Precedential Patent Case Decisions During September 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

Biogen MA Inc. v. Emd Serono, Inc., 2019-1133 (Fed. Cir. 9/28/2020).

This is a decision on appeal from the D. N.J. district court case 2:10-cv-02734-CCC-MF.

A jury, in relevant part, found the asserted claim anticipated. The district court, in relevant part, granted JMOL of no anticipation, and conditionally granted a new trial on anticipation. Biogen appealed. The Federal Circuit reversed the district court's grant of JMOL of no anticipation.

In summarizing the district court's errors, the Federal Circuit stated:

> In evaluating the evidentiary record presented to the jury on the question of anticipation, the district court: (1) declined to apply a product-by-process analysis to the claimed recombinant IFN-ß source limitation; and (2) in its alternative ground analysis, required identity of three-dimensional structures not specifically recited in the claims rather than the claimed and lexicographically defined "polypeptide." Both of these determinations led to an erroneous conclusion on anticipation. [Biogen MA Inc. v. Emd Serono, Inc., 2019-1133 (Fed. Cir. 9/28/2020).]

Legal issue: 35 USC 112, claim construction, method claim defining use of a product defined by the process by which the product is made

The claim at issue defined a method with a single method step of administering "therapeutically effective amount of a composition comprising: a recombinant polypeptide...." The remainder of the claim defined the polypeptide by the method by which it was produced.

The Federal Circuit concluded that there was "no logical reason why the nesting of a product-by-process limitation within a method of treatment claim should change how novelty of that limitation is evaluated." In other words, if the step of administering the polypeptide was old, then the claim was anticipated.

> On the merits, Serono asserts that a source limitation alone cannot confer novelty unless the product itself is novel. Serono argues that the district court erred by holding that the lack of a recombinantly produced IFN-ß product in the prior art compelled a finding of no anticipation. Biogen argues that the source of the IFN-ß matters is an independent limitation. We agree with Serono. The

district court's refusal to consider the identity of recombinant and native IFN-ß runs afoul of the longstanding rule that "an old product is not patentable even if it is made by a new process." *Amgen*, 580 F.3d at 1366. *See also Gen. Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 373 (1938) ("[A] patentee who does not distinguish his product from what is old except by reference, express or constructive, to the process by which he produced it, cannot secure a monopoly on the product by whatever means produced."); *Cochrane v. Badische Anilin & Soda Fabrik*, 111 U.S. 293, 311 (1884) ("While a new process for producing [an old product] was patentable, the product itself could not be patented, even though it was a product made artificially for the first time."); *SmithKlineBeecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1317 (Fed. Cir. 2006) ("It has long been established that one cannot avoid anticipation by an earlier product disclosure by claiming the same product . . . as produced by a particular process."). [Biogen MA Inc. v. Emd Serono, Inc., 2019-1133 (Fed. Cir. 9/28/2020).]

Biogen's only basis for novelty of the method of treatment claims at issue here is the novelty of the recombinant IFN-ß composition that is administered. That composition is claimed in terms of the process by which it is manufactured. If the novelty of the recombinant IFN-ß composition requires comparing its structure to the structure of native IFN-ß, as *Amgen* requires, it would defy all reason to excuse that analysis for a method of administration claim using that composition. Such a rule could have the absurd result that a recombinant composition could be non-novel, the method of administration could be non-novel, but the method of administration of the composition defined by the process of its manufacture would be novel as a matter of law. [Biogen MA Inc. v. Emd Serono, Inc., 2019-1133 (Fed. Cir. 9/28/2020).]

There is no logical reason why the nesting of a product-by-process limitation within a method of treatment claim should change how novelty of that limitation is evaluated. Indeed, we have previously applied product-by-process analysis to a nested limitation. In *Purdue Pharma*, we interpreted a claim to "an oral dosage form comprising . . . oxycodone hydrochloride active pharmaceutical ingredient having less than 25 ppm 14-hydroxy[ ], wherein at least a portion of the 14-hydroxy [] is derived from 8a[ ] during conversion of oxycodone free base to oxycodone hydrochloride" as including a product-by-process limitation; namely, the 14-hydroxy as derived. *Purdue Pharma*, 811 F.3d at 1353 (emphasis omitted). Similar to our analysis here, the court in *Purdue Pharma* held that it was appropriate to focus on the identity of the products of the claimed and prior art processes, and not on the source limitation, in analyzing obviousness. *See id.* at 1353–54. The nesting of the product-by-process limitation within a method of treatment claim does not change the proper construction of the product-by-process limitation itself. [Biogen MA Inc. v. Emd Serono, Inc., 2019-1133 (Fed. Cir. 9/28/2020).]

We are also unpersuaded by the district court's and Biogen's reasoning that a product-by-process-type analysis is inappropriate here because the composition was otherwise capable of definition other than by the process. That argument is precluded by *Amgen*, where the product was also well-defined in the claims: "human erythropoietin . . . wherein said erythropoietin is purified from mammalian cells grown in culture." 580 F.3d at 1364. Furthermore, as noted *supra*, the rule in *Amgen* is a necessary outgrowth of the black-letter legal principle that an old product made by a new process is not novel and cannot be patented. Logic compels extending that rule to the pre-sent case; an old method of administration of an old product made by a new process is not novel and cannot be patented. [Biogen MA Inc. v. Emd Serono, Inc., 2019-1133 (Fed. Cir. 9/28/2020).]

Biogen explicitly defined "polypeptide" in the '755 patent: ["]Polypeptide—A linear array of amino acids connected one to the other by peptide bonds between the a-amino and carboxy groups of adjacent amino acids. ["] The "polypeptide" structure is thus defined by reference to its "linear" array, without regard to its folded protein structure. The district court charged the jury with this definition, adding that the jury "must accept my definition of these words in the claims as correct." Final Jury Instructions at 17, ECF No. 968. Biogen did not object to this charge and did not ask the court for a jury instruction requiring identity of the folded protein structures. *** The claims, in calling for antiviral activity, do not recite any specific folded three-dimensional structure that gives rise to that activity. While it is indisputable that an amino acid sequence alone cannot give rise to antiviral activity, it is also indisputable that every linear sequence of proteins will fold into some three-dimensional configuration. *** The jury thus had sufficient evidence to find that native IFN-ß polypeptide is identical to recombinant IFN-ß polypeptide, was administered in therapeutically effective amounts, and showed antiviral activity in the prior art. The district court thus erred in granting JMOL of no anticipation. [Biogen MA Inc. v. Emd Serono, Inc., 2019-1133 (Fed. Cir. 9/28/2020).]

Apple Inc. v. Voip-Pal.com, 2018-1456, 2018-1457 (Fed. Cir. 9/25/2020).

This is a decision on appeals from PTAB cases IPR2016-01198 and IPR2016-01201. The PTAB issued final written decisions on the merits finding that Apple failed to prove that the challenged claims were unpatentable. Apple appealed. The Federal Circuit vacate and remand on mootness grounds for a subset of challenged claims, and affirmed as to the other subset of challenged claims.

Legal issue: Mootness, of a first subset set of challenged claims, due to an intervening Federal Circuit decision in another proceeding affirming a district court decision finding the first subset set of challenged claims invalid; remedy.

The Federal Circuit followed the "established practice" of remanding with a direction to the PTAB to dismiss the petition with respect to the subset of challenged claims finally determined to be invalid in the other proceeding.

> In two consolidated appeals, Apple Inc. challenges the final written decisions of the Patent Trial and Appeal Board that certain claims of Voip-Pal.com, Inc.'s patents were not invalid for obviousness. *** At oral argument, Apple argued, and Voip-Pal did not dispute, that these appeals are moot as to Claims 1, 7, 27, 28, 72, 73, 92, and 111 of the '815 patent and Claims 49, 73, 74, 75, 77, 78, 83, 84, 94, 96, and 99 of the '005 patent (collectively, the "overlapping claims"). [2] These nineteen overlapping claims were at issue in the underlying IPR proceedings and were also deemed patent ineligible in *Twitter*. We agree that these overlapping claims are rendered moot in these appeals in light of *Twitter*. Because we have determined that the overlapping claims failed the Section 101 threshold in *Twitter*, Apple "no longer has the potential for injury, thereby mooting the [obviousness] inquiry" at issue in the instant appeals. *Momenta Pharm., Inc. v. Bristol-Myers Squibb Co.*, 915 F.3d 764, 770 (Fed. Cir. 2019) ("[W]hen the potential for injury has been mooted by events, the federal courts are deprived of jurisdiction."). Thus, we vacate-in-part the Board's final written decisions only as to these overlapping claims and direct the Board to dismiss Apple's petitions as to these claims. *See, e.g., United States v. Munsingwear, Inc.*, 340 U.S. 36, 39–41 (1950) (noting that the "*established practice* . . . in dealing with a civil case from a court in the federal system which has become moot while [on appeal] is to reverse or vacate the judgment below and remand with a direction to dismiss" (emphasis added)). [3] [Apple Inc. v. Voip-Pal.com, 2018-1456, 2018-1457 (Fed. Cir. 9/25/2020).]

Legal issue: Mootness, of a second subset set of challenged claims, due to an intervening Federal Circuit decision in another proceeding affirming a district court decision finding a the first subset set of the challenged claims invalid.

Apple urged that the Federal Circuit should vacate the PTAB's final written decision. Apple argued for this result on the theory that the patent ineligibility decision in the district court as to the first subset of challenged claims precluded Voip-Pal from suing Apple for patent infringement of the second subset of challenged claims. The Federal Circuit failed to take the bait to issue an advisory opinion.

> We now turn to whether these appeals are moot as to the "nonoverlapping claims." The nonoverlapping claims are the fifteen remaining claims at issue in the underlying IPR proceedings and were not part of the ineligibility determination in *Twitter*. [4] Apple argues that the question of obviousness as to the nonoverlapping claims "appears to be moot" in light of *Twitter* because Apple faces no liability for infringing these claims. Suggestion of Mootness at 11(emphasis added). Apple argues that "[b]asic principles of claim preclusion (res judicata) preclude Voip-Pal from accusing Apple" of infringing the nonoverlapping claims in future litigation, and thus, Apple can never face infringement liability as to these claims. *Id*. According to Apple, Voip-Pal is precluded from asserting these fifteen nonoverlapping claims against Apple because they are "essentially the same" as the claims held patent ineligible in the

Twitter appeal. *Id*. Apple also argues that Voip-Pal effectively conceded in the underlying district court litigation that the overlapping claims are essentially the same as the nonoverlapping claims when Voip-Pal dropped the latter claims from the litigation (at the request of the district court). We disagree with Apple's assertion of claim preclusion. [Apple Inc. v. Voip-Pal.com, 2018-1456, 2018-1457 (Fed. Cir. 9/25/2020).]

Under the doctrine of claim preclusion, "a judgment on the merits in a prior suit involving the same parties or their privies bars a second suit based on the same cause of action." *Lawlor v. Nat'l Screen Serv. Corp.*, 349 U.S. 322, 326 (1955) (internal quotation marks omitted). The determination of the "precise effect of the judgment[] in th[e] [first] case will necessarily have to be decided in any such later actions that may be brought." *In re Katz Interactive Call Processing Pat. Litig.*, 639 F.3d 1303, 1310 n.5 (Fed. Cir. 2011) (emphasis added). Apple acknowledges that any res judicata effect of a first proceeding is "an issue that only a future court can resolve." Appellant's Br. at 35 (citing *Matsushita Elec. Indus. Co. v. Epstein*, 516 U.S. 367, 396 (1996) (Ginsburg, J., concurring in part and dissenting in part) ("A court conducting an action cannot predetermine the res judicata effect of the judgment; that effect can be tested only in a subsequent action.") (emphasis added)). Thus, any preclusive effects that Twitter could have against the same or other parties must be decided in any subsequent action brought by Voip-Pal. Until then, any determination we make as to whether Voip-Pal is claim precluded from filing an infringement action concerning the nonoverlapping claims—claims that no court has deter mined are patent ineligible—is advisory in nature and falls outside of our Article III jurisdiction. *See Flast v. Cohen*, 392 U.S. 83, 96 (1968) ("[I]t is quite clear that the oldest and most consistent thread in the federal law of justiciability is that the federal courts will not give advisory opinions.") (internal quotation marks omitted). The question of obviousness as to the nonoverlapping claims is thus not moot. On these grounds, we deny Apple's request that we vacate the Board's sanctions order as moot. We maintain jurisdiction over both appeals as to the nonoverlapping claims and now turn to the merits of the appeals. [Apple Inc. v. Voip-Pal.com, 2018-1456, 2018-1457 (Fed. Cir. 9/25/2020).]

Legal issue: 5 USC 706(2)(A), review of agency compliance with its rules, scope of sanctions authorized by 37 CFR 42.12(b).

The Federal Circuit concluded that 42.12(b) authorized sanctions including, but not limited to, the eight sanctions listed in the rule.

Apple argues that the Board violated the APA when the Board exceeded its authority under its own sanction regulations. According to Apple, upon determining that Voip-Pal's ex parte communications were sanctionable, the Board was required to issue one of eight authorized sanctions under 37 C.F.R. § 42.12(b). *** We reject this argument. The provision at issue provides that: ["]

(a) The Board *may* impose a sanction against a party for misconduct, ...(b) Sanctions include entry of one or more of the following: (1) An order... (8) Judgment in the trial or dismissal of the petition. ["] *** Key here, Section 42.12(b) uses the term "include," which signifies a non-exhaustive list of sanctions. *See, e.g., Marrama v. Citizens Bank of Mass*., 549 U.S. 365, 373 & n.8 (2007) (determining statutory list of ten items preceded by term "including" to be "a nonexclusive list"); *Talk Am., Inc. v. Mich.Bell Tel. Co.*, 564 U.S. 50, 63 n.5 (2011) (determining regulation using phrase "include, but are not limited to," to be "nonexhaustive"); *see also Include, Black's Law Dictionary* (11th ed. 2019) ("The participle *including* typically indicates a partial list."). Additionally, reading this regulatory provision as non-exhaustive is consistent with the context of the Board's sanctioning regime, which affords the Board discretion to impose sanctions in the first place. See 37 C.F.R. § 42.12(a)(1) (providing that the Board "***may*** impose a sanction" (emphasis added)); Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions, 77 Fed. Reg. 48,612, 48,616 (Aug. 14, 2012) (providing that "an *ex parte* communication *may* result in sanctions") (second emphasis added). The use of "may" emphasized above renders permissible and non-exhaustive use of the listed sanctions. Thus, contrary to Apple's position, Section 42.12(b) does not limit the Board to the eight listed sanctions. Rather, the plain reading of Section 42.12(b) allows the Board to issue sanctions not explicitly provided in the regulation. We therefore hold that the plain reading of Section 42.12(b) provides the Board with discretion to issue sanctions and that the Board did not commit an APA violation when it issued a sanction not explicitly listed under Section 42.12. [Apple Inc. v. Voip-Pal.com, 2018-1456, 2018-1457 (Fed. Cir. 9/25/2020).]

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

This is a decision on appeals from E.D. Tex cases 6:11-cv-00492-RWS and 6:13-cv-00072-RWS. 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. 9/24/2020).]

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. 9/24/2020).]

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. 9/24/2020).]

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. 9/24/2020).]

Facebook, Inc. v. Windy City Innovations, LLC, 2018-1400, et al. (Fed. Cir. 9/4/2020).

This is a decision on appeals from PTAB cases: IPR2016-01156; IPR2016-01157; IPR2016-01158, IPR2016-01159; IPR2017-00659; and IPR2017-00709. This opinion was originally issued 3/18/2020, and then modified 9/4/2020. This opinion was modified and reissued following a combined petition for panel rehearing and rehearing en banc filed by Facebook.

Facebook filed some IPR petitions, and then late filed two IPR petitions, meaning that these IPR petitions were filed after a 315(b) bar date had run against Facebook.

The PTAB instituted review on those two late filed IPR petitions and joined those instituted review proceedings to instituted review proceedings resulting from Facebook's timely filed IPR petitions.

In relevant part, the PTAB held that, certain claims challenged only in the two late filed IPR petitions, were unpatentable. Both parties appealed.

Windy City's appeals, in relevant part, challenged the PTAB's joinder decisions allowing Facebook to join instituted reviews resulting from Facebook's late filed IPR proceedings to instituted reviews resulting from Facebook's timely filed IPR petitions.

The Federal Circuit, in relevant part, vacated the final written decisions in the late filed IPRs, and remanded the late filed IPRs to the PTAB.

Legal issue: 35 USC 314(d), scope of bar to reviewability of IPR institution decisions.

The Federal Circuit held that the 314(d) bar to reviewability of IPR institution decisions did not extend to 315(c) joinder decisions, because joinder decisions are "a separate and subsequent decision to the institution decision."

> To join a party to an instituted IPR, the plain language of § 315(c) requires two different decisions. First, the statute requires that the Director (or the Board acting through a delegation of authority, see 37 C.F.R. §§ 42.4(a), 42.122)) determine whether the joinder applicant's petition for IPR "warrants" institution under § 314. We may not review this decision, whether for timeliness or to consider whether the petitioner is likely to succeed on the merits. *SeeThryv*, 140 S. Ct. at 1373 ("[Section] 314(d) bars review at least of matters 'closely tied to the application and interpretation of statutes related to' the institution decision." (quoting *Cuozzo*, 136 S. Ct. at 2141)). Second, to effect joinder, § 315(c) requires the Director to exercise his discretion to decide whether to "join as a party" the joinder applicant. That is, the statute requires the Director (or the Board on behalf of the Director) to make a "joinder decision." *See* PTO Supp. Br. 10. The statute makes clear that the joinder decision is made after a determination that a petition warrants institution, thereby affecting the manner in which an IPR will proceed. *See Thryv*, 140 S. Ct. at 1377. Thus, the joinder decision is a separate and subsequent decision to the intuition decision. Nothing in § 314(d), nor any other statute, overcomes the strong presumption that we have jurisdiction to review that joinder decision. [Facebook, Inc. v. Windy City Innovations, LLC, 2018-1400, et al. (Fed. Cir. 9/4/2020).]

Legal issue: 35 USC 315(c), scope of authorized joinder.

The Federal Circuit held that 315(c) does not authorize joining a new proceeding filed by a party to an existing proceeding filed by the same party (that is same party joinder).

The Federal Circuit held that 315(c) does not authorize joining a new proceeding to an existing proceeding, when the new proceeding presents issues not present in the existing proceeding (new issues joinder).

> ...The clear and unambiguous text of § 315(c) does not authorize same-party joinder, and does not authorize the joinder of new issues. [Facebook, Inc. v. Windy City Innovations, LLC, 2018-1400, et al. (Fed. Cir. 9/4/2020).]

> ...Assuming that the Board in fact joined Facebook 'as a party' to its existing IPRs, the question before us is whether § 315(c) authorizes a person to be joined as a party to a proceeding in which it is already a party. The clear and unambiguous language of § 315(c) confirms that it does not. [Facebook, Inc. v. Windy City Innovations, LLC, 2018-1400, et al. (Fed. Cir. 9/4/2020).]

> Setting aside the question of same-party joinder, the language in 315(c)

does no more than authorize the Director to join 1) a person 2) as a party, 3) to an already instituted IPR. This language does not authorize the joined party to bring new issues from its new proceeding into the existing proceeding. As discussed above, § 315(c) authorizes joinder of a person as a party, not "joinder" of two proceedings. [Facebook, Inc. v. Windy City Innovations, LLC, 2018-1400, et al. (Fed. Cir. 9/4/2020).]

The lack of an express prohibition, however, does not make § 315(c) ambiguous as to whether it permits joinder of new issues. Rather, it simply permits the Director, at his or her discretion, to join any person as a party to an already-instituted IPR. *SeeThryv*, 140 S. Ct. at 1374 ("[T]he §315(b)-barred party can join a proceeding initiated by another petitioner." (emphasis added)). The already-instituted IPR to which a person may join as a party is governed by its own petition and is confined to the claims and grounds challenged in that petition. *SAS*, 138 S. Ct. at1356 ("[T]he petitioner's petition, not the Director's discre-tion, is supposed to guide the life of the litigation."); *id*. at 1355 ("Congress chose to structure a process in which it's the petitioner, not the Director, who gets to define the con-tours of the proceeding."). We therefore conclude that the unambiguous meaning of § 315(c) is that it allows the Di-rector discretion to join a person as a party to an already-instituted IPR but does not permit the joined party, by virtue of the joinder decision alone, to bring new issues from a second proceeding into the existing proceeding. Any other conclusion would improperly join proceedings, rather than parties—which § 315(c) does not authorize. [Facebook, Inc. v. Windy City Innovations, LLC, 2018-1400, et al. (Fed. Cir. 9/4/2020).]

315(c), authorizes joinder of parties, not proceedings

Our interpretation of § 315(c) is also consistent with the statutory scheme of § 315 as a whole, as illustrated by the neighboring subsections. For example, as noted previously, § 315(d) specifically contemplates "consolidation" of two proceedings and their respective issues. *** This section thus authorizes consolidation of, for example, multiple instituted (and therefore timely) IPRs and the issues contained therein, even when the issues may not be identical. There is a clear distinction between § 315(c), which refers to the joinder of a person as a party, and § 315(d), which refers to the consolidation of multiple proceedings and the issues in each. Construing § 315(c) to permit joinder of proceedings, and all the new issues therein, would render superfluous the reference to consolidation in § 315(d), which is disfavored in statutory interpretation. *See Marx v. Gen. Revenue Corp.*, 568 U.S. 371, 386 (2013) ("[T]he canon against surplusage is strong-est when an interpretation would render superfluous an-other part of the same statutory scheme."). Again, construing § 315(c) to allow unfettered joinder of proceedings is inconsistent with all common understandings of the terms "joinder" and "consolidation." [Facebook, Inc. v. Windy City Innovations, LLC, 2018-1400, et al. (Fed. Cir. 9/4/2020).]

> Our interpretation is further supported by the legislative history of § 315(c). The final committee report states that under § 315(c), "[t]he Director may allow other petitioners to join an inter partes . . . review." H.R. Rep. No. 112-98, pt. 1, at 76 (2011), as reprinted in 2011 U.S.C.C.A.N. 67, 100 (emphasis added). Like the statutory language itself, this contemplates allowing a person to join an already-instituted IPR as a party but not to bring with it its new issues. *See Nidec*, 868 F.3d at 1020 (Dyk, J., concurring). [Facebook, Inc. v. Windy City Innovations, LLC, 2018-1400, et al. (Fed. Cir. 9/4/2020).]
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> Accordingly, we hold that the clear and unambiguous meaning of § 315(c) does not authorize joinder of two proceedings, and does not authorize the Director to join a person to a proceeding in which that person is already a party. [Facebook, Inc. v. Windy City Innovations, LLC, 2018-1400, et al. (Fed. Cir. 9/4/2020).]

Note: The Supreme Court has told the Federal Circuit that 314(d) bars the Federal Circuit from reviewing an institution decision. So, the Federal Circuit had to remand the late filed IPRs to the PTAB for the PTAB to determine what to do with the late filed IPRs. The PTO however, published and made precedential its contrary decision as to same party joinder and new issues joinder, *see Proppant Express Investments, LLC v. Oren Techs., LLC*, IPR2018-00914, paper 38 (3/13/2019; designated precedential 3/13/2019). This decision remains present, as of today, 9/30/2020, on the PTAB's web page listing precedential decisions.

The Federal Circuit's decision in this case relies upon its conclusion that 314(d) does not bar it from reviewing 315(c) decisions. That issue might go to the Supreme Court, and the Supreme Court might reverse. Accordingly, the *Proppant* decision might stand the test of time, -- or not. All we can say at this point in time, is that the law regarding 315(c) remains unsettled.

(I include here a case that from 7/31/2020 that failed to make it into my July or August articles.)

IBSA Institut Biochimique v. Teva Pharmaceuticals USA, Inc., 2019-2400 (Fed. Cir. 7/31/2020).

This is a decision on an appeal from the D.Del. district court case 1:18-cv-00555-RGA. The district court held certain claims invalid for 35 USC 112 indefiniteness. IBSA appealed. The Federal Circuit affirmed.

The Federal Circuit restated the definiteness requirement.

> The definiteness requirement of 35 U.S.C. § 112 "must take into account the inherent limitations of language." *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 909 (2014). At the same time, "a patent must be precise enough to afford clear notice of what is claimed, thereby 'appris[ing] the public of what is still open to them.'" *Id.* (quoting *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996) (alteration in original)). Accordingly, a "claim is invalid for indefiniteness if its language, read in light of the specification and prosecution history, 'fail[s] to inform, with reasonable certainty, those skilled in the art about

> the scope of the invention.'" *HZNP Meds. LLC v. Actavis Labs. UT, Inc.*, 940 F.3d 680, 688 (Fed. Cir. 2019) (quoting *Nautilus*, 572 U.S. at 901 (alteration in original)). [IBSA Institut Biochimique v. Teva Pharmaceuticals USA, Inc., 2019-2400 (Fed. Cir. 7/31/2020).]

The Federal Circuit then went through the analysis for determining definiteness by considering the language of the claims, the specification, the prosecution history, and the extrinsic record.

Legal issue: 35 USC 112, definiteness, effect of inconsistency between asserted claim construction and specification.

The Federal Circuit concluded that an assertion of a claim construction of an element of a list described in the specification as a disjunctive list (e.g., a, b, c, or d), which construction covered more than that one element in the list, resulted in uncertainty as to the boundaries of the claim.

> We next look to the specification. The district court relied on a passage of the specification stating that "[i]n particular, said soft capsule contains an inner phase consisting of a liquid, a half-liquid, a paste, a gel, an emulsion or a suspension comprising the liquid (or half-liquid) vehicle and the thyroid hormones together with possible excipients in suspension or solution," to determine that a "half-liquid is not, or at least is not necessarily, a gel or a paste." *Decision*, 2019 WL 3936656, at *6 (quoting '390 patent col. 7 l. 65–col. 8 l. 2). Not only do we agree with the district court's interpretation of this passage, but a second passage reinforces this interpretation. *See* '390 patent col. 10 ll. 38–39 ("Soft capsules (SEC) with liquid, half-liquid, paste-like or gel-like inner phase"). These disjunctive lists designate that a "half-liquid" is an alternative to the other members of the list, including pastes and gels. *See, e.g., SkinMedica, Inc. v. Histogen Inc.*, 727 F.3d 1187, 1199–1200 (Fed. Cir. 2013) ("The disjunctive 'or' plainly designates that a series describes alternatives."). Pastes and gels, however, have a thick consistency between a liquid and a solid and would be included in IBSA's proposed construction. Such inclusion is at odds with the above passages and creates uncertainty as to the boundaries of a "half-liquid." [IBSA Institut Biochimique v. Teva Pharmaceuticals USA, Inc., 2019-2400 (Fed. Cir. 7/31/2020).]

Legal issue: 35 USC 112, definiteness, discrepancies between terms in the patent and its Paris priority application.

The Federal Circuit concluded that it was proper to view the discrepancies between the the patent and its Paris priority application, as intentional, to conclude that the claimed "half-liquid" was not synonymous with the disclosed "semi-liquid."

> Besides the differences the district court discussed between the Italian Application and the '390 patent, Teva also points out that the language of claim 1 of the '390 patent differs from that of claim 1 of the Italian application. As Teva

notes, claim 1 of the ’390 patent incorporates the Fourth Embodiment of the ’390 patent, which was not found in the Italian Application. Further, unlike the ’390 patent, the Italian Application does not use the term “gel.” For example, the ’390 patent includes the passage “an inner phase consisting of a liquid, a half-liquid, a paste, a gel, an emulsion or a suspension,” while the certified translation of the Italian Application translates the Italian Application as “an internal phase consisting of a liquid, a semi-liquid, a paste, an emulsion or a suspension.” Appellant Br. 67 (Table 1). Accordingly, we agree with Teva that a POSA would likely consider the discrepant usage of “half-liquid” and “semiliquido” between the ’390 patent and the Italian Application to be intentional, implying that the different word choice has a different scope. [IBSA Institut Biochimique v. Teva Pharmaceuticals USA, Inc., 2019-2400 (Fed. Cir. 7/31/2020).]

Furthermore, and contrary to IBSA’s suggestion, such weighing of the evidence does not unfairly subordinate a foreign priority application and does not amount to a refusal to consider a foreign priority document. Rather, when discrepancies between a foreign priority document and the U.S. filing exist, it may be proper to view the discrepancies as intentional. *See Abbott Labs. v. Sandoz, Inc.*, 566 F.3d 1282, 1290 (Fed. Cir. 2009) (determining that although a Japanese priority application mentioned Crystal A and B, the fact that the patent-at-issue excluded Crystal B “strongly suggest[ed] that the [patent-at-issue] intentionally excluded Crystal B compounds”). [IBSA Institut Biochimique v. Teva Pharmaceuticals USA, Inc., 2019-2400 (Fed. Cir. 7/31/2020).]

In addition to the Italian Application, another portion of the prosecution history reinforces our conclusion that the applicant intentionally used “half-liquid” instead of “semi-liquid.” During the prosecution of the ’390 patent the applicant had a pending claim using “half-liquid” and another claim, depending from that claim, using the term “semi-liquid.” *See Decision*, 2019 WL 3936656, at *5. Although the claim using “semi-liquid” was ultimately removed, this is additional evidence that the applicant knew the term “semi-liquid” yet elected to use “half-liquid” to mean some-thing different. Accordingly, the intrinsic evidence fails to establish the boundaries of a “half-liquid.” [IBSA Institut Biochimique v. Teva Pharmaceuticals USA, Inc., 2019-2400 (Fed. Cir. 7/31/2020).]