

RECENT DEVELOPMENTS IN PATENT LAW (Fall 2024-Winter 2025)

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PATENTABLE SUBJECT MATTER

Software and Business Method Cases

Unpatentable

AI Visualize, Inc. v. Nuance Communications, Inc., 97 F.4th 1371 (Fed. Cir. Apr. 4, 2024)

In this appeal from the District of Delaware, the Federal Circuit affirmed a finding that four patents owned by plaintiff AI Visualize and directed to the advanced visualization of medical scans via a web application were subject matter ineligible.⁴ The court explained that, for computer-based technologies, the “claimed advances over the prior art” must be focused on “an improvement in computer technologies, rather than the mere use of computers” to avoid being categorized as directed to an abstract idea under *Alice* step one.⁵ It concluded that the claims at issue did not meet this test and were merely directed to the “abstract idea of data manipulation,” as they recited the idea of “creating” visualizations based on an existing dataset, rather than explaining how to create those views from a technological perspective.⁶

Having found the claims directed to an abstract idea under *Alice* step one, the court proceeded to analyze whether the claims recited something “significantly more” than that abstract idea to make them patent-eligible under *Alice* step two.⁷ In order for a claim to recite “significantly more” than an abstract idea, the nature of the claim must be “transformed” by elements or combinations thereof that go beyond “elements that are routine, conventional, or well-known” in the art.⁸ Here, however, the Federal Circuit found that AI Visualize made no arguments for inventive concepts in its claims that reached beyond the creation of “a virtual view,” which itself was the abstract idea addressed under step one and was a well-known concept in the art.⁹ Thus, the claims failed at both steps of the *Alice* test and were ultimately deemed patent ineligible.¹⁰

⁴ *AI Visualize, Inc. v. Nuance Communications, Inc.*, 97 F.4th 1371 (Fed. Cir. 2024).

⁵ *Id.* at 1378.

⁶ *Id.* at 1379.

⁷ *Id.*

⁸ *Id.*

⁹ *Id.* at 1380.

¹⁰ *Id.* at 1381.

Beteiro, LLC v. Draftkings Inc., 104 F.4th 1350 (Fed. Cir. June 21, 2024)

In this appeal from the District of New Jersey, the Federal Circuit affirmed a finding that four patents owned by Beteiro were subject matter ineligible.¹¹ The patents were all directed at facilitating live, remote gambling activity via communication devices based on a user’s GPS-determined location.¹² At *Alice* step one, the Federal Circuit held that the claims were directed to an abstract idea because they recited generic steps for retrieving information based on location,¹³ used “result-focused functional language” without specificity on how the invention achieved those results,¹⁴ and were rooted in a “fundamental and longstanding economic activity.”¹⁵ In so holding, the Federal Circuit rejected Beteiro’s contention that the claims improved computer technologies; instead, the claims merely involved the use of computers as a tool, without any improvement in the computer-related technology itself.¹⁶

At *Alice* step two, the Federal Circuit affirmed the district court’s finding that the claims failed to provide an inventive concept.¹⁷ Though the claims involved the use of GPS on a mobile phone, the court found that this was not sufficiently inventive since GPS was, as of the priority date, conventionally used in various computers, and the specification of the patent did not describe any difference between the use of GPS on phones and computers.¹⁸ Accordingly, since the patent did not purport to advance GPS technology or the use of GPS on phones in the specification, the Federal Circuit affirmed that the abstract ideas embodied in the patent lacked an inventive concept.¹⁹

Patentable

Contour IP Holding LLC v. GoPro, Inc., 113 F.4th 1373 (Fed. Cir. Sept. 9, 2024)

In this appeal from the Northern District of California, the Federal Circuit reversed the district court’s finding that, at *Alice* step one, the asserted claims were

¹¹ *Beteiro, LLC v. Draftkings Inc., 104 F.4th 1350 (Fed. Cir. 2024)*.

¹² *Id.* at 1353-54.

¹³ *Id.* at 1355-56.

¹⁴ *Id.* at 1356.

¹⁵ *Id.* at 1356-57.

¹⁶ *Id.* at 1357.

¹⁷ *Id.* at 1357.

¹⁸ *Id.* at 1357-58.

¹⁹ *Id.* at 1358-59.

directed at an abstract idea, and were thus, patent ineligible under § 101.²⁰ The Federal Circuit criticized the district court for characterizing the claims “at an impermissibly high level of generality.”²¹ Read properly, the claim was directed to “specific, technological means”—the recording of two video streams in parallel, and wirelessly transferring the lower quality video for real-time viewing—that in turn provided a “technological improvement” to the class of products at issue, which would otherwise suffer from “bandwidth limitations on wireless data transfer.”²² Distinguishing GoPro’s cases, the Federal Circuit noted that this invention was not a “long-known or fundamental practice” and it was sufficiently specific to avoid reciting a mere abstract idea.²³

IOENGINE, LLC v. Ingenico Inc., 100 F.4th 1395 (Fed. Cir. May 3, 2024)

In this appeal from the PTAB, the Federal Circuit reversed the PTAB’s finding that several claims in two patents were ineligible under the printed matter doctrine.²⁴ The claims were directed at a portable device that “tunneled” encrypted data through an access terminal by allowing data to be provided through the terminal and used by a user, without the data actually residing on the terminal.²⁵ The PTAB determined that the claim was ineligible under the printed matter doctrine, since there was “nothing in the claim that requires anything beyond sending and receiving data, even if the data is in an encrypted form.”²⁶ The Federal Circuit disagreed, explaining that printed matter is only “matter claimed for what it communicates.”²⁷ The mere fact that the claim involves a communication does not invoke the printed matter doctrine, as the doctrine only covers *what* is communicated—“the content or information being communicated”—not the communication itself.²⁸ And since the claim did not invoke the *content* of the encrypted communications, the doctrine did not apply.²⁹ For similar reasons, the Federal Circuit reversed the PTAB’s decision not to afford patentability to a “program code” limitation

²⁰ *Contour IP Holding LLC v. GoPro, Inc.*, 113 F.4th 1373 (Fed. Cir. 2024).

²¹ *Id.* at 1379-80.

²² *Id.* at 1378.

²³ *Id.* at 1380-81.

²⁴ *IOENGINE, LLC v. Ingenico Inc.*, 100 F.4th 1395, 1404 (Fed. Cir. 2024).

²⁵ *Id.* at 1400.

²⁶ *Id.* at 1404 (quoting PTAB decision).

²⁷ *Id.* (quoting *In re Distefano*, 808 F.3d 845, 850 (Fed. Cir. 2015)).

²⁸ *Id.*

²⁹ *Id.*

asserted in one of the claims, since the claim was “altogether silent” as to the contents of the code, and therefore, no content was claimed.³⁰

Astellas Pharma, Inc. v. Sandoz Inc., 2024 WL 4219374 (Fed. Cir. Sept. 18, 2024)

In this appeal from the District of Delaware, the Federal Circuit vacated the judgment entered by the district court in Sandoz’s favor after a bench trial.³¹ By stipulation prior to trial, Sandoz agreed to limit its invalidity defenses to those arising under § 112 and waived all other invalidity challenges.³² Though the parties never litigated § 101 issues at trial, the district court found that the claims were patent ineligible and entered judgment in Sandoz’s favor.³³

Citing the longstanding principle of party presentation—that courts may only assume the “role of neutral arbiter of matters” framed and litigated by the parties³⁴—the Federal Circuit held that the district court abused its discretion by rendering a decision on a ground not raised by the parties.³⁵ In so doing, the district court had “misapprehended its rule” because it viewed § 101 as a threshold inquiry that it was obligated to address even in the absence of party presentation.³⁶ Instead, the Federal Circuit explained, because 35 U.S.C. § 282 entitles granted patents to a presumption of validity, the district court’s role is only to determine whether the challenge has presented clear and convincing evidence to overcome that presumption—not to engage in a free-ranging inquiry on whether the invention is sufficiently worthy of protection.³⁷ Finally, the Federal Circuit both rejected Sandoz’s reliance on contrary caselaw that failed to consider the presumption created by § 282, as well as Sandoz’s appeal to public policy.³⁸

³⁰ *Id.* at 1405.

³¹ *Astellas Pharma, Inc. v. Sandoz Inc.*, 2024 WL 4219374 (Fed. Cir. Sept. 18, 2024).

³² *Id.* at *3.

³³ *Id.*

³⁴ *Id.* at *4 (quoting *Greenlaw v. United States*, 554 U.S. 237, 243 (2008)).

³⁵ *Id.*

³⁶ *Id.* at *5.

³⁷ *Id.* at *4-6.

³⁸ *Id.* at *5-6.

DISCLOSURE

Definiteness

Maxell, Ltd. v. Amperex Technology Limited, 94 F.4th 1369 (Fed. Cir. Mar. 6, 2024)

In this appeal from the Western District of Texas, the Federal Circuit reversed a finding that a claim directed to a lithium-ion battery was indefinite for containing necessarily contradictory elements.³⁹ The District Court found that one claim limitation requiring a transition metal element to “contain cobalt, nickel, or manganese” contradicted a second limitation that the same claim element “contain cobalt at a content of 30% to 100% by mole,” as the second limitation “takes back” options that the first limitation granted.⁴⁰ The Federal Circuit, however, explained that this interpretation was incorrect; claim limitations recite “conditions that must be met” rather than providing options, and as long as two requirements can both be met, “there is no contradiction.”⁴¹

Defendant Amperex had conceded that, in fact, “there would be no contradiction, and therefore no indefiniteness problem, if [the second limitation] were recited in a dependent claim,” but argued it was not appropriate for both limitations to be in the same claim.⁴² The court disagreed, explaining that “there is no difference material to the indefiniteness inquiry” between limitations within the same independent claim and those separated into an independent and dependent claim.⁴³ It therefore concluded that no indefiniteness due to contradictory claim elements existed and reversed the District Court’s decision.⁴⁴

Janssen Pharmaceuticals, Inc. v. Teva Pharmaceuticals USA, Inc., 97 F.4th 915 (Fed. Cir. Apr. 1, 2024)

In this appeal from the District of New Jersey, the Federal Circuit affirmed the district court’s finding that a claim limitation requiring “an average particle size . . . from

³⁹ *Maxell, Ltd. v. Amperex Technology Limited*, 94 F.4th 1369 (Fed. Cir. 2024).

⁴⁰ *Id.* at 1373.

⁴¹ *Id.*

⁴² *Id.* at 1374.

⁴³ *Id.*

⁴⁴ *Id.*

about 1600 nm to about 900 nm” was definite.⁴⁵ Neither the claim or specification specified which of the several conventional techniques for measuring particle size should be used, and defendant Teva argued that each of these techniques “would yield meaningfully different results,” making it indefinite whether any particular particle sample satisfied the claim limitation.⁴⁶ However, Teva’s only evidence that different measurement techniques would lead to different results was based on “an outlier measurement taken with a defective device.”⁴⁷ The court therefore concluded Teva had failed to prove that different measurement techniques would cause discrepancies in general, meaning that the district court’s finding of definiteness was not clearly erroneous.⁴⁸

Vascular Solutions LLC v. Medtronic, Inc., 2024 WL 4195130 (Fed. Cir. Sept. 16, 2024)

In this appeal from the District of Minnesota, the Federal Circuit reversed the district court’s finding that the claim limitation “substantially rigid portion/segment” was indefinite and vacated the entry of judgment in Medtronic’s favor.⁴⁹ The seven asserted patents were directed to a “coaxial guide catheter that is deliverable through standard guide catheters by utilizing a guidewire rail segment to permit delivery without blocking use of the guide catheter.”⁵⁰ After a lengthy claim construction dispute over the physical boundaries of the “substantially rigid portion/segment” limitation, the district court found that Vascular Solution’s construction would result in the same device infringing two mutually exclusive claims, and thus, the limitation was indefinite.⁵¹

On appeal, the Federal Circuit held that the district court had erred in finding the two claims “mutually exclusive” because the boundaries for the “substantially rigid portion/segment” limitation were different in each claim.⁵² The district court’s conclusion, in effect, meant that “(1) claims in a patent cannot vary in the way they claim the disclosed subject matter, and (2) independent claims must be totally consistent with other independent claims.”⁵³ But claiming “is not restricted in this way” so long as the

⁴⁵ *Janssen Pharmaceuticals, Inc. v. Teva Pharmaceuticals USA, Inc.*, 97 F.4th 915 (Fed. Cir. 2024).

⁴⁶ *Id.* at 937.

⁴⁷ *Id.*

⁴⁸ *Id.*

⁴⁹ *Vascular Solutions LLC v. Medtronic, Inc.*, 2024 WL 4195130 (Fed. Cir. Sept. 16, 2024).

⁵⁰ *Id.* at *1.

⁵¹ *Id.* at *5.

⁵² *Id.* at *7.

⁵³ *Id.*

claims are themselves sufficiently informing.⁵⁴ Instead, the Federal Circuit directed the district court to conduct a “claim-by-claim” construction of the limitation, with the understanding that, at claim construction, the claims are not necessarily mutually exclusive since each independent claim is a different combination of limitations.⁵⁵ The Federal Circuit also held that the claim limitation was functional in nature, and thus, the physical boundaries of the “substantially rigid portion/segment” did not have to be consistent across claims.⁵⁶ Though the *construction* of the limitation must be the same across claims, “that construction can be a functional construction that does not specify the [physical] boundary of the ‘substantially rigid portion.’”⁵⁷ The court reserved judgment on Medtronic’s argument—that a functional construction of the limitation would allow a single device to infringe claims that define the physical boundary differently—since that infringement argument was premature at claim construction.⁵⁸

Written Description

In re Entresto, ___ F.4th ___, 2025 WL 63577 (Fed. Cir. Jan. 10, 2025)

In this appeal from the District of Delaware, the Federal Circuit reversed the district court’s finding that the claimed combination of two drug therapies lacked written description.⁵⁹

At claim construction before the district court, the parties disputed a single limitation: “wherein [the two drugs] are administered *in combination*.”⁶⁰ The district court, considering the “plain and ordinary meaning” of the terms, construed the limitation to include *any* combination of the drugs—including a physical mixture, or a “complexed” chemical mixture of the drugs.⁶¹ Based on that construction, the district court found the claims invalid for lack of written description, since it was undisputed that complexed mixtures were unknown to persons of ordinary skill in the art at the time of the patent application.⁶²

⁵⁴ *Id.*

⁵⁵ *Id.*

⁵⁶ *Id.*

⁵⁷ *Id.* at *7.

⁵⁸ *Id.*

⁵⁹ *In re Entresto*, 2025 WL 63577, at *1 (Fed. Cir. Jan. 10, 2025).

⁶⁰ *Id.* at *2.

⁶¹ *Id.* at *2-3.

⁶² *Id.* at *4.

On appeal, the Federal Circuit first clarified that the issue was whether the patent described what was claimed—a composition of the two drugs *in combination*.⁶³ The court emphasized that the patent *did not* claim a complexed mixture, and thus, “those complexes need not have been described.”⁶⁴ In holding otherwise, “the district court erroneously conflated the distinct issues of patentability and infringement, which led it astray in evaluating written description.”⁶⁵ On the proper analysis, the Federal Circuit found that the invention—any combination of the two drugs—was “plainly described” throughout the specification, which was also conceded by MSN’s expert.⁶⁶ Though not addressed by the court, the Federal Circuit’s holding is in tension with *Chiron Corp. v. Genentech, Inc.*, which held that a patentee cannot satisfy the written description requirement for subject matter “that did not exist” at the time of the publication.⁶⁷

⁶³ *Id.* at *5.

⁶⁴ *Id.*

⁶⁵ *Id.* at *6.

⁶⁶ *Id.* at *5.

⁶⁷ *Chiron Corp. v. Genentech, Inc.*, 363 F.3d 1247, 1255 (Fed. Cir. 2004).

NOVELTY

Celanese International Corp. v. International Trade Commission, 111 F.4th 1338 (Fed. Cir. Aug. 12, 2024)

In this appeal from the International Trade Commission (“ITC”), the Federal Circuit affirmed the ITC’s finding that the appellants’ post-AIA patents were invalid due to secret commercial use under § 102(a)’s on-sale bar.⁶⁸ It was undisputed that Celanese’s patented process was in secret use in Europe prior to the critical date (i.e., one year before the effective filing date) and that Celanese had made pre-critical-date sales of products, made using the patented process, in the United States.⁶⁹ The Federal Circuit first examined “long-settled pre-AIA precedent” establishing that the sale of products made using secret processes, as here, triggered the pre-AIA on-sale bar.⁷⁰ The court then rejected Celanese’s argument that Congress intended to abrogate the “settled construction” of “on sale.”⁷¹ Consistent with the Supreme Court’s decision in *Helsinn*,⁷² the Federal Circuit held that textual modifications to AIA § 102(a) did not show Congress’ intent to alter the settled meaning of the on-sale bar.⁷³ Similarly, the Federal Circuit rejected Celanese’s argument that various new provisions added to the AIA, including Sections 102(b), 271(g), and 273(a), and the legislative history of the AIA evinced Congress’ intent to change the well-settled meaning of “on sale” in § 102(a).⁷⁴

Sanho Corp. v. Kaijet Technology International Ltd., Inc., 108 F.4th 1376 (Fed. Cir. July 31, 2024)

In this appeal from the PTAB, the Federal Circuit affirmed the PTAB’s finding that the patentee’s private sale of a product embodying the claimed invention did not qualify for the AIA’s “public disclosure” exception that would create a one-year grace period.⁷⁵ The Board first found that, based on a prior art reference (Kuo), the claims were

⁶⁸ *Celanese International Corp. v. International Trade Commission*, 111 F.4th 1338 (Fed. Cir. 2024).

⁶⁹ *Id.* at 1341.

⁷⁰ *Id.* at 1343-44

⁷¹ *Id.* at 1345.

⁷² *Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc.*, 139 S. Ct. 628 (2019).

⁷³ *Celanese International Corp.*, 111 F.4th at 1345-46.

⁷⁴ *Id.* at 1347-49.

⁷⁵ *Sanho Corp. v. Kaijet Technology International Ltd., Inc.*, 108 F.4th 1376 (Fed. Cir. 2024).

obvious.⁷⁶ But, prior to the Kuo filing date, the inventor had sold products practicing the patent to Sanho through a series of private messages that did not disclose the features of the invention to others beyond Sanho.⁷⁷ Sanho contended that this private sale amounted to a “public disclosure” under § 102(b)(2)(B), which would give Sanho a one-year grace period good not just against its own disclosures but also third party disclosures, and thus render Kuo not prior art.⁷⁸

The Federal Circuit disagreed, holding that § 102(b)(2)(B)’s “public disclosure” provision does not cover *all* disclosures contemplated in § 102, but rather, only those disclosures that “result in the subject matter of the invention being ‘publicly disclosed.’”⁷⁹ Sanho’s reading, in the court’s view, was contrary to the purpose of § 102(b)(2)(B), which is designed to protect inventors who share their works with the public from later disclosures by others.⁸⁰ The Federal Circuit also rejected Sanho’s appeal to cases like *Egbert v. Lippmann*⁸¹—which dealt with secret “public uses” under § 102(a)—because § 102(b)(2)(B)’s provision involves a different term (public disclosure, not public use) and serves different purposes than § 102(a). Accordingly, since the sale at issue was purely private, the Court affirmed the Board’s finding that Kuo was prior art not affected by § 102(b)(2)(B).⁸²

Crown Packaging Tech., Inc. v. Belvac Prod. Mach., Inc., 122 F.4th 919 (Fed. Cir. December 1, 2024)

On appeal from the Western District of Virginia, the Federal Circuit reversed the district court’s finding that the on-sale bar did not invalidate Crown’s patents and remanded for an entry of judgment in Belvac’s favor.⁸³ At issue was a price quotation signed by Crown’s representative and directed to a specific company, Complete.⁸⁴ While the language of the offer—“quotation”—suggested that the offer wasn’t sufficiently definite to trigger the on-sale bar, the court found that the quotation was an offer based on other circumstantial factors, including that the offer was sent to a single potential purchaser, signed by Crown’s representative, and sufficiently definite in terms of price,

⁷⁶ *Id.* at 1379.

⁷⁷ *Id.* at 1384-85.

⁷⁸ *Id.* at 1379.

⁷⁹ *Id.* at 1382.

⁸⁰ *Id.*

⁸¹ 104 U.S. 333 (1881).

⁸² *Sanho Corp.*, 108 F.4th at 1385.

⁸³ *Crown Packaging Tech., Inc. v. Belvac Prod. Mach., Inc.*, 122 F.4th 919, 922 (Fed. Cir. 2024).

⁸⁴ *Id.* at 926.

delivery date and conditions, and other terms.⁸⁵ Though the offer included a condition requiring Crown to accept Complete’s response in writing, the Federal Circuit noted this was not “determinative,” especially since Crown had previously deemed orders complete without sending back a written acceptance.⁸⁶ Finally, the court rejected Crown’s argument that the offer did not trigger the on-sale bar because it was not made “in this country” under pre-AIA § 102(b).⁸⁷ Though Crown had submitted the offer from outside the United States, the on-sale bar still applied because Crown’s offer was addressed to a U.S. entity, Complete, at its U.S. place of business.⁸⁸

Lynk Labs, Inc. v. Samsung Electronics Co., Ltd., ___ F.4th ___ (Fed. Cir. Jan. 14, 2025)

In this appeal from the PTAB, the Federal Circuit affirmed the PTAB’s holding that a patent application is deemed prior art in inter partes review as of the date of its filing, not its publication.⁸⁹ The prior art patent application (“Martin”) was *filed* before the priority date of the patent in suit, but had been published after that date and subsequently abandoned.⁹⁰ On appeal, the Federal Circuit rejected Lynk Labs’ argument that Martin could not serve as prior art since it was only publicly accessible after the patent in suit’s priority date.⁹¹

The Federal Circuit first emphasized that, under § 102(e)(1), “even if a patent application was *published* after a claimed invention, it may serve as prior art to the invention if the application was *filed* before the invention.”⁹² Thus, the court held, a published patent application is prior art “as of its filing date,” rather than the date of public accessibility.⁹³ And because a published patent application is a “printed publication,” the Federal Circuit held that it may serve as prior art in IPR as of the filing date pursuant to § 311(b).⁹⁴ In so holding, the court canvassed that the legislative history

⁸⁵ *Id.* at 926-27.

⁸⁶ *Id.* at 927.

⁸⁷ *Id.* at 928.

⁸⁸ *Id.*

⁸⁹ *Lynk Labs, Inc. v. Samsung Electronics Co., Ltd.*, 2025 WL 85559 (Fed. Cir. Jan. 14, 2025).

⁹⁰ *Id.* at *2.

⁹¹ *Id.*

⁹² *Id.* at *3.

⁹³ *Id.*

⁹⁴ *Id.* at *4.

of § 102 and § 311(b), which demonstrated that “printed publications” under § 311(b) encompassed patent applications as of the filing, not publication, date.⁹⁵

⁹⁵ *Id.* at *4-8.

OBVIOUSNESS

Virtek Vision International ULC v. Assembly Guidance Systems, Inc., 97 F.4th 882 (Fed. Cir. Mar. 27, 2024)

In this appeal from the PTAB, the Federal Circuit affirmed in part and reversed in part a finding of obviousness for various claims in appellant Virtek’s patent directed to “an improved method for aligning a laser projector.”⁹⁶ The Board had found one set of claims reciting “identifying a pattern of the reflective targets on the work surface in a three dimensional coordinate system” obvious over two prior art references which “disclose[d] determining an angular direction of each target” and a third reference (Briggs), which disclosed the missing element “of determining the 3D coordinates of targets.”⁹⁷ However, the Federal Circuit concluded that a skilled artisan would not have been motivated to combine these references, because neither Briggs nor Virtek’s petition “provide[d] any reason why a skilled artisan would use 3D coordinates instead of angular directions in a system.”⁹⁸ The mere fact that both coordinate systems were known in the prior art was insufficient for the court to find that making the substitution was obvious, and it reversed this part of the PTAB’s decision.⁹⁹

With respect to another group of claims, the Federal Circuit found that cross-appellee Aligned Vision had failed to prove obviousness for similar reasons.¹⁰⁰ Aligned Vision argued for the combination of elements from several prior art references, but only on the basis that “a skilled artisan would have been motivated to combine the references as a matter of ‘common sense.’”¹⁰¹ Its only evidence for this proposition was “conclusory” testimony that the various elements were well-known in the art, which the court found insufficient.¹⁰² Therefore, it affirmed the Board’s finding that Aligned Vision failed to prove this group of claims was obvious.¹⁰³

⁹⁶ *Virtek Vision International ULC v. Assembly Guidance Systems, Inc.*, 97 F.4th 882 (Fed. Cir. 2024).

⁹⁷ *Id.* at 886.

⁹⁸ *Id.* at 887.

⁹⁹ *Id.* at 887-88.

¹⁰⁰ *Id.* at 889.

¹⁰¹ *Id.* at 888.

¹⁰² *Id.* at 889.

¹⁰³ *Id.*

Inline Plastics Corp. v. Lacerta Group, LLC, 97 F.4th 889 (Fed. Cir. Mar 27, 2024)

In this appeal from the District of Massachusetts, the Federal Circuit concluded that “the district court gave an incorrect jury instruction regarding the objective indicia of nonobviousness.”¹⁰⁴ At trial, plaintiff Inline had presented evidence of industry praise for its product, copying, and licensing activity.¹⁰⁵ Inline “specifically requested objective-indicia instructions that included mention” of these factors, but the district court only instructed the jury as to the “commercial success and long-felt need” objective indicia.¹⁰⁶ The Federal Circuit found that this error was not harmless, concluding that a reasonable jury might not have found all the asserted claims obvious if it was properly instructed to consider the evidence on industry praise, copying, and licensing, which arguably cut against the objective indicia the jury did consider.¹⁰⁷ The court therefore vacated the district court's judgment and remanded for a new trial on invalidity.¹⁰⁸

Janssen Pharmaceuticals, Inc. v. Teva Pharmaceuticals USA, Inc., 97 F.4th 915 (Fed. Cir. Apr. 1, 2024)

In this appeal from the District of New Jersey, the Federal Circuit remanded on grounds that the district court’s obviousness analysis was “impermissibly rigid.”¹⁰⁹ Having already instructed the district court to correct several claim construction errors, the Federal Circuit explained that the district court additionally erred by considering prior art “without giving the needed weight to the perspective of a POSA capable of deducing what references fairly suggest or employing ordinary creativity.”¹¹⁰

First, the court explained that the district court improperly assumed that a POSA would not think to combine a prior art reference with other references if it did not “contain safety and efficacy data” or lacked specific results.¹¹¹ Second, the district court incorrectly assumed that, because a prior art reference did not “hold itself out as flawed,” a POSA would not find it obvious to modify its protocols.¹¹² Third, the district court identified several differences between the claims at issue and the prior art references, but

¹⁰⁴ *Inline Plastics Corp. v. Lacerta Group, LLC, 97 F.4th 889, 897 (Fed. Cir. 2024).*

¹⁰⁵ *Id.* at 898.

¹⁰⁶ *Id.* at 897-98.

¹⁰⁷ *Id.* at 899.

¹⁰⁸ *Id.*

¹⁰⁹ *Janssen Pharmaceuticals, Inc. v. Teva Pharmaceuticals USA, Inc., 97 F.4th 915 (Fed. Cir. 2024).*

¹¹⁰ *Id.* at 928.

¹¹¹ *Id.* at 928-29.

¹¹² *Id.* at 929.

“cut short” its analysis by not considering whether an “ordinarily creative POSA” would have found the claims obvious in light of the reference regardless of the lack of explicit overlap.¹¹³ Overall, these oversights meant that *KSR*’s mandate to consider the “interrelated teachings” of prior art references, along with the background knowledge and creativity of a POSA, was ignored by the district court.¹¹⁴

Furthermore, the Federal Circuit found that the district court had applied the wrong standard for “teaching away.” It had concluded that a teaching of an optimal value for particle size was a “criticism of all other particle sizes,” but the Federal Circuit explained that teaching away only occurs when certain values are explicitly discouraged, rather than when a preferred value is merely recommended.¹¹⁵ The court therefore deemed it necessary to remand on the issue of obviousness, with additional instructions for the district court to revise its analysis of the relevant secondary considerations.¹¹⁶

Salix Pharmaceuticals, Ltd. v. Norwich Pharmaceuticals Inc., 98 F.4th 1056 (Fed. Cir. Apr. 11, 2024)

In this appeal from the District of Delaware, the Federal Circuit affirmed the district court’s findings that two categories of claims—the IBS-D claims and the polymorph claims—were obvious.¹¹⁷

The IBS-D claims were directed to treating IBS-D with 550 mg of rifaximin, three times daily, for 14 days.¹¹⁸ Norwich challenged this claim as obvious based on a clinical trial protocol (Protocol) and journal article (Pimentel) in the prior art, which, respectively, evaluated a twice-daily dose of 550 mg and endorsed administering 400 mg, three times daily (while opining that the “optimal dosage . . . may, in fact, be higher than that used in our study”).¹¹⁹ The district court held that a skilled artisan would have been motivated to combine these references with a reasonable expectation of success, making the claim obvious.¹²⁰ On appeal, Salix argued that, even though the combination of these references discloses the claimed 1,650 mg/day dosage, that dosage was nonobvious because the only

¹¹³ *Id.* at 931.

¹¹⁴ *Id.*

¹¹⁵ *Id.* at 932.

¹¹⁶ *Id.* at 936.

¹¹⁷ *Salix Pharms., Ltd. v. Norwich Pharms. Inc.*, 98 F.4th 1056 (Fed. Cir. 2024).

¹¹⁸ *Id.* at 1061.

¹¹⁹ *Id.* (quoting prior art).

¹²⁰ *Id.*

dosage that might reasonably have been successful was the 400 mg, three times daily, regimen evaluated by Pimentel.¹²¹

The Federal Circuit disagreed, since Pimentel explicitly taught that the “*optimal dosage . . . may, in fact, be higher*” and other prior art references confirmed that teaching.¹²² Accordingly, “the combined message that the skilled artisan would have discerned from the Protocol and Pimentel is that the optimal dosage for treating patients suffering from IBS disorders may be higher than 400 mg [three times daily], and the next higher dosage unit from the Protocol was 550 mg,” which is the regimen claimed by the patent.¹²³

The polymorph claims were directed at obtaining the β -form of rifaximin.¹²⁴ Norwich challenged this claim as obvious based on a prior patent (“Cannata”), which taught that rifaximin exists in crystalline form with “outstanding antibacterial properties.”¹²⁵ Based on this prior art, the district court held that a skilled artisan would have had good reason to characterize the crystalline form of rifaximin, that the characterization was routine and easy to accomplish, and that doing so would have led the skilled artisan to detect rifaximin form β .¹²⁶

On appeal, it was undisputed that form β could be readily produced from Cannata, and that the skilled artisan would have had the ability and motivation to do so.¹²⁷ But Salix argued that form β remained nonobvious because skilled artisans would not have expected to succeed in producing the polymorph because, as of the critical date, the identity of form β was unknown and skilled artisans would not have been able to predict what polymorphic forms might have resulted.¹²⁸ The Federal Circuit rejected this argument, holding that Salix did “no more than” combine known elements of the prior art in order to verify information about a substance that was already known to skilled artisans.¹²⁹ In so holding, the court rejected the proposition that discovery of a previously-unknown substance is necessarily nonobvious.¹³⁰

¹²¹ *Id.* at 1062.

¹²² *Id.* at 1062 (quoting prior art), 1063-64.

¹²³ *Id.* at 1062.

¹²⁴ *Id.* at 1064.

¹²⁵ *Id.* (quoting prior art).

¹²⁶ *Id.* at 1064-65.

¹²⁷ *Id.* at 1066.

¹²⁸ *Id.*

¹²⁹ *Id.* at 1067.

¹³⁰ *Id.* at 1066.

Allergan USA, Inc. v. MSN Laboratories Private Ltd., 111 F.4th 1358 (Fed. Cir. Aug. 13, 2024)

In this appeal from the District of Delaware, the Federal Circuit reversed the district court’s finding that one of Allergan’s patents was invalid for obviousness-type double patenting (OTDP).¹³¹ At issue was a first-filed patent subject to a patent term adjustment period (PTA) that would persist after several continuing patents (without PTAs) would expire.¹³² Explaining that the purpose of the OTDP doctrine is to prevent “prevent patentees from obtaining a *second* patent on a patentably indistinct invention to effectively extend the life of a *first* patent to that subject matter,” the Federal Circuit held that the second-filed, continuing patents did not improperly extend the scope of rights created by the first-filed patent because “the first-filed, first-issued patent in its family . . . is the patent that sets the maximum period of exclusivity for the claimed subject matter and any patentably indistinct variants.”¹³³ “To hold otherwise would not only run afoul of the fundamental purposes of ODP, but effectively abrogate the benefit Congress intended to bestow on patentees when codifying PTA,” since it would limit the congressionally-guaranteed, extended terms of parent patents to the shorter terms of their children patents.¹³⁴ The court distinguished its prior decision in *In re Collect*,¹³⁵ which had held that additional PTA in a *second* patent would extend the term and therefore be subject to obviousness-type double patenting in the absence of a terminal disclaimer of the additional term.

Palo Alto Networks, Inc. v. Centripetal Networks, LLC, 122 F.4th 1378 (Fed. Cir. December 10, 2024) In this appeal from the PTAB, the Federal Circuit vacated and remanded the Board’s conclusion that Palo Alto Networks had not established that Centripetal’s claims were obvious over the relevant prior art.¹³⁶ The patent in suit was directed at identifying packets from a host in a first network, and correlating those packets with packets sent to a host in a second network.¹³⁷ This “packet correlation technique de-obfuscates the identity of an obfuscated host,” which can help networks detect unauthorized entry by malicious entities.¹³⁸

¹³¹ *Allergan USA, Inc. v. MSN Laboratories Private Ltd.*, 111 F.4th 1358 (Fed. Cir. Aug. 13, 2024)

¹³² *Id.* at 1368-69.

¹³³ *Id.* at 1369.

¹³⁴ *Id.* at 1371.

¹³⁵ 81 F.4th 1216 (Fed. Cir. 2013).

¹³⁶ *Palo Alto Networks, Inc. v. Centripetal Networks, LLC*, 122 F.4th 1378 (Fed. Cir. 2024).

¹³⁷ *Id.* at 1380-81.

¹³⁸ *Id.* at 1381.

The PTAB, in analyzing Palo Alto Network’s obviousness challenge, considered two prior art references (Sutton and Paxton).¹³⁹ Palo Alto Network relied on Paxton for most of the limitations in the challenged claim, but relied on Sutton for the final claim limitation (“transmitting an indication of the first host responsive to the correlating”).¹⁴⁰ According to Palo Alto Networks, a person of ordinary skill in the art would have been motivated to combine Paxton’s technique—which taught packet-correlation—with Sutton’s method of notifying “administrators . . . to identify or drop future packets to prevent future malicious communications.”¹⁴¹ In other words, Paxton explained the correlation technique but “leaves, to a [person of ordinary skill in the art], remedial steps (e.g., uses of the correlation results), which are taught by Sutton.”¹⁴² The PTAB disagreed, however, holding that Palo Alto Networks did not sufficiently explain the motivation to combine the two references. While Paxton provided the correlation technique, it did not provide “specific actions taken post-correlation.” Sutton provided a “transmission . . . unrelated to any correlation,” and Palo Alto Networks lacked the “necessary bridge showing that one of ordinary skill in the art would have appreciated that the transmission would be responsive to the correlation.”¹⁴³

On appeal, the Federal Circuit vacated and remanded the PTAB’s decision on two grounds. First, the court held that the PTAB erred in failing to expressly find whether there was a motivation to combine.¹⁴⁴ The court could not “discern with any confidence” what the PTAB’s “necessary bridge” language even meant.¹⁴⁵ Moreover, to the extent the Board intended to find no motivation to combine, that finding would be error, as it failed to address the evidence raised by Palo Alto Networks.¹⁴⁶ Second, the Federal Circuit held that the PTAB erred in viewing the references individually, rather than in combination from the view of a skilled artisan.¹⁴⁷ On remand, the Federal Circuit emphasized that the PTAB must evaluate obviousness in terms of the combined prior art references, clearly articulate its findings on motivation to combine, and provide an adequate explanation of those findings.¹⁴⁸

¹³⁹ *Id.* at 1382.

¹⁴⁰ *Id.*

¹⁴¹ *Id.*

¹⁴² *Id.* at 1383.

¹⁴³ *Id.* at 1384-85.

¹⁴⁴ *Id.*

¹⁴⁵ *Id.* at 1385.

¹⁴⁶ *Id.*

¹⁴⁷ *Id.* at 1386.

¹⁴⁸ *Id.* at 1385-86.

Cytiva BioProcess R&D AB v. JSR Corp., 122 F.4th 876 (Fed. Cir. December 24, 2024)

In this appeal from the PTAB, the Federal Circuit affirmed the PTAB’s finding of obviousness regarding composition claims directed at chromatography compounds to isolate target compounds, particularly antibodies, and reversed the PTAB’s finding of nonobviousness on four process claims.¹⁴⁹

At IPR, the PTAB found the composition claims obvious because the chemical modifications claimed by Cytiva had been “express[ly] suggest[ed]” in the prior art.¹⁵⁰ Certain other dependent claims were obvious because they claimed an “inherent property” of the composition.¹⁵¹ But, for Cytiva’s parallel process claims, the PTAB declined to find obviousness despite the claiming of an inherent property; instead, because JSR had failed to show an expectation of success, the process claims were nonobvious.¹⁵²

On appeal, Cytiva’s primary contention with regard to the invalidated composition claims was that the PTAB erred in failing to conduct a “lead-compound” analysis. A lead-compound analysis is a two-part test that assesses first, “whether a chemist of ordinary skill would have selected the asserted prior art compounds as lead compounds, or starting points, for further development efforts,” and second, “whether the prior art would have supplied one of ordinary skill in the art with a reason or motivation to modify a lead compound to make the claimed compound with a reasonable expectation of success.”¹⁵³ The court rejected Cytiva’s argument, holding that such an analysis “is not required where the prior art references expressly suggest” the proposed modification.”¹⁵⁴ In such circumstances, the Federal Circuit indicated that *KSR*’s obvious-to-try test would suffice.¹⁵⁵

Even applying the lead-compound test, the Federal Circuit held that Cytiva’s composition claims were still obvious.¹⁵⁶ At the first step, the court observed that the prior art sufficiently disclosed the lead compounds for further development; and, at the second step, that there would be sufficient motivation to modify the compound once the lead compound was selected, especially in light of the prior art’s express modification teachings.¹⁵⁷

¹⁴⁹ *Cytiva BioProcess R&D AB v. JSR Corp.*, 122 F.4th 876 (Fed. Cir. 2024).

¹⁵⁰ *Id.* at 883.

¹⁵¹ *Id.*

¹⁵² *Id.*

¹⁵³ *Id.* at 884 (quotations omitted).

¹⁵⁴ *Id.* at 884-85.

¹⁵⁵ *Id.* at 885.

¹⁵⁶ *Id.*

¹⁵⁷ *Id.* at 886.

Finally, the court turned to the merits of the *KSR* analysis for the process claims.¹⁵⁸ The Federal Circuit held that Cytiva’s claims were obvious, since the only disputed claim limitation was “an inherent property” of the compositions and processes that had already determined to be obvious.¹⁵⁹ In such circumstances, a challenger need not even demonstrate a reasonable expectation of success under *KSR*.¹⁶⁰ Only where the “claims require prior knowledge of the inherent property” would a challenger “still generally need to demonstrate a reasonable expectation of success.”¹⁶¹ Thus, affirming in part and reversing in part the PTAB, the Federal Circuit concluded that all of Cytiva’s claims were obvious.¹⁶²

¹⁵⁸ *Id.* at 888.

¹⁵⁹ *Id.* at 890-91.

¹⁶⁰ *Id.* at 890.

¹⁶¹ *Id.*

¹⁶² *Id.* at 891-92.

CLAIM CONSTRUCTION

Janssen Pharmaceuticals, Inc. v. Teva Pharmaceuticals USA, Inc., 97 F.4th 915 (Fed. Cir. Apr. 1, 2024)

In this appeal from the District of New Jersey, the Federal Circuit remanded on the issue of obviousness because of errors the district court made in claim construction.¹⁶³ First, the district court read into claims reciting “a dosing regimen for ‘a psychiatric patient in need of treatment for schizophrenia’” a requirement that the regimen be appropriate for the “general population of patients.”¹⁶⁴ However, the Federal Circuit agreed with defendant Teva’s argument that the claims did not require the regimen to be used for the general population, reasoning that, on their face, the claims only required the regimen to be used for “a psychiatric patient,” not any generalized group of patients.¹⁶⁵ Although Teva did describe its claims as being “general dosing regimens,” there was no evidence that “general” was meant to connote that the treatment could be “generalized” population-wide.¹⁶⁶

Second, the court agreed with Teva that the district court improperly read in a limitation that the treatments be administered to patents with “mild renal impairment.”¹⁶⁷ Since the claims themselves did not specify a “level of renal impairment,” the Federal Circuit held it was improper for the district court to analyze obviousness with this limitation in mind.¹⁶⁸ Therefore, the case was remanded for further obviousness analysis consistent with correcting these two errors in claim construction.¹⁶⁹

¹⁶³ *Janssen Pharmaceuticals, Inc. v. Teva Pharmaceuticals USA, Inc.*, 97 F.4th 915 (Fed. Cir. 2024).

¹⁶⁴ *Id.* at 925.

¹⁶⁵ *Id.* at 926.

¹⁶⁶ *Id.* at 927.

¹⁶⁷ *Id.*

¹⁶⁸ *Id.* at 928.

¹⁶⁹ *Id.* at 926-28.

Chewy, Inc. v. International Business Machines Corporation, 94 F.4th 1354 (Fed. Cir. Mar. 5, 2024)

In this appeal from the Southern District of New York, the Federal Circuit affirmed the district court’s claim construction of the limitation “selectively storing advertising objects at a store established at the reception system” in appellant IBM’s patent directed to web-based advertising.¹⁷⁰ The district court construed this limitation to require the advertising objects to be “pre-fetched,” or stored in anticipation of the need to be displayed.¹⁷¹ It based this construction on several instances in the specification of “this invention,” “the method,” and “the present invention” being described “as including pre-fetching of advertising objects.”¹⁷²

IBM argued that these descriptions should not limit the claim scope, relying on precedent that stated the use of phrases like “this invention” is not limiting when “the references to a certain limitation as being the “invention” are not uniform, or where other portions of the intrinsic evidence do not support applying the limitation to the entire patent.”¹⁷³ However, the court found these “narrow exceptions” to be inapplicable, as the prosecution history and patent itself “uniformly refer[] to the pre-fetching of advertising objects as an aspect of the invention.”¹⁷⁴ Therefore, the Federal Circuit affirmed the district court’s claim construction requiring advertising objects to be pre-fetched.¹⁷⁵

UTTO Inc. v. Metrotech Corp., No. 2023-1435, 2024 WL 4522564, at *7 (Fed. Cir. Oct. 18, 2024)

In this appeal from the Northern District of California, the Federal Circuit vacated the district court’s dismissal of the complaint because the district court had erred in its construction, based on the limited record before it, of the limitation “generating, based on the group of buried asset data points, a two dimensional area comprising the buffer zone” in appellant UTTO’s patent directed to methods for detecting underground utility lines (“buried asset”).¹⁷⁶ On a motion to dismiss, the district court had construed the “group” phrase in the limitation to require at least two data points per buried asset.¹⁷⁷

¹⁷⁰ *Chewy, Inc. v. International Business Machines Corporation*, 94 F.4th 1354 (Fed. Cir. 2024).

¹⁷¹ *Id.* at 1359.

¹⁷² *Id.* at 1359-60.

¹⁷³ *Id.* at 1360 (quoting *Absolute Software, Inc. v. Stealth Signal, Inc.*, 659 F.3d 1121, 1136–37 (Fed. Cir. 2011)).

¹⁷⁴ *Id.* at 1360-61.

¹⁷⁵ *Id.* at 1361.

¹⁷⁶ *UTTO Inc. v. Metrotech Corp.*, 2024 WL 4522564 (Fed. Cir. Oct. 18, 2024).

¹⁷⁷ *Id.* at *4.

The Federal Circuit first held that district courts may engage in claim construction when considering a motion to dismiss.¹⁷⁸ Because claim construction is “properly done based on intrinsic evidence alone in many cases,” the court concluded that there is “is no procedural error in the mere fact that a court has construed claims without conducting a separate *Markman* claim-construction set of proceedings, much less without hearing extrinsic evidence or expert testimony.”¹⁷⁹ The Federal Circuit acknowledged, however, that some “case-specific circumstances” may make claim construction inappropriate at the motion to dismiss stage.¹⁸⁰

The Federal Circuit then held that this case required “fuller claim-construction proceedings and analysis . . . than were provided in and by the district court.”¹⁸¹ When analyzing the term “group,” the court held that the district court had failed to adequately consider evidence showing that “group” should be construed as “one or more,” even if that construction did not accord with the ordinary and customary meaning of the phrase.¹⁸² In particular, the patent’s specification mentioned the use of “group” in conjunction with “one or more” buried assets, which supported the appellant’s favored construction.¹⁸³ Moreover, the Federal Circuit noted that there “may be a role for extrinsic evidence to play” in claim construction on remand, which the district court did not consider at the motion to dismiss.¹⁸⁴

DDR Holdings, LLC v. Priceline.com LLC, 122 F.4th 911 (Fed. Cir. December 21, 2024)

In this appeal from the District of Delaware, the Federal Circuit affirmed the district court’s construction of the terms “merchants” and “commerce object” in claims directed to a composite web page that combine visual objects from the host of the site with content from third-party merchants.¹⁸⁵ DDR sought a construction of the terms that would include both goods *and* services, while Priceline.com pressed for a goods-only construction.¹⁸⁶ The Federal Circuit agreed with Priceline.com based on the patent’s specification and prosecution history.¹⁸⁷ First, the patent’s specification failed to mention

¹⁷⁸ *Id.* at *7.

¹⁷⁹ *Id.* at *5-7.

¹⁸⁰ *Id.*

¹⁸¹ *Id.* at *7.

¹⁸² *Id.* at *9.

¹⁸³ *Id.*

¹⁸⁴ *Id.* at *10.

¹⁸⁵ *DDR Holdings, LLC v. Priceline.com LLC, 122 F.4th 911, 913 (Fed. Cir. 2024).*

¹⁸⁶ *Id.* at 915.

¹⁸⁷ *Id.*

services in relation to merchants and commerce objects.¹⁸⁸ Even though the provisional application referred to “products or services,” that counted against DDR since “the deletion made by the patent drafter between the provisional application and the patent specification” would indicate to a skilled artisan an “evolution of the applicant’s intended meaning of the claim term.”¹⁸⁹ It was immaterial that the patent purported to incorporate by reference the provisional application.¹⁹⁰ Finally, the Federal Circuit held that it was not bound by prior claim construction during IPR because the PTAB applies the broadest reasonable interpretation standard, rather than the *Phillips* standard.¹⁹¹

Kids2, LLC v. TOMY Int’l, Inc., No. 2023-1524, 2025 WL 87335 (Fed. Cir. Jan. 14, 2025)

In this appeal from the District of Rhode Island, the Federal Circuit reversed the district court’s entry of summary judgment of non-infringement in Kids2’s favor and remanded for further proceedings.¹⁹²

At claim construction, the district court construed a key claim limitation, “distal edges joined at a bottom surface apex,” to mean “edges of the seating surfaces situated farthest away from their respective back rests *joined to each other* at the area of a high point of the bottom surface of the body between the seating surfaces.”¹⁹³ In other words, the district court’s construction required the two edges to be directly joined to each other, rather than indirectly joined to either side of an intervening structure.¹⁹⁴ Based on that construction, the district court entered summary judgment in favor of Kids2 of non-infringement.¹⁹⁵

On appeal, the Federal Circuit held that the term “at a bottom surface apex” indicated “*where* the distal edges of the two seating surfaces joined, but does not limit *how* those distal edges must be joined.”¹⁹⁶ That conclusion was supported by the “plain and ordinary” meaning of “joined,” which includes both direct joining and indirect joining.¹⁹⁷ What’s more, the Federal Circuit construed one of the dependent claims as including indirect joinder; and since an independent claim “must be broad enough to

¹⁸⁸ *Id.* at 916.

¹⁸⁹ *Id.* at 916.

¹⁹⁰ *Id.* at 917-18.

¹⁹¹ *Id.* at 918-19.

¹⁹² *Kids2, LLC v. TOMY Int’l, Inc., 2025 WL 87335 (Fed. Cir. Jan. 14, 2025).*

¹⁹³ *Id.* at *2.

¹⁹⁴ *Id.* at *4.

¹⁹⁵ *Id.* at *2.

¹⁹⁶ *Id.* at *4.

¹⁹⁷ *Id.*

contain the full scope of its independent claim,” that provided evidence for the broader reading of “joined.”¹⁹⁸ That conclusion found further support in the specification and prosecution history, which disclosed embodiments with only indirect joinder.¹⁹⁹ The court, however, rejected TOMY’s other claim construction arguments, affirming the district court’s construction of the terms “bottom surface” and “seating surfaces.”²⁰⁰ Judge Chen dissented from the majority’s claim construction disposition and would have affirmed the district court’s claim construction in full.²⁰¹

The court further opined on TOMY’s infringement theories, finding that Kids2’s product documentation and witness testimony could support a finding that a certain feature of the accused product—a raised portion of the bottom surface that prevents a child from sliding down—could constitute a “seating surface.”²⁰² On this theory of infringement, Judge Chen disagreed in dissent.²⁰³ Judge Chen explained that a “seating surface” is something that one “sits *on*, not something that one sits *against*”; and since the feature of the accused product was merely an intervening *rest* that restrained movement, it did not constitute a “seating surface.”²⁰⁴

On TOMY’s second theory of infringement—which ignored the resting point and treated the two surrounding surfaces as the “seating structures”—the majority held that a reasonable factfinder could find that Kids2 product had “two seating surfaces disposed at differing inclinations” because one of the surfaces was horizontal (i.e., of zero inclination) and the other was steeper.²⁰⁵ Judge Chen dissented from this point too, arguing that a horizontal surface lacks any inclination at all, that TOMY had forfeited the argument in failing to assert that the “inclination” claim included zero incline, and that the prosecution history suggested that the claim required both seating surfaces to be inclined at a greater-than-zero angle.²⁰⁶

¹⁹⁸ *Id.*

¹⁹⁹ *Id.* at *5.

²⁰⁰ *Id.*

²⁰¹ *Id.* at *8 (Chen, J., dissenting in part).

²⁰² *Id.* at *6.

²⁰³ *Id.* at *8 (Chen, J., dissenting in part).

²⁰⁴ *Id.*

²⁰⁵ *Id.* at *6 (majority opinion).

²⁰⁶ *Id.* at *10 (Chen, J., dissenting in part).

INFRINGEMENT

Doctrine of Equivalents

NexStep, Inc. v. Comcast Cable Commc'ns, LLC, 2024 WL 4558613 (Fed. Cir. Oct. 24, 2024)

In this appeal from the District of Delaware, the Federal Circuit affirmed the district's grant of judgment as a matter of law of noninfringement on the '009 patent, which was directed to a "digital butler" that controls consumer electronics based on audio inputs.²⁰⁷

At the district court, NexStep presented expert testimony to prove infringement by the doctrine of equivalents, arguing that the infringing product's multi-step sequence was allegedly equivalent to the claimed limitation of "single action."²⁰⁸ The Federal Circuit found this insufficient under the means-way-result test because the expert failed to provide "particularized testimony and linking argument as to the insubstantiality of the differences between the claimed invention and the accused device."²⁰⁹ First, because the expert made only "generalized references" to features in the infringing product, NexStep failed to identify the specific elements that were equivalent to the claimed limitation.²¹⁰ Moreover, NexStep's expert failed to explain *why* the function in the infringing device was the same as the claimed limitation.²¹¹ Second, under the way prong of the test, the Federal Circuit held that the expert did not explain the way that the accused product functioned, let alone show that it performed in substantially the same way as the claim limitation.²¹² And, for the result prong, the court held that NexStar's testimony was too "generalized, unclear, and unconnected to the claimed invention."²¹³

For the "insubstantial differences" formulation of the doctrine of equivalents, the Federal Circuit similarly found the expert's testimony insufficient; it failed to "particularly identif[y] *what* specific elements of the accused products are allegedly equivalent to the "single action" limitation nor offered the required testimony explaining

²⁰⁷ *NexStep, Inc. v. Comcast Cable Commc'ns, LLC*, No. 2024 WL 4558613 (Fed. Cir. Oct. 24, 2024).

²⁰⁸ *Id.* at *10.

²⁰⁹ *Id.* at *9 (citation omitted).

²¹⁰ *Id.* at *11.

²¹¹ *Id.* at *12.

²¹² *Id.*

²¹³ *Id.* at *13.

why those elements were only insubstantially different in light of the claim language reciting what is being avoided by the “single action.”²¹⁴

Next, the Federal Circuit rejected the contention that NexStar’s literal infringement testimony, combined with its doctrine of equivalents evidence, was sufficient to sustain a finding of infringement by the doctrine of equivalents.²¹⁵ Though literal infringement evidence can bear on the doctrine of equivalents analysis, the court found the evidence insufficient because, taking it all together, it still failed to provide “particularized testimony and linking argument.”²¹⁶

Finally, the Federal Circuit rejected NexStar’s invitation to create an exception to the “particularized testimony and linking argument” rule in cases where the technology at issue is easily understandable.²¹⁷ Noting that the complexity of the doctrine is present “regardless of the simplicity of the underlying technology,” the court held that “patentees must still present juries with particularized testimony and linking argument to ensure that the jury does not misapply the doctrine and thereby stray beyond the doctrine’s ‘properly limited’ role.”²¹⁸

In dissent, Judge Reyna disagreed with the majority’s decision to “concoct[] a rigid new rule that in all cases a patentee must present expert opinion testimony to prove infringement under the doctrine of equivalents.”²¹⁹ The majority disagreed with this characterization, quoting the standard articulated in *AquaTex Industries, Inc. v. Techniche Solutions*: “[B]oth the Supreme Court and this court have made clear that the evidence of equivalents must be from the perspective of someone skilled in the art, for example through testimony of experts or others versed in the technology; *by documents, including texts and treatises*; and, of course, by the disclosures of the prior art.”²²⁰

Judge Reyna also disagreed with the majority’s application of the doctrine of equivalents inquiry, and opined that NexStar’s expert provided substantial evidence of infringement.²²¹

²¹⁴ *Id.* at *15.

²¹⁵ *Id.*

²¹⁶ *Id.*

²¹⁷ *Id.* at *16.

²¹⁸ *Id.*

²¹⁹ *Id.* at *21 (Reyna, J., concurring in part and dissenting in part).

²²⁰ *Id.* at *17 (quoting *AquaTex Indus., Inc. v. Techniche Sols.*, 479 F.3d 1320, 1329 (Fed. Cir. 2007)) (cleaned up).

²²¹ *Id.* at *19-21.

Reverse Doctrine of Equivalents

Steuben Foods, Inc. v. Shibuya Hoppmann Corp., 2025 WL 285173 (Fed. Cir. Jan. 24, 2025)

In this appeal from the District of Delaware, the Federal Circuit reversed the district court’s granting judgment as a matter of law (“JMOL”) of noninfringement on two patents (‘591 and ‘188), and affirmed JMOL of noninfringement on a third patent (‘685).²²² The patents at issue concerned systems for aseptic packaging of food.²²³

With respect to ‘591, the jury’s infringement verdict was overturned by the district court because it found that Shibuya had satisfied its burden to prove the reverse doctrine of equivalents (“RDOE”), entitling it to judgment as a matter of law.²²⁴ On appeal, Steuben first argued that the 1952 Patent Act eliminated RDOE. In support of its contention, Steuben pointed to § 271(a), which requires that all exceptions to infringement must be enumerated by statute, and to § 112, arguing that this section was intended to cover similar ground to the common law RDOE.²²⁵ While the Federal Circuit found these arguments “compelling,” it declined to hold that RDOE had been abrogated by statute.²²⁶ Instead, the court found that JMOL based on RDOE was inappropriate in this case because, considering Steuben’s expert’s rebuttal testimony (which had been improperly excluded by the district court), a reasonable jury could have found that the operation of the devices were sufficiently similar to overcome RDOE.²²⁷

With respect to ‘188, the district court concluded that Steuben’s claimed structures, including a conveyor and conveyor plates, did not function equivalently to Shibuya’s rotary wheels and neck grippers, which entitled Shibuya to a finding of noninfringement as a matter of law because the doctrine of equivalents (“DOE”) had not been satisfied.²²⁸ The Federal Circuit reversed, again based in large part on Steuben’s expert’s testimony.²²⁹ Because Steuben’s expert testified that the systems differed in form, but still performed the same function (filling bottles at a certain rate) in substantially the same way (by holding bottles as they move down a conveyor, albeit by different

²²² *Steuben Foods, Inc. v. Shibuya Hoppmann Corp.*, 2025 WL 285173, at *1 (Fed. Cir. Jan. 24, 2025)

²²³ *Id.* at *2.

²²⁴ *Id.* at *3.

²²⁵ *Id.* at *4.

²²⁶ *Id.*

²²⁷ *Id.* at *5.

²²⁸ *Id.* at *6.

²²⁹ *Id.* at *6.

mechanisms), the Federal Circuit held that a reasonable jury could have applied the DOE to find infringement, thereby reversing the grant of JMOL.²³⁰

Finally, with respect to ‘985, the key claim limitation required sterilant to be “intermittently” added to the system, which the parties stipulated to mean “added in a non-continuous manner.”²³¹ And because Shibuya’s system *continuously* added sterilant, the district court granted a JMOL of noninfringement, since “intermittently” and “continuously” are “antonyms,” and therefore cannot serve as “equivalents” in a DOE analysis.²³² The Federal Circuit affirmed, observing that, to apply DOE in this case would “vitiating the claim limitation.”²³³ “Something that is done non-continuously cannot be the equivalent of something done continuously.”²³⁴ Thus, because no reasonable jury could find equivalence, JMOL of noninfringement was warranted.²³⁵

Inducement

Amarin Pharma, Inc. v. Hikma Pharms. USA Inc., 104 F.4th 1370 (Fed. Cir. June 7, 2024)

In this appeal from the District of Delaware, the Federal Circuit found that Amarin had plausibly stated a claim for inducement based on a skinny label and reversed the district court’s dismissal of Amarin’s complaint.²³⁶

Amarin’s patented drug, icosapent ethyl (brand name, Vascepa), was approved by the FDA initially for only one indication, severe hypertriglyceridemia (“SH”), but was later approved for cardiovascular risk (“CV”).²³⁷ While Vascepa was only approved for SH, the FDA granted an ANDA to Hikma to market generic icosapent ethyl using a “skinny label” that contained only the SH, and not the CV, indication.²³⁸ Following approval of the generic, Hikma distributed information through press releases, its website, and its product label suggesting that Hikma’s drug was the “generic version of

²³⁰ *Id.* at *6.

²³¹ *Id.* at *7.

²³² *Id.*

²³³ *Id.* at *8.

²³⁴ *Id.*

²³⁵ *Id.*

²³⁶ *Amarin Pharma, Inc. v. Hikma Pharms. USA Inc.*, 104 F.4th 1370 (Fed. Cir. 2024).

²³⁷ *Id.* at 1372.

²³⁸ *Id.* at 1373.

Vascepa.”²³⁹ Many of these statements were made after Vascepa had been approved for the CV indication, which was covered by Amarin’s patent and unauthorized by the ANDA.²⁴⁰ On these facts, Amarin alleged that Hikma’s press released, website, and product label collectively induced physicians to infringe the asserted patents by prescribing generic icosapent ethyl for the off-label CV indication.²⁴¹

On appeal, it was undisputed that physicians directly infringe the patents by prescribing the drug for off-label uses, and that Hikma had the requisite intent and knowledge to induce that infringement.²⁴² The issue, then, was whether Amarin had sufficiently alleged Hikma’s “active[]” role in the inducement so as to impose liability.²⁴³ Even though the skinny label did not directly induce, the Federal Circuit held that the allegations were sufficient because: (1) Hikma’s press releases consistently referred to its drug as a “generic equivalent” to the multi-indication Vascepa, even though Hikma’s generic was not approved for the CV indication; and (2) Hikma advertised the drug in the broad category of “hypertriglyceridemia,” which encompassed both infringing and noninfringing uses.²⁴⁴ Moreover, the court found evidence of “active inducement” in the allegation that Hikma touted Vascepa sales figures to investors that were largely attributable to the off-label, infringing use.²⁴⁵ The Federal Circuit emphasized that the issue turned on what the statements communicated “to physicians and marketplace,” which was a question of fact unsuitable for resolution on a motion to dismiss.²⁴⁶ In so holding, the Federal Circuit noted that inducement ordinarily should not be found based solely on a skinny label or a claim that a drug is AB-rated.²⁴⁷

²³⁹ *Id.* at 1373-74.

²⁴⁰ *Id.*

²⁴¹ *Id.* at 1375.

²⁴² *Id.* at 1378.

²⁴³ *Id.*

²⁴⁴ *Id.* at 1379-80.

²⁴⁵ *Id.* at 1379.

²⁴⁶ *Id.*

²⁴⁷ *Id.* at 1381.

§271(e)(1)

Edwards Lifesciences Corporation v. Meril Life Sciences Pvt. Ltd., 96 F.4th 1347 (Fed. Cir. Mar. 25, 2024)

In this appeal from the Northern District of California, the Federal Circuit affirmed a finding of noninfringement of plaintiff Edwards’ patent directed to transcatheter heart valve systems.²⁴⁸ Edwards sued defendant Meril for infringement based on the importation of two heart valve systems its representative had brought from India to a conference in the United States.²⁴⁹ These valve systems were not offered for sale, but were brought as samples to have on hand while Meril attempted to recruit physicians from the conference to help with its FDA premarket approval application for the technology.²⁵⁰ These systems were never sold or offered for sale, and in fact were never even shown to members of the public.²⁵¹

The district court granted Meril a motion for summary judgment on grounds that 35 U.S.C. § 271(e)(1), which provides a safe harbor for otherwise infringing activities engaged in “solely for uses reasonably related to the development and submission of information under a Federal law which regulates the manufacture, use, or sale of drugs”²⁵² The Federal Circuit explained that § 271(e)(1) has been interpreted such that the safe harbor applies regardless of the intention behind the allegedly infringing activity, so long as the activity itself “was reasonably related to developing information for FDA submission.”²⁵³ Therefore, it agreed with the district court that the safe harbor applied to Meril’s importation of the valve systems because this importation was related to Meril’s efforts to obtain FDA approval, dismissing Edwards’ contentions that Meril had unrelated commercial motivations.²⁵⁴

Edwards additionally argued that “§ 271(e)(1) requires a use distinct from the otherwise infringing acts” for its safe harbor to apply.²⁵⁵ The court rejected this argument by looking to the text of the rule, which lists each of the possible infringing acts separately and does not require that the “uses reasonably related to the development and

²⁴⁸ *Edwards Lifesciences Corporation v. Meril Life Sciences Pvt. Ltd.*, 96 F.4th 1347 (Fed. Cir. 2024).

²⁴⁹ *Id.* at 1349-50.

²⁵⁰ *Id.* at 1350.

²⁵¹ *Id.*

²⁵² *Id.* at 1351.

²⁵³ *Id.* at 1352 (quoting *Amgen Inc. v. Hospira, Inc.*, 944 F.3d 1327, 1339 (Fed. Cir. 2019)).

²⁵⁴ *Id.* at 1353-55.

²⁵⁵ *Id.* at 1355.

submission of information” be “actual use[s]” in the patent infringement sense.²⁵⁶ Therefore, the Federal Circuit concluded that Meril was shielded from infringement liability by the § 271(e)(1) safe harbor and affirmed the district court’s decision.²⁵⁷

Judge Lourie dissented, pointing out that whatever the policy merits of the result, it did not fit with the language of the statute.

International Trade Commission

Zircon Corp. v. International Trade Commission, 101 F.4th 817 (Fed. Cir. May 8, 2024)

In this appeal from the International Trade Commission, the Federal Circuit affirmed the Commission’s finding that Section 337 of the Tariff Act had not been violated because the “domestic industry” requirement failed.²⁵⁸ To establish a section 337 violation—which prohibits the importation, sale for importation, or sale after importation of infringing goods²⁵⁹—Zircon was required to show that “an industry in the United States, relating to the articles protected by the patent . . . exists or is in the process of being established,” referred to as the “domestic industry” requirement.²⁶⁰ In turn, the domestic industry provision requires showing that “the articles protected by the patent” involve “(A) significant [domestic] investment in plant and equipment; (B) significant [domestic] employment of labor or capital; or (C) substantial [domestic] investment in its exploitation, including engineering, research and development, or licensing.”²⁶¹

Zircon alleged that it met the “domestic industry” requirement “based on its investment in plant and equipment, its employment of labor and capital, and its investment in the exploitation of the asserted patents.”²⁶² The Commission disagreed because Zircon had “relied on evidence of its cumulative expenditures on *all 53* of its domestic industry products,” but not all of these products practiced the patents.²⁶³ Thus, since Zircon “did not allocate its [domestic] expenditures . . . with respect to . . . each of

²⁵⁶ *Id.* at 1356.

²⁵⁷ *Id.* at 1357.

²⁵⁸ *Zircon Corp. v. International Trade Commission*, 101 F.4th 817 (Fed. Cir. 2024).

²⁵⁹ 19 U.S.C. § 1337(a)(1)(B)(i).

²⁶⁰ *Id.* § 1337(a)(2).

²⁶¹ *Id.* § 1337(a)(3)(A)–(C).

²⁶² *Zircon Corp.*, 101 F.4th at 820.

²⁶³ *Id.* at 822 (emphasis added).

the asserted patents,” the Commission could not “evaluate the significance of Zircon’s investments with respect to each asserted patent” in isolation.²⁶⁴

On appeal, the Federal Circuit agreed with the Commission, holding that “in cases in which the complainant’s products or groups of products each practice different patents, the complainant would need to establish separate domestic industries for each of those different groups of products.”²⁶⁵ The Federal Circuit concluded that the “domestic industry” requirement requires a complainant to “identify, in some manner, how much of its investment in each statutory category was attributable to each group of products” that practiced the patents.²⁶⁶

²⁶⁴ *Id.*

²⁶⁵ *Id.* at 824.

²⁶⁶ *Id.* at 826.

DEFENSES

Inequitable Conduct and Unclean Hands

Freshub, Inc. v. Amazon.com, Inc., 2024 WL 761779 (Fed. Cir. Feb. 24, 2024)

In this appeal from the Western District of Texas, the Federal Circuit determined that the district court did not commit clear error in its rejection of defendant Amazon’s inequitable conduct defense.²⁶⁷ Prevailing on this defense requires proof of clear and convincing evidence that the patent applicant “misrepresented or omitted material information with the specific intent to deceive the PTO.”²⁶⁸ Although counsel for Ikan, the parent company of plaintiff Freshub, did make a materially false statement by denying the patent at issue was abandoned intentionally after a five-year period in which Freshub did not respond to examiner notices, the court held that Amazon failed to prove the required deceptive intent.²⁶⁹

It explained that the relevant inquiry was into Ikan’s intent during a period of non-response to the PTO ranging from 2012-2017.²⁷⁰ Amazon provided evidence that Ikan’s counsel communicated with the company several times regarding the patent during this period but never received a reply to continue prosecution.²⁷¹ However, the court held that this evidence was insufficient to demonstrate knowing authorization of abandonment on the part of Ikan, as it is possible the relevant Ikan decisionmakers never received or understood the communications.²⁷² Therefore, the attorney may have genuinely believed Ikan did not intend to abandon the application and, in that case, would not have made his statement with deceptive intent.²⁷³ On this basis, the Federal Circuit affirmed the district court’s holding that deceptive intent was not proven.²⁷⁴

²⁶⁷ *Freshub, Inc. v. Amazon.com, Inc.*, 2024 WL 761779 (Fed. Cir. 2024).

²⁶⁸ *Id.* at *6 (quoting *Therasense, Inc. v. Becton, Dickinson and Co.*, 649 F.3d 1276, 1287 (Fed. Cir. 2011)).

²⁶⁹ *Id.*

²⁷⁰ *Id.* at *7.

²⁷¹ *Id.*

²⁷² *Id.*

²⁷³ *Id.* at *8.

²⁷⁴ *Id.* at *8.

Luv n' Care, Ltd. v. Laurain, 98 F.4th 1081 (Fed. Cir. Apr. 12, 2024)

In this appeal from the Western District of Louisiana, the Federal Circuit affirmed the district court's finding that the doctrine of unclean hands barred counter-claimant Eazy-PZ, LLC ("EZPZ") from seeking relief.²⁷⁵ It also vacated the district court's finding that plaintiff Luv N' Care ("LNC") failed to prove that a patent held by EZPZ was unenforceable due to inequitable conduct.²⁷⁶

The district court had found unclean hands on grounds that EZPZ failed to disclose relevant patent applications to LNC, concealed relevant prior art searches, and gave "purposely evasive" or false testimony on several occasions.²⁷⁷ EZPZ argued that this misconduct did not rise to the level of "unconscionable acts" or, alternatively, it did not "bear[] an immediate and necessary connection to EZPZ's claims for infringement" and should therefore not trigger unclean hands.²⁷⁸ However, the Federal Circuit agreed with the district court that EZPZ engaged in "deceit and reprehensible conduct . . . to gain an unfair advantage," and thus found it was not clear error to deem its behavior unconscionable.²⁷⁹ It also agreed that the conduct was necessarily connected to the claims at issue, as EZPZ's knowing concealment of information from LNC affected the litigation of all EZPZ's claims.²⁸⁰ The Federal Circuit therefore affirmed the unclean hands judgment below.²⁸¹

On the issue of inequitable conduct, the Federal Circuit found two errors in the district court's analysis.²⁸² First, it explained that "affirmative egregious misconduct" satisfies the materiality requirement for inequitable conduct automatically, but that the district court did not analyze materiality as a "separate requirement" from deceptive intent to see if such misconduct occurred.²⁸³ Next, the Federal Circuit explained that the district court applied the wrong standard to the deceptive intent inquiry, as it considered several of EZPZ's misrepresentations to the PTO in isolation without recognizing that a pattern of misconduct can, as a whole, demonstrate deceptive intent even when each individual act does not.²⁸⁴ It also found the district court had insufficiently analyzed the

²⁷⁵ *Luv n' Care, Ltd. v. Laurain*, 98 F.4th 1081, 1094 (Fed. Cir. 2024).

²⁷⁶ *Id.* at 1096.

²⁷⁷ *Id.* at 1095.

²⁷⁸ *Id.*

²⁷⁹ *Id.*

²⁸⁰ *Id.* at 1096.

²⁸¹ *Id.*

²⁸² *Id.* at 1097-99.

²⁸³ *Id.* at 1097.

²⁸⁴ *Id.* at 1098.

intent behind several of these misrepresentations, a critical part of the deceptive intent inquiry.²⁸⁵ Thus, the Federal Circuit vacated the district court’s finding that LNC failed to prove inequitable conduct and remanded.²⁸⁶

Staton Techiya v. Samsung, No. 21-cv-00413, Dkt. No. 933 (E.D. Tex. May 24, 2024)

After conducting a bench trial in the Eastern District of Texas, the court found that Samsung had established that Techiya’s patents were unenforceable due to unclean hands by clear and convincing evidence and entered judgment in Samsung’s favor.²⁸⁷

The district court found that Techiya exclusively licensed its patents to Synergy IP²⁸⁸—a patent assertion entity created by two former Samsung attorneys²⁸⁹—and those Synergy attorneys, in turn, used Samsung’s confidential and privileged information in order to help Techiya litigate its claim against Samsung.²⁹⁰ Specifically, the court found that these former Samsung attorneys used confidential information learned during the scope of their previous employment,²⁹¹ unlawfully solicited confidential information from a current Samsung employee about the patents-in-suit (which resulted in a Korean criminal investigation),²⁹² and used that information to prosecute the litigation.²⁹³ The Synergy attorneys also took various steps to cover up their misconduct.²⁹⁴

This conduct—including “stealing the opponent’s privileged and confidential analyses of the patents-in-suit both before and during the litigation,” breaching fiduciary duties,²⁹⁵ lying in pleadings and depositions,²⁹⁶ and subverting discovery through spoliation and other means²⁹⁷—exceeded the degree of misconduct that warranted

²⁸⁵ *Id.* at 1099.

²⁸⁶ *Id.*

²⁸⁷ *Staton Techiya v. Samsung, No. 21-cv-00413, Dkt. No. 933, at *1-2 (E.D. Tex. May 24, 2024).*

²⁸⁸ *Id.* at 104-05.

²⁸⁹ *Id.* at 18-22.

²⁹⁰ *Id.* at 2-3.

²⁹¹ *Id.* at 22-24.

²⁹² *Id.* at 26-35.

²⁹³ *Id.* at 43.

²⁹⁴ *Id.* at 86-87.

²⁹⁵ *Id.* at 84-85.

²⁹⁶ *Id.* at 86.

²⁹⁷ *Id.* at 86-87.

application of the unclean hands doctrine in prior precedent.²⁹⁸ And since Synergy acted as Techiya’s agent before and during the litigation, the court held that Synergy’s unclean hands were imputable to Techiya.²⁹⁹ Finally, the court held that dismissal with prejudice was the proper remedy, since the plaintiff’s bad faith conduct “infected” the entire case and mere monetary sanctions were not sufficient to cure the irreparable harm incurred by Samsung, restore the integrity of the litigation, or punish the plaintiffs for their misconduct.³⁰⁰

²⁹⁸ *Id.* at 83.

²⁹⁹ *Id.* at 89-97.

³⁰⁰ *Id.* at 97-99.

REMEDIES

Damages

Brumfield, Trustee for Ascent Trust v. IBG LLC, 97 F.4th 854 (Fed. Cir. Mar. 27, 2024)

In this appeal from the Northern District of Illinois, the Federal Circuit affirmed the denial of plaintiff Trading Technologies International’s (“TT’s”) post-trial motion for a new damages trial.³⁰¹ TT’s damages expert had argued at trial that it “should recover foreign damages flowing from [m]aking the Accused Products in the United States.”³⁰² In that regard, the Federal Circuit explained that the determination of whether patent damages should be awarded “based partly on conduct abroad” is now governed by the two-step framework outlined by the Supreme Court in *WesternGeco LLC v. ION Geophysical Corp.*, 585 U.S. 407 (2018).³⁰³ The first step is to start with a presumption that the applicable statute “lacks extraterritorial reach” and then analyze whether that presumption has been rebutted.³⁰⁴ The second step is to analyze the statute’s “focus” and determine whether the conduct relevant to that focus is domestic.³⁰⁵ If so, a patentee can recover for lost *foreign* profits without violating extraterritoriality, because the infringing actions causing those losses will be considered *domestic* conduct.³⁰⁶

As a preliminary matter, the Federal Circuit clarified that the *WesternGeco* framework applied to the present suit, which concerned infringement under 35 U.S.C. § 271(a), despite *WesternGeco* itself being a case about infringement under §271(f), as both types of infringement involve “domestic act[s].”³⁰⁷ It also explained that *WesternGeco* should govern the instant case regarding reasonable royalties, despite being a case about lost profits, as the Supreme Court did not distinguish between forms of damages in its analysis.³⁰⁸ However, the Federal Circuit was careful to note that, for reasonable royalty cases in particular, “foreign conduct that is not itself infringing” must cause the value of domestic infringement to increase to be included in the damages calculation, as otherwise it would not be relevant to the hypothetical domestic licensing negotiations that a

³⁰¹ *Brumfield, Trustee for Ascent Trust v. IBG LLC*, 97 F.4th 854 (Fed. Cir. 2024).

³⁰² *Id.* at 870 (internal quotation marks omitted).

³⁰³ *Id.* at 871-72.

³⁰⁴ *Id.* at 872.

³⁰⁵ *Id.* at 873.

³⁰⁶ *Id.* at 872-73.

³⁰⁷ *Id.* at 875.

³⁰⁸ *Id.* at 875-76.

reasonable royalty determination envisions.³⁰⁹ It left further consideration of the complications introduced by this causation requirement to future cases.³¹⁰

Applying the above framework to the instant case, the court found it dispositive that the infringement asserted by TT, “Making the Accused Product,” did not have the needed causal relationship to the foreign conduct at issue.³¹¹ The patent at issue had two groups of claims, one directed to a method and the other to software implemented on a computer.³¹² Patent law does not recognize a means of “making” a method, meaning infringement must be based on the computer claim, but TT only alleged that defendant IBG distributed infringing software, which is not equivalent to making copies of a software *on a computer*.³¹³ Thus, the court found there was no act of infringement from which a causal connection to the foreign conduct could be drawn and affirmed the district court’s judgment.³¹⁴

EcoFactor, Inc. v. Google LLC, 104 F.4th 243 (Fed. Cir. June 3, 2024)

In this appeal from the Western District of Texas, the Federal Circuit affirmed the district court’s award of reasonable royalty damages to EcoFactor.³¹⁵ This panel decision, however, was vacated when the Federal Circuit granted Google’s motion for rehearing en banc.³¹⁶ The case is now pending en banc resolution.

On appeal, Google first argued that a new trial on damages was warranted because EcoFactor’s damages expert, Kennedy, lacked reliable methodology and underlying calculations, and thus, should have been excluded.³¹⁷ Kennedy had used the “hypothetical negotiation” model for calculating reasonable royalty damages.³¹⁸ In Google’s view, Kennedy’s proposed per unit royalty rate had been “plucked” from nowhere and was unsupported by sound methodology.³¹⁹ But the Federal Circuit panel disagreed, observing that Kennedy’s rate was based on the rate contemplated in three

³⁰⁹ *Id.* at 877.

³¹⁰ *Id.* at 878.

³¹¹ *Id.* at 878-79.

³¹² *Id.* at 879.

³¹³ *Id.* at 879-80.

³¹⁴ *Id.* at 882.

³¹⁵ *Ecofactor, Inc. v. Google LLC, 104 F.4th 243 (Fed. Cir. June 3, 2024).*

³¹⁶ *EcoFactor, Inc. v. Google LLC, 2024 WL 4282269 (Mem.) (Fed. Cir. Sept. 25, 2024).*

³¹⁷ *Id.* at 250.

³¹⁸ *Id.* at 251.

³¹⁹ *Id.* at 252.

license agreements EcoFactor had reached with other licensees, as well as testimony and documents describing the nature of the market.³²⁰ Because this evidence “sufficiently tied” Kennedy’s proposed rate to the “facts of the case,” the Federal Circuit ruled that his testimony was sufficiently reliable to be admitted.³²¹

Google next argued that Kennedy’s testimony should have been excluded for lack of severability and apportionment.³²² While the three license agreements referenced by Kennedy were technically comparable to the hypothetical license, Google contended that they were not economically comparable because those three actual license agreements were for EcoFactor’s *entire* patent portfolio, whereas the hypothetical license concerned only the single patent-in-suit.³²³ Agreeing with the basic principle that damages owed “must reflect the value of only the patented improvement,” the panel still held that Kennedy had properly set the royalty rate based on the value of the patent itself.³²⁴ Even though the three license agreements were of different value than the hypothetical license agreements, the court held that Kennedy “accounted” for such differences by decreasing the royalty rate and considering that, in the actual licensing agreements, the rate had been discounted based on the risk that the patents would not be found not infringed or invalid.³²⁵ In addition, Kennedy conducted a profit analysis using Google’s data to show the amount of profit per unit that could be attributed to the patent, which supported increasing the royalty rate. The Federal Circuit held that, using these data, Kennedy had sufficient grounds to provide a reliable opinion as to the royalty rate, making his testimony admissible.³²⁶

In dissent, Judge Prost sided with Google.³²⁷ Judge Prost emphasized that the prior three licensing agreements involved *lump-sum* payments, not per-unit royalties; language in these agreements concerning per-unit royalties were not actually assented to by the parties.³²⁸ Rather, the royalty rates were merely EcoFactor’s preambular representations as to what it *believed* would be a reasonable royalty calculation.³²⁹ In Judge Prost’s view, those “self-serving recitals reflect only EcoFactor’s transparent

³²⁰ *Id.* at 252-53.

³²¹ *Id.* at 253-54.

³²² *Id.* at 254.

³²³ *Id.*

³²⁴ *Id.* at 254-55.

³²⁵ *Id.* at 255.

³²⁶ *Id.* at 256-57.

³²⁷ *Id.* at 257 (Prost, J., dissenting in part).

³²⁸ *Id.* (Prost, J., dissenting in part).

³²⁹ *Id.* at 258 (Prost, J., dissenting in part).

attempt to manufacture a royalty rate using its ‘belief.’”³³⁰ Even setting that issue aside, Judge Prost asserted that these three licensing agreements were not comparable to the hypothetical licensing agreement. Contrary to the majority’s view, Judge Prost opined that Kennedy had failed to account for the specific effects of other patents that were the subject of previous licensing agreements, but not at issue; instead, Kennedy accounted for these merely by general appeal to industry practice and generic price effects, without considering the specific effects the other patents would have had on the hypothetical negotiation.³³¹ For those reasons, Judge Prost would have reversed and granted Google a new trial on damages.³³²

Provisur Techs., Inc. v. Weber, Inc., No. 2023-1438, 2024 WL 4363502 (Fed. Cir. Oct. 2, 2024)

In this appeal from the Western District of Missouri, the Federal Circuit reversed a \$10.5 million jury verdict in Provisur’s favor.³³³ Provisur had accused certain components of Weber’s meat and cheese slicers of infringement.³³⁴

The Federal Circuit held that the district court had erred in allowing the royalty rate to be calculated using the entire market value rule because Provisur had failed to show that the patented features drove market demand for the entire line of products.³³⁵ Provisur’s expert had shown that various features of the product were “conventional,” whereas the patented features were “unique selling points.”³³⁶ But still, the court noted, these “conventional” factors could provide value and drive demand, such that apportionment would be required.³³⁷ Moreover, Provisur provided no market studies or consumer surveys to determine whether the patented features drove demand.³³⁸ Because the “patented technology is just one small component of one of the machines, and no other evidence supports the notion that this small component of just one portion of such a

³³⁰ *Id.* at 259 (Prost, J., dissenting in part).

³³¹ *Id.* at 260-61 (Prost, J., dissenting in part).

³³² *Id.* at 262 (Prost, J., dissenting in part).

³³³ *Provisur Techs., Inc. v. Weber, Inc., 2024 WL 4363502 (Fed. Cir. Oct. 2, 2024).*

³³⁴ *Id.* at *6.

³³⁵ *Id.* at *6.

³³⁶ *Id.* at *6.

³³⁷ *Id.*

³³⁸ *Id.* at *7.

large system ever drove customer demand,” the court held it was an abuse of discretion to apply the entire market value rule.³³⁹

Willfulness

Provisur Techs., Inc. v. Weber, Inc., No. 2023-1438, 2024 WL 4363502 (Fed. Cir. Oct. 2, 2024)

In this appeal from the Western District of Missouri, the Federal Circuit reversed the district court’s denial of judgment as a matter of law of nonwillfulness because the district court had improperly considered evidence in violation of 35 U.S.C. § 298.³⁴⁰

At trial, Provisur’s expert had testified about Weber’s failure to consult a third party to evaluate the allegedly infringed patents, including by conducting a freedom to operate analysis under supervision of a patent attorney.³⁴¹ On appeal, Provisur argued that this testimony was simply about industry standards, and did not amount to commenting on Weber’s failure to seek advice of counsel.³⁴² The Federal Circuit disagreed, noting that the expert “did not distinguish between legal and non-legal services when testifying about consulting a third party” and could not circumvent § 298 “by substituting advice from a third party for advice of counsel.”³⁴³

The remaining evidence, the court held, was insufficient to prove willfulness, since it only showed Weber’s knowledge of the asserted patents and fell short of proving that Weber knew that it was infringing and intended to infringe.³⁴⁴

³³⁹ *Id.*

³⁴⁰ *Provisur Techs., Inc. v. Weber, Inc., 2024 WL 4363502 (Fed. Cir. Oct. 2, 2024).*

³⁴¹ *Id.* at *4.

³⁴² *Id.* at *5.

³⁴³ *Id.* at *5.

³⁴⁴ *Id.*

PRACTICE AND PROCEDURE

Pleading

Exeltis USA, Inc. v. Lupin Ltd., 22-cv-434-RGA (D. Del. Oct. 29, 2024)

In this memorandum order by the District Court for the District of Delaware, the court dismissed with prejudice claims that Exeltis had previously agreed to withdraw pursuant to a case narrowing order.³⁴⁵ In this Hatch-Waxman action, the operative complaint asserted fifteen patents.³⁴⁶ To narrow the action for trial, Exeltis withdrew numerous claims, leaving only seven claims from six patents to be tried.³⁴⁷ After Exeltis won at trial on those seven claims, the issue was whether the withdrawn claims should be dismissed with or without prejudice.³⁴⁸ The court held that the claims should be dismissed with prejudice, rejecting Exeltis’s “fundamental fairness” argument. The court observed that Lupin’s invalidity counterclaims had also been dropped under the narrowing order, making the effect of the order even-handed.³⁴⁹ Finally, the court noted that dismissal with prejudice served the purposes of the Hatch-Waxman Act, since it would preclude “repeat litigation” by a branded company to “protect its highly profitable branded product.”³⁵⁰

Venue and Transfer

In re Datanet LLC, 2024 WL 4141612 (Fed. Cir. Sept. 11, 2024)

In this petition for Writ of Mandamus from the Western District of Texas (WDTX), the Federal Circuit held that the district court had properly transferred the case from WDTX to the Northern District of California (NDCA).³⁵¹ Though the magistrate judge had initially recommended that the case proceed in WDTX and that the transfer motion be denied, the district judge reviewing the recommendation found this analysis

³⁴⁵ *Exeltis USA, Inc. v. Lupin Ltd.*, 22-cv-434-RGA, at *1 (D. Del. Oct. 29, 2024), https://www.govinfo.gov/content/pkg/USCOURTS-ded-1_22-cv-00434/pdf/USCOURTS-ded-1_22-cv-00434-4.pdf.

³⁴⁶ *Id.*

³⁴⁷ *Id.*

³⁴⁸ *Id.* at *1-2.

³⁴⁹ *Id.* at *2.

³⁵⁰ *Id.* at *3.

³⁵¹ *In re Datanet LLC*, 2024 WL 4141612, at *1 (Fed. Cir. Sept. 11, 2024).

erroneous and ordered transfer to NDCA.³⁵² Reviewing the motion under Fifth Circuit law, the Federal Circuit explained that it would “not disturb a transfer decision unless it is clear ‘that the facts and circumstances are without any basis for a judgment of discretion.’”³⁵³ Under that highly deferential standard, the Federal Circuit affirmed the district court’s order to transfer the case to NDCA, since the accused technology was designed and marketed there and several party and non-party witnesses and custodians of evidence were also present there.³⁵⁴

In re Apple Inc., 2024 WL 3886316 (Fed. Cir. Aug. 21, 2024)

In this petition for Writ of Mandamus from the Western District of Texas (WDTX), the Federal Circuit held that the district court had properly declined to transfer the case to the Northern District of California (NDCA).³⁵⁵ At the district court, Apple argued that transfer was warranted because, according to a declaration from an Apple engineer, the Apple engineers who researched, designed, developed, and implemented the relevant feature of the accused products were located in California.³⁵⁶ The district court disagreed because the engineer’s declaration was deficient and the suppliers of component parts to Apple for the accused products were located in WDTX.³⁵⁷ Reviewing the motion under Fifth Circuit law, the Federal Circuit explained that “transfer ‘is properly granted only if the moving party clearly establishes good cause by clearly demonstrating that a transfer is for the convenience of parties and witnesses, in the interest of justice.’”³⁵⁸ Under that highly deferential standard, the Federal Circuit held that the district court “reasonably found” that WDTX would be more convenient and Apple’s evidence to the contrary was “plausibly . . . deficien[t]”³⁵⁹

Xockets v. Nvidia, No. 24-cv-453, Dkt. 61 (W.D. Tex. Sept. 17, 2024)

In this case pending in the Western District of Texas, the district court reassigned the case to a randomly assigned district judge in the Western District pursuant to the Western District’s May 30, 2024 Order Assigning The Business Of The Court As It

³⁵² *Id.*

³⁵³ *Id.* (quoting *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 312 n.7 (5th Cir. 2008) (en banc)).

³⁵⁴ *Id.*

³⁵⁵ *In re Apple Inc.*, No. 2024-129, 2024 WL 3886316, at *1 (Fed. Cir. Aug. 21, 2024).

³⁵⁶ *Id.*

³⁵⁷ *Id.*

³⁵⁸ *Id.* (quoting *In re Clarke*, 94 F.4th 502, 508 (5th Cir. 2024) (cleaned up)).

³⁵⁹ *Id.* at *2.

Relates To Patent Cases.³⁶⁰ Xockets had attempted to avoid reassignment under the May 30, 2024 Order by alleging only antitrust violations in their complaint.³⁶¹ That same very day, Xockets filed an amended complaint adding seven patent causes of action.³⁶² Based on that amended complaint, the court found that the case “involve[ed] patents” and therefore was subject to the May 30, 2024 Reassignment Order.

Disclosure of Controlling Entities

Backertop Licensing LLC v. Canary Connect, Inc., 107 F.4th 1335 (Fed. Cir. July 16, 2024)

In this appeal from the District of Delaware related to *Nimitz Technologies*, the Federal Circuit affirmed the imposition of sanctions entered by Judge Connolly related to the plaintiffs’ failure to disclose controlling entities.³⁶³ This opinion arises out of the same circumstances as *Nimitz Technologies*.³⁶⁴

After Backertop filed twelve cases in various district courts, the district court “identified the same pattern of potential misconduct seen in the other IP Edge-linked and Maxevar-linked cases,” including *Nimitz Technologies*.³⁶⁵ The district court subsequently ordered Backertop’s sole owner, Ms. LaPray, and its attorneys to appear in-person for a hearing to address ownership documents submitted by Backertop that raised “concerns about potential attorney and party misconduct.”³⁶⁶ After the court denied Ms. LaPray’s motion to appear by telephone, Ms. LaPray refused to appear, resulting in her being held in civil contempt under the court’s inherent powers.³⁶⁷

The Federal Circuit affirmed, rejecting Backertop’s argument that Rule 45 limits the *sua sponte* power of courts to issue an order to appear.³⁶⁸ Because Rule 45 concerns the issuance of subpoenas by *parties* and their attorneys—not a court’s *sua sponte* orders

³⁶⁰ Xockets v. Nvidia, No. 24-cv-453, Dkt. 61 (W.D. Tex. Sept. 17, 2024); *see also* Order Assigning the Business of the Court as it Relates to Patent Cases (W.D. Tex., May 30, 2024), <https://www.txwd.uscourts.gov/wp-content/uploads/2024/05/Order-re-Patent-Cases-05302024.pdf>.

³⁶¹ *Id.*, Dkt. 1

³⁶² *Id.*, Dkt. 61.

³⁶³ *Backertop Licensing LLC v. Canary Connect, Inc.*, 107 F.4th 1335 (Fed. Cir. 2024)

³⁶⁴ *Id.* at 1337-38.

³⁶⁵ *Id.* at 1338-39.

³⁶⁶ *Id.* at 1339-40.

³⁶⁷ *Id.* at 1339-41.

³⁶⁸ *Id.* at 1343.

—the court held that it was inapposite.³⁶⁹ And since the order to compel Ms. LaPray’s appearance was “an appropriate means to investigate potential misconduct involving Backertop, a corporate party of which she is the sole representative,” the Federal Circuit held that compelling her attendance—and holding her in contempt for noncompliance—was not an abuse of discretion.³⁷⁰

Incorporation by Reference

Promptu Systems Corporation v. Comcast Corporation, 2024 WL 649221 (Fed. Cir. Feb. 16, 2024)

In this appeal from the PTAB, the Federal Circuit issued a *sua sponte* order that “[p]arties may not incorporate by reference arguments into one brief from another . . . if it would result in exceeding the applicable word count.”³⁷¹ Counsel for Comcast submitted a brief which incorporated by reference almost 2,000 words from a brief in a related appeal, making the brief over 1,300 words longer than the applicable word count.³⁷² Comcast’s counsel argued this was done to “increase efficiency” and that the Federal Circuit had never explicitly ruled on whether incorporation “from the same party’s brief in a companion appeal” was allowed.³⁷³ However, the court held that there is no exception to the previously stated rule that all incorporations by reference must obey the applicable word count, and that future violations of this rule “will likely result in sanctions.”³⁷⁴

Attorney’s Fees

Realtime Adaptive Streaming v. Sling, 113 F.4th 1248 (Fed Cir. Aug. 23, 2024)

In this appeal from the District of Colorado, the Federal Circuit vacated the district court’s award of attorneys’ fees to Sling.³⁷⁵

³⁶⁹ *Id.* at 1343-44.

³⁷⁰ *Id.* at 1344-45.

³⁷¹ *Promptu Systems Corporation v. Comcast Corporation*, 2024 WL 649221 (Fed. Cir. 2024).

³⁷² *Id.* at *1.

³⁷³ *Id.*

³⁷⁴ *Id.* at *2.

³⁷⁵ *Realtime Adaptive Streaming L.L.C. v. Sling TV, L.L.C.*, 113 F.4th 1348 (Fed. Cir. 2024).

The district court’s order of fees was based on six “red flags” that rendered the case exceptional.³⁷⁶

First, the district court found that, given parallel litigation that had invalidated the patents asserted by Realtime, Realtime should have reconsidered its patent eligibility position in this case.³⁷⁷ The Federal Circuit agreed that this factor was relevant to whether the case warranted attorneys’ fees. But the Federal Circuit held the remaining red flags did not support an award of attorneys’ fees.

The court rejected the second “red flag”—a Federal Circuit case concerning a different, but related, technology—since the claims and limitations at issue in that case were not at issue in this case.³⁷⁸ The same was true of the third red flag—a PTAB decision invalidating the asserted patents—because the PTAB decision did not concern patent eligibility, and therefore did not “put Realtime on notice that its arguments regarding the eligibility of its patent claims were entirely without merit.”³⁷⁹ The Federal Circuit similarly rejected the district court’s fourth red flag—two non-final office actions during *ex parte* reexamination of the asserted patent—because those office actions used a claim construction that the district court itself had rejected.³⁸⁰ The fifth red flag cited by the district court—a notice letter from Dish that included a threat to seek fees—was also improper, according to the Federal Circuit, since providing “notice of adverse case law and the possibility that opposing counsel” would seek fees did not amount to clear notice that the claims pursued by Realtime were invalid.³⁸¹ Finally, the Federal Circuit rejected the district court’s reliance on Dish’s expert, who had testified that the asserted patents were ineligible, since that sort of testimony was “typical of the ordinary, unexceptional patent infringement case” and Realtime had put forth evidence rebutting Dish’s expert.³⁸²

Dragon Intellectual Property LLC v. DISH Network L.L.C., 101 F.4th 1366 (Fed. Cir. May 20, 2024)

In this appeal from the District of Delaware, the Federal Circuit affirmed the district court’s finding that attorney’s fees incurred in IPR proceedings are not recoverable under 35 U.S.C. § 285.³⁸³ Defendants DISH and Sirius XM (“SXM”)

³⁷⁶ *Id.* at 1353-54.

³⁷⁷ *Id.* at 1355.

³⁷⁸ *Id.* at 1356.

³⁷⁹ *Id.* at 1357.

³⁸⁰ *Id.*

³⁸¹ *Id.* at 1358.

³⁸² *Id.* at 1358-59.n

³⁸³ *Dragon Intellectual Property LLC v. DISH Network L.L.C.*, 101 F.4th 1366 (2024).

initiated an IPR, which found that the asserted patents were invalid.³⁸⁴ Even though the IPR proceeded in parallel to litigation at the district court, the Federal Circuit noted that the defendants had “voluntarily pursued” these parallel proceedings and accrued “advantages”—including lower burdens of proof and an expeditious dispute-resolution process—in doing so.³⁸⁵ The court concluded that, “[i]n cases where a party voluntarily elects to pursue an invalidity challenge through IPR proceedings, we see no basis for awarding IPR fees under § 285.”³⁸⁶ The court also noted that, if “cases” under § 285 included IPR proceedings, that would require district court judge to “evaluat[e] the exceptionality of arguments, conduct, and behavior in a proceeding in which they had no involvement,” which does not comport with the level of deference accorded to § 285 findings on exceptionalness.³⁸⁷

In dissent, Judge Bencivengo, sitting by designation, disagreed with the majority’s assertion that the IPR proceedings were “voluntary.”³⁸⁸ Judge Bencivengo observed that the defendants had been “compelled to contest the validity of Dragon’s patents in response to Dragon’s meritless infringement suit,” and, in response, they “exercised their statutory option to litigate their affirmative invalidity defenses in IPR.”³⁸⁹ And because the district court had stayed the invalidity proceedings pending the outcome of the IPR, the IPR effectively “substituted” for district court litigation on invalidity and resulted in the determination that defendants were the prevailing party.³⁹⁰ On exceptionalness, Judge Bencivengo asserted that, since the case was “objectively baseless from its inception,” district courts should have the discretion “to award *all* reasonable fees incurred by the prevailing defendant, including fees incurred in an IPR that resolved any invalidity defenses that were required to be asserted in response to the baseless complaint.”³⁹¹

Judge Bencivengo’s dissent seems clearly correct that the voluntariness of a proceeding does not affect entitlement to attorneys fees.

³⁸⁴ *Id.* at 1369.

³⁸⁵ *Id.* at 1371.

³⁸⁶ *Id.* at 1371.

³⁸⁷ *Id.* 1372.

³⁸⁸ *Id.* at 1374 (Bencivengo, J., dissenting in part).

³⁸⁹ *Id.*

³⁹⁰ *Id.*

³⁹¹ *Id.*

Personal Jurisdiction

SnapRays v. Lighting Defense Group, 100 F.4th 1371 (Fed. Cir. May 2, 2024)

In this appeal from the District of Utah, the Federal Circuit reversed the district court’s dismissal of a declaratory judgment complaint for lack of personal jurisdiction.³⁹² Lighting Defense Group (“LDG”), a Delaware LLC, had used Amazon’s Patent Evaluation Express (“APEX”) program—which allows third-party patent owners to identify infringing listings on Amazon and cause the third parties to be notified—to notify SnapPower, a Utah company, of possibly infringing products.³⁹³ After negotiations between the parties broke down, SnapPower filed a declaratory judgment action, which was dismissed after the district court held that LDG lacked sufficient contacts with Utah.³⁹⁴

The Federal Circuit reversed, holding that LDG, by submitting its request to APEX, “purposefully directed its activities at SnapPower in Utah” because LDG knew that this request would “affect sales and activities in Utah.”³⁹⁵ The court distinguished contrary precedent involving cease and desist letters, observing that the “APEX Agreement goes beyond a cease and desist letter because, absent action by SnapPower in response to the APEX Agreement, SnapPower’s listings would have been removed from Amazon.com,” which would “automatic[ally] . . . affect sales and activities in the forum state.”³⁹⁶ Finally, the Federal Circuit found the exercise of jurisdiction reasonable.³⁹⁷

³⁹² *SnapRays v. Lighting Defense Group*, 100 F.4th 1371 (2024).

³⁹³ *Id.*

³⁹⁴ *Id.* at 1373-74.

³⁹⁵ *Id.* at 1375.

³⁹⁶ *Id.* at 1376.

³⁹⁷ *Id.* at 1378 (“LDG initiated a process that, if SnapPower took no action, would result in SnapPower’s listings being removed from Amazon.com, necessarily affecting sales activities in Utah. LDG has not articulated a compelling argument why it would be unfair or unreasonable for it to be subject to specific personal jurisdiction in Utah under these circumstances.”).

Expert Qualifications

Osseo Imaging, LLC v. Planmeca UCA Inc., ___ F.4th ___, 2024 WL 4031140 (Fed. Cir. Sept. 4, 2024)

In this appeal from the District of Delaware, the Federal Circuit affirmed the district court’s decision finding that a technical expert’s testimony provided substantial evidence to support the jury’s verdict in favor of Osseo Imaging.³⁹⁸ On appeal, Planmeca argued that technical expert’s testimony was infirm because the expert became skilled in the art some years *after* the invention was made, and the expert was not skilled at the time of the invention.³⁹⁹

The Federal Circuit first noted the “unusual” posture of this challenge—an appeal from a Rule 50 motion for judgment as a matter of law—since Planmeca had not litigated a *Daubert* motion nor appealed the relevant evidentiary motions decided adversely to Planmeca at trial.⁴⁰⁰ And, on the merits, the court rejected Planmeca’s attempt “to add a timing requirement” to the minimum qualifications for expert testimony.⁴⁰¹ The court found that this notion—that a technical expert “must possess the requisite ordinary skill in the art ‘at the time of the alleged invention’”⁴⁰²—was unsupported by Federal Circuit precedent and went to credibility, rather than reliability, of the expert’s testimony.⁴⁰³

ParkerVision, Inc. v. Qualcomm Inc., ___ F.4th ___, 2024 WL 4094640 (Fed. Cir. Sept. 6, 2024)

In this appeal from the Middle District of Florida, the Federal Circuit reversed the district court’s decision to exclude ParkerVision’s expert testimony on infringement and vacated the district court’s finding of noninfringement.⁴⁰⁴ The district court had granted Qualcomm’s *Daubert* motion to exclude testimony from ParkerVision’s experts because those experts did not support their opinions with their own independent testing and simulation of the accused products.⁴⁰⁵ This was reversible error, the Federal Circuit held, because the experts considered schematics and technical documents concerning the

³⁹⁸ *Osseo Imaging, LLC v. Planmeca UCA Inc.*, 2024 WL 4031140 (Fed. Cir. Sept. 4, 2024).

³⁹⁹ *Id.* at *2.

⁴⁰⁰ *Id.* at *2.

⁴⁰¹ *Id.* at *3.

⁴⁰² *Id.* (quoting Planmeca’s briefing).

⁴⁰³ *Id.* at *3-4.

⁴⁰⁴ *ParkerVision, Inc. v. Qualcomm Inc.*, 2024 WL 4094640 (Fed. Cir. Sept. 6, 2024).

⁴⁰⁵ *Id.* at *12.

accused products.⁴⁰⁶ Because the experts reasonably relied on information created by others skilled in the art—a methodology that even Qualcomm admitted would be sufficient to form “an accurate understanding”—the court found that there was “neither a factual nor legal basis here for finding that expert testimony is unreliable unless the expert *herself* undertakes to test or simulate the accused products.”⁴⁰⁷

Preemption of State Tort Claims

BearBox LLC v. Lancium LLC, __ F.4th __, 2025 WL 77755 (Fed. Cir. Jan. 13, 2025)

In this appeal from the District of Delaware, the Federal Circuit affirmed the district court’s holding that BearBox’s conversion claim was preempted.⁴⁰⁸ The Federal Circuit framed the inquiry as whether Bearbox’s claims, “as pled,” stand “as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress.”⁴⁰⁹ And because Bearbox’s conversion claim used “patent-like” language, sought remedies akin to those awarded under patent law, and sought to recover for the use of information by Lancium that was in the public domain under the patent laws, the Federal Circuit held that recognizing BearBox’s claim would “offer patent-like protection to intellectual creations [under state law] which would otherwise remain unprotected as a matter of federal law.”⁴¹⁰ Thus, Bearbox’s conversion claim was preempted.⁴¹¹

Sanctions

PS Products Inc. v. Panther Trading Co. Inc., 122 F.4th 893 (Fed. Cir. December 15, 2024)

In this appeal from the Eastern District of Arkansas, the Federal Circuit affirmed the district court’s award of sanctions to Panther both under 35 U.S.C. § 285 and the court’s inherent powers.⁴¹² After finding that PS Products’ infringement allegations were

⁴⁰⁶ *Id.* at *12.

⁴⁰⁷ *Id.* at *12 (emphasis added).

⁴⁰⁸ *BearBox LLC v. Lancium LLC*, 2025 WL 77755, at *1 (Fed. Cir. Jan. 13, 2025).

⁴⁰⁹ *Id.* at *5 (citation omitted).

⁴¹⁰ *Id.* at *5-7 (quoting *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 156 (1989)).

⁴¹¹ *Id.*

⁴¹² *PS Products Inc. v. Panther Trading Co. Inc.*, 122 F.4th 893 (Fed. Cir. 2024).

frivolous, the district court deemed the case “exceptional” under § 285, and further ordered inherent sanctions to “deter” future misconduct.⁴¹³

Applying Eighth Circuit law, the Federal Circuit affirmed the award of deterrence sanctions. First, rejecting PS Products’ argument to the contrary, the court noted that it was “well-settled” that § 285 sanctions do not preclude the issuance of deterrence sanctions under the court’s inherent authority.⁴¹⁴ And the court found that there was sufficient evidence of bad faith to justify deterrence sanctions.⁴¹⁵ The Federal Circuit first observed that PS Products’ claim was utterly baseless—so much so that it could be characterized as a “nuisance suit”—and procedurally flawed since venue was not proper in the Eastern District of Arkansas.⁴¹⁶ And because PS Products had filed dozens of similarly flawed lawsuits, the Federal Circuit found that the district court’s issuance of sanctions was not an abuse of discretion.⁴¹⁷

PTO AND PTAB PROCEDURE

Inter Partes Review Procedure

American Honda Motor Co., Inc. v. Neo Wireless LLC, IPR2023-00797, Paper 27, (PTAB March 22, 2024) (Director Decision)

In this Director review decision, Director Vidal overturned the PTAB’s denial of petitioner Honda’s request for IPR institution.⁴¹⁸ Volkswagen, which was under a court-ordered obligation to coordinate case management with Honda, had filed an earlier IPR concerning the same patent Honda was challenging.⁴¹⁹ Neo, the patent’s owner, argued before the Board that Honda could not institute its own IPR because a “significant relationship” under the *General Plastics/Valve* test existed between Honda and Volkswagen.⁴²⁰ The Board agreed, but Director Vidal explained that a “significant relationship” does not exist between parties that “merely engage in court-ordered pretrial coordination” as long as those parties have “different accused products.”⁴²¹ She therefore

⁴¹³ *Id.* at 897.

⁴¹⁴ *Id.* at 898.

⁴¹⁵ *Id.*

⁴¹⁶ *Id.* at 899.

⁴¹⁷ *Id.* at 900-901.

⁴¹⁸ *American Honda Motor Co., Inc. v. Neo Wireless LLC, IPR2023-00797, Paper 27, (PTAB March 22, 2024) (Director Decision)*.

⁴¹⁹ *Id.*

⁴²⁰ *Id.*

⁴²¹ *Id.*

vacated the Board’s decision and remanded because Honda and Volkswagen were, in fact, accused of having different infringing products.⁴²²

Koninklijke KPN N.V. v. Vidal, 2024 WL 4929541, at *2 (Fed. Cir. Dec. 2, 2024)

In this appeal from the PTAB, the Federal Circuit allowed the PTO to intervene to defend its ruling after the IPR petitioners had withdrawn from the case.⁴²³ The court noted that the PTO, as intervenor, was “relying on” the briefs of the petitioners.⁴²⁴ On the merits, the Federal Circuit affirmed the board’s determination that the asserted claims were obvious.⁴²⁵

DESIGN PATENTS

LKQ Corp. v. GM Glob. Tech. Operations LLC, 102 F.4th 1280 (Fed. Cir. 2024) (*en banc*)

In this appeal from the PTAB, the Federal Circuit, sitting *en banc*, affirmed the PTAB’s novelty determination and vacated the PTAB’s obviousness determination with respect to GM’s design patent claiming the design of a vehicle fender.⁴²⁶

The PTAB had determined, under the *Gorham* “ordinary observer” test⁴²⁷, that the claimed design was not anticipated by prior art due to differences between the designs.⁴²⁸ The original Federal Circuit panel affirmed this finding, and the *en banc* court agreed with that portion of the panel’s holding.⁴²⁹

On obviousness, the PTAB applied the long-standing *Rosen-Durling*⁴³⁰ test, under which a court must first, at the first step, find a single reference that is “basically the same” as the claimed design, and then, at the second step, the court may consider other relevant references that might modify the primary reference to create a substantially similar design—but only if those secondary references are “so related” to the primary reference that they would suggest application of those features to the primary

⁴²² *Id.*

⁴²³ *Koninklijke KPN N.V. v. Vidal*, 2024 WL 4929541, at *2 n.5 (Fed. Cir. Dec. 2, 2024)

⁴²⁴ *Id.*

⁴²⁵ *Id.* at *5.

⁴²⁶ *LKQ Corp. v. GM Glob. Tech. Operations LLC*, 102 F.4th 1280 (Fed. Cir. 2024) (*en banc*). N.B.: Mark Lemley represented LKQ in this appeal.

⁴²⁷ *See Gorham Manufacturing Co. v. White*, 81 U.S. 511 (1871).

⁴²⁸ *LKQ*, 102 F.4th at 1289.

⁴²⁹ *Id.* at 1290.

⁴³⁰ *In re Rosen*, 673 F.2d 388, 391 (CCPA 1982); *Durling v. Spectrum Furniture Co., Inc.*, 101 F.3d 100, 103 (Fed. Cir. 1996).

reference.⁴³¹ The Federal Circuit panel reviewing the PTAB decision affirmed, rejecting LKQ’s argument that *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) overruled the *Rosen-Durling* test.⁴³²

Sitting en banc, the Federal Circuit agreed with LKQ and overruled the *Rosen-Durling* test.⁴³³ The court observed that the first step in *Rosen-Durling*’s rigid approach—one that effectively ends the analysis unless there is a primary reference that is “basically the same” as what is claimed—was out of step both with *KSR* and with *Smith v. Whitman Saddle Co.*,⁴³⁴ an 1893 Supreme Court case analyzing obviousness in the design patent context.⁴³⁵ The second step of the test—which requires that a secondary reference be “so related” to the primary reference that it creates its own motivation to combine the references—was similarly contrary to *KSR* and *Whitman*.⁴³⁶

Having overruled *Rosen-Durling*, the en banc court then set forth a new test based on *Graham v. John Deere Co.*⁴³⁷ for obviousness in the design patent context.⁴³⁸

For the first factor of the *Graham* analysis (scope and content of the prior art), the court instructed that all “analogous art” should be considered a prior art reference.⁴³⁹ While the court declined to specify the full contours of the “analogous art” test, it noted, at a minimum, that “art from the same field of endeavor as the article of manufacture of the claimed design” would be included, while leaving open the possibility that other art could be analogous.⁴⁴⁰

For the second factor of the *Graham* analysis (differences between prior art and the claimed design), the test involves “compar[ing] the visual appearance of the claimed design with prior art designs, albeit from the perspective of an ordinary designer in the field of the article of manufacture.”⁴⁴¹

And for the third *Graham* factor (level of skill), the relevant inquiry is the knowledge of “a designer of ordinary skill who designs articles of the type involved.”⁴⁴²

⁴³¹ *LKQ*, 102 F.4th at 1289.

⁴³² *Id.* at 1290.

⁴³³ *Id.* at 1295.

⁴³⁴ 148 U.S. 674 (1893)

⁴³⁵ *LKQ*, 102 F.4th at 1294.

⁴³⁶ *Id.* at 1295.

⁴³⁷ 383 U.S. 1 (1966).

⁴³⁸ *LKQ*, 102 F.4th at 1295.

⁴³⁹ *Id.* at 1296.

⁴⁴⁰ *Id.* at 1297.

⁴⁴¹ *Id.* at 1298.

⁴⁴² *Id.* at 1299 (citation omitted).

In applying these factors, the ultimate inquiry is whether “ordinary designer[s] in the field to which the claimed design pertains would have been motivated to modify the prior art design ‘to create the same overall visual appearance as the claimed design,’ though the motivation need not come from the references themselves.⁴⁴³ Secondary considerations remain relevant in this inquiry, though the court declined to hold whether certain secondary considerations from the utility patent context were relevant in the design patent context.⁴⁴⁴

The court thus vacated the PTAB’s decisions and remanded for the PTAB to apply the new obviousness test.⁴⁴⁵

⁴⁴³ *Id.* at 1299 (citation omitted).

⁴⁴⁴ *Id.* at 1300.

⁴⁴⁵ *Id.* at 1301.