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Click-to-Call Technologies, LP v. Ingenio, Inc.

APPEAL NO.
15-1242

OP. BELOW
PATO

OPINION
**August 16,
2018**

SUBJECT
Patent

AUTHOR
O'Malley

Question(s) Presented

“[W]hether 35 U.S.C. § 315(b)’s time bar applies to bar institution when an IPR petitioner was served with a complaint for patent infringement more than one year before filing its petition, but the district court action in which the petitioner was so served was voluntarily dismissed without prejudice.”

Holding

“The en banc court holds that § 315(b)’s time bar applies in such a scenario.”

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October 19, 2022

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MASIMO 1057
Masimo v. Apple
IPR2023-00728

December 5, 2016

[Click-to-Call's Petition for Rehearing En Banc](#)



January 19, 2018

[Order on Petition for Panel Rehearing](#)

February 5, 2018

[Supplemental Brief of Appellant](#)

February 21, 2018

[Supplemental Brief of Appellees in Response to Court's January 19, 2018 Order](#)

March 5, 2018

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[Panel Oral Argument](#)

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Nantkwest, Inc. v. Iancu

APPEAL NO.	OP. BELOW	OPINION	SUBJECT	AUTHOR
16-1794	DCT	July 27, 2018	Patent	Stoll

Question(s) Presented

“When the United States Patent and Trademark Office’s Patent Trial and Appeal Board (‘Board’) affirms an examiner’s rejection of a patent application, § 145 of the Patent Act permits the disappointed applicant to challenge the Board’s decision in district court. Applicants who invoke § 145 are required by statute to pay ‘[a]ll the expenses of the proceedings’ incurred by the U.S. Patent and Trademark Office (‘PTO’) in defending the Board’s decision, regardless of the outcome. Historically, the agency relied on this provision to recover sums it spent on travel and printing and, more recently, expert witnesses. Now, 170 years after Congress introduced § 145’s predecessor, the agency argues that § 145 also compels applicants to pay its attorneys’ fees.” Does § 145 compel applicants to pay the PTO’s attorneys’ fees?

Holding

“We hold that it does not, for the American Rule prohibits courts from shifting attorneys’ fees from one party to another absent a ‘specific and explicit’ directive from Congress. The phrase ‘[a]ll the expenses of the proceedings’ falls short of this stringent standard.”

DATE SELECTED PROCEEDINGS AND ORDERS

June 6, 2016 **Brief for Appellant**

September 6, 2016 **Brief of Plaintiff-Appellee Nantkwest, Inc.**

October 11, 2016

Reply Brief

February 9, 2017

Panel Oral Argument

June 23, 2017

Panel Opinion

August 31, 2017

Order Granting Sua Sponte Rehearing En Banc

November 15, 2017

Brief for the Appellant on Rehearing En Banc

January 16, 2018

En Banc Brief of Plaintiff-Appellee Nantkwest, Inc.

January 31, 2018

Reply Brief for the Appellant on Rehearing En Banc

March 8, 2018

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July 27, 2018

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Wi-Fi One, LLC v. Broadcom Corp.

APPEAL NO.
15-1944, 15-
1945, 15-1946

OP. BELOW
PATO

OPINION
**January 8,
2018**

SUBJECT
Patent

AUTHOR
Reyna

Question(s) Presented

“Congress has prohibited the Director of the United States Patent and Trademark Office from instituting inter partes review if the petition requesting that review is filed more than one year after the petitioner, real party in interest, or privy of the petitioner is served with a complaint for patent infringement. 35 U.S.C. § 315(b). Congress also provided that the Director’s determination ‘whether to institute an inter partes review under this section shall be final and nonappealable.’ Id. § 314(d). The question before us is whether the bar on judicial review of institution decisions in § 314(d) applies to timebar determinations made under § 315(b). In *Achates Reference Publishing, Inc. v. Apple Inc.*, 803 F.3d 652, 658 (Fed. Cir. 2015), a panel of this court held in the affirmative that a § 315(b) time-bar determination is final and nonappealable under § 314(d). Today, the court revisits this question en banc.”

Holding

“We recognize the strong presumption in favor of judicial review of agency actions. To overcome this presumption, Congress must clearly and convincingly indicate its intent to prohibit judicial review. We find no clear and convincing indication of such congressional intent. We therefore hold that the time-bar determinations under § 315(b) are appealable, overrule *Achates*’s contrary conclusion, and remand these cases to the panel for further proceedings consistent with this opinion.”

DATE

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August 1, 2016	Panel Oral Argument (Part 2)
September 16, 2016	Panel Opinion
October 17, 2016	Wi-Fi One, LLC's Combined Petition for Rehearing En Banc and Panel Rehearing
November 18, 2016	Appellee Broadcom Corporation's Response to Appellant Wi-Fi One, LLC's Combined Petition for Rehearing En Banc and Panel Rehearing
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February 13, 2017	Appellant Wi-Fi One, LLC's Supplemental En Banc Brief
March 15, 2017	Supplemental Brief for Appellee Broadcom Corporation on Rehearing En Banc
March 22, 2017	En Banc Brief for Intervenor Michelle K. Lee, Director, United States Patent and Trademark Office
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January 8, 2018	En Banc Opinion



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Aqua Products, Inc. v. Matal

APPEAL NO.
15-1177**OP. BELOW**
PATO**OPINION**
October 4,
2017**SUBJECT**
Patent**AUTHOR**
O'Malley

Question(s) Presented

“In this appeal, we consider the proper allocation of the burden of proof when amended claims are proffered during inter partes review proceedings (‘IPRs’) under the Leahy-Smith America Invents Act (‘AIA’).”

Holding

“Upon review of the statutory scheme, we believe that [35 U.S.C.] § 316(e) unambiguously requires the petitioner to prove all propositions of unpatentability, including for amended claims.”

DATE

SELECTED PROCEEDINGS AND ORDERS

May 25, 2016

[Panel Opinion](#)

June 6, 2016

[Appellant's Petition for Rehearing En Banc](#)

July 6, 2016

[Response to the Petition for Rehearing En Banc for Intervenor](#)

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[Order On Petition for Rehearing](#)September 26,
2016[Supplemental Brief for Appellant Aqua Products, Inc. on Rehearing En Banc](#)**MASIMO 1057**
Masimo v. Apple
IPR2023-00728

October 26, 2016

[Supplemental Brief on Rehearing En Banc for Intervenor](#)



November 10, 2016

[Corrected Supplemental Reply Brief for Appellant Aqua Products, Inc. on Rehearing En Banc](#)

December 9, 2016

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October 4, 2017

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Medicines Company v. Hospira, Inc.

APPEAL NO.
14-1469, 14-
1504

OP. BELOW
DCT

OPINION
July 11, 2016

SUBJECT
Patent

AUTHOR
O'Malley

Question(s) Presented

“Today, we consider the circumstances under which a product produced pursuant to the claims of a product-by-process patent is ‘on sale’ under 35 U.S.C. § 102(b). This is important because, if ‘on sale’ more than one year before the filing of an application for a patent on the governing claims, any issued patent is invalid and the right to exclude others from making, using, and selling the resulting product is lost.”

Holding

“We conclude that, to be ‘on sale’ under § 102(b), a product must be the subject of a commercial sale or offer for sale, and that a commercial sale is one that bears the general hallmarks of a sale pursuant to Section 2-106 of the Uniform Commercial Code. We conclude, moreover, that no such invalidating commercial sale occurred in this case. . . . [W]e first clarify that the mere sale of manufacturing services by a contract manufacturer to an inventor to create embodiments of a patented product for the inventor does not constitute a ‘commercial sale’ of the invention. We then address the issue of ‘stockpiling’ by an inventor and clarify that ‘stockpiling’ by the purchaser of manufacturing services is not improper commercialization under § 102(b). We explain that commercial benefit—even to both parties in a transaction—is not enough to trigger the on-sale bar of § 102(b); the transaction must be one in which the product is ‘on sale’ in the sense that it is ‘commercially marketed.’”

DATE

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March 6, 2015

Panel Oral Argument

MASIMO 1057
Masimo v. Apple
IPR2023-00728

July 2, 2015

Panel Opinion



July 31, 2015

Combined Petition for Panel Rehearing and Rehearing En Banc

September 8, 2015

Defendant-Cross-Appellant Hospira, Inc.'s Opposition to
Petition for Rehearing En Banc

November 13, 2015

Order On Petition for Panel Rehearing and Rehearing En Banc

January 11, 2016

Principal Brief of Defendant-Cross-Appellant Hospira, Inc. in
Response to the Court's November 13, 2015 Order

February 24, 2016

En Banc Brief of Plaintiff-Appellant The Medicines Company

March 14, 2016

Reply Brief of Defendant-Cross-Appellant Hospira, Inc. in
Response to the Court's November 13, 2015 Order

May 5, 2016

En Banc Oral Argument

July 11, 2016

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Lexmark Int’l, Inc. v. Impression Products, Inc.

APPEAL NO.	OP. BELOW	OPINION	SUBJECT	AUTHOR
14-1617, 14-1619	DCT	February 12, 2016	Patent	Taranto

Question(s) Presented

“We decided to hear this case en banc to consider whether two decisions of this court concerning the uncodified doctrine of patent exhaustion—one decision from 1992, the other from 2001—remain sound in light of later decisions of the Supreme Court.”

Holding

“First, we adhere to the holding of *Mallinckrodt, Inc. v. Medipart, Inc.*, 976 F.2d 700 (Fed. Cir. 1992), that a patentee, when selling a patented article subject to a single-use/no-resale restriction that is lawful and clearly communicated to the purchaser, does not by that sale give the buyer, or downstream buyers, the resale/reuse authority that has been expressly denied. Such resale or reuse, when contrary to the known, lawful limits on the authority conferred at the time of the original sale, remains unauthorized and therefore remains infringing conduct under the terms of [35 U.S.C.] § 271.”

“Second, we adhere to the holding of *Jazz Photo Corp. v. International Trade Comm’n*, 264 F.3d 1094 (Fed. Cir. 2001), that a U.S. patentee, merely by selling or authorizing the sale of a U.S.-patented article abroad, does not authorize the buyer to import the article and sell and use it in the United States, which are infringing acts in the absence of patentee-conferred authority.”

DATE

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March 6, 2015

Panel Oral Argument

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April 14, 2015

Order Sua Sponte Granting Hearing En Banc



June 12, 2015

Brief for Defendant-Appellant Impression Products, Inc. on En Banc Review

August 12, 2015

En Banc Brief for Plaintiff-Cross-Appellant Lexmark International, Inc.

August 27, 2015

Reply Brief for Defendant-Appellant Impression Products, Inc. on En Banc Review

October 2, 2015

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February 12, 2016

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Errata



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SCA Hygiene Products Aktiebolag v. First Quality Baby Products, LLC

APPEAL NO.
13-1564

OP. BELOW
DCT

OPINION
**September
18, 2015**

SUBJECT
Patent

AUTHOR
Prost

Question(s) Presented

“We convene en banc to resolve whether, in light of the Supreme Court’s recent decision in *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962 (2014), laches remains a defense to legal relief in a patent infringement suit.”

Holding

“We conclude that Congress codified a laches defense in 35 U.S.C. § 282(b)(1) that may bar legal remedies. Accordingly, we have no judicial authority to question the law’s propriety.”

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April 8, 2014

Panel Oral Argument

MASIMO 1057
Masimo v. Apple
IPR2023-00728

September 17, 2014 **Panel Opinion**



October 15, 2014 **Combined Petition for Panel Rehearing and Rehearing En Banc of Plaintiffs-Appellants SCA Hygiene Products Aktiebolag and SCA Personal Care, Inc.**

November 4, 2014 **Response of Defendants-Appellees to Combined Petition for Rehearing and Rehearing En Banc**

December 30, 2014 **Order On Petition for Rehearing En Banc**

February 27, 2015 **Non-Confidential En Banc Brief of Plaintiffs-Appellants SCA Hygiene Products Aktiebolag and SCA Personal Care, Inc.**

April 16, 2015 **En Banc Brief of Defendants-Appellees**

May 15, 2015 **En Banc Reply Brief of Plaintiffs-Appellants SCA Hygiene Products Aktiebolag and SCA Personal Care, Inc.**

June 19, 2015 **En Banc Oral Argument**

September 18, 2015 **En Banc Opinion**



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Lighting Ballast Control LLC v. Philips Electronics North America Corp.

APPEAL NO.
12-1014**OP. BELOW**
DCT**OPINION**
February
21, 2014**SUBJECT**
Patent**AUTHOR**
Newman

Question(s) Presented

“This court undertook rehearing en banc for the purpose of reconsidering the standard of appellate review of claim construction.”

Holding

“[W]e apply the principles of stare decisis, and confirm the Cybor standard of de novo review of claim construction, whereby the scope of the patent grant is reviewed as a matter of law.”

DATE

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July 9, 2012

[Panel Oral Argument](#)

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February 19, 2013

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February 20, 2013

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March 15, 2013

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