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I. Patentability Requirements

A. Inventorship/Invention and Priority Dates

1. Reduction to Practice

a. Constructive

“An asserted prior art reference can be antedated based on a constructive reduction to practice by a showing of (1) conception prior to the filing date of the asserted reference and (2) reasonably continuous diligence from just before the date the asserted reference was filed until the date that the patent owner filed its priority application.” *Medtronic, Inc. v. Teleflex Life Scis. Ltd.*, 2022-1721, 11/16/23.

B. Prior Art Invalidity

1. Reference Disclosure

a. Disclosure to POSITA

i. Expert Testimony

“Cross-Appellants’ expert, Dr. Kakaes, explained that a skilled artisan would have understood Chen’s selective transmission of selected code symbols from certain generators to refer to puncturing Despite Sisvel’s arguments to the contrary, Chen’s disclosure and Dr. Kakaes’s testimony are substantial evidence supporting the Board’s finding that Chen teaches the “second puncturing pattern” limitation.” *Sisvel Int’l S.A. v. Sierra Wireless, Inc.*, 2022-1493, 10/6/23 (citation omitted).

2. Obviousness (§ 103)

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

i. Level of Abstraction in Framing Obviousness

“We have made clear that “where the relevant factual inquiries underlying an obviousness determination are otherwise clear,” characterizing references “as ‘primary’ and ‘secondary’ is merely a matter of presentation with no legal significance.”” *Schwendimann v. Neenah, Inc.*, 2022-1333, 10/6/23.

ii. Common Sense Changes / Design Choices

“The Board found a skilled artisan would understand that an image printed on a Kronzer transfer sheet containing white pigment must be positioned to be on top of the white layer to avoid obscuring the image Again, the Board’s analysis is sound, and substantial evidence supports the Board’s finding that a skilled artisan would use their common sense when making the proposed combination to arrive at an operable transfer sheet.” *Schwendimann v. Neenah, Inc.*, 2022-1333, 10/6/23.

b. Analogous Prior Art

“Prior art references are applicable to the obviousness inquiry only when they are analogous to the claims being challenged.” *Corephotonics, Ltd. v. Apple Inc.*, No. 2022-1340, 10/16/23.

c. Motivation/Apparent Reason to Combine/Modify

i. Compared to Analogous Art Requirement

“[M]erely assertions that the references were analogous art, which, without more, is an insufficient articulation for motivation to combine.” *Sisvel Int’l S.A. v. Sierra Wireless, Inc.*, 2022-1493, 10/6/23.

ii. Evidence of Reasons to Combine

“The Board found that each of Cross-Appellants’ ten reasons for combining Chen and GSM “[did] not suffice as an articulated reason with a rational underpinning to combine the respective teachings of the references.” That finding was more than reasonable in this case, where Cross-Appellants’ proposed combinations and rationales were expressed at such a nonspecific, high level of generality, they never made clear to the Board what portions of the references were being combined and why a skilled artisan would identify those particular elements for a combination.” *Sisvel Int’l S.A. v. Sierra Wireless, Inc.*, 2022-1493, 10/6/23 (citation omitted).

d. Teaching Away

“Although Oez used a white pigment with a cross-linking polymer, it does not discourage a skilled artisan from using the white pigment without a cross-linking polymer or lead the skilled artisan in a direction divergent from the path taken in the Appealed Patents. Thus, Oez’s disclosure is substantial evidence that supports the Board’s finding that Oez does not teach away from the proposed combination.” *Schwendimann v. Neenah, Inc.*, 2022-1333, 10/6/23.

e. Summary Judgment/JMOL

i. Improper to Grant

Appellant asserts that “the district court erred in granting JMOL that the asserted claims are not invalid as obvious because of factual disputes that should have been given to the jury. We agree.” “These underlying findings of fact set the foundation for the ultimate determination of obviousness.” *Cyntec Co. v. Chilisin Elecs. Corp.*, No. 2022-1873, 10/16/23.

C. Invalidity Based on § 112

1. Written Description (¶ 1)

a. Genus Disclosure Supporting Sub-Genus or Species Claim

“Just because the specification states PGGs are useful for the invention does not suggest how PGGs are gelling agents. The disclosure of the application does not reasonably convey to those skilled in the art that the inventor had possession of the claimed drug formula containing PGGs as a gelling agent (aversive agent). In other words, there are insufficient blaze marks.” *Purdue Pharma L.P. v. Collegium Pharm., Inc.*, 2022-1482, 11/21/23.

2. Indefiniteness (¶ 2)

a. Means plus function elements

i. Expert Testimony

“[T]he question presented by this case is whether the specification’s explicit reference to protocol names—which no party disputes refer to protocols known in the art—is sufficient to bring this case into Noah group two. We hold that it is. As such, the Board should have considered the knowledge of a skilled artisan to assess whether the protocol name sufficiently discloses an understood algorithm corresponding to the means-plusfunction limitation.” *Sisvel Int’l S.A. v. Sierra Wireless, Inc.*, 2022-1493, 10/6/23.

ii. Computer-implemented

“[W]here the specification discloses *some* arguable algorithm, even if a party contends that the algorithm is inadequate, the sufficiency of the purportedly-adequate structure disclosed in the specification must be evaluated in light of the knowledge possessed by a skilled artisan.” *Sisvel Int’l S.A. v. Sierra Wireless, Inc.*, 2022-1493, 10/6/23 (emphasis in original).

II. Literal Infringement

A. Summary Judgment/JMOL

1. Role of Claim Construction

The defendant’s noninfringement JMOL argument “turns entirely on its contention that the claims require” some functionality, but the defendant “sought no claim construction on this point. When a claim phrase is not construed, we defer to the jury’s view of the claim element unless that view is contrary to the *only reasonable view* of the claim element.” *VLSI Tech. LLC v. Intel Corp.*, 2022-1906, 12/4/23 (emphasis added).

B. Indirect Infringement

1. Contributory Infringement

a. Substantial Noninfringing Uses

“[S]ubstantial noninfringing use in section 271(c) refers to uses that do not infringe the patent in question, not other patents.” H. Lundbeck A/S v. Lupin Ltd., 2022-1194, 12/7/23.

2. ANDA Infringement

“Our cases establish that “the use . . . claimed in a patent” under section 271(e)(2)(A) must be the use for which an applicant is seeking marketing approval.” H. Lundbeck A/S v. Lupin Ltd., 2022-1194, 12/7/23.

“[W]e do not see how, in the normal course, a label required to market the drug for a use covered by expired patents could demonstrate the required specific intent to encourage infringement of new patents covering different uses.” H. Lundbeck A/S v. Lupin Ltd., 2022-1194, 12/7/23.

“[A] central purpose of the Hatch-Waxman Act is to allow, through the section viii carve out process, the sale of drugs for unpatented uses even though those sales result in some infringing uses. So too, the fact that some individuals may have been influenced by one piece of information from a label required to sell the drug for other purposes does not amount to inducement.” H. Lundbeck A/S v. Lupin Ltd., 2022-1194, 12/7/23 (citation omitted).

III. DOE Infringement

A. Substantial Equivalence

1. Function-Way-Result Test

“Such matching requires that each of function, way, and result be “substantially the same,” with the “way” requirement of particular importance, as a practical matter, in keeping the doctrine properly limited.” VLSI Tech. LLC v. Intel Corp., 2022-1906, 12/4/23 (citation omitted) (quoting *Spectrum Pharms., Inc. v. Sandoz Inc.*, 802 F.3d 1326, 1337 (Fed. Cir. 2015)).

a. Sufficient Evidence

FWR testimony was that the same “requesting” function was provided “in substantially the same way as the claim,” that “in a schematic drawing used to illustrate functions, an engineer could “draw[] . . . [a] line” in different places,” and that “the different functionality-location placements were a “design choice.”” “That testimony is insufficient. It contains no meaningful explanation of why the way in which the request is made is substantially the same as what the claim prescribes.” VLSI Tech. LLC v. Intel Corp., 2022-1906, 12/4/23.

IV. Relief

A. Attorneys' fees

1. Exceptional Case (§ 285)

a. Bad Faith Litigation/Litigation Misconduct

i. Shifting Positions

“We hold that the district court did not abuse its discretion in concluding that PersonalWeb’s position-shifting supported an exceptionality determination.” In re PersonalWeb Techs., LLC, 2021-1858, 11/3/23.

ii. Prolonging Litigation

“[T]he district court did not abuse its discretion when it supported its exceptionality determination on PersonalWeb unnecessarily prolonging the case after claim construction.” In re PersonalWeb Techs., LLC, 2021-1858, 11/3/23.

b. Baseless Claims

“Attorneys’ fees under § 285 are not a penalty for losing a patent infringement suit. It is a form of sanction where, for example, a party advances an argument that is wholly unsupported by the law. Here, a straightforward application of *Kessler* barred PersonalWeb’s claims.” In re PersonalWeb Techs., LLC, 2021-1858, 11/3/23.

i. CVSG on Petition for Cert

“Nor does it matter that, on appeal to the Supreme Court of PersonalWeb I, Solicitor General views were sought. This is a common occurrence. The Supreme Court, however, denied certiorari.” In re PersonalWeb Techs., LLC, 2021-1858, 11/3/23.

2. Amount

Award of over \$5M affirmed. “The district court thoroughly analyzed the extensive record, considered conduct that both supported and detracted from its award of attorneys’ fees, and explained the award’s relation to the misconduct.” In re PersonalWeb Techs., LLC, 2021-1858, 11/3/23.

B. Entire Market Value Rule/Convoyed Sales

1. Apportionment

a. Expert Exclusions

“Because Finjan’s expert admitted that he presented no analysis to assess the value of the sub-features, the district court did not abuse its discretion by concluding that Finjan’s expert failed to carefully tie his analysis to allegedly infringing features and to exclude

value attributable to unpatented features.” *Finjan LLC v. SonicWall, Inc.*, 2022-1048, 10/13/23 (citation omitted).

C. Damages Expert Testimony

1. Excluded

a. Appellate Standard

“In a pretrial motion under Federal Rule of Evidence 702, [appellant] challenged various aspects of the damages analysis set forth by [patentee]’s damages expert, and it made similar arguments in seeking a new trial after the jury verdict. As relevant here, the district court’s denial of both motions is reviewable for abuse of discretion. An abuse of discretion exists, for purposes of this appeal, if the damages analysis departed from an economically sound methodology under the legal principles governing royalty damages, overall and as applied, and if that departure cannot be deemed harmless.” *VLSI Tech. LLC v. Intel Corp.*, 2022-1906, 12/4/23.

b. Inadequate Royalty Base Segregation

“The district court denied [Appellant]’s motion to exclude Mr. Van Uden’s importation calculations This was error. The revenue reported in the customers’ annual reports cited by Mr. Van Uden included sales of irrelevant products and services, and he failed to account for these irrelevant products and services.” “Indeed, no third-party discovery or testing from a technical expert was performed to see if the third-party products contained the accused chokes.” “We are not persuaded . . . that “corroboration” with third party data saves [the] calculations. He applied the Gartner Research data to corroborate only six of the 27 customers.” *Cyntec Co. v. Chilisin Elecs. Corp.*, 2022-1873, 10/16/23.

D. Reasonable Royalty

1. Established and Comparable Royalties/License Agreements

a. Comparability Threshold

License must be sufficiently comparable. “That requirement often precludes use of other licenses that involve (only or even partly) technology other than the patented technology at issue in the case at hand, e.g., where there is an inadequate basis for soundly extracting from such licenses information that is truly informative about the value of the technology in the case at hand.” *VLSI Tech. LLC v. Intel Corp.*, 2022-1906, 12/4/23.

V. Claim Construction

“We decide the proper claim construction in this case de novo, as intrinsic evidence is decisive of the proper construction.” *ABS Global, Inc. v. Cytonome/ST, LLC*, No. 2022-1761, 10/19/23.

A. Claim Language

1. Plain and Ordinary Meaning

a. Multiple Word Limitations Including Modifiers

“Looking at the individual words in the claim, the immediately apparent meaning is that a “pipette guiding mechanism” is a mechanism that guides the pipette. The claim language contains no restrictions that would suggest that the “pipette guiding mechanism” is only manual. Instead, the broad claim language supports the conclusion that the “pipette guiding mechanism” encompasses both manual and automatic embodiments.” *Malvern Panalytical Inc. v. TA Instruments-Waters LLC*, 2022-1439, 11/1/23.

b. Exceptions

i. Lexicography

“[W]e see no indication of any attempt at redefinition . . . [b]efore the EPO, however, [patentee] consistently argued that its view of barcodes was the ordinary meaning.” *K-fee Systems GmbH v. Nespresso USA, Inc.*, 2022-2042, 12/26/23.

ii. Absence of Ordinary Meaning

“In *Indacon*, we held that claim terms that “have no plain or established meaning to one of ordinary skill in the art” “ordinarily cannot be construed broader than the disclosure in the specification.” We have sparingly applied this principle of construction in other cases.” “This analysis, however, does not answer the question of what plain and ordinary meaning a term has in the context of a patent, which is the focus of our analysis.” *Malvern Panalytical Inc. v. TA Instruments-Waters LLC*, 2022-1439, 11/1/23.

2. Open/Closed Claims, Generic and Negative Limitations

a. Identifiers: said, the, a, at least one, each, unitary, plurality, first, member, component, particular

i. One v. one or more v. two or more

“In particular, the singular only meaning is not demanded by the specification’s embodiments, described as nothing more than examples.” “Nor has Cytonome shown an operational impossibility or something comparable that requires rejecting the pluralallowing meaning.” *ABS Global, Inc. v. Cytonome/ST, LLC*, No. 2022-1761, 10/19/23.

ii. Multiple Functions Linked to “a” Limitation

The understanding that the indefinite article a means one or more in open-ended claims containing the transitional phrase comprising “is a separate issue from whether the claims

require the same component to perform multiple functions or satisfy multiple limitations of a claim.” *Finjan LLC v. SonicWall, Inc.*, 2022-1048, 10/13/23.

b. Range Limitations and Measurements

“[T]here is no blanket rule that ranges, or specifically open-ended ranges, must foreclose rounding.” *Actelion Pharms. LTD v. Mylan Pharms. Inc.*, 2022-1889, 11/6/23.

3. Section 112(f)

a. When Applied

i. Overcoming the “means/step” Presumptions

Claim 18’s “physiological sensor means” not subject to 112(f). “The use of “physiological sensor” in claim 1, combined with Masimo’s failure to dispute that claim 1 recites adequate structure, suggests that a skilled artisan would understand the structure of a physiological sensor from the words “physiological sensor” alone. We have determined means-plus-function construction is not appropriate in similar situations where the limitation preceding “means” provides a sufficiently definite structure to a skilled artisan.” *Masimo Corp. v. Sotera Wireless, Inc.*, 2022-1393, 10/24/23 (nonprecedential).

4. Functional v. Structural Language

a. Functional Definitions of Limitations, e.g. “such that,” “by means of”

“The key phrase “by means of” is certainly broad enough to include but for causation. But the phrase is also broad enough to capture mere contribution.” *Cyntec Co. v. Chilsin Elecs. Corp.*, No. 2022-1873, 10/16/23.

b. Appearance

“The evidence persuades us that a relevant artisan identifies a barcode by appearance and not by other criteria such as a particular encoding of data of the sort reflected in the district court’s claim construction.” *K-fee Systems GmbH v. Nespresso USA, Inc.*, 2022-2042, 12/26/23.

5. Fuzzy Language: About, Approximately, Substantially.

a. Selective Usage

“We reject any invitation to create a bright-line rule—either that language like “precisely” or “exactly” is always needed to avoid rounding or that the lack of approximation language, even when it may be found elsewhere in the claims, dictates a precise value.” *Actelion Pharms. LTD v. Mylan Pharms. Inc.*, 2022-1889, 11/6/23.

6. Effect of Other Limitations in Claim

a. Overlap in scope of different limitations

“Although the three phrases share a term, “centerline,” the additional terms (“of the sample stream,” “of the flow channel,” and “of the microfluid channel”) make clear that the phrases as a whole refer to different things (even if they may overlap)—precluding the conclusion of redundancy on which the Board relied.” *ABS Glob., Inc. v. Cytonome/St, LLC*, 84 F.4th 1034, 1042 (Fed. Cir. 2023), No. 2022-1761, 10/19/23.

7. Effect of Other Claims

a. Relationship Between Independent and Dependent Claims

“The lack of weight afforded to the dependent claims is particularly appropriate here because such claims were added after the filing of the original patent application and because the motive for adding such claims appears to be litigation-driven.” *Barrday, Inc. v. Lincoln Fabrics Inc.*, 2022-1903, 11/16/23 (nonprecedential).

B. Written Description

1. Lexicography

a. Requirements

“[3.] The terms storage module and storage capacitance, as used herein, are distinguishable from the terms holding module and holding capacitance, respectively. [4.] Holding modules . . . as used above . . . identify . . . [5.] Storage modules and storage capacitances, on the other hand, refer to systems that store non-negligible amounts of energy from an input EM signal.” “The critical paragraph clearly expresses an intent to define the term “storage element” in sentence 5. Sentence 3 uses the phrase “as used herein” to indicate that the descriptions in sentences 4 and 5 that follow are applicable to the ’551 patent as a whole rather than to a specific embodiment.” “The patentee’s use of the phrases “as used herein” and “refer to” conveys an intent for sentence 5 to be definitional.” “[T]hat this sentence is comparative does not prevent it from being definitional.” *ParkerVision, Inc. v. Vidal*, 2022-1548, 12/15/23.

b. Definition by Contrast

“[T]hat this sentence is comparative does not prevent it from being definitional.” *ParkerVision, Inc. v. Vidal*, 2022-1548, 12/15/23.

2. Differences Between Claim Language and Specification Language

“Waters further invokes the fact that the pipette assembly and stirring motor are automatic. According to Waters, the implication is that the “pipette guiding mechanism” is not automatic since the specification never explicitly describes the “pipette guiding mechanism” as automatic. Our conclusion from this difference, however, is that unlike the

pipette assembly and the stirring motor, the specification describes the guiding mechanism broadly, without limitation to either manual or automatic embodiments” Malvern Panalytical Inc. v. TA Instruments-Waters LLC, 2022-1439, 11/1/23 (citation omitted).

3. Advantages/Purposes/Problems Addressed

Specification disclosures do not support limiting a term to just manual embodiments because “the benefits articulated in these disclosures are consistent with both manual and automatic embodiments of the guiding mechanism.” Malvern Panalytical Inc. v. TA Instruments-Waters LLC, 2022-1439, 11/1/23.

C. Prosecution History

1. Prior Art Provided in IDS

“[M]erely listing the ’782 patent office actions in the IDS of the ’175 patent supplemental examination was insufficient to inform the meaning of “pipette guiding mechanism” in the unrelated ’175 and ’549 patents.” Malvern Panalytical Inc. v. TA Instruments-Waters LLC, 2022-1439, 11/1/23.

2. Foreign Counterparts

District court negative limitation based on EPO statements reversed. “[Patentee’s] remarks all suggest that [it] understood the relationship between barcodes and bit codes to be more complex than simply that bit codes cannot be barcodes.” K-fee Systems GmbH v. Nespresso USA, Inc., 2022-2042, 12/26/23.

D. Extrinsic Evidence

1. Proper Reliance Upon

“[T]he claims do not recite just any measurement of 13 or higher; rather they are directed to a pH of 13 or higher. Thus, the district court should consider whether a pH of 13 carries any meaning to a person of ordinary skill in the art as regards precision of measurement, significant digits, or rounding.” “[T]he specification supplies the same clarity as to the desired level of precision as muddied water.” “Here, the prosecution history does not provide clarity.” “We find that this case is one where the proper claim construction cannot be reached without the aid of extrinsic evidence, and that the district court should have considered, at minimum, the textbook excerpts offered and addressed by the parties.” Actelion Pharms. LTD v. Mylan Pharms. Inc., 2022-1889, 11/6/23.

E. Related Case Constructions

“Nor do we find the analysis proffered in related district court litigations to be persuasive.” “The analysis in these district court proceedings does not alter our conclusion that the Board arrived at the correct construction for the term “storage element.”” ParkerVision, Inc. v. Vidal, 2022-1548, 12/15/23.

F. Timing of Construction and Parties' Positions

1. Agreed and Proposed Constructions

“We do not permit parties on appeal to raise claim construction arguments challenging a stipulated construction.” *Finjan LLC v. SonicWall, Inc.*, 2022-1048, 10/13/23.

VI. Procedural Law

A. Preclusion

1. Issue Preclusion - Collateral Estoppel

a. Subsequent Reversal or Vacation

“The district court held that the ESET court’s order meant that collateral estoppel required granting judgment of invalidity as to the claims of the ’844, ’780, and ’494 patents. We have since vacated the judgment upon which the district court based its application of collateral estoppel. We cannot uphold applying collateral estoppel based on a vacated judgment.” *Finjan LLC v. SonicWall, Inc.*, 2022-1048, 10/13/23 (citations omitted).

B. Privilege and Attorney/Client Issues

1. Disqualification of Counsel

“Under Fifth Circuit law, the disqualification decision is generally committed to the sound discretion of the district court.” “[W]e cannot say that it was a clear abuse of discretion for the district court to have considered the limited nature of that prior representation and determine, based on the particular facts, that disqualification was not warranted.” *In re LG Elecs. Inc.*, 2023-148, 12/26/23 (nonprecedential).

C. Transfer to New Judge or Venue

“[T]he district court clearly erred in finding that the court congestion factor weighed slightly against transfer.” “In the context in which we confront this error, however, we conclude it is harmless, as we cannot say it would be a clear abuse of discretion to deny transfer to the NDCA even changing this one factor from weighing against transfer to being neutral.” *In re Meta Platforms, Inc.*, 2023-143, 10/30/23 (nonprecedential).

1. Cost of Attendance of Willing Witnesses Factor

“The Fifth Circuit recently rejected similar reasoning in *In re TikTok, Inc.*, 85 F. 4th 352 (5th Cir. 2023). Because most of the potential witnesses here are in Korea and NDCA, transfer would greatly reduce the time and inconvenience of travel. As in TikTok, the presence of some Samsung employees in Eastern Texas, who have no technical knowledge of the accused functionality here, “cannot overcome the immense inconvenience that the majority of relevant witnesses would face if this case were to be tried in” WDTX. *Id.* at

361. The district court thus abused its discretion by not weighing this factor in favor of transfer.” In re Samsung Elecs. Co., 2023-146, 12/18/23 (nonprecedential).

VII. Federal Circuit Appeals

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

1. PTO Appeals

a. New Arguments at the Federal Circuit

“Ms. Schwendimann asserts . . . the argument was indirectly preserved in three ways” “That is plainly not the same as and did not preserve her Primary Reference Argument she now makes on appeal.” “[T]he law is clear that arguments raised to the Board at an oral hearing are not preserved.” “The Board’s “red herring” comment was directed . . . not to her argument on appeal that the Board must justify using Kronzer as the primary reference.” “Ms. Schwendimann does not cite any exceptional circumstances that could warrant consideration of her Primary Reference Argument. Therefore, we hold Ms. Schwendimann forfeited her Primary Reference Argument before this court.” Schwendimann v. Neenah, Inc., 2022-1333, 10/6/23.

2. New Argument in Reply Brief

a. Insufficient Language in Principal Brief

“That page of its opening brief includes the following two sentences on diligence: “In addressing diligence, the Board simply adopted its earlier erroneous diligence analysis in IPR2020-00132. Appx61–62. Therefore, if this Court vacates the Board’s diligence holding in No. 21-2356, it should likewise vacate the Board’s decision here.” “We did not vacate the Board’s diligence holding in that decision, so Medtronic’s condition precedent has therefore not been met. That statement by Medtronic in its opening brief therefore constitutes a clear waiver of its diligence argument.” “Recognizing that we did not address the issue of diligence in the previous Medtronic decisions, Medtronic nevertheless urges us, in its Response to Teleflex’s Citation of Supplemental Authority, to “decide” “the diligence question briefed at pp. 51-71 of Medtronic’s brief in 21-2356.” That is no argument; it is an improper incorporation by reference.” Medtronic, Inc. v. Teleflex Life Scis. Ltd., 2022-1721, 11/16/23 (citations omitted).

“In pursuing this appeal, Medtronic chose to make certain strategic decisions concerning what material to include in its opening brief, and it affirmatively chose not to include developed arguments on diligence.” “It cannot now undo those decisions. We therefore consider Medtronic’s challenges to the Board’s finding of diligence waived.” Medtronic, Inc. v. Teleflex Life Scis. Ltd., 2022-1721, 11/16/23.

B. Appellate Jurisdiction

1. Requirements and Timing for Notice of Appeal

“Purdue also sought Director review of the Final Written Decision which, contrary to Collegium’s argument, was subject to a thirty-day deadline. This tolled Purdue’s time to appeal, and once the Director denied review on February 7, 2022, Purdue timely appealed on February 16, 2022.” *Purdue Pharma L.P. v. Collegium Pharm., Inc.*, n.2, 2022-1482, 11/21/23.

C. Scope of Claim Construction Review

1. Claim Construction Modified on Appeal

a. Affirmed/Reversed Under New Construction

“In many cases involving reversal of a Board claim construction, the appropriate course of action is to vacate the Board’s decision and remand the matter. In some cases, however, . . . it is appropriate to reverse the Board’s determination when the evidence supports only the conclusion that the challenged claims are unpatentable, where no properly raised issues still need to be decided by the Board in order to adjudicate a particular patentability challenge.” *ABS Global, Inc. v. Cytonome/ST, LLC*, No. 2022-1761, 10/19/23 (citation omitted).

Federal Circuit adopted new construction for a claim element and then made factual finding that the construction was met by the prior art. “As the Board found that every other element of claim 1 was disclosed by Simonnet and Cytonome has not meaningfully challenged those findings on appeal, the evidence compels a finding that claim 1 is anticipated.” “Because the uncontested evidence establishes that [the reference] discloses claim 8’s additional limitation, we reverse the Board’s determination and hold that claim 8 is anticipated” *ABS Global, Inc. v. Cytonome/ST, LLC*, No. 2022-1761, 10/19/23.

2. District Court Did Not Address Extrinsic Evidence

“It is not for this court to make those findings in the first instance.” “[W]e leave those and other relevant factual questions that might arise based on the extrinsic evidence, including the three textbooks, for the district court to address in the first instance.” *Actelion Pharms. LTD v. Mylan Pharms. Inc.*, 2022-1889, 11/6/23.

D. Mootness of Appealed Rulings

1. Damages Rulings

Appellant “also challenges the district court’s denial of its motion for JMOL regarding lost profits. Because we vacate the damages award, we need not reach this issue.” *Cyntec Co. v. Chilisin Elecs. Corp.*, n.5 , No. 2022-1873, 10/16/23.

2. Based on Possible Determinations on Remand

“We decline to reach these issues because they will be rendered moot if, on remand, the Board finds Martin is not analogous art.” *Corephotonics, Ltd. v. Apple Inc.*, No. 2022-1340, 10/16/23.

E. Standards of Review and Record/Appendix on Appeal

1. Abuse of Discretion

a. Denial of Daubert Challenge

“An abuse of discretion exists, for purposes of this appeal, if the damages analysis departed from an economically sound methodology under the legal principles governing royalty damages, overall and as applied, and if that departure cannot be deemed harmless.” *VLSI Tech. LLC v. Intel Corp.*, 2022-1906, 12/4/23.

F. Relief Outside Appeal Process

1. Mandamus

a. Non-Precedential Transfer Rulings by Outcome

In re *Sony Interactive Entertainment Inc.*, 2023-144, 10/19/23 (denial).

VIII. Patent Office Proceedings

A. Inter Partes Review

1. Appeal

a. Sufficient Reasoning to Review

Remand where “[w]e are unable to discern if the Board’s error was, in fact, merely typographical and harmless or, instead, a potentially-impactful error of substance.” *Corephotonics, Ltd. v. Apple Inc.*, No. 2022-1340, 10/16/23.

b. Favorable Review of FWD Content

“The Board meticulously considered and addressed each of Ms. Schwendimann’s arguments, explaining why the record contradicted each argument.” *Schwendimann v. Neenah, Inc.*, 2022-1333, 10/6/23.

c. Jurisdiction Over Appeals Challenging PTAB Decisions

i. Petitioner Appeals of Final Written Decision

Argument that future collateral estoppel from the FWD is an injury in fact fails because “collateral estoppel does not apply to non-appealable judgments and the patentee thus

would be able to challenge the examiner’s findings and conclusions in the reexamination proceeding on appeal.” *Allgenesis Biotherapeutics Inc. v. Cloudbreak Therapeutics, LLC*, 2022-1706, 11/7/23.

“[Appellant] asserts it has standing to appeal the Board’s decision based on (1) its potential infringement liability and (2) the Board’s priority determination [regarding Appellee’s claims]. We conclude [Appellant] has failed to meet its burden to establish standing on either ground.” *Allgenesis Biotherapeutics Inc. v. Cloudbreak Therapeutics, LLC*, 2022-1706, 11/7/23.

ii. Standing Evidence

A declaration only identifying “a Phase II clinical trial completed over three years ago and a related 2020 publication” and “conclusory testimony” of “continuing to devote resources to the development of this project,” does not establish the required concrete plans for injury in fact based on future infringement disputes. *Allgenesis Biotherapeutics Inc. v. Cloudbreak Therapeutics, LLC*, 2022-1706, 11/7/23.

2. Supplemental Information/Arguments (e.g., in reply)

“[N]either the petitioner nor the patent owner expressly proposed a pre-institution construction of any claim terms, and the Board’s institution decision did not expressly construe any terms.” “Intel’s reply appropriately responded to ParkerVision’s new [in the POR] claim construction.” “The Board was obligated under *Axonics* to afford Intel the opportunity to respond to this construction.” *ParkerVision, Inc. v. Vidal*, 2022-1548, 12/15/23.

“We begin by further explaining the permissible scope of an IPR petitioner’s reply.” “First, the arguments and evidence in the reply must not be part of a *new* theory of unpatentability. Second, the arguments and evidence in the reply must be *responsive* to the patent owner’s contentions or the Board’s institution decision.” *Corephotonics, Ltd. v. Apple Inc.*, No. 2022-1340, 10/16/23 (emphasis in original).

“The newness restriction . . . we review de novo.” “The responsiveness restriction . . . we review for abuse of discretion.” *Corephotonics, Ltd. v. Apple Inc.*, No. 2022-1340, 10/16/23.

Patent Owner “argue[d] [that the references] were not in the same field of endeavor as the Challenged Patents.” Petitioner “was permitted to respond both by bolstering its field of endeavor argument and by adding that its prior art is pertinent to the problem faced by the inventors of the Challenged Patents.” *Corephotonics, Ltd. v. Apple Inc.*, No. 2022-1340, 10/16/23.

a. Information/Arguments Required in Petition

“The IPR petition, thus, must provide an understandable explanation of the element-by-element specifics of the patentability challenges, including the identification of particular

portions of prior art on which the petitioner is relying.” Corephotonics, Ltd. v. Apple Inc., No. 2022-1340, 10/16/23.

b. Sur-reply

“The Board thus reasonably understood ParkerVision’s excluded sur-reply arguments as offering a new theory of patentability that ParkerVision should have included with its other attacks on Tayloe in its patent owner response, rather than waiting to raise it in a sur-reply.” ParkerVision, Inc. v. Vidal, 2022-1548, 12/15/23.

3. Obviousness Rulings

a. Petition Requirements

“It is not always necessary for a petition to expressly address analogousness. For instance, it may be clear from the petition’s description of the references and the challenged claims that prior art is in the same field of endeavor as the challenged patent, or the pertinence of the prior art to the problem solved by the invention may be implicit in the petition’s discussion of the challenged claims and why a person of ordinary skill would be motivated to combine the prior art references with a reasonable expectation of success.” Corephotonics, Ltd. v. Apple Inc., No. 2022-1340, 10/16/23.

4. Board Final Written Decision

a. New Theories Adopted by Board

“Once an issue is fairly presented in a petition and made the subject of dispute by the patent owner’s response, the Board is free to make its own factual findings grounded in the evidence presented to it, without being bound to choose between the specific positions the parties advocated.” “[T]he Board may resolve an issue the parties put in dispute by making findings supported by the evidence, regardless of whether any party advocated for that particularly expressed finding.” Corephotonics, Ltd. v. Apple Inc., No. 2022-1340, 10/16/23.

b. Addressing Parties’ Arguments

“While the Board should not take an overly mechanistic view of a petition and decline to address an argument because the petitioner did not present it with ideal vigor and clarity, the Board should also not have to decode a petition to locate additional arguments beyond the ones clearly made. A petitioner may not rely on a vague, generic, and/or meandering petition and later fault the Board for failing to understand what the petition really meant.” Netflix, Inc. v. DivX, LLC, 2022-1203, 10/25/23.

c. Covering Claims and Grounds from Petition

“Ultimately, it is the petitioner’s burden to present a clear argument.” Netflix, Inc. v. DivX, LLC, 2022-1203, 10/25/23.

i. Alternative Arguments

“We do not wish to discourage petitioners from making arguments in the alternative. Rather, we emphasize that it is the petitioner’s burden to make clear when alternative arguments are being presented and to sufficiently expound on each one.” *Netflix, Inc. v. DivX, LLC*, 2022-1203, 10/25/23.

d. Indefiniteness

“If the Board finds that the specification lacks a sufficiently disclosed algorithm, the Board should state as much in its decision. It must then proceed to follow the guidance in our opinion in *Intel Corp. v. Qualcomm Inc.*, 21 F.4th 801 (Fed. Cir. 2021).” *Sisvel Int’l S.A. v. Sierra Wireless, Inc.*, 2022-1493, 10/6/23.

B. Post-Grant Reviews

1. Priority Date Requirement

Applications with a priority date before March 16, 2013, are not subject to PGR. *Purdue Pharma L.P. v. Collegium Pharm., Inc.*, 2022-1482, 11/21/23.

2. Timing of Final Written Description

“The statute at issue here does not provide consequences for non-compliance with the deadline. Thus, following the Supreme Court’s rule, the Board has authority to issue a Final Written Decision even after the deadline proscribed in the statute has passed absent any contrary indication in the language, structure, or legislative history of the statute.” “[W]e conclude that the Board’s failure to comply with the statutory deadline does not deprive it of authority thereafter to issue a final written decision.” *Purdue Pharma L.P. v. Collegium Pharm., Inc.*, 2022-1482, 11/21/23.