

Table of Contents

I.	Patentability Requirements	1
A.	Prior Art Invalidity.....	1
1.	Reference Disclosure	1
a.	Inherency.....	1
2.	Anticipation (§ 102).....	1
a.	On Sale Bar	1
i.	Commercial Offer for Sale.....	1
ii.	In This Country	1
3.	Obviousness (§ 103)	1
a.	Differences Between the Prior Art and the Claims at Issue.....	1
i.	Undisclosed Elements and Different Claims	1
b.	Reasonable Expectation of Success	2
i.	Inherent Properties	2
c.	Secondary Indicia of Nonobviousness.....	2
i.	Commercial Success	2
ii.	Unexpected Results.....	2
d.	Subject Matter as a Whole/Routine Additions.....	2
e.	Chemical Compounds.....	2
i.	Lead Compound Analysis.....	2
II.	Other Defenses.....	3
A.	License/Covenant Not to Sue.....	3
III.	Literal Infringement	3
A.	Summary Judgment/JMOL.....	3
1.	Despite Marketing/Promotion Materials.....	3
2.	Despite Expert Testimony.....	3
B.	Indirect Infringement	3
1.	Pleading.....	3
C.	Infringing by Using the Claimed Invention	4
D.	Capability	4
E.	Joint Infringement/Divided Infringement.....	4
1.	Direction or Control.....	4
IV.	DOE Infringement	4
A.	Substantial Equivalence	4
1.	Summary Judgment/JMOL.....	4
a.	Lack of Particularized Testimony and Linking Argument	4
2.	Insufficient Evidence of Equivalence	5
3.	Insubstantial Differences Test.....	5
V.	Relief.....	5
A.	Attorneys' fees	5
1.	Sanctions Under Inherent Powers.....	5
a.	Consideration of Multiple Cases.....	6
2.	Amount	6
B.	Entire Market Value Rule/Convoyed Sales	6
1.	Apportionment	6

a.	Inadequate Evidence	6
C.	Willfulness	6
1.	Opinion of Counsel	6
2.	JMOL/Summary Judgment	6
D.	Injunction	7
1.	ANDA-specific injunctions	7
a.	Orange Book Modifications.....	7
2.	Injunctions Against Other Proceedings	7
a.	Injunctions Against Pursuing Foreign Litigation.....	7
E.	False Marking (35 USC § 292 and Lanham Act § 43(a)).....	8
VI.	Claim Construction	8
A.	Claim Language	8
1.	Open/Closed Claims, Generic and Negative Limitations	8
a.	Comprising.....	8
i.	No negative limitation.....	8
b.	Identifiers: said, the, a, at least one, each, unitary, plurality, first, member, component, particular	8
2.	Fuzzy Language: About, Approximately, Substantially.....	8
a.	Information/Data limitations.....	8
3.	Effect of Other Claims	8
a.	Claim Differentiation	8
i.	Surplusage Rather Than Differentiation	8
B.	Written Description.....	9
1.	Advantages/Goals/Purposes/Problems Addressed.....	9
2.	Background.....	9
3.	Incorporated/Identified Materials	9
C.	Prosecution History.....	9
1.	Priority Applications.....	9
VII.	Procedural Law	9
A.	Applicable Circuit Law.....	9
1.	Rule 12(b)(6) Dismissal.....	9
2.	Antisuit Injunctions.....	10
B.	Preclusion.....	10
1.	Issue Preclusion - Collateral Estoppel	10
a.	Courts, Agencies and Commissions	10
C.	JMOL (Rule 50) / Summary Judgment (Rule 56)	10
1.	Evidence Required to Oppose Summary Judgment.....	10
a.	Reasonable Inference	10
D.	Pleadings/Parties	10
1.	12(b)(6) Dismissals.....	10
a.	Well-pled Factual Allegations	10
b.	Conflicting Pleading Statements.....	10
c.	Claim Construction	11
E.	Discovery/Evidence	11
1.	Expert Testimony.....	11
a.	Copying Report Analysis.....	11

b.	Based on Inadmissible Material.....	11
F.	Transfer to New Judge or Venue	11
1.	Compulsory Process/Unwilling Witness Factor	11
VIII.	Federal Circuit Appeals	12
A.	New Arguments/Issues on Appeal/Forfeiture/Waiver/Judicial Estoppel	12
1.	District Court/ITC Appeals.....	12
a.	Claim Construction Forfeiture/Wiaver	12
i.	Construction Advocated at Markman	12
b.	Arguments Not in Granted/Denied Motion on Appeal.....	12
i.	Summary Judgment	12
B.	Issue Preclusion on Appeal.....	12
1.	Related Appeals	12
C.	Appellate Jurisdiction	13
1.	Final Decision/Judgment	13
a.	Denial of Summary Judgment	13
D.	Sanctions/Contempt	13
E.	Scope of Claim Construction Review.....	13
1.	Implicit Claim Construction Disputes	13
F.	Mootness of Appealed Rulings.....	13
1.	Invalidity Rulings.....	13
G.	Standards of Review and Record/Appendix on Appeal	14
1.	De Novo Review.....	14
a.	Categorizing Complaint Allegations.....	14
2.	Substantial Evidence Threshold.....	14
a.	Expert Testimony.....	14
i.	Not Substantial/Conclusory	14
3.	Clear/Plain Error Review	14
a.	Expert Testimony.....	14
H.	Harmless Error	14
1.	Flawed Claim Construction	14
I.	Remand Determination	15
1.	Resolution in the First Instance.....	15
2.	No Resolution of Issues in the First Instance.....	15
a.	Claim Construction	15
3.	Remand to PTAB to Make Factual Finding	15
IX.	Patent Office Proceedings.....	15
A.	Inter Partes Review	15
1.	Petition Requirements.....	15
2.	Appeal	16
a.	Sufficient Reasoning to Review.....	16
b.	Waiver of issues not included in rehearing request	16
3.	Supplemental Information/Arguments (e.g., in reply).....	16
a.	Information/Arguments Required in Petition	16
b.	POPR, But Not POR.....	16

I. Patentability Requirements

A. Prior Art Invalidity

1. Reference Disclosure

a. Inherency

“While much of our case law on inherency in the chemical and biological fields discusses composition claims, we see no reason that these same guideposts do not apply equally to claims for processes of making those compositions.” *Cytiva BioProcess R&D AB v. JSR Corp.*, n.16, 2023-2074, 12/4/24.

2. Anticipation (§ 102)

a. On Sale Bar

i. Commercial Offer for Sale

“Quotation” found [by Judge Dyk] to be a commercial offer of sale as a matter of law, contrary to the district court’s summary judgment for patentee and without mention of the standard of review for reversing a denial of summary judgment. “[T]he letter was sent specifically to potential-purchaser Complete and signed by Crown’s representative, Adrian Long.” “Moreover, the letter to Complete was sufficiently definite as to the terms of the offer for sale to constitute a commercial offer for sale.” “The district court also concluded that Crown’s express reservation that “[q]uotations . . . are subject to [Crown’s] written acceptance of your order,” precluded Complete from creating a binding contract through acceptance. Our case law, however, counsels against concluding that a term of written acceptance is determinative.” *Crown Pack’g Tech., Inc. v. Belvac Production Machinery, Inc.*, 2022-2299, 12/10/24 (citation omitted).

ii. In This Country

“Our precedent demonstrates that an offer directed to a United States entity at its United States place of business is an offer “made in this country” as required for pre-AIA § 102(b).” *Crown Pack’g Tech., Inc. v. Belvac Production Machinery, Inc.*, 2022-2299, 12/10/24.

3. Obviousness (§ 103)

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

i. Undisclosed Elements and Different Claims

“Because the composition and process claims have no material differences, and because the parties relied on the same arguments before the Board for each of these claims, we see no basis for treating the claims differently here and for finding one set of claims

unpatentable and the other not unpatentable.” Cytiva BioProcess R&D AB v. JSR Corp., 2023-2074, 12/4/24.

b. Reasonable Expectation of Success

i. Inherent Properties

“When claims require prior knowledge of the inherent property—e.g., for motivation to combine—then a petitioner would still generally need to demonstrate a reasonable expectation of success.” “But that situation is different from simply claiming an inherent property of an otherwise obvious composition or process—i.e., one obvious without regard to the property at issue.” Cytiva BioProcess R&D AB v. JSR Corp., 2023-2074, 12/4/24.

c. Secondary Indicia of Nonobviousness

i. Commercial Success

“Bald assertions of commercial success unconnected to the patented features of the claimed invention are not given patentable weight.” Purdue Pharma L.P. v. Accord Healthcare, Inc., 2023-1953, 12/30/24 (nonprecedential).

ii. Unexpected Results

“It is also not unusual that the reasonable expectation-of-success and unexpected-results inquiries may contain similar underlying factual inquiries.” Cytiva BioProcess R&D AB v. JSR Corp., 2023-2074, 12/4/24.

d. Subject Matter as a Whole/Routine Additions

“As a practical matter, a court must normally address one issue at a time, and in patent cases, it is the norm for both parties and courts to discuss disputed claim limitations sequentially.” “Therefore, we disagree that the court erred by failing to address the claims as a whole.” Purdue Pharma L.P. v. Accord Healthcare, Inc., 2023-1953, 12/30/24 (nonprecedential).

e. Chemical Compounds

i. Lead Compound Analysis

“A lead-compound analysis is not required where the prior-art references expressly suggest the proposed modification.” Cytiva BioProcess R&D AB v. JSR Corp., 2023-2074, 12/4/24.

II. Other Defenses

A. License/Covenant Not to Sue

“As patent infringement is the practice of a patent claim without consent of the patentee, the existence of a license, express or implied, provides an affirmative defense to infringement.” *AlexSam, Inc. v. Aetna Inc.*, 2022-2036, 10/8/24.

III. Literal Infringement

“In short, the claims identify the invention. Infringement is a distinct concept with a different statutory basis. Inventors claim what they invent, but infringement occurs when others make, use, or sell the invention without authorization.” *Teva Branded Pharm. Prods. R&D, Inc. v. Amneal Pharms. of N.Y., LLC*, 2024-1936, 12/20/24.

A. Summary Judgment/JMOL

1. Despite Marketing/Promotion Materials

Noninfringement SJ affirmed because claims required full compliance with a limitation and “the cited exhibits and testimony cannot be reasonably understood to establish that generalization.” “Others are nontechnical high-level promotions about the Timeline feature as a whole, not reasonably read as either comprehensive or focused on the specific issue of Timeline Aggregator and Timeline DB.” *Mirror Worlds Techs., LLC v. Facebook, Inc.*, 2022-1600, 12/4/24.

2. Despite Expert Testimony

Affirmed summary judgment where plaintiff’s expert “refers to certain Facebook source code, which is not itself presented to us, and the most specific assertion [plaintiff] makes about the code to support its “glance view” argument is that the code is used “to create a contextual-dialog component containing a member-bio-story component and displays it on hover.” [That expert] testimony does not supply a reasonable basis for finding that the accused systems display an “abbreviated version” of the underlying document indicative of its *content*, as the claim requires.” *Mirror Worlds Techs., LLC v. Facebook, Inc.*, 2022-1600, 12/4/24 (emphasis in original)(citation omitted).

B. Indirect Infringement

1. Pleading

“[W]e do not require patentees to plead that an alleged inducer of infringement had knowledge of the specific patent claims a patentee later asserts in litigation.” *AlexSam, Inc. v. Aetna Inc.*, 2022-2036, 10/8/24.

C. Infringing by Using the Claimed Invention

“Like the customers in *Centillion*, NCR’s merchants put the system into service because they initiate at the POS terminal a demand for service (for example, building or editing a POS) and benefit from the back end providing that service.” “That NCR occasionally provides the POS hardware used by the customer-merchants does not change our view.” *CloudofChange, LLC v. NCR Corp.*, 2023-1111, 12/18/24.

D. Capability

“Provisur proffered no evidence that Weber’s *customers could readily* activate the alleged advance-to-fill functionality. Dr. Vorst testified about configuring the SmartLoader through the HMI, but he had access to screens that Weber’s customers do not.” “Dr. Vorst provided no evidence Weber’s SmartLoader ever was configured to advance-to-fill and no evidence that he configured it to advance-to-fill. He admitted as much Dr. Vorst’s testimony is therefore not substantial evidence demonstrating [the accused product] infringes [the asserted] claim.” *Provisur Techs., Inc. v. Weber, Inc.*, 2023-1048, 10/2/24 (emphasis added).

E. Joint Infringement/Divided Infringement

1. Direction or Control

“NCR does not direct or control its merchants to subscribe to the NCR Silver system, download the NCR Silver app on their POS terminals, or put the NCR Silver system into use by initiating action at the POS terminals to cause the NCR Silver software to modify its POS terminals. NCR’s merchants take these actions of their own accord. That NCR’s Merchant Agreement makes merchants responsible for obtaining and maintaining Internet access does not equate to contractually obligating merchants put the entire accused NCR Silver system into use.” *CloudofChange, LLC v. NCR Corp.*, 2023-1111, 12/18/24.

“[I]n the context of this case, directing the merchants to perform one element of a system claim is not the proper test for analyzing vicarious liability for use of a system claim.” *CloudofChange, LLC v. NCR Corp.*, 2023-1111, 12/18/24.

IV. DOE Infringement

A. Substantial Equivalence

1. Summary Judgment/JMOL

a. Lack of Particularized Testimony and Linking Argument

“Dr. Selker’s testimony never identified a particular element or elements in the My Account App as being equivalent to the “single action” limitation.” “Dr. Selker’s generalized reference to “several button presses” fails to identify what specific elements in the My Account App are allegedly equivalent to the claimed “single action” limitation.” “By itself, the failure to explicitly identify the alleged equivalent is fatal to NexStep’s

doctrine of equivalents theory” NexStep, Inc. v. Comcast Cable Commc’ns, LLC, 2022-1815, 10/24/24.

“NexStep’s final argument is that we should adopt a novel exception to the requirement of particularized testimony and linking argument. According to NexStep, for certain “easily understandable” technologies, a patentee simply need not offer particularized testimony and linking argument from a skilled artisan. We reject this argument because it is contrary to both our precedent and the policies underlying why we require particularized testimony and linking argument.” “Simply put, our precedent requires particularized testimony and linking argument, regardless of the complexity or the simplicity of the underlying technology.” NexStep, Inc. v. Comcast Cable Commc’ns, LLC, 2022-1815, 10/24/24.

2. Insufficient Evidence of Equivalence

“That leaves only [Appellant]’s evidence of bioequivalence, which at most showed substantially the same result. This is insufficient to meet either the “function, way, result” test or the “insubstantial differences” test.” Galderma Lab’ys L.P. v. Lupin Inc., 2024-1664, 12/6/24.

3. Insubstantial Differences Test

“Dr. Selker’s testimony neither particularly identified what specific elements of the accused products are allegedly equivalent to the “single action” limitation nor offered the required testimony explaining why those elements were only insubstantially different in light of the claim language reciting what is being avoided by the “single action.”” “Either of these shortcomings is sufficient to foreclose a verdict of infringement under the doctrine of equivalents.” NexStep, Inc. v. Comcast Cable Commc’ns, LLC, 2022-1815, 10/24/24.

V. Relief

A. Attorneys’ fees

1. Sanctions Under Inherent Powers

“We see no reason to treat sanctions under the court’s inherent power differently from sanctions under Rule 11 or expert fees under the court’s inherent power. We hold the district court can impose sanctions under its inherent power in addition to awarding attorney fees and costs under § 285.” PS Prods., Inc. v. Panther Trading Co., 2023-1665, 12/6/24.

“Given there were no other mechanisms to sanction PSP’s bad faith conduct except the court’s inherent power, the district court acted within its discretion by relying on its inherent power to sanction conduct that would typically fall under Rule 11.” PS Prods., Inc. v. Panther Trading Co., 2023-1665, 12/6/24.

a. Consideration of Multiple Cases

“While the district court did not individually analyze each of the twenty-five lawsuits, it was reasonable given these facts for the district court to infer PSP’s many other lawsuits mirroring this suit’s procedural posture were similarly meritless. Under these circumstances, the district court did not clearly err when it inferred bad faith from PSP’s history of filing meritless lawsuits.” PS Prods., Inc. v. Panther Trading Co., 2023-1665, 12/6/24.

2. Amount

Inadequate analysis of amount being reasonable where “the district court provided no explanation as to why it held Salesforce’s attorneys’ fees to be reasonable, even though the narratives for all of Salesforce’s time entries were redacted.” Applications in Internet Time, LLC v. Sallesforce.com, Inc., 2024-1133, 10/10/24 (citation omitted) (nonprecedential).

B. Entire Market Value Rule/Convoyed Sales

1. Apportionment

a. Inadequate Evidence

“Dr. Vorst testified that the patented features drive the demand or substantially create the value of Weber’s accused products. But Dr. Vorst’s testimony was conclusory and did not provide any evidence, *e.g.*, evidence from customers, to show the patented features drove the demand for the entire slicing line.” “His testimony does not explain why these “conventional” features do not provide any value or drive customer demand.” Provisur Techs., Inc. v. Weber, Inc., 2023-1048, 10/2/24 (citation omitted).

C. Willfulness

1. Opinion of Counsel

“Patentees are prohibited from using the accused infringer’s failure to obtain the advice of counsel as an element of proof that the accused infringer willfully infringed.” “Provisur cannot circumvent § 298 by substituting advice from a third party for advice of counsel.” Provisur Techs., Inc. v. Weber, Inc., 2023-1048, 10/2/24.

2. JMOL/Summary Judgment

“At most, the patent matrix demonstrates Weber’s knowledge of the asserted patents and their relevance to Weber’s business in general.” “Provisur’s evidence as a matter of law is not enough to establish deliberate or intentional infringement.” Provisur Techs., Inc. v. Weber, Inc., 2023-1048, 10/2/24.

D. Injunction

1. ANDA-specific injunctions

a. Orange Book Modifications

For purposes of the orange book statute, “a patent claims the drug when it particularly points out and distinctly claims the drug as the invention.” “[T]o qualify for listing, a patent must claim at least what made the product approvable as a drug in the first place—its active ingredient.” *Teva Branded Pharm. Prods. R&D, Inc. v. Amneal Pharms. of N.Y., LLC*, 2024-1936, 12/20/24.

“When looking at *how* the FDA approves the many different medical products it regulates, it is apparent that a product regulatable and approvable as a drug contains an active ingredient.” *Teva Branded Pharm. Prods. R&D, Inc. v. Amneal Pharms. of N.Y., LLC*, 2024-1936, 12/20/24 (emphasis in original).

“[W]e conclude that a combination product being approved with an NDA does not necessarily make every part of the NDA a drug.” *Teva Branded Pharm. Prods. R&D, Inc. v. Amneal Pharms. of N.Y., LLC*, 2024-1936, 12/20/24.

2. Injunctions Against Other Proceedings

a. Injunctions Against Pursuing Foreign Litigation

“Courts that have analyzed foreign-antisuit-injunction requests have used—at least in substance—the general framework as articulated in the Ninth Circuit’s *Microsoft* opinion.” *Telefonaktiebolaget LM Ericsson v. Lenovo (United States), Inc.*, 2024-1515, 10/24/24.

CAFC vacated denial of injunction based on agreeing that “Ericsson’s FRAND commitment precludes Ericsson from pursuing SEP-based injunctive relief unless it has first complied with the commitment’s obligation to negotiate in good faith over a license to those SEPs. Therefore, the argument goes, whether Ericsson has complied with that obligation—an issue before the district court—is dispositive of Ericsson’s ability to pursue its Colombian and Brazilian injunctions.” *Telefonaktiebolaget LM Ericsson v. Lenovo (United States), Inc.*, 2024-1515, 10/24/24.

“In sum, we conclude that the “dispositive” requirement of the foreign-antisuit-injunction framework is met here. That is because (1) the ETSI FRAND commitment precludes Ericsson from pursuing SEP-based injunctive relief unless it has first complied with the commitment’s obligation to negotiate in good faith over a license to those SEPs; and (2) whether Ericsson has complied with that obligation is an issue before the district court.” *Telefonaktiebolaget LM Ericsson v. Lenovo (United States), Inc.*, 2024-1515, 10/24/24.

E. False Marking (35 USC § 292 and Lanham Act § 43(a))

“We hold that a cause of action arises from Section 43(a)(1)(B) where a party falsely claims that it possesses a patent on a product feature and advertises that product feature in a manner that causes consumers to be misled about the nature, characteristics, or qualities of its product.” *Crocs, Inc. v. Effervescent, Inc.*, 2022-2160, 10/3/24.

VI. Claim Construction

A. Claim Language

1. Open/Closed Claims, Generic and Negative Limitations

a. Comprising

i. No negative limitation

“[T]he potential presence of additional features is the bedrock understanding of a “comprising” claim, which “[i]n the patent claim context” means “including but not limited to.”” *Teva Branded Pharm. Prods. R&D, Inc. v. Amneal Pharms. of N.Y., LLC*, 2024-1936, 12/20/24 (quoting *CIAS Inc. v. Alliance Gaming Corp.*, 504 F.3d 1356, 1360 (Fed. Cir. 2007)).

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

“That is enough for non-infringement given the demanding “each” claim language chosen by Mirror Worlds in its patent, with its undisputed “every” meaning.” *Mirror Worlds Techs., LLC v. Facebook, Inc.*, 2022-1600, 12/4/24.

2. Fuzzy Language: About, Approximately, Substantially.

a. Information/Data limitations

“The phrase “data unit” has a facially broad ordinary meaning that does not exclude a query or a search criterion.” *Mirror Worlds Techs., LLC v. Facebook, Inc.*, 2022-1600, 12/4/24.

3. Effect of Other Claims

a. Claim Differentiation

i. Surplusage Rather Than Differentiation

“We are unconvinced that construing VoIP to require capability for two-way communication renders superfluous claim 4’s requirement for an audio output, particularly because claim 4 does not even recite a VoIP limitation.” *NexStep, Inc. v. Comcast Cable Commc’ns, LLC*, 2022-1815, 10/24/24.

B. Written Description

1. Advantages/Goals/Purposes/Problems Addressed

“It is hardly enough that “*one* of the principal goals of the invention” is “managing personal electronic information.”” *Mirror Worlds Techs., LLC v. Facebook, Inc.*, 2022-1600, 12/4/24 (emphasis in the original).

2. Background

“The lack of any discussion of intelligent agents in the solution described by the Abstract, Background, and Summary of the Invention sections of the patent weighs against concluding that the inventor intended to limit the invention to the use of intelligent agents. Moreover, the Background section’s criticism of the prior art for failing to use intelligent agent routines similarly fails to limit the claim scope.” *Applications in Internet Time, LLC v. Sallesforce.com, Inc.*, 2024-1133, 10/10/24 (citation omitted) (nonprecedential).

3. Incorporated/Identified Materials

“A skilled artisan reading the incorporated provisional application in the context of the ’399 patent specification would consider that “merchants” providing “services” was included in the provisional application, yet deleted by the patent drafter from the final specification.” *DDR Holdings, LLC v. Priceline.com LLC*, 2023-1176, 12/9/24.

C. Prosecution History

1. Priority Applications

“[T]he deletion made by the patent drafter between the provisional application and the patent specification is highly significant.” “A skilled artisan would understand this progression between the provisional application and the patent specification to indicate an evolution of the applicant’s intended meaning of the claim term.” “In light of the patentee’s deletion of any reference to merchants providing “services” in the final specification, we agree with the district court’s construction that “merchants” are purveyors of goods, not services.” *DDR Holdings, LLC v. Priceline.com LLC*, 2023-1176, 12/9/24.

VII. Procedural Law

A. Applicable Circuit Law

1. Rule 12(b)(6) Dismissal

“We apply our own law to the specific question of whether a complaint states a claim of patent infringement on which relief may be granted.” *AlexSam, Inc. v. Aetna Inc.*, 2022-2036, 10/8/24.

2. Antisuit Injunctions

“We review a district court’s decision on whether to issue an antisuit injunction under the regional circuit’s law.” *Telefonaktiebolaget LM Ericsson v. Lenovo (United States), Inc.*, 2024-1515, 10/24/24.

B. Preclusion

1. Issue Preclusion - Collateral Estoppel

a. Courts, Agencies and Commissions

While an IPR decision can be the source of issue preclusion, “that principle is inapplicable here, where we employ a different claim construction standard than that used by the Board.” “Accordingly, although the Board found the statement at issue in the specification to not be definitional, we conclude under *Phillips* that it is, in light of the intrinsic evidence.” *DDR Holdings, LLC v. Priceline.com LLC*, 2023-1176, 12/9/24.

C. JMOL (Rule 50) / Summary Judgment (Rule 56)

1. Evidence Required to Oppose Summary Judgment

a. Reasonable Inference

“According to *Mirror Worlds*, the lack of reference to coefficient data in this evidence can reasonably support an inference that the coefficient data does not enter the Timeline system at all. We, like the district court, find this evidence insufficient to create a genuine dispute of fact.” *Mirror Worlds Techs., LLC v. Facebook, Inc.*, 2022-1600, 12/4/24.

D. Pleadings/Parties

1. 12(b)(6) Dismissals

a. Well-pled Factual Allegations

“We note, however, that the requirement to take as true all well-pled factual allegations in the course of evaluating a motion to dismiss extends to all such allegations in a complaint.” *AlexSam, Inc. v. Aetna Inc.*, n.5, 2022-2036, 10/8/24.

“[T]he Supreme Court has directed a federal court’s inquiry under Rule 12(b)(6) to whether the factual allegations of the complaint are not merely consistent with but cross the line to support a plausible inference of liability under the invoked legal standard.” *UTTO Inc. v. Metrotech Corp.*, 2023-1435, 10/18/24.

b. Conflicting Pleading Statements

“Viewed in the light most favorable to AlexSam, as we must at this preliminary stage, all that the exhibits establish is that Aetna Inc.’s subsidiaries are responsible for allegedly infringing actions. This is not the same thing as establishing that Aetna Inc. is not

responsible for such actions. The latter is the conclusion Aetna would need us to reach to sustain the district court’s dismissal.” *AlexSam, Inc. v. Aetna Inc.*, 2022-2036, 10/8/24.

c. Claim Construction

“Where claims are construed based on intrinsic evidence alone, a decision on claim construction is not different in kind from the interpretation of other legal standards, which is proper and routine in ruling on a motion under Rule 12(b)(6).” “Some case-specific circumstances can make it improper for a district court to resolve a claim construction dispute in the context of adjudicating a Rule 12(b)(6) motion, but sometimes a claim’s meaning may be so clear on the only point that is ultimately material to deciding the dismissal motion that no additional process is needed.” *UTTO Inc. v. Metrotech Corp.*, 2023-1435, 10/18/24.

E. Discovery/Evidence

1. Expert Testimony

a. Copying Report Analysis

One party asserted that “[expert]’s opinions . . . were questionable based on the fact that much of his testimony was identical to that of [a second] expert in a separate ex parte reexamination proceeding—and that [the expert] could not specify how much of his report he wrote or edited. These allegations provide specific bases for doubting the credibility of [the expert]’s testimony.” *Applications in Internet Time, LLC v. Salesforce.com, Inc.*, 2024-1133, 10/10/24 (citation omitted) (nonprecedential).

b. Based on Inadmissible Material

“The screenshots were unauthenticated and from third-party websites. The district court explained that it is “plainly unreasonable for a technical expert to rely on unauthenticated, undated screenshots in forming an opinion” and that such screenshots “are not independently admissible” under Federal Rules of Evidence 901. We see no abuse of discretion in the district court’s exclusion of the screenshots and Dr. Koskinen’s testimony relying on them.” *Mirror Worlds Techs., LLC v. Facebook, Inc.*, 2022-1600, 12/4/24 (citations omitted).

F. Transfer to New Judge or Venue

1. Compulsory Process/Unwilling Witness Factor

District Court found that three prior art witnesses in transferee forum were “far outweighed by the volume and relevancy of the former Zebra employees, Qualcomm witnesses, and Wi-Fi Alliance employees residing in this district,” but that no significant weight could be applied because “neither party has sufficiently shown that the non-party witnesses would be unwilling to testify.” “Zebra argues the district court clearly abused its discretion because IV relied in part on LinkedIn profiles to identify third-party individuals in WDTX

as potential witnesses. But it fails to show a basis for such a categorical prohibition.” In re Zebra Techs. Corp., 2024-141, 11/13/24 (nonprecedential).

VIII. Federal Circuit Appeals

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

1. District Court/ITC Appeals

a. Claim Construction Forfeiture/Waiver

i. Construction Advocated at Markman

“NexStep never made that argument below, and instead affirmatively asserted the opposite view by contending that the established meaning of VoIP controlled the interpretation of the term. The district court expressly relied on NexStep’s representations in construing VoIP in accord with its industry standard meaning at the relevant time. Based on these representations, NexStep forfeited any argument that the ’802 patent redefined VoIP to differ from its industry standard meaning.” NexStep, Inc. v. Comcast Cable Commc’ns, LLC, 2022-1815, 10/24/24 (citations omitted).

b. Arguments Not in Granted/Denied Motion on Appeal

i. Summary Judgment

“NexStep argues that even if we agree with the district court’s construction of VoIP, we should remand for a trial on infringement because NexStep showed genuine disputes of material fact even under the court’s clarified construction. NexStep forfeited this argument by failing to present it to the district court.” “NexStep opposed summary judgment by arguing that one-way audio transmissions satisfied the district court’s construction of VoIP.” NexStep, Inc. v. Comcast Cable Commc’ns, LLC, 2022-1815, 10/24/24.

B. Issue Preclusion on Appeal

1. Related Appeals

“St. Jude argues that because Snyders expressly waived its *Arthrex*-based challenge in a companion appeal, [], we should deem the argument waived in this appeal. Snyders was not obligated to press every argument available to it in a different appeal to maintain its rights in this one. The companion appeal addresses inter partes reviews of a different patent than the one at issue in this appeal. We do not find waiver on this record.” Snyders Heart Valve LLC v. St. Jude Med., LLC, n.2, 2019-2111, 9/9/20 (nonprecedential), *but see* Cellspin Soft, Inc. v. Fitbit LLC, 2023-1526, 11/1/24 (nonprecedential) (“Although Cellspin filed its recusal motion in the dockets for Garmin and Fossil as well as Fitbit, Cellspin did not appeal the denial of the recusal motions in the cases against Garmin and Fossil. Accordingly, Cellspin no longer has any argument that the district court’s grants of summary judgment for Garmin and Fossil were tainted by a lack of recusal.”).

C. Appellate Jurisdiction

1. Final Decision/Judgment

a. Denial of Summary Judgment

“The United States District Court for the Western District of Virginia granted summary judgment to Crown that the three patents were not invalid under the on-sale bar and denied summary judgment to Belvac. After a jury trial, the district court entered a judgment in accordance with the jury verdict that the asserted claims of the patents were not invalid and not infringed. Crown appealed the judgment of noninfringement, and Belvac appealed the judgment of no invalidity. Because the undisputed record shows that the asserted claims of the three patents were the subject of an invalidating offer for sale in the United States, we reverse and remand for a final judgment of invalidity.” *Crown Pack’g Tech., Inc. v. Belvac Production Machinery, Inc.*, 2022-2299, 12/10/24.

D. Sanctions/Contempt

“While this appeal, and the arguments made herein, are entirely without merit, they are not quite frivolous. It was not, for example, frivolous to argue, as PSP did, that the district court could not award deterrence sanctions under its inherent power in addition to attorney fees pursuant to § 285. While the argument is without merit, it has not previously been decided by this court.” “But merely repeating meritless arguments, without more, does not make an appeal frivolous as argued.” *PS Prods., Inc. v. Panther Trading Co.*, 2023-1665, 12/6/24.

E. Scope of Claim Construction Review

1. Implicit Claim Construction Disputes

No implicit claim construction that “imposed a pH limitation” when “[t]he district court’s reliance on pH ranges was limited to its analysis of whether the two-stage dissolution test represented in vivo behavior of Lupin’s ANDA Product.” Also, “[Appellant] argues the district court required an exact thirty-minute cutoff between the IR and DR portions. The district court did not impose this requirement. Instead, the district court used thirty minutes as an example of a possible distinction between immediate and delayed release” *Galderma Lab’s L.P. v. Lupin Inc.*, 2024-1664, 12/6/24.

F. Mootness of Appealed Rulings

1. Invalidity Rulings

Despite *Cardinal Chem.*, when the Federal Circuit concludes that the patent at issue is not infringed in the appealed case and it expired more than 6 years before that decision, the Court need not review the district court’s holding regarding an invalidity counterclaim. *Mirror Worlds Techs., LLC v. Facebook, Inc.*, 2022-1600, 12/4/24.

G. Standards of Review and Record/Appendix on Appeal

1. De Novo Review

a. Categorizing Complaint Allegations

“[W]e have not said whether we accord deferential or non-deferential review to a trial court’s decision that an allegation is factual or legal, well-pled or merely conclusory. We hold today that our review of trial court determinations on these matters is de novo.” *AlexSam, Inc. v. Aetna Inc.*, 2022-2036, 10/8/24.

2. Substantial Evidence Threshold

a. Expert Testimony

i. Not Substantial/Conclusory

“The testimony of Mirror Worlds’ expert Dr. Koskinen does not create a genuine dispute. To the extent that he made the “all” data generalization argued by Mirror Worlds, it is at most in a few conclusory assertions. Dr. Koskinen’s discussion of specific evidence about Facebook products, which is largely limited to the “user actions” subcategory of “data units,” does not reasonably support a generalization about all data units.” *Mirror Worlds Techs., LLC v. Facebook, Inc.*, 2022-1600, 12/4/24.

“[C]onclusory and circular “because I said so” testimony is insufficient.” *NexStep, Inc. v. Comcast Cable Commc’ns, LLC*, 2022-1815, 10/24/24.

3. Clear/Plain Error Review

a. Expert Testimony

“[T]he district court did not clearly err in rejecting the testimony of NexStep’s expert.” “That Dr. Selker’s underlying evidence contradicted his opinion testimony provided ample basis for the district court to reject the testimony.” *NexStep, Inc. v. Comcast Cable Commc’ns, LLC*, 2022-1815, 10/24/24.

H. Harmless Error

1. Flawed Claim Construction

“Because Voice Tech has not shown any prejudice resulting from the Board’s constructions of “audio command interface” or “mobile device interface,” we decline to consider Voice Tech’s claim construction arguments.” *Voice Tech Corp. v. Unified Patents, LLC*, 2022-2163, 10/1/24.

I. Remand Determination

1. Resolution in the First Instance

“In view of these considerations, we deem this contract interpretation issue appropriate for our resolution in this appeal. The parties have joined issue on this subject in their briefing before us, and neither party has suggested that, instead of resolving this issue in this appeal, we must leave it to the district court in the first instance. Nor has either party persuasively argued that any outstanding factual issue would affect the proper interpretation. Further, as we explain below, we have little doubt that the interpretation we adopt is proper, and we believe judicial economy is best served by resolving the issue now.” *Telefonaktiebolaget LM Ericsson v. Lenovo (United States), Inc.*, 2024-1515, 10/24/24.

2. No Resolution of Issues in the First Instance

“Such entitlement (or not) is dedicated to the district court’s discretion in the first instance and will, if the requested antisuit injunction is to be entered, require analysis of the remaining parts of the foreign-antisuit-injunction framework—an analysis that has yet to be undertaken.” *Telefonaktiebolaget LM Ericsson v. Lenovo (United States), Inc.*, 2024-1515, 10/24/24.

a. Claim Construction

“We flag the issues, leaving for remand the needed additional examination of the case-specific materials and of governing claim-construction precedents.” *UTTO Inc. v. Metrotech Corp.*, 2023-1435, 10/18/24.

3. Remand to PTAB to Make Factual Finding

“Under our court’s precedent, because Yamazaki is not drawn to scale and does not show relative proportions, the Board erred by relying on the bold lines in Figure 1 to make findings regarding the thickness of (and thus the structural support provided by) element 11a. For the reasons explained above, we vacate the Board’s decision with respect to the cathode/anode limitation and remand for the Board to assess whether Yamazaki teaches the cathode/anode limitation of claim 1 without reliance on the relative thickness of the bolded lines in Yamazaki’s Figure 1.” *Regents of the University of Cal. v. Staco Prods., Inc.*, 2023-1356, 12/4/24 (nonprecedential).

IX. Patent Office Proceedings

A. Inter Partes Review

1. Petition Requirements

“Subsequent attorney argument made for the first time on appeal cannot save a petition the Board reasonably concluded was evidentiarily deficient.” *Bell Semiconductor LLC v. NXP B.V.*, 2023-1260, 12/5/24 (nonprecedential).

2. Appeal

a. Sufficient Reasoning to Review

“We hold that the Board failed to make the requisite finding on motivation to combine, and that it failed to explain what it meant by “necessary bridge.”” “[T]he Board must consider whether the particular combination argued by the Petitioner—modifying Paxton by adding Sutton’s notification step after Paxton’s correlation step—would meet the claim limitations at issue.” *Palo Alto Networks, Inc. v. Centripetal Networks, LLC*, 2023-1636, 12/16/24.

b. Waiver of issues not included in rehearing request

“The regulatory requirement that a rehearing request “identify all matters the party believes the Board misapprehended or overlooked,” *id.*, simply requires the party to identify the issues it wishes to present for rehearing by the agency after the agency has rendered a final decision. Nothing in the regulation appears to contemplate that the Board would expect requests for rehearing, if filed, to regurgitate all arguments the Board had already considered and rejected, simply to preserve them for appeal.” “We thus hold that a party’s choice to not re-raise an argument in the party’s request for rehearing to the Board does not, in and of itself, forfeit the argument for review by this court.” *Voice Tech Corp. v. Unified Patents, LLC*, 2022-2163, 10/1/24.

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

a. Information/Arguments Required in Petition

A petition’s misquoting of claim language in subsequent limitations does not foreclose an adequate disclosure where “[t]he petition identified, via cross-reference, that its prior art analysis on limitation [1.6] equally applied to [those supplemental limitations].” *Voice Tech Corp. v. Unified Patents, LLC*, 2022-2163, 10/1/24.

b. POPR, But Not POR

“Accordingly, because 3G did not maintain the argument it brought pre-institution, i.e., that slide 8 confirms that an RRI can itself function as an IAB, in its post-institution briefing, the Board did not err in finding 3G’s slide argument to be waived pursuant to its Trial Practice Guide and Nuvasive.” *3G Licensing S.A. v. Honeywell Int’l, Inc.*, 2023-1557, 12/10/24 (nonprecedential).