Precedential Patent Case Decisions During November 2020

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I. Introduction

This paper abstracts what I believe to be the significant new points of law from the precedential decisions in patent cases this month. Cases captions relating to the PTAB are in **red** text. Case captions of extraordinary importance are in **blue** text.

II. Abstracts and New Points of Law

Vidstream LLC v. Twitter, Inc., 2019-1734, 2019-1735 (Fed. Cir. 11/25/2020).

This is a decision on appeals from PTAB cases IPR2017-00829 and IPR2017-00830.

The PTAB held claims of the patent unpatentable for obviousness. Patentee Vidstream appealed. The Federal Circuit affirmed.

Relevant Facts: Twitter relied upon "Bradford" to in the petition's grounds for unpatentability. Vidstream's patent owner response showed that Bradford was a reprint actually printed in 2015, and therefore not prior art, as alleged in the petition.

Twitter filed a reply with evidence proof the existence of an earlier publication by the same name, and the earlier publication was prior art (published, and available to the public prior to the invention date for the patent), and that the earlier publication contained the disclosure in Bradford relied upon in the petition.

Legal issue: PTAB discretion to belatedly admit petitioner evidence supporting grounds for unpatentability.

The Federal Circuit held that the PTAB did not abuse its discretion in admitting evidence submitted with a petitioner's reply supporting grounds for unpatentability.
showing that a non-prior art publication relied upon in grounds for unpatentability had an earlier version that was a prior art publication and that had the same substantive disclosure relied upon in the petition, and relying upon that evidence of an earlier publication that was prior art, to find claims unpatentable.

Twitter filed two petitions for IPR, with method claims 1–19 in one petition, and medium and system claims 20–35 in the other petition. Twitter cited Bradford as the primary reference for both petitions, combined with other references.

> VidStream argues that the Board erred in accepting and considering the documents that Twitter provided with its replies. *** VidStream argues that the Board violated its own rules in considering evidence that was not provided with the IPR petitions, but only with the replies. *** Twitter responded that the information filed with its replies was appropriate in view of VidStream's challenge to Bradford's publication date, and that this practice is permitted by the PTAB rules and by precedent *** The Board denied VidStream's Motion to Exclude, holding that it was appropriate to permit Twitter to respond to VidStream's challenge by providing additional evidence to establish the Bradford publication date. We conclude that the Board acted appropriately, for the Board

> permitted both sides to provide evidence concerning the reference date of the Bradford book, in pursuit of the correct answer. *** The evidence well supports the Board's finding that Bradford was published and publicly accessible before the '997 patent's 2012 priority date. *See Nobel Biocare Servs. AG v. Instraden USA Inc.*, 903 F.3d 1365, 1376 (Fed. Cir. 2018) (considering the entirety of the evidence relevant to the Board's finding of printed publication). [Vidstream LLC v. Twitter, Inc., 2019-1734, 2019-1735 (Fed. Cir. 11/25/2020).]

Note: But the Bradford book submitted with the petition was clearly not prior art. It was published in 2015. It was only the additional evidence of publication of an earlier version of that book that was prior art, which Twitter submitted with its reply, that showed unpatentability. This opinion is lacking in analysis of the specific point of contention; that what was submitted with the petition as the basis for grounds of unpatentability was not a prior art reference.

Network-1 Technologies, Inc. v. Hewlett-Packard Company, 2018-2338, 2018-2339, 2018-2395, 2018-2396 (Fed. Cir. 9/24/2020; modified 11/20/2020).

This is a decision on appeals from E.D. Tex cases 6:11-cv-00492-RWS and 6:13-cv-00072-RWS. The decision was modified and reissued 11/20/2020 in response to a petition for rehearing. However, no portion of the 11/20/2020 decision differs from the earlier decision in any respect reviewed below.

A jury found the patent not infringed and invalid. The district court granted a motion for JMOL that the patent was not invalid.

Network-1 appealed the finding of noninfringment. In response, the Federal Circuit affirmed in part and reversed in part the district court's claim construction, and remanded.

HP cross-appealed the JMOL that the patent was not invalid. In response, the Federal Circuit vacated the JMOL of no invalidity, and remanded.

Legal issue: 35 USC 315(e), scope of estoppel against a party that joins an existing IPR proceeding pursuant to 315(c).

The Federal Circuit held that, because a party joining an existing IPR proceeding pursuant to 315(c), "cannot bring with it grounds other than those already instituted, that party is not statutorily estopped from raising other invalidity grounds." That conclusion follows from the Federal Circuit's recent holding, as modified 9/4/2020, in *Facebook v. Windy City*, that 315(c) precludes a party joining an IPR form raising new issues.

> HP argues that, in granting Network-1's motion for JMOL on invalidity, the district court misapplied the estoppel provision under 35 U.S.C. § 315(e)(2). Specifically, HP argues that no validity ground that it raised at trial "reasonably could have [been] raised" through its joinder to the Avaya IPR. *See* J.A. 88–91. We agree with HP. HP's joinder to the Avaya IPR and the estoppel consequences of that joinder are governed by the America Invents Act ("AIA"), which established IPR proceedings. According to the AIA, under 35 U.S.C. § 315(c), HP was permitted to join the Avaya IPR "as a party" even though HP was time-barred under § 315(b) from bringing its own petition. But, as we held in *Facebook, Inc. v. Windy City Innovations, LLC*, the joinder provision does not

permit a joining party to bring into the proceeding new grounds that were not already instituted. *Facebook, Inc. v. Windy City Innovations, LLC*, __ F.3d __, No. 18-1400, 2020 WL 5267975, at *9–10 (Fed. Cir. Sept. 4, 2020). Rather, it may only join the already-instituted proceeding as a party. *Id.* [Network-1 Technologies, Inc. v. Hewlett-Packard Company, 2018-2338 et al. (Fed. Cir. 11/20/2020).]

Following a final written decision in an IPR, the AIA provides for statutory estoppel under 35 U.S.C. § 315(e) to limit the invalidity challenges that an IPR petitioner may bring in a separate action involving the same patent claims. With respect to district court actions, § 315(e)(2) states: ["]CIVIL ACTIONS AND OTHER PROCEEDINGS.—The petitioner in an inter partes review of a claim in a patent under this chapter *that results in a final written decision* under section 318(a) . . . may not assert in . . . a civil action arising in whole or in part under section 1338 of title 28 . . . that the claim is invalid on any ground that the petitioner raised or *reasonably could have raised* during that inter partes review. ["] 35 U.S.C. § 315(e)(2) (emphases added). Thus, according to the statute, a party is only estopped from challenging claims in the final written decision based on grounds that it "raised or reasonably could have raised" during the IPR. Because a joining party cannot bring with it grounds other than those already instituted, that party is not statutorily estopped from raising other invalidity grounds. [Network-1 Technologies, Inc. v. Hewlett-Packard Company, 2018-2338 et al. (Fed. Cir. 11/20/2020).]

Legal issue: 35 USC 112, claim construction, reexamination, effect of broadening of dependent claims on an original independent claim.

The Federal Circuit restated its law that "dependent claims cannot broaden an independent claim from which they depend."

HP argues that dependent claims 15 and 16 added during the '401 reexamination resulted in improper claim broadening of claim 6 and asserted dependent claims. In relevant part, prior to reexamination, claim 6 of the '930 patent was construed in two separate district court actions to require the "secondary power source" to be physically separate from the "main power source." See J.A.59–62; see also J.A. 40–42. Subsequently, during the '401 reexamination, Network-1 added claims 15 and 16, which depended from claim 6 and respectively added the limitations that the secondary power source "is the same source of power" and "is the same physical device" as the main power source. '930 patent, Ex Parte Reexamination Certificate, col. 1 ll. 39–44. [Network-1 Technologies, Inc. v. Hewlett-Packard Company, 2018-2338 et al. (Fed. Cir. 11/20/2020).]

Furthermore, our precedent is clear that "dependent claims cannot broaden an independent claim from which they depend." *Enzo Biochem Inc. v. Applera*

Corp., 780 F.3d 1149, 1156–57 (Fed. Cir. 2017). *** Despite the clarity of our caselaw, HP principally relies on *ArcelorMittal France v. AK Steel Corp.*, 786 F.3d 885 (Fed. Cir. 2015), to argue that claim 6 was improperly broadened and should be invalidated. *** *ArcelorMittal* is inapposite. In that case, the patentee had stipulated that all reissued claims, including claim 1,were broader than the original claims. *ArcelorMittal*, 786 F.3d at 890. Thus, in *ArcelorMittal*, there was no dispute that the claims had been broadened. Furthermore, we did not hold, as HP suggests, see Appellee's Br. 70–71, that a dependent claim added during reissue (or reexamination)may broaden and therefore invalidate an unamended, in-dependent claim. To the contrary, we rejected "the argument that a defective reissue application invalidates . . . [the] original claims carried over from the original application." *ArcelorMittal*, 786 F.3d at 891 (quoting *Hewlett–Packard Co. v. Bausch & Lomb, Inc.*, 882 F.2d 1556, 1566 (Fed. Cir. 1989)). [Network-1 Technologies, Inc. v. Hewlett-Packard Company, 2018-2338 et al. (Fed. Cir. 11/20/2020).]

Vectura Limited, v. Glaxosmithkline LLC, 2020-1054 (Fed. Cir. 11/19/2020).

This is a decision on an appeal from the D. Del. district court case 1:16-cv-00638-RGA. After a jury found Glaxo infringed and the patent not invalid, the district court denied GSK's for JMOL and a new trial. GSK appealed. The Federal Circuit affirmed.

Legal issue: 35 USC 112, claim construction, doctrine of specification disavowal, requirement for a claimed apparatus to be limited to manufacture by a particular process.

The Federal Circuit concluded that a specification which states that a particular process of fabrication is required, and also states that process is preferred, does not mean that the particular process is an essential part of the claimed invention, and therefore does effect a disavowal limiting the scope of the apparatus claim to an apparatus formed using the process.

As to the merits of GSK's claim construction arguments, this case falls between two prior cases from this court: *Continental Circuits LLC v. Intel Corp.*, 915 F.3d 788 (Fed. Cir. 2019), and *Andersen Corp. v. Fiber Composites, LLC*, 474 F.3d 1361 (Fed. Cir. 2007). In *Andersen*, we construed an apparatus claim to include a process limitation. 474 F.3d at 1373–74, 1377. In *Continental Circuits*, we declined to import a process limitation into an apparatus claim. 915 F.3d at 799–800. In both cases, we recognized that "process steps can be treated as part of the product claim if the patentee has made clear that the process steps are an essential part of the claimed invention." *Continental Circuits*, 915 F.3d at 799 (quoting Andersen, 474 F.3d at 1375). In both cases, as here, the accused infringers argued that the patent's specification made it clear that a process was an essential part of the apparatus claim and that the patent's prosecution history confirmed that essential role. *See Continental Circuits*, 915 F.3d at 796–99; Andersen, 474 F.3d at 1371–75. [Vectura Limited, v. Glaxosmithkline LLC, 2020-1054 (Fed. Cir. 11/19/2020).]

In *Andersen*, we emphasized that the specification used "language of

requirement, not preference," when describing the apparatus-producing process. 474 F.3d at 1372. In *Continental Circuits*, however, we found that the specification "merely indicate[d] a preference for using" the apparatus-producing process. 915 F.3d at 799. We considered the specification's statements that the apparatus "can be carried out" by the disclosed process and that the process was merely "one technique for forming the [apparatus]." Id. at 797. [Vectura Limited, v. Glaxosmithkline LLC, 2020-1054 (Fed. Cir. 11/19/2020).]

The specification of the '991 patent is more like the specification in *Continental Circuits* than the specification in *Andersen*. Although the '991 patent contains a few statements suggesting that its high-energy milling is required, *see, e.g.*, col. 2, ll. 57–65, and col. 3, ll. 9–14, those statements are outweighed by the numerous statements indicating that high-energy milling is merely a preferred process. *See, e.g.*, col. 3, ll. 15–25 (describing how high-energy milling may not be required for smaller particles because the short-range Van der Waals forces may be sufficient to ensure adhesion); col. 3, ll. 59–65, and col. 5, ll. 35–37 (naming "preferred methods"); col. 4, ll. 22–25 ("Preferably, the milling step involves the compression of the mixture of active and additive particles . . . ."); col. 6, ll. 38–57. Moreover, the fact that the '991 patent criticizes other methods, see, e.g., col. 2, ll. 57–65, and col. 3, ll. 52–58, is not dispositive. *See AstraZeneca LP v. Breath Ltd.*, 542 F. App'x 971, 976 (Fed. Cir. 2013) ("[M]ere criticism of a particular embodiment encompassed in the plain meaning of a claim term is not sufficient to rise to the level of clear disavowal." (quoting *Thorner v. Sony Comput. Entm't Am. LLC*, 669 F.3d 1362, 1366 (Fed. Cir. 2012)). We thus conclude that the specification of the '991 patent does not make its milling method an essential part of apparatus claim 1. [Vectura Limited, v. Glaxosmithkline LLC, 2020-1054 (Fed. Cir. 11/19/2020).]

Legal issue: 35 USC 112, claim construction, doctrine of doctrine of prosecution history disclaimer, requirement for a claimed apparatus to be limited to manufacture by a particular process.

The Federal Circuit concluded that a prosecution history indicating that the claimed apparatus was necessarily different from the prior art apparatus, because the prior art process could not produce the claimed apparatus, distinguished the prior art based upon structure, and not method of fabrication, and therefore did not disclaim the claimed apparatus to only the method by which it was made.

We also reject GSK's argument that the prosecution history requires "composite active particles" to be construed to include a process limitation. In *Andersen*, the applicant distinguished the prior art based on the method used to produce the claimed product. 474 F.3d at 1373. We held that the applicant clearly disclaimed apparatuses produced by the prior art's methods, confirming that the apparatus claim should be construed to include a process limitation. *Id*. at 1373–74. [Vectura Limited, v. Glaxosmithkline LLC, 2020-1054 (Fed. Cir.

11/19/2020).]

In this case, the applicants distinguished the Bosch reference on the ground that Bosch disclosed only "the application of surface modifier material that is in the liquid phase," while the applicants' claim recited active particles coated with "particulate additive material." J.A. 10218–19. Thus, according to the applicants, Bosch involved "wet processes that involve dissolution of the surface modifier, or use of a liquid surface modifier, and subsequently forming a film over the active particle," while "the composite particles claimed in the present application do not comprise 'coatings such as those formed by wet processes that require dissolution of one or both components.'" J.A. 10220 (quoting the patent application). The applicants added that Bosch "does not teach or suggest the milling of particulate surface modifier with drug particles. Instead, the milling operations disclosed in the Bosch reference are performed with liquid phase surface modifier, in other words, surface modifier that is a liquid or is in solution." *Id*. Because Bosch teaches "the application of a film layer of surface modifier material by adsorption, which will produce a thin, uniform, continuous coating on the drug particles," it does not "include particulate additive material on the surface of the active particles" and therefore "does not disclose the particles claimed in the present application." J.A. 10221. [Vectura Limited, v. Glaxosmithkline LLC, 2020-1054 (Fed. Cir. 11/19/2020).]

Although the applicants stated that the composite particles "are fused to the active particle in a manner only possible using an aggressive milling procedure," J.A. 10218,2 that statement did not purport to add a process limitation to the apparatus claim. Instead, that statement merely sought to demonstrate that Bosch's coated particles were necessarily different from the applicants' coated particles because Bosch used a process that could not possibly produce "particulate additive matter on the surface of [a] particle of active material," as required by the applicants' claim. Accordingly, the most reasonable interpretation of the April 2012 response is that the applicant distinguished Bosch based on the unique structure of the claimed composite particles, not the disclosed milling method. We therefore reject GSK's challenge to the district court's claim construction. [Vectura Limited, v. Glaxosmithkline LLC, 2020-1054 (Fed. Cir. 11/19/2020).]

Legal issue, 35 USC 284, damages, built-in apportionment based upon a sufficiently comparable license.

The Federal Circuit restated its apportionment damages law when the evidence of damages relied upon comparable licenses, that "when a sufficiently comparable license is used as the basis for determining the appropriate royalty, further apportionment may not necessarily be required." In other words, a sufficiently comparable license is good evidence of the patentee's damage.

The damages theories tried in this case present a rather unusual circumstance. Ordinarily, an entire-market-value royalty base is appropriate only when the patented feature creates the basis for customer demand or substantially creates the value of the component parts, and apportionment is required when an entire-market-value royalty base is inappropriate. *Virnetx, Inc. v. Cisco Sys., Inc.*, 767 F.3d 1308, 1326 (Fed. Cir. 2014). However, this court has explained that when a sufficiently comparable license is used as the basis for determining the appropriate royalty, further apportionment may not necessarily be required. *See, e.g., Bio-Rad Labs., Inc. v. 10X Genomics Inc.*, 967 F.3d 1353 (Fed. Cir. 2020); *Elbit Sys. Land & C4I Ltd. v. Hughes Network Sys., LLC*, 927 F.3d 1292 (Fed. Cir. 2019); *Commonwealth Sci. & Indus. Rsch. Organisation v. Cisco Sys., Inc.*, 809 F.3d 1295 (Fed. Cir. 2015). That is because a damages theory that is dependent on a comparable license (or a comparable negotiation) may in some cases have "built-in apportionment." *See, e.g., Commonwealth*, 809 F.3d at 1303. [Vectura Limited, v. Glaxosmithkline LLC, 2020-1054 (Fed. Cir. 11/19/2020).]

Built-in apportionment effectively assumes that the negotiators of a comparable license settled on a royalty rate and royalty base combination embodying the value of the asserted patent. *Id*. As the district court noted, a party relying on a sufficiently comparable license can adopt the comparable license's royalty rate and royalty base without further apportionment and without proving that the infringing feature was responsible for the entire market value of the accused product. *Vectura*, 397 F. Supp. 3d at 593 (citing *Commonwealth*, 809 F.3d at 1301–04). That is what Ms. Schenk did when she adopted the royalty rate and royalty base that was used in the 2010 license. To support Ms. Schenk's damages theory, Vectura offered evidence that the circumstances of the 2010 license and the hypothetical negotiation in 2016 were highly comparable and that principles of apportionment were effectively baked into the 2010 license. J.A. 1447–48; *see Bio-Rad*, 967 F.3d at 1373. [Vectura Limited, v. Glaxosmithkline LLC, 2020-1054 (Fed. Cir. 11/19/2020).]

Whitewater West Industries, Ltd. v. Richard Alleshouse, 2019-1852, 2019-2323 (Fed. Cir. 11/19/2020).

This is a decision on appeals from the S.D. Cal. district court case 3:17-cv-00501-DMS-NLS. The district court held, inter alia, that Whitewater was entitled to assignment of the patent rights due to an assignment provision in an employment agreement. The Federal Circuit reversed, finding that the assignment provision violated California Business and Professions Code § 16600.

California Business and Professions Code § 16600 reads:

Except as provided in this chapter, every contract by which anyone is restrained from engaging in a lawful profession, trade, or business of any kind is to that extent void." (Added by Stats. 1941, Ch. 526.)

Legal issue: Validity of expansive assignment provisions for inventive rights under California Business and Professions Code § 16600.

The Federal Circuit held that an automatic ownership and an obligation to assign provision in an employment agreement: (1) that applies to inventions conceived at any time after employment ended; (2) that applies to inventions in any way connected to the contemplated business of the employer; and (3) that which would significantly impair the prior employee's ability to pursue his profession, trade, or business, is void under California Business and Professions Code § 16600.

> On September 8, 2008, Mr. Alleshouse signed a "Covenant Against Disclosure and Covenant Not to Compete" with Wave Loch (Agreement). J.A. 1021–25. The Agreement includes the following assignment provision: ["]a. Assignment: In consideration of compensation paid by Company, Employee agrees that all right, title and interest in all inventions, improvements, developments, trade-secret, copyrightable or patentable material that Employee conceives or here-after may make or conceive, whether solely or jointly with others: (a) with the use of Company's time, materials, or facilities; or (b) resulting from or suggested by Employee's work for Company; or (c) in any way connected to any subject matter within the existing or contemplated business of Company shall automatically be deemed to become the property of Company as soon as made or conceived, and Employee agrees to assign to Company, its successors, assigns, or nominees, all of Employee's rights and interests in said inventions, improvements, and developments in all countries worldwide. Employee's obligation to assign the rights to such inventions shall survive the discontinuance or termination of this Agreement for any reason. ["] J.A. 1022. The Agreement is governed by California law. [Whitewater West Industries, Ltd. v. Richard Alleshouse, 2019-1852, 2019-2323 (Fed. Cir. 11/19/2020).]
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> The Agreement's assignment provision is broad. It requires, among other things, that Mr. Alleshouse, as a former employee, assign to Wave Loch (or its successors, assignees, or nominees) all of his rights or interests in any invention he "may make or conceive," "whether solely or jointly with others," if the invention is either "resulting from or suggested by" his "work for" Wave Loch or "in any way connected to any subject matter within the existing or contemplated business of" Wave Loch. J.A. 1022. The assignment duty applies to all of Mr. Alleshouse's "rights and interests in said inventions . . . in all countries worldwide." *Id.* [Whitewater West Industries, Ltd. v. Richard Alleshouse, 2019-1852, 2019-2323 (Fed. Cir. 11/19/2020).]
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> No trade-secret or other confidential information need have been used to conceive the invention or reduce it to practice for the assignment provision to apply. The obligation is unlimited in time and geography. It applies when Mr. Alleshouse's post-employment invention is merely "suggested by" his work for Wave Loch. It applies, too, when his post-employment invention is "in any way

connected to any subject matter" that was within Wave Loch's "existing or contemplated" business when Mr. Alleshouse worked for Wave Loch. [Whitewater West Industries, Ltd. v. Richard Alleshouse, 2019-1852, 2019-2323 (Fed. Cir. 11/19/2020).]

The restraining effect of these requirements is evident. For a number of years, Mr. Alleshouse worked for Wave Loch in a wide variety of capacities involving design and implementation of water attractions. Anyone in his position would have developed useful, specialized knowledge of the business of water attractions, wholly apart from any confidential information. Work in the same line of business was necessarily among the best and likeliest prospects for such an individual to pursue when leaving the employer. Yet under the Agreement's assignment provision, pursuit of the very prospects for which the individual "is particularly fitted," as the Seventh Circuit noted in 1934,carries a heavy price. *Guth*, 72 F.2d at 389. A wide range of inventions made after leaving the employer, for all time, would have to be assigned to that (now former) employer. The individual, and the individual's new employer or enterprise, would lose the likely competitive benefits of the exclusivity rights provided by patents on such new inventions—or, worse, could be subject to being sued by the former employer, as assignee, for infringement of those very patents. The impairment of the individual's ability to pursue his profession, trade, or business would be significant. [Whitewater West Industries, Ltd. v. Richard Alleshouse, 2019-1852, 2019-2323 (Fed. Cir. 11/19/2020).]

On appeal, the parties accept two important factual premises: first, the inventions at issue were not conceived until after Mr. Alleshouse left his job at Wave Loch; second, Mr. Alleshouse did not use any trade-secret or other confidential information belonging to Wave Loch (now Whitewater) in arriving at the patented inventions. The defendants, who do not appeal the determination of breach, also now accept that the assignment provision applies to post-employment inventions. Relying on those now-undisputed premises, we conclude that the assignment provision is invalid under § 16600, and we reject Whitewater's argument that § 2870 saves the provision from invalidity under § 16600. We need not address the defendants' argument for invalidation under § 2872, which Whitewater does not contend saves the assignment provision from invalidity under § 16600. We therefore reverse the district court's ruling on breach of contract. [Whitewater West Industries, Ltd. v. Richard Alleshouse, 2019-1852, 2019-2323 (Fed. Cir. 11/19/2020).]

Our best assessment of California law on the subject is that California has chosen, in § 16600, to forbid the restraint on former employees imposed by the agreement in this case. [Whitewater West Industries, Ltd. v. Richard Alleshouse, 2019-1852, 2019-2323 (Fed. Cir. 11/19/2020).]

Legal issue: Scope of California Labor Code § 2870(a) to assignment of inventions clauses in employment agreements.

Code section 2870 reads:

> (a) Any provision in an employment agreement which provides that an employee shall assign, or offer to assign, any of his or her rights in an invention to his or her employer shall not apply to an invention that the employee developed entirely on his or her own time without using the employer's equipment, supplies, facilities, or trade secret information except for those inventions that either:
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> (1) Relate at the time of conception or reduction to practice of the invention to the employer's business, or actual or demonstrably anticipated research or development of the employer; or
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> (2) Result from any work performed by the employee for the employer.
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> (b) To the extent a provision in an employment agreement purports to require an employee to assign an invention otherwise excluded from being required to be assigned under subdivision (a), the provision is against the public policy of this state and is unenforceable. (Amended by Stats. 1991, Ch. 647, Sec. 5.)

The Federal Circuit concluded that the most reasonable view of the temporal scope of the 2870(a) was that it was limited to inventions made during the course of employment.

> For such reasons, we think that § 2870(a)'s own terms suggest that it is sensibly, perhaps even best, understood to be restricted in its reach to inventions conceived during employment. That understanding, moreover, fits well with neighboring § 2871. That section authorizes employers to require employees to disclose "all of the employee's inventions made . . . during the term of his or her employment." Cal. Lab. Code § 2871. Although Whitewater contrasts the temporal language in § 2871 with the absence of similar words in § 2870, the language is just as easily understood as making explicit what is already implicit in § 2870, forming a coherent whole. [Whitewater West Industries, Ltd. v. Richard Alleshouse, 2019-1852, 2019-2323 (Fed. Cir. 11/19/2020).]

> We conclude that, at a minimum, § 2870(a) is nowhere close to clear in applying to post-employment inventions. No case law supports such an interpretation. Moreover, to read it as applying to such inventions, and authorizing temporally unlimited assignment requirements through its exceptions, would produce a conflict with what we think is otherwise the clear prohibition of § 16600 on agreements like the one at issue here. In these circumstances, the duty to harmonize statutes requires reading § 2870(a) not to apply to post-employment inventions. [Whitewater West Industries, Ltd. v. Richard Alleshouse, 2019-1852, 2019-2323 (Fed. Cir. 11/19/2020).]

SIPCO, LLC, v. Emerson Electric Co., 2018-1635 (Fed. Cir. 11/17/2020).

In *Thryv*, the Supreme Court held that judicial review of a PTAB decision depending upon a statute that expressly governs institution and nothing (in that case 315(b)'s 1 year bar) more was barred by the institution nonappealability provision (in that case, 314(d)).

This is a decision on an appeal from CBM2016-00095. The PTAB found the claims unpatentable under 101 and 103. Eventually, the Supreme Court vacated and remanded the Federal Circuit's prior decision, in view of the Supreme Court's decision in *Thryv*.

Legal issue: 35 USC 324(e), nonappealability of a PGR institution decision, AIA 18(a)(1)(A) (applicability of PGR statutes to AIA Sec 18 proceedings, AIA 18(d)(1), definition of a CBM patent qualifying for CBM review), reviewability of PTAB institution decision that a patent qualifies as a CBM patent.

The Federal Circuit held that the PTAB's determination, whether a patent was a CBM patent, was a condition of institution, and by analogy with 315(b)/314(d) nonappealability, also not appealable.

> Covered business method patent review is subject to a similar, materially identical "No Appeal" provision in 35U.S.C. § 324(e), which recites that "[t]he determination by the Director whether to institute a post-grant review under this section shall be final and nonappealable." Just as "[s]ection 315(b)'s time limitation is integral to, indeed a condition on, institution" of inter partes review, *Thryv*, 140 S. Ct. at 1373, AIA § 18(a)(1)(E) likewise commands that "[t]he Director may institute a transitional proceeding [CBM review] only for a patent that is a covered business method patent." 125 Stat. at 329–30. AIA § 18(d) further conditions institution of CBM review for only those patents that "claim[] a method or corresponding apparatus for per-forming data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions." *Id.* at 331. The determination that a patent qualifies for CBM review is thus expressly and exclusively tied to the decision to institute the proceeding. *** Under *Thryv*, § 324(e) prohibits judicial review of SIPCO's challenge because it is nothing more than a contention that the agency should have refused to institute CBM review. [SIPCO, LLC, v. Emerson Electric Co., 2018-1635 (Fed. Cir. 11/17/2020).]

On this issue, the Federal Circuit concluded that:

> ...We see no meritorious distinction between the application of § 314(d) to prohibit judicial review of § 315(b)'s time bar or § 312(a)(2)'s "real parties in interest" requirement and the application of § 324(e) to prohibit review of AIA § 18(b)'s restriction on CBM review to only certain patents. Under Thryv, § 324(e) prohibits judicial review of SIPCO's challenge because it is nothing more than a contention that the agency should have refused to institute CBM review. [SIPCO, LLC, v. Emerson Electric Co., 2018-1635 (Fed. Cir. 11/17/2020).]

Legal issue: Fate of Federal Circuit decisions for which there was no authority to

decide, 315(b), and real parties and privies.

The fate of Federal Circuit decisions on development of PTAB case, in those areas in which the Federal Circuit weighed in prior to recognizing the Supreme Court's conclusion that the Federal Circuit was barred from doing so, remains uncertain. The Federal Circuit peripherally touched on this issue in footnote 1, but only in the context of how it affected the Federal Circuit, not the PTAB:

> We recognize that *Thryv* has abrogated our practice of reviewing whether the Board's institution of CBM review breached the limits on its authority imposed by AIA § 18(d). *See, e.g., Versata Dev. Grp., Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1322 (Fed. Cir. 2015). But "[i]t is established that a later panel can recognize that the court's earlier decision has been implicitly overruled as inconsistent with intervening Supreme Court authority." *Troy v. Samson Mfg. Corp.*, 758 F.3d 1322, 1326 (Fed. Cir. 2014). [SIPCO, LLC, v. Emerson Electric Co., 2018-1635 (Fed. Cir. 11/17/2020).]

Therefore, treatment of 315(b) and real parties and privies issues by the PTAB, those issues on which the Federal Circuit weighed in, and is now barred from reviewing, remains uncertain.

In re Google, 2019-1828 (Fed. Cir. 11/13/2020).

This is a decision on appeal from PTAB case 15/179,765. The PTAB affirmed the examiner's final rejection. Google appealed. The Federal Circuit affirmed.

Legal issue: Doctrines of forfeiture and waiver, restatement and clarification.

The Federal Circuit admitted that its prior case law conflated doctrines of waiver and forfeiture. The Federal circuit restated failure to timely make an argument to be forfeiture, and intentionally relinquishing a right to be waiver.

> As an initial matter, we recognize that our court's opinions have not always been precise when discussing the doctrines of waiver and forfeiture. The court seemingly has used the terms interchangeably at times. *Compare In re Watts*, 354 F.3d 1362, 1368 (Fed. Cir. 2004) ("Because the appellant failed to argue his current interpretation of the prior art below . . . we hold that appellant has waived [this argument]."), and *In re Baxter Int'l, Inc.*, 678 F.3d 1357, 1362 (Fed. Cir. 2012) ("We agree with the PTO that Baxter waived its arguments regarding the [means for] limitation in claim 30 by failing to timely raise them before the Board."), *with Nuvo Pharms. (Ireland) Designated Activity Co. v. Dr. Reddy's Labs. Inc.*, 923 F.3d 1368, 1378 (Fed. Cir. 2019) (concluding that "Nuvo's argument was not raised below and thus is forfeited" and citing in support of this proposition *TVIIM, LLC v. McAfee, Inc*., 851 F.3d 1356, 1363 (Fed. Cir. 2017), which utilized the term "waiver"). [In re Google, 2019-1828 (Fed. Cir. 11/13/2020).]
>
> It is well established that "[w]aiver is different from forfeiture." *United States v. Olano*, 507 U.S. 725, 733 (1993).7 "Whereas forfeiture is the failure to

make the timely assertion of a right, waiver is the 'intentional relinquishment or abandonment of a known right.'" *Id*. (quoting *Johnson v. Zerbst*, 304 U.S. 458, 464 (1938)) (additional citations omitted). The two scenarios can have different consequences for challenges raised on appeal, *id*. at 733–34, and for that reason, it is worth attending to which label is the right one in a particular case. [In re Google, 2019-1828 (Fed. Cir. 11/13/2020).]

By and large, in reviewing this court's precedent, it is evident that the court mainly uses the term "waiver" when applying the doctrine of "forfeiture." [8] The parties in the case at hand, understandably, have done just the same. Specifically, the Patent Office contends that "Google never made [its claim construction lexicography] arguments to the Board, so it waived them." Appellee's Br. at 18. We interpret the Patent Office to be arguing that Google's failure to raise its lexicography arguments, inadvertent or not, compels a finding of forfeiture. We agree. [In re Google, 2019-1828 (Fed. Cir. 11/13/2020).]

Legal issue: Doctrine of forfeiture, claim construction, failure to contest the PTAB's *sua sponte* claim construction, below.

The Federal Circuit held that Google *forfeited* the right to contest the Board's *sua sponte* claim construction, because Google did not contest that construction below.

On appeal, Google posits the following: "[T]he Board err[ed] when it construed the claim terms 'cost associated with retrieving the content' and 'network penalty' in contradiction to their explicit definitions in the specification." *** Meritorious or not, Google never presented these arguments to the Board. And therein lies the problem. Because Google failed to present these claim construction arguments to the Board, Google forfeited both arguments. We have regularly stated and applied the important principle that a position not presented in the tribunal under review will not be considered on appeal in the absence of exceptional circumstances. *See, e.g., Nuvo Pharm.*, 923 F.3d at 1378; *Golden Bridge Tech., Inc. v. Nokia, Inc.*, 527 F.3d 1318, 1323 (Fed. Cir. 2008). We see no exceptional circumstances justifying a departure from that principle here.

Legal issue: Doctrine of forfeiture, claim construction, exceptional circumstances.

The Federal Circuit concluded that it was not an exceptional circumstance avoiding forfeiture, when the issue was an issue of law and fully briefed on appeal and there was no reasonable explanation why the issue was never argued below.

Google presents two main reasons as to why this court should exercise its discretion to hear its forfeited arguments on appeal: (1) the Board in its decision sua sponte construed the term "cost" and thus, because it "passed upon" on the issue, Google is not barred from appealing that construction; and (2) the issue of the construction of "network penalty" is one of law fully briefed (now) and

> consistent with Google's position before the Board. We are unpersuaded. *** In this instance, we decline to hear Google's new arguments as to the construction of "cost." Google has not provided any reasonable explanation as to why it never argued to the examiner during the iterative examination process or later to the Board for a particular construction of the term "cost,"—an argument that is now the linchpin to its claims' patentability. Accord Watts, 354 F.3d at 1368 ("Watts has shown no reason why we should excuse his failure to raise this argument before the Board."). [In re Google, 2019-1828 (Fed. Cir. 11/13/2020).]

Ferring BV v. Allergan, Inc., 2020-1098 (Fed. Cir. 11/10/2020).

This is a decision on two appeals from the S.D.N.Y. district court case 1:12-cv-02650-PKC.

The facts for this sad story date back to clinical trials in 1999 and patent applications filed, starting in 2002, and a civil action filed in 2012. This case shows just how long and slow the slog is to finality in some patent related legal actions.

In very brief summary of the facts (which occupy ten pages of the Federal Circuit decision), Ferring sued Allergan and Serenity for correction of inventorship to have its employee inventors named as the inventors of the Fein/Allergan patents. Allergan counterclaimed for correction of inventorship to have its employees named as inventors of the Ferring patents.

The district court entered summary judgement rejecting Ferring's request to add its inventors to the Fein/Allergan patents, concluding that request was barred by equitable estoppel.

The district court also entered a final judgement denying Allergan's counterclaim to add its inventors to the Ferring patents.

Legal issue: Equitable estoppel of inventorship, relevance of pre-issuance conduct.

The Federal Circuit held that pre-issuance conduct could be a factor assessing whether to apply equitable estoppel.

> Ferring claims that, because its written exchanges with Fein predated the issuance of the Fein patents, those exchanges should not have been factored into the court's equitable estoppel analysis, leaving nothing else upon which to predicate the judgment on Ferring's claims. During oral argument, however, Ferring conceded that our decision in *MCV, Inc. v. King-Seeley Thermos Co.*, 870 F.2d 1568, 1572 (Fed. Cir. 1989), stands for the proposition that a court may consider pre-issuance conduct in assessing the application of equitable estoppel to § 256 claims, and that *MCV* remains good law. [Ferring BV v. Allergan, Inc., 2020-1098 (Fed. Cir. 11/10/2020).]

Legal issue: Equitable estoppel of inventorship, relevance of difference between scope of issued claims and pre-issuance claims.

The Federal Circuit held that a difference in scope of the issued patent relative to the scope of the invention the parties discussed in communications leading to the allegedly misleading conduct could be relevant to equitable estoppel.

> As "equitable estoppel is not limited to a particular factual situation nor

> subject to resolution by simple or hard and fast rules," *Aukerman*, 960 F.2d at 1041, we decline to adopt a bright-line rule that equitable estoppel cannot apply whenever the scope of the issued patent is different than what the parties discussed in communications leading to the allegedly misleading conduct. Thus, while differences in claim scope are relevant to the equitable estoppel inquiry, their mere existence does not render pre-issuance conduct or communications irrelevant. [Ferring BV v. Allergan, Inc., 2020-1098 (Fed. Cir. 11/10/2020).]

The Federal Circuit held that the SJ of equitable estoppel precluding correction of inventorship was improper because the facts did not support only a conclusion that Ferring acquiesced to Fein/Allergan's claim to sole inventorship.

First, the Federal Circuit restated the standard for SJ of equitable estoppel, as it related to patent infringement.

> ...Equitable estoppel has three elements: (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; *** "To justify summary judgment of equitable estoppel, any inference that a patentee made a misleading communication by omission or acquiescence 'must be the only possible inference from the evidence.'" *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 767 F.3d 1339, 1350 (Fed. Cir. 2014) (quoting *Aukerman*, 960 F.2d at 1044), vacated in part on other grounds, 137 S. Ct. at 967. [Ferring BV v. Allergan, Inc., 2020-1098 (Fed. Cir. 11/10/2020).]

Second, the Federal Circuit applied a variation of this factor to a claim of inventorship (and therefore ownership) of patents. The Federal Circuit concluded that the district court erred, by failing to consider the change in claim scope from what the parties discussed pre-issuance to the scope of Fein's issued claims, in assertions of inventorship. More specifically, the Federal Circuit noted that facts showed that Ferring disclaimed ownership of claims limited to sublingual administration of desmopressin, whereas none of Fein/Allergan's patented claims were limited to sublingual administration of desmopressin.

> We agree with Ferring that the Speranza correspondence is subject to interpretation and does not support the single inference that Ferring, by its statements in the letters and subsequent silence, acquiesced in Fein's sole inventorship of the material in the Fein patents, particularly because the claims in those patents are not limited to, and do not even mention, the sublingual route of delivery of desmopressin. We conclude that the district court erred when it concluded as a matter of law that "Ferring's present application to correct inventorship contradicts its earlier position in the Speranza correspondence," *Ferring, 253 F. Supp. 3d at 718*, and, accordingly, abused its discretion in granting summary judgment of equitable estoppel. [Ferring BV v. Allergan, Inc., 2020-1098 (Fed. Cir. 11/10/2020).]

The district court's decision rested on the erroneous view that the scope of the Speranza correspondence and the scope of Fein's application claims were commensurate with the scope of Fein's issued claims. The district court abused its discretion by applying equitable estoppel to bar Ferring's § 256 claims because it failed to address material differences in the scope of Fein's issued patent claims as compared to the invention described in the Speranza correspondence and Fein's application claims. *See John Bean*, 887 F.3d at 1329. [Ferring BV v. Allergan, Inc., 2020-1098 (Fed. Cir. 11/10/2020).]

To be sure, the parties understood from the Speranza correspondence that Ferring disavowed any ownership claim to the sublingual, transmucosal route of delivery of desmopressin and its associated low-dosage possibilities that Fein identified as his invention in the Speranza correspondence. When Fein advised Ferring that he intended independently to pursue patent protection for "the sub-lingual administration route and the associated low dosage possibilities enabled by same," J.A. 539, Ferring responded that it "will not be pursuing this claim" because "[t]he low dosage possibilities enabled by the sublingual administration route are already available in the public domain," J.A. 542. [Ferring BV v. Allergan, Inc., 2020-1098 (Fed. Cir. 11/10/2020).]

But, contrary to those representations to Ferring, Fein did not pursue patent protection for claims limited to sub-lingual (or transmucosal) administration of desmopressin. Instead, Fein pursued claims untethered to sublingual administration of desmopressin. E.g., J.A. 587–89. In fact, most of Fein's PCT application claims are untethered to any route of administration. Most of Fein's PCT application claims cover pharmaceutical compositions comprising various low doses of desmopressin, some of which are further limited to require that the claimed pharmaceutical composition is effective to establish various desmopressin plasma/serum concentrations. Indeed, none of Fein's PCT or '100 application claims and none of his issued claims are limited to sublingual administration of desmopressin.See'203 patent at col. 28, ll. 7–56; '321 patent at col. 28, l. 34–col. 30, l. 18; '761 patent at col. 28, l. 39–col. 30, l. 19; J.A. 587–89, 651. Very few of Fein's PCT or '100 application claims and very few of his issued claims are limited to a transmucosal route of administration. *See id.* Fein's PCT and '100 application claims are a sweeping departure from his sublingual low-dose desmopressin invention as he described it to Ferring. Importantly, Fein sought patent protection for his claims despite Ferring's prior warning to him that Ferring could not "say now that Ferring will not make any claim as to ownership of any other material Dr[.] Fein may include in any patent application . . . without seeing the text." J.A. 542. In view of Ferring's representation to Fein that it could not disclaim ownership of any material beyond the sublingual administration route and associated low-dose possibilities, a reasonable factfinder could conclude that it would have been unreasonable for Fein to infer from Ferring's pre-2004 communications that Ferring intended to relinquish inventorship rights

in the issued claims of the Fein patents. [Ferring BV v. Allergan, Inc., 2020-1098 (Fed. Cir. 11/10/2020).]

Legal issue: Equitable estoppel of inventorship, notice and acquiescence, difference between scope of issued claims and noticed claims.

Third, the Federal Circuit concluded that the district court erred, by concluding that Ferring acquiesced to Fein/Allergan's inventorship claim because Ferring was on notice that Fein/Allergan's pre-issuance claims were not limited to sublingual administration of desmopressin. More particularly, the Federal Circuit concluded that Ferring was only on notice of Fein/Allergan's pre-issuance claims, that these pre-issuance claims did not include the duration of action limitation to which Ferring asserted inventorship, and that the duration of action limitation was present in Fein/Allergan's issued patent claims. The Federal Circuit explained that the district court's error was that its "conclusion rested on an inadequate claim scope analysis, particularly as to Fein's issued claims containing duration of action limitations.

> Serenity argues that Ferring did acquiesce in Fein's inventorship of patent claims untethered to the sublingual route of administration when it remained silent after learning, in December 2004, "of exactly what [Fein] was claiming—through the claims in his published PCT Application and '100 Application."4 Appellees' Br. 32. The district court agreed with Serenity, resting its decision that Ferring engaged in misleading conduct in part on its determination that "[t]he low-dosage invention as described in the PCT at issue in the Speranza correspondence is the same subject matter detailed in the patents-in-suit, down to the specific numerical quantity of desmopressin to be used." *Ferring*, 253 F. Supp. 3d at 718. The district court implicitly concluded that Ferring had notice of the invention in Fein's issued claims as of Ferring's December 2004 letter, by virtue of that letter's reference to Fein's 2003 PCT application. [Ferring BV v. Allergan, Inc., 2020-1098 (Fed. Cir. 11/10/2020).]
>
> But that conclusion rested on an inadequate claim scope analysis, particularly as to Fein's issued claims containing duration of action limitations. In discussing the relative scope of Fein's issued claims and the application claims, the district court did not point to any claims. Instead, the district court stated only that "[t]he low-dosage invention as described in the PCT at issue in the Speranza correspondence is the same subject matter detailed in the patents-in-suit, down to the specific numerical quantity of desmopressin to be used." *Id.* The district court's conclusion that the claim scope of Fein's issued claims is the same as that of his application claims fails to account for the fact that most of Fein's issued claims contain duration of action limitations completely absent from Fein's application claims. *Compare, e.g.,* '203 patent at col. 28, ll. 7–56,with J.A. 587–89. Ferring based its § 256 claims in part on the very duration of action limitations the district court overlooked. *See, e.g., Complaint at 26–33, Ferring B.V. v. Allergan, Inc.*, No. 12-cv-2650 (S.D.N.Y. Apr. 5, 2012), ECF No. 1; J.A. 1155 ("Indeed, the '203, '321, and '761 patents claim the very . . . duration of

action (around 4–6 hours) that Dr. Norgaard and Dr. Senderovitz developed before any of Fein's alleged conversations with Nardi."). [Ferring BV v. Allergan, Inc., 2020-1098 (Fed. Cir. 11/10/2020).]

In the absence of notice to Ferring of Fein's claim to inventorship of the duration of action limitations, a reasonable factfinder could find that Ferring did not mislead Fein regarding Ferring's claims of inventorship with respect to any of Fein's application claims or issued claims reciting a duration of action limitation. [Ferring BV v. Allergan, Inc., 2020-1098 (Fed. Cir. 11/10/2020).]

Legal issue: Equitable estoppel, defense of unclean hands, requirement to consider all evidence.

The Federal Circuit concluded that the district court abused its discretion by failing to consider all of Ferring's evidence of unclean hands, in deciding to grant Fein/Allergan's SJ motion for equitable estoppel barring Ferring's request to add Ferring's inventors to the Fein/Allergan patents. Note that unclean hands is a bar to equitable action. *Cf. Hor v. Chu*, (Fed. Cir. 11/14/2012).

On appeal, Ferring argues that the district court erred by: ... ignoring evidence of Defendants' unclean hands. *** Specifically, Ferring maintains that in assessing Defendants' unclean hands, the district court erred by ignoring evidence that Fein intentionally and deliberately copied Ferring's CS009 clinical study protocol for use in his own clinical studies. *** "[T]he trial court must, even where the three elements of equitable estoppel are established, take into consideration any other evidence and facts respecting the equities of the parties in exercising its discretion and deciding whether to allow the defense of equitable estoppel to bar the suit." *Aukerman*, 690 F.2d at 1043. Indeed, "equitable estoppel is not limited to a particular factual situation nor subject to resolution by simple or hard and fast rules." *Id.* at 1041. Ferring's opposition to Defendants' motion for summary judgment of equitable estoppel raised four bases to support the argument that Defendants' unclean hands should preclude the district court from granting equitable relief. *** (4) Fein duplicated Ferring's CS009 clinical study protocol in his own CNF Desmo PK200301 clinical study, misrepresented it as his own, and subsequently included data from the study in the Fein patents as Example 8. J.A. 1169–71. With respect to Fein's copying, Ferring further argued that Fein had misrepresented to the USPTO in his patent applications that he had evaluated pharmacokinetic parameters at each desmopressin dose level. J.A. 1170, 1205–06. Ferring cited evidence that Fein did not attempt to measure plasma/serum levels of desmopressin in the CNF Desmo PK200301 study before he filed his patent applications, because the plasma samples from the study were still in frozen storage as of November 2006. *Id.* (citing S.A. 4234). [Ferring BV v. Allergan, Inc., 2020-1098 (Fed. Cir. 11/10/2020).]

Despite the district court's statement that it "has also considered and

rejects Ferring's unclean hands arguments," the court discussed only Ferring's first three arguments. *Ferring*, 253 F. Supp. 3d at 721. The district court's opinion does not mention Ferring's CS009 study or Example 8 of the Fein patents at all. This leaves us no basis to infer that the district court considered Ferring's evidence that Fein copied Ferring's CS009 study and made related misrepresentations to the USPTO. We therefore conclude that the district court abused its discretion in granting summary judgment of equitable estoppel because the court failed to consider all relevant evidence regarding the equities of the parties. *See Aukerman*, 690 F.2d at 1043; *Rothschild Connected Devices Innovations, LLC v. Guardian Protection Servs., Inc.*, 858 F.3d 1383, 1388 (Fed. Cir. 2017) ("A district court abuses its discretion when, as here, it 'fail[s] to conduct an adequate inquiry.'" (alteration in original) (quoting *Atl. Research Mktg. Sys., Inc. v. Troy*, 659 F.3d 1345, 1360 (Fed. Cir. 2011))). [Ferring BV v. Allergan, Inc., 2020-1098 (Fed. Cir. 11/10/2020).]

C R Bard Inc v. Angiodynamics, Inc., 2019-1756, 2019-193 (Fed. Cir. 11/10/2020).

This is a decision on appeals from the D. Del. district court case 1:15-cv-00218-JFB-SRF. The district court granted AngioDynamics' motion for JMOL of non-infringement and non-willful infringement and AngioDynamics' motion for summary judgement of invalidity and patent ineligibility. The Federal Circuit vacated the district court's non-infringement and non-willful infringement holdings, reversed the district court's ineligibility and invalidity holding, and remanded.

Legal issue: FRCP 50, JMOL, evidence sufficient to avoid JMOL, expert testimony finding intent, in addition to the elements of the construed claim.

The Federal Circuit concluded that expert testimony concluding there is infringement of a claim construed to be more limiting that the properly construed claim was legally sufficient to support an infringement verdict of infringement, and therefore precluded JMOL of non-infringement.

> We agree with Bard that the district court erred in granting JMOL. First, although Dr. Clark testified during cross-examination that he believed there was an intent requirement "implied" in the court's construction of the "ac-cess port" terms as "structured for power injection," this mistake did not undermine the factual basis of his infringement opinion. J.A. 25565–67. There is no indication from the record that Dr. Clark relied on the intent aspect of his claim interpretation in reaching his infringement opinion. During his direct testimony, he testified that each of the accused ports were suitable for power injection based on evidence that they were structurally capable of withstanding the pressures and flow rates used during such injections. This testimony did not rest on any conclusion that the devices were intended for such use. *** Here, even if Dr. Clark assumed that the claims required an additional intent element, nothing in the record suggests that this caused him to disregard the requirements of the asserted claims under the correct construction. Although the mistake might undermine his credibility, it does not make his testimony legally insufficient to

support an infringement verdict. The district court thus erred in granting JMOL on this basis. [C R Bard Inc v. Angiodynamics, Inc., 2019-1756, 2019-193 (Fed. Cir. 11/10/2020).]

Legal issue: FRCP 50, JMOL, evidence sufficient to avoid JMOL, defendant's representations to customers and the FDA regarding capabilities of its product.

The Federal Circuit concluded that the defendant's representations to others that its product was suitable for the process range limitations defined by the claim, was evidence sufficient to avoid JMOL.

> Second, although Bard did not conduct its own tests of the Xcela port's suitability for power injection, Bard was entitled to rely on AngioDynamics's representations to its customers and to the FDA that the Xcela port was suitable for power injection at the flow rate and pressure required by the claims. See J.A. 26640–41, 25300–01. Neither the district court nor AngioDynamics provide any reason for why direct testing evidence is required as a matter of law to establish infringement under these circumstances. AngioDynamics's statements regarding the capabilities of its own product constituted substantial evidence of those capabilities. See FED.R.EVID. 801(d)(2). The weight assigned to that evidence was a question for the jury. [C R Bard Inc v. Angiodynamics, Inc., 2019-1756, 2019-193 (Fed. Cir. 11/10/2020).]

Legal issue: FRCP 50, JMOL, evidence sufficient to avoid JMOL of no induced infringement of a method claim, when there is no evidence that a single entity directly infringed.

The Federal Circuit restated its law that evidence sufficient to avoid JMOL of no induced infringement of a method claim includes evidence that the defendant designed the product for use that would infringe a patented method and instructed users to use the product in a manner that infringed the method.

> Third, even if Bard did not present direct evidence of specific instances in which an entity performed each of the claimed steps of the '478 patent, there was sufficient circumstantial evidence in the record to support AngioDynamics's induced infringement of the method claims. This court held in *Toshiba Corp. v. Imation Corp.* that "where an alleged infringer designs a product for use in an infringing way and instructs users to use the product in an in-fringing way, there is sufficient evidence for a jury to find direct infringement." 681 F.3d 1358, 1365 (Fed. Cir. 2012). This type of circumstantial evidence is sufficient for a jury to "reasonably conclude that, sometime during the relevant period[,] more likely than not one [entity] somewhere in the United States" performed each of the claim steps, even when there is no direct evidence of a specific person doing so. *Id.* at 1366 (ellipsis omitted, alterations added). Here, Dr. Clark testified that, in his professional experience,(1) the steps of scanning, identifying, and injecting, as required by the asserted method claims, were generally per-formed by a single CT

technician (J.A. 25554–55), and (2) the implantation of the port, as required by claims 9 and 11, were typically performed by another medical provider at the same hospital, who would be acting as part of the same "entity" as the medical providers performing the other claim steps (J.A. 25533, 25539, 25558, 25569–70). Dr. Clark also pointed to instructional materials provided by AngioDynamics that directed medical providers to perform each step of the claimed methods. J.A. 25540; 26660–71, 26783–90, 26803–08, 26820–25. This constituted substantial evidence to support a jury verdict of infringement as to the method claims of the '478 patent. *Id.* [C R Bard Inc v. Angiodynamics, Inc., 2019-1756, 2019-193 (Fed. Cir. 11/10/2020).]

Legal issue: FRCP 50, JMOL, evidence sufficient to avoid JMOL of no willful infringement.

The Federal Circuit concluded that the defendant's knowledge of the patent application prior to its issuance, and the defendant's copying of the claimed radiographic marker feature based upon market demand was sufficient to avoid JMOL of no willful infringement.

The Federal Circuit described the significance of the claimed radiographic marker feature subsequent to deciding there was evidence sufficient to avoid JMOL of no willful infringement. I quote that description next, however, to provide clarification on this issue.

> With that understanding, we turn to the claims at issue here. *** the claimed invention is described in the patents as satisfying a specific need for easy vascular access during CT imaging, and it is the radiographic marker in the claimed invention that makes the claimed port particularly useful for that purpose because the marker allows the implanted device to be readily and reliably identified via x-ray, as used during CT imaging. [C R Bard Inc v. Angiodynamics, Inc., 2019-1756, 2019-193 (Fed. Cir. 11/10/2020).]

> The district court granted judgment of no willful infringement based on its conclusion that Bard had failed to show infringement. In the alternative, the court held that Bard had failed to meet its burden as to willfulness because AngioDynamics had obtained written opinions of counsel regarding the invalidity of the asserted claims of the patents-in-suit, and Bard had failed to show that the opinions were "drafted by a bad law firm" or put forth other evidence of willfulness. *Bard*, 382 F. Supp. 3d at 335 n.5.2 This was error. Bard introduced evidence at trial that AngioDynamics's Director of Intellectual Property was aware of the applications that issued as the patents-in-suit prior to their issuance. J.A. 25505, 25550, 25496. Bard also introduced evidence that AngioDynamics intentionally copied Bard's CT radiographic marker based on market demand. Appellants' Br. 37–38. This is sufficient evidence to support a jury verdict of willfulness. *See Eko Brands, LLC v. Adrian Rivera Maynez Enters., Inc.*, 946 F.3d 1367, 1377–79 (Fed. Cir. 2020) (discussing list of facts a jury can properly consider in assessing willfulness); *Polara Eng'g Inc. v. Campbell Co.*, 894 F.3d

1339, 1353–54 (Fed. Cir. 2018) (discussing evidence of intentional copying of a competing product as sufficient to support a verdict of willful infringement). While the existence of an invalidity opinion is a relevant factor in determining willfulness, it was not dispositive, and the question of whether AngioDynamics reasonably believed that the asserted claims were invalid was a question of fact for the jury. *See Eko Brands*, 946 F.3d at 1379. [C R Bard Inc v. Angiodynamics, Inc., 2019-1756, 2019-193 (Fed. Cir. 11/10/2020).]

Legal issue: FRCP 50, JMOL, timing, JMOL improper before a party "has been fully heard on an issue."

The Federal Circuit explained that it excluded consideration of the district court's JMOL of invalidity because that judgement was rendered prior to when the plaintiff and defendant had tried the validity issue.

> We first clarify procedural aspects of the district court's judgment before addressing the merits of validity. In its final order, the district court granted both summary judgment and JMOL that the patents were invalid and patent ineligible, without specifying the statutory grounds for invalidity. J.A. 1–4. At the time the motions were granted, however, AngioDynamics had not yet presented its invalidity case at trial and Bard had not had the opportunity to defend the validity of its asserted claims. The district court's JMOL of invalidity was thus procedurally improper because Rule 50 provides that JMOL against a party is only appropriate once the party "has been fully heard on an issue." FED.R.CIV.P. 50. For that reason, we consider the merits of the district court's invalidity judgment only as to the grounds on which AngioDynamics moved for summary judgment, and only to the extent we can reasonably read the district court's decision as bearing on those grounds. [C R Bard Inc v. Angiodynamics, Inc., 2019-1756, 2019-193 (Fed. Cir. 11/10/2020).]

Legal issue: 35 USC 101, eligibility, printed matter doctrine, whether claims that contain printed matter can be patent eligible.

The Federal Circuit held that the claim was patent eligible because the remaining elements of the claim, other than the printed matter that was functionally unrelated to those remaining elements, was patent eligible.

> We conclude that although the asserted claims contain printed matter that is not functionally related to the remaining elements of the claims, each claim as a whole is patent eligible because none are solely directed to the printed matter. We also conclude that when we assign no patentable weight to the claimed printed matter, material disputes of fact remain as to whether other elements of the claim are novel over the prior art. [C R Bard Inc v. Angiodynamics, Inc., 2019-1756, 2019-193 (Fed. Cir. 11/10/2020).]
>
> Bard also contends that the printed matter is functionally related to the

power injection step of the method claims because the medical provider performs the power injection "based on" the identification of the port's functionality. But there is no language in the claims suggesting such a causal relationship. Bard did not advocate for that construction before the district court, and we see no persuasive basis for reading that limitation into the claims. Thus, we hold that the content of the information conveyed by the claimed markers—i.e. that the claimed access ports are suitable for injection at the claimed pressure and flow rate—is printed matter not entitled to patentable weight. [C R Bard Inc v. Angiodynamics, Inc., 2019-1756, 2019-193 (Fed. Cir. 11/10/2020).]

Legal issue: 35 USC 101, eligibility, claim directed solely to non-functional printed matter, claim containing no additional inventive concept.

The Federal Circuit held that a claim may be found patent ineligible under § 101 on the grounds that it is directed solely to non-functional printed matter and the claim contains no additional inventive concept. (Although in this case the Federal Circuit found such an inventive concept at *Alice*, step 2.)

Although the underlying rationale of the printed matter doctrine lies in the requirements of subject matter eligibility under § 101, our case law has typically applied the doctrine to hold that specific limitations of a claim are not entitled to patentable weight for purposes of novelty under § 102 and non-obviousness under § 103. *See Praxair*, 890 F.3d at 1032 (*citing King Pharms., Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1279 (Fed. Cir. 2010), and *In re Huai-Hung Kao*, 639 F.3d 1057, 1072–74 (Fed. Cir. 2011)). Notably, since the Supreme Court articulated its two-step framework in *Alice*, this court has not directly addressed whether a patent claim as a whole can be deemed patent ineligible on the grounds that it is directed to printed matter at step one and contains no additional inventive concept at step two. *** We therefore hold that a claim may be found patent ineligible under § 101 on the grounds that it is directed solely to non-functional printed matter and the claim contains no additional inventive concept. [C R Bard Inc v. Angiodynamics, Inc., 2019-1756, 2019-193 (Fed. Cir. 11/10/2020).]

In concluding that the claims could not be directed to the claimed means for identifying functionality, the district court accepted AngioDynamics's assertion that all the claimed forms of identification, including radiographic marking, were routine and conventional in the art, and thus could not constitute the patentable focus of the claims. *** But even if we were to conclude that the sole focus of the claimed advance was the printed matter, AngioDynamics's evidence is not sufficient to establish as a matter of law, at *Alice* step two, that the use of a radio-graphic marker, in the "ordered combination" of elements claimed, was not an inventive concept. *BASCOM Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1347 (Fed. Cir. 2016). Even if the prior art asserted by AngioDynamics demonstrated that it would have been obvious to combine radiographic marking with the other claim elements, that evidence does not

establish that radio-graphic marking was routine and conventional under *Alice* step two. In concluding that the method claims were patent ineligible, the district court further relied on its conclusion that the method claims contained no more than a recitation of the standards of medical care required after the FDA warned doctors about power injection through vascular access ports. But while the FDA directed medical providers to verify a port's suitability for power injection before using a port for that purpose, it did not require doing so via imaging of a radiographic marker. There is no evidence in the record that such a step was routinely conducted in the prior art. [C R Bard Inc v. Angiodynamics, Inc., 2019-1756, 2019-193 (Fed. Cir. 11/10/2020).]

Donner Technology, LLC v. Pro Stage Gear, LLC, 2020-1104 (Fed. Cir. 11/9/2020).

This is an appeal from PTAB case IPR2018-00708. The PTAB's final written decision held that Donner failed to prove unpatentability. Donner appealed. The Federal Circuit vacated and remanded.

Legal issue: 35 USC 103, analogous art, reasonably pertinent test, similar purpose or problem test, requirement for comparison of problems to be solved.

The Federal Circuit held that "when addressing whether a reference is analogous art with respect to a claimed invention under a reasonable-pertinence theory, the problems to which both relate must be identified and compared." The Federal Circuit concluded that the PTAB failed to conduct this analysis, and therefore vacated and remanded.

> Although the dividing line between reasonable pertinence and less-than-reasonable pertinence is context dependent, it ultimately rests on the extent to which the reference of interest and the claimed invention relate to a similar problem or purpose. *See, e.g., Wyers v. Master Lock Co.*, 616 F.3d 1231, 1238 (Fed. Cir. 2010) (concluding that prior art padlocks were analogous art because they "were clearly directed toward the same problem the inventor was trying to solve in the" patent at issue); *GPAC*, 57 F.3d at1578; *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992) (concluding that, where a "reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection"). Thus, when addressing whether a reference is analogous art with respect to a claimed invention under a reasonable-pertinence theory, the problems to which both relate must be identified and compared. [Donner Technology, LLC v. Pro Stage Gear, LLC, 2020-1104 (Fed. Cir. 11/9/2020).]

The Federal Circuit noted that the relevant purposes of an invention are those relating to solving a problem, and not to admitted prior art.

> Moreover, even assuming that the Board did consider all relevant arguments and evidence, the Board also failed to properly identify and compare the purposes or problems to which Mullen and the '023 patent relate. For instance, the Board at one point stated that the "purpose of the '023 patent" is "to

mount guitar effects on a pedal board." *Decision*, 2019 WL 4020204, at *9. But substantial evidence does not support that statement. As the '023 patent readily discloses, guitar effects had already been mounted on a pedalboard. '023 patent col. 1 ll. 56–61. Thus, that could not possibly be a relevant purpose of the invention. Indeed, with respect to the analogous art inquiry, the relevant purposes of an invention are those relating to solving a problem. *See, e.g., Clay*, 966 F.2d at 659. [Donner Technology, LLC v. Pro Stage Gear, LLC, 2020-1104 (Fed. Cir. 11/9/2020).]

Legal issue: 35 USC 103, analogous art, reasonably pertinent test, assumes a PHOSITA is considering turning to art outside the field of endeavor.

The Federal Circuit held that "that the reasonable-pertinence analysis must be carried out through the lens of a PHOSITA who is considering turning to art outside her field of endeavor."

> In addition, the Board's articulation of the purpose of or problem to be solved by the '023 patent is so intertwined with the patent's field of endeavor that it would effectively exclude consideration of any references outside that field. The problems to which the claimed invention and reference at issue relate must be identified and compared from the perspective of a person having ordinary skill in the art ("PHOSITA"). *See, e.g., Sci. Plastic Prods., Inc. v. Biotage AB*, 766 F.3d 1355, 1360 (Fed. Cir. 2014) ("The analogous art inquiry is a factual one, requiring inquiry into the similarities of the problems and the closeness of the subject matter as viewed by a person of ordinary skill."). Importantly, this analysis must be carried out from the vantage point of a PHOSITA who is considering turning to the teachings of references outside her field of endeavor. *See Clay*, 966 F.2d at 660 (concluding that a reference was not reasonably pertinent where a PHOSITA "would not reasonably have expected to solve the [relevant] problem . . . by considering" that reference). Such a PHOSITA—resigned to considering art outside her field of endeavor—would thus not identify the problems so narrowly so as to rule out all such art. [1] The Board's characterization of the problem to which the claimed invention relates effectively collapses the field-of-endeavor and reasonable-pertinence inquiries and ignores that the reasonable-pertinence analysis must be carried out through the lens of a PHOSITA who is considering turning to art outside her field of endeavor. [Donner Technology, LLC v. Pro Stage Gear, LLC, 2020-1104 (Fed. Cir. 11/9/2020).]

The Federal Circuit noted that the PTAB failed to identify the problem to which the prior art reference related, and therefore could not have conducted the analysis required by Federal Circuit case law.

> Nor did the Board ever identify the problems to which Mullen relates. Because the Board failed to identify and compare the problems to which the '023 patent and Mullen relate, the Board failed to apply the proper standard. [Donner

Technology, LLC v. Pro Stage Gear, LLC, 2020-1104 (Fed. Cir. 11/9/2020).]

Legal issue: 35 USC 103, analogous art, reasonably pertinent test, requires a PHOSITA understand only the portions of the reference relevant to solving the problem.

The Federal Circuit concluded that the reasonable pertinence requirement only required a PHOSITA to understand the portion of a reference relevant to solving the problem.

> The Board also explained that the relevant PHOSITA would have a "relatively low level" of skill and would have "had a poor understanding of Mullen's relay technology." Decision, 2019 WL 4020204, at *9–10. While the level of skill in the art is certainly relevant to this inquiry and will continue to remain relevant on remand, the Board's findings are, standing alone, insufficient to determine whether Mullen is analogous art. The relevant question is whether a PHOSITA "would reasonably have consulted" the reference in solving the relevant problem. *Heidelberger Druckmaschinen AG v. Hantscho Com. Prods., Inc.*, 21 F.3d 1068, 1071 (Fed. Cir. 1994). A PHOSITA might reasonably choose to consult a reference even if she would not understand every last detail of that reference, so long as she would understand the portions of the reference relevant to solving her problem well enough to glean useful information. [Donner Technology, LLC v. Pro Stage Gear, LLC, 2020-1104 (Fed. Cir. 11/9/2020).]

> For example, here Donner need not show that a PHOSITA would understand the entirety of Mullen for Mullen to qualify as analogous art. Rather, the question is whether a PHOSITA would understand the relevant teachings of Mullen—i.e., the improved support structure as depicted in Figures 1 and 4—sufficiently well to use those teachings to solve her problem. [Donner Technology, LLC v. Pro Stage Gear, LLC, 2020-1104, footnote 2 (Fed. Cir. 11/9/2020).]

Schlich et al. v. The Broad Institute, Inc., T 0844/18 (EPO Board 1/16/2020).

This is an opinion of the EPO Board. The opposition division "found that priority had not been validly claimed from certain US provisional applications (P1, P2, P5 and P11)," and consequently "the European patent was found not to be novel over the disclosure of documents D3 and D4 and was revoked." Broad appealed. The EPO board affirmed.

The EPO board addressed three questions. The EPO stated the questions as follows:

> IX. The core issue to be decided in this case can be stated in the following form:
>
> "A and B are applicants for the priority application. A alone is the applicant for the subsequent application. Is a priority claim valid even without any assignment of priority right from B to A?"
>
> The appellants say that the answer is "yes" and the respondents that the answer is "no".
>
> X. The appellants have set out their arguments in their Grounds of Appeal

in the form of three questions that need to be answered. These are:

1) Should entitlement to priority be assessed by the EPO?

2) How is the expression "any person" in Article 87(1) EPC to be interpreted?

3) Does national law (in this case US law) govern the determination of "any person" who has "duly filed" in Article 87(1) EPC? [Schlich et al. v. The Broad Institute, Inc., T 0844/18 (EPO Board 11/7/2020).]

These questions, and the EPO board's answers to them appear below.

1) Should entitlement to priority be assessed by the EPO? *** 24. Thus the Board concludes that the instances of the EPO are empowered and obliged to assess the validity of a priority right claim as required by Article 87(1) EPC. [Schlich et al. v. The Broad Institute, Inc., T 0844/18 (EPO Board 11/7/2020).]

2) How is the expression "any person" in Article 87(1) EPC to be interpreted? *** 86. *** In the light of these considerations the Board finds that the words "any person" in Article 87(1) EPC require that all applicants for the priority application, or their successors in title, are applicants for the subsequent application. [Schlich et al. v. The Broad Institute, Inc., T 0844/18 (EPO Board 11/7/2020).]

3) Does national law (in this case US law) govern the determination of "any person" who has "duly filed" in Article 87(1) EPC? *** 104. As a first point the Board notes that the US is a party to the Paris Convention. Article VI, clause 2 of the US Constitution states: "This Constitution, and the Laws of the United States which shall be made in Pursuance thereof; and all Treaties made, or which shall be made, under the Authority of the United States, shall be the supreme Law of the Land; and the Judges in every State shall be bound thereby, any Thing in the Constitution or Laws of any State to the Contrary notwithstanding." From this the Board concludes that the Paris Convention is part of the "supreme Law of the Land" in the US. *** 110. It is thus clear that the Paris Convention, being an integral part of US law, determines who "any person" is, and that this determination is a purely formal one. It does not require that the "any person" is actually legally entitled to make the filing, but merely that they did so. Thus the Paris Convention and the EPC provide self-contained definitions of the person who claims priority, both treaties define this person by means of the action that this person has performed. *** 116. The Board thus finds that the "national law" that determines who "any person" is, is in this case, the Paris Convention. [Schlich et al. v. The Broad Institute, Inc., T 0844/18 (EPO Board 11/7/2020).]

Legal issue: Paris Convention article 4A.(1), Article 87(1) EPC, EPO construction of "any person"

The EPO Board construed "any person" to mean the person who has performed the act of

filing the patent application, regardless of their right to do so.

> 10. The appellants are thus arguing that the EPO should not consider the underlined words, "Any person who has duly filed ... an application for a patent ... shall enjoy, for the purpose of filing a European patent application ... a right of priority ...", in Article 87(1) EPC, as being a requirement whose meaning is to be examined by the EPO. *** 11. It is helpful to consider the text of Article 87(1) to (3) EPC: *** This wording, other than necessary contextual changes, is identical to the wording found in Article 4A of the Paris Convention. *** 15. Article 87(1) EPC does not require that the "any person" who has filed the patent application is actually legally entitled to do so, merely that they have done so. [Schlich et al. v. The Broad Institute, Inc., T 0844/18 (EPO Board 11/7/2020).]

The EPO Board held that the EPO's scope of review was limited to a "formal assessment" to determine who actually filed the application whose priority was claimed in an EP application.

> ...Thus, as regards the "any person" of Article 87(1) EPC, the EPO does not carry out any substantial assessment of the legal entitlement to property rights, it does not go beyond a formal assessment of the person ("any person") who has performed the act of filing the patent application. [Schlich et al. v. The Broad Institute, Inc., T 0844/18 (EPO Board 11/7/2020).]

The EPO Board held that the EPO was obliged to assess who performed the act of filing the application whose priority was claimed in an EP application.

> 18. The Board can see no basis in Article 88 EPC and Rules 52 and 53 EPC for disregarding the "any person" requirement of Article 87 EPC, none of these provisions relieve the EPO from the obligation to formally assess who has performed the act of filing the patent application as required by Article 87(1) EPC. [Schlich et al. v. The Broad Institute, Inc., T 0844/18 (EPO Board 11/7/2020).]

The EPO Board noted that the EPO did conduct a substantive assessment of whether an entity was a successor in title to an original applicant, but that was not an issue.

> 19. Turning now to the appellants' arguments (see point 100 Grounds of Appeal) concerning successors in title: *** 20. The EPO only assesses, and for this it is the practice of the EPO to require evidence, that a successor in title is in fact the successor in title of the original applicant; an assessment which indeed involves a substantial legal assessment but not an assessment of legal entitlement to a priority right. 21. However, the issue of successorship in title is not an issue in this case and therefore the appellants' arguments on this point are irrelevant for deciding this case. [Schlich et al. v. The Broad Institute, Inc., T 0844/18 (EPO

Board 11/7/2020).]

Note: Here is a copy of EPC Article 87

EPC Article 87 Priority Right

(1) Any person who has duly filed, in or for

(a) any State party to the Paris Convention for the Protection of Industrial Property or (b) any Member of the World Trade Organization, an application for a patent, a utility model or a utility certificate, or his successor in title, shall enjoy, for the purpose of filing a European patent application in respect of the same invention, a right of priority during a period of twelve months from the date of filing of the first application.

(2) Every filing that is equivalent to a regular national filing under the national law of the State where it was made or under bilateral or multilateral agreements, including this Convention, shall be recognised [sic] as giving rise to a right of priority.

(3) A regular national filing shall mean any filing that is sufficient to establish the date on which the application was filed, whatever the outcome of the application may be.

(4) A subsequent application in respect of the same subject-matter as a previous first application and filed in or for the same State shall be considered as the first application for the purposes of determining priority, provided that, at the date of filing the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.

(5) If the first filing has been made with an industrial property authority which is not subject to the Paris Convention for the Protection of Industrial Property or the Agreement Establishing the World Trade Organization, paragraphs 1 to 4 shall apply if that authority, according to a communication issued by the President of the European Patent Office, recognises [sic] that a first filing made with the European Patent Office gives rise to a right of priority under conditions and with effects equivalent to those laid down in the Paris Convention. (As amended by the Act revising the European Patent Convention of 29.11.2000.)

Valeant Pharmaceuticals North America LLC v. Mylan Pharmaceuticals Inc., 2019-2402 (Fed. Cir. 11/5/2020).

This is a decision on an appeal from the NJ district court case 3:18-cv-14305-PGS-LHG. The district court *inter alia* dismissed certain claims under FRCP 12(b)(3) for improper venue. Valeant *inter alia* appealed that dismissal. The Federal Circuit inter alia affirmed the dismissal.

Legal issue: 28 USC 1400(b), "acts of infringement" supporting venue in a 35 USC 271(e)(2) (Hatch-Waxman) infringement action are limited to submission of the ANDA.

The Federal Circuit held that the acts supporting an assertion of venue under 28 USC 1400(b) are only those acts that occurred in submission of the ANDA, and not any future act of distribution of the generic product.

> Today we answer the question of where "acts of infringement" under § 1400(b) occur with respect to infringement claims brought pursuant to the

Hatch-Waxman Act.[1] We conclude that, in cases brought under 35 U.S.C. § 271(e)(2)(A), infringement occurs for venue purposes only in districts where actions related to the submission of an Abbreviated New Drug Application ("ANDA") occur, not in all locations where future distribution of the generic products specified in the ANDA is contemplated. [Valeant Pharmaceuticals North America LLC v. Mylan Pharmaceuticals Inc., 2019-2402 (Fed. Cir. 11/5/2020).]

As noted, the Hatch-Waxman Act makes it "an act of infringement to submit [an ANDA] for a drug claimed in a patent or the use of which is claimed in a patent . . . if the purpose of such submission is to obtain approval under such Act to engage in the commercial manufacture, use, or sale of a drug . . . claimed in a patent or the use of which is claimed in a patent before the expiration of such patent." 35 U.S.C. § 271(e)(2). A plain language reading of this provision directs us to the conclusion that it is the submission of the ANDA, and only the submission, that constitutes an act of infringement in this context. Valeant makes several arguments as to why we should understand § 271(e)(2) as encompassing more. None persuade us to reach a different conclusion. [Valeant Pharmaceuticals North America LLC v. Mylan Pharmaceuticals Inc., 2019-2402 (Fed. Cir. 11/5/2020).]

...The Hatch-Waxman Act itself never says the act that constitutes infringement is artificial, however. It speaks in real terms—submission of the ANDA is the infringing act. It does so, moreover, after declaring other acts, which otherwise may have been infringing, to be non-infringing when undertaken solely for purposes of requesting regulatory approval to market a drug—i.e., solely for purposes of submitting the ANDA. 35 U.S.C. § 271(e)(1). Thus, the statute "artificially" declares certain very real acts of infringement to be non-infringing acts and other acts that would not otherwise constitute infringement to be acts of infringement. But, in both instances the result is real; the statute delineates which acts may or may not give rise to a cause of action under the Hatch-Waxman Act. The language used by courts to characterize Hatch-Waxman cases does not change that an ANDA submission is a real, albeit statutorily created, act of infringement. *See Eli Lilly*, 496 U.S. at 678 (The Hatch-Waxman Act creates "a highly artificial act of infringement that consists of submitting an ANDA." (emphasis added)). [Valeant Pharmaceuticals North America LLC v. Mylan Pharmaceuticals Inc., 2019-2402 (Fed. Cir. 11/5/2020).]

Legal issue: 28 USC 1400(b), "acts of infringement" supporting venue in a 35 USC 271(e)(2) (Hatch-Waxman) infringement action are limited acts prior to when the action was filed

...For the reasons discussed below, we hold that venue in Hatch-Waxman cases must be predicated on past acts of infringement—i.e., acts that occurred before the action alleging infringement was filed. And we hold those acts occur

only in districts where actions related to the ANDA submission occur. [Valeant Pharmaceuticals North America LLC v. Mylan Pharmaceuticals Inc., 2019-2402 (Fed. Cir. 11/5/2020).]

Legal issue: 28 USC 1400(b), "acts of infringement" supporting venue in a 35 USC 271(e)(2) (Hatch-Waxman) action do not include future distribution of the generic product

> Accordingly, we hold that, in Hatch-Waxman cases, venue is not proper in all judicial districts where a generic product specified in an ANDA is likely to be distributed. It is proper only in those districts that are sufficiently related to the ANDA submission—in those districts where acts occurred that would suffice to categorize those taking them as a "submitter" under § 271(e). We find ourselves bound by the plain language of the statutes and a directive from the Supreme Court that venue "is not one of those vague principles which, in the interest of some overriding policy, is to be given a liberal construction." *Schnell*, 365 U.S. at 264 (internal quotation marks omitted). [Valeant Pharmaceuticals North America LLC v. Mylan Pharmaceuticals Inc., 2019-2402 (Fed. Cir. 11/5/2020).]

Legal issue: 35 USC 271(e)(2) infringement, acts determining infringement differ from acts supporting venue

The Federal Circuit explained that act supporting venue for an ANDA action were different from the acts that could support patent infringement in the ANDA action.

> ...As noted, it is true that the judicial inquiry on the merits once an action has been commenced considers the ANDA defendant's potential future conduct—i.e., whether the conduct in which that defendant would like to engage would infringe a valid patent. The content of the litigation does not, however, turn potential future acts into past infringement. Under the plain language of the statute, the only past infringing act is the ANDA submission, which creates the right to bring suit in the first instance. [Valeant Pharmaceuticals North America LLC v. Mylan Pharmaceuticals Inc., 2019-2402 (Fed. Cir. 11/5/2020).]

> Importantly, the Supreme Court told us several things in *TC Heartland*. First, that its own decision in *Fourco Glass Co. v. Transmirra Products Corp.*, 353 U.S. 222 (1957), made clear that Congress enacted § 1400(b) in 1948 to be a standalone venue statute for patent cases. *TC Heartland*, 137 S. Ct. at 1519. Second, that the term "resides" in the first clause of § 1400(b) was meant to have the same meaning in 1948 as the term "inhabits" had in the earlier version of that statute—i.e., that corporations were only subject to suit in patent cases under the first clause of § 1400(b) in their state of incorporation. *Id*. Third, that Congress expressed no intention to alter either clause of § 1400 in 1988 when it enacted amendments to the general venue statute and made that intention even clearer when it enacted the current version of the general venue statute in 2011. *Id*. at 1521. Given this guidance, we similarly must assume that, when Congress

enacted the Hatch-Waxman Act in 1984, it did so with a clear understanding of where § 1400(b) allowed patent actions to be commenced at that time. And, we must assume that, when it excepted Hatch-Waxman cases from the new joinder provisions for patent cases enacted in 2011, Congress understood that it was not *sub silentio* also excepting Hatch-Waxman cases from 1400(b). As the Court noted in *TC Heartland*, when Congress intends to effect a change as sweeping as a revision to § 1400(b), "it ordinarily provides a relatively clear indication of its intent in the text" of the statute. *Id*. at 1520 (citing *United States v. Madigan*, 300 U.S. 500, 506 (1937)). We can glean no such clear guidance from the text of the Hatch-Waxman Act. [Valeant Pharmaceuticals North America LLC v. Mylan Pharmaceuticals Inc., 2019-2402 (Fed. Cir. 11/5/2020).]

Finally, Valeant looks to *Acorda* . Appellants' Br. 29–33. *Acorda* did not, however, address proper venue—a question of statutory interpretation. It was focused on the narrow constitutional question of whether minimum contacts were present for purposes of personal jurisdiction based on the ANDA submission. We held that submission with an intent to distribute the generic product in a given state was sufficient for personal jurisdiction purposes. *Acorda* , 817 F.3d at 762. *Acorda* said nothing about whether an act of infringement had already occurred in any such state or venue. While our then-current venue law meant *Acorda* had a big impact on the venue analysis in Hatch-Waxman cases, we did not address venue in the case. And, though our venue law has changed, we cannot stretch *Acorda* to reach that issue now. As we indicated then, we would be remiss to treat venue and personal jurisdiction as the same inquiry. *See id.* at 763. [Valeant Pharmaceuticals North America LLC v. Mylan Pharmaceuticals Inc., 2019-2402 (Fed. Cir. 11/5/2020).]

Chevron U.S.A. Inc. V. University of Wyoming Research Corporation, 2019-1530 (Fed. Cir. 11/4/2020).

This is a decision on an appeal from PTAB case 106,064. The PTAB entered judgement in favor of Wyoming. Chevron appealed. The panel majority consisting of Judges Schall and Lourie affirmed. Judge Newman dissented.

This decision contains no novel point of law. It appears only to be precedential due to the existence of a dissent.

Legal issue: 35 USC 112, written description support, particular limitation, "radially and continuously changing the alkane mobile phase solvent to a final mobile phase solvent."

In dissent, Judge Newman stated:

As I shall discuss, the Board erred. The Wyoming specification does not describe and does not support the claims copied from Chevron. In its chain of applications Wyoming describes and claims a different method. Wyoming's only mention of the Chevron method is in the claims that Wyoming copied from Chevron. In the absence of any description of the Chevron method, Wyoming's

applications cannot establish conception and constructive reduction to practice [2] of the Chevron method. No Wyoming inventor asserted conception or reduction to practice of the Chevron method, and no testimonial or documentary evidence was offered. Wyoming relies entirely on its earlier filed specifications, which describe only the different Wyoming method. As summarized in *Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.*, 598 F.3d 1336 (Fed. Cir. 2010) (en banc), the test is whether the priority application "convey[ed] to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." *Id*. at 1351 (citing *Ralston Purina Co. v. Far–Mar–Co, Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985)). The Board erred in law and fact. From the majority's affirmance of the Board's decision, I respectfully dissent. [Chevron U.S.A. Inc. V. University of Wyoming Research Corporation, 2019-1530 (Fed. Cir. 11/4/2020).]

In support of the judgement, the panel majority concluded:

Chevron's appeal presents us with only one, narrow issue: whether the Board erred in its construction of the limitation "gradually and continuously changing the alkane mobile phase solvent to a final mobile phase solvent." This is so for two reasons: first, because it is the only claim limitation the parties dispute; and second, because the parties are in agreement that Wyoming's '425 patent and the priority applications have written description support for the limitation under the Board's construction, but that they lack such support under the construction urged by Chevron. In other words, the parties concur that if we agree with the Board's construction of "gradually," we must affirm, whereas if we conclude that the Board erred, we must reverse. [Chevron U.S.A. Inc. V. University of Wyoming Research Corporation, 2019-1530 (Fed. Cir. 11/4/2020).]

Because Wyoming copied claim 1 of Chevron's '814 application to provoke the interference, we give the claim its broadest reasonable construction in light of the '814 application's specification. *ULF Bamberg v. Dalvey*, 815 F.3d 793, 796 (Fed. Cir. 2016) ("Because this is an interference, and Bamberg copied Dalvey's claims, we give the claims their broadest reasonable construction in light of the Dalvey specification."). "Under the broadest reasonable interpretation, the Board's construction cannot be divorced from the specification and the record evidence, and must be consistent with the one that those skilled in the art would reach.'' *Id*. (brackets and citation omitted). [Chevron U.S.A. Inc. V. University of Wyoming Research Corporation, 2019-1530 (Fed. Cir. 11/4/2020).]

We agree with Wyoming that the Board did not err in construing the "gradually and continuously changing" limitation. Paragraphs 37–41 of the '814 application, upon which Chevron relies, do not persuade us that the broadest reasonable construction of the "gradually and continuously changing" limitation requires a change of solvents at the inlet to the column. First and most

significantly, ¶ 37 of the '814 application, upon which the Board relied, provides an express definition of "gradually." That definition requires "incremental[] remov[al]" and "continuous[] adding." *** Accordingly, while ¶¶ 38–41 provide examples of "gradually and continuously changing" that is accomplished by "gradually and continuously add[ing]" solvents to a column, and provide potential time frames for "gradually and continuously changing," or "gradually and continuously adding," we do not read these paragraphs to require that the claimed "chang[ing]" be limited to occurring at the column's inlet. This is particularly true given the language used in the express definition of "gradually" set forth in ¶ 37. [Chevron U.S.A. Inc. V. University of Wyoming Research Corporation, 2019-1530 (Fed. Cir. 11/4/2020).]

I add the following case in response to this month's In re Google decision.

United States v. Olano, 91-1306, 507 US 725 (4/26/1993).

This is a Supreme Court decision. The significance of this case to patent law, is that the Federal Circuit relied upon it, in *In re Google*, 2019-1828 (Fed. Cir. 11/13/2020), to de-conflate pre-existing Federal Circuit case law referring to the doctrines of waiver and forfeiture.

This case decides an issue relating to application of the Federal Rules of Criminal Procedures, specifically, rule 52(b). Accordingly, the portions of the decision relating specifically to that rule are not necessarily relevant to civil proceedings.

Legal issue: Doctrine of forfeiture

The Court restated the doctrine of forfeiture as failure to timely assert a right.

"No procedural principle is more familiar to this Court than that a constitutional right," or a right of any other sort, "may be forfeited in criminal as well as civil cases by the failure to make timely assertion of the right before a tribunal having jurisdiction to determine it." *Yakus v. United States*, 321 U. S. 414, 444 (1944). Federal Rule of Criminal Procedure 52(b), which governs on appeal from criminal proceedings, provides a court of appeals a limited power to correct errors that were forfeited because not timely raised in district court. The Rule has remained unchanged since the original version of the Criminal Rules, and was intended as "a restatement of existing law." Advisory Committee's Notes on Fed. Rule Crim. Proc. 52, 18 U. S. C. App., p. 833. It is paired, appropriately, with Rule 52(a), which governs nonforfeited errors. [United States v. Olano, 507 US 725 (4/26/1993).]

Legal issue: Doctrine of waiver.

The Court restated the doctrine of waiver, as an intentional relinquishment of a known right.

Waiver is different from forfeiture. Whereas forfeiture is the failure to make the timely assertion of a right, waiver is the "intentional relinquishment or abandonment of a known right." *Johnson v. Zerbst*, 304 U. S. 458, 464 (1938);

see, e. g., Freytag v. Commissioner, 501 U. S. 868, 894, n. 2 (1991) (Scalia, J., concurring in part and concurring in judgment) (distinguishing between "waiver" and "forfeiture"); Spritzer, Criminal Waiver, Procedural Default and the Burger Court, 126 U. Pa. L. Rev. 473, 474-477 (1978) (same); Westen, Away from Waiver: A Rationale for the Forfeiture of Constitutional Rights in Criminal Procedure, 75 Mich. L. Rev. 1214, 1214— 1215 (1977) (same). [United States v. Olano, 507 US 725 (4/26/1993).]

...Whether a particular right is waivable; whether the defendant must participate personally in the waiver; whether certain procedures are required for waiver; and whether the defendant's choice must be particularly informed or voluntary, all depend on the right at stake. *See, e. g.*, 2 W. LaFave & J. Israel, Criminal Procedure § 11.6 (1984) (allocation of authority between defendant and counsel); Dix, Waiver in Criminal Procedure: A Brief for More Careful Analysis, 55 Texas L. Rev. 193 (1977) (waivability and standards for waiver). Mere forfeiture, as opposed to waiver, does not extinguish an "error" under Rule 52(b). Although in theory it could be argued that "[i]f the question was not presented to the trial court no error was committed by the trial court, hence there is nothing to review," Orfield, The Scope of Appeal in Criminal Cases, 84 U. Pa. L. Rev. 825, 840 (1936), this is not the theory that Rule 52(b) adopts. If a legal rule was violated during the district court proceedings, and if the defendant did not waive the rule, then there has been an "error" within the meaning of Rule 52(b) despite the absence of a timely objection. [United States v. Olano, 507 US 725 (4/26/1993).]