

## Table of Contents

I.	Patentability Requirements .....	1
A.	Prior Art Invalidity.....	1
1.	Anticipation (§ 102).....	1
a.	Publications/Patents .....	1
i.	Public Accessibility – presented documents (or both).....	1
2.	Obviousness (§ 103) .....	1
a.	Differences Between the Prior Art and the Claims at Issue.....	1
i.	Prior Art Overlaps with Claimed Range.....	1
ii.	Undisclosed Elements and Dependent Claims .....	1
iii.	Whether All Limitations Disclosed .....	1
b.	Motivation/Apparent Reason to Combine/Modify .....	2
i.	Language in combined references .....	2
ii.	Known Reason to Combine .....	2
iii.	Evidence of Reasons to Combine .....	2
c.	Reasonable Expectation of Success .....	2
d.	Expert Testimony.....	2
i.	Conclusory .....	3
e.	Secondary Indicia of Nonobviousness.....	3
i.	Weighing with other <i>Graham</i> Factors .....	3
ii.	Jury Instructions.....	3
f.	Inventor Actions or Knowledge/Obvious to Try .....	3
B.	Invalidity Based on § 112 .....	4
1.	Written Description (¶ 1) .....	4
a.	Claimed Measurement Range.....	4
C.	Section 101.....	4
1.	Abstract Idea Exclusion .....	4
a.	Information Processing.....	4
b.	Inventive Concept/Transformation Exception.....	4
2.	Combination of Natural Phenomenon and Abstract Idea .....	4
II.	Other Defenses.....	4
A.	Improper Venue .....	4
1.	Mandamus.....	4
B.	ANDA Infringement Defenses .....	5
III.	Literal Infringement.....	5
A.	Summary Judgment/JMOL.....	5
1.	In Favor of Patentee .....	5
2.	Evidence Sufficient for Material Dispute .....	5
IV.	Relief.....	6
A.	Injunction .....	6
1.	Permanent Injunction .....	6
a.	Irreparable Injury .....	6
i.	Nature of Plaintiff’s Business .....	6
2.	Injunctions Against Other Proceedings .....	6
a.	Injunctions Against IPR Petitions.....	6

B.	Reasonable Royalty .....	6
1.	Minimum Measure of Damages.....	6
a.	No Damages.....	6
2.	Accused Infringer Patents.....	6
C.	Foreign Activities.....	7
V.	Claim Construction.....	7
A.	Claim Language.....	7
1.	Plain and Ordinary Meaning.....	7
a.	Multiple Word Limitations .....	7
2.	Open/Closed Claims, Generic and Negative Limitations .....	7
a.	Comprising.....	7
i.	Negative limitation.....	7
b.	Defining/Positioning/Connecting Terms .....	8
3.	Functional v. Structural Language.....	8
a.	Capable/Adaptable/Adjustable Elements.....	8
i.	Design Intent.....	8
4.	Effect of Other Limitations in Claim.....	8
a.	Surplusage OK.....	8
b.	Overlap in scope of different limitations .....	8
c.	Different terms have different meanings .....	8
d.	Absent Modifiers Should Not Be Construed Into Existence .....	9
5.	Effect of Other Claims .....	9
a.	Claim Differentiation .....	9
i.	Differentiation Between Independent Claims.....	9
6.	Method Claims.....	9
a.	Required Order of Steps.....	9
i.	Order indicated in subset of steps .....	9
B.	Written Description.....	9
1.	Figures.....	9
2.	Summary of the Invention .....	10
C.	Prosecution History.....	10
1.	Issuing Application .....	10
a.	Changes Meaning.....	10
i.	Limits Particular Claim Term .....	10
D.	Extrinsic Evidence .....	10
1.	Industry Practice .....	10
2.	Party Admissions/Marking/Expert Testimony/Marketing.....	10
E.	Timing of Construction and Parties' Positions .....	10
1.	Agreed and Proposed Constructions.....	10
a.	Independent Construction .....	10
VI.	Unenforceability .....	11
A.	Intent to Deceive.....	11
1.	Declarations .....	11
a.	To Revive Application.....	11
VII.	Procedural Law .....	11
A.	Preclusion.....	11

1.	Issue Preclusion - Collateral Estoppel .....	11
a.	Same Issue of Law or Fact Necessary to Judgment.....	11
i.	Claim Construction Preclusion .....	11
B.	Jury Issues.....	11
1.	Jury Instructions.....	11
a.	Prejudicial Effect of Erroneous Jury Instructions.....	11
C.	International Trade Commission/Customs .....	11
1.	Domestic Industry.....	11
D.	Transfer to New Judge or Venue .....	12
1.	Cost of Attendance of Willing Witnesses Factor.....	12
E.	Staying Case.....	12
1.	Copending IPR/CBMR .....	12
a.	Mandamus.....	12
VIII.	Federal Circuit Appeals .....	12
A.	New Arguments/Issues on Appeal/Forfeiture/Waiver/Judicial Estoppel .....	12
1.	District Court/ITC Appeals.....	12
a.	Failure to Object at Trial.....	12
i.	After Denial of Motion in Limine.....	12
2.	PTO Appeals.....	13
a.	Appeals from PTAB Decision .....	13
B.	Appellate Jurisdiction .....	13
1.	Rulings on Issues Not Relied Upon for Appealed Judgment .....	13
a.	Claim Construction .....	13
C.	Sanctions/Contempt.....	13
D.	Cross-Appeals v. Alternate Bases for Affirmance.....	13
1.	Alternative Bases for Expert Exclusion.....	13
E.	Scope of Claim Construction Review.....	14
1.	Implicit Claim Construction Disputes .....	14
2.	Claim Construction Modified on Appeal.....	14
a.	Vacate and Remand in View of New Construction .....	14
3.	Construing claim terms not necessary to resolve appeal .....	14
a.	Rejecting Unwarranted Limitations Enough .....	15
F.	Standards of Review and Record/Appendix on Appeal .....	15
1.	Substantial Evidence Threshold.....	15
a.	Expert Testimony.....	15
i.	Not substantial .....	15
2.	Clear/Plain Error Review .....	15
a.	Based on Analysis as a Whole .....	15
G.	Harmless Error .....	15
1.	Mistatement in Decision/Order/Opinion.....	15
H.	Remand Determination .....	16
1.	Vacating General Jury Verdict.....	16
2.	Resolution in the First Instance.....	16
3.	Judicial Notice on Appeal.....	16
a.	Denied.....	16
I.	Briefing Related and Multi-Defendant Cases .....	16

IX.	Patent Office Proceedings.....	16
A.	Inter Partes Review .....	16
1.	Joinder.....	16
a.	Limitations on Participation.....	16
2.	Amendments .....	17
a.	Preliminary Guidance under Pilot Program .....	17
3.	Appeal .....	17
a.	Reversal of PTAB .....	17
i.	Teachings of Reference.....	17
4.	Supplemental Information/Arguments (e.g., in reply).....	17
a.	Information/Arguments Required in Petition .....	17
5.	Obviousness Rulings.....	17
a.	Reversal.....	17
6.	Director Rehearing Decisions .....	18
7.	Due Process and APA Violations .....	18

## **I. Patentability Requirements**

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

#### **1. Anticipation (§ 102)**

##### **a. Publications/Patents**

“Weber’s assertion of copyright ownership does not negate its own ability to make the reference publicly accessible.” *Weber, Inc. v. Provisur Techs., Inc.*, 2022-1751, 2/8/24.

##### **i. Public Accessibility – presented documents (or both)**

“[O]perating manuals were accessible to interested members of the relevant public by reasonable diligence. For instance, Weber employees testified that the operating manuals could be obtained either upon purchase of the Weber food slicer or upon request directed to a Weber employee.” *Weber, Inc. v. Provisur Techs., Inc.*, 2022-1751, 2/8/24.

“*Cordis* is readily distinguishable from this case. Weber’s operating manuals were created for dissemination to the interested public to provide instructions about how to assemble, use, clean, and maintain Weber’s slicer, as well as guidance for addressing malfunctions that users might encounter.” *Weber, Inc. v. Provisur Techs., Inc.*, 2022-1751, 2/8/24.

#### **2. Obviousness (§ 103)**

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

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

“[A]n overlap between a claimed range and a prior art range creates a presumption of obviousness that can be rebutted with evidence that the given parameter was not recognized as result-effective.” *Pfizer Inc. v. Sanofi Pasteur Inc.*, 2019-1871, 3/5/24.

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

Dependent claims 48 and 49 remanded. “The only mention of those claims in that decision is a conclusory statement, prior to any analysis, that the Board determined that “claims 46 and 48–52 would have been obvious over the combination of Hausdorff, Merck-086, GSK-711, and the knowledge of the skilled artisan.” The ensuing analysis, however, focuses only on the elements of claim 46, and fails to consider whether the incorporation of the glycoconjugates recited in proposed claims 48 and 49 would have been expected to exhibit the claimed 2-log IgG increase.” *Pfizer Inc. v. Sanofi Pasteur Inc.*, 2019-1871, 3/5/24 (citation omitted).

##### **iii. Whether All Limitations Disclosed**

“[T]he determination whether or not a claimed parameter is a result-effective variable is merely one aspect of a broader routine optimization analysis.” “A routine optimization

analysis generally requires consideration whether a person of ordinary skill in the art would have been motivated, with a reasonable expectation of success, to bridge any gaps in the prior art to arrive at a claimed invention. Where that gap includes a parameter not necessarily disclosed in the prior art, it is not improper to consider whether or not it would have been recognized as result-effective.” Pfizer Inc. v. Sanofi Pasteur Inc., 2019-1871, 3/5/24.

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

“KSR did not do away with the requirement that there must exist a motivation to combine various prior art references in order for a skilled artisan to make the claimed invention.” Virtek Vision Int’l ULC v. Assembly Guidance Sys., Inc., 2022-1998, 3/27/24.

**i. Language in combined references**

“In light of Robinson’s statements about altering the heating element and the potential for design choices, the Board’s finding that Robinson invites a person of skill in the art to look at other heating elements outside of Robinson is reasonable.” RAI Strategic Holdings, Inc. v. Philip Morris Prods., S.A., 2022-1862, 2/9/24.

**ii. Known Reason to Combine**

“It does not suffice to simply be known. A reason for combining must exist.” Virtek Vision Int’l ULC v. Assembly Guidance Sys., Inc., 2022-1998, 3/27/24.

**iii. Evidence of Reasons to Combine**

“The asserted prior-art references and product-design-related testimony from other witnesses provides additional support for finding a motivation to make the argued combination.” Inline Plastics Corp. v. Lacerta Group, LLC, 2022-1954, 3/27/24.

**c. Reasonable Expectation of Success**

“While neither Merck-086 nor Hausdorff discloses the claimed result across *all* fourteen claimed serotypes, a finding of obviousness does not require a guarantee of success. As we have already noted, an expectation of success need only be *reasonable*, not absolute.” Pfizer Inc. v. Sanofi Pasteur Inc., 2019-1871, 3/5/24 (both emphases in original).

**d. Expert Testimony**

Discussing open question of whether expert testimony as to conclusion of obviousness may be admitted without “all factors” of obviousness being considered and “without documentation of the consideration in an adequate expert report.” Inline Plastics Corp. v. Lacerta Group, LLC, 2022-1954, 3/27/24.

**i. Conclusory**

“With respect to claim 3, Dr. Mohazzab testified ’094 Rueb discloses a camera with a multi megapixel sensor and a skilled artisan “would also have known to use a camera with a multi megapixel sensor in mid-2016.” This conclusory testimony fails to address why or whether a skilled artisan would have been motivated to combine the camera disclosed in ’094 Rueb with Keitler and Briggs.” *Virtek Vision Int’l ULC v. Assembly Guidance Sys., Inc.*, 2022-1998, 3/27/24.

**e. Secondary Indicia of Nonobviousness**

**i. Weighing with other *Graham* Factors**

“[W]e have never held that the challenger must present its own testimony on objective indicia or else the patentee’s evidence must be credited, much less must be credited as dispositive of the obviousness issue. After all, a jury may reasonably decide not to credit the patentee’s evidence on objective indicia, or to assign it little weight, because of the weakness of that evidence on its own.” *Inline Plastics Corp. v. Lacerta Group, LLC*, 2022-1954, 3/27/24.

**ii. Jury Instructions**

“During the trial, Inline presented evidence of industry praise for its products, evidence that it highlighted in its closing arguments. Inline also presented evidence earlier in the trial that, it reasonably asserts, has weight as evidence for additional objective indicia, such as copying and licensing. That evidence, taken together, called for an instruction, if properly requested, on the objective indicia to which the evidence pertains, so that the jury could assess its weight as objective indicia and—where the jury was asked for the bottom-line answer on obviousness—in relation to the prima facie case.” (citations omitted). *Inline Plastics Corp. v. Lacerta Group, LLC*, 2022-1954, 3/27/24.

**f. Inventor Actions or Knowledge/Obvious to Try**

“Cardiovalve argues that, in order to be a “known option[.]” within the obvious-to-try passage of *KSR*, 550 U.S. at 421, the option at issue must have been expressed in prior art documents. That proposed document requirement is nowhere articulated in *KSR*, and adopting it would be inconsistent with the Supreme Court’s rejection in *KSR* of a rigid demand for the steps in an obviousness analysis to be proved by prior-art documents, to the exclusion of the knowledge and skill of the relevant artisan.” *Cardiovalve Ltd. v. Edwards Lifesciences Corp.*, 2022-2230, 3/21/24 (citation omitted) (nonprecedential).

## **B. Invalidity Based on § 112**

### **1. Written Description (¶ 1)**

#### **a. Claimed Measurement Range**

“The question thus is whether the disclosure of a length of about 75% to about 125%, about 80% to about 120%, about 85% to about 115%, or about 90% to about 110% “reasonably conveys to those skilled in the art that the inventor had possession” of the claimed length of “about 75% to about 85%.”” “[T]here is no evidence that the claimed subrange results in a different invention than the invention disclosed in the specification. Accordingly, for all of the above reasons, we conclude that no reasonable fact finder could find that the claimed subrange is not within the appellant’s invention.” RAI Strategic Holdings, Inc. v. Philip Morris Prods., S.A., 2022-1862, 2/9/24.

## **C. Section 101**

### **1. Abstract Idea Exclusion**

#### **a. Information Processing**

“The claims broadly recite correlating advertisements with search results using a generic process.” Chewy, Inc. v. Int’l Bus. Machs. Corp., 2022-1756, 3/5/24.

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

“Using a generic database to store the information used in correlating advertisements with search results is not an inventive concept.” Chewy, Inc. v. Int’l Bus. Machs. Corp., 2022-1756, 3/5/24.

### **2. Combination of Natural Phenomenon and Abstract Idea**

“PureCircle contends that because the conversion of Reb D to Reb X would never reach 50% completion in nature, claim 14 is not directed to a natural phenomenon. The problem with PureCircle’s argument is that the 50% completion is itself an abstract idea.” PureCircle USA Inc. v. SweeGen, Inc., 2022-1946, 1/2/24 (nonprecedential).

## **II. Other Defenses**

### **A. Improper Venue**

#### **1. Mandamus**

Petitioner “petitions for a writ of mandamus directing the . . . Western District of Texas to transfer this action to the . . . Western District of North Carolina.” “We conclude that the court’s denial of Honeywell’s motion to transfer amounts to a clear abuse of discretion leading to a patently erroneous result. We accordingly grant Honeywell’s mandamus petition and direct transfer.” In re Honeywell Int’l Inc., 2023-152, 1/26/24.



“In sum, as in *TikTok* and other recent cases in which this court and the Fifth Circuit have granted mandamus, several important transfer factors favor transfer, while nothing of significance ties this case to the Western District of Texas.” *In re Honeywell Int’l Inc.*, 2023-152, 1/26/24.

## **B. ANDA Infringement Defenses**

“35 U.S.C. § 271(e)(1)’s safe harbor applies when undisputed evidence shows [] importation of [] demonstration samples of [claimed devices] to a medical conference was reasonably related to recruiting investigators for a clinical trial to support FDA approval.” “[T]he relevant inquiry is not *why* Meril imported the two transcatheter heart valve systems, or *how* Meril used the imported transcatheter heart valve systems, but whether the act of importation was for a use reasonably related to submitting information to the FDA.” *Edwards Lifesciences Corp. v. Meril Life Sciences Pvt. Ltd.*, 2022-1877, 3/25/24 (emphases in original).

## **III. Literal Infringement**

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

#### **1. In Favor of Patentee**

Denial of JMOL for patentee affirmed where “there was evidence from which the jury could reasonably find the claim limitation, when given its ordinary meaning in the context of the patent, not to be met by the [evidence of the accused feature.” “One reasonable understanding of the “identify an item” claim language, in the context of the patent, is that it refers to a specific, purchasable item.” *Freshub, Inc. v. Amazon.com, Inc.*, 2022-1391, 2/26/24.

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

Summary judgment vacated based on privacy policy creating material dispute. “When viewed through the proper lens, the privacy policy supports a finding that Chewy delivers advertisements based on the individual user’s interaction history.” *Chewy, Inc. v. Int’l Bus. Machs. Corp.*, 2022-1756, 3/5/24.

Accused infringer criticized lack of source code citations, but “Strategies” document was sufficient for SJ. “Chewy’s “Currently Launched Strategies” document sufficiently describes the accused functionality to create a genuine dispute of fact.” *Chewy, Inc. v. Int’l Bus. Machs. Corp.*, 2022-1756, 3/5/24.

## **IV. Relief**

### **A. Injunction**

#### **1. Permanent Injunction**

##### **a. Irreparable Injury**

###### **i. Nature of Plaintiff's Business**

“Such an exclusive-licensing patentee might well face harm beyond the simple loss of reliably measurable licensing fees, including price erosion, damage to intangible reputation, harm to brand loyalty, and permanent loss of customers.” *In re California Expanded Metal Prods. Co.*, 2023-1140, 3/20/24 (nonprecedential).

#### **2. Injunctions Against Other Proceedings**

##### **a. Injunctions Against IPR Petitions**

Denial of preliminary injunction affirmed. “[S]ections F.3 and F.4 indisputably allowed IPR filings during the Covenant Period under certain conditions. It necessarily follows that because the forum selection clause governs both during and after the Covenant Period, the clause cannot operate to prohibit the filing of IPRs after the Covenant Period if it allowed them during the Covenant Period.” *DexCom, Inc. v. Abbott Diabetes Care, Inc.*, 2023-1795, 1/3/24 (citation omitted).

“Although we held that the specific forum selection clauses at issue in those cases prohibited filing a proceeding outside the stipulated forum, those cases lacked a key circumstance present here—that the Agreement allowed the filing of IPR petitions under certain circumstances notwithstanding the existence of the forum selection clause. *DexCom, Inc. v. Abbott Diabetes Care, Inc.*, 2023-1795, 1/3/24.

### **B. Reasonable Royalty**

#### **1. Minimum Measure of Damages**

##### **a. No Damages**

“We find no error in the district court’s conclusion that, as a matter of law, CEMCO failed to carry its burden to prove damages for lack of such explanation of the proper royalty rate in its evidence.” *In re California Expanded Metal Prods. Co.*, 2023-1140, 3/20/24 (nonprecedential).

#### **2. Accused Infringer Patents**

“[Patentee] has not pointed to legal authority establishing that [accused infringer]’s patent was inadmissible as irrelevant, as a matter of law, to the issues of willfulness or damages. And as [patentee] itself observes, the district court gave a limiting instruction to the jury,

on two occasions, clarifying that the jury should consider [accused infringer]’s patent only on the issues of willfulness and damages but not on the issue of infringement. We do not see reversible error in these circumstances.” *Inline Plastics Corp. v. Lacerta Group, LLC*, 2022-1954, 3/27/24 (citation omitted).

### **C. Foreign Activities**

Court found minimum requirements for seeking reasonable royalties based on foreign activities. “If the patentee seeks to increase that amount by pointing to foreign conduct that is not itself infringing, the patentee must, at the least, show why that foreign conduct increases the value of the domestic infringement itself—because, e.g., the domestic infringement enables and is needed to enable otherwise-unavailable profits from conduct abroad—while respecting the apportionment limit that excludes values beyond that of practicing the patent. This kind of causal connection, framed in terms of the agreement-to-pay aspect of a hypothetical negotiation, is a necessary beginning—we need not here say it is sufficient—for a foreign-conduct analysis in a reasonable-royalty case.” *Brumfield v. IBG LLC*, 2022-1630, 3/27/24.

## **V. Claim Construction**

### **A. Claim Language**

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

##### **a. Multiple Word Limitations**

“[S]omething more must also be included in the construction, for we must give weight to both “matingly” and “engaged.”” *CoolIT Sys. Inc. v. Vidal*, 2022-1221, 3/7/24 (nonprecedential).

“We first conclude that the district court erred by narrowly construing “back channel” . . . . Nothing in the claim language suggests the limitation to a fixed band of frequencies or time slots. “Back” undisputedly refers to . . . . And whether “channel” means . . . .” *Promptu Sys. Corp. v. Comcast Corp.*, 2022-1939, 2/16/24.

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

##### **a. Comprising**

##### **i. Negative limitation**

“‘[I]dentifying a single biomolecule’ . . . has an ordinary meaning on its face and in context. The language refers to (a) ascertaining the identity of a biomolecule, i.e., what that biomolecule is, and (b) doing so by examining just that one biomolecule, not others (even copies).” “We agree with the Board that this identifying-by-examining-one-alone meaning is the ordinary meaning of the phrase in context. The striking feature of the phrase is its inclusion of the word “single.” There is no apparent reason for the inclusion of the word “single” in the phrase except to indicate that the capability required is to identify a molecule

with just that one molecule in view.” Pacific Biosciences of California, Inc. v. Personal Genomics Taiwan, Inc., 2022-1410, 1/9/24.

**b. Defining/Positioning/Connecting Terms**

“We have several times held variants of “coupled to” in patent claims before us to mean simply “connected to.”” Promptu Sys. Corp. v. Comcast Corp., 2022-1939, 2/16/24.

**3. Functional v. Structural Language**

**a. Capable/Adaptable/Adjustable Elements**

**i. Design Intent**

“Specifically, the court’s construction erroneously required that the figurative handle be “designed especially to be grasped by the hand,” which improperly suggested a design intent requirement.” Sorrell Holdings, LLC v. Infinity Headwear & Apparel, LLC, 2022-1964, 2/5/24 (nonprecedential).

**4. Effect of Other Limitations in Claim**

**a. Surplusage OK**

“These cases do not create a *per se* rule that separately listed claim elements are distinct components, regardless of the intrinsic record.” “Rather, we have explained that there is a “presumption” that separately listed claim limitations may indicate separate and distinct physical structure, but that presumption may always be rebutted in the context of a particular patent.” Google LLC v. EcoFactor, Inc., 2022-1750, 2/7/24 (emphasis in original).

**b. Overlap in scope of different limitations**

Despite five inputs being separating identified, CAFC reversed construction barring coverage of one input only indirectly through another. “Here, the claim language supports a broader reading of the [1m] limitation, which must allow for any of the five claimed inputs to potentially be used to calculate another claimed input. The claim language broadly recites that “a first time” is determined “based at least in part on” each of the five inputs. This language places no constraint on the manner in which the inputs are used.” Google LLC v. EcoFactor, Inc., 2022-1750, 2/7/24 (citation omitted).

**c. Different terms have different meanings**

“It is clear that a “head-end unit” and a “centralized processing station” are different things: the two phrases are different claim elements used in separate claims throughout the ’538 patent.” Promptu Sys. Corp. v. Comcast Corp., 2022-1939, 2/16/24.

**d. Absent Modifiers Should Not Be Construed Into Existence**

“The “centralized” modifier (used in the composite term defined in the specification) must add some meaning to or limitation on the “wireline node” being modified. The absence of the “centralized” modifier in the claims, in turn, means that the claimed “wireline node” must be broader in some way than the “centralized wireline node” defined in the specification.” *Promptu Sys. Corp. v. Comcast Corp.*, 2022-1939, 2/16/24.

**5. Effect of Other Claims**

**a. Claim Differentiation**

**i. Differentiation Between Independent Claims**

Court disregarded differentiation with respect to different independent claims. “Claims 9 and 10 depend from unasserted independent claim 8, and claims 22 and 23 depend from unasserted independent claim 21.” *Chewy, Inc. v. Int’l Bus. Machs. Corp.*, 2022-1756, 3/5/24.

**6. Method Claims**

**a. Required Order of Steps**

**i. Order indicated in subset of steps**

“We start with the claim language. Our focus is on the inserting and advancing the ICD step (step 1.f), which recites, in part, “inserting the [ICD] into and through the continuous lumen of the standard guide catheter alongside of the substantially rigid portion.” ’413 patent claim 1. This language demonstrates that the flexible tip portion is advanced (step 1.e) before inserting the ICD. The claim language suggests this order by reciting inserting the ICD “alongside of *the* substantially rigid portion.”” “The fact that all other steps must be performed in order, while not dispositive, suggests that claim 1 requires performance of its steps in the recited order.” *Medtronic, Inc. v. Teleflex Life Sciences Ltd.*, 2022-1605, 3/21/24 (emphasis in original) (nonprecedential).

**B. Written Description**

“The written description of the ’849 patent supports the district court’s construction. The written description consistently describes the invention as including pre-fetching of advertising objects.” *Chewy, Inc. v. Int’l Bus. Machs. Corp.*, 2022-1756, 3/5/24.

**1. Figures**

“And the use of a single figure-element number when referring to the centralized processing station and the head-end unit likewise need not mean anything more than that, in the embodiment illustrated in figure 1, the two components are colocated. Neither of those specification sources implies that the two components *must* be colocated.” *Promptu Sys. Corp. v. Comcast Corp.*, 2022-1939, 2/16/24 (emphasis in original).

## **2. Summary of the Invention**

“In light of these repeated descriptions of the present invention, a skilled artisan would understand the claimed invention requires pre-fetching of advertising objects.” *Chewy, Inc. v. Int’l Bus. Machs. Corp.*, 2022-1756, 3/5/24.

### **C. Prosecution History**

#### **1. Issuing Application**

##### **a. Changes Meaning**

###### **i. Limits Particular Claim Term**

Supported limiting construction where “IBM explained that selectively storing advertising objects means advertising objects are pre-fetched.” *Chewy, Inc. v. Int’l Bus. Machs. Corp.*, 2022-1756, 3/5/24.

### **D. Extrinsic Evidence**

#### **1. Industry Practice**

“And the district court made no finding that no other such techniques were known to relevant artisans at the time relevant to construing this patent.” *Promptu Sys. Corp. v. Comcast Corp.*, 2022-1939, 2/16/24.

#### **2. Party Admissions/Marking/Expert Testimony/Marketing**

CAFC reversed narrow construction based on expert agreement. “The parties’ experts generally agreed that the plain claim language did not contain additional alignment requirements.” *Weber, Inc. v. Provisur Techs., Inc.*, 2022-1751, 2/8/24.

### **E. Timing of Construction and Parties’ Positions**

#### **1. Agreed and Proposed Constructions**

##### **a. Independent Construction**

“In view of the record before us, we conclude that the correct construction of “matingly engaged” should be “mechanically joined or fitted together.” Although that exact phrasing was not urged by either party or the Board, we find that it accurately captures the meaning of the term and various arguments of the parties.” *CoolIT Sys. Inc. v. Vidal*, 2022-1221, 3/7/24 (nonprecedential).

## **VI. Unenforceability**

### **A. Intent to Deceive**

#### **1. Declarations**

##### **a. To Revive Application**

“The evidence clearly shows that Ikan’s counsel knew that the application had been abandoned, as he testified. But whether he made his 2017 statement with deceptive intent depends on what he believed about the subject of his statement, namely, the intent behind the abandonment. And as to the latter, he testified that “[t]he intent does not go to my intent. It goes to intent of the applicant.” The district court could find that counsel genuinely so believed, whether or not the belief was legally correct, and that counsel did not think that Ikan had the intent to abandon during the 2012–17 non-response period.” *Freshub, Inc. v. Amazon.com, Inc.*, 2022-1391, 2/26/24 (citations omitted).

## **VII. Procedural Law**

### **A. Preclusion**

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

##### **a. Same Issue of Law or Fact Necessary to Judgment**

###### **i. Claim Construction Preclusion**

Challenging construction of identical claim language in related patent not precluded. “Because the claim language may provide an independent basis for the construction, there is doubt that the Google Order’s interpretation of the specification was necessary to the judgment, as is required for collateral estoppel to apply.” *MasterObjects, Inc. v. Meta Platforms, Inc.*, 2023-1097, 2/15/24 (nonprecedential).

### **B. Jury Issues**

#### **1. Jury Instructions**

##### **a. Prejudicial Effect of Erroneous Jury Instructions**

“[T]he jury instruction on the objective indicia of nonobviousness constituted prejudicial legal error, so the invalidity judgment must be set aside.” *Inline Plastics Corp. v. Lacerta Group, LLC*, 2022-1954, 3/27/24.

### **C. International Trade Commission/Customs**

#### **1. Domestic Industry**

“[A] complainant can satisfy the economic prong of the domestic industry requirement based on expenditures related to a subset of a product, if the patent(s) at issue only involve

that subset. Here, there is no dispute that the “intellectual property” at issue is practiced by QuickSet and the related QuickSet technologies, a subset of the entire television.” Roku, Inc. v. Int’l Trade Comm’n, 2022-1386, 1/19/24.

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

**1. Cost of Attendance of Willing Witnesses Factor**

“Apple also argues that it identified additional unnamed team members in the Northern District, which were not counted. But we are not prepared to say that the district court clearly erred in refusing to credit these unnamed team members when presented with little information as to what, if any, relevant and material information they may possess.” In re Apple Inc., n.4, 24-111, 3/18/24 (nonprecedential).

**E. Staying Case**

**1. Copending IPR/CBMR**

**a. Mandamus**

“We are troubled by the district court’s delay in resolving Micron’s stay motion. At the same time, we are confronting a situation in which Micron, the party seeking a stay, petitioned for this court’s intervention only less than three weeks before trial is set to begin. Under the circumstances presented by this case, we cannot say that Micron has shown entitlement to the extraordinary relief of mandamus.” In re: Micron Tech., Inc., 2024-107, 1/12/24 (nonprecedential).

**VIII. Federal Circuit Appeals**

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

**1. District Court/ITC Appeals**

**a. Failure to Object at Trial**

**i. After Denial of Motion in Limine**

“The pretrial ruling did not foreclose consideration at trial of whether uses actually being made of the information were running afoul of the evidentiary standards. But the just-cited Fifth Circuit authority indicates that it is broadly up to the litigant seeing prejudice to object in a timely fashion to identify such uses, so they may be evaluated in the context of the unfolding evidence and argument, and prevented or corrected.” Freshub, Inc. v. Amazon.com, Inc., 2022-1391, 2/26/24.



## **2. PTO Appeals**

### **a. Appeals from PTAB Decision**

“[Appellant] also offers a more focused argument . . . [Appellant] failed to raise this argument before the Board, so we decline to consider it.” *CyWee Grp. Ltd. v. ZTE (USA), Inc.*, 2021-1855, 1/18/24.

## **B. Appellate Jurisdiction**

### **1. Rulings on Issues Not Relied Upon for Appealed Judgment**

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

“Mantissa asks us to review the district court’s construction of “OFF.” We lack the jurisdiction to do so because the decision in the district court under review did not rest on any such determination. While the claim construction may have consequences for other cases, it has no significance for this case.” *Mantissa Corp. v. First Financial Corp.*, 2022-1963, 2/14/24 (nonprecedential).

## **C. Sanctions/Contempt**

“When it becomes apparent that a lawyer has violated a court rule, as an officer of the court, it would be best for that lawyer to bring it to the court’s attention and withdraw the improper argument. Here, Appellee was made aware of our case law, but chose to do nothing.” “While we will not award sanctions in this case, future litigants should appreciate that: (1) it is improper to incorporate material from one brief by reference into another unless in compliance with Fed. R. App. P. 28; (2) in no event is such incorporation permitted if it would result in exceeding the applicable word count; and (3) violating these provisions in the future will likely result in sanctions.” *Promptu Sys. Corp. v. Comcast Cable Commc’ns, LLC*, 2022-1939, 2/16/24.

## **D. Cross-Appeals v. Alternate Bases for Affirmance**

### **1. Alternative Bases for Expert Exclusion**

“The district court was reluctant to conclude, on its own, that *WesternGeco* displaces *Power Integrations* as the required framework of analysis for this case, involving 35 U.S.C. § 271(a) and a reasonable royalty. We now draw that conclusion, in agreement with TT. Nevertheless, we conclude that, even under the *WesternGeco* framework, the evidence offered by TT’s expert was properly excluded.” *Brumfield v. IBG LLC*, 2022-1630, 3/27/24.

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

### **1. Implicit Claim Construction Disputes**

“As an initial matter, the Board’s statement that it was not engaging in claim construction is not dispositive as to whether claim construction occurred.” “The cases relied on by the Board support our determination that the Board engaged in claim construction. Each of the cases the Board cited relates to interpreting claims in the claim construction context.” *Google LLC v. EcoFactor, Inc.*, 2022-1750, 2/7/24.

“Less clear, at times, is whether a court or other tribunal has construed a claim or whether it has simply compared the claim to prior art or an allegedly infringing technology. While the line between these two inquiries can be fine, the answer could be critical given the different standard of review applicable to each issue on appeal.” *Google LLC v. EcoFactor, Inc.*, 2022-1750, 2/7/24.

“Neither party explicitly argued for claim construction to resolve the issue.” “[T]he Board determined that claim construction was unnecessary, and then concluded, based on the claim language, that the inputs [i]–[v] of the [1m] limitation were separate and distinct components that required distinctly different input data.” “If the outcome of the analysis of the claim term establishes the scope (e.g., boundaries) and meaning of *the patented subject matter*, the court (or the Board) has mostly likely construed the claim.” “The point in the proceeding at which the analysis occurs is not dispositive.” *Google LLC v. EcoFactor, Inc.*, 2022-1750, 2/7/24.

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

“In view of the record before us, we conclude that the correct construction of “matingly engaged” should be “mechanically joined or fitted together.” Although that exact phrasing was not urged by either party or the Board, we find that it accurately captures the meaning of the term and various arguments of the parties.” *CoolIT Sys. Inc. v. Vidal*, 2022-1221, 3/7/24 (nonprecedential).

#### **a. Vacate and Remand in View of New Construction**

“As the trial substantially concerned whether Infinity’s accused device satisfied the “cinch” and “figurative handle” limitations as construed by the district court, we find both claim construction errors prejudicial and thus vacate the district court’s judgment of noninfringement and remand for further proceedings under the correct claim construction.” *Sorrell Holdings, LLC v. Infinity Headwear & Apparel, LLC*, 2022-1964, 2/5/24 (nonprecedential).

### **3. Construing claim terms not necessary to resolve appeal**

“We do not go further to find words for a proper construction to replace the one we reject. The parties have not adequately explored alternatives, and again we are not sure what aspects of the phrase need clarification for resolution of the liability issues.” *Promptu Sys. Corp. v. Comcast Corp.*, 2022-1939, 2/16/24.

**a. Rejecting Unwarranted Limitations Enough**

“That conclusion suffices to reject the construction of “back channel” adopted by the district court. The parties also dispute whether “channel” in that phrase refers to . . . . We leave this dispute to be addressed, if necessary, on remand.” *Promptu Sys. Corp. v. Comcast Corp.*, 2022-1939, 2/16/24.

**F. Standards of Review and Record/Appendix on Appeal**

**1. Substantial Evidence Threshold**

**a. Expert Testimony**

**i. Not substantial**

“In light of our case law and the other evidence of record, we do not view the expert’s testimony as evidence that a reasonable mind could accept as adequate to support the Board’s finding that a skilled artisan would not think that the inventor possessed a smoking article with a heating member with a length that is about 75% to about 85% the length of the inhalable substance medium.” *RAI Strategic Holdings, Inc. v. Philip Morris Prods., S.A.*, 2022-1862, 2/9/24.

**2. Clear/Plain Error Review**

**a. Based on Analysis as a Whole**

“We also do not view the district court’s mistaken reference to production of the assignment just three days prior to trial as clear error. Rather, we view this as a stray (albeit incorrect) comment in light of the fact that elsewhere, both the court and the parties correctly recognized that the assignment was produced a month prior to trial.” *Sorrell Holdings, LLC v. Infinity Headwear & Apparel, LLC*, 2022-1964, 2/5/24 (nonprecedential).

**G. Harmless Error**

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

“The Board erroneously referred to “advancing the substantially rigid portion of the coaxial guide catheter” instead of the flexible tip portion when discussing claim 1 and its proper order. Medtronic argues that the Board’s erroneous statement reflects a misunderstanding of claim 1’s scope. We disagree. The Board’s seemingly clerical error does not change the crux of its conclusion: that Medtronic cited no evidence establishing that Kontos discloses inserting the ICD after advancing the flexible tip portion. The Board’s error is therefore harmless.” *Medtronic, Inc. v. Teleflex Life Sciences Ltd.*, 2022-1605, 3/21/24 (emphasis in original) (nonprecedential).

## **H. Remand Determination**

### **1. Vacating General Jury Verdict**

Invalidity judgment vacated and remanded where multiple invalidity bases were assessed by jury in one question. “For one thing, although the jury was presented with invalidity grounds in addition to obviousness, the jury, acting reasonably, could well have determined that at least some claims were invalid for obviousness only.” *Inline Plastics Corp. v. Lacerta Group, LLC*, 2022-1954, 3/27/24.

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

“The district court was reluctant to conclude, on its own, that *WesternGeco* displaces *Power Integrations* as the required framework of analysis for this case, involving 35 U.S.C. § 271(a) and a reasonable royalty. We now draw that conclusion, in agreement with TT. Nevertheless, we conclude that, even under the *WesternGeco* framework, the evidence offered by TT’s expert was properly excluded.” *Brumfield v. IBG LLC*, 2022-1630, 3/27/24.

### **3. Judicial Notice on Appeal**

#### **a. Denied**

“We deny SmartSky’s motions to supplement. We “will not consider new evidence on appeal absent extraordinary circumstances, such as those that render the case moot or alter the appropriateness of injunctive relief, a change in pertinent law, or facts of which a court may take judicial notice.” *SmartSky Networks, LLC v. Gogo Business Aviation, LLC*, 2023-1058, 1/31/24 (nonprecedential) (quoting *In re Application of Adan*, 437 F.3d 381, 388 n.3 (3d Cir. 2006), *abrogated on other grounds by Golan v. Saada*, 142 S. Ct. 1880 (2022)).

## **I. Briefing Related and Multi-Defendant Cases**

“We have repeatedly held that incorporating argument by reference “cannot be used to exceed word count.” *Microsoft Corp. v. DataTern, Inc.*, 755 F.3d 899, 910 (Fed. Cir. 2014).” *Promptu Sys. Corp. v. Comcast Cable Commc’ns, LLC*, 2022-1939, 2/16/24.

## **IX. Patent Office Proceedings**

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

#### **1. Joinder**

##### **a. Limitations on Participation**

Board affirmed in allowing joining party to argue against particular substitute claims in a motion to amend where original petitioner no longer appeared to be meaningfully

adversarial with respect to those claims. *CyWee Grp. Ltd. v. ZTE (USA), Inc.*, 2021-1855, 1/18/24.

“[G]iven the substantive importance of a motion to amend in the context of an IPR (in that it can lead to the issuance of new, otherwise unexamined claims), and that the terms of LG’s joinder relegated it to understudy status only insofar as ZTE “remain[ed] active in the [IPR],” we see no error in the Board’s allowing LG to oppose the revised motion to amend.” *CyWee Grp. Ltd. v. ZTE (USA), Inc.*, 2021-1855, 1/18/24 (citation omitted).

## **2. Amendments**

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

“We do not address the extent to which the Board may permit evidence or arguments not raised in an opposition to an initial motion to amend to be raised in opposition to a revised motion to amend that does not modify the proposed claims.” *CyWee Grp. Ltd. v. ZTE (USA), Inc.*, 2021-1855, 1/18/24.

## **3. Appeal**

### **a. Reversal of PTAB**

#### **i. Teachings of Reference**

“[T]he Board erred in determining that the “product bed conveyer” disclosed in Weber’s operating manuals, including as shown in Figures 10 and 227, does not disclose the “stop gate” limitation. We conclude that the Board’s determinations are not supported by substantial evidence.” “In reaching a contrary conclusion, the Board failed to meaningfully consider Weber’s cited Figures 10 and 227 and accompanying expert testimony.” *Weber, Inc. v. Provisur Techs., Inc.*, 2022-1751, 2/8/24.

## **4. Supplemental Information/Arguments (e.g., in reply)**

### **a. Information/Arguments Required in Petition**

“Even assuming Dr. Mohazzab articulated a sufficient motivation to combine at his deposition, a petitioner may not, in its reply and accompanying expert declaration, rely “on an entirely new rationale to explain why one of skill in the art would have been motivated to combine.”” *Virtek Vision Int’l ULC v. Assembly Guidance Sys., Inc.*, n.3, 2022-1998, 3/27/24 (quoting *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369–70 (Fed. Cir. 2016)).

## **5. Obviousness Rulings**

### **a. Reversal**

“We conclude that the Board erred as a matter of law with regard to the motivation to combine. It does not suffice to meet the motivation to combine requirement to recognize

that two alternative arrangements such as an angular direction system using a single camera and a 3D coordinate system using two cameras were both known in the art.” “There was no argument in the petition regarding why a skilled artisan would make this substitution—other than that the two different coordinate systems were “known to be used.”” “The petition does not argue Briggs articulates any reason to substitute one for another or any advantages that would flow from doing so. Nor does Dr. Mohazzab, Aligned Vision’s expert, articulate any reason why a skilled artisan would combine these references. In his declaration, he testified “it would have been obvious” to use the 3D coordinates instead of angular measurements because “both such measurement systems were known.”” *Virtek Vision Int’l ULC v. Assembly Guidance Sys., Inc.*, 2022-1998, 3/27/24.

## **6. Director Rehearing Decisions**

“Pfizer further argues that the PTO has never provided any reason or evidence as to why its practices with respect to Director Review qualify for any of the exceptions to notice-and-comment rulemaking in 5 U.S.C. § 553(b)(B).” “Pfizer timely and properly filed each of its requests, none of which was denied for a failure to abide by the PTO’s procedural requirements. Because we can find no prejudice to Pfizer, any APA violation by the PTO was harmless and cannot serve as a basis to reverse or vacate the Board’s decisions.” *Pfizer Inc. v. Sanofi Pasteur Inc.*, 2019-1871, 3/5/24.

## **7. Due Process and APA Violations**

“While an explicit claim construction was not proposed by either party, both parties recognized that the core issue related to the scope and boundaries of the five inputs enumerated in [1m] and, thus, were afforded both notice and opportunity to address this issue.” *Google LLC v. EcoFactor, Inc.*, 2022-1750, 2/7/24.