



2023 – Patent Law Year in Review

Corporate IP Roundtable Webinar

January 22, 2024

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Tech Summary

- 1. All attendees will be muted.**
- 2. Only panelists can be seen.**
- 3. Use “Raise your hand” or type “Q&A” in the chat and we’ll either unmute you or read your question or comment**
- 4. Any technical issues, please email:
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Disclaimer

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Today's Topics:

1. **Abstract Ideas – Pretty Clear at this Point?**
2. **Prior Art – The Tradeshow Public Use Trap**
3. **Obviousness – Analogous Art and Motivation to Combine**
4. **Obviousness – Secondary Considerations Make Waves**
5. **Enablement – *Amgen* and The Full Scope of the Claim**
6. **Continuations, Reissues, and Laches – Pitfalls to Watch For**
7. **Claim Construction – Canons of Construction Applied**
8. **Infringement – Doctrine of Equivalents Sinks Huge Verdict**
9. **Design Patents – Infringement and Obviousness**
10. **Inter Partes Reviews – New Developments**

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Abstract Ideas – Mere Use of Computer

Trinity Info Media, LLC v. Covalent Inc., 72 F.4th 1355 (Fed. Cir. 2023)

- Trinity had claims on a “poll-based networking system” which matched two users based on similar answers to polling questions.
- District court granted Covalent’s motion to dismiss, concluding that the patents were directed to the abstract idea of “**matching users who gave corresponding answers to a question.**”

1. A poll-based networking system, comprising:
a data processing system having one or more processors and a memory, the memory being specifically encoded with instructions such that when executed, the instructions cause the one or more processors to perform operations of:
receiving user information from a user to generate a unique user profile for the user;
providing the user a first polling question, the first polling question having a finite set of answers and a unique identification;
receiving and storing a selected answer for the first polling question;
comparing the selected answer against the selected answers of other users, based on the unique identification, to generate a likelihood of match between the user and each of the other users; and
displaying to the user the user profiles of other users that have a likelihood of match within a predetermined threshold.

U.S. Pat. No. 9,087,321

Abstract Ideas – Mere Use of Computer

Trinity Info Media, LLC v. Covalent Inc., 72 F.4th 1355 (Fed. Cir. 2023)

- Trinity hit every technical argument they could:
 - We use unique identifiers...
 - We use servers...
 - We use parallel processing...
 - We use databases...
 - Our claim is for handheld devices...
 - Our system is special purpose, novel...

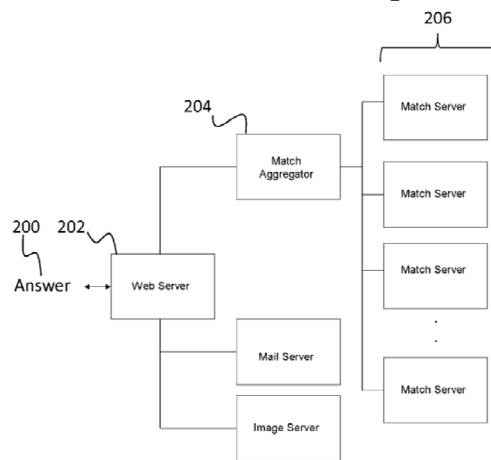


FIG. 3

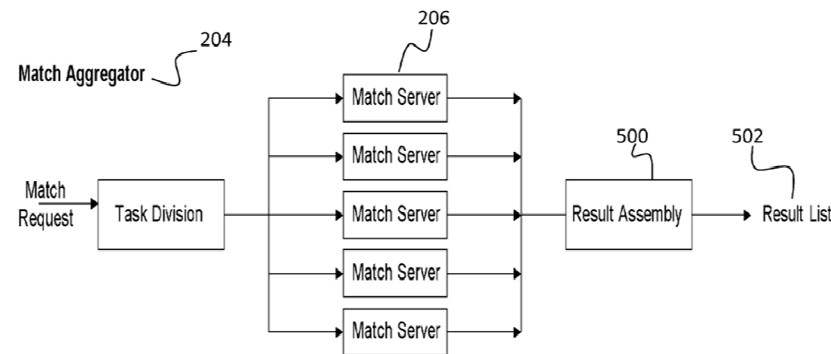


FIG. 5

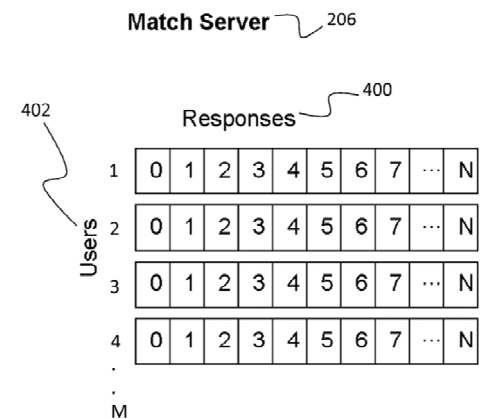


FIG. 4

Abstract Ideas – Mere Use of Computer

Trinity Info Media, LLC v. Covalent Inc., 72 F.4th 1355 (Fed. Cir. 2023)

- Federal Circuit agreed with the district court:
 - The claims were focused on “collecting information, analyzing it, and displaying certain results” which is a frequent pattern in cases found ineligible as directed to abstract ideas.
 - The Federal Circuit observed that the specification “frame[d] the inventor's problem in terms of how to improve existing polling systems by performing progressive polling, not how to improve computer technology.”
- Two notes on early resolution of § 101:
 - Trinity argued construction was required before a § 101 judgment.
 - But Trinity failed to identify any claim construction issues that would move the needle on § 101.
 - Trinity argued that D.Ct. failed to consider allegations in the complaint that the features were not conventional.
 - But conclusory allegations that the prior art is missing elements are insufficient to demonstrate an inventive concept.

Abstract Ideas – Mere Use of Computer

Sanderling Management Ltd. v. Snap Inc., 65 F.4th 698 (Fed. Cir. 2023)

- Abstract Idea?
 - Providing information based on meeting a condition.
 - Here, providing an image processing function based on matching a GPS location indication with a geographic location.
- Inventive Concept?
 - The distribution rule is just the application of the abstract idea using common computer components.
 - Benefits from the claimed technology come from the abstract idea, not from improvements to computing technology.
- Hail Mary?
 - But the USPTO said the claimed inventions improve mobile device technology itself!
 - D.Ct. properly considered prosecution history and accounted for presumption of validity. Courts are not required to defer to PTO determinations on eligibility.

Abstract Ideas – It's About How

Hawk Tech. Sys., LLC v. Castle Retail, LLC, 60 F.4th 1349 (Fed. Cir. 2023)

- Hawk Tech asserted a patent relating to a method for viewing multiple simultaneous videos from surveillance system against a grocery store owner (Castle) who allegedly used the technology in its security surveillance video operations.
- The district court granted a motion to dismiss, finding the claims were directed to the abstract idea of storing and displaying video and did not provide an inventive step that transformed the abstract idea into patent-eligible subject matter.

1. A method of viewing, on a remote viewing device of a video surveillance system, multiple simultaneously displayed and stored video images, comprising the steps of: receiving video images at a personal computer based system from a plurality of video sources, wherein each of the plurality of video sources comprises a camera of the video surveillance system; digitizing any of the images not already in digital form using an analog-to-digital converter; displaying one or more of the digitized images in separate windows on a personal computer based display device, using a first set of temporal and spatial parameters associated with each image in each window; converting one or more of the video source images into a selected video format in a particular resolution, using a second set of temporal and spatial parameters associated with each image; contemporaneously storing at least a subset of the converted images in a storage device in a network environment; providing a communications link to allow an external viewing device to access the storage device; receiving, from a remote viewing device remotely located remotely from the video surveillance system, a request to receive one or more specific streams of the video images; transmitting, either directly from one or more of the plurality of video sources or from the storage device over the communication link to the remote viewing device, and in the selected video format in the particular resolution, the selected video format being a progressive video format which has a frame rate of less than substantially 24 frames per second using a third set of temporal and spatial parameters associated with each image, a version or versions of one or more of the video images to the remote viewing device, wherein the communication link traverses an external broadband connection between the remote computing device and the network environment; and displaying only the one or more requested specific streams of the video images on the remote computing device.

Abstract Ideas – It's About How

Hawk Tech. Sys., LLC v. Castle Retail, LLC, 60 F.4th 1349 (Fed. Cir. 2023)

- Figure 3 of the patent shows a video surveillance system “in accordance with the invention” that has multiple cameras 302, broadband connection 310, a server 312, and a monitor control system 314.
- In this configuration, the signals from the cameras are transmitted as streaming sources at relatively low data rates and variable frame rates via a broadband connection.
- This results in reduced costs to the user, lower memory storage requirements, and the ability to handle a larger monitoring application (due to bandwidth efficiency).
- This configuration, the patent notes, uses “existing broadband infrastructures” and a “generic PC-based server.”

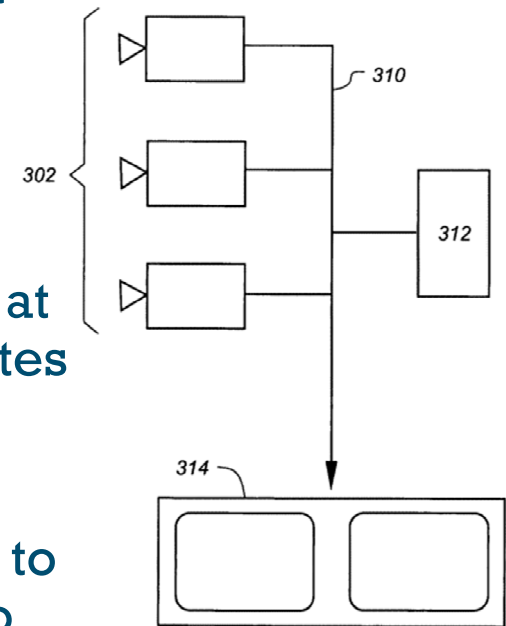


Fig - 3

U.S. Pat. No. 10,499,091

Abstract Ideas – It's About How

Hawk Tech. Sys., LLC v. Castle Retail, LLC, 60 F.4th 1349 (Fed. Cir. 2023)

- D.Ct. – “even using Hawk’s description of the limitations, it is not clear how the claims do more than take video surveillance and digitize it for display and storage in a conventional computer system.”
- Although Hawk identified the “temporal and spatial parameters” as the inventive concept and argued that “converting the data using” those “parameters” changes the nature of the data, neither the claims nor the specification “explain what those parameters are or how they should be manipulated.”
- A-to-D converters, computer based systems, conversion parameters and frame rate are all conventional features as generically used in the patent.

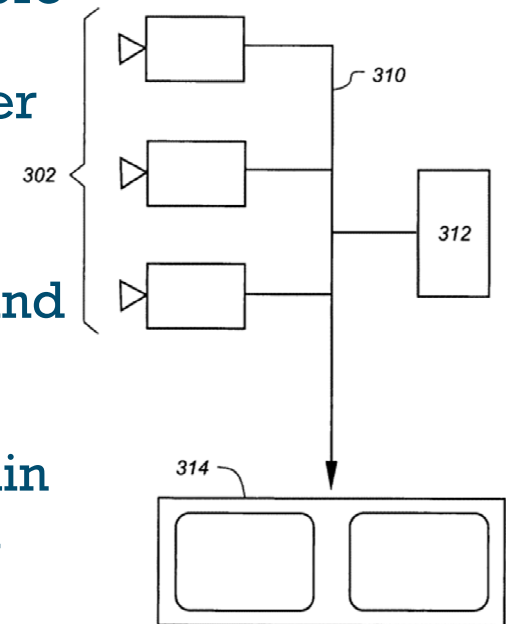


Fig - 3

U.S. Pat. No. 10,499,091

Abstract Ideas – It's About How

Hawk Tech. Sys., LLC v. Castle Retail, LLC, 60 F.4th 1349 (Fed. Cir. 2023)

- Federal Circuit agreed with D.Ct.
 - Claims directed to abstract idea of storing and displaying video.
 - Claims are written using “result-based functional language.”
 - “The claims themselves do not disclose performing any ‘special data conversion’ or otherwise describe how the alleged goal of ‘conserving bandwidth while preserving data’ is achieved.”
 - “Stated otherwise, the ’091 patent claims lack ‘sufficient recitation of how the purported invention improve[s] the functionality’ of video surveillance systems and are ‘recited at such a level of result-oriented generality that those claims amount[] to a mere implementation of an abstract idea.’”
 - The claims also failed at Alice step two, since they only use generic functional language and recite conventional computer and network components, and the claims did not specify what the parameters are and at best they relate to abstract data manipulation – image formatting and compression.

“Transitory” Computer Readable Media

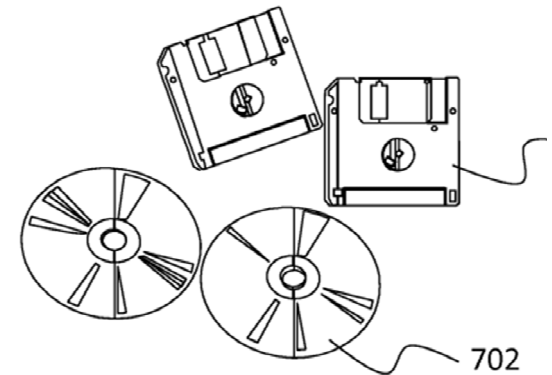
Sequoia Tech. LLC v. Dell Techs., Inc., 66 F.4th 1317 (Fed. Cir. 2023)

- District Court construed “computer-readable recording medium storing instructions” as including transitory media (i.e. ineligible signals or waves).
 - Specification discussed “computer readable medium” as “including” various items (none of which were transitory), but D.Ct. saw list as open for media that could be transitory.
- Federal Circuit reverses, finding the claim term cannot encompass transitory media.
 - A POSA would not understand a transitory signal to record or store instructions in memory.
 - The specification further supported this conclusion because it only disclosed non-transitory media.
 - Open-ended “including” did not mean the claim could encompass transitory media in context of entire patent.

“Transitory” Computer Readable Media

Sequoia Tech. LLC v. Dell Techs., Inc., 66 F.4th 1317 (Fed. Cir. 2023)

- Are CRM claims safe now?
 - Claim recited a “computer-readable recording medium storing instructions” rather than a “computer readable medium.”
 - Many other patent specifications include boilerplate language that may imply signals are within the scope of CRM terms.
 - Fed. Cir. explains that prior cases finding CRM terms included signals involved express definitions including, e.g., carrier waves.
 - In prior cases, Fed. Cir. says they “did not address the situation where, as here, the patentee did not expressly define CRM to include carrier waves or other transitory signals.”
 - Check your boilerplate!
 - Fed. Cir. distinguishes USPTO policy based on broadest reasonable interpretation vs plain and ordinary meaning.
 - So don’t expect any changes in prosecution, yet.



*see Trinity Info Media, *supra*

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Prior Art – Public Use Without “Use”

Minerva Surgical Inc. v. Hologic Inc., 59 F.4th 1371 (Fed. Cir. 2023)

- Patent-in-suit involved surgical devices for use in an endometrial ablation procedure.
 - Part of a long running patent battle, including a SCOTUS case last year on assignor estoppel.
- Minerva had presented its “Aurora” device at a conference in 2009 (the “Super Bowl” of the industry), before the critical date.
 - The Aurora device arguably embodied key claim limitations relating to the materials of the inner and outer elements of the device (“substantially different material properties”)
 - The 2009 trade show was open to the public and there were no confidentiality obligations placed on attendees.
 - Minerva disclosed fifteen fully functioning Aurora devices over several days at a booth, in meetings, and in a technical presentation.



Prior Art – Public Use Without “Use”

Minerva Surgical Inc. v. Hologic Inc., 59 F.4th 1371 (Fed. Cir. 2023)

- District court granted summary judgment that the asserted claims were anticipated under the pre-AIA public use bar.
- Two requirements for public use:
 - The invention was accessible to the public or was commercially exploited by the inventor; and
 - The invention was ready for patenting, through reduction to practice or sufficiently specific descriptions of the invention.

Prior Art – Public Use Without “Use”

Minerva Surgical Inc. v. Hologic Inc., 59 F.4th 1371 (Fed. Cir. 2023)

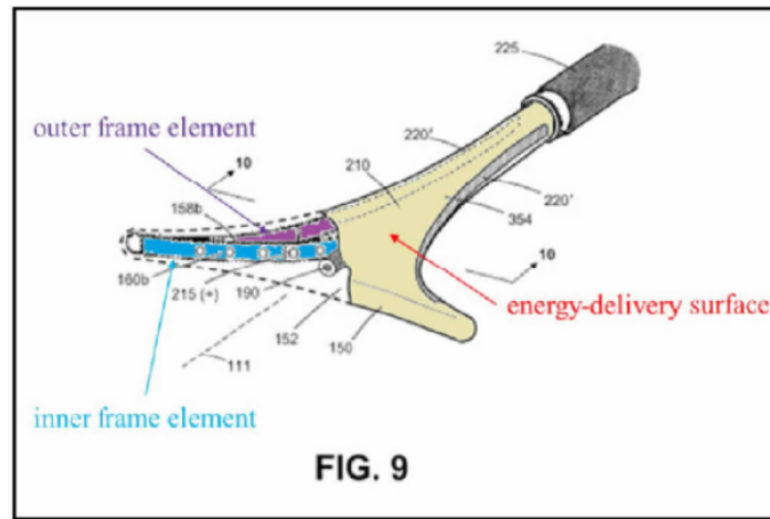
- Minerva argued that the disclosure of the Aurora device was not public use because Minerva merely displayed the device.
- Federal Circuit rejected this argument:
 - Minerva pitched the Aurora device to sophisticated industry members who were able to scrutinize the device closely and see how it operated as reflected in comments Minerva received.
 - While Minerva disputed whether attendees “handled” the device, the public use bar is not predicated on a device being physically handled, and instead was met here because the display allowed a member of the public to recognize and understand the technology and invention.



Prior Art – Public Use Without “Use”

Minerva Surgical Inc. v. Hologic Inc., 59 F.4th 1371 (Fed. Cir. 2023)

- Similarly, Fed. Cir. rejected arguments that the Aurora device did not meet the material claim limitations or that it was ready for patenting.
 - No genuine dispute of fact that SDMP features had been conceived prior to conference and reduced to practice in the prototypes brought to conference, even if not ready for “live human” use or FDA approvals.



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Obviousness – Motivations to Combine

Sisvel Int’l S.A. v. Sierra Wireless, Inc. 82 F.4th 1355 (Fed. Cir. 2023).

- Sisvel’s patent related to channel coding when transmitting data in radio systems, adding redundant information to a data block to account for noise and interference.
- The patent-in-suit used link adaptation and incremental redundancy to improve on prior channel coding techniques.
- Sierra Wireless filed an IPR, arguing a combination of references rendered the patent obvious.
- PTAB found in favor of some obviousness grounds over one reference, but rejected other grounds combining references due to a lack of motivation to combine.



MOTIVATION

Obviousness – Motivations to Combine

Sisvel Int’l S.A. v. Sierra Wireless, Inc. 82 F.4th 1355 (Fed. Cir. 2023).

- Sierra Wireless presented ten reasons for combining Chen and GSM, but none provided “an articulated reason with a rational underpinning to combine the respective teachings of the references.”
 - “[Sierra’s] proposed combinations and rationales were expressed at such a non-specific, high level of generality, [that] they never made clear to the Board what portions of the references were being combined and why a skilled artisan would identify those particular elements for a combination.”
 - Arguments merely asserting that the references were analogous art were insufficient motivation to combine.
 - Petition did not explain which reference is the primary vs secondary reference, what elements are missing from the primary reference, what elements should be added from the secondary reference to reach the claimed invention, or why those particular elements would be obvious to add.
 - Petition was inconsistent in whether Chen was used to improve GSM, or the other way around.
- Clearly articulated motivation to combine is a key part of an obviousness argument.

Analogous Art – Solutions Worth Trying

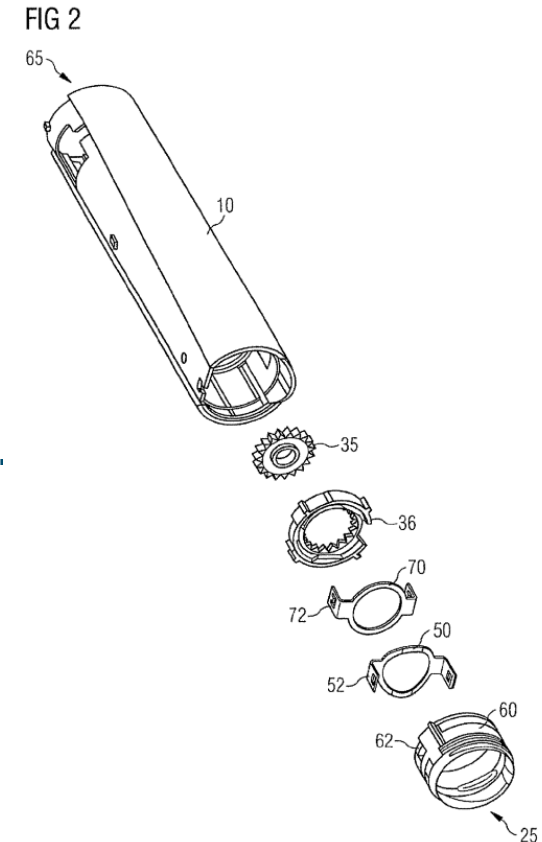
Sanofi-Aventis Deutschland GmbH v. Mylan Pharms. Inc., 66 F.4th 1373 (Fed. Cir. 2023)

- Mylan filed an IPR petition challenging claims in a patent related to a drug delivery device as unpatentable as obvious.
- Mylan’s petition relied on a combination of three prior art references Burren, Venezia and de Gennes.
 - Mylan sought to combine Burren with Venezia to teach the use of spring washers within drug delivery devices, and relied on de Gennes to add “snap-fit engagement grips” to secure the spring washer.
 - Mylan argued in its petition that although de Gennes concerned a clutch bearing in automobiles, it addresses “a problem analogous to that addressed in *Burren*....”
- PTAB found all challenged claims unpatentable for obviousness after finding that the de Gennes patent was analogous prior art because it was reasonably pertinent to the problem faced by the inventor of the challenged patents.

Analogous Art – Solutions Worth Trying

Sanofi-Aventis Deutschland GmbH v. Mylan Pharms. Inc., 66 F.4th 1373 (Fed. Cir. 2023)

- Two tests define the scope of analogous prior art:
 1. Whether the art is from the same field of endeavor, regardless of the problem addressed, and
 2. If the reference is not within the field of the inventor's endeavor, whether the reference still is reasonable pertinent to the particular problem with which the inventor is involved.
- The problem being examined must not be defined so narrowly as to collapse these inquiries and only consider art within the inventor's field of endeavor.
- But key here is the focus on the inventor's field of endeavor.



Analogous Art – Solutions Worth Trying

Sanofi-Aventis Deutschland GmbH v. Mylan Pharms. Inc., 66 F.4th 1373 (Fed. Cir. 2023)

- Federal Circuit reversed, finding that de Gennes was not analogous prior art.
 - Federal Circuit explained that in evaluating whether a reference is analogous requires comparing the reference **to the challenged patent and the problems it faced**.
 - The evaluation does not allow a fact finder to focus on the problems contained in other prior art references to the exclusion of the problem of the challenged patent.
 - Because Mylan argued that de Gennes is analogous to another prior art reference and not the challenged patent, Mylan did not meet its burden to establish obviousness premised on de Gennes.
- Fed. Cir. noted that Mylan could have responded to this points in the Petitioner's Reply, but instead Mylan focused only on how de Gennes would be used to solve the prior art's shortcomings.
 - This differs from KSR rationales, since it is about what can be considered prior art.

Analogous Art – Solutions Worth Trying

Elekta Ltd. v. Zap Surgical Sys., Inc., 81 F.4th 1368 (Fed. Cir. 2023)

- Elekta appealed from a final written decision of the PTAB finding claims of a challenged patent unpatentable as obvious.
 - The challenged patent claimed a device for treating a patient with ionizing radiation for certain types of radiosurgery and radiation therapy.
 - Elekta argued in the IPR that a skilled artisan would not have been motivated to combine prior art references disclosing radiation *imaging* with references disclosing radiation *therapy*.
 - The Board rejected the argument and concluded that a skilled artisan would have been motivated to combine the references. Elekta challenged the Board's findings on appeal.

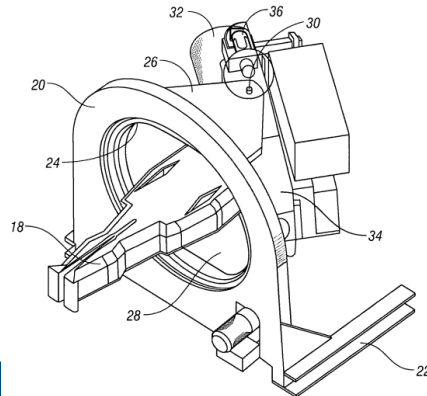


FIG. 5

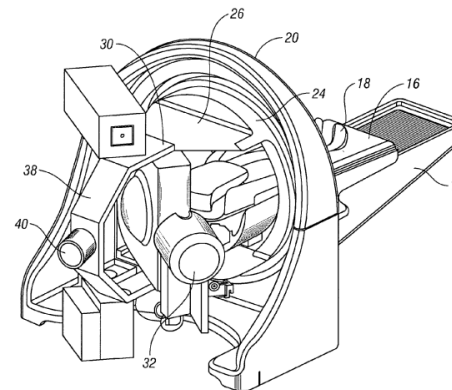


FIG. 7

Analogous Art – Solutions Worth Trying

Elekta Ltd. v. Zap Surgical Sys., Inc., 81 F.4th 1368 (Fed. Cir. 2023)

- Federal Circuit affirmed, finding the Board's motivation to combine finding was supported by substantial evidence.
 - Board's decision was supported by the prosecution history of the challenged patent, the teaching of the asserted prior art, and the expert testimony of record.
 - The court emphasized that the prosecution history cited references directed to imaging devices and the patentee did not argue that those prior art references were not relevant art.
 - See practice point discussion re IDS filings.
 - Two prior art references of record also taught the advantages of combining radiation imaging with the delivery of radiation.
 - And the petitioner's expert opined as to what would motivate a skilled artisan to make the proposed combination – reducing the patient's exposure to radiation.

Practice Point? – Admissions in IDSs

Eleкта Ltd. v. Zap Surgical Sys., Inc., 81 F.4th 1368 (Fed. Cir. 2023)

- Fed. Cir. expressly noted that the applicant did not argue that imaging references were not analogous art in case about therapeutic treatments during prosecution.
- Industry bloggers realized the offending art was actually cited by patentee during prosecution in an IDS, and discussed potential best practices to avoid admissions/disclaimer.

How Prosecution History Can Support a Motivation to Combine

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- Consider whether to file statements with IDSs and in responses disclaiming any admission that references are analogous art.
- But many other factors at play here, so be careful about extrapolating a general rule.
 - Federal Circuit may have been more convinced by the other findings – particularly the finding that the references themselves established that the two fields were analogous.

<https://patentlyo.com/patent/2023/09/prosecution-history-motivation.html>

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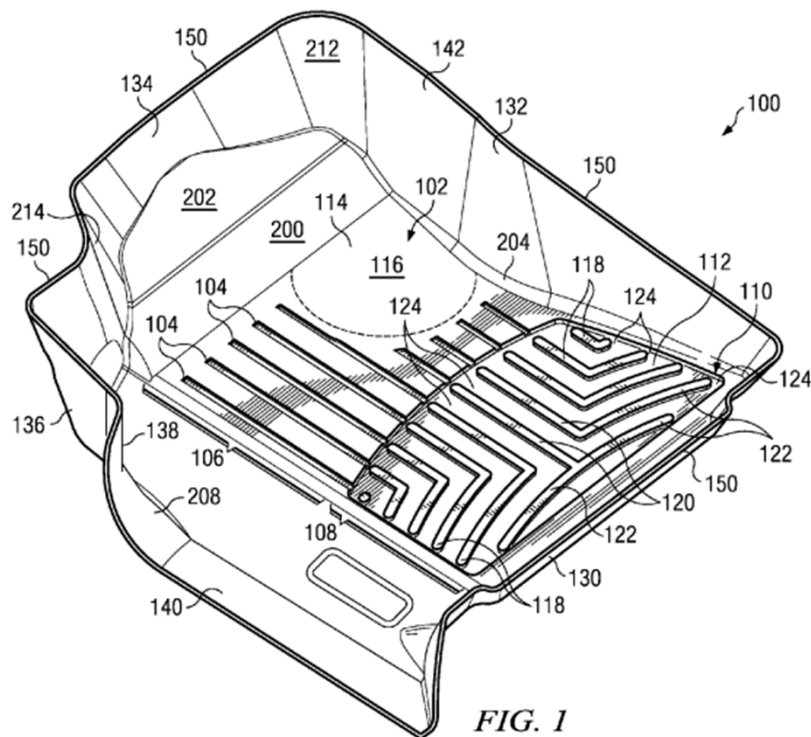
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Secondary Considerations of Nonobviousness

Yita LLC v. MacNeil IP LLC, 69 F.4th 1356 (Fed. Cir. 2023)

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Auto. Home. Pet. Find Your Fit.



Secondary Considerations of Nonobviousness

Yita LLC v. MacNeil IP LLC, 69 F.4th 1356 (Fed. Cir. 2023)

- PTAB issued final written decision holding claims 1-7 not unpatentable for obviousness
- Board found strong evidence of secondary considerations overcame *prima facie* case of obviousness
- Yita appealed, arguing the Board erred in finding a nexus

Secondary Considerations of Nonobviousness

Yita LLC v. MacNeil IP LLC, 69 F.4th 1356 (Fed. Cir. 2023)

- Secondary considerations must have a “legally and factually sufficient connection (nexus) to the claimed invention
- Nexus presumed when a commercial product “is the invention disclosed and claimed in the patent”
- Objective evidence lacks a nexus if it exclusively relates to a feature known in the prior art

Secondary Considerations of Nonobviousness

Yita LLC v. MacNeil IP LLC, 69 F.4th 1356 (Fed. Cir. 2023)

- Board found secondary-consideration evidence related ***exclusively*** to “close-conformance limitation” – laser fit
- Board also found that ***prior art*** disclosed the “close-conformance limitation”
- Board’s nexus finding rested on legal error and was not supported
- Federal Circuit reversed PTAB

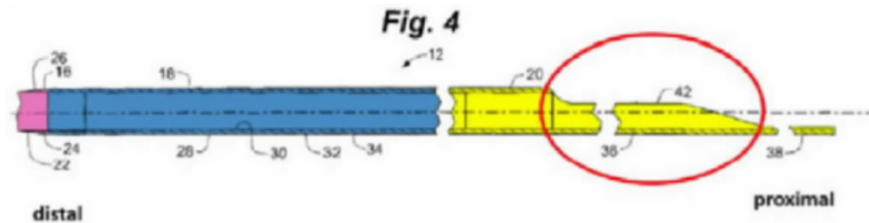
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Secondary Considerations of Nonobviousness

Medtronic, Inc. v. Teleflex Innovations S.A.R.L., 70 F.4th 1331 (Fed. Cir. 2023)

- Teleflex patent related to a extension guide catheter
- Three main parts:
 - Rigid portion (yellow)
 - Reinforced portion (blue)
 - Distal flexible tip (pink)
- “Side opening” (red circle)
 - Permits catheter to receive and deliver interventional cardiological device while within a guide catheter



Secondary Considerations of Nonobviousness

Medtronic, Inc. v. Teleflex Innovations S.A.R.L., 70 F.4th 1331 (Fed. Cir. 2023)

- Medtronic filed IPR petitions challenging “side opening” claims in three Teleflex patents
- The Board found the “side opening” claims were not shown unpatentable for obviousness
- “Close case” of obviousness
- Board found Teleflex’s strong objective evidence overcame *prima facie* case of obviousness

Secondary Considerations of Nonobviousness

Medtronic, Inc. v. Teleflex Innovations S.A.R.L., 70 F.4th 1331 (Fed. Cir. 2023)

- Federal Circuit addressed nexus to the “side opening claims”
- Undisputed that presumption of nexus applies because GuideLiner product “is the invention disclosed and claimed in the patents-in-suit

Secondary Considerations of Nonobviousness

Medtronic, Inc. v. Teleflex Innovations S.A.R.L., 70 F.4th 1331 (Fed. Cir. 2023)

- Presumption of nexus may be rebutted by showing the objective evidence resulted from features known in the prior art
- The Board found that the GuideLiner product's success based on combination of features
- No error in the Board's finding
 - Medtronic showed every claim element *individually* known in the prior art
 - ***But, combination*** of GuideLiner features not known in the prior art

Secondary Considerations of Nonobviousness

Medtronic, Inc. v. Teleflex Innovations S.A.R.L., 70 F.4th 1331 (Fed. Cir. 2023)

- Medtronic also appealed the Board's finding that Medtronic copied the GuideLiner products
- Board found copying based on:
 - (1) Medtronic's access to GuideLiner, and
 - (2) "direct evidence" Medtronic copied "a portion" of the GuideLiner device
- Medtronic argued that the Board's copying finding should be reversed because:
 - (1) no "evidence of actual copying" and
 - (2) inferring copying based on similarity is legal error

Secondary Considerations of Nonobviousness

Medtronic, Inc. v. Teleflex Innovations S.A.R.L., 70 F.4th 1331 (Fed. Cir. 2023)

- Federal Circuit rejected Medtronic's arguments:
 - “Evidence of access and substantially similarity *is* evidence of copying.”
 - Our case law has never drawn a distinction between “direct” evidence and “circumstantial” evidence for proving copying
 - Sufficient circumstantial evidence supported Board's finding of copying



Secondary Considerations of Nonobviousness

Medtronic, Inc. v. Teleflex Innovations S.A.R.L., 70 F.4th 1331 (Fed. Cir. 2023)

- Secondary Consideration findings not challenged:
 - Commercial Success –
 - Teleflex’s licenses had essentially 100% of the market
 - Medtronic’s internal documents state GuideLiner created the market
 - Industry Praise/Long-felt need
 - GuideLiner “elegant method to overcome” problems the industry previously considered “impossible”
 - Copying
 - Multiple competitors copied GuideLiner

Secondary Considerations of Nonobviousness

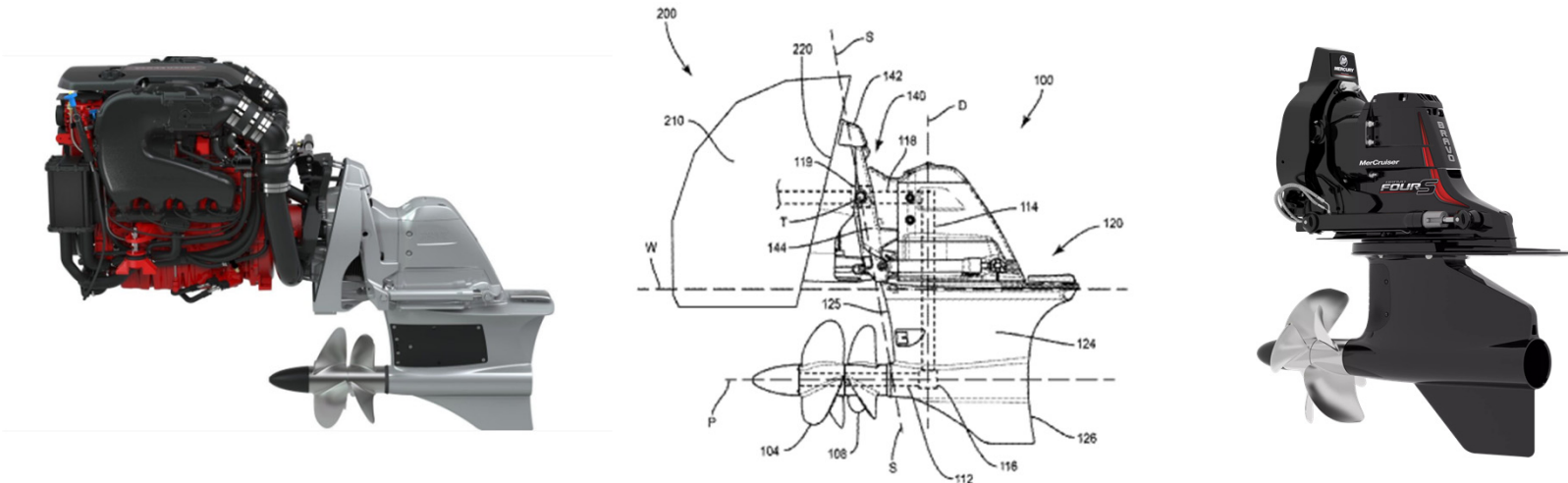
Medtronic, Inc. v. Teleflex Innovations S.A.R.L., 70 F.4th 1331 (Fed. Cir. 2023)

- Federal Circuit affirmed “side opening” claims not shown unpatentable:
- “While we have acknowledged ‘[a] strong case of prima facie obviousness ... cannot be overcome by a far weaker showing of objective indicia of nonobviousness,’ ..., this case presents the opposite scenario. The Board found Medtronic presented a ‘close’ *prima facie* case, but that showing was overcome by Teleflex’s ‘strong’ objective evidence.”

Secondary Considerations of Nonobviousness

Volvo Penta of the Americas, LLC v. Brunswick Corp., 81 F.4th 1202 (Fed. Cir. 2023)

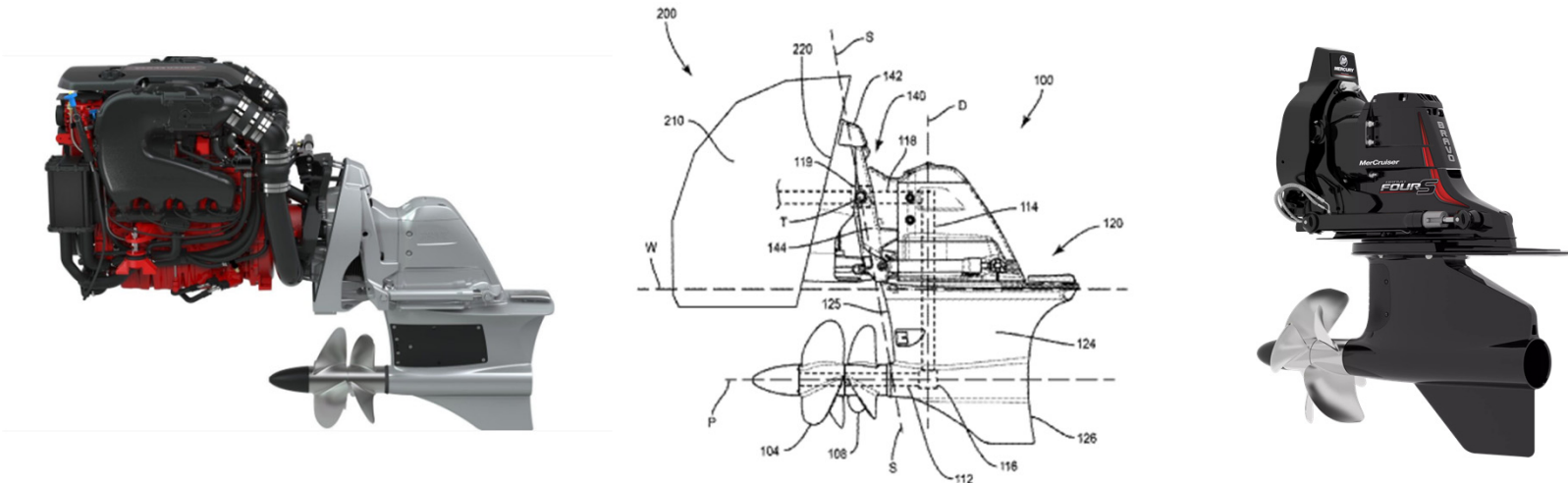
- Volvo Penta's patent related to a tractor-type stern drive for a boat unpatentable
- Forward facing propeller that pulls boat through the water
- Undisputed both parties commercial products embodied the patent
 - Volvo Penta - Forward Drive launched 2015
 - Brunswick - Bravo Four S launched 2020



Secondary Considerations of Nonobviousness

Volvo Penta of the Americas, LLC v. Brunswick Corp., 81 F.4th 1202 (Fed. Cir. 2023)

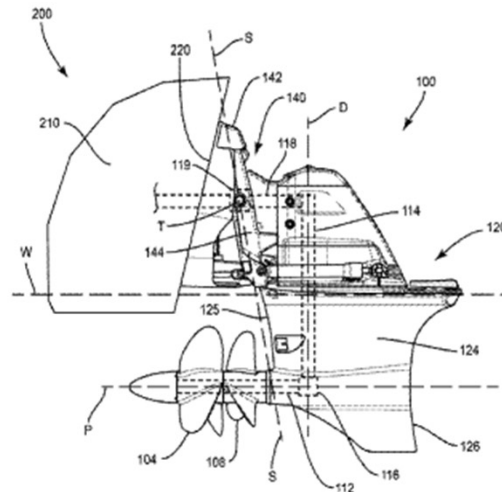
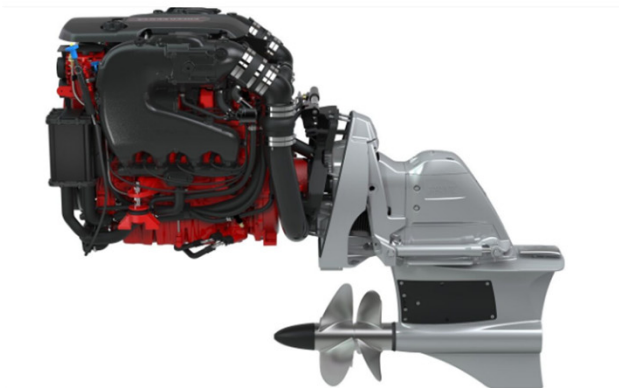
- Brunswick filed an IPR petition that day it launched Bravo Four motor alleging all claims were unpatentable for obviousness
- Volvo Penta responded arguing:
 - No motivation to combine the reference with reasonable expectation of success
 - Objective indicia of nonobviousness overcame any *prima facie* case of obviousness



Secondary Considerations of Nonobviousness

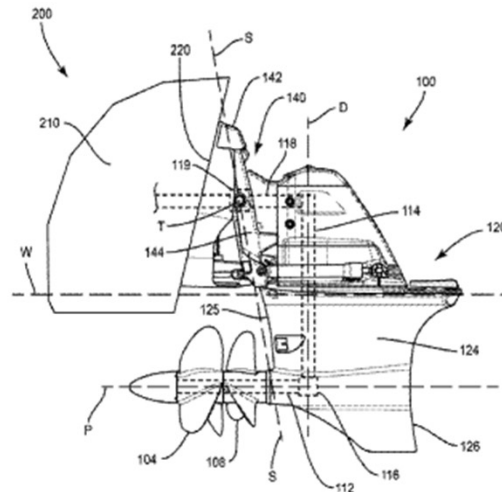
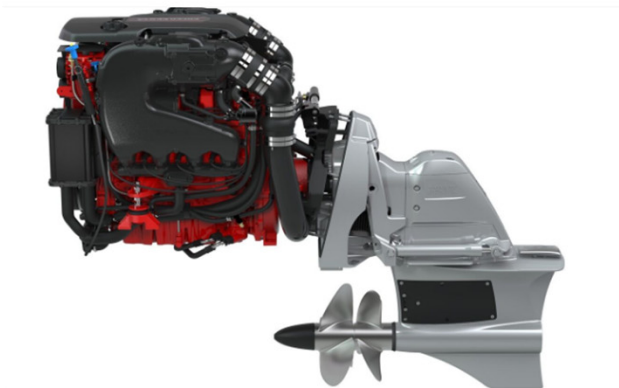
Volvo Penta of the Americas, LLC v. Brunswick Corp., 81 F.4th 1202 (Fed. Cir. 2023)

- Board found all claims unpatentable for obviousness
 - Found motivation to combine based on statement in prior art and Volvo Penta employee testimony
 - No **presumption** of nexus because Volvo Penta did not make sufficient arguments of coextensiveness
 - No showing of nexus – failed to identify unique characteristics or merits of the claimed invention



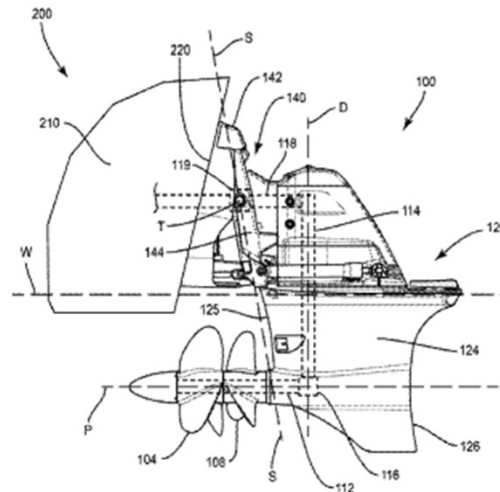
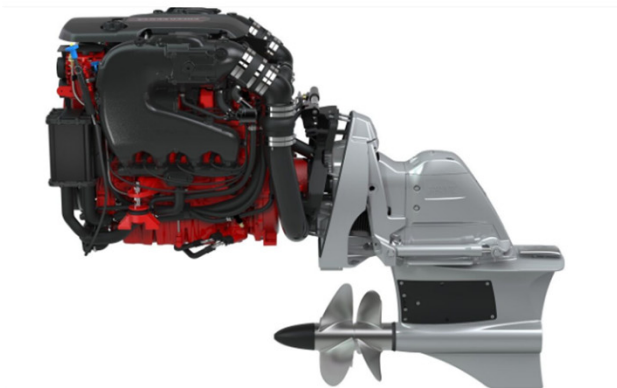
Secondary Considerations of Nonobviousness

- **Volvo Penta argued the Board erred:**
 - Finding motivation to combine references
 - Finding Volvo Penta did not demonstrate a nexus
 - Failing to properly weigh secondary considerations
- **Federal Circuit vacated and remanded**
 - Board erred in finding no nexus
 - Board erred in considering objective evidence



Volvo Penta of the Americas, LLC v. Brunswick Corp., 81 F.4th 1202 (Fed. Cir. 2023)

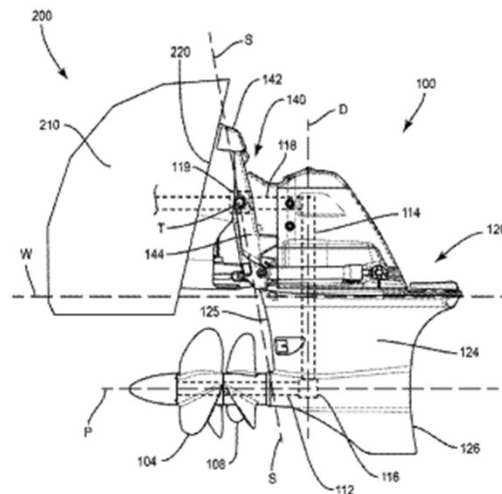
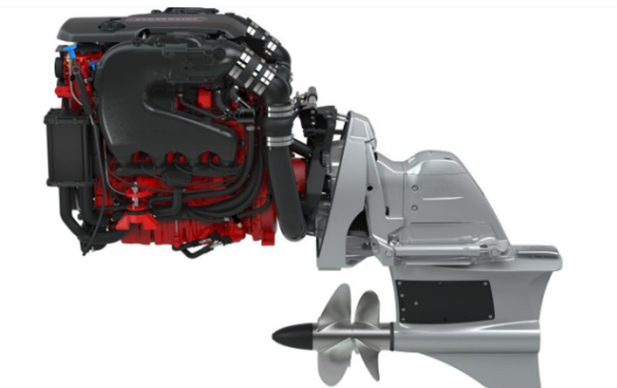
- Federal Circuit explained nexus standard:
 - “A showing of nexus can be made in two ways: (1) via a presumption of nexus, or (2) via a showing that the evidence is a direct result of the unique characteristics of the claimed invention.”
 - “A patent owner is entitled to a presumption of nexus when it shows that the asserted objective evidence is tied to a specific product that “embodies the claimed features, and is *coextensive with them*.”



Secondary Considerations of Nonobviousness

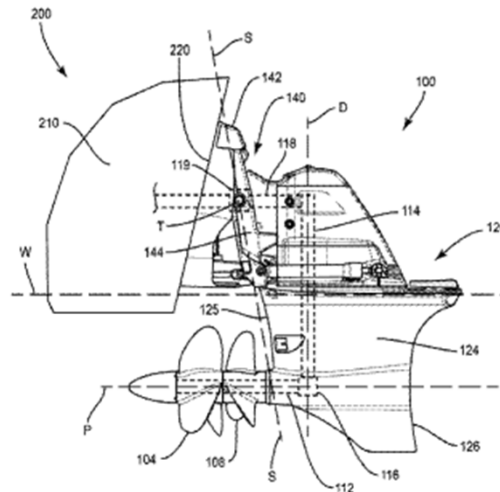
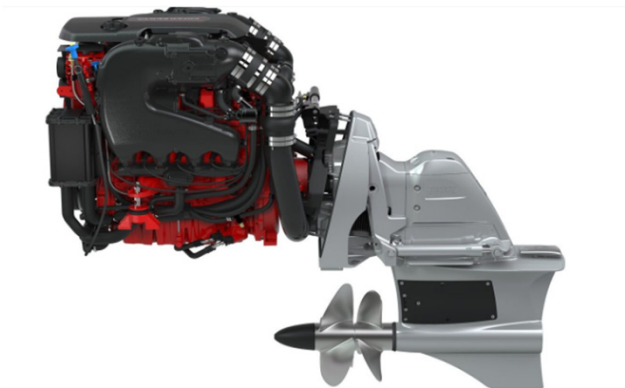
Volvo Penta of the Americas, LLC v. Brunswick Corp., 81 F.4th 1202 (Fed. Cir. 2023)

- CAFC vacated and held that Volvo Penta demonstrated a nexus
 - Board ignored crux of Volvo Penta’s argument that the “steerable tractor-type drive” drove success of commercial products
 - Benefits of forward-facing drive valuable for wake-surfing
 - Boat makers strongly desired Forward Drive motor and encouraged Brunswick to enter market
 - Brunswick’s Bravo Four S development guided by Forward Drive – akin to copying



Volvo Penta of the Americas, LLC v. Brunswick Corp., 81 F.4th 1202 (Fed. Cir. 2023)

- CAFC found the PTAB erred by giving “some weight” to copying, industry praise, and commercial success
- Board’s findings were not supported by substantial evidence
 - Copying occurred and is usually considered “strong evidence of nonobviousness”
 - Commercial success undisputed and Volvo Penta created the market
 - Industry praised motor as “radical,” “game-changing,” started a “revolution”



Today's Topics:

1. **Abstract Ideas – Pretty Clear at this Point?**
2. **Prior Art – The Tradeshow Public Use Trap**
3. **Obviousness – Analogous Art and Motivation to Combine**
4. **Obviousness – Secondary Considerations Make Waves**
5. **Enablement – *Amgen* and The Full Scope of the Claim**
6. **Continuations, Reissues, and Laches – Pitfalls to Watch For**
7. **Claim Construction – Canons of Construction Applied**
8. **Infringement – Doctrine of Equivalents Sinks Huge Verdict**
9. **Design Patents – Infringement and Obviousness**
10. **Inter Partes Reviews – New Developments**

Enablement – Full Scope of the Invention

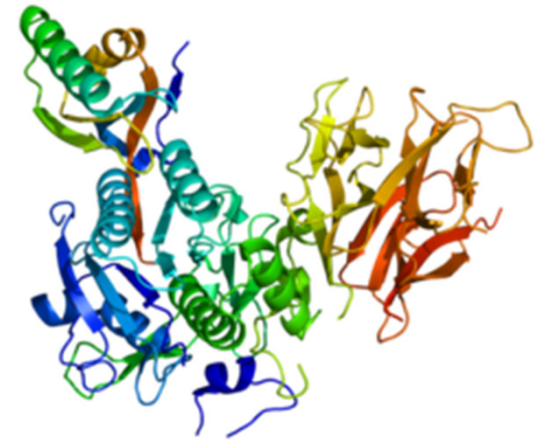
Amgen Inc. v. Sanofi, 143 S.Ct. 1243 (2023)

- The Supreme Court clarified the legal standard applicable to determining whether patent claims are sufficiently enabled under 35 U.S.C. § 112(a).
 - The specification shall contain a **written description of the invention, and of the manner and process of making and using it**, in such full, clear, concise, and exact terms as **to enable any person skilled in the art** to which it pertains, or with which it is most nearly connected, **to make and use the same**, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.
- The key question addressed was whether the specification needs to sufficiently teach a person of skill in the art to:
 - make and use at least one embodiment of a genus claim without too much effort; or
 - cumulatively identify and make all or nearly all embodiments of the invention without substantial 'time and effort.'

Enablement – Full Scope of the Invention

Amgen Inc. v. Sanofi, 143 S.Ct. 1243 (2023)

- Amgen's patents cover monoclonal antibodies which help reduce blood levels of lipoprotein, or "bad cholesterol," reducing blood levels of low-density lipoprotein (LDL), also known as "bad cholesterol."
- The antibodies inhibit a naturally occurring protein known as PCSK9 that binds to and degrades LDL receptors, contributing to high cholesterol levels.
- In the mid-2000s, a number of pharmaceutical companies began looking into the possibility of making antibodies to target PCSK9, including Amgen and Sanofi.
- In 2011, Amgen obtained a patent for a specific antibody used in its Repatha drug and Sanofi obtained a patent for the specific antibody used in its Praluent drug.



Enablement – Full Scope of the Invention

Amgen Inc. v. Sanofi, 143 S.Ct. 1243 (2023)

- In 2014, Amgen obtained two patents that did not seek protection for any particular antibody described by an amino acid sequence. Instead, the two patents claimed the entire genus of antibodies that (1) bind to specific amino acid residues on PCSK9, and (2) block PCSK9 from binding to LDL receptors.
- The claim in question recited a “monoclonal antibody *[that] binds to at least one of*” fifteen residues under certain conditions.

1. An isolated monoclonal antibody, wherein, when bound to PCSK9, the monoclonal antibody binds to at least one of the following residues: S153, I154, P155, R194, D238, A239, I369, S372, D374, C375, T377, C378, F379, V380, or S381 of SEQ ID NO:3, and wherein the monoclonal antibody blocks binding of PCSK9 to LDLR.

19. The isolated monoclonal antibody of claim 1 wherein the isolated monoclonal antibody binds to at least two of the following residues S153, I154, P155, R194, D238, A239, I369, S372, D374, C375, T377, C378, F379, V380, or S381 of PCSK9 listed in SEQ ID NO:3.

29. A pharmaceutical composition comprising an isolated monoclonal antibody, wherein the isolated monoclonal antibody binds to at least two of the following residues S153, I154, P155, R194, D238, A239, I369, S372, D374, C375, T377, C378, F379, V380, or S381 of PCSK9 listed in SEQ ID NO: 3 and blocks the binding of PCSK9 to LDLR by at least 80%.

Enablement – Full Scope of the Invention

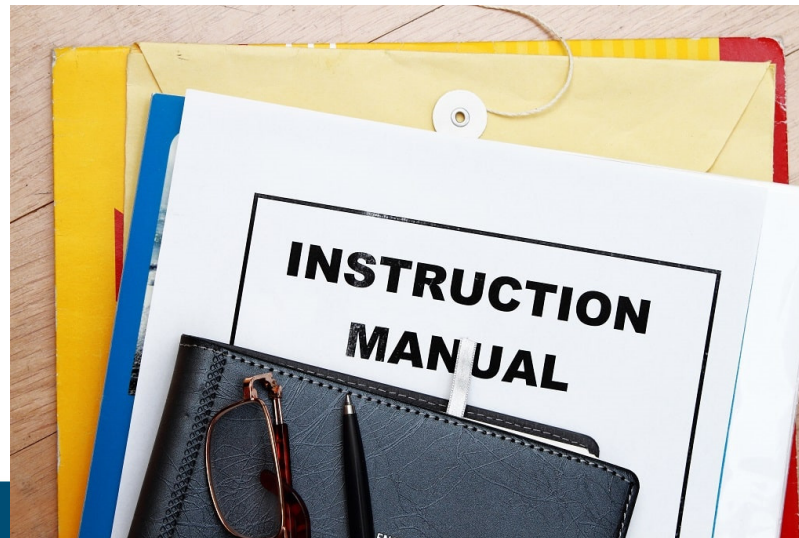
Amgen Inc. v. Sanofi, 143 S.Ct. 1243 (2023)

- Amgen subsequently sued Sanofi for infringement, and Sanofi challenged whether the genus claims were sufficiently enabled.
- Sanofi contended that Amgen's patents failed to meet this standard because they sought to claim for Amgen's exclusive use potentially millions more antibodies than the company had taught scientists to make.
 - Research efforts by Amgen had identified hundreds of effective antibodies.
 - 26 were detailed with full structures in the patent application.
 - Current science was unable to determine all possible antibodies that bind to PCSK9, hence functional claiming approach.
- Both the district court and Federal Circuit sided with Sanofi, finding the patents invalid for lack of enablement.

Enablement – Full Scope of the Invention

Amgen Inc. v. Sanofi, 143 S.Ct. 1243 (2023)

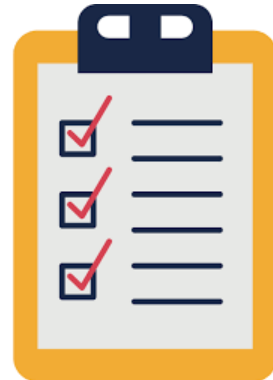
- Supreme Court affirms, reiterating the full scope of the invention standard for enablement.
 - The Court's prior decisions in *Morse, Incandescent Lamp* and *Holland Furniture* reinforce that if a patent claims an entire class of processes, machines, manufactures, or compositions of matter, the patent's specification must enable a person skilled in the art to make and use the entire class.
 - In other words, the specification must enable “the full scope of the invention” as defined by its claims.



Enablement – Full Scope of the Invention

Amgen Inc. v. Sanofi, 143 S.Ct. 1243 (2023)

- Supreme Court affirms, reiterating the full scope of the invention standard for enablement.
 - The Supreme Court clarified that a specification does not always need to describe with particularity how to make and use every embodiment within a claimed class.
 - Sometimes a general quality running through the class may reliably enable a skilled artisan to make and use all of what is claimed, and not merely a subset.
 - The Supreme Court also commented that a specification is not necessarily inadequate simply because it leaves the skilled artisan to engage in some measure of adaption or testing.



Enablement – Full Scope of the Invention

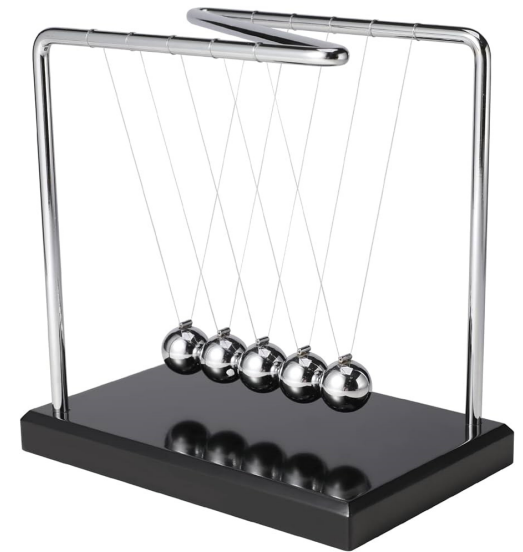
Amgen Inc. v. Sanofi, 143 S.Ct. 1243 (2023)

- Turning to Amgen’s claims, the Supreme Court affirmed that they are not enabled.
 - Amgen’s patents disclosed 26 antibodies described by their amino acid sequence, but the claims encompassed a vast number of additional antibodies.
 - Amgen argued that the claims are enabled because scientists can make and use every undisclosed but functional antibody if they simply follow the company’s “roadmap” or its proposal for “conservative substitution.”
 - The Supreme Court rejected the arguments, finding this amounted to research assignments requiring a step-by-step and trial-and-error method that leaves a scientist forced to engage in painstaking experimentation to see what works. And the specification did not identify any common quality for every functional embodiment.
- The Supreme Court concluded that “the more a party claims for itself the more it must enable.”

Enablement – Full Scope of the Invention

Amgen Inc. v. Sanofi, 143 S.Ct. 1243 (2023)

- Takeaways:
 - Be careful with overgeneralizing in functional/genus claims.
 - Include “common qualities” that identify embodiments of the genus – what properties does an embodiment have to have?
 - Include all known working examples.
 - Consider a mix of claim approaches – some on specific embodiments, others on functional/genus approach.
- How does this relate to other validity issues?
 - 101 – are “do it on a computer” claims just overbroad “genus” claims?
 - 103 – if the invention is anything in this genus, what makes this specific species so important?



Enablement after *Amgen*

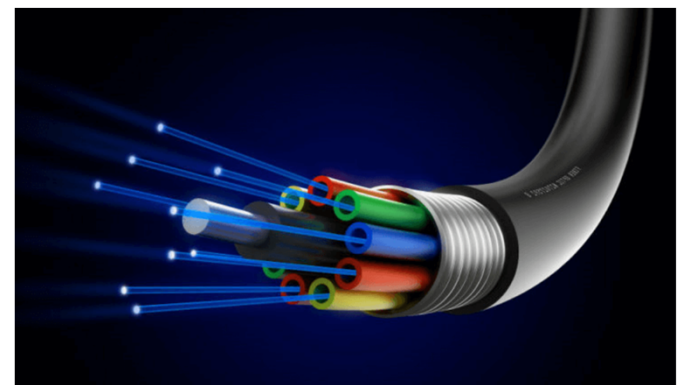
Baxalta Inc. v. Genentech, Inc., 81 F.4th 1362 (Fed. Cir. 2023)

- Straightforward application of *Amgen* back at Federal Circuit.
- Baxalta's patent related to a hemophilia treatment and covered all antibodies that (i) bind to Factor IX/IXa and (ii) increase the procoagulant activity of Factor IXa.
- The Federal Circuit stated that there are *millions* of potential candidate antibodies, but the specification disclosed only *eleven* antibodies with the two claimed functions.
 - The inventors performed four hybridoma experiments to determine whether antibodies that bind to Factor IX/IXa increase procoagulant activity, but discovered that only 1.6% of thousands of screened antibodies did so.
- The specification “directs skilled artisans to engage in the same iterative, trial-and-error process the inventors followed to discover the eleven antibodies they elected to disclose,” which *Amgen* found insufficient to enable the full scope of the claims.
- Accordingly, the Federal Circuit affirmed D.Ct. finding of lack of enablement.

Enablement (not) after *Amgen*

FS.com Inc. v. Int’l Trade Comm’n, 65 F.4th 1373 (Fed. Cir. 2023)

- Corning Optical LLC filed a complaint with the ITC alleging FS was violating § 337 by importing high-density fiber optic equipment that infringed four Corning patents.
- FS challenged the Commission’s determination that claims in two patents that recite “a fiber optic connection density of at least [ninety-eight (98) or 144] fiber optic connections per U space” was enabled.
- FS argued that open-ended density ranges are not enabled because the specification only enables up to 144 fiber optic connections per U space.



Enablement (not) after *Amgen*

FS.com Inc. v. Int’l Trade Comm’n, 65 F.4th 1373 (Fed. Cir. 2023)

- The Commission applied the two-part standard from the Federal Circuit’s *Andersen Corp. v. Fiber Composites* decision that open ended claims are enabled if there is an “inherent, albeit not precisely known, upper limit and the specification enables one of skill in the art to approach that limit.”
- The Federal Circuit found substantial evidence supported the Commission’s finding that there is an inherent upper limit of about 144 connections.
 - In particular, the written description disclosed that the maximum density achieved at the time of the invention was 144 connections and expert testimony established that, despite market pressure, no commercial product had achieved a density greater than 144 connections.
 - FS did not dispute that the claims were enabled if they do not encompass densities above about 144 connections.
 - Accordingly, the Federal Circuit affirmed the Commission’s enablement determination.

Enablement after *Amgen*

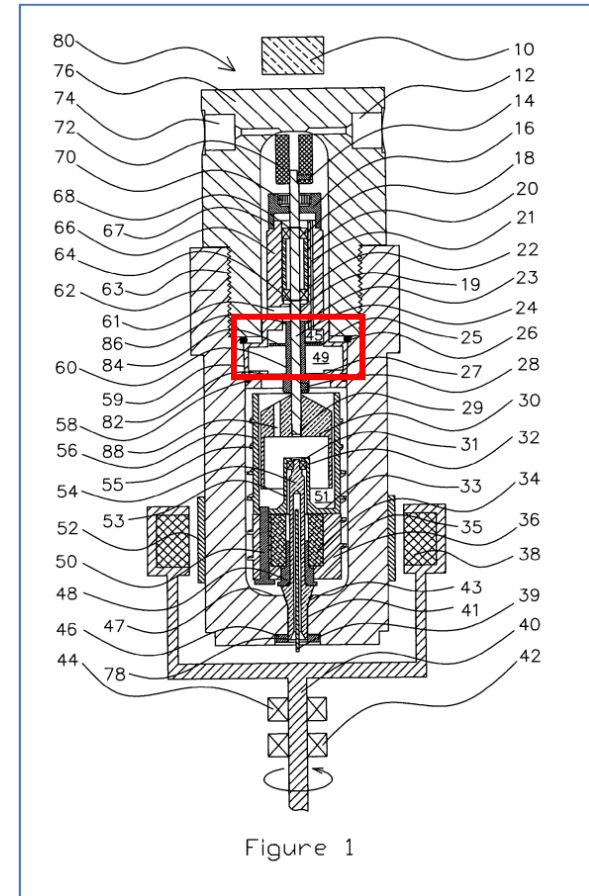
Medytox, Inc. v. Galderma S.A. 71 F.4th 990 (Fed. Cir. 2023)

- Medytox appealed a final written decision in a post-grant review (PGR) proceeding that denied patentee's motion to amend to substitute new claims for canceled original claims in a patent relating to use of an animal-protein-free botulinum toxin composition.
 - Medytox amended the claims to recite a new limitation that the “responder rate limitation” was “50% or greater.”
 - Galderma argued that the full scope of the claims was not enabled because a skilled artisan would not have been able to achieve higher than 62% for the responder rate limitation and the claims as properly construed covered the range of 50% to 100%.
- Federal Circuit affirmed – the full scope of the claims was not enabled because undue experimentation would be required.
 - The specification need not include a working example of all possible embodiments to enable the full scope of the claims.
 - But the patent at issue disclosed only three examples of responder rates above 50% - 52%, 61% and 62%.
 - Substantial evidence supported conclusion that the substitute claims were not enabled because a skilled artisan would not have been able to achieve responder rates higher than the limited examples disclosed in the specification.

Indefiniteness – Relative Terms

Grace Instrument Indus., LLC v. Chandler Instruments Co., LLC., 57 F.4th 1001 (Fed. Cir. 2023)

- Grace sued Chandler alleging Chandler's liquid pressurized viscometer used in drilling oil wells infringed.
- The district court held that the term “enlarged chamber” was a “term of degree” that “necessarily calls for some comparison against some baseline.”
 - Saying something is large enough to do a certain task does not answer the question – “larger than what?”
 - Finding no objective boundaries in the patent, D.Ct. held indefinite.



Indefiniteness – Relative Terms

Grace Instrument Indus., LLC v. Chandler Instruments Co., LLC., 57 F.4th 1001 (Fed. Cir. 2023)

- Federal Circuit: it means “large enough”
 - The specification informed a skilled artisan that the “enlarged chamber” is large enough to accomplish a particular function (to prevent pressurization fluid from entering the lower section of the pressure vessel during elevated pressurization).
 - Have to look a context and use of term in patent – not a relative term of degree in this case.
 - Prosecution history was also informative, and a skilled artisan would understand that the purpose of the “enlarged chamber” is to prevent commingling of the sample and pressurization fluids in the lower zone without using a seal.

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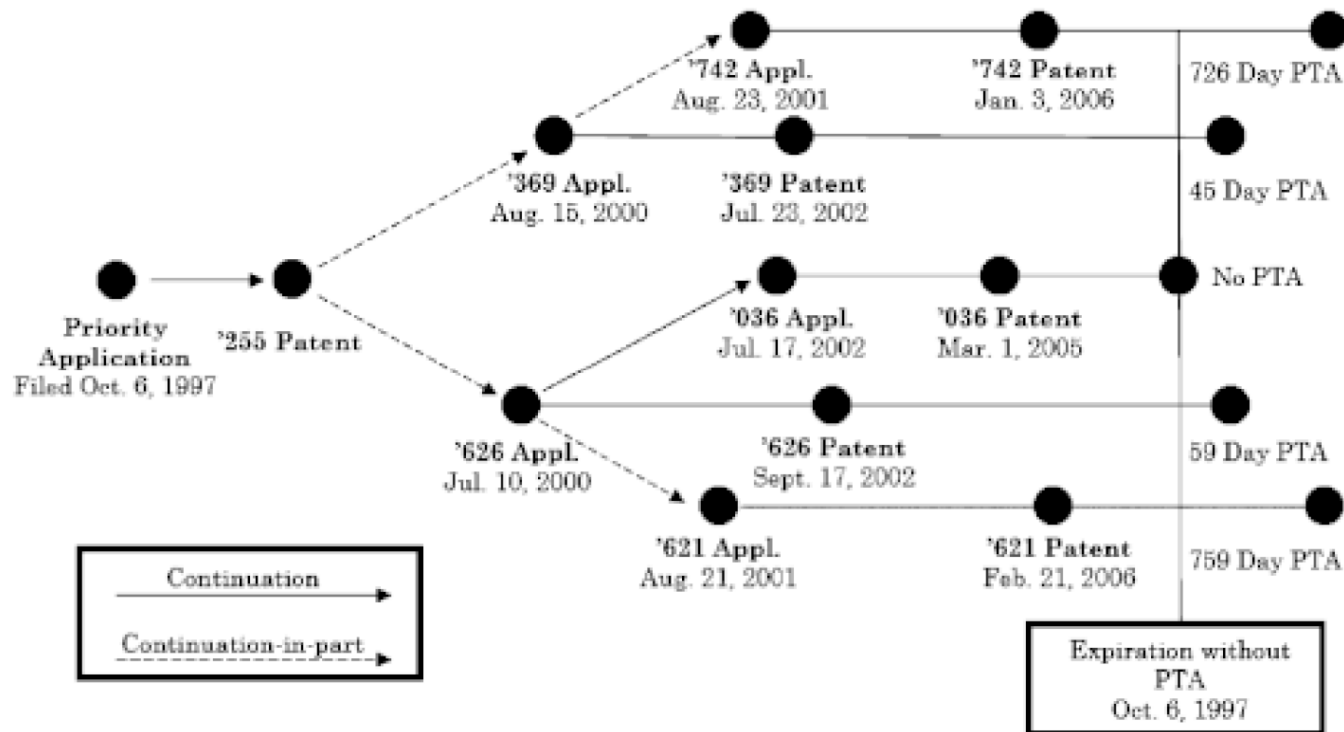
Double Patenting – PTA and Expired Patents

In re Collect, 81 F.4th 1216 (Fed. Cir. 2023)

- Four Collect patents related to mobile device cameras were challenged by Samsung in ex parte reexamination for obviousness-type double patenting, where the patents in question outlasted other patents in family due to PTA.
 - Patents rejected for being invalid due to ODP over a “reference” patent from the same family that did not get any PTA.
 - Challenged patents and the reference patent all derived from a common ancestor.
 - Absent any patent term adjustment (PTA) for USPTO delay, each of the patents would have expired on the same day.
 - Each of the challenged patents had PTA but reference patent did not.
- Challenged patents deemed patentably indistinct and found invalid for obviousness type double patenting.

Double Patenting – PTA and Expired Patents

In re Collect, 81 F.4th 1216 (Fed. Cir. 2023)



Double Patenting – PTA and Expired Patents

In re Collect, 81 F.4th 1216 (Fed. Cir. 2023)

- Federal Circuit determined that the relevant expiration date for obviousness-type double patenting for patent entitled to PTA is the expiration date **after** the addition of the patent-term adjustment.
 - For patent term extension (PTE), its expiration date used for the ODP analysis is the patent's expiration date **before** the PTE has been added.
 - See *Novartis AG v. Ezra Ventures LLC*, 909 F.3d 1367 (Fed. Cir. 2018); *Merck & Co. v. Hi-Tech Pharmacal Co.*, 482 F.3d 1317 (Fed. Cir. 2007).
 - But patent term adjustment (PTA) is different from PTE, as recognized by the *Novartis* court.
 - In particular, the statute defining PTA expressly contemplates that terminal disclaimers may operate to cut off PTA.
- Federal Circuit affirmed unpatentability of four challenged patents

Double Patenting – PTA and Expired Patents

In re Collect, 81 F.4th 1216 (Fed. Cir. 2023)

- This case presents an important practice point and a trap for the unwary.
 - Later-filed but earlier expiring continuations (e.g., due to PTA in the earlier patent) can serve as double patenting references and cut off the PTA.
 - And where the reference patent is already expired, as happens not infrequently in litigation, a terminal disclaimer is **not** available to save the patent under the Federal Circuit's precedent in *Boehringer*.
- Look at your continuations in families with PTA.
- If the natural 20-year term of a case is expired or going to expire during litigation, assess impact on cases with PTA.

Prosecution Laches

Personalized Media Communications, LLC v. Apple, Inc., 57 F.4th 1346 (Fed. Cir. 2023)

- PMC sued Apple, and a jury awarded over \$308 million in reasonable royalty damages.
- Following a bench trial after the jury trial, the district court found the patent-in-suit unenforceable based on prosecution laches.
 - PMC delayed eight to fourteen years to file its patent applications and at least sixteen years to present the asserted claims for examination, a delay period similar to that in the precedential *Hyatt* decision.
 - Although the PTO suspended prosecution of PMC's applications, prosecution had been pending for nearly ten years and the suspension was directly attributable to PMC's prosecution conduct.
 - PMC's prosecution strategy was a deliberate strategy of delay and its actions a "conscious and egregious use of the statutory patent system."
- The district court found Apple was prejudiced by PMC's delay because Apple began developing its accused system before 2003 but the patent issued in 2012 – years after the accused system was first sold.

Prosecution Laches

Personalized Media Communications, LLC v. Apple, Inc., 57 F.4th 1346 (Fed. Cir. 2023)

- Federal Circuit found the record established unreasonable delay, as PMC institutionalized its abuse of the patent system by adopting and implementing dilatory prosecution strategies.
 - The delay period was comparable to the 7-11 years to file applications and 10-19 year delay before presenting claims found to be an unreasonable delay in *Hyatt*.
- As to prejudice, Fed. Cir. rejected PMC argument that Apple needed to prove that PMC was still engaged in egregious conduct *after* Apple began developing its accused product.
 - Federal Circuit rejected the argument as misconstruing the record and the law.
 - PMC incorrectly assumed that the district court did not find that PMC engaged in post-development conduct that caused delay.
 - Indeed, the Federal Circuit pointed to the district court's reliance on PMC strategies in 2011 that contributed to the delay.
 - Dissent: key period for delay is 2000 when PMC was wrongfully delaying prosecution, but later acts were less egregious.
- *Hyatt* and *PMC* – edge cases?
 - See *Sonos Inc. v. Google LLC*, 20-06754 WHA, 2023 WL 6542320 (N.D. Cal. Oct. 6, 2023)

Broadening Reissues – Essential Features

In re Float’N’Grill LLC 72 F.4th 1347 (Fed. Cir. 2023)

- Float’N’Grill (FNG) appealed the decision from the Board affirming the Examiner’s rejection of claims in an application for reissue of a patent.
 - The patent was directed to a float designed to support a grill to facilitate a user grilling food while remaining in a body of water.
 - The specification described a single embodiment for the float having a pair of inverted U-shaped grill supports where a middle segment of each support includes a “plurality of magnets.”
 - The issued patent claims included a limitation using this same language, reciting a “plurality of magnets.”
 - FNG filed a broadening reissue application where none of the claims included a plurality of magnets limitation.
 - Instead, the reissue application claims recited more generically removably securing a grill to the support.

Broadening Reissues – Essential Features

In re Float’N’Grill LLC 72 F.4th 1347 (Fed. Cir. 2023)



Broadening Reissues – Essential Features

In re Float’N’Grill LLC 72 F.4th 1347 (Fed. Cir. 2023)

- The Examiner rejected the reissue claims for failure to satisfy § 251, finding the original patent disclosed a single embodiment for the floating apparatus using a “plurality of magnets” and did not disclose the magnets as being an optional feature.
- The Examiner concluded the magnets are a “critical element of the invention” and that the original patent requirement of § 251 was not satisfied because the reissue application claims did not include a “plurality of magnets” limitation.
- Board sustained the examiner, and FNG appealed.

Broadening Reissues – Essential Features

In re Float’N’Grill LLC 72 F.4th 1347 (Fed. Cir. 2023)

- Federal Circuit held that “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.”
 - The reissue claims are not directed to the invention disclosed in the original patent since the magnets are essential to the invention because they are the only structures disclosed for removably securing a grill to the float and the specification contained nothing to suggest that alternative mechanisms may be used in place of the magnets.
 - The Federal Circuit found the omission of the magnets similar to the omission of water necessary for the reactions in *U.S. Industrial Chemicals*, a Supreme Court case holding that such essential elements of the invention cannot be omitted.
 - Accordingly, the Federal Circuit affirmed the rejection of the reissue claims.

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Claim Construction – “A,” “An,” and “The”

Salazar v. AT&T Mobility, LLC, 64 F.4th 1311 (Fed. Cir. 2023)

- Jury found a patent relating to technology for wireless and wired communication not infringed
- Salazar challenged the district court’s claim construction of “a microprocessor”
- Claim recited: “a microprocessor for generating ..., said microprocessor creating ..., a plurality of parameter sets retrieved by said microprocessor ..., said microprocessor generating ...”
- District court construed “a microprocessor” as one or more processors configured to perform **each** function (generating, creating, retrieving, generating)

Claim Construction – “A,” “An,” and “The”

Salazar v. AT&T Mobility, LLC, 64 F.4th 1311 (Fed. Cir. 2023)

- Salazar argued on appeal that properly construed, “a microprocessor” could encompass one microprocessor that performed one function and a different microprocessor performing a different recited function

≥ 1 Microprocessor:

- **Generating**
- **Creating**
- **Retriev[ing]**
- **Generating**

Microproc
#1 - Gene

Microprocessor
#2 - Creating

Microproc
#3 -
Retriev[ing]

Microprocessor
#4 - Generating

Claim Construction – “A,” “An,” and “The”

Salazar v. AT&T Mobility, LLC, 64 F.4th 1311 (Fed. Cir. 2023)

- The Federal Circuit affirmed
- The Federal Circuit cited the general rule that “a microprocessor” means on or more for an open-ended claim using “comprising”
- But, subsequent limitation referring back to “said microprocessor” required at least one microprocessor be capable of performing each recited function
- Jury verdict of noninfringement affirmed because accused product did not include a single processor that performed all the recited functions

Claim Construction – Extrinsic Evidence

Actelion Pharms. Ltd. v. Mylan Pharms., Inc., 85 F.4th 1167 (Fed. Cir. 2023)



- Actelion owns two patents directed to improved epoprostenol formulations used to treat cardiovascular disease
- Patented formulations sold under the Veletri® mark
- Mylan sought approval to manufacture a generic version by filing an ANDA with the FDA
- Actelion sued for patent infringement



Claim Construction – Extrinsic Evidence

Actelion Pharms. Ltd. v. Mylan Pharms., Inc., 85 F.4th 1167 (Fed. Cir. 2023)

- The claims recited a “bulk solution” including epoprostenol “wherein the bulk solution has a *pH of 13 or higher*”
- Meaning of “*pH of 13 or higher*” disputed

	
Cannot cover any pH values less than 13	<p>“a value of acidity that is given as an order of magnitude that is subject to rounding.”</p> <p>Would encompass a pH of 12.5</p>

Claim Construction – Extrinsic Evidence

Actelion Pharms. Ltd. v. Mylan Pharms., Inc., 85 F.4th 1167 (Fed. Cir. 2023)

- Actelion argued that there would need to be a significant figure to the right of 13 to describe a specific pH value
- Actelion cited three textbooks as extrinsic evidence to support its argument
- Mylan countered that the textbooks supported a narrower range pH of 12.995-13.004
- District court adopted Actelion's construction based on the intrinsic record alone
- Following claim construction, the parties stipulated to final judgement of infringement in favor of Actelion
- Mylan appealed

Claim Construction – Extrinsic Evidence

Actelion Pharms. Ltd. v. Mylan Pharms., Inc., 85 F.4th 1167 (Fed. Cir. 2023)

- The Federal Circuit started with the claim language and found a range with a specified lower limit
- Rejected Mylan's argument for a blanket rule that open-ended ranges must foreclose rounding
- Mylan also argued that the lack of approximation language (e.g. about or approximately) must mean a pH of 13 exactly
- Absence of approximation language not dispositive and Federal Circuit rejected invitation to create that bright-line rule
- After consulting the specification and prosecution history the Federal Circuit found the scope of the claim term unclear

Claim Construction – Extrinsic Evidence

Actelion Pharms. Ltd. v. Mylan Pharms., Inc., 85 F.4th 1167 (Fed. Cir. 2023)

- Conclusion: proper claim construction cannot be reached without aid of extrinsic evidence
- District court erred by not considering the textbooks offered and addressed by the parties
- District court should make subsidiary fact findings about the extrinsic evidence in the first instance
- Federal Circuit vacated judgement of infringement

Today's Topics:

1. **Abstract Ideas – Pretty Clear at this Point?**
2. **Prior Art – The Tradeshow Public Use Trap**
3. **Obviousness – Analogous Art and Motivation to Combine**
4. **Obviousness – Secondary Considerations Make Waves**
5. **Enablement – *Amgen* and The Full Scope of the Claim**
6. **Continuations, Reissues, and Laches – Pitfalls to Watch For**
7. **Claim Construction – Canons of Construction Applied**
8. **Infringement – Doctrine of Equivalents Sinks Huge Verdict**
9. **Design Patents – Infringement and Obviousness**
10. **Inter Partes Reviews – New Developments**

Infringement in Landmark Verdict

VLSI Tech. LLC v. Intel Corp., __ F.4th __ (Fed. Cir. 2023)

- VLSI filed five cases with 21 patents against Intel in three venues
- The 373 Patent and 759 Patent were asserted in cases consolidated for trial in the Western District of Texas
- Intel filed IPR petitions October 2019 and February 2020
- The PTAB exercised its discretion under 35 U.S.C. § 314(a) not to institute review after applying the *Fintiv* factors
- Decision based on trial scheduled for November 2020



Infringement in Landmark Verdict

VLSI Tech. LLC v. Intel Corp., __ F.4th __ (Fed. Cir. 2023)

- Trial concluded March 2021
- Jury found the '373 Patent literally infringed and awarded \$1.5 billion in damages
- Jury found the '759 Patent infringed under the doctrine of equivalents and awarded \$675 million in damages
- Intel appealed the jury's infringement findings and damage awards



Doctrine of Equivalents

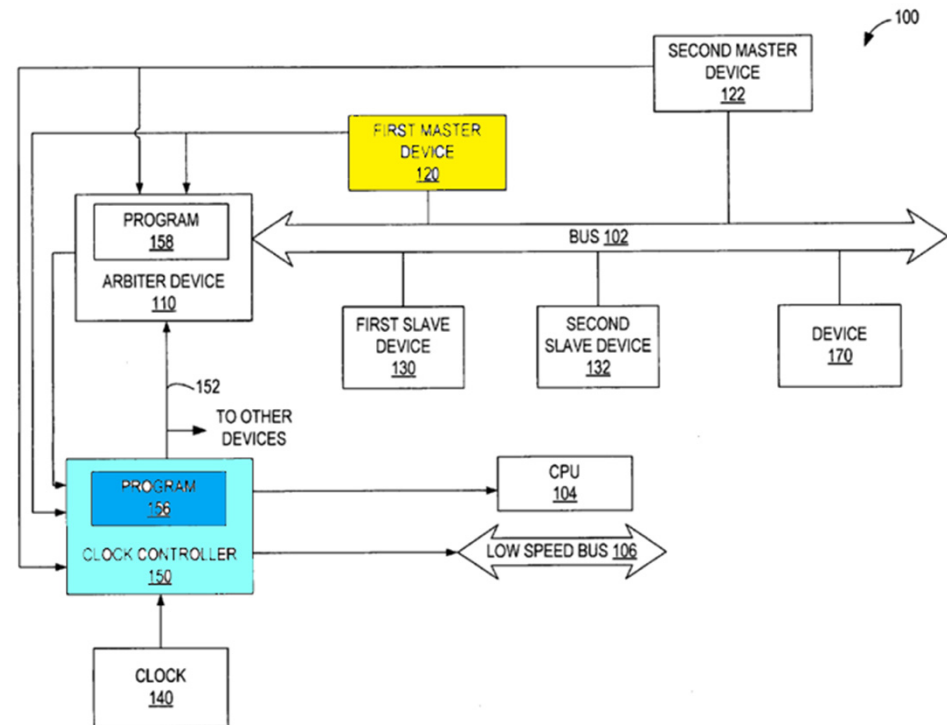
VLSI Tech. LLC v. Intel Corp., __ F.4th __ (Fed. Cir. 2023)

- Fed. Cir. reversed the doctrine of equivalents verdict for the '759 Patent
- “Doctrine of equivalents provides a *limited exception* to the principle that claim meaning defines”
- “Liability under the doctrine is ‘exceptional.’”
- Three restrictions on DOE:
 - First, the proof of equivalents must be limitation specific and not focused on the claim as a whole
 - Insubstantially different—whether a substitute matches the function, way and result of the claimed element
 - Requires “particularized testimony and linking argument as to the insubstantiality of the differences between the claimed invention and the accused device”

Doctrine of Equivalents

VLSI Tech. LLC v. Intel Corp., __ F.4th __ (Fed. Cir. 2023)

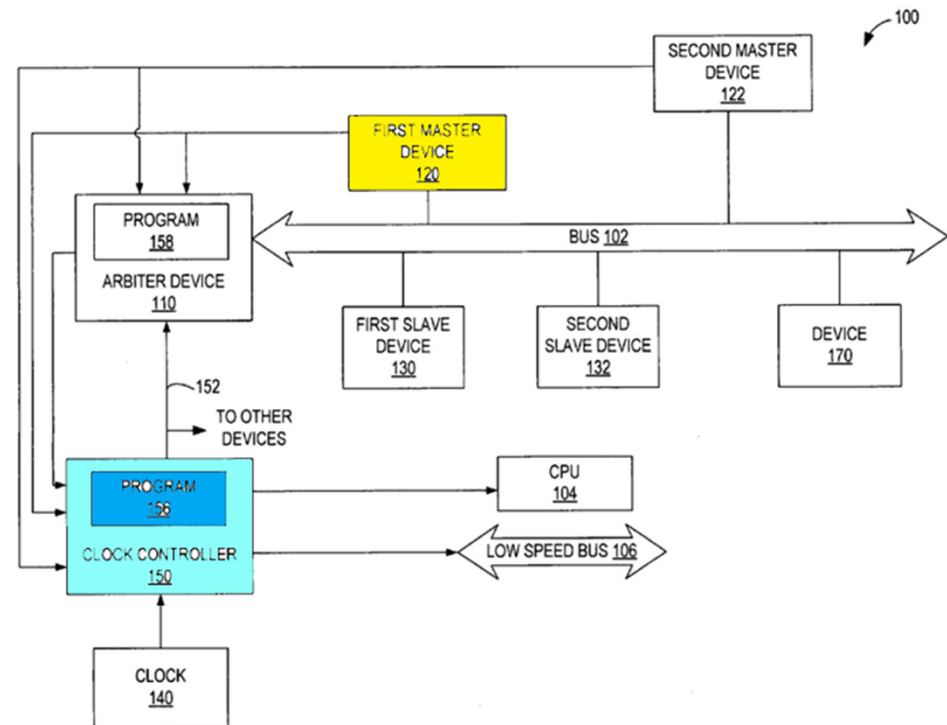
- VLSI claim requires a “first master device” and a distinct “programmable clock controller”
- Functionality in Intel products overlapped on one power control unit
- VLSI’s expert Dr. Conte testified that “It’s just a difference of where an engineer draws this data line. It’s a design choice.”



Doctrine of Equivalents

VLSI Tech. LLC v. Intel Corp., __ F.4th __ (Fed. Cir. 2023)

- Merely labeling it a “design choice” was legally insufficient
- Needed to explain why splitting functions as Intel did was “substantially the same way” as recited in the claims



Doctrine of Equivalents

VLSI Tech. LLC v. Intel Corp., __ F.4th __ (Fed. Cir. 2023)

- Reigning in DOE?
- Or, extra scrutiny for controversial case with \$2 billion damages award?



Damages – Reasonable Royalty

VLSI Tech. LLC v. Intel Corp., __ F.4th __ (Fed. Cir. 2023)

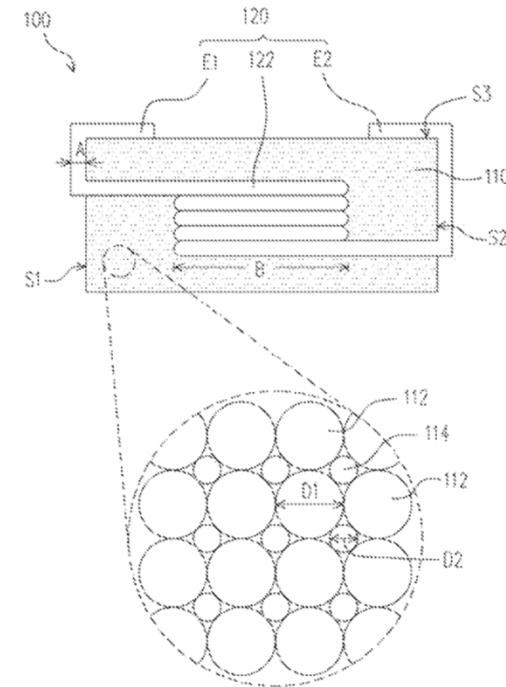
- Federal Circuit vacated damages award for '373 Patent, despite affirming finding of infringement
- VLSI's expert created damages model to identify incremental value over non-infringing alternatives
- First step in model determined power savings from using patented technology
- “Readily identifiable error” in selecting data inputs for power savings
- Inputs used did not practice the patented functionality



Damages – Reasonable Royalty

Cyntec Co., Ltd. v. Chilisin Elecs. Corp., 84 F.4th 979 (Fed. Cir. 2023)

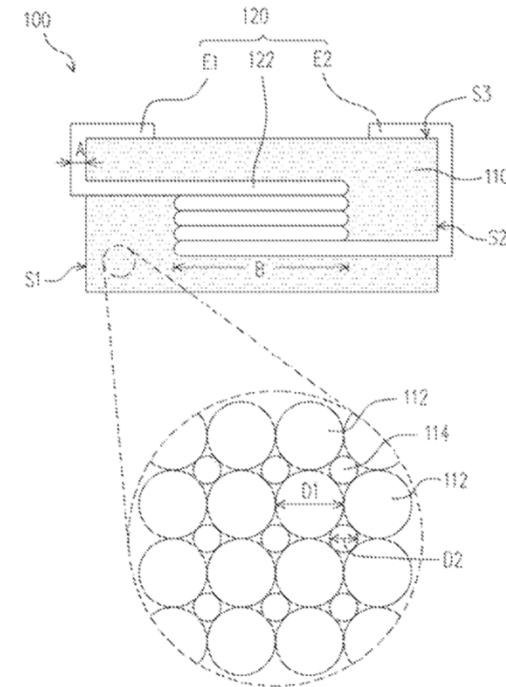
- Patents related to chokes – inductors used to eliminate undesirable signals in circuits
- Cyntec presented a market-share lost profits damages theory
- Jury award \$1.87 million in damages
- District Court enhanced damages to \$5.55 million



Damages – Reasonable Royalty

Cyntec Co., Ltd. v. Chilisin Elecs. Corp., 84 F.4th 979 (Fed. Cir. 2023)

- District court denied pre-trial *Daubert* motion to exclude the testimony of Cyntec's expert
- Federal Circuit found district court abused its discretion in denying motion
- Federal Circuit found customer reports included sales and revenue of irrelevant products and services
- Cyntec's expert did not differentiate revenue from products that would or would not incorporate accused chokes



Today's Topics:

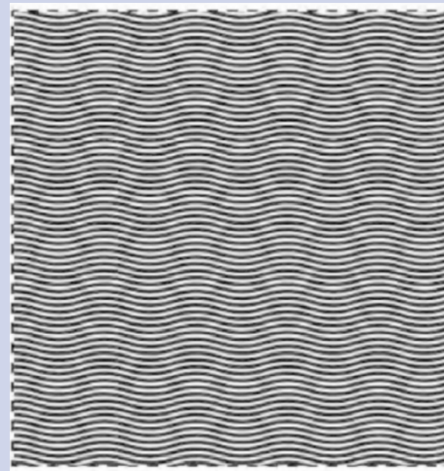
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Design Patent – Comparison Prior Art

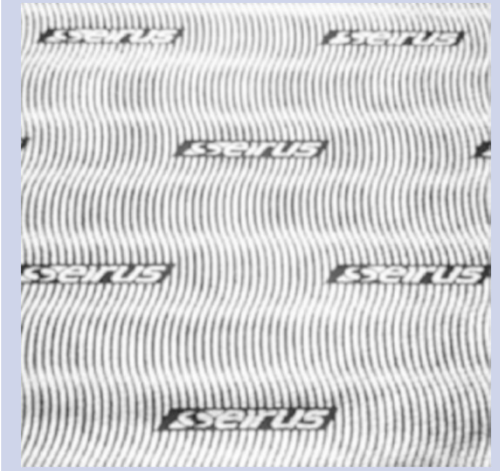
Columbia Sportswear N. Amer. Inc. v. Seirus Innovative Accessories, Inc., 80 F.4th 1363 (Fed. Cir. 2023)

- Court granted summary judgment of infringement
- Jury awarded \$3.0 MM
- Federal Circuit vacated summary judgment after instructing district court to consider Seirus' logo when assessing infringement
- Second jury found Seirus did not infringe
- Columbia appealed

D093 Patent – “Heat Reflective Material”



Seirus HeatWave material



Design Patent – Comparison Prior Art

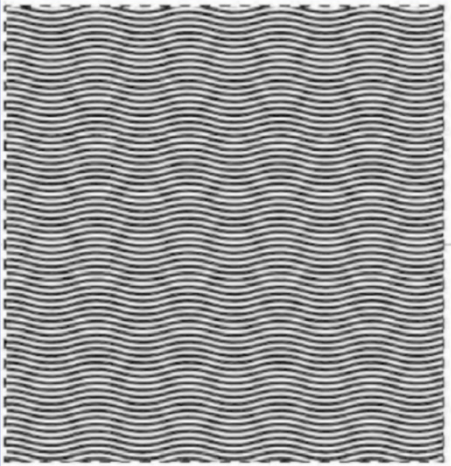
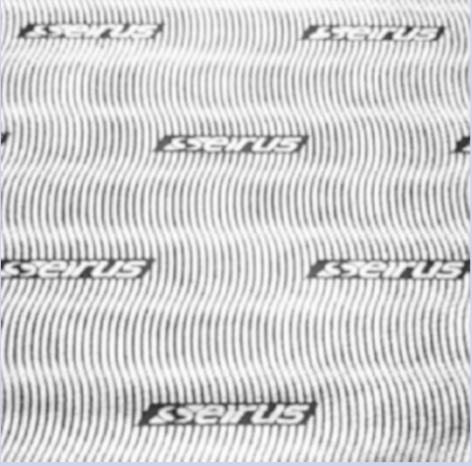
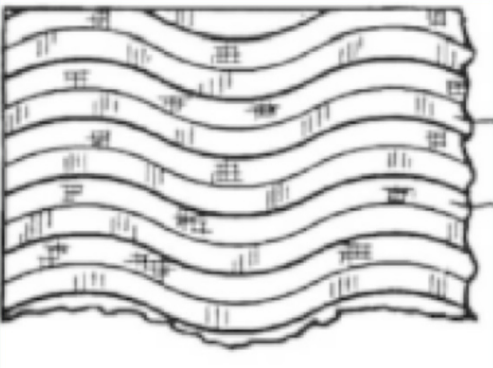
Columbia Sportswear N. Amer. Inc. v. Seirus Innovative Accessories, Inc., 80 F.4th 1363 (Fed. Cir. 2023)

- Design infringement evaluated under “ordinary observer” test – *Egyptian Goddess*, 543 F.3d 665 (Fed. Cir. 2008) (en banc)
- Would the ordinary observer find the accused design to be “substantially similar” to the claimed design, such that they would be deceived into purchasing the accused design believing it to be the claimed design?
- “Comparison prior art” may be considered to resolve whether the ordinary observer would consider the two designs to be substantially similar

Design Patent – Comparison Prior Art

Columbia Sportswear N. Amer. Inc. v. Seirus Innovative Accessories, Inc., 80 F.4th 1363 (Fed. Cir. 2023)

- Issue of first impression of the scope of “comparison prior art” in infringement analysis

D093 Patent – “Heat Reflective Material”	Seirus HeatWave material	Prior Art Patent (Blauer ‘949 patent) “Breathable Shell for Outerwear”
		

Design Patent – Comparison Prior Art

Columbia Sportswear N. Amer. Inc. v. Seirus Innovative Accessories, Inc., 80 F.4th 1363 (Fed. Cir. 2023)

- “Comparison prior art” must apply design to *same* article of manufacture as claimed design
- *Surgisil* limited prior art for anticipation to only design applied to same article as claimed design
- *Curver* held design patent cannot be infringed unless applied to same article of manufacture as claimed design

Design Patent – Comparison Prior Art

Columbia Sportswear N. Amer. Inc. v. Seirus Innovative Accessories, Inc., 80 F.4th 1363 (Fed. Cir. 2023)

- Federal Circuit vacated noninfringement judgment because district court did not instruct jury on proper “comparison prior art” standard
- Federal Circuit declined to rule in first instance whether alleged comparison prior art could be considered at trial
- Future fight will be what constitutes “heat reflective material,” which the Federal Circuit noted could involve claim construction

Design Patent – Comparison Prior Art

Columbia Sportswear N. Amer. Inc. v. Seirus Innovative Accessories, Inc., 80 F.4th 1363 (Fed. Cir. 2023)

- Federal Circuit affirmed the logo-related jury instructions
- Instructions recited:
 - Ordinary-observer test for infringement
 - Stated the jury “need not ... find that any purchasers were actually deceived or confused by the appearance of the products”
- Columbia argued that consumer confusion as to source was irrelevant for design patent infringement
- Federal Circuit rejected Columbia’s argument

Design Patent – Obviousness

LKQ Corp. v. GM Global Tech. Operations LLC, 71 F.4th 1383 (Fed. Cir. 2023)

- Federal Circuit currently applies *Rosen-Durling* framework for design patent obviousness
 - Identify single reference for claimed article of manufacture having basically the same characteristics of the claimed design
 - Secondary reference “may only be used to modify the primary reference if they are ‘so related to the primary reference that the appearance of certain ornamental features in one would suggest the application of those features to the other’”

Design Patent – Obviousness

LKQ Corp. v. GM Global Tech. Operations LLC, 71 F.4th 1383 (Fed. Cir. 2023)

- Federal Circuit granted rehearing *en banc* petition to address design patent obviousness standard
 - Did Supreme Court's *KSR* decision overrules or abrogate *Rosen-Durling*?
 - Does *KSR* apply to design patents and suggest *Rosen-Durling* should be eliminated or modified?
 - If *Rosen-Durling* eliminated, what should the test be?
 - Would eliminating *Rosen-Durling* cause uncertainty in an otherwise settled area of law?
 - What role should differences between utility and design patents play in the test for obviousness?

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IPR Estoppel – Reasonably Could Have Raised

Ironburg Inventions Ltd. v. Valve Corp., 64 F.4th 1274 (Fed. Cir. 2023)

- Ironburg sued Valve for infringing a patent directed to a hand-held video game console controller
- Valve filed IPR petition that was partially instituted
- Prior to trial, the district court held that Valve was estopped from pressing prior-art based invalidity defenses based on IPR petition

IPR Estoppel – Reasonably Could Have Raised

Ironburg Inventions Ltd. v. Valve Corp., 64 F.4th 1274 (Fed. Cir. 2023)

- The IPR estoppel provision of § 315(e)(2) applies to “any ground that the petitioner raised or reasonably could have raised during that inter partes review”
- On appeal, Valve argued that it could not have reasonably raised two non-instituted grounds or two grounds not raised in the petition (“non-petitioned grounds”)
- The Federal Circuit held that the non-instituted grounds were “raised” during the *inter partes* review

IPR Estoppel – Reasonably Could Have Raised

Ironburg Inventions Ltd. v. Valve Corp., 64 F.4th 1274 (Fed. Cir. 2023)

- As to the non-petitioned grounds, the Federal Circuit acknowledged that it has “not fully addressed the standards by which a determination is to be made as to what invalidity grounds not presented in a petition are estopped pursuant to § 315(e)(2)”
- Statute estops a petitioner on any ground that “a skilled searcher conducting a diligent search reasonably could have been expected to discover”
- Patent Owner bears the burden of proving by a preponderance of the evidence an IPR estoppel defense

[BONUS!] Generative AI – The Real Story of 2023

Impacts on Inventing, Inventors, and Attorneys

- AI as tool – modeling and simulation, discovery, testing
- AI as inventor – AI-generated inventions, *Thaler* case
- AI as co-inventor – obviousness, inventorship, disclosure
- AI as lawyer – patent drafting, patent searching, discovery, litigation



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