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I. Patentability Requirements

A. Inventorship/Invention and Priority Dates

1. Priority from Previous Applications

a. Section 120

“[A] claim for benefit of the filing date of an earlier application must include ‘a specific reference to [an] earlier filed application.’ 35 U.S.C. § 120. We agree with the Board that incorporation by reference cannot satisfy this statutory requirement.” *Droplets, Inc. v. E*Trade Bank*, 2016-2504, 4/19/18.

2. Coinventorship/Joint Inventors

Because substantial evidence “supports the Board’s determinations that Lamb contributed the idea of the figure eight loop and that the figure eight loop is an essential feature of the invention not insignificant in quality or well-known in the art . . . , we conclude that Lamb is a joint inventor.” *In re VerHoef*, 2017-1976, 5/3/18.

B. Prior Art Invalidity

1. Reference Disclosure

“On the question of what [the prior art reference] teaches, which is a factual question, *see, e.g., In re Fulton*, 391 F.3d 1195, 1199–200 (Fed. Cir. 2004), we conclude that the Board’s finding rests on a reasonable reading of [the prior art reference].” *PGS Geophysical AS v. Iancu*, 2016-2470, 6/7/18.

a. Inherency

i. Information/Printed Matter Limitations

“Claim limitations directed to the content of information and lacking a requisite functional relationship are not entitled to patentable weight because such information is not patent eligible subject matter under 35 U.S.C. § 101.” *Praxair Distrib., Inc. v. Mallinckrodt Hosp. Prods. IP Ltd.*, 2016-2616, 5/16/18.

Printed matter doctrine applies to “information together with a purely mental step.” *Praxair Distrib., Inc. v. Mallinckrodt Hosp. Prods. IP Ltd.*, 2016-2616, 5/16/18.

“By interrelating the claimed information . . . with the concrete step of discontinuing treatment because of the information, . . . the printed matter in claim 9 has a functional relationship to the rest of the claim and giving the printed matter patentable weight.” *Praxair Distrib., Inc. v. Mallinckrodt Hosp. Prods. IP Ltd.*, 2016-2616, 5/16/18.

b. Incorporation

“Taken together, 37 C.F.R. §§ 1.57(c) and (d) define information—essential and other (nonessential) material, respectively—that can be incorporated by reference into an application.” *Droplets, Inc. v. E*Trade Bank*, 2016-2504, 4/19/18.

c. Combining/Identifying separate embodiments in a reference

“We see no error in this case from the Board’s use of a reference’s background to furnish context for how a skilled artisan would understand the reference’s disclosed embodiments.” *WesternGeco LLC v. Ion Geophysical Corp.*, 889 F.3d 1308 (Fed. Cir. 2018), 2016-2099, 5/7/18.

2. Anticipation (Section 102)

a. Mirrors Infringement

i. Comparing Prior Art to Disclosed Embodiment

PTAB’s patentability conclusion for claim 1 reversed without interpretation or application of claim limitations based on identification of shared disclosure between prior art and application at issue and the assertion that “Claim 1 of the ’408 patent is directed to the shared disclosure; any differences in the disclosures are not in claim 1.” *Ericsson Inc. v. Intellectual Ventures I LLC*, 2016-1671, 5/29/18.

b. Publications/Patents

i. Dissemination

“The parties here do not allege that the Video and Slides were stored somewhere for public access after the conferences. Thus, the question becomes whether such materials were sufficiently disseminated at the time of their distribution at the conferences.” *Medtronic, Inc. v. Barry*, 2017-1169, 6/11/18.

“[T]he size and nature of the meetings and whether they are open to people interested in the subject matter of the material disclosed are important considerations. Another factor is whether there is an expectation of confidentiality between the distributor and the recipients of the materials.” *Medtronic, Inc. v. Barry*, 2017-1169, 6/11/18.

“Distributing materials to a group of experts, does not, without further basis, render those materials publicly accessible or inaccessible, simply by virtue of the relative expertise of the recipients. The nature of those meetings, as well as any restrictions on public disclosures, expectations of confidentiality, or, alternatively, expectations of sharing the information gained, can bear important weight in the overall inquiry.” *Medtronic, Inc. v. Barry*, 2017-1169, 6/11/18.

c. Prior Art by Admission

“A post-issuance statement regarding a single element of a claimed invention does not establish invalidity” *Stone Basket Innovations, LLC v. Cook Med. LLC*, 2017-2330, 6/11/18.

3. Obviousness (§ 103)

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

i. Prior Art is Genus of Claimed Species

“Where a prior art patent discloses a range of values, showing a claimed value falls within that range meets a party’s burden of establishing the narrower claim would have been obvious where there is no reason to think the result would be unpredictable.” *Gen. Hosp. Corp. v. Sienna Biopharm., Inc.*, 2017-1012, 5/4/18.

ii. Undisclosed Elements and Dependent Claims

“[B]ecause the court’s nonobviousness decision applied commonly to all of the challenged claims, the court did not and needed not make separate decisions on the validity of the claims at issue.” *Impax Labs., Inc. v. Lannett Holdings Inc.*, 2017-2020, 6/28/18.

iii. All Limitations Disclosed

“The Board found that one of ordinary skill in the art would have been motivated to modify Workman’s control system to implement a feather angle mode threshold parameter and would have had a reasonable expectation of success.” “Although Workman does not disclose a feather angle, the Board credited passages from Workman and expert testimony that explained why one of skill in the art would want to control and maintain consistent separations between streamers during seismic surveys.” “The Board also explained why prescribing a specific offset “feather angle” value to the streamers’ positioning determination system would have been apparent to one of skill in the art confronting the challenge of towing streamers through cross-currents.” “Viewed collectively, substantial evidence supports the Board’s conclusion that the skilled artisan would have been motivated to modify Workman to include a feather angle threshold parameter with a reasonable expectation of success.” *WesternGeco LLC v. Ion Geophysical Corp.*, 889 F.3d 1308 (Fed. Cir. 2018), 2016-2099, 5/7/18.

iv. New Use of Known Instrumentality

“Where the patent is directed to a new treatment using a known compound, it is reasonable to assume that similar compounds that share certain common properties are apt to share other related properties as well.” *Anacor Pharm., Inc. v. Iancu*, 2017-1947, 5/14/18.

b. Reasonable Expectation of Success

“Appellants argue that this presumption [of enablement for claimed species] establishes a reasonable expectation of success as a matter of law. We disagree. Appellants do not cite any authority for the proposition that the presumption of an enabled genus of compounds precludes the district court from finding that there was no reasonable expectation of success of creating a species falling within that genus.” *UCB, Inc. v. Accord Healthcare, Inc.*, 2016-2610, 5/23/18.

c. Secondary Indicia of Nonobviousness

i. Commensurate with Claim Scope

Secondary consideration linked only to information limitation found to have no weight. *Praxair Distrib., Inc. v. Mallinckrodt Hosp. Prods. IP Ltd.*, 2016-2616, 5/16/18.

ii. Commercial Success

Substantial evidence that commercial success evidence lacked nexus when “[patentee] has not shown that the driving force behind the product sales was a direct result of the unique characteristics of the claimed inventions.” *WesternGeco LLC v. Ion Geophysical Corp.*, 889 F.3d 1308 (Fed. Cir. 2018), 2016-2099, 5/7/18.

iii. Licensing

Adequate nexus even though other patents were licensed in the same agreement. *Impax Labs., Inc. v. Lannett Holdings Inc.*, 2017-2020, 6/28/18.

d. Chemical Compounds

i. Lead Compound Analysis

“A lead compound analysis is not required in analyzing obviousness of a chemical compound when, in the inventing process, there was no lead compound.” “And an obviousness rejection by an examiner, or a challenge in court, may be based on the closest prior art, which may not have been a lead compound that the inventor had in mind.” *UCB, Inc. v. Accord Healthcare, Inc.*, 2016-2610, 5/23/18.

C. Invalidity Based on § 112

1. Written Description (§ 1)

a. Genus Disclosure Supporting Sub-Genus or Species Claim

“The disclosure of a broad range of values does not by itself provide written description support for a particular value within that range. Instead, where a specification discloses a broad range of values and a value within that range is claimed, the disclosure must allow

one skilled in the art to “immediately discern the limitation at issue in the claims.”” *Gen. Hosp. Corp. v. Sienna Biopharm., Inc.*, 2017-1012, 5/4/18.

b. Species Disclosure Supporting Genus Claim

New claims covering “washerless assemblies using attachments other than . . . W[-]shaped prongs” lacked written description in an earlier application, because that “2009 Application in no way contemplates the use of other types of attachment brackets in a washerless assembly.” “[B]oilerplate language at the end of the 2009 Application’s specification is not sufficient to show adequate disclosure of the actual combinations and attachments used in the Washerless Claims.” *D Three Enters., LLC v. SunModo Corp.*, 2017-1909, 5/21/18.

D. Double Patenting

1. Obviousness-Type

“[T]he district court did not err by focusing its double patenting analysis on the claims’ differences, as well as the claims as a whole.” *UCB, Inc. v. Accord Healthcare, Inc.*, 2016-2610, 5/23/18.

“The second part of this analysis is analogous to the obviousness inquiry under 35 U.S.C. § 103 in the sense that if an earlier claim . . . *anticipates* a later claim, the later claim is not patentably distinct and is thus invalid for obviousness-type double patenting.” *UCB, Inc. v. Accord Healthcare, Inc.*, 2016-2610, 5/23/18 (emphasis added).

E. Section 101

1. Found in Nature/Preemption of Natural Phenomenon

Claims are not directed to a law of nature where “claims are directed to a method of using [a substance] to treat [a disease]. The inventors recognized the relationships between [the substance], [a particular] metabolism, and [a therapeutic result], but that is not what they claimed. They claimed an application of that relationship.” *Vanda Pharm. Inc. v. West-Ward Pharm. Int’l Ltd.*, 2016-2707, 4/13/18.

2. Abstract Idea Exclusion

“Their subject is nothing but a series of mathematical calculations based on selected information and the presentation of the results of those calculations (in the plot of a probability distribution function). No matter how much of an advance in the finance field the claims recite, the advance lies entirely in the realm of abstract ideas, with no plausibly alleged innovation in the non-abstract application realm. An advance of that nature is ineligible for patenting.” *SAP Am., Inc. v. InvestPic, LLC*, 2017-2081, 5/15/18.

“[I]t does not matter to this conclusion whether the information here is information about real investments.” *SAP Am., Inc. v. InvestPic, LLC*, 2017-2081, 5/15/18.

Claims that are “drawn to the concept of” a three step activity performed for hundreds of years and described by the patentee as “human cognitive actions,” are directed to an abstract idea. *Voter Verified, Inc. v. Election Sys. & Software LLC*, 2017-1930, 4/20/18.

“We agree . . . that *Alice* was not an intervening change in the law, so that it does not exempt a potential application of issue preclusion.” *Voter Verified, Inc. v. Election Sys. & Software LLC*, 2017-1930, 4/20/18.

3. Stage of Case for Determination

a. Motion to Dismiss

“Like other legal questions based on underlying facts, this question may be, and frequently has been, resolved on a Rule 12(b)(6) or (c) motion where the undisputed facts, considered under the standards required by that Rule, require a holding of ineligibility under the substantive standards of law.” *SAP Am., Inc. v. InvestPic, LLC*, 2017-2081, 5/15/18.

II. Other Defenses

A. Equitable Estoppel

1. Misleading Communication

“Because the asserted claims in this action were substantively amended or added following ex parte reexamination in 2014, and the plaintiff only sought damages for infringement of the reexamined claims, the district court abused its discretion in finding equitable estoppel based on activity beginning in 2002, twelve years prior to the issuance of the reexamination certificate.” *John Bean Techs. Corp. v. Morris & Assocs., Inc.*, 2017-1502, 4/19/18.

2. Summary Judgment

“A grant of summary judgment that equitable estoppel bars an infringement action is reviewed in two steps. First, we review de novo whether the district court erred in finding no genuine issues of material fact exist. Second, we review the district court’s application of equitable estoppel for abuse of discretion.” *John Bean Techs. Corp. v. Morris & Assocs., Inc.*, 2017-1502, 4/19/18 (citations omitted).

B. Lack of Subject Matter Jurisdiction

1. Standing (see also II.H)

a. Incorrect Inventorship

“[Plaintiff] alleges that he is the sole inventor of the inventions claimed in the [] patent, that sole inventorship entails sole ownership, and that 35 U.S.C. § 256 gives him a cause of action to establish sole inventorship and therefore sole ownership. [] In the absence of

other facts, that is enough to give [plaintiff] Article III standing.” *James v. j2 Cloud Services, LLC*, 2017-1506, 4/20/18.

2. Declaratory Judgment Jurisdiction

a. Controversy of “sufficient immediacy and reality” based on the “totality of the circumstances”

i. Future Lapse of Exclusivity Rights

“[T]he time consumed by litigation of a speculative future controversy does not provide the “immediacy and reality” required for declaratory judgment actions.” *AIDS Healthcare Found. v. Gilead Scis., Inc.*, 2016-2475, 5/11/18.

b. Present Activity/Concrete Steps Toward

“The uncertainty of whether future infringement might occur at all weighs against the immediacy and reality requirement of declaratory action.” *AIDS Healthcare Found. v. Gilead Scis., Inc.*, 2016-2475, 5/11/18.

c. Covenant not to Sue

“[T]he absence of a covenant not to sue infringers did not create a justiciable case or controversy.” *AIDS Healthcare Found. v. Gilead Scis., Inc.*, 2016-2475, 5/11/18.

3. ANDA-Based Complaints

Court found subject matter jurisdiction where “the asserted patent issued after the ANDA was filed and the complaint was filed before the ANDA applicant submitted a Paragraph IV certification for the asserted patent.” *Vanda Pharm. Inc. v. West-Ward Pharm. Int’l Ltd.*, 2016-2707, 4/13/18.

“The mere fact that [the accused infringer] had not submitted a Paragraph IV certification for the [asserted] patent until after [the patentee] filed suit does not establish that there was not a justiciable controversy over which the court could exercise jurisdiction.” *Vanda Pharm. Inc. v. West-Ward Pharm. Int’l Ltd.*, 2016-2707, 4/13/18.

C. Lack of Personal Jurisdiction

1. Over Accused Infringer

a. Due Process for Specific Jurisdiction

“[T]he parties only dispute . . . whether exercise of personal jurisdiction . . . comports with due process.” “[W]e apply a three-part test considering whether: (1) the defendant purposefully directed its activities at residents of the forum; (2) the claim arises out of or relates to the defendant’s activities with the forum; and (3) assertion of personal jurisdiction is reasonable and fair.” “The plaintiff bears the burden as to the first two

requirements, and if proven, the burden then shifts to the defendant to “present a compelling case that the presence of some other considerations would render jurisdiction unreasonable.” *M-I Drilling Fluids U.K. Ltd. v. Dynamic Air Ltda.*, 2016-1772, 5/14/18, (quoting *Burger King Corp. v. Rudzewicz*, 471 U.S. 462, 477 (1985)).

“Here, it is undisputed that [defendant] installed [accused] systems on [ships] then deliberately continued to engage in the allegedly infringing activities aboard the ships even after [patentee] had cautioned [defendant] that its systems infringed the asserted patents. Nothing more is required to show that DAL purposefully directed its activities at the United States.” *M-I Drilling Fluids U.K. Ltd. v. Dynamic Air Ltda.*, 2016-1772, 5/14/18 (record citations omitted).

D. Improper Venue

“[A] domestic corporation incorporated in a state having multiple judicial districts “resides” for purposes of the patent-specific venue statute, 28 U.S.C. § 1400(b), only in the single judicial district within that state where it maintains a principal place of business, or failing that, the judicial district in which its registered office is located.” *In re BigCommerce, Inc.*, 18-120, 5/15/18.

“[T]he burden of persuasion question is a substantive aspect of § 1400(b), whose interpretation is governed by our law, not of § 1406, the general improper-venue statute.” “[U]pon motion by the Defendant challenging venue in a patent case, the Plaintiff bears the burden of establishing proper venue.” *In re ZTE (USA) Inc.*, 2018-113, 5/15/18.

1. Foreign Entities

“With the Supreme Court having spoken on this issue twice, this court—without clear guidance from Congress— will not broadly upend the well-established rule that suits against alien defendants are outside the operation of the federal venue laws.” *In re HTC Corp.*, 2018-130, 5/9/18.

2. Appeal

“Specifically, if after judgment venue is determined to have been improper, and the improper-venue objection was not waived, the appellants “will be entitled to assert it on appeal and, if the objection is sustained, obtain from [the appeals] court an order vacating the judgment . . . and directing the remand of the action to the [appropriate venue].”” *In re HTC Corp.*, 2018-130, 5/9/18 (citing 3d and 7th circuit cases and a S.Ct. case).

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

1. Assignment

a. Employment Agreements

Agreement language stating that employee “will develop software solutions for the exclusive use of” employer was “not itself a conveyance of any rights.” *James v. j2 Cloud Services, LLC*, 2017-1506, 4/20/18.

“Further support for [plaintiff]’s view [that the employment agreement did not assign or obligate him to assign inventions] is found in the [employment agreement]’s express reference to copyrights and complete silence about patents.” *James v. j2 Cloud Services, LLC*, 2017-1506, 4/20/18.

2. Hired to Invent Doctrine

There is a “general legal principle that tightly limits the finding of an implied-in-fact contract where an express contract governs the parties’ relationship.” *James v. j2 Cloud Services, LLC*, 2017-1506, 4/20/18.

“Whether the [hired to invent] doctrine is viewed as a matter of federal law or a matter of the state law of implied-in-fact contracts, its applicability in a given case depends on the terms of the contractual relationship of the parties.” *James v. j2 Cloud Services, LLC*, 2017-1506, 4/20/18.

F. Unclean Hands/Sanctions

CAFC “review[s] the district court’s ruling for abuse of discretion, which means that we review factual findings only for clear error.” Unclean hands defense affirmed because “the ‘immediate and necessary relation’ standard, in its natural meaning, generally must be met if the conduct normally would enhance the claimant’s position regarding legal rights that are important to the litigation if the impropriety is not discovered and corrected.” *Gilead Sciences, Inc. v. Merck & Co.*, 2016-2302, 4/25/18.

Unclean hands as to one patent found to infect the other asserted patent that had the same specification. *Gilead Sciences, Inc. v. Merck & Co.*, 2016-2302, 4/25/18.

III. Literal Infringement

“Consequently, either an invalidity or a noninfringement determination is sufficient for a final judgment holding that a party is not liable for infringement.” *Voter Verified, Inc. v. Election Sys. & Software LLC*, 2017-1930, 4/20/18.

A. Indirect Infringement

a. ANDA Application

An ANDA plaintiff “can satisfy its burden to prove the predicate direct infringement by showing that if the proposed ANDA product were marketed, it would infringe the [asserted] patent.” *Vanda Pharm. Inc. v. West-Ward Pharm. Int’l Ltd.*, 2016-2707, 4/13/18.

B. Infringement by Foreign Acts

1. Offers to Sell

“Evidence of domestic negotiations and testing of some of [defendant]’s products does not demonstrate “substantial activities regarding sales” sufficient to raise a material dispute of fact as to sales or offers to sell in the United States.” Summary judgment appropriate where “the undisputed facts show manufacture, packaging, and testing abroad, and shipping of the units to locations abroad.” *Tex. Advanced Optoelec. Sols., Inc. v. Renesas Elecs. Am., Inc.*, 2016-2121, 5/1/18.

2. Sales

Evidence of domestic negotiations and testing of some of [defendant]’s products does not demonstrate “substantial activities regarding sales” sufficient to raise a material dispute of fact as to sales or offers to sell in the United States.” Summary judgment appropriate where “the undisputed facts show manufacture, packaging, and testing abroad, and shipping of the units to locations abroad.” *Tex. Advanced Optoelec. Sols., Inc. v. Renesas Elecs. Am., Inc.*, 2016-2121, 5/1/18.

C. Direct Infringement of a Claimed Process

1. Products that Occasionally Perform a Patented Process

Denial of noninfringement JMOL for method (not apparatus) claims reversed where evidence showed that “default mode of the chip is noninfringing” and “no evidence presented at trial that any of [defendant]’s products in fact operate in [mode accused of infringing].” *Tex. Advanced Optoelec. Sols., Inc. v. Renesas Elecs. Am., Inc.*, 2016-2121, 5/1/18.

D. Capability

“Although infringement of the apparatus claims requires that [defendant]’s products have the ability to perform in [an infringing mode], infringement does not require actual use of [defendant]’s products in [an infringing mode].” *Tex. Advanced Optoelec. Sols., Inc. v. Renesas Elecs. Am., Inc.*, 2016-2121, 5/1/18.

E. Standard of Proof/Review

1. ANDA Infringement

“Thus, amendments to an ANDA, including a Paragraph IV certification for a later-issued patent, can constitute an act of infringement under § 271(e)(2)(A).” *Vanda Pharm. Inc. v. West-Ward Pharm. Int’l Ltd.*, 2016-2707, 4/13/18.

“Here, the district court found that the proposed label itself recommends infringing acts. Accordingly, even if the proposed ANDA product has “substantial noninfringing uses,” [the ANDA filer] may still be held liable for induced infringement.” *Vanda Pharm. Inc. v. West-Ward Pharm. Int’l Ltd.*, 2016-2707, 4/13/18.

IV. Relief

A. Attorneys’ fees

1. Exceptional Case (§ 285)

a. Prevailing Party

“The relevant inquiry post-*CRST*, then, is not limited to whether a defendant prevailed on the merits, but also considers whether the district court’s decision—‘a judicially sanctioned change in the legal relationship of the parties’—effects or rebuffs a plaintiff’s attempt to effect a “material alteration in the legal relationship between the parties.”” *Ranieri v. Microsoft Corp.*, 2017-1400, 4/18/18 (quoting *CRST*, 136 S. Ct. at 1646, 1651).

“The district court’s dismissal with prejudice of [patentee]’s action gave Appellees the full relief to which they were legally entitled. . . . This suffices to make Appellees ‘prevailing parties.’” *Ranieri v. Microsoft Corp.*, 2017-1400, 4/18/18.

b. Baseless Claims

Proper for District Court to consider defendant’s “failure to send any communication to [plaintiff] that highlighted and set out with precision the specific invalidity argument,” in deciding whether case was unusually weak. *Stone Basket Innovations, LLC v. Cook Med. LLC*, 2017-2330, 6/11/18.

“Having been issued a valid patent, [plaintiff] was entitled to a presumption of good faith in asserting its patent rights against [defendant] in the form of a suit for infringement. . . . [defendant]’s invalidity contentions, based on prior art already considered by the Examiner and with no further explanation, do not make the substantive strength of [plaintiff]’s position exceptional.” *Stone Basket Innovations, LLC v. Cook Med. LLC*, 2017-2330, 6/11/18.

“A post-issuance statement regarding a single element of a claimed invention does not establish invalidity” *Stone Basket Innovations, LLC v. Cook Med. LLC*, 2017-2330, 6/11/18.

c. Inequitable Conduct

“[A] district court must articulate a basis for denying attorneys’ fees following a finding of inequitable conduct.” *Marathon Oil Co. v. Heat On-The-Fly, LLC*, 2016-1559, 5/4/18.

B. Injunction

1. Permanent Injunction

i. Type of Damages Sought

“A patent owner’s request for relief in the form of a reasonable royalty may be relevant to [irreparable harm and inadequacy of compensation], but it is not conclusive without further analysis.” *Tex. Advanced Optoelec. Sols., Inc. v. Renesas Elecs. Am., Inc.*, 2016-2121, 5/1/18.

C. Reasonable Royalty

1. Expert Testimony and Methodology

a. Reliance on Technical Expert

Affirmed based on reliance on “Dr. Madisetti, who stated that the patents “are fundamental to the provision of PoE under the standards” and “relate to the majority and the most critical aspects of the standard”; that “the standards would not be successful without Chrimar’s inventions”; and that “the standards would not have gained widespread adoption without Chrimar’s patented inventions.”” *Chrimar Holding Co. v. ALE USA, Inc.*, 2017-1848, 5/8/18 (nonprecedential).

2. Post Verdict Sales/Ongoing Royalties

“Although district courts may award a lower ongoing royalty rate if economic factors have changed in the infringer’s favor post-verdict—for example, if a newly developed non-infringing alternative takes market share from the patented products—the district court identified no economic factors that would justify the imposition of rates that were lower than the jury’s.” *XY, LLC v. Trans Ova Genetics, L.C.*, 2016-2610, 5/23/18.

D. Multiple Claims or Patents

“Given the (affirmed) judgment of infringement of the ’107 and ’760 patents, the absence of an infringement judgment on the ’012 patent is immaterial to damages because any damages that would result from the alleged infringement of the ’012 patent also results from the infringement of the ’107 and ’760 patents.” *Chrimar Holding Co. v. ALE USA, Inc.*, 2017-1848, 5/8/18 (nonprecedential).

V. Claim Construction

A. Claim Language

1. Section 112, paragraph 6

a. When Applied

“That determination must be made under the traditional claim construction principles, on an element-by-element basis, and in light of evidence intrinsic and extrinsic to the asserted patents.” *Zeroclick, LLC v. Apple Inc.*, 2017-1267, 6/1/18.

i. Evidentiary Impact of Presumption

Where a party argues to overcome the presumption resulting from no use of the word means, but offers “no evidentiary support for that position” it “failed to carry its burden, and the presumption against the application of § 112, ¶ 6 to the disputed limitations remained unrebutted.” *Zeroclick, LLC v. Apple Inc.*, 2017-1267, 6/1/18.

2. Effect of Other Limitations in Claim

a. No Surplusage

“If the term “pharmaceutically acceptable” impliedly included the information regarding the relationship between inhaled nitric oxide, LVD, and side effects like pulmonary edema, there would have been no need to explicitly recite that information later in the claim.” *Praxair Distrib., Inc. v. Mallinckrodt Hosp. Prods. IP Ltd.*, 2016-2616, 5/16/18.

B. Written Description

1. Lexicography

a. Insufficient Definition

Adding “automatic” to the construction of “control mode” rejected when “[i]n deed, the words “automated” and “automatic” do not appear anywhere in the claims or the written description addressing “control mode.” *WesternGeco LLC v. Ion Geophysical Corp.*, 889 F.3d 1308 (Fed. Cir. 2018), 2016-2099, 5/7/18.

b. Definition by Intrinsic Use

“[T]he Board properly construed “about” to mean “within 10%.” “Although the specification and prosecution history of the ’941 patent do not expressly define “about,” the Board considered Dr. Tao’s testimony that a range of 10% is consistent with the use of the word “about” in the ’941 specification.” *Gen. Hosp. Corp. v. Sienna Biopharm., Inc.*, 2017-1012, 5/4/18.

2. Disclosed Embodiment(s)

a. Presumption of Claim Coverage

i. Multiple Embodiments

“The specification describes one embodiment []. Knowles’s proffered construction would improperly read this embodiment out of the patent.” *Knowles Elecs. LLC v. Iancu*, 2016-1964, 4/6/18.

b. Limitations from Sole Embodiment

“Compound No. 101 just happens to be the only other place in the patent where claim 14’s structure appears. This, of course, is not enough to restrict a claim’s scope.” *Sumitomo Dainippon Pharma Co. v. Emcure Pharm. Ltd.*, 2017-1798, 4/16/18.

C. Extrinsic Evidence

1. Dictionaries

“The PTAB found the use of the phrase “in general” [in a dictionary definition] “permits for possible exceptions” because it describes integrated packages in a non-limiting fashion. . . . We find that the PTAB’s interpretation of this piece of extrinsic evidence is reasonable.” *Knowles Elecs. LLC v. Iancu*, 2016-1964, 4/6/18.

D. Timing of Construction and Parties’ Positions

1. Agreed and Proposed Constructions

“Moreover, the Board is not bound to adopt either party’s preferred articulated construction of a disputed claim term.” *WesternGeco LLC v. Ion Geophysical Corp.*, 889 F.3d 1308 (Fed. Cir. 2018), 2016-2099, 5/7/18.

E. Limited and Ordinary Meaning Constructions

1. Impermissibly Vague Construction

Not “proper to read limitations . . . into the term” when “so injecting [that limitation] to the construction adds nothing meaningful.” *WesternGeco LLC v. Ion Geophysical Corp.*, 889 F.3d 1308 (Fed. Cir. 2018), 2016-2099, 5/7/18.

VI. Unenforceability

A. Material Information

1. Omissions

a. Information concerning sales

Inequitable conduct affirmed where “[inventor] admitted at trial that he and his companies used water-heating systems containing all the elements of claim 1 on at least 61 frac jobs before the critical date.” *Marathon Oil Co. v. Heat On-The-Fly, LLC*, 2016-1559, 5/4/18.

2. The “But for” Standard

“[T]he PTO’s treatment of the continuation patent is factually irrelevant because the continuation patent’s claims materially differ from the [asserted] patent’s claims.” *Marathon Oil Co. v. Heat On-The-Fly, LLC*, 2016-1559, 5/4/18.

VII. Procedural Law

A. Preclusion

1. Issue Preclusion - Collateral Estoppel

a. Same Issue of Law or Fact Necessary to Judgment

Even where a conclusion in favor of plaintiff on section 101 invalidity was stated in the final judgment, CAFC concluded that it was not necessary to that judgment because the judgment also included noninfringement and the section 101 issue had not been litigated. *Voter Verified, Inc. v. Election Sys. & Software LLC*, 2017-1930, 4/20/18.

b. Actually Litigated to Final Judgment

Section 101 not actually litigated where accused infringer “[chose] not to respond to [patentee]’s arguments against its § 101 invalidity counterclaim.” *Voter Verified, Inc. v. Election Sys. & Software LLC*, 2017-1930, 4/20/18.

B. Jury Issues

1. Right to a Jury Trial

a. Disgorgement of Profits Relief

“We conclude, therefore, that [plaintiff] has no right to a jury decision on its request for disgorgement of [defendant]’s profits as a remedy for trade secret misappropriation.” *Tex. Advanced Optoelec. Sols., Inc. v. Renesas Elecs. Am., Inc.*, 2016-2121, 5/1/18.

2. Verdict Form

a. Interaction with Instructions

Jury verdict upheld because it was understandable in view of jury instructions even if it was not on its own. *XY, LLC v. Trans Ova Genetics, L.C.*, 2016-2610, 5/23/18.

C. Privilege and Attorney/Client Issues

1. Scope and Availability of Waiver

“[T]he district court did not abuse its discretion in excluding [attorney]’s testimony. The attorney-client privilege cannot be used as both a sword and a shield. [Client] was the one who asserted the attorney-client privilege in the first instance and was also the one who failed to follow up later by deposing or otherwise making [attorney] available for examination prior to trial. [Client] cannot have it both ways. Accordingly, we conclude that the district court did not abuse its discretion in excluding this evidence on [Client]’s advice of counsel defense.” *Marathon Oil Co. v. Heat On-The-Fly, LLC*, 2016-1559, 5/4/18.

D. JMOL (Rule 50) / Summary Judgment (Rule 56)

1. Pre-Verdict JMOL Requirements

“[W]hen [appellant] raised the issue at the Rule 50(b) stage, [appellee] did not make, and thus waived, any argument that [appellant] had waived the issue at the 50(a) stage.” *Tex. Advanced Optoelec. Sols., Inc. v. Renesas Elecs. Am., Inc.*, n. 5, 2016-2121, 5/1/18.

2. New Trial Granted on Rule 50 Motion

“A new trial of limited scope may be a proper form of relief on a motion for judgment as a matter of law.” *Tex. Advanced Optoelec. Sols., Inc. v. Renesas Elecs. Am., Inc.*, 2016-2121, 5/1/18.

E. Preemption

Tortious interference not preempted where there was substantial evidence that the interfering accusation of infringement included assertion of validity despite inequitable conduct in not submitting prior sales information to the PTO. *Marathon Oil Co. v. Heat On-The-Fly, LLC*, 2016-1559, 5/4/18.

F. Pleadings/Parties

1. 12(b)(6) Dismissals

“This case involves a simple technology. The asserted patents, which were attached to the complaint, consist of only four independent claims. The complaint specifically identified the three accused products—by name and by attaching photos of the product

packaging as exhibits—and alleged that the accused products meet “each and every element of at least one claim of the ’113 [or ’509] Patent, either literally or equivalently.” “These disclosures and allegations are enough to provide [defendant] fair notice of infringement of the asserted patents.” *Disc Disease Sols., Inc. v. VGH Sols., Inc.*, 2017-1483, 5/1/18.

G. Discovery/Evidence

1. Adequate Objections

“[A first witness]’s testimony was properly objected to and thus could not be admitted for the truth of the matter asserted. [The offering party], however, also called [a second witness], who testified that, according to [a third party], [an employee of the opposing party] had mentioned the patent to [the third party]. [The opposing party] did not object to [the second witness]’s testimony. Thus, the jury properly heard and considered his testimony for the truth of the matter asserted.” *Marathon Oil Co. v. Heat On-The-Fly, LLC*, 2016-1559, 5/4/18.

VIII. Federal Circuit Appeals

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

1. District Court/ITC Appeals

“[Appellant]’s invalidity arguments relying on [two references], which were not raised or developed either before the district court or on appeal in its opening brief, are waived.” *Impax Labs., Inc. v. Lannett Holdings Inc.*, 2017-2020, 6/28/18.

a. Arguments Regarding Summary Judgment or JMOL

Theory in support of verdict waived based on statements offering a different theory in opening, closing and the presentation of the issue in the jury instruction. *Tex. Advanced Optoelec. Sols., Inc. v. Renesas Elecs. Am., Inc.*, 2016-2121, 5/1/18.

b. New Argument Regarding Issue That Was Raised

“[The accused infringer] waived its written description challenge with respect to non-poor metabolizers by failing to properly present it to the trial court.” “[The accused infringer] points only to a single page in each of its opening and reply post-trial briefs to support its claim that this issue is not waived. Those pages make passing reference to the dosage range for non-poor metabolizers in the context of the written description arguments [the accused infringer] advanced for poor metabolizers.” *Vanda Pharm. Inc. v. West-Ward Pharm. Int’l Ltd.*, 2016-2707, 4/13/18.

2. PTO Appeals

a. Intervening Supreme Court Law

“Even if the Board could be said to have acted “ultra vires” in refusing to institute reviews of some claims and grounds—and then proceeding to merits decisions concerning the claims and grounds included in the instituted reviews—the Board’s error is waivable, not one we are required to notice and act on in the absence of an appropriate request for relief on that basis.” *PGS Geophysical AS v. Iancu*, 2016-2470, 6/7/18.

B. Appellate Jurisdiction

1. Final Judgment

“[L]egal error does not mean lack of finality.” *PGS Geophysical AS v. Iancu*, 2016-2470, 6/7/18.

C. Cross-Appeals v. Alternate Bases for Affirmance

1. Alternative Basis for Injunction

“The district court expressly ordered relief that [patentee] argues may be affirmed on the basis of § 271(e)(4). See J.A. 33. Thus, our affirmance does not enlarge [patentee]’s rights under the judgment or require its amendment.” *Vanda Pharm. Inc. v. West-Ward Pharm. Int’l Ltd.*, 2016-2707, 4/13/18.

D. Standards of Review and Record/Appendix on Appeal

1. Clear/Plain Error Review

“Because these findings are supported by expert testimony and the record, we conclude that they are not clearly erroneous.” “We cannot reweigh the evidence, make credibility findings, or find facts.” *UCB, Inc. v. Accord Healthcare, Inc.* *UCB, Inc. v. Accord Healthcare, Inc.*, 2016-2610, 5/23/18.

A court’s “decision to credit the plausible testimony of certain witnesses and reject the testimony of [another party]’s witness as not credible . . . ‘can virtually never be clear error.’” *Vanda Pharm. Inc. v. West-Ward Pharm. Int’l Ltd.*, 2016-2707, 4/13/18 (citing *Anderson*, 470 U.S. at 575).

2. Abuse of Discretion

a. Assessing 285 Attorneys’ Fees Determinations

“[T]his finding in the court’s opinion leaves us unsure as to whether the court’s basis for denying attorneys’ fees rests on a misunderstanding of the law or an erroneous fact finding. Accordingly, we are unable to affirm the court’s exercise of discretion, absent

further explanation or reconciliation of the court’s reasoning with regard to its finding of inequitable conduct.” *Marathon Oil Co. v. Heat On-The-Fly, LLC*, 2016-1559, 5/4/18.

b. Agency Rulings

“Finally, it is our task to review decisions based on the grounds relied on by the tribunal being reviewed and on the arguments raised before us.” *Praxair Distrib., Inc. v. Mallinckrodt Hosp. Prods. IP Ltd.*, 2016-2616, 5/16/18.

3. Scope of Evidence in the Record

Appellant “now relies, in large part, on trial testimony and trial exhibits, rather than the exhibits submitted at the summary judgment stage. . . . Such evidence, which was not before the district court on summary judgment, is not a proper ground for disturbing the summary judgment ruling.” *Tex. Advanced Optoelec. Sols., Inc. v. Renesas Elecs. Am., Inc.*, 2016-2121, 5/1/18.

4. Alternative Legal and Factual Theories to Jury

While acknowledging the general rule that “if a jury could find liability according to multiple theories, and one of them is [legally] erroneous, we reverse unless we can tell that the jury came to its decision using only correct legal theories,” the Court found the legal deficiency in one theory to be harmless error where appellant stated that the verdict was “based largely on” a different theory that was affirmed and that relationship between the verdict and the affirmed theory was “amply supported by the evidence.” *Tex. Advanced Optoelec. Sols., Inc. v. Renesas Elecs. Am., Inc.*, 2016-2121, 5/1/18.

E. Mandamus and Stays Pending Appeal

“While the availability of seeking reconsideration ordinarily weighs heavily against granting a writ, courts have recognized that such a general rule should give way in circumstances where reconsideration by the district court would have been futile.” *In re BigCommerce, Inc.*, 2018-120, 5/15/18.

F. Harmless Error

1. Subset of Appealed Claims

“Because we affirm the district court’s infringement findings with respect to these independent claims, we need not reach this issue regarding the dependent claims because any error in the district court’s analysis of the dependent claims is harmless.” *Vanda Pharm. Inc. v. West-Ward Pharm. Int’l Ltd.*, n. 8, 2016-2707, 4/13/18.

G. Remand Determination

1. Remand for New Damages Determination

Where “liability [for a claim] can properly rest on only” a subset of grounds asserted to support that claim at trial and plaintiff’s trial “calculation of monetary relief did not distinguish among those grounds,” the court vacates the damages award. *Tex. Advanced Optoelec. Sols., Inc. v. Renesas Elecs. Am., Inc.*, 2016-2121, 5/1/18.

2. No Resolution of Issues in the First Instance

a. Improperly Decided Denial of Injunction

“We will not grant [patentee]’s request that we order an injunction to be issued. It suffices in this case to say that “[t]he decision to grant or deny permanent injunctive relief is an act of equitable discretion by the district court,” *eBay*, 547 U.S. at 391, and we are not in a position to make the necessary factual findings.” *Tex. Advanced Optoelec. Sols., Inc. v. Renesas Elecs. Am., Inc.*, 2016-2121, 5/1/18.

3. Opinion Dicta in View of Likely Remand Considerations

“But we are remanding for a new trial on this relief (if it continues to be requested on remand), and so it is significant whether the jury or the court is to decide [an issue]. We therefore address [appellant]’s argument.” *Tex. Advanced Optoelec. Sols., Inc. v. Renesas Elecs. Am., Inc.*, 2016-2121, 5/1/18.

IX. Patent Office Proceedings

A. Interferences

1. New Claims

Where party proposing a new claim “certified it was not aware of any reason why the claim was not patentable,” the PTAB “acted arbitrarily and capriciously in holding [that party] failed to show the proposed claim was patentable absent evidence of inconsistency with the prosecution history.” *Gen. Hosp. Corp. v. Sienna Biopharm., Inc.*, 2017-1012, 5/4/18.

B. Inter Partes Review

1. Institution

i. Privity

“[T]he privity inquiry in this context naturally focuses on the relationship between the named IPR petitioner and the party in the prior lawsuit.” “[S]ufficiently close that it can be fairly said that the petitioner had a full and fair opportunity to litigate the validity of the patent in that lawsuit.” “the petitioner is simply serving as a proxy to allow another

party to litigate the patent validity question that the other party raised in an earlier-filed litigation.” *WesternGeco LLC v. Ion Geophysical Corp.*, 889 F.3d 1308 (Fed. Cir. 2018), 2016-2099, 5/7/18.

“To the extent the Board analyzed privity based on ION’s control over the PGS proceedings, it properly did so in response to WesternGeco’s advancement of a theory focusing primarily on control.” *WesternGeco LLC v. Ion Geophysical Corp.*, 889 F.3d 1308 (Fed. Cir. 2018), 2016-2099, 5/7/18.

“As a general proposition, we agree with the Board that a common desire among multiple parties to see a patent invalidated, without more, does not establish privity.” *WesternGeco LLC v. Ion Geophysical Corp.*, 889 F.3d 1308 (Fed. Cir. 2018), 2016-2099, 5/7/18.

“the Board found that ION and PGS had a contractual and fairly standard customer-manufacturer relationship regarding the accused product. J.A. 203. This finding does not necessarily suggest that the relationship is sufficiently close that both should be bound by the trial outcome and related estoppels, nor does it suggest, without more, that the parties were litigating either the district court action or the IPRs as proxies for the other.” *WesternGeco LLC v. Ion Geophysical Corp.*, 889 F.3d 1308 (Fed. Cir. 2018), 2016-2099, 5/7/18.

“The use of the familiar common law terms “privity” and “real party in interest” indicate that Congress intended to adopt common law principles to govern the scope of the section 315(b) one-year bar.” *Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329 (Fed. Cir. 2018), 2015-1944, 4/20/18.

Affirmed Board determination of no privity even though Board did not discuss every *Taylor* (*Taylor v. Sturgell*, 553 U.S. 880, 893-95 & n.8 (2008)) factor, because the Board discussed the factors implicated by patentee’s arguments that there was privity. *Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329 (Fed. Cir. 2018), 2015-1944, 4/20/18.

“In applying the privity requirement of section 315(b), the Board has stated that the inquiry typically requires proof that the party in question had sufficient control over the prior proceeding that it could be bound by the results of that proceeding.” *Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329 (Fed. Cir. 2018), 2015-1944, 4/20/18.

ii. Real Party in Interest

“There was essentially no evidence before the Board that any of the [parties served more than a year before] was a real party in interest in the inter partes review proceeding. While [patentee] has speculated that [petitioner] may have been serving the interests of the [parties served more than a year before] when it sought inter partes review, [patentee] clearly has an interest of its own in challenging the ’215 patent, based on its manufacture of the assertedly infringing chips. Other than [patentee]’s conjecture, there is no evidentiary support for [patentee]’s theory that [petitioner] was acting at the behest or on behalf of the [parties served more than a year before].” *Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329 (Fed. Cir. 2018), 2015-1944, 4/20/18.

2. Amendments

Board rejected amended claims based on new combination, but refused to apply that combination to original challenged claims. “We see no error in the Board’s decision not to decide grounds of unpatentability not raised in the petition.” *Sirona Dental Systems GmbH v. Institut Straumann AG*, 2017-1341, 6/19/18.

3. Appeal

a. Reversal of PTAB Refusing to Cancel

“[R]emand is unnecessary. The Board’s uncontested findings regarding Bernasconi render claim 9 obvious under the proper reading of the claim.” *Praxair Distrib., Inc. v. Mallinckrodt Hosp. Prods. IP Ltd.*, 2016-2616, 5/16/18.

b. Petitioner Cross-Appeal Standing

“[Patentee] filed a motion to dismiss, asserting that [challenger] lacked Article III standing to appeal the PTAB’s Final Written Decision.” “A single judge of this court ‘deem[ed] it the better course to deny the motion and for the parties to address standing in their briefs.’” *Altaire Pharm., Inc. v. Paragon Biotech, Inc.*, n.4, 2017-1487, 5/2/18.

“[Petitioner] cross-appeals . . . [b]ecause [petitioner] has not established an injury in fact sufficient to confer Article III standing, however, this court dismisses the cross-appeal.” *Luitpold Pharm., Inc. v. Pharmacosmos A/S*, 2017-1786, 4/12/18 (nonprecedential).

c. Misapprehension of Board Findings

“Anacor’s argument is premised on the misapprehension that the Board viewed structural similarity as a binary factor—either present or absent—and that the Board found it was present in this case. That is not an accurate characterization of the Board’s assessment of the issue of structural similarity.” *Anacor Pharm., Inc. v. Iancu*, 2017-1947, 5/14/18.

d. Standard for Reviewing Findings

“Although the PTAB adopted the opinion of [patentee]’s expert and stated on rehearing that it found [petitioner]’s expert lacking in credibility, this is not a matter of credibility but of technological evidence.” *Ericsson Inc. v. Intellectual Ventures I LLC*, 2016-1671, 5/29/18.

“[B]oth the Board’s findings . . . depended on an incorrect interpretation of that claim, and we therefore hold that they are not supported by substantial evidence.” *Praxair Distrib., Inc. v. Mallinckrodt Hosp. Prods. IP Ltd.*, 2016-2616, 5/16/18.

4. Discovery

“Given that the Board explored the discovery issue in detail and applied the proper legal test for finding privity or real party in interest status under section 315(b), we decline to

hold that the Board abused its discretion when it concluded that additional discovery was not warranted in this case.” *Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329 (Fed. Cir. 2018), 2015-1944, 4/20/18.

5. Submitting Supplemental Information

Board abused its discretion in barring a second declaration when “[patentee] challenged [petitioner’s witness]’s qualifications to testify and personal knowledge of the tests in its Patent Owner Response” and petitioner submitted the second declaration with its reply addressing the witness’s qualifications. *Altaire Pharm., Inc. v. Paragon Biotech, Inc.*, 2017-1487, 5/2/18.

6. New Theories Adopted by Board

“It would thus not be proper for the Board to deviate from the grounds in the petition and raise its own obviousness theory.” *Sirona Dental Systems GmbH v. Institut Straumann AG*, 2017-1341, 6/19/18.

“Because the petition provided [patent owner] notice and opportunity to address the portions of [the reference] relied on by the Board, the Board’s reliance on these portions of [the reference] did not violate the APA and is not inconsistent with SAS.” *Sirona Dental Systems GmbH v. Institut Straumann AG*, 2017-1341, 6/19/18.

“It was not improper for the Board to cite Segal and Mertin (along with Nimura) as evidence of the knowledge that a skilled artisan would bring to bear in reading Austin and Brehove, even though those references were not cited in the petition.” *Anacor Pharm., Inc. v. Iancu*, 2017-1947, 5/14/18.

“Contrary to WesternGeco’s argument, the Board was permitted to issue a new construction in the final written decision given that claim construction was a disputed issue during the proceedings.” *WesternGeco LLC v. Ion Geophysical Corp.*, 889 F.3d 1308 (Fed. Cir. 2018), 2016-2099, 5/7/18.

7. Interaction with Litigation

“[O]ur affirmance today in a separate appeal [of an IPR final written decision] invalidating these same claims [] collaterally estops [patentee] from asserting the patent in any further proceedings.” “[A]n affirmance of an invalidity finding, whether from a district court or the Board, has a collateral estoppel effect on all pending or co-pending actions.” *XY, LLC v. Trans Ova Genetics, L.C.*, 2016-2610, 5/23/18.

C. Rejection Appeal Procedure

1. Board Reliance on New/Changing Grounds of Rejection

“Under these circumstances of multiple shifting articulations, this Court is not confident in the Patent Office’s reasoning for its rejection of the Application, specifically as to

which embodiment of Burger the Board relied on, and whether the Board relied on inherency as a basis for the tumbling function.” *In re Durance*, 2017-1486, 6/1/18.

No new ground where the “PTAB’s rejection relied on the same reasons provided by the Examiner, albeit using slightly different verbiage.” *Knowles Elecs. LLC v. Iancu*, 2016-1964, 4/6/18.