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I. Patentability Requirements

A. Prior Art Invalidity

1. Reference Disclosure

a. Disclosure to POSITA

i. Substantial Evidence of Disclosure

"[T]he Board found that it was standard practice in the field to describe lipid particles by the composition of components in the input formulation. The Board further relied on the disclosures of the prior art and the '435 patent itself, as well as the testimony of expert witnesses." "[T]he question for the Board was whether the '554 publication discloses at least one composition that falls within the claimed ranges. The Board weighed the evidence and found, as a factual matter, that the '554 publication disclosed at least one composition that anticipates the claims." ModernaTx, Inc. v. Arbutus Biopharma Corp., 2020-1184, 12/1/21.

2. Anticipation (§ 102)

a. Question of Fact

"Although anticipation is ultimately a question of fact, the Board's predicate decision that the article of manufacture identified in the claim is not limiting was a legal conclusion." In re SurgiSil, L.L.P., 2020-1940, 10/4/21.

b. Claim Interpretation

i. Indefinite Claims

"Importantly, it is not always impossible to adjudicate a prior-art challenge, one way or the other, just because some aspect of a claim renders the claim indefinite. For example, the indefiniteness of one limitation may not preclude the Board from rejecting a challenge by finding that another limitation is missing from the argued prior art and its argued combinations and modifications. In the other direction, if a claim limitation requires alternative limitations A or B, and A is indefinite, but B is not, the Board may well be able to determine that the argued prior art and its argued combinations or modifications cover the B option, thus satisfying the A or B limitation." Intel Corp. v. Qualcomm Inc., 2020-1828, 12/28/21 (citations omitted).

3. Obviousness (§ 103)

"An obviousness determination generally requires a finding that 'all claimed limitations are disclosed in the prior art,' and 'that a person of ordinary skill in the art would have been motivated to combine or modify the teachings in the prior art and would have had a reasonable expectation of success in doing so.'" Univ. of Strathclyde v. Clear-Vu Lighting LLC, 2020-2243, 11/4/21 (citations omitted).

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

i. Prior Art Overlaps with Claimed Range

"Before the presumption of obviousness could be applied, Moderna would have to first show that, despite the lack of an express disclosure in the references, a person of ordinary skill would have nevertheless understood that the '196 PCT and the '189 publication teach or suggest a range for the phospholipid component that overlaps with the claimed range. Moderna has failed to make that threshold showing." ModernaTx, Inc. v. Arbutus Biopharma Corp., 2020-2329, 12/1/21.

ii. Whether All Limitations Disclosed

"Importantly, the claims require that the inactivation is a result of exposing bacteria to 400–420 nm light *without using a photosensitizer*, which is neither taught nor suggested by the prior art of record. We decline Clear-Vu's invitation to read the inactivation limitation in isolation, divorced from the claim as a whole." Univ. of Strathclyde v. Clear-Vu Lighting LLC, 2020-2243, 11/4/21 (emphasis in original).

b. Motivation/Apparent Reason to Combine/Modify

i. Chemical Subject Matter

"Substantial evidence supports the Board's finding that the general working conditions disclosed in the prior art did not encompass the claimed invention, i.e., there was no overlap in ranges." Teva Pharms. USA, Inc. v. Corcept Therapeutics, Inc., 2021-1360, 12/7/21.

"Then the question would be whether Moderna showed that reaching the claimed ranges for these result-effective variables would have been achievable through routine optimization. Moderna failed to make that showing. Moderna provided evidence of general considerations to be taken into account with respect to each individual component. But Moderna's evidence failed to address the interdependence of the claimed lipid components and how adjustments would affect the nucleic acid-lipid particle as a whole." ModernaTx, Inc. v. Arbutus Biopharma Corp., 2020-2329, 12/1/21.

c. Reasonable Expectation of Success

i. Based on Combined References

"[N]either [combined reference] provides a skilled artisan with any evidence or data or other promising information showing successful [claimed result]. These references thus contain no suggestion that a skilled artisan would reasonably expect that [claimed composition] could be [claimed result]." Univ. of Strathclyde v. Clear-Vu Lighting LLC, 2020-2243, 11/4/21.

"In this case, where the prior art evidences only failures to achieve that at which the inventors succeeded, no reasonable fact finder could find an expectation of success based

on the teachings of that *same* prior art." Univ. of Strathclyde v. Clear-Vu Lighting LLC, 2020-2243, 11/4/21 (emphasis in original).

ii. Specific Claim Limitations

"The Board did not err by requiring Teva to show a reasonable expectation of success for a specific mifepristone dosage. The reasonable-expectation-of-success analysis must be tied to the scope of the claimed invention." "Teva was required to prove a reasonable expectation of success in achieving the specific invention claimed, a 600 mg dosage." Teva Pharms. USA, Inc. v. Corcept Therapeutics, Inc., 2021-1360, 12/7/21.

d. Teaching Away

"Although true [that the reference] itself does not contain explicit disparagement of the control formulations, the district court properly relied on expert testimony regarding how a skilled artisan would interpret the data in [the reference] to find implicit disparagement. Indeed, whether a reference teaches away must be determined from the viewpoint of a skilled artisan. And, as discussed above, the district court credited [the expert]'s testimony that a person of ordinary skill in the art would have known that the control formulations were unsuitable for further experimentation, thus "discouraging investigation into" these formulations." AstraZeneca AB v. Mylan Pharms. Inc., 2021-1729, 12/8/21.

B. Invalidity Based on § 112

1. Written Description (¶ 1)

a. Genus Disclosure Supporting Sub-Genus or Species Claim

"The '514 Patent, as issued, features multiple claims that are drawn exclusively to the specific DMF480 dose, but the specification's focus on basic research and broad DMF-dosage ranges show that the inventors did not possess a therapeutically effective DMF480 dose at the time of filing in 2007." Biogen Int'l GmbH v. Mylan Pharms. Inc., 2020-1933, 11/30/21.

"[T]he district court did not clearly err in finding that a skilled artisan would not have recognized, based on the single passing reference to a DMF480 dose in the disclosure, that DMF480 would have been efficacious in the treatment of MS, particularly because the specifica-tion's only reference to DMF480 was part of a wide DMF-dosage range and not listed as an independent therapeutically efficacious dose." Biogen Int'l GmbH v. Mylan Pharms. Inc., 2020-1933, 11/30/21.

b. Original Claims

"[T]he range was not expressly claimed in the '571 application; if it had been, that could have constituted written description support." Indivior UK Ltd. v. Dr. Reddy's Lab'ys S.A., 2020-2073, 11/24/21.

c. Claimed Measurement Range

"We have said that it is not necessary that the limitations of a claim be set forth in haec verba, id. at 1352, or, presumably, in the case where numbers, not words, are at issue, in haec numera. But the specification must indicate with some clarity what the claim recites. In the case of a claimed range, a skilled artisan must be able to reasonably discern a disclosure of that range." Indivior UK Ltd. v. Dr. Reddy's Lab'ys S.A., 2020-2073, 11/24/21.

"[The specification has particular values, but] these values do not constitute ranges; they are only specific, particular examples. For written description support of a claimed range, more clarity is required." Indivior UK Ltd. v. Dr. Reddy's Lab'ys S.A., 2020-2073, 11/24/21.

d. Four Corners v. Expert/Fact Testimony

"[G]iven that claim 8 does not recite a range, but only a specific amount, which can be derived by selection and addition of [specification's disclosure of] the amounts of selected, but identified, components, we accept that there is substantial evidence to support" the Board's finding of written description. Indivior UK Ltd. v. Dr. Reddy's Lab'ys S.A., 2020-2073, 11/24/21.

C. Section 101

1. Case-by-Case Analysis

"While prior cases can be helpful in analyzing eligibility, whether particular claim limitations are abstract or, as an ordered combination, involve an inventive concept that transforms the claim into patent eligible subject matter, must be decided on a case-by-case basis in light of the particular claim limitations, patent specification, and invention at issue." CosmoKey Solutions GmbH & Co. KG v. Duo Security LLC, 2020-2043, 10/4/21.

2. Abstract Idea Exclusion

a. Inventive Concept/Transformation Exception

"[T]hese claims did not recite an inventive concept because the combination of long-standing conventional methods of authentication yielded expected results of an additive increase in security, and nothing in the record suggested an additional technological improvement." CosmoKey Solutions GmbH & Co. KG v. Duo Security LLC, 2020-2043, 10/4/21.

Reversing dismissal under 101 because "[w]hile authentication of a user's identity using two communication channels and a mobile phone was known at the time of the invention, nothing in the specification or anywhere else in the record supports the district court's suggestion that the last four claim steps . . . are conventional." CosmoKey Solutions GmbH & Co. KG v. Duo Security LLC, 2020-2043, 10/4/21.

3. Stage of Case for Determination

a. Motion to Dismiss

i. Nonmovant gets Reasonable Inferences from Specification Language

"The district court erred in its interpretation of this passage [of the specification]. This is particularly so given the procedural posture of Duo's motion for judgment under Rule 12(c), which requires the district court to draw all reasonable inferences in favor of CosmoKey." CosmoKey Solutions GmbH & Co. KG v. Duo Security LLC, 2020-2043, 10/4/21.

II. Other Defenses

A. Improper Venue

1. Mandamus

"Unlike with motions to transfer under § 1404(a), mandamus ordinarily is unavailable for immediate review of rulings on motions asserting lack of venue under § 1400(b), because a post-judgment appeal generally is an adequate remedy for such violations." In re Medtronic, Inc., p. 4, 2022-107, 12/27/21 (nonprecedential).

2. Employee Locations

"Celgene instead points to a roster of employees who live in the state, a handful of business cards with employee names and New Jersey home addresses, and two LinkedIn profiles mentioning New Jersey. Without more, this is all too speculative to show ratification of those addresses as MPI's or Mylan Inc.'s places of business (much less that the employees themselves regularly conducted business specifically at their homes)."" Evidence of "two small storage lockers rented by MPI sales or marketing employees to store product samples" also insufficient. Celgene Corp. v. Mylan Pharms. Inc., 2021-1154, 11/5/21.

3. Corporate Affiliates

"[I]t might be that a parent corporation might specifically ratify a subsidiary's place of business, even if the two do maintain corporate separateness." Celgene Corp. v. Mylan Pharms. Inc., 2021-1154, 11/5/21.

"[A] subsidiary's presence isn't imputed to a parent for venue unless the parties 'disregarded the corporate form in their dealings with their respective subsidiaries and affiliates.' And that wasn't shown, the district court concluded. We agree." Celgene Corp. v. Mylan Pharms. Inc., 2021-1154, 11/5/21.

4. ANDA-Based Complaints

Location notice letter does not include that jurisdiction as one where an act of infringement occurred because "[u]nder the statute and regulations, then, receipt of the notice letter occurs after and apart from the submission of the ANDA." Celgene Corp. v. Mylan Pharms. Inc., 2021-1154, 11/5/21.

III. Literal Infringement

A. Summary Judgment/JMOL

1. Section 112, Paragraph 6 Limitations

SJ affirmed where "the identified structure from the specification is a "very detailed" algorithm. That algorithm includes numerous steps necessary for its function. [And patentee] neglected to address a significant fraction of that structure." "[Patentee's] infringement expert instead discussed the accused technology at only a generalized level and didn't at all discuss at least nine entire steps of the algorithm." Traxcell Techs., LLC v. Sprint Comm's Co., 2020-1852, 10/12/21.

2. Attorney Argument v. Evidence

"[Patentee's] unexplained listing of accused elements that purportedly send, receive, generate, store, or use a wireless device's location is insufficient to create a genuine issue of material fact." Traxcell Techs., LLC v. Sprint Comm's Co., 2020-1852, 10/12/21.

IV. DOE Infringement

A. Prosecution History Bar

1. Argument Estoppel

a. Matching Prosecution Disclaimer

"Traxcell's first challenge to the application of prosecution-history estoppel is its contention that nothing was surrendered at all. We disagree with Traxcell, as explained in our claim-construction analysis." Traxcell Techs., LLC v. Nokia Solutions & Networks Oy, 2020-1852, 10/12/21.

V. Relief

A. Attorneys' fees

1. Exceptional Case (§ 285)

a. Against Patentee

i. Other Patentee Enforcement

"That [patentee] made representations in bad faith that it held a valid patent was within the district court's "equitable discretion" to consider as part of the totality of the circumstances of [patentee]'s infringement case." Energy Heating, LLC v. Heat On-The-Fly, LLC, 2020-2038, 10/14/21.

ii. Related Applications and Patents

"The district court did not abuse its discretion in finding the later-issued continuation patents (which concern different claims) of little or no relevance to its exceptionality determination." Energy Heating, LLC v. Heat On-The-Fly, LLC, 2020-2038, 10/14/21.

b. Bad Faith Litigation/Litigation Misconduct

"[W]hile the "manner" or "broader conduct" of litigation is relevant under § 285, the absence of litigation *misconduct* is not separately of mandatory weight." Energy Heating, LLC v. Heat On-The-Fly, LLC, 2020-2038, 10/14/21 (emphasis in original).

VI. Claim Construction

A. Special Constructions

1. Design Patent Claim Construction

"A design claim is limited to the article of manufacture identified in the claim; it does not broadly cover a design in the abstract." In re SurgiSil, L.L.P., 2020-1940, 10/4/21.

B. Claim Language

1. Plain and Ordinary Meaning

a. Exceptions

"[Appellee] argues that this "ordinary meaning" controls absent lexicography or disclaimer. We disagree, as this narrow view of our precedent would necessitate adopting an acontextual construction of this disputed claim term." AstraZeneca AB v. Mylan Pharms. Inc., 2021-1729, 12/8/21 (citations omitted).

2. Open/Closed Claims, Generic and Negative Limitations

a. Multiple Word Limitations Including Modifiers

"[I]t is not always appropriate to break down a phrase and give it an interpretation that is merely the sum of its parts." Intel Corp. v. Qualcomm Inc., 2020-1664, 12/28/21.

b. Range Limitations and Measurements

Court considered "whether the concentration of PVP being "0.001%" means 0.001% within one significant figure—encompassing a concentration of PVP in the range of 0.0005% to 0.0014%, [or] precisely 0.001% w/w PVP with only "minor variations,"" and adopted "construe[d] "0.001%" as that precise number, with only minor variations, i.e., 0.00095% to 0.00104%." AstraZeneca AB v. Mylan Pharms. Inc., 2021-1729, 12/8/21.

3. Fuzzy Language: About, Approximately, Substantially.

a. Information limitations

"[L]ocation and distance from a point are different, the court concluded. We agree." Traxcell Techs., LLC v. Sprint Comm's Co., 2020-1852, 10/12/21.

4. Effect of Other Limitations in Claim

a. No Surplusage

"[B]ecause every buffer in our (physical) world is ultimately implemented on a physical device (i.e., hardware), a "hardware buffer" must mean something more than just a "buffer implemented in hardware," as Intel urges, or else the word "hardware" would be erased from the claims." Intel Corp. v. Qualcomm Inc., 2020-1828, 12/28/21.

b. Different terms have the same meaning

Construing different terms the same proper "where the various claims all just seem to say the same thing differently phrased." Traxcell Techs., LLC v. Nokia Solutions & Networks Oy, 2020-1852, 10/12/21.

C. Written Description

1. Lexicography

a. Definition by Contrast

Claimed term RFIS found to exclude IF in part because "[a]s background, [the specification discusses RFIS and IF] This statement doesn't describe an intermediate frequency as a species of "radio frequency input signal." Rather, it uses a distinct label, "intermediate frequency (IF)."" Intel Corp. v. Qualcomm Inc., 2020-1664, 12/28/21.

2. Background

"As background, it states: [] This statement doesn't describe an intermediate frequency as a species of "radio frequency input signal." Rather, it uses a distinct label, "intermediate frequency (IF)."" Intel Corp. v. Qualcomm Inc., 2020-1664, 12/28/21.

D. Prosecution History

1. Issuing Application

a. Changes Meaning

i. All Claims Affected

Where "the applicant argued that its claimed invention . . . operated "without the limitation of a 'grid pattern,'" the Court concluded that "[i]n view of the prosecution history, the disclaimer here was clear and unmistakable." The Court affirmed the expressly negative construction of ""location" to mean a "location that is not merely a position in a grid pattern."" Traxcell Techs., LLC v. Nokia Solutions & Networks Oy, 2020-1852, 10/12/21.

E. Timing of Construction and Parties' Positions

1. Agreed and Proposed Constructions

"[Patentee] insists in retrospect that this construction was wrong. But having stipulated to it, [patentee] cannot pull an about-face." Traxcell Techs., LLC v. Sprint Comm's Co., 2020-1852, 10/12/21.

VII. Procedural Law

A. Arbitration

1. Agreement to Arbitrate

"Absent that clear and unmistakable delegation, the issue of arbitrability should be decided by a court." ROHM Semiconductor USA, LLC v. MaxPower Semiconductor, Inc., 2021-1709, 11/12/21.

"Virtually all courts to consider the question, including this court, have concluded that, in contracts between sophisticated parties, incorporation of rules with a provision on the subject is normally sufficient "clear and unmistakable" evidence of the parties' intent to delegate arbitrability to an arbitrator." ROHM Semiconductor USA, LLC v. MaxPower Semiconductor, Inc., 2021-1709, 11/12/21.

B. Construction

1. Contracts/Orders

a. Incorporated Provisions

"In contracts between sophisticated parties, it is fair to hold the parties to all provisions of their contract, including those incorporated by reference." ROHM Semiconductor USA, LLC v. MaxPower Semiconductor, Inc., 2021-1709, 11/12/21.

C. Pleadings/Parties

1. 12(b)(6) Dismissals

"[Appellant]'s remaining relevant allegations are . . . too conclusory." Celgene Corp. v. Mylan Pharms. Inc., 2021-1154, 11/5/21.

VIII. Federal Circuit Appeals

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

1. District Court/ITC Appeals

a. Judicial Estoppel

Under Second Circuit law, an earlier argument that "allegations of trade secret misappropriation and the willful nature of patent infringement were related to the NDA because they were premised on the disclosure of the confidential information covered by the NDA" was not sufficiently inconsistent with a later argument that "the NDA . . . is not related to patent validity disputes at the Board." Kannuu Pty Ltd. v. Samsung Elecs. Co., 2021-1638, 10/7/21.

b. Arguments Not in Granted/Denied Motion on Appeal

i. Summary Judgment

Rejecting challenge to summary judgment based on evidence where "that evidence seems to be from another case entirely (one not even involving the Ericsson C-SON). We agree with Verizon that it is puzzling how it could be error for the district court not to account for this evidence." Traxcell Techs., LLC v. Sprint Comm's Co., n.8, 2020-1852, 10/12/21 (citations omitted).

B. Appellate Jurisdiction

1. Final Judgment

a. Denial of Motion on the Pleadings

Reversing denial of section 101 motion on the pleadings rather than reviewing subsequent grant of motion for summary judgment on noninfringement. CardioNet, LLC v. InfoBionic, Inc, 2020-2123,10/29/21 (nonprecedential).

2. Mootness

"Because Apple's injury disappeared before it invoked our jurisdiction, Apple's problem is lack of standing at the outset of the appeal, not mootness." Apple Inc. v. Qualcomm Inc., 2020-1683, 11/10/21.

"And even if this could be framed as mootness, vacatur would still be inappropriate because the jurisdiction-destroying event is a settlement Apple voluntarily entered." Apple Inc. v. Qualcomm Inc., 2020-1683, 11/10/21.

"[W]e are not persuaded that an impact on other cases between Acceleration Bay and third parties confers jurisdiction." Acceleration Bay LLC v. 2K Sports, Inc., 2020-1700, 10/4/21.

"It is well established that an appeal should be dismissed as moot when it is impossible to grant the appellant "any effectual relief whatever."" Acceleration Bay LLC v. 2K Sports, Inc., 2020-1700, 10/4/21 (quoting *Nasatka v. Delta Sci. Corp.*, 58 F.3d 1578, 1580 (Fed. Cir. 1995) (citation omitted)).

a. Issues Relevant to Attorneys' Fees

In *Nasatka*, we rejected the appellant's argument that the appeal was not moot because a favorable ruling would impact the parties' positions on the appellee's then-pending motion for attorney fees under 35 U.S.C. § 285. We discern no reason to decide otherwise here." Acceleration Bay LLC v. 2K Sports, Inc., 2020-1700, 10/4/21.

"Acceleration Bay argues that this court's reversal on the "final assembler" issue would grant Acceleration Bay effectual relief, and thereby avoid mootness, because it would help Acceleration Bay oppose Take Two's forthcoming "exceptional case motion." We are not persuaded." Acceleration Bay LLC v. 2K Sports, Inc., 2020-1700, 10/4/21.

3. Standing to Appeal

a. Appeals of Post-Grant Challenges

"[A] party's participation in the underlying IPR before the Board is insufficient by itself to confer standing on that party to appeal the Board's decision to this Article III court." ModernaTx, Inc. v. Arbutus Biopharma Corp., 2020-1184, 12/1/21.

"[Appellant] must show that standing existed at the time it filed its appeal and has continued to exist at all times throughout the appeal." ModernaTx, Inc. v. Arbutus Biopharma Corp., 2020-1184, 12/1/21.

i. Appellant-Licensee

"Even if the '435 patent was the only patent that Moderna had licensed under the Acuitas sublicenses, Moderna's evidence of financial burdens from the validity of that patent is too speculative." "Moderna concedes that the last milestone payment it made under the Acuitas sublicenses was approximately five years earlier, and Mr. Ryan's declaration states only that Moderna would have to make an additional milestone payment "if and when" a future milestone is reached."" ModernaTx, Inc. v. Arbutus Biopharma Corp., 2020-1184, 12/1/21.

"Moderna has provided no evidence as to how, if at all, its obligations under the Acuitas sublicenses would change if it is successful in its attempts to have the '435 patent declared invalid while the remaining licensed patents continue to exist. Thus, Moderna has failed to meet its burden of demonstrating that it suffers an injury from the existence of the '435 patent, or that any such injury would be redressed by invalidation of that patent." ModernaTx, Inc. v. Arbutus Biopharma Corp., 2020-1184, 12/1/21.

ii. General Statements of Portfolio Coverage

Standing found based on declaration that "listed a series of public statements made by [patentee] in 2017 regarding the alleged extensive scope of its patent coverage over virtually all lipid nanoparticle ("LNP") delivery systems." "[O]n the record before us, Moderna has demonstrated enough of a risk that it will be faced with an infringement suit based on the combination of its own activities in developing the COVID-19 vaccine, Arbutus's broad public statements about its extensive patent coverage in this area, and Arbutus's refusal to grant a covenant not to sue." ModernaTx, Inc. v. Arbutus Biopharma Corp., 2020-2329, 12/1/21.

iii. Suits Against Others

"Qualcomm initiated actions against Apple Inc. (not party to this appeal) in district court and at the International Trade Commission (ITC), alleging that Apple infringed the '949 patent (and other patents) by making, selling, and using iPhone models that incorporated baseband processors made by Intel." Court found enough facts for standing even though "Intel has only shown that it manufactures the claimed "secondary processor" of the '949 patent's claimed inventions, not all the components required by the claims, given the centrality of that component to the claims, the possibility of direct infringement suits based on product testing, and the possibility of indirect infringement suits based on at least inducement." Intel Corp. v. Qualcomm Inc., 2020-1828, 12/28/21 (see also Intel Corp. v. Qualcomm Inc., 2020-1664, 12/28/21).

C. Sanctions/Contempt

"We generally have authority to award appellate fees under § 285." "Federal Circuit Rule 47.7, which requires here that "the application must be made within thirty (30) days after

entry of the judgment or order denying rehearing, whichever is later."" Energy Heating, LLC v. Heat On-The-Fly, LLC, 2020-2038, 10/14/21.

D. Standards of Review and Record/Appendix on Appeal

1. Clear/Plain Error Review

a. Witness Credibility

"Courts of appeals cannot reweigh a district court's assessment of witness credibility and must take into account the "unchallenged superiority" of a district court's ability to make witness-credibility determinations and findings of fact." Biogen Int'l GmbH v. Mylan Pharms. Inc., 2020-1933, 11/30/21 (quoting *Salve Regina Coll. v. Russell*, 499 U.S. 225, 233 (1991)).

E. Remand Determination

1. Judicial Notice on Appeal

"Here, many of the proffered documents were published in the Federal Register or on the USPTO's website. Other agency documents were obtained through a Freedom of Information Act ("FOIA") request. One document is a report from the Congressional Research Service. These types of government documents are capable of being "accurately and readily determined from sources whose accuracy cannot reasonably be questioned." Mobility Workx, LLC v. Unified Patents, LLC, 2020-1441, 10/13/21.

IX. Patent Office Proceedings

A. Inter Partes Review

1. Constitutionality

"The leadership APJs' role in budgeting is therefore too remote to constitute a due process violation." Mobility Workx, LLC v. Unified Patents, LLC, 2020-1441, 10/13/21.

"It follows that constitutional challenges to the statute under which the agency operates need not be raised before the agency." "[C]ongressional control of the USPTO's budget renders any agency interest in fee generation too tenuous to constitute a due process violation." Mobility Workx, LLC v. Unified Patents, LLC, 2020-1441, 10/13/21.

"[Appellant] does not dispute that APJs have access to non-AIA work or that there is sufficient non-AIA work for APJs to meet the 84 decisional unit threshold for additional compensation. Thus, even if there were an incentive to institute AIA proceedings to earn decisional units, any interest APJs have in instituting AIA proceedings to earn decisional units would be too remote to constitute a due process violation." Mobility Workx, LLC v. Unified Patents, LLC, 2020-1441, 10/13/21.

2. Institution

a. Forum Selection Clauses

"The underlying question that this case presents is one of first impression: Does the forum selection clause in the non-disclosure agreement between the entities prohibit Samsung from petitioning for *inter partes* review of Kannuu's patents at the Board?" "The district court correctly concluded that the inter partes review proceedings "do not relate to the Agreement itself," "[n]or do the [inter partes review] proceedings relate to transactions contemplated under the Agreement." This is because, the district court explains, "the Agreement implicates confidentiality and not the intellectual property rights of the parties."" Kannuu Pty Ltd. v. Samsung Elecs. Co., 2021-1638, 10/7/21 (citations omitted).

"[T]he mere possibility of some factual relevancy between the allegations of breach of the NDA and potential evidence in the inter partes review—is too attenuated to place the inter partes review petitions within the scope of an agreement that was always about protecting confidential information and was never about patent rights." Kannuu Pty Ltd. v. Samsung Elecs. Co., 2021-1638, 10/7/21.

3. Appeal

a. Standard for Reviewing Findings

"Given that the Board's stated reason for discrediting this written testimony is unsupported by the record before us, we see no reason to 'defer[] to the special province of the Board to exercise its discretion concerning the credibility of expert witnesses'" Univ. of Strathclyde v. Clear-Vu Lighting LLC, 2020-2243, 11/4/21.

4. Scope of Estoppel

"[T]hat obligation does not mean that the Board must reach a determination of the patentability of a claim on the presented prior-art grounds if such a determination is rendered impossible because of the indefiniteness of an essential claim limitation. In such a case, the statutory estoppel provision of 35 U.S.C. § 315(e) does not apply, because the problem of indefiniteness is one of the patentee's own making, not attributable to the challenger." Intel Corp. v. Qualcomm Inc., 2020-1828, 12/28/21 (citations omitted).

B. Appeals to District Court Under Sections 145 and 146

"We affirm the district court's denial of expert fees because § 145 does not specifically and explicitly shift expert witness fees." Hyatt v. Hirshfeld, 2020-2321, 8/18/21 (modified opinion with the same language issued 10/12/21).