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## **I. Patentability Requirements**

### **A. Inventorship/Invention and Priority Dates**

“The first step in assessing inventorship is ordinarily claim construction, in order to determine the scope of a claim’s subject matter. Where, as here, the parties do not dispute the scope of any particular claim term, however, claim construction is not necessary.” *Plastipak Packaging, Inc. v. Premium Waters, Inc.*, 2021-2244, 12/19/22 (citation omitted).

#### **1. Coinventorship/Joint Inventors**

SJ of joint inventorship reversed where there was “evidence from which a reasonable factfinder could find that [the named inventors] conceived of their inventions entirely independently of any work on which [a named inventor and an unnamed person] had collaborated.” *Plastipak Packaging, Inc. v. Premium Waters, Inc.*, 2021-2244, 12/19/22.

SJ of joint inventorship reversed where “there is, at a minimum, a genuine dispute of material fact as to whether [the unnamed person] contributed anything other than what was already the state of the art.” *Plastipak Packaging, Inc. v. Premium Waters, Inc.*, 2021-2244, 12/19/22.

### **B. Prior Art Invalidity**

#### **1. Reference Disclosure**

“[I]t is well established that what the prior art teaches is a factual question . . . [t]he standard of review does not change when the district court is assessing documentary evidence rather than testimony.” *Genetech, Inc. v. Sandoz Inc.*, 2022-1595, 12/22/22.

#### **2. Anticipation (§ 102)**

##### **a. Claim Interpretation**

###### **i. Not In Haec Verba or Ipsissimis Verbis**

Summary judgment of no anticipation reversed where “[a] reasonable juror could find that a skilled artisan would interpret the disclosed combination of facility and line number as mapping onto the MSBs of claim 1. Indeed, ADASA’s witness, Mr. Williams, testified to that effect, stating the cited passage of RFID for Dummies, while not specifically mentioning MSBs, “exactly describes” the concept of MSBs as recited in the claim.” “[T]he district court erred in interpreting these linguistic differences as fatal to a finding of anticipation.” *ADASA Inc. v. Avery Dennison Corp.*, 2022-1092, 12/16/22.

###### **b. Summary Judgment/JMOL**

“The burden of proof to invalidate [] claims is a heavy one – clear and convincing evidence – and it is a burden that rests squarely on [the challenger]. To obtain summary judgment of invalidity, [the] challenge was even greater: to show that no reasonable factfinder, taking

the evidence in the light most favorable to [patentee], could do anything other than find clear and convincing evidence of anticipation.” Patentee “showed that [an on sale witness]’s credibility is a genuinely disputed material fact, thereby raising a related genuine dispute as to whether [challenger]’s corroborating documentary evidence is what it purports to be. [Those] challenges to [] credibility and to the authenticity of [] documentary evidence render summary judgment unwarranted on the record before us.” *Mosaic Brands, Inc. v. Ridge Wallet LLC*, 2022-1001, 12/20/22.

### **3. Obviousness (§ 103)**

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

##### **i. Level of Abstraction in Framing Obviousness**

“[V]arying doses in response to the occurrence of side effects would seem to be a well-established, hence obvious, practice. Thus, claiming it as an invention would appear to be at best a long shot.” *Genetech, Inc. v. Sandoz Inc.*, 2022-1595, 12/22/22.

##### **ii. Common Sense Changes / Design Choices**

“[V]arying doses in response to the occurrence of side effects would seem to be a well-established, hence obvious, practice. Thus, claiming it as an invention would appear to be at best a long shot.” *Genetech, Inc. v. Sandoz Inc.*, 2022-1595, 12/22/22.

##### **iii. Undisclosed Elements and Dependent Claims**

Where the record, specifically portions of prior art references cited by the district court for other claims, was sufficient to support the conclusions as to the dependent claims, “the court did not err in not discussing its factual findings with respect to those claims specifically.” *Genetech, Inc. v. Sandoz Inc.*, 2022-1595, 12/22/22.

##### **iv. Whether All Limitations Disclosed**

“[T]he specific dose modifications claimed in the LFT patents would have been obvious over the disclosures in [prior products], combined with well-known standard medical practices.” *Genetech, Inc. v. Sandoz Inc.*, 2022-1595, 12/22/22.

### **C. Invalidity Based on § 112**

#### **1. Enablement (¶ 1)**

##### **a. Specification Errors**

Board correctly upheld substitute claims against enablement challenge where “regardless of whether the error was first discovered during examination or afterward, the specification itself makes clear that the reference to step 168 instead of step 176 is an obvious error.” “Board did not err in determining that the proposed amended claims were enabled, despite an admitted error in the specification, because that error and its correction would have been

obvious to a person of ordinary skill in the art.” Am. Nat’l Mfg., Inc. v. Sleep No. Corp., 2021-1321, 11/14/22.

## **D. Section 101**

### **1. Each Claim Considered as a Whole v. Representative Claims**

“Although [Appellant] argues on appeal that a number of claims are “exemplary,” he only describes and analyzes claim 1 of each patent in any significant detail. Accordingly, we treat claim 1 of each patent as representative.” Weisner v. Google LLC, n.2, 2021-2228, 10/13/22 (citation omitted).

“[T]he district court erred by failing to separately analyze these patents. Although the specifications in all four patents are the same, the claims of the ’905 and ’911 patents are not directed to the same subject matter as the ’202 and ’910 patents.” Weisner v. Google LLC, 2021-2228, 10/13/22.

### **2. Abstract Idea Exclusion**

#### **a. Claimed Subject Matter**

Representative claims directed to abstract travel log creation idea where “[t]he steps in the body of the claim describe a generic process for achieving the goal of creating a digital travel log, such as “maintaining a processing system” and using an “application” to generate a user’s “location history entry” on their “handheld mobile communication device.”” Weisner v. Google LLC, 2021-2228, 10/13/22.

“Although the claims do recite a “member of the member network” and other “member” limitations, they do not limit the data collection to only members. Thus, the purported benefit of limiting data accumulation to members is not captured in the claims and, accordingly, does not shift the focus of the claims away from the abstract idea of creating a digital travel log.” Weisner v. Google LLC, 2021-2228, 10/13/22 (citation omitted).

#### **b. Improving Computer Functionality**

Not improved computer functionality where “claims are directed to limiting and coordinating the display of information based on a user selection.” Int’l Bus. Machs. Corp. v. Zillow Group, Inc., 2021-2350, 10/17/22.

#### **c. Information Processing**

A claim not directed to an abstract idea when it “is directed to a specific, hardware-based RFID serial number data structure designed to enable technological improvements to the commissioning process. Setting aside the conventional RFID hardware components, claim 1 as a whole focuses on the data structure of the serial number space.” “[T]he claimed MSBs function as an additional data field within the serial number space that uniquely identifies the allocated block from which it came. This one-to-one correspondence has

important technological consequences.” ADASA Inc. v. Avery Dennison Corp., 2022-1092, 12/16/22.

**d. Inventive Concept/Transformation Exception**

“[T]he specification describes the components and features listed in the claims generically, supporting the conclusion that these components and features are conventional, not inventive concepts in the patents.” Weisner v. Google LLC, 2021-2228, 10/13/22.

“[W]e conclude that [Appellant] has plausibly alleged that the . . . claims recite a specific implementation of the abstract idea that purports to solve a problem unique to the Internet . . . these claims do not per se concern searching for new information, but rather concern a new technique for prioritizing the results of the conventional search.” Weisner v. Google LLC, 2021-2228, 10/13/22.

**3. Stage of Case for Determination**

**a. Motion to Dismiss**

**i. 12(b)(6) v. 12(c)**

“[Appellee] filed a motion for judgment on the pleadings . . . . The district court granted Zillow’s motion . . . concluding that both were “directed to abstract ideas, contain[] no inventive concept, and fail[] to recite patentable subject matter.” “When considering eligibility under a Rule 12 motion, we take the facts alleged in the complaint as true.” Int’l Bus. Machs. Corp. v. Zillow Group, Inc., 2021-2350, 10/17/22.

**ii. Alice Step Two**

“[T]he district court need not accept a patent owner’s conclusory allegations of inventiveness.” Int’l Bus. Machs. Corp. v. Zillow Group, Inc., 2021-2350, 10/17/22.

**II. Other Defenses**

**A. License/Covenant Not to Sue**

**1. Express**

**a. Construction Rules**

**i. Avoid surplusage**

“This narrow exception for the survival of sublicenses granted prior to termination suggests that not all license rights would survive termination.” Uniloc 2017 LLC v. Google LLC, 2021-1498, 11/4/22.

## **ii. Expiration/Termination clauses**

“Under the relevant case law, the term “irrevocable” does not suggest that the license could not be eliminated by mutual agreement.” *Uniloc 2017 LLC v. Google LLC*, 2021-1498, 11/4/22.

“[C]ourts have found that rights or contract provisions that by their nature survive termination include those related to what remedies are available in case of breach occurring during the term of the contract or dispute resolution mechanisms concerning such breach.” “[T]here is no basis for believing that the plain meaning of “rights . . . which by their nature survive” encompasses a bare unexercised license.” *Uniloc 2017 LLC v. Google LLC*, 2021-1498, 11/4/22.

### **B. Spoliation and Discovery Sanctions**

#### **1. Due Process**

“Avery Dennison thus not only had notice and opportunity to address the sanctions ultimately imposed, it did address them. Accordingly, there was no due process violation.” *ADASA Inc. v. Avery Dennison Corp.*, 2022-1092, 12/16/22.

#### **2. Requirements for Sanction Remedy**

“While the district court invoked this deterrent purpose, by tying the award to the timely, as well as untimely, disclosed tags, it divorced the remedy from the harm that flowed from Avery Dennison’s discovery violation. We therefore vacate the sanctions award and remand for the district court to reconsider the appropriate remedy.” *ADASA Inc. v. Avery Dennison Corp.*, 2022-1092, 12/16/22.

## **III. Literal Infringement**

### **A. Summary Judgment/JMOL**

#### **1. All Elements**

“In order to avoid summary judgment of noninfringement, [patentee] must establish a genuine issue of material fact that [accused products] perform every step of the asserted claims.” *Treehouse Avatar LLC v. Valve Corp.*, 2022-1171, 11/30/22.

### **B. Indirect Infringement**

#### **1. ANDA Infringement**

“The court did not clearly err by considering physician evidence, weighing it against the language in Sandoz’s proposed label, and finding that Genentech failed to prove direct infringement.” *Genetech, Inc. v. Sandoz Inc.*, 2022-1595, 12/22/22.



## **IV. Relief**

### **A. Injunction**

#### **1. Preliminary Injunction**

##### **a. Likelihood of Success**

“An injunction cannot be granted because a trial is required or because the accused products are not “sufficiently dissimilar” or “plainly dissimilar” from the patented design.” *ABC Corp. I v. P’ship & Unincorporated Ass’ns*, 2022-1071, 10/28/22.

##### **b. Notice under FRCP 65**

“A preliminary injunction issued without notice, motion, hearing or evidence should be vacated.” *Atari Games Corp. v. Nintendo of America, Inc.*, 897 F.2d 1572, 1578 n.7 (Fed. Cir. 1990) (quoted in *ABC Corp. I v. P’ship & Unincorporated Ass’ns*, 2021-2150, 10/28/22).

#### **2. Required Specificity of Injunctions**

“[T]he district court failed to apply the ordinary observer test on a product-by-product basis, which is particularly important here in light of significant differences among the accused products themselves.” “On remand, should a new injunction issue, the district court must describe the products enjoined with specificity . . . .” *ABC Corp. I v. P’ship & Unincorporated Ass’ns*, 2022-1071, 10/28/22.

### **B. Reasonable Royalty**

#### **1. Established and Comparable Royalties/License Agreements**

##### **a. Adjusting Comparable License with More Patents**

“Dr. Sweeney’s analysis, however, was inadequate to establish the technological comparability.” “[I]n a single brief paragraph, he observed that the licensed portfolios “include patents that cover RFID transponders,” that one of the portfolios included patents cited by ADASA during the prosecution of the ’967 patent, and that Avery Dennison allegedly obtained the right to sell the RFID transponders accused of infringing the ’967 patent.” “[T]hese conclusory observations are insufficient to establish comparability.” “Mr. Sweeney’s conclusory opinions were inadequate to carry Avery Dennison’s burden to establish comparability.” *ADASA Inc. v. Avery Dennison Corp.*, 2022-1092, 12/16/22.

## **V. Claim Construction**

### **A. Claim Language**

#### **1. Open/Closed Claims, Generic and Negative Limitations**

##### **a. Defining/Positioning/Connecting Terms**

“[T]he fact that the security system processor is “different” than the mobile device processor does not suggest that the two processors are remote from one another.” “So two processors may be different from one another and yet both be embedded in a single device.” CUPP Computing AS v. Trend Micro Inc., 2020-2262, 11/16/22.

#### **2. Functional v. Structural Language**

##### **a. Requirement of Actual Function**

“[T]he use of the words “being used for” in the claim imply that some sort of actual use of the metal interconnect layers to carry electricity is required.” “[T]he words “being used for” imply that the interconnect layers are at least capable of carrying electricity” VLSI Tech. LLC v. Intel Corp., 2021-1826, 11/15/22.

#### **3. Effect of Other Limitations in Claim**

##### **a. Surplusage OK**

“While a construction that introduces redundancy into a claim is disfavored, it is not foreclosed. That is particularly true where, as in this case, intrinsic evidence makes it clear that the “redundant” construction is correct. To be sure, the claim language in question could have been drafted more precisely.” VLSI Tech. LLC v. Intel Corp., 2021-1826, 11/15/22 (citation omitted).

##### **b. Different terms have different meanings**

“[T]he recitation of “dummy metal lines” elsewhere in claim 20 implies that the claimed “metal-containing interconnect layers” are capable of carrying electricity; otherwise, there would be no distinction between the dummy metal lines and the rest of the interconnect layer.” VLSI Tech. LLC v. Intel Corp., 2021-1826, 11/15/22.

### **B. Written Description**

#### **1. Disclaimer**

“[H]ere, in context, a person of ordinary skill in the art would have understood the “present invention” statements as describing the claimed invention as a whole . . . thereby disclaiming inventions constructed out of materials other than extrudable plastic.” Mosaic Brands, Inc. v. Ridge Wallet LLC, 2022-1001, 12/20/22.

## **2. Incorporated/Identified Materials**

“[T]he disclosure of the host patent provides context to determine what impact, if any, a patent incorporated by reference will have on construction of the host patent claims.” “The use of a restrictive term in an earlier application does not reinstate that term in a later patent that purposely deletes the term, even if the earlier patent is incorporated by reference.” *Finjan LLC v. ESET, LLC*, 2021-2093, 11/1/22.

### **C. Prosecution History**

#### **1. Disclaimer During IPR**

“To be clear, a disclaimer in an IPR proceeding is binding in later proceedings, whether before the PTO or in court. We hold only that a disclaimer is not binding on the PTO in the very IPR proceeding in which it is made.” *CUPP Computing AS v. Trend Micro Inc.*, 2020-2262, 11/16/22.

#### **2. Issuing Application**

##### **a. Does Not Change Meaning**

##### **i. No Disclaimer**

“CUPP’s comment to the examiner is therefore consistent with it retaining claims to security system processors embedded in a mobile device with a separate processor. As the Board properly held, this reading is a “reasonable interpretation[.]” that defeats CUPP’s assertion of prosecutorial disclaimer.” *CUPP Computing AS v. Trend Micro Inc.*, 2020-2262, 11/16/22.

## **VI. Procedural Law**

### **A. Knowledge of the Law Presumption**

“Parties are charged with knowledge of the law and, particularly in the case of a sophisticated litigant like Uniloc, are presumed to know background legal principles like collateral estoppel.” *Uniloc USA, Inc. v. Motorola Mobility*, 2021-1555, 11/4/22.

### **B. Preclusion**

#### **1. Issue Preclusion - Collateral Estoppel**

“The ultimate question of collateral estoppel is a legal question, which we review de novo. Like many legal doctrines, however, collateral estoppel may implicate underlying facts, which we review for substantial evidence.” *Google LLC v. Hammond Dev. Int’l, Inc.*, 2021-2218, 12/8/22 (citation omitted).

**a. Discretionary Exceptions**

“To be sure, there is some discretion to deny the application of non-mutual collateral estoppel, but this discretion is confined to defined situations where application of collateral estoppel is not appropriate under various rules established by case law, such as when one party lacks a full and fair opportunity to litigate. The discretion is not unbounded discretion to apply collateral estoppel whenever the court thinks that outcome might be desirable.” *Uniloc USA, Inc. v. Motorola Mobility*, 2021-1555, 11/4/22 (citations omitted).

**b. Same Issue of Law or Fact Necessary to Judgment**

**i. Invalidity/Patentability of Different Claims**

“Whether the differences between the patent claims materially alter the question of patentability is a legal conclusion based on underlying facts.” *Google LLC v. Hammond Dev. Int’l, Inc.*, 2021-2218, 12/8/22.

**c. Full and Fair Opportunity to Litigate the Issues.**

“Generally, collateral estoppel cannot be denied because the decision was incorrect.” *Uniloc USA, Inc. v. Motorola Mobility*, 2021-1555, 11/4/22.

**i. Appeal**

“To be sure, collateral estoppel can be applied based on a district court decision that is still pending on appeal, and we have affirmed the application of issue preclusion even when the preclusive judgment was pending appeal.” *Uniloc USA, Inc. v. Motorola Mobility*, 2021-1555, 11/4/22.

**d. Forfeiture and Waiver**

“[T]here are strong policy reasons supporting a finding of no forfeiture of collateral estoppel when the argument was first raised after the appeal process of the preclusive case was concluded, and we conclude that forfeiture is not appropriate here.” *Uniloc USA, Inc. v. Motorola Mobility*, 2021-1555, 11/4/22.

“Google could not have raised its collateral estoppel argument in its petition because the preclusive judgment did not yet exist. In such circumstances, Google did not forfeit its collateral estoppel argument by raising it for the first time on appeal.” *Google LLC v. Hammond Dev. Int’l, Inc.*, 2021-2218, 12/8/22.

**C. Jury Issues**

**1. Rejecting Accurate Jury Instructions**

“Where Avery Dennison failed to present a lump-sum damages theory to the jury and, moreover, actively undermined the very evidentiary basis it now contends required a lump-

sum instruction, the district court did not err in declining to include such an instruction.” ADASA Inc. v. Avery Dennison Corp., 2022-1092, 12/16/22.

**D. Discovery/Evidence**

**1. Evidentiary Standards**

“Equivocal evidence plainly fails to satisfy a preponderance-of-the-evidence standard, so Sunset is wrong to suggest that the district court would have reached a different result had it applied the correct standard.” SoClean, Inc v. Sunset Healthcare Sols., Inc., 2021-2311, 11/9/22.

**2. Expert Testimony**

“We affirm that the grant of a motion to strike expert testimony is not improper when such testimony is based on a claim construction that is materially different from the construction adopted by the parties and the court.” Treehouse Avatar LLC v. Valve Corp., 2022-1171, 11/30/22.

**E. Transfer to New Judge or Venue**

**1. Stay Pending Decision**

“Where, as here, the parties agree that no additional discovery or briefing is necessary and there are clearly less time-consuming and more cost-effective means for the court to resolve the motion (including considering whether the court should give less weight to certain evidence), it is a clear abuse of discretion to require the parties to expend additional party and court resources litigating the substantive matters of the case while Apple’s motion to transfer unnecessarily lingers on the docket.” In re Apple Inc., 2022-162, 11/8/22.

**F. Severance**

“Because we find the district court clearly abused its discretion in evaluating the motions to sever and transfer, we grant the petition and direct the district court to grant Amazon’s motions to sever and transfer.” In re Amazon.com, Inc., 2022-157, 12/15/22 (nonprecedential).

**VII. Federal Circuit Appeals**

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

**1. District Court/ITC Appeals**

**a. Claim Construction Forfeiture/Waiver**

**i. Claim Language in Different Patents**

“Before the district court, appellants did not make any argument for why the separate patentability of the D’856, D’857, and D’297 patents had any bearing on the infringement

analysis. Because the argument was not properly raised, we do not consider it.” ABC Corp. I v. P’ship & Unincorporated Ass’ns, 2022-1071, 10/28/22.

## **2. New Argument in Reply Brief**

### **a. Claim Construction**

“[Appellant] did not clearly argue these portions of the District Court’s claim construction were incorrect in its opening brief.” “Hence, we have not considered this untimely contention.” Mosaic Brands, Inc. v. Ridge Wallet LLC, n.7, 2022-1001, 12/20/22.

## **3. Mischaracterizations of Reviewed Decision**

“After reading the decisions as a whole, we are convinced that the Board properly analyzed the obviousness issue, first setting forth its fact findings and reasoning for why it concluded that the claims would have been obvious and then responding to Sleep Number’s specific contrary arguments.” Am. Nat’l Mfg., Inc. v. Sleep No. Corp., 2021-1321, 11/14/22.

## **B. Appellate Jurisdiction**

### **1. Appeal from Injunction under Section 1292**

#### **a. Modifying a Previous Injunction**

A modification is appealable if it includes “a change in the legal relationship” between the parties. ABC Corp. I v. P’ship & Unincorporated Ass’ns, 2021-2150, 10/28/22 (applying 7<sup>th</sup> Cir law).

#### **b. Denying Modification or Dissolution**

“Federal Rule of Appellate Procedure 4(a)(1), has been recognized sometimes to limit appellate review of a denial of a motion for dissolution or modification to exclude review of a ground for dissolution or modification that the appellant had fully available when the injunction was initially entered and was, because it was a properly served party at that time, obligated to raise by appeal within 30 days from the injunction’s entry.” ABC Corp. I v. P’ship & Unincorporated Ass’ns, 2021-2150, 10/28/22 (applying 7<sup>th</sup> Cir law).

## **2. Mootness**

### **a. Defenses and Counterclaims**

“[O]nce [the district court] had found [patentee]’s patent claims invalid as anticipated, [defendant] could not have been found liable for infringing invalid claims, so [defendant]’s *defense* that those same claims were unenforceable due to inequitable conduct became a moot issue.” Mosaic Brands, Inc. v. Ridge Wallet LLC, 2022-1001, 12/20/22 (emphasis added).

### **3. Requirements and Timing for Notice of Appeal**

A notice only naming an old injunction as the appealed order “should be read to refer to the May 24 Order amending” that old injunction such that the notice is timely. “Seeing no prejudice to [appellee], we think this is a case in which the mistake should not be fatal. Because [appellant]’s May 24, 2021 notice of appeal, fairly read, refers to the May 24 Order, the notice was timely filed within the thirty days allowed by § 2107(a).” ABC Corp. I v. P’ship & Unincorporated Ass’ns, 2021-2150, 10/28/22.

### **4. Collateral Order Doctrine**

“Generally, pretrial discovery orders are not “final”—and therefore, not reviewable—under the collateral order doctrine. Such discovery orders are generally unreviewable under the third requirement of the collateral order doctrine because they can be adequately reviewed after a final judgment.” Modern Font Applications LLC v. Alaska Airlines, Inc., 2021-1838, 12/29/22 (citations omitted).

“[T]his case does not involve whether Alaska’s information should be sealed or unsealed, but rather whether its information could be disclosed to MFA’s inhouse counsel, which is an entirely different issue. Moreover, the district court did not permit disclosure of Alaska’s confidential information to MFA’s in-house counsel, instead protecting that information by denying MFA’s inhouse counsel access. Because there is no risk Alaska’s information will be revealed to an improper recipient, the district court’s order does not fall within the “small class” of collateral rulings appropriate for appellate review.” Modern Font Applications LLC v. Alaska Airlines, Inc., 2021-1838, 12/29/22.

## **C. Scope of Claim Construction Review**

### **1. Claim Construction Modified on Appeal**

#### **a. Affirmed/Reversed Under New Construction**

“The Board was able to resolve the case by construing the term “force region” to include at least the area directly under the bond pad and by not limiting the term to situations in which the flip chip bonding method is used. That construction is not inconsistent with our construction. The Board therefore properly found that the Oda reference, in combination with other references cited to the Board, made claims 1, 2, and 11 unpatentable.” VLSI Tech. LLC v. Intel Corp., 2021-1826, 11/15/22.

## **D. Standards of Review and Record/Appendix on Appeal**

### **1. De Novo Review and Appellant Burden**

“The Board held that Google failed to show these dependent claims would have been obvious. Google, who bears the burden on appeal, has failed to convince us that the Board’s determinations should be reversed. Accordingly, we affirm.” Google LLC v. Hammond Dev. Int’l, Inc., 2021-2218, 12/8/22.

## **2. Substantial Evidence Threshold**

### **a. Evidence v. Attorney Argument**

SJ inappropriate where “the corroborating documents are only persuasive if the factfinder determines Kaminski is credible. Ridge has identified specific facts in the record that create doubt as to Kaminski’s credibility and, relatedly, as to the authenticity of the documents Mosaic offered as corroboration of his testimony.” *Mosaic Brands, Inc. v. Ridge Wallet LLC*, 2022-1001, 12/20/22.

### **E. Harmless Error**

“The district court’s misstatement of the applicable standard of proof is harmless error.” *SoClean, Inc v. Sunset Healthcare Sols., Inc.*, 2021-2311, 11/9/22.

#### **1. Mistatement in Decision/Order/Opinion**

“[E]ven if it might have been useful for the Board to begin by expressly acknowledging the district court’s claim construction, the Board was not required to do so, and any failure to do so was at most harmless error.” *VLSI Tech. LLC v. Intel Corp.*, 2021-1826, 11/15/22.

### **F. Remand Determination**

#### **1. Remand for Sufficient Reasoning to Review**

Injunctions require more than judgments. “[T]he district court was required to conduct the ordinary observer analysis through the lens of the prior art, and the court’s conclusory discussion contains no indication that it conducted the required analysis.” *ABC Corp. I v. P’ship & Unincorporated Ass’ns*, 2022-1071, 10/28/22.

## **VIII. Patent Office Proceedings**

### **A. Inter Partes Review**

#### **1. Amendments**

“[N]othing in the America Invents Act (AIA) or the Board’s regulations precludes a patent owner from amending a claim to both overcome an instituted ground and correct other perceived issues in the claim.” *Am. Nat’l Mfg., Inc. v. Sleep No. Corp.*, 2021-1321, 11/14/22.

#### **2. Board Final Written Decision**

##### **a. Claim Construction**

“Each of those cases stands for the proposition that the petition defines the scope of the IPR proceeding and that the Board must base its decision on arguments that were advanced by a party and to which the opposing party was given a chance to respond. None of those cases prohibits the Board from construing claims in accordance with its own analysis. To



the contrary, we have held that the Board is not limited to the claim constructions proffered by the parties, but may adopt its own claim construction of a disputed claim term.” VLSI Tech. LLC v. Intel Corp., 2021-1826, 11/15/22.

### **3. Previous District Court and CAFC Determinations**

#### **a. Claim construction**

“[T]he Board addressed an argument not made to the district court, and it reached a conclusion not at odds with the conclusion reached by the district court.” “Because the parties’ positions before the Board made it clear that the Board needed to go beyond the district court’s claim construction in order to resolve the parties’ dispute, it was unnecessary for the Board to advert to the district court’s claim construction.” VLSI Tech. LLC v. Intel Corp., 2021-1826, 11/15/22.