

## Table of Contents

I.	Patentability Requirements .....	1
A.	Prior Art Invalidity.....	1
1.	Reference Disclosure .....	1
a.	Disclosure to POSITA .....	1
i.	Context of Cited Articles .....	1
2.	Anticipation (§ 102).....	1
a.	Publications/Patents .....	1
i.	Public Accessibility .....	1
ii.	Establishing Publication Date .....	1
3.	Obviousness (§ 103) .....	1
a.	Differences Between the Prior Art and the Claims at Issue.....	1
i.	Single Reference with Differences .....	1
b.	Analogous Prior Art.....	2
i.	Same Field of Endeavor.....	2
ii.	Reasonably Pertinent to Problem.....	2
c.	Reasonable Expectation of Success .....	2
d.	Expert Testimony.....	2
e.	Secondary Indicia of Nonobviousness.....	2
i.	Copying.....	2
ii.	Presumption of Nexus.....	3
f.	Teaching Away .....	3
B.	Invalidity Based on § 112 .....	4
1.	Enablement (¶ 1).....	4
a.	Full Scope of the Claim .....	4
b.	Undue Experimentation .....	4
2.	Written Description (¶ 1) .....	4
a.	Species Disclosure Supporting Genus Claim .....	4
3.	Indefiniteness (¶ 2).....	4
a.	Invalid .....	4
i.	Measurable Claim Limitations.....	4
ii.	Construable .....	5
b.	Surrounding claim language .....	5
C.	Section 101.....	5
1.	Claim Considered as a Whole.....	5
2.	Found in Nature/Preemption of Natural Phenomenom .....	5
3.	Abstract Idea Exclusion .....	5
II.	Other Defenses.....	6
A.	License .....	6
1.	Sublicense .....	6
2.	Termination.....	6
a.	Bankruptcy.....	6
B.	Improper Venue .....	7
1.	Waiver.....	7
C.	Insufficient U.S. Activities .....	7

1.	Location of a “Sale” under 271(a)	7
D.	Testing for FDA Purposes (271(e)(1))	7
III.	Literal Infringement	7
A.	Indirect Infringement	7
1.	ANDA Infringement	7
B.	Infringement by Foreign Acts	8
1.	Foreign Products Made Using a Patented Process (271(g))	8
C.	Design Patents	8
D.	Evidence of Infringement	8
1.	Marketing/Instruction Materials	8
IV.	DOE Infringement	8
A.	Substantial Equivalence	8
1.	Summary Judgment/JMOL	8
B.	Prosecution History Bar	9
1.	Amendment Estoppel	9
a.	Narrowing Amendment	9
b.	Scope of Estoppel	9
i.	Merely Tangential	9
V.	Relief	9
A.	Attorneys’ fees	9
1.	Exceptional Case (§ 285)	9
a.	Prevailing Party	9
b.	Bad Faith Litigation/Litigation Misconduct	10
c.	Baseless Claims	10
d.	Totality of the Circumstances	10
2.	Amount	10
B.	Reasonable Royalty	10
1.	Lump sum v. Running	10
C.	Multiple Claims or Patents	11
VI.	Claim Construction	11
A.	Claim Language	11
1.	Plain and Ordinary Meaning	11
a.	Exceptions	11
i.	Prosecution/Specification Disavowal	11
2.	Functional and Structural Language	11
a.	Whereby, Wherein and Intended Result Clauses	11
b.	Predetermined Limitations	11
3.	Effect of Other Claims	12
a.	Terms are Consistent in Different Claims	12
i.	Terms in Related Patents	12
B.	Written Description	12
1.	Advantages/Purposes/Problems Addressed	12
C.	Extrinsic Evidence	12
1.	Inventor/Prosecutor Statements	12
D.	Timing of Construction and Parties’ Positions	12
1.	In Granting Summary Judgment	12

a.	Reliance on Markman Order Discussion of Construction Rather Than Construction Itself.....	12
E.	Limited and Ordinary Meaning Constructions .....	13
1.	Questions of Fact in Applying Constructions.....	13
VII.	Procedural Law .....	13
A.	Applicable Circuit Law.....	13
1.	Contract Interpretation .....	13
B.	Jury Issues.....	13
1.	Right to a Jury Trial .....	13
C.	New Trial; Altering or Amending Judgment (Rule 59).....	13
1.	False Testimony .....	13
D.	Construction.....	14
1.	Statutes/Regulations.....	14
a.	Conflicting Federal Statutes.....	14
E.	Waiver.....	14
VIII.	Federal Circuit Appeals .....	14
A.	New Arguments/Issues on Appeal/Waiver/Judicial Estoppel .....	14
1.	PTO Appeals.....	14
a.	Appeals from PTAB Decision .....	14
2.	Insufficient Language in Principal Brief.....	14
B.	Cross-Appeals v. Alternate Bases for Affirmance.....	15
1.	Alternative Bases in Agency Appeals.....	15
C.	Mootness of Appealed Rulings.....	15
1.	Invalidity Rulings.....	15
D.	Standards of Review and Record/Appendix on Appeal .....	15
1.	Substantial Evidence Threshold.....	15
a.	Prior Art .....	15
b.	Expert Testimony.....	15
c.	Tying Evidence to Legal Requirements.....	16
2.	Review Judgments not Opinions .....	16
a.	Interpreting Opinion Being Reviewed .....	16
E.	Harmless Error .....	16
F.	Remand Determination .....	16
1.	Scope of Mandate .....	16
IX.	Patent Office Proceedings.....	17
A.	Inter Partes Review .....	17
1.	Institution .....	17
a.	Time limit under section 315(b) .....	17
i.	Qualifying Complaints.....	17
2.	Appeal.....	17
a.	Waiver of issues not included in rehearing request .....	17
b.	Petitioner Standing.....	17
c.	Remand to Consider Relevant Evidence in Record.....	17
3.	Expert Testimony.....	17
4.	Submitting Supplemental Information/Arguments.....	17
5.	Obviousness Rulings.....	18

a.	Reversal.....	18
6.	Board Final Written Decision .....	18
a.	Waiver of New Theories .....	18
B.	Post-Grant Reviews .....	18
1.	Scope of Authority of Director .....	18
2.	Requests for Permission to File a Motion.....	18

## **I. Patentability Requirements**

### **A. Prior Art Invalidity**

#### **1. Reference Disclosure**

##### **a. Disclosure to POSITA**

###### **i. Context of Cited Articles**

“Gibbs is a review article that collects, reviews, and analyzes other research studies. As such, the above passage relies on references 12 and 13 to support its discussion about anti-cancer activity.” “Reading Gibbs in the context of its cited articles reveals that this statement cannot be referring to erlotinib.” “The Board erred by not properly considering that none of the cited articles supported its reading of Gibbs, as well as Dr. Gibbs’s testimony to that effect.” *OSI Pharm., LLC v. Apotex Inc.*, 2018-1925, 10/4/19.

#### **2. Anticipation (§ 102)**

##### **a. Publications/Patents**

###### **i. Public Accessibility**

Accessibility upheld despite lack of indexing evidence where the article was in a “journal [that] had been published for at least thirty years and that the library was accessible to the public.” *Telefonaktiebolaget LM Ericsson v. TCL Corp.*, 2017-2381, 11/7/19.

###### **ii. Establishing Publication Date**

“[T]he proponent of a foreign publication bears the burden of proving its availability if challenged.” *Telefonaktiebolaget LM Ericsson v. TCL Corp.*, 2017-2381, 11/7/19.

Upholding Board determination that date had been established when patentee “provided no evidence to counter [a librarian] Declaration, the date on the face of the journal, and the Library’s records showing receipt of the journal and its shelving.” *Telefonaktiebolaget LM Ericsson v. TCL Corp.*, 2017-2381, 11/7/19.

#### **3. Obviousness (§ 103)**

##### **a. Differences Between the Prior Art and the Claims at Issue**

###### **i. Single Reference with Differences**

Challenger argued obviousness based on modifying a first aspect of a reference while keeping second aspect the same. Board determination that a POOSITA would only modify the two aspects in a manner proportional to the disclosed example of the two aspects, which would not meet a claim limitation, supported by substantial evidence when the reference expressly suggested “the device may be made in any desired [first

aspect] to accommodate [second aspect].” *Campbell Soup Co. v. Gamon Plus, Inc.*, 2018-2099, 10/15/19 (nonprecedential).

**b. Analogous Prior Art**

“[A]n analysis of whether an asserted reference is analogous art should take into account any relevant evidence in the record cited by the parties to demonstrate the knowledge and perspective of a person of ordinary skill in the art.” *Airbus S.A.S. v. Firepass Corp.*, 2019-1803, 11/8/19.

**i. Same Field of Endeavor**

Concluding that a “finding under the field of endeavor test is supported by substantial evidence” where evidence included comparing “the preamble of claim 1” and “the title” of the challenged patent to “the title” and “several passages from the Field of the Invention section” of the art. *Airbus S.A.S. v. Firepass Corp.*, 2019-1803, 11/8/19.

**ii. Reasonably Pertinent to Problem**

“[T]he Board erred in its “reasonably pertinent” determination because the Board declined to consider record evidence advanced by Airbus to demonstrate the knowledge and perspective of a person of ordinary skill in the art at the time of the invention.” *Airbus S.A.S. v. Firepass Corp.*, 2019-1803, 11/8/19.

**c. Reasonable Expectation of Success**

Prior art stating that a particular mechanism has reached a development point where there is still an “over 99.5% failure rate” does not provide substantial evidence of a reasonable expectation of success. *OSI Pharm., LLC v. Apotex Inc.*, 2018-1925, 10/4/19.

**d. Expert Testimony**

“[W]e are not persuaded that the legal determination of obviousness in this case requires such evidence. The technology here—coated materials for cold weather and outdoor products—is “easily understandable without the need for expert explanatory testimony.”” *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories*, 2018-1329, 11/13/19 (quoting *Centricut, LLC v. Esab Grp., Inc.*, 390 F.3d 1361, 1369 (Fed. Cir. 2004)).

**e. Secondary Indicia of Nonobviousness**

**i. Copying**

“[C]opying requires the replication of a specific product.” *Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1325 (Fed. Cir. 2004), 04-1149, 12/14/04; but see analysis of that language as dicta: “[t]he Board, however, disregarded its finding that L’Oreal copied Liqwd’s patented method, determining that the evidence of L’Oreal’s copying efforts was irrelevant because Liqwd had not shown that L’Oreal “copied a patented product.” *Id.*

The evidence presented by Liqwd shows more than merely a “competing product that arguably falls within the scope of a patent.” Wyers, 616 F.3d at 1245–46. Determining that this evidence is relevant does not implicate our concern with avoiding every infringement suit turning into a confirmation of the nonobviousness of a patent. See Iron Grip Barbell, 392 F.3d at 1325. Because this evidence of actual copying efforts is relevant, the Board erred by disregarding its finding.” Liqwd, Inc. v. L’Oreal USA, Inc., 2018-2152, 10/30/19.

## ii. Presumption of Nexus

“. . . SRAM’s marketing materials confirm that the forwardly protruding tooth tips, hook features, and mud clearing recesses each materially impacts the functioning of a chainring. *For each of these features* that the Board confirms is included in the X-Sync chainrings, nexus can only be presumed between the X-Sync chainrings and a patent claim if the claim includes limitations relating to these features.” Fox Factory, Inc. v. SRAM, LLC, 2018-2024, 12/18/19.

“It is undisputed that the [products] include unclaimed features that the patentee describes as [achieving the purpose] of another one of SRMA’s patents. In light of the patentee’s own assertions about the significance of the un-claimed features, no reasonable fact finder could conclude that these features are insignificant.” Fox Factory, Inc. v. SRAM, LLC, 2018-2024, 12/18/19.

“[I]f the unclaimed features amount to nothing more than additional insignificant features, presuming nexus may nevertheless be appropriate.” “Although we do not require the patentee to prove perfect correspondence to meet the coextensiveness requirement, what we do require is that the patentee demonstrate that the product is essentially the claimed invention.” Fox Factory, Inc. v. SRAM, LLC, 2018-2024, 12/18/19.

“Whether a product is coextensive with the patented invention, and therefore whether a presumption of nexus is appropriate in a given case, is a question of fact.” Fox Factory, Inc. v. SRAM, LLC, 2018-2024, 12/18/19.

## f. Teaching Away

“[A]lthough [the reference] recites the disadvantage of the high power demand of frequency dividers, [the reference] does not suggest that this mode of phase shifting would be ineffective in achieving the high phase accuracy required of frequency dividers. [The reference] does not criticize, discredit, or discourage the technological efficacy of a frequency divider for phase shifting.” Telefonaktiebolaget LM Ericsson v. TCL Corp., 2017-2381, 11/7/19.

## **B. Invalidity Based on § 112**

### **1. Enablement (¶ 1)**

#### **a. Full Scope of the Claim**

“This factor, however, considers the scope of the claim as written, not just the subset of the claim that a POSA might practice. [] We therefore conclude that the breadth of the claims weighs in favor of non-enablement.” Idenix Pharm. LLC v. Gilead Scis., Inc., 2018-1691, 10/30/19.

“and because the only working examples provided are exceedingly narrow relative to the claim scope, these two factors weigh in favor of non-enablement.” Idenix Pharm. LLC v. Gilead Scis., Inc., 2018-1691, 10/30/19.

“Idenix’s attempt to treat NS5B as a claim limitation, based on the knowledge of a POSA, would be an impermissible end-run around the requirement to enable the full scope of the claim.” Idenix Pharm. LLC v. Gilead Scis., Inc., 2018-1691, 10/30/19.

#### **b. Undue Experimentation**

“We are not persuaded by Idenix’s attempts to distinguish *Wyeth* based on the state of the arts of screening and synthesis in 1992, when the *Wyeth* patent application was filed, as compared to 2000, when Idenix’s first application was filed.” Idenix Pharm. LLC v. Gilead Scis., Inc., 2018-1691, 10/30/19.

“We agree with the district court that the quantity of experimentation required to determine which [compounds from a class of “at least many, many thousands”] meet claim 1 is very high, which favors a finding of non-enablement.” Idenix Pharm. LLC v. Gilead Scis., Inc., 2018-1691, 10/30/19.

### **2. Written Description (¶ 1)**

#### **a. Species Disclosure Supporting Genus Claim**

“Each of [working examples, formulas, data, synthesis routes, and the target] suffer from the same flaw. They provide lists or examples of supposedly effective nucleosides, but do not ex-plain what makes them effective, or why.” Idenix Pharm. LLC v. Gilead Scis., Inc., 2018-1691, 10/30/19.

### **3. Indefiniteness (¶ 2)**

#### **a. Invalid**

##### **i. Measurable Claim Limitations**

“Here, an evaluation of the specification reveals inconsistencies about the [claim requirement at issue]. Two tests are disclosed, but those tests do not provide consistent

results upon which a POSITA would be able to evaluate [the requirement].” HZNP Medicines LLC v. Actavis Labs. UT, Inc., 2017-2149, 10/10/19.

## **ii. Construable**

Patentee’s “proposed construction” of Term A includes Term B. “Since [Term B] is indefinite, it logically follows that another term, such as [Term A], which relies on [Term B] for its construction, must also be indefinite.” HZNP Medicines LLC v. Actavis Labs. UT, Inc., 2017-2149, 10/10/19.

### **b. Surrounding claim language**

“First, we look to the language of the claims to evaluate if the meaning of [the disputed claim term] is reasonably clear.” HZNP Medicines LLC v. Actavis Labs. UT, Inc., 2017-2149, 10/10/19.

When a claim use “consisting essentially of” as its transition term, “the basic and novel properties must be sufficiently definite so as to inform, with reasonable certainty, a POSITA of their scope within the context of the invention.” HZNP Medicines LLC v. Actavis Labs. UT, Inc., 2017-2149, 10/10/19.

## **C. Section 101**

### **1. Claim Considered as a Whole**

“[F]eatures that are not claimed are irrelevant as to step 1 or step 2 of the Mayo/Alice analysis.” American Axle & Manuf., Inc. v. Neapco Hldgs. LLC, 2018-1763, 10/3/19.

### **2. Found in Nature/Preemption of Natural Phenomenon**

“[T]he claims’ general instruction to tune a liner amounts to no more than a directive to use one’s knowledge of Hooke’s law, *and possibly other natural laws*, to engage in an ad hoc trial-and-error process of changing the characteristics of a liner until a desired result is achieved.” American Axle & Manuf., Inc. v. Neapco Hldgs. LLC, 2018-1763, 10/3/19 (emphasis added).

Invalidity SJ upheld of a “a claim to a method of manufacturing” as “directed to a natural law.” American Axle & Manuf., Inc. v. Neapco Hldgs. LLC, 2018-1763, 10/3/19 (Dyk and Taranto majority with Moore dissent).

### **3. Abstract Idea Exclusion**

“By requiring that the permutation applied to original data be modified “in time,” claim 2, which is incorporated into all appealed claims, recites a specific implementation of varying the way check data is generated that improves the ability of prior art error detection systems to detect systematic errors.” “[T]he appealed claims recite a sufficiently specific implementation (i.e., modifying the permutation applied to the original data “in time”) of an existing tool (i.e., check data generating device) that

improves the functioning of the overall technological process of detecting systematic errors in data transmissions.” Koninklijke KPN N.V. v. Gemalto M2M GmbH, 2018-1863, 11/15/19.

“A claim that is directed to improving the functionality of one tool (e.g., error checking device) that is part of an existing system (e.g., data transmission error detection system) does not necessarily need to recite how that tool is applied in the overall system (e.g., perform error detection) in order to constitute a technological improvement that is patent-eligible.” Koninklijke KPN N.V. v. Gemalto M2M GmbH, 2018-1863, 11/15/19.

## **II. Other Defenses**

### **A. License**

#### **1. Sublicense**

“[O]ur law does not provide for automatic survival of a sublicense.” Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung E.V. v. Sirius XM Radio Inc., 2018-2400, 10/17/19.

“It may be that the sublicense grant was complete and irrevocable before the termination of the Master Agreement. Under such circumstances the sublicensor, at the time of the grant of the sublicense, would not be conveying more to the sublicensee than it had received from the master licensor.” Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung E.V. v. Sirius XM Radio Inc., 2018-2400, 10/17/19.

Even where a license is rescinded, a bona fide sublicensor for value retains its rights. *Rhone-Poulenc Agro, S.A. v. DeKalb Genetics Corp.*, 284 F.3d 1323, 1332 (Fed. Cir. 2001), 00-1266, 11/19/01. But see “*Rhone-Poulenc* does not stand for the proposition that a district court may forgo contract interpretation and assume that a sublicense survives by operation of law.” Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung E.V. v. Sirius XM Radio Inc., 2018-2400, 10/17/19.

#### **2. Termination**

“[I]t is a general rule of contract law that a party exercising the right to terminate the contract must give notice within a reasonable time.” Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung E.V. v. Sirius XM Radio Inc., n.3, 2018-2400, 10/17/19.

##### **a. Bankruptcy**

“Fraunhofer argues that because the Sublicense Agreement was never expressly assumed during bankruptcy proceedings, it was rejected under 11 U.S.C. § 365(d)(1). Fraunhofer further argues that because SXM never made an “affirmative election” of its rights under section 365(n)(1)(B), it relinquished its rights under the Sublicense Agreement.” “This termination theory is without merit.” Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung E.V. v. Sirius XM Radio Inc., n.3, 2018-2400, 10/17/19.

Applying *Mission Prod. Holdings, Inc. v. Tempnology, LLC*'s holding that "[a] rejection breaches a contract but does not rescind it" to a patent license. *Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung E.V. v. Sirius XM Radio Inc.*, n.3, 2018-2400, 10/17/19.

## **B. Improper Venue**

### **1. Waiver**

"[In *In re Micron*] we did not prohibit a district court from excusing litigation conduct-based waiver based on an intervening change in the law." *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories*, 2018-1329, 11/13/19.

## **C. Insufficient U.S. Activities**

### **1. Location of a "Sale" under 271(a)**

Noninfringement of importer affirmed based on "evidence that because the shipment [] was marked "f.o.b. China," legal title passed [] in Hong Kong. [] evidence that [another entity] is responsible for clearing the shipments [] through customs in United States and for registering [] with the EPA. [] testimony that [another entity] reimburses [the importer] for the freight charges, and [] invoices stating that [another entity] assumes the entire liability for the shipment [] from China to the United States." *Syngenta Crop Protection, LLC v. Willowood, LLC*, 2018-1614, 12/18/19.

## **D. Testing for FDA Purposes (271(e)(1))**

"Here, the patented inventions are Amgen's claimed methods of manufacture. The accused activity is Hospira's use of Amgen's claimed methods of manufacture. The relevant inquiry, therefore, is not *how* Hospira used each batch it manufactured, but whether each act of manufacture was for uses reasonably related to submitting information to the FDA." *Amgen Inc. v. Hospira, Inc.*, 2019-1067, 12/16/19.

Admission that "CPV is not required before FDA approval" is substantial evidence that use of invention for CPV not within safe harbor. *Amgen Inc. v. Hospira, Inc.*, 2019-1067, 12/16/19.

## **III. Literal Infringement**

### **A. Indirect Infringement**

#### **1. ANDA Infringement**

SJ of no inducement affirmed where patent requires steps of (1) applying gel; (2) waiting for it to dry and (3) applying a second topical agent and accused company's "label never affirmatively instructs the patient to apply anything after the diclofenac sodium gel; the label merely permits applying a second topical agent after the patient waits for the diclofenac sodium to dry." Patentee's "evidence, viewed in the light most favorable to it,

establishes that some users might infringe.” HZNP Medicines LLC v. Actavis Labs. UT, Inc., 2017-2149, 10/10/19.

## **B. Infringement by Foreign Acts**

### **1. Foreign Products Made Using a Patented Process (271(g))**

“This is an issue of first impression. We conclude that the district court erred by imposing a single-entity requirement under § 271(g).” “We hold that in light of the plain language of the statute, the broader context of the statutory scheme as a whole, and the legislative history, § 271(g) does not require a single entity to perform all of the steps of a patented process for infringement liability to arise from the importation into the United States or offer to sell, sale, or use within the United States of a product made by a process patented in the United States.” Syngenta Crop Protection, LLC v. Willowood, LLC, 2018-1614, 12/18/19.

## **C. Design Patents**

“*L.A. Gear* does not prohibit the fact finder from considering an ornamental logo, its placement, and its appearance as one among other potential differences between a patented design and an accused one.” *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories*, 2018-1329, 11/13/19.

## **D. Evidence of Infringement**

### **1. Marketing/Instruction Materials**

“As seen in the images, [defendant]’s own product literature refers to the [portion of the accused product] as [the disputed claim limitation]. But the district court correctly determined in its claim construction—accepting [patentee]’s arguments—that the patentee gave the [disputed limitation] a special definition, and the patents “do not use the [disputed limitation in] its conventional, plain and ordinary meaning.” Thus, the patentee’s definition of [the term] in the specification and as construed by the court—not [defendant]’s product literature—controls whether the accused product falls within the scope of the claim.” *Plastic Omnium Advanced Innovation & Research v. Donghee Am., Inc.*, 2018-2087, 12/3/19.

## **IV. DOE Infringement**

### **A. Substantial Equivalence**

#### **1. Summary Judgment/JMOL**

“[Patentee] failed to present evidence as to why the differences between the touted advantage of uniform wall thickness in the ’812 and ’921 patents and the capability of independent wall thickness manipulation in the accused product were insubstantial.” “[Patentee] therefore failed to demonstrate a genuine dispute of material fact that would

prevent the grant of summary judgment as to the doctrine of equivalents.” *Plastic Omnium Advanced Innovation & Research v. Donghee Am., Inc.*, 2018-2087, 12/3/19.

“While the district court provided little analysis or support as to its determination of no infringement under the doctrine of equivalents, “we review judgments, not opinions.” We must therefore determine whether the record supports the district court’s determination that no reasonable jury could find that [the] accused product infringes under the doctrine of equivalents.” *Plastic Omnium Advanced Innovation & Research v. Donghee Am., Inc.*, 2018-2087, 12/3/19 (citations omitted).

## **B. Prosecution History Bar**

### **1. Amendment Estoppel**

#### **a. Narrowing Amendment**

“Prior to the inventors’ October 1997 amendment, application claim 4 was broad enough to cover any [set A]. The October 1997 amendment narrowed the claims to [set A with required functionality]. The applicants thus presumptively surrendered any [set A] that do not [required functionality].” *Pharma Tech Sols., Inc. v. LifeScan, Inc.*, 2019-1163, 11/22/19.

#### **b. Scope of Estoppel**

##### **i. Merely Tangential**

“The inventors’ clear statements not only establish argument-based estoppel, but also negate [the patentee]’s reliance on the tangential relation exception.” *Pharma Tech Sols., Inc. v. LifeScan, Inc.*, 2019-1163, 11/22/19.

## **V. Relief**

### **A. Attorneys’ fees**

#### **1. Exceptional Case (§ 285)**

“Because the district court did not find that *the case overall* was exceptional, we vacate its finding of exceptionality under § 285 and remand for an analysis under the proper legal standard.” *Intellectual Ventures, I LLC v. Trend Micro, Inc.*, 2019-1122, 12/19/19 (emphasis added).

#### **a. Prevailing Party**

“The PTO instituted review of the asserted claims and found them unpatentable. [Petitioner] obtained the outcome it sought via the mootness dismissal; it rebuffed [patentee]’s attempt to alter the parties’ legal relationship in an infringement suit. This is true even though the mootness decision was made possible by a winning a battle on the merits before the PTO.” *B.E. Tech., L.L.C. v. Facebook, Inc.*, 2018-2356, 10/9/19.

## **b. Bad Faith Litigation/Litigation Misconduct**

“The District Court made multiple findings to support [litigation in an unreasonable manner] each of which is supported by the record. First, the District Court found that Blackbird “made multiple settlement demands that were far less than the anticipated cost of defense,” i.e., nuisance value settlement offers.” “Second, the District Court found that Blackbird unreasonably “delayed in producing documents, withheld many documents until after [Appellees] took [Blackbird’s] deposition[,] and completely failed to produce other responsive documents.”” “Finally, the District Court determined that Blackbird had unreasonably “filed a notice of dismissal, covenant not to sue, and motion to dismiss without first notifying [Appellees’] counsel, on the same day pretrial submissions were due and shortly before [Appellees’] motion for summary judgment was to be decided.”” Blackbird Tech LLC v. Health In Motion LLC, 2018-2393, 12/16/19.

## **c. Baseless Claims**

“At a minimum, Blackbird was aware of Appellees’ intention to seek attorney fees and expenses [] when, in answering [], Appellees requested attorney fees and expenses. While this request may not have provided the “focused” and “supported” notice [], it undermines Blackbird’s attempt to blame others, including the District Court, for it being purportedly unaware of the weaknesses in its litigation position. Accordingly, the District Court did not abuse its discretion in determining that this case “stands out” with respect to the lack of substantive strength in Blackbird’s litigation position.” Blackbird Tech LLC v. Health In Motion LLC, 2018-2393, 12/16/19.

## **d. Totality of the Circumstances**

“[A] district court has discretion, in an appropriate case, to find a case exceptional based on a single, isolated act.” Intellectual Ventures, I LLC v. Trend Micro, Inc., 2019-1122, 12/19/19.

## **2. Amount**

“Indeed, 650 hours, for this litigation, is a far cry from the “countless hours” we have cautioned against.” “Accordingly, the District Court did not abuse its discretion in awarding Appellees the full requested amount of \$363,243.80.” Blackbird Tech LLC v. Health In Motion LLC, 2018-2393, 12/16/19.

## **B. Reasonable Royalty**

### **1. Lump sum v. Running**

“Dr. Heeb explained his reasoning for proposing a lump-sum structure for the royalties, including the fact that in this case, infringement is tied to manufacture and not directly to the sales of the product. Accordingly, the district court did not abuse its discretion in permitting Dr. Heeb to testify.” “As to his proposal of a lump-sum damages amount without a claw-back provision, Dr. Heeb distinguished the claw-back provision in the only other lump-sum agreement in the evidence as a “mutually profitable arrangement”

instead of a license from one competitor to another. . . . It was not unreasonable for the jury to choose a damages award within the amounts proposed by each expert.” Amgen Inc. v. Hospira, Inc., 2019-1067, 12/16/19 (citations omitted).

### **C. Multiple Claims or Patents**

“Because substantial evidence supports the jury’s finding that claim 27 is not invalid and Hospira is liable for infringement of claim 27 of the ’298 patent, and “[b]ecause the damages calculation at trial was not predicated on the infringement of particular claims,” we need not reach the parties’ arguments regarding claim 24.” Amgen Inc. v. Hospira, Inc., 2019-1067, 12/16/19.

## **VI. Claim Construction**

### **A. Claim Language**

#### **1. Plain and Ordinary Meaning**

##### **a. Exceptions**

###### **i. Prosecution/Specification Disavowal**

“A disavowal must be clear, but it need not be explicit.” Techtronic Indus. Co.v. Int’l Trade Comm’n, 2018-2191, 12/12/19.

Even where some claims recited the passive infrared detector as part of the wall console and some did not, all claims were interpreted to require that limitation because “the ’319 patent disavows coverage of wall consoles lacking a passive infrared detector because the specification, in each of its sections, discloses as the invention a garage door opener improved by moving the passive infrared detector from the head unit to the wall console.” Techtronic Indus. Co.v. Int’l Trade Comm’n, 2018-2191, 12/12/19.

#### **2. Functional and Structural Language**

##### **a. Whereby, Wherein and Intended Result Clauses**

“In a “wherein” clause, claim 1 specifies how the original data is varied by the varying device: by including a “permutating device configured to perform a permutation” on the bits in each block making up “said original data.” Thus, contrary to Appellees’ proposed reading, claim 1 logically requires that original data be varied by permutation before being supplied to the generating device as “varied data.”” Koninklijke KPN N.V. v. Gemalto M2M GmbH, 2018-1863, 11/15/19 (citation omitted).

##### **b. Predetermined Limitations**

A document indicating an anticipated range of activity was substantial evidence that the limitation requiring a “predetermined . . . activity” was met. Amgen Inc. v. Hospira, Inc., 2019-1067, 12/16/19.

### **3. Effect of Other Claims**

#### **a. Terms are Consistent in Different Claims**

##### **i. Terms in Related Patents**

Court limited claims in patent issuing from child application to include a nonrecited limitation “the infrared detector must be on the wall unit” even though claims in the parent expressly recited that limitation. *Techtronic Indus. Co.v. Int’l Trade Comm’n*, 2018-2191, 12/12/19.

#### **B. Written Description**

##### **1. Advantages/Purposes/Problems Addressed**

Describing multiple advantages in the specification does not prevent the Court from importing one particular advantage as a limitation where it is identified as part of the invention in the specification. “The suggestion that the patent recites another invention—related to programming the microcontroller—in no way undermines the conclusion that the infrared detector must be on the wall unit.” *Techtronic Indus. Co.v. Int’l Trade Comm’n*, 2018-2191, 12/12/19.

#### **C. Extrinsic Evidence**

##### **1. Inventor/Prosecutor Statements**

Accused infringer argued for a limited construction based on “the testimony of the inventor Dr. Strickland, who stated that the purpose of his invention “was to separate isoforms and then ‘recombine’ them or ‘mix those fractions back together’ to make EPO compositions with specific in vivo activity.”” However, the Court disagreed “The intrinsic evidence suggests that the claim is not limited to methods of preparing individual isoforms separately and mixing them together. It is therefore improper to limit claim 27 to one embodiment based on Dr. Strickland’s testimony.” *Amgen Inc. v. Hospira, Inc.*, 2019-1067, 12/16/19.

#### **D. Timing of Construction and Parties’ Positions**

##### **1. In Granting Summary Judgment**

###### **a. Reliance on Markman Order Discussion of Construction Rather Than Construction Itself**

“In construing the [disputed] terms, the district court made clear that [negative requirement] and that [positive requirement] [citation of Markman Order]. Thus, no [disputed term] is formed until [the combination of those requirements is met]. The district court’s determination on summary judgment is consistent with its Claim Construction Order.” *Plastic Omnium Advanced Innovation & Research v. Donghee Am., Inc.*, 2018-2087, 12/3/19.

## **E. Limited and Ordinary Meaning Constructions**

### **1. Questions of Fact in Applying Constructions**

Accused infringer in closing used “a demonstrative that showed the ’349 claim limitation “as determined by [RIA]” as being within a fence of claimed land, while showing a “dot blot” outside the fence.” However, district court decided accused infringer “did not argue claim construction to the jury.” “It was within the district court’s discretion to allow the demonstrative at issue and we do not find any abuse of discretion in the district court’s denial of a new trial.” *Amgen Inc. v. Hospira, Inc.*, 2019-1067, 12/16/19.

## **VII. Procedural Law**

### **A. Applicable Circuit Law**

#### **1. Contract Interpretation**

“The question here is whether the sublicense could survive the termination of the [license], i.e., whether [the sublicensee] retained a license that negates infringement under 35 U.S.C. § 271, even after [the licensee]’s own license rights were terminated. In the circumstances presented, we apply Federal Circuit law based on relevant U.S. law principles generally.” *Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung E.V. v. Sirius XM Radio Inc.*, 2018-2400, 10/17/19.

### **B. Jury Issues**

#### **1. Right to a Jury Trial**

CAFC considered damages where patentee is bound by a FRAND obligation. “Because we conclude that the release payment is in substance compensatory relief for [defendant]’s past patent infringing activity, we hold that [patentee] was entitled to a jury trial on the calculation of the release payment amount, and that the district court deprived [patentee] of that right by determining that legal relief in a bench trial.” “Most tellingly, the court dismissed Ericsson’s counterclaims of patent infringement as moot in light of the release payment.” *TCL Commc’n Tech. Holdings Ltd. v. Telefonaktiebolaget LM Ericsson*, 2018-1363, 12/5/19.

### **C. New Trial; Altering or Amending Judgment (Rule 59)**

#### **1. False Testimony**

“Even if Dr. Block purposefully misrepresented the contents of Fottinger, Fottinger itself was in the record for the jury to consider. The jury could have easily verified any representations about the reference. Moreover, Columbia had ample opportunity to cross-examine Dr. Block on his incorrect understanding of Fottinger’s disclosure. Under these circumstances and given the uncomplicated nature of the evidence, we cannot conclude that Dr. Block’s misstatements warrant a new trial.” *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories*, 2018-1329, 11/13/19.

## **D. Construction**

### **1. Statutes/Regulations**

#### **a. Conflicting Federal Statutes**

“[W]here the later-enacted statute does not cover the whole subject of the earlier one and is not “clearly intended as a substitute,” an implied repeal will only be found where provisions in the two statutes are in “irreconcilable conflict”—a stringent standard that renders implicit repeals a “rarity.”” *Syngenta Crop Protection, LLC v. Willowood, LLC*, 2018-1614, 12/18/19 (quoting *Nat’l Ass’n of Home Builders v. Defs. of Wildlife*, 551 U.S. 644, 662-63 (2007)).

“It is possible that after a full assessment of the re-quirements of copyright law and FIFRA as applied in this case, there may come to light a truly irreconcilable conflict between Copyright Act liability and implementation of FIFRA. In the absence of a clear facial conflict, however, we decline to wield the blunt tool of preclusion before the full factual and legal contours of any latent problem have been examined.” *Syngenta Crop Protection, LLC v. Willowood, LLC*, 2018-1614, 12/18/19.

## **E. Waiver**

“When read in context of the record as a whole, we decline to interpret this isolated statement as a waiver . . . .” *TCL Commc’n Tech. Holdings Ltd. v. Telefonaktiebolaget LM Ericsson*, 2018-1363, 12/5/19.

## **VIII. Federal Circuit Appeals**

### **A. New Arguments/Issues on Appeal/Waiver/Judicial Estoppel**

#### **1. PTO Appeals**

##### **a. Appeals from PTAB Decision**

“Customedia did not raise any semblance of an Appointments Clause challenge in its opening briefs or raise this challenge in a motion filed prior to its opening briefs. Consequently, we must treat that argument as forfeited in these appeals.” *Customedia Techs., LLC v. DISH Network Corp.*, 2018-2239 and 2019-1001, 11/1/19.

#### **2. Insufficient Language in Principal Brief**

“[I]n its response to [appellant]’s statement of the case, [appellee] briefly contends that we can enter judgment in favor of [appellee] on an alternative ground . . . . Notably, [appellee] does not mention this argument in its summary of the argument or argument sections of the brief.” “We have previously declined to address arguments that appear in the statement of facts but not the summary of the argument or argument sections of the brief.” *Fox Factory, Inc. v. SRAM, LLC*, 2018-2024, 12/18/19.

“[Appellant] simply states that it “provided proof [of the UK service] and provided proof that [Appellee]’s counsel in writing on February 11, 2016 waived any defenses as to improper service.” This level of detail is insufficient to properly preserve [Appellant]’s arguments on appeal.” *Game and Tech. Co. v. Wargaming Grp. Ltd.*, 2019-1171, 11/19/19.

## **B. Cross-Appeals v. Alternate Bases for Affirmance**

### **1. Alternative Bases in Agency Appeals**

After concluding that the Board improperly determined that an argument was waived and refused to consider it, the Federal Circuit still affirmed after taking that argument into account. “We now address the Board’s finding that Schindler anticipates claim 18 of the ’611 patent, even considering Chamberlain’s “responsive to” argument. We conclude that the Board’s finding is supported by substantial evidence.” *Chamberlain Group, Inc. v. One World Techs., Inc.*, 2018-2112, 12/17/19.

## **C. Mootness of Appealed Rulings**

### **1. Invalidity Rulings**

“[B]ecause we agree with [defendant] that substantial evidence supports the jury’s verdict that the claims would have been obvious, we need not reach [patentee]’s anticipation arguments.” *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories*, 2018-1329, 11/13/19.

## **D. Standards of Review and Record/Appendix on Appeal**

### **1. Substantial Evidence Threshold**

#### **a. Prior Art**

“As an initial matter, in reaching its conclusion, the Board misinterpreted the asserted references to teach more than substantial evidence supports. When the references are properly read, the Board’s finding that the asserted references provide a reasonable expectation of success also is not supported by substantial evidence.” *OSI Pharm., LLC v. Apotex Inc.*, 2018-1925, 10/4/19.

#### **b. Expert Testimony**

“Conclusory expert testimony does not qualify as substantial evidence.” *TQ Delta, LLC v. Cisco Sys., Inc.*, 2018-1766, 11/22/19.

Expert testimony is conclusory that “offers only unsupported and conclusory statements asserting that an ordinarily skilled artisan at the time of the invention would have been motivated to apply the [technique] disclosed in [a first reference] as a means to reduce [a problem] in [a second reference]. [The expert] first provides a brief, high-level explanation of how [using the technique] in [the second reference] will reduce [the

problem], but that explanation is unsupported by any evidence other than the disclosure of the invention in the patents-in-suit.” “Then, [the expert] states in conclusory fashion—again without any support—that the combination “would have been a relatively simple and obvious solution to reduce [the problem in the second reference].”” TQ Delta, LLC v. Cisco Sys., Inc., 2018-1766, 11/22/19.

### **c. Tying Evidence to Legal Requirements**

“[T]he jury heard evidence on whether Hospira’s process met the limitations of claim 1. Amgen’s failure to mention claim 1 at trial does not negate this evidence.” Amgen Inc. v. Hospira, Inc., 2019-1067, 12/16/19.

## **2. Review Judgments not Opinions**

“While the district court provided little analysis or support as to its determination of no infringement under the doctrine of equivalents, “we review judgments, not opinions.” We must therefore determine whether the record supports the district court’s determination that no reasonable jury could find that [the] accused product infringes under the doctrine of equivalents.” Plastic Omnium Advanced Innovation & Research v. Donghee Am., Inc., 2018-2087, 12/3/19 (citations omitted).

### **a. Interpreting Opinion Being Reviewed**

“Persion’s entire argument with respect to this issue is based on incomplete quotations from the district court’s opinion.” Persion Pharm. LLC v. Alvogen Malta Operations Ltd., 2018-2361, 12/27/19.

### **E. Harmless Error**

“[T]o the extent the Board failed to do so here, its error is harmless. Even taking these additional prior art references into account, we are not persuaded that a reasonable factfinder could conclude that [legal test].” Airbus S.A.S. v. Firepass Corp., 2019-1803, 11/8/19.

### **F. Remand Determination**

#### **1. Scope of Mandate**

Where mandate included remand for consideration of record evidence and no new record evidence was considered, court reversed. “Because the Board’s decision remains unsupported, we reverse the Board’s finding of invalidity as to ground one and, because all other challenges to the Board’s final judgment of invalidity are waived, we vacate that judgment.” In re IPR Licensing, Inc., 2018-1805, 11/22/19.

## **IX. Patent Office Proceedings**

### **A. Inter Partes Review**

#### **1. Institution**

##### **a. Time limit under section 315(b)**

###### **i. Qualifying Complaints**

“[T]he Board must necessarily determine whether service of a complaint alleging infringement was properly effectuated. The Board cannot strictly rely on a district court’s determination of proper service because district courts rarely make such determinations. Indeed, where the parties do not challenge service, a district court might never determine whether service was proper or whether the defendant waived its defense of improper service.” *Game and Tech. Co. v. Wargaming Grp. Ltd.*, 2019-1171, 11/19/19.

#### **2. Appeal**

##### **a. Waiver of issues not included in rehearing request**

“This argument, however, is unavailing because SAS issued after the Board’s final written decision, and we have not required filing a request for reconsideration to preserve a SAS-based remand.” *Fox Factory, Inc. v. SRAM, LLC*, 2018-2024, 12/18/19.

##### **b. Petitioner Standing**

“In appeals from decisions of the Board, an appellant that is not facing a suit for infringement or immediate threat of suit for infringement may nonetheless have standing to appeal a decision if it is currently using claimed features of a patent or nonspeculatively planning to do so.” *Fisher & Paykel Healthcare Ltd. v. ResMed Ltd.*, 2018-2262, 11/27/19 (nonprecedential).

##### **c. Remand to Consider Relevant Evidence in Record**

“[W]e vacate the Board’s reversal of the examiner’s rejection and remand to the Board to consider whether Kotliar is analogous art in view of the four prior art references . . . .” *Airbus S.A.S. v. Firepass Corp.*, 2019-1803, 11/8/19.

#### **3. Expert Testimony**

“Conclusory expert testimony does not qualify as substantial evidence.” *TQ Delta, LLC v. Cisco Sys., Inc.*, 2018-1766, 11/22/19.

#### **4. Submitting Supplemental Information/Arguments**

“[W]hen the challenged evidence is reasonably viewed as material, and the opponent has adequate opportunity to respond and to produce contrary evidence, the interest of justice

weighs on the side of admitting the evidence.” Telefonaktiebolaget LM Ericsson v. TCL Corp., 2017-2381, 11/7/19.

## **5. Obviousness Rulings**

### **a. Reversal**

Obviousness reversed rather than vacated without considering additional evidence. “Although [Petitioner] introduced some additional evidence with its reply to support the Board’s factfinding, [PO] objected to the admission of the evidence and the Board expressly declined to consider it.” “Accordingly, we do not consider the additional evidence provided by [Petitioner] but not considered by the Board.” TQ Delta, LLC v. Cisco Sys., Inc., n. 4, 2018-1766, 11/22/19.

## **6. Board Final Written Decision**

### **a. Waiver of New Theories**

“[T]he Board erred in finding waiver [where patentee raised a new argument during the oral hearing.] That argument directly responded to [petitioner]’s position in its reply that Schindler identifies multiple activities, and that the timing of the identification is immaterial. We agree with [patentee] that waiver is inappropriate in this situation, as [patentee] was merely clarifying its earlier position, not raising a new issue.” “When a petitioner raises new arguments (in the sense of new issues) in its petitioner’s reply, the patent owner is entitled to an opportunity to respond to those arguments.” Chamberlain Group, Inc. v. One World Techs., Inc., 2018-2112, 12/17/19.

## **B. Post-Grant Reviews**

### **1. Scope of Authority of Director**

“[T]he Board abused its discretion by assuming the authority that 35 U.S.C. § 255 expressly delegates to the Director: to determine when a Certificate of Correction is appropriate.” Honeywell Int’l Inc. v. Arkema Inc., 2018-1151, 10/1/19.

### **2. Requests for Permission to File a Motion**

“By requiring that [patentee show it met the requirements for a Certificate of Correction] before authorizing [patentee] to file a motion for leave to seek a Certificate of Correction from the Director, the Board abused its discretion.” Honeywell Int’l Inc. v. Arkema Inc., 2018-1151, 10/1/19.