents covered by an agreement.”⁵⁴⁴ The panel ordered the district court to “consider whether Super Lighting properly apportioned damages.”⁵⁴⁵ 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.⁵⁴⁶

⁵³⁷ *Id.*

⁵³⁸ *Id.*

⁵³⁹ *Jiaxing Super Lighting Electric Appliance Co, Ltd. v. CH Lighting Tech. Co., Ltd.*, 146 F.4th 1098, 1102 (Fed. Cir. 2025).

⁵⁴⁰ *Id.* at 1110 (quotation and citation omitted).

⁵⁴¹ *Id.* at 1110-11.

⁵⁴² *Id.* at 1111-1112.

⁵⁴³ *Id.* at 1112.

⁵⁴⁴ *Id.*

⁵⁴⁵ *Id.*

⁵⁴⁶ *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.⁵⁴⁷ 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.⁵⁴⁸ 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.⁵⁴⁹ And since the expert's testimony was "harmful and prejudicial," the Federal Circuit ruled that a new trial was warranted.⁵⁵⁰ 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.⁵⁵¹

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.⁵⁵² 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."⁵⁵³ 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."⁵⁵⁴ Thus, Bearbox's conversion claim was preempted.⁵⁵⁵

⁵⁴⁷ *Trudell Med. Int'l Inc. v. D R Burton Healthcare, LLC*, 127 F.4th 1340, 1346-47 (Fed. Cir. 2025).

⁵⁴⁸ *Id.* at 1347-48.

⁵⁴⁹ *Id.* at 1348.

⁵⁵⁰ *Id.* at 1351.

⁵⁵¹ *Id.* at 1352-53.

⁵⁵² *BearBox LLC v. Lancium LLC*, 2025 WL 77755, at *1 (Fed. Cir. Jan. 13, 2025).

⁵⁵³ *Id.* at *5 (citation omitted).

⁵⁵⁴ *Id.* at *5-7 (quoting *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 156 (1989)).

⁵⁵⁵ *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.⁵⁵⁶

Causam initiated an ITC investigation over alleged infringement of its ‘268 patent related to “demand response” functionality for electronic utilities.⁵⁵⁷ 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.”⁵⁵⁸ Therefore, the inventor Forbes’s purported assignment of the ‘268 patent—a descendant of the ‘909 application—was invalid.⁵⁵⁹ The ITC did not reach the issue, instead affirming based on the ALJ’s finding of noninfringement.⁵⁶⁰

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.”⁵⁶¹ 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*.⁵⁶²

The court then concluded that Causam had standing because it was the owner of the ‘268 patent.⁵⁶³ The issue turned on whether the 2007 assignment included the ‘761 continuation-in-part application, derived from the original ‘909 application.⁵⁶⁴ 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.”⁵⁶⁵ 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.⁵⁶⁶ 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.”⁵⁶⁷ The court also declined to extend the rule from *Regents of Univ. of New Mexico v. Knight*—holding that “assignment of an

⁵⁵⁶ *Causam Enterprises, Inc. v. International Trade Commission*, 155 F.4th 1338, 1340 (Fed. Cir. 2025).

⁵⁵⁷ *Id.*

⁵⁵⁸ *Id.* at 1341-42.

⁵⁵⁹ *Id.* at 1342.

⁵⁶⁰ *Id.*

⁵⁶¹ *Id.* at 1343.

⁵⁶² *Id.* (citing *TransUnion LLC v. Ramirez*, 594 U.S. 413, 426 (2021)).

⁵⁶³ *Id.* at 1346.

⁵⁶⁴ *Id.* at 1345.

⁵⁶⁵ *Id.*

⁵⁶⁶ *Id.*

⁵⁶⁷ *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.”⁵⁶⁸ 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.⁵⁶⁹

⁵⁶⁸ *Id.* (distinguishing *Regents of University of New Mexico v. Knight*, 321 F.3d 1111, 1119-20 (Fed. Cir. 2003)).

⁵⁶⁹ *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).⁵⁷⁰ 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).⁵⁷¹

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.⁵⁷²

On appeal, GHS argued that the PTAB had committed multiple reversible errors and should have considered naming GHS as a co-inventor.⁵⁷³ 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.”⁵⁷⁴ The first-filer “can overcome this showing by proving independent conception prior to receiving relevant communications from the petitioner.”⁵⁷⁵ 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.⁵⁷⁶ 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.⁵⁷⁷

⁵⁷⁰ *Global Health Solutions LLC v. Selner*, ___ F.4th ___, 2025 WL 2446374, at *1 (Fed. Cir. Aug. 26, 2025).

⁵⁷¹ *Id.*

⁵⁷² *Id.* at *1-2.

⁵⁷³ *Id.* at *4.

⁵⁷⁴ *Id.* at *5.

⁵⁷⁵ *Id.*

⁵⁷⁶ *Id.*

⁵⁷⁷ *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).⁵⁷⁸

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.”⁵⁷⁹ Motorola petitioned for mandamus relief, arguing that the Director violated APA procedural protections and the Fifth Amendment’s Due Process Clause.⁵⁸⁰ 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.⁵⁸¹

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.”⁵⁸² Although the court “noted possible exceptions for ‘colorable constitutional claims’ and certain statutory challenges,” it concluded that “no such claims have been presented here.”⁵⁸³

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.⁵⁸⁴ Motorola argued the Memorandum “imposed ‘substantive limits’ on the PTO’s ‘officials discretion’ to deny an IPR.”⁵⁸⁵ 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.⁵⁸⁶ 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.”⁵⁸⁷ 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

⁵⁷⁸ *In re Motorola Solutions, Inc.*, --- F.4th ----, 2025-134, 2025 WL 3096514, at *1 (Fed. Cir. Nov. 6, 2025).

⁵⁷⁹ *Id.*

⁵⁸⁰ *Id.*

⁵⁸¹ *Id.* at *1-3.

⁵⁸² *Id.* at *3.

⁵⁸³ *Id.* (citation omitted).

⁵⁸⁴ *Id.* at *4.

⁵⁸⁵ *Id.*

⁵⁸⁶ *Id.*

⁵⁸⁷ *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.⁵⁸⁸

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.”⁵⁸⁹ 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.”⁵⁹⁰ 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.”⁵⁹¹ 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.⁵⁹² The court reiterated that such arguments are not reviewable in light of § 314(d) because they amount to challenging the Director’s discretion.⁵⁹³

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.”⁵⁹⁴ 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.”

⁵⁸⁸ *Id.*

⁵⁸⁹ *Id.* at *5.

⁵⁹⁰ *Id.*

⁵⁹¹ *Id.* (quoting *Apple v. Vidal*, 63 F.4th 1, 14 (Fed. Cir. 2023)).

⁵⁹² *Id.* at *5.

⁵⁹³ *Id.*

⁵⁹⁴ 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.”⁵⁹⁵ But the PTAB should not ignore “the skilled artisan’s knowledge” in determining obviousness, and AAPA can be provide evidence of that general knowledge.⁵⁹⁶

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.’”⁵⁹⁷ 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.⁵⁹⁸ 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.⁵⁹⁹

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.⁶⁰⁰ 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.”⁶⁰¹

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.”⁶⁰² The Board analogized to the logic of time-limitations on infringement lawsuits.⁶⁰³ On the other side of the ledger, the Board observed that petitioner had failed to provide persuasive reasoning why an IPR would be

⁵⁹⁵ *Shockwave Medical, Inc. v. Cardiovascular Systems, Inc.*, 142 F.4th 1371, 1377-78 (Fed. Cir. 2025)

⁵⁹⁶ *Id.* at 1378.

⁵⁹⁷ *Id.* at 1379 (citing *Qualcomm I*, 24 F.4th 1367, 1376 (Fed. Cir. 2022)).

⁵⁹⁸ *Id.* at 1379.

⁵⁹⁹ *Id.* at 1380.

⁶⁰⁰ *Dabico Airport Solutions Inc. v. AXA Power ApS, No. IPR2025-00408, 2025 WL 1710080 (PTO Director, June 18, 2025).*

⁶⁰¹ *Id.*

⁶⁰² *Id.*

⁶⁰³ *Id.*

“an appropriate use of Office resources.”⁶⁰⁴ Without such reasoning, “the Office is disinclined to upset the settled expectations of Patent Owner in this instance.”⁶⁰⁵

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.⁶⁰⁶

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.⁶⁰⁷ On the issue of the PTAB’s jurisdiction to do so, Gesture argued on appeal that, under *Oil States*,⁶⁰⁸ 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.⁶⁰⁹ 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.”⁶¹⁰ 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.⁶¹¹

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.⁶¹²

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.⁶¹³

⁶⁰⁴ *Id.*

⁶⁰⁵ *Id.*

⁶⁰⁶ *Apple Inc. v. Gesture Tech. Partners, LLC*, 127 F.4th 364, 366-67 (Fed. Cir. 2025).

⁶⁰⁷ *Id.* at 367.

⁶⁰⁸ *Oil States Energy Services, LLC v. Greene's Energy Group, LLC*, 584 U.S. 325 (2018).

⁶⁰⁹ *Apple*, 137 F.4th at 368.

⁶¹⁰ *Id.* at 369.

⁶¹¹ *Id.*

⁶¹² *IGT v. Zynga Inc.*, 144 F.4th 1357, 1360 (Fed. Cir. 2025).

⁶¹³ *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.⁶¹⁴ The PTO director affirmed that decision, and the Board ultimately concluded that IGT’s claims were unpatentable under § 103.⁶¹⁵

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.”⁶¹⁶ 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.”⁶¹⁷ 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.⁶¹⁸ 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).⁶¹⁹

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.⁶²⁰ 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.⁶²¹ 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.”⁶²²

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.*⁶²³ The dissent distinguished the Supreme Court’s decision in *Grogan v. Garner*⁶²⁴, 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.”⁶²⁵

⁶¹⁴ *Id.* at 1364.

⁶¹⁵ *Id.* at 1364-65.

⁶¹⁶ *Id.* at 1365 (quotation and citation omitted).

⁶¹⁷ *Id.* at 1366.

⁶¹⁸ *Id.*

⁶¹⁹ *Id.*

⁶²⁰ *Kroy IP Holdings, LLC v. Groupon, Inc.*, 146 F.4th 1360, 1361 (Fed. Cir. 2025).

⁶²¹ *Id.* at 1361.

⁶²² *Id.* at 1362.

⁶²³ *Id.* at 1362; 890 F.3d 1282, 1294 (Fed. Cir. 2018).

⁶²⁴ 498 U.S. 279 (1991).

⁶²⁵ *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.⁶²⁶

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.⁶²⁷ 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.”⁶²⁸

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).”⁶²⁹ 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.⁶³⁰ The court found this interpretation consistent with the statute’s other provisions and its own prior interpretations.⁶³¹ 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.”⁶³² 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.⁶³³

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.⁶³⁴ 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.”⁶³⁵ 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

⁶²⁶ *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1359.

⁶²⁷ *Id.* at 1364.

⁶²⁸ *Id.*

⁶²⁹ *Id.* at 1365.

⁶³⁰ *Id.* at 1365-66.

⁶³¹ *Id.*

⁶³² *Id.* at 1366.

⁶³³ *Id.* at 1366-67.

⁶³⁴ *Kroy IP Holdings, LLC v. Groupon, Inc.*, 127 F.4th 1376, 1378 (Fed. Cir. 2025).

⁶³⁵ *Id.* at 1380.

satisfies the statutorily-prescribed clear and convincing evidence standard.”⁶³⁶ 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.⁶³⁷

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.⁶³⁸ The court distinguished the two based on the differing burdens of proof.

⁶³⁶ *Id.* at 1380-81.

⁶³⁷ *Id.* at 1380-81.

⁶³⁸ 575 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.⁶³⁹

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.⁶⁴⁰ 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.⁶⁴¹ 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.”⁶⁴²

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.⁶⁴³ 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.⁶⁴⁴

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.⁶⁴⁵ 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.⁶⁴⁶

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.⁶⁴⁷ The court affirmed the Board’s contrary findings on

⁶³⁹ *Top Brand LLC v. Cozy Comfort Co. LLC, 143 F.4th 1349, 1353 (Fed. Cir. July 17, 2025)*

⁶⁴⁰ *Id.* at 1356.

⁶⁴¹ *Id.* at 1357.

⁶⁴² *Id.*

⁶⁴³ *Id.* at 1357-58.

⁶⁴⁴ *Id.* at 1362.

⁶⁴⁵ *In re Floyd, No. 2023-2395, 2025 WL 1163561 (Fed. Cir. April 22, 2025)*

⁶⁴⁶ *Id.* at *1.

⁶⁴⁷ *Id.* at *2.

substantial evidence review.⁶⁴⁸ 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."⁶⁴⁹ The Board reasonably interpreted this as indicating that the individual rectangular compartments might vary in size, rather than disclosing different grid configurations.⁶⁵⁰ Second, the disclosure of six-by-six and six-by-four embodiments did not sufficiently disclose that Floyd possessed the six-by-five array.⁶⁵¹ 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.⁶⁵² 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."⁶⁵³

⁶⁴⁸ *Id.*

⁶⁴⁹ *Id.* at *3.

⁶⁵⁰ *Id.*

⁶⁵¹ *Id.* at *3-4.

⁶⁵² *Id.* at *4.

⁶⁵³ *Id.* at *4-5.