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I. Patentability Requirements

A. Prior Art Invalidity

1. Anticipation (§ 102)

a. Exception for AIA Patents

35 U.S.C. 102(b)(2)(B) provides that “prior patent filings by another . . . “shall not be prior art” if “the subject matter disclosed had . . . been publicly disclosed by the inventor.”” However, “the exception applies only to “disclosures” that result in the subject matter of the invention being “publicly disclosed.”” *Sanho Corp. v. Kaijet Tech. Int’l Ltd.*, 2023-1336, 7/31/24.

“Section 102(b)(2)(B) thus works to protect inventors who share their inventions with the public from later disclosures made by others. Animating this exception appears to be the idea that priority should be given to the patentees who make their invention available to the public before a patent application filing by another.” *Sanho Corp. v. Kaijet Tech. Int’l Ltd.*, 2023-1336, 7/31/24.

“Although there was no confidentiality or nondisclosure agreement, there was no teaching of the features of the invention to others beyond Sanho.” “On these facts, we do not think it is a close question that the relevant subject matter of the invention, that is, the claimed circuitry allegedly described in *Kuo*, was “publicly disclosed” by the sale. The testimony establishes only that there was a private sale between two individuals arranged via private messages.” *Sanho Corp. v. Kaijet Tech. Int’l Ltd.*, 2023-1336, 7/31/24.

b. On Sale Bar

i. AIA Changes in Language

“[W]e hold that the enactment of the AIA did not constitute a foundational change in the theory of the statutory on-sale bar provision, 35 U.S.C. § 102(a)(1), in particular, to require that sales of products made using a secret process cannot trigger the on-sale bar.” *Celanese Int’l Corp. v. Int’l Trade Comm’n*, 2022-1827, 8/12/24.

2. Obviousness (§ 103)

a. Differences Between the Prior Art and the Claims at Issue

i. Whether All Limitations Disclosed

“It is not sufficient to merely allege that the individual elements of the claimed invention were each known in the prior art.” *Natera, Inc. v. NeoGenomics Labs., Inc.*, 2024-1324, 7/12/24.

b. Motivation/Apparent Reason to Combine/Modify

i. Unclaimed Requirements

“Unclaimed factors relevant to the feasibility of creating a useful claimed invention can impact the motivation to combine analysis if a skilled artisan would reasonably consider them.” *Natera, Inc. v. NeoGenomics Labs., Inc.*, 2024-1324, 7/12/24.

B. Section 282

“[T]he presumption of validity afforded to patents under § 282 applies equally to all grounds of validity, including the eligibility of the claimed subject-matter. Accordingly, to the extent the district court believed that validity under § 101 is treated any differently than validity under §§ 102, 103, and 112 for purposes of the party presentation principle, that was error.” *Astellas Pharma Inc. v. Sandoz Inc.*, 2023-2032, 9/18/24.

C. Invalidity Based on § 112

1. Written Description (§ 1)

a. Aspirational Claims

“Whether a claimed invention would “work,” or whether it is operable, goes more directly to the utility requirement or the enablement requirement, not the written description requirement.” *Allergan USA, Inc. v. MSN Lab’ys Priv. Ltd.*, 2024-1061, 8/13/24.

b. Critical Aspect of Invention

Particular inert ingredient, a glidant, was not a critical aspect where the specification included “embodiments [that] plainly require only eluxadoline and some other ingredient. They do not require, however, any one of the inert ingredients, so long as at least one of those inert ingredients is present.” “Accordingly, those embodiments contemplate a formulation that both includes and does not include a glidant. Stated otherwise, they contemplate a formulation in which a glidant is optional.” *Allergan USA, Inc. v. MSN Lab’ys Priv. Ltd.*, 2024-1061, 8/13/24.

c. Original Claims

“Originally filed claims have long been held to be part of the specification to be considered in any § 112 analysis.” “It therefore cannot be, as the district court found, that the inventors did not have possession of a formulation in which a glidant was not required. They did have such possession as they disclosed it in an original claim, whether that claim remained or not.” *Allergan USA, Inc. v. MSN Lab’ys Priv. Ltd.*, 2024-1061, 8/13/24.

2. Indefiniteness (¶ 2)

a. Valid

i. Intrinsic evidence definition

Term added during prosecution can be definite based context of the amendment providing sufficient clarity to construe it. *Neonode Smartphone LLC v. Samsung Elecs. Co.*, 2023-2304, 8/20/24 (nonprecedential) (citing *Univ. of Mass. v. L'Oréal S.A.*, 36 F.4th 1374, 1382–83 (Fed. Cir. 2022)).

D. Double Patenting

1. Obviousness-Type

“[T]he only question before us is one of law. Namely, can a first-filed, first-issued, later-expiring claim be invalidated by a later-filed, later-issued, earlier-expiring reference claim having a common priority date? We hold that it cannot.” *Allergan USA, Inc. v. MSN Lab’ys Priv. Ltd.*, 2024-1061, 8/13/24.

E. Section 101

1. Each Claim Considered as a Whole v. Representative Claims

Once “[t]he patent challenger who identifies a claim as representative of a group of claims bears the initial burden to make a prima facie showing that the group of claims are “substantially similar and linked to the same” ineligible concept [], the burden shifts to the patent owner to present non-frivolous arguments as to why the eligibility of the identified representative claim cannot fairly be treated as decisive of the eligibility of all claims in the group.” *Mobile Acuity Ltd. v. Blippar Ltd.*, 2022-2216, 8/6/24.

“Because the eligibility findings with respect to representative claims only extend to claims for which they are representative, and correspondingly do *not* extend to claims they do *not* represent, it is important for courts to resolve any disputes over representativeness and clearly state which claims are, and are not, adequately represented by others.” *Mobile Acuity Ltd. v. Blippar Ltd.*, 2022-2216, 8/6/24 (emphasis added).

2. Abstract Idea Exclusion

a. Claimed Subject Matter

“Importantly, the district court construed “generate” in representative claim 11 to require recording multiple video streams “in parallel.” Thus, the claims do not cover other ways that a camera processor might generate multiple video streams of varying quality for wireless transmission, such as streams created “in sequence.”” *Contour IP Holding LLC v. GoPro, Inc.*, 2022-1654, 9/9/24.

b. “Directed to”: Advance over the Prior Art

“The specification further confirms our understanding of what the claims are directed to. According to the ’026 patent, an increase in content offerings created the need to “enable home TV viewers to find something of interest for viewing among the vast numbers of new programs.”” *Broadband iTV v. Amazon.com, Inc.*, 2023-1107, 9/3/24.

c. Improving Computer Functionality

“The written description discloses improving POV camera technology through specific means of generating high- and low-quality video streams in parallel and transferring a low-quality video stream to a remote device, and the claims reflect this improvement. The claims, therefore, recite patent eligible subject matter at *Alice* step one.” *Contour IP Holding LLC v. GoPro, Inc.*, 2022-1654, 9/9/24.

“[T]he fact that the claims involve a user interface does not automatically put the claims in the same category as *Core Wireless* and *Data Engine*.” “Reordering content within a user guide is not a sufficient technological solution to a technological problem, but rather a results-oriented abstract idea.” *Broadband iTV v. Amazon.com, Inc.*, 2023-1107, 9/3/24.

d. Information Processing

“[R]eceiving metadata and organizing the display of video content based on that metadata is abstract.” *Broadband iTV v. Amazon.com, Inc.*, 2023-1107, 9/3/24.

Affirming invalidity of claims “directed to the abstract idea of receiving information, associating information with images, comparing the images, and presenting information based on that comparison.” *Mobile Acuity Ltd. v. Blippar Ltd.*, 2022-2216, 8/6/24.

e. Inventive Concept/Transformation Exception

“Yet we must take care to avoid allowing a conventionality analysis at step one to render step two superfluous (except where the claimed innovation at step two is nothing more than practice of the abstract idea of step one).” *Broadband iTV v. Amazon.com, Inc.*, 2023-1107, 9/3/24.

“Automation of an abstract idea does not constitute an inventive concept.” *Broadband iTV v. Amazon.com, Inc.*, 2023-1107, 9/3/24.

Complaint allegations that “are nothing more than the implementation of an abstract idea with conventional computer operations . . . [do not] survive step two of the *Alice* test.” *Mobile Acuity Ltd. v. Blippar Ltd.*, 2022-2216, 8/6/24.

3. Stage of Case for Determination

a. Adjudicated as Affirmative Defense

“We agree with [patentee] that a challenge to patent eligibility on § 101 grounds is an affirmative defense to a claim of patent infringement . . . the district court applied the correct legal standard for evaluating an affirmative defense at the motion to dismiss stage . . . is the lack of patentable subject matter apparent on the face of the complaint, which alleged infringement of the Asserted Patents, which are themselves attached as exhibits to the complaint?” *Mobile Acuity Ltd. v. Blippar Ltd.*, 2022-2216, 8/6/24.

II. Literal Infringement

A. All Elements

1. All Steps

Affirmed summary judgment of noninfringement because the accused process, which only involved one step, could not infringe the claimed method because it required multiple discrete steps. *Amgen Inc. v. Sandoz Inc.*, 923 F.3d 1023, 1028-31 (Fed. Cir. 2019) (explained in *Natera, Inc. v. NeoGenomics Labs., Inc.*, 2024-1324, 7/12/24).

B. Direct Infringement of a Claimed Process

1. Human Performance of Steps

“[W]e do not read this claim to require the absence of human involvement in the comparison step. That is, the *comparing* limitation may be satisfied if a computer of the Accused Systems displays two densitometry models in a manner that invites the comparison of the two densitometry models.” *Osseo Imaging, LLC v. Planmeca USA Inc.*, 2023-1627, 9/4/24 (emphasis in original).

C. Evidence of Infringement

1. Expert Testimony

“An expert need not have acquired that skill level prior to the time of the invention to be able to testify *from the vantage point* of a person of ordinary skill in the art. Rather, an expert can acquire the necessary skill level later and develop an understanding of what a person of ordinary skill knew at the time of the invention.” *Osseo Imaging, LLC v. Planmeca USA Inc.*, 2023-1627, 9/4/24 (emphasis in original).

a. Lack of Reliability

“There is, then, neither a factual nor legal basis here for finding that expert testimony is unreliable unless the expert herself undertakes to test or simulate the accused products.” *ParkerVision, Inc. v. Qualcomm Inc.*, 2022-1755, 9/6/24.

2. Marketing/Instruction Materials

“Substantial evidence supports the jury’s infringement verdict. To start, the Accused Systems’ user manual states that HU values are calculated by the Accused Systems in operation.” *Osseo Imaging, LLC v. Planmeca USA Inc.*, 2023-1627, 9/4/24.

III. DOE Infringement

A. Waiver

“[W]e conclude that (1) no change in the claim construction excused WARF’s failure to present its doctrine-of-equivalents theory to the jury in *WARF I*; (2) in fact, WARF affirmatively abandoned that theory for strategic purposes unrelated to claim construction; and (3) for each of these reasons, our holding in *Exxon II* does not help WARF.” *Wis. Alumni Rsch. Found. v. Apple, Inc.*, 2022-1884, 8/28/24.

“WARF was not foreclosed from raising the doctrine of equivalents at trial as an alternative to literal infringement given Apple’s noninfringement position.” “That confidence in the strength of its literal infringement theory does not excuse WARF from failing to litigate the doctrine of equivalents.” *Wis. Alumni Rsch. Found. v. Apple, Inc.*, 2022-1884, 8/28/24.

IV. Relief

A. Attorneys’ fees

1. Exceptional Case (§ 285)

a. Against Patentee

i. Other Patentee Enforcement

“There simply was not enough in the Board decisions—which concerned different sections of the Patent Act and did not analyze whether anything in the prior art was well-understood, routine, or conventional—to put [patentee] on notice that its arguments regarding the eligibility of its patent claims were entirely without merit.” *Realtime Adaptive Streaming LLC v. Sling TV, L.L.C.*, 2023-1035, 8/23/24.

ii. Related Applications and Patents

Exceptional case could be based on Section 101 decision regarding “a similar patent in the same family with nearly identical claim language”, but not on a Section 101 decision “about a different technology entirely” where there was not more analysis “such as a side-by-side analysis of all limitations of [an asserted claim] and the claims at issue in [the other decision].” *Realtime Adaptive Streaming LLC v. Sling TV, L.L.C.*, 2023-1035, 8/23/24.

2. Sanctions Under Inherent Powers

“[T]he District Court’s order did not conflict with FRCP 45, because that Rule does not limit the geographical range of a court’s ability to sua sponte issue an order to appear.” “The court itself will know who is receiving the subpoena and will have weighed the need for the testimony against the potential burden on that person. It therefore is understandable that FRCP 45 only expressly addresses attorney and party-initiated subpoenas, leaving district courts with discretion to manage their own orders to appear.” *Backertop Licensing LLC v. Canary Connect, Inc.*, 2023-2367, 7/16/24.

B. Injunction

1. Preliminary Injunction

a. Irreparable Harm

i. Causal Nexus

“NeoGenomics argues the district court erred by considering the tumor-informed testing market because tumor-informed testing is not claimed in the ’035 patent.” “The district court did not err by crediting Natera’s argument that the allegedly infringing method is key to RaDaR’s tumor-informed testing.” “We therefore see no error in the district court’s causal nexus analysis.” *Natera, Inc. v. NeoGenomics Labs., Inc.*, 2024-1324, 7/12/24.

ii. Delay in Bringing Suit

A seven-month delay is not unreasonable where plaintiff put in evidence that “it was involved in ongoing infringement litigation,” “timely brought suit four days after [the accused product] was approved for Medicare coverage and within four months of [the accused product] becoming commercially available, events which would significantly increase the harm to Natera.” *Natera, Inc. v. NeoGenomics Labs., Inc.*, 2024-1324, 7/12/24.

b. Likelihood of Success

i. Invalidity

“If challenged, a patentee must show it will likely withstand the challenges to the validity of the patent to obtain a preliminary injunction.” *Natera, Inc. v. NeoGenomics Labs., Inc.*, 2024-1324, 7/12/24.

V. Claim Construction

A. Claim Language

1. Effect of Other Claims

a. Claim Differentiation

i. Differentiation Between Independent Claims

“[T]he claims are not necessarily “mutually exclusive” since each independent claim is a different ordered combination of limitations.” *Vascular Solutions LLC v. Medtronic, Inc.*, 2024-1398, 9/16/24.

b. Terms are Consistent in Different Claims

“The art of claiming sometimes involves drafting claims in a variety of ways to encompass the disclosed subject matter.” “[W]e hold that the boundary of the “substantially rigid portion/segment” does not have to be consistent across claims.” “[T]his decision clarifies that the term “substantially rigid portion” be construed the same way across the patents, but that construction can be a functional construction that does not specify the boundary of the “substantially rigid portion.”” *Vascular Solutions LLC v. Medtronic, Inc.*, 2024-1398, 9/16/24.

B. Prosecution History

1. Issuing Application

a. Changes Meaning

i. Replacing Words in Claim

“[W]hen a word is changed during prosecution, the change tends to suggest that the new word differs in meaning in some way from the original word.” *Ajinomoto Co. v. Int'l Trade Comm'n*, 932 F.3d 1342, 1351 (Fed. Cir. 2019) (cited in *Google LLC v. Neonode Smartphone LLC*, 2023-1638, 7/18/24 (nonprecedential) as supporting “[t]hat the applicant amended the claim to eliminate “moving” and replace it with “gliding” demonstrates that Google’s proposed construction cannot be correct.”).

VI. Procedural Law

A. Applicable Circuit Law

1. Request for New Judge on Remand

CAFC “declined to order the extraordinary remedy of reassignment” where the judge invalidated the asserted claims sua sponte after trial on a ground not raised by the defendant and stated in his order that “[t]he pharmaceutical industry, to put it mildly, has perverted th[e] intent [of the Hatch-Waxman Amendments]. With alarming regularity since, brand

and generic drug manufacturers have colluded to protect weak or invalid patents and share in the startling profits.” *Astellas Pharma Inc. v. Sandoz Inc.*, 2023-2032, 9/18/24.

B. Preclusion

1. Issue Preclusion - Collateral Estoppel

a. Same Issue of Law or Fact Necessary to Judgment

“*B & B Hardware* does not hold that the factors or tests must be identical for issues to be identical.” *Wis. Alumni Rsch. Found. v. Apple, Inc.*, 2022-1884, 8/28/24.

i. Claim Construction Preclusion

“Qualcomm, as the party invoking collateral estoppel and the party moving for summary judgment, bears the burden of proving the identity of the issues litigated in the 2011 and 2014 Actions. Thus, if any party was obligated to request claim construction, it was Qualcomm” *ParkerVision, Inc. v. Qualcomm Inc.*, 2022-1755, 9/6/24 (citation omitted).

ii. Different Products

“It is simply not credible to rely on statements made while the products were still under development in 2014 and ignore all of the parties’ statements and evidence after the products were developed from 2015 to today. We therefore conclude that the district court did not err in finding that the A7/A8 and A9/A10 processors are essentially the same.” *Wis. Alumni Rsch. Found. v. Apple, Inc.*, 2022-1884, 8/28/24.

iii. Infringement Determinations

“The parties have stipulated that the accused products at issue here operate, in all material respects, in the same manner as the products accused of infringement in the 2011 Action. Therefore, determining whether the infringement issue here is the same as the infringement issue in the 2011 Action requires only an assessment of whether the receiver claims of the ’907 and ’940 patents asserted in this case are materially the same as the claims that were the basis for the finding of non-infringement in the 2011 Action.” *ParkerVision, Inc. v. Qualcomm Inc.*, 2022-1755, 9/6/24.

“Absent a claim construction finding a generating limitation or similar requirement to be part of the claims, the Qualcomm accused products might infringe the receiver claims in this action even if they are found to down-convert the signal before the capacitor. Thus, . . . there is at least a dispute as to the scope of the asserted receiver claims Consequently, summary judgment of non-infringement based on collateral estoppel is not warranted at this stage.” *ParkerVision, Inc. v. Qualcomm Inc.*, 2022-1755, 9/6/24.

35 USC 271(a) “is the statutory basis for direct infringement, which covers both literal infringement and the doctrine of equivalents. Thus, unlike *B & B Hardware*, we are not dealing with two statutes, just one describing liability for all direct infringement.” “[L]iteral

infringement and the doctrine of equivalents are the same issue for issue-preclusion purposes.” Wis. Alumni Rsch. Found. v. Apple, Inc., 2022-1884, 8/28/24.

2. Kessler Doctrine

“Therefore, like in *SpeedTrack*, the *Kessler* doctrine bars WARF’s second lawsuit against essentially the same products.” “[T]his court has indeed relied on the *Kessler* doctrine to bar assertion of claims against essentially the same products made or sold before the judgment of noninfringement in the earlier case.” Wis. Alumni Rsch. Found. v. Apple, Inc., 2022-1884, 8/28/24.

C. JMOL (Rule 50) / Summary Judgment (Rule 56)

1. Conflicting Testimony as Substantial Evidence

“[T]here is sufficient evidence from which a reasonable juror could choose to credit ParkerVision’s experts’ infringement opinions rather than view the deposition statements as admissions of non-infringement.” ParkerVision, Inc. v. Qualcomm Inc., 2022-1755, 9/6/24.

D. Construction

1. Statutes/Regulations

Identical words used in a given field of law typically carry the same meaning. SoftView LLC v. Apple Inc., 2023-1005, 7/26/24 (citing *Henson v. Santander Consumer USA Inc.*, 582 U.S. 79, 85 (2017)).

E. Discovery/Evidence

1. Expert Testimony

“An expert need not have acquired that skill level prior to the time of the invention to be able to testify *from the vantage point* of a person of ordinary skill in the art. Rather, an expert can acquire the necessary skill level later and develop an understanding of what a person of ordinary skill knew at the time of the invention.” Osseo Imaging, LLC v. Planmeca USA Inc., 2023-1627, 9/4/24 (emphasis in original).

F. Transfer to New Judge or Venue

“[A]t least at the time of the motion to transfer, it would not have been unreasonable to say that keeping this case in EDTX could potentially produce judicial economy benefits.” In re Sony Group Corp., 2024-140, 9/30/24 (nonprecedential).

VII. Federal Circuit Appeals

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

1. District Court/ITC Appeals

a. Underlying Facts of Obviousness

“NeoGenomics attempts to make additional arguments on appeal regarding motivation to combine that it did not present below. We will not decide arguments raised for the first time on appeal.” *Natera, Inc. v. NeoGenomics Labs., Inc.*, 2024-1324, 7/12/24.

b. Issues Before the Trial Court That Were Not Addressed

i. Issues Abandoned at Trial

“[T]he parties filed a joint stipulation in which Astellas agreed to assert only claims 5, 20, and 25 of the ’780 patent, while Sandoz agreed to limit its invalidity defenses to only those arising under § 112. J.A. 6591–93. Accordingly, in the days leading up to trial, Sandoz waived any challenge to the asserted claims arising under §§ 102 and 103.” *Astellas Pharma Inc. v. Sandoz Inc.*, 2023-2032, 9/18/24.

B. Appellate Jurisdiction

1. Final Decision/Judgment

a. Sanctions and Attorney Fee Rulings

“Ms. LaPray—as an officer of [plaintiff] Backertop—is best characterized as a non-party for purposes of appealability [of a sanctions order against her].” *Backertop Licensing LLC v. Canary Connect, Inc.*, 2023-2367, 7/16/24.

C. Mootness of Appealed Rulings

1. PTAB Appeals

In a suit against a different party than petitioner, the patentee “[r]ather than wait for the district court to decide Plantronics’s second Motion to Dismiss, [] voluntarily stipulated to dismiss the litigation with prejudice. When doing so, [the patentee] did not ask the district court to vacate its earlier order finding all claims of the asserted patents invalid.” “Contrary to [the patentee]’s understanding, its decision not to reallege all of the dismissed claims in district court did not alter its ability to appeal the district court’s order regarding ineligibility as to the claims not realleged (i.e., did not render the order an unappealable nullity as to those claims). What altered [patentee]’s right to appeal was its own voluntary decision to dismiss the case with prejudice without reserving a right of appeal.” “Because all the claims in the patents at issue [in several PTAB FWDs] were invalidated in prior district court litigation, we find the appeals moot and dismiss.” *Koss Corp. v. Bose Corp.*, 2022-2090, 7/19/24.

“[Petitioner] informed us that [patentee] had granted it a covenant not to sue on the [IPR’d] patent and that [Petitioner] “no longer has any commercial interest in the validity of this patent.” We consider sua sponte whether the case is moot. We conclude that it is not.” *Sanho Corp. v. Kaijet Tech. Int’l Ltd.*, n. 2, 2023-1336, 7/31/24 (citations omitted).

D. Standards of Review and Record/Appendix on Appeal

1. Abuse of Discretion

a. Sua Sponte Rulings

“By rendering its decision on a ground not raised by any party at any stage of the proceedings . . . the district court disregarded the longstanding principle of party presentation and, in doing so, abused its discretion.” *Astellas Pharma Inc. v. Sandoz Inc.*, 2023-2032, 9/18/24.

“[T]here are circumstances in which it may be appropriate for a court to take a “modest initiating role” in the shape of the litigation. But rendering a patent invalid on a basis not advanced by any party is not such a circumstance.” *Astellas Pharma Inc. v. Sandoz Inc.*, 2023-2032, 9/18/24 (citation omitted).

E. Harmless Error

1. Flawed Claim Construction

“We also do not address whether the various claim constructions SoftView challenges were improper. Even if we were to agree with SoftView’s positions, SoftView’s failure to tie its claim construction arguments to specific claims prevents us from determining whether the Board’s constructions “could impact the conclusion.” *See State Contracting & Eng’g Corp. v. Condotte Am., Inc.*, 346 F.3d 1057, 1068 (Fed. Cir. 2003).” *SoftView LLC v. Apple Inc.*, 2023-1005, 7/26/24.

F. Remand Determination

1. Remand Due to New Collateral Estoppel

“Because the potential for collateral estoppel did not become available until our reversal of the Board’s finding as to claim 8, we conclude that ZyXEL did not forfeit the argument by failing to raise it earlier. We remand to the Board to determine if, in light of our conclusion that claim 8 is unpatentable as obvious (together with the unpatentability of claims 1–4 and 6–7), collateral estoppel should apply, and the substitute claims should be deemed unpatentable.” *ZyXEL Commc’ns Corp. v. UNM Rainforest Innovations*, 2022-2220, 7/22/24.

VIII. Patent Office Proceedings

A. Inter Partes Review

1. Prior Art to be Considered

a. Patent Applications

“Under the AIA, whether a reference is prior art is determined based on “the effective filing date of the claimed invention,” rather than the date of the invention. Thus, prior art includes other patent applications effectively filed, or other patents issued, before the effective filing date of the patent at issue.” *Sanho Corp. v. Kaijet Tech. Int’l Ltd.*, 2023-1336, 7/31/24 (citation omitted).

2. Amendments

a. Preliminary Guidance under Pilot Program

“It thus appears that the MTA Pilot Program is designed to allow reply briefs to address and correct errors. We do not think the Board erred in permitting UNMRI to use its reply brief to supplement the written description support that should have been, but was not, included in its original motion to amend.” *ZyXEL Commc’ns Corp. v. UNM Rainforest Innovations*, 2022-2220, 7/22/24.

3. Appeal

a. Reversal of PTAB

i. Reasons to Combine

“The Board’s determination is not supported by substantial evidence, and the record supports only a conclusion of obviousness.” “While Nystrom may not explicitly state that denser pilot symbols counteract the effect of high Doppler shifts or improve channel estimation, this is not necessary to show obviousness. A prior art reference does not need to explicitly articulate or express why its teachings are beneficial so long as its teachings are beneficial and a POSA would recognize that their application was beneficial.” *ZyXEL Commc’ns Corp. v. UNM Rainforest Innovations*, 2022-2220, 7/22/24.

b. Jurisdiction Over Appeals Challenging PTAB Decisions

i. Standing Evidence

“[M]ere speculation about a possibility of suit, without more, is insufficient to confer standing.” *Platinum Optics Tech. Inc. v. Viavi Solutions Inc.*, 2023-1227, 8/16/24.

ii. Impact of Claim Preclusion

Accusatory letter inadequate where it was sent prior to the conclusion of cases in which patent infringement claims regarding the patent at issue were dismissed with prejudice. *Platinum Optics Tech. Inc. v. Viavi Solutions Inc.*, 2023-1227, 8/16/24.

iii. Adequacy of Future Plans

Declaration that petitioner “continues to work with [customers] to develop new models of [relevant products] and anticipates selling the new models . . . within the next few years” was inadequate for standing because it “does not provide any detailed plans for development of these new” models or “explain the particulars of these new models, or how the models may relate to the [IPR’d] patent . . . vague and conclusory statements are insufficient to establish that [petitioner] has concrete plans for the development of [relevant products].” *Platinum Optics Tech. Inc. v. Viavi Solutions Inc.*, 2023-1227, 8/16/24.

4. Evidentiary Rulings

a. Objection Timing

“We see no abuse in discretion by the Board’s interpretation of its own rules to require a filing within five business days of service of evidence to which the objection is directed.” *ZyXEL Commc’ns Corp. v. UNM Rainforest Innovations*, 2022-2220, 7/22/24.

5. Interaction with Litigation

a. Issue Preclusion by PTAB FWD Findings

“Although we have not previously addressed the question of whether a finding underlying an unpatentability decision in an IPR proceeding collaterally estops a patentee from making validity arguments regarding separate, related claims in district court litigation, we now hold that it does not.” *ParkerVision, Inc. v. Qualcomm Inc.*, 2022-1755, 9/6/24.

b. Prior Judgment

“Once we have affirmed the invalidity of a patent claim – regardless of whether the case leading to that conclusion arose at the Board, applying a preponderance standard, or in the district court, applying the more stringent clear and convincing standard – the claim no longer exists and cannot be asserted as a basis for infringement.” *ParkerVision, Inc. v. Qualcomm Inc.*, 2022-1755, 9/6/24.

B. Regulatory Estoppel Among PTO Proceedings

Estoppel under “section 42.73(d)(3) applies to judgments in “derivation proceedings, inter partes review, post-grant review, and covered business method review.” “In particular, the regulation prohibits a patent owner from “obtaining in any patent: (i) A claim that is not patentably distinct from a finally refused or canceled claim.”” *SoftView LLC v. Apple Inc.*, 2023-1005, 7/26/24.

“Section 42.73(d)(3)(i) goes beyond the common law rule by calling for a comparison between the claims an applicant is “obtaining” and the “finally refused or canceled claim.”” *SoftView LLC v. Apple Inc.*, 2023-1005, 7/26/24.

“[W]e disagree with the Board’s application of [the section 42.73(d)(3)(i)] regulation to previously issued claims. By its terms, the regulation applies to “obtaining” a claim—not maintaining an existing claim.” *SoftView LLC v. Apple Inc.*, 2023-1005, 7/26/24.