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I. Patentability Requirements

A. Inventorship/Invention and Priority Dates

“[T]he Patent Act requires an “inventor” to be a natural person.” Affirmed denial of “patent applications, which failed to list any human as an inventor.” “That non-humans may infringe patents does not tell us anything about whether non-humans may also be inventors of patents.” *Thaler v. Vidal*, 2021-2347, 8/5/22.

B. Prior Art Invalidity

1. Reference Disclosure

“We review the Board’s findings regarding the scope and content of the prior art for substantial evidence.” *Polaris Innovations Ltd. v. Brent*, 2019-1483, 9/15/22.

a. Disclosure to POSITA

i. Obvious Errors

“[W]e view *Yale*’s standard as sound law, ensuring that an obviously errant disclosure of a typographical or similar nature would not prevent a true inventor of the claimed subject matter from later obtaining patent protection.” *LG Elecs. Inc. v. ImmerVision, Inc.*, 2021-2037, 7/11/22.

“We review the Board’s . . . underlying factual findings, including whether a prior art reference includes an obvious typographical or similar error that would be apparent to persons of ordinary skill, for substantial evidence.” *LG Elecs. Inc. v. ImmerVision, Inc.*, 2021-2037, 7/11/22.

In evaluating invalidity based on a prior art reference with an error, the fact finder can consider whether “the error would have been apparent to a person of ordinary skill in the art such that the person would have disregarded the disclosure or corrected the error.” *LG Elecs. Inc. v. ImmerVision, Inc.*, 2021-2037, 7/11/22.

“Certainly, the amount of time it takes a skilled artisan to detect an error may be relevant to whether an error is, in fact, an apparent error under *Yale*. But this is just one factor for the fact finder to consider as part of the overall analysis.” “The distinction between the typographical error in *Yale* and the copy-and-paste error here is a distinction without a difference.” *LG Elecs. Inc. v. ImmerVision, Inc.*, 2021-2037, 7/11/22.

b. Comparison with Embodiments of Patent at Issue

“Weber’s reply explained that the prior art used the same type of camera as the one described in the ’089 patent’s specification. The Board properly concluded that the reply evidence was . . . *highly probative*.” *Provisur Techs., Inc. v. Weber, Inc.*, 2021-1942, 9/27/22 (emphasis added).

2. Anticipation (§ 102)

a. Published/Issued Application Under 102(e)

i. By Another Requirement

Where it is “undisputed that [new] features of [the asserted reference] were irrelevant to anticipation of the [claims at issue] and that the concept of [the claims at issue] was disclosed in the [previous reference by the inventors] and merely repeated in [the asserted reference’s] Background section . . . the Board did not err in holding that [the asserted reference] did not qualify as “the work of another.”” LSI Corp. v. Regents of the University of Minnesota, 2021-2057, 8/11/22.

3. Obviousness (§ 103)

a. Analogous Prior Art

i. Same Field of Endeavor

“[T]he ’957 patent is directed to flow meters that include different types of sensors. Elson discloses a “system for sensing a characteristic of fluid flowing” and includes a probe for sensing a desired characteristic, such as temperature. Barker is directed to a fluid temperature sensor, having a through lumen for conducting fluid. Thus, substantial evidence supports the Board’s determination that Elson and Barker are analogous art because they are at least in the same field of endeavor as the ’957 patent.” Kamstrup A/S v. Axion Metering UAB, 2021-1923, 8/12/22 (citations omitted).

b. Level of Ordinary Skill

The claim at issue “recites “using the computer to computationally calculate [a]nd the written description is replete with references to the invention being implemented on a computer. The Board, relying on these teachings, was not unreasonable in concluding that a skilled artisan would have had formal computer programming experience.” Best Med. Int’l Inc. v. Elekta Inc., 2021-2099, 8/29/22.

C. Section 101

1. Found in Nature/Preemption of Natural Phenomenon

Affirming summary judgment that claims that “apply conventional measurement techniques to detect a natural phenomenon” are ineligible based on what “the claims boil down to.” The district court “later found this fact issue non-genuine due to the explicit contradiction between CareDx’s extrinsic evidence and the numerous admissions of conventionality in the intrinsic record.” CareDx, Inc. v. Natera, Inc., 2022-1027, 7/18/22.

2. Abstract Idea Exclusion

a. Information Processing

The “claims must fail *Alice/Mayo* step one as they are directed to collection of information, comprehending the meaning of that collected information, and indication of the results, all on a generic computer network operating in its normal, expected manner. As the application’s specification suggests, nothing technical exists in the nature of these steps; they could be performed by a person reading and comprehending the meaning of the recited information.” In re Killian, 2021-2113, 8/23/22.

b. Inventive Concept/Transformation Exception

“[W]e conclude that claim 1 recites a specific technical solution that is an inventive concept: it recites a particular arrangement of peer nodes for distributing content “outside controlled networks and/or [CDNs],” which did not exist in the prior art. This is not an “abstract idea implemented on a generic computer,” and it is alleged to improve the performance of the content delivery network with reductions in costs and improvements in several aspects of system performance.” *Coop. Ent., Inc. v. Kollektive Tech., Inc.*, 2021-2167, 9/28/22 (citations omitted).

“This argument misses the point—useful improvements to computer networks are patentable regardless of whether the network is comprised of standard computing equipment. And, notably, Kollektive does not argue that the use of trace routes to segment content in claim 1’s dynamic P2P network structure is not inventive.” *Coop. Ent., Inc. v. Kollektive Tech., Inc.*, 2021-2167, 9/28/22 (citations omitted).

No inventive concept where “the claims require comparing information against eligibility requirements—the same process that humans seeking to determine benefit eligibility must follow either with or without a computer.” In re Killian, 2021-2113, 8/23/22.

3. Stage of Case for Determination

a. Motion to Dismiss

i. Claim Construction Role

“As Kollektive acknowledges, Cooperative asserted below and on appeal that “[t]he ’452 patent claims all require segmenting the digital content according to the trace routes.” The district court did not conduct claim construction or otherwise resolve whether claim 1 requires segmenting content based on a trace route. Under these circumstances, we “proceed by adopting the non-moving party’s construction[.]” that claim 1 requires segmenting content based on trace routes.” *Coop. Ent., Inc. v. Kollektive Tech., Inc.*, 2021-2167, 9/28/22 (citations omitted).

ii. Alice Step Two

“Claim 1 contains several alleged inventive concepts which the specification touts as specific improvements in the distribution of data compared to the prior art. The amended complaint plausibly alleges these inventive concepts, and this should have defeated Kollektive’s Rule 12(b)(6) motion in this case.” *Coop. Ent., Inc. v. Kollektive Tech., Inc.*, 2021-2167, 9/28/22.

b. Summary Judgment

Summary judgment affirmed where district court “later found this fact issue non-genuine due to the explicit contradiction between CareDx’s extrinsic evidence and the numerous admissions of conventionality in the intrinsic record.” *CareDx, Inc. v. Natera, Inc.*, 2022-1027, 7/18/22.

D. Post-Issuance Invalidity

1. Reissued Patents

a. Recapture Rule

“Whether the recapture rule applies to a particular set of facts—that is, whether the claims of a reissue patent violate 35 U.S.C. § 251—is a question of law, which we review de novo.” *In re McDonald*, 2021-1697, 8/10/22.

i. Surrendered Subject Matter

“The common thread through our prior decisions remains whether there is an intentional surrender of claim scope.” “We reject the argument that the recapture rule leaves a unique gap that would permit the recapture of claim scope surrendered in response to § 101 rejections.” *In re McDonald*, 2021-1697, 8/10/22.

E. Timing of Expiration

1. Term Extension

a. Appellate Review Delay

“While there is no dispute that the Board cast aside the examiner’s basis for rejecting claim 11, the Board in the same review found claim 11 unpatentable, albeit for a different reason. . . . The appeal thus resulted in no substantive change in the patentability of claim 11. Such a substantive change is required by the language of the statute itself.” *SawStop Holding LLC v. Vidal*, 2021-1537, 9/14/22.

“The statutory requirement is not met if the claim that ultimately issues differs substantively from the claim under review.” *SawStop Holding LLC v. Vidal*, 2021-1537, 9/14/22.

“[T]he singular reversal referenced in the statute is the determination of patentability of the claim under appellate review, not a basis for a rejection or number of rejections.” *SawStop Holding LLC v. Vidal*, 2021-1537, 9/14/22.

“Here, the only claim that was subject to the decision under review was claim 1, which was cancelled and thus not part of the issued patent. The ’796 patent therefore did not issue under a decision in the review.” *SawStop Holding LLC v. Vidal*, 2021-1537, 9/14/22.

F. Assignor/Licensor Estoppel

“[C]laim 1 is not “materially broader” than the claims assigned to [the assignee]. Accordingly, [the assignor] is estopped from challenging the validity of claim 1.” *Hologic, Inc. v. Minerva Surgical, Inc.*, 2019-2054, 8/11/22.

“The 2004 assignment assigned not just the rights to the ’072 application, but also the rights to any continuation, continuation-in-part, or divisional patent applications not yet filed. For certain, canceled claim 31 [cancelled due to a restriction requirement] traveled with the ’072 application and its assignment to Hologic.” Mr. Truckai signed an oath when presenting the ’072 application . . . Mr. Truckai represented (whether implicitly or explicitly) that the subject matter of claim 31 was not invalid.” *Hologic, Inc. v. Minerva Surgical, Inc.*, 2019-2054, 8/11/22.

The “materially broader” determination requires “constru[ing] the assigned and issued claims and compare the properly construed claims, focusing on the material aspects of those claims. Because this determination rests on principles of claim construction, it is ultimately a question of law we review de novo where, as here, it is decided only on the intrinsic evidence.” *Hologic, Inc. v. Minerva Surgical, Inc.*, n.4, 2019-2054, 8/11/22.

“[W]e need not in this case define the line between broader claims and materially broader claims.” *Hologic, Inc. v. Minerva Surgical, Inc.*, 2019-2054, 8/11/22.

II. Other Defenses

A. Improper Venue

1. Mandamus

It is possible that “the issue of imputing employee homes to a defendant for purposes of venue will become an issue of greater concern given the shift to remote work. But, in our view, at present, the district court’s ruling does not involve the type of broad, fundamental, and recurring legal question or usurpation of judicial power that might warrant immediate mandamus review.” *In re Monolithic Power Sys., Inc.*, 2022-153, 9/30/22.

III. Literal Infringement

A. Capability

“We agree with the intervenors that, although the asserted ’439 claims do not include the base station itself, the base station’s operation is a part of the infringement analysis.” INVT SPE LLC v. Int’l Trade Comm’n, 2020-1903, 8/31/22.

“For infringement purposes, a computer-implemented claim drawn to a functional capability requires some showing that the accused computer-implemented device is programmed or otherwise configured, without modification, to perform the claimed function when in operation.” INVT SPE LLC v. Int’l Trade Comm’n, 2020-1903, 8/31/22.

“In contexts involving software functionality, we have never suggested that reasonable capability can be established without any evidence or undisputed knowledge of an instance that the accused product performs the claimed function when placed in operation.” “Because we require claim limitations to have some teeth and meaning, proof of reasonable capability of performing claimed functions requires, at least as a general matter, proof that an accused product—when put into operation—in fact executes all of the claimed functions at least some of the time or at least once in the claim-required environment.” INVT SPE LLC v. Int’l Trade Comm’n, 2020-1903, 8/31/22.

B. Standard of Proof/Review

1. ANDA Infringement

“If the ANDA specification does not speak clearly and directly to the question of infringement, courts may look to other relevant evidence, such as data or samples the ANDA filer has submitted to the FDA, to assess whether a proposed product will infringe.” Par Pharm., Inc. v. Eagle Pharms. Inc., 2021-2342, 8/18/22.

A patentee’s “unsupported conjecture that [the accused infringer] will not abide by its [ANDA] representations is inadequate to establish infringement.” Par Pharm., Inc. v. Eagle Pharms. Inc., 2021-2342, 8/18/22.

C. Functional and Means plus Function Language

1. Sale of products Capable of Performing Function

“An accused device cannot meet the required capabilities of the ’439 claims without evidence or agreement that the accused device performs, without modification, the recited functions at least once when it is in operation.” INVT SPE LLC v. Int’l Trade Comm’n, 2020-1903, 8/31/22.

D. Evidence of Infringement

1. Technical Standards

“Infringement can be proven based on an accused product’s use of an industry standard if the asserted claim is standard essential.” “Therefore, once a claim is found to be standard essential, that is sufficient to find infringement for any standard-compliant device.” *INVT SPE LLC v. Int’l Trade Comm’n*, 2020-1903, 8/31/22.

IV. Relief

A. Attorneys’ fees

1. Sanctions Under Inherent Powers

Attorney fee award affirmed based on patentee dismissing Delaware case after magistrate judge recommended 101 invalidity and “refiling in California, [where] it could effectively erase the Delaware magistrate judge’s fulsome and compelling patent-ineligibility analysis and findings.” “While we agree with Realtime that it is generally permissible under Rule 41(a)(1)(A)(i) for a plaintiff to voluntarily dismiss an action and refile the case in another forum, that is a woefully incomplete description of the circumstances of this case.” *Realtime Adaptive Streaming LLC v. Netflix, Inc.*, 2021-1484, 7/27/22.

B. Injunction

1. Preliminary Injunction

a. Irreparable Harm

i. Speculative/Future Harm

“Evidence of speculative harms, such as customers merely expressing concern that a potential future ITC exclusion order could affect Thales’ ability to deliver products down the road, is insufficient to show a *likelihood* of irreparable harm.” *Koninklijke Philips N.V. v. Thales DIS AIS USA LLC*, 2021-2037, 7/11/22 (emphasis in original).

2. Injunctions Against Other Proceedings

a. Injunctions Against ITC

Defendant in patent case pleaded a “declaratory counterclaim for a FRAND rate determination, and it moved for a preliminary injunction barring Philips from pursuing its ITC action.” Federal Circuit affirmed denial of injunction. *Koninklijke Philips N.V. v. Thales DIS AIS USA LLC*, 2021-2037, 7/11/22.

“Evidence of speculative harms, such as customers merely expressing concern that a potential future ITC exclusion order could affect Thales’ ability to deliver products down

the road, is insufficient to show a *likelihood* of irreparable harm.” Koninklijke Philips N.V. v. Thales DIS AIS USA LLC, 2021-2037, 7/11/22 (emphasis in original).

3. SEPs/FRAND and Injunctions

a. Injunctions Against Exclusion Orders

Defendant in patent case pleaded a “declaratory counterclaim for a FRAND rate determination, and it moved for a preliminary injunction barring Philips from pursuing its ITC action.” Federal Circuit affirmed denial of injunction. Koninklijke Philips N.V. v. Thales DIS AIS USA LLC, 2021-2037, 7/11/22.

V. Claim Construction

A. Claim Language

1. Plain and Ordinary Meaning

a. How the Claim Could Have Been Written

“Mr. Truckai and the other inventors knew how to draft claims that require moisture permeability. The fact that they chose not to include this limitation in claim 31, unlike claims 1 and 16, indicates that they did not intend to so limit that claim.” Hologic, Inc. v. Minerva Surgical, Inc., 2019-2054, 8/11/22.

b. Exceptions

““[M]emory chip” would have been understood by a person of ordinary skill as either a packaged integrated circuit or an unpackaged integrated circuit die. Thus, as the Board correctly recognized, Polaris must find support in the intrinsic record to limit the broad claim language only to the latter option.” Polaris Innovations Ltd. v. Brent, 2019-1483, 9/15/22 (citations omitted).

2. Functional and Structural Language

a. Capable/Adaptable/Adjustable Elements

“Because of the nature of the technology, computer and software claims typically use functional language to define the invention. Functional language is used to define and delimit otherwise generic or interchangeable general purpose computer hardware, which can be programmed to perform an unlimited array of functions. In other words, the recited operative steps a computer- or software-based device undertakes is what defines what a computer-implemented invention is. We have frequently construed such functional language as not requiring actual performance of those operative steps for infringement purposes. Moreover, we have not required claims to adhere to a specific grammatical form to find that the claim is drawn to capability, contrary to the Commission’s and the intervenors’ contentions.” INVT SPE LLC v. Int’l Trade Comm’n, 2020-1903, 8/31/22.

3. Effect of Other Claims

a. Claim Differentiation

i. Surplusage Rather Than Differentiation

“[C]laim 1, which allows single-chip or multiple-chip semiconductor memory components, [has dependent] claim 2, which requires a plurality of chips. But the distinction between the claims regarding number of chips in a semiconductor memory component remains whether or not the chips are individually packaged. Thus, the Board did not violate the principle of claim differentiation.” *Polaris Innovations Ltd. v. Brent*, 2019-1483, 9/15/22.

b. Surplusage Subset, Explicit Bars Implicit

“Mr. Truckai and the other inventors knew how to draft claims that require moisture permeability. The fact that they chose not to include this limitation in claim 31, unlike claims 1 and 16, indicates that they did not intend to so limit that claim.” *Hologic, Inc. v. Minerva Surgical, Inc.*, 2019-2054, 8/11/22.

4. Product by Process Claims

Court affirmed that ““cast in one piece” is a product-by-process claim element” where “[t]he claim describes “a monolithic polymer structure being cast in one piece.” On its face, the claim element claims a process because it describes the structure “being” cast in a particular way.” “[specification] disclosure discussing the fabrication process for the device [is] further support that this is a product-by-process claim element.” *Kamstrup A/S v. Axioma Metering UAB*, 2021-1923, 8/12/22.

The product-by-process claim element does not “impart[] patentable weight to the claims” because Appellant “has not identified functional and structural differences between a structure “cast in one piece” and a structure manufactured using another method. Rather, the argument is merely that the claim element describes a manufacturing method with some inherent restrictions.” “Second, the alleged structural and functional difference that Kamstrup identifies is detached from the claims.” *Kamstrup A/S v. Axioma Metering UAB*, 2021-1923, 8/12/22.

VI. Procedural Law

A. Applicable Circuit Law

1. Dismissal of Duplicative Complaints

“Under the circumstances of this case, the question of dismissing the Arendi II complaint as duplicative of the Arendi I complaint involves a procedural issue [, w]e, therefore, apply the Third Circuit’s standard of reviewing dismissals of duplicative complaints for abuse of discretion.” *Arendi S.A.R.L. v. LG Elecs. Inc.*, 2021-1967, 9/7/22.

B. Construction

1. Statutes/Regulations

a. Persons v. Entities v. Individuals

“[T]he Dictionary Act, . . . provides that legislative use of the words “person” and “whoever” broadly include (“unless the context indicates otherwise”) “corporations, companies, associations, firms, partnerships, societies, and joint stock companies, as well as individuals.” 1 U.S.C. § 1.” *Thaler v. Vidal*, 2021-2347, 8/5/22.

C. Pleadings/Parties

1. Amendments

a. Asserting New Patent Claims

“[I]t is unsurprising that a defendant would assert invalidity of any claim a plaintiff purported to assert. This does not act as a waiver of [defendant]’s right to challenge whether these claims were properly part of the case and does not prohibit the district court from denying [plaintiff]’s subsequent request to amend.” *Click-to-Call Techs., LP v. Ingenio, Inc.*, 2022-1016, 8/17/22.

2. Dismissal of Duplicative Complaints

Reviewed for “for abuse of discretion.” *Arendi S.A.R.L. v. LG Elecs. Inc.*, 2021-1967, 9/7/22.

“The duplicative-litigation doctrine does not require a final judgment to bar a later complaint, but it does involve a similar inquiry in that it also looks to whether the later complaint is, essentially, repetitious.” *Arendi S.A.R.L. v. LG Elecs. Inc.*, n.1, 2021-1967, 9/7/22.

No abuse of discretion in dismissing second complaint asserting identical patents and identifying products accused in the first case, even though appellant asserted a “lack of overlap is a consequence of the district court’s grant of [motion to strike infringement report portions related to accused products because patentee] “failed to fulfill its discovery obligations” with respect to those products.” *Arendi S.A.R.L. v. LG Elecs. Inc.*, n.1, 2021-1967, 9/7/22.

D. Transfer to New Judge or Venue

Mandamus denied where “[t]he court found, among other things, that the locus of events giving rise to this suit largely took place outside of the transferee venue and that the Texas forum, where several of Monolithic’s customers are located, could more easily access relevant information pertaining to induced and contributory infringement and could compel several potential third-party witnesses. The court weighed these and other administrative factors against two willing witnesses within the transferee forum favoring transfer and

determined that Monolithic had not demonstrated that the transferee form was clearly more convenient.” In re Monolithic Power Sys., Inc., 2022-153, 9/30/22.

VII. Federal Circuit Appeals

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

“We will not fault the district court for failing to apply a case that [Appellant] did not even present to the district court.” Click-to-Call Techs., LP v. Ingenio, Inc., 2022-1016, 8/17/22.

1. Discretion to Reach Forfeited or Waived Issue

“[W]e are not required to accept [Appellant]’s legal arguments even if [Appellee] did not respond. Hyatt v. U.S. Pat. & Trademark Off., n.5, 2021-2324, 9/8/22.

“We need not decide whether PAN similarly forfeited its Appointments Clause challenge by seeking institution decisions under regulations that make no provision for Director review (arguably a different situation from that presented in *Ciena*) because “courts of appeals may forgive waiver or forfeiture of claims that implicate structural constitutional concerns.”” In re Palo Alto Networks, Inc., 2022-145, 8/16/22.

2. Mischaracterizations of Reviewed Decision

“Thus, the bulk of [Appellant]’s argument on appeal—contending that the Board [adopted a certain argument— is founded on a faulty premise.” Polaris Innovations Ltd. v. Brent, 2019-1483, 9/15/22.

B. Appellate Jurisdiction

1. Mootness

“We also hold that Munsingwear vacatur is inapplicable here because this appeal did not become moot during the pendency of the appeal.” Best Med. Int’l Inc. v. Elekta Inc., 2021-2099, 8/29/22.

a. ITC Appeals

“[T]he ’590 patent portion of this appeal is mooted due to the intervening happenstance of the patent’s expiration.” INVT SPE LLC v. Int’l Trade Comm’n, 2020-1903, 8/31/22.

C. Sanctions/Contempt

Federal Circuit found that appeal against SJ of noninfringement was frivolous both “as filed” and “as argued.” “We award Kobo \$107,748.27, for which Pop Top and its counsel are jointly and severally liable.” Pop Top Corp. v. Rakuten Kobo Inc., 2021-2174, 7/14/22 (nonprecedential).

D. Scope of Claim Construction Review

1. Claim Construction Modified on Appeal

a. Affirmed/Reversed Under New Construction

“We agree with INVT that the asserted ’439 claims are drawn to “capability,” and not to actual operation as the ALJ found. However, INVT has failed to show that the accused LTE-compliant devices have the capability required by the claims. Therefore, whether under a theory of the claims being standard essential or the claims being met by the accused devices, INVT has not proven infringement.” INVT SPE LLC v. Int’l Trade Comm’n, 2020-1903, 8/31/22.

“The ALJ erred in construing claim limitations as requiring more than capability for infringement, a legal question. The ALJ’s factual findings for noninfringement, however, are equally applicable under the correct claim construction because, as a matter of law, reasonable capability cannot be proven in light of the total absence of evidence put on by INVT.” INVT SPE LLC v. Int’l Trade Comm’n, 2020-1903, 8/31/22.

E. Standards of Review and Record/Appendix on Appeal

1. Substantial Evidence Threshold

a. Prior Art

“The Board grounded its finding in the testimony from Mylan’s own expert, Dr. Chorghade, stating that nothing in Edmondson directs a skilled artisan to sitagliptin from among the 33 listed DP-IV inhibitors. Further, nothing in Edmondson singles out phosphoric acid or any phosphate salt of any DP-IV inhibitor, and the list of “pharmaceutically preferred” salts comes 44 pages earlier in the specification. The Board reasonably concluded that Edmondson does not expressly disclose the 1:1 sitagliptin DHP salt.” Mylan Pharms. Inc. v. Merck Sharp & Dohme Corp., 2021-2121, 9/29/22.

b. Expert Testimony

i. Not substantial

Expert testimony agreeing to a conclusion based on an assumption for which there is no evidence, is not substantial evidence of that conclusion. “INVT’s counsel posed a hypothetical, which Dr. Acampora ultimately agreed with. This hypothetical included *as an assumption* that there is a MCS index that the base station can choose and send to the user device that could result in a coding parameter that is listed in the CQI table.” “Dr. Acampora’s testimony does not show that the base station, operating under the LTE standard, ever selects the same parameters chosen by the user device.” INVT SPE LLC v. Int’l Trade Comm’n, 2020-1903, 8/31/22.

2. Clear/Plain Error Review

a. Prohibited Evidence Reweighing

“[Appellant] does not contest that products manufactured using the optimized process did not drift into the infringing range. Instead, it asserts the post-optimization data is less probative than the evidence of pH fluctuations in pre-optimized products because there was less testing on the post-optimization products. [Appellant] is simply challenging the district court’s weighing of the evidence. Absent a clear conviction the district court erred, it is not our role to set aside the district court’s factual findings.” *Par Pharm., Inc. v. Eagle Pharms. Inc.*, 2021-2342, 8/18/22.

3. Abuse of Discretion

“[W]e refuse to find an abuse of discretion in the district court’s short analysis, considering the minimal effort [Appellant] put into making its argument [below].” *Click-to-Call Techs., LP v. Ingenio, Inc.*, 2022-1016, 8/17/22.

F. Remand Determination

1. Remand for Sufficient Reasoning to Review

“[W]e refuse to find an abuse of discretion in the district court’s short analysis, considering the minimal effort [Appellant] put into making its argument [below].” *Click-to-Call Techs., LP v. Ingenio, Inc.*, 2022-1016, 8/17/22.

G. Briefing Related and Multi-Defendant Cases

1. Letters under Rule 28(j)

“Following oral argument, Mr. Hyatt submitted a Rule 28(j) letter in an attempt to clarify this SAA-based argument. This letter was improper. Rule 28(j) is not a vehicle for seeking to substantively improve an answer to a question asked of a party at oral argument, and it is certainly not a vehicle for attempting to supplement briefing with four new paragraphs of argument and citations to five new cases that Mr. Hyatt could have identified previously.” *Hyatt v. U.S. Pat. & Trademark Off.*, 2021-2324, 9/8/22.

VIII. Patent Office Proceedings

A. Inter Partes Review

1. Constitutionality

Federal Circuit rejects argument that “the categorical refusal to accept requests for Director review of institution decisions violates the Appointments Clause.” “[T]his case fundamentally differs from *Arthrex*. Here, there is no structural impediment to the Director’s authority to review institution decisions either by statute or by regulation. Indeed, institution decisions are, by statute, the Director’s to make and are only made by

the Board as a matter of delegated authority.” In re Palo Alto Networks, Inc., 2022-145, 8/16/22.

2. Appeal

a. Sufficient Reasoning to Review

The Board only analyzed one limitation of the independent claims and only adopted petition for the others (e.g., “Petitioner’s argument and evidence summarized above, which we adopt as our own, persuades us that [prior art] collectively disclose or suggest all elements of claim 1 other than [the analyzed limitation.]”) That was inadequate under the APA where PO “argued that “[petitioner] failed to show how the purported combination would have worked to determine a [different limitation]” and “then proceeded to examine the disclosures [petitioner] relied on as teaching that claim element and concluded that “[petitioner] offers no explanation on how the two [references] would be combined to disclose this claim limitation.”” Provisur Techs., Inc. v. Weber, Inc., 2021-1942, 9/27/22.

b. Independent Bases for Affirmance

Affirmed without reaching the merits because where “[t]he Board concluded that this theory was both untimely (because it was raised for the first time at the Board hearing) and unpersuasive . . . the Board’s timeliness holding constitutes an independent ground for its decision.” LSI Corp. v. Regents of the University of Minnesota, 2021-2057, 8/11/22.

c. Remand to Consider Relevant Arguments/Evidence in Record

“We therefore conclude that the Board erred in deciding that claims 11 and 12 are not obvious and accordingly vacate that judgment. On remand, should the Board find the independent claims obvious after considering the surfacearea limitations, claims 11 and 12 are also obvious in view of the Board’s determinations regarding claims 2, 6, and 7, which we do not otherwise disturb on appeal.” Provisur Techs., Inc. v. Weber, Inc., 2021-1942, 9/27/22.

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

“The Board did not abuse its discretion. Weber’s IPR petition purported to explain why the ’089 patent’s claims were invalid, Provisur’s response argued that the prior art did not disclose a digital camera, and Weber’s reply explained that the prior art used the same type of camera as the one described in the ’089 patent’s specification. The Board properly concluded that the reply evidence was both directly responsive to Provisur’s arguments and highly probative.” Provisur Techs., Inc. v. Weber, Inc., 2021-1942, 9/27/22.

“Provisur contends that Weber’s reply “gap-filled” the petition, but the gaps it points to are the holes it tried—and failed—to poke with its responsive arguments.” Provisur Techs., Inc. v. Weber, Inc., n.1, 2021-1942, 9/27/22.

4. Scope of Estoppel

“[T]he district court’s reason for rejecting [Appellant]’s argument—a reason derived from the issue-preclusion rubric—does not apply to IPR estoppel . . . IPR estoppel has no such express requirement.” *Click-to-Call Techs., LP v. Ingenio, Inc.*, 2022-1016, 8/17/22.

“It is true that § 315(e) estoppel applies on a “claim-by-claim basis.” And the statute does specify that it applies estoppel from “an inter partes review of a claim in a patent under this chapter that results in a final writ-ten decision.” § 315(e)(2). But here, [Appellee] included claim 27 in its petition, and the IPR did result in a final written decision. The fact that the Board, due to a legal error corrected by *SAS*, failed to include claim 27 in its final written decision does not absolve [Appellee] of the estoppel triggered by its choice to challenge claim 27 at the Board.” *Click-to-Call Techs., LP v. Ingenio, Inc.*, 2022-1016, 8/17/22 (citation omitted).

Appellee “was not helpless to remedy the Board’s institution error. Due to the long appellate history of the IPR proceeding, the appeal of [Appellee]’s IPR was still pending at the time *SAS* issued in 2018. [Appellee], however, never sought a *SAS* remand directing the Board to address its non-instituted claims and grounds.” *Click-to-Call Techs., LP v. Ingenio, Inc.*, 2022-1016, 8/17/22.

“The PTO argues that [petitioner]’s statutory interpretation of the estoppel provision is incorrect because ‘the denied ground never became part of the IPR.’ We agree with the PTO that § 315(e) would not estop [petitioner] from bringing its [rejected as redundant] arguments in either the PTO or the district courts.” *Shaw Indus. Group, Inc. v. Automated Creel Sys., Inc.*, 2015-1116, 3/23/16 (“We recently overruled *Shaw. Caltech*, 25 F.4th at 991.” *Click-to-Call Techs., LP v. Ingenio, Inc.*, 2022-1016, 8/17/22.)

5. Settlement

“[T]he Board administratively suspended the IPRs (along with many others) pending potential Supreme Court action in *Arthrex I*. During that administrative suspension, . . . Polaris and NVIDIA filed a joint motion to terminate the proceedings.” “[T]he Supreme Court vacated our vacatur . . . the Board determined “the appropriate course of action on remand . . . [wa]s to authorize [Polaris] to request Director review.” This order effectively denied the joint motions to terminate.” “[B]ecause the Board decided the merits of the IPR before Polaris filed its motion to terminate, Polaris’s motion was untimely.” *Polaris Innovations Ltd. v. Brent*, 2019-1483, 9/15/22 (citations omitted).

“[T]he plain language of the statute gives the Board discretion to carry on to a final written decision—even without any petitioner.” *Polaris Innovations Ltd. v. Brent*, 2019-1483, 9/15/22.

6. Board Final Written Decision

a. Addressing Parties' Arguments

i. Inadequate Analysis

“Because the Board never directly or implicitly addressed the arguments that Weber had set forth in its petition, it erred.” *Provisur Techs., Inc. v. Weber, Inc.*, 2021-1942, 9/27/22.

b. Covering Claims and Grounds from Petition

“As the Board correctly noted, claim 1 had not been finally canceled at that point (e.g., BMI had not filed a statutory disclaimer of the patent claim under 35 U.S.C. § 253(a)) and so it remained part of the proceeding.” “We cannot say that the Board erred in addressing claim 1’s patentability under these circumstances.” *Best Med. Int’l Inc. v. Elekta Inc.*, 2021-2099, 8/29/22.

c. Contradictions

“Second, and more importantly, the Board’s findings for claims 11 and 12 are inconsistent with those it made for claims 2, 6, and 7.” *Provisur Techs., Inc. v. Weber, Inc.*, 2021-1942, 9/27/22.