

## Table of Contents

I.	Patentability Requirements .....	1
A.	Prior Art Invalidity.....	1
1.	Reference Disclosure .....	1
a.	Disclosure to POSITA .....	1
i.	No Substantial Evidence.....	1
2.	Anticipation (§ 102).....	1
a.	Published/Issued Application Under 102(e).....	1
b.	Enablement .....	1
3.	Obviousness (§ 103) .....	2
a.	Reasonable Expectation of Success .....	2
i.	Single Reference .....	2
B.	Invalidity Based on § 112 .....	2
1.	Enablement (¶ 1).....	2
a.	Full Scope of the Claim .....	2
b.	Expert Testimony.....	2
2.	Indefiniteness (¶ 2).....	3
a.	Valid.....	3
i.	Construable .....	3
C.	Section 101.....	3
1.	Abstract Idea Exclusion .....	3
a.	Claimed Subject Matter .....	3
b.	Inventive Concept/Transformation Exception.....	3
2.	Stage of Case for Determination.....	3
a.	Motion to Dismiss.....	3
i.	Treatment of Factual Allegations.....	3
ii.	Lack of Expert Testimony .....	4
II.	Other Defenses.....	4
A.	Lack of Subject Matter Jurisdiction.....	4
1.	Substantial Question of Federal Patent Law .....	4
a.	Walker-Process Claim .....	4
B.	Lack of Personal Jurisdiction.....	4
1.	Over Patentee .....	4
a.	Notice Letters.....	4
b.	Other Non-exclusive Patent Licensees .....	4
2.	Fair Play and Substantial Justice.....	4
C.	No Ownership/Standing (see also II.C.2) .....	5
1.	Assignment .....	5
a.	Employment Agreements.....	5
D.	Laches .....	5
1.	In Prosecution .....	5
III.	Literal Infringement .....	6
A.	Indirect Infringement .....	6
1.	Contributory Infringement.....	6
a.	Substantial Noninfringing Uses .....	6

IV.	DOE Infringement .....	6
A.	Vitiation Bar/Specific Exclusion .....	6
1.	Opposite Feature/Element/Step .....	6
V.	Claim Construction .....	6
A.	Claim Language .....	6
1.	Preambles .....	6
a.	Top Level Label is Limiting or Affects Body Construction.....	6
2.	Plain and Ordinary Meaning .....	6
a.	Exceptions.....	7
i.	Prosecution/Specification Disavowal .....	7
ii.	Contrary Embodiment(s) .....	7
3.	Open/Closed Claims, Generic and Negative Limitations .....	7
a.	Conjoined Elements .....	7
4.	Functional and Structural Language .....	7
a.	Functional Definitions of Limitations, e.g. “such that” .....	7
5.	Effect of Other Limitations in Claim .....	7
a.	No Surplusage.....	7
B.	Written Description.....	8
1.	Lexicography .....	8
a.	Definition by Contrast.....	8
2.	Disclosed Embodiment(s).....	8
a.	Limiting Construction.....	8
C.	Prefer Narrow/Preserve Validity.....	8
D.	Timing of Construction and Parties’ Positions .....	8
1.	Construing the Construction .....	8
VI.	Procedural Law .....	8
A.	Setting Aside Judgment (60(b)).....	8
1.	Fraudulent Evidence .....	8
B.	JMOL (Rule 50) / Summary Judgment (Rule 56) .....	9
1.	Evidence Required to Oppose Summary Judgment.....	9
C.	Discovery/Evidence .....	9
1.	Expert Testimony.....	9
a.	Based on Inadmissible Material.....	9
2.	Hearsay .....	9
a.	Business Records Exception.....	9
D.	Transfer to New Judge or Venue .....	10
1.	Determining Venues Where Case Could Have Been Brought .....	10
2.	Sources of Proof Factor .....	10
3.	Cost of Attendance of Willing Witnesses Factor.....	10
4.	Local Interest Factor .....	11
5.	Congestion Factor .....	11
VII.	Federal Circuit Appeals .....	11
A.	New Arguments/Issues on Appeal/Forfeiture/Waiver/Judicial Estoppel .....	11
1.	District Court/ITC Appeals.....	11
a.	Claim Construction Waiver .....	11
i.	Construction Advocated at Markman .....	11

2.	Discretion to Reach Waived Issue .....	11
3.	Mischaracterizations of Reviewed Decision.....	11
B.	Appellate Jurisdiction .....	12
1.	Final Judgment.....	12
a.	Orders Not Titled Final Judgment .....	12
C.	Cross-Appeals v. Alternate Bases for Affirmance.....	12
1.	Conditional Cross-Appeals .....	12
D.	Standards of Review and Record/Appendix on Appeal .....	12
1.	Substantial Evidence Threshold.....	12
a.	Expert Testimony.....	12
i.	Not Required.....	12
b.	Documentary Evidence.....	12
c.	Conflicting Evidence .....	12
d.	Implied Jury Findings .....	13
2.	Abuse of Discretion .....	13
a.	Granting New Trial.....	13
E.	Precedent.....	13
1.	Conflicting/Vacated/Implicitly Overruled Decisions .....	13
F.	Remand Determination .....	13
1.	Remand for Sufficient Reasoning to Review.....	13
2.	Judicial Notice on Appeal.....	13
G.	Substitution of Parties on Appeal .....	14
VIII.	Patent Office Proceedings.....	14
A.	Inter Partes Review .....	14
1.	Appeal.....	14
a.	Jurisdiction Over Appeals Challenging PTAB Decisions .....	14
i.	Petitioner Appeals of Final Written Decision.....	14
ii.	Standing Evidence .....	14
2.	Obviousness Rulings.....	14
a.	Reversal.....	14
B.	Post-Grant Reviews .....	15
1.	Estoppel.....	15
C.	Appeals to District Court Under Sections 145 and 146.....	15

## **I. Patentability Requirements**

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

#### **1. Reference Disclosure**

##### **a. Disclosure to POSITA**

###### **i. No Substantial Evidence**

“The Board determined that Alexander does not teach or render obvious the verification limitation. . . . We conclude that the Board’s determination is not supported by substantial evidence.” “In the context of Alexander, “may” does not mean “occasionally,” but rather that one “may” choose to systematically check each step. This is quite clear from the context of Alexander.” “Plainly, Alexander discloses systematic step-by-step review and authorization by the pharmacist.” *Becton, Dickinson and Co. v. Baxter Corp.* Englewood, 2020-1937, 5/28/21.

“The Board’s determination [that a reference did not support obviousness of highlighting information in the pharmacy field] is not supported by substantial evidence” where a reference taught “to highlight patient characteristics when dispensing a prepackaged medication” and an expert testified without contradiction that “a person of ordinary skill [would have included] other information in the pharmacy field.” *Becton, Dickinson and Co. v. Baxter Corp.* Englewood, 2020-1937, 5/28/21.

#### **2. Anticipation (§ 102)**

##### **a. Published/Issued Application Under 102(e)**

“The text of the statute requires only that the patent be “granted,” meaning the “grant[]” has occurred. 35 U.S.C. § 102(e)(2) (pre-AIA). The statute does not require that the patent be currently valid.” *Becton, Dickinson and Co. v. Baxter Corp.* Englewood, 2020-1937, 5/28/21.

##### **b. Enablement**

“Thus, regardless of the forum, prior art patents and publications enjoy a presumption of enablement, and the patentee/applicant has the burden to prove nonenablement for such prior art. It was error for the Board to suggest otherwise.” *Apple Inc. v. Corephotonics, Ltd.*, 2020-1438, 6/23/21 (nonprecedential).

### **3. Obviousness (§ 103)**

#### **a. Reasonable Expectation of Success**

##### **i. Single Reference**

“[I]f an obviousness case is based on a non-self-enabled reference, and no other prior art reference or evidence would have enabled a skilled artisan to make the claimed invention, then the invention cannot be said to have been obvious.” Raytheon Techs. Corp. v. Gen’l Elec. Co., 2020-1755, 4/16/21.

“[T]he Board found that [a reference] discloses [a limitation]. During the proceeding, [patentee] submitted un rebutted evidence establishing that [the reference]’s disclosure of [the limitation] was based on the use of nonexistent composite materials. In response, the petitioner [] never put forth any evidence suggesting a skilled artisan could have made [the subject matter] recited in the claims. Because the relied-upon prior art fails to enable a skilled artisan to make and use the claimed invention, we reverse.” Raytheon Techs. Corp. v. Gen’l Elec. Co., 2020-1755, 4/16/21.

#### **B. Invalidity Based on § 112**

##### **1. Enablement (§ 1)**

###### **a. Full Scope of the Claim**

Testimony that a claimed method could be performed does not require JMOL of enablement because “the jury could have understood Dr. Goldman to be saying no more than that a relevant artisan could have [performed the claim method] on the particular subset of nucleic acids addressed in the [prior art].” “Especially in light of other evidence about the difference between the synthetic nucleic acids [the prior art] addressed and biological DNA, the jury could properly understand the specific answer to the specific question on which PacBio relies not to be conceding that a skilled artisan could make and use the full scope of the invention.” Pac. Biosciences of Cal., Inc. v. Oxford Nanopore Techs., Inc., 2020-2155, 5/11/21.

###### **b. Expert Testimony**

“[W]hat its expert “constructed” was a computer model simulation of Knip’s imagined engine, not a physical working engine. GE’s expert never suggested that a skilled artisan could have actually built such an engine.” Raytheon Techs. Corp. v. Gen’l Elec. Co., 2020-1755, 4/16/21 (citation omitted).

## **2. Indefiniteness (¶ 2)**

### **a. Valid**

#### **i. Construable**

“[A]ll the Commission (and ALJ) did was to resolve, correctly, a potential uncertainty in an initial formulation of the proper claim meaning, a process that does not support a conclusion of indefiniteness.” *Bio-Rad Labs., Inc. v. Int’l Trade Comm’n*, n.5, 2020-1785, 4/29/21.

## **C. Section 101**

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

#### **a. Claimed Subject Matter**

Result of camera system claim used as abstract idea, where last limitation is a processor with “producing . . .” language that district court used as abstract idea. “At the outset, we note that claim 1 results in [the abstract idea].” For the other limitations, “as claimed, these conventional components perform only their basic functions.” *Yu v. Apple Inc.*, 2020-1760, 6/11/21.

“In these circumstances, the mismatch between the specification statements that Yu points to and the breadth of claim 1 underscores that the focus of the claimed advance is the abstract idea and not the particular configuration discussed in the specification that allegedly departs from the prior art.” *Yu v. Apple Inc.*, 2020-1760, 6/11/21.

“The asserted claims do not incorporate any such methods [discussed in the specification] of piercing the sandbox.” *Free Stream Media Corp. v. Alphonso Inc.*, 2019-1506, 5/11/21.

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

“[S]uch a “work around” or “bypassing” of a client device’s sandbox security does nothing more than describe the abstract idea of providing targeted content to a client device.” *Free Stream Media Corp. v. Alphonso Inc.*, 2019-1506, 5/11/21.

## **2. Stage of Case for Determination**

### **a. Motion to Dismiss**

#### **i. Treatment of Factual Allegations**

“Here, the district court considered the intrinsic record and concluded that the claims were directed to patent-ineligible subject matter, despite Yu’s allegations to the contrary. This is not error.” *Yu v. Apple Inc.*, 2020-1760, 6/11/21.

## ii. Lack of Expert Testimony

“[P]atent eligibility can be determined at the Rule 12(b)(6) stage without the aid of expert.” Yu v. Apple Inc., 2020-1760, 6/11/21.

## II. Other Defenses

### A. Lack of Subject Matter Jurisdiction

#### 1. Substantial Question of Federal Patent Law

##### a. Walker-Process Claim

Federal Circuit transferred Walker-Process claim to regional circuit. “Although we do not hold that our jurisdiction turns on whether a patent can still be asserted, we find it significant that Appellants fail to clearly raise any patent law questions not already addressed in [a previous appeal].” Chandler v. Phoenix Services LLC, 20-1848, 6/10/21.

### B. Lack of Personal Jurisdiction

“Because the parties do not dispute the jurisdictional facts, we review the question of personal jurisdiction de novo.” Trimble Inc. v. PerDiemCo LLC, 2019-2164, 5/12/21.

#### 1. Over Patentee

“[T]he minimum contacts or purposeful availment test is satisfied in this case.” “PerDiemCo exchanged twenty-two communications with Trimble in California over a period of three months.” “PerDiemCo had negotiated some ten other nonexclusive licenses, including several with large firms operating nationwide.” Trimble Inc. v. PerDiemCo LLC, 2019-2164, 5/12/21.

##### a. Notice Letters

“Three subsequent developments have clarified the scope of *Red Wing*.” “*Red Wing* remains correctly decided with respect to the limited number of communications involved in that case.” Trimble Inc. v. PerDiemCo LLC, 2019-2164, 5/12/21.

##### b. Other Non-exclusive Patent Licensees

“In light of *Ford* [*Ford Motor Co. v. Mont. Eighth Jud. Dist. Ct.*, 141 S. Ct. 1017 (2021)], just as sales of similar vehicles and the presence of dealerships in a forum can support personal jurisdiction in the tort context, so too can nonexclusive patent licenses in this case.” Trimble Inc. v. PerDiemCo LLC, 2019-2164, 5/12/21.

#### 2. Fair Play and Substantial Justice

To escape jurisdiction despite sufficient contacts, a patentee must make a compelling case that “five factors from *Burger King* and *World-Wide Volkswagen* relating to the question whether the exercise of personal jurisdiction would comport with fair play and substantial

justice” establish that jurisdiction would be unreasonable. *Trimble Inc. v. PerDiemCo LLC*, 2019-2164, 5/12/21.

EDTX “office” does not give weight to factor 1 where it is not used. “While PerDiemCo claims to have offices in the Eastern District of Texas, Mr. Babayi, PerDiemCo’s sole employee, has never visited that office and his office is in Washington, D.C.” *Trimble Inc. v. PerDiemCo LLC*, 2019-2164, 5/12/21.

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

**1. Assignment**

**a. Employment Agreements**

Where assignment provisions apply to “intellectual property” that an employee “creates . . . during the term of Employee’s employment with the Company,” where that intellectual property is defined to include “inventions, and other ideas,” the Court concluded that “the assignment provisions do not apply to a signatory’s ideas developed during the employment [] solely because the ideas ended up contributing to a post-employment patentable invention in a way that supports co-inventorship of that eventual invention.” “[T]he pertinent intellectual property does not exist until at least conception of that invention.” *Bio-Rad Labs., Inc. v. Int’l Trade Comm’n*, 2020-1785, 4/29/21.

**D. Laches**

**1. In Prosecution**

“Hyatt’s delay of more than six years, by any measure, shifts the burden to Hyatt to prove that Hyatt’s delay has not caused the PTO or any third party material prejudice.” *Hyatt v. Hirshfeld*, 2018-2390, 6/1/21.

Where an applicant’s “approach to prosecuting [] applications made it impossible for the PTO to process them using its normal compact prosecution procedures” then “exemplary figures [regarding the PTO’s high costs], combined with the details surrounding Hyatt’s pattern of prosecution conduct, show that the PTO has carried its burden of proving that Hyatt’s prosecution of his applications clearly abused the PTO’s patent examination system and that that clear abuse contributed to the delay that occurred with respect to the four applications at issue.” *Hyatt v. Hirshfeld*, 2018-2390, 6/1/21.

### **III. Literal Infringement**

#### **A. Indirect Infringement**

##### **1. Contributory Infringement**

###### **a. Substantial Noninfringing Uses**

Accused infringer's hypothetical uses not relevant where it "failed to point to any real available noninfringing uses." *Bio-Rad Labs., Inc. v. Int'l Trade Comm'n*, 2020-1475, 5/28/21.

### **IV. DOE Infringement**

#### **A. Vitiating Bar/Specific Exclusion**

##### **1. Opposite Feature/Element/Step**

"[W]e conclude that the district court erred in evaluating this element as a binary choice between a single-component structure and a multi-component structure, rather than evaluating the evidence to determine whether a reasonable juror could find that the accused products perform substantially the same function, in substantially the same way, achieving substantially the same result as the claims." *Edgewell Personal Care Brands, LLC v. Munchkin, Inc.*, 2020-1203, 5/26/21.

### **V. Claim Construction**

#### **A. Claim Language**

##### **1. Preambles**

###### **a. Top Level Label is Limiting or Affects Body Construction**

"The parties do not dispute that the '420 patent claims are directed only to a cassette. Therefore, absent an express limitation to the contrary, the term "clearance" should be construed as covering all uses of the claimed cassette." *Edgewell Personal Care Brands, LLC v. Munchkin, Inc.*, 2020-1203, 5/26/21.

##### **2. Plain and Ordinary Meaning**

"[W]e arrive at that construction by focusing on the prosecution history, the specification, and the context of the particular claims in which the term "intercepting" appears. Those pieces of intrinsic evidence outweigh Uniloc's reliance on dictionary definitions; analogies; and the purported plain meaning of "intercepting" in isolation." *Uniloc 2017 LLC v. Apple Inc.*, 2020-1403, 5/12/21 (citations omitted).

**a. Exceptions**

**i. Prosecution/Specification Disavowal**

“In no uncertain terms, “the applicant[]s argued that Schwartz had a ‘hierarchical’ relationship between fields and values that fell outside the scope of the amended claims.” Therefore, the claims exclude predefined field-and-value relationships as explained by the district court. They are disclaimed.” “[Patentee’s] interpretation leads to the paradoxical result that the claims cover hierarchical relationships between fields and values but not among values, even though Schwartz discloses that exact arrangement.” *SpeedTrack, Inc. v. Amazon.com, Inc.*, 2020-1573, 6/3/21.

**ii. Contrary Embodiment(s)**

“Intercepting” interpreted to cover receipt from a “sending client device [] intentionally direct[ing] the message to the intercepting entity” where “the patent contemplates that the sending client device will purposely direct the message through an intermediate recipient.” *Uniloc 2017 LLC v. Apple Inc.*, 2020-1403, 5/12/21.

**3. Open/Closed Claims, Generic and Negative Limitations**

**a. Conjoined Elements**

“The Commission properly found that, after the specified oligonucleotides have been releasably attached to the gel bead, the specified “oligonucleotides are part of the gel bead.” *Bio-Rad Labs., Inc. v. Int’l Trade Comm’n*, 2020-1785, 4/29/21.

**4. Functional and Structural Language**

**a. Functional Definitions of Limitations, e.g. “such that”**

“The claim contains more than 25 lines of text that characterize and define the features of the chip (e.g., wells and channels) by differentiating them from each other based on the material (e.g., sample, background fluid, or droplets) that is contained within them. Inventors are masters of their claims, and the words they use to describe and claim their invention are decisive and binding.” “[T]he inventors chose to characterize the wells and channels based on the material contained within them. [Appellant] cannot escape that choice by pointing to the general proposition of law that “apparatus claims cover what a device is, not what a device does.”” *Bio-Rad Labs., Inc. v. Int’l Trade Comm’n*, 2020-1475, 5/28/21 (omitting citations).

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

**a. No Surplusage**

“The district court also added that including “one-way” in the construction would improperly read “session” out of the claims, because Samba’s construction would then

encompass any “communication.” We agree.” Free Stream Media Corp. v. Alphonso Inc., 2019-1506, 5/11/21 (citation omitted).

## **B. Written Description**

### **1. Lexicography**

#### **a. Definition by Contrast**

“The compelling factor here is the distinction between “samples” and “reagents.”” “[The] opening sentences of the introduction section [distinguish them:] “**samples** combined with **reagents**” and “using target-specific **reagents** can provide high-quality information about **samples**.” “[T]he patent defines a “reagent” as “a compound, set of compounds, and/or composition that is **combined with a sample**.”” Bio-Rad Labs., Inc. v. Int’l Trade Comm’n, 2020-1475, 5/28/21 (emphasis in original).

### **2. Disclosed Embodiment(s)**

#### **a. Limiting Construction**

Because “in each of these examples, the output multimedia data stream is being output from the integrated multimedia encoding system,” it was proper to limit “output multimedia data stream” to “combined audio and video stream that are output from the system.” Wi-LAN Inc. v. Sharp Elecs. Corp., 2020-1041, 4/6/21.

## **C. Prefer Narrow/Preserve Validity**

“[A]rguments based on prior art . . . necessarily carry less weight in the claim construction analysis.” Bio-Rad Labs., Inc. v. Int’l Trade Comm’n, 2020-1475, 5/28/21.

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

### **1. Construing the Construction**

“As the district court recognized, its summary judgment order resolved a further claim construction dispute between the parties, adding a limitation not present in the original construction.” “The district court’s clarification that the “clearance” cannot be filled by an unclaimed interfering member, therefore, constitutes a separate claim construction subject to our review.” Edgewell Personal Care Brands, LLC v. Munchkin, Inc., 2020-1203, 5/26/21.

## **VI. Procedural Law**

### **A. Setting Aside Judgment (60(b))**

#### **1. Fraudulent Evidence**

CAFC affirmed district court setting aside judgment and injunction where party’s president testified in his individual capacity that he was not aware of certain prior art and sales

activity was later found to have occurred, even though “Rule 60(b)(3) requires that the fraud, misrepresentation, or misconduct be by “an opposing party.”” “Here, Lawrie, Zinus’s president and expert witness, misrepresented his knowledge of highly material prior art. The district court properly declined to condone such conduct.” *Cap Export, LLC v. Zinus, Inc.*, n.9, 2020-2087, 5/5/21.

“A motion under Rule 60(b)(3) “must be made within a reasonable time,” and “no more than a year after the entry of the judgment or order or the date of the proceeding.” Fed. R. Civ. P. 60(c)(1). The motion here satisfied the one-year requirement.” *Cap Export, LLC v. Zinus, Inc.*, n.9, 2020-2087, 5/5/21.

## **B. JMOL (Rule 50) / Summary Judgment (Rule 56)**

### **1. Evidence Required to Oppose Summary Judgment**

“[D]eclarations are typically used at summary judgment as a proxy for trial testimony. But declarations cannot be used for this purpose unless the witness will be available to testify at trial.” “[W]hen asked by the court at the summary judgment hearing whether the declarants would appear at trial, Wi-LAN’s counsel responded that Wi-LAN did not “think that [it would be] able to force them to come to trial.”” “Wi-LAN thus did not establish that the declarants would be available to testify at trial and, as a result, the declarations could not be used as a substitute for trial testimony.” *Wi-LAN Inc. v. Sharp Elecs. Corp.*, 2020-1041, 4/6/21.

## **C. Discovery/Evidence**

### **1. Expert Testimony**

#### **a. Based on Inadmissible Material**

“[E]xpert reliance does not translate to admissibility.” *Wi-LAN Inc. v. Sharp Elecs. Corp.*, 2020-1041, 4/6/21.

“The burden to establish reasonable reliance is on the proponent of challenged expert testimony.” *Wi-LAN Inc. v. Sharp Elecs. Corp.*, 2020-1041, 4/6/21.

“[Appellant] argues that experts typically rely on material, like source code, in reaching opinions about infringement. That is obviously correct. But [appellant] has not made a showing that source code experts reasonably rely on unauthenticated source code printouts.” *Wi-LAN Inc. v. Sharp Elecs. Corp.*, 2020-1041, 4/6/21.

### **2. Hearsay**

#### **a. Business Records Exception**

“Instead, the declarations were created and prepared for the purposes of litigation, placing them outside the scope of the exception. As a result, the declarations were not admissible

as business records for use to authenticate the source code printout.” *Wi-LAN Inc. v. Sharp Elecs. Corp.*, 2020-1041, 4/6/21.

“[Proponent] does not meet Rule 803(6)’s final requirement that “the opponent does not show that the source of information or the method or circumstance of preparation indicate a lack of trustworthiness.” [where opponents] “have demonstrated a lack of trustworthiness in the materials; the source code contains inconsistent dates in the metadata, copyright, and revisions histories as well as added commentary on the printed excerpts.” *Wi-LAN Inc. v. Sharp Elecs. Corp.*, 2020-1041, 4/6/21.

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

“[W]e reject [the] argument that the initial complaint . . . governs this [transfer] inquiry. Once the respondents filed their amended complaints, the original complaints were “dead letter[s]” and “no longer perform[ed] any function in the case[s].”” “We therefore look to the amended complaints to determine whether venue would have been proper had these suits initially been filed in Northern California.” *In re Samsung Elecs. Co.*, 2021-139, 6/30/21.

##### **1. Determining Venues Where Case Could Have Been Brought**

“[I]n ascertaining proper venue, we are not bound by a plaintiff’s efforts to manipulate venue.” “[T]he presence of Ikorongo Texas is plainly recent, ephemeral, and artificial—just the sort of maneuver in anticipation of litigation that has been routinely rejected . . . disregarding this manipulation, Ikorongo Tech could have filed suit in the Northern District of California.” *In re Samsung Elecs. Co.*, 2021-139, 6/30/21.

##### **2. Sources of Proof Factor**

“[T]he district court here clearly assigned too little weight to the relative convenience of the Northern District of California. Given the relevant events and circumstances giving rise to these infringement claims, it is unsurprising that many identified sources of proof and likely witnesses are in Northern California and none in the Western District of Texas. Indeed, petitioners submitted undisputed affidavits identifying over a dozen third-party individuals with relevant and material information as residing in Northern California. Moreover, at least two of the inventors also reside in Northern California. In addition, LG indicated that its relevant party witnesses also reside in the Northern District of California. By contrast, not a single witness has been identified as residing in or near the Western District of Texas.” *In re Samsung Elecs. Co.*, 2021-139, 6/30/21.

##### **3. Cost of Attendance of Willing Witnesses Factor**

“Even if not all witnesses testify, with nothing on the other side of the ledger, the factor strongly favors transfer. Moreover, because these potential witnesses reside in Northern California, transfer ensures that the transferee court could compel these individuals to appear.” *In re Samsung Elecs. Co.*, 2021-139, 6/30/21.

#### **4. Local Interest Factor**

Infringement accusations “based on third-party applications” and “[i]t is undisputed that those third parties researched, designed, and developed most of those applications in Northern California. These are significant factors that give the Northern District of California a legitimate interest in adjudicating the cases “at home.”” *In re Samsung Elecs. Co.*, 2021-139, 6/30/21.

#### **5. Congestion Factor**

“And even if the court’s speculation is accurate that it could more quickly resolve these cases based on the transferee venue’s more congested docket, neither respondents nor the district court pointed to any reason that a more rapid disposition of the case that might be available in the Western District of Texas would be important enough to be assigned significant weight in the transfer analysis here.” *In re Samsung Elecs. Co.*, 2021-139, 6/30/21.

### **VII. Federal Circuit Appeals**

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

##### **1. District Court/ITC Appeals**

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

##### **i. Construction Advocated at Markman**

No waiver where Court concludes “current claim construction position to be consistent with that reasonable interpretation of its proposed construction, . . . asserted since the beginning of the proceedings in this case.” *Bio-Rad Labs., Inc. v. Int’l Trade Comm’n*, 2020-1475, 5/28/21.

##### **2. Discretion to Reach Waived Issue**

“We exercise our discretion to reach the issue of standing because: (1) the issue of Apple’s standing is fully briefed; (2) we see no prejudice to Qualcomm; and (3) the question of standing impacts these and other appeals.” *Apple Inc. v. Qualcomm Inc.*, 2020-1561, 4/7/21.

##### **3. Mischaracterizations of Reviewed Decision**

“As a preliminary matter, in the cited passage the Board was merely recounting Apple’s assertions, not endorsing them.” *Uniloc 2017 LLC v. Apple Inc.*, 2020-1403, 5/12/21.

## **B. Appellate Jurisdiction**

### **1. Final Judgment**

#### **a. Orders Not Titled Final Judgment**

“L’Oréal then renewed its motion for judgment as a matter of law (JMOL) and moved for a new trial. Olaplex, for its part, sought prejudgment interest on the damages award and attorney’s fees, among other things. On December 16, 2019, the district court issued a *memorandum and order* resolving the parties’ post-trial motions.” “[T]he district court’s December 2019 order . . . entered on the docket sheet, resolved all issues on the merits and left only ministerial calculations, so it was a final decision.” *Olaplex, Inc. v. L’Oréal USA, Inc.*, 2020-1382, 5/6/21 (nonprecedential) (emphasis added).

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

### **1. Conditional Cross-Appeals**

“Once we address infringement, we generally must address invalidity. But we need not here. Cross-Appellants state that if we “affirm[] the judgment of noninfringement, [they] will voluntarily dismiss their cross-appeal, because the ’360 patent expired more than six years ago.” Therefore, we do not reach the cross-appeal.” *SpeedTrack, Inc. v. Amazon.com, Inc.*, 2020-1573, 6/3/21 (citations omitted).

## **D. Standards of Review and Record/Appendix on Appeal**

### **1. Substantial Evidence Threshold**

#### **a. Expert Testimony**

##### **i. Not Required**

“For the reasons explained above, Dr. Goldman’s testimony does not stand alone, and the jury could reasonably rely on the evidence as a whole to determine that the claims at issue were not enabled.” *Pac. Biosciences of Cal., Inc. v. Oxford Nanopore Techs., Inc.*, 2020-2155, 5/11/21.

#### **b. Documentary Evidence**

An image with a feature that is arguably counter to a finding does not trump substantial evidence of that finding “[w]ithout record evidence explaining what the [feature] is.” *Bio-Rad Labs., Inc. v. Int’l Trade Comm’n*, 2020-1785, 4/29/21.

#### **c. Conflicting Evidence**

“The jury’s task was not to view one portion of Dr. Goldman’s testimony in isolation, but to consider all the evidence, including any portion of the evidence that might clarify how

to understand other portions.” Pac. Biosciences of Cal., Inc. v. Oxford Nanopore Techs., Inc., 2020-2155, 5/11/21.

#### **d. Implied Jury Findings**

“With no greater detail in the verdict, we treat the jury as having made all verdict-supporting factual findings that are supported by substantial evidence.” Pac. Biosciences of Cal., Inc. v. Oxford Nanopore Techs., Inc., 2020-2155, 5/11/21.

### **2. Abuse of Discretion**

#### **a. Granting New Trial**

Denial of new trial affirmed where the district court “determined that there was not a high enough likelihood, in light of the curative instructions, that [a party]’s improper opening tainted the jury’s consideration of the issues to justify ordering a new trial.” Pac. Biosciences of Cal., Inc. v. Oxford Nanopore Techs., Inc., 2020-2155, 5/11/21.

### **E. Precedent**

#### **1. Conflicting/Vacated/Implicitly Overruled Decisions**

“[T]he Supreme Court cases following *Red Wing* have made clear that the analysis of personal jurisdiction cannot rest on special patent policies. To the extent that *Red Wing* and other cases have suggested otherwise, that language is not consistent with these Supreme Court cases.” Trimble Inc. v. PerDiemCo LLC, 2019-2164, 5/12/21.

“Three subsequent developments have clarified the scope of *Red Wing*.” “*Red Wing* remains correctly decided with respect to the limited number of communications involved in that case.” Trimble Inc. v. PerDiemCo LLC, 2019-2164, 5/12/21.

### **F. Remand Determination**

#### **1. Remand for Sufficient Reasoning to Review**

Where “claim construction was based on the intrinsic record, including the claims themselves, which are “of primary importance” in claim construction, as well as the specifications of the asserted patents, [the CAFC did] not fault the ALJ for including a statement indicating that, in the interest of brevity, the parties’ less relevant arguments—e.g., arguments based on prior art, which necessarily carry less weight in the claim construction analysis—were considered but not specifically addressed in the opinion.” Bio-Rad Labs., Inc. v. Int’l Trade Comm’n, 2020-1475, 5/28/21.

#### **2. Judicial Notice on Appeal**

“To cure the deficiencies in its evidence, Apple suggested we could take judicial notice that Apple sells and will continue to sell its smart phone products. A court may take judicial notice of a fact only when it is either “generally known” or “accurately and readily

[discernible] from sources whose accuracy cannot reasonably be questioned.” FED. R. EVID. 201(b). What products and product features Apple may be selling at the expiration of the license agreement years from now are not the kind of undisputed facts we may take judicial notice of because they may be reasonably questioned. We are not fortune-tellers.” Apple Inc. v. Qualcomm Inc., 2020-1561, 4/7/21 (citations omitted).

### **G. Substitution of Parties on Appeal**

Substitution granted. “[T]he first sale from U.S.A. Dawgs to Dawgs Holdings clearly transferred all of U.S.A. Dawgs’s assets and claims and did so using broad language. U.S.A. Dawgs did not need to enumerate each of its assets individually to effectuate the broad transfer. U.S.A. Dawgs dissolved and did not continue to participate before the Board. Under the circumstances, the transfer of all assets on its face included the rights in the Board proceeding.” Mojave Desert Holdings, LLC v. Crocs, Inc., 2020-1167, 4/21/21.

## **VIII. Patent Office Proceedings**

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

#### **1. Appeal**

##### **a. Jurisdiction Over Appeals Challenging PTAB Decisions**

###### **i. Petitioner Appeals of Final Written Decision**

Where an appellant that “has not alleged that the validity of the patents at issue will affect its contract rights (i.e., its ongoing royalty obligations)[, t]his failure is fatal to establishing standing under the reasoning of *MedImmune*, whether we analyze [appellant]’s evidence for injury in fact or redressability.” Apple Inc. v. Qualcomm Inc., 2020-1561, 4/7/21.

###### **ii. Standing Evidence**

A mere “possibility of suit is too speculative to confer standing. [Appellant] provides no evidence that it intends to engage in any activity that may give rise to an infringement suit of the patent[s subject to the appeal] when the license expires.” Apple Inc. v. Qualcomm Inc., 2020-1561, 4/7/21.

#### **2. Obviousness Rulings**

##### **a. Reversal**

“Baxter does not meaningfully argue that the weak showing of secondary considerations here could overcome the showing of obviousness based on the prior art. The Board’s determination that the verification and highlighting limitations are not obvious is not supported by substantial evidence. We reverse.” Becton, Dickinson and Co. v. Baxter Corp. Englewood, 2020-1937, 5/28/21.

## **B. Post-Grant Reviews**

### **1. Estoppel**

“We conclude that L’Oréal is estopped from pressing its challenges both to written description and obviousness in an effort to overturn the jury verdict.” *Olaplex, Inc. v. L’Oréal USA, Inc.*, 2020-1382, 5/6/21 (nonprecedential).

## **C. Appeals to District Court Under Sections 145 and 146**

“We hold that prosecution laches is a defense available to the Patent and Trademark Office in an action to obtain a patent under 35 U.S.C. §145.” *Hyatt v. Hirshfeld*, 2018-2390, 6/1/21.