

Federal Circuit Precedential & Supreme Court Patent Decisions of 2023

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Author's Note: The following is my working compilation of the 75 Federal Circuit precedential patent decisions and orders (and one U.S. Supreme Court patent decision) issued in 2023. Each entry includes a URL linking the opinion, an identification of the panel and authoring judge, my abbreviated list of the issues decided, and any accompanying same-day Tweets or other notes I made. Follow @patent_maven on X/Twitter for 2024 updates!

- 1) **01/06/2023** **21-2372** **PTO**
[DIONEX SOFTRON GMBH v. AGILENT TECHNOLOGIES, INC.](#) [OPINION] **Precedential**

Reyna, Chen, STARK

Pre-AIA Interference priority; Corroboration of inventor testimony

TWEET: Dionex v Agilent 1/6/23 #FedCir affirms interference priority to jr pty A. A's spec supports Bd's BRC of claims D copied. Prior actual RTP testimony by A inventor corroborated by 2 colleagues witnessing successful prototype. No negative infer from lack of A co-inventor testimony.

- 2) **01/09/2023** **23-102** **RIT**
[In Re STINGRAY IP SOLUTIONS, LLC](#) [ORDER] **Precedential**

Lourie, Taranto, STARK

Question of first impression: Venue for foreign defendant *

TWEET1: In re Stingray 1/10 #FedCir grants mandamus to resolve deep DCt split, holding that defendant (here, foreign corp sued in EDTx) canNOT defeat personal jurisdiction under FRCP 4(k)(2) by unilaterally consenting post-suit to be sued in a different, preferred district (here, CDCal).

TWEET2: Instead, defendant (here TP-Link) must show that patentee "could have brought suit" in preferred venue (here CDCal) independent of def's consent. FRCP 1404 fairness/convenience standard applies, not defendant's unilateral wish.

- 3) **01/09/2023** **22-1012** **PTO**
[In Re GOOGLE LLC](#) [OPINION] **Precedential**

MOORE, Lourie, Prost

Obviousness; PTO procedure--PTAB must explain reasoning

TWEET: In re Google 1/9/23 #FedCir vacates PTO ex parte determination that search query filtering method claims wd hv bn obvious. PTAB didn't explain how to modify prior art. "Squint as we may, we do not see the justifications invoked by the PTO on appeal reflected in the record below."

- 4) **01/12/2023 21-2370 DCT**
**[GRACE INSTRUMENT INDUSTRIES, LLC v. CHANDLER INSTRUMENTS COMPANY, LLC](#) [OPINION]
Precedential**

CHEN, Cunningham, Stark

Indefiniteness; Claim construction; Intrinsic evidence prevails; Error to rely on dictionary

TWEET1: Grace v Chandler 1/12 #FedCir resuscitates G's oil drilling viscometer patent. "Enlarged chamber" NOT indefinite. Although not term of art & not explicitly defined, intrinsic evidence -> "large enough" to do recited fn: avoid co-mingling 2 fluids. SDTx erred in using dictionary.

TWEET2: This is a good teaching case on patent claim interpretation and satisfying the definiteness requirement, authored by #FedCir Judge Chen.

- 5) **01/20/2023 21-2275 DCT**
[PERSONALIZED MEDIA COMMUNICATIONS, LLC v. APPLE INC.](#) [OPINION] Precedential

REYNA, Chen, Stark (Dissent by Stark)

Prosecution Laches *

TWEET: PMC v Apple 1/20 #FedCir 2-1 affirms EDTx: P's patent unenforceable for prosecution laches. Case "very similar" & "more egregious" than Hyatt. P filed 328 GATT-bubble apps. Unreasonable delay despite Consolidation Agrmt w/ PTO. Dissent: A didn't develop accused prod until after.

- 6) **02/01/2023 23-101 RIT**
[In Re GOOGLE LLC](#) [ORDER] Precedential

Lourie, Taranto, STARK

Venue transfer--factors analysis

TWEET: In re Google 2/1/23 #FedCir mandamuses WDTex (Albright J) to xfer venue to NDCal, "clearly" the "center of gravity" here. DCT erred on multiple xfer factors. Jawbone's earbud invention & G's accused device were developed in NDCal. J rented office in Waco TX only 1 mo before suit.

- 7) **02/08/2023 20-1565 PTO**
[CYWEE GROUP LTD. v. GOOGLE LLC](#) [OPINION] Precedential

PROST, Taranto, Chen

Timeliness of Director review of PTAB IPR decisions not governed by PTAB's statutory deadlines

TWEET1: Cywee v Google 2/8 #FedCir affirms 2 IPR rulings that C's claims unpatentable for obviousness. C's untimeliness/Due Process arguments "meritless." Nothing requires that Director review of PTAB institution & FWDs per Arthrex be accomplished within statutory 3-mo & 1-yr deadlines.

TWEET2: #FedCir also rejects as "meritless" C's argument that Director delegating time-extension for FWDs in case of joinder to PTAB violates Appointments Clause. No evidence of contrary Congressional intent for Director to so delegate & Director is vested with "broad rulemaking powers.

- 8) **02/13/2023** **22-1116** **DCT**
[CHROMADEx, INC. v. ELYSIUM HEALTH, INC.](#) [OPINION] **Precedential**

PROST, Chen, Stoll

Section 101 eligibility for products of nature *

TWEET: ChromaDex v Elysium 2/13 #FedCir affirms DDel that vitamin B3 supplement patent is s101 UN-eligible. "Very broad" claims to isolated nicotinamide riboside comp not markedly different from natural milk. This product of nature fails under *Chakrabarty/Myriad; Mayo* 2-step not req'd.

Also similar to Circuit's *Natural Alternatives* case.

- 9) **02/13/2023** **21-2345** **DCT**
[SSI TECHNOLOGIES, LLC v. DONGGUAN ZHENGYANG ELECTRONIC MECHANICAL LTD.](#) [OPINION]
Precedential

Reyna, BRYSON, Cunningham

Claim interpretation; doctrine of equivalents infringement; tortious interference by patentee communicating with customers about alleged infringement (*Noerr-Pennington* immunity or sham litigation exception?)

- 10) **02/15/2023** **21-2246** **DCT**
[MINERVA SURGICAL, INC. v. HOLOGIC, INC.](#) [OPINION] **Precedential**

Prost, REYNA, Stoll

Section 102(b) Public Use; Ready for Patenting

TWEET1: Minerva v Hologic 2/15 #FedCir affirms D.Del that M's surgical device patent is s102b (pre-AIA) invalid: (1) in public use at pre-critical date trade show (physician attendees had "close scrutiny," no NDAs) & (2) ready for patenting (working prototypes needed only "fine tuning").

TWEET2: Note that pre-AIA s102(b) critical date was 11/7/2010, one year before US provisional appln filing date of 11/7/2011. #FedCir missed a teaching moment by referring generally to "priority date" instead of "US priority date." One-year clock didn't run from a foreign priority date.

11) 02/17/2023 23-1146 DCT
[LITE-NETICS, LLC v. NU TSAI CAPITAL LLC](#) [OPINION] Precedential

Lourie, TARANTO, Stark

First Amendment; injunctions against patentee giving notice of patent rights; Eighth Circuit law

12) 02/17/2023 22-1222 DCT
[HAWK TECHNOLOGY SYSTEMS, LLC v. CASTLE RETAIL, LLC](#) [OPINION] Precedential

REYNA, Hughes, Cunningham

§101 Patent Un-Eligibility

Affirming DCt that patent claims were directed to the abstract idea of storing and displaying video; claims failed to provide an inventive step that transformed that abstract idea into a patent-eligible invention.

13) 02/24/2023 23-1186 DCT
[JAZZ PHARMACEUTICALS, INC. v. AVADEL CNS PHARMACEUTICALS, LLC](#) [OPINION] Precedential

LOURIE, Reyna, Taranto

FDA Orange Book de-listing

Affirms order of D. Del. granting Avadel's motion for an injunction directing Jazz to take measures to de-list its U.S. Patent 8,731,963 from FDA's "Orange Book" because the patent claims a system comprising computer memories and a data processor, not an approved method of use.

14) 03/06/2023 21-2168 PTO
[REGENTS OF THE UNIVERSITY OF MINNESOTA v. GILEAD SCIENCES, INC.](#) [OPINION] Precedential

LOURIE, Dyk, Stoll

Written description of the invention requirement *

TWEET: Regents U Mn v Gilead 3/6/23 #FedCir (AL) affirms Mn's patent anticipated. "Laundry list disclosure" of its provisional app did not supply adequate written description support for later claimed subgenus. Provisional's indeterminate "maze-like path" -> insufficient "blaze marks."

15) 03/13/2023 22-1249 DCT
[APPLE INC. v. VIDAL](#) [OPINION] Precedential

Lourie, TARANTO, Stoll

APA; Notice & Comment Rulemaking; IPR Institution Instructions per *Fintiv*

TWEET: Apple v Vidal 3/13 #FedCir: Although USPTO Dir’s discretion whether to institute an IPR is not reviewable, her decision to issue the Fintiv/NHK instructions to PTAB without notice & comment rule making is. Apple has standing to press its challenge to *Fintiv* under APA s553.

16) 03/13/2023 22-1037 PTO
[INTEL CORPORATION v. PACT XPP SCHWEIZ AG](#) [OPINION] Precedential

Newman, PROST, Hughes

Obviousness; Motivation to combine; KSR “known technique” rationale

TWEET1: Intel v PACT XPP 3/13/23 #FedCir reverses PTAB. Claimed multiprocessor system would hv been obvious in view of 2 refs that each addressed same cache consistency problem. KSR’s rationale of using “known technique” to improve similar devices supplied the motivation to combine here.

TWEET2: Curmudgeon’s comment: the “claimed interconnect system” is a misnomer; the interconnect system is one of several claim-recited limitations. What is claimed (per the PACT XPP patent’s claim 4) is simply “[a] system.” That system includes the claim-recited interconnect system.

17) 03/13/2023 22-1349 DCT
[ALTERWAN, INC. v. AMAZON.COM, INC.](#) [OPINION] Precedential

Lourie, DYK, Stoll

Stipulation of judgment of non-infringement ambiguous; Claim construction

18) 03/31/2023 22-1058 PTO
[ROKU, INC. v. UNIVERSAL ELECTRONICS, INC.](#) [OPINION] Precedential

Reyna, Newman, STOLL

Obviousness: fact question re what prior art teaches

TWEET: Roku v. UnivElec 3/31/23 #FedCir 2-1 affirms PTAB that improved universal remote wd NOT hv bn obvious. What prior art taught was a “close,” “highly disputed” fact q. Substantial evidence for PTAB’s finding. Dissent (PN): we can still review de novo the ultimate q of obviousness.

19) 03/31/2023 22-1227 ITC
[PHILIP MORRIS PRODUCTS S.A. v. ITC](#) [OPINION] Precedential

Prost, Reyna, STOLL

Section 337 action; Issue forfeiture; ITC duty to consult with FDA; Public interest exception to exclusion order; Domestic industry; Obviousness—motivation to modify prior art; Infringement—claim construction; Corroboration of testimony for invalidating public use

20) 04/03/2023 21-2296 DCT
[IRONBURG INVENTIONS LTD. v. VALVE CORPORATION](#) [OPINION] Precedential

Lourie, Clevenger, STARK (dissent by Clevenger)

Claim definiteness; IPR Estoppel

TWEET: Ironburg v ValveCorp 4/3/23 #FedCir 2-1 affirms WDWa that handheld video controller claims NOT indefinite. But compelling dissent (RC) contends no reasonable certainty on WHERE to measure top-to-bottom "full distance" limitation. Dissent would give this claim drafter "no slack."

21) 04/05/2023 21-2320 DCT
[SALAZAR v. AT&T MOBILITY LLC](#) [OPINION] Precedential

STOLL, Schall, Stark

Claim interpretation—singular vs plural

TWEET: Salazar v AT&TMobilty 4/5 #FedCir rules DCt correctly interpreted "a" & "said" "microprocessor" as req'g a single microprocessor (of one or more microprocessors) that is capable of performing ALL of the later recited "generating," "creating," & "retrieving" functions in S's claim

21.1) 04/06/2023 21-1542 DCT
[SAS INSTITUTE, INC. v. WORLD PROGRAMMING LIMITED](#) [OPINION] Precedential
COPYRIGHT CASE

Newman, REYNA, Wallach (Dissent by Newman)

Copyrightable subject matter *

TWEET1: SAS Inst v WPL 4/6 #FedCir 2-1 affirms EDTx that non-literal elements of SAS software (overall selection/arrangement of input formats & output designs) are NOT copyrightable. SAS failed filtration step of A/F/C test. Pre-trial "copyrightability hearing" was within DCt's discretion.

TWEET2: Newman J dissents from majority's "far-reaching change." Legal error to apply filtration analysis (from A/F/C test for infringement) to determine copyrightability. Also error to req © holder to come forward with evidence that nonliteral elements are independently copyrightable.

22) 04/11/2023 20-1183 PTO
[ARBUTUS BIOPHARMA CORPORATION v. MODERNATX, INC.](#) [OPINION] Precedential

REYNA, Schall, Chen

Anticipation by inherency

TWEET1: Arbutus v Moderna 4/11 #FedCir affirms Bd that A's patent on SNALP particles w/ non-lamellar structure anticipated. Recited morphology limitation inherently disclosed in A's own s102(e) patent; would naturally result from following its limited # of tools. Not just a probability.

TWEET2: Curmudgeon's Comment: "claim 1(d) of the '127 patent" is better referred to as "limitation (d) of claim 1 of the '127 patent." To reference "claim 1(d)" suggests that limitation (d) alone is the claimed invention, which it is not.

23) 04/12/2023 22-1268 DCT
[HEALTHIER CHOICES MANAGEMENT CORP. v. PHILIP MORRIS USA, INC.](#) [OPINION] Precedential

Taranto, STOLL, Cunningham

Plausible allegations of infringement; FRCP 12(b)(6) dismissal reversed

HCM's original and amended complaints recited sufficient allegations to raise facially plausible case of patent infringement, specifically rejecting MRTPA's statements that accused IQOS system did not initiate a combustion reaction. HMC's specific, targeted allegations were "neither general nor conclusory." District court's award of attorneys' fees also vacated.

24) 04/12/2023 21-2173 DCT
[SANDERLING MANAGEMENT LTD. v. SNAP INC.](#) [OPINION] Precedential

Chen, Cunningham, STARK

Section 101 patent un-eligibility

Affirming district court's dismissal of Sanderling's patent infringement suit against Snap due to the asserted claims' §101 lack of patent-eligible subject matter. Claimed invention didn't improve computer functionality. Claims were directed to abstract idea "'of providing information – in this case, a processing function – based on meeting a condition,' e.g., matching a GPS location indication with a geographic location." "[D]istribution of information is an abstract idea." No error in DCt not interpreting claims when patentee didn't propose constructions for terms it identified. No transformative inventive concept (Alice #2); the distribution rule merely uses common computer components to apply the abstract idea.

25) 04/12/2023 21-2263 DCT
[SEQUOIA TECHNOLOGY, LLC v. DELL, INC.](#) [OPINION] Precedential

Lourie, Dyk, STOLL

Claim interpretation; Section 101 Patent-eligible subject matter; Infringement

TWEET1: Sequoia v Dell 4/12 #FedCir revives S's digital storage method patent; DCt erred construing "computer-readable recording medium storing instructions" as including transitory media (waves); h/w context limits "including." Error to rely on extrinsic evid. Claims ARE 101 eligible.

TWEET2: But DCt correctly construed "logical volumes" to mean entire "disk partitions", not portions thereof. Also correctly ruled that whether "extent . . . is used or not used" in allocation table = used for storage. Thus #FedCir affirms that accused Red Hat s/w tool does NOT infringe.

26) 04/12/2023 21-1924 DCT
[UCB, INC. v. ACTAVIS LABORATORIES UT, INC.](#) [OPINION] Precedential

Moore, Chen, STOLL

Hatch-Waxman litigation; Anticipation--overlapping ranges; Obviousness; Hatch-Waxman

U.S. Patent No. 10,130,589, directed to transdermal rotigotine patches

TWEET: UCB v Actavis 4/12 #FedCir agrees that U's Parkinsons skin patch patent wd hv bn obvious, but DCt erred in anticipation analysis. Error to convert prior art range to discrete points & apply Kennametal/"immediately envisage" test; should look at criticality of claim-recited range.

27) 04/19/2023 22-1147 DCT
[AMGEN INC. v. SANDOZ INC.](#) [OPINION] Precedential

LOURIE, Cunningham, Stark

Pharma nonobviousness; motivation to modify; secondary considerations; unexpected results *

TWEET1: Amgen v Sandoz 4/19 #FedCir upholds A's USP7427,638 on stereomerically pure apremilast (covering A's OTEZLE psoriasis med). Motivation lacking to modify prior art racemic mixture into its enantiomers. 20-fold difference => unexpected result. Long-felt need for oral treatment.

TWEET2: "There is no specific fold-difference that defines what may, or may not, support a finding of nonobviousness." But here, when skilled artisan would expect 2-fold difference, a 20-fold difference in potency between pure apremilast & racemic mix supports unexpected results finding.

TWEET3: #FedCir also affirms on x-appeal that A's USP 10,092,541 on apremilast dose-titration schedules is invalid for obviousness. "We note here, as in Genentech, that varying a dose in response to the occurrence of side effects is well-known and obvious to the skilled artisan."

28) 04/20/2023 22-1228 ITC
[FS.COM INC. v. ITC](#) [OPINION] Precedential

MOORE, Prost, Hughes

Enablement of open-ended claims (inherent upper limit); Claim interpretation—singular versus plural-general rule that "a" means one or more

TWEET: FS.com v ITC 4/20 #FedCir affirms Corning fiber optic patents valid & infringed. Open-ended claims enabled bcz 2008 artisan knew max connection density technologically feasible = ~144 connect's/U space. "A front opening" = 1 or more; no clear intent to limit to 1.

29) 05/02/2023 22-1696 DCT
[HIP, INC. v. HORMEL FOODS CORPORATION](#) [OPINION] Precedential

LOURIE, Clevenger, Taranto

Joint inventorship standards (not met); *Pannu* factors analysis

TWEET: HIP v Hormel 5/2 #FedCir reverses DCt decision adding HIP employee as co-inventor of Hormel patent. Alleged contribution to preheat bacon in IR oven was insignificant in quality compared to centrality of preheat in microwave oven; only mention 1 Markush grp but not in exampls.

30) 05/08/2023 22-1363 DCT
[UNITED CANNABIS CORPORATION v. PURE HEMP COLLECTIVE INC.](#) [OPINION] Precedential

Lourie, Cunningham, STARK

Exceptional case §285; attorney fees

TWEET1: UnitedCannabis v PureHemp 5/8 #FedCir affirms denial of atty fees. PH was prevailing party bcz UC's infringmt claim dismissed with prejudice. DCt contrary finding harmless error; case not exceptional bcz dismissed before any DCt fact findings on UC's alleged inequitable conduct.

TWEET2: PH's appeal, as a whole, not frivolous. But "close call"; #FedCir "not pleased" w/ PH's arguments. Circuit "remind[s] counsel of their obligation not to lightly launch attacks on one another's integrity and most certainly not to do so without a sound basis and solid evidence."

31) 05/09/2023 21-1981 PTO
[SANOFI-AVENTIS DEUTSCHLAND GMBH v. MYLAN PHARMACEUTICALS INC.](#) [OPINION] Precedential

Reyna, Mayer, CUNNINGHAM

Obviousness: analogous art—problem to be solved *

TWEET: Sanofi v Mylan 5/9 #FedCir reverses PTAB, resuscitating S drug delivery device patent. Bd erred by agreeing that prior art ref 3 (involving cars) was analogous bcz concerned same problem as prior art ref 1, NOT claimed invention. M's conclusory arg that problems were same fails.

32) 05/09/2023 22-1291 PTO
[BOT M8 LLC v. SONY INTERACTIVE ENTERTAINMENT LLC](#) [OPINION] Precedential

PROST, Reyna, Cunningham

Claim construction; obviousness: motivation to combine

33) 05/23/2023 22-1099 DCT
[ONESUBSEA IP UK LIMITED v. FMC TECHNOLOGIES, INC.](#) [OPINION] Precedential

Moore, CLEVINGER, Dyk

Denial of §285 attorney fees

33.1) 05/18/2023 [AMGEN v. SANOFI](#) (U.S. Supreme Court)

Gorsuch, J. (for a unanimous Court)

Enablement—full scope ***

TWEET: Amgen v Sanofi 5/18/23 #SCOTUS (Gorsuch J) unanimously affirms #FedCir that “vast” full scope of A’s antibody claims not enabled. “The more one claims, the more one must enable.” Same principle as Morse, Incandescent Lamp, & Holland Furniture. #FedCir did not create any new test.

34) 32) 05/24/2023 21-2356 PTO
[MEDTRONIC, INC. v. TELEFLEX INNOVATIONS S.A.R.L.](#) [OPINION] Precedential

Moore, LOURIE, Dyk (Dissent by Dyk)

Pre-AIA Antedating prior art; actual reduction to practice; corroboration

TWEET1: Medtronic v Teleflex 5/24 #FedCir affirms PTAB in 5 IPRs that patentee T did antedate M’s 102(e) primary reference by showing ARP earlier than ref’s critical date. Catheter prototype worked for its intended purpose. “Qualitative” testing sufficient; comparative testing not req’d.

TWEET2: T’s inventors’ testimony on ARP was sufficiently corroborated. We don’t impose an “impossible” standard by requiring that every point of ARP be corroborated by evidence that’s totally independent of the inventors. Such a standard would be the “antithesis of the rule of reason.”

TWEET3: Dyk J dissents from Lourie J’s majority opinion; disputes the sufficiency of T’s corroborating evidence that the RX Guide-Liner prototypes had been tested & shown to work for their intended purpose. T produced “essentially no internal documents” to corroborate prototype testing.

35) 06/05/2023 21-2359 PTO
[MEDTRONIC, INC. v. TELEFLEX INNOVATIONS S.A.R.L.](#) [OPINION] Precedential

MOORE, Lourie, Dyk

Obviousness: motivation to modify prior art, intended purpose of the reference

TWEET: Medtronic v Teleflex 6/5/23 #FedCir upholds T’s guide catheter patent claims as nonobvious. Distinguishes Intel v Qualcomm (2021). Here, PHOSITA not motivated to modify prior art ref to render it inoperable for sole stated purpose. KSR’s “common sense” reasoning works both ways.

36) 06/06/2023 22-1373 PTO
[YITA LLC v. MACNEIL IP LLC](#) [OPINION] Precedential

TARANTO, Stoll, Chen

Nonobviousness; Nexus for secondary considerations evidence *

TWEET: Yita v MacNeil 6/6 #FedCir reverses PTAB, killing M's thermoformed car mat patent. Primary ref taught claim-recited "close conformance" to footwell. M's compelling commercial success didn't overcome p/f case obv. Nexus lacking here bcz conformance was known, even though not well.

37) 06/09/2023 21-2316 DCT
[BLUE GENTIAN, LLC v. TRISTAR PRODUCTS, INC.](#) [OPINION] Precedential

PROST, Chen, Stark

Co-inventorship; §256 inventorship correction

TWEET: BlueGenetian v TriStar 6/9 #FedCir affirms DCt's s256 correction adding non-party R as co-inventor on B's 6 expandable hose patents. Claim construction not a pre-req when no material meaning disputes. R's contribution to conception of a novel 3-"key" element-combo "significant."

38) 06/12/2023 22-1269 PTO
[PARUS HOLDINGS, INC. v. GOOGLE LLC](#) [OPINION] Precedential

LOURIE, Bryson, Reyna

Obviousness; antedating prior art ref; burden of production/explain evidence. Written description.

TWEET1: Parus v Google 6/12 #FedCir affirms P's voice-based web browser patents unpatentable for obviousness. P can't antedate prior art by "throwing mountains of evidence" at Bd without explaining it. Judges aren't buried-truffle-hunting pigs. P had ~3K unused words in its PO response.

TWEET2: PTAB also correct that P's continuation claims reciting "configured to periodically search via one or more networks to identify new web sites and to add the new web sites to the plurality of web sites" NOT entitled to earlier priority date; written description support lacking.

39) 06/14/2023 22-1489 PTO
[In Re COUVARAS](#) [OPINION] Precedential

LOURIE, Dyk, Stoll

Obviousness

TWEET: In re Couvaras 6/14 #FedCir (AL) affirms PTO rejection for obviousness. PHOSITA motivated to co-administer 2 known hypertension treatments to treat hypertension. Unexpected mechanism of action here doesn't overcome p/f case; didn't show unexpected benefit. No failure of others.

40) 06/27/2023 22-1165 PTO
[MEDYTOX, INC. v. GALDERMA S.A.](#) [OPINION] Precedential

Dyk, REYNA, Stark

Enablement; PGR procedure: PTAB change of position

TWEET1: Medytox v Galderma #FedCir affirms PTAB denial in PGR of M's motion to substitute claims reciting "50% or greater" responder rate compared to BOTOX®. Full scope of this 50-100% range NOT enabled. Examples show only 52, 61, & 62%. Amgen: "[t]hemoreoneclaims, themoreonemustenable."

TWEET2: PTAB didn't violate APA or Due Process by changing its claim interpretation in FWD after issuing more patentee-favorable but non-binding Preliminary Guidance (Pilot Program). Not arbitrary/capricious for PTAB to change view after extrinsic (expert w) evidence introduced post-PG.

41) 06/30/2023 21-2348 PTO
[LKQ CORPORATION v. GM GLOBAL TECHNOLOGY OPERATIONS LLC](#) [ORDER] Precedential

En Banc grant

Design patent nonobviousness **

Order vacating 1/20/23 panel opinion and granting rehearing *en banc*. Circuit requests briefing on impact of *KSR* (2007). Did *KSR*'s criticism of "rigid rule[s]" eliminate or otherwise modify the longstanding *Rosen/Durling* analysis for design nonobviousness? What differences between design and utility patents are relevant to the nonobviousness inquiry for designs?

TWEET: Design patent law referendum: #FedCir vacates panel opinion in *LKQ Corp v GM* (1/20/23) & grants rehearing *en banc*. Did *KSR*'s criticism of rigid rules for utility patent nonobviousness modify the *Rosen-Durling* test? Our 2011 view of this "impossible" issue:
<https://uknowledge.uky.edu/cgi/viewcontent.cgi?article=1204&context=klj>

42) 07/05/2023 22-1385 DCT
[INGURAN, LLC v. ABS GLOBAL, INC.](#) [OPINION] Precedential

Lourie, Bryson, REYNA

Claim preclusion/res judicata

TWEET: *Inguran v ABS* 7/5 #FedCir reverses DCt dismissal of "ABS III" lawsuit, asserting 271b inducing infringement. No claim preclusion/res judicata by "ABS I," which asserted only 271a direct infringement. New transactional facts discovered after ABS I. Could not have raised 271b earlier.

43) 07/10/2023 22-1451 PTO
[AXONICS, INC. v. MEDTRONIC, INC.](#) [OPINION] Precedential

Lourie, Dyk, TARANTO

Obviousness; claim interpretation

TWEET: *Axonics v Medtronic* 7/10 #FedCir vacates IPR that had sustained M's claims to a "implantable medical lead." PTAB erred in construing claims as limited to sacral nerve implants. "Present invention" broader. This infected Bd's analysis of motivation to combine & "relevant artisan."

44) 07/12/2023 22-1438 PTO
[In Re FLOAT'N'GRILL LLC](#) [OPINION] Precedential

Prost, LINN, Cunningham

Reissue “original patent requirement”

TWEET1: In re FloatNGrill 7/12 #FedCir affirms PTO that reissue claims to a floating grill support do NOT satisfy s251 original patent reqt. Disclosed plurality of magnets is essential to claimed safely securing a portable grill to float. Can’t broaden to claim nondisclosed alternatives.

TWEET2: Holds: “reissue claims broadening a limitation to cover undisclosed alternatives to a particular feature appearing from the face of the original specification to be a necessary, critical, or essential part of the invention, do not meet the original patent requirement of § 251.”

TWEET3: Satisfaction of s251 original patent requirement demands more than s112 written description compliance (2 independent bases for reissue claim patentability). Test here is not whether original spec would support the reissue claims; “explicit[] & unequivocal[]” disclosure needed.

45) 07/14/2023 22-1260 PTO
[SNIPR TECHNOLOGIES LIMITED v. ROCKEFELLER UNIVERSITY](#) [OPINION] Precedential

CHEN, Wallach, Hughes

AIA; Priority; No more interferences *

TWEET1: SNIPR v RockefellerU 7/14/23 important #FedCir decision on patent priority, reversing PTAB. S’s CRISPR patents filed in 2016 (well after 3/16/2013 AIA first-to-file changeover), “pure AIA patents,” cannot be in an interference w R’s patents filed 2/7/2013 (pure pre-AIA patents).

TWEET2: The technology at issue relates to methods of selectively killing bacteria in a mixed set of bacteria using clustered regularly interspaced short palindromic repeats (CRISPR) gene editing.” Held (Chen J), “the AIA bars pure AIA patents from being subject to an interference.”

TWEET3: PTO erred in applying AIA s3(n) so as to construe old s102(g) and “any unexpired patent” in old s135 to include pure AIA patents (like S’s). Plain language of s3(n) and the AIA’s purpose make this clear. Congress was “dead set” on eradicating interferences for new applications.

46) 07/14/2023 22-1308 DCT
[TRINITY INFO MEDIA, LLC v. COVALENT, INC.](#) [OPINION] Precedential

Stoll, Bryson, CUNNINGHAM

Section 101 patent un-eligible subject matter

TWEET1: Trinity v Covalent 7/14 #FedCir affirms dismissal for s101 un-eligibility. Cites ChargePoint (2019)(“[W]hen analyzing patent eligibility, reliance on the specification must always yield to the claim language in identifying that focus.”) Consistent w/ Phillips (en banc)? But dicta

TWEET2: Full Chargepoint quote: "[W]hile the specification may help illuminate the true focus of a claim, when analyzing patent eligibility, reliance on the specification must always yield to the claim language in identifying that focus." But dicta here bcz ct relies on spec repeatedly.

47) 07/24/2023 22-2217 DCT
[UNITED THERAPEUTICS CORPORATION v. LIQUIDIA TECHNOLOGIES, INC.](#) [OPINION] Precedential

Lourie, Dyk, Stoll

Claim interpretation; Enablement; Written Description; Induced infringement; Anticipation

TWEET1: UnitedTherapeutics v Liquidia 7/24 #FedCir (AL) affirms validity in important method of treatment decision. Claims to therapeutically effective single dose that didn't include safety or efficacy limitations still enabled despite increased mortality for one variant of the disease.

TWEET2: Multiple variants of pulmonary hypertension aren't analogous to multiple species within a claimed chemical compound. Error to "fractionate" a treated disease if patent's claims don't recite its variants. FDA rules on disease-specific safety concerns, not #FedCir.

48) 08/07/2023 22-1532 PTO
[AXONICS, INC. v. MEDTRONIC, INC.](#) [OPINION] Precedential

Lourie, DYK, Taranto

IPR Claim construction; IPR procedure; IPR Estoppel

TWEET1: Axonics v Medtronic 8/7 #FedCir holds when patentee raises new claim construction after IPR institution, petitioner must have notice & opp'ty to respond. PTAB erred by refusing to consider A's Reply arg's (not relying on new prior art). Don't let M game/sandbag to avoid [sic, create] estoppel.

TWEET2: If Patentee had objected to petition's proposed construction & presented a new (2d) construction in Prelim Response that PTAB adopted & did not institute, no 315 estoppel on Petitioner. Here, risk of Pat gaming system by holding back stronger construction, getting FWD & estoppel.

49) 08/11/2023 21-1796 PTO
[REMBRANDT DIAGNOSTICS, LP v. ALERE, INC.](#) [OPINION] Precedential

Moore, Dyk, REYNA

IPR process—proper scope of the petitioner's Reply to PO's Response; no "new theory or evidence."

TWEET: Rembrandt v Alere 8/11 #FedCir affirms PTAB that R's test assay device patent obvious. A's Reply (w expert dec) was properly responsive to R's Response on motivation to combine & a "fair extension" of prior efficiency arguments. No new theories--cited same ref, no new embodiment.

50) 08/16/2023 21-2063 PTO
[INCEPT LLC v. PALETTE LIFE SCIENCES, INC.](#) [OPINION] Precedential

Newman, SCHALL, Taranto (Dissent in part by Newman)

Anticipation; Obviousness

TWEET: Incept v Palette 8/16 #FedCir Newman J dissents-in-part: "The majority appears to hold that, when the broader claim is anticipated, the dependent claims are automatically anticipated. That is not the law. Each claim must be considered as a whole, including all its limitations."

51) 08/24/2023 22-1765 PTO
[VOLVO PENTA OF THE AMERICAS, LLC v. BRUNSWICK CORPORATION](#) [OPINION] Precedential

Moore, LOURIE, Cunningham

Nonobviousness; secondary considerations; nexus requirement *

TWEET1: VolvoP v Brunswick 8/24 #FedCir vacates FWD that V's forward-facing boat stern drive obvious. Although motivation to combine existed, Bd didn't properly analyze objective evidence--ambiguously gave only "some weight" to B's copying & V's great success. B's own docs showed nexus.

TWEET2: This important nonobviousness decision highlights the power of secondary considerations/objective indicia evidence. Also illustrates patentee briefing that was not sufficient to establish nexus under the presumption (though nexus was established by connective evidence of record).

52) 08/28/2023 22-1293 PTO
[In Re CELLECT, LLC](#) [OPINION] Precedential

LOURIE, Dyk, Reyna

Patent Term Adjustment; Double patenting *

TWEET: In re Collect 8/28 #FedCir (AL) affirms PTO in 4 ex parte reexams (Samsung) cancelling C's 4 patents. For family of patents w/ Patent Term Adjustment, use the expiration date *with PTA added* to see which is later-expired, to determine if obviousness-type double patenting exists.

Terminal disclaimer doesn't overcome OTDP here

53) 09/01/2023 22-1387 PTO
[SISVEL INTERNATIONAL S.A. v. SIERRA WIRELESS, INC.](#) [OPINION] Precedential

Moore, Clevenger, CHEN

IPR motion to substitute new claims, improper broadening

TWEET: Sisvel v Sierra 9/1 #FedCir affirms Bd's denial mtn to amend. Proposed substitute telecom claims improperly broadened scope under "broader in any respect" rule. No abuse discretion/legal error in Bd's claim interpretation. Original claims dead (dep claims not separately argued).

54) 09/11/2023 22-1138 PTO
[NETFLIX, INC. v. DIVX, LLC](#) [OPINION] Precedential

Hughes, STOLL, Clark

Nonobviousness—analogous art – field of endeavor

TWEET: Netflix v DivX 9/11 #FedCir: #PTAB abused discretion in ruling N's ReplyBrf didn't identify analogous art "field of endeavor" for D's invention & Kaku reference. Petitioner need not use "magic words." N's briefing made clear that general field of endeavor here = AVI file formats.

55) 09/11/2023 22-1350 PTO
[APPLE INC. v. COREPHOTONICS, LTD.](#) [OPINION] Precedential

STOLL, Linn, Stark

Nonobviousness; claim construction; new ground of rejection

56) 09/15/2023 21-2299 DCT
[COLUMBIA SPORTSWEAR NORTH AMERICA, INC. v. SEIRUS INNOVATIVE ACCESSORIES, INC.](#) [OPINION]
Precedential

PROST, Reyna, Hughes

Design patent infringement--comparison prior art—question of first impression *

TWEET1: Columbia v Seirus 9/15 #FedCir answers q of 1st impression: to qualify as comparison prior art (frame of ref) in a design patent infringement analysis, the prior art design must be applied to the same article of manufacture that design patent claim recites. Judgmt for S vacated.

TWEET2: Impact of S's logo in its accused design? DesignPat vs trademark. No DCt error to instruct jury of Gorham ordinary observer infringmt test & that jury did "not need . . . to find that any purchasers were *actually* deceived or confused by the appearance of the accused products."

57) 09/20/2023 22-1461 DCT
[BAXALTA INCORPORATED v. GENENTECH, INC.](#) [OPINION] Precedential

MOORE, Clevenger, Chen

Enablement; full scope enablement; antibody claims

Affirming Dyk, J. sitting as D. Del. District Court judge

Facts materially indistinguishable from *Amgen* (U.S. 2023)

58) 09/21/2023 21-1985 PTO
[ELEKTA LIMITED v. ZAP SURGICAL SYSTEMS, INC.](#) [OPINION] Precedential

REYNA, Schall, Stark

Obviousness

Affirming PTAB that claims unpatentable as obvious. Motivation to combine prior art teachings and reasonable expectation of success.

59) 10/06/2023 22-1333 PTO
[SCHWENDIMANN v. NEENAH, INC.](#) [OPINION] Precedential

Prost, CLEVINGER, Cunningham

Obviousness; combining refs; motivation to combine; reas expectation success; designating reference as “primary” or “secondary”

TWEET: Schwendimann v Neenah 10/6 #FedCir affirms IPR_FWD that S's 4 inkjet transfer patents obvious over Kronzer in view of Oez. Motivation to combine K's layered sheet w/ O's white pigment to improve transfer onto dark fabrics. PTAB didn't have to explain why K used as "primary" ref.

60) 10/06/2023 22-1493 PTO
[SISVEL INTERNATIONAL S.A. v. SIERRA WIRELESS, ULC](#) [OPINION] Precedential

Moore, Clevenger, CHEN

Obviousness--motivation to combine, what reference teaches; Means plus function claims for software—understood algorithm, *Noah* two types

Summary of precedent--two types of computer-implemented MPF claims as described in *Noah* (Fed. Cir. 2012).

Holding that specification’s explicit reference to protocol names brought case into *Noah* group 2. Board should have considered the knowledge of a skilled artisan to assess whether the protocol name sufficiently disclosed an understood algorithm corresponding to the MPF limitation. Case was indistinguishable from *Atmel*, where the specification’s reference to an article title “alone” was sufficient to permit consideration of expert testimony on its meaning.

61) 10/13/2023 22-1048 DCT
[FINJAN LLC v. SONICWALL, INC.](#) [OPINION] Precedential

Reyna, Bryson, CUNNINGHAM (Dissent in part by Bryson)

Claim construction; Collateral estoppel; Apportionment of damages

62) 10/16/2023 22-1873 DCT
[CYNTEC COMPANY, LTD. v. CHILISIN ELECTRONICS CORP.](#) [OPINION] Precedential

Moore, STOLL, Cunningham

Obviousness; claim interpretation; Damages expert testimony *Daubert*.

TWEET: Cyntec v Chilisin 10/16 useful review of #FedCir excluding unreliable & speculative expert testimony on damages. Jury's \$4.6M lost profits award vacated. Cy expert's importation rate data included many "irrelevant" products/services that didn't incorporate accused molded chokes.

63) 10/16/2023 22-1340 PTO
[COREPHOTONICS, LTD. v. APPLE INC.](#) [OPINION] Precedential

Stoll, Linn, STARK

IPR procedure review; Obviousness—analogue art: PTAB's determination on "same field of endeavor" analogousness affirmed; but PTAB's determination on "pertinent to the problem" analogousness vacated/remanded for more articulation; Permissible scope of IPR Reply Brief

64) 10/19/2023 22-1761 PTO
[ABS GLOBAL, INC. v. CYTONOME/ST, LLC](#) [OPINION] Precedential

Reyna, TARANTO, Stark

Claim construction: singular vs plural; reverse vs. remand.

TWEET: ABS GLOBAL v CYTONOME 10/19 #FedCir: PTAB erred in limiting "the sample stream" of microfluidic device to a singular sample stream; antecedent of "the" is "a" stream and spec expressly said "a" means one or more. Claim 1 anticipated by split-stream prior art; dep claims remanded.

65) 10/25/2023 22-1203 PTO
[NETFLIX, INC. v. DIVX, LLC](#) [OPINION] Precedential

Dyk, Linn, CHEN (Dissent by Dyk, J)

IPR procedure: PTAB's interpretation of petition--which arguments are fairly presented

Affirming PTAB that arguments Netflix now raises on appeal were not clearly raised in its IPR petition.

TWEET1: Netflix v DivX 10/25/23 #FedCir sympathizes with PTAB APJs on challenge of determining which arguments are fairly raised in an IPR petition. Shouldn't have to decode petition to find arguments that aren't clearly made. N's args on appeal weren't clearly raised below —> forfeited.

TWEET2: Netflix is 2-1 decision (Chen J joined by Linn J). Dyk J dissents, contending that Board improperly ignored N's adequately raised arguments as to "filtering" & "retrieving" limitations. He would remand for consideration of those arguments on the merits.

66) 11/01/2023 22-1439 DCT
[MALVERN PANALYTICAL INC. v. TA INSTRUMENTS-WATERS LLC](#) [OPINION] Precedential

PROST, Hughes, Cunningham

Claim construction; plain & ordinary meaning; co-owned patent prosecution history

TWEET1: Malvern v TA Instruments #FedCir 11/1 DCt erred in narrowly interpreting calorimeter's "pipette guiding mechanism" as limited to manual embodiment. Plain & ordinary meaning governs; not a "coined term." Spec silent on manual v automatic. Like Hill-Rom (2014), not Indacon (2016).

TWEET2: Bare listing (in this patent's s257 supplemental exam) of Office Actions from a co-owned but unrelated patent doesn't make the latter's prosecution controlling for claim interptn here. & even if relevant, that prosecution did not make any unambiguous/clear prosecution disclaimer.

67) 11/03/2023 21-1858 DCT
[IN RE PERSONALWEB TECHNOLOGIES LLC](#) [OPINION] Precedential

Lourie, Dyk, REYNA (Dissent by Dyk)

Exceptional case; \$285 attorney fees (\$5.2M affirmed); Kessler doctrine; claim preclusion

68) 11/06/2023 22-1889 DCT
[ACTELION PHARMACEUTICALS LTD v. MYLAN PHARMACEUTICALS INC.](#) [OPINION] Precedential

Reyna, STOLL, Stark

Claim interpretation; numerical terms; rounding; significant digits; consult extrinsic evidence when intrinsic is ambiguous

TWEET: Actelion v Mylan 11/6 #FedCir says "a pH of 13 or higher" may or may not contemplate 12.5 via rounding. Spec & pros history here are ambiguous on # of significant digits. DCt should have consulted extrinsic evidence (eg textbks) offered by parties. AstraZeneca 2021 distinguished.

69) 11/07/2023 22-1706 PTO
[ALLGENESIS BIOTHERAPEUTICS INC. v. CLOUDBREAK THERAPEUTICS, LLC](#) [OPINION] Precedential

MOORE, Stoll, Cunningham

Standing to appeal to Federal Circuit (lacking here)

70) 11/16/2023 22-1721 PTO
[MEDTRONIC, INC. v. TELEFLEX LIFE SCIENCES LIMITED](#) [OPINION] Precedential

LOURIE, Prost, Chen

Pre-AIA antedating a §102(e) reference; conception, diligence, reduction to practice; waiver; incorporation by reference

TWEET: Medtronic v Teleflex 11/16 #FedCir affirms PTAB & upholds T's catheter method. T antedated M's 102(e) ref by earlier conception + diligence. M waived its diligence argument & violated F Cir's word limits by incorporating its diligence argumt by reference from related IPR appeals.

71) 11/21/2023 No. 22-1482 PTO
[PURDUE PHARMA L.P. v. COLLEGIUM PHARMACEUTICAL, INC.](#) [OPINION] Precedential

DYK, Hughes, Stoll

PGR procedure: PTAB decision issued outside statutory deadline

TWEET: PurduePharma v Collegium 11/21 #FedCir affirms PGR decision invalidating P's abuse-deter dosage claims as lacking written description. Q of 1st impression: PTAB didn't lose jurisdiction to issue FWD after statutory deadline passed. No consequences in s326 for missing deadline.

72) 12/04/2023 22-1906 DCT
[VLSI TECHNOLOGY LLC v. INTEL CORPORATION](#) [OPINION] Precedential

Lourie, Dyk, TARANTO

Doctrine of Equivalent infringement; Reasonable royalty damages vacatur *

Two patents, jury found both valid and infringed. FedCir says new trial on one, and reverses jury DOE verdict on other.

TWEET: VLSI v Intel 12/4 important #FedCir doctrine of equivalents case reversing jury infrgmt verdict \$675M. DOE = exception not rule. V's expert testimony re integrated circuit engineer's "design choice" wasn't "remotely sufficient," particularized evidence of substantially same "way."

TWEET2: PLUS vacatur of jury \$1.5B reas royalty award on V's 2d patent; new trial on damages. Non-harmless error in V's expert's damages calculation re dividing up shares of incremental value in Intel's use of V's patented tech over non-infringing alternatives to set royalty.

73) 12/07/2023 22-1194 DCT
[H. LUNDBECK A/S v. LUPIN LTD.](#) [OPINION] Precedential

DYK, Prost, Hughes

Hatch-Waxman Act/ANDA litigation; Section viii carve-out; induced infringement; skinny label *

TWEET: Lundbeck v Lupin 12/7 #FedCir (Dyk J) affirms DDel (Stark) that generic's filing ANDA w Sec viii carve-out does NOT infringe patents claiming other methods of using same antidepressant. Unlike GSK 2021, no ads/promo materials besides skinny label. No evidence of inducing intent.

74) 12/15/2023 22-1548 PTO
[PARKERVISION, INC. v. VIDAL](#) [OPINION] Precedential

Nonobviousness; Claim interpretation; IPR procedure

Prost, Wallach, CHEN

TWEET1: ParkerVision v Vidal 12/15 #FedCir affirms PTAB construction of WLAN's "storage element"; "as used herein" & "refer to" show P's definitional/own lexicographer intent. WDTx special master's narrower construction in related litigations "unduly influenced" by exemplary embodiments.

TWEET2: Nor did PTAB violate APA. No express claim construction of "storage element" in Institution D. PO's Response was first proposed construction. Intel's Reply properly argued its broader construction (though not in its Petition) met by prior art device. Bd didn't "change theories."

75) 12/26/2023 22-2042 DCT

[K-FEE SYSTEM GMBH v. NESPRESSO USA, INC.](#) [OPINION] Precedential

TARANTO, Clevenger, Stoll

Claim interpretation

TWEET: K-Fee v Nespresso 12/26 #FedCir resuscitates K's coffee pod infringement suit. CDCal construed "barcode" too narrowly. K's "decidedly ambiguous" statements re prior art in EPO submission weren't a clear disclaimer of claim scope or a redefinition of ordinary meaning. SJ reversed.