GIBSON DUNN

Federal Circuit Year in Review 2020/2021

Intellectual Property and Appellate Practice Groups

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TABLE OF CONTENTS

Page

INTRODUCTION 1

ACKNOWLEDGEMENT 2

GIBSON DUNN'S FEDERAL CIRCUIT CLERKS 3

STATISTICAL ANALYSIS 5

INDEX BY ISSUE 27

CASE SUMMARIES 38

ALPHABETICAL INDEX OF ALL CASES 92

INTRODUCTION

The Federal Circuit's 2020–2021 term saw a number of important developments in patent law. The Court issued 76 published opinions, which is the lowest number of opinions in several years. Still, this term included significant panel decisions in patent law jurisprudence with regard to standing (*ABS Global, Inc. v. Cytonome/ST, LLC*, 984 F.3d 1017 (Fed. Cir. 2021) and *Gen. Elec. Co. v. Raytheon Techs. Corp.*, 983 F.3d 1334 (Fed. Cir. 2020)); subject matter eligibility (*cxLoyalty, Inc. v. Maritz Holdings Inc.*, 986 F.3d 1367 (Fed. Cir. 2021) and *Illumina, Inc. v. Ariosa Diagnostics, Inc.*, 967 F.3d 1319 (Fed. Cir. 2020)); venue (*In re Samsung Elecs. Co.*, 2 F.4th 1371 (Fed. Cir. 2021) and *Valeant Pharms. N. Am. LLC v. Mylan Pharms. Inc.*, 978 F.3d 1374 (Fed. Cir. 2020)); IPR procedures (*Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321 (Fed. Cir. 2020)); and public accessibility of prior art (*M & K Holdings, Inc. v. Samsung Elecs. Co.*, 985 F.3d 1376 (Fed. Cir. 2021) and *VidStream LLC v. Twitter, Inc.*, 981 F.3d 1060 (Fed. Cir. 2020)). Each of these decisions, as well as all other precedential decisions issued by the Federal Circuit in the 2020–2021 term, is summarized in the pages that follow.

There are numerous analytics in the pages that follow, as well as summaries of the precedential decisions from the Federal Circuit this term. We hope this information serves you well this coming year. As always, if we can answer any questions, please do not hesitate to contact us.

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ACKNOWLEDGEMENT

We would like to thank all of the Gibson Dunn partners, associates, and staff who contributed significant time and energy to this undertaking and without whom this publication would not have been possible. We would like to specifically recognize Nathan Curtis and Florina Yezril for their tireless efforts organizing, implementing, and making this project happen, and the contributions of the following attorneys:

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GIBSON DUNN'S FEDERAL CIRCUIT CLERKS

Gibson Dunn is proud to have as key members of its Appellate and Intellectual Property practices 13 former clerks from the U.S. Court of Appeals for the Federal Circuit:

William C. Rooklidge (Former Chief Judge Nies, 1985–1987), a partner in the Orange County office of Gibson Dunn, joined the firm in 2015. A member of the firm's Litigation Department and Intellectual Property Practice Group, he has extensive experience in patent and trademark infringement litigation in the federal district courts and before the United States Court of Appeals for the Federal Circuit, as well as arbitration of patent disputes.

Brian Buroker (Judge Bryson, 1996–1997) is a partner in Gibson Dunn's Washington, D.C. office and is a member of the firm's Intellectual Property Practice, focusing on patent litigation, appeals and complex patent issues, having tried patent cases, litigated many patent cases to resolution, argued cases at the Federal Circuit and handled complex patent reexaminations, covered business method review and *inter partes* review proceedings at the U.S. Patent Office.

Stuart M. Rosenberg (Former Chief Judge Michel, 2007–2008) is a partner in the Palo Alto office of Gibson Dunn, where his practice focuses on intellectual property litigation. He has represented clients in a variety of industries and technologies, including software, consumer electronics, medical devices, sporting goods, and automotive design.

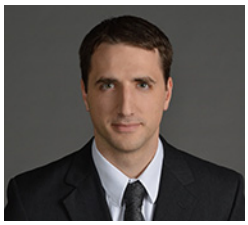
Kate Dominguez (Judge Taranto, 2013–2014) is a partner in the New York office of Gibson Dunn and is a member of Gibson Dunn's Intellectual Property Practice Group. Ms. Dominguez has litigated patent cases across a broad spectrum of technologies, including global positioning systems, interactive television, intrusion detection, mobile communications, and wireless networking.

Nathan R. Curtis (Judge Dyk, 2011–2012) is an associate in the Dallas office of Gibson Dunn, where his practice focuses on intellectual property litigation before district courts, the Patent Trial and Appeal Board, and the U.S. International Trade Commission. Mr. Curtis litigates intellectual property cases in a wide range of technological fields, including telecommunications, computer architecture, medical devices, semiconductors, and manufacturing.

Christine Ranney (Judge Newman, 2013–2015) is an associate in the Denver Office of Gibson Dunn and is a member of the firm's Litigation department, where she focuses on patent litigation. Before her clerkship, Ms. Ranney was an analyst in a leadership development program at Merck & Co.

Jaysen Chung (Former Chief Judge Rader, 2014) is an associate in the San Francisco office of Gibson Dunn and is a member of the firm's Litigation department. He focuses on patent and appellate litigation, and has experience in a range of arts and practices, including pharmaceuticals, DNA sequencing applications, RF switch circuits, and semiconductor products and processes.

Ryan Iwahashi (Judge O'Malley, 2014–2015) is an associate in the Palo Alto office of Gibson Dunn and is a member of the firm's Litigation department. His practice focuses on intellectual property litigation and he has experience in a range of technologies, including software, consumer electronics, and medical devices.



Andrew Robb (Judge Dyk, 2014–2015) is an associate in the Palo Alto office of Gibson Dunn. He is a member of the firm's Litigation department, with a focus on intellectual property and other technology-based litigation. He has litigated cases across a broad range of industries and technologies, including wireless telecommunications, consumer fitness devices, mobile gaming network architecture, and mechanical sleep aids.

Taylor King (Judge O'Malley, 2016–2017) is an associate in the Orange County office of Gibson Dunn. Taylor is a member of the firm's Litigation department and his practice focuses on intellectual property litigation and appeals. He has represented clients in a variety of industries and technologies, including electronics, medical devices, vehicle emissions, sporting goods, e-commerce, and pharmaceuticals.

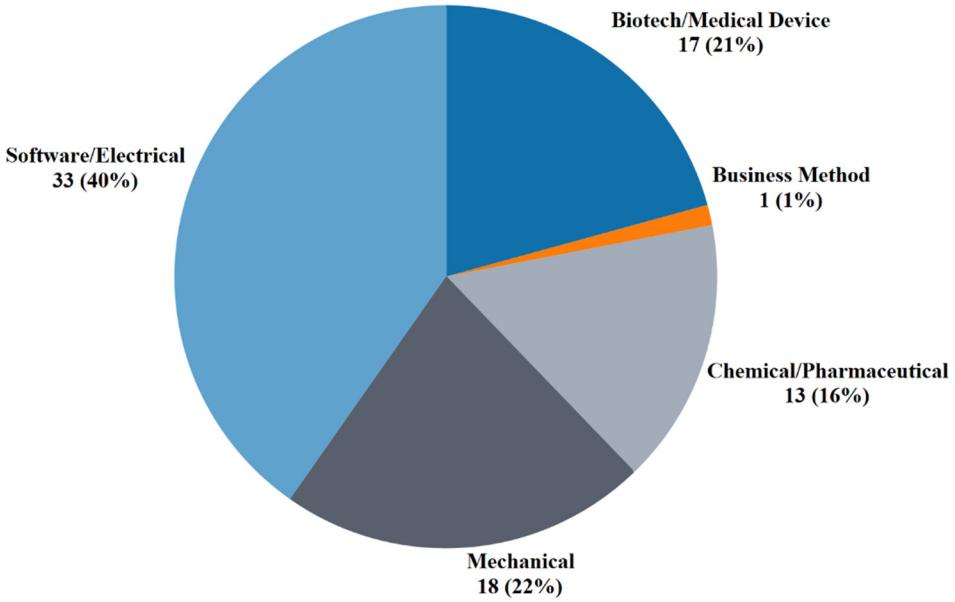
Allen Kathir (Judge Hughes, 2016–2017) is an associate in the New York office of Gibson Dunn. Allen is a member of the firm's Litigation Department, and his practice focuses on intellectual property litigation. He has experience litigating a broad range of technologies, including representing mobile telecommunications providers and medical device manufacturers.

Kim Do (Judge Dyk, 2020–2021) is an associate in the Palo Alto office of Gibson Dunn. Kim is a member of the firm's Litigation Department and her practice focuses on internal investigations, data privacy, and intellectual property disputes.

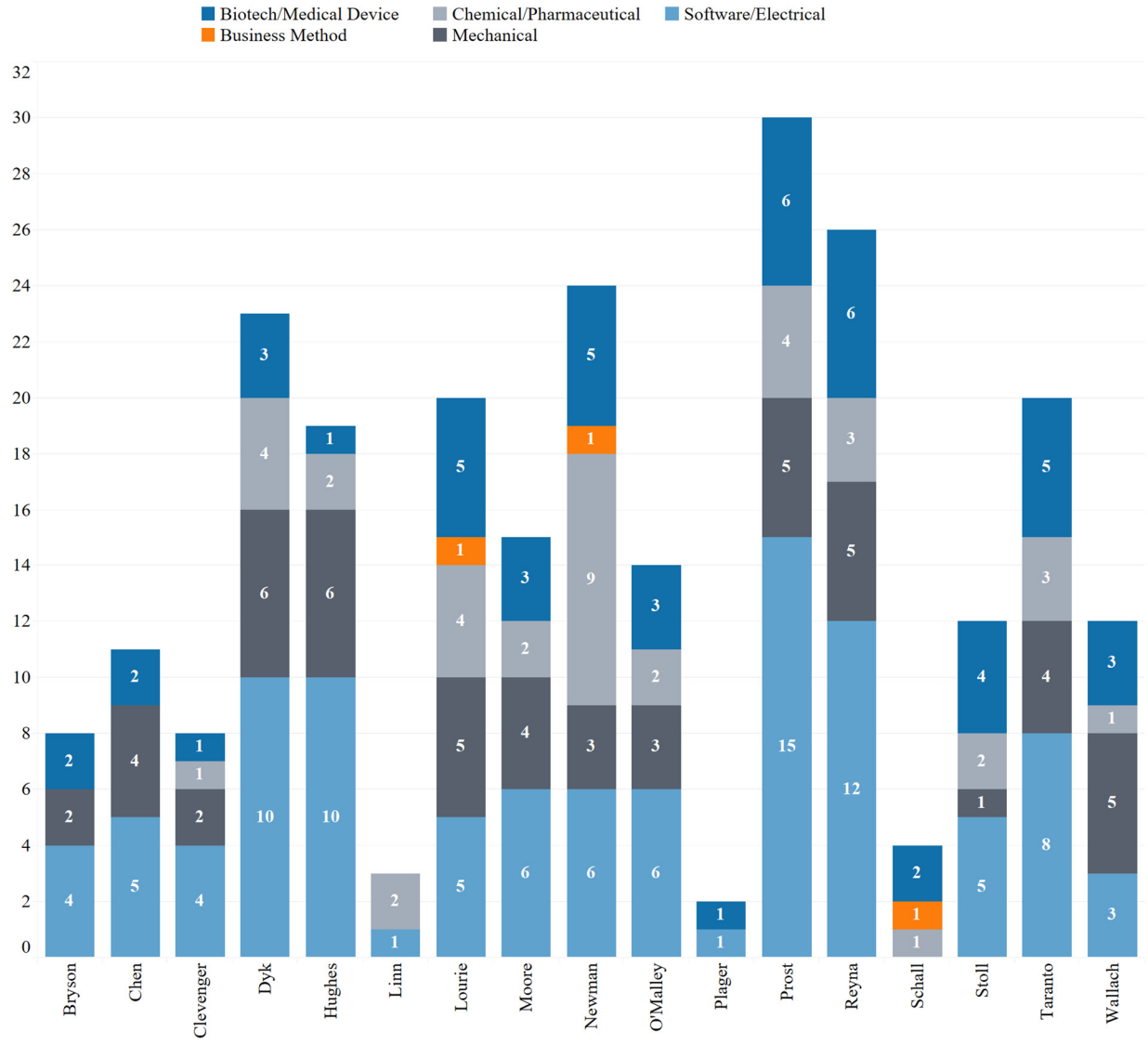
STATISTICAL ANALYSIS
(August 1, 2020 – July 31, 2021)

Precedential Patent Cases	76
District Court (% of cases)	59%
PTO (% of cases)	36%
ITC (% of cases)	3%
CFC (% of cases)	3%
Top 5 District Courts	District of Delaware (27) Northern District of California (19) District of Massachusetts (12) District of New Jersey (6) Eastern District of Texas (6)
Final Decisions on Validity of the Patent	Valid 10 / Invalid 21 / Both 1
Cases With Amicus Briefs	12
En Banc Cases Decided	1
Cases Decided without Oral Argument	10
Average Times	
Lower Tribunal Decision to Federal Circuit Oral Argument*	440 Days
Lower Tribunal Decision to Federal Circuit Decision	563 Days
Docketing to Federal Circuit Oral Argument*	373 Days
Docketing to Federal Circuit Decision	496 Days
Oral Argument* to Federal Circuit Decision * Only cases where oral argument held	136 Days
Opinion Authorship	
Most Opinions	Dyk, Prost (13 each)
Most Majority Opinions	Prost (11)
Fewest Majority Opinions	Clevenger, Mayer, Plager, Wallach (0 each)
Most Concurring Opinions	Dyk, Moore, Newman (1 each)
Most Dissenting Opinions	Newman (3)
Fewest Dissenting Opinions	Bryson, Chen, Clevenger, Hughes, Linn, Lourie, Mayer, Plager, Schall, Stoll, Taranto, Wallach (0 each)
Most Unanimous Decisions	Prost (9)

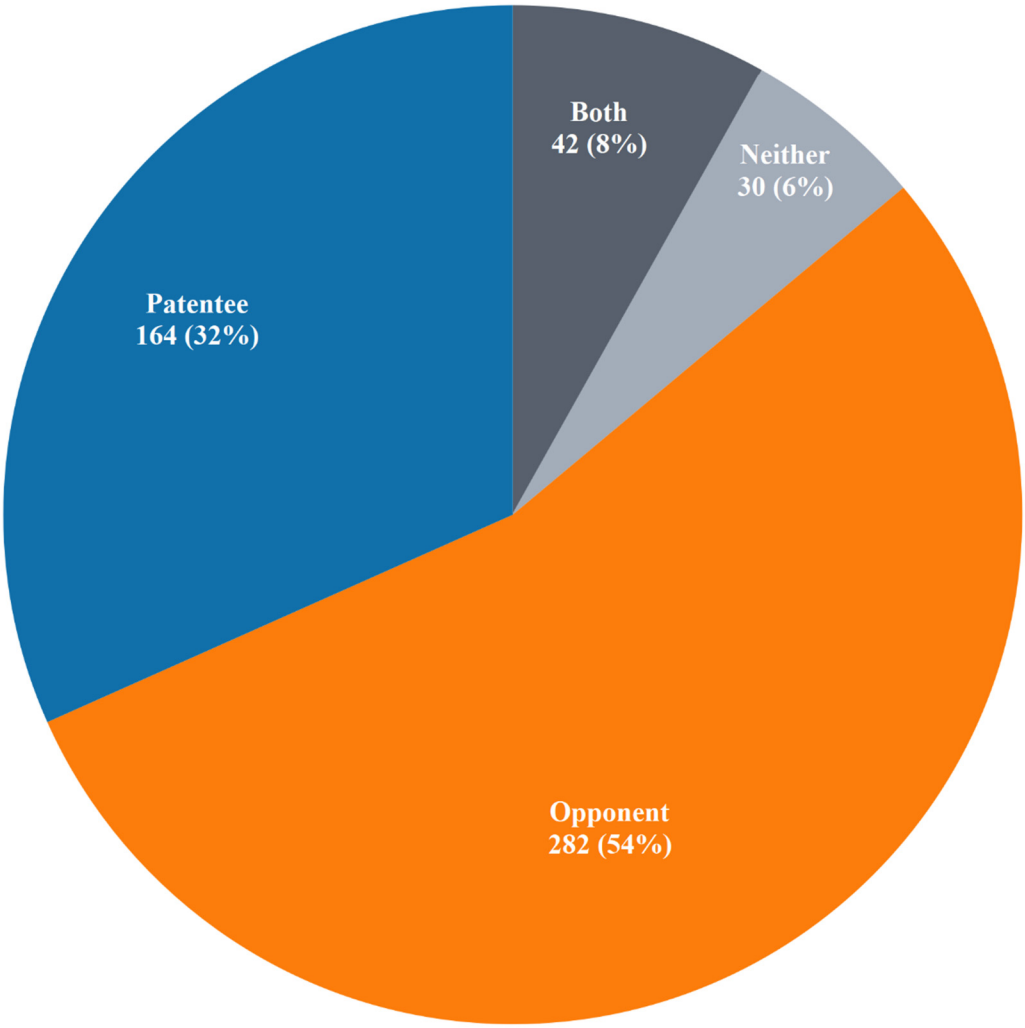
Decisions by Patent Subject Matter



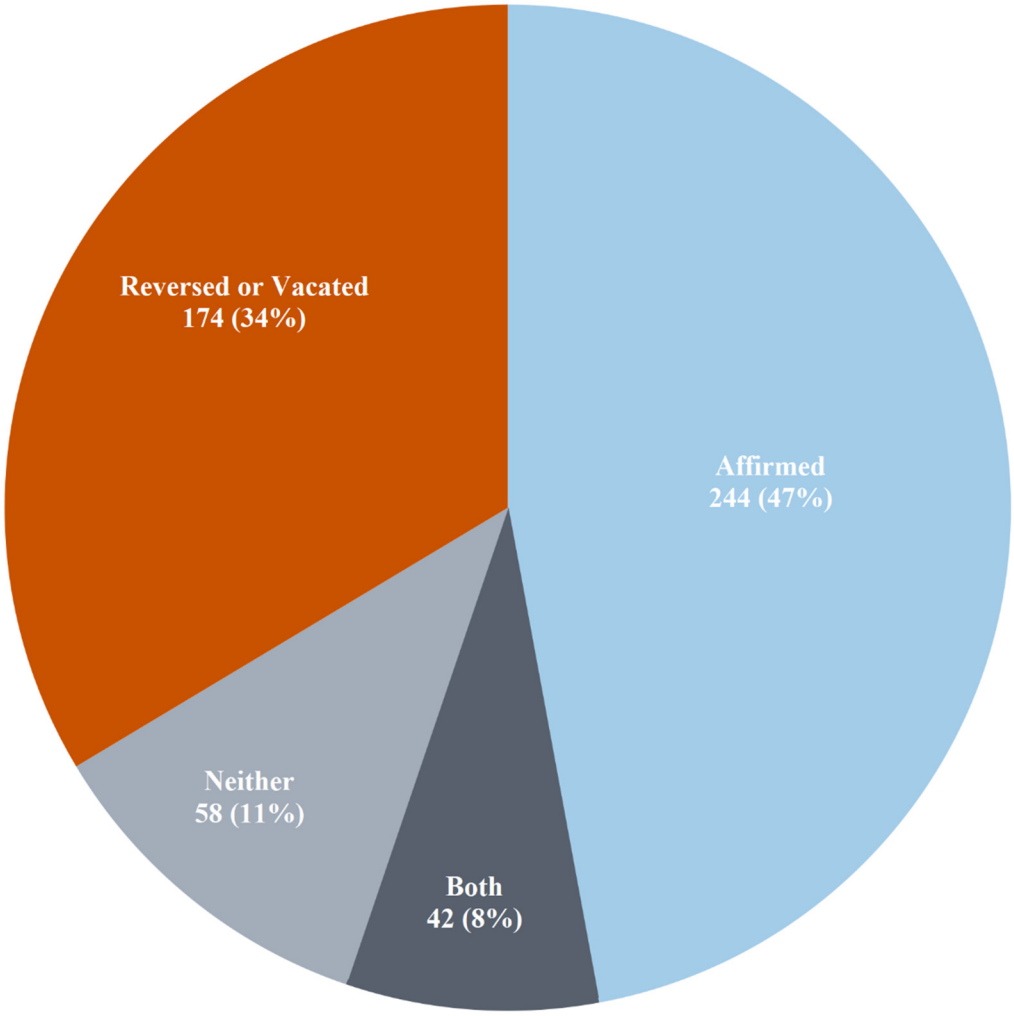
Patent Subject Matter by Author



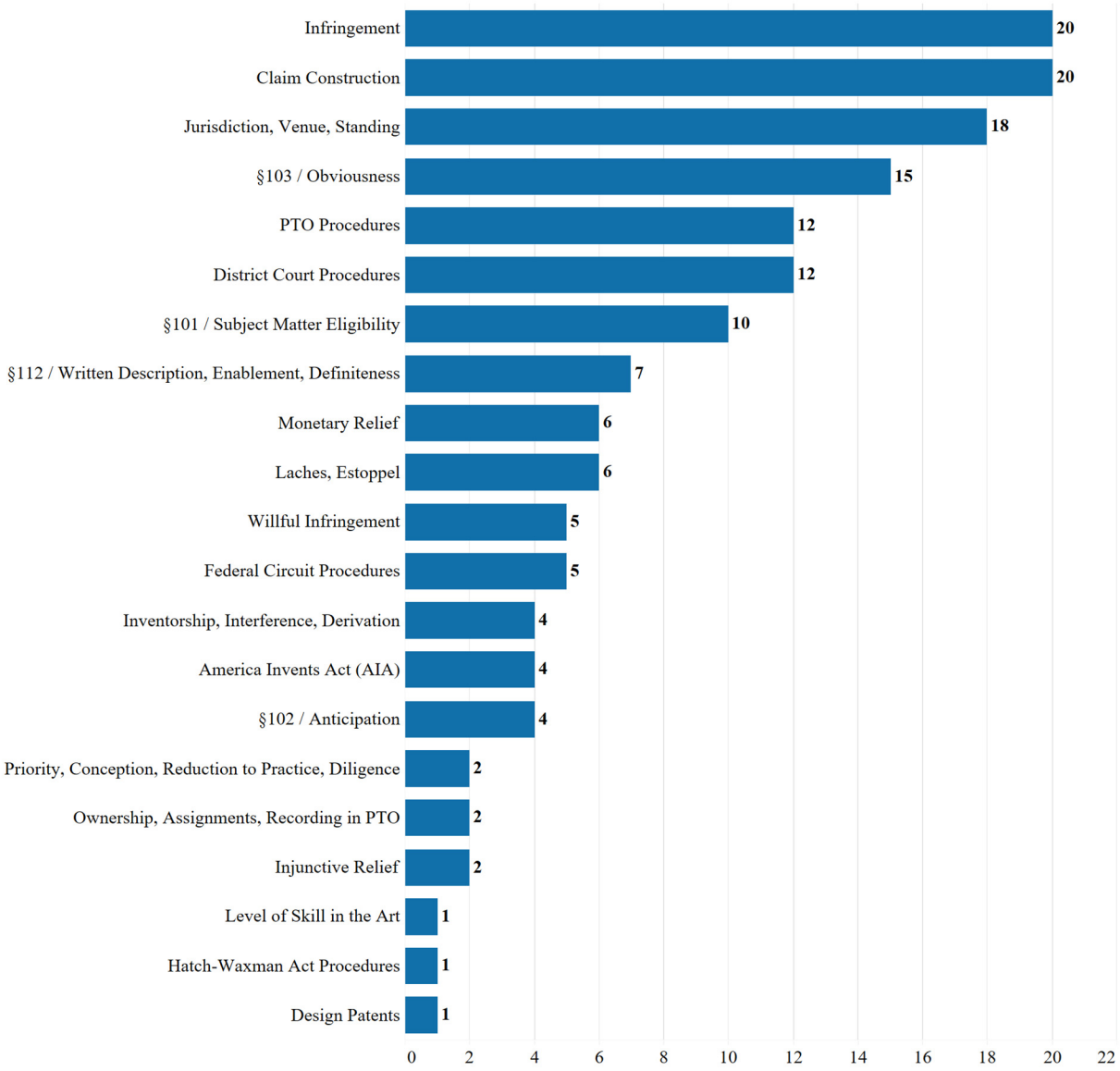
Overall Outcomes: Party Win Rate

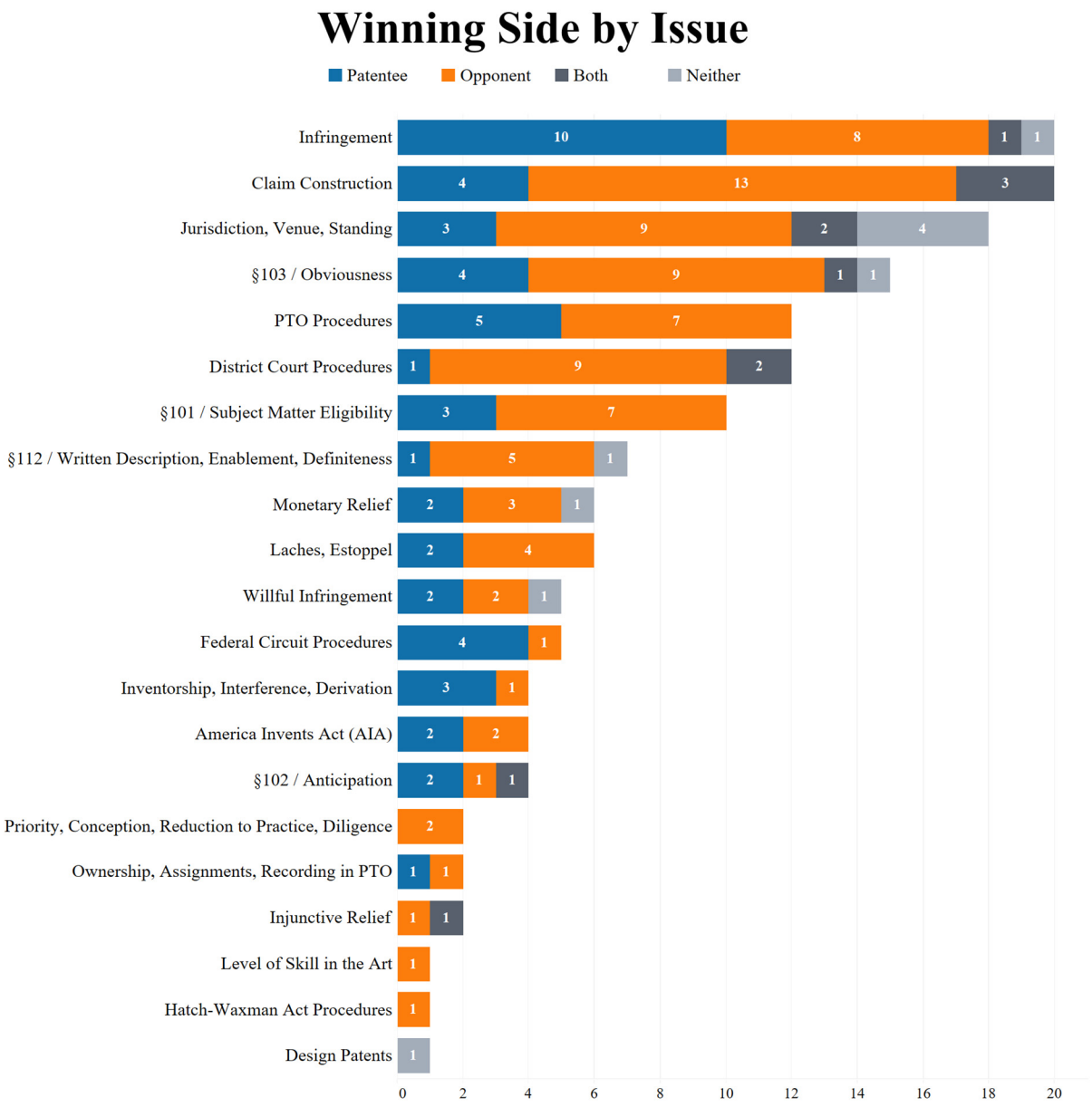


Overall Outcomes: Affirmance/Reversal



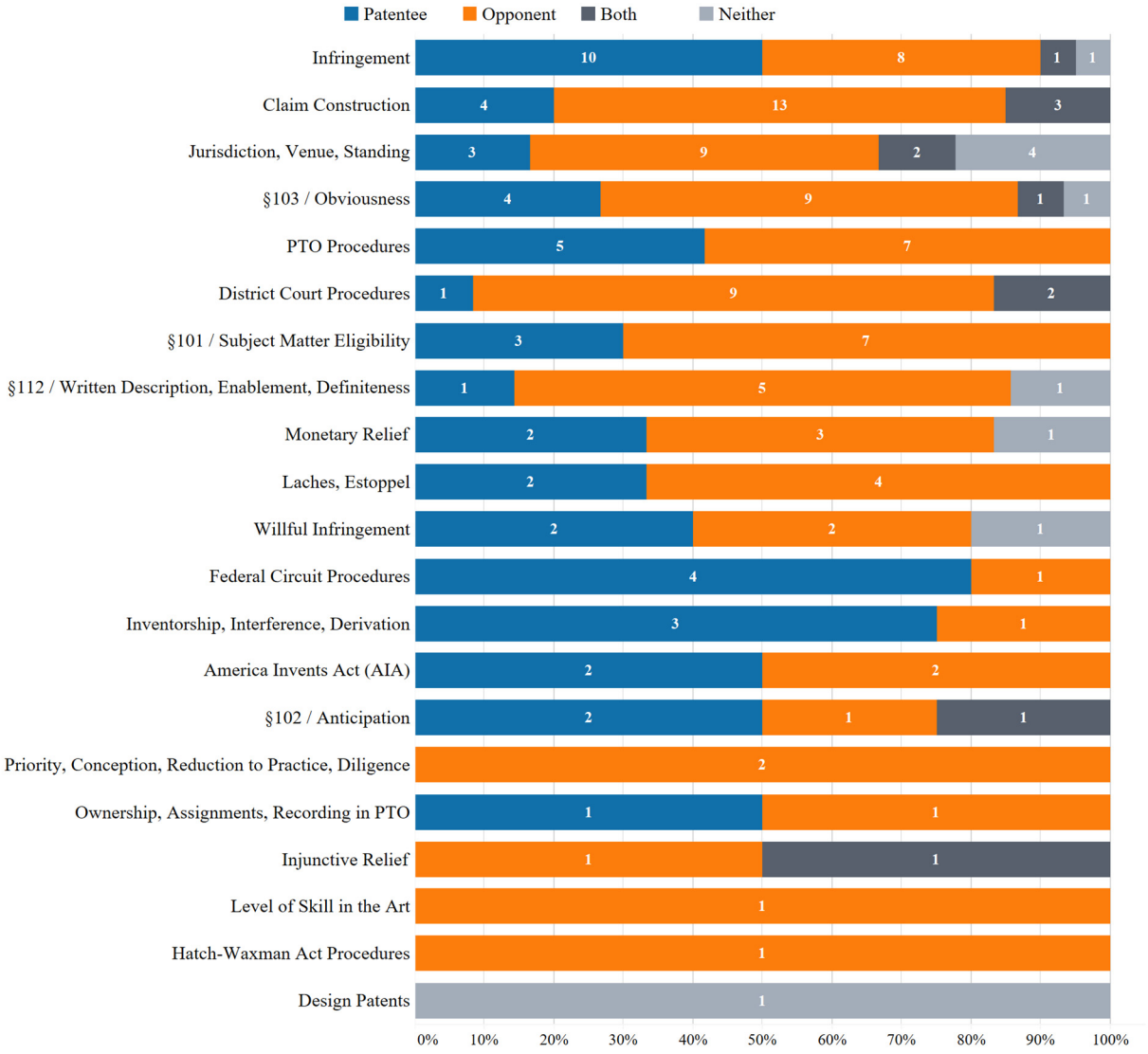
Top Issues


Infringement 20
Claim Construction 20
Jurisdiction, Venue, Standing 18
§103 / Obviousness 15
PTO Procedures 12
District Court Procedures 12
§101 / Subject Matter Eligibility 10
§112 / Written Description, Enablement, Definiteness 7
Monetary Relief 6
Laches, Estoppel 6
Willful Infringement 5
Federal Circuit Procedures 5
Inventorship, Interference, Derivation 4
America Invents Act (AIA) 4
§102 / Anticipation 4
Priority, Conception, Reduction to Practice, Diligence 2
Ownership, Assignments, Recording in PTO 2
Injunctive Relief 2
Level of Skill in the Art 1
Hatch-Waxman Act Procedures 1
Design Patents 1
0 2 4 6 8 10 12 14 16 18 20 22

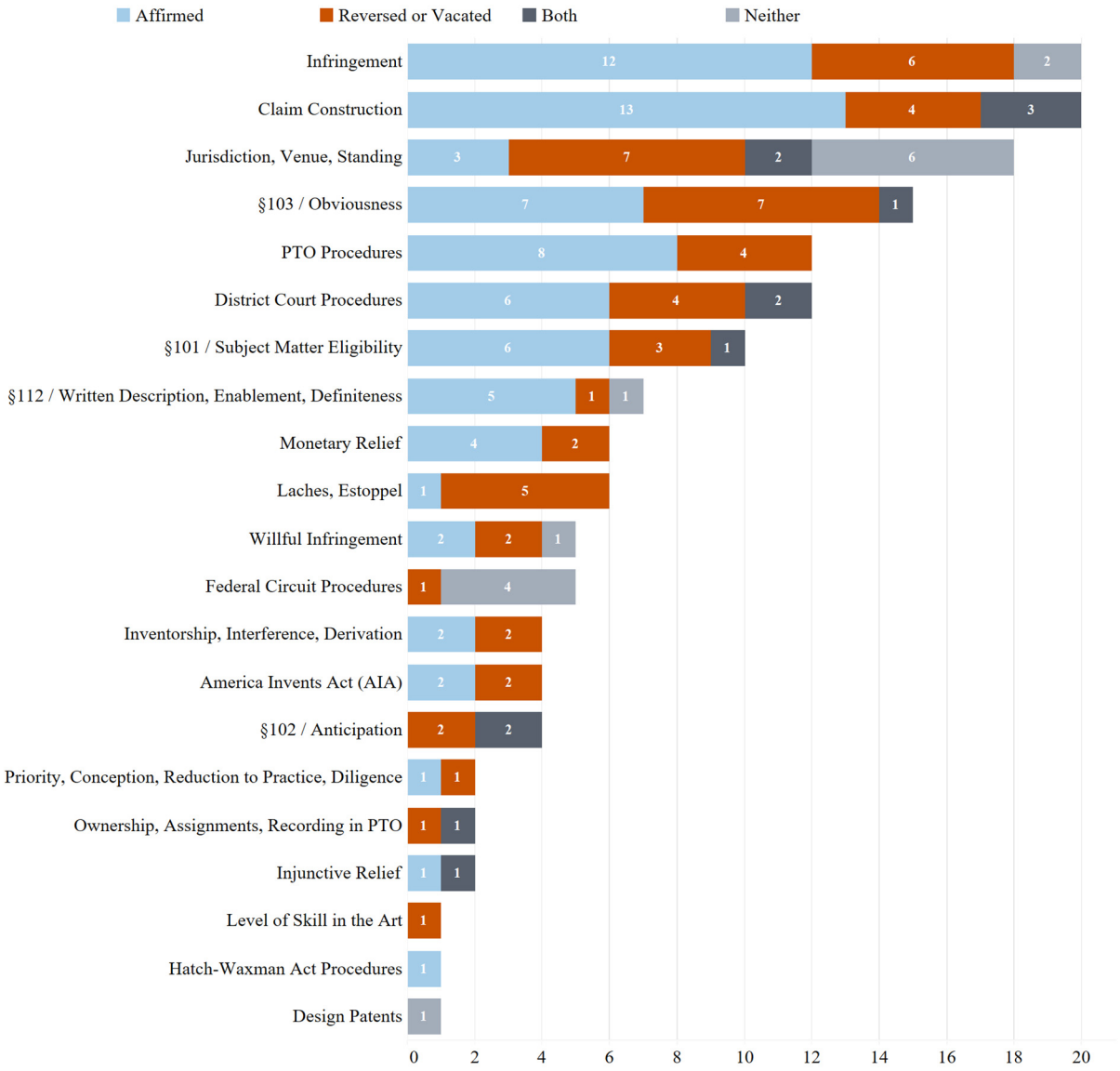

Winning Side by Issue
Patentee
Opponent
Both
Neither
Infringement 10 8 1 1
Claim Construction 4 13 3
Jurisdiction, Venue, Standing 3 9 2 4
§103 / Obviousness 4 9 1 1
PTO Procedures 5 7
District Court Procedures 1 9 2
§101 / Subject Matter Eligibility 3 7
§112 / Written Description, Enablement, Definiteness 1 5 1
Monetary Relief 2 3 1
Laches, Estoppel 2 4
Willful Infringement 2 2 1
Federal Circuit Procedures 4 1
Inventorship, Interference, Derivation 3 1
America Invents Act (AIA) 2 2
§102 / Anticipation 2 1 1
Priority, Conception, Reduction to Practice, Diligence 2
Ownership, Assignments, Recording in PTO 1 1
Injunctive Relief 1 1
Level of Skill in the Art 1
Hatch-Waxman Act Procedures 1
Design Patents 1
0 2 4 6 8 10 12 14 16 18 20

Winning Side Rates By Issue

Number of Issue Outcomes Shown in Bars

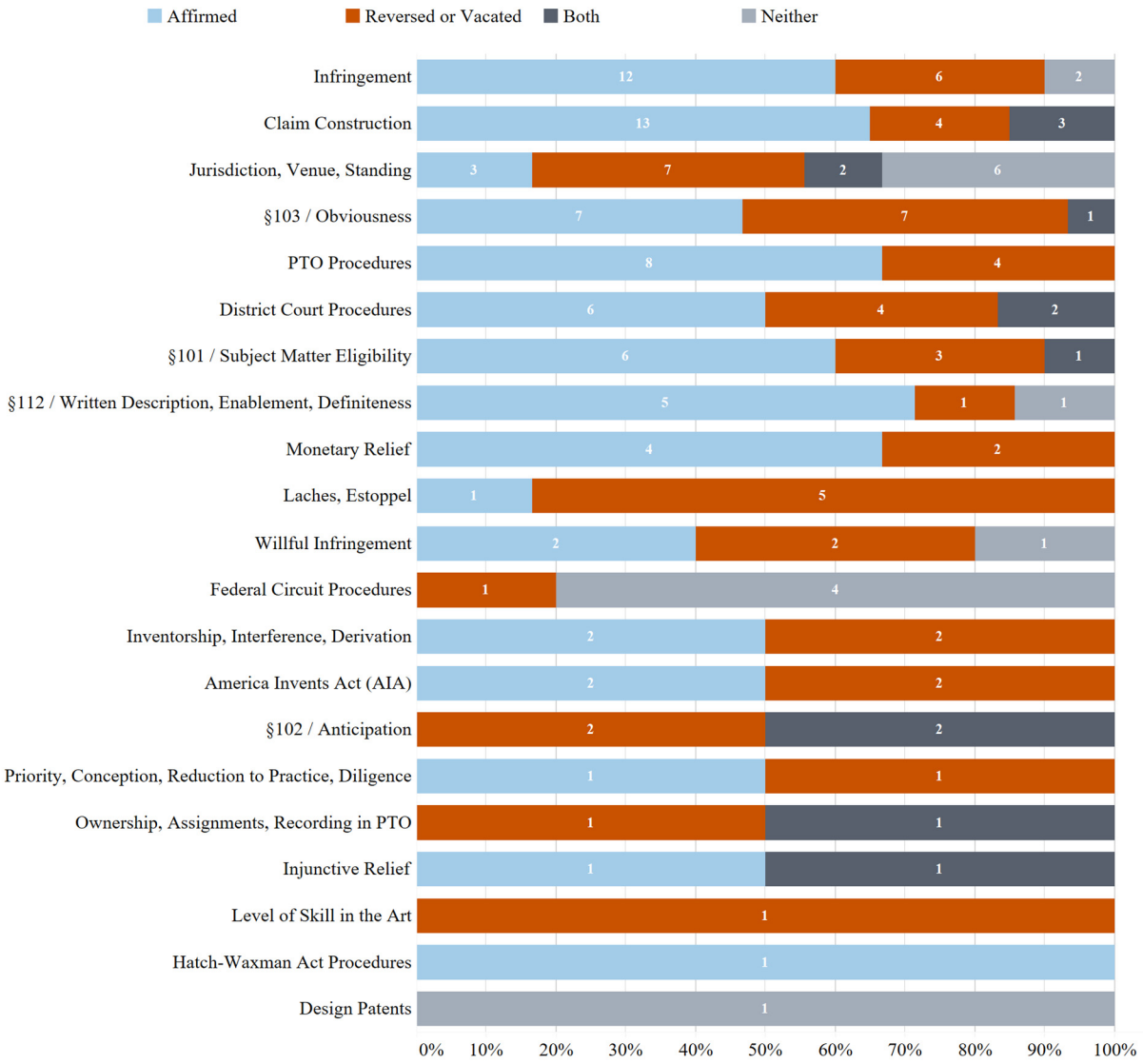


Outcome by Issue

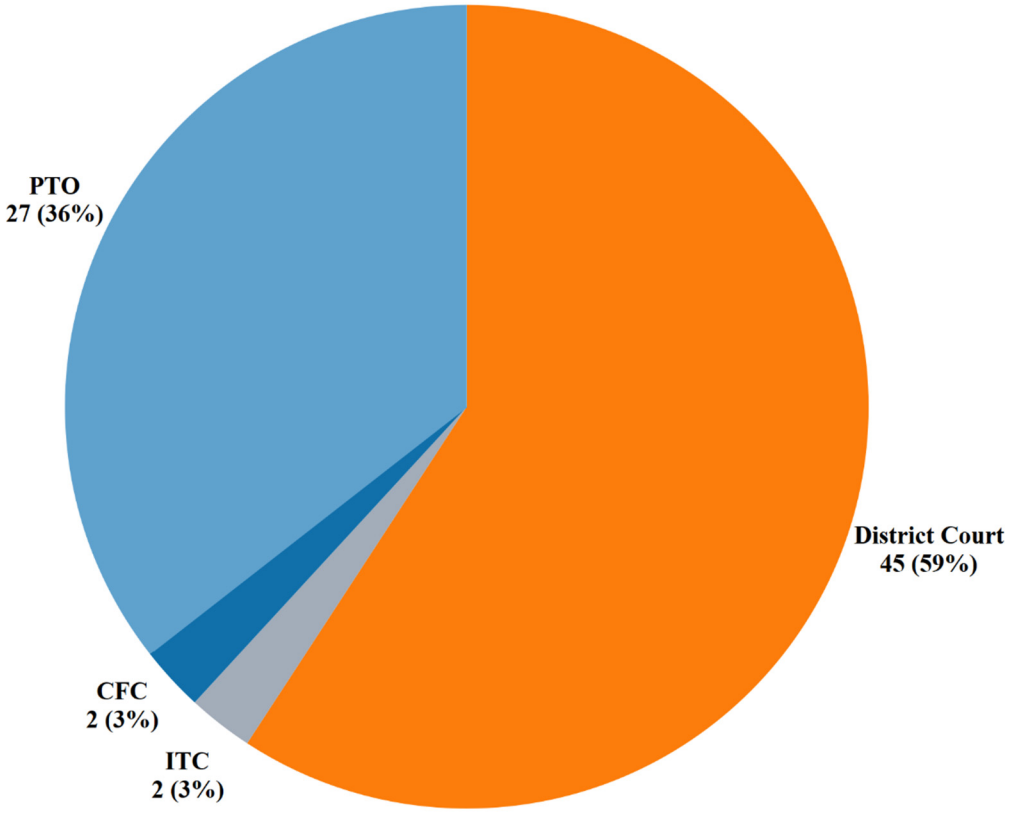


Outcome Rates by Issue

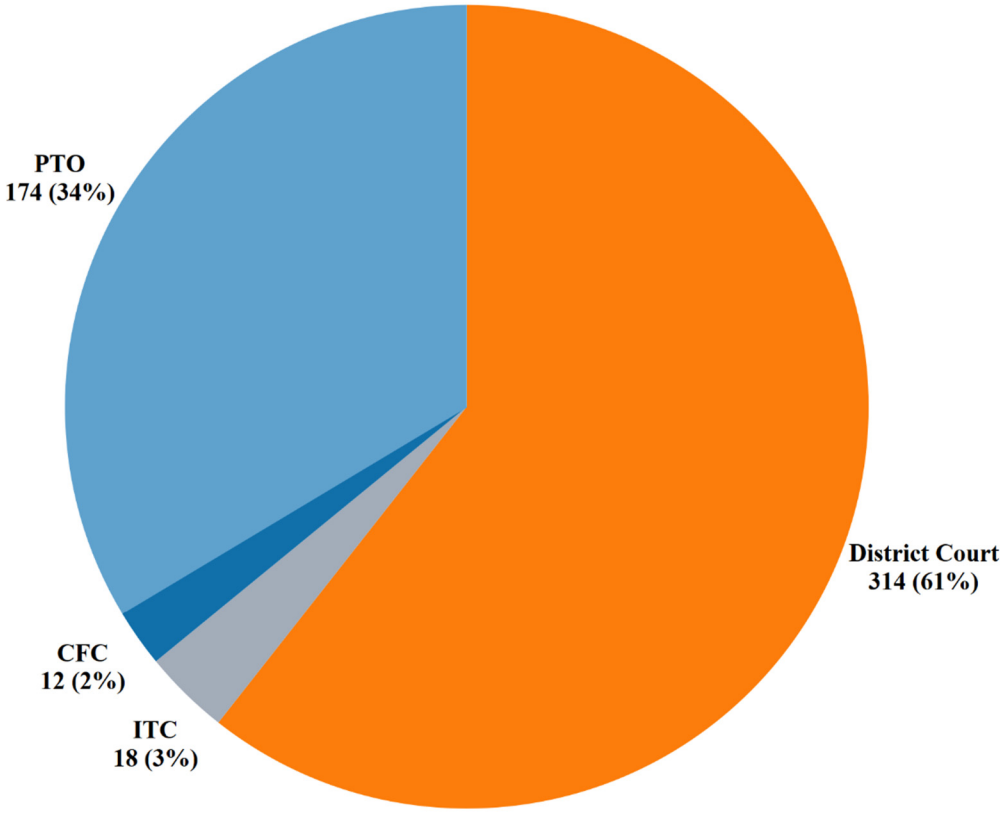
Number of Issue Outcomes Shown in Bars



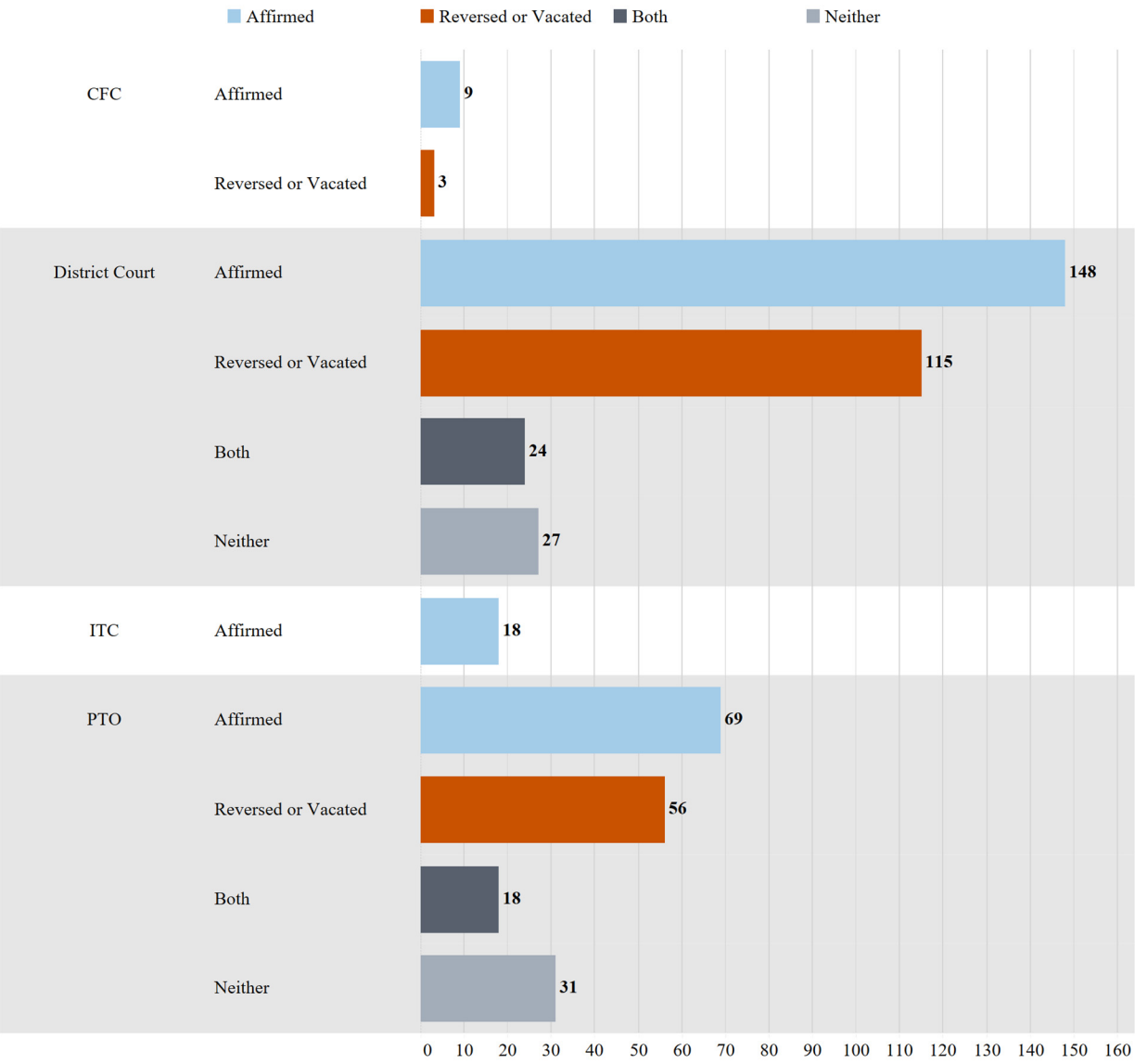
Number of Cases by Source

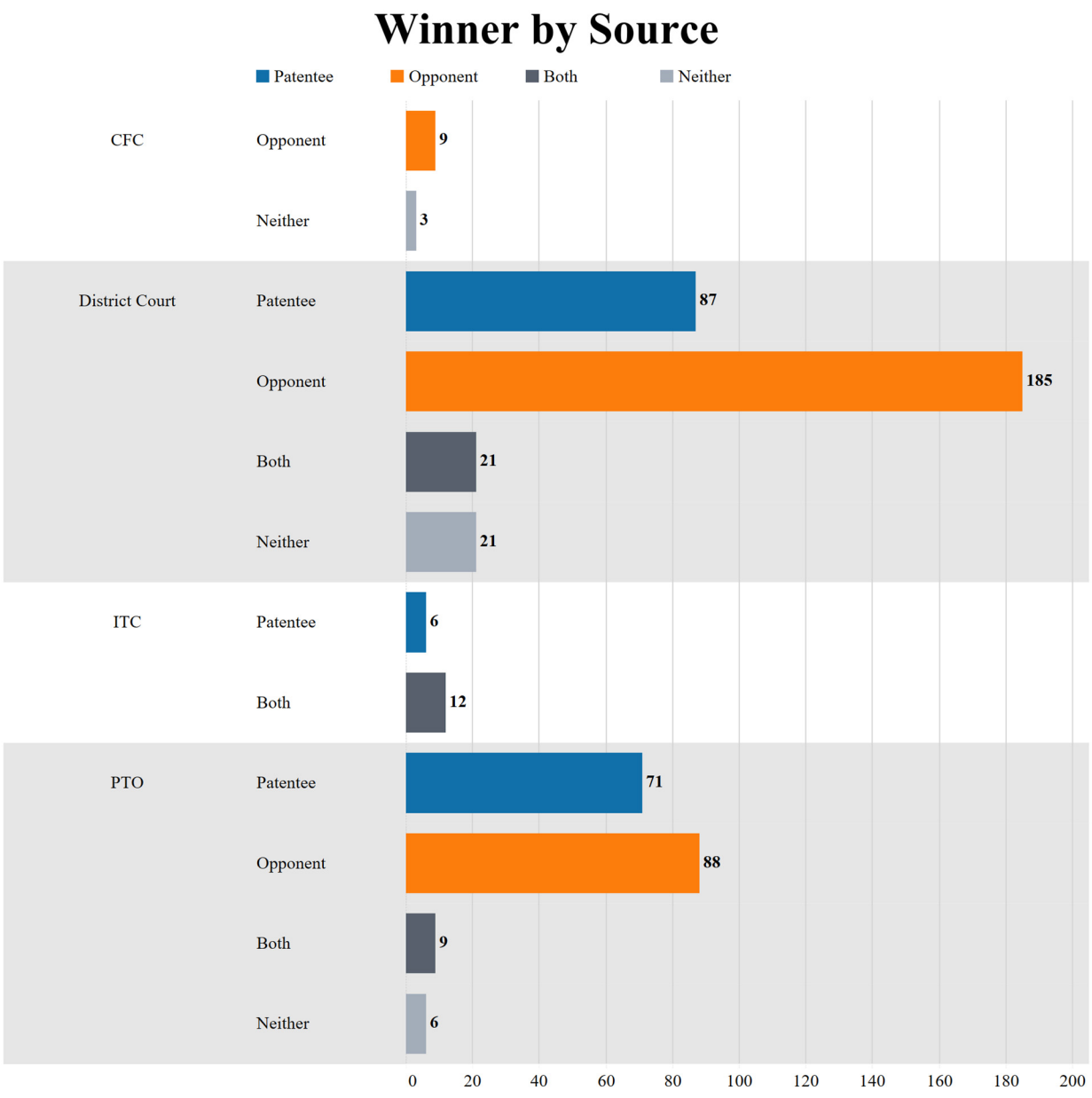


Number of Issues by Source



Outcome by Source




Winner by Source
Patentee
Opponent
Both
Neither
CFC
Opponent
9
Neither
3
District Court
Patentee
87
Opponent
185
Both
21
Neither
21
ITC
Patentee
6
Both
12
PTO
Patentee
71
Opponent
88
Both
9
Neither
6
0
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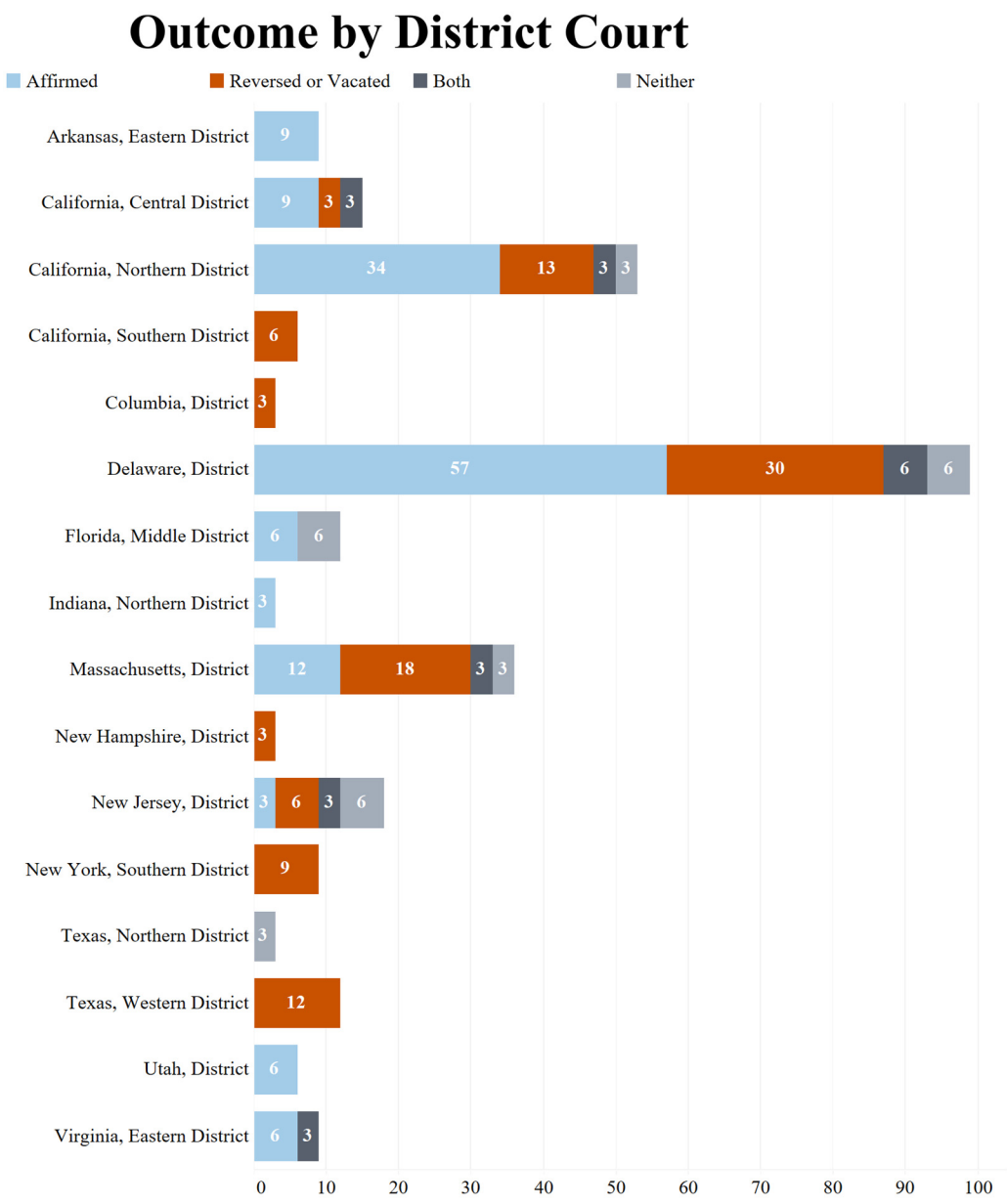
40
60
80
100
120
140
160
180
200


Outcome by District Court
Affirmed
Reversed or Vacated
Both
Neither
Arkansas, Eastern District
California, Central District
California, Northern District
California, Southern District
Columbia, District
Delaware, District
Florida, Middle District
Indiana, Northern District
Massachusetts, District
New Hampshire, District
New Jersey, District
New York, Southern District
Texas, Northern District
Texas, Western District
Utah, District
Virginia, Eastern District
9
9 3 3
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57 30 6 6
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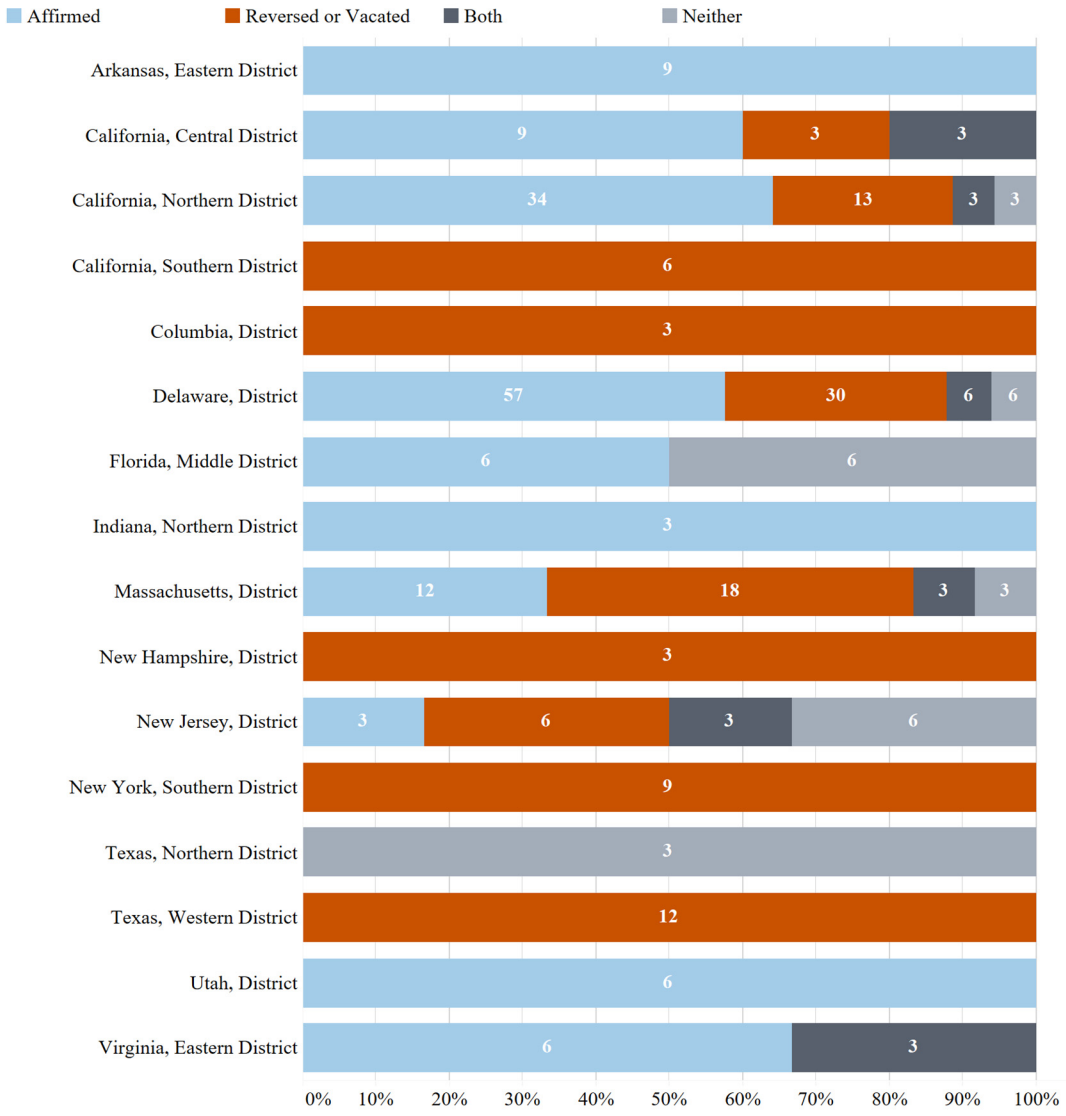
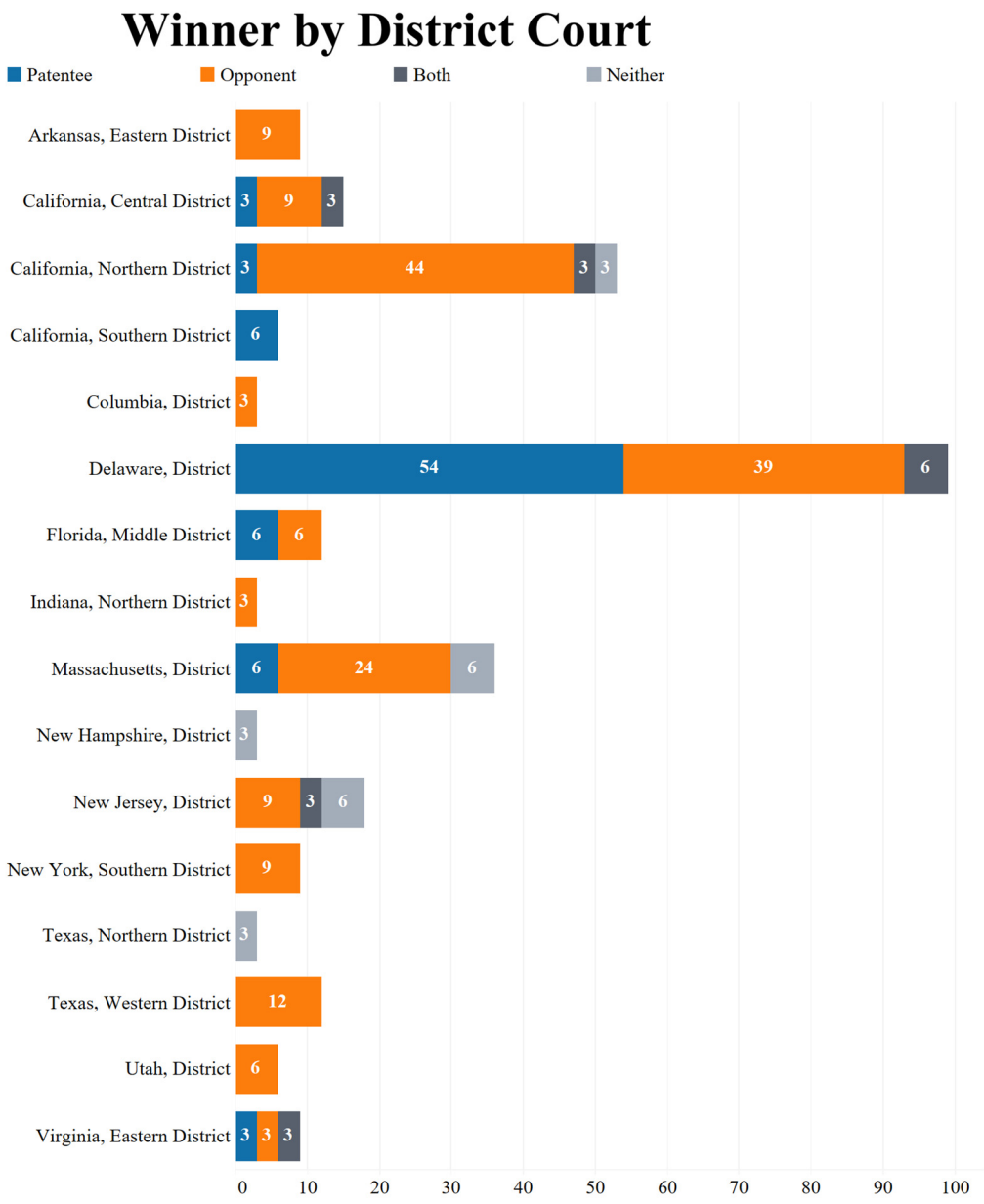
Outcome Rates by District Court

Number of Issue Outcomes Shown in Bars




Winner by District Court
Patentee
Opponent
Both
Neither
Arkansas, Eastern District
California, Central District
California, Northern District
California, Southern District
Columbia, District
Delaware, District
Florida, Middle District
Indiana, Northern District
Massachusetts, District
New Hampshire, District
New Jersey, District
New York, Southern District
Texas, Northern District
Texas, Western District
Utah, District
Virginia, Eastern District
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10
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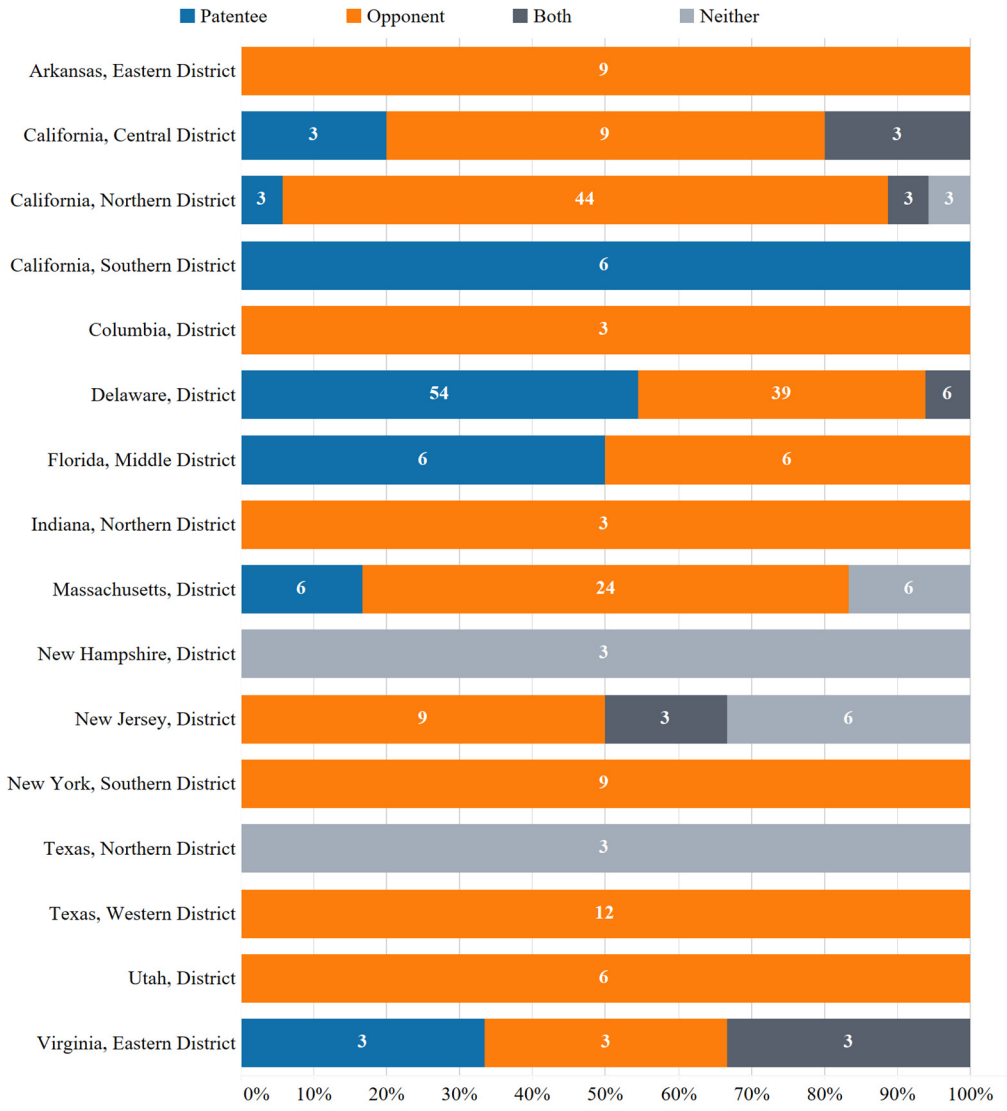
30
40
50
60
70
80
90
100

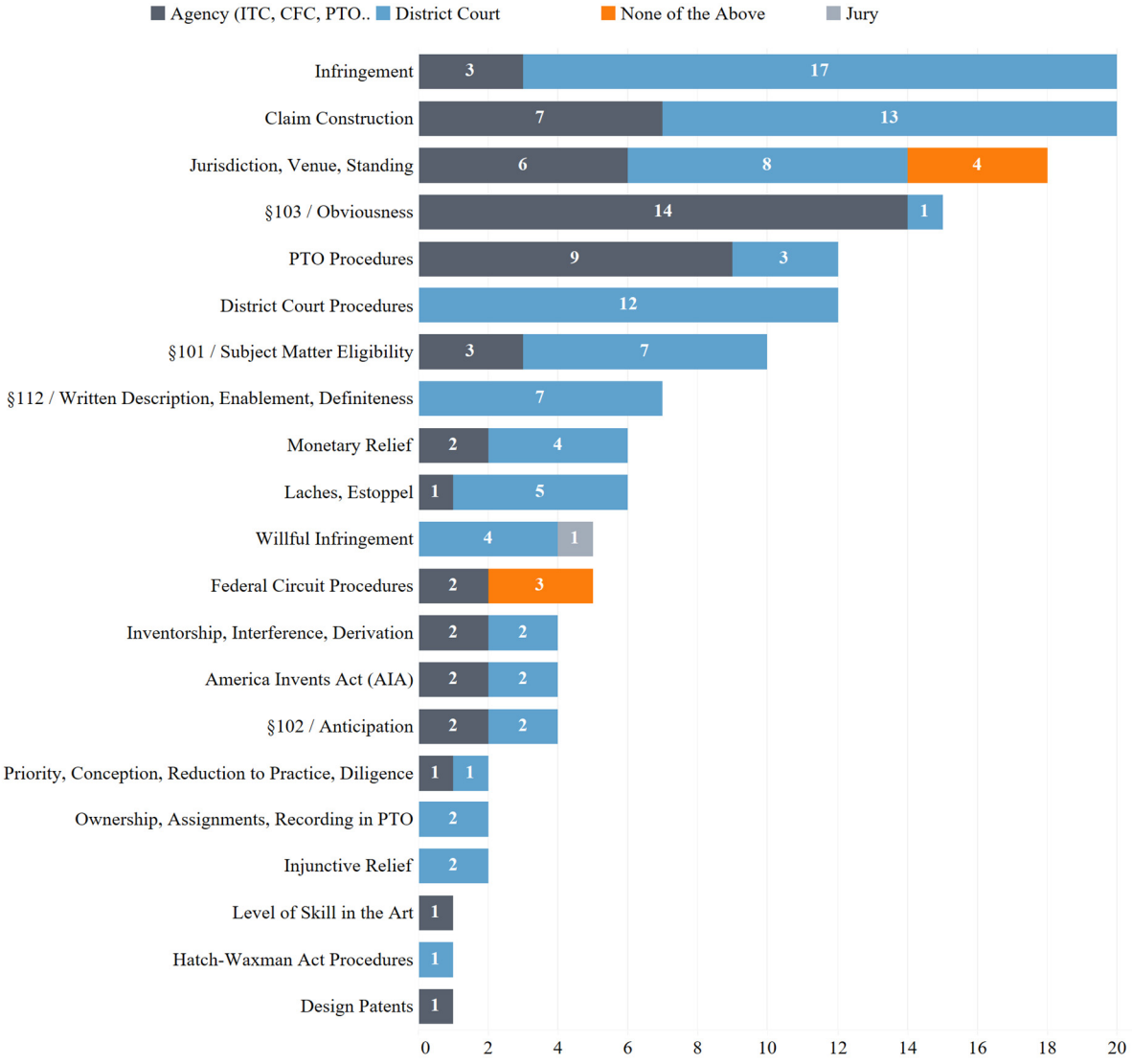
Winner Rate by District Court

Number of Issue Outcomes Shown in Bars



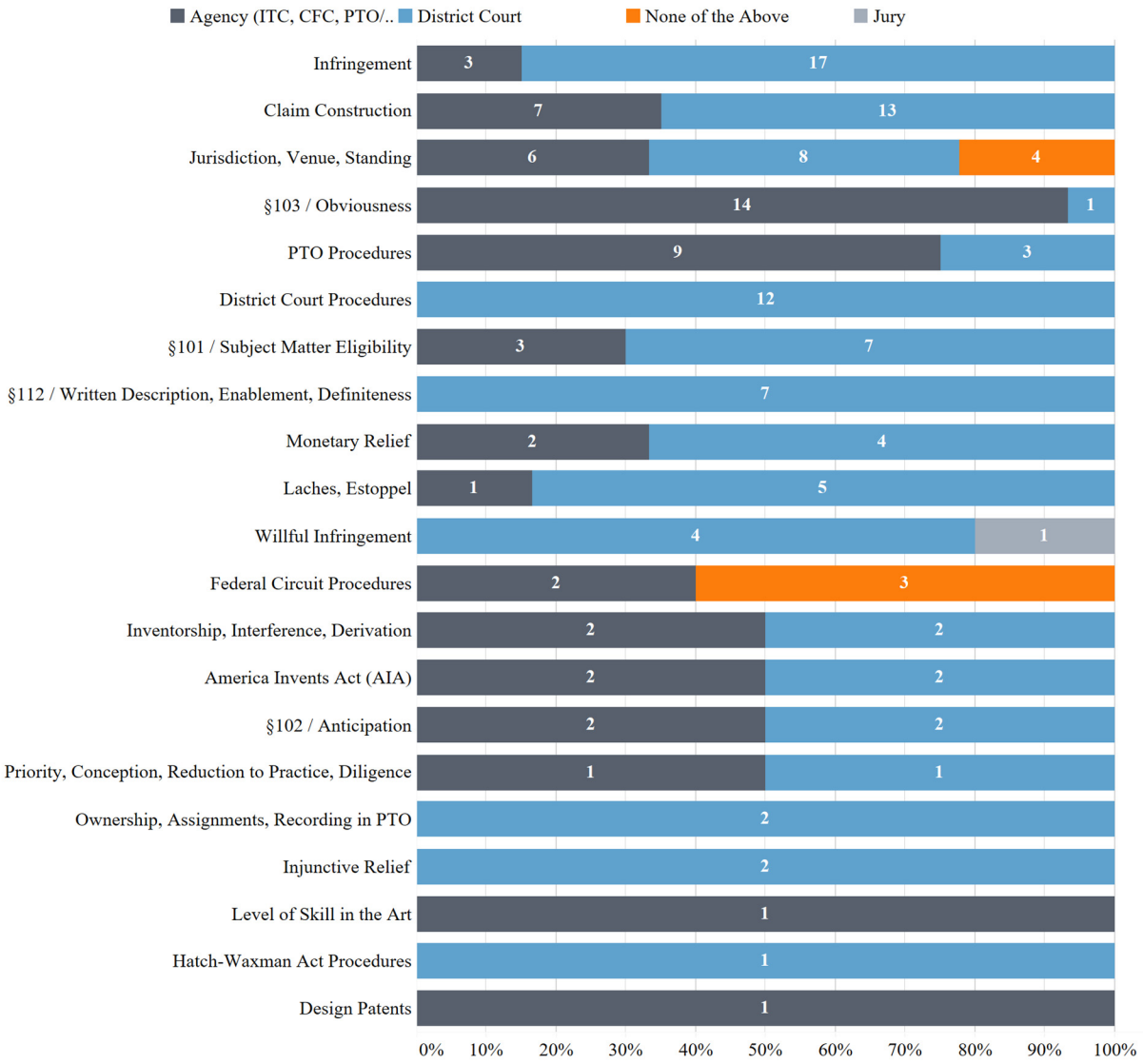
Source Breakdown by Issue

Whether Court, Agency or Jury Decided Issue Below

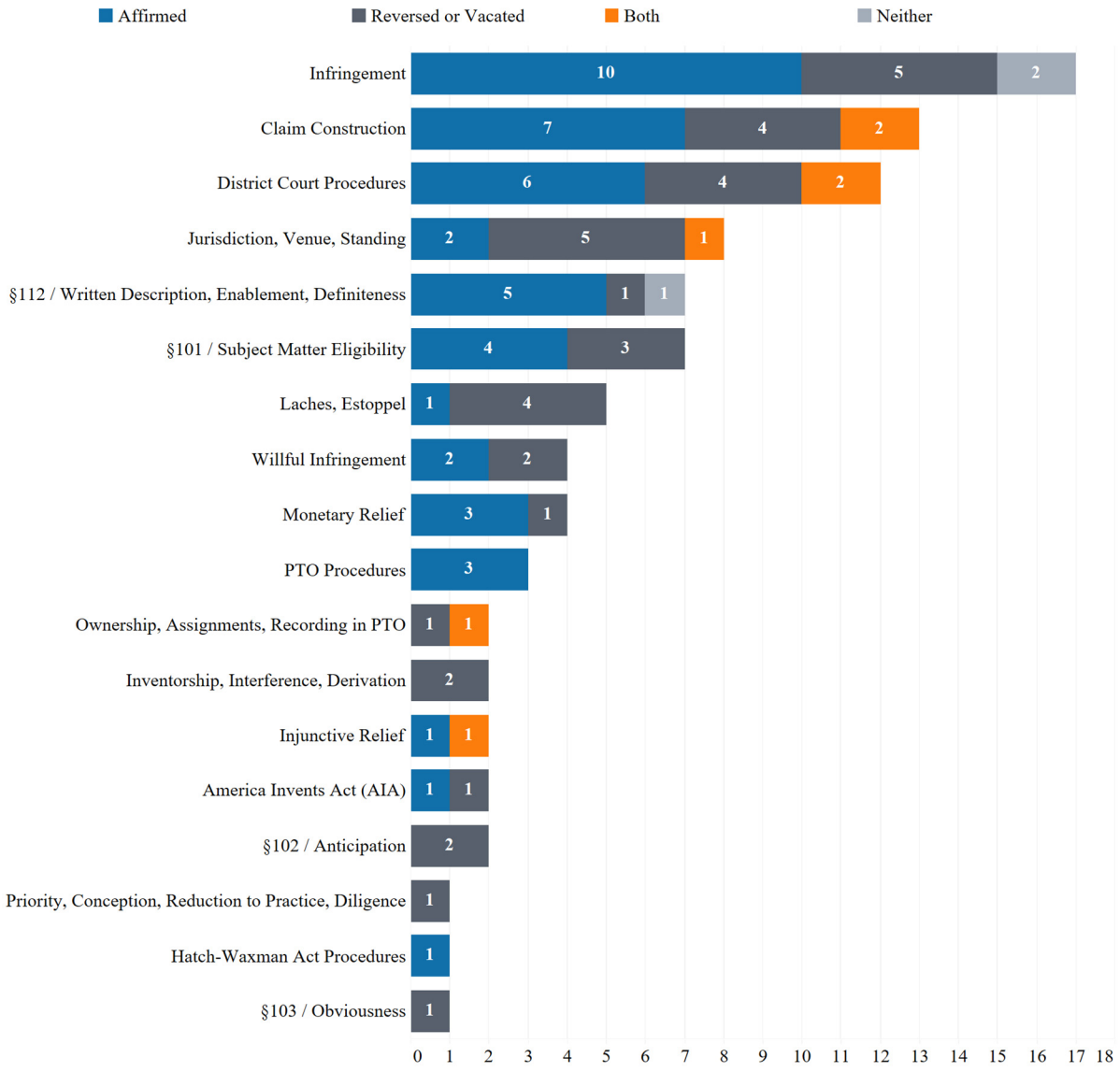


Source Breakdown by Issue, Rates

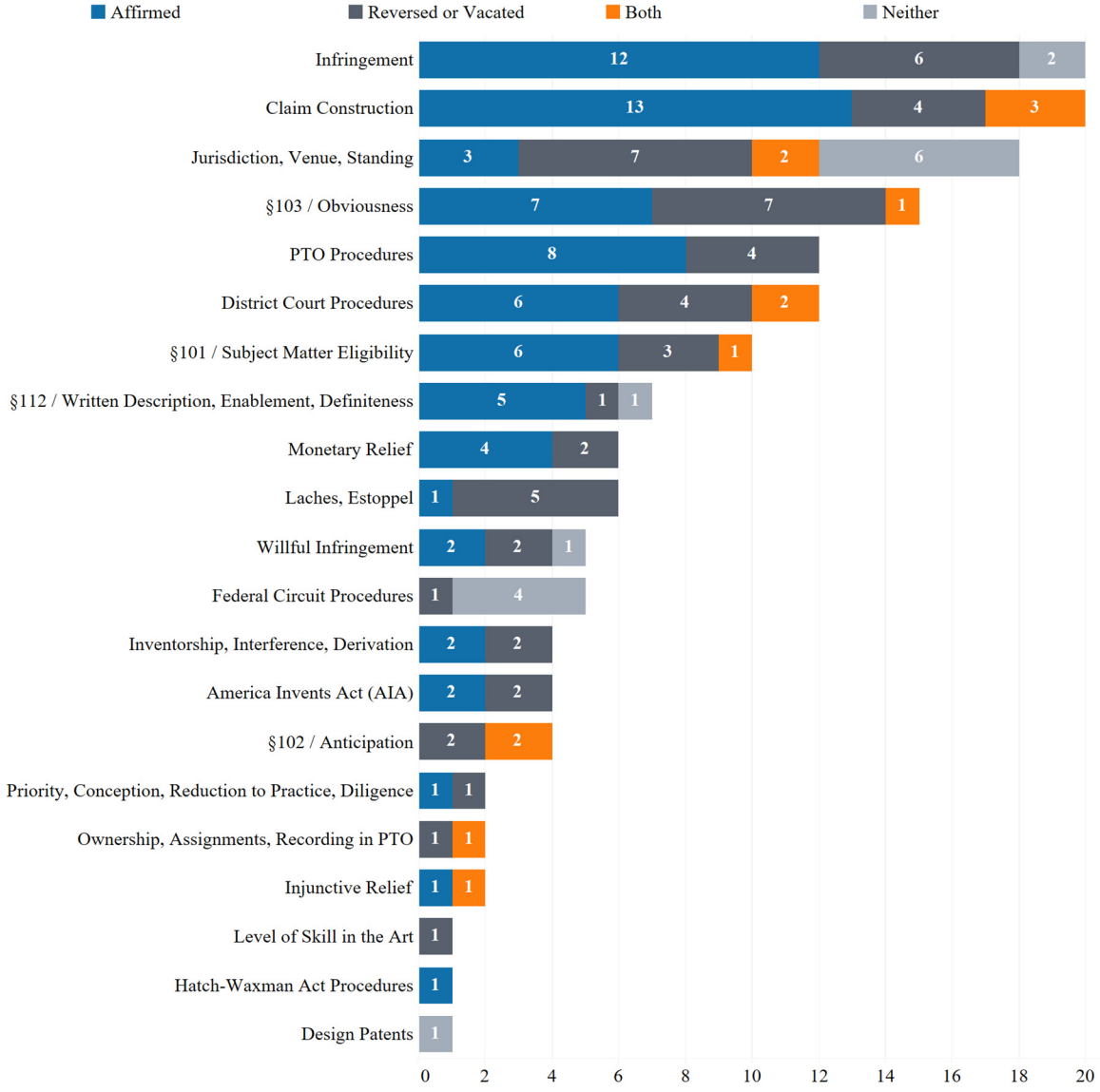
Whether Court, Agency, or Jury Decided Issue Below



Affirmance/Reversal of Issues Decided by a Court



Affirmance/Reversal of Issues Decided by an Agency



INDEX BY ISSUE

I. § 101 / Subject Matter Eligibility

Bot M8 LLC v. Sony Corp. of Am.
4 F.4th 1342 (Fed. Cir. 2021) 48

C.R. Bard Inc. v. AngioDynamics, Inc.
979 F.3d 1372 (Fed. Cir. 2020)..... 48

cxLoyalty, Inc. v. Maritz Holdings Inc.
986 F.3d 1367 (Fed. Cir. 2021)..... 54

Free Stream Media Corp. v. Alphonso Inc.
996 F.3d 1355 (Fed. Cir. 2021)..... 60

Illumina, Inc. v. Ariosa Diagnostics, Inc.
967 F.3d 1319 (Fed. Cir. 2020)..... 63

In re Bd. of Trs. of Leland Stanford Junior Univ.
991 F.3d 1245 (Fed. Cir. 2021)..... 65

In re Bd. of Trs. of Leland Stanford Junior Univ.
989 F.3d 1367 (Fed. Cir. 2021)..... 66

Simio, LLC v. FlexSim Software Prods., Inc.
983 F.3d 1353 (Fed. Cir. 2020)..... 77

TecSec, Inc. v. Adobe Inc.
978 F.3d 1278 (Fed. Cir. 2020)..... 84

Yu v. Apple, Inc.
1 F.4th 1040 (Fed. Cir. 2021) 90

II. § 102 / Anticipation

Biogen MA, Inc. v. EMD Serono, Inc.
976 F.3d 1326 (Fed. Cir. 2020)..... 44

C.R. Bard Inc. v. AngioDynamics, Inc.
979 F.3d 1372 (Fed. Cir. 2020)..... 48

M & K Holdings, Inc. v. Samsung Elecs. Co.
985 F.3d 1376 (Fed. Cir. 2021)..... 70

St. Jude Medical, LLC v. Snyders Heart Valve LLC
977 F.3d 1232 (Fed. Cir. 2020)..... 81

St. Jude Medical, LLC v. Snyders Heart Valve LLC
977 F.3d 1232 (Fed. Cir. 2020)..... 81

III. § 103 / Obviousness

Apple Inc. v. Voip-Pal.com, Inc.
976 F.3d 1316 (Fed. Cir. 2020)..... 40

Becton, Dickinson & Co. v. Baxter Corp. Englewood
998 F.3d 1337 (Fed. Cir. 2021)..... 43

Canfield Sci., Inc. v. Melanoscan, LLC
987 F.3d 1375 (Fed. Cir. 2021)..... 49

Chemours Co. FC, LLC v. Daikin Indus., Ltd.
4 F.4th 1370 (Fed. Cir. 2021) 51

Donner Tech., LLC v. Pro Stage Gear, LLC
979 F.3d 1353 (Fed. Cir. 2020)..... 55

Facebook, Inc. v. Windy City Innovations, LLC
973 F.3d 1321 (Fed. Cir. 2020)..... 57

Gen. Elec. Co. v. Raytheon Techs. Corp.
983 F.3d 1334 (Fed. Cir. 2020)..... 60

In re Google Tech. Holdings LLC
980 F.3d 858 (Fed. Cir. 2020)..... 66

Network-1 Techs., Inc. v. Hewlett-Packard Co.
981 F.3d 1015 (Fed. Cir. 2020)..... 72

SIPCO, LLC v. Emerson Elec. Co.
980 F.3d 865 (Fed. Cir. 2020)..... 78

St. Jude Medical, LLC v. Snyders Heart Valve LLC
977 F.3d 1232 (Fed. Cir. 2020)..... 81

Uniloc 2017 LLC v. Apple, Inc.
996 F.3d 1368 (Fed. Cir. 2021)..... 85

Uniloc 2017 LLC v. Facebook Inc.
989 F.3d 1018 (Fed. Cir. 2021)..... 86

VidStream LLC v. Twitter, Inc.
981 F.3d 1060 (Fed. Cir. 2020)..... 88

IV. § 112 / Written Description, Enablement, Definiteness

Amgen Inc. v. Sanofi, Aventisub LLC
987 F.3d 1080 (Fed. Cir. 2021)..... 39

Bayer Healthcare LLC v. Baxalta Inc.
989 F.3d 964 (Fed. Cir. 2021)..... 42

Biogen MA, Inc. v. EMD Serono, Inc.
976 F.3d 1326 (Fed. Cir. 2020)..... 44

Infinity Comput. Prods., Inc. v. Oki Data Ams., Inc.
987 F.3d 1053 (Fed. Cir. 2021)..... 68

Pac. Biosciences of Cal., Inc. v. Oxford Nanopore Techs., Inc.
996 F.3d 1342 (Fed. Cir. 2021)..... 74

Rain Computing, Inc. v. Samsung Elecs. Am., Inc.
989 F.3d 1002 (Fed. Cir. 2021)..... 75

Rain Computing, Inc. v. Samsung Elecs. Am., Inc.
989 F.3d 1002 (Fed. Cir. 2021)..... 75

Synchronoss Techs., Inc. v. Dropbox, Inc.
987 F.3d 1358 (Fed. Cir. 2021)..... 82

V. Claim Construction

Baxalta Inc. v. Genentech, Inc.
972 F.3d 1341 (Fed. Cir. 2020)..... 41

Bayer Healthcare LLC v. Baxalta Inc.
989 F.3d 964 (Fed. Cir. 2021)..... 42

Bio-Rad Lab'ys, Inc. v. 10X Genomics Inc.
967 F.3d 1353 (Fed. Cir. 2020)..... 45

Bio-Rad Lab'ys, Inc. v. Int'l Trade Comm'n
998 F.3d 1320 (Fed. Cir. 2021)..... 46

Chevron U.S.A. Inc. v. Univ. of Wyo. Rsch.
978 F.3d 1361 (Fed. Cir. 2020)..... 52

Edgewell Pers. Care Brands, LLC v. Munchkin, Inc.
989 F.3d 1358 (Fed. Cir. 2021)..... 56

Egenera, Inc. v. Cisco Sys., Inc.
972 F.3d 1367 (Fed. Cir. 2020)..... 57

Free Stream Media Corp. v. Alphonso Inc.
996 F.3d 1355 (Fed. Cir. 2021)..... 60

Immunex Corp. v. Sanofi-Aventis U.S. LLC
977 F.3d 1212 (Fed. Cir. 2020)..... 64

In re Google Tech. Holdings LLC
980 F.3d 858 (Fed. Cir. 2020)..... 66

Network-1 Techs., Inc. v. Hewlett-Packard Co.
981 F.3d 1015 (Fed. Cir. 2020)..... 72

Neville v. Found. Constructors, Inc.
972 F.3d 1350 (Fed. Cir. 2020)..... 73

Qualcomm Inc. v. Intel Corp.
6 F.4th 1256 (Fed. Cir. 2021) 74

Rain Computing, Inc. v. Samsung Elecs. Am., Inc.
989 F.3d 1002 (Fed. Cir. 2021)..... 75

SIMO Holdings Inc. v. Hong Kong uCloudlink Network Tech. Ltd.
983 F.3d 1367 (Fed. Cir. 2021)..... 77

SpeedTrack, Inc. v. Amazon.com, Inc.
998 F.3d 1373 (Fed. Cir. 2021)..... 80

St. Jude Medical, LLC v. Snyders Heart Valve LLC
977 F.3d 1232 (Fed. Cir. 2020)..... 81

Synchronoss Techs., Inc. v. Dropbox, Inc.
987 F.3d 1358 (Fed. Cir. 2021)..... 82

Uniloc 2017 LLC v. Apple, Inc.
996 F.3d 1368 (Fed. Cir. 2021)..... 85

Vectura Limited v. GlaxoSmithKline LLC
981 F.3d 1030 (Fed. Cir. 2020)..... 87

VI. Infringement

Bayer Healthcare LLC v. Baxalta Inc.
989 F.3d 964 (Fed. Cir. 2021)..... 42

Biogen MA, Inc. v. EMD Serono, Inc.
976 F.3d 1326 (Fed. Cir. 2020)..... 44

Bio-Rad Lab'ys, Inc. v. Int'l Trade Comm'n
996 F.3d 1302 (Fed. Cir. 2021)..... 45

Bio-Rad Lab'ys, Inc. v. 10X Genomics Inc.
967 F.3d 1353 (Fed. Cir. 2020)..... 45

Bio-Rad Lab'ys, Inc. v. Int'l Trade Comm'n
998 F.3d 1320 (Fed. Cir. 2021)..... 46

C.R. Bard Inc. v. AngioDynamics, Inc.
979 F.3d 1372 (Fed. Cir. 2020)..... 48

Edgewell Pers. Care Brands, LLC v. Munchkin, Inc.
989 F.3d 1358 (Fed. Cir. 2021)..... 56

Gen. Elec. Co. v. Raytheon Techs. Corp.
983 F.3d 1334 (Fed. Cir. 2020)..... 60

GlaxoSmithKline LLC v. Teva Pharms. USA, Inc.
976 F.3d 1347 (Fed. Cir. 2020)..... 60

Godo Kaisha IP Bridge 1 v. TCL Commc'n Tech. Holdings Ltd.
967 F.3d 1380 (Fed. Cir. 2020)..... 61

Infinity Comput. Prods., Inc. v. Oki Data Ams., Inc.
987 F.3d 1053 (Fed. Cir. 2021)..... 68

John Bean Techs. Corp. v. Morris & Assocs., Inc.
988 F.3d 1334 (Fed. Cir. 2021)..... 69

Network-1 Techs., Inc. v. Hewlett-Packard Co.
981 F.3d 1015 (Fed. Cir. 2020)..... 72

Neville v. Found. Constructors, Inc.
972 F.3d 1350 (Fed. Cir. 2020)..... 73

Pac. Biosciences of Cal., Inc. v. Oxford Nanopore Techs., Inc.
996 F.3d 1342 (Fed. Cir. 2021)..... 74

SIMO Holdings Inc. v. Hong Kong uCloudlink Network Tech. Ltd.
983 F.3d 1367 (Fed. Cir. 2021)..... 77

SiOnyx LLC v. Hamamatsu Photonics K.K.
981 F.3d 1339 (Fed. Cir. 2020)..... 78

SpeedTrack, Inc. v. Amazon.com, Inc.
998 F.3d 1373 (Fed. Cir. 2021)..... 80

Synchronoss Techs., Inc. v. Dropbox, Inc.
987 F.3d 1358 (Fed. Cir. 2021)..... 82

Vectura Limited v. GlaxoSmithKline LLC
981 F.3d 1030 (Fed. Cir. 2020)..... 87

VII. Willful Infringement

Bayer Healthcare LLC v. Baxalta Inc.
989 F.3d 964 (Fed. Cir. 2021)..... 42

C.R. Bard Inc. v. AngioDynamics, Inc.
979 F.3d 1372 (Fed. Cir. 2020)..... 48

GlaxoSmithKline LLC v. Teva Pharms. USA, Inc.
976 F.3d 1347 (Fed. Cir. 2020)..... 60

John Bean Techs. Corp. v. Morris & Assocs., Inc.
988 F.3d 1334 (Fed. Cir. 2021)..... 69

SiOnyx LLC v. Hamamatsu Photonics K.K.
981 F.3d 1339 (Fed. Cir. 2020)..... 78

VIII. Injunctive Relief

Bio-Rad Lab'ys, Inc. v. 10X Genomics Inc.
967 F.3d 1353 (Fed. Cir. 2020)..... 45

SiOnyx LLC v. Hamamatsu Photonics K.K.
981 F.3d 1339 (Fed. Cir. 2020)..... 78

IX. Monetary Relief

Bayer Healthcare LLC v. Baxalta Inc.
989 F.3d 964 (Fed. Cir. 2021)..... 42

Christy, Inc. v. United States
971 F.3d 1332 (Fed. Cir. 2020)..... 52

Egenera, Inc. v. Cisco Sys., Inc.
972 F.3d 1367 (Fed. Cir. 2020)..... 57

FastShip, LLC v. United States
968 F.3d 1335 (Fed. Cir. 2020)..... 58

SiOnyx LLC v. Hamamatsu Photonics K.K.
981 F.3d 1339 (Fed. Cir. 2020)..... 78

Vectura Limited v. GlaxoSmithKline LLC
981 F.3d 1030 (Fed. Cir. 2020)..... 87

X. Laches, Estoppel

Egenera, Inc. v. Cisco Sys., Inc.
972 F.3d 1367 (Fed. Cir. 2020)..... 57

Ferring B.V. v. Allergan, Inc.
980 F.3d 841 (Fed. Cir. 2020)..... 59

Hyatt v. Hirshfeld
998 F.3d 1347 (Fed. Cir. 2021)..... 62

John Bean Techs. Corp. v. Morris & Assocs., Inc.
988 F.3d 1334 (Fed. Cir. 2021)..... 69

Network-1 Techs., Inc. v. Hewlett-Packard Co.
981 F.3d 1015 (Fed. Cir. 2020)..... 72

SynQor, Inc. v. Vicor Corp.
988 F.3d 1341 (Fed. Cir. 2021)..... 82

XI. Ownership, Assignments, Recording in PTO

SiOnyx LLC v. Hamamatsu Photonics K.K.
981 F.3d 1339 (Fed. Cir. 2020)..... 78

Whitewater West Indus., Ltd. v. Alleshouse
981 F.3d 1045 (Fed. Cir. 2020)..... 89

XII. Inventorship, Interference, Derivation

Bio-Rad Lab'ys, Inc. v. Int'l Trade Comm'n
996 F.3d 1302 (Fed. Cir. 2021)..... 45

Chevron U.S.A. Inc. v. Univ. of Wyo. Rsch.
978 F.3d 1361 (Fed. Cir. 2020)..... 52

Egenera, Inc. v. Cisco Sys., Inc.
972 F.3d 1367 (Fed. Cir. 2020)..... 57

Whitewater West Indus., Ltd. v. Alleshouse
981 F.3d 1045 (Fed. Cir. 2020)..... 89

XIII. Design Patents

Mojave Desert Holdings, LLC v. Crocs, Inc.
995 F.3d 969 (Fed. Cir. 2021)..... 70

XIV. PTO Procedures

Apple Inc. v. Voip-Pal.com, Inc.
976 F.3d 1316 (Fed. Cir. 2020)..... 40

Christy, Inc. v. United States
971 F.3d 1332 (Fed. Cir. 2020)..... 52

Chudik v. Hirshfeld
987 F.3d 1033 (Fed. Cir. 2021)..... 53

Facebook, Inc. v. Windy City Innovations, LLC
973 F.3d 1321 (Fed. Cir. 2020)..... 57

Mojave Desert Holdings, LLC v. Crocs, Inc.
995 F.3d 969 (Fed. Cir. 2021)..... 70

Network-1 Techs., Inc. v. Hewlett-Packard Co.
981 F.3d 1015 (Fed. Cir. 2020)..... 72

New Vision Gaming & Dev., Inc. v. SG Gaming, Inc.
996 F.3d 1378 (Fed. Cir. 2021)..... 73

Qualcomm Inc. v. Intel Corp.
6 F.4th 1256 (Fed. Cir. 2021) 74

Sec. People, Inc. v. Iancu
971 F.3d 1355 (Fed. Cir. 2020)..... 76

SIPCO, LLC v. Emerson Elec. Co.
980 F.3d 865 (Fed. Cir. 2020)..... 78

Uniloc 2017 LLC v. Apple, Inc.
996 F.3d 1368 (Fed. Cir. 2021)..... 85

VidStream LLC v. Twitter, Inc.
981 F.3d 1060 (Fed. Cir. 2020)..... 88

XV. America Invents Act (AIA)

Apple Inc. v. Voip-Pal.com, Inc.
976 F.3d 1316 (Fed. Cir. 2020)..... 40

M & K Holdings, Inc. v. Samsung Elecs. Co.
985 F.3d 1376 (Fed. Cir. 2021)..... 70

Network-1 Techs., Inc. v. Hewlett-Packard Co.
981 F.3d 1015 (Fed. Cir. 2020)..... 72

Sec. People, Inc. v. Iancu
971 F.3d 1355 (Fed. Cir. 2020)..... 76

XVI. District Court Procedures

Biogen MA, Inc. v. EMD Serono, Inc.
976 F.3d 1326 (Fed. Cir. 2020)..... 44

Bot M8 LLC v. Sony Corp. of Am.
4 F.4th 1342 (Fed. Cir. 2021) 48

DePuy Synthes Prods., Inc. v. Veterinary Orthopedic Implants, Inc.
990 F.3d 1364 (Fed. Cir. 2021)..... 54

GlaxoSmithKline LLC v. Teva Pharms. USA, Inc.
976 F.3d 1347 (Fed. Cir. 2020)..... 60

In re Nitro Fluids L.L.C.
978 F.3d 1308 (Fed. Cir. 2020)..... 67

Pac. Biosciences of Cal., Inc. v. Oxford Nanopore Techs., Inc.
996 F.3d 1342 (Fed. Cir. 2021)..... 74

Simio, LLC v. FlexSim Software Prods., Inc.
983 F.3d 1353 (Fed. Cir. 2020)..... 77

Sowinski v. California Air Res. Bd.
971 F.3d 1371 (Fed. Cir. 2020)..... 79

TecSec, Inc. v. Adobe Inc.
978 F.3d 1278 (Fed. Cir. 2020)..... 84

Trimble Inc. v. PerDiemCo LLC
997 F.3d 1147 (Fed. Cir. 2021)..... 84

XVII. Jurisdiction, Venue, Standing

ABS Global, Inc. v. Cytonome/ST, LLC
984 F.3d 1017 (Fed. Cir. 2021)..... 38

Am. Axle & Mfg. v. Neapco Holdings LLC
977 F.3d 1379 (Fed. Cir. 2020)..... 38

AntennaSys, Inc. v. AQYR Techs., Inc.
976 F.3d 1374 (Fed. Cir. 2020)..... 39

Apple Inc. v. Voip-Pal.com, Inc.
976 F.3d 1316 (Fed. Cir. 2020)..... 40

Chandler v. Phoenix Services, LLC
1 F.4th 1013 (Fed. Cir. 2021) 51

Christy, Inc. v. United States
971 F.3d 1332 (Fed. Cir. 2020)..... 52

DePuy Synthes Prods., Inc. v. Veterinary Orthopedic Implants, Inc.
990 F.3d 1364 (Fed. Cir. 2021)..... 54

Gen. Elec. Co. v. Raytheon Techs. Corp.
983 F.3d 1334 (Fed. Cir. 2020)..... 60

In re Apple Inc.
979 F.3d 1332 (Fed. Cir. 2020)..... 65

In re Nitro Fluids L.L.C.
978 F.3d 1308 (Fed. Cir. 2020)..... 67

In re Samsung Elecs. Co.
2 F.4th 1371 (Fed. Cir. 2021) 67

Mojave Desert Holdings, LLC v. Crocs, Inc.
995 F.3d 969 (Fed. Cir. 2021)..... 70

Mylan Lab'ys. Ltd. v. Janssen Pharmaceutica, N.V.
989 F.3d 1375 (Fed. Cir. 2021)..... 71

Synchronoss Techs., Inc. v. Dropbox, Inc.
987 F.3d 1358 (Fed. Cir. 2021)..... 82

Trimble Inc. v. PerDiemCo LLC
997 F.3d 1147 (Fed. Cir. 2021)..... 84

Uniloc 2017 LLC v. Facebook Inc.
989 F.3d 1018 (Fed. Cir. 2021)..... 86

Valeant Pharms. N. Am. LLC v. Mylan Pharms. Inc.
978 F.3d 1374 (Fed. Cir. 2020)..... 86

Warsaw Orthopedic, Inc. v. Sasso
977 F.3d 1224 (Fed. Cir. 2020)..... 88

XVIII. Federal Circuit Procedures

ABS Global, Inc. v. Cytonome/ST, LLC
984 F.3d 1017 (Fed. Cir. 2021)..... 38

Mylan Lab'ys. Ltd. v. Janssen Pharmaceutica, N.V.
989 F.3d 1375 (Fed. Cir. 2021)..... 71

SynQor, Inc. v. Vicor Corp.
988 F.3d 1341 (Fed. Cir. 2021)..... 82

XIX. Hatch-Waxman Act Procedures

Valeant Pharms. N. Am. LLC v. Mylan Pharms. Inc.
978 F.3d 1374 (Fed. Cir. 2020)..... 86

CASE SUMMARIES

ABS Global, Inc. v. Cytonome/ST, LLC
984 F.3d 1017 (Fed. Cir. 2021)

Cytonome sued ABS Global in district court for infringement of six patents, including the '161 patent, relating to microfluidic devices. During the pendency of the case, ABS petitioned for IPR of the '161 patent. The PTAB invalidated many of the challenged claims but upheld two. Shortly afterwards, the district court granted ABS's motion for summary judgment of noninfringement of the '161 patent. ABS appealed the PTAB's final written decision to the Federal Circuit, challenging the remaining '161 patent claims. Cytonome argued that the appeal was moot because the district court's finding of noninfringement meant that ABS had no risk of actually infringing the patent, and therefore there was no injury sufficient to sustain Article III standing. With its appeal brief, Cytonome included an affidavit disclaiming any appeal as to the district court's ruling of noninfringement.

The Federal Circuit held that ABS's appeal was moot under the voluntary cessation doctrine. The Court reaffirmed that appeal from an IPR requires Article III standing, including a "concrete and particularized" harm stemming from an "actual case or controversy." Because Cytonome had already lost on infringement and expressly disavowed any right to appeal, it had shown it could not be "reasonably expected" to resume its enforcement effort against ABS. That shifted the burden to ABS to show concrete plans for activity that created a substantial risk of infringement. ABS failed to meet that burden, and thus the Court concluded that ABS had no "particularized, concrete stake in the outcome" of the IPR appeal. The Federal Circuit therefore dismissed the appeal as moot.

Am. Axle & Mfg. v. Neapco Holdings LLC
977 F.3d 1379 (Fed. Cir. 2020)

American Axle moved to stay issuance of a mandate from a patent infringement case pending the filing of a petition for writ of certiorari in the Supreme Court. The Federal Circuit adopted and applied the three-prong test from *Hollingsworth*, but it denied the motion for lack of an irreparable injury. *See Hollingsworth v. Perry*, 558 U.S. 183, 190 (2010). The Court explained that the *Hollingsworth* test requires the movant to show "(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." Noting that Chief Justice Roberts previously applied *Hollingsworth* to a patent case, the Federal Circuit held "[a]s a matter of Federal Circuit law, we interpret [Federal Rule of Appellate Procedure 41] as requiring application of the standard articulated by the Supreme Court in *Hollingsworth* and the Justices' in-chamber opinions."

On the merits, however, the Court found that American Axle failed to meet the third prong of the test (irreparable harm) because litigation expenses and the prospect of further district

court proceedings on remand while American Axle seeks certiorari did not constitute irreparable harm. The Court did not reach the question of whether American Axle satisfied the first two prongs.

Amgen Inc. v. Sanofi, Aventisub LLC
987 F.3d 1080 (Fed. Cir. 2021)

Amgen owned the '165 and '741 patents covering antibodies capable of blocking the PCSK9 enzyme from binding to low-density lipoprotein cholesterol (LDL) receptors. With aid of the antibodies, the receptors could freely bind LDL cholesterol and remove it from the bloodstream, which may have benefits for cardiovascular health. The U.S. District Court for the District of Delaware granted judgment as a matter of law of non-enablement, holding that "undue experimentation" would be required to practice the claimed invention. The Federal Circuit affirmed, finding the challenged claims were invalid for lack of enablement under Section 112.

It was the second time the Court heard an appeal over the same patents. In 2017, the Court found error in the district court's evidentiary rulings and jury instructions and remanded for a new trial. On remand, a jury for the second time ruled in favor of Amgen on the issue of enablement. The trial judge granted Sanofi's motion for a judgment as a matter of law, reversing the jury verdict.

On appeal, the Federal Circuit applied the *Wands* factors to determine the issue of undue experimentation. It focused on the "functional breadth" of the embodiments falling within the claims, which were far broader in "functional diversity" than the disclosed examples. In addition, the Court agreed with the district court that the invention was "in an unpredictable field of science" and that one could not predictably generate the full scope of the claims.

AntennaSys, Inc. v. AQYR Techs., Inc.
976 F.3d 1374 (Fed. Cir. 2020)

AntennaSys sued Windmill International, Inc. and AQYR, Windmill's wholly-owned subsidiary, in the District of New Hampshire for patent infringement and related state law claims. The district court granted summary judgment for Windmill and AQYR, and AntennaSys appealed. On appeal, the defendants challenged AntennaSys's standing to bring a patent infringement claim absent joinder of Windmill as a co-plaintiff.

The '868 patent's two named inventors each assigned their interest to their respective employers—AntennaSys and Windmill. The parties entered into a license agreement in which Windmill acquired an exclusive license to AntennaSys's one-half interest in the patent. Windmill agreed to pay AntennaSys three percent of the gross sales price. The license becomes non-exclusive if Windmill fails to meet certain minimum sales requirements in the commercial marketplace, and either party has the right to commence a lawsuit against "third party" infringers. The parties also agreed that "Windmill shall

create" an LLC to own both Windmill's interest in the patent and Windmill's license to AntennaSys's interest. Windmill failed to meet the sales requirements of the agreement.

AntennaSys's suit against AQYR and Windmill included one patent infringement count against AQYR and five state law counts against Windmill and AQYR. Following claim construction, AntennaSys conceded it could not prevail on its patent infringement claim under the court's claim construction and sought summary judgment of noninfringement. After conducting a hearing, the district court entered judgment for Windmill and AQYR. AntennaSys timely appealed.

The Federal Circuit concluded that whether a patent co-owner must be joined is a threshold issue that must be resolved prior to addressing the district court's claim construction. If AQYR was never a proper party to these proceedings, the district court had no jurisdiction over them. The Court thus held no judgment on infringement should be entered without first resolving AQYR's defense that it was authorized by a co-owner to practice the '868 patent. The Court vacated the district court's summary judgment grant and remanded to the district court to resolve all factual issues pertaining to AntennaSys's ability to bring its patent infringement claim against AQYR. If the district court concludes that AntennaSys's patent infringement claim should be dismissed, the district court would have no independent jurisdiction over the state law counts.

Apple Inc. v. Voip-Pal.com, Inc.
976 F.3d 1316 (Fed. Cir. 2020)

Voip-Pal.com, Inc. sued Apple Inc. for infringement of two patents in the District of Nevada. Thereafter, Apple petitioned for IPR of the asserted patents in two separate proceedings, arguing the claims were obvious. During both IPR proceedings, Voip-Pal's former CEO sent *ex parte* communications to administrative patent judges at the PTAB, among other officials, criticizing the IPR system, complaining about the PTAB's patent cancellation rates, and requesting judgment in favor of Voip-Pal or dismissal of Apple's petitions. The letters did not, however, discuss the merits of Apple's IPR petitions.

Following a final written decision finding the asserted patents to not be invalid for obviousness, Apple moved for sanctions against Voip-Pal based on its *ex parte* communications with the PTAB. A new PTAB panel determined that while Voip-Pal's conduct was sanctionable, it rejected Apple's request for a directed judgment and request for a new proceeding, and instead fashioned its own sanction—that the new panel would preside over Apple's petition for rehearing, which the panel ultimately denied. Apple appealed the PTAB's sanction, arguing that the PTAB violated the Administrative Procedures Act and due process rights when the PTAB imposed a sanction that was not enumerated in 37 C.F.R. § 42.12(b).

The Federal Circuit affirmed the sanctions order of the PTAB, noting that the PTAB is not limited to only the sanctions identified in the Code of Federal Regulations. Specifically, the applicable regulations used the open term "include" when enumerating the sanctions the PTAB may impose, demonstrating the availability of sanctions is not limited to those

explicitly included in the regulation. The Federal Circuit also rejected Apple's contention that the PTAB abused its discretion in not ordering a sanction of judgment in favor of Apple, stating that "[a] sanction which may sound the death knell for important [patent] rights and interests . . . should be used as a weapon of last, rather than first, resort." The Federal Circuit determined that in this instance, the PTAB's "choice [fell] within a reasonable range."

Apple Inc. v. Qualcomm Inc.
992 F.3d 1378 (Fed. Cir. 2021)

This case concerns a six-year licensing agreement between Apple and Qualcomm covering Qualcomm's patents that Apple challenged in IPR proceedings. The PTAB rejected Apple's argument that Qualcomm's patents were obvious and therefore invalid. The Federal Circuit dismissed Apple's appeal of the PTAB decision for a lack of standing.

On appeal, the Federal Circuit first rejected Qualcomm's argument that it did not have the discretion to review the issue of standing, holding that the issue was fully briefed, the review would not prejudice Qualcomm, and the question at issue impacts other appeals.

On the merits, Apple argued that three conditions established its standing in federal court: (1) its ongoing payment obligations were a condition for rights in the license agreement; (2) the threat of Qualcomm suing Apple for patent infringement after the expiration of the license agreement; and (3) an estoppel could prevent future challenges to the validity of the patents. The Federal circuit rejected each of Apple's arguments.

The Federal Circuit rejected Apple's first argument, holding that Apple's ongoing payment obligations do not establish standing because Apple failed to show that the validity of the patents could materially impact any of its ongoing payment obligations or contracts to pay royalty fees. The Court then rejected Apple's second argument, finding that the possibility of Qualcomm suing Apple for infringing on the patents after the license expires is too speculative to grant standing. Qualcomm's past infringement lawsuit, its refusal to give Apple permanent licensing, and Apple's general history of selling smartphones did not offer concrete evidence that Qualcomm is likely to assert these particular patents against any particular products that would be sold after the license agreement expires. Finally, the Federal Circuit rejected Apple's last argument for standing, holding that the estoppel effects of 35 U.S.C. § 315(e) do not provide an independent basis for standing.

Baxalta Inc. v. Genentech, Inc.
972 F.3d 1341 (Fed. Cir. 2020)

Baxalta brought a patent infringement suit against Genentech, claiming infringement of the '590 patent. Specifically, Baxalta alleged that Genentech's hemophilia treatment, Hemlibra®, infringed claims 1, 4, 17, and 19 of the '590 patent. The '590 patent relates to preparations that comprise antibodies or antibody fragments that bind with an enzyme to treat hemophilia patients who have developed factor VIII inhibitors to compensate for

decreased factor VIII activity. Factor VIII, known as activated clotting factor VIII, is a critical component of blood clotting.

During the suit, the parties disputed the construction of the terms "antibody" and "antibody fragment." Although Baxalta and Genentech both proposed acceptable definitions according to the district court, the district court chose Genentech's narrower definition of "antibody." The district court also adopted Genentech's construction of "antibody fragment." Following the district court's constructions, the parties stipulated to noninfringement of the asserted claims. On appeal, Baxalta argued that the district court erred in its construction of the terms "antibody" and "antibody fragment."

The Federal Circuit reviewed the district court's claim construction *de novo*. First, the Court held that the plain language of the claims is inconsistent with the district court's construction, as it would render the dependent claims invalid. Second, the Court noted that the district court's constructions were inconsistent with the written description. Third, the prosecution history of the '590 patent did not support the district court's constructions. Consequently, the Federal Circuit vacated the judgment based on erroneous constructions and remanded for further proceedings consistent with the correct construction of the terms.

Bayer Healthcare LLC v. Baxalta Inc.
989 F.3d 964 (Fed. Cir. 2021)

Bayer HealthCare sued Baxalta and Nektar Therapeutics, claiming that Adynovate®, Baxalta's biologic product, infringed Bayer's '520 patent. The jury found that Baxalta infringed the '520 patent, that Baxalta had failed to prove invalidity for lack of enablement, and that Bayer was entitled to damages. The district court also found that Baxalta's infringement was not willful. Both Bayer and Baxalta appealed to the Federal Circuit. The Federal Circuit affirmed the district court's holdings of infringement, enablement, damages, pre-verdict supplemental damages, and lack of willfulness.

The Federal Circuit first upheld the district court's construction of the claim term "at the B-domain." The Federal Circuit concluded that Baxalta's claim construction arguments presented "close questions," but that the claim language, the specification, and the prosecution history ultimately supported the district court's construction. The Court also rejected Baxalta's argument that the district court had created an *O2 Micro* issue by failing to construe the term "random" and instead leaving that question to the jury. The Court concluded that the district court sufficiently laid out the scope of its construction and that Baxalta's argument merely attempted to arrive at its argued-for construction that the district court and Federal Circuit had rejected.

The Federal Circuit next upheld the jury's finding of infringement on the '520 patent. Bayer presented experts to support the idea that PEGylation sites are clustered on the B-domain; therefore, even though Baxalta presented contradicting evidence, the district court was correct in allowing the jury to determine which evidence was more persuasive.

The Federal Circuit upheld the jury's finding on enablement. The Federal Circuit found that the '520 patent specified detailed instructions and provided a working example of non-random cysteine PEGylation at the B-domain. In addition, multiple witnesses testified that random lysine PEGylation was known during the creation of the '520 patent. Therefore, there was substantial evidence supporting the jury's verdict on enablement.

The Federal Circuit then rejected Baxalta's argument that the district court had erred as a matter of law in applying the enablement standard. The Court reiterated that the specification "need not include a working example of every possible embodiment to enable the full scope of the claims," so the district court had correctly considered the knowledge of an ordinarily skilled artisan to reject Baxalta's arguments regarding undue experimentation. The Court also agreed with Baxalta that it was error for the district court to rely on testimony regarding post-priority knowledge to support the jury's verdict, but the Court found that error harmless because the district court also relied on appropriate testimony and evidence regarding knowledge available at the time of the invention.

On the issue of damages, the Federal Circuit found that the district court did not err in allowing Bayer to provide a range to the jury to choose from or in awarding pre-verdict supplemental damages. The Court explained that it was appropriate for Bayer's damages expert to present a range of potential royalty rates from which the jury could select because the expert had adequately supported that royalty rate range through analysis of the *Georgia-Pacific* factors. The Court also rejected Baxalta's Seventh Amendment argument against the award of pre-verdict supplemental damages because the district court had merely applied the royalty rate found by the jury to be reasonable to the undisputed infringing sales base.

Finally, on the issue of willfulness, the Federal Circuit held that Bayer failed to provide sufficient evidence of Baxalta's "state of mind" to establish willful infringement based on deliberate or intentional infringement. "Knowledge of the asserted patent and evidence of infringement is necessary, but not sufficient, for a finding of willfulness" because "willfulness requires deliberate or intentional infringement."

Becton, Dickinson & Co. v. Baxter Corp. Englewood
998 F.3d 1337 (Fed. Cir. 2021)

Becton, Dickinson and Company petitioned the PTAB for IPR of multiple claims of Baxter's '579 patent, two of which were at issue in this appeal. The PTAB held that the prior art references presented by Becton did not teach or make obvious the limitations at issue, and that the limitations were therefore not invalid as obvious. The Federal Circuit reversed, finding that the PTAB's determinations as to the obviousness of claims were not supported by substantial evidence.

The '579 patent is directed to "[s]ystems for preparing patient-specific doses and a method for telepharmacy in which data captured while following [a protocol associated with each received drug order and specifying a set of steps to fill the drug order] are provided to a remote site for review and approval by a pharmacist." The two contested limitations in

this appeal were the "verification" limitation, which covers a system that requires an operator following a drug order protocol to verify completion of each step of the protocol before being able to move on to the next one, and the "highlighting" limitation, which covers a system that allows the operator to highlight prompts on an interactive screen in order to find more information about a particular step of the drug protocol.

With respect to the "verification" limitation, the Court found that the Alexander prior art reference plainly teaches step-by-step review, approval by a pharmacist, and verification of each step of a drug order protocol before authorization to go to the next step—no different from the '579 patent's claims. The Court then looked to Liff, another prior art reference, in its analysis of the '579 patent's highlighting limitation. Liff teaches "highlight[ing] patient characteristics when dispensing a prepackaged medication." It discloses a different display of information (tabs) from the '579 patent (clickable buttons), and contemplates different information to be displayed (patient details) from the '579 patent (patient details and other information). Even so, the Court found that in light of Alexander and Liff, a POSITA would have found the '579 patent's highlighting limitation obvious, citing the principle from *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007), that "[a] person of ordinary skill is also a person of ordinary creativity."

Baxter also claimed that the PTAB erroneously deemed Alexander prior art, arguing that it did not qualify under the pre-AIA version of Section 102 that applied in this case because all of Alexander's claims had been cancelled after IPR. *See* 35 U.S.C. § 102(e)(2) (pre-AIA). The Court rejected this argument, reasoning that the text of the statute required only that a patent was granted, not currently valid, in order to qualify as prior art.

Biogen MA, Inc. v. EMD Serono, Inc.
976 F.3d 1326 (Fed. Cir. 2020)

Biogen filed suit against Serono, among others, in the District of New Jersey for contributory and induced infringement of the '755 patent directed towards a recombinant interferon-β ("IFN-β") product used to treat Multiple Sclerosis ("MS"). At trial, a jury found that the '755 patent claims were anticipated by two prior art references teaching the use of native (*i.e.*, naturally occurring) IFN-β to treat viral diseases. Biogen thereafter sought JMOL of no anticipation, which the district court granted in part because the treatment in the prior art undoubtedly disclosed the administration of *native*, and not *recombinant*, IFN-β. In reaching this decision, the district court declined to apply a product-by-process analysis to the recombinant IFN-β method of treatment claim limitation. The district court also held that, even if it applied a product-by-process analysis, no reasonable jury could have found anticipation because the jury lacked sufficient evidence of identity between the claimed *recombinant* polypeptide and the native IFN-β.

On appeal, the Federal Circuit disagreed. The Federal Circuit held that it was error not to apply a product-by-process analysis to the claimed recombinant IFN-β source limitation, rejecting Biogen's argument that the product-by-process analysis only applied to product claims and not the challenged method of treatment claim at issue here. The Federal Circuit

stated that "[t]he nesting of the product-by-process limitation within a method of treatment claim does not change the proper construction of the product-by process limitation itself." The Federal Circuit explained that such a holding "is a necessary outgrowth of the black-letter legal principle that an old product made by a new process is not novel and cannot be patented," as "an old method of administration of an old product made by a new process is not novel and cannot be patented." On the merits, the Federal Circuit explained that the prior art indisputably taught the administration of native IFN-β that has a linear amino acid sequence identical to the claimed amino acid sequence of the recited recombinant IFN-β. The Court thus concluded that the jury "had sufficient evidence to find that native IFN-β polypeptide is identical to recombinant IFN-β polypeptide, was administered in therapeutically effective amounts, and showed antiviral activity in the prior art."

The Federal Circuit thus remanded with instructions to the district court to reinstate the jury verdict finding anticipation of the asserted '755 patent.

Bio-Rad Lab'ys, Inc. v. Int'l Trade Comm'n
996 F.3d 1302 (Fed. Cir. 2021)

The Federal Circuit affirmed the ITC's decision finding that Bio-Rad Laboratories violated Section 337 of the Tariff Act of 1930 by infringing Genomics's biotechnology patents. The ALJ held that Bio-Rad violated the statute with respect to all three asserted patents. The ALJ rejected Bio-Rad's defense that it could not be liable for infringement because it co-owned the asserted patents under assignment provisions that the inventors signed when they were Bio-Rad employees. The Commission affirmed the ALJ's holding.

Former Bio-Rad employees invented and patented technology related to technology that they developed at Bio-Rad. Shortly thereafter, Bio-Rad began selling a product that the inventors alleged infringed on their patents. The patent holders filed a complaint with the Commission. In its defense, Bio-Rad alleged that it co-owned the patents at issue based on the assignment provisions in the former employees' contracts. The contracts stipulated that all inventions developed during the employment period shall be assigned to Bio-Rad.

On appeal, the Federal Circuit Court affirmed the ALJ and Commission's holding that Bio-Rad violated the inventors' patents. The Court rejected Bio-Rad's defense that it co-owned the patents at issue, finding that Bio-Rad did not furnish any persuasive basis for disturbing the Commission's conclusion that the assignment provisions do not apply to a signatory's ideas developed during employment solely because the ideas ended up contributing to a post-employment patentable invention.

Bio-Rad Lab'ys, Inc. v. 10X Genomics Inc.
967 F.3d 1353 (Fed. Cir. 2020)

Bio-Rad Laboratories and the University of Chicago brought suit accusing 10X Genomics for infringement of three of their patents: the '083 patent, '193 patent, and '407 patent. The relevant patents are directed to "systems and methods for forming microscopic droplets (also called 'plugs') of fluids to perform biochemical reactions." The microfluidic systems

utilize chips that have "microfluidic channels" through which "cells and fluids flow," allowing scientists to conduct microscale chemical and biological reactions. Bio-Rad accused five of 10X's product lines of infringement. The jury found all three patents valid and willfully infringed, and awarded $23,930,716 in damages. The district court denied 10X's subsequent motion for JMOL and granted Bio-Rad's motion for a permanent injunction. 10X appealed.

On appeal, the Court addressed four issues: whether the district court properly determined (1) the validity of the '083 patent and rejection of 10X's doctrine of equivalents argument based on prosecution history estoppel and claim vitiation; (2) the validity of the '407 and '193 patents based on a disputed claim construction; (3) the damages award; and (4) the grant of the permanent injunction.

First, the Court affirmed the jury's finding of infringement of the '083 patent and rejected 10X's argument that prosecution history estoppel applied to this case because of statements Bio-Rad made during prosecution of the '083 patent to overcome prior art. The Court held that the amendment was "only tangentially related" to the accused equivalent. The Court further held that claim vitiation did not bar a finding of infringement and affirmed the validity of the '083 patent and that it was infringed.

Second, the Court vacated the infringement findings for the '407 and '193 patents based on the an erroneous claim construction. The Court determined that the preamble provided the antecedent basis for terms in the body of the claim and found that was a strong indication that the preamble should be limiting. Based on this antecedent relationship, the Court determined that the claimed methods should be limited to on-chip reactions. The Court thus remanded for a new trial on those issues.

Third, the Court affirmed the awarded damages, holding that the jury's damages award was supported by substantial evidence and that the expert's testimony on comparable licenses and apportionment were properly admitted.

Finally, the Court vacated the permanent injunction as to two product lines, but concluded that the injunction should remain in place as to the other product lines. The Court determined that (1) money damages would not be able to compensate the harm to Bio-Rad, (2) it was an abuse of discretion to enjoin two of the product lines in the absence of noninfringing alternatives, and (3) there was no abuse of discretion in the district court's carefully crafted injunction that allowed existing 10X customers to continue their research as long as 10X paid a 15% royalty.

Bio-Rad Lab'ys, Inc. v. Int'l Trade Comm'n
998 F.3d 1320 (Fed. Cir. 2021)

The asserted patents relate to the creation of microscopic droplets. The asserted patents involve systems and methods for creating microscopic droplets using a device referred to as a "chip." This appeal involved two challenges to the ITC's determinations. First, Bio-Rad challenged the ITC's determination that 10X Genomics did not infringe the

’664 patent with its “Chip GB.” Second, 10X challenged the ITC’s ruling that it infringed the ’682 and ’635 patents with the “GEM Chip.”

As to Bio-Rad’s appeal of the noninfringement of the ’664 patent, Bio-Rad advanced two arguments. First, Bio-Rad argued the ALJ erred by imposing additional limitations that the sample must be biological and that it must be “of interest” to end-user consumers. Bio-Rad further argued the ALJ erred in finding the monomer input for the Chip GB is not a sample. Ultimately, the Court rejected these arguments and found there was no error in the ALJ’s claim construction and that the term “sample” was not defined so broadly as to include “reagents” within its scope. After finding no error in claim construction, the Court stated that the monomer in Chip GB was not a sample because 10X does not analyze the monomers but instead uses them to make gel beads that go into reagent kits.

Second, Bio-Rad argued that regardless of whether the monomer solution in Chip GB is a “sample,” the claims recited structural limitations, all of which were included in the Chip GB. Specifically, Bio-Rad stated that the physical object in the claims is a “chip with three wells and interconnecting channels,” and that Chip GB contains these structural elements. The Court rejected this argument for a number of reasons, including: (1) Bio-Rad did not raise this argument before the ITC and therefore is precluded from raising it on appeal; and (2) even if this argument was not waived, the argument failed because it was premised on rewriting the claims in an oversimplified form and removing all limitations that differentiate the relevant structure from each other. Thus, the Court affirmed the ITC’s determination that the Chip GB does not infringe the ’664 patent.

Next, 10X advanced two challenges to the ITC’s determinations in regard to the GEM Chips. First, 10X challenged the ITC’s claim construction that the GEM Chips included the “droplet-generation region” as required by all asserted claims. Rejecting this argument, the Court found that the ALJ correctly construed the “droplet-generation region” term. Specifically, the Court found there was nothing to justify imposing a requirement that the channels that intersect at the droplet-generation region must extend directly from input wells. Under this construction, the Court held there was substantial evidence to support the ITC’s finding that the use of 10X’s GEM Chips directly infringed the asserted patents.

Second, 10X challenged the ITC’s findings with regard to direct infringement. 10X argued substantial evidence did not support the ITC’s findings with regard to the knowledge requirements. 10X asserted that it had knowledge of patent applications but not the patents, and that the inventors had an objectively reasonable belief that use of the GEM Chips would not infringe the patents. Further, 10X argued the GEM Chips were suitable for substantial noninfringing uses. The Court found these arguments to be unpersuasive given the named inventors’ sale of the patent rights to Bio-Rad and then launch of a competing company and product. Regarding the noninfringing uses, the Court stated that because 10X failed to point to any real available noninfringing uses, rather than simply hypothetical systems not yet available to 10X’s customers, the ITC’s decision was correct.

Bot M8 LLC v. Sony Corp. of Am.
4 F.4th 1342 (Fed. Cir. 2021)

In this appeal from the Northern District of California, the Federal Circuit affirmed in part and reversed in part the district court's decision to dismiss or grant summary judgment on five claims of patent infringement.

Bot M8 sued Sony, alleging that Sony's PlayStation 4 and certain video games infringed various patents related to gaming authentication mechanisms, fault inspection programs, and updated gaming conditions. The Federal Circuit affirmed the district court's decision to grant Sony's motion to dismiss with respect to the '540 and '990 patents. The Court reasoned that Bot M8 failed to plausibly allege infringement of the '540 patent because Bot M8's assertion that the PlayStation 4 stored certain programs on its motherboard was inconsistent with the patent's requirement that those programs be stored separately from the motherboard. As to the '990 patent, which "requires storing gaming information and a mutual authentication program on the same medium," Bot M8 never specifically alleged which PlayStation 4 component stored gaming information and a mutual authentication program together.

The Court reversed the dismissal of Bot M8's infringement claims with respect to the '988 and '670 patents, which require execution of a "fault inspection program before the game is started." Bot M8 plausibly alleged infringement of the two patents because it identified certain PlayStation 4 error messages that allowed the Court to reasonably infer that the PlayStation 4 completes a fault inspection program prior to the start of a game. As to the '363 patent, the Court affirmed the district court's grant of summary judgment. Because claim 1 did not specify the mechanism behind which it purported to change a game's difficulty, the claim was "directed to an abstract idea" and ineligible under Section 101.

The Federal Circuit also rejected Bot M8's claims that the district court erred in "forcing" Bot M8 to file an amended complaint and abused its discretion in denying Bot M8 leave to amend its first amended complaint. The Court reasoned that the district court did not force Bot M8 to file an amended complaint because the record showed that Bot M8 willingly chose to do so after the district court merely offered Bot M8 "another chance to plead" before letting Sony bring its motion to dismiss. The district court also did not abuse its discretion in denying Bot M8 leave to amend its first amended complaint to address new evidence obtained from reverse engineering the PlayStation 4. Bot M8 argued that it did not engage in reverse engineering earlier due to concerns over certain anti-hacking statutes. The Court determined that, because Bot M8 failed to diligently raise any issues with respect to the legality of reverse engineering Sony's product, Bot M8 did not have "good cause" to amend under Rule 16 of the Federal Rules of Civil Procedure.

C.R. Bard Inc. v. AngioDynamics, Inc.
979 F.3d 1372 (Fed. Cir. 2020)

C.R. Bard sued competitor AngioDynamics, Inc. for infringement of its '417, '460, and '478 patents, which relate to strategies for identifying a vascular access port as suitable for

power injection and methods for performing a power injection procedure that include identifying a suitable vascular access port. During the jury trial, the district court granted AngioDynamics's motion for judgment as a matter of law and motion for summary judgment on the grounds that Bard's claims were invalid as anticipated, not patent eligible under Section 101, not infringed, and not willfully infringed. Bard appealed.

The Federal Circuit reversed in part the district court's ineligibility ruling, vacated in part the district court's holding of anticipation, vacated the holding of noninfringement and no willful infringement, and remanded the case for further proceedings.

With respect to eligibility, the Federal Circuit, as a matter of first impression, considered whether "a patent claim as a whole can be deemed patent ineligible on the grounds that it is directed to printed matter at step one and contains no additional inventive concept at step two," holding generally that a claim may be found patent ineligible under Section 101 on the grounds that it is directed only to non-functional printed matter and the claim contains no additional inventive concept. Here, the Federal Circuit found the claims contained printed matter not functionally related to the remaining elements of the claims and held that each claim was patent eligible because none were solely directed to the printed matter.

Regarding infringement, the Federal Circuit held the district court erred in granting judgment as a matter of law in favor of AngioDynamics, finding that while a mistake by Bard's expert with respect to claim construction might undermine his credibility, it does not make his testimony legally insufficient to support an infringement verdict. Further, the Court found that Bard was not required to rely on direct testing where AngioDynamics provided statements about the capabilities of its own products and substantial circumstantial evidence existed for a jury to find infringement as to the method claims of the '478 patent. The Federal Circuit further held the district court erred in granting judgment as a matter of law of no willful infringement, holding that the existence of an invalidity claim was not dispositive in determining willfulness, which is a question for the jury.

Finally, the Federal Circuit held that the district court erred to the extent it granted summary judgment of invalidity based on anticipation under Section 102, as a genuine dispute of material fact existed as to the novelty of the asserted claims.

Canfield Sci., Inc. v. Melanoscan, LLC
987 F.3d 1375 (Fed. Cir. 2021)

Canfield Scientific, Inc. petitioned the PTAB for *inter partes* review of the '748 patent owned by Melanoscan, asserting the '748 patent was unpatentable as obvious. The '748 patent "relates to the detection, diagnosis, and treatment of skin cancer as well as other diseases and cosmetic conditions of the visible human." It claims an apparatus described as "an enclosure fitted with cameras and lights arranged in a manner that 'allows for the imaging of total or subtotal non-occluded body surfaces in order to detect health and cosmetic conditions and involves the measurement and analysis of an optically depicted image of a patient's surfaces.'"

Canfield cited five prior art references in its petition. The PTAB found that these references, whether analyzed individually or combined with each other, failed to show that the two independent claims of the '748 patent—claims 1 and 51—were obvious. In particular, the PTAB found that a POSITA would not have been motivated to combine Voight—"an enclosure containing cameras and lights, for analyzing and measuring images on the skin of a patient"—with any of Hurley, Crampton, or Daanen, each a multi-camera system placing the subject in the center of the apparatus, used for imaging a person's surface. The PTAB held in favor of Melanoscan, finding that claims 1 and 51 are patentable, and therefore did not decide the separate patentability of the dependent claims.

Canfield appealed the PTAB's decision to the Federal Circuit, which reversed the PTAB's decision with respect to claims 1 and 51, and vacated and remanded the PTAB's decision with respect to the dependent claims. The Federal Circuit agreed with Canfield's argument that "it would have been obvious to use known or obvious multiple imaging systems in known or obvious enclosures having the object being imaged at the center of the enclosure." The Court ultimately held that "[c]laims 1 and 51 place the subject within the enclosure, as in the prior art, and place multiple cameras and lights within the enclosure, as in the prior art," and that therefore, the teachings of claims 1 and 51 would have been obvious to a POSITA.

Cap Export, LLC v. Zinus, Inc.

996 F.3d 1332 (Fed. Cir. 2021)

The Federal Circuit Court affirmed the district court's holding that Zinus's president and expert witness misrepresented his knowledge of highly material prior art. The Court affirmed the district court's decision to grant Cap Export's motion to vacate the prior judgement under Rule 60(b)(3).

The district court established that Zinus's patent was valid as a matter of law because none of the prior art references considered by the court either anticipated or made obvious the patent claims in the '123 patent. The court relied on the expert testimony of Colin Lawrie, Zinus's president, to make its determination. Thereafter, Cap discovered evidence that Lawrie's testimony had been false as to the prior art because Zinus purchased beds with all of the components of its patented beds before the '123 patent was issued.

The district court found that Lawrie's testimony was an affirmative misrepresentation and met Rule 60(b)(3)'s standard requiring that the misrepresentation prevented the losing party from fully and fairly presenting the defense. The district court rejected Zinus's defense that Cap did not adequately perform its due diligence during discovery when its lawyers failed to propound standard document production requests that would have allowed it to discover the emails relating to Zinus's purchase of the compact beds. The Federal Circuit agreed that Lawrie misrepresented his knowledge of highly material prior art and that the district court did not abuse its discretion in granting the motion to vacate the judgement under Rule 60(b)(3).

Chandler v. Phoenix Services, LLC
1 F.4th 1013 (Fed. Cir. 2021)

In this appeal, appellants asserted antitrust claims based on defendants' alleged listing of the '993 patent on their website, even though the '993 patent had been held unenforceable due to inequitable conduct in a prior Federal Circuit decision. The Court transferred the case to the Fifth Circuit, finding that the Court lacked jurisdiction because the case does not arise under the patent laws of the United States.

Plaintiffs filed suit against defendants in the Northern District of Texas under Section 2 of the Sherman Act. The antitrust suit was a *Walker Process* monopoly claim, in which the plaintiff must prove "(1) that 'the antitrust-defendant obtained the patent by knowing and willful fraud on the patent office and maintained and enforced that patent with knowledge of the fraudulent procurement,' and (2) that the plaintiff can satisfy 'all other elements necessary to establish a Sherman Act monopolization claim.'" Defendants acquired the '993 patent, and as did the prior owner of the patent, enforced the '993 patent in various forums. However, in an unrelated suit, the Federal Circuit held that the '993 patent was unenforceable on the basis of a knowing failure to disclose prior public uses. Plaintiffs contended that the listing of the unenforceable patent satisfied the first prong of the *Walker Process* test.

The Court explained that while *Walker Process* antitrust claims may relate to patents generally per the statutory language of 28 U.S.C. § 1295(a)(1), its jurisdiction is limited to cases in which federal patent law creates the cause of action. Thus, it lacked subject matter jurisdiction over plaintiff's claims because (1) they arose from the Sherman Act rather than from patent law, and (2) they do not depend on a resolution of a substantial question of patent law. The Court noted a similar recent decision, *Xitronix I*, in which the plaintiff claimed that enforcement of a purportedly fraudulent (but live) patent constituted a violation of the Sherman Act. There, the Court also found that it lacked subject matter jurisdiction because "a *Walker Process* claim does not inherently present a substantial issue of patent law." Further, because the '993 patent has been determined to be unenforceable, the Fifth Circuit would have "little or no need to delve into patent law issue." Based on this reasoning, the Federal Circuit transferred the case to the Fifth Circuit.

Chemours Co. FC, LLC v. Daikin Indus., Ltd.
4 F.4th 1370 (Fed. Cir. 2021)

On appeal, the Federal Circuit reversed an IPR final written decision finding a patent relating to a polymer with a high melt flow rate for insulating wires was obvious in view of a prior art patent that disclosed a lower melt flow rate and a narrow molecular weight distribution. The Court found that, absent another reference, the primary reference would not have motivated a person of skill in the art to increase the polymer melt flow rate to the claimed range because the reference cautioned that doing so could broaden the molecular weight distribution and decrease performance. Judge Dyk concurred in part but dissented to this conclusion; he would have affirmed that the reference did not teach away from the

claimed invention where it disclosed an inferior but feasible alternative that was closer to the claim limitation.

The Court also disagreed with the PTAB's conclusions about objective indicia of nonobviousness, stating that disclosure of individual limitations in separate references, where the invention combined multiple properties, does not negate a nexus between the invention and alleged commercial success, and that market share data is not required to establish commercial success, as sales figures alone could be sufficient. The Court also found that the PTAB erred by misapplying the "blocking patents" doctrine to the challenged patents themselves.

Chevron U.S.A. Inc. v. Univ. of Wyo. Rsch.
978 F.3d 1361 (Fed. Cir. 2020)

In an appeal arising out of a patent interference case, the Federal Circuit held the PTAB did not err in its construction of the limitation "gradually and continuously changing the alkane mobile phase solvent to a final mobile phase solvent," and affirmed the PTAB's judgment in favor of the University of Wyoming Research Corporation.

At issue was "[a] method for determining asphaltene stability in a hydrocarbon-containing material having solvated asphaltenes therein," in which substances would be dissolved and measured in a column to learn information about impurities in oil. On appeal, Chevron argued that the PTAB erred in construing "gradually and continuously changing" as referring to the change of solvents in the column as opposed to the inlet of the column where the alkane mobile phase solvent was fed. The Federal Circuit agreed with the PTAB that the broadest reasonable construction of the limitation at issue did not require a changing of the solvents at the inlet to the column based on the proper construction of "gradually" and "continuously." Additionally, the Court held that the PTAB did not improperly consider extrinsic evidence; while it referred to an expert's testimony, it did so only to confirm its understanding of the fluid dynamics in the column based on intrinsic evidence. Because the PTAB's construction was consistent with the patent's specification, the appeals court affirmed the judgment in the interference in favor of Wyoming.

Christy, Inc. v. United States
971 F.3d 1332 (Fed. Cir. 2020)

Christy obtained the '640 patent for its ambient air back-flushed filter vacuum in 2006. In order to maintain the patent, Christy paid the following fees: a $1,000 issuance fee and $490 three-and-a-half-year, $1,800 seven-and-a-half-year, and $3,700 11.5-year maintenance fees. In 2014, Christy initiated an action for patent infringement against competitors. One of Christy's competitors filed a petition for IPR of the '640 patent. The PTAB reached a decision of invalidity, and Federal Circuit affirmed and dismissed the appeal of the PTAB's decision. In response, Christy filed a class-action suit in the Court of Federal Claims, seeking compensation from the government, alleging a Fifth Amendment takings claim, four claims on contractual theories, and in the alternative, an illegal exaction claim. The government moved to dismiss all claims, and the Federal

Claims Court granted the government's motion with various grounds for dismissing each count. Christy then appealed.

On appeal, Christy argued that the Court of Federal Claims erred by "(1) finding that Christy failed to state a compensable takings claim based on the cancellation of claims 1–18 of the '640 patent; (2) finding that the court lacked subject matter jurisdiction over Christy's illegal ex-action claim; and (3) finding that Christy failed to state a plausible illegal exaction claim." The government in turn argued that the court lacked jurisdiction over the takings claim. Relying on *Golden v. United States*, 955 F.3d 981 (Fed. Cir. 2020), the Federal Circuit disposed of the government's argument that the Court of Federal Claims lacked jurisdiction and Christy's failure to state a claim appeal. Additionally, the Court reiterated that under *Golden*, a cancellation of a patent in an IPR cannot constitute a taking under the Fifth Amendment. Lastly, the Court turned to the failure to state a plausible claim of illegal exaction. The Court held that Christy's arguments failed because the law requires payment of fees without regard to any later post-issuances proceedings, and Christy fails to identify any other statute or law providing for compensation. Consequently, the Court affirmed the dismissal.

Chudik v. Hirshfeld

987 F.3d 1033 (Fed. Cir. 2021)

In an appeal concerning a patent term adjustment, the Federal Circuit held that a patentee may obtain "C-delay" only when a reviewing court or the PTAB reverses an unpatentability ruling. A PTO examiner's reopening of prosecution that leads to a patent award does not qualify for a term adjustment under the C-delay provision.

The case required the Court to interpret the American Inventors Protection Act of 1999. The section at issue gives patent owners three grounds on which they can seek longer patent terms to account for time lost in PTO proceedings. Patentees may seek adjustments (1) when the PTO fails to meet certain deadlines (A-delay), (2) for each day an application remains pending beyond three years (B-delay), and (3) for delays due to "derivation proceedings, secrecy orders, and appeals." 35 U.S.C. § 154(b)(1)(A)-(C). C-delay includes appellate review by the PTAB or a federal court "in a case in which the patent was issued under a decision in the review reversing an adverse determination of patentability." 35 U.S.C. § 154(b)(1)(C)(iii).

The Court interpreted the C-delay provision to require that a patent issue under a decision, by either the PTAB or a reviewing court, that reverses an unpatentability ruling. Dr. Chudik patented a method for shoulder surgery after a decade of rejections, claim modifications, reopened examinations, and four notices of appeal; he unsuccessfully argued he was entitled to a 655-day extension of his patent term for the time his notices of appeal were pending in the PTAB. Because his patent was issued after an examiner reopened prosecution, rather than after an appellate tribunal's reversal, the time at issue did not count toward a term adjustment. The Court found he was also ineligible for greater B-delay adjustments due to a statutory exclusion for "time consumed by continued examination of the application requested by the applicant." 35 U.S.C. § 154(b)(1)(B)(i).

Thus, applicants who immediately appeal to the PTAB may preserve greater time for a term adjustment than those who request a continued examination.

cxLoyalty, Inc. v. Maritz Holdings Inc.
986 F.3d 1367 (Fed. Cir. 2021)

The Federal Circuit ruled that a method for customers to purchase items from third-party vendors using loyalty rewards points was patent ineligible. The '087 patent held by Maritz Holdings outlined a computerized system in which a loyalty program participant could use points to buy products from vendors, with the actual dollar value of the transaction hidden from the customer. The PTAB determined the original claims were ineligible for patenting under 35 U.S.C. § 101 but found Maritz's proposed substitute claims were patent eligible because they contained an "inventive concept." cxLoyalty appealed the decision as to the substitute claims, and Maritz cross-appealed. The Court ruled for cxLoyalty on both issues.

Applying *Alice*'s two-step inquiry, the Court concluded that Maritz's claims were directed to an abstract idea and implemented the abstract idea using "well-understood, routine, and conventional" techniques. Even if some of the claims involved a "novel subject matter," that alone does not render a claim patent eligible, the Court explained. The claims were not "a technological solution to a technological problem" because they merely recited basic computer components and described long-standing commercial practices at a high level of generality.

In a footnote, the Court stressed it was not bound by PTO guidelines regarding patent eligibility. The Court noted the PTAB below repeatedly referred to the PTO's 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50. But the Court, quoting *In re Rudy*, 956 F.3d 1379, 1382 (Fed. Cir. 2020), reaffirmed that the agency's guidance "is not, itself, the law of patent eligibility, does not carry the force of law, and is not binding on our patent eligibility analysis." And when the PTO's guidance conflicts with the Court's case law, as *Rudy* held, "it is our caselaw, and the Supreme Court precedent it is based upon, that must control."

DePuy Synthes Prods., Inc. v. Veterinary Orthopedic Implants, Inc.
990 F.3d 1364 (Fed. Cir. 2021)

In a case involving a district court order to unseal an amended complaint containing alleged trade secrets, the Federal Circuit found that it had jurisdiction to hear an interlocutory appeal under the collateral order doctrine. On the merits, the Court found that the district court did not abuse its discretion in ordering the amended complaint unsealed.

The dispute arose from a patent infringement suit between the owner of the '921 patent, DePuy Synthes Products, Inc. and DePuy Synthes Sales, Inc. (collectively "DePuy"), and defendant Veterinary Orthopedic Implants, Inc. ("VOI"). VOI appealed a district court order unsealing DePuy's amended complaint, which VOI argued contained VOI's trade secrets designated highly confidential under the protective order.

The Federal Circuit found that it had jurisdiction to hear the interlocutory appeal under the collateral order doctrine, which "is a narrow exception to the usual rule of finality" for appeals. The Court found that unsealing the amended complaint "satisfies all three conditions" of the doctrine because (1) the information should be on the public docket, (2) the sealing is unrelated to the merits of the infringement claim, and (3) the "order could not be meaningfully reviewed after a final judgment because the information in the amended complaint, once disclosed to the public, could not be made confidential again."

After finding it had jurisdiction, the Federal Circuit concluded that the district court did not abuse its discretion in ordering the amended complaint unsealed. Although there was a protective order in place, the Court held that "the presumption of public access applies" to the amended complaint and rejected VOI's argument that the information it sought to keep sealed constituted a trade secret. The Court further noted that the district court "was required to make its own independent decision by weighing the parties' interests in confidentiality against the public right of access."

Donner Tech., LLC v. Pro Stage Gear, LLC
979 F.3d 1353 (Fed. Cir. 2020)

Donner Technology appealed an IPR decision holding that Pro Stage Gear's '023 patent for a guitar effects pedalboard was not unpatentable as obvious. Donner's petition set forth three grounds of unpatentability and, among others, cited a prior art reference relating to electrical relays. The PTAB rejected these challenges on the ground that Donner failed to prove the prior art reference was analogous art.

The Federal Circuit vacated and remanded the case to the PTAB. The Federal Circuit applied two tests to determine the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether it is reasonably pertinent to the particular problem with which the inventor is involved. Further, to determine whether a reference is analogous art with respect to a claimed invention under the second "reasonably pertinent" test, "the problems to which both relate must be identified and compared."

The Federal Circuit focused its analysis on the second test, as it was undisputed that the '023 patent and prior art reference were from different fields of endeavor. First, the Court held that the PTAB failed to consider all arguments and evidence under the "reasonably pertinent" test, as it was unclear the PTAB meaningfully reviewed the expert testimony and evidence Donner submitted. Second, the Court held that the PTAB failed to properly identify and compare the purposes and problems to which the '023 patent and prior art reference related through the lens of a POSITA. In one instance, the PTAB misstated the purpose of the '023 patent. Further, the PTAB's characterization of the problem "effectively collapse[d]" the "field of endeavor" and "reasonably pertinent" tests. As such, the Federal Circuit held that the PTAB applied the wrong standard when assessing whether the prior art reference was analogous art and vacated and remanded the case to the PTAB.

Edgewell Pers. Care Brands, LLC v. Munchkin, Inc.
989 F.3d 1358 (Fed. Cir. 2021)

Edgewell appealed the district court's summary judgment of noninfringement for both the '420 and '029 patents, which were related to improving the cassette design of a diaper pail system called the "Diaper Genie." The Federal Circuit remanded because the district court erred in its claim construction of the '420 patent and incorrectly granted summary judgment on noninfringement for the '029 patent.

For the '420 patent, the Federal Circuit first found that the construction of "clearance" was subject to the Court's review. Munchkin, the opponent in this action, claimed that the Court could not review the summary judgment claim construction because it was the same as the district court's original construction. However, the Federal Circuit held that they can review "clearance" because the district court added limitations not present in the original construction.

The Federal Circuit then vacated and remanded the district court's holding of noninfringement and its construction of "clearance" for the '420 patent. The district court's construction required a clearance after insertion. However, the Federal Circuit held that the district court's construction contradicted the specification, since the cassette had a clearance that supported proper insertion regardless of whether there was space after insertion. Thus the district court erred in its construction of the term "clearance." As a result, the Federal Circuit vacated and remanded the district court's finding of summary judgment of noninfringement of the '420 patent.

With respect to the '029 patent, the Federal Circuit rejected Edgewell's argument that the district court incorrectly construed the contested terms, holding that the plain language of the claims supports the lower court's construction. However, the Court agreed that the district court erred in its judgment that application of the doctrine of equivalents would result in vitiation. The district court's analysis improperly focused on "a binary choice": whether the Munchkin apparatus possessed a single-component structure like Edgewell's, or a multi-component structure. But, Federal Circuit precedent cautions that courts should not "shortcut [the] inquiry by identifying a 'binary' choice in which an element is either present or 'not present.'" *Deere & Co. v. Bush Hog, LLC*, 703 F.3d 1349, 1356-57 (Fed. Cir. 2012). Instead, under the doctrine of equivalents, the district court should have conducted a broader "function-way-result" analysis, analyzing whether a reasonable juror could have seen the Munchkin product as performing substantially the same function as the Edgewell product, in substantially the same way, and achieving substantially the same result. The Court found that expert and lay witness testimony in this case under the function-way-result test created a "genuine issue of material fact for the jury to resolve," therefore precluding summary judgment under the doctrine of equivalents. As such, the Court reversed the district court's judgment of noninfringement of the '029 patent and remanded the case.

Egenera, Inc. v. Cisco Sys., Inc.
972 F.3d 1367 (Fed. Cir. 2020)

Egenera sued Cisco in the District of Massachusetts, alleging that Cisco's enterprise server systems infringe various claims of Egenera's '430 patent. The '430 patent claims a platform for automatically deploying a scalable and reconfigurable virtual network. Prior to the district court's claim construction and alongside Cisco's IPR petition, Egenera separately petitioned the PTO to remove one of the listed inventors from the '430 patent likely in an effort to "swear behind" a prior art reference asserted against Egenera in the IPR. Following claim construction and a trial on inventorship, Egenera asked the district court to add the removed inventor back to the patent. The district court determined that Egenera could not re-list the inventor due to judicial estoppel, and thus held the '430 patent was invalid for failing to name all inventors. Egenera appealed, challenging the district court's claim construction of "logic to modify" and application of judicial estoppel. The Federal Circuit affirmed in part and vacated in part.

The Federal Circuit agreed with the district court's claim construction finding "logic" to be "a generic substitute for 'means' in the logic to modify" limitation. The Court held Egenera failed to explain in its claims and specifications how its logic amounts to sufficient structure for performing the modification function under 35 U.S.C. § 112(f), and that mere inclusion of a limitation within a structure fails to establish that the limitation recites sufficient structure.

Egenera also contended that the district court had incorrectly applied judicial estoppel and prevented Egenera from correcting inventorship. The Federal Circuit cited precedent and statutory law under 35 U.S.C. § 265(b) recognizing that patents cannot be invalidated if inventors omitted in error can be corrected instead. The Court found Egenera's omission of the inventor was an "error" because its inventorship petition to the PTO was filed before the district court's claim construction opinion, and it was the claim construction opinion that "illuminated the omitted inventor's necessary presence as an inventor." Applying First Circuit law, the Federal Circuit also found the criteria for judicial estoppel had not been met. The Federal Circuit thus affirmed the district court's claim construction, but vacated the invalidity judgment based on judicial estoppel and remanded for further proceedings.

Facebook, Inc. v. Windy City Innovations, LLC
973 F.3d 1321 (Fed. Cir. 2020)

Windy City Innovations filed a complaint in the Western District of North Carolina against Facebook for infringement of its '245, '657, '552, and '356 patents. The '245 patent claims relate to the ability to handle "out-of-band" information, and the '657, '552, and '356 patents generally relate to censorship features. After the case was transferred to the Northern District of California, the case schedule required Windy City to identify its asserted claims after the expiration of the one-year time bar under 35 U.S.C. § 315(b). Facebook timely filed several IPR petitions on several claims of each patent, which the PTAB instituted. Pursuant to the case schedule, Windy City identified its asserted claims in the district court case and identified claims that Facebook had not challenged in its IPR

petitions. Thus, Facebook filed additional IPR petitions along with motions for joinder to the already-instituted IPRs.

The PTAB instituted and terminated Facebook's two new IPRs and granted the motion for joinder. It held Facebook showed by a preponderance of evidence some challenged claims as unpatentable as obvious, and failed to show this was the case for others. Notably, many of the unpatentable claims were challenged by Facebook in the late-filed petitions. Facebook appealed and Windy City cross-appealed, challenging the PTAB's joinder decisions allowing Facebook to join its new IPRs to existing IPRs and to include new claims in the joined proceedings. The Federal Circuit affirmed in part, vacated in part, dismissed in part, and remanded in part.

The Federal Circuit held the PTAB erred in allowing Facebook to join itself to a proceeding in which it was already a party and to add new claims to the IPRs through that joinder. The Court agreed with Windy City that the joinder decision is a separate and subsequent decision to whether an IPR petition warrants institution. The Court held the "clear and unambiguous text" of 35 U.S.C. § 315(c) does not authorize same-party joinder nor joinder of new issues. The Court thus found the PTAB exceeded its statutory authority under Section 315(c). The Court also noted that petitioners "faced with an enormous number of asserted claims on the eve of the IPR filing deadline [] are not without options," including filing petitions challenging hundreds of claims or challenging those claims in the district court proceedings.

The Court also found substantial evidence supporting the PTAB's obviousness determinations for Facebook's timely filed claims and affirmed. As the Court found the joinder was improper in allowing Facebook to add time-barred issues to its IPRs, it vacated the PTAB's final written decisions with respect to claims improperly added through joinder. The Court also dismissed Facebook's appeal to some claims in the '356 patent, which it found moot after Windy City voluntarily dismissed its appeal.

FastShip, LLC v. United States
968 F.3d 1335 (Fed. Cir. 2020)

The Federal Circuit vacated and remanded the Claims Court's decision to award attorneys' fees and expenses to FastShip.

FastShip, a designer of littoral combat ships (LCS), filed an administrative claim against the Navy, claiming that the Navy's LCS program infringed upon two of its patents. Following a 10-day trial, the Claims Court determined the claims were valid and infringed, which the Federal Circuit affirmed. FastShip then filed a motion for attorneys' fees and expenses pursuant to 28 U.S.C. § 1498(a). The Claims Court awarded $6,178,288.29 in attorneys' fees and related expenses to FastShip, finding that the government's pre-litigation conduct and positions taken during the litigation were not substantially justified. The government appealed.

On appeal, the Federal Circuit vacated the fee award and remanded. The Court agreed with the government's argument that the Claims Court erred in relying on the government's pre-litigation conduct. The Court held that it was error to "consider the government's actions during the procurement process and during the administrative proceeding." On remand, the Claims Court must consider whether the government's litigation conduct alone was sufficient to justify a fee award.

The Federal Circuit then rejected the government's claims that the Claims Court erred in considering the government's litigation conduct in two respects. First, the Court held no clear error in the Claims Court's factual findings regarding the reading of Figure 11 as using metric units and the government's expert's use of imperial units as wrong, concluding that the government's position was not substantially justified. Second, the Court determined it was not unreasonable for the government to proffer its expert, Mr. Blount, and his "feasibility analysis." The Court agreed that the Claims Court erred in finding this reliance was not substantially justified and remanded for further consideration by the Claims Court.

Ferring B.V. v. Allergan, Inc.
980 F.3d 841 (Fed. Cir. 2020)

Ferring appealed the district court's grant of summary judgment on Allergan's equitable estoppel defense to claims for correction of inventorship. During his six years of employment at Ferring, a consultant helped develop a synthetic hormone to regulate the body's retention of water. Ferring eventually filed a PCT application listing this consultant as an inventor, but the consultant asserted that he had no obligation to assign any inventions to Ferring. Both the consultant and Ferring filed subsequent patent applications, which were eventually granted. The consultant assigned his intellectual property rights to Allergan. Ferring brought suit in the Southern District of New York, asserting New York state law claims and claims for correction of inventorship on the grounds that Ferring scientists should be named the sole inventors or co-inventors on the consultant's patents. Allergan counterclaimed, alleging the consultant should be named the sole or joint inventor on Ferring's patents. The district court granted Allergan's motion for summary judgment, holding that Ferring's seven-year delay in filing the lawsuit satisfied the misleading conduct, reliance, and prejudice prongs of equitable estoppel. The district court dismissed the counterclaims, refusing to add the consultant as an inventor on Ferring's patents.

The Federal Circuit vacated and remanded the district court's grant of summary judgment. First, the Court reaffirmed its holding in *MCV, Inc. v. King-Seeley Thermos Co.*, 870 F.2d 1568, 1572 (Fed. Cir. 1989), that a court "may consider pre-issuance conduct in assessing the application of equitable estoppel" to correction of inventorship claims. Second, the Court rejected Ferring's bright-line rule that equitable estoppel cannot apply when the scope of the issued patent differs from what the parties discussed in communications prior to the allegedly misleading conduct. However, the Court determined that the district court erred in concluding that Ferring engaged in misleading conduct because the evidence supported other inferences and because the district court failed to consider all relevant

evidence and facts regarding the equities of the parties. Thus, the Court vacated and remanded the district court's judgment.

Free Stream Media Corp. v. Alphonso Inc.
996 F.3d 1355 (Fed. Cir. 2021)

The Federal Circuit Court reversed the district court's denial of Alphonso Inc.'s motion to dismiss claims of the '356 patent because it found that the claims were directed to the abstract idea of targeted advertising, a patent-ineligible subject matter. The Court affirmed the district court's construction, finding that a POSITA would have understood the "communication session" as requiring bidirectional communication.

Gen. Elec. Co. v. Raytheon Techs. Corp.
983 F.3d 1334 (Fed. Cir. 2020)

This case arose when General Electric (GE) filed a petition for IPR of a patent issued to Raytheon before Raytheon had sued or threatened to sue GE. Raytheon's patent was directed to a two-stage high-pressure turbine engine for commercial airplanes. At the conclusion of the IPR proceedings, the PTAB determined that Raytheon's patent claims were not obvious in light of two prior art references submitted by GE. GE filed a request for rehearing in the PTAB, which was denied. GE then appealed the PTAB's IPR determination to the Federal Circuit.

Raytheon first moved to dismiss GE appeal for lack of standing challenge the PTAB's IPR determination because GE did not currently face a threat of litigation from Raytheon. The Federal Circuit disagreed, finding that GE had demonstrated a sufficient risk of future infringement liability to constitute an injury-in-fact. The Federal Circuit focused on investments GE had already made in developing an allegedly infringing engine design that GE was likely to begin marketing to airplane manufacturers in the near future.

On the merits, the Federal Circuit vacated and remanded the PTAB's determination, finding that the PTAB's determination lacked substantial evidence to support its finding of nonobviousness. The Federal Circuit stressed that the PTAB had viewed potential motivations to combine too narrowly in finding that one reference taught away from the solution proposed in the other, when the first reference did not disclose a "strong preference" for an alternative solution to that presented in the second reference.

GlaxoSmithKline LLC v. Teva Pharms. USA, Inc.
976 F.3d 1347 (Fed. Cir. 2020)

GlaxoSmithKline LLC and SmithKline Beecham (Cork) Ltd. (collectively, "GSK") brought suit against Teva in the District of Delaware for infringement of GSK's '000 patent. The '000 patent is a reissue of GSK's '069 patent, which was a method of treatment with the medicinal product "carvedilol" claimed by GSK in its '067 patent. The '000 patent is a method of decreasing mortality from congestive heart failure which includes administering carvedilol with other therapeutic agents. In 2002, Teva applied for

FDA approval of its generic carvedilol, certifying in the ANDA that its product would not be launched until the ’067 patent expired in March 2007. Teva also certified, and notified GSK, that the ’069 patent was unenforceable, not infringed, or invalid for anticipation or obviousness. FDA tentatively approved for Teva’s generic drug to become effective on expiration of the ’067 patent. In 2003, GSK filed an application to reissue the ’069 patent, resulting in the ’000 patent allegedly infringed in this case. In 2011, Teva complied with FDA requirements to amend its carvedilol label to be “identical in content to the approved [GSK Coreg] labeling.”

Trial was held in the District of Delaware. The jury found the patent valid and willfully infringed, and assessed damages based on lost profits and royalty. The district court then granted Teva’s JMOL motion, stating the verdict of induced infringement by Teva was not supported by substantial evidence. GSK appealed the JMOL, and Teva conditionally cross-appeals the damages verdict. No appeal was taken from the patent validity verdict.

The Federal Circuit found there was substantial evidence to support the verdict of inducement to infringe GSK’s ’000 patent. The Court held the district court applied an incorrect legal standard, noting precedent that “makes clear that when 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.” The Court cited evidence of promotional materials, press releases, product catalogs, the FDA labels, and testimony of witnesses from both sides to support the jury verdict of inducement to infringe.

The jury assessed damages of $234,110,000 based on lost profits, plus royalty payments of $1,400,000. Teva argued that on correct instructions, Teva would have incurred no damages, or at most only a reasonable royalty. The Court concluded that the jury instructions are in conformity to law and sustained the damages verdict.

Godo Kaisha IP Bridge 1 v. TCL Commc’n Tech. Holdings Ltd.
967 F.3d 1380 (Fed. Cir. 2020)

Godo Kaisha IP Bridge 1 (“IP Bridge”) brought this action against TCL Communication Technology Holdings Limited, TCT Mobile Limited, TCT Mobile (US) Inc., and TCT Mobile, Inc. (collectively, “TCL”) for infringement of two patents. IP Bridge argued that the patents-in-suit are essential to the Long-Term Evolution (“LTE”) standard and that the accused products comply with the LTE standard. The jury found TCL liable for infringement. TCL appealed arguing that whether a patent is standards essential is a question of law that should have been resolved in the context of claim construction and should not have gone to the jury.

The Federal Circuit affirmed the jury verdict, disagreeing with TCL, and held that whether a patent is essential to any standard established by a standard setting organization is a question of fact to be resolved by the trier of fact. The Federal Circuit determined that essentiality was a question of fact about whether the claim elements read onto mandatory portions of the standard that standard-compliant devices must incorporate, which is more akin to an infringement analysis than to a claim construction analysis.

Hyatt v. Hirshfeld

998 F.3d 1347 (Fed. Cir. 2021)

In this appeal, the PTO appealed a judgment of the District Court of the District of Columbia that the PTO failed to carry its burden of proving prosecution laches. Applicant Hyatt filed multiple patent applications directed to "various computer technologies." These applications were part of the "GATT Bubble" triggered by the June 1995 change in the term of U.S.-issued patents. During prosecution, Hyatt continued to file amendments to the four applications at issue until they contained an average of 300 claims per application. The timing of these amendments meant that Hyatt presented claims for examination that were between 12 and 28 years after their alleged priority dates. From 2003 to 2012, the examination was stayed pending litigation. After resuming examination, the PTO noted the many challenges to processing Hyatt's long and complex applications claiming priority to multiple other applications, including the difficulty of reasonably ascertaining the priority dates and compliance with Section 112. The PTO ultimately rejected the four applications at issue, and the decision was in large part affirmed by the PTAB.

Hyatt challenged the PTO's decision at the district court, seeking issuance of the four patents under 35 U.S.C. § 145. The PTO filed motions to dismiss based on prosecution laches, arguing that Hyatt engaged in a "pattern of delay in prosecuting his nearly 400 patent applications from 1969 through the present day." The district court rejected this argument and concluded that prosecution laches did not apply because the PTO itself "had failed to take actions necessary to advance the prosecution of Hyatt's applications," pointing to the PTO's refusal to tailor its procedures in a "specific and formal" manner to Hyatt's voluminous applications other than "informal" meetings between Hyatt and the PTO. The district court also found that neither of Hyatt's "claim shifting" nor "re-introduc[tion]" of claims warranted a finding of prosecution laches. The PTO appealed.

Addressing the district court's finding, the Federal Circuit reiterated the two elements required for proving prosecution laches: namely, (1) that the patentee's delay in prosecution was unreasonable and inexcusable under the totality of circumstances, and (2) that the accused infringer suffered prejudice attributable to the delay.

As a preliminary matter, the Court held that the PTO can assert prosecution laches in a Section 145 action because (1) the PTO has the authority to deny applications based on the same and thus has the right to defend its rejection on appeal, and (2) the statutory language of Section 282 demonstrates Congressional intent to make the laches defense "broadly available." The Court added that the PTO can assert the prosecution laches defense even if it did not previously raise prosecution laches during the prosecution, though its failure to put the applicant on notice may inform the "totality of the circumstances" determination of prosecution laches.

The Court then vacated and remanded the district court decision because it misapplied the legal standard for prosecution laches. First, the Court stated the district court failed to properly consider the totality of the circumstances. Specifically, the Court found the

district court disproportionately focused on the PTO's role in the prosecution and "discounted and ignored" evidence suggesting Hyatt's own contributions to the delay. The Court found that the PTO's failure to accommodate Hyatt's "extreme prosecution conduct" does not negate prosecution laches, and that the "magnitude of Hyatt's delay in presenting his claims" was enough to invoke prosecution laches.

Next, the Court held that in a Section 145 action, "unreasonable and unexplained prosecution delay of six years or more" triggers a presumption of prejudice. Upon demonstrating the unreasonable and unexplained delay by Hyatt, according to the Court, the burden to prove lack of prejudice now shifts to Hyatt, the applicant. The Court further held that, where an applicant's conduct amounts to "clear abuse" of the patent examination system, such as Hyatt's conduct which "unduly increases the administrative burden" of prosecution, that abuse meets the prejudice element of prosecution laches. The Court determined that the PTO's evidence shifted the burden to Hyatt to show a "legitimate, affirmative reason for his delay," vacating the district court's judgment and remanding the case for an opportunity for Hyatt to do so by preponderance of evidence.

Illumina, Inc. v. Ariosa Diagnostics, Inc.
967 F.3d 1319 (Fed. Cir. 2020)

Illumina filed suit against Ariosa Diagnostics, Inc., Roche Sequencing Solutions, Inc., and Roche Molecular Systems, Inc. (collectively, "Roche") alleging infringement of the '751 and '931 patents. The U.S. District Court for the Northern District of California held that several claims of the '751 and '931 patents are directed to patent-ineligible subject matter under 35 U.S.C § 101. Illumina appealed.

The majority reversed, concluding that under *Alice*/*Mayo* step one the claims were not directed to the natural phenomenon that "cell-free fetal DNA tends to be shorter than cell-free material DNA in a mother's bloodstream," but rather to a patent-eligible method that utilizes that discovery. The patents at issue stem from a discovery that cell-free fetal DNA existed in maternal plasma and serum. The method of detecting the small fraction of cell-free fetal DNA was claimed in a patent at issue in *Ariosa.* In that case, the Federal Circuit determined the method was patent ineligible because it was directed to naturally occurring matter.

Here, the patents at issue were directed to "methods of preparing a fraction of cell-free DNA that is enriched in fetal DNA." The majority pointed to specific process steps such as size discriminating and selectively removing DNA fragments above a certain size threshold and the physical process steps that change the composition of the mixture that resulted in a DNA fraction different from the naturally occurring fraction in the mother's blood. These concrete processes were used not merely to observe the presence of the natural phenomenon, but rather to exploit that discovery in a "method for preparation of a mixture enriched in fetal DNA."

The majority determined that these claims differed from the invalid diagnostic claims at issue in *Mayo*, *Athena*, and *Cleveland Clinic*, which were directed to detecting a natural

phenomenon. The majority also determined that these claims differed from *Myraid*, which held ineligible a patent directed to naturally occurring DNA segments that had been isolated. Because the majority concluded the claims were not directed to a patent-ineligible concept in step one, it did not reach step two.

Judge Reyna dissented, concluding that the patents at issue were directed to a natural phenomenon, and that the sole claimed advancement is the discovery of the natural phenomenon, which utilized routine and conventional steps that were well known in the art.

Immunex Corp. v. Sanofi-Aventis U.S. LLC
977 F.3d 1212 (Fed. Cir. 2020)

On appeal, the Federal Circuit affirmed the PTAB's IPR judgment holding Immunex's '487 patent invalid due to obviousness. The '487 patent claimed a *human antibody* that binds with certain receptors to treat a number of inflammatory disorders. Sanofi challenged the patent and the PTAB concluded the '487 patent was unpatentable as obvious over two references. The first reference described a commercially available antibody that met all the limitations of the claim at issue; however, it was fully murine, not human. But the second reference explained how to humanize murine antibodies by grafting them with fully human antibodies. As such, the PTAB construed "human antibody" to include "humanized antibody," so the '487 patent was unpatentable as obvious. Immunex appealed, challenging the PTAB's construction of human antibody as including humanized antibody.

After holding that the broadest reasonable interpretation standard was the applicable claim construction standard, the Court rejected Immunex's argument that "humanized antibody" is not "human antibody." The Court began by reviewing the language of the claim itself, noting that nothing restricted the term "human antibodies" to only those that are fully human, in contrast with other patentees that expressly defined human antibody. Emphasizing the specification as "the single best guide to the meaning of a disputed term," the Court noted that it "ma[de] clear that 'human antibodies' is a broad category encompassing both partially and completely human antibodies." Similarly, the Court found that the prosecution history supported the PTAB's construction. The Court also rejected Immunex's argument that the PTAB failed to adequately consult extrinsic evidence to determine whether "human antibody" had an established meaning to a POSITA. The Court noted that while it is appropriate to determine the meaning of claim terms from the perspective of a POSITA, that determination must be made in light of the specification. Here, because the intrinsic evidence was clear on the issue, Immunex's reading of the extrinsic evidence squarely conflicted with it, so "the intrinsic record trumps." Finally, the Court explained that the PTAB's departure from the original district court's claim construction without significant discussion was not an issue because the PTAB's opinion "was sufficiently detailed to permit meaningful appellate review." Thus, the Court affirmed the PTAB's invalidity determination.

In re Apple Inc.
979 F.3d 1332 (Fed. Cir. 2020)

Uniloc 2017 LLC brought a patent infringement suit against Apple in the Western District of Texas. Apple moved to transfer the case to the Northern District of California pursuant to Section 1404(a) on grounds of convenience and moved to stay all activity in the case unrelated to its transfer motion pending a decision on the motion. The district court denied the stay motion without providing an explanation. The court then held a hearing on Apple's motion in which the court stated it would deny Apple's motion and issue a written order. However, after the hearing but before issuing the written order, the district court held a *Markman* hearing and issued claim construction and discovery orders. In response, Apple petitioned the Federal Circuit for a writ of mandamus directing the district court to transfer the case to the Northern District of California. A week later, the district court issued the written order denying the transfer. The court granted the writ of mandamus, holding Apple demonstrated that the district court clearly abused its discretion in denying transfer.

First, although Apple failed to raise a number of arguments in its petition, the Federal Circuit declined to apply waiver due to the quick progression of the case and the fact the district court issued its written order after Apple filed its petition. The Federal Circuit then assessed Apple's transfer request according to the private and public interest factors established by Fifth Circuit law. Analyzing these factors, the appeals court concluded the district court misapplied the law to the facts of the case and abused its discretion in concluding the transfer was inappropriate. Thus, the Federal Circuit held that the district court's decision resulted in a "patently erroneous result" and granted Apple's writ of mandamus.

Judge Moore dissented, stating that the majority substituted its judgment for that of the district court, and that the "misapplication of law to fact" errors the majority identified at most supported a motion for reconsideration rather than a grant of mandamus.

In re Bd. of Trs. of Leland Stanford Junior Univ.
991 F.3d 1245 (Fed. Cir. 2021)

The Federal Circuit affirmed a PTAB decision rejecting the '982 application by the Board of Trustees of the Leland Stanford Junior University ("Stanford") as directed to patent ineligible subject matter. The patent application concerned "methods and computing systems for determining haplotype phase," a process for determining from which parent an individual has inherited a gene. In affirming the decision, the Federal Circuit found that the Stanford patent was rightfully rejected under the two-step *Alice* test for determining patent eligibility under 35 U.S.C. § 101.

Under step one of the *Alice* test, the Federal Circuit found that the claims of the '925 application were "abstract ideas" based on mathematical calculations and therefore patent ineligible. At the second step, the Court found "no inventive concept that would warrant treating the use of the claimed algorithms and mathematical calculations as patent eligible subject matter."

In re Bd. of Trs. of Leland Stanford Junior Univ.
989 F.3d 1367 (Fed. Cir. 2021)

The Federal Circuit affirmed a PTAB decision rejecting the claims in the Board of Trustees of the Leland Stanford Junior University's ("Stanford") '925 patent application as patent ineligible subject matter. The '925 application concerned "methods and computing systems for determining haplotype phase," a process for determining from which parent an individual has inherited a gene. In affirming the decision, the Federal Circuit found that the claims in the '925 application were rightfully rejected under the two-step *Alice* test for determining patent eligibility under 35 U.S.C. § 101.

Under step one of the *Alice* test, the Federal Circuit found that the claims of the '925 application were "abstract ideas" and therefore patent ineligible. The Court noted that "[c]ourts have long held that mathematical algorithms for performing calculations, without more, are patent ineligible under § 101." The Federal Circuit rejected Stanford's argument that the patent was not an abstract idea because it advanced a novel application that results in increased data. The Court was also not persuaded that the patent was "not directed to an abstract mathematical calculation."

The Federal Circuit therefore moved to step two of the *Alice* test. The Court noted that the patent was not transformed under this step because "[s]imply storing information and providing it upon request does not alone transform the abstract idea into patent eligible subject matter." The Federal Circuit noted that the steps in the mathematical calculation "are conventional and well understood in the prior art" and highlighted the "generic terms" that the claim uses to describe the patent's hardware limitations. Overall, the Court found the claims in Stanford's patent application "devoid of an inventive concept" that would transform the claims "into a patent eligible application."

In re Google Tech. Holdings LLC
980 F.3d 858 (Fed. Cir. 2020)

Google appealed the PTAB's decision affirming the examiner's rejection of claims 1 and 2 of its '765 application as obvious. The '765 application relates to "distributed caching for video-on-demand systems, and in particular to a method and apparatus for transferring content within such video-on-demand systems." The PTAB affirmed the examiner's rejection of the claims as obvious, holding that Google failed to rebut the collective teachings and suggestions of the applied references, and failed to include any construction of the contested terms.

On appeal, Google argued the PTAB relied on incorrect constructions of certain claim terms and therefore incorrectly upheld the examiner's rejections. In analyzing whether Google was permitted to raise its claim construction arguments for the first time on appeal, the Court discussed the difference between the doctrines of waiver and forfeiture, recognizing that its opinions "had not always been precise" when discussing the two doctrines. Forfeiture is the "failure to make the timely assertion of a right," while waiver is the "intentional relinquishment or abandonment of a known right." The Federal Circuit

found that Google's failure to raise its claim construction arguments before the PTAB was forfeiture. The Court also found Google did not provide any reasonable explanation for its failure to raise its claim construction arguments to the examiner or the PTAB, so there were no "exceptional circumstances" to justify Google raising them for the first time on appeal.

The Federal Circuit emphasized the important role of the PTAB in reviewing the rejection of patent applications, holding that allowing Google to raise these arguments on appeal would "deprive the PTAB, an expert body" of its role in reviewing patent application rejections. The word "review" "presupposes that a litigant's arguments have been raised and considered in the tribunal of first instance"; this principle prevents "sandbagging." Thus, the Federal Circuit affirmed the PTAB's decision based on forfeiture.

In re Nitro Fluids L.L.C.
978 F.3d 1308 (Fed. Cir. 2020)

The Federal Circuit granted Nitro's petition for a writ of mandamus, vacating the district court's order denying Nitro's motion to transfer the action to another district based on the first-to-file rule. Reviewing for an abuse of discretion and accepting the district court's premise that transfer would be proper in the absence of compelling circumstances, the Court focused on the district court's finding that the balance of transfer factors established a compelling circumstance to deny the transfer. The district court's "determination rested on the legal proposition that the first-to-file rule is only applicable when the balance of factors favors the first-filed court." The Court explained that this was legal error because the law requires the opposite: only if the balance of transfer factors favored keeping the case in the *second-filed* court would there be compelling circumstances to justify an exception to the first-to-file rule.

The Court also concluded that the district court erred in its assessment of two transfer factors. The district court found that the court congestion factor weighed against transfer because its standing patent procedures would allow it to decide the case much faster than the first-filed court. The Federal Circuit rejected this reasoning, explaining that speed of resolution does not necessarily equate to a difference in congestion. The Court also rejected the district court's application of the judicial economy factor, explaining that the first-to-file "rule places a premium on the importance of allowing one court to resolve substantially overlapping cases," and the district court erred by substituting that importance with its preference for quick resolution. The Court therefore granted the petition and directed the district court to conduct a proper transfer analysis.

In re Samsung Elecs. Co.
2 F.4th 1371 (Fed. Cir. 2021)

Ikorongo Tech and Ikorongo Texas originally filed suit against Samsung and LG for patent infringement in the Western District of Texas. Samsung Electronics appealed the district court's decision to deny a transfer from the District Court in the Western District of Texas to the Northern District of California. Under an abuse of discretion standard, the Federal

Circuit granted the writs of mandamus and thus moved the action to the Northern District of California.

The Federal Circuit first held that the district court was correct in referring to the amended complaints to determine proper venue; however, district court erred in finding that venue was proper in the Western District of Texas under Section 1400(b). A case may be transferred under Section 1404(a) "for the convenience of parties and witnesses, in the interest of justice" so long as venue is proper. Under Section 1400(b), venue is proper "where a defendant has committed acts of infringement and has a regular and established place of business." The Federal Circuit noted that even though on its face venue seemed improper in the Northern District of California, the Federal Circuit was not bound to plaintiff's attempts at manipulating venue. Ikorongo Texas was created only in the months prior to suing Samsung and LG. Ikorongo Texas and Ikorongo Tech shared the same office in North Carolina and used the same person when signing company agreements. The Court concluded that the presence of Ikorongo Texas "is plainly recent, ephemeral, and artificial." Under Section 1404(a), this case "might have been brought" in the Northern District of California.

Secondly, the Federal Circuit concluded that the district court erred in assessing the traditional transfer factors. The district court did not put enough weight into the convenience of the Northern District of California. Many sources of proof and witnesses—including the inventors—are in the Northern District of California, rather than the Western District of Texas. Furthermore, the district court overstated their concern about the waste of judicial resources and inconsistent results (since plaintiffs also filed suit against Bumble in the Western District of Texas). Thirdly, the local interests weigh in favor of transferring to the Northern District of California. Finally, Ikorongo's argument that the congestion factor supports maintain the case in the Western District of Texas does not hold enough weight to override other factors in favor of moving the venue.

Infinity Comput. Prods., Inc. v. Oki Data Ams., Inc.
987 F.3d 1053 (Fed. Cir. 2021)

Patent claims that Infinity Computer Products, Inc. ("Infinity") asserted in an infringement lawsuit against Oki Data Americas, Inc. ("Oki Data") were held indefinite, in part because Infinity took conflicting positions during prosecution about a key feature of the invention. Infinity had accused Oki Data of infringing four patents, which all involved using a fax machine as a printer or scanner for a personal computer. The Federal Circuit held that Infinity poorly and inconsistently defined the term "passive link," a connection between the fax machine and computer.

Initially, in seeking to distinguish its invention from a prior art reference, Infinity argued that a "passive link" would connect a fax machine to a computer without any intervening apparatus, like a fax modem. This distinction allowed Infinity to obtain its '811 patent. Later during reexamination, however, Infinity reversed course. In defending against a different anticipation challenge, Infinity argued its claim should be backdated to one of its earlier applications. But that earlier iteration contained diagrams showing intervening

circuitry between the fax machine and computer. The inconsistency in Infinity's positions created uncertainty about "where the passive link ends and where the computer begins." Affirming the district court, the Federal Circuit found Infinity's asserted claims were invalid for indefiniteness.

John Bean Techs. Corp. v. Morris & Assocs., Inc.
988 F.3d 1334 (Fed. Cir. 2021)))

John Bean Technologies Corporation ("John Bean") sued Morris & Associates, Inc. ("Morris") in the Eastern District of Arkansas for infringement of John Bean's reexamined '622 patent. The '622 patent claims "an auger-type poultry chiller used to help process poultry for human consumption." On remand from a prior appeal, the Eastern District of Arkansas granted in part Morris's motion for summary judgment on the ground of equitable intervening rights, and denied in part Morris's motion on the ground of prosecution laches. In this appeal, John Bean challenged the district court's decision to award Morris equitable intervening rights, an affirmative defense under Section 252 that provides an alleged infringer "protect[ion] from liability for infringement of substantively and substantially altered claims in a reissued patent." 35 U.S.C. § 252.

John Bean argued that the district court's equitable intervening rights analysis was flawed. In particular, it argued that the court should have found Morris's full recoupment of its monetary investment in the poultry chiller business sufficient to defeat Morris's entitlement to an equitable remedy. The Federal Circuit disagreed, holding that monetary recoupment is only one factor in the court's broad equitable intervening rights analysis, and the district court had not weighed it inappropriately. The district court considered several factors in granting the equitable remedy to Morris, including John Bean's apparent bad faith in delaying for 11 years to dispute Morris's position on the patent's invalidity, Morris's nonmonetary investments into the poultry chiller business, and Morris's conversion of two-thirds of its business to the accused product. As a result, the Federal Circuit held that the district court did not abuse its discretion in its application of Section 252, and affirmed the district court's decision to award equitable intervening rights to Morris.

Moreover, the Federal Circuit rejected John Bean's argument that "genuine issues of material fact remain[ed] as to willful infringement." Willful infringement would have made Morris a "bad actor" to whom equitable defenses, such as equitable intervening rights, were not available. The Court held that once the district court awarded Morris equitable intervening rights, Morris was not infringing the '622 patent—which therefore foreclosed any claim of willful infringement.

Morris had cross-appealed the district court's decision to deny its motion for summary judgment on the ground of prosecution laches. However, because the Court affirmed the district court's decision to grant the motion for summary judgment, it did not reach the prosecution laches issue.

M & K Holdings, Inc. v. Samsung Elecs. Co.
985 F.3d 1376 (Fed. Cir. 2021)

Samsung petitioned for IPR of M&K's patent, which relates to efficient video file compression. Samsung asserted that a reference called "WD4-v3" anticipated certain claims and rendered other claims, including claim 3, obvious when read in combination with references Park and Zhou; all three references had been uploaded to the website of a joint task force that established industry standards for high-efficiency video coding. The PTAB found that all three references were publicly accessible and the claims were anticipated or rendered obvious by the references.

M&K appealed, challenging (1) the public accessibility of references Park and Zhou and (2) the PTAB's finding that claim 3 was anticipated, when Samsung's petition only asserted obviousness.

The Federal Circuit affirmed the PTAB's finding that references Park and Zhou were publicly accessible because persons of ordinary skill in the video coding community could have accessed those sources with reasonable diligence on the task force website despite limited search functionality, and the research was presented and discussed at task force meetings without any expectation of confidentiality before the priority date of the disputed patent. The references were deemed printed publications.

The Federal Circuit agreed with M&K regarding claim 3 and vacated the PTAB's finding that claim 3 was anticipated because Samsung had only asserted obviousness and conceded that the reference was not anticipatory during the IPR proceeding. M&K was not put on notice that the PTAB might invalidate claim 3 on anticipation grounds, depriving it of a chance to challenge, which was a procedural error and a violation of the Administrative Procedure Act. The Federal Circuit vacated and remanded claim 3 for further proceedings.

Mojave Desert Holdings, LLC v. Crocs, Inc.
995 F.3d 969 (Fed. Cir. 2021)

The Federal Circuit Court reversed the PTAB's decision to deny Mojave Desert Holdings, LLC's ("Mojave") motion to substitute parties pursuant to Federal Rule of Appellate Procedure 43(b). The Court held that all of the first entity's interests were included as property of its estate when it filed for bankruptcy. Therefore, when the first entity transferred its interests to a second entity, the transfer of all assets included the rights in the PTAB proceeding. The Court held that a second assignment, in which the second entity assigned Mojave its litigation claims, including all claims against Crocs, made it clear that Mojave is the successor-in-interest with respect to the PTAB proceeding.

The litigation commenced when Crocs, Inc., the owner of the '789 design patent, brought suit against U.S.A. Dawgs, Inc. for infringement. U.S.A. Dawgs filed a third-party request for *inter partes* reexamination of the '789 patent at the USPTO, resulting in invalidation. Crocs appealed to the PTAB. While the appeal was pending, U.S.A. Dawgs filed for bankruptcy and assigned all of its assets to Dawgs Holdings, LLC ("Dawgs Holdings").

Dawgs Holdings then assigned its litigation claims, explicitly including the claims asserted by U.S.A. Dawgs in the infringement action and the *inter partes* reexamination against Crocs, to Mojave. Mojave filed a petition with the PTAB to change the real party in interest from U.S.A. Dawgs, Inc., to Mojave Desert Holdings, LLC in the *inter partes* reexamination hearing.

The PTAB rejected Mojave's request on the following grounds: (1) the initial transfer of asserts from U.S.A. Dawgs, Inc. to U.S.A. Dawgs Holdings, LLC appeared to be silent about rights with regard to the proceeding; (2) Mojave was not a party to the instant *inter partes* reexamination and did not have standing to update the real party in interest pursuant to 37 C.F.R. § 41.8(a) and; (3) Mojave did not file its submissions within 20 days of any change as required by 37 C.F.R. § 41.8(a).

This case came before the Federal Circuit in November 2019 after the PTAB reversed the USPTO's invalidation of the '789 patent and U.S.A. Dawgs appealed. Mojave filed a motion to substitute parties pursuant to Federal Rule of Appellate Procedure 43(b). In granting the motion, the Court disagreed with the PTAB's reasoning because U.S.A. Dawgs's assignment to Dawgs Holdings was comprehensive and the second assignment to Mojave clearly enumerated Mojave's interest as the requester in the *inter partes* examination. The Court explained that it does not read 37 C.F.R. § 41.8(a) as permitting the PTAB to ignore a transfer of interest in an *inter partes* reexamination because such a reading would defeat the important interest of having the proper party before the PTAB. Finally, the Court reasoned that an assignor's right may be transferred at least when it occurs as part of the transfer of the assignor's past infringement liability under 35 U.S.C. § 141.

Mylan Lab'ys. Ltd. v. Janssen Pharmaceutica, N.V.
989 F.3d 1375 (Fed. Cir. 2021)

The Federal Circuit dismissed a PTAB appeal by Mylan Laboratories Ltd. for lack of jurisdiction following the PTAB's decision to deny institution of IPR for the '906 patent owned by Janssen Pharmaceutica NV. Mylan had petitioned for IPR after Janssen sued the company in district court for infringement, arguing that certain claims in the '906 patent were obvious. The PTAB denied institution, applying the *Fintiv* analysis, and Mylan appealed.

Because 35 U.S.C. § 314(d) "prevents 'appeal' from a decision denying institution," the Federal Circuit found that it could not hear the case under its general grant of jurisdiction in 28 U.S.C. § 1295(a)(4). The Federal Circuit also denied Mylan's petition for a writ of mandamus challenging the denial of institution, while enshrining its jurisdiction to review such a petition.

In finding that it lacked jurisdiction to hear Mylan's appeal, the Federal Circuit reaffirmed its holding in *St. Jude* that the Court cannot hear an appeal from an IPR petition denial. Acknowledging Mylan's argument that recent Supreme Court cases "undermined" *St. Jude*'s reasoning, the Federal Circuit noted that the relevant cases "involved an appeal

from a final written decision—not an institution decision." As the Court could not identify a statute that would give it jurisdiction over appeals from decisions denying institution, it dismissed Mylan's PTAB appeal.

In addition, the Federal Circuit denied Mylan's petition for a writ of mandamus, noting that the remedy is "reserved for really extraordinary causes." Although the Federal Circuit established that it has jurisdiction to review a petition for a writ of mandamus such as the one in the case, the Court also found that "it is difficult to imagine a mandamus petition that challenges a denial of institution and identifies a clear and indisputable right to relief." Under this standard, the Court rejected Mylan's arguments that the PTAB's precedential *Fintiv* decision violates the APA by circumventing notice-and-comment rulemaking and unlawfully shortens the statutory period for filing an IPR. The Federal Circuit noted that Mylan did not identify a deprivation of "life, liberty, [or] property" necessary for a procedural due process challenge, or point to "history [or] tradition" that supports a fundamental right that would bolster the case.

Network-1 Techs., Inc. v. Hewlett-Packard Co.
981 F.3d 1015 (Fed. Cir. 2020)

Network-1 sued Hewlett-Packard ("HP") in the Eastern District of Texas, alleging infringement of '930 patent. The '930 patent relates to an apparatus and methods for allowing electronic devices to automatically determine if remote equipment is capable of accepting remote power over Ethernet. HP argued the patent was invalid and it did not infringe, and the jury agreed. The district court denied Network-1's request for a new trial on infringement but granted its JMOL on validity. Network-1 appealed the district court's final judgment of noninfringement, arguing the district court erred in its claim construction. HP cross-appealed the court's determination that it was estopped from raising obviousness challenges under 35 U.S.C. § 315(e)(2) by HP's joinder to an IPR before the PTAB. HP also argued that Network-1 improperly broadened a claim of the '930 patent during reexamination.

Network-1's appeal contends the district court erroneously construed the claim terms "main power source" and "low level current." On cross-appeal, HP contends that Network-1 improperly broadened the term "secondary power source" during reexamination. The Federal Circuit concluded the district court correctly construed "low level current" but erred in construing "main power source," agreeing with Network-1's argument that this includes both AC and DC power sources. As a result, Network-1 was entitled to a new trial on infringement and the district court's judgment of noninfringement was vacated and remanded for a new trial.

HP's cross-appeal argued the district court erroneously granted JMOL with respect to the '930 patent's validity. The Federal Circuit disagreed with the district court's determination that HP was estopped under Section 315(e) from presenting obviousness challenges as a consequence of its joinder to an IPR. The Court held that as a joining party, HP could not have raised any additional invalidity challenges with its joinder. It thus vacated the district court's JMOL on validity with respect to estoppel. HP also argued a claim was invalid as

Network-1 improperly broadened claims during reexamination. The Federal Circuit disagreed, finding the claim in dispute was not itself amended during reexamination and the district court's construction after reexamination was consistent with how earlier courts construed it. The Court thus affirmed the district court's judgment that the asserted claims were not improperly broadened.

Neville v. Found. Constructors, Inc.
972 F.3d 1350 (Fed. Cir. 2020)

Neville sued Foundation Constructors, Inc. in the Central District of California for alleged infringement of its '708 and '236 patents, which relate to screw-type foundation piles driven into the ground through rotational torque. Neville alleged that Foundation's ED2M and ED3 pile tips infringed claims to (1) an end plate having a "substantially flat surface" and (2) an end plate with "at least one protrusion extending outwardly from it." The district court construed the patent claims and found no infringement. Neville appealed, and the Federal Circuit affirmed.

The Federal Circuit held the claim specification referring to a "substantially flat surface" only applies to externally-facing surfaces, or the surface through which the pile tip applies force to the underlying soil. The Court noted the specification is silent as to any interior surface and to any purpose served by the shape of the interior surface. The Court thus agreed with the district court's conclusion that the accused ED2M and ED3 pile tips do not include the claimed end plate having a "substantially flat surface" within the meaning in the specification and thus do not infringe Neville's patents.

The Federal Circuit also found there was no protrusion from the end plate of the ED2M and ED3 pile tips. Because the end piece of the ED2M and ED3 pile tip is a single piece, there is no demarcation between the end plate and the "protrusion." The Court agreed with the district court in finding that within the plain meaning of the claim, the end plate cannot be "an indistinguishable part of the alleged 'protrusion'" as an object cannot protrude from itself. The Federal Circuit thus affirmed the district court's ruling at summary judgment of noninfringement.

New Vision Gaming & Dev., Inc. v. SG Gaming, Inc.
996 F.3d 1378 (Fed. Cir. 2021)

In this case the Federal Circuit vacated and remanded the PTAB's decision for proceedings consistent with *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019). *Arthrex*, decided after the PTAB's decisions in this case, held that the removal protections for the Administrative Patent Judges (APJs) of the PTAB were unconstitutional, and New Vision argued that the PTAB's decisions invalidating two New Vision patents for subject-matter ineligibility were invalid in light of that holding. In a one-paragraph decision, the Court vacated and remanded for proceedings consistent with *Arthrex* and reached no other issues presented.

Judge Newman concurred in part and dissented in part. Judge Newman agreed that *Arthrex* applied and that it was appropriate to vacate the decision of the unconstitutionally appointed PTAB. But in this case, Judge Newman argued, both parties previously mutually agreed on a forum-selection provision that selected Nevada state or federal court as the exclusive jurisdiction for any dispute. The PTAB proceeded to judgment on the claims despite the forum-selection provision, so Judge Newman argued that the question of proper forum needed to be resolved before remand.

Pac. Biosciences of Cal., Inc. v. Oxford Nanopore Techs., Inc.
996 F.3d 1342 (Fed. Cir. 2021)

The Federal Circuit rejected PacBio's argument that the jury verdict below—that several PacBio patents were invalid for lack of enablement—was unsupported by the evidence and required JMOL in PacBio's favor. The Court noted that JMOL would only be appropriate if the factual record were deficient of the minimum quantity of evidence required to reasonably afford relief to the winner. Here, the Court decided, the jury was not required to construe an expert's brief answer as supporting enablement of the full claimed process, when it may have supported just one part of the process—especially since substantial evidence supported non-enablement. The Court also noted that PacBio presented no evidence of actual reduction to practice of its own that would contradict Oxford's evidence of non-enablement; PacBio instead only relied on the constructive reduction to practice illustrated by its patent specification.

The Court also rejected PacBio's argument that Oxford's remarks during its opening statement regarding the COVID-19 applications of its product incurably prejudiced the jury and warranted a new trial. The Court found no abuse of discretion in the district court's determination that Oxford's remarks were unlikely to have created a miscarriage of justice. PacBio, the Court noted, also mentioned COVID-19 in its opening—and PacBio knew that Oxford planned to include it and did not object. Moreover, when PacBio requested that the court give curative jury instructions, the court gave exactly the instructions PacBio requested. In light of these circumstances, the Federal Circuit found no reason to overturn the district court's assessment of the prejudicial impact of Oxford's remarks.

Qualcomm Inc. v. Intel Corp.
6 F.4th 1256 (Fed. Cir. 2021)

The Court vacated and remanded a PTAB final written decision that found challenged claims obvious. The PTAB relied on a new claim construction without a limitation that the parties had agreed to include. Unlike cases where the Federal Circuit permitted the PTAB to adopt a claim construction that neither party proposed, here the "increased bandwidth" requirement was not in dispute. The Federal Circuit held that the PTAB violated patent owner Qualcomm's procedural due process rights and Administrative Procedure Act (APA) guarantees because the patent owner had no notice of, or adequate opportunity to respond to, the PTAB's construction. At oral argument, the limitation was mentioned only once, Qualcomm was not asked about it, and the PTAB's post-argument, *sua sponte* request for additional briefing on separate claim language did not touch on this

claim limitation. The Court also held that Qualcomm did not need to seek rehearing before appealing.

The Court found no error in the PTAB's construction that the structure of the means-plus-function claim was a circuit, declining to extend the *WMS Gaming* rule, which says that a general purpose computer becomes a special purpose computers once it is specially programmed to carry out an algorithm, to circuits.

Rain Computing, Inc. v. Samsung Elecs. Am., Inc.
989 F.3d 1002 (Fed. Cir. 2021)

Rain Computing sued Samsung for infringing Rain's '349 patent. The district court originally construed the claim term "user identification module" as a means-plus-function term that was not invalid as indefinite. Rain appealed the district court's judgment of noninfringement, and Samsung cross-appealed. The Federal Circuit reversed the district court's judgment on indefiniteness and dismissed Rain's appeal as moot.

The Federal Circuit first found that "user identification module" is a means-plus-function claim term subject to 35 U.S.C. § 112. In order to determine whether Section 112 applied, the Federal Circuit first inquired "whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure." *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1349 (Fed. Cir. 2015). The word "module" and the phrase "user identification" both did not provide any additional information about structure. Furthermore, the specification did not provide structural significance to the term "user identification module." Therefore, the Federal Circuit held "user identification module" to be a mean-plus-function limitation.

Subsequently, the Federal Circuit found that the claim term "user identification module" lacked sufficient structure and was therefore indefinite. The Federal Circuit identified two steps to determine whether the claim was indefinite. First, the Court considered the term's claimed function, which was "controlling access." Second, the Court determined whether the structure disclosed in the specification corresponded to the claimed function of "controlling access." For means-plus-function claims in which the disclosed structure is a computer programmed to carry out an algorithm, the Court has held that the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm. *WMS Gaming, Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1349 (Fed. Cir. 1999). Here, the Federal Circuit found that when a general purpose computer is the corresponding structure and is not capable of performing the "controlling access" function absent specialized software, an algorithm is required. Because nothing in the claim language or specification provided an algorithm to achieve the "control access" function, the term "user identification module" lacks sufficient structure and renders the claims indefinite. Therefore, the Federal Circuit reversed the district court's judgment on indefiniteness, and dismissed Rain's appeal as moot.

Raytheon Techs. Corp. v. Gen. Elec. Co.
993 F.3d 1374 (Fed. Cir. 2021)

The Federal Circuit reversed a PTAB decision on an IPR that found unpatentable claims of a patent held by Raytheon Technologies Corp. for a turbine engine because prior art rendered the claims obvious. The PTAB ruled that the prior art was self-enabling, providing enough information to allow a skilled artisan to determine a power density of its engine and thus invalidated Raytheon's patents by rendering the invention obvious.

The Federal Circuit reversed, finding that being able to calculate the power density of the engine did not render the claims obvious because they could not have been made at the time of the prior art. Raytheon provided evidence that certain materials were not existent and production had not been achieved as of the priority date. The Federal Circuit was unconvinced by the patent challengers' evidence that the prior art may have allowed a skilled artisan to create a computerized model of the futuristic engine, and held that the prior art did not enable the creation of the engine itself. The Federal Circuit thus reversed the PTAB's finding of obviousness.

Sec. People, Inc. v. Iancu
971 F.3d 1355 (Fed. Cir. 2020)

The Federal Circuit affirmed the district court's dismissal of an Administrative Procedure Act suit brought by Security People, Inc. in the Northern District of California. Security People had brought a suit against the PTO challenging the constitutionality of the cancellation of its patent. The PTAB had previously instituted an IPR and found Security People's patent to be unpatentable. Security People then appealed the PTAB's decision on the grounds of patentability, but did not raise a constitutionality argument, and the Federal Circuit affirmed the PTAB's decision. Security People then sought a declaratory judgement of the retroactive application of an IPR, alleging that the cancellation violated its Fifth Amendment due process right. The district court dismissed the suit for lack of subject matter jurisdiction, citing that because the American Invents Act (AIA) "provides for 'broad Federal Circuit review' of the Board's final written decisions . . . but allows for review 'only' in the Federal Circuit, *see* § 141(c), Congress discernibly intended to preclude district court review of Board decisions under the APA."

On appeal, the Federal Circuit reviewed *de novo* the dismissal of the APA claims. First, the Court rejected Security People's argument that the PTAB's lack of authority to decide constitutional claims prevented it from raising constitutional questions because the retroactivity of the IPR final written decision raised issues requiring factual resolution. The Court held that the text and structure of the statutory scheme accommodated fact-finding for a constitutional challenge on appeal, providing the Federal Circuit with the opportunity to meaningfully address constitutional questions on appeal.

Second, the Court rejected Security People's argument that its as-applied challenge was not ripe until the cancellation of its patent claims and the affirmation by the Federal Circuit, and was thus required to exhaust its nonconstitutional claims before raising its

constitutional ones. The Court held that Security People's argument misapplied the law defining when an agency action becomes final for judicial review. The test for finality is "whether the agency has completed its decisionmaking process, and whether the result of that process is one that will directly affect the parties." *See Franklin v. Massachusetts*, 505 U.S. 788, 797 (1992). The court held the final written decision served as the agency action that will directly affect the parties. Finding no persuasive arguments, the Federal Circuit affirmed the dismissal.

Simio, LLC v. FlexSim Software Prods., Inc.
983 F.3d 1353 (Fed. Cir. 2020)

Simio sued FlexSim for infringement of a patent directed to a system for "object-oriented" simulation programming, which purportedly allowed "using graphics instead of programming to create object-oriented simulations." FlexSim moved to dismiss the complaint as directed to patent-ineligible subject matter. The district court granted the motion to dismiss, finding that the patent failed to disclose an inventive concept under *Alice v. CLS Bank*, and instead was directed to the abstract idea of "substituting text-based coding with graphical processing." Simio appealed.

The Federal Circuit affirmed the District Court's dismissal. The Federal Circuit first found that the District Court had properly determined that the patent was directed to the abstract idea of "using graphics instead of programming to create object-oriented simulations." The Federal Circuit further rejected the argument that the patent disclosed improvements to the functionality of prior simulation systems because the patent did not describe the nature or implementation of any such changes.

SIMO Holdings Inc. v. Hong Kong uCloudlink Network Tech. Ltd.
983 F.3d 1367 (Fed. Cir. 2021)

SIMO brought action for infringement of the '689 patent, describing apparatuses and methods that allow users to reduce roaming charges on their phones while traveling abroad. At issue on appeal was the construction of the clause "non-local calls database," and whether that clause was a limitation required for infringement to occur. The district court concluded that a non-local calls database was not a necessary element to establish infringement; therefore, it granted summary judgment of infringement. After a jury trial that found the infringement had been willful, the district court entered final judgment of $8.2 million in SIMO's favor.

The Federal Circuit concluded that the district court had erred in its claim construction. The Court held that the clause in question was part of the body, not preamble, and was limiting in either case. The Court's disagreement with the district court's approach hinged on the application of *Oatey*, and how to properly balance a claim's express language with the doctrine that construction should not exclude described embodiments. Ultimately, the Court held that the claim at issue required the non-local calls databases element, even though that construction excluded some embodiments in the specification. Because uCloudlink's product did not practice the non-local calls database element, the Court

reversed the judgment below and granted uCloudlink summary judgment of noninfringement.

SiOnyx LLC v. Hamamatsu Photonics K.K.
981 F.3d 1339 (Fed. Cir. 2020)

In 2007, SiOnyx and Hamamatsu entered into an NDA to allow the parties to share confidential information to evaluate and develop applications for "pulsed laser process doped photonic devices." The agreement provided that, concerning the exchange of information, the disclosing party "claims ownership of the information and all patent rights in, or assign from the [disclosed] information." SiOnyx disclosed a confidential manufacturing process for a photodetector device. Hamamatsu terminated the joint development agreement, and after the NDA expired, allegedly used confidential information received from SiOnyx in a series of Japanese and U.S. patent applications.

SiOnyx sued Hamamatsu, seeking to correct inventorship on Hamamatsu's patent to name a SiOnyx inventor. SiOnyx prevailed at trial. On SiOnyx's post-trial motion, the district court transferred the U.S. patents in question to SiOnyx (in addition to changing inventorship), but refused to do so with respect to the Japanese patents, citing concerns over whether the district court had the authority to do so. Both parties cross-appealed to the Federal Circuit.

The Federal Circuit found that SiOnyx was entitled to ownership of both the U.S. and Japanese patents. The Federal Circuit emphasized that "it is well established that courts have authority to compel parties properly before them to transfer ownership of foreign patent" because "an order compelling a party to assign ownership of a foreign patent is an exercise of the court's authority over the party, not the foreign patent office." The Federal Circuit also noted that, because the U.S. patents claimed priority to the Japanese patents, they were necessarily directed to the same invention, meaning that there was "no rational basis" for differing treatment of the U.S. and Japanese patents.

SIPCO, LLC v. Emerson Elec. Co.
980 F.3d 865 (Fed. Cir. 2020)

The Federal Circuit reconsidered this case on appeal after the Supreme Court vacated and remanded the Federal Circuit's previous decision for further consideration in light of *Thryv, Inc. v. Click-To-Call Techs., LP*, 140 S. Ct. 1367 (2020). In *Thryv,* the Supreme Court held that the PTAB's decision to institute inter parties review under Section 315(b) is "final and nonappealable" under the "No Appeal" provision of Section 314(d).

The first time the Federal Circuit considered this case, SIPCO had appealed the PTAB's covered business method ("CBM") review of SIPCO's '842 patent, which claims a two-step communication path for remote devices, including ATMs and vending machines. The PTAB determined the '842 patent was not excluded from CBM review under the statutory "technological invention" exception of Rule 42.301(b), under which the PTAB considers "whether the claimed subject matter as a whole recites a technological feature that is novel

and unobvious over the prior art; and solves a technical problem using a technical solution." Ultimately, the PTAB determined that multiple claims were ineligible under Section 101 and were unpatentable for obviousness under Section 103.

In its original opinion, the Federal Circuit reversed the PTAB's finding that the '842 patent did not contain a "technical solution to a technical problem," and vacated and remanded the case for the PTAB to consider whether the "novel and unobvious" portion of Rule 42.301(b) was satisfied. The Supreme Court vacated and remanded the Federal Circuit's previous decision for further consideration in *Thryv*.

On remand, the Federal Circuit considered two issues: (1) whether the threshold determination that SIPCO's '842 patent qualified for CBM review was an appealable decision under Section 324(e); and (2) whether to uphold the PTAB's holding that the claims were unpatentable for obviousness. On the first issue, the Federal Circuit applied *Thryv*'s holding that judicial review is unavailable "where the grounds for attacking the decision to institute inter partes review consist of questions that are closely tied to the application and interpretation of statutes related to the Patent Office's decision to initiate inter partes review" to Section 324(e). Section 324(e) states "[t]he determination by the Director whether to institute a post-grant review under this section shall be final and nonappealable." The Federal Circuit determined that Section 324(e) subjects CBM reviews to an identical "No Appeal" provision as Section 314(d) and, therefore, held the PTAB's threshold determination that SIPCO's '842 patent qualified for CBM review was non-appealable. On the second issue, the Federal Circuit held that substantial evidence supported the PTAB's obviousness determination, and thus affirmed the PTAB's decision.

Sowinski v. California Air Res. Bd.
971 F.3d 1371 (Fed. Cir. 2020)

This appeal arises out of the dismissal of Dr. Richard Sowinski's suit against the California Air Resources Board ("CARB") on the ground of *res judicata*. In 2015, Sowinski filed suit against CARB and other associated individual and corporate defendants for alleged infringement of the '033 patent. The '033 patent describes an electronic apparatus for trading and validating consumer pollution-control tax credits. Sowinski alleged that the California Cap-and-Trade Program infringed the '033 patent. After Sowinski failed to respond to the defendants' motion to dismiss, his suit was dismissed with prejudice by the district court in the Central District of California. Sowinski then appealed to the Federal Circuit, which affirmed the dismissal ("*Sowinski I*").

On January 31, 2018, Sowinski filed a second complaint in the United States District Court for the Northern District of California with CARB as the only named defendant. The new complaint related to the same conduct, except that he sought damages only for infringement that occurred post *Sowinski I*. CARB filed a motion to dismiss on several grounds, including *res judicata*, Eleventh Amendment immunity from suit, and patent invalidity. The district court dismissed on the basis of *res judicata*, and Sowinski appealed.

The Federal Circuit affirmed the district court's dismissal, citing that a dismissal for failure to prosecute "operates as an adjudication on the merits." Additionally, the Court concluded that the district court properly applied claim preclusion, citing the Federal Circuit's statement in *Senju Pharmaceutical* that "[c]laim preclusion will generally apply when a patentee seeks to assert the same patent against the same party and the same subject matter." *Senju Pharm. Co. v. Apotex Inc.*, 746 F.3d 1344, 1349 (Fed. Cir. 2014). Further, the Court held that preclusion may apply to claims that arise after the prior judgment because the same act was previously adjudged not wrongful. Since the CARB activity in question had previously been held as not infringing, the Federal Circuit affirmed dismissal.

SpeedTrack, Inc. v. Amazon.com, Inc.
998 F.3d 1373 (Fed. Cir. 2021)

In this appeal, plaintiff-appellant SpeedTrack appealed the Northern District of California's judgment of noninfringement based on the court's claim construction relying on prosecution history disclaimer. The Federal Circuit affirmed.

The patent at issue is directed to "computer filing system for accessing files and data according to user-designated criteria." The representative claim recites a three-step process where a "category description table" containing "category descriptions" is created. According to that claim, category descriptions "hav[e] no predefined hierarchical relationship with such list or each other." The District Court initially adopted plaintiff's proposed construction of the "hierarchical" limitation but later modified it based on "clear and unambiguous disavowal of category descriptions based on hierarchical field-and-value systems" during prosecution. As a result, the court found that the limitation does not provide for "predefined" hierarchical relationships among field-and-value category descriptions. The parties then stipulated to noninfringement. Plaintiff appealed, disputing whether statements made by the applicants during prosecution amounted to such a disclaimer.

During prosecution, the applicants had added the hierarchical limitation to distinguish over a piece of prior art ("Schwartz"), which disclosed a system that "assigns user-definable attributes to . . . data files." In the accompanying remarks, the applicants stated that their invention is a "non-hierarchical filing system . . . without regard to rigid definitions of distinct fields containing values" and noted that Schwartz disclosed a "'hierarchical' relationship between values and fields," pointing to various examples in the reference.

The Court rejected appellant's argument that the applicants' statements covered only "category descriptions" but not "values" because the applicants "repeatedly highlighted predefined hierarchical field-and-value relationships" as the distinguishing element over Schwartz. The Court also rejected the argument that non-inventor statements do not amount to prosecution history disclaimer, reiterating the policy behind prosecution history disclaimer, which is to "ensure[] that the claims are not 'construed on way in order to obtain their allowance and in a different way against accused infringers.'" Based on this reasoning, the Federal Circuit affirmed the district court's construction and thus the final judgment of noninfringement.

St. Jude Medical, LLC v. Snyders Heart Valve LLC
977 F.3d 1232 (Fed. Cir. 2020)

The Federal Circuit affirmed in part and reversed in part the PTAB's patentability decisions for a patent directed to an artificial heart valve and insertion system. The PTAB instituted two IPR proceedings, IPR2018-00105 and IPR2018-00106. In the -00105 proceeding, the PTAB determined that St. Jude failed to establish unpatentability because the challenged claims were not anticipated by the Leonhardt prior art reference and were not obvious over Leonhard in combination with several other prior art references. In the -00106 proceeding, the PTAB found claims 1, 2, 6, and 8 anticipated by the Bessler prior art reference, but rejected St. Jude's contentions as to all other challenged claims. St. Jude appealed both final written decisions. With respect to the first proceeding, St. Jude argued that the PTAB applied an erroneous claim construction for the term "band." Specifically, St. Jude asserted that the PTAB adopted a construction substantially identical to that proposed by St. Jude, but then implicitly applied a narrower construction in its final written decision. With respect to the second proceeding, St. Jude argued the PTAB erred in rejecting its obviousness arguments for all challenged claims. Snyders cross-appealed in this proceeding, alleging errors in the PTAB's anticipation determination for claims 1, 2, 6, and 8.

The Federal Circuit affirmed the PTAB's final written decision in the -00105 proceeding, rejecting St. Jude's argument that the PTAB implicitly applied a different claim construction in its decision from the one it adopted during the proceeding. The key limitation in the Leonhardt prior art patent was a graft material that acted like a sleeve. St. Jude argued that by rejecting its contention that this sleeve satisfied the "band" term, the PTAB implicitly added a "narrow width" constraint to its construction of that term. The Federal Circuit rejected this argument, concluding that nothing in the intrinsic or extrinsic record (or St. Jude's proposed construction) suggested that a POSITA's understanding of the term "band" could not include a width constraint.

With respect to the -00106 proceeding, the Court reversed the PTAB's finding that Bessler anticipated the relevant claims, but affirmed the PTAB's nonobviousness determinations. On anticipation, the Court concluded that that Bessler did not disclose the "size and shaped" limitation of the relevant claims. The Court explained that Bessler "cover[ed] frames sized and shaped for installation with the native [heart] valve removed," whereas the '782 patent referred to a size and shape that allowed for insertion with the native valve still intact and in place. According to the Court, that difference between removing the native heart valve before insertion as compared to leaving it in place during insertion, and the subsequent constraints on the size and shape of the frame to be inserted, was material and precluded anticipation by Bessler. The Court rejected St. Jude's obviousness arguments with respect to all challenged claims in the -00106 proceeding, agreeing with the PTAB that St. Jude failed to prove that a POSITA would have made the specific combination of Bessler and other references proposed by St. Jude.

Synchronoss Techs., Inc. v. Dropbox, Inc.
987 F.3d 1358 (Fed. Cir. 2021)

The Federal Circuit affirmed the district court's grant of summary judgment of indefiniteness as to two patents and noninfringement as to a third patent. As an initial matter, the Federal Circuit asserted appellate jurisdiction despite outstanding counterclaims for declaratory judgment of invalidity by defendant Dropbox at the time of appeal. Dropbox agreed to give up those counterclaims during oral argument.

Regarding indefiniteness of the '446 patent, the Federal Circuit found that the asserted claims contained an impossibility. The claims required "generating a [single] digital media file" that itself "compris[es] a directory of digital media files." Plaintiff Synchronoss did not dispute the literal impossibility of the claim language, but proposed that a POSITA would understand it to mean that, in response to input from a user, a digital media file is generated as a second, updated version of the media data in the same format as the first version of the media data. The Federal Circuit found that adopting Synchronoss's proposal would require rewriting the claims and declined to do so merely to preserve their validity.

Regarding indefiniteness of the '696 patent, the Federal Circuit found that the claim phrase "user identifier module" in the asserted claims invoked Section 112(6) despite the lack of the word "means." Also, the specification did not detail what a user identifier module consists of or how it operates. Synchronoss argued that a POSITA would understand a "user identifier module" to correspond to structure, citing as evidence Dropbox's expert's list of "nearly 20 different structures" with which a system could perform user identification. The Federal Circuit found Synchronoss's argument to cut the other way because the argument suggested that "user identifier module" "correspond[ed] to every known way of achieving the claimed function" instead of adequate structure in the specification. Because "user identifier module" lacked adequate structure in the specification, it was indefinite.

Regarding noninfringement of the '757 patent, Synchronoss's own construction, adopted by the district court, for the terms "device," "system," and "apparatus" was "software . . . residing on . . . hardware" and Synchronoss had conceded that the asserted claims could not cover software absent hardware. Dropbox, however, provided its customers with software for download but no corresponding hardware. Synchronoss argued that its "concession" was misinterpreted and that "hardware" was not meant to be a limitation but rather a reference to the environment in which the software operated. The Federal Circuit disagreed, finding that Dropbox did not infringe due to the lack of hardware. The Federal Circuit also found that Dropbox did not "use" the entire claimed system by merely supplying the software to customers.

SynQor, Inc. v. Vicor Corp.
988 F.3d 1341 (Fed. Cir. 2021)

In this appeal, SynQor, Inc. challenged the PTAB's *inter partes* reexamination decision finding multiple claims of its '190 patent obvious and thus unpatentable. SynQor argued

that the PTAB's findings related to obviousness contradicted previous findings by the PTAB, and that the PTAB should have applied collateral estoppel. The court addressed: (1) whether collateral estoppel applies in the *inter partes* reexamination context; and (2) whether the facts of this particular case support collateral estoppel. The Court answered each of those questions affirmatively.

The Court began by citing *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. 138, 148-49 (2015), for the established rule that collateral estoppel applies "[w]hen an administrative agency is acting in a judicial capacity and resolves disputed issues of fact properly before it which the parties have had an adequate opportunity to litigate." As for *inter partes* reexamination, the Court first reviewed the statutes governing reexaminations, and found no evident congressional intent to preclude the application of collateral estoppel. The Court then moved on to find that *inter partes* reexaminations do not "categorically fail to meet the ordinary elements of issue preclusion." The Court rejected Vicor's argument that collateral estoppel should not apply due to the supposed "inquisitorial" nature of *inter partes* reexaminations and their lack of compulsory process and procedures for cross-examination of witnesses, noting that that neither cross-examination nor live testimony are prerequisites to the application of collateral estoppel in other administrative proceedings. More generally, there are no "bright-line procedural requirements;" so long as parties have a "full and fair opportunity to contest evidence," collateral estoppel may apply. Because other procedural safeguards create such opportunities in the *inter partes* reexamination context, the Court found that collateral estoppel may apply to reexamination proceedings generally.

Having established that collateral estoppel applies in the *inter partes* reexamination context, the Court then moved on to decide the appropriateness of applying collateral estoppel to the facts of this case, applying the four-part test set out in *In re Freeman*, 30 F.3d 1459, 1465 (Fed. Cir. 1994): collateral estoppel applies if "(1) the issue [at hand] is identical to one decided in the first action; (2) the issue was actually litigated in the first action; (3) resolution of the issue was essential to a final judgment in the first action; and (4) plaintiff had a full and fair opportunity to litigate the issue in the first action." In dissent, Judge Dyk argued that the fact that Vicor submitted new testimony from the creator of one of the prior art references, which arguably led to the PTAB's contradictory factual determinations, meant that the issue failed the test. The Court's response was that a "losing party does not get a second bite at the apple simply because they can find a new and arguably more persuasive witness to present their evidence," and that "this is precisely the type of rematch that collateral estoppel is intended to foreclose." The Court thus held that the PTAB was precluded from making a contradictory finding, vacated the PTAB's decision, and remanded.

The Court also dealt with the issue of whether a patent's expiration renders review of particular claims of the patent moot. The '190 patent expired before appellate proceedings on the new claims 34-38 finished, meaning those claims would never issue. The Court found that the patentability of those claims was indeed moot, and vacated the PTAB's decision with respect to them.

TecSec, Inc. v. Adobe Inc.
978 F.3d 1278 (Fed. Cir. 2020)

On appeal from the District Court for the Eastern District of Virginia, the Federal Circuit affirmed in part and reversed in part the district court's rulings regarding Adobe's alleged infringement of several of TecSec's "Distributed Cryptographic Object Method" patents. The two primary issues in the case were the district court's evidentiary ruling that excluded TecSec's evidence of induced infringement and its denial of Adobe's motion that the asserted claims were ineligible under Section 101.

The Court reversed the district court's exclusion of evidence of inducement that allegedly took place after the date of the parties' stipulation of noninfringement earlier in the case based on a later-reversed claim construction. The district court provided two reasons for its ruling: (1) the stipulation made it legally impossible for Adobe to have the necessary knowledge and intent to commit inducement because the prior claim construction, although later reversed, was objectively reasonable; and (2) such evidence would have confused the jury and been substantially prejudicial. The Federal Circuit rejected both rationales. The Court explained that under the *Global-Tech* inducement standard, TecSec could have proved inducement if it could have shown that Adobe subjectively believed that the prior claim construction was wrong, even if it would have been objectively reasonable for Adobe to rely on that claim construction. Because this was a factual question, Adobe was not entitled to "a no-knowledge finding as a matter of law." Addressing the second rationale for exclusion, the Court explained that while Rule 403 of the Federal Rules of Evidence permits the exclusion of some relevant but prejudicial evidence, the district court's decision effectively barred TecSec from presenting *any* evidence of the post-stipulation inducement, including evidence that was not before the district court on the motion in limine. The Court held that this went beyond an acceptable application of Rule 403. As such, the Court reversed and remanded for further proceedings on the post-stipulation inducement claim.

The Court affirmed the district court's denial of Adobe's motion that the asserted claims were ineligible under Section 101 because the claims were not impermissibly abstract. Explaining how the claims were aimed at improving network security, the Court emphasized that just because "non-computer settings may have security issues addressed by multilevel security, it does not follow that all patents relating to multilevel security are necessarily ineligible for patenting." Because the claimed solution of using a combination of techniques to address particular network security issues was sufficiently specific, the Court concluded that the district court correctly rejected Adobe's ineligibility challenge.

Trimble Inc. v. PerDiemCo LLC
997 F.3d 1147 (Fed. Cir. 2021)

In this case the Federal Circuit reversed the district court's decision that it lacked personal jurisdiction over PerDiemCo. Citing recent developments in Supreme Court precedent (specifically the Supreme Court's recent decision in *Ford Motor Co. v. Mont. Eighth Jud. Dist. Ct.*), the Court found that *Red Wing Shoe Co. v. Hockerson-Halberstadt, Inc.*, 148 F.3d 1355 (Fed. Cir. 1998), did not create a general rule that demand letters can never

create personal jurisdiction. PerDiemCo, a Texas company, accused Trimble and its subsidiary Innovative Software Engineering LLC (ISE), which is headquartered within the Northern District of California, of infringing 11 patents related to electronic logging or geofencing. PerDiemCo sent a letter to ISE beginning negotiations, and when negotiations broke down Trimble and ISE sought a declaratory judgment of noninfringement in the Northern District of California. Citing *Red Wing*, the district court decided that it lacked specific personal jurisdiction over PerDiemCo.

The Federal Circuit found that the communications between PerDiemCo and Trimble were more extensive than those in *Red Wing* and that they constituted purposeful availment of the forum for jurisdictional purposes. Whereas *Red Wing* involved just three communications, in this case PerDiemCo had engaged Trimble 22 times over three months. PerDiemCo argued that the exercise of personal jurisdiction would not comport with fair play and substantial justice, but the Court found that exercising personal jurisdiction would not significantly burden PerDiemCo; that it would vindicate the forum state's valid interest in adjudicating the dispute; that it would satisfy Trimble's interest in obtaining convenient relief; that it would most efficiently allocate the interstate judicial system's resources; and that it would further the states' shared interest in furthering fundamental substantive policy.

Uniloc 2017 LLC v. Apple, Inc.
996 F.3d 1368 (Fed. Cir. 2021)

The Federal Circuit upheld the finding of the PTAB that certain Uniloc patents were invalid for obviousness. The Court held that the PTAB's construction of a key claim term was supported by the prosecution history. In a cross-appeal, the Court rejected Apple's argument that the PTAB erred when it rejected Apple's challenge to the remaining claim of the patent.

Uniloc's appeal centered on the PTAB's construction of the claim term "intercepting" as it applied to communications between two endpoints of a call that the device inspects. The PTAB had construed "intercepting" simply to mean reception by any entity between the endpoints of a call; Uniloc argued that "intercepting" excluded reception by the intended recipient. It offered as an analogy the interception in football, where the "intercepting" player is never the intended receiver but instead has seized the ball as it traveled to the intended receiver. The Federal Circuit rejected this argument in light of the prosecution history.

On cross-appeal, Apple challenged the PTAB's finding that Apple had not offered a viable invalidity theory as to the remaining claim. The Court declined to reach the issue of whether Apple raised a viable theory because it found that, regardless, Apple would lose on the merits. The Court came to the same conclusion as the PTAB: the prior art was sufficiently distinct from the remaining claim such that it was not obvious.

Uniloc 2017 LLC v. Facebook Inc.
989 F.3d 1018 (Fed. Cir. 2021)

The Federal Circuit affirmed two PTAB IPR decisions that found that Facebook and LG were not estopped from challenging certain claims of Uniloc's '433 patent, which the PTAB also held were unpatentable as obvious. For background, Apple had initially filed an IPR challenging certain claims of the '433 patent. Facebook filed multiple petitions, including a petition that was identical in substance to Apple's IPR petition with a motion to join the Apple IPR. LG also filed a petition that was identical to Facebook's other petitions along with a motion to join. The PTAB granted the parties' motions to join the respective petitions. The PTAB issued a final written decision in the Apple IPR, and held that Facebook was not estopped from challenging a claim that was not challenged by Apple and that LG was not estopped because it was not an RPI or in privity with Facebook.

As an initial matter, the Court considered whether it had the authority to review the PTAB's determination regarding estoppel. Although acknowledging that "questions can arise as to whether we have the authority to review certain matters addressed in an IPR," the Federal Circuit found that there was "no indication" that 35 U.S.C. § 314(d), which includes a "No Appeal" provision, precludes its review of PTAB decisions where the alleged estoppel-triggering event occurred after institution. The Court found that in these circumstances, Facebook and LG were not estopped from maintaining the IPR challenges because there was no final written decision in the Apple IPR when the PTAB instituted review of the subsequent IPR petitions. The PTAB's "no estoppel" decision regarding Facebook and LG was "thus was later than and separate from its earlier institution decision." On the merits, the Court affirmed the PTAB's findings regarding estoppel.

The Federal Circuit also held that the PTAB did not err in finding certain claims of Uniloc's '433 patent unpatentable as obvious. The Court found that specific references would teach the proposed patent's "instant voice messaging application" limitation because one reference's "stated goal of organization of electronic messages would have provided motivation for a skilled artisan to combine the message database" into another reference's software. In addition, the Federal Circuit credited the PTAB's finding that one of the references "accomplishes 'attachments' in the same manner as the '433 patent."

Valeant Pharms. N. Am. LLC v. Mylan Pharms. Inc.
978 F.3d 1374 (Fed. Cir. 2020)

The Federal Circuit held that "in Hatch-Waxman cases, venue is not proper in all judicial districts where a generic product specified in an [Abbreviated New Drug Application] is likely to be distributed. It is proper only in those districts that are sufficiently related to the ANDA submission."

The district court had dismissed Valeant's infringement claims brought under the Hatch-Waxman Act against three defendants—two U.S.-based and one foreign. The court held that New Jersey was an improper venue because the only alleged acts of infringement, the submissions of the ANDA, occurred in West Virginia and Maryland, not New Jersey.

While the court acknowledged the foreign defendant was properly subjected to venue in every judicial district, the district court did not provide rationale for its dismissal.

After reviewing the history and case law for venue in Hatch-Waxman cases, the Federal Circuit concluded it was proper to narrowly construe the requirements of venue in patent cases, and affirmed the district court, holding that venue was proper "only in districts where actions related to the ANDA submission occur." But, while the two U.S.-based defendants were properly dismissed for lack of venue, the Federal Circuit reversed and remanded the district court's ruling as to the foreign defendant because venue was proper in New Jersey and the motion to dismiss required a ruling on the merits.

Vectura Limited v. GlaxoSmithKline LLC
981 F.3d 1030 (Fed. Cir. 2020)

GlaxoSmithKline LLC and Glaxo Group Limited (jointly, "GSK") appealed a District of Delaware court's findings that GSK infringed Vectura Limited's '991 patent and that the '991 patent was not invalid. GSK further appealed the district court's denial of GSK's post-trial motions for judgment as a matter of law and a new trial. The '991 patent relates to the production of "composite active particles" for use in pulmonary administration, such as in dry-powdered inhalers. The jury ruled in favor of Vectura on validity, infringement, and willful infringement, and found that Vectura was entitled to a royalty payment of $89,712,069. GSK raised four issues in its appeal to the Federal Circuit.

First, GSK argued because "Vectura failed to present substantial evidence that the accused inhalers use additive material that 'promotes the dispersion' of the active material" as required by the claims, GSK was entitled to a judgment as a matter of law on noninfringement or in the alternative, a new trial. The Federal Circuit rejected this argument, finding that even if one scientific study Vectura relied upon had infirmities, substantial additional evidence supported the jury's finding, including testing evidence, testimony from infringement experts, and testimony of employees from both GSK and Vectura, and documentary evidence.

Second, GSK argued the district court erred in its construction of the term "composite active particles" and therefore GSK was entitled to a new trial on infringement. Because GSK challenged the claim construction based on intrinsic evidence, the Court applied *de novo* review. GSK argued the district court should have construed the term to "require that the composite particles be produced by the 'high-energy milling' process referred to in the specification," citing passages in the specification and the prosecution history. The Federal Circuit found that high-energy milling was merely a preferred embodiment rather than a claim requirement. Thus, the Court rejected GSK's challenge to the district court's claim construction.

Third, GSK argued that Vectura's damages theory, which was based on a prior license between the parties, was legally flawed and required a new trial on damages. GSK argued that it was improper for Vectura's damages expert to use GSK's total sales because Vectura failed to show that the patented portion of the accused products drove demand, and thus

that Vectura was required to apportion to account for noninfringing components. Although the Court noted that "[o]rdinarily, an entire-market-value royalty base is appropriate only when the patented feature creates the basis for customer demand or substantially creates the value of the component parts," it held that "when a sufficiently comparable license is used as the basis for determining the appropriate royalty, further apportionment may not necessarily be required." Thus, the Federal Circuit rejected GSK's motion for a new trial on damages.

Fourth and finally, GSK argued it was entitled to a new trial on damages because Vectura made prejudicial references to GSK's sales. The Court rejected GSK's argument, deferring to the district court's finding "that the effect of the remarks that it found improper was not so prejudicial as to require a new trial."

VidStream LLC v. Twitter, Inc.
981 F.3d 1060 (Fed. Cir. 2020)

In 2017, Twitter filed two petitions requesting IPR of a 2012 patent owned by VidStream that dealt with recording and publishing content on social media websites. Twitter relied on a book published by Anselm Bradford on HTML5 mastery as the primary reference and submitted evidence on the book's public accessibility, including its copyright date of 2011 and ISBN information. However, the version of the book Twitter submitted included the text "Made in the USA . . . 13 December 2015." VidStream argued that the book was not an available reference because the relied-upon version of the book was published after the priority date. In response to VidStream's challenge, Twitter's reply contained additional evidence showing that the book was available by December 2011 with substantively similar content. The PTAB found that the book was an available prior art reference and that every claim of the challenged patent was unpatentable due to obviousness in light of the Bradford reference in combination with other cited references.

On appeal, the Federal Circuit found that the PTAB properly admitted Twitter's evidence submitted for the first time on reply and that the evidence, when considered in its entirety, supported the PTAB's finding that the book was published and publicly accessible before the priority date. Because the book was prior art, the Court affirmed the PTAB's conclusion of obviousness.

Warsaw Orthopedic, Inc. v. Sasso
977 F.3d 1224 (Fed. Cir. 2020)

On appeal from the District Court for the Northern District of Indiana, the Federal Circuit held that the district court did not abuse its discretion in abstaining from exercising declaratory jurisdiction in view of a concurrent action in Indiana state court involving the same issue and parties. At issue in both federal and state court were medical devices Dr. Sasso allegedly invented and sold to Medtronic. The state action was a contract case involving a dispute over the royalty due for certain patent rights. Dr. Sasso prevailed in state court because the court found that the amount of money owed to Dr. Sasso did not depend on the validity of the patents at issue. In federal court, Medtronic sought

declaratory judgment that there was no contractual breach over royalties because the contract only covered valid patents, and Medtronic was challenging the patents at issue. The district court dismissed the declaratory judgment action without prejudice, noting that the state court had already resolved the contract issue and the district court could do nothing to change that judgment. Medtronic appealed to the Federal Circuit, arguing that federal courts have exclusive jurisdiction over patent validity issues and the state court erred in holding that the validity of the patents did not affect the contract issue.

As a preliminary matter, the Court held that the declaratory action was properly in the district court's jurisdiction because issues of patent validity and claim scope "are substantial to the federal system as a whole, and the federal-state judicial balance would not be disrupted by the district court's exercise of declaratory jurisdiction." As such, the Court found that it had jurisdiction to receive the resulting appeal.

Discussing both the *Wilton/Brillhart* and *Colorado River* abstention standards, the Court held that the district court properly applied the more flexible *Wilton/Brillhart* standard because there had already been a state court trial and appeal. As such, acknowledging that while "the discretion to decline declaratory judgment jurisdiction is not unlimited," given the facts of the case, the Court held that the district court did not abuse its discretion in abstaining and dismissing the declaratory judgment without prejudice.

Whitewater West Indus., Ltd. v. Alleshouse
981 F.3d 1045 (Fed. Cir. 2020)

Richard Alleshouse and Yong Yeh were named on three patents that relate to "water-park attractions that individuals may ride as if surfing, and . . . nozzle configurations for regulating water flow in such surfing attractions." Pacific Surf Designs Inc., the company Alleshouse and Yeh formed to develop these surfing attractions, was the assignee of the three patents. Whitewater West Industries, Ltd., the successor of the company that employed Alleshouse just before he formed Pacific Surf Designs, brought suit in the United States District Court for the Southern District of California asserting claims of breach of contract and correction of inventorship. Whitewater claimed Alleshouse's employment contract obligated him to assign the three patents to Whitewater and that Yeh was improperly named as an inventor. The district court held Alleshouse "breached the employment agreement, the agreement was valid under state law, and Whitewater was therefore entitled to assignment of the defendants'[s] patent interests," and that Yeh was improperly joined as an inventor. Alleshouse, Yeh, and Pacific Surf Designs Inc. appealed.

The Federal Circuit reviewed Alleshouse's employment agreement under Section 16600 of the California Business and Professions Code. The agreement assigned all of Alleshouse's rights and interests in any invention he conceived that was "in any way connected to any subject matter within the existing or contemplated business" of Whitewater's predecessor, regardless of whether trade secret or confidential information was used to conceive the invention, and regardless of time and geography. The Federal Circuit, applying case law from California district courts, held that the agreement's assignment provision went "beyond protection of proprietary information and ensnare[d]

postemployment inventions," and therefore had a broad restraining effect that rendered it invalid. As such, the court reversed the district court's decision that Alleshouse breached his contract by failing to assign the three patents to Whitewater. Further, since the Court determined the assignment provision was invalid, the Court also reversed the district court's decision on the inventorship claim.

Wi-LAN Inc. v. Sharp Elecs.
992 F.3d 1366 (Fed. Cir. 2021)

Wi-LAN, owner of (1) a patent claiming methods and systems for displaying interlaced video on non-interlaced devices, and (2) a patent relating generally to multimedia encoders, sued television manufacturer Sharp and Vizio for patent infringement. The United States District Court for the District of Delaware granted summary judgement for Sharp and Vizio because Wi-LAN failed to produce admissible evidence of Sharp and Vizio's source code that could prove infringement.

The Federal Circuit reviewed the summary judgement *de novo* and affirmed the lower court's decision. As evidence of Sharp's infringement, Wi-LAN relied on printouts of Sharp's source code from a third-party chip manufacturer that were authenticated by employees. The Federal Circuit ruled that this evidence was inadmissible because the declarations of authenticity that the employees provided could not serve as a business record or proxy for trial testimony. The Federal Circuit rejected Wi-LAN's argument that the declarations served as business records because they were obtained through lawsuit rather than the regular course of business. To serve as a proxy for trial testimony the declarants must be available for trial, but the Federal Circuit found that Wi-LAN thus did not establish that the declarants would be available to testify at trial.

Additionally, the Federal Circuit found that the source code could not be admitted because Wi-LAN did not meet Rule 803(6)'s final requirement that "the opponent does not show that the source of information or the method or circumstance of preparation indicate a lack of trustworthiness." The Federal Circuit also found that Wi-LAN's expert's reliance on the source code did not validate the source code because the source code was not authenticated. Finally, the Federal Circuit rejected Wi-LAN's argument that it should receive more time to gather an admissible version of the source code given the ample opportunities Wi-LAN had to do so and to find custodial witnesses to authenticate the source code during the course of discovery.

Yu v. Apple, Inc.
1 F.4th 1040 (Fed. Cir. 2021)

Appellants sued Apple and Samsung alleging they infringed their '298 patent. Defendants filed a Rule 12(b)(6) motion to dismiss, which the district court granted after finding the patent ineligible under 35 U.S.C. § 101. Specifically, the court stated the asserted claims were directed to the abstract idea of taking two pictures and using those pictures to enhance each other. The court found photographers have long used this technique and that the claims lacked an inventive concept because the steps were well-known and conventional.

Yu appealed to the Federal Circuit. First, the Court analyzed whether the patent claim was directed to an unpatentable abstract idea. The Court found that it was; it was directed to the abstract idea of taking two pictures and using one to enhance the other. The Court found only conventional camera components were used to effectuate the resulting "enhanced" image and the components only performed their basic functions.

As to Step Two, the Court found that the claims did not include an inventive concept sufficient to transform the abstract idea into a patent-eligible invention. The Court reasoned this was because the claim was recited at a high level of generality and invoked routine and conventional components to apply the abstract idea.

The Court also disposed of other arguments advanced by Yu. First, the Court stated it was acceptable for the court at the pleading stage to consider the fact the practice was well-known for over a century. Second, the Court found that patent eligibility can be determined at the 12(b)(6) stage without expert testimony. Thus, the panel majority affirmed the district court's ruling.

ALPHABETICAL INDEX OF ALL CASES

Page

ABS Global, Inc. v. Cytonome/ST, LLC
984 F.3d 1017 (Fed. Cir. 2021)..... 38

Am. Axle & Mfg. v. Neapco Holdings LLC
977 F.3d 1379 (Fed. Cir. 2020)..... 38

Amgen Inc. v. Sanofi, Aventisub LLC
987 F.3d 1080 (Fed. Cir. 2021)..... 39

AntennaSys, Inc. v. AQYR Techs., Inc.
976 F.3d 1374 (Fed. Cir. 2020)..... 39

Apple Inc. v. Voip-Pal.com, Inc.
976 F.3d 1316 (Fed. Cir. 2020)..... 40

Apple Inc. v. Qualcomm Inc.
992 F.3d 1378 (Fed. Cir. 2021)..... 41

Baxalta Inc. v. Genentech, Inc.
972 F.3d 1341 (Fed. Cir. 2020)..... 41

Bayer Healthcare LLC v. Baxalta Inc.
989 F.3d 964 (Fed. Cir. 2021)..... 42

Becton, Dickinson & Co. v. Baxter Corp. Englewood
998 F.3d 1337 (Fed. Cir. 2021)..... 43

Biogen MA, Inc. v. EMD Serono, Inc.
976 F.3d 1326 (Fed. Cir. 2020)..... 44

Bio-Rad Lab'ys, Inc. v. Int'l Trade Comm'n
996 F.3d 1302 (Fed. Cir. 2021)..... 45

Bio-Rad Lab'ys, Inc. v. 10X Genomics Inc.
967 F.3d 1353 (Fed. Cir. 2020)..... 45

Bio-Rad Lab'ys, Inc. v. Int'l Trade Comm'n
998 F.3d 1320 (Fed. Cir. 2021)..... 46

Bot M8 LLC v. Sony Corp. of Am.
4 F.4th 1342 (Fed. Cir. 2021) 48

C.R. Bard Inc. v. AngioDynamics, Inc.
979 F.3d 1372 (Fed. Cir. 2020)..... 48

Canfield Sci., Inc. v. Melanoscan, LLC
987 F.3d 1375 (Fed. Cir. 2021)..... 49

Cap Export, LLC v. Zinus, Inc.
996 F.3d 1332 (Fed. Cir. 2021)..... 50

Chandler v. Phoenix Services, LLC
1 F.4th 1013 (Fed. Cir. 2021) 51

Chemours Co. FC, LLC v. Daikin Indus., Ltd.
4 F.4th 1370 (Fed. Cir. 2021) 51

Chevron U.S.A. Inc. v. Univ. of Wyo. Rsch.
978 F.3d 1361 (Fed. Cir. 2020)..... 52

Christy, Inc. v. United States
971 F.3d 1332 (Fed. Cir. 2020)..... 52

Chudik v. Hirshfeld
987 F.3d 1033 (Fed. Cir. 2021)..... 53

cxLoyalty, Inc. v. Maritz Holdings Inc.
986 F.3d 1367 (Fed. Cir. 2021)..... 54

DePuy Synthes Prods., Inc. v. Veterinary Orthopedic Implants, Inc.
990 F.3d 1364 (Fed. Cir. 2021)..... 54

Donner Tech., LLC v. Pro Stage Gear, LLC
979 F.3d 1353 (Fed. Cir. 2020)..... 55

Edgewell Pers. Care Brands, LLC v. Munchkin, Inc.
989 F.3d 1358 (Fed. Cir. 2021)..... 56

Egenera, Inc. v. Cisco Sys., Inc.
972 F.3d 1367 (Fed. Cir. 2020)..... 57

Facebook, Inc. v. Windy City Innovations, LLC
973 F.3d 1321 (Fed. Cir. 2020)..... 57

FastShip, LLC v. United States
968 F.3d 1335 (Fed. Cir. 2020)..... 58

Ferring B.V. v. Allergan, Inc.
980 F.3d 841 (Fed. Cir. 2020)..... 59

Free Stream Media Corp. v. Alphonso Inc.
996 F.3d 1355 (Fed. Cir. 2021)..... 60

Gen. Elec. Co. v. Raytheon Techs. Corp.
983 F.3d 1334 (Fed. Cir. 2020)..... 60

GlaxoSmithKline LLC v. Teva Pharms. USA, Inc.
976 F.3d 1347 (Fed. Cir. 2020)..... 60

Godo Kaisha IP Bridge 1 v. TCL Commc'n Tech. Holdings Ltd.
967 F.3d 1380 (Fed. Cir. 2020)..... 61

Hyatt v. Hirshfeld
998 F.3d 1347 (Fed. Cir. 2021)..... 62

Illumina, Inc. v. Ariosa Diagnostics, Inc.
967 F.3d 1319 (Fed. Cir. 2020)..... 63

Immunex Corp. v. Sanofi-Aventis U.S. LLC
977 F.3d 1212 (Fed. Cir. 2020)..... 64

In re Apple Inc.
979 F.3d 1332 (Fed. Cir. 2020)..... 65

In re Bd. of Trs. of Leland Stanford Junior Univ.
991 F.3d 1245 (Fed. Cir. 2021)..... 65

In re Bd. of Trs. of Leland Stanford Junior Univ.
989 F.3d 1367 (Fed. Cir. 2021)..... 66

In re Google Tech. Holdings LLC
980 F.3d 858 (Fed. Cir. 2020)..... 66

In re Nitro Fluids L.L.C.
978 F.3d 1308 (Fed. Cir. 2020)..... 67

In re Samsung Elecs. Co.
2 F.4th 1371 (Fed. Cir. 2021) 67

Infinity Comput. Prods., Inc. v. Oki Data Ams., Inc.
987 F.3d 1053 (Fed. Cir. 2021)..... 68

John Bean Techs. Corp. v. Morris & Assocs., Inc.
988 F.3d 1334 (Fed. Cir. 2021)))..... 69

M & K Holdings, Inc. v. Samsung Elecs. Co.
985 F.3d 1376 (Fed. Cir. 2021)..... 70

Mojave Desert Holdings, LLC v. Crocs, Inc.
995 F.3d 969 (Fed. Cir. 2021)..... 70

Mylan Lab'ys. Ltd. v. Janssen Pharmaceutica, N.V.
989 F.3d 1375 (Fed. Cir. 2021)..... 71

Network-1 Techs., Inc. v. Hewlett-Packard Co.
981 F.3d 1015 (Fed. Cir. 2020)..... 72

Neville v. Found. Constructors, Inc.
972 F.3d 1350 (Fed. Cir. 2020)..... 73

New Vision Gaming & Dev., Inc. v. SG Gaming, Inc.
996 F.3d 1378 (Fed. Cir. 2021)..... 73

Pac. Biosciences of Cal., Inc. v. Oxford Nanopore Techs., Inc.
996 F.3d 1342 (Fed. Cir. 2021)..... 74

Qualcomm Inc. v. Intel Corp.
6 F.4th 1256 (Fed. Cir. 2021) 74

Rain Computing, Inc. v. Samsung Elecs. Am., Inc.
989 F.3d 1002 (Fed. Cir. 2021)..... 75

Raytheon Techs. Corp. v. Gen. Elec. Co.
993 F.3d 1374 (Fed. Cir. 2021)..... 76

Sec. People, Inc. v. Iancu
971 F.3d 1355 (Fed. Cir. 2020)..... 76

Simio, LLC v. FlexSim Software Prods., Inc.
983 F.3d 1353 (Fed. Cir. 2020)..... 77

SIMO Holdings Inc. v. Hong Kong uCloudlink Network Tech. Ltd.
983 F.3d 1367 (Fed. Cir. 2021)..... 77

SiOnyx LLC v. Hamamatsu Photonics K.K.
981 F.3d 1339 (Fed. Cir. 2020)..... 78

SIPCO, LLC v. Emerson Elec. Co.
980 F.3d 865 (Fed. Cir. 2020)..... 78

Sowinski v. California Air Res. Bd.
971 F.3d 1371 (Fed. Cir. 2020)..... 79

SpeedTrack, Inc. v. Amazon.com, Inc.
998 F.3d 1373 (Fed. Cir. 2021)..... 80

St. Jude Medical, LLC v. Snyders Heart Valve LLC
977 F.3d 1232 (Fed. Cir. 2020)..... 81

Synchronoss Techs., Inc. v. Dropbox, Inc.
987 F.3d 1358 (Fed. Cir. 2021)..... 82

SynQor, Inc. v. Vicor Corp.
988 F.3d 1341 (Fed. Cir. 2021)..... 82

TecSec, Inc. v. Adobe Inc.
978 F.3d 1278 (Fed. Cir. 2020)..... 84

Trimble Inc. v. PerDiemCo LLC
997 F.3d 1147 (Fed. Cir. 2021)..... 84

Uniloc 2017 LLC v. Apple, Inc.
996 F.3d 1368 (Fed. Cir. 2021)..... 85

Uniloc 2017 LLC v. Facebook Inc.
989 F.3d 1018 (Fed. Cir. 2021)..... 86

Valeant Pharms. N. Am. LLC v. Mylan Pharms. Inc.
978 F.3d 1374 (Fed. Cir. 2020)..... 86

Vectura Limited v. GlaxoSmithKline LLC
981 F.3d 1030 (Fed. Cir. 2020)..... 87

VidStream LLC v. Twitter, Inc.
981 F.3d 1060 (Fed. Cir. 2020)..... 88

Warsaw Orthopedic, Inc. v. Sasso
977 F.3d 1224 (Fed. Cir. 2020)..... 88

Whitewater West Indus., Ltd. v. Alleshouse
981 F.3d 1045 (Fed. Cir. 2020)..... 89

Wi-LAN Inc. v. Sharp Elecs.
992 F.3d 1366 (Fed. Cir. 2021)..... 90

Yu v. Apple, Inc.
1 F.4th 1040 (Fed. Cir. 2021) 90