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## **I. Patentability Requirements**

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

#### **1. Reduction to Practice**

##### **a. Actual**

“Sufficiency of the testing required to show an invention worked for its intended purpose is a question of fact reviewed for substantial evidence.” *Medtronic, Inc. v. Teleflex Innovations S.ÀR.L.*, 2021-2356, 5/24/23.

##### **i. Intended Purpose**

“Similar to claim construction, a determination of an invention’s intended purposes is a legal issue, reviewed *de novo*.” *Medtronic, Inc. v. Teleflex Innovations S.ÀR.L.*, 2021-2356, 5/24/23.

“[A]lthough the patents themselves are the most important and, indeed, most persuasive evidence of the patents’ intended purpose, we find it is appropriate to consider extrinsic evidence, particularly when it does not contradict the patents themselves.” *Medtronic, Inc. v. Teleflex Innovations S.ÀR.L.*, 2021-2356, 5/24/23.

Rejecting intended purpose of crossing tough or chronic occlusions in favor of merely providing increased backup support as compared with a guide catheter alone. “Although the challenged patents do mention crossing “tough” or “chronic” occlusions, we find that to be a specific example within a broader general purpose. Indeed, as the Board found, the challenged patent specification itself recognizes a broader purpose when discussing the field and background of the invention.” *Medtronic, Inc. v. Teleflex Innovations S.ÀR.L.*, 2021-2356, 5/24/23.

“The very title of the patents themselves, “Coaxial Guide Catheter for Interventional Cardiology Procedures,” describes the purpose of the claimed inventions, and it is undisputed that the claim language does not impose a further purpose than this.” *Medtronic, Inc. v. Teleflex Innovations S.ÀR.L.*, 2021-2356, 5/24/23.

#### **2. Coinventorship/Joint Inventors**

Coinventorship determination reversed based on insufficient contribution “under the second *Pannu* factor” where the “alleged contribution . . . is mentioned only once in the [] specification as an alternative [and] is recited only once in a single claim of the [] patent.” *HIP, Inc. v. Hormel Foods Corp.*, 2022-1696, 5/2/23.

##### **a. Significant Contribution**

Court could find a significant contribution to four different utility patents and two design patents without construing any of the claims. “In other words, the court is not required to prospectively address hypothetical claim construction disputes. That is as true for

inventorship analyses as it is for invalidity and infringement analyses.” “[T]hese three elements, taken together, were a significant contribution to at least one claim of each asserted patent.” *Blue Gentian, LLC v. Tristar Prods., Inc.*, 2021-2316, 6/9/23.

“Key features that the patent owner itself acknowledges distinguish the *invention* of the asserted patents from the prior art are necessarily tied to the claims.” *Blue Gentian, LLC v. Tristar Prods., Inc.*, 2021-2316, 6/9/23 (emphasis in original).

### **3. Corroboration**

“Nor must every individual aspect of reduction to practice be corroborated. Rather, the corroborative evidence simply needs to be sufficient to support the credibility of the inventors’ story.” *Medtronic, Inc. v. Teleflex Innovations S.À.R.L.*, 2021-2356, 5/24/23 (citation omitted).

#### **a. Inventor’s Documents**

“[C]ertain documents could only be connected to the rapid exchange prototype through inventor testimony, which carries little to no weight in the context of corroboration; one cannot corroborate oneself, after all.” *Medtronic, Inc. v. Teleflex Innovations S.À.R.L.*, 2021-2356, 5/24/23.

#### **b. Joint Inventor Communication**

“The district court properly evaluated whether Mr. Ragner’s account, including both what he knew about expandable hoses going into the meeting and what he conveyed to Mr. Berardi at the meeting, was corroborated.” *Blue Gentian, LLC v. Tristar Prods., Inc.*, 2021-2316, 6/9/23.

“[E]ven if the statement in *Price* were fully apt, it does not preclude an analysis of corroboration that considers conception and communication together.” *Blue Gentian, LLC v. Tristar Prods., Inc.*, 2021-2316, 6/9/23 (referring to *Price v. Symsek*, 988 F.2d 1187, 1190 (Fed. Cir. 1993)).

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

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

##### **a. Inherency**

“Demonstrating inherent disclosure requires meeting a stringent standard.” *Amgen Inc. v. Sandoz Inc.*, 2022-1147, 4/19/23.

##### **i. Evidence of Necessarily Present**

“[T]he inherent anticipation analysis involves understanding whether, by making the formulations (1:57 or 1:62) by the DDM process, which are similarly disclosed in both the [challenged] and [prior art] patents with the disclosures of the incorporated references,

would naturally result in a composition having the Morphology Limitation.” “To anticipate, the prior art need only meet the inherently disclosed limitation to the same extent as the patented invention.” *Arbutus Biopharma Corp. v. ModernaTX, Inc.*, 2020-1183, 4/11/23.

**ii. Apparent Arrangement or Combination**

“The district court’s use of the “immediately envisage” line of cases to convert this case into a point-within-a-range case constitutes an improper application of our precedent governing overlapping ranges.” *UCB, Inc. v. Actavis Labs. UT, Inc.*, 2021-1924, 4/12/23.

**b. Disclosure to POSITA**

**i. Context of Challenged Patent**

“The district court did not err in *not* holding Amgen to the statements set forth in the specification regarding isolating apremilast. In *PharmaStem*, we held that it was not unfair to hold the inventors to the consequences of their admissions because their characterization of the prior art references was not unreasonable, and the prior art references themselves strongly supported the interpretation. In contrast, here, the district court found that Sandoz’s own expert conceded that the formation of chiral salts was not a viable method for separating the Example 12 enantiomers contrary to the statement in the specification.” *Amgen Inc. v. Sandoz Inc.*, 2022-1147, 4/19/23 (emphasis added) (citation to *PharmaStem Therapeutics, Inc. v. ViaCell, Inc.*, 491 F.3d 1342, 1362 (Fed. Cir. 2007) omitted)

**2. Obviousness (§ 103)**

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

**i. Prior Art Overlaps with Claimed Range**

“Here, it is undisputed that the range claimed in the ’589 patent overlaps with the ranges taught by the Muller patents. Thus, Actavis established a prima facie case of obviousness.” *UCB, Inc. v. Actavis Labs. UT, Inc.*, 2021-1924, 4/12/23.

**ii. Inherent Properties**

“Reciting the mechanism for known compounds to yield a known result cannot overcome a prima facie case of obviousness, even if the nature of that mechanism is unexpected.” *In re Couvaras*, 2022-1489, 6/14/23.

**b. Analogous Prior Art**

“Because Mylan argued that de Gennes is analogous to another prior art reference and not the challenged patent, Mylan did not meet its burden to establish obviousness premised on de Gennes and the Board’s factual findings regarding analogousness are not supported by substantial evidence.” *Sanofi-Aventis Deutschland GmbH v. Mylan Pharms. Inc.*, 2021-1981, 5/9/23.

**i. Reasonably Pertinent to Problem**

“[T]he purpose of the “prior art” must be evaluated *with reference to* the inventor’s purported invention disclosed within the challenged patent.” *Sanofi-Aventis Deutschland GmbH v. Mylan Pharms. Inc.*, 2021-1981, 5/9/23.

**c. Motivation/Apparent Reason to Combine/Modify**

**i. Nature of problem to be solved**

“GABA-a agonists and ARBs were known to be useful for the same purpose—alleviating hypertension . . . [t]he Board was correct that this fact alone can serve as a motivation to combine.” *In re Couvaras*, 2022-1489, 6/14/23.

**ii. Incompatible Reference Requirements**

“The Board reasonably recognized that modifying a device in a manner that would undermine a purpose it shares with the challenged claims counsels against a motivation to make such modifications.” *Medtronic, Inc. v. Teleflex Innovations S.ÀR.L.*, 2021-2359, 6/5/23.

**iii. Hindsight Risk**

“Indeed, to hold otherwise would countenance motivation arguments based on functionally irrelevant features of references that happen to exhibit a benefit for altogether different reasons, a recipe that would be ripe for hindsight abuse.” *Medtronic, Inc. v. Teleflex Innovations S.ÀR.L.*, 2021-2359, 6/5/23.

**d. Reasonable Expectation of Success**

“[T]he absence of a reasonable expectation of success defeats obviousness.” *Medtronic, Inc. v. Teleflex Innovations S.ÀR.L.*, 2021-2357, 6/5/23.

**e. Secondary Indicia of Nonobviousness**

**i. Intervening Time from Prior Art**

“In *Leo Pharmaceutical*, we held that the “length of the intervening time between the publication dates of the prior art and the claimed invention can also qualify as an objective indicator of nonobviousness.” However, that followed from a finding that the record established evidence of a long-felt but unsolved need and failure of others.” *In re Couvaras*, 2022-1489, 6/14/23 (citation omitted).

**ii. Copying**

“The fact that a competitor copied the patentee’s invention, rather than one within the public domain, is probative of nonobviousness because it suggests the competitor saw



value in the invention that he could not achieve without copying.” Medtronic, Inc. v. Teleflex Innovations S.ÀR.L., 2021-2357, 6/5/23.

**iii. Simultaneous Invention**

“Indeed, a competitor’s independent and contemporaneous development of a similar product may, in some cases, even suggest the patented product *would* have been obvious.” “Evidence of access and substantial similarity *is* evidence of copying.” Medtronic, Inc. v. Teleflex Innovations S.ÀR.L., 2021-2357, 6/5/23 (emphasis in original).

**iv. Nexus**

“[T]he unexpected properties of a compound necessarily have a nexus to that compound.” Amgen Inc. v. Sandoz Inc., 2022-1147, 4/19/23.

**v. Presumption of Nexus**

“The Board thus explicitly grounded its nexus finding on a combination of GuideLiner features it found were not disclosed, at least as a combination, in the prior art. We detect no legal error in this analysis.” Medtronic, Inc. v. Teleflex Innovations S.ÀR.L., 2021-2357, 6/5/23.

**vi. Exclusion of Prior Art Results**

“[O]ur case law makes clear that “objective evidence of nonobviousness lacks a nexus if it exclusively relates to a feature that was ‘known in the prior art’”—not necessarily well-known.” Yita LLC v. MacNeil IP LLC, 2022-1373, 6/6/23 (quoting *Rambus Inc. v. Rea*, 731 F.3d 1248, 1257 (Fed. Cir. 2013)).

**vii. Weighing with other *Graham* Factors**

“While we review the ultimate question of obviousness de novo, the Board’s finding that the objective evidence carried significant weight is entitled to deference.” Medtronic, Inc. v. Teleflex Innovations S.ÀR.L., 2021-2357, 6/5/23.

“There is no specific fold-difference that defines what may, or may not, support a finding of nonobviousness. Nor do we draw a line between a difference in degree insufficient to rebut a showing of obviousness and a difference in kind that may be sufficient to do so; each inquiry need be fact-specific.” Amgen Inc. v. Sandoz Inc., 2022-1147, 4/19/23.

## **C. Invalidity Based on § 112**

### **1. Enablement (¶ 1)**

#### **a. Full Scope of the Claim**

##### **i. Range Limitations**

Court considered a 50%-100% limitation with a specification for which “there are at most three examples of responder rates above 50% at 16 weeks: 52%, 61%, and 62%.” “[T]he Board found that the arguments and evidence were insufficient to demonstrate enablement to a skilled artisan because said artisan “would not have been able to achieve” responder rates higher than the limited examples provided in the specification. Substantial evidence supports that finding.” *Medytox, Inc. v. Galderma S.A.*, 2022-1165, 6/27/23.

##### **ii. Open-Ended Limitations**

“Read as a whole, however, we understand the Commission’s opinion as determining there is an inherent upper limit of about 144 connections per U space. That determination was based on the Commission’s finding that skilled artisans would have understood, as of the ’320 and ’456 patent’s shared priority date (August 2008), that densities substantially above 144 connections per U space were technologically infeasible. The Commission’s finding is supported by substantial evidence.” *FS.com Inc. v. Int’l Trade Comm’n*, 2022-1228, 4/20/23.

### **2. Indefiniteness (¶ 2)**

#### **a. Valid**

##### **i. Despite infringement dispute**

“That the jury could have credited [defendant]’s expert and found that the [accused product] does not have [the claim limitation,] but alternatively was free to (and did) credit [patentee]’s contrary position, does not render the claim indefinite. Instead, it simply means the parties here had a genuine dispute on the material question of infringement.” *Ironburg Inventions Ltd. v. Valve Corp.*, 2021-2296, 4/3/23 (citations omitted).

##### **b. Terms Found Definite in Other Patents**

“[W]e find further support for our conclusion, that a person of ordinary skill would be able to reasonably ascertain the scope of the “elongate member” in the context of the ’525 patent’s claims, in prior cases in which we have rejected indefiniteness challenges to similar claim terms.” *Ironburg Inventions Ltd. v. Valve Corp.*, 2021-2296, 4/3/23.

##### **c. Claims with Relative Terms**

“Elongate member” found not to be indefinite because “[f]rom all this intrinsic evidence, as well as the undisputed requirement that the length be greater than the width, one of

ordinary skill would understand that for members to be elongate, as the claims require, they must be sufficiently long to permit a wide range of people, having very different sized hands, to operate the member.” Ironburg Inventions Ltd. v. Valve Corp., 2021-2296, 4/3/23.

#### **d. PTAB Application Supports Definiteness**

“Further support for our conclusion is found in the fact that the PTAB was able to construe the claim term without any indication the parties (or their experts) had any difficulty discerning the meaning of the term.” Ironburg Inventions Ltd. v. Valve Corp., n.3, 2021-2296, 4/3/23.

### **D. Section 101**

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

“District courts have discretion to require parties litigating Section 101 motions to identify representative claims and to articulate why (or why not) claims are representative (including by explaining how a limitation missing from a purportedly representative claim could make a material impact to the Section 101 analysis).” Sanderling Mgmt. Ltd. v. Snap Inc., n.1, 2021-2173, 4/12/23.

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

“The claims of the asserted patents here, by contrast, have a “distribution rule” that merely receives, matches, and then distributes the corresponding function based on the user’s location, a much more generic set of steps than *McRO*’s specific claim language.” Sanderling Mgmt. Ltd. v. Snap Inc., 2021-2173, 4/12/23.

#### **3. Stage of Case for Determination**

##### **a. Motion to Dismiss**

##### **i. Claim Construction Role**

“If claims are directed to ineligible (or eligible) subject matter under all plausible constructions, then the court need not engage in claim construction before resolving a Section 101 motion.” Sanderling Mgmt. Ltd. v. Snap Inc., 2021-2173, 4/12/23.

##### **ii. Leave to Amend**

“No amendment to a complaint can alter what a patent itself states. In this case, then, our agreement with the district court as to what the patent discloses, and our agreement with the court’s application of the *Alice* test, leads inexorably to the conclusion that amendment of the complaint would have been futile.” Sanderling Mgmt. Ltd. v. Snap Inc., 2021-2173, 4/12/23.

## **II. Literal Infringement**

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

#### **1. Despite Expert Testimony**

“While the jury also heard from [defendant]’s noninfringement expert, . . . , it is presumed to have found [plaintiff’s expert] more credible and persuasive, as it was permitted to do.” *Ironburg Inventions Ltd. v. Valve Corp.*, 2021-2296, 4/3/23.

### **B. Evidence of Infringement**

#### **1. No Expert Testimony**

“Thus, we agree with the district court that “expert testimony was not necessary; the technology at issue was easily understandable. . . . [T]he jury could therefore have reached its decision on infringement by ignoring all of the expert testimony and focusing solely on the patent and the accused device.”” *Ironburg Inventions Ltd. v. Valve Corp.*, 2021-2296, 4/3/23.

#### **2. Expert Testimony**

##### **a. Lack of cross**

“[I]t is worth noting that Valve chose to barely crossexamine Mr. Kitchen, asking him only four questions, none of which related to the substance of his infringement opinion.” *Ironburg Inventions Ltd. v. Valve Corp.*, 2021-2296, 4/3/23.

#### **3. Demonstration of Accused Product To the Jury**

“The evidence the jury was free to credit, and on which it could base its finding of infringement, begins with the patent and the Steam Controller itself.” *Ironburg Inventions Ltd. v. Valve Corp.*, 2021-2296, 4/3/23.

## **III. Relief**

### **A. Attorneys’ fees**

#### **1. Exceptional Case (§ 285)**

##### **a. Case Settled**

The parties “stipulated to the dismissal of their claims and counterclaims. [Defendant] then moved for attorney fees and sanctions, which the district court denied. Pure Hemp asks us to reverse and declare this case exceptional. We affirm.” *United Cannabis Corp. v. Pure Hemp Collective Inc.*, 2022-1363, 5/8/23.

## **B. Enhanced Damages**

No abuse to deny enhancement. “Nor did the district court abuse its discretion in finding, as further reason not to enhance, that the only patent claim Ironburg alleged Valve infringed prior to suit was later cancelled by the PTAB in the IPR.” *Ironburg Inventions Ltd. v. Valve Corp.*, 2021-2296, 4/3/23.

### **1. Independent of Willfulness**

“Valve also moved for judgment as a matter of law that any infringement was not willful or, in the alternative, for a new trial on willfulness. The district court erroneously struck this motion as moot, reasoning that because it was not going to exercise its discretion to enhance infringement damages, it did not matter whether the willfulness judgment remained or not. Willfulness and enhancement are separate issues, and a finding of willful infringement may have collateral consequences even for a party not ordered to pay enhanced damages, such as reputational injuries and possible nondischargeability of debts in bankruptcy. Valve should have been provided a ruling on the merits of its motion.” *Ironburg Inventions Ltd. v. Valve Corp.*, 2021-2296, 4/3/23 (citations omitted).

## **C. Willfulness**

### **1. JMOL/Summary Judgment**

No JMOL where there is evidence of patent “notice”, recipient “never provided” patent to “designers”, and “did not attempt to design around the patent.” “All of this provided the jury with substantial evidence to support a finding that [defendant] “recklessly” disregarded [patentee]’s patent rights and, therefore, willfully infringed.” “Valve had notice of the patent – since Ironburg, “through its counsel, sent [Valve] a letter dated March 7, 2014, and provided [Valve] with notice of the '525 patent,” Appx11168 – and agreed to the court instructing the jury that it needed to determine whether Valve acted with “deliberate or reckless disregard of plaintiff’s patent rights,” Appx12094. The jury heard Mr. Quackenbush's admission that he never provided the '525 patent to Valve's designers, a point which the designers confirmed in their testimony, and learned that Valve did not attempt to design around the patent.” *Ironburg Inventions Ltd. v. Valve Corp.*, 64 F.4th 1274 (WestLaw \*12) (Fed. Cir. 2023), *Ironburg Inventions Ltd. v. Valve Corp.*, 2021-2296, 4/3/23 (pages 28-29).

## **IV. Claim Construction**

### **A. Claim Language**

“We start with the claim language.” *Sequoia Tech., LLC v. Dell, Inc.*, 2021-2263, 4/12/23.

## **1. Plain and Ordinary Meaning**

### **a. Statutory subject matter type: system v. device v. method v. computer-readable medium**

“Where, as here, the intrinsic record demonstrates that the term computer-readable recording medium storing instructions (or the like) does not reasonably include transitory media and the specification’s examples are all non-transitory, we will not require the addition of the words “non-transitory” in the claims or specification.” *Sequoia Tech., LLC v. Dell, Inc.*, 2021-2263, 4/12/23.

### **b. Exceptions**

#### **i. Ambiguity/Uncertainty**

“The claim language read in isolation does not clearly support either parties’ construction. Rather, the plain language of the claim limitation “used or not used” begs the question—used for what?” *Sequoia Tech., LLC v. Dell, Inc.*, 2021-2263, 4/12/23.

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

### **a. “Portions” of Elements**

Claimed “disk partition” does not encompass portion where patentee “argues otherwise because the claims do not include the word “whole” in front of “disk partition.” But neither do they include the words “parts” or “portions.” This claim language thus more reasonably suggests that the logical volume is constructed by disk partitions, not portions of disk partitions.” *Sequoia Tech., LLC v. Dell, Inc.*, 2021-2263, 4/12/23 (citations omitted).

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

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

“[Appellant] argues the recitation of “front openings” in unasserted claim 63 evinces the patentee’s clear intent to limit “a front opening” in claim 14 to a single opening. That the patentee limited claim 63 to multiple openings does not show an intent to limit claim 14 to one opening.” *FS.com Inc. v. Int’l Trade Comm’n*, 2022-1228, 4/20/23.

#### **ii. Multiple Functions Linked to “a” Limitation**

“[W]hile the claim term “a microprocessor” does not require there be only one microprocessor, the subsequent limitations referring back to “said microprocessor” require that at least one microprocessor be capable of performing each of the claimed functions. This approach is entirely consistent with our precedent.” “Here, it does not suffice to have multiple microprocessors, each able to perform just one of the recited functions; the claim language requires at least one microprocessor capable of performing each of the recited functions.” *Salazar v. AT&T Mobility LLC*, 2021-2320, 4/5/23.

### **c. Range Limitations and Measurements**

Constructions of greater than 50% and 50%-100% equivalent for determining enablement. “The parties do not meaningfully dispute that there is not a substantive difference between a “threshold” or “range” construction of the responder rate limitation.” “We agree that there appears to be no substantive difference in the claim construction proposed by the parties for the responder rate limitation.” *Medytox, Inc. v. Galderma S.A.*, 2022-1165, 6/27/23.

### **B. Written Description**

#### **1. Advantages/Purposes/Problems Addressed**

Claimed “disk partition” construed to exclude portions. “[A]n expressed purpose of the invention is minimizing metadata.” “The only explanation in the patent for how metadata is minimized is the quoted language above, which credits constructing logical volumes with disk partitions, not portions of disk partitions.” *Sequoia Tech., LLC v. Dell, Inc.*, 2021-2263, 4/12/23.

“Those embodiments that allow the claim’s purpose to be effectuated are within the scope of the claims, while those that do not are not.” *Ironburg Inventions Ltd. v. Valve Corp.*, 2021-2296, 4/3/23.

### **C. Extrinsic Evidence**

#### **1. Improper Reliance Upon**

“[W]e find that the district court clearly erred in considering Red Hat’s expert testimony, which is both inconsistent with the intrinsic evidence and also based on *different* express definitions of CRM in patent specifications directed to *different* inventions.” *Sequoia Tech., LLC v. Dell, Inc.*, 2021-2263, 4/12/23 (emphasis in original).

#### **2. Other Patents**

“Simply put, extrinsic evidence of what other inventors chose to do cannot surmount the intrinsic evidence of what the inventors chose here; context is key in claim construction.” *Sequoia Tech., LLC v. Dell, Inc.*, 2021-2263, 4/12/23.

### **D. Limited and Ordinary Meaning Constructions**

#### **1. Permissibly Vague Construction**

“The district court . . . stated “[t]he term ‘elongate member’ means what it says” and gave the term its plain and ordinary meaning. It also rejected Valve’s proposed construction . . . because it “improperly import[ed] limitations . . . into the claims.” On de novo review, we agree with the district court’s determinations on these points.” *Ironburg Inventions Ltd. v. Valve Corp.*, 2021-2296, 4/3/23.

## **V. Procedural Law**

### **A. JMOL (Rule 50) / Summary Judgment (Rule 56)**

#### **1. Post-Verdict JMOL Requirements**

“AT&T failed to move for judgment as a matter of law under Federal Rule of Civil Procedure 50. Its failure to do so dooms this argument.” The Court contrasted “cursory motions” found to be sufficient in the Fifth Circuit under *Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1380 (Fed. Cir. 2009) with “AT&T explicitly expressed to the district court that it would not move under Rule 50(a) regarding anticipation.” *Salazar v. AT&T Mobility LLC*, 2021-2320, 4/5/23.

### **B. Pleadings/Parties**

#### **1. 12(b)(6) Dismissals**

“Under the Federal Rules of Civil Procedure, the district court must construe the complaint in a light most favorable to the plaintiff and accept as true all facts which the plaintiff alleges. In this case, HCM’s original complaint contained specific allegations that the IQOS system initiated a combustion reaction. In our view, these specific, targeted allegations are sufficient to disavow the contradictory statements in the attached MRTPA.” *Healthier Choices Mgmt. Corp. v. Philip Morris USA, Inc.*, 2022-1268, 4/12/23.

### **C. Discovery/Evidence**

#### **1. Expert Testimony**

##### **a. By Persons with Fact Knowledge**

Discussion of fact witness’s infringement analysis not excluded. “This was fact, not expert, testimony, and the district court was free to exercise its discretion to treat it as relevant to [patentee]’s willfulness claim and, therefore, admissible.” *Ironburg Inventions Ltd. v. Valve Corp.*, 2021-2296, 4/3/23.

## **VI. Federal Circuit Appeals**

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

#### **1. District Court/ITC Appeals**

##### **a. Claim Construction Forfeiture/Wiaver**

##### **i. Indefiniteness waiver**

Argument that “expert’s trial testimony . . . contradicted by a portion of [Appellee]’s closing statement” was forfeited when not raised in JMOL motion. *Ironburg Inventions Ltd. v. Valve Corp.*, 2021-2296, 4/3/23.



## **b. Exceptions**

“Neither party’s briefing failures absolve us of our obligation to apply our binding precedent. [Appellee] does not argue that [Appellant] forfeited its opportunity to rely on Dow and Teva, and [Appellee]’s own decision not to brief these cases cannot be read as a concession that they are indistinguishable.” *Ironburg Inventions Ltd. v. Valve Corp.*, n.4, 2021-2296, 4/3/23.

## **c. New Argument Regarding Issue That Was Raised**

Argument that “expert’s trial testimony . . . contradicted by a portion of [Appellee]’s closing statement” was forfeited when not raised in JMOL motion. *Ironburg Inventions Ltd. v. Valve Corp.*, 2021-2296, 4/3/23.

## **2. Mischaracterizations of Reviewed Decision**

“That the Board did not explicitly address some of Medtronic’s proposed motivations in its *exemplary* reasons does not imply the Board ignored those motivations, especially where, as here, the Board had just enumerated the arguments.” “Indeed, if any inference is to be drawn from the absence of the allegedly ignored motivations in the Board’s exemplary criticisms, it is that the Board considered those motivations and found them more persuasive than those it explicitly decried—precisely the opposite of what Medtronic suggests.” *Medtronic, Inc. v. Teleflex Innovations S.ÀR.L.*, 2021-2357, 6/5/23 (emphasis in original).

### **B. Issue Preclusion on Appeal**

#### **1. Unappealed Issues**

“The district court disagreed, rejecting the importation of a limitation from the specification. UCB does not challenge the district court’s claim construction on appeal. Accordingly, UCB’s argument that the district court ignored long-term room temperature stability fails.” *UCB, Inc. v. Actavis Labs. UT, Inc.*, 2021-1924, 4/12/23.

### **C. Sanctions/Contempt**

“While Pure Hemp’s position is extremely weak, it is neither “frivolous as filed” nor “frivolous as argued.”” *United Cannabis Corp. v. Pure Hemp Collective Inc.*, 2022-1363, 5/8/23.

### **D. Mootness of Appealed Rulings**

#### **1. Element of Appealed Issues**

“We note, however, that even if we agreed to analyze the intrinsic record for the first time on appeal, it would not change our holding on claim construction because the parties’ constructions do not substantively differ. We, therefore, decline to decide the forfeiture issue.” *Medytox, Inc. v. Galderma S.A.*, 2022-1165, 6/27/23.

“Finally, we need not reach the question of corroboration. Howard’s alleged contribution of infrared preheating was insignificant under *Pannu*, so the question of corroboration of evidence regarding Howard’s alleged contribution is rendered moot.” *HIP, Inc. v. Hormel Foods Corp.*, 2022-1696, 5/2/23.

## **2. Addressing Correctness of Moot Rulings**

“Although we do not find error in the district court’s finding of unexpected potency of apremilast relative to the racemic mixture, and we also find it to be dispositive, we also affirm the district court’s findings pertaining to the other objective indicia of nonobviousness.” *Amgen Inc. v. Sandoz Inc.*, 2022-1147, 4/19/23.

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

#### **1. Clear/Plain Error Review**

##### **a. Prohibited Evidence Reweighing**

“Ultimately, even if we saw some merit in UCB’s view of the evidence, we do not reweigh the evidence.” *UCB, Inc. v. Actavis Labs. UT, Inc.*, 2021-1924, 4/12/23.

#### **2. Abuse of Discretion**

##### **a. Collateral Attacks on Appeal**

“It is self-evident that a district court does not abuse its discretion by not conducting a post-dismissal inequitable conduct proceeding, in aid of resolution of a § 285 motion, when the moving party explicitly disclaims any desire for such a proceeding.” *United Cannabis Corp. v. Pure Hemp Collective Inc.*, 2022-1363, 5/8/23.

#### **3. Review Judgments not Opinions**

##### **a. Findings of Fact and Conclusions of Law**

“[W]e read Finding 80 in the context of all the other findings by the district court to simply mean that the claimed range and that in the Muller patents are not patentably distinct.” *UCB, Inc. v. Actavis Labs. UT, Inc.*, 2021-1924, 4/12/23.

##### **b. Interpreting Opinion Being Reviewed**

“Implicit in the district court’s reasoning, however, is the view that the burden of proof rests on Valve, as the party challenging the patent’s validity.” *Ironburg Inventions Ltd. v. Valve Corp.*, n.2, 2021-2296, 4/3/23.

“In the absence of any clear indication that the district court misapprehended or overlooked the full scope of [Appellant]’s indefiniteness contention, we must presume that the court considered, and here rejected, all of it.” *Ironburg Inventions Ltd. v. Valve Corp.*, n.2, 2021-2296, 4/3/23.

## **F. Harmless Error**

### **1. Subset of Evidence Supporting Finding**

“Even assuming this strayed into the realm of undisclosed expert opinion, Valve has failed to show that any error in admitting it was prejudicial, given all the other evidence of infringement the jury had before it, and given that the jury had already heard, without objection, Mr. Ironmonger’s general opinion that the Steam Controller infringed.” “For all of these reasons, there was no abuse of discretion in admitting Mr. Ironmonger’s testimony and, even if there was, any error was harmless, as the jury had substantial evidence to support a verdict of infringement even without considering this testimony.” *Ironburg Inventions Ltd. v. Valve Corp.*, 2021-2296, 4/3/23.

“Valve makes no persuasive showing that admission of the excluded portion of Mr. Quackenbush’s testimony would have affected the jury’s verdict.” *Ironburg Inventions Ltd. v. Valve Corp.*, 2021-2296, 4/3/23.

### **2. PTAB Decisions**

“Our review under the APA is subject to a harmless-error rule, see, e.g., 5 U.S.C. § 706 (“[D]ue account shall be taken of the rule of prejudicial error.”), and the party challenging the Board’s decision must demonstrate the harmfulness of the alleged error.” *M8 LLC v. Sony Interactive Entertainment LLC*, 2022-1291, 5/9/23.

### **3. Additional Element Not Reached**

“After erroneously stating that Pure Hemp had not established it was the prevailing party, the district court went on to consider the question of whether this case is exceptional and concluded that Pure Hemp failed to meet its burden on this additional, necessary element of its motion. As we explain below, the district court did not abuse its discretion in finding this case unexceptional. Therefore, the court’s error was harmless.” *United Cannabis Corp. v. Pure Hemp Collective Inc.*, 2022-1363, 5/8/23.

## **VII. Patent Office Proceedings**

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

#### **1. Burdens of Proof**

“*Aqua Products* stands for the principle that the Board must decide all issues properly before it, even if they are contrary to its result. Nothing in *Aqua Products* mandates that the Board review evidence and issues introduced by a party in violation of its rules or not introduced at all.” *Parus Holdings, Inc. v. Google LLC*, 2022-1269, 6/12/23.

## **a. Petitioner’s Burden of Production**

### **i. Analogous Art**

Where the petitioner “did not make the analogous art argument on which the Board’s obviousness finding relied,” the Federal Circuit reversed the obviousness conclusion. “A petitioner is not required to anticipate and raise analogous art arguments in its petition; instead a petitioner can use its reply to “respond to arguments raised in the corresponding opposition, patent owner preliminary response, patent owner response, or decision on institution.” However, Mylan did not use its reply to explain how de Gennes is analogous to the ’614 patent.” *Sanofi-Aventis Deutschland GmbH v. Mylan Pharms. Inc.*, 2021-1981, 5/9/23 (citation omitted).

## **b. Patent Owner’s Burden of Production**

Patentee “chose to take on an affirmative burden to show that it was the first to make its claimed inventions. Once [patentee] chose to submit a response and assume that burden, it bore the responsibilities that came with it—including submitting a response that complied with the rules and regulations of the USPTO.” *Parus Holdings, Inc. v. Google LLC*, 2022-1269, 6/12/23.

“[W]hen a patent owner attempts to antedate an asserted prior art reference, the patent owner assumes a temporary burden of production.” “The burden of production cannot be met simply by throwing mountains of evidence at the Board without explanation or identification of the relevant portions of that evidence.” *Parus Holdings, Inc. v. Google LLC*, 2022-1269, 6/12/23.

“However, when a patent owner attempts to antedate an asserted prior art reference, the patent owner takes on a temporary burden of production. Once that burden is met, the burden shifts back to the petitioner.” *Medtronic, Inc. v. Teleflex Innovations S.À.R.L.*, 2021-2356, 5/24/23 (citation omitted).

## **c. Conclusory Statements**

“Regardless, Mylan’s conclusory statements arguing that Burren and the ’614 patent address the “same problem” are insufficient to carry its burden to argue de Gennes is analogous to the ’614 patent.” *Sanofi-Aventis Deutschland GmbH v. Mylan Pharms. Inc.*, 2021-1981, 5/9/23.

## **2. Amendments**

### **a. Preliminary Guidance under Pilot Program**

“To be sure, the agency must inform the parties on procedures relevant to its practices, like the Pilot Program, and must respect the boundaries imposed by the APA. There must be structural integrity to the program in en-suring that the patent owners who have requested such guidance be given an opportunity to be heard and due process. On this record, such requirements were met.” *Medytox, Inc. v. Galderma S.A.*, 2022-1165, 6/27/23.

### **3. Appeal**

#### **a. Waiver of issues not included in rehearing request**

“Teleflex contends Medtronic forfeited various arguments by failing to raise them in its Requests for Director Rehearing made pursuant to 37 C.F.R. § 42.71(d), which requires the petitioning party to “specifically identify all matters the party believes the Board misapprehended or overlooked.” Specifically, Teleflex argues Medtronic’s alleged failure to comply with § 42.71(d), while not a jurisdictional bar to our review, grants us discretion to find unraised issues forfeited. We need not resolve this question. Even if Medtronic forfeited these arguments, an issue we do not decide, we have the discretion to reach them on appeal.” *Medtronic, Inc. v. Teleflex Innovations S.ÀR.L.*, n. 5, 2021-2357, 6/5/23.

#### **b. Reversal of PTAB Refusing to Cancel**

##### **i. Objective Indicia**

“[T]he Board’s own findings, in light of the proper application of our precedent, compel the conclusion that MacNeil’s secondary-consideration evidence is of no relevance to the obviousness inquiry in this case.” *Yita LLC v. MacNeil IP LLC*, 2022-1373, 6/6/23.

### **4. Scope of Estoppel**

“[W]e hold that, provided the other conditions of the statute are satisfied, § 315(e)(2) estops a petitioner as to invalidity grounds a skilled searcher conducting a diligent search reasonably could have been expected to discover, as these are grounds that the petitioner “reasonably could have raised” in its petition.” *Ironburg Inventions Ltd. v. Valve Corp.*, 2021-2296, 4/3/23.

#### **a. Burden of establishing estoppel**

“We agree with Valve and now hold that the burden of proving, by a preponderance of the evidence, that a skilled searcher exercising reasonable diligence would have identified an invalidity ground rests on the patent holder, as the party asserting and seeking to benefit from the affirmative defense of IPR estoppel. Our holding is consistent with the general practice that a party asserting an affirmative defense bears the burden to prove it.” *Ironburg Inventions Ltd. v. Valve Corp.*, 2021-2296, 4/3/23.