

Table of Contents

I.	Patentability Requirements	1
A.	Prior Art Invalidity.....	1
1.	Anticipation (§ 102).....	1
a.	Mirrors Infringement	1
i.	Product by Process Claims.....	1
b.	Claim Interpretation	1
i.	Prior Art Discloses Genus.....	1
2.	Obviousness (§ 103)	1
a.	Analogous Prior Art.....	1
i.	Same Field of Endeavor.....	1
b.	Motivation/Apparent Reason to Combine/Modify	2
i.	Impact of Broad Claims	2
ii.	Known Reason to Combine	2
iii.	Portions of References Serve Similar Function	2
iv.	Incompatible Reference Requirements	2
v.	Expert Testimony.....	2
vi.	Evidence of Reasons to Combine	2
c.	Reasonable Expectation of Success	3
i.	Based on Motivation to Combine	3
ii.	Implicit Findings.....	3
d.	Secondary Indicia of Nonobviousness.....	3
i.	Presumption of Nexus.....	3
ii.	Weighing with other <i>Graham</i> Factors	3
B.	Invalidity Based on § 112	3
1.	Enablement (¶ 1).....	3
a.	Full Scope of the Claim	3
i.	Species Disclosures for Genus Claims	3
ii.	Guidance for Identifying Undisclosed Embodiments.....	4
2.	Written Description (¶ 1)	4
a.	Alternative Species	4
C.	Double Patenting.....	4
1.	Obviousness-Type.....	4
a.	Terminal disclaimer	4
D.	Section 101.....	5
1.	Abstract Idea Exclusion	5
a.	Claimed Subject Matter	5
b.	Application of Information or Mathematical Algorithm(s).....	5
c.	Information Processing	5
d.	Inventive Concept/Transformation Exception	5
i.	Distinguished from Novelty.....	5
2.	Stage of Case for Determination.....	5
a.	Motion to Dismiss.....	5
i.	Claim Construction Role.....	5
E.	Post-Issuance Invalidity	6

1.	Reissued Patents.....	6
a.	Invention Disclosed in the Original Patent	6
II.	Literal Infringement	6
A.	Indirect Infringement	6
1.	Induced Infringement.....	6
a.	Intent to Induce	6
i.	Good Faith Belief of Invalidity.....	6
B.	Design Patents.....	6
1.	Jury Instructions on Infringement.....	6
a.	Role of Function	7
b.	Logo	7
III.	Relief.....	7
A.	Injunction	7
1.	Interpreting Injunctions.....	7
IV.	Claim Construction	7
A.	Claim Language	7
1.	Section 112(f).....	7
a.	When Applied	7
i.	Specific Nonce Terms.....	7
b.	How Applied.....	8
i.	Location as Structure	8
B.	Written Description.....	8
1.	Disclosed Embodiment(s).....	8
a.	Presumption of Claim Coverage.....	8
i.	Multiple Embodiments.....	8
b.	Limitations from Sole Embodiment.....	8
2.	Differences Between Claim Language and Specification Language.....	8
V.	Procedural Law	9
A.	Preclusion.....	9
1.	Claim Preclusion - Res Judicata	9
a.	Timing of Accused Acts	9
b.	Direct and Indirect Infringement	9
2.	Issue Preclusion - Collateral Estoppel	9
a.	Full and Fair Opportunity to Litigate the Issues.	9
i.	Appeal.....	9
b.	Courts, Agencies and Commissions	9
B.	Jury Issues.....	10
1.	Jury Instructions.....	10
a.	Prejudicial Effect of Erroneous Jury Instructions	10
C.	Pleadings/Parties	10
1.	Amendments	10
a.	Nonprejudicial Narrowing of Claims.....	10
VI.	Federal Circuit Appeals	10
A.	New Arguments/Issues on Appeal/Forfeiture/Waiver/Judicial Estoppel	10
1.	District Court/ITC Appeals.....	10
a.	Judicial Estoppel	10

2.	PTO Appeals	10
a.	New Arguments at the Federal Circuit	10
b.	Inadequate Objections	11
3.	Previous Appeal in Same Case	11
4.	New Issue Raised in Oral Argument	11
5.	Discretion to Reach Forfeited or Waived Issue	11
B.	Issue Preclusion on Appeal	11
1.	Unappealed Issues	11
a.	Claim Construction	11
C.	Appellate Jurisdiction	11
1.	Section 1338 Jurisdiction	11
D.	Mootness of Appealed Rulings	12
1.	Infringement Rulings	12
E.	Harmless Error	12
1.	PTAB Decisions	12
F.	Precedent	12
1.	Dictum	12
VII.	Patent Office Proceedings	13
A.	Interferences	13
1.	Post-AIA Patents	13
B.	Inter Partes Review	13
1.	Amendments	13
a.	Burdens	13
b.	Broadening Prohibition	13
c.	Preliminary Guidance under Pilot Program	13
2.	Appeal	13
a.	Sufficient Reasoning to Review	13
b.	Reversal of PTAB	14
i.	Objective Indicia	14
3.	Submitting Supplemental Information/Arguments (e.g., in reply)	14
a.	Responsiveness to Previous Briefing	14
4.	Board Final Written Decision	14
a.	New Theories Adopted by Board	14
b.	Waiver of New Theories	15
c.	Addressing Parties' Arguments	15
i.	Inadequate Analysis	15
d.	Claim Construction	15
5.	Due Process and APA Violations	15

I. Patentability Requirements

A. Prior Art Invalidity

1. Anticipation (§ 102)

a. Mirrors Infringement

i. Product by Process Claims

“[A] product-by-process claim is a product claim, even if claimed by a process by which it can be made.” “As these claims are product claims, they are anticipated by a disclosure of the same product irrespective of the processes by which they are made.” *United Therapeutics Corp. v. Liquidia Techs., Inc.*, 2022-2217, 7/24/23.

b. Claim Interpretation

i. Prior Art Discloses Genus

Anticipation affirmed where “patent claims are directed to a method of introducing fillers having certain general qualities, which general qualities [the prior art reference]’s compositions are also described as having. [Appellant] cannot use the fact that [the prior art reference] describes multiple compositions to evade an anticipation finding where [that reference] provides “as complete detail as is contained in the patent claim,” such that a skilled artisan would have understood that [that reference]’s compositions had the same generic properties as those in the [at issue] patent claims.” *Incept LLC v. Palette Life Sciences, Inc.*, 2021-2063, 8/16/23.

2. Obviousness (§ 103)

a. Analogous Prior Art

“[T]he evidence and analysis relating to the field of endeavor and reasonably pertinent prongs may overlap.” *Netflix, Inc. v. DivX, LLC*, 2022-1138, 9/11/23.

i. Same Field of Endeavor

“Unlike the reasonable-pertinence test, the field-of-endeavor test does not look to the problem that the patent purports to address.” *Netflix, Inc. v. DivX, LLC*, 2022-1138, 9/11/23.

“The Board relied on the “Field of the Invention” paragraph, but the language of that paragraph can readily be understood as identifying examples, not narrowing, even if read alone. And it must be so understood when not read in isolation. The “Summary of the Invention,” like the title of each patent, states the invention in general terms, not limited to the sacral-nerve context.” “We therefore conclude that substantial evidence does not support the Board’s limitation of “the relevant art” to sacral-nerve stimulation.” *Axonics, Inc. v. Medtronic, Inc.*, 2022-1451, 7/10/23.

b. Motivation/Apparent Reason to Combine/Modify

i. Impact of Broad Claims

“The inquiry is not whether a relevant artisan would combine a first reference’s feature with a second reference’s feature to meet requirements of the first reference that are not requirements of the claims at issue.” *Axonics, Inc. v. Medtronic, Inc.*, 2022-1451, 7/10/23.

ii. Known Reason to Combine

“It is not decisive here whether or not there are other ways to improve speed and efficiency. Regardless whether or not that is true, that does not mean improved speed and efficiency cannot provide a motivation for the method of using a tractor-type drive. It is likewise not conclusive that speed may not be the *primary* or *only* metric by which recreational boats are measured. Substantial evidence supports a finding that speed is at least a consideration.” *Volvo Penta of the Ams., LLC v. Brunswick Corp.*, 2022-1765, 8/24/23 (emphasis in original).

iii. Portions of References Serve Similar Function

“[A] skilled artisan may be motivated to combine particular features of different references, e.g., to secure some benefits at the expense of others, even when bodily incorporation would be impossible or inadvisable.” *Axonics, Inc. v. Medtronic, Inc.*, 2022-1451, 7/10/23.

iv. Incompatible Reference Requirements

“The inquiry is not whether a relevant artisan would combine a first reference’s feature with a second reference’s feature to meet requirements of the first reference that are not requirements of the claims at issue.” *Axonics, Inc. v. Medtronic, Inc.*, 2022-1451, 7/10/23.

v. Expert Testimony

“[A] broadly applicable motivation may be sufficient as long as it is supported by more than conclusory expert testimony.” *Volvo Penta of the Ams., LLC v. Brunswick Corp.*, 2022-1765, 8/24/23.

vi. Evidence of Reasons to Combine

The Board’s “finding that a skilled artisan would have been motivated to combine . . . is supported by substantial evidence, including the prosecution history of the ’648 patent, [s]pecifically . . . the patentee notably did not argue that prior art references directed to imaging devices were not relevant art.” *Elekta Ltd. v. ZAP Surgical Sys, Inc.*, 2021-1985, 9/21/23.

c. Reasonable Expectation of Success

i. Based on Motivation to Combine

“[I]n some cases, such as here, the evidence establishing a motivation to combine may establish a finding of reasonable expectation of success.” *Elekta Ltd. v. ZAP Surgical Sys, Inc.*, 2021-1985, 9/21/23.

ii. Implicit Findings

“[A] finding of reasonable expectation of success can be implicit.” “We understand that requiring less than an explicit statement may appear to be in tension with our review of Board determinations under the Administrative Procedure Act (“APA”)” “But there is no such tension where the Board makes an implicit finding on reasonable expectation of success by considering and addressing other, intertwined arguments, including, as we hold today, a motivation to combine.” *Elekta Ltd. v. ZAP Surgical Sys, Inc.*, 2021-1985, 9/21/23.

“[T]he Board made no error in addressing the issues of motivation to combine and reasonable expectation of success in the same blended manner that Elekta chose to present those very issues.” *Elekta Ltd. v. ZAP Surgical Sys, Inc.*, 2021-1985, 9/21/23.

d. Secondary Indicia of Nonobviousness

i. Presumption of Nexus

“The Board correctly found the single, conclusory sentence and one-paragraph [expert report] citation to be insufficient to show a presumption of nexus.” *Volvo Penta of the Ams., LLC v. Brunswick Corp.*, 2022-1765, 8/24/23.

ii. Weighing with other *Graham* Factors

“Even if its assignment of weight to each individual factor was supported by substantial evidence (“some weight” for copying, industry praise, and commercial success; and “very little weight” for skepticism, failure of others, and long-felt but unsolved need), it stands to reason that these individual weights would sum to a greater weight.” *Volvo Penta of the Ams., LLC v. Brunswick Corp.*, 2022-1765, 8/24/23.

B. Invalidity Based on § 112

1. Enablement (§ 1)

a. Full Scope of the Claim

i. Species Disclosures for Genus Claims

“[T]he ’590 patent’s roadmap simply directs skilled artisans to engage in the same iterative, trial-and-error process the inventors followed to discover the eleven antibodies they elected

to disclose. . . . Nor does the patent describe why the eleven disclosed antibodies perform the claimed functions, or why the other screened antibodies do not. [S]uch an instruction, without more, is not enough to enable the broad functional genus claims at issue here.” *Baxalta Inc. v. Genentech, Inc.*, 2022-1461, 9/20/23.

ii. Guidance for Identifying Undisclosed Embodiments

“Even accepting as true that skilled artisans will generate at least one claimed antibody each time they follow the disclosed process, this does not take the process out of the realm of the trial-and-error approaches rejected in *Amgen*.” *Baxalta Inc. v. Genentech, Inc.*, 2022-1461, 9/20/23.

2. Written Description (§ 1)

a. Alternative Species

“[A]nalogizing a subset of patients having a variant of a particular disease to traditional genus and species claims is inapt. It would be incorrect to fractionate a disease or condition that a method of treatment claim is directed to, and to require a separate disclosure in the specification for each individual variant of the condition (here, an individual group of pulmonary hypertension patients) in order to satisfy the enablement and written description provisions of 35 U.S.C. § 112, unless these variants are specified in the claims.” “A subset of unresponsive patients is not analogous to unsupported species in a generic claim to chemical compounds.” *United Therapeutics Corp. v. Liquidia Techs., Inc.*, 2022-2217, 7/24/23.

C. Double Patenting

1. Obviousness-Type

“The ability of the applicant to show good faith during prosecution does not entitle it to a patent term to which it otherwise is not entitled. An applicant’s ability to show that it did not engage in gamesmanship in obtaining a grant of PTA is not sufficient to overcome a finding that it has received an unjust timewise extension of term.” *In re Collect, LLC*, 2022-1293, 8/28/23.

“[W]hile the expiration date used for an ODP [obviousness-type double patenting] analysis where a patent has received PTE [Patent Term Extension, § 156] is the expiration date before the PTE has been added, the expiration date used for an ODP analysis where a patent has received PTA [Patent Term Adjustment, § 154(b)] is the expiration date after the PTA has been added.” *In re Collect, LLC*, 2022-1293, 8/28/23.

a. Terminal disclaimer

“[T]he patents at issue have all expired, precluding any late filings of terminal disclaimers.” *In re Collect, LLC*, 2022-1293, 8/28/23.

D. Section 101

1. Abstract Idea Exclusion

a. Claimed Subject Matter

“Independent claims 1 and 19 of the ’321 patent require: (1) receiving user information; (2) providing a polling question; (3) receiving and storing an answer; (4) comparing that answer to generate a “likelihood of match” with other users; and (5) displaying certain user profiles based on that likelihood.” “These independent claims are focused on “collecting information, analyzing it, and displaying certain results,” which places them in the “familiar class of claims ‘directed to’ a patent-ineligible concept.”” “The ’685 patent’s requirements that the abstract idea be performed on a “hand-held device” or that matches are “reviewable by swiping” does not alter our conclusion” Trinity Info Media, LLC v. Covalent, Inc., 2022-1308, 7/14/23.

b. Application of Information or Mathematical Algorithm(s)

Despite claim requiring “wherein the at least one manufacturing machine manufactures the components,” the Court ruled that the claim was “directed to the patent-ineligible abstract idea of extracting and transferring information from a design file to a manufacturing machine.” “Automating a previously manual process is not sufficient for patent eligibility.” Ficep Corp. v. Peddinghaus Corp., 2022-1590, 8/21/23 (nonprecedential).

c. Information Processing

“[A] claim is not rendered patent eligible merely because the abstract idea is applied on a handheld device or using a mobile application.” Trinity Info Media, LLC v. Covalent, Inc., 2022-1308, 7/14/23.

d. Inventive Concept/Transformation Exception

i. Distinguished from Novelty

“These conclusory allegations that the prior art lacked elements of the asserted claims are insufficient to demonstrate an inventive concept.” Trinity Info Media, LLC v. Covalent, Inc., 2022-1308, 7/14/23.

2. Stage of Case for Determination

a. Motion to Dismiss

i. Claim Construction Role

“A patentee must do more than invoke a generic need for claim construction or discovery to avoid grant of a motion to dismiss under § 101. Instead, the patentee must propose a specific claim construction or identify specific facts that need development and explain

why those circumstances must be resolved before the scope of the claims can be understood for § 101 purposes.” *Trinity Info Media, LLC v. Covalent, Inc.*, 2022-1308, 7/14/23.

E. Post-Issuance Invalidity

1. Reissued Patents

a. Invention Disclosed in the Original Patent

“Once a patent is granted, however, a patentee seeking to change the scope of the claims through reissue is subject to the additional statutory limitations in 35 U.S.C. § 251, including, as particularly relevant here, that the reissue claims must be directed to “the invention disclosed in the original patent.”” *In re Float‘N’Grill LLC*, 2022-1438, 7/12/23.

“[W]e hold that reissue claims broadening a limitation to cover undisclosed alternatives to a particular feature appearing from the face of the original specification to be a necessary, critical, or essential part of the invention, do not meet the original patent requirement of § 251.” *In re Float‘N’Grill LLC*, 2022-1438, 7/12/23.

“The omitted tapering limitation in *Peters* had no described functional role and its configuration was superficial at best. The original specification in *Peters* comprehensively described the metal tips many times by characteristics and functions independent of their tapering.” *In re Float‘N’Grill LLC*, 2022-1438, 7/12/23 (describing one of the few cases not upholding an invalidity challenge based on the original patent requirement).

II. Literal Infringement

A. Indirect Infringement

1. Induced Infringement

a. Intent to Induce

i. Good Faith Belief of Invalidity

“A pending, non-final litigation does not negate an intent to infringe that is otherwise supported by evidence.” *United Therapeutics Corp. v. Liquidia Techs., Inc.*, 2022-2217, 7/24/23.

B. Design Patents

1. Jury Instructions on Infringement

“Columbia correctly states that a design-patent claim’s scope is limited to the article of manufacture identified in the claim (which here is heat reflective material), and it argues that the scope of comparison prior art should be likewise limited.” “[W]e agree with Columbia.” “That is, to qualify as comparison prior art, the prior-art design must be applied

to the article of manufacture identified in the claim.” *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, 2021-2299, 9/15/23.

a. Role of Function

“A natural, relevant consideration for distinguishing one article from another involves looking to the articles’ respective functions.” *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, 2021-2299, 9/15/23.

b. Logo

“[J]ust because consumers might not be confused about an accused product’s *source*, that alone would not preclude an ordinary observer from deeming the claimed and accused *designs* similar enough to constitute design-patent infringement.” “[A] logo’s . . . potential to render an accused design dissimilar to the patented one—maybe even enough to establish non-infringement as a matter of law—should not be discounted.” *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, 2021-2299, 9/15/23.

III. Relief

A. Injunction

1. Interpreting Injunctions

“Subsequent to entering judgment in ABS I, the district court clarified that the language in its order covered straws sold by ABS that were processed with the GSS technology and imported into the United States for sale. Years later, the district court again “conclude[d]” that the judgment of ABS I “reasonably . . . cover[ed] straws produced by third parties using GSS technology as licensed by ABS.”” “We conclude that the district court’s subsequent interpretation or clarification of its initial order essentially rewrites that order.” “[T]he district court abused its discretion by interpreting its initial order in ABS I in a way that expanded that scope of the order.” *Inguran, LLC v. ABS Global, Inc.*, 2022-1385, 7/5/23 (citation omitted).

IV. Claim Construction

A. Claim Language

1. Section 112(f)

a. When Applied

i. Specific Nonce Terms

“We agree with Google and the district court that the term “unit,” in a vacuum, is defined only by the function it performs, much like terms such as “element” or “means.” See J.A. 679; see also M.P.E.P. § 2181 (including “unit for” on its list of “non-structural generic

placeholders that may invoke 35 U.S.C. § 112[, ¶ 6]”).” *WSOU Investments, LLC v. Google LLC*, 2022-1066, 9/25/23 (nonprecedential).

b. How Applied

i. Location as Structure

“However, that language merely describes the location of the communication engine, rather than what it is or how it operates.” *WSOU Investments, LLC v. Google LLC*, 2022-1066, 9/25/23 (nonprecedential).

B. Written Description

1. Disclosed Embodiment(s)

a. Presumption of Claim Coverage

i. Multiple Embodiments

“Our caselaw counsels against interpreting the claims in a way that would omit a disclosed embodiment absent clear evidence to the contrary.” *Apple Inc. v. Corephotonics, Ltd.*, 2022-1350, 9/11/23.

b. Limitations from Sole Embodiment

CAFC affirmed construction rejecting limitation to UMTS and GSM networks. “The specification, while only expressly disclosing embodiments in a UMTS or GSM network, also broadly teaches: [t]he invention is applicable in many different cellular telecommunication systems, such as the UMTS system or the GSM system. The invention is applicable in any such cellular telecommunication system, in which the cellular telecommunication network sends a rejection message as a response to a connection setup request from a mobile station, if the network is unable to provide the requested connection.” *Sisvel Int’l S.A. v. Sierra Wireless, Inc.*, 2022-1387, 9/1/23.

2. Differences Between Claim Language and Specification Language

Broad interpretation covering any of the disclosed types appropriate where “the inventor took pains in the specification to describe different types of point of view—Wide position, Wide perspective, Tele position, and Tele perspective—but intentionally chose to claim only “a point of view of the Wide camera.” *Apple Inc. v. Corephotonics, Ltd.*, 2022-1350, 9/11/23.

V. Procedural Law

A. Preclusion

1. Claim Preclusion - Res Judicata

a. Timing of Accused Acts

“Indeed, claim preclusion requires that the claim either was asserted, or could have been asserted, in the prior action. If, for example, the claim did not exist at the time of the earlier action, it could not have been asserted in that action and is not barred by res judicata.” *Inguran, LLC v. ABS Global, Inc.*, 2022-1385, 7/5/23 (citation omitted).

b. Direct and Indirect Infringement

“There is no dispute that the parties and the asserted ’987 patent are the same between ABS I and ABS III, or that there was a final judgment on the merits.” “An induced patent infringement claim brought at the time of trial in ABS I would have been based on speculation, in part because the parties stipulated to direct infringement and the question of inducement was not before the jury. We agree with ST that it could not have asserted an inducement claim during ABS I. Accordingly, the district court erred in applying res judicata or claim preclusion to ST’s induced infringement claim.” *Inguran, LLC v. ABS Global, Inc.*, 2022-1385, 7/5/23.

2. Issue Preclusion - Collateral Estoppel

a. Full and Fair Opportunity to Litigate the Issues.

i. Appeal

“To be sure, collateral estoppel can be applied based on a district court decision that is still pending on appeal, and we have affirmed the application of issue preclusion even when the preclusive judgment was pending appeal.” *Uniloc USA, Inc. v. Motorola Mobility*, 2021-1555, 11/4/22. [*But see* *United Therapeutics Corp. v. Liquidia Techs., Inc.*, 2022-2217, 7/24/23 (“And we have previously held that an IPR decision does not have collateral estoppel effect until that decision is affirmed or the parties waive their appeal rights.”)]

b. Courts, Agencies and Commissions

“Further, as the court noted, the Board’s final written decision does not cancel claims; the claims are cancelled when the Director issues a certificate confirming unpatentability, which occurs only after “the time for appeal has expired or any appeal has terminated.” 35 U.S.C. § 318(b). The ’793 IPR decision thus has no impact here on a finding of induced infringement.” *United Therapeutics Corp. v. Liquidia Techs., Inc.*, 2022-2217, 7/24/23.

B. Jury Issues

1. Jury Instructions

a. Prejudicial Effect of Erroneous Jury Instructions

“Whether a particular reference meets that standard for comparison prior art—i.e., whether it discloses a design applied to the article of manufacture identified in the claim—is a question of fact reserved for the fact finder (at least, where there could be reasonable disagreement on that fact question such that it has not been reduced to a question of law). But the standard *itself* is legal. And the failure to provide it was error—albeit quite an understandable one, given that we have only now articulated the standard.” *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, 2021-2299, 9/15/23 (emphasis in original) (citation omitted).

C. Pleadings/Parties

1. Amendments

a. Nonprejudicial Narrowing of Claims

The reduction in the number of asserted trade secrets pursuant to a stipulated order setting forth required narrowing at certain times “occurred without prejudice.” *Teradata Corp. v. SAP SE*, 2022-1286, 8/1/23 (nonprecedential) (citing *Hells Canyon Preservation Council v. U.S. Forest Service*, 403 F.3d 683, 690 (9th Cir. 2005) (“It is axiomatic that prejudice does not attach to a claim that is properly dropped from a complaint under Rule 15(a) prior to final judgment.”))

VI. Federal Circuit Appeals

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

1. District Court/ITC Appeals

a. Judicial Estoppel

“And we see no equity in letting a position Columbia took while securing a (currently inapplicable) damages award impede its efforts to secure infringement liability—and thus damages—at all.” *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, 2021-2299, 9/15/23.

2. PTO Appeals

a. New Arguments at the Federal Circuit

“Volvo Penta forfeited the argument that Kiekhaefer’s statement only related to racing boats, and not recreational sport boats, by not making it before the Board.” *Volvo Penta of the Ams., LLC v. Brunswick Corp.*, 2022-1765, 8/24/23.

b. Inadequate Objections

“Rembrandt’s generic objection is insufficient to constitute a proper objection—especially because Rembrandt expressly objected to other allegedly new theories without doing so here.” *Rembrandt Diagnostics, LP v. Alere, Inc.*, 2021-1796, 8/11/23.

3. Previous Appeal in Same Case

“Insofar as Columbia I concerned the D’093 patent, Columbia came to this court as the appellee, having prevailed on infringement. We therefore do not see—nor has Seirus supplied—any reason why Columbia should have quibbled with the district court’s decision not to construe the claim.” *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, 2021-2299, 9/15/23.

4. New Issue Raised in Oral Argument

During oral argument, appellant argued that the “Board failed to consider its argument that the teachings of certain prior art references did not render substitute claim 36 obvious, in view of the limitations Sisvel added to the new claim.” “Counsel acknowledged, however, that it did not make this argument in its briefing to us.” “Thus, the issue is forfeited.” *Sisvel Int’l S.A. v. Sierra Wireless, Inc.*, 2022-1387, 9/1/23.

5. Discretion to Reach Forfeited or Waived Issue

“Still, whether to excuse a forfeiture is generally within our discretion.” “Because we are just now articulating this scope, we deem it the better course to allow the parties and the district court to engage with it afresh—both as to Blauer and other references.” *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, 2021-2299, 9/15/23.

B. Issue Preclusion on Appeal

1. Unappealed Issues

a. Claim Construction

“We need not address whether the district court’s construction was correct because Liquidia, on appeal, does not challenge that construction.” *United Therapeutics Corp. v. Liquidia Techs., Inc.*, 2022-2217, 7/24/23.

C. Appellate Jurisdiction

1. Section 1338 Jurisdiction

Answered whether “patent-infringement counterclaims arise out of the same transaction or occurrence as [] relevant technical-trade-secret claims so that they are compulsory counterclaims” in the negative. Appeal of affirmative antitrust and trade secret claims was then transferred to the regional circuit. *Teradata Corp. v. SAP SE*, 2022-1286, 8/1/23 (nonprecedential).

“Our jurisdiction depends on the complaint as *amended*.” *Teradata Corp. v. SAP SE*, 2022-1286, 8/1/23 (nonprecedental) (citing *Chamberlain Group, Inc. v. Skylink Technologies, Inc.*, 381 F.3d 1178, 1189 (Fed. Cir. 2004)).

D. Mootness of Appealed Rulings

1. Infringement Rulings

“We need not evaluate this argument that claims 1–3 of the ’066 patent are not infringed, because Liquidia correctly argues that the district court did not clearly err in finding those claims invalid as anticipated by Moriarty.” *United Therapeutics Corp. v. Liquidia Techs., Inc.*, 2022-2217, 7/24/23.

E. Harmless Error

1. PTAB Decisions

“It was therefore an error for the Board to rely on Mr. Sweet’s testimony for the knowledge of a skilled artisan.” “Nonetheless, the Board’s reliance on Mr. Sweet’s testimony does not deprive the Board’s finding of motivation to combine as being supported by substantial evidence. Substantial evidence exists when a reasonable fact finder could have reached the same conclusion when considering the record as a whole.” *Volvo Penta of the Ams., LLC v. Brunswick Corp.*, 2022-1765, 8/24/23.

“That legally incorrect framing of its motivation inquiry was not harmless. The Board did not find that the critical space limitations of the trigeminal-nerve area are present elsewhere, including the sacral-nerve area. And the Board did not rely on any ground for rejecting the motivation argument of Axonics that is independent of the legally erroneous framing.” *Axonics, Inc. v. Medtronic, Inc.*, 2022-1451, 7/10/23.

F. Precedent

1. Dictum

“Moreover, in the patentee’s appeal to this court, the only developed argument in its opening brief concerning the district court’s treatment of the prior art was that the district court had improperly revived the point-of-novelty test—an argument we separately rejected. We therefore do not regard *Lanard* as controlling on the proper scope of comparison prior art.” *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, n.8, 2021-2299, 9/15/23 (emphasis in original) (citations omitted).

VII. Patent Office Proceedings

A. Interferences

1. Post-AIA Patents

“SNIPR’s pure AIA patents were examined and issued under the AIA’s first-inventor-to-file patentability requirements; they cannot then be cancelled under the different, pre-AIA invention priority requirements. As such, the Director erred by declaring an interference involving the SNIPR Patents.” SNIPR Techs. Ltd. v. Rockefeller Univ., 2022-1260, 7/14/23.

B. Inter Partes Review

1. Amendments

a. Burdens

“[I]t is Sisvel’s burden, as the patent owner, to show that the proposed amendment complies with relevant regulatory and statutory requirements.” Sisvel Int’l S.A. v. Sierra Wireless, Inc., 2022-1387, 9/1/23.

b. Broadening Prohibition

“If the Board legally erred in concluding that the proposed substitute claims were broader than Sisvel’s original claims, the Board would have abused its discretion in denying the motion to amend on that ground, and we would have to reverse (absent any alternative ground justifying the denial).” Sisvel Int’l S.A. v. Sierra Wireless, Inc., 2022-1387, 9/1/23.

c. Preliminary Guidance under Pilot Program

“Preliminary guidance is just that, preliminary, and the Board retains authority to reject proposed substitute claims even if it preliminarily indicates it is likely to grant such claims.” Sisvel Int’l S.A. v. Sierra Wireless, Inc., 2022-1387, 9/1/23.

2. Appeal

a. Sufficient Reasoning to Review

“[T]he Board’s analysis of objective indicia of nonobviousness, including its assignments of weight to different considerations, was overly vague and ambiguous.” “We therefore vacate and remand for further consideration consistent with this opinion. The Board should make additional findings as needed, considering the totality of the evidence of obviousness, including the teachings of the combined references in relation to secondary considerations.” Volvo Penta of the Ams., LLC v. Brunswick Corp., 2022-1765, 8/24/23.

b. Reversal of PTAB

i. Objective Indicia

“The Board’s finding of a lack of nexus is therefore not supported by substantial evidence. We hold that Volvo Penta demonstrated a nexus between the claims and its evidence of secondary considerations.” *Volvo Penta of the Ams., LLC v. Brunswick Corp.*, 2022-1765, 8/24/23.

3. Submitting Supplemental Information/Arguments (e.g., in reply)

“In each final written decision, the Board adopted a claim construction first presented in the patent owner’s response after the institution decision and declined to consider Axonics’ reply arguments and evidence under the new claim construction. We hold that the Board’s refusal to consider the new arguments and evidence was erroneous, and we vacate and remand for the Board to consider the merits of Axonics’ responsive arguments and evidence under the new claim construction.” “That is not to say a petitioner may rely on new prior art in response to a new claim construction presented in the patent owner response.” “We leave for another day the question of whether, when presented with a new claim construction, a petitioner can rely in its reply on new embodiments from the prior art references that were relied on in the petition.” *Axonics, Inc. v. Medtronic, Inc.*, 2022-1532, 8/7/23.

a. Responsiveness to Previous Briefing

“[R]eply argument discussing cost and time savings has a nexus to Rembrandt’s prior argument and is responsive. It refutes Rembrandt’s assertions that there is no motivation to add multiple test strips or an expectation of success. And by discussing time and cost savings as a form of efficiency, it also properly expands on and is a fair extension of its previously raised efficiency argument.” *Rembrandt Diagnostics, LP v. Alere, Inc.*, 2021-1796, 8/11/23.

4. Board Final Written Decision

a. New Theories Adopted by Board

Patentee “briefly noted—in the Background section of its Patent Owner Response—that, [petitioner’s argument had an error]” but “did not mention this error again. It did not, for example, mention this typographical error at any point in its argument regarding obviousness or allege that this error altered whether the prior art combination discloses any of the claimed lens parameters.” “[T]he Board’s determination that the typographical error in Dr. Sasián’s declaration was essentially dispositive of the issues in the case does not comport with the notice requirements of the APA” *Apple Inc. v. Corephotonics, Ltd.*, 2022-1350, 9/11/23.

b. Waiver of New Theories

“Taken together and in context” a petitioner may make an argument sufficient in detail for the Board to abuse its discretion in refusing to consider it. *Netflix, Inc. v. DivX, LLC*, 2022-1138, 9/11/23.

c. Addressing Parties’ Arguments

i. Inadequate Analysis

“[I]n this unique case, where the Board found Netflix’s reply brief so deficient as to not present any argument regarding the field of endeavor, we are reluctant to affirm the Board’s factual finding, which rests on a failure to identify a field of endeavor rather than a clear analysis of why Kaku is not, in fact, directed to the same field of endeavor.” *Netflix, Inc. v. DivX, LLC*, 2022-1138, 9/11/23.

d. Claim Construction

“There is no rule, for example, requiring a petition to describe all possible or reasonable claim constructions and to present invalidity theories under those constructions.” *Axonics, Inc. v. Medtronic, Inc.*, 2022-1532, 8/7/23.

5. Due Process and APA Violations

“[A] petitioner is entitled under the APA to respond to new claim construction arguments made by a patent owner or adopted by the Board sua sponte and [] both parties are entitled to respond to a new construction adopted by the Board sua sponte after an institution decision.” *Axonics, Inc. v. Medtronic, Inc.*, 2022-1532, 8/7/23.