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I. Patentability Requirements

A. Inventorship/Invention and Priority Dates

1. Corroboration

Corroboration of two witnesses' testimony in the form of (1) their agreement, (2) a copy of the catalogue they referenced with a date agreeing with their testimony and (3) a third witness's testimony that the company named on the catalog had a booth on that date was found sufficient. *Nobel Biocare Servs. AG v. Intradent USA, Inc.*, 2017-2256, 9/13/18.

B. Prior Art Invalidity

1. Reference Disclosure

In determining whether there was substantial evidence to support that one ordinary skill would read a reference in a particular way “uncorroborated inventor testimony” and “another reference stating generally that [the first reference taught a similar concept]” was insufficient. *Wisconsin Alumni Research Found. v. Apple Inc.*, 2017-2265, 9/28/18.

a. Inherency

A formulation is not inherently disclosed by a reference describing a study, even if is “later revealed to be the actual formulation” used in the study, when the reference does not “necessarily disclose[] the vehicle formulation to one of skill in the art.” While those of skill at the time need not have recognized or appreciated the inherent characteristic, the evidence must show that there were no alternatives that satisfy the actual disclosure of the reference. *Endo Pharm. Sols., Inc. v. Custopharm Inc.*, 2017-1719, 7/13/18.

b. Expert Testimony Regarding Reference Disclosure

“Dr. Delson explained that such relative motion necessarily implies that the hole is bigger than the rod . . . substantial evidence supports the Board’s conclusion that if relative movement is possible, a person of ordinary skill would know that the pivot hole is larger in diameter than the rod.” *Luminara Worldwide, LLC v. Iancu*, 2017-1629, 8/16/18.

2. Anticipation (§ 102)

a. Claim Interpretation

i. Prior Art Can Operate with Claimed Capability

“[A] prior art reference may anticipate or render obvious an apparatus claim—depending on the claim language—if the reference discloses an apparatus that is reasonably capable of operating so as to meet the claim limitations, even if it does not meet the claim limitations in all modes of operation.” *ParkerVision, Inc. v. Qualcomm Inc.*, 2017-2012, 9/13/18.

b. Publications/Patents

i. Public Accessibility

“[E]ven relatively obscure documents qualify as prior art so long as the relevant public has a means of accessing them.” *GoPro, Inc. v. Contour IP Holding LLC*, 2017-1894, 7/27/18.

“Although the trade show was only open to dealers, there is no evidence or indication that any of the material disseminated or the products at the show excluded POV action cameras, or information related to such cameras. Contrary to the Board’s conclusion, the attendees attracted to the show were likely more sophisticated and involved in the extreme action vehicle space than an average consumer.” *GoPro, Inc. v. Contour IP Holding LLC*, 2017-1894, 7/27/18.

“We have consistently held that indexing or searchability is unnecessary for a reference to be a printed publication under § 102(b).” *Jazz Pharm., Inc. v. Amneal Pharm., LLC*, 2017-1671, 7/13/18.

“[W]ide dissemination of a reference through a publication like the Federal Register that those of ordinary skill would be motivated to examine is a factor strongly favoring public accessibility.” *Jazz Pharm., Inc. v. Amneal Pharm., LLC*, 2017-1671, 7/13/18.

“[D]isclosure through public domain sources such as the Federal Register and a public federal agency website plainly indicates that there was no reasonable expectation that the ACA materials would remain confidential.” *Jazz Pharm., Inc. v. Amneal Pharm., LLC*, 2017-1671, 7/13/18.

“Unlike meetings of at most several hundred persons as in the cases above, the Notice in the Federal Register widely disseminated the ACA materials through a hyperlink to a public FDA website where the ACA materials could be accessed.” *Jazz Pharm., Inc. v. Amneal Pharm., LLC*, 2017-1671, 7/13/18.

ii. Dissemination

The Board could treat as supporting evidence the fact that a witness “testified about his habitual practice in obtaining product literature, including brochures” based on “Fed. R. Evid. 406.” *Nobel Biocare Servs. AG v. Intradent USA, Inc.*, 2017-2256, 9/13/18.

iii. Establishing Publication Date

“Although the ABT Catalog’s date is not dispositive of the date of public accessibility, its date is relevant evidence that supports the Board’s finding of public accessibility at the March 2003 IDS Conference.” *Nobel Biocare Servs. AG v. Intradent USA, Inc.*, 2017-2256, 9/13/18. Public Use Bar

iv. Experimental Use Exception (See also On Sale Bar.Experimental Use)

Jury verdict of experimental use upheld where the evidence supported a “need for testing to ensure the durability and safety of the claimed [device]” and, despite there being no confidentiality agreement, “[patentee] introduced evidence that it maintained the secrecy of the invention in other ways. The jury heard testimony that [patentee] installed, uninstalled, and tested the prototypes itself and did not explain to the [cooperating party] employees how the invention operated.” *Polara Eng’g, Inc. v. Campbell Co.*, 2017-1974, 7/10/18.

c. Anticipating Methods with Structure Art

Challenger must “present evidence and argument that a person of ordinary skill would have been motivated to operate [the prior art structure] in a manner that satisfied [each method step] limitation.” *ParkerVision, Inc. v. Qualcomm Inc.*, 2017-2012, 9/13/18; *see also InTouch Techs., Inc. v. VGO Commc’ns, Inc.*, 751 F.3d 1327, 1346–47 (Fed. Cir. 2014).

3. Obviousness (§ 103)

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

i. Prior Art Overlaps with Claimed Range

“[T]he [*Galderma Labs.*] scheme applicable to district court adjudications and PTO examinations controls in IPR proceedings.” *E. I. du Pont de Nemours and Co. v. Synvina C.V.*, 2017-1977, 9/17/18.

“There are several ways by which the patentee may rebut that presumption. First, a modification of a process parameter may be patentable if it “produce[s] a new and unexpected result which is different in kind and not merely in degree from the results of the prior art.” [] Second, and relatedly, a patentee may rebut the presumption of obviousness by showing that the prior art taught away from the claimed range. [] Third, a change to a parameter may be patentable if the parameter was not recognized as “result-effective.” [] Fourth, we have reasoned that disclosure of very broad ranges may not invite routine optimization.” *E. I. du Pont de Nemours and Co. v. Synvina C.V.*, 2017-1977, 9/17/18 (citations omitted).

“[I]f the prior art does recognize that the variable affects the relevant property or result, then the variable is result-effective.” *E. I. du Pont de Nemours and Co. v. Synvina C.V.*, 2017-1977, 9/17/18.

ii. Undisclosed Elements and Dependent Claims

Where counsel admitted during oral argument that there was “no piece of prior art that was presented that says citric acid is a carrier particle or should be used as a carrier particle” and the claims required “microparticles of [active ingredient] are in contact with particles comprising citric acid,” the Court reversed a bench conclusion of obviousness even though

there was expert testimony that “if [citric acid] were selected, the artisan would expect it to work.” *Orexo AB v. Actavis Elizabeth LLC*, 2017-1333, 9/10/18.

iii. All Limitations Disclosed

Even where petitioner acknowledges that a location requirement for an element is not “expressly state[d],” by a reference the Board can be affirmed where it finds that “a POSITA would read [the reference] to understand that [the element] may be located [as required]” based on “substantial evidence.” *IXI IP, LLC v. Samsung Elecs. Co., Ltd.*, , 2017-1665, 9/10/18.

b. Motivation/Apparent Reason to Combine/Modify

i. Burden to Modify

“To meet its burden, [challenger] needed to do more than merely show that the prior art does not preclude [the modification]. [Challenger] needed to affirmatively demonstrate that a skilled artisan would have been motivated to [modify] despite no clear evidence of [a problem] under [contemporaneous] Guidelines.” *Endo Pharm. Sols., Inc. v. Custopharm Inc.*, 2017-1719, 7/13/18.

c. Reasonable Expectation of Success

“[N]o authority from the Supreme Court or this court requiring as a matter of law, for reasonableness of an expectation of success, testing of specific doses versus placebo that shows the relevant result with statistical significance.” *Acorda Therapeutics, Inc. v. Roxane Labs., Inc.*, 2017-2078, 9/10/18.

Success is defined by the claimed outcome, if there is one, not all potential advantages. “But efficacy in patients’ global impression is not the issue—efficacy in timed gait is.” *Acorda Therapeutics, Inc. v. Roxane Labs., Inc.*, 2017-2078, 9/10/18.

Affirmed denial of obviousness assertion based only substantial evidence underlying lack of reasonable expectation of success. *University of California v. Broad Institute, Inc.*, 2017-1907, 9/10/18.

d. Secondary Indicia of Nonobviousness

i. Relevance of Blocking Patents

“If the later invention is eventually patented by an owner or licensee of the blocking patent, that potential deterrent effect is relevant to understanding why others had not made, developed, or marketed that “blocked” invention and, hence, to evaluating objective indicia of the obviousness of the later patent.” *Acorda Therapeutics, Inc. v. Roxane Labs., Inc.*, 2017-2078, 9/10/18.

ii. Initial Skepticism/Failure of Others

Affirmed finding that a failure that “preceded publications that would render the invention obvious to those of skill in the art” indicated that the failure was “not particularly probative” as an *objective indicia*. *Acorda Therapeutics, Inc. v. Roxane Labs., Inc.*, 2017-2078, 9/10/18.

iii. Unexpected Results

“The district court erred in discounting the enhanced bioavailability in the ’330 Patent’s formulation as “a ‘difference in degree,’ not a difference in ‘kind.’”” *Orexo AB v. Actavis Elizabeth LLC*, 2017-1333, 9/10/18.

iv. Simultaneous Invention

“Simultaneous invention may serve as evidence of obviousness when considered in light of all of the circumstances.” “First, it is evidence of the level of skill in the art.” “Second, it constitutes objective evidence that persons of ordinary skill in the art understood the problem and a solution to that problem.” *University of California v. Broad Institute, Inc.*, 2017-1907, 9/10/18.

“[E]vidence of simultaneous invention cannot alone show obviousness.” *University of California v. Broad Institute, Inc.*, 2017-1907, 9/10/18.

e. Teaching Away

Earlier prior art does not teach away if later prior art abandons the basis for the early statements. “Even if many earlier studies used [steps outside the claimed subject matter] to avoid adverse effects [of a particular type], those studies do not, as the district court found, undermine the other evidence in the prior art that a person of skill would have a reasonable expectation of success for [steps within the claimed subject matter].” *Acorda Therapeutics, Inc. v. Roxane Labs., Inc.*, 2017-2078, 9/10/18.

f. Summary Judgment/JMOL

i. Proper to Grant

“Even drawing all reasonable inferences in favor of [patentee], such evidence is insufficient to withstand summary judgment on the question of obviousness. The weak evidence of secondary considerations presented here simply cannot overcome the strong showing of obviousness.” *ZUP, LLC v. Nash Mfg., Inc.*, 2017-1601, 7/25/18.

ii. Motivation to Combine

“In the face of the significant evidence presented by [challenger] regarding the consistent desire for [meeting a goal], and given that the elements [defining the claimed subject matter] were used in the prior art for this very purpose, there is no genuine dispute as to

the existence of a motivation to combine.” *ZUP, LLC v. Nash Mfg., Inc.*, 2017-1601, 7/25/18.

C. Invalidity Based on § 112

1. Enablement (¶ 1)

a. Full Scope of the Claim

“[Patentee] lastly argues that the [specification] need not enable the claimed device with a [particular embodiment]. [Patentee] notes that there is no dispute as to enablement of five out of the six referenced permutations and argues “[t]hat is sufficient.”” “We disagree. Our precedents make clear that the specification must enable the full scope of the claimed invention.” *Trs. of Boston Univ. v. Everlight Elecs. Co.*, 2016-2576, 7/25/18.

b. Summary Judgment/JMOL

JMOL of invalidity ordered on appeal where patentee’s evidence regarding making the claimed layers amounted to expert testimony that “is entirely conclusory and therefore insufficient” and other evidence “[s]imply observing that it could be done—years after the patent’s effective filing date—[which] bears little on the enablement inquiry.” *Trs. of Boston Univ. v. Everlight Elecs. Co.*, 2016-2576, 7/25/18.

2. Indefiniteness (¶ 2)

a. Invalid

The claim term “QoS requirements” that is described in the specification as “defined by what network performance characteristic is most important to a particular user” and as “a relative term, finding different meanings for different users” *rendered the claim indefinite.* *Intellectual Ventures I LLC v. T-Mobile USA, Inc.*, 2017-2434, 9/4/18.

b. Means plus function elements

Where a figure’s illustrations of an element “are indistinguishable from” it’s illustrations of other different elements, that figure “fails to disclose any structure” *for the particular element.* *Diebold Nixdorf, Inc. v. Int’l Trade Comm’n*, 2017-2553, 8/15/18.

c. Design Patents

“A visual disclosure may be inadequate—and its associated claim indefinite—if it includes multiple, internally inconsistent drawings.” *In re Maatita*, 2017-2037, 8/20/18.

“[I]n the design patent context, one skilled in the art would assess indefiniteness from the perspective of an ordinary observer. Thus, a design patent is indefinite under § 112 if one skilled in the art, viewing the design as would an ordinary observer, would not understand the scope of the design with reasonable certainty based on the claim and visual disclosure.” *In re Maatita*, 2017-2037, 8/20/18.

D. Section 101

1. Abstract Idea Exclusion

Where the claim “amounts to having users consider previous item descriptions before they describe items to achieve more consistent item descriptions” *it is direct to an abstract idea.* *BSG Tech LLC v. BuySeasons, Inc.*, 2017-1980, 8/15/18.

“[A] claimed improvement in a mathematical technique with no improved display mechanism” *is abstract.* *SAP Am., Inc. v. InvestPic, LLC.*, 2017-2081, 8/2/18.

“Standing alone, the act of providing someone an additional set of information without disrupting the ongoing provision of an initial set of information is an abstract idea.” *Interval Licensing LLC v. AOL, Inc.*, 2016-2502, 7/20/18.

a. Inventive Concept/Transformation Exception

“If a claim’s only “inventive concept” is the application of an abstract idea using conventional and well-understood techniques, the claim has not been transformed into a patent-eligible application of an abstract idea.” *BSG Tech LLC v. BuySeasons, Inc.*, 2017-1980, 8/15/18.

“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 nonabstract application realm. An advance of that nature is ineligible for patenting.” *SAP Am., Inc. v. InvestPic, LLC.*, 2017-2081, 8/2/18.

No transformation because “while the specification and claims of the ‘[] patent purport to describe an improved user experience which allows the presentation of an additional set of information, the patent is wholly devoid of details which describe how this is accomplished.” *Interval Licensing LLC v. AOL, Inc.*, 2016-2502, 7/20/18.

2. Stage of Case for Determination

a. Motion to Dismiss

“[A]ll of the claim details identified by [patentee]—including in the claims that emerged from reexamination—fall into one or both of two categories: they are themselves abstract; or there are no factual allegations from which one could plausibly infer that they are inventive. In these circumstances, judgment on the pleadings that the claims recite no “inventive concept” is proper.” *SAP Am., Inc. v. InvestPic, LLC.*, 2017-2081, 8/2/18.

i. Claim Construction Required

Federal Circuit construes claim term in affirming dismissal: “Therefore, “summary comparison usage information” covers any information concerning the relative frequency at which different parameters and values have been used.” *BSG Tech LLC v. BuySeasons, Inc.*, 2017-1980, 8/15/18.

II. Other Defenses

A. Lack of Subject Matter Jurisdiction

1. Substantial Question of Federal Patent Law

a. PTO Violations of APA

“[I]f a plaintiff’s APA challenge raises a substantial question of patent law, district courts have jurisdiction under 28 U.S.C. § 1338(a).” “[T]he PTO Director’s denial of [a] petition is not a PTAB decision. Thus, [a] challenge to the denial of [that] petition falls outside the exclusive zone of jurisdiction created by § 141 and § 145.” *Hyatt v. U.S. Patent and Trademark Office*, 2017-1722, 9/24/18.

III. Literal Infringement

A. 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, 7/9/18.

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, 7/9/18.

B. 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, 7/9/18.

C. Capability

Court reversed denial of noninfringement JMOL because a claim requiring association between one element, load tag, and a single (or particular) other element, load instruction, was not met where “because of the way [defendant]’s hashing algorithm is designed, multiple load instructions *may* hash to the same load tag.” “But after reviewing the evidence and drawing all reasonable inferences in favor of WARF, we find that there is insufficient evidence to support WARF’s theory that Apple’s load tags are sometimes associated with a single load instruction.” *Wisconsin Alumni Research Found. v. Apple Inc.*, 2017-2265, 9/28/18 (emphasis added).

“[A] patent that claims an automobile configured to operate in third gear would be infringed by an automobile that is configured to operate in first, second, and third gears. The automobile is at all times configured to operate in any one of its possible gears, including the infringing one, even if the automobile is never driven in the infringing gear.” *Core Wireless Licensing S.a.r.l. v. Apple Inc.*, 2017-2102, 8/16/18.

“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, 7/9/18.

D. Design Patents

1. Prosecution History Estoppel

No estoppel to accusing an assembly when an applicant elects component drawings over assembly drawings during prosecution, because “Advantek elected to patent the ornamental design for a kennel with a particular skeletal structure. A competitor who sells a kennel embodying Advantek’s patented structural design infringes the D’006 patent, regardless of extra features, such as a cover, that the competitor might add to its kennel.” *Advantek Mktg., Inc. v. Shanghai Walk-Long Tools Co.*, 2017-1314, 8/1/18.

IV. DOE Infringement

A. Prosecution History Bar

1. Argument Estoppel

a. Related Applications

No estoppel where argument made in a first patent was based on different language than the language in a second patent whose DOE is sought to be estopped and “functions performed in the two patents are related but different.” *Power Integrations, Inc. v. Fairchild Semiconductor Int’l, Inc.*, 2016-2691, 9/20/18.

V. Relief

A. Attorneys' fees

1. Sanctions under 28 U.S.C. § 1927

“On its face, § 1927 only applies to actions that result in unreasonable and vexatious multiplication of proceedings. This necessarily excludes a filing of a baseless complaint, which is properly analyzed under Fed. R. Civ. P. 11.” *Gust, Inc. v. AlphaCap Ventures, LLC*, 2017-2414, 9/28/18.

“The district court also improperly relied on Safier’s statement that the case is “not worth litigating” as evidence of Gutride’s knowledge that AlphaCap’s patents were invalid. In the context of advocating for settlement with the opposing party to settle, this is an inoffensive assertion that the calculus favors settlement, not an admission that the patents were invalid.” *Gust, Inc. v. AlphaCap Ventures, LLC*, 2017-2414, 9/28/18.

“We appreciate the district court’s concern with AlphaCap’s business/litigation model here. As a noncapitalized, non-practicing entity, represented on a contingency fee basis, AlphaCap bears relatively little risk and cost in filing its infringement actions, as compared with the relatively high costs incurred by defendants to defend the lawsuit.” “Nevertheless, § 1927 is not the proper vehicle to generally address those concerns.” *Gust, Inc. v. AlphaCap Ventures, LLC*, 2017-2414, 9/28/18.

2. Amount

“Rembrandt instead argues that the fee award is excessive and unreasonable because the district court failed to establish a causal connection between the claimed misconduct and the fees awarded. We agree.” *In re Rembrandt Techs., LP Patent Litig.*, 2017-1784, 8/15/18.

3. PTO’s Fees in Section 145 Litigation

“Given the Supreme Court’s construction of ‘expenses,’ the guidance dictionary and treatises provide on this term, and the context in which Congress applied it, we conclude that the term ‘expenses’ includes the USPTO’s attorneys’ fees under § 145.” *Nantkwest, Inc. v. Matal*, 2016-1794, 6/23/17. *Nantkwest, Inc. v. Matal*, 2016-1794, 6/23/17 [**vacated in sua sponte en banc order on 8/31/17**][**reversed en banc 7/27/18**]

“Awarding “[a]ll the expenses” simply cannot supply the “specific and explicit” directive from Congress to shift attorneys’ fees, and nothing else in the statute evinces congressional intent to make them available.” *NantKwest, Inc. v. Iancu*, 2016-1794, 7/27/18.

B. Entire Market Value Rule/Convoyed Sales

“Where the accused infringer presents evidence that its accused product has other valuable features beyond the patented feature, the patent holder must establish that these features do not cause consumers to purchase the product.” If the patent holder does not, then a damages

verdict based on EMVR must be vacated. *Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc.*, 2016-2691, 9/20/18.

C. Enhanced Damages

Enhancement of 2.5 vacated where “the district court awarded almost the maximum amount of enhanced damages, but did not adequately explain its basis for doing so, and failed to even mention [defendant]’s public use defense, which presented a close question in this case.” *Polara Eng’g, Inc. v. Campbell Co.*, 2017-1974, 7/10/18.

D. Injunction

1. Permanent Injunction

a. Irreparable Injury

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, 7/9/18.

VI. Claim Construction

A. Special Constructions

1. Broadest Reasonable Interpretation During Prosecution

“[I]t is not reasonable to read the claims more broadly than the description in the specification.” *TF3 Ltd. v. Tre Milano, LLC*, 2016-2285, 7/13/18.

B. Claim Language

1. Plain and Ordinary Meaning

a. How the Claim Could Have Been Written

“Moreover, disclaimed independent claim 9 describes [the construction sought], demonstrating that the patentee knew how to specify [that construction]. It did not so choose in the frustoconical limitation.” *Nobel Biocare Servs. AG v. Intradent USA, Inc.*, 2017-2256, 9/13/18.

2. Open/Closed Claims, Generic and Negative Limitations

a. Other Transition Terms

i. Having

“[B]oth the claim context and the specification demonstrate that the Board correctly determined that “having” is open-ended. The coronal region thus must contain a frustoconical shape, but other shapes are not excluded.” *Nobel Biocare Servs. AG v. Instrand USA, Inc.*, 2017-2256, 9/13/18.

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

“[T]he plain meaning of “particular,” as understood by a person of ordinary skill in the art after reading the [asserted] patent, requires . . . a single . . . more than one . . . does not meet this limitation.” *Wisconsin Alumni Research Found. v. Apple Inc.*, 2017-2265, 9/28/18.

c. Linking Limitations (associated with, aware of, corresponds, represents, etc.)

“[Classification] awareness requires only that [the element perform its function] based on [the claimed classification], which can be discerned using information obtained from any of [the potential sources].” “The plain language of claims [] does not specify how [one element] becomes “aware” of [the claimed classification].” *Intellectual Ventures I LLC v. T-Mobile USA, Inc.*, 2017-2434, 9/4/18.

3. Section 112, paragraph 6

a. When Applied

i. Overcoming Presumption Against 112.6

“Thus, in appropriate cases, a party advocating that a claim limitation that does not recite the word “means” is subject to § 112, para. 6 can overcome the presumption against its application solely by reference to evidence intrinsic to the patent.” *Diebold Nixdorf, Inc. v. Int’l Trade Comm’n*, 2017-2553, 8/15/18.

“We conclude that the term “cheque standby unit” in the ’235 patent is a means-plus-function term subject to 35 U.S.C. § 112, para. 6.” “[T]he claims do not recite any structure [where] the claims describe the term “cheque standby unit” solely in relation to its function and location in the apparatus.” *Diebold Nixdorf, Inc. v. Int’l Trade Comm’n*, 2017-2553, 8/15/18.

4. Functional and Structural Language

a. Capable/Adaptable/Adjustable Elements

“[O]ur cases distinguish between claims with language that recites capability, and those that recite configuration.” *ParkerVision, Inc. v. Qualcomm Inc.*, 2017-2012, 9/13/18.

5. Effect of Other Claims

a. Relationship Between Independent and Dependent Claims

“The dependent claims [patentee] identifies do not compel a construction of [the term at issue] inconsistent with the specification, particularly where these claims were added after the patent application filing date.” *Barkan Wireless Access Techs., L.P. v. Cellco P’ship*, 2017-2264, 8/29/18 (nonprecedential).

C. Written Description

1. Lexicography

a. Definition by Intrinsic Use

Board erred in not limiting claim requirement that “the length of hair can pass through the secondary opening” to cover only the way which “specification describes how the curled hair is removed from the device.” *TF3 Ltd. v. Tre Milano, LLC*, 2016-2285, 7/13/18.

2. Disclosed Embodiment(s)

a. Presumption of Claim Coverage

i. Multiple Embodiments

“It is further undisputed that figures 8 and 9 are encompassed by the Board’s construction, but would be excluded by Nobel’s proposed construction.” “Because the claim language does not require the exclusion of those embodiments, and there is no basis in the intrinsic record for excluding them, Nobel has not overcome this presumption.” *Nobel Biocare Servs. AG v. Intradent USA, Inc.*, 2017-2256, 9/13/18.

“Where a party argued for a construction that results in “unclaimed embodiments,” that construction was rejected because the party provided “no persuasive support in either the plain meaning of [the term] or in the written description to exclude an embodiment repeatedly highlighted in the specification.” *Jazz Pharm., Inc. v. Amneal Pharm., LLC*, 2017-1671, 7/13/18.

3. Summary of the Invention

“In cases where we have held limitations ought to be read in, it was not simply because those limitations appeared in the Summary of the Invention. There was specific language

that made clear those limitations were important to the claimed invention.” *Blackbird Tech LLC v. ELB Elecs., Inc.*, 2017-1703, 7/16/18.

4. Limitations Not Imported

“Without any evidence that the fastener is important, essential, or critical to the invention, it should not be read in as a claim limitation.” *Blackbird Tech LLC v. ELB Elecs., Inc.*, 2017-1703, 7/16/18.

“We decline to read such limitations into the broad claim language based on the specification’s use of the word “contains” or “includes” in the context of describing a certain embodiment.” *Jazz Pharm., Inc. v. Amneal Pharm., LLC*, 2017-1671, 7/13/18.

D. Prosecution History

1. Terms Added During Prosecution

“By indicating that the specification’s disclosure of [a feature] provides written description support for the [disputed] term, the prosecution history lends further support to the Board’s construction that does not exclude [the feature] from the scope of the claims.” *Jazz Pharm., Inc. v. Amneal Pharm., LLC*, 2017-1671, 7/13/18.

2. Issuing Application

a. Changes Meaning

i. Broadens Claim Scope

“[N]o skilled artisan would understand this claim to require a fastening mechanism connecting the ballast cover to the attachment surface when that very limitation was expressly removed from the claim to secure patentability with the examiner’s blessing and agreement.” *Blackbird Tech LLC v. ELB Elecs., Inc.*, 2017-1703, 7/16/18.

ii. No Rejection on Reference Distinguished

“By indicating that the specification’s disclosure of [a feature] provides written description support for the [disputed] term, the prosecution history lends further support to the Board’s construction that does not exclude [the feature] from the scope of the claims.” *Jazz Pharm., Inc. v. Amneal Pharm., LLC*, 2017-1671, 7/13/18.

b. Does Not Change Meaning

i. No Disclaimer

A statement that a claimed process is “aware” of certain information does not disavow coverage of methods that don’t “use” *that information*. *Intellectual Ventures I LLC v. T-Mobile USA, Inc.*, 2017-2434, 9/4/18.

E. Timing of Construction and Parties' Positions

1. Construing the Words in the Construction

Proposed interpretation of the words of the construction in a manner that would not encompass disclosed embodiments rejected because “doing so would impermissibly render the claims inoperable.” *Power Integrations, Inc. v. Fairchild Semiconductor Int’l, Inc.*, 2016-2691, 9/20/18.

VII. Unenforceability

A. Intent to Deceive

1. Witnesses That Don’t Show Up or Aren’t Credible

“Although the other misconduct occurred much later, the district court was entitled to weigh it when assessing the key players’ trustworthiness and the likelihood that they had deceptive intent.” *In re Rembrandt Techs., LP Patent Litig.*, 2017-1784, 8/15/18.

B. Implied Waiver Through Violation of Standards Organization Rules

Remand to determine if a violation occurred despite proposal not being adopted, because policy required disclosure when “submitting a technical proposal” if that party has intellectual property that “might” be essential “if that proposal is adopted.” *Core Wireless Licensing S.a.r.l. v. Apple Inc.*, 2017-2102, 8/16/18.

“In the analogous case of implied waiver, which like inequitable conduct involves the breach of a disclosure duty, the same equitable considerations require either a showing of prejudice or egregious misconduct sufficient to justify the sanction of unenforceability of the patent at issue.” *Core Wireless Licensing S.a.r.l. v. Apple Inc.*, 2017-2102, 8/16/18.

VIII. Procedural Law

A. Preclusion

1. Issue Preclusion - Collateral Estoppel

a. Same Issue of Law or Fact Necessary to Judgment

“To determine whether there is an identity of claims, this court is guided by the Restatement (Second) of Judgments.” *Hyatt v. U.S. Patent and Trademark Office*, 2017-1722, 9/24/18.

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, 7/9/18.

C. 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, 7/9/18.

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, 7/9/18.

D. New Trial; Altering or Amending Judgment (Rule 59)

“Where a motion for a new trial is based on insufficiency of the evidence, a district court abuses its discretion in denying that motion only if the appellant makes a “clear showing” of “an absolute absence of evidence to support the jury’s verdict.” [citation omitted] Thus, in that context, the standard of review is actually “even more deferential than [the court of appeals’] review of the denial of a motion for judgment as a matter of law.” *Hidden Oaks Ltd. v. City of Austin*, 138 F.3d 1036, 1049 (5th Cir. 1998).” *Raytheon Co. v. Indigo Sys. Corp.*, 2016-1945, 7/12/18.

E. Discovery/Evidence

1. Witness Payment

Improper for hiring party to offer contingent payment in consulting agreement if, “when [hiring party] signed the consulting agreement, it was likely that the consultants would play a role in litigation.” *In re Rembrandt Techs., LP Patent Litig.*, 2017-1784, 8/15/18.

“[T]he issue that the district court correctly identified was not that witnesses lied, but that the contingent fee arrangement gave them incentives to lie.” *In re Rembrandt Techs., LP Patent Litig.*, 2017-1784, 8/15/18.

IX. Federal Circuit Appeals

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

1. District Court/ITC Appeals

a. Claim Construction Waiver

i. Construction Advocated at Markman

Even though Appellant sought only to get its originally-proposed construction, where the “district court added this limitation to the construction on its own without providing a clear explanation” and “the district court had not specifically addressed this issue in its claim construction order, in order to preserve an objection to the district court’s claim construction, [appellant] was required to raise the issue before submission to the jury.” *Power Integrations, Inc. v. Fairchild Semiconductor Int’l, Inc.*, 2016-2691, 9/20/18.

b. 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, 7/9/18.

B. Appellate Jurisdiction

1. Standing to Appeal

a. Appeals of Post-Grant Challenges

“As the party seeking judicial review, [IPR petitioner] has the burden of establishing that it possesses the requisite injury.” “The fact that [IPR petitioner] has no product on the market at the present time does not preclude Article III standing, either in IPRs or in declaratory judgment actions.” *JTEKT Corp. v. GKN Automotive LTD*, 2017-1828, 8/3/18.

“To be sure, IPR petitioners need not concede infringement to establish standing to appeal.” “[W]e conclude that [IPR petitioner] has not established at this stage of the development that its product creates a concrete and substantial risk of infringement or will likely lead to claims of infringement.” Court also rejected IPR petitioner’s “argu[ment] that the creation of estoppel based on its participation in the IPR constitutes a separate, and independent, injury in fact.” *JTEKT Corp. v. GKN Automotive LTD*, 2017-1828, 8/3/18.

C. Cross-Appeals v. Alternate Bases for Affirmance

1. Alternative Bases in Agency Appeals

“Petitioners also argue that, even if the Board erred . . . the institution of the IPR proceeding was nevertheless proper for two independent reasons. . . . We therefore address these arguments in turn. *See Killip v. Office of Pers. Mgmt.*, 991 F.2d 1564, 1568–69 (Fed. Cir.

1993) (recognizing, in the context of a Merit Systems Protection Board case, that we may “affirm the Board on grounds other than those relied upon in rendering its decision, when upholding the Board’s decision does not depend upon making a determination of fact not previously made by the Board”).” *Click-To-Call Technologies, LP, v. Ingenio, Inc.*, 2015-1242, 8/16/18.

D. Standards of Review and Record/Appendix on Appeal

1. Substantial Evidence Threshold

a. Specific to Findings

“It is not our role to ask whether substantial evidence supports factfindings not made by the Board, but instead whether such evidence supports the findings that were in fact made.” *University of California v. Broad Institute, Inc.*, 2017-1907, 9/10/18.

b. Conflicting Evidence

“Although there are a few isolated statements from Apple’s fact and expert witnesses that WARF argues support its theory, the most thorough explanation of this piece of evidence comes from WARF’s expert, and his testimony undermines the inference WARF seeks to draw.” “[I]n light of [WARF’s expert]’s testimony, it is unreasonable to infer [WARF’s theory].” *Wisconsin Alumni Research Found. v. Apple Inc.*, 2017-2265, 9/28/18 (citation omitted).

“WARF points to Apple’s technical documentation, arguing that certain language in the documentation demonstrates that Apple’s LSD predictor “uniquely” identifies load instructions. Apple points out, however, that the documentation merely states that the LSD predictor “can be thought of” as uniquely identifying load instructions, and that “in practice” the load tags are the result of applying the hashing algorithm. [citing Apple’s expert]. Reading the quote in context, it is not reasonable to infer that the load tags, in practice, uniquely identify load instructions.” *Wisconsin Alumni Research Found. v. Apple Inc.*, 2017-2265, 9/28/18 (citation omitted).

2. Clear/Plain Error Review

Not clear error for district court to reject an argument based on one set of standards when it was not consistent with another set of standards that were more often used. *Endo Pharm. Sols., Inc. v. Custopharm Inc.*, 2017-1719, 7/13/18.

3. Abuse of Discretion

“The district court’s remarkably terse orders shed little light on its justifications for its decisions on these fact-intensive issues. But abuse of discretion is a deferential standard. On the record before us, we cannot say that any of the district court’s findings was based “on an erroneous view of the law or on a clearly erroneous assessment of the evidence.”” *In re Rembrandt Techs., LP Patent Litig.*, 2017-1784, 8/15/18.

4. Review Judgments not Opinions

a. Interpreting Opinion Being Reviewed

“We think, however, that the district court’s opinion is best read not as invoking a categorical rule, but as drawing conclusions on the limited factual record created in this case bearing on the effect of a blocking patent.” *Acorda Therapeutics, Inc. v. Roxane Labs., Inc.*, 2017-2078, 9/10/18.

5. 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, 7/9/18.

E. Relief Outside Appeal Process

1. Mandamus

“But a writ of mandamus is not intended to be simply an alternative means of obtaining appellate relief, particularly where relief by appeal has been specifically prohibited by Congress.” *In re Power Integrations, Inc.*, 2018-144, 8/16/18.

a. Mandamus from PTO Proceedings

“[T]he APA offers a remedy for such situations by enabling reviewing courts to compel agency actions unlawfully withheld or unreasonably delayed without adequate reason or justification. 5 U.S.C. §§ 702, 706(1).” *Hyatt v. U.S. Patent and Trademark Office*, 2017-1722, 9/24/18.

F. 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, 7/9/18.

2. Scope of Mandate

a. No Remand on Particular Issue

“Only the Director suggests a remand on this issue. But the Director identifies no material facts requiring further development on remand. And, the Director has not explained exactly what the Board might wish to, or be able to, consider on remand. The issue in this case thus raises only a legal question, and under current law, including the current regulation, the answer to the legal question is already determined in this opinion.” “We know of no authority or sound basis to support a remand to allow for a possible intervening change of law, especially in the context of a statute prizing expedition.” *Click-To-Call Technologies, LP, v. Ingenio, Inc.*, 2015-1242, 8/16/18.

3. 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, 7/9/18.

4. 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, 7/9/18.

X. Patent Office Proceedings

A. Inter Partes Review

1. Institution

a. Appeals and Petitions for Writ

Can’t use mandamus to review noninstitution decision. *In re Power Integrations, Inc.*, 2018-144, 8/16/18.

“If the Director decides not to institute, for whatever reason, there is no review. In making this decision, the Director has complete discretion to decide not to institute review.” *Saint Regis Mohawk Tribe v. Mylan Pharm., Inc.*, 2018-1638, 7/20/18.

b. Time limit under section 315(b)

“We read section 315(b), as implemented by the existing regulation, to apply petition-by-petition, not petitioner-by-petitioner, with the collection of petitioners on a single petition treated as a unit indistinguishable from each member of that collection.” *Click-To-Call Technologies, LP, v. Ingenio, Inc.*, 2015-1242, 8/16/18.

i. Real Party in Interest

“[A]n IPR petitioner’s initial identification of the real parties in interest should be accepted unless and until disputed by a patent owner.” *Worlds Inc. v. Bungie, Inc.*, 2017-1481, 9/7/18.

“[A] patent owner must produce *some* evidence that tends to show that a particular third party should be named a real party in interest.” *Worlds Inc. v. Bungie, Inc.*, 2017-1481, 9/7/18 (emphasis in original).

Remand necessary where a Board’s statement “implies that the Board assumed the burden of persuasion rests with the patent owner.” If the “the Board placed the burden on Worlds, the patent owner, to persuade the Board that [petitioner] failed to list a real party in interest . . . this would have been improper.” *Worlds Inc. v. Bungie, Inc.*, 2017-1481, 9/7/18.

ii. Qualifying Complaints

“This case differs from *Click-to-Call* only in that Bennett’s complaint was involuntarily dismissed without prejudice. We identify no reason to distinguish *Click-to-Call* on that basis.” *Bennett Regulator Guards, Inc. v. Atlanta Gas Light Co.*, 2017-1555, 9/28/18.

Section 315(b)’s time-bar applies to bar institution when an IPR petitioner was served with a complaint for patent infringement more than one year before filing its petition, but the district court action in which the petitioner was so served was voluntarily dismissed without prejudice. *Click-To-Call Technologies, LP, v. Ingenio, Inc.*, 2015-1242, 8/16/18 (en banc).

iii. Challenged Patent

“[W]e reject Petitioners’ effort to deem the reexamined ’836 patent a “new patent” for § 315(b) purposes.” *Click-To-Call Technologies, LP, v. Ingenio, Inc.*, 2015-1242, 8/16/18.

2. Appeal

a. Remand Due to Issue Preclusion

“[T]he determination of whether a party is a real party in interest may differ from one IPR to the next, even among a set of seemingly related IPRs. Without a more comprehensive understanding of the issues raised in each case, we decline to apply collateral estoppel.” *Worlds Inc. v. Bungie, Inc.*, 2017-1481, 9/7/18.

b. Petitioner Standing

“Such a controversy exists here because [petitioner] currently operates a plant capable of infringing the [challenged] patent.” “[W]e make no judgment on whether [petitioner] has infringed or is infringing the [challenged] patent.” *E. I. du Pont de Nemours and Co. v. Synvina C.V.*, 2017-1977, 9/17/18 (declaration submitted on appeal).

c. Misapprehension of Board Findings

“It is not our role to ask whether substantial evidence supports factfindings not made by the Board, but instead whether such evidence supports the findings that were in fact made.” *University of California v. Broad Institute, Inc.*, 2017-1907, 9/10/18.

3. Submitting Supplemental Information

“The portions of the Reply the Board declined to consider expressly follow from these contentions raised in the Petition” *and, therefore, the Board’s decision not to consider those arguments was an abuse of discretion.* *Ericsson Inc. v. Intellectual Ventures I LLC*, 2017-1521, 8/27/18.

4. Obviousness Rulings

a. Reversal

“[T]his case involves a strong case of obviousness based on very close prior art and weak evidence of nonobviousness. We conclude that the Board therefore erred in not concluding that claims 1–5 would have been obvious at the time of the claimed invention.” *E. I. du Pont de Nemours and Co. v. Synvina C.V.*, 2017-1977, 9/17/18.

5. Sovereign Immunity

“We hold that tribal sovereign immunity cannot be asserted in IPRs.” *Saint Regis Mohawk Tribe v. Mylan Pharm., Inc.*, 2018-1638, 7/20/18.

B. Interpretation of Regulations

1. Challenges under APA

“For substantive challenges, the right of action accrues either when the agency makes its initial decision or at the time of an adverse application of the decision against the plaintiff, whichever comes later. An agency’s denial of a plaintiff’s petition for rulemaking qualifies as an adverse application of the existing rule against the plaintiff. We see no reason to depart from this precedent regarding the accrual date for a substantive challenge.” *Hyatt v. U.S. Patent and Trademark Office*, 2017-1722, 9/24/18 (citations omitted).