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I. Patentability Requirements

A. Inventorship/Invention and Priority Dates

1. Conception

a. Design Changes

“The Board therefore legally erred by focusing on Regents’ scientists’ statements of uncertainty, without considering whether those statements led to modifications in their experiments that substantively changed their original idea.” Regents of the University of California v. Broad Institute, Inc., 2022-1594, 5/12/25.

b. Difference from Reduction

“The Board therefore legally erred by requiring Regents’ scientists to know their invention would work to prove conception.” Regents of the University of California v. Broad Institute, Inc., 2022-1594, 5/12/25.

c. Role of Ordinary/Routine Level of Skill

“[T]he Board erred by failing to consider routine methods or skill, focusing almost entirely on Regents’ scientists’ perceived experimental difficulties and related statements of doubt.” Regents of the University of California v. Broad Institute, Inc., 2022-1594, 5/12/25.

2. Priority from Previous Applications

a. Burden of Proof

“The district court clearly and consistently communicated to the jury that Ingenico had the burden of proving the prior art predated the claimed invention. We see no error in the district court’s instruction.” Ingenico, Inc. v. IOENGINE, LLC, 2023-1367, 5/7/25.

B. Prior Art Invalidity

1. Reference Disclosure

a. Disclosure to POSITA

i. Not Express

“An anticipation analysis is undertaken from the perspective of the person of ordinary skill in the art and, therefore, must take account of the knowledge of such a person.” Sage Prods., LLC v. Stewart, n.5, 2023-1603, 4/15/25.

b. Inconsistent Embodiments

“The disclosure of some non-working examples in Pioneer Hi-Bred does not undermine the disclosure of other examples that were disclosed as functional.” *Agilent Techs., Inc. v. Synthego Corp.*, 2023-2186, 6/11/25.

2. Anticipation (§ 102)

a. Public Use Bar

i. Actual Use Requirement

“It is true that public use requires actual use. But circumstantial evidence is not second-class to direct evidence.” “M-Systems’ employees were encouraged to inform their partners, customers, reps, and distributors about the Firmware Upgrader. Those customers had access to a user guide that informed them about the beneficial functionality of the Firmware Upgrader.” “And it is not in dispute that a single download of the Firmware Upgrader results in a system that meets the patents-at-issue’s claim requirements. Thus, there is substantial evidence to support the jury’s finding that the DiskOnKey System, including the Firmware Upgrader, was in public use.” *Ingenico, Inc. v. IOENGINE, LLC*, 2023-1367, 5/7/25.

ii. By Third Party

No difference with public use by inventor or requirement that “the claimed features of the invention are discernible from a prior art product that is accessible to the public.” *Ingenico, Inc. v. IOENGINE, LLC*, 2023-1367, 5/7/25.

b. Enablement

Faulty testing data irrelevant to enablement when it does not correspond to claimed subject matter. “Agilent’s argument is unpersuasive because the testing data Agilent cites is only applicable to synthetic DNA sequences, not to the modified RNA sequences at issue in the challenged claims.” *Agilent Techs., Inc. v. Synthego Corp.*, 2023-2186, 6/11/25.

3. Obviousness (§ 103)

a. Relationship to Anticipation

“Agilent’s argument assumes that express disclosure of PACE and thioPACE modifications in Pioneer Hi-Bred is required, but the Board found the dependent claims unpatentable as obvious, which does not necessarily require all the claimed limitations to be expressly disclosed in Pioneer Hi-Bred.” *Agilent Techs., Inc. v. Synthego Corp.*, 2023-2186, 6/11/25.

b. Secondary Indicia of Nonobviousness

i. Licensing Showing Value

“The Board applied a more exacting nexus standard than our case law requires for license evidence. Unlike products, which may incorporate numerous features beyond those claimed or described in a patent and therefore may require careful parsing to establish a nexus, actual licenses to the subject patent do not demand the same, as they are, by their nature, directly tied to the patented technology.” *Ancora Techs., Inc. v. Roku, Inc.*, 2023-1674, 6/16/25.

“The reverse is not true in the context of nexus findings; that is, the fact that a license concerns rights to more than one patent does not detract from the fact that each patent is a subject of the license.” *Ancora Techs., Inc. v. Roku, Inc.*, 2023-1674, 6/16/25.

ii. Licensing Showing Lack of Value

“The Board further noted, but did not evaluate, petitioners’ arguments citing Ancora’s settlements with other companies in which Ancora licensed the ’941 patent for much less than anticipated litigation costs.” “On remand, the Board should also consider the nexus issue and the probative value of these licenses and weigh that against the licenses produced by Ancora in support of its argument of commercial success as objective indicia of nonobviousness.” *Ancora Techs., Inc. v. Roku, Inc.*, 2023-1674, 6/16/25.

iii. Nexus

“It was not error for the Board to require that the AMI press release and agreement have a nexus to the challenged claims as opposed to the patent as a whole.” *Ancora Techs., Inc. v. Roku, Inc.*, 2023-1674, 6/16/25.

c. Level of Ordinary Skill

Affirming Board’s determination of knowledge based on experience: specifically, that it was “implausible that someone with four years of experience with sterilization processes for medical products and their components would lack familiarity with the regulatory regimes that set the conditions under which the products or processes they work with may be used.” *Sage Prods., LLC v. Stewart*, 2023-1603, 4/15/25.

C. Section 282

1. Jury Instruction

“Here, the district court properly and repeatedly instructed the jury on the clear and convincing standard. Thus, there was no error in declining to instruct the jury on the presumption of validity.” *Ingenico, Inc. v. IOENGINE, LLC*, 2023-1367, 5/7/25.

D. Invalidity Based on § 112

1. Written Description (§ 1)

a. Predictable/Unpredictable Arts

“[T]he Board inquired about working examples as but one indication, in addition to others, of whether a person of ordinary skill in the art would understand P1 to establish possession despite the complex and unpredictable nature of the technology at hand. In doing so, the Board faithfully applied our precedent.” *Regents of the University of California v. Broad Institute, Inc.*, 2022-1594, 5/12/25.

2. Indefiniteness (§ 2)

a. Means plus function elements

“Fintiv’s purported two-step algorithm merely recites the asserted claims’ language. The specifications do not provide additional disclosures other than reciting the function of the payment-handler terms using generic terms without providing any details about an algorithm to carry out the functions of using APIs of different payment processors including one or more APIs of banks, credit and debit cards processors, bill payment processors, and exposing a common API for interacting with different payment processors.” *Fintiv, Inc. v. PayPal Holdings, Inc.*, 2023-2312, 4/30/25.

E. Section 101

1. Abstract Idea Exclusion

a. Claimed Subject Matter

“USAA discusses how “accomplishing check deposit on a consumer device required the development of extremely non-obvious algorithms.” But those algorithms are not found within the claim or the specification—the claim merely recites a system that is “configured to” “authenticate the customer,” “check for errors,” and “confirm that the mobile check deposit can go forward”” *United Servs. Auto. Ass’n v. PNC Bank N.A.*, 2023-1639, 6/12/25 (citation omitted).

b. Application of Information or Mathematical Algorithm(s)

“[T]he claims are directed to reciting an equation that outputs a value to be used as the specific start position for decoding information in a cellular network. This is an ineligible mathematical formula.” *Optis Cellular Tech., LLC v. Apple Inc.*, 2022-1925, 6/16/25.

c. Application of Machine Learning/AI

“This case presents a question of first impression: whether claims that do no more than apply established methods of machine learning to a new data environment are patent

eligible. We hold that they are not.” *Recentive Analytics, Inc. v. Fox Corp.*, 2023-2437, 4/18/25.

d. Improving Computer Functionality

“The requirements that the machine learning model be “iteratively trained” or dynamically adjusted in the Machine Learning Training patents do not represent a technological improvement.” *Recentive Analytics, Inc. v. Fox Corp.*, 2023-2437, 4/18/25.

e. Information Processing

“But these are routine processes implemented by a general-purpose device (e.g., a handheld mobile device) in a conventional way” “The addition of a handheld mobile device to carry out these routine steps does not make the claim any less abstract.” *United Servs. Auto. Ass’n v. PNC Bank N.A.*, 2023-1639, 6/12/25.

f. Inventive Concept/Transformation Exception

“Moreover, the mobile device is a piece of generic hardware. USAA contends that the inventive concept is implementing these steps on a customer’s mobile device, instead of a specialized check scanner. But such implementation is not inventive.” *United Servs. Auto. Ass’n v. PNC Bank N.A.*, 2023-1639, 6/12/25 (citation omitted).

i. Data Capture and Handling

“The claim recites nothing more than routine image capture, OCR, and data processing steps—all of which were well-known and routine.” *United Servs. Auto. Ass’n v. PNC Bank N.A.*, 2023-1639, 6/12/25.

ii. Judge or Jury

“If on remand the district court chooses to have the jury decide whether what Optis alleges is the inventive concept is well-understood, routine, and conventional, then the jury should be instructed what the abstract idea is (i.e., a mathematical formula) and that the abstract idea cannot contribute to the inventive concept.” *Optis Cellular Tech., LLC v. Apple Inc.*, n.11, 2022-1925, 6/16/25.

2. Stage of Case for Determination

a. Summary Judgment

“USAA argues that summary judgment should be denied even if we reach step two, because there are still material disputes of fact, namely that some claim elements, like OCR, remote deposit applications, and cameras, were not conventional. We disagree; there are no genuine disputes of material fact on this issue.” *United Servs. Auto. Ass’n v. PNC Bank N.A.*, 2023-1639, 6/12/25 (citation omitted).

F. Post-Issuance Invalidity

1. Reissued Patents

a. Broadening After 2 Years

“The text, history, and purpose of 35 U.S.C. § 251 all support looking at the actual scope of the original claim language, not the intended scope. Accordingly, when considering whether a reissued patent broadens the scope of the original patent under 35 U.S.C. § 251(d), we hold that we look to the actual scope of the claim-at-issue, not the subjective intended scope of the inventors.” *In re Kostic*, 2023-1437, 5/6/25.

II. Other Defenses

A. Equitable Estoppel

Equitable estoppel “has three requirements (1) the patentee engages in misleading conduct that leads the accused infringer to reasonably infer that the patentee does not intend to assert its patent against the accused infringer; (2) the accused infringer relies on that conduct; and (3) as a result of that reliance, the accused infringer would be materially prejudiced if the patentee is allowed to proceed with its infringement action.” *Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V. v. Sirius XM Radio Inc.*, 2023-2267, 6/9/25 (quoting *Ferring B.V. v. Allergan, Inc.*, 980 F.3d 841, 853 (Fed. Cir. 2020)).

1. Misleading Conduct

“[I]f we accept Fraunhofer’s view that all parties knew that any rights SXM had in the asserted patents were “derivative of” the rights granted from Fraunhofer to WorldSpace in the Master Agreement, such that “termination” of the Master Agreement in 2010 stripped SXM of any of its rights to the patents, then the more-than-five-year delay in raising the issue of SXM’s potential infringement rises to the level of misleading conduct.” *Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V. v. Sirius XM Radio Inc.*, 2023-2267, 6/9/25 (emphasis in original).

“We therefore agree with the district court’s conclusion that Fraunhofer’s more-than-five-year silence in asserting infringement, in light of its clear knowledge of that infringement, rose to the level misleading conduct.” *Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V. v. Sirius XM Radio Inc.*, 2023-2267, 6/9/25.

2. Reliance on the Misleading Conduct

An accused infringer “must nevertheless establish that it at least *considered* [patentee]’s silence or inaction and that such consideration influenced its decision to migrate to the accused [] system.” *Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V. v. Sirius XM Radio Inc.*, 2023-2267, 6/9/25 (emphasis in original).

3. Material Prejudice

“The undisputed evidence is clear that SXM made a business decision to migrate to the accused high-band system while simultaneously deciding to “set aside further efforts on the low-band system.” That decision, made in the face of a viable non-infringing alternative, is sufficient to establish prejudicial reliance.” *Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V. v. Sirius XM Radio Inc.*, 2023-2267, 6/9/25.

4. Summary Judgment

Summary judgment reversed where “an [accused infringer] representative testified that the impetus for pursuing the accused XM DARS System over the non-infringing low-band alternative was not that [the accused infringer] took [patentee]’s silence as acquiescence of [the accused infringer]’s continued use of the patented technology, but that the XM DARS System had greater market penetration and was the easier business choice.” *Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V. v. Sirius XM Radio Inc.*, 2023-2267, 6/9/25.

B. Lack of Subject Matter Jurisdiction

1. Declaratory Judgment Jurisdiction

a. Controversy of “sufficient immediacy and reality” based on the “totality of the circumstances”

i. Threats Against Customers

“Rather, as Mitek acknowledges, USAA relied on Mitek’s documentation during the Wells Fargo trial for only certain limitations of each asserted claim. Mitek has not pointed to any suggestion by USAA or other record evidence—including the documentation provided with MiSnap—that establishes a reasonable potential that Mitek encourages performance of the remaining limitations.” *Mitek Sys., Inc. v. United Servs. Auto. Ass’n*, 2023-1687, 6/12/25 (citation omitted).

“[W]hether a supplier’s product is a “material component” is a matter for contributory infringement under 35 U.S.C. § 271(c), not induced infringement under § 271(b).” *Mitek Sys., Inc. v. United Servs. Auto. Ass’n*, 2023-1687, 6/12/25.

“Mitek argues that it has established a reasonable potential of a contributory infringement claim because MiSnap was “primarily developed” for ““touch-free autocapture’ functionality for document acquisition.”” “[E]ven if MiSnap has no substantial non-infringing uses, the record does not show that USAA ever suggested that.” *Mitek Sys., Inc. v. United Servs. Auto. Ass’n*, 2023-1687, 6/12/25.

ii. Indemnity Requests/Obligations from/to Customers

“The district court found that each agreement contained applicable carve-outs that precluded a reasonable potential for indemnification liability. We see no error in this analysis.” *Mitek Sys., Inc. v. United Servs. Auto. Ass’n*, 2023-1687, 6/12/25.

b. Evidence of Post-Complaint Events

“Our review of post-complaint events and evidence further supports the district court’s conclusion that it lacked subject-matter jurisdiction over Mitek’s non-infringement claims.” *Mitek Sys., Inc. v. United Servs. Auto. Ass’n*, 2023-1687, 6/12/25.

C. ANDA Infringement Defenses

“[A]pplicability of the safe harbor typically arises in situations where the patent owner alleges that certain past or current activities of the defendant, activities that the defendant believes fall within the scope of the safe harbor, constitute infringement. In those cases, then, there is a burden on the defendant to establish in fact that the accused activities are non-infringing under the safe harbor. And those cases are resolved when the factfinder adjudicates that issue.” *Jazz Pharms., Inc. v. Avadel CNS Pharms., LLC*, 2024-2274, 5/6/25.

The accused infringer’s “argument is that the district court’s forward-looking injunction is unlawful on its face insofar as it necessarily enjoins [it] from making, using, and selling [its product] “solely for uses reasonably related to the development and submission of information” to the FDA, i.e., noninfringing activities, in violation of § 271(e)(3). That facial challenge, contrary to [patentee]’s position, is a purely legal invocation of the safe harbor and does not require factual development.” *Jazz Pharms., Inc. v. Avadel CNS Pharms., LLC*, 2024-2274, 5/6/25.

III. Literal Infringement

A. Infringing by Using the Claimed Invention

1. Seeking Approval to Sell an Invention

Appellant “argues that “the mere submission of an FDA application” is not a “use” of a patented invention and therefore not an infringement under § 271(a).” “We agree that the submission of an application to the FDA is not infringement under § 271(a). That activity is not a making, using, offering to sell, selling, or importing of a patented invention.” *Jazz Pharms., Inc. v. Avadel CNS Pharms., LLC*, 2024-2274, 5/6/25.

B. Standard of Proof/Review

1. ANDA Infringement

a. Claims of a Patent Not in the Orange Book

“[Appellant] is incorrect in its assertion that it is the certification relating to an Orange Book patent that constitutes the artificial act of infringement. Section 271(e)(2) makes plain that it is the submission of the application, ANDA or paper NDA, that is the infringement.” “Nonetheless, as the issue was raised only at oral argument and not briefed, we leave it for the district court to address in the first instance on remand, if it remains contested.” *Jazz Pharms., Inc. v. Avadel CNS Pharms., LLC*, 2024-2274, 5/6/25.

C. Functional and Means plus Function Language

1. Performing Method Satisfying Structure Requirement

“Rather, the Board agreed with petitioners that testimony showed that the claimed verification structure corresponded to Hellman’s method of storing M values at address H.” “This testimony was substantial evidence supporting the Board’s finding that Hellman taught the claimed verification structure.” *Ancora Techs., Inc. v. Roku, Inc.*, 2023-1674, 6/16/25.

D. Evidence of Infringement

1. Negative Limitations

“The infringement inquiry here is very simple: propylene glycol was disclaimed; the ANDA contains propylene glycol; therefore there is no infringement.” *Azurity Pharms., Inc. v. Alkem Lab’ys, Ltd.*, 2023-1977, 4/8/25.

IV. Relief

A. Injunction

1. Preliminary Injunction

a. Irreparable Harm

i. First to Market Advantage

“A patentee can be irreparably harmed by an alleged infringer’s improper “head start” and the loss of the “first mover advantage” because the alleged infringer can capture market share and secure a competitive lead.” *Incyte Corp. v. Sun Pharm. Indus., Ltd.*, 2025-1162, 5/7/25.

“Sun is prepared to launch. The ’335 patent expires in December 2026. And Incyte will not launch its product, under its best-case scenario, until at least several years after its ’335 patent expires.” “It was clearly erroneous for the district court to find that Incyte would be

first to market if its preliminary injunction were granted.” *Incyte Corp. v. Sun Pharm. Indus., Ltd.*, 2025-1162, 5/7/25. (citation omitted).

B. Damages Expert Testimony

1. Excluded

“While the credibility of an expert’s damages calculation is properly left to a jury, a determination of reliability under Rule 702 is an essential prerequisite.” *EcoFactor, Inc. v. Google LLC*, 2023-1101, 5/21/25 (en banc).

“We hold the existing licenses upon which Mr. Kennedy relied were insufficient, individually or in combination, to support his conclusion that prior licensees agreed to the \$X royalty rate and therefore the district court abused its discretion in failing to exclude this testimony.” *EcoFactor, Inc. v. Google LLC*, 2023-1101, 5/21/25 (en banc).

“In the absence of any evidence, Mr. Habib’s testimony amounts to an unsupported assertion from an interested party. His testimony cannot provide a sufficient factual basis for Mr. Kennedy to provide a reliable opinion that the licensees agreed to pay the \$X rate.” *EcoFactor, Inc. v. Google LLC*, 2023-1101, 5/21/25 (en banc).

C. Reasonable Royalty

1. Infringement of Published Application

“[W]e hold that provisional rights are granted only when a patent would issue with exclusionary rights (i.e., would issue before its expiration date).” *In re Forest*, 2023-1178, 4/3/25.

D. Double Recovery

“Intersil argues that TAOS’s trade-secret and contract claims arose from the same indivisible injury. . . and that allowing TAOS to recover under both claims would therefore constitute an impermissible double recovery.” “The district court found that the recoveries on the two claims are for non-overlapping sets of units sold by Intersil.” “TAOS is entitled to recover on each of the two theories for distinct sales by Intersil.” *ams-OSRAM USA Inc. v. Renesas Elecs. Am., Inc.*, 2022-2185, 4/4/25.

V. Claim Construction

A. Claim Language

1. Plain and Ordinary Meaning

a. Exceptions

i. Lexicography

A statement of purpose does not broaden the limitation to anything fulfilling that purpose. If the specification says that “[a] bicycle is a vehicle that a user can ride to get from place to place,” “[t]he bicycle has not been redefined to now include a tractor/car/motorcycle/plane/boat/canoe (all of which are vehicles that a user can ride to get from place to place).” *Xerox Corp. v. Snap Inc.*, 2023-1967, 4/17/25 (nonprecedential).

ii. Prosecution/Specification Disavowal

“Courts must take care, however, to interpret purported disavowals in the context of the prosecution history as a whole.” *Azurity Pharms., Inc. v. Alkem Lab’s, Ltd.*, 2023-1977, 4/8/25.

2. Open/Closed Claims, Generic and Negative Limitations

a. Other Transition Terms

i. Consisting Essentially of

“As confirmed by the examiner’s repetition of and maintained emphasis on the applicant’s representations, the applicant secured allowance of the amended claims by arguing that the claimed methods were novel because they “do not require the use of any other active ingredients.” This promotes a more restrictive interpretation of “consisting essentially of” than our precedents interpreting the typical use of the phrase would prescribe.” *Eye Therapies, LLC v. Slayback Pharma, LLC*, 2023-2173, 6/30/25.

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

“The plain and ordinary meaning of “any” includes “of all types,” so “any communication” includes “all types” of communication and, specifically, “direct and indirect communication.”” *Swarm Tech., LLC v. Amazon.com, Inc.*, 2023-2323, 6/30/25 (nonprecedential).

3. Section 112(f)

a. When Applied

i. Overcoming Presumption Against 112(f)

Affirming district court determination that 112(f) applied despite no “means” because patentee’s extrinsic evidence “suggests that the [] terms “can refer to many different entities in a [] system with different structures.” *Fintiv, Inc. v. PayPal Holdings, Inc.*, 2023-2312, 4/30/25.

ii. Connections with Other Limitations

“Our case law does not provide for a blanket rule that these connecting words (i.e., “that,” “operable to,” and “configured to”) automatically suggest terms are structural.” *Fintiv, Inc. v. PayPal Holdings, Inc.*, 2023-2312, 4/30/25.

“In contrast, here, the claims and specifications, including the figures in the asserted patents, do not provide sufficiently definite structure to the “inputs, outputs, connections, and operation” of the payment-handler terms.”” *Fintiv, Inc. v. PayPal Holdings, Inc.*, 2023-2312, 4/30/25 (quoting *Apple Inc. v. Motorola, Inc.*, 757 F.3d 1286, 1303 (Fed. Cir. 2014)).

iii. Specific Nonce Terms

“Here, the word “unit” does not sufficiently connote structure and is similar to other terms that we have held to be nonce terms similar to “means” and invoke § 112 ¶ 6.” *Optis Cellular Tech., LLC v. Apple Inc.*, 2022-1925, 6/16/25.

“The district court correctly analogized “handler” with the nonce term “module,” which we have determined was “simply a generic description of software or hardware that performs a specified function.”” *Fintiv, Inc. v. PayPal Holdings, Inc.*, 2023-2312, 4/30/25 (quoting *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1350 (Fed. Cir. 2015)).

iv. Expert Testimony

“Unlike in *Dyfan*, where the expert’s testimony that the term “code” / “application” connoted software structure to a POSA was unrebutted, here, neither expert testified that the payment-handler terms connoted structure. *Fintiv, Inc. v. PayPal Holdings, Inc.*, 2023-2312, 4/30/25.

4. Functional v. Structural Language

“Rather, the Board agreed with petitioners that testimony showed that the claimed verification structure corresponded to Hellman’s method of storing M values at address H.” “This testimony was substantial evidence supporting the Board’s finding that Hellman taught the claimed verification structure.” *Ancora Techs., Inc. v. Roku, Inc.*, 2023-1674, 6/16/25.

5. Precise Limitations: Flat, Parallel, Cylindrical, 100%, Synchronous

“The plain meaning of “between 1 and 10” includes tiny, even undetectable, magnification, and Zeiss has pointed to nothing compelling a contrary conclusion.” That construction was adopted even though “absolute, theoretical parallelism cannot be achieved as a practical matter” and “if there is divergence of the X-ray beams . . . at the point they pass through the [sample], then . . . the consequence of that is that there would be some geometric magnification in the projection.” *Sigray, Inc., v. Carl Zeiss X-Ray Microscopy, Inc.*, 2023-2211, 5/23/25.

6. Effect of Other Claims

a. Claim Differentiation

i. Improper Differentiation Argument

Where a “dependent claim [] narrows the scope of the independent claim on which it depends in a way that does not require [the proponents claim construction]”, that will “satisfy the dependent-claim-is-narrower principle.” *Alnylam Pharms., Inc. v. Moderna, Inc.*, 2023-2357, 6/4/25.

B. Written Description

1. Lexicography

a. Requirements

Specification text “appear[ing] under the title “Definitions.”” of “Unless otherwise specified, the term[] refer[s] to an alkyl . . . group in which [additional requirements]” was sufficient to act as a lexicographer in applying the additional requirements where the asserted claim did not clearly otherwise specify. *Alnylam Pharms., Inc. v. Moderna, Inc.*, 2023-2357, 6/4/25.

Using the term “refer to” generally conveys an intent to be definitional. *Alnylam Pharms., Inc. v. Moderna, Inc.*, 2023-2357, 6/4/25.

b. Overcome by Exception or Prosecution History

“[O]nce the high threshold for lexicography is met in a patent, it makes sense that a high threshold would have to be met before finding a departure from that controlling definition.” “[W]hen a definition is expressly stated, the public is generally entitled to expect clear notice of exceptions.” *Alnylam Pharms., Inc. v. Moderna, Inc.*, 2023-2357, 6/4/25.

“Though the prosecution history comes closest to suggesting that Alnylam understood a branched alkyl to include a secondary carbon, we conclude that it is not sufficiently decisive to override the definition set forth in column 412.” *Alnylam Pharms., Inc. v. Moderna, Inc.*, 2023-2357, 6/4/25.

2. Disclosed Embodiment(s)

a. Presumption of Coverage Overcome

i. Construction Not Only Claim Limitation Excluding Embodiment

“For the same reason, the district court’s claim construction does not read out disclosed embodiments that would be covered but for that construction.” *Alnylam Pharms., Inc. v. Moderna, Inc.*, 2023-2357, 6/4/25.

ii. Prosecution History

“And it is hardly surprising or unusual that a specification written with broader claim language (“comprising”) would contain embodiments no longer compatible with narrowed claim language adopted during prosecution (“consisting essentially of”) accompanied by a clear narrowing explanation, as here. Such actions, post-dating the filing of the specification, naturally can and often do result in claims that do not cover all embodiments in the specification.” *Eye Therapies, LLC v. Slayback Pharma, LLC*, 2023-2173, 6/30/25.

3. Advantages/Goals/Purposes/Problems Addressed

“[T]hese statements, like those in the specification addressed above, simply describe problems in both software- and hardware-based products; the statements do not provide that, to overcome these problems, an “agent” must be software *only*.” *Ancora Techs., Inc. v. Roku, Inc.*, 2023-1674, 6/16/25 (emphasis in original).

4. Related Applications

a. Using Parent to Construe Child

“Azurity’s amendments and arguments made while prosecuting the ’059 application apply directly to the ’400 application and the ’948 patent that followed because the ’400 application is a continuation of the ’059 application.” *Azurity Pharms., Inc. v. Alkem Lab’ys, Ltd.*, 2023-1977, 4/8/25.

b. Not Applicable to Patent at Issue

“[T]he ’421 application was in effect the ’400 application’s grand-nephew. And Azurity made its “for the record” statement in the ’421 application after the examiner had allowed the claims of the [patent at issue]. Judging these circumstances through the lens of public notice, Azurity’s unilateral and belated statement carries no weight.” *Azurity Pharms., Inc. v. Alkem Lab’ys, Ltd.*, 2023-1977, 4/8/25 (citation omitted).

5. Issuing Application

a. Changes Meaning

i. Limitation Extends Beyond Prior Art

“Azurity argues that in [the prior art reference], propylene glycol functions only as a carrier. That may be true, but what matters most is the broad language that Azurity used to distinguish [that reference]. Just as the echo matches the shout, Azurity’s repeated, sweeping statements—endorsed by the examiner—return an equally sweeping disclaimer.” *Azurity Pharms., Inc. v. Alkem Lab’ys, Ltd.*, 2023-1977, 4/8/25.

ii. Affects Transition Term

“As confirmed by the examiner’s repetition of and maintained emphasis on the applicant’s representations, the applicant secured allowance of the amended claims by arguing that the claimed methods were novel because they “do not require the use of any other active ingredients.” This promotes a more restrictive interpretation of “consisting essentially of” than our precedents interpreting the typical use of the phrase would prescribe.” *Eye Therapies, LLC v. Slayback Pharma, LLC*, 2023-2173, 6/30/25.

iii. Limits Particular Claim Term

“The applicant’s use of “i.e.” here indicates an intent to define . . .” *Eye Therapies, LLC v. Slayback Pharma, LLC*, 2023-2173, 6/30/25.

b. Does Not Change Meaning

i. Did Not Distinguish Prior Art on a Certain Basis

“Where there were multiple ways for [applicant] to distinguish the proposed claims from the prior art, and no further illumination of the reason for [applicant]’s choice, we decline to read [applicant]’s asserted meaning into the choice of one route as opposed to another.” *Alnylam Pharms., Inc. v. Moderna, Inc.*, 2023-2357, 6/4/25.

C. Extrinsic Evidence

1. Party Admissions/Marking/Expert Testimony/Marketing

“The Board relied on Ancora’s “acknowledg[ments]” that a prior district court decision on the ’941 patent held that “the plain and ordinary meaning [of] ‘agent’ is ‘a software program or routine,’” without further limiting “agent” to use at the OS-level. Ancora’s acknowledgements are substantial evidence supporting the Board’s conclusion that the computer industry understood “agent” as not limited to use at the OS-level.” *Ancora Techs., Inc. v. Roku, Inc.*, 2023-1674, 6/16/25.

2. District Court or Board Fact Findings

“The Board relied on Ancora’s “acknowledg[ments]” that a prior district court decision on the ’941 patent held that “the plain and ordinary meaning [of] ‘agent’ is ‘a software program or routine,’” without further limiting “agent” to use at the OS-level. Ancora’s acknowledgements are substantial evidence supporting the Board’s conclusion that the computer industry understood “agent” as not limited to use at the OS-level.” *Ancora Techs., Inc. v. Roku, Inc.*, 2023-1674, 6/16/25.

VI. Procedural Law

A. Preclusion

1. Claim Preclusion - Res Judicata

a. Different Patents

“[E]ach of the asserted patents defined a distinct cause of action with distinct asserted claims, not five alternative theories for a single common legal claim.” *Optis Cellular Tech., LLC v. Apple Inc.*, 2022-1925, 6/16/25.

B. Jury Issues

1. Right to a Jury Trial

a. Combined Patent Infringement Questions

“[T]he question whether Apple infringed “ANY” of the asserted claims erroneously required an affirmative answer even in a situation where all jurors did not agree that *the same patent* was being infringed.” *Optis Cellular Tech., LLC v. Apple Inc.*, 2022-1925, 6/16/25 (emphasis in original).

“There may be cases in which an issue of infringement is identical across more than one asserted patent such that a single infringement question does not run afoul the Seventh Amendment and Rule 48(b).” *Optis Cellular Tech., LLC v. Apple Inc.*, n.7, 2022-1925, 6/16/25 (emphasis in original).

C. Construction

1. Contracts/Orders

a. Conflicting Language

“Azurity’s view of the disputed stipulation is implausible because it would have Alkem frame the infringement dispute and then, several lines down, turn around and concede the same issue.” *Azurity Pharms., Inc. v. Alkem Lab’ys, Ltd.*, 2023-1977, 4/8/25.

D. Sanctions/Punitive Damages

“The district court found that Appellants (1) withheld information surrounding the circumstances of the License Agreement until compelled to release this information and (2) attempted to prevent discovery of the circumstances surrounding the creation of the License Agreement. These findings are not clearly erroneous and are sufficient to support a bad faith determination.” BPI Sports, LLC v. ThermoLife Int’l LLC, 2023-1068, 6/16/25 (nonprecedential).

E. Discovery/Evidence

1. Expert Testimony

a. Motions to Exclude Under Rule 702

“In the absence of any evidence, Mr. Habib’s testimony amounts to an unsupported assertion from an interested party. His testimony cannot provide a sufficient factual basis for Mr. Kennedy to provide a reliable opinion that the licensees agreed to pay the \$X rate.” EcoFactor, Inc. v. Google LLC, 2023-1101, 5/21/25 (en banc).

“When evaluating the sufficiency of an expert’s factual basis for the propositions asserted as the expert’s opinion, a court examines the evidence on which the expert purports to rely.” EcoFactor, Inc. v. Google LLC, 2023-1101, 5/21/25 (en banc).

2. Prejudicial Evidence

“[I]t was highly prejudicial to Apple for Optis (and Mr. Kennedy) to repeatedly recite the large settlement figure given “the probative value of the [AppleQualcomm settlement agreement] is dubious.” In fact, Optis posted the large settlement figure on trial slides and emphasized the dollar amount to the jury several times.” “This is true notwithstanding the fact that Mr. Kennedy purported to use the Apple-Qualcomm settlement agreement only as a check or “ballpark”.” Optis Cellular Tech., LLC v. Apple Inc., 2022-1925, 6/16/25 (citation omitted).

VII. Federal Circuit Appeals

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

1. District Court/ITC Appeals

a. Claim Construction Forfeiture/Wiaver

“The principle requiring timely and consistent presentation of fundamental claim-construction positions that shape the litigation is an important one for conservation of courts’ and litigants’ resources.” WSOU Investments LLC v. F5, Inc., 2023-1427, 4/17/25 (nonprecedential).

b. Exceptions

i. District Court Addressed the Issue

“The district court addressed the jury unanimity argument on the merits, which preserved the issue for appeal.” *Optis Cellular Tech., LLC v. Apple Inc.*, n.5, 2022-1925, 6/16/25.

2. PTO Appeals

a. Appeals from PTAB Decision

“Ancora never raised this argument in its response to either petition. Thus, we conclude that Ancora waived its inoperability argument.” *Ancora Techs., Inc. v. Roku, Inc.*, 2023-1674, 6/16/25.

3. Previous Appeal in Same Case

“We conclude that, because Intersil could have made this argument that the statute bars exemplary damages in the first appeal, but did not, it cannot make the argument now.” *ams-OSRAM USA Inc. v. Renesas Elecs. Am., Inc.*, 2022-2185, 4/4/25.

4. New Argument in Reply Brief

a. Insufficient Language in Principal Brief

“[U]nelaborated sentence” in principal brief not enough. *ams-OSRAM USA Inc. v. Renesas Elecs. Am., Inc.*, n.2, 2022-2185, 4/4/25.

5. Discretion to Reach Forfeited or Waived Issue

“At most, [Appellant] forfeited its argument by unclearly developing it in the district court. But we have discretion to consider forfeited arguments and we exercise that discretion here where [Appellant]’s argument turns entirely on a legal question.” *Jazz Pharms., Inc. v. Avadel CNS Pharms., LLC*, 2024-2274, 5/6/25 (citations omitted).

B. Mischaracterizations of Reviewed Decision

1. PTAB

“Ancora misreads the Board’s analysis: The Board found that Chou’s contribution to the combination was not merely to add a BIOS to Hellman’s computer, but, more specifically, to motivate a person of ordinary skill in the art “to store Hellman’s license” information in the BIOS EEPROM, in order to discourage users from tampering with the license information and to provide extra protection to the sensitive information.” *Ancora Techs., Inc. v. Roku, Inc.*, 2023-1674, 6/16/25.

“Ancora again misreads the Board’s decision: The Board did not identify Hellman’s address H as the verification structure.” *Ancora Techs., Inc. v. Roku, Inc.*, 2023-1674, 6/16/25.

C. Appellate Jurisdiction

1. Final Decision/Judgment

a. Achieving Finality Post-Appeal

“The district court dismissed the counterclaims without prejudice on March 3, 2025, after which Brazos filed a new notice of appeal and this court recalled the mandate and proceeded to oral argument on the already-filed briefs.” *WSOU Investments LLC v. F5, Inc.*, 2023-1427, 4/17/25 (nonprecedential).

2. Jurisdiction Requirements for ITC Petition for Review

a. Sanctions

Denial of sanctions not appealable because “[a] final decision on the merits, as contemplated by sections 1295(a)(6) and 1337(c), is a decision that is tied to the entry of articles.” *Realtek Semiconductor Corp. v. Int’l Trade Comm’n*, 2023-1187, 6/18/25.

D. Cross-Appeals v. Alternate Bases for Affirmance

1. Alternative Basis for Summary Judgment

“The district court did not address these alternative grounds and we thus need not consider them on appeal.” *Fintiv, Inc. v. Apple Inc.*, n.1, 2023-2208, 5/16/25 (citation omitted).

E. Scope of Claim Construction Review

1. Implicit Claim Construction Disputes

“Here the Board’s analysis demonstrates that it construed the disputed claim limitation. Most notably, the Board stated that Sigray “fail[ed] to show that the . . . Xray beam in Jorgensen diverges enough to result in projection magnification ‘between 1 and 10 times’” The Board’s use of the word “enough” reflects that it considered a certain level of divergence as outside the claim. Narrowing the claim scope in this way is in fact claim construction.” *Sigray, Inc., v. Carl Zeiss X-Ray Microscopy, Inc.*, 2023-2211, 5/23/25 (citation omitted).

F. Mootness of Appealed Rulings

1. Addressing Correctness of Moot Rulings

“Having already concluded Mitek does not have any basis for jurisdiction, we nonetheless address the district court’s alternative discretionary dismissal.” *Mitek Sys., Inc. v. United Servs. Auto. Ass’n*, 2023-1687, 6/12/25.

G. Standards of Review and Record/Appendix on Appeal

1. Abuse of Discretion

a. Denial of Summary Judgment

“[W]e briefly address Fraunhofer’s request that we should not only reverse the grant of summary judgment, but also find that summary judgment should affirmatively be granted for Fraunhofer.” “We are an appellate court; we review only the judgments before us, and so we decline to consider Fraunhofer’s request.” *Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V. v. Sirius XM Radio Inc.*, 2023-2267, 6/9/25.

2. Summary Judgment of Indefiniteness

“This means that we review factual findings underpinning an indefiniteness determination under the “clear error” standard, even if it is made in the same order resolving the parties’ summary judgment motions. See, e.g., *Synchronoss Techs., Inc. v. Dropbox, Inc.*, 987 F.3d 1358, 1364–65 (Fed. Cir. 2021) (applies “clear error” review to a district court decision that resolved indefiniteness issue and summary judgment motions in one order). In other words, although a court may grant summary judgment based on a determination of indefiniteness, the determination itself is distinct from the Rule 56 analysis. See *Sonix Tech. Co. v. Publ’ns Int’l, Ltd.*, 844 F.3d 1370, 1371 (Fed. Cir. 2017).” *Ball Metal Beverage Container Corp. v. Crown Packaging Tech., Inc.*, 2023-2308, 6/30/25 (citations omitted) (nonprecedential).

H. Harmless Error

1. Flawed Claim Construction

Where appellant fails to address a basis for the agency ruling independent of the claim construction, any error is harmless/moot. “Even if we agree with Broad that the Board’s claim construction analysis was erroneous, we could not grant Broad any effectual relief.” “Broad chose to only appeal the Board’s claim construction analysis.” *Regents of the University of California v. Broad Institute, Inc.*, 2022-1594, 5/12/25.

2. PTAB Decisions

“[E]ven if the Board’s confirmatory reference to the non-prior-art confidential employee declarations, including their incorporation of confidential quality assurance protocol information was error, it was harmless because it did not prejudice Sage.” *Sage Prods., LLC v. Stewart*, 2023-1603, 4/15/25.

I. Remand Determination

1. Resolution in the First Instance

a. Denied Cross MSJ

i. Section 101

“Because the district court concluded that the claim was not directed to an abstract idea, it did not reach Alice step two. We do and conclude that the claim is not eligible under § 101.” *United Servs. Auto. Ass’n v. PNC Bank N.A.*, 2023-1639, 6/12/25.

2. No Resolution of Issues in the First Instance

a. Claim Construction

“Having determined that “selecting unit” invokes § 112 ¶ 6, we conclude that in this case, remand is appropriate for the district court to conduct the second step of the analysis—determining whether the specification discloses adequate corresponding structure—in the first instance.” *Optis Cellular Tech., LLC v. Apple Inc.*, 2022-1925, 6/16/25.

b. Section 101

“The district court denied Apple’s motion. The district court found: “[T]he claims are not abstract” “We conclude that the claims are directed to an abstract idea—a mathematical formula.” “We conclude that, in this case, remand is required for the court to conduct the Alice step two analysis in the first instance.” *Optis Cellular Tech., LLC v. Apple Inc.*, 2022-1925, 6/16/25.

3. Opinion Dicta in View of Likely Remand Considerations

“Despite having already concluded that summary judgment was inappropriate, we nevertheless address the third and final requirement of equitable estoppel—prejudice.” *Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V. v. Sirius XM Radio Inc.*, 2023-2267, 6/9/25.

VIII. Patent Office Proceedings

A. Inter Partes Review

1. Prior Art to be Considered

a. Applicant Admitted Prior Art

“Under the plain meaning of § 311(b), the question is whether a petitioner has used AAPA as the basis, or part of the basis, of a ground—not whether the request relies on AAPA in combination with prior art patents or printed publications” *Qualcomm Inc. v. Apple Inc.*, 2023-1208, 4/23/25.

“We see no support for the position that an IPR petitioner should not be held to its express inclusion of AAPA in the basis of a ground. Here, Apple’s petitions expressly included AAPA in the “Basis” of Ground 2. It was thus error for the Board to determine that, despite these express statements, the use of AAPA in Ground 2 complied with § 311(b).” *Qualcomm Inc. v. Apple Inc.*, 2023-1208, 4/23/25 (citation omitted).

2. Appeal

a. 314(d) Review Bar

“Qualcomm’s appeal originates from its challenge to only part of the Board’s final written decision prior to remand—its consideration of Ground 2—and not the decision to institute review.” “Accordingly, Qualcomm’s challenge does not pertain to the Board’s determination about a run-of-the-mill statutory provision of a procedural nature regarding the threshold decision of whether to institute an IPR. Rather, as in *SAS*, Qualcomm’s appeal presents a question about “the manner in which the agency’s review proceeds once instituted.”” *Qualcomm Inc. v. Apple Inc.*, 2023-1208, 4/23/25 (quoting *Thryv*, 590 U.S. at 58).

b. Jurisdiction Over Appeals Challenging PTAB Decisions

i. Required Timeframe of Evidence

“Incyte argues that it anticipates spending significantly more money in the coming years—after it concludes initial development activities—to formulate, test, and gain regulatory approval. This argument is unavailing because it does not change any of the facts as of the date Incyte filed this appeal.” *Incyte Corp. v. Sun Pharm. Indus., Inc.*, 2023-1300, 5/7/25 (citation omitted).

ii. Requirements for New Evidence During Appeal

“[Appellant] was on notice that it was required to submit evidence of its standing at the earliest possible opportunity and that its standing was not self-evident because [Appellee]’s docketing statement asserted its intent to challenge standing.” *Incyte Corp. v. Sun Pharm. Indus., Inc.*, 2023-1300, 5/7/25.

“[T]he supplemental [] declaration does not make standing patently obvious and inserts a new theory []. Because [appellant] has not shown good cause for its delayed submission, we decline to exercise our discretion and hold [appellant] cannot rely on the supplemental Lee declaration.” *Incyte Corp. v. Sun Pharm. Indus., Inc.*, 2023-1300, 5/7/25.

iii. Adequacy of Future Plans

“Incyte’s development plans amount to an expression of intent to create a product that runs a substantial risk of infringement if it is able to clear all development hurdles, secure FDA-approval, and bring its product to market. This is too speculative to show concrete plans to develop a deuterated ruxolitinib product to treat hair loss at specific dosages.” *Incyte Corp. v. Sun Pharm. Indus., Inc.*, 2023-1300, 5/7/25.

iv. Doctrine of Competitor Standing

“In other words, it is not enough to show a benefit to a competitor to establish injury in fact; the party seeking to establish standing must show a concrete injury to itself.” *Incyte Corp. v. Sun Pharm. Indus., Inc.*, 2023-1300, 5/7/25.

3. Scope of Estoppel

“[W]e hold that IPR estoppel applies only to a petitioner’s assertions in district court that the claimed invention is invalid under 35 U.S.C. §§ 102 or 103 because it was patented or described in a printed publication (or would have been obvious only on the basis of prior art patents or printed publications). IPR estoppel does not preclude a petitioner from asserting that a claimed invention was known or used by others, on sale, or in public use in district court.” *Ingenico, Inc. v. IOENGINE, LLC*, 2023-1367, 5/7/25.

4. Board Final Written Decision

a. Level of Ordinary Skill and Knowledge

“[T]he Board decided it had to delve into not just the undisputed identification of *who* is the pertinent skilled artisan, but also had to assess *what* that skilled artisan would know. In the FWD, the Board considered all the evidence and argument before it and, necessarily and properly, resolved the factual dispute. In doing so, the Board did not exceed its role, but rather fulfilled it.” *Sage Prods., LLC v. Stewart*, 2023-1603, 4/15/25 (emphasis in original).