

Table of Contents

I.	Patentability Requirements	1
A.	Prior Art Invalidity.....	1
1.	Reference Disclosure	1
a.	Inherency.....	1
i.	Information/Printed Matter Limitations.....	1
2.	Anticipation (§ 102).....	1
a.	Publications/Patents	1
i.	Public Accessibility	1
3.	Obviousness (§ 103)	1
a.	Analogous Prior Art.....	1
i.	Reasonably Pertinent to Problem.....	1
b.	Motivation/Apparent Reason to Combine/Modify	2
i.	Evidence of Reasons not to Combine	2
c.	Subject Matter as a Whole/Routine Additions.....	2
d.	Teaching Away	2
B.	Section 101.....	2
1.	Abstract Idea Exclusion	2
a.	Specification	3
b.	Application of Mathematical Algorithm(s)	3
c.	Information Processing	3
II.	Other Defenses.....	3
A.	Equitable Estoppel	3
1.	Misleading Communication.....	3
a.	Change in Claim Scope.....	3
b.	Failing to Meet a Duty to Respond.....	4
2.	Summary Judgment	4
3.	Preclusion by Unclean Hands	4
B.	Lack of Subject Matter Jurisdiction.....	4
1.	Declaratory Judgment Jurisdiction	4
a.	Discretionary	4
2.	Substantial Question of Federal Patent Law	4
C.	Improper Venue	4
1.	ANDA-Based Complaints	4
D.	No Ownership/Standing (see also II.C.2)	5
1.	Must Be Addressed Before Substantive Issues.....	5
2.	Court Ordered Transfer	5
III.	Literal Infringement	5
A.	Summary Judgment/JMOL.....	5
1.	Role of Claim Construction	5
B.	Appellate Review.....	5
1.	Representative Claims for Trial	5
C.	Indirect Infringement	6
1.	Induced Infringement.....	6
a.	Intent to Induce	6
i.	Knowledge of the patent	6

ii.	Piggybacking on Patentee Communications.....	6
iii.	During Appeal of Noninfringement SJ.....	6
2.	ANDA Infringement.....	6
D.	Joint Infringement/Divided Infringement.....	6
E.	Evidence of Infringement.....	7
1.	Marketing/Instruction Materials.....	7
2.	Testing.....	7
IV.	Relief.....	7
A.	Willfulness.....	7
1.	Opinion of Counsel.....	7
B.	Reasonable Royalty.....	7
1.	Minimum Measure of Damages.....	7
2.	Established and Comparable Royalties/License Agreements.....	7
a.	Substantial Evidence of Comparability.....	7
V.	Claim Construction.....	8
A.	Special Constructions.....	8
1.	Broadest Reasonable Interpretation During Prosecution.....	8
a.	Expiration Exception.....	8
b.	Doesn't Include Absent Modifier.....	8
B.	Claim Language.....	8
1.	Open/Closed Claims, Generic and Negative Limitations.....	8
a.	Linking Limitations (associated with, aware of, corresponds, represents, etc.).....	8
2.	Functional and Structural Language.....	8
a.	Structure Elements Limited by Method of Manufacture.....	8
C.	Written Description.....	9
1.	Lexicography.....	9
a.	Requirements.....	9
2.	Differences Between Claim Language and Specification Language.....	9
3.	Advantages/Purposes/Problems Addressed.....	9
D.	Prosecution History.....	9
1.	Examiner's Statements.....	9
E.	Extrinsic Evidence.....	9
1.	Proper Reliance Upon.....	9
F.	Timing of Construction and Parties' Positions.....	10
1.	Waiver.....	10
2.	Construing the Words in the Construction.....	10
VI.	Procedural Law.....	10
A.	Applicable Circuit Law.....	10
1.	Interpretation of State Statutes.....	10
B.	Pleadings/Parties.....	10
1.	12(b)(6) Dismissals.....	10
a.	Sufficient Identification of Individual Defendants.....	10
C.	Discovery/Evidence.....	11
1.	Prejudicial Evidence.....	11
D.	Transfer to New Judge or Venue.....	11

1.	Sources of Proof Factor	11
2.	Cost of Attendance of Willing Witnesses Factor.....	12
3.	Other Practical Problems Factor	12
4.	Congestion Factor	12
VII.	Federal Circuit Appeals	12
A.	New Arguments/Issues on Appeal/Forfeiture/Waiver/Judicial Estoppel	12
1.	District Court/ITC Appeals.....	12
a.	Claim Construction Waiver	12
i.	Construction Advocated at Markman	12
2.	PTO Appeals.....	13
a.	Claim Construction Arguments	13
3.	New Argument in Reply Brief.....	13
B.	Cross-Appeals v. Alternate Bases for Affirmance.....	13
1.	Alternative Bases in Agency Appeals.....	13
2.	Dismissing Cross-Appeals	13
a.	Invalidity as Affirmative Defense Only.....	13
C.	Mootness of Appealed Rulings.....	13
1.	Willfulness Rulings.....	13
D.	Standards of Review and Record/Appendix on Appeal	14
1.	Clear/Plain Error Review	14
2.	Abuse of Discretion	14
a.	Granting New Trial	14
E.	Relief Outside Appeal Process.....	14
1.	Mandamus.....	14
F.	Remand Determination	14
1.	Resolution in the First Instance.....	14
a.	Issue of Fact	14
2.	Opinion Dicta in View of Likely Remand Considerations	15
G.	Supreme Court Review	15
1.	Stay of Mandate during Cert Process.....	15
VIII.	Patent Office Proceedings.....	15
A.	Inter Partes Review	15
1.	Appeal	15
a.	Sufficient Reasoning to Review.....	15
b.	Jurisdiction Over Appeals Challenging PTAB Decisions	15
i.	Petitioner Appeals of Final Written Decision.....	15
2.	Submitting Supplemental Information/Arguments.....	16
B.	Covered Business Method Reviews.....	16
1.	Review of Institution Decision	16

I. Patentability Requirements

A. Prior Art Invalidity

1. Reference Disclosure

a. Inherency

i. Information/Printed Matter Limitations

“[A]lthough the asserted claims contain printed matter that is not functionally related to the remaining elements of the claims, each claim as a whole is patent eligible because none are solely directed to the printed matter.” “When each claim is read as a whole, the focus of the claimed advance is not solely on the content of the information conveyed, but also on the means by which that information is conveyed.” *C. R. Bard Inc. v. AngioDynamics, Inc.*, 2019-1756, 11/10/20.

Patentee unsuccessfully argued that “the information conveyed by the markers provides new functionality to the port because it makes the port “self-identifying.”” “A conclusion that mere identification of a device’s own functionality is sufficient to constitute new functionality for purposes of the printed matter doctrine would eviscerate our established case law.” *C. R. Bard Inc. v. AngioDynamics, Inc.*, 2019-1756, 11/10/20.

“[A] claim may be found patent ineligible under § 101 on the grounds that it is directed solely to non-functional printed matter and the claim contains no additional inventive concept.” *C. R. Bard Inc. v. AngioDynamics, Inc.*, 2019-1756, 11/10/20.

2. Anticipation (§ 102)

a. Publications/Patents

i. Public Accessibility

Board affirmed where it concluded that “[a]lthough no one piece of evidence definitively es-tablishes Bradford’s public accessibility prior to May 9, 2012, we find that the evidence, viewed as a whole, sufficiently does so.” *VidStream LLC v. Twitter, Inc.*, 2019-1734, 11/25/20.

3. Obviousness (§ 103)

a. Analogous Prior Art

i. Reasonably Pertinent to Problem

“[W]hen addressing whether a reference is analogous art with respect to a claimed invention under a reasonable-pertinence theory, the problems to which both relate must be identified and compared.” *Donner Tech., LLC v. Pro Stage Gear, LLC*, 2020-1104, 11/9/20.

“The problems . . . must be identified and compared from the perspective of a person having ordinary skill in the art (“PHOSITA”). Importantly, this analysis must be carried out from the vantage point of a PHOSITA who is considering turning to the teachings of references outside her field of endeavor. Such a PHOSITA—resigned to considering art outside her field of endeavor—would thus not identify the problems so narrowly so as to rule out all such art.” *Donner Tech., LLC v. Pro Stage Gear, LLC*, 2020-1104, 11/9/20 (citations omitted).

“[A] reference can be analogous art with respect to a patent even if there are significant differences between the two references.” *Donner Tech., LLC v. Pro Stage Gear, LLC*, 2020-1104, 11/9/20 (citations omitted).

b. Motivation/Apparent Reason to Combine/Modify

i. Evidence of Reasons not to Combine

Where combination of two references required removing one component but keeping another for one of the references, the Board had substantial evidence not to combine where the purpose of the second component was attaching the first component and there was “no “adequate[]” or “persua[sive]” explanation by [petitioner] for why a relevant artisan would keep the second component while replacing the [first component] to which it is attached.” *St. Jude Medical, LLC v. Snyders Heart Valve LLC*, 2019-2108, 10/15/20.

c. Subject Matter as a Whole/Routine Additions

“It does not matter that [petitioner] did not explain why an artisan would be motivated to use each element disclosed in [one reference]. That [the reference] treats the claim parameters as desirable is enough motivation for an artisan to combine them with [an element of another reference], as long as the artisan can make the combination with a reasonable expectation of success.” *Gen. Elec. Co. v. Raytheon Techs. Corp.*, 2019-1319, 12/28/20.

d. Teaching Away

“[The reference] does not make a single negative statement about the use of a two-stage high-pressure turbine; therefore, [the reference] does not criticize, credit, or discourage the use of a two-stage high-pressure turbine. For that reason, substantial evidence does not support [the teaching away finding.]” *Gen. Elec. Co. v. Raytheon Techs. Corp.*, 2019-1319, 12/28/20.

B. Section 101

1. Abstract Idea Exclusion

Characterizing the patent as having “a claim directed to the idea of using graphics instead of programming to create object-oriented simulations—maybe a new idea, but still an abstract one—and lacking any inventive concept, any meaningful *application* of this idea,

sufficient to save the claim’s eligibility.” *Simio, LLC v. FlexSim Software Prods. Inc.*, 2020-1171, 12/29/20 (emphasis in original).

a. Specification

Step evaluated based on what the “patent showcases its key advance.” *Simio, LLC v. FlexSim Software Prods. Inc.*, 2020-1171, 12/29/20.

b. Application of Mathematical Algorithm(s)

Conclusion that application step “does not, by itself, change the claim’s “character as a whole” from one directed to an abstract idea to one that’s not” supported by the fact that “the specification dedicates relatively little attention to the functionality reflected in the [application] limitation.” *Simio, LLC v. FlexSim Software Prods. Inc.*, 2020-1171, 12/29/20.

c. Information Processing

“Simply applying the already-widespread practice of using graphics instead of programming to the environment of *object-oriented* simulations is no more than an abstract idea.” *Simio, LLC v. FlexSim Software Prods. Inc.*, 2020-1171, 12/29/20 (emphasis in original).

II. Other Defenses

A. Equitable Estoppel

1. Misleading Communication

While one party “disavowed any ownership claim to [a specific] route of delivery of desmopressin and its associated low-dosage possibilities,” none of the “issued claims are limited to [that specific] administration of desmopressin.” Therefore, “a reasonable factfinder could conclude that it would have been unreasonable for [the second party] to infer from [the first party’s] communications that [the first party] intended to relinquish inventorship rights in the issued claims.” SJ of inequitable conduct reversed. *Ferring B.V. v. Allergan, Inc.*, 2020-1098, 11/10/20.

a. Change in Claim Scope

“[W]e decline to adopt a bright-line rule that equitable estoppel cannot apply whenever the scope of the issued patent is different than what the parties discussed in communications leading to the allegedly misleading conduct. Thus, while differences in claim scope are relevant to the equitable estoppel inquiry, their mere existence does not render pre-issuance conduct or communications irrelevant.” *Ferring B.V. v. Allergan, Inc.*, 2020-1098, 11/10/20.

b. Failing to Meet a Duty to Respond

“To the extent [a first party’s assertions] gave rise to a duty for [the other party] to respond, a reasonable factfinder could find that [the first party]’s blatant mischaracterization of the scope of [the other party]’s prior disclaimer relieved [the other party] of any such duty.” *Ferring B.V. v. Allergan, Inc.*, 2020-1098, 11/10/20.

2. Summary Judgment

“Our review of a district court’s grant of summary judgment of equitable estoppel proceeds in two steps. First, applying the law of the regional circuit (here, the Second Circuit), we review whether there are genuine issues of material fact.” “Second, we review the district court’s application of equitable estoppel for abuse of discretion.” *Ferring B.V. v. Allergan, Inc.*, 2020-1098, 11/10/20 (citations omitted).

3. Preclusion by Unclean Hands

“We therefore conclude that the district court abused its discretion in granting summary judgment of equitable estoppel because the court failed to consider all relevant evidence regarding the equities of the parties.” *Ferring B.V. v. Allergan, Inc.*, 2020-1098, 11/10/20.

B. Lack of Subject Matter Jurisdiction

1. Declaratory Judgment Jurisdiction

a. Discretionary

Affirmed discretionary dismissal without prejudice of DJ action seeking ruling on whether patent license agreement required valid claims and determination of such validity when a state court had already entered judgment after trial on a breach of license agreement claim. *Warsaw Orthopedic, Inc. v. Sasso*, 2019-1583, 10/14/20.

2. Substantial Question of Federal Patent Law

“Here, the federal issue—infringement of the patent in suit—is fact-bound and situation-specific. This case does not present a context-free interpretation of a patent statute, but requires merely that the court apply patent law to the facts of the case. As *Gunn* makes clear, it is not enough to suggest that there is an interest in uniform application of patent law, or that the federal courts are uniquely-situated to resolve the patent law question presented.” *AntennaSys, Inc. v. AQYR Techs., Inc.*, 2019-2244, 10/7/20.

C. Improper Venue

1. ANDA-Based Complaints

“[I]n cases brought under 35 U.S.C. § 271(e)(2)(A), infringement occurs for venue purposes only in districts where actions related to the submission of an Abbreviated New Drug Application (“ANDA”) occur, not in all locations where future distribution of the generic

products specified in the ANDA is contemplated.” “[D]istricts that are sufficiently related to the ANDA submission—in those districts where acts occurred that would suffice to categorize those taking them as a “submitter” under § 271(e).” *Valeant Pharms. N. Am. LLC v. Mylan Pharms. Inc.*, 2019-2402, 11/5/20.

D. No Ownership/Standing (see also II.C.2)

1. Must Be Addressed Before Substantive Issues

“Despite their non-jurisdictional nature, we agree that whether [plaintiff] meets these statutory prerequisites for bringing an infringement claim is a threshold question that both we and the district court must resolve before reaching the district court’s claim construction and summary judgment rulings. Put simply, if [plaintiff] does not meet the statutory requirements for bringing its patent infringement claim against [defendant], either because [a co-owner] was not joined as a co-plaintiff or because [plaintiff] does not adequately state a claim under the Patent Act against [defendant], we need not delve into the district court’s claim construction.” *AntennaSys, Inc. v. AQYR Techs., Inc.*, 2019-2244, 10/7/20.

2. Court Ordered Transfer

“Here, there is no argument that the district court lacked jurisdiction over Hamamatsu, and therefore the court had authority to compel assignment of foreign patents.” *SiOnyx LLC v. Hamamatsu Photonics K.K.*, 2019-2359, 12/7/20.

III. Literal Infringement

A. Summary Judgment/JMOL

1. Role of Claim Construction

Opinion of infringement not undermined by statement of incorrect claim construction when “[t]here is no indication from the record that [the witness] relied on the intent aspect of his claim interpretation in reaching his infringement opinion.” “even if [the witness] assumed that the claims required an additional intent element, nothing in the record suggests that this caused him to disregard the requirements of the asserted claims under the correct construction. Although the mistake might undermine his credibility, it does not make his testimony legally insufficient to support an infringement verdict.” *C. R. Bard Inc. v. AngioDynamics, Inc.*, 2019-1756, 11/10/20.

B. Appellate Review

1. Representative Claims for Trial

“[Patentee] did not officially “withdraw” its patents or claims, but merely selected “representative” claims to present to the jury upon the court’s request that it do so.” *Hoist Fitness Sys., Inc. v. TuffStuff Fitness Int’l, Inc.*, n.7, 2020-1047, 10/2/20 (nonprecedential).

C. Indirect Infringement

1. Induced Infringement

a. Intent to Induce

i. Knowledge of the patent

Press release issued before the patent, but maintained on website after the patent issued, was evidence from which the jury could find intent to induce. *GlaxoSmithKline LLC v. Teva Pharm. USA, Inc.*, 2018-1976, 10/2/20.

ii. Piggybacking on Patentee Communications

“[W]hen the provider of an identical product knows of and markets the same product for intended direct infringing activity, the criteria of induced infringement are met.” *GlaxoSmithKline LLC v. Teva Pharm. USA, Inc.*, 2018-1976, 10/2/20.

iii. During Appeal of Noninfringement SJ

“[A] defendant may have the liability-supporting subjective state of mind even if a person could believe, with objective reasonableness (though wrongly), that the induced conduct was not infringing. To make the point in terms of this case, Adobe may have had the requisite knowledge of infringement if it believed (as we ultimately held in 2013) that the March 3, 2011 claim construction was incorrect, even if that construction was objectively reasonable.” *TecSec, Inc. v. Adobe Inc.*, 2019-2192, 10/23/20.

2. ANDA Infringement

Type of use “carved out” of label still induced where generic referenced original product, which was known to have that use. *GlaxoSmithKline LLC v. Teva Pharm. USA, Inc.*, 2018-1976, 10/2/20.

D. Joint Infringement/Divided Infringement

Testimony sufficient to avoid joint infringement problem under JMOL standard: “in his professional experience, (1) the steps of scanning, identifying, and injecting, as required by the asserted method claims, were generally performed by a single CT technician, and (2) the implantation of the port, as required by claims 9 and 11, were typically performed by another medical provider at the same hospital, who would be acting as part of the same “entity” as the medical providers performing the other claim steps.” *C. R. Bard Inc. v. AngioDynamics, Inc.*, 2019-1756, 11/10/20.

E. Evidence of Infringement

1. Marketing/Instruction Materials

“[A]lthough Bard did not conduct its own tests of the Xcela port’s suitability for power injection, Bard was entitled to rely on AngioDynamics’s representations to its customers and to the FDA that the Xcela port was suitable for power injection at the flow rate and pressure required by the claims.” C. R. Bard Inc. v. AngioDynamics, Inc., 2019-1756, 11/10/20.

2. Testing

“[A]lthough Bard did not conduct its own tests of the Xcela port’s suitability for power injection, Bard was entitled to rely on AngioDynamics’s representations to its customers and to the FDA that the Xcela port was suitable for power injection at the flow rate and pressure required by the claims.” C. R. Bard Inc. v. AngioDynamics, Inc., 2019-1756, 11/10/20.

IV. Relief

A. Willfulness

1. Opinion of Counsel

Unchallenged invalidity opinions disregarded where defendant was “aware of the applications that issued as the patents-in-suit prior to their issuance” and “intentionally copied [patentee’s product] based on market demand.” “This is sufficient evidence to support a jury verdict of willfulness.” C. R. Bard Inc. v. AngioDynamics, Inc., 2019-1756, 11/10/20.

B. Reasonable Royalty

1. Minimum Measure of Damages

“The statute does not require an award of damages if none are proven that adequately tie a dollar amount to the infringing acts.” TecSec, Inc. v. Adobe Inc., 2019-2192, 10/23/20.

2. Established and Comparable Royalties/License Agreements

A damages model higher than the comparable license affirmed. “[T]he assumption of validity and infringement in a hypothetical negotiation, among other changed circumstances, supported not including a cap on her proposed royalty. The jury was entitled to credit that testimony.” Vectura Ltd. v. GlaxoSmithKline LLC, 2020-1054, 11/19/20.

a. Substantial Evidence of Comparability

“Similarity of scope is confirmed by the fact that the mixtures Vectura points to as infringing the ’991 patent would have been the very same mixtures covered by the 2010

license. On appeal, GSK has offered nothing to undermine that conclusion. Accordingly, the fact that other patents were included in the 2010 license does not fatally undermine Ms. Schenk’s theory of comparability.” *Vectura Ltd. v. GlaxoSmithKline LLC*, 2020-1054, 11/19/20.

V. Claim Construction

A. Special Constructions

1. Broadest Reasonable Interpretation During Prosecution

a. Expiration Exception

Exception not applied to post-briefing terminal disclaimer. “This court “shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office.” 35 U.S.C. § 144. Our predecessor court has refused to consider terminal disclaimers filed after the Board’s decision. In this situation, we do the same.” *Immunex Corp. v. Sanofi-Aventis U.S. LLC*, 2019-1749, 10/13/20 (citations omitted).

b. Doesn’t Include Absent Modifier

“Human antibody” not limited to “fully human antibody” where the specification used “fully” in some, but not all, discussions and the applicants left that modifier out of the claim language. *Immunex Corp. v. Sanofi-Aventis U.S. LLC*, 2019-1749, 10/13/20.

B. Claim Language

1. Open/Closed Claims, Generic and Negative Limitations

a. Linking Limitations (associated with, aware of, corresponds, represents, etc.)

“[T]he Board did not err in declining to import exemplary embodiments of “instruction code” from the specification into the broader claim term “instruction data.”” *SIPCO, LLC v. Emerson Elec. Co.*, 2018-1635, 11/17/20.

2. Functional and Structural Language

a. Structure Elements Limited by Method of Manufacture

Process of manufacture not a limitation. “Although the ’991 patent contains a few statements suggesting that its high-energy milling is required, those statements are outweighed by the numerous statements indicating that high-energy milling is merely a preferred process.” *Vectura Ltd. v. GlaxoSmithKline LLC*, 2020-1054, 11/19/20.

C. Written Description

1. Lexicography

a. Requirements

Where a claim term is used in the specification with “as used herein shall be understood to mean that”, the following text is a definition and the surrounding claim text is understood in view of that definition. “This is particularly true given the language used in the express definition of “gradually” set forth in ¶ 37.” *Chevron U.S.A. Inc. v. University of Wyoming Research Corp.*, 2019-1530, 11/4/20.

2. Differences Between Claim Language and Specification Language

Where the specification says that “the frame is sized and shaped for insertion *between the plurality of cusps C of the damaged heart valve in a position* between an upstream region and a downstream region” but the claims leave out the italicized language, the Court concluded that the limited claim language “is not meant to refer only to placement in a position between the upstream and down-stream regions, but also to fitting between the cusps of the intact native valve.” *St. Jude Medical, LLC v. Snyders Heart Valve LLC*, 2019-2108, 10/15/20.

3. Advantages/Purposes/Problems Addressed

Where the specification includes a “specific description of overcoming deficiencies”, the claim should not be construed to cover the identified deficiencies even under the broadest reasonable interpretation. *St. Jude Medical, LLC v. Snyders Heart Valve LLC*, 2019-2108, 10/15/20.

D. Prosecution History

1. Examiner's Statements

“[G]iven that [the reference] itself uses the term “fully human” to describe its own disclosure, we decline to treat as significant the examiner’s adoption of that term in making the rejection.” *Immunex Corp. v. Sanofi-Aventis U.S. LLC*, 2019-1749, 10/13/20.

E. Extrinsic Evidence

1. Proper Reliance Upon

Where “the meaning of [the disputed term] as discerned from the intrinsic evidence squarely conflicts with the meaning that [a party] would distill from its selected extrinsic evidence . . . , the intrinsic record trumps.” *Immunex Corp. v. Sanofi-Aventis U.S. LLC*, 2019-1749, 10/13/20.

F. Timing of Construction and Parties' Positions

1. Waiver

“[T]he Board adopted as the governing claim construction for “band” . . . “a structure generally in the shape of a closed strip or ring.” St. Jude expressly accepts that construction.” “St. Jude has offered nothing at all to indicate that “strip” and “ring” cannot have any width (“length,” in the patent’s terms) constraint in the relevant skilled artisan’s understanding. If St. Jude wanted to argue that “band” precludes any such constraint, it should have proposed a claim construction that did so. It did not. The adopted claim construction therefore governs.” St. Jude Medical, LLC v. Snyders Heart Valve LLC, 2019-2108, 10/15/20.

2. Construing the Words in the Construction

Improper to construe words in the construction using definitions of the claim term rather than the words in the construction. “The more fundamental problem with St. Jude’s basis for its argument, however, is that it simply does not address the terms “strip” and “ring,” which St. Jude itself proposed and now accepts as the defining terms of the claim construction. The relied-on dictionary definitions and specification passages address “band” but not “strip” or “ring.”” St. Jude Medical, LLC v. Snyders Heart Valve LLC, 2019-2108, 10/15/20.

VI. Procedural Law

A. Applicable Circuit Law

1. Interpretation of State Statutes

“We review a district court’s interpretation of a State’s statutes de novo. In doing so, we give weight to decisions of federal courts that are “better schooled in” the law of the particular State involved.” *Whitewater West Indus., Ltd. v. Alleshouse*, 2019-1852, 11/19/20.

B. Pleadings/Parties

1. 12(b)(6) Dismissals

a. Sufficient Identification of Individual Defendants

“[T]here are eight other paragraphs in the complaint asserting that “Mylan”—defined to encompass all three entities—“submitted” the ANDA and materials related to it. The district court may well find that these paragraphs are sufficient to state a claim against MLL, despite the phrasing in paragraph 29, or that leave to amend to clarify any apparent confusion would be appropriate.” *Valeant Pharms. N. Am. LLC v. Mylan Pharms. Inc.*, 2019-2402, 11/5/20.

C. Discovery/Evidence

1. Prejudicial Evidence

“[T]he district court in this case went beyond excluding a single piece, or even a fixed set, of evidence Instead, the court foreclosed the introduction of any evidence on the issue of post-March 3, 2011 inducement of infringement. This is materially different from any application of Rule 403 Adobe has identified.” *TecSec, Inc. v. Adobe Inc.*, 2019-2192, 10/23/20.

D. Transfer to New Judge or Venue

Ever where the CAFC did not “disturb the district court’s ultimate conclusion that the location of relevant documents is neutral” or that “the availability of compulsory process to secure the attendance of witnesses—was neutral in this case”, it still concluded that “the remainder of the factors convince us that transfer is appropriate and that the court clearly abused its discretion in concluding otherwise.” *In re Apple Inc.*, 2020-135, 11/9/20.

“Although district courts have discretion as to how to handle their dockets, once a party files a transfer motion, disposing of that motion should unquestionably take top priority.” *In re Apple Inc.*, 2020-135, 11/9/20.

“Unless the balance of transfer factors favors keeping the case in the second-filed court, there are no compelling circumstances to justify such an exception.” *In re Nitro Fluids L.L.C.*, 2020-142, 10/28/20.

Court congestion factor is whether there is “an appreciable difference in docket congestion between the two forums.” “Cameron’s multiple efforts to amend its complaint and also the proceedings being stayed pending potential review of the asserted patents by the Patent Office at least suggest that any potential difference between the two courts in being able to schedule a trial would not actually be related to whether such an appreciable difference existed.” *In re Nitro Fluids L.L.C.*, 2020-142, 10/28/20.

1. Sources of Proof Factor

“The district court legally erred in considering witnesses as “sources of proof” for purposes of the first private interest factor. This factor relates to the ease of access to non-witness evidence, such as documents and other physical evidence; the third private interest factor—the cost of attendance for willing witnesses—relates to the convenience of each forum to witnesses.” *In re Apple Inc.*, 2020-135, 11/9/20.

“[A]lthough we credit the district court’s determination that some relevant documents are located in WDTX, the movant need not show that all relevant documents are located in the transferee venue to support a conclusion that the location of relevant documents favors transfer.” *In re Apple Inc.*, 2020-135, 11/9/20.

2. Cost of Attendance of Willing Witnesses Factor

Where the district court gave significant weight to the difference in distance from NY to WDTX as opposed to NY to NDCA, it did not comply with *Genentech*'s instruction that the 100-mile rule should not be rigidly applied where witnesses "will be required to travel a significant distance no matter where they testify." "The district court misapplied the law to the facts of this case by too rigidly applying the 100-mile rule." *In re Apple Inc.*, 2020-135, 11/9/20.

3. Other Practical Problems Factor

Legally incorrect to weigh against transfer significant steps taken in the case where "all the "significant steps" that had been taken by the court and parties in the case were taken *after* Apple moved for transfer in November 2019, as well as *after* Apple moved to stay the case in January 2020." *In re Apple Inc.*, 2020-135, 11/9/20.

"Although the district court noted that NDCA has more pending cases than WDTX, this fact is, without more, too tenuously related to any differences in speed by which these districts can bring cases to trial." *In re Apple Inc.*, 2020-135, 11/9/20.

4. Congestion Factor

"Indeed, a district court cannot merely set an aggressive trial date and subsequently conclude, on that basis alone, that other forums that historically do not resolve cases at such an aggressive pace are more congested for venue transfer purposes. This is particularly true where, like here, the forum itself has not historically re-solved cases so quickly." *In re Apple Inc.*, 2020-135, 11/9/20.

VII. Federal Circuit Appeals

A. New Arguments/Issues on Appeal/Forfeiture/Waiver/Judicial Estoppel

1. District Court/ITC Appeals

a. Claim Construction Waiver

i. Construction Advocated at Markman

"Vectura argues that GSK waived its claim construction challenge by proposing a different construction in the district court." "Given the similarities between GSK's arguments here and in the district court, we find no waiver." *Vectura Ltd. v. GlaxoSmithKline LLC*, 2020-1054, 11/19/20.

"Even under the most generous of readings, Google's arguments below did not suggest any definition of "network penalty," let alone the highly particularized definition it presents on appeal." *In re Google Tech. Holdings LLC*, 2019-1828, 11/13/20.

2. PTO Appeals

a. Claim Construction Arguments

“Because Google failed to present these claim construction arguments to the Board, Google forfeited both arguments.” “Allowing Google to press, on appeal, a specific claim construction that it did not present to the Board deprives the Board, an expert body, of its important role in reviewing the rejection of patent applications.” *In re Google Tech. Holdings LLC*, 2019-1828, 11/13/20.

3. New Argument in Reply Brief

“To the extent Apple raises new arguments in its reply brief in response to the district court’s order, we exercise our discretion to not apply waiver because doing so would be unfair under the circumstances.” “In the petition, Apple addressed what it believed would be the court’s likely reasons for its denial of the motion. Apple was first able to directly address the district court’s order in its reply brief.” *In re Apple Inc.*, 2020-135, 11/9/20.

B. Cross-Appeals v. Alternate Bases for Affirmance

1. Alternative Bases in Agency Appeals

“We conclude that the Board’s obviousness determination was supported by substantial evidence even under SIPCO’s proposed construction.” *SIPCO, LLC v. Emerson Elec. Co.*, 2018-1635, 11/17/20.

2. Dismissing Cross-Appeals

a. Invalidity as Affirmative Defense Only

“[Patentee] moved to dismiss that cross-appeal as improperly directed to [defendant]’s affirmative defense of patent invalidity. We granted [patentee]’s motion Notably [defendant] did not seek a declaratory judgment of invalidity, asserting invalidity only as an affirmative defense to the claim of infringement.” *AntennaSys, Inc. v. AQYR Techs., Inc.*, n.1, 2019-2244, 10/7/20.

C. Mootness of Appealed Rulings

1. Willfulness Rulings

“Because there is no “tangible, demonstrable consequence” to the jury’s finding of willfulness, our consideration of the issue would be tantamount to an advisory opinion, which we lack the authority to provide.” *SiOnyx LLC v. Hamamatsu Photonics K.K.*, 2019-2359, 12/7/20.

D. Standards of Review and Record/Appendix on Appeal

1. Clear/Plain Error Review

“But the existence of contrary testimony alone does not make the district court’s finding clearly erroneous.” *SiOnyx LLC v. Hamamatsu Photonics K.K.*, 2019-2359, 12/7/20.

2. Abuse of Discretion

Abuse of discretion found where district court “fail[s] to conduct an adequate inquiry.” *Ferring B.V. v. Allergan, Inc.*, 2020-1098, 11/10/20 (quoting *Atl. Research Mktg. Sys., Inc. v. Troy*, 659 F.3d 1345, 1360 (Fed. Cir. 2011)).

a. Granting New Trial

“On the issue of the impact of improper conduct at trial, the views of the judge who supervised the trial proceedings are entitled to considerable weight. *See Fineman v. Armstrong World Indus., Inc.*, 980 F.2d 171, 207 (3d Cir. 1992) (“Because the trial judge was present and able to judge the impact of counsel’s remarks, we defer to his assessment of the prejudicial impact.”). We find no basis to second-guess the judgment of the experienced trial judge in this regard. We therefore decline to conclude that the district court abused its discretion, and we uphold the court’s decision denying a new trial on this ground.” *Vectura Ltd. v. GlaxoSmithKline LLC*, 2020-1054, 11/19/20.

E. Relief Outside Appeal Process

1. Mandamus

Mandamus relief appropriate where CAFC “properly reviewed the district court’s order only for reliance on clearly erroneous fact findings, erroneous conclusions of law, or misapplications of law to fact. District courts have no discretion to make these kinds of errors. And when such errors accumulate to produce a patently erroneous result, as they have here, we are obliged to act.” *In re Apple Inc.*, 2020-135, 11/9/20 (citations omitted).

F. Remand Determination

1. Resolution in the First Instance

a. Issue of Fact

“[I]n general, appellate courts can rule on an issue of fact in the first instance only where “no reasonable fact finder could find otherwise.”” *Donner Tech., LLC v. Pro Stage Gear, LLC*, 2020-1104, 11/9/20.

2. Opinion Dicta in View of Likely Remand Considerations

“While we have already concluded that a remand is appropriate for other reasons, we address this issue because it will remain live on remand.” *Ferring B.V. v. Allergan, Inc.*, 2020-1098, 11/10/20.

G. Supreme Court Review

1. Stay of Mandate during Cert Process

A motion for stay of mandate under FRAP 41 is only granted when “the applicant show[s] (1) a reasonable probability that four Justices will consider the issue sufficiently meritorious to grant certiorari; (2) a fair prospect that a majority of the Court will vote to reverse the judgment below; and (3) a likelihood that irreparable harm will result from the denial of a stay. In close cases the Circuit Justice or the Court will balance the equities and weigh the relative harms to the applicant and to the respondent.” “As a matter of Federal Circuit law, we interpret the Rule as requiring application of the standard articulated by the Supreme Court in *Hollingsworth* and the Justices’ in-chambers opinions.” *American Axle & Manuf., Inc. v. Neapco Hldgs. LLC*, 2018-1763, 10/23/20.

“[T]his Court will have to recall its mandate to conform its disposition with such a decision. This action, common to every case in which the Supreme Court does not affirm, is not irreparable harm.” *American Axle & Manuf., Inc. v. Neapco Hldgs. LLC*, 2018-1763, 10/23/20 (citations omitted).

VIII. Patent Office Proceedings

A. Inter Partes Review

1. Appeal

a. Sufficient Reasoning to Review

“Thus, [petitioner] set forth both arguments and evidence that [the reference at issue] is analogous art. Given the Board’s mistaken assertion to the contrary, it is unclear whether the Board meaningfully considered all of [petitioner]’s arguments and evidence.” *Donner Tech., LLC v. Pro Stage Gear, LLC*, 2020-1104, 11/9/20.

b. Jurisdiction Over Appeals Challenging PTAB Decisions

i. Petitioner Appeals of Final Written Decision

“[Petitioner] has met its requisite burden of production to show that it will likely engage in activity that would prompt an infringement suit.” “[Petitioner]’s specific investment in continued development of a geared turbofan engine design, its avowed preference to offer this design for sale, and its informal offer of this engine to [a customer] in an ongoing bidding process together establish that [petitioner] will likely engage in the sale of this geared turbofan engine design to customers.” Declaratory statements of substantial risk of

infringement made “coyly” were sufficient. *Gen. Elec. Co. v. Raytheon Techs. Corp.*, 2019-1319, 12/28/20.

2. Submitting Supplemental Information/Arguments

Denial of motion to strike petitioner’s additional publication evidence offered in the reply was affirmed. “We conclude that the Board acted appropriately, for the Board permitted both sides to provide evidence concerning the reference date of the Bradford book, in pursuit of the correct answer.” *VidStream LLC v. Twitter, Inc.*, 2019-1734, 11/25/20.

B. Covered Business Method Reviews

1. Review of Institution Decision

“[T]he threshold determination that SIPCO’s ’842 patent qualifies for CBM review is a decision that is non-appealable under 35 U.S.C. § 324(e). We therefore are pre-cluded from reviewing SIPCO’s challenge to that threshold determination.” *SIPCO, LLC v. Emerson Elec. Co.*, 2018-1635, 11/17/20.