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I. Patentability Requirements

A. Prior Art Invalidity

1. Anticipation (§ 102)

a. Publications/Patents

i. Establishing Publication Date

Not quite saying that IDS can be used as evidence of publication date despite *ResQNet.com, Inc. v. Lansa, Inc.*, 594 F.3d 860, 866 (Fed. Cir. 2010) (holding that including a reference in an IDS is not an admission that any reference is prior art). “The IDS is significant here, not because of its inclusion of the Burns article by the applicant, but because of the applicant’s characterization of the Burns article as being dated 2010, which is before the critical date of each patent.” *Valve Corp. v. Ironburg Inventions Ltd.*, 2020-1315, 8/17/21.

“Patent examiners are trained and required to determine publication dates. The patent examiner’s determination of the publication date is a “factual finding[] from a legally authorized investigation.” Fed. R. Evid. 803(8)(A)(iii). It also “is supported by sufficient guarantees of trustworthiness.” See Fed. R. Evid. 807(a)(1).” *Valve Corp. v. Ironburg Inventions Ltd.*, 2020-1315, 8/17/21.

“District courts have taken judicial notice of the contents of webpages available through the Wayback Machine “as facts that can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned.” We agree.” *Valve Corp. v. Ironburg Inventions Ltd.*, 2020-1315, 8/17/21 (citations omitted).

2. Obviousness (§ 103)

a. Motivation/Apparent Reason to Combine/Modify

i. Limited equally viable options

“When two equally viable options are available, as here, then, without more, either one would seem to have been obvious.” *C.R. Bard, Inc. v. Medline Indus., Inc.*, 2020-1900, 8/13/21 (nonprecedential).

ii. Impact of Broad Claims

“Because the claims are directed to humanized antibodies, the question before the Board was whether a skilled artisan at the time of the invention would have been motivated to make the claimed humanized antibodies, not whether a skilled artisan would have been motivated to use those antibodies to treat human disease. Teva is, of course, correct that the analysis must account for “reasons not to combine,” which are facts relevant to the overall consideration of obviousness. But, as it pertains to Teva’s argument about safety and efficacy concerns, the relevant inquiry is not (as Teva suggests) whether the asserted

concerns would have presented a reason not to use the claimed antibodies in human treatments. Rather, the relevant inquiry—which the Board extensively analyzed—is whether those concerns would have dissuaded a skilled artisan from making the claimed antibodies to study their therapeutic potential in the first place.” *Teva Pharms. Int’l GmbH v. Eli Lilly & Co.*, 2020-1747, 8/16/21 (citations omitted).

iii. Analogous Art Requirement

“The Board’s obviousness findings are not supported by substantial evidence. Although the Board may rely on other prior art to inform itself of the state of the art at the time of the invention, the scope of the relevant prior art is that which is “‘reasonably pertinent to the particular problem with which the inventor was involved.’” . . . the Board appears to have ignored the express disclosure in Kaulbach that teaches away from the claimed invention and relied on teachings from other references that were not concerned with the particular problems Kaulbach sought to solve.” *Chemours Co. FC, LLC v. Daikan Indus., Ltd.*, 2020-1289, 7/22/21.

b. Reasonable Expectation of Success

For an IPR assertion of obviousness, “the law does not require certainty; it requires a reasonable expectation of success. But, in considering what constitutes a reasonable expectation of success, we must also consider that the law places the burden of proof on the petitioner to prove a proposition of unpatentability by a preponderance of the evidence.” *Eli Lilly & Co. v. Teva Pharms. Int’l GmbH*, 2020-1876, 8/16/21 (citation omitted).

“[I]t was not enough for the [patent challenger] to have shown that a skilled artisan would have pursued the claimed method as a treatment option, but the [patent challenger] also had to show that the skilled artisan would have reasonably expected to achieve success in the treatment.” *Eli Lilly & Co. v. Teva Pharms. Int’l GmbH*, 2020-1876, 8/16/21.

i. Unclaimed Requirements

“[A]lthough one prior art reference contained a [requirement] that was not met by a different reference in the asserted obviousness combination, that fact was irrelevant to the reasonable expectation of success analysis because the challenged claim itself did not contain that requirement.” *Eli Lilly & Co. v. Teva Pharms. Int’l GmbH*, 2020-1876, 8/16/21.

c. Secondary Indicia of Nonobviousness

i. Commercial Success

“The Board is certainly entitled to weigh evidence and find, if appropriate, that Chemours’s gross sales data were insufficient to show commercial success without market share data. The Board, however, erred in its analysis that gross sales figures, absent market share data, “are inadequate to establish commercial success.”” *Chemours Co. FC, LLC v. Daikan Indus., Ltd.*, 2020-1289, 7/22/21.

ii. Licensing

“[G]iven that 188 patents were licensed, the nexus between the license and the validity of any particular claim is rather tenuous to say the least. Thus, the Board was correct to require that Teva show something more than the mere existence of the license.” *Teva Pharms. Int’l GmbH v. Eli Lilly & Co.*, 2020-1747, 8/16/21.

iii. Nexus

“[I]t presented evidence that merely ties commercial success and praise to aspects of the label area that were already present in the prior art.” “Accordingly, given the absence of evidence tying any commercial success or praise to the claimed unique characteristics of the iQ Maximizer, substantial evidence does not support a nexus between those objective indicia and the claims.” *Campbell Soup Co. v. Gamon Plus, Inc.*, 2020-2344, 8/19/21.

“[T]he separate disclosure of individual limitations, where the invention is a unique combination of three interdependent properties, does not negate a nexus.” *Chemours Co. FC, LLC v. Daikan Indus., Ltd.*, 2020-1289, 7/22/21.

iv. Presumption of Nexus

“Because the claims in this case have a broad scope due to their lack of structural limitations, the unclaimed features in the commercial products cited here are of particular importance to the coextensiveness analysis.” *Teva Pharms. Int’l GmbH v. Eli Lilly & Co.*, 2020-1747, 8/16/21.

d. Design Patents

“[Appellant] contends that [the proposed primary reference] can only accommodate a can with a smaller diameter than the can depicted in the claimed designs. [Appellant] further appears to argue that [the proposed primary reference]’s can would come to rest farther rearward than in the claimed designs. Those slight differences, however, do not substantially detract from the similarity in overall visual appearances.” *Campbell Soup Co. v. Gamon Plus, Inc.*, 2020-2344, 8/19/21.

i. Secondary Considerations

“In determining coextensiveness, the question is not whether unclaimed features are insignificant *to a product’s ornamental design*. The question is instead whether unclaimed features are “insignificant,” period.” “The Board attempted to distinguish *Fox Factory* because it involved a utility patent, rather than a design patent. But the coextensiveness requirement does not depend on the type of patent at issue. The Board offered no rationale for taking a different approach in design patent cases, and we do not discern any.” *Campbell Soup Co. v. Gamon Plus, Inc.*, 2020-2344, 8/19/21.

B. Invalidity Based on § 112

1. Written Description (¶ 1)

a. Species Disclosure Supporting Genus Claim

“[C]laims 3 and 9 broadly cover, as part of the claimed nucleic acid polymer encoding for the three-part CAR, *any* scFv for binding *any* target. But the ’190 patent’s written description fails to provide a representative sample of species within, or defining characteristics for, that expansive genus.” *Juno Therapeutics, Inc. v. Kite Pharma, Inc.*, 2020-1758, 8/26/21 (emphasis in original).

“The ’190 patent contains no details about these [disclosed examples] beyond the alphanumeric designations J591 and SJ25C1 for a skilled artisan to determine how or whether they are representative of the entire claimed genus. [Patentee] argues these two working embodiments are representative of all scFvs in the context of a CAR. The evidence does not support [patentee]’s argument.” *Juno Therapeutics, Inc. v. Kite Pharma, Inc.*, 2020-1758, 8/26/21.

b. Critical Aspect of Invention

“[Patentee] relies on . . . testimony that [the inventor] invented the backbone, not scFvs. But the ’190 patent’s claims are not limited to just the claimed backbone; they also include the functional scFv for binding the target.” *Juno Therapeutics, Inc. v. Kite Pharma, Inc.*, 2020-1758, 8/26/21.

C. Section 101

1. Abstract Idea Exclusion

“[T]he claims are directed to the use of an algorithm-generated content-based identifier to perform the claimed data-management functions, which across the three patents include controlling access to data items (the ’310 patent), retrieving and delivering copies of data items (the ’280 patent), and marking copies of data items for deletion (the ’662 patent). These functions are mental processes that “can be performed in the human mind” or “using a pencil and paper.”—a telltale sign of abstraction.” *PersonalWeb Techs. LLC v. Google LLC*, 2020-1543, 8/12/21 (citations omitted).

“As explained below, each component of the claims’ three-step progression reflects a concept we have already described as abstract.” “The claims as a whole, then, are directed to a medley of mental processes that, taken together, amount only to a multistep mental process.” *PersonalWeb Techs. LLC v. Google LLC*, 2020-1543, 8/12/21.

a. Claimed Subject Matter

“[T]he claims generically provide for the collection of biometric information to generate a first authentication information, and then authenticating a user using both the biometric-

information-derived first authentication and a second authentication information.” Universal Secure Registry LLC v. Apple Inc., 2020-2044, 8/26/21.

b. Information Processing

“The claims are directed to a method for enabling a transaction between a user and a merchant, where the merchant is given a time-varying code instead of the user’s secure (credit card) information. The time-varying code is used to access a database that indicates any restrictions on the user’s transactions with the merchant and also allows a third party or credit card company to approve or deny the transaction based on the secure information without the provider gaining access to the secure information.” “Accordingly, the claims are directed to an abstract idea.” Universal Secure Registry LLC v. Apple Inc., 2020-2044, 8/26/21 (citing *Solutran*, 931 F.3d at 1168).

“[A]uthenticating a user using conventional tools and generating and transmitting that authentication” is an abstract idea. Universal Secure Registry LLC v. Apple Inc., 2020-2044, 8/26/21.

“[T]he claims are directed to an abstract idea. Specifically, the claims are directed to multi-factor authentication of a user’s identity using two devices to enable a transaction.” Universal Secure Registry LLC v. Apple Inc., 2020-2044, 8/26/21.

c. Inventive Concept/Transformation Exception

Because “sending data to a third-party as opposed to the merchant is itself an abstract idea, it cannot serve as an inventive concept.” Universal Secure Registry LLC v. Apple Inc., 2020-2044, 8/26/21.

D. Summary Judgment/JMOL

1. Reasonable Fact Finder Standard

“The ’190 patent provides no details about [the claimed component with required functionality], such as an exemplary amino acid sequence, a shape, or general characteristics that would allow this [functionality]. Instead, it provides only an alphanumeric designation, SJ25C1, as the source for [an example component]. Without more guidance, in a vast field of possible [components with the required functionality] with so few of them known, no reasonable jury could find the inventors satisfied the written description requirement.” Juno Therapeutics, Inc. v. Kite Pharma, Inc., 2020-1758, 8/26/21.

2. Despite Expert Testimony

“[T]hat testimony is far too general. Dr. Brocker testified that the two exemplary scFvs are representative “because [scFvs] all do the same thing. They bind to the antigen.” Nothing about that testimony explains which scFvs will bind to which target or cures the ’190 patent’s deficient disclosure on this score.” Juno Therapeutics, Inc. v. Kite Pharma, Inc., 2020-1758, 8/26/21.

II. Other Defenses

A. Improper Venue

1. Corporate Affiliates

Dismissal of Non-Store Defendants (affiliated with Stores) affirmed where “Andra argues that Stores locations are “a regular and established place of business” of the Non-Store Defendants because Stores employees are agents of the Non-Store Defendants, or, alternatively, because the Non-Store Defendants have ratified Stores locations as their places of business.” Andra Grp., LP v. Victoria’s Secret Stores, LLC, 2020-2009, 8/3/21.

“Andra’s contention that LBI controls the hiring and firing of store employees is directly contradicted by the testimony of the store manager for the Plano, Texas store, Lisa Barcelona, who stated during her deposition that she, a Stores employee, interviews associates and makes offers of employment. She also testified that she decides whether to fire employees and that she does not need any approval before doing so, and that it is she who holds Stores employees at her store accountable for following the Code of Conduct, not LBI. Thus, none of the facts alleged by Andra are sufficient to prove that Stores employees are agents of LBI.” Andra Grp., LP v. Victoria’s Secret Stores, LLC, 2020-2009, 8/3/21.

“A threshold inquiry when determining whether the place of business of one company can be imputed to another, related company is whether they have maintained corporate separateness. If corporate separateness has not been maintained, the place of business of one corporation may be imputed to the other for venue purposes. But where related companies have maintained corporate separateness, the place of business of one corporation is not imputed to the other for venue purposes.” Andra Grp., LP v. Victoria’s Secret Stores, LLC, 2020-2009, 8/3/21.

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

1. Assignment

a. Employment Agreements

“When Dr. Islam joined the UM faculty, he executed an employment agreement that included a provision agreeing to abide by UM’s bylaws.” “[W]hether [appellee] has an exclusionary right in the asserted patents . . . turns on a legal question of contract interpretation: whether paragraph 1 of bylaw 3.10 automatically and presently assigned legal title of Dr. Islam’s inventions to UM.” Omni MedSci, Inc. v. Apple Inc., 2020-1715, 8/2/21.

“[P]aragraph 4 of bylaw 3.10 shares the same operative language, “shall be the property of,” as paragraph 1, but cannot logically be read as a present automatic assignment.” “Each case in which this court found a present automatic assignment examined contractual language with a present tense executing verb.” Omni MedSci, Inc. v. Apple Inc., 2020-1715, 8/2/21.

III. Literal Infringement

A. All Elements

[Patentee] “labels the distinction described above as “hair-splitting” and argues it is irrelevant in light of the purpose of the invention We reject this argument. First, in a literal infringement case, as we have here, the meaning ascribed to the claims is significant. The burden is on a patent owner to show that “the properly construed claim reads on the accused device exactly.” “[Appellant]’s reliance on the claim terms as construed by the district court is not “hairsplitting,” as [patentee] argues, but instead properly shows that [patentee] failed to meet its burden at the district court and that no reasonable jury could have found otherwise.” *CommScope Techs. LLC v. Dali Wireless, Inc.*, 2020-1817, 8/24/21.

B. Summary Judgment/JMOL

1. Despite Expert Testimony

The expert’s “testimony points to the *result* that “you turn the feedback off” rather than the *specific mechanism claimed to achieve that result*—“switching a controller off.” This testimony from Dr. Kenney thus does not provide substantial evidence to support the jury’s finding that the FlexWave meets the district court’s claim construction.” No discussion of whether the jury could reasonably infer the mechanism from the result. *CommScope Techs. LLC v. Dali Wireless, Inc.*, 2020-1817, 8/24/21 (emphasis added).

C. Indirect Infringement

1. ANDA Infringement

“A generic producer may exclude a patented use from its label, by way of a “section viii carveout” as provided by 21 U.S.C § 355(j)(2)(A)(viii).” *GlaxoSmithKline LLC v. Teva Pharm. USA, Inc.*, 2018-1976, 8/5/21.

“As this record reflects, in both time periods, substantial evidence supports that Teva actively induced by marketing a drug with a label encouraging a patented therapeutic use. They did not “omit[] all patented indications” or “merely note[] (without mentioning any infringing uses) that FDA had rated a product as therapeutically equivalent to a brand-name drug.” This is a case in which substantial evidence supports a jury finding that the patented use was on the generic label at all relevant times and that, therefore, Teva failed to carve out all patented indications.” *GlaxoSmithKline LLC v. Teva Pharm. USA, Inc.*, 2018-1976, 8/5/21.

D. Joint Infringement/Divided Infringement

1. Corporate v. Individual Liability

“The fact that Mr. Chung may have acted on behalf of his corporation does not excuse him from individual liability.” *Lubby Holdings, LLC v. Chung*, 2019-2286, 9/1/21.

IV. Relief

A. Entire Market Value Rule/Convoyed Sales

1. Apportionment

“[W]e disagree with the district court to the extent it suggested that the only way to apportion is through the royalty base.” *MLC Intell. Prop., LLC v. Micron Tech., Inc.*, n.4, 2020-1413, 8/26/21.

a. Comparable Licenses

Expert’s reasonable royalty analysis included “no assessment of the licensed technology versus the accused technology to account for any differences” and relied on an agreement that “is not a license for the same single patent” and its exclusion was affirmed. *MLC Intell. Prop., LLC v. Micron Tech., Inc.*, 2020-1413, 8/26/21.

B. Enhanced Damages

Affirming multiplier of 2 where “the district court appropriately considered the factors laid out in *Read Corp. v. Portec, Inc.*, including at least “the infringer’s behavior as a party to the litigation,” the infringer’s “size and financial condition,” the infringer’s “motivation for harm,” and the “[c]loseness of the case.”” *SRI Int’l, Inc. v. Cisco Sys., Inc.*, 2020-1685, 9/28/21.

C. Willfulness

1. Compared to Indirect Infringement Intent

“[A] finding of induced infringement does not compel a finding of willfulness.” “Nonetheless, in this case, the jury’s unchallenged findings on induced infringement, when combined with Cisco’s lack of reasonable bases for its infringement and invalidity defenses, provide sufficient support for the jury’s finding of willful infringement for the period after May 8, 2012, when Cisco had notice of the patent.” *SRI Int’l, Inc. v. Cisco Sys., Inc.*, 2020-1685, 9/28/21.

D. Notice/Marking

1. Burdens of Proof

“Mr. Chung objected to Lubby’s damages computation, including raising the issue of whether Lubby’s products were properly marked as required by 35 U.S.C. § 287. In his objection, Mr. Chung specifically pointed to the J-Pen Starter Kit product as listed on Lubby’s website, which did not include a patent number.” “After Mr. Chung’s objection, Lubby “b[ore] the burden to prove the products identified do not practice the patented invention.”” *Lubby Holdings, LLC v. Chung*, 2019-2286, 9/1/21.

E. Reasonable Royalty

1. Established and Comparable Royalties/License Agreements

a. No Separate Apportionment Requirement

New damages trial justified where “[patentee]’s president, Mr. Flick, testified that under Omega’s licensing program the licensing fee was “five dollars [per unit] whether it’s one patent or 50 patents.”” “[R]elying on its internal “policy” without regard to comparability [and seeking] the same licensing fee regardless of what patents were included or what technology was covered . . . does not sufficiently speak to “built-in apportionment” between the patented improvement added to the [accused products] and the conventional features of the [accused products]. To hold otherwise would improperly permit Omega to hide behind its generic licensing arrangement to avoid the task of apportionment.” Omega Patents, LLC v. CalAmp Corp., 2020-1793, 9/14/21.

“[A]bsent evidence of a comparable license or comparable negotiation to support an identical \$5.00 rate for a one-patent license to the [asserted] patent, we fail to see how this patent/claim-independent approach accounts for apportionment.” Omega Patents, LLC v. CalAmp Corp., 2020-1793, 9/14/21.

b. Derived Royalty Rate

“Mr. Milani’s testimony that he understood the Hynix and Toshiba licenses to use a 0.25% royalty is not sufficiently tethered to the evidence presented. Neither the Hynix agreement nor the Toshiba agreement discloses any royalty rate. Rather than deriving a rate from the lump-sum payments and projected sales, Mr. Milani’s testimony rests on an inference from the most favored customer clause that goes well beyond what the clause implies and is incompatible with the Hynix agreement as a whole.” MLC Intell. Prop., LLC v. Micron Tech., Inc., 2020-1413, 8/26/21.

2. Portion of Profit Attributable to the Claimed Invention (Apportionment)

“We therefore reject [appellee]’s contention that it was not required to show apportionment simply because the jury heard testimony that the [accused products] have no component parts outside what is claimed in the [asserted] patent. [T]here is no question that the [accused products] have conventional components that are not the *inventive aspects* of the [asserted] patent.” Omega Patents, LLC v. CalAmp Corp., 2020-1793, 9/14/21.

F. Lost Profits

1. Noninfringing Substitutes/Alternatives

Both sale and use must be noninfringing to qualify. “The district court correctly instructed the jury that the availability of carvedilol from other generic producers is not a “non-infringing substitute.” GSK’s expert’s analysis accounted for Teva’s sales for the infringing use, amounting to 17.1% of Teva’s total carvedilol sales. Had another generic

producer made those sales, those uses too would have been infringing. The other generic carvedilol producers were, therefore, not noninfringing alternatives.” GlaxoSmithKline LLC v. Teva Pharm. USA, Inc., 2018-1976, 8/5/21.

V. Claim Construction

A. Claim Language

1. Preambles

a. Construed as Limitation

i. Statements of Intended Purpose

“[O]ur case law does not support [appellant]’s proposed binary distinction between statements of mere intended purpose on the one hand and limiting preambles on the other.” Eli Lilly & Co. v. Teva Pharms. Int’l GmbH, 2020-1876, 8/16/21.

CAFC looked at a claim body with “a single step of administering an effective amount of a composition, namely, a humanized anti-CGRP antagonist antibody. This claim format is particularly relevant in our consideration of the claim as a whole because, while there is no bright-line rule for determining whether a preamble is limiting, we have generally construed statements of intended purpose in such method claims as limiting.” Eli Lilly & Co. v. Teva Pharms. Int’l GmbH, 2020-1876, 8/16/21.

ii. Antecedent Reference

CAFC found intended purpose preamble limiting based on antecedent reference. “[T]he “individual” is part of the statement of intended purpose—for “treating at least one vasomotor symptom in an individual”—the entirety of which provides antecedent basis for the later claim term “administering to the individual.”” Eli Lilly & Co. v. Teva Pharms. Int’l GmbH, 2020-1876, 8/16/21.

2. Plain and Ordinary Meaning

a. Grammar Rules

“The claims recite a “geophone internally fixed within [the] housing.” We conclude, based upon the intrinsic evidence, that the word fixed here carries its ordinary meaning, i.e., attached or fastened. The adverb internally and the preposition within straddling the word fixed indicate that it specifies the geophone’s relationship with the housing, not the type of geophone.” Seabed Geosolutions (US), Inc. v. Magseis FF LLC, 2020-1237, 8/11/21.

3. Open/Closed Claims, Generic and Negative Limitations

a. Conjoined Elements

“Valve argues that the Board erred because “the Board construed the claims to exclude any ‘elongate member’ made from multiple parts.” The Board’s construction did not exclude an “elongate member” made of multiple parts; it simply required that the elongate member itself be inherently resilient and flexible. The Board’s decision was based on *a factual determination that the spring of Uy is not part of the elongate member of Uy*, i.e., the lever, and Valve did not argue to the Board that anything in Uy other than the spring provided flexibility and resilience.” Valve Corp. v. Ironburg Inventions Ltd., 2020-1315, 8/17/21.

b. Defining/Positioning/Connecting Terms

“Under the ordinary meaning of these terms, a “first surface disposed proximate an outer surface of the case” requires that the first surface of the additional control and the outer surface of the case be arranged close or near to each other, but does not require them to be facing each other.” Valve Corp. v. Ironburg Inventions Ltd., 2020-1315, 8/17/21.

4. Section 112(f)

a. How Applied

i. Corresponding Structure/Material/Acts

“[When corresponding structure] is not a general-purpose computer, it does not trigger the algorithm requirement of *WMS Gaming*.” “[Appellant] asks us to extend the algorithm requirement to circuitry. We decline to do so. The reasoning for the algorithm requirement of *WMS Gaming* does not apply to functions implemented through circuitry.” Qualcomm Inc. v. Intel Corp., 2020-1589, 7/27/21.

B. Prosecution History

1. Issuing Application

a. Changes Meaning

“Consistent with the public notice function of the prosecution history, the public is entitled to rely on these statements as defining the scope of the claims.” Data Engine Techs. LLC v. Google LLC, 2021-1050, 8/26/21.

i. Limitation Extends Beyond Prior Art

“Even if this alone would have been sufficient to overcome the Examiner’s rejection, the applicants went further, providing an express definition of a three-dimensional spreadsheet and arguing that Lotus 1-2-3 is not a “true” three-dimensional spreadsheet under that definition. DET cannot escape the import of its statements to the Patent Office by

suggesting they were not needed to overcome the Examiner’s rejection.” Data Engine Techs. LLC v. Google LLC, 2021-1050, 8/26/21.

ii. Limits Particular Claim Term

Federal Circuit affirmed limiting preamble term, three-dimensional spreadsheet, because “the applicants provided an explicit definition of a “true” three-dimensional spreadsheet and distinguished prior art under this definition.” Data Engine Techs. LLC v. Google LLC, 2021-1050, 8/26/21.

C. Limited and Ordinary Meaning Constructions

1. Questions of Fact in Applying Constructions

“Valve argues that the Board erred because “the Board construed the claims to exclude any ‘elongate member’ made from multiple parts.” The Board’s construction did not exclude an “elongate member” made of multiple parts; it simply required that the elongate member itself be inherently resilient and flexible. The Board’s decision was based on *a factual determination that the spring of Uy is not part of the elongate member of Uy*, i.e., the lever, and Valve did not argue to the Board that anything in Uy other than the spring provided flexibility and resilience.” Valve Corp. v. Ironburg Inventions Ltd., 2020-1315, 8/17/21.

VI. Unenforceability

A. Intent to Deceive

1. Most Reasonable Inference

“The district court found Mr. Rubin’s reasons for withholding the JHP product to be implausible and not credible. But the district court also relied on other record evidence to support its intent finding, including Mr. Rubin’s prior knowledge of the JHP product, his central role in both FDA approval and patent prosecution, and his arguments to the examiner about the “criticality” of the 2.8 to 3.3 pH range despite knowing that Sintetica’s batches used the same range. As in *Aventis*, we conclude that the district court did not clearly err in finding that the single most reasonable inference is that Mr. Rubin possessed the specific intent to deceive the PTO when withholding the JHP product.” Belcher Pharms., LLC v. Hospira, Inc., 2020-1799, 9/1/21 (citations omitted).

B. Material Information

“A prior art reference may constitute material information, even where the reference is not sufficient to invalidate the claim in district court, if the disclosure of the reference would have blocked the issuance of a patent under the PTO’s evidentiary standards.” Belcher Pharms., LLC v. Hospira, Inc., 2020-1799, 9/1/21.

1. The “But for” Standard

a. Expert Testimony

“Regarding materiality, the district court credited the testimony of Hospira’s expert witness, Dr. Pinal, that each of the three pieces of information that Mr. Rubin withheld (JHP’s product, Sintetica’s product, and Stepensky) were but-for material to patentability because they disclosed two aspects of the asserted claims: the pH range and the impurity levels.” *Belcher Pharms., LLC v. Hospira, Inc.*, 2020-1799, 9/1/21.

VII. Procedural Law

A. Applicable Circuit Law

1. Contract Interpretation

a. License and Assignment Provisions

“We apply federal law to determine whether the contract here created an automatic assignment or created an obligation to assign.” *Omni MedSci, Inc. v. Apple Inc.*, 2020-1715, 8/2/21.

B. Circumstances for Modifying Law of the Case/Patent

1. Limits of Mandate Rule

While a legal decision made at one stage of the litigation, unchallenged in a subsequent appeal when the opportunity existed, can become the law of the case for future stages of the same litigation, and the parties are deemed to have waived the right to challenge that decision at a later time, “such waiver does not necessarily apply where, as here, the mandate permits consideration on remand of the otherwise-waived issue.” *Omega Patents, LLC v. CalAmp Corp.*, n.6, 2020-1793, 9/14/21.

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

1. Improperly Excluded Evidence

“[A] new trial on damages . . . is warranted because the district court abused its discretion in precluding Dr. McDuff from offering his fully disclosed rebuttal testimony in the retrial, and in denying CalAmp’s motion for a new trial on that basis.” *Omega Patents, LLC v. CalAmp Corp.*, 2020-1793, 9/14/21.

2. Insufficient Evidence

“Because Mr. Chung did not properly raise the issue of his direct infringement liability in his Rule 50(a) motion and raised it only in his Rule 59(a) motion, we evaluate this issue under the substantially constrained abuse-of-discretion standard of review applicable to Rule 59(a) motions.” *Lubby Holdings, LLC v. Chung*, 2019-2286, 9/1/21.

D. Pleadings/Parties

1. Amendments

a. District Court Requiring Amendments

Appellant argued that “the district court erred in sua sponte forcing [appellant] to replead” its original complaint.” “That [appellant] agreed to put together the requested claim chart at the case management conference weighs against [appellant]’s objections on appeal.” Bot M8 LLC v. Sony Corp. of Am., 2020-2218, 7/13/21.

2. 12(b)(6) Dismissals

“A plaintiff is not required to plead infringement on an element-by-element basis.” “The level of detail required in any given case will vary depending upon a number of factors, including the complexity of the technology, the materiality of any given element to practicing the asserted claim(s), and the nature of the allegedly infringing device.” Bot M8 LLC v. Sony Corp. of Am., 2020-2218, 7/13/21.

The pleading “contains too much rather than too little, to the point that [appellant] has essentially pleaded itself out of court.” “Where, as here, the factual allegations are actually *inconsistent* with and contradict infringement, they are likewise insufficient to state a plausible claim.” Bot M8 LLC v. Sony Corp. of Am., 2020-2218, 7/13/21 (emphasis in original).

Rule 12(b)(6) dismissal reversed where pleading “identifies specific error messages that are displayed by the PS4 when faults are detected [and] give rise to a reasonable inference that the fault inspection program is completed before a game starts.” Bot M8 LLC v. Sony Corp. of Am., 2020-2218, 7/13/21.

E. Discovery/Evidence

1. Authenticity

“The Exhibit may be authenticated by “[a] comparison with an authenticated specimen by an expert witness or the trier of fact,” here, the article by Dave Burns in the certified ’525 patent prosecution history (“the ’525 Burns article”).” Valve Corp. v. Ironburg Inventions Ltd., 2020-1315, 8/17/21 (citing Fed. R. Evid. 901(b)(3)).

“The Board appears to have held that it was not obligated to compare the two because Valve provided no testimony that the two were identical. There is no requirement that such testimony be supplied. Rule 901(b)(3) of the Federal Rules of Evidence contemplates comparison by the “trier of fact,” and, as noted, that is done routinely.” “The Board had an obligation to make the comparison, as Rule 901(b)(3) contemplates and as the cases require.” Valve Corp. v. Ironburg Inventions Ltd., 2020-1315, 8/17/21.

2. Prejudicial Evidence

Even if evidence as to an invalid infringement theory was offered, the instructions clearly rejected that theory and there was “evidence . . . independent from [the theory] that [appellant] complains was improper. Given the instruction, we must assume the jury verdict rested on a proper theory.” *Omega Patents, LLC v. CalAmp Corp.*, 2020-1793, 9/14/21.

3. Exclusion for Discovery Failures (Rule 37)

“[T]he district court was within its discretion in determining that, though MLC was not required to disclose its expert opinions during fact discovery, it was still required to disclose (1) its view that the Hynix and Toshiba license agreements reflect a 0.25% royalty rate and (2) the extrinsic evidence Mr. Milani relied on to support that view in response to Micron’s reasonable requests for all facts, evidence, and testimony regarding any applicable royalty rates that MLC intended to rely on at trial.” *MLC Intell. Prop., LLC v. Micron Tech., Inc.*, 2020-1413, 8/26/21.

4. Hearsay

“With respect to hearsay, the [prosecution history] documents are excluded by the hearsay rule or fall within an exception.” *Valve Corp. v. Ironburg Inventions Ltd.*, n.6, 2020-1315, 8/17/21.

F. Transfer to New Judge or Venue

1. Sources of Proof Factor

Where movant’s declaration stated that “majority of its documentary evidence relevant to the Accused Products” was in transferee forum along with lack of “evidence relating to the facts of these lawsuits is located in the [transferor forum,] the district court should have weighed that factor in favor of transfer.” *In re Juniper Networks, Inc.*, 2021-160, 9/24/21.

2. Cost of Attendance of Willing Witnesses Factor

“The force of Juniper’s showing as to the inconvenience and cost entailed in requiring witnesses to testify at a remote forum is particularly strong in light of the very weak showing on that issue made by Brazos.” *In re Juniper Networks, Inc.*, 2021-160, 9/24/21.

“This categorical rejection of Hulu’s witnesses is entirely untethered to the facts of this case and therefore was an abuse of discretion.” *In re Hulu LLC*, 2021-142, 8/2/21 (nonprecedential).

3. Local Interest Factor

“The court acknowledged that the events forming the basis for Brazos’s infringement claims occurred mainly in the Northern District of California; none occurred in the Western

District of Texas. That is sufficient to give the transferee venue a greater localized interest in the dispute, which favors transfer.” In re Juniper Networks, Inc., 2021-160, 9/24/21.

4. Potential Need for Recourse to Compulsory Process

“That no party expressly identified any witness as unwilling to testify, however, does not cut in favor of conducting this litigation in the Western District of Texas rather than in the Northern District of California.” In re Juniper Networks, Inc., 2021-160, 9/24/21.

5. Congestion Factor

“[W]e do not regard the relative speed with which this case might be brought to trial in the two districts to be of particular significance.” In re Juniper Networks, Inc., 2021-160, 9/24/21.

VIII. Federal Circuit Appeals

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

1. District Court/ITC Appeals

a. Judicial Estoppel

i. Arguments Contrary to Prosecution Statements

“We further reject Belcher’s argument . . . Belcher’s argument is directly at odds with its argument during prosecution that the claimed range was “critical.” Belcher Pharms., LLC v. Hospira, Inc., 2020-1799, 9/1/21.

ii. Claim Construction Arguments

“[W]here, as here, a patentee relies on language found in the preamble to successfully argue that its claims are directed to eligible subject matter, it cannot later assert that the preamble term has no patentable weight for purposes of showing infringement.” Data Engine Techs. LLC v. Google LLC, 2021-1050, 8/26/21.

b. Claim Construction Waiver

i. Construction Advocated at Markman

“We reject Magseis’ contention that Seabed waived certain arguments concerning the prosecution history by failing to raise them below. The doctrine of waiver does not preclude a party from supporting its original claim construction with new citations to intrinsic evidence of record.” Seabed Geosolutions (US), Inc. v. Magseis FF LLC, 2020-1237, 8/11/21.

c. Excluding Expert Testimony

A decision not to exclude evidence under Rule 702 does not foreclose a challenge to the sufficiency of evidence. *Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579, 596 (1993) (explained in *Omega Patents, LLC v. CalAmp Corp.*, 2020-1793, 9/14/21).

2. Insufficient Language in Principal Brief

“First, an argument that is only made in a footnote of an appellant’s brief is forfeited.” *CommScope Techs. LLC v. Dali Wireless, Inc.*, 2020-1817, 8/24/21.

3. Mischaracterizations of Reviewed Decision

“Though the court stated that . . . that sentence must be read in context of the entire opinion.” *SRI Int’l, Inc. v. Cisco Sys., Inc.*, 2020-1685, 9/28/21.

“Lilly’s argument misreads the Board’s decision.” “Lilly directs its argument at isolated, out-of-context statements plucked from dozens of pages of the Board’s factual findings regarding the reasonable expectation of success.” *Eli Lilly & Co. v. Teva Pharms. Int’l GmbH*, 2020-1876, 8/16/21.

B. Appellate Jurisdiction

1. Effect of Federal Rules of Appellate Procedure

“[T]he Rules cannot override federal statute any more than state law could do so in *Budinich*, and to the extent that there is any conflict between the Rules and federal statutes, the statutes must prevail.” *Mondis Tech. Ltd. V. LG Elecs., Inc.* 2020-1812, 8/3/21.

2. 1292(c)(2) Jurisdiction When Damages Remain

“But when FRAP 4(a)(4) pertains to interlocutory appeals under § 1292(c)(2), the enumerated motions can only toll the time to appeal if they relate to the interlocutory judgment such that the judgment is not final except for an accounting until the court disposes of the motions.” *Mondis Tech. Ltd. V. LG Elecs., Inc.* 2020-1812, 8/3/21.

Ruling on liability JMOL and new trial motion was the point at which the case became final, except for an accounting. “No matter what judgment is being challenged, the date that matters under § 1292(c)(2) is the date at which the case became final except for an accounting.” *Mondis Tech. Ltd. V. LG Elecs., Inc.* 2020-1812, 8/3/21.

3. Rulings on Issues Not Relied Upon for Appealed Judgment

a. Third Party Infringement

CAFC did not review finding of customer infringement where it was only relevant to indirect infringement, which was not found by the jury. However, CAFC vacated the finding. *Omega Patents, LLC v. CalAmp Corp.*, 2020-1793, 9/14/21.

4. Requirements and Timing for Notice of Appeal

Any interlocutory appeal of liability issues under § 1292(c)(2) was required to be filed within 30 days of the rulings on liability post-trial motions where “[t]he district court disposed of the post-trial motions in two separate orders. On September 24, 2019, the district court denied LG’s motions regarding infringement, invalidity, and willfulness but ordered further briefing on damages. Then, on April 22, 2020, the district court granted LG’s motion for a new trial on damages.” *Mondis Tech. Ltd. V. LG Elecs., Inc.* 2020-1812, 8/3/21.

5. Interlocutory Review of Orders Certified under Section 1292(b)

“Thereafter, the district court certified the preceding three damages orders for interlocutory appeal pursuant to 28 U.S.C. § 1292(b). We granted MLC’s petition for permission to appeal.” *MLC Intell. Prop., LLC v. Micron Tech., Inc.*, 2020-1413, 8/26/21.

C. Standards of Review and Record/Appendix on Appeal

1. Substantial Evidence Threshold

a. Importance of Jury Instructions

In reviewing a factual issue, “we presume, as we must, that consistent with the jury instructions, the jury found that” whatever the instructions required for the verdict outcome was proven. *SRI Int’l, Inc. v. Cisco Sys., Inc.*, 2020-1685, 9/28/21.

Even if evidence as to an invalid infringement theory was offered, “there was sufficient evidence [of a valid theory] for the jury to find the . . . limitation . . . met.” The instructions clearly rejected the invalid theory and there was “evidence . . . independent from [the theory] that [appellant] complains was improper. Given the instruction, we must assume the jury verdict rested on a proper theory.” *Omega Patents, LLC v. CalAmp Corp.*, 2020-1793, 9/14/21.

2. Abuse of Discretion

a. Factual Errors

“While we acknowledge the district court’s factual error in finding that MLC did not identify the Toshiba and Hynix licenses, we nonetheless determine that the district court did not abuse its discretion.” *MLC Intell. Prop., LLC v. Micron Tech., Inc.*, 2020-1413, 8/26/21.

3. Review Judgments not Opinions

“The district court stated that it drew upon its own knowledge in its opinion, and while that would ordinarily constitute legal error, here the district court did so only after finding that Flash-Control had failed to show a triable issue of fact as to written description on the evidence of record. Decision at *8 n.1. The district court expressly drew on its own

knowledge only in order to expound upon additional reasons for rejecting Flash-Control’s arguments. Although the better course would have been to omit that additional reasoning, the court’s separate findings made under the proper summary judgment standard are sufficient to support the judgment. And because we review judgments, not opinions, and the judgment in this case was based upon the evidence of record, we conclude that the inclusion of that additional reasoning was not reversible error.” *Flash-Control, LLC v. Intel Corp.*, 2020-2141, 7/14/21 (nonprecedential and *Stratoflex* citation omitted)

D. Harmless Error

1. PTAB Decisions

“However, any error was harmless because we conclude that the deficiency of the prior art concerning the lubricating chamber limitation was supported by substantial evidence and hence sufficient to establish nonobviousness.” *C.R. Bard, Inc. v. Medline Indus., Inc.*, 2020-1900, 8/13/21 (nonprecedential).

E. Remand Determination

1. Resolution in the First Instance

a. Discretionary PTO Decision

“Our finding that the Patent Office misunderstood the scope of its authority to terminate reexamination once instituted would normally prompt us to vacate the Patent Office’s decision so that it may exercise the authority as now properly understood. Doing so in this case would be a waste of everyone’s resources, however. It would be arbitrary and capricious for the Patent Office to do anything on remand other than terminate the reexamination.” *In re Vivant, Inc.*, 2020-1992, 9/29/21.

IX. Patent Office Proceedings

A. Reexamination

1. Reconsideration of Original Prosecution Issues

“[A] question of patentability is new until it has been considered and decided on the merits.” *In re Vivant, Inc.*, 2020-1992, 9/29/21.

2. Interaction with IPRs

Where “vast swaths of the ex parte reexamination request copied, almost word for word, the [IPR] petition”, patentee “petitioned . . . seeking dismissal of the ex parte reexamination”, and the PTO dismissed that petition “holding that any [] petition raising 35 U.S.C. § 325(d) must be filed before reexamination is ordered . . . granting ex parte reexamination was not inconsistent with denying IPR [and] contrasted the statutory frameworks used to make each decision”, the Federal Circuit ruled that “we vacate and remand with instructions to dismiss.” *In re Vivant, Inc.*, 2020-1992, 9/29/21.

“Section 325(d) applies to both IPR petitions and requests for ex parte reexamination.” In re Vivant, Inc., 2020-1992, 9/29/21.

B. Inter Partes Review

1. Constitutionality

“The Supreme Court’s decision in *Arthex* did not disturb our holding in *Ciena Corp. v. Oyster Optics, LLC*, 958 F.3d 1157 (Fed. Cir. 2020), in which we held that a petitioner had forfeited its Appointments Clause challenge because “unlike the patent owner in *Arthrex*, [the petitioner] requested that the Board adjudicate its petition [and] thus, affirmatively sought a ruling from the Board members, regardless of how they were appointed.” *Valve Corp. v. Ironburg Inventions Ltd.*, 2020-1315, 8/17/21.

2. Appeal

a. Discretionary Denial under § 325(d)

“[W]e reject the government’s argument that § 325(d) decisions are not reviewable.” In re Vivant, Inc., 2020-1992, 9/29/21.

b. Standard for Reviewing Findings

“Unsurprisingly, Teva disagrees with the Board’s interpretations of Tan and Wimalawansa. But what a piece of prior art teaches presents a question of fact that is reviewed for substantial evidence.” *Teva Pharms. Int’l GmbH v. Eli Lilly & Co.*, 2020-1747, 8/16/21.

3. Submitting Supplemental Information/Arguments

“The single question-answer exchange between one judge and Intel regarding the increased bandwidth requirement, followed by that judge’s offhand comment that the panel would “think about whether that’s necessary,” did not provide Qualcomm notice that the Board might depart from the increased bandwidth requirement.” *Qualcomm Inc. v. Intel Corp.*, 2020-1589, 7/27/21.

4. Obviousness Rulings

a. Reversal

“[W]e conclude that the claimed designs would have been obvious over Linz. Accordingly, we reverse the Board’s decisions holding that Appellants failed to prove unpatentability based on Linz.” *Campbell Soup Co. v. Gamon Plus, Inc.*, 2020-2344, 8/19/21.

5. Board Final Written Decision

a. New Theories Adopted by Board

Board vacated where it adopted a new construction addressing “the issue of whether increased bandwidth was a required part of the claim construction[, which] was not in

dispute.” “The Board’s construction . . . diverged from the agreed-upon increased bandwidth requirement for the term; it did not merely adopt its own construction of a disputed term . . . unlike with disputed terms, it is unreasonable to expect parties to brief or argue agreed-upon matters of claim construction” *Qualcomm Inc. v. Intel Corp.*, 2020-1589, 7/27/21.

C. Appeals to District Court Under Sections 145 and 146

“We affirm the district court’s denial of expert fees because § 145 does not specifically and explicitly shift expert witness fees.” *Hyatt v. Hirshfeld*, 2020-2321, 8/18/21.