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## **I. Patentability Requirements**

### **A. Prior Art Invalidity**

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

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

###### **i. Information/Printed Matter Limitations**

“The fact that there is a communication itself is not content; content is what the communication actually says. Nor is the form of a communication, such as whether the communication is encrypted, considered to be content.” “Because “encrypted communications” and “program code” are not being claimed here for the content they communicate, they are not printed matter.” *IOENGINE, LLC v. Ingenico Inc.*, 2021-1227, 5/3/24.

##### **b. Prosecution History**

“[W]here, as here, reexamination evidence is offered by a patentee in connection with opposing summary judgment of invalidity (or reconsideration thereof), and is neither excluded nor deemed inadmissible by the district court, it is error to find a lack of a genuine dispute of material fact by ignoring, dismissing, or discounting the probative value of the reexamination evidence in the record.” *Luv n’ care, Ltd. v. Laurain*, 2022-1905, 4/12/24.

##### **c. Combining/Identifying separate embodiments in a reference**

“The Board found that a skilled artisan would have combined this embodiment, which discloses playing a remote device, with Kim’s watch-type embodiment used in “Figure A,” based on Kim’s direct teaching that its embodiments may be used singly and/or by being combined together. Kim’s disclosure that its sub-device can play music on another device is substantial evidence supporting this finding.” *GUI Glob. Prods., Ltd. v. Samsung Elecs. Co.*, 2022-2156, 4/11/24 (nonprecedential).

#### **2. Obviousness (§ 103)**

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

“Because “[w]hat matters is the objective reach of the claim,” *KSR*, 550 U.S. at 419, the district court erred to the extent it effectively defined its obviousness inquiry as one concerning the “generalized” suitability of the dosing regimens.” “We are persuaded that this misunderstanding about the claims impacted the district court’s overall obviousness analysis.” *Janssen Pharms., Inc. v. Teva Pharms. USA, Inc.*, 2022-1258, 4/1/24.

##### **b. Motivation/Apparent Reason to Combine/Modify**

“This seemingly siloed and inflexible approach left insufficient room for consideration of how background knowledge in the art would have impacted a POSA’s understanding of,

or motivation to modify, the primary references at issue, thereby inflating the significance of minor variations between the prior art and the claims. We vacate and remand on this basis too because it also seems to have prevented the court from carrying out its factfinding role, irrespective of claim scope.” *Janssen Pharms., Inc. v. Teva Pharms. USA, Inc.*, 2022-1258, 4/1/24.

**i. Language in combined references**

No clear error in combining first reference disclosing more than the claimed dosage with reference disclosing lower dosage and suggestion of increasing: “Pimentel further teaches that “[r]ecent data suggest that the *optimal dosage* of rifaximin *may, in fact, be higher* than that used in our study.”” *Salix Pharms., Ltd. v. Norwich Pharms., Inc.*, 2022-2153, 4/11/24.

**c. Secondary Indicia of Nonobviousness**

**i. Unexpected Results**

“To the extent this analysis related to *results* (unexpected or otherwise), it clearly does not involve a comparison of the closest prior art.” *Janssen Pharms., Inc. v. Teva Pharms. USA, Inc.*, 2022-1258, 4/1/24 (emphasis in original).

**ii. Nexus**

“To the extent the court’s nexus analysis consists of the mere observation that Invega Sustenna is a product that embodies the claims and the praise related to Invega Sustenna, that was insufficient.” *Janssen Pharms., Inc. v. Teva Pharms. USA, Inc.*, n.11, 2022-1258, 4/1/24.

**iii. Weighing with other *Graham* Factors**

“Moreover, as Teva correctly notes, the district court here did not explain in the first instance what significance it assigned to secondary considerations within its overall assessment of obviousness.” *Janssen Pharms., Inc. v. Teva Pharms. USA, Inc.*, 2022-1258, 4/1/24.

**d. Design Patents**

“[T]he same conditions for patentability that apply to utility patents apply to design patents.” *LKQ Corp. v. GM Glob. Tech. Operations LLC*, 2021-2348, 5/21/24 (en banc).

**B. Section 135**

“[T]here has been a long-standing exception to section 135(b)(1) when the applicant files its claim after the critical period but “had already been claiming substantially the same invention as the patentee” during the critical period. In such cases, those claims are not time-barred by section 135(b)(1).” *Speck v. Bates*, 2023-1147, 5/23/24 (citations omitted).

“The holdings of our predecessor court, the Court of Customs and Patent Appeals (“CCPA”), which is binding precedent on our court, supports the application of a two-way test.” *Speck v. Bates*, 2023-1147, 5/23/24.

“Because precedent and policy favor application of a two-way test, we hold that the two-way test should be applied to determine if pre-critical date claims and post-critical date claims are materially different.” *Speck v. Bates*, 2023-1147, 5/23/24.

**C. Invalidity Based on § 112**

**1. Indefiniteness (¶ 2)**

**a. Valid**

**i. Measurable Claim Limitations**

“[T]he district court correctly determined that, on this record, Teva did not meet its burden to show that claims 20 and 21 are invalid as indefinite. Specifically, if the measurement discrepancy is an outlier, Teva did not present evidence that different measurement techniques would typically yield different particle-size measurements of paliperidone palmitate.” *Janssen Pharms., Inc. v. Teva Pharms. USA, Inc.*, 2022-1258, 4/1/24.

**D. Section 101**

**1. Abstract Idea Exclusion**

**a. Claimed Subject Matter**

“We determine if the claim’s character as a whole is directed to ineligible subject matter by considering the claim limitations that are purported to describe the claimed advance over the prior art.” *AI Visualize, Inc. v. Nuance Communications, Inc.*, 2022-2109, 4/4/24.

**b. Results-Oriented Claim Language**

“[T]he claims are drafted using largely (if not entirely) result-focused functional language, containing no specificity about how the purported invention achieves those results. Claims of this nature are almost always found to be ineligible for patenting under Section 101.” *Beteiro, LLC v. DraftKings Inc.*, 2022-2275, 6/21/24.

**c. Information Processing**

Invalidity affirmed where “the claims broadly recite generic steps of a kind we have frequently held are abstract: detecting information, generating and transmitting a notification based on the information, receiving a message (bet request), determining (whether the bet is allowed based on location data), and processing information (allowing or disallowing the bet).” *Beteiro, LLC v. DraftKings Inc.*, 2022-2275, 6/21/24.

“Here, the claims in groups 1 and 2 recite a system that includes the functionally-oriented steps of: storing data (VVD) on a server, accepting user requests to view a portion of that data (virtual views), checking for the location of all data needed for the virtual view, “creating” image frames from any non-locally-stored virtual view data, transmitting all non-locally-stored image frames to the user, compiling all image frames, and sequentially displaying the image frames to the user. The group 3 claims are similar. They involve transmitting two versions of all frames—initial, low-quality versions followed by higher-quality versions—from the server to the user. In other words, the asserted claims are directed to converting data and using computers to collect, manipulate, and display the data.” *AI Visualize, Inc. v. Nuance Communications, Inc.*, 2022-2109, 4/4/24 (citations omitted).

#### **d. Inventive Concept/Transformation Exception**

“That only 15 lines out of a specification that runs to no less than 98 columns are addressed to what Beteiro now insists is unconventional technology greatly undermines the plausibility of Beteiro’s allegations.” *Beteiro, LLC v. DraftKings Inc.*, 2022-2275, 6/21/24.

## **II. Other Defenses**

### **A. Lack of Subject Matter Jurisdiction**

#### **1. Standing (see also II.H)**

##### **a. Constitutional Standing**

“Because the ownership question is a threshold “jurisdictional issue of standing” separate from the merits of Core Optical’s patent-infringement suit, the district court has the authority to act as the finder of fact “to resolve the jurisdictional issues.” In this matter, shifting from summary judgment to fact-finding does not involve a shift from judge to jury.” *Core Optical Techs., LLC v. Nokia Corp.*, 2023-1001, 5/21/24 (citation omitted).

“Standing requires: (1) an injury in fact; (2) traceability; and (3) redressability.” *Intell. Tech LLC v. Zebra Techs. Corp.*, 2022-2207, 5/1/24.

“Zebra does present a cursory redressability argument based on IT’s ability to sufficiently prove its damages model. Because this is an argument about IT’s ability to prove substantive elements of its claims instead of a jurisdictional argument, we reject it without further discussion.” *Intell. Tech LLC v. Zebra Techs. Corp.*, n.2, 2022-2207, 5/1/24 (citation omitted).

“The only question before us is whether IT demonstrated the irreducible constitutional minimum of an injury in fact. All that requires here is that IT retained an exclusionary right—i.e., infringement would amount to an invasion of IT’s legally protected interest.” “A patent owner has exclusionary rights sufficient to meet the injury-in-fact requirement even where, without more, it grants another party the ability to license.” *Intell. Tech LLC v. Zebra Techs. Corp.*, 2022-2207, 5/1/24.

“A patent owner has exclusionary rights as a baseline matter unless it has transferred all exclusionary rights away.” *Intell. Tech LLC v. Zebra Techs. Corp.*, 2022-2207, 5/1/24.

“[I]n the context of patent co-owners, which share exclusionary rights, we have concluded that an individual co-owner has Article III standing.” *Intell. Tech LLC v. Zebra Techs. Corp.*, 2022-2207, 5/1/24.

“[An] unexercised option to assign—whether to itself or to others—was not a present divestment of [predecessor]’s exclusionary rights.” *Intell. Tech LLC v. Zebra Techs. Corp.*, 2022-2207, 5/1/24.

## **B. Lack of Personal Jurisdiction**

### **1. Over Patentee**

#### **a. Amazon Program**

“[Accused infringer HQ’d in Utah] argues that [patentee] purposefully directed enforcement activities at Utah when it initiated the APEX program. We agree.” “Because we hold [patentee]’s action of submitting the APEX Agreement was directed towards [the accused infringer] in Utah and aimed to affect marketing, sales, and other activities in Utah, we also conclude [the accused infringer]’s suit arises out of defendant’s activities with the forum.” *SnapRays v. Lighting Defense Group*, 2023-1184, 5/2/24.

“Parties who participate in APEX by submitting an Agreement will only be subject to specific personal jurisdiction where they have targeted a forum state by identifying listings for removal that, if removed, affect the marketing, sales, or other activities in that state.” *SnapRays v. Lighting Defense Group*, 2023-1184, 5/2/24.

## **C. No Ownership/Standing (see also II.C.2)**

### **1. Assignment**

#### **a. Employment Agreements**

“We conclude that the entirely-own-time phrase does not unambiguously express a mutual intent to designate either all the time Dr. Core spent performing his PhD research as his own time (as Core Optical contends) or some of it as partly TRW’s time (as the district court, in agreement with Nokia, held).” *Core Optical Techs., LLC v. Nokia Corp.*, 2023-1001, 5/21/24

## **D. Acts Pursuant to Government Contract (see III.R)**

### **1. PREP Act’s Immunity Provision**

“The PREP Act, when applicable, confers two types of immunity: immunity from suit and immunity from liability. The essence of immunity from suit “is its possessor’s entitlement not to have to answer for his conduct in a civil damages action.” Immunity from liability



means that one cannot be held to pay or otherwise be accountable for whatever loss one has caused.” Copan Italia S.p.A. v. Puritan Med. Prods. Co. LLC, 2022-1943, 5/14/24 (quoting *Mitchell v. Forsyth*, 472 U.S. 511, 525 (1985)).

### **E. Unclean Hands/Sanctions**

“Nor do we find clear error in the district court’s determination that [Appellant]’s misconduct bears an immediate and necessary connection to [Appellant]’s claims for infringement of its ’903 patent. The undisclosed patent applications and their prosecution are directly relevant to the development of [Appellee]’s litigation strategy.” “[Appellant]’s failure to disclose the prior art searches undermined [Appellee]’s ability to press its invalidity and unenforceability challenges.” Luv n’ care, Ltd. v. Laurain, 2022-1905, 4/12/24.

Rejecting challenge to linking conduct regarding one claim to others based on district court finding that “conduct with respect to its pursuit of the [first] claim cannot be cordoned off from its conduct with respect to its pursuit of its other claims.” Luv n’ care, Ltd. v. Laurain, 2022-1905, 4/12/24.

#### **1. Appellate Review**

“We may affirm on any grounds that are adequately supported by the evidence in the record and are not limited to those bases for unclean hands expressly relied on by the district court.” Luv n’ care, Ltd. v. Laurain, 2022-1905, 4/12/24.

### **III. Literal Infringement**

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

##### **1. Evidence Sufficient for Material Dispute**

Sufficient evidence where the plaintiff expert relied on “website guides maintained by Google for the benefit of software engineers who develop applications for use with Nest thermostats. One website page states that the Nest thermostats measure the “[a]mbient temperature,” defined as the “temperature measured near the thermostat”—not just within the thermostat.” “Another website page explains that the temperature sensors of certain Nest products measure ambient room temperature.” In addition, “Google’s non-infringement expert agreed that, according to Google’s website pages, the current ambient temperature in the room is measured by the Nest thermostat’s internal sensors.” In other words, the expert did not agree to the technical fact, only to the statements in the marketing materials. EcoFactor, Inc. v. Google LLC, 2023-1101, 6/3/24.

#### **B. Indirect Infringement**

##### **1. Pleading**

“[T]his case . . . , at bottom, . . . is nothing more than a run-of-the-mill induced infringement case arising under 35 U.S.C. § 271(b). In such a case, we review the allegations of

inducement as a whole, not piecemeal. Accordingly, we must consider whether the totality of the allegations, taken as true, plausibly plead that [defendant] induced infringement.” *Amarin Pharma, Inc. v. Hikma Pharms. USA Inc.*, 2023-1169, 6/25/24.

Allegations that product was identified as a generic version of or equivalent to another product, which was identified as capable of being used in the infringing manner, were sufficient to avoid 12(b)(6) dismissal and “many of the allegations depend on what Hikma’s label and public statements would communicate to physicians and the marketplace. As we observed in *GSK*, that is a question of fact—not law—and is therefore not proper for resolution on a motion to dismiss.” *Amarin Pharma, Inc. v. Hikma Pharms. USA Inc.*, 2023-1169, 6/25/24.

## **2. Induced Infringement**

### **a. Whether Inducement is Active**

Under *Takeda (Takeda Pharms. U.S.A., Inc. v. W.-Ward Pharm. Corp.*, 785 F.3d 625, 631 (Fed Cir. 2015)), “actively” inducing direct infringement can be shown by encouraging, recommending, or promoting such infringement. *Amarin Pharma, Inc. v. Hikma Pharms. USA Inc.*, 2023-1169, 6/25/24.

## **C. Standard of Proof/Review**

### **1. ANDA Infringement**

“That the ANDA further recited a non-patent-protected indication does not negate the infringement resulting from the ANDA’s submission.” *Salix Pharms., Ltd. v. Norwich Pharms., Inc.*, 2022-2153, 4/11/24.

## **D. Evidence of Infringement**

### **1. Marketing/Instruction Materials**

Sufficient evidence where the plaintiff expert relied on “website guides maintained by Google for the benefit of software engineers who develop applications for use with Nest thermostats. One website page states that the Nest thermostats measure the “[a]mbient temperature,” defined as the “temperature measured near the thermostat”—not just within the thermostat.” “Another website page explains that the temperature sensors of certain Nest products measure ambient room temperature.” In addition, “Google’s non-infringement expert agreed that, according to Google’s website pages, the current ambient temperature in the room is measured by the Nest thermostat’s internal sensors.” In other words, the expert did not agree to the technical fact, only to the statements in the marketing materials. *EcoFactor, Inc. v. Google LLC*, 2023-1101, 6/3/24.

## **IV. Relief**

### **A. Attorneys' fees**

#### **1. Exceptional Case (§ 285)**

##### **a. Prevailing Party**

Reversing finding that plaintiff was not prevailing party where plaintiff won on unclean hands which “successfully achieved a material alteration in its legal relationship to [defendant], which no longer has the ability to enforce the '903 patent against [plaintiff]'s accused products.” “It is true that [plaintiff] did not prevail on its LUTPA claims and the district court dismissed its Lanham Act claims without prejudice. It is further true that we are remanding inequitable conduct and obviousness, so it may turn out that [plaintiff] ultimately fails to prove the '903 patent is unenforceable and obvious. But a party is not required “to prevail on all claims in order to qualify as a prevailing party.”” *Luv n' care, Ltd. v. Laurain*, 2022-1905, 4/12/24 (quoting *Shum v. Intel Corp.*, 629 F.3d 1360, 1367-68 (Fed. Cir. 2010)).

##### **b. Entity Liable for Fees**

“We hold § 285 does not entitle Appellants to recovery of fees incurred in parallel IPR proceedings and does not entitle Appellants to hold Dragon's counsel jointly and severally liable for fees.” *Dragon Intellectual Property, LLC v. DISH Network L.L.C.*, 2022-1621, 5/20/24.

##### **c. Fees Incurred in PTO Proceedings**

“We hold § 285 does not entitle Appellants to recovery of fees in-curred in parallel IPR proceedings and does not entitle Ap-pellants to hold Dragon's counsel jointly and severally liable for fees.” *Dragon Intellectual Property, LLC v. DISH Network L.L.C.*, 2022-1621, 5/20/24.

### **B. Injunction**

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

##### **a. Irreparable Harm**

“[N]either a generalized fear of a larger competitor nor any theoretical sale that can be remedied with damages constitutes a cognizable irreparable harm.” *Insulet Corp. v. EOfFlow, Co.*, 2024-1137, 6/17/24.

## **C. Damages Expert Testimony**

### **1. Tied to Particular Facts of Case**

“Far from plucking the \$X royalty rate from nowhere, Mr. Kennedy based this rate on the following admissible evidence: three license agreements and the testimony of EcoFactor’s CEO, Mr. Habib.” EcoFactor, Inc. v. Google LLC, 2023-1101, 6/3/24.

### **2. Reliance on Technical Expert**

## **D. Reasonable Royalty**

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

#### **a. Settlement Agreements**

“Far from plucking the \$X royalty rate from nowhere, Mr. Kennedy based this rate on the following admissible evidence: three license agreements and the testimony of EcoFactor’s CEO, Mr. Habib.” “Each license agreement provided in a whereas clause that the licensee would pay EcoFactor a lump sum amount “set forth in this Agreement based on what EcoFactor believes is a reasonable royalty calculation of [\$X] per-unit for . . . estimated past and [] projected future sales of products accused of infringement in the Litigation.”” EcoFactor, Inc. v. Google LLC, 2023-1101, 6/3/24.

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

“[Plaintiff’s damages expert] testified that in arriving at the \$X royalty rate in a hypothetical negotiation, Google would argue that the three license agreements included EcoFactor’s portfolio, not just the ’327 patent, and thus the \$X royalty rate should be decreased. [Plaintiff’s damages expert] then provided that the three license agreements reflect a settlement and thus the \$X royalty rate reflects a risk that that EcoFactor’s patents would be found not infringed or invalid. According to [Plaintiff’s damages expert], this consideration would not be present at the hypothetical negotiation between EcoFactor and Google, since the assumption is that the ’327 patent was infringed and valid. As a result, this point would place upward pressure on the negotiated rate.” EcoFactor, Inc. v. Google LLC, 2023-1101, 6/3/24.

#### **c. Derived Royalty Rate**

“How much weight should be given to the provisions in the license agreements, including whether they are “self-serving” as Google claims, and the EcoFactor-Johnson email is a question for the jury.” EcoFactor, Inc. v. Google LLC, 2023-1101, 6/3/24.

## **V. Claim Construction**

### **A. Timing of Construction and Parties' Positions**

#### **1. Waiver**

##### **a. PTAB**

Patentee started with a “proposed construction in its [POPR and then], following the Board’s institution decision, [filed a] Patent Owner Response [that] switched its construction to [a second approach].” Patentee’s “choice before the Board to drop its argument [in the POPR] and pivot to [a different POR construction] seems to be a clear abandonment of [the POPR construction].” *IOENGINE, LLC v. Ingenico Inc.*, n.2, 2021-1227, 5/3/24.

## **VI. Unenforceability**

### **A. Material Information**

#### **1. The “But for” Standard**

##### **a. Per Se Materiality Exception**

“[T]he district court should determine whether [the] misrepresentation of the self-sealing functionality of the Platinum Pets mat amounted to affirmative egregious misconduct and is, therefore, per se material.” *Luv n’ care, Ltd. v. Laurain*, 2022-1905, 4/12/24.

## **VII. Procedural Law**

### **A. Setting Aside Judgment (60(b))**

“But Rule 60(b) is permissive, holding only that the court “may relieve a party or its legal representative from a final judgment, order, or proceeding” under various circumstances. That is—a district court has the discretion, not the obligation, to modify a final judgment in view of a post-judgment ANDA amendment. And as the district court held, simply asserting that a patented indication has been carved out of an ANDA application does not necessarily satisfy the judgment or entitle the applicant to direct entry to the market. We see no abuse of discretion in the district court reaching that conclusion or in subsequently denying the motion.” *Salix Pharms., Ltd. v. Norwich Pharms., Inc.*, 2022-2153, 4/11/24.

### **B. Construction**

#### **1. Statutes/Regulations**

When a statute does not define a given word or phrase, we presume that Congress intended the word or phrase to have its ordinary meaning. *Salix Pharms., Ltd. v. Norwich Pharms., Inc.*, 2022-2153, 4/11/24 (citing *Asgrow Seed Co. v. Winterboer*, 513 U.S. 179, 187 (1995)).

## C. Pleadings/Parties

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

“[T]his case reaches us at its most nascent stage: on a motion to dismiss under Federal Rule of Civil Procedure 12(b)(6), where we are tasked with reviewing *allegations*, not findings, for *plausibility*, not probability.” *Amarin Pharma, Inc. v. Hikma Pharms. USA Inc.*, 2023-1169, 6/25/24 (emphases in original).

## D. International Trade Commission/Customs

### 1. Domestic Industry

“Zircon did not allocate its expenditures on its 53 stud finder products separately with respect to each of its products or each of the asserted patents.” “Zircon was required to identify, in some manner, how much of its investment in each statutory category was attributable to each group of products.” “The Commission did not err in finding that Zircon failed to meet that burden when it relied on aggregated evidence of its investments in all domestic industry products.” *Zircon Corp. v. Int’l Trade Comm’n*, 2022-1649, 5/8/24.

## E. Transfer to New Judge or Venue

### 1. Other Practical Problems Factor

“Judicial economy can serve important ends in a transfer analysis. *See In re Vistaprint Ltd.*, 628 F.3d 1342, 1346 (Fed. Cir. 2010). Here, the district court reasonably found that judicial economy considerations disfavor transfer in light of the trial court’s familiarity with the patents and technology from its substantial involvement with prior litigation.” *In re Google LLC*, 2024-117, 4/4/24 (nonprecedential).

## VIII. Federal Circuit Appeals

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

#### 1. District Court/ITC Appeals

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

“[T]he doctrine of waiver does not preclude . . . making any of the arguments [] made to us—e.g., offering a new analogy, changing the emphasis on or ways of describing sources of support—in “defending the original scope of [his] claim construction.”” *D’Agostino v. MasterCard Int’l Inc.*, 2016-1592, 12/22/16 (*quoting Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1346 (Fed. Cir. 2001)). [But see “*Monsanto Tech. LLC v. E.I. DuPont de Nemours & Co.*, 878 F.3d 1336, 1342 n.8 (Fed. Cir. 2018) (finding a claim construction argument forfeited because the appellant failed to raise it to the Board)” used to find forfeiture of a “claim construction argument” even though the same claim construction was advocated below. *Daedalus Blue, LLC v. Vidal*, 2023-1312, 5/21/24 (nonprecedential).]

### **i. Small Difference**

Patentee “argues that it did not forfeit its proposed construction because, in [its] view, its constructions before the Board and this Court embody the same concepts. We disagree. Requiring [appellate construction] meaningfully from requiring [IPR construction].” IOENGINE, LLC v. Ingenico Inc., 2021-1227, 5/3/24 (citation omitted).

## **2. PTO Appeals**

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

“*Monsanto Tech. LLC v. E.I. DuPont de Nemours & Co.*, 878 F.3d 1336, 1342 n.8 (Fed. Cir. 2018) (finding a claim construction argument forfeited because the appellant failed to raise it to the Board)” used to find forfeiture of a “claim construction argument” even though the same claim construction was advocated below. *Daedalus Blue, LLC v. Vidal*, 2023-1312, 5/21/24 (nonprecedential).

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

“[Appellant] focuses on minor differences in the language the Board used to argue that the Board’s reasoning was inconsistent, but these minor differences do not matter. The Board cited the same evidence to make the same finding, and we decline [Appellant]’s invitation to undo adequately explained, evidence-supported findings over inconsequential differences in word choice.” *GUI Glob. Prods., Ltd. v. Samsung Elecs. Co.*, 2022-2156, 4/11/24 (nonprecedential).

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

### **1. Invalidity/Unpatentability Findings**

“Our remand . . . did not end the litigation on the merits. Instead, to comply with our remand, the district court was required to modify its original judgment to eliminate a portion of its compensatory damages award and to determine the impact of that elimination on the proper amount of enhanced damages. Again, this is something more than “nothing . . . but execute the judgment.”” *Packet Intel. LLC v. NetScout Sys., Inc.*, 2022-2064, 5/2/24.

## **C. Appellate Jurisdiction**

### **a. Denial of Summary Judgment**

“Google now appeals the district court’s denial of summary judgment regarding patent ineligibility of claim 5 of the ’327 patent, but we have held that a district court’s denial of

summary judgment is not appealable after a trial on the merits.” “Because trial on the merits of the § 101 issue was held, the court’s denial of summary judgment is not appealable.” *EcoFactor, Inc. v. Google LLC*, 2023-1101, 6/3/24.

### **b. Liability-Only/Outstanding-Accounting Determinations**

After SJ of both infringement and non-obviousness, jurisdiction was available under 28 U.S.C. § 1292(c)(2) and *Robert Bosch, LLC v. Pylon Mfg. Corp.*, 719 F.3d 1305, 1317 (Fed. Cir. 2013) (en banc). *Fullview, Inc. v. Polycom, Inc.*, 2023-1201, 4/29/24 (nonprecedential).

## **2. Collateral Order Doctrine**

“The collateral order doctrine is a limited exception to the general requirement that appellate jurisdiction arises only after a district court issues a final order.” *Copan Italia S.p.A. v. Puritan Med. Prods. Co. LLC*, 2022-1943, 5/14/24.

“It must [1] ‘conclusively determine the disputed question,’ [2] ‘resolve an important issue completely separate from the merits of the action,’ and [3] ‘be effectively unreviewable on appeal from a final judgment.’” If any one of these conditions is not met, the collateral order doctrine does not apply, and we lack jurisdiction to review the order in question.” *Copan Italia S.p.A. v. Puritan Med. Prods. Co. LLC*, 2022-1943, 5/14/24.

Appeal dismissed because “[t]he district court did not make any factual or legal determination that Puritan’s flocked swabs made at its P3 facility are not immune. Instead, it simply – and preliminarily – held that it was not in a position to make these determinations at this time. This is not a “conclusive determination” of the immunity issue.” *Copan Italia S.p.A. v. Puritan Med. Prods. Co. LLC*, 2022-1943, 5/14/24.

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

### **1. Substantial Evidence Threshold**

#### **a. Agency Findings**

“The Board relied on the petitioner’s expert testimony, as well as the disclosures in [the references] themselves, to conclude that a skilled artisan would have been motivated to combine [the references]. Substantial evidence supported the Board’s finding.” *IOENGINE, LLC v. Ingenico Inc.*, 2021-1227, 5/3/24 (citation omitted).

#### **b. Expert Testimony**

##### **i. For Rejecting**

“The ALJ also did not credit expert witness Walter Bratic’s testimony on that issue because Mr. Bratic relied exclusively on Mr. Bourque’s testimony and did not review any documents to support his testimony. The Commission found no error in the ALJ’s determination and adopted the ALJ’s finding on that issue.” “Substantial evidence supports



the Commission’s finding that Zircon failed to meet its burden to prove its investments in the chip were substantial. The ALJ did not err by finding that Mr. Bourque’s unelaborated statement regarding the portion of the company’s research and development funds that were devoted to developing the chip was not sufficient to show that Zircon’s investments in the chip were substantial.” *Zircon Corp. v. Int’l Trade Comm’n*, 2022-1649, 5/8/24 (citation omitted).

## **2. Abuse of Discretion**

“An abuse of discretion may be established by showing that a material factor deserving significant weight has been ignored, that an improper fact was relied upon, or that the court made a serious mistake in weighing the facts.” “[T]he court did not assess the statute of limitations in the context of evaluating Insulet’s likelihood of success on the merits. The court thus ignored a material factor deserving significant weight, which constitutes an abuse of discretion.” *Insulet Corp. v. EOFlow, Co.*, 2024-1137, 6/17/24 (applying first circuit law).

### **a. Legal Errors**

“Here, the district court did not apply this legal standard and, thereby, abused its discretion. The district court considered each [] individual act[] of misconduct in isolation and failed to address the collective weight of the evidence regarding each person’s misconduct as a whole. Hence, we vacate the district court’s findings on deceptive intent.” *Luv n’ care, Ltd. v. Laurain*, 2022-1905, 4/12/24.

## **E. Harmless Error**

“At bottom, under the facts here, substance beats form.” *United Therapeutics Corp. v. Liquidia Techs., Inc.*, 2022-2133, 6/28/24 (nonprecedential).

### **1. Harmless Error in Improperly Relying on Document**

“Although the district court cited the Press Release in its discussion of the skilled artisan’s expectations, it ultimately held that the “Protocol and Pimentel [] disclose all limitations of the IBS-D claims” and that a skilled artisan “would have been motivated to combine the . . . Protocol and Pimentel [] with a reasonable expectation of success.” We therefore need not decide whether or not the Press Release was prior art because, even assuming that it was not, the Protocol and Pimentel alone established the obviousness of the claims.” *Salix Pharms., Ltd. v. Norwich Pharms., Inc.*, 2022-2153, 4/11/24 (citation omitted).

### **2. Flawed Claim Construction**

“We are persuaded that this misunderstanding about the claims impacted the district court’s overall obviousness analysis.” “In sum, as discussed above, the court’s framing led it to ask the wrong questions about important aspects of the obviousness inquiry. This error requires a remand as to all claims because as it currently stands, the record does not contain underlying obviousness factfindings that are cued to the “a psychiatric patient” claims at issue here.” *Janssen Pharms., Inc. v. Teva Pharms. USA, Inc.*, 2022-1258, 4/1/24.

## **F. Precedent**

### **1. Prior Courts**

““The holdings of our predecessor court, the Court of Customs and Patent Appeals (“CCPA”), which is binding precedent on our court, supports the application of a two-way test.” *Speck v. Bates*, 2023-1147, 5/23/24.” *Speck v. Bates*, 2023-1147, 5/23/24.

### **2. District Court Decisions**

“[T]he court here acted within its discretion when it declined to follow the district court decision in *Pharmacyclics* as though it was binding precedent. And our later affirmance of the factual findings in *Pharmacyclics* did not retroactively override the district court’s analysis here.” *Salix Pharms., Ltd. v. Norwich Pharms., Inc.*, 2022-2153, 4/11/24 (citation omitted).

## **G. Remand Determination**

### **1. Case Management Direction on Remand**

Appellant “proposes . . . that we order the district court to limit discovery to the immunity issue, and address its affirmative defense, before proceeding to patent-related discovery. We will not interfere with the district court’s broad case management discretion by ordering it to proceed in this manner.” *Copan Italia S.p.A. v. Puritan Med. Prods. Co. LLC*, 2022-1943, 5/14/24.

### **2. Scope of Mandate**

#### **a. Vacating Infringement, But Not Claim Construction**

“The district court vacated its noninfringement judgments but declined to dismiss the cases, retaining jurisdiction to resolve Appellants’ fee motions. Dragon did not request, and the district court did not grant, vacatur of the claim construction order.” “Dragon’s argument that vacatur of the noninfringement judgment required the district court to ignore its claim construction order in determining exceptionality is incorrect.” *Dragon Intellectual Property, LLC v. DISH Network L.L.C.*, 2022-1621, 5/20/24 (citation omitted).

### **3. Resolution in the First Instance**

#### **a. Whether Claims are Materially Different**

“Here the Board only determined that the claims were not materially different under the one-way test and did not address whether there were material differences under the two-way test.” “On the record before us, we conclude that as a matter of law under the two-way test the two sets of claims are materially different.” *Speck v. Bates*, 2023-1147, 5/23/24.

## **IX. Patent Office Proceedings**

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

#### **1. Evidentiary Rulings**

##### **a. Declaration Errors**

Affirmed Board’s relying on a declaration after excusing Appellant’s “fail[ure] to include such an oath or declaration in the Winkler Declaration” where “[Appellee] made the strategic decision to “rigorously” depose Dr. Winkler”, “questioned Dr. Winkler about his declaration under oath [and] confirmed there were no issues concerning the truthfulness of the opinions in the Winkler Declaration” and “Dr. Winkler confirmed that he would “provide truthful, accurate testimony” that he wrote the Winkler Declaration[, and] confirmed his signature on the Winkler Declaration.” “These are the hallmark guarantees of truthfulness that supplant the missing oath or declaration.” *United Therapeutics Corp. v. Liquidia Techs., Inc.*, 2022-2133, 6/28/24 (nonprecedential) (citations omitted).