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§ 10:2 Enplas Display Device Corp. v. Seoul Semiconductor Co., Ltd. 204

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§ 10:3 Exmark Manufacturing Co. v. Briggs & Stratton Power Products Group, LLC 206

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	<i>There is no blanket prohibition against the introduction of new evidence during an IPR proceeding.</i>	
§ 11:4	Applications in Internet Time, LLC v. RPX Corp.	253
	<i>Federal Circuit concluded that PTAB had applied an unduly restrictive test for determining whether a person or entity is a “real party in interest” under section 315(b). Circuit Judge O’Malley writes a tutorial opinion on “real party in interest.” “Determining whether a non-party is a ‘real party in interest’ demands a flexible approach that takes into account both equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that has a preexisting, established relationship with the petitioner.” Circuit Judge Reyna writes a tutorial concurring opinion on “privity.”</i>	
§ 11:5	Arista Networks, Inc. v. Cisco Systems, Inc.	261
	<i>Whether section 311(a) contemplates application of assignor estoppel in IPRs is reviewable, thereby overturning</i>	

the contrary 2016 opinion in Husky Injection Molding Sys. Ltd. v. Athena Automation Ltd. Under section 311(a), assignor estoppel does not apply in IPRs.

§ 11:6 Arthrex, Inc. v. Smith & Nephew, Inc. 264

Federal Circuit panel majority concludes that PTAB may enter adverse judgment under 37 C.F.R. § 42.73(b), after a patent owner disclaims claims, and before an institution decision.

§ 11:7 Bennett Regulator Guards, Inc. v. Atlanta Gas Light Co. 267

Federal Circuit extends Click-to-Call to “involuntary” dismissals without prejudice. Federal Circuit refused to consider potential sanctions without a final decision by the PTAB.

§ 11:8 BioDelivery Sciences International, Inc. v. Aquestive Therapeutics, Inc. 268

Federal Circuit following SAS, remands to PTAB to consider “non-instituted” claims and grounds.

§ 11:9 Click-to-Call Technologies, LP v. Ingenio, Inc. 269

Federal Circuit, in an en banc footnote, concludes that the one-year time bar of section 315(b) applies when an IPR petitioner was served with a complaint more than one year before filing the petition, but the infringement action was thereafter voluntarily dismissed without prejudice. The time bar of section 315(b) is triggered with service of a complaint alleging patent infringement regardless of what later happens in the case. A patent subject to ex parte reexamination following filing of the original complaint does not become a “new patent” so as to avoid the time bar, even though claims were cancelled, amended and added.

§ 11:10 Dell Inc. v. Accelaron, LLC (Dell II) 274

PTAB did not violate remand order by declining to consider party’s “new argument” and proposed response.

§ 11:11 In re Durance 274

Federal Circuit vacates and remands PTAB decision where PTAB improperly failed to consider arguments raised

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in applicant’s reply brief where the examiner’s basis for rejection was shifting. “The purpose of [37 C.F.R.] § 41.41 [dealing with reply briefs] is not to prevent an applicant from responding to new arguments raised for the first time in the examiner’s answer.” “Neither [MPEP § 1207.03 nor 37 C.F.R. § 41.41] contemplates that the applicant has to petition to have a new argument in an answer designated as a new ground of rejection before it can respond to the new argument.”

§ 11:12	Ericsson Inc. v. Intellectual Ventures I LLC	276
	<i>Federal Circuit reverses PTAB decision (which held certain claims to be patentable), in a lengthy, largely fact-based opinion which a dissent urges contravened rule that an agency’s factual findings were reviewed for substantial evidence.</i>	
§ 11:12.1	The Claims at Issue in This Case.....	279
§ 11:13	Ericsson Inc. v. Intellectual Ventures I LLC	280
	<i>PTAB erred by not considering portions of reply brief.</i>	
§ 11:14	<i>In re Hodges</i>	281
	<i>Federal Circuit splits over question whether PTAB decision deemed inadequate to support finding of anticipation should be reversed or vacated and remanded.</i>	
§ 11:15	IXI IP, LLC v. Samsung Electronics Co., Ltd.....	285
	<i>Federal Circuit concluded that PTAB’s reading of a reference was “reasonable” and supported by substantial evidence.</i>	
§ 11:16	Knowles Electronics LLC v. Iancu.....	286
	<i>Federal Circuit panel majority, over dissent by Judge Newman, concludes that PTO director has standing to participate in appeal after third-party requester declined to defend a judgment in its favor in an inter partes reexamination. Federal Circuit panel majority concluded that PTAB correctly considered prior judicial construction of disputed term.</i>	

§ 11:17 Luminara Worldwide, LLC v. Iancu 289
Federal Circuit, following footnote 3 of Click-to-Call, concludes that one of the IPRs was time-barred under section 315(b).

§ 11:18 MaxLinear, Inc. v. CF CRESPE LLC..... 290
Collateral estoppel applies when PTAB finds, and Federal Circuit affirms, that claims are unpatentable in another IPR.

§ 11:19 Nestlé USA, Inc. v. Steuben Foods, Inc..... 291
Collateral estoppel applies to bar relitigating claim construction settled in earlier case involving a related patent with a “substantially similar” specification (including the same lexicography vis-à-vis the disputed term).

§ 11:20 *In re* Power Integrations, Inc. 292
Federal Circuit, in a precedential motions panel decision, characterizing a request for a more complete notice of reasons for non-institution from the PTAB as just a “camel’s nose under the tent,” rejects a petition for writ of mandamus as a “work around” for the “no appeal” provision of section 314(d).

§ 11:21 Saint Regis Mohawk Tribe v. Mylan Pharmaceuticals Inc..... 294
Federal Circuit concludes that tribal sovereign immunity cannot be asserted in IPRs.

§ 11:22 Sirona Dental Systems GmbH v. Institut Straumann AG..... 296
Federal Circuit, following its en banc decision in Aqua Products, vacates and remands PTAB decision where PTAB improperly failed to consider an amendment proposed by the patent owner. Panel writes that “[t]he petitioner bears the burden of proving that proposed amended claims are unpatentable” citing what it characterizes as a plurality opinion in Aqua Products.

§ 11:23 VirnetX Inc. v. Apple, Inc. 297
Party is collaterally estopped from re-litigating whether a document constitutes a printed publication where that issue

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was decided in an appeal in a related IPR. Party did not preserve argument whether IPR procedures can apply retroactively to patents filed before Congress enacted the AIA.

§ 11:24	WesternGeco LLC v. ION Geophysical Corp. (WesternGeco III)	299
	<i>“Privity” in time-bar provision of section 315(b) construed according to common law meaning. Federal Circuit adopts USPTO office Patent Trial Practice Guide analysis of “privity.” Federal Circuit adopts non-exhaustive list of considerations from Taylor v. Sturgell on non-party preclusion.</i>	
§ 11:25	Wi-Fi One, LLC v. Broadcom Corp. (Wi-Fi III)	304
	<i>Federal Circuit panel majority affirms PTAB’s conclusion that petitioner was not “in privity” with district court defendants because the petitioner did not have control over district court litigation and affirms PTAB’s conclusion denying “additional discovery” on the issue. Circuit Judge Reyna dissents urging that “privity” may exist in other situations.</i>	
§ 11:26	Worlds Inc. v. Bungie, Inc.	310
	<i>The IPR petitioner bears the burden of persuasion to demonstrate that its petitions are not time-barred under section 315(b) based on a complaint served on a real party in interest more than one year earlier. The IPR petitioner’s initial identification of the real parties in interest should be accepted unless and until disputed by a patent owner. Federal Circuit disagrees that the initial acceptance constitutes a “rebuttable presumption” that formally shifts a burden of production to the patent owner, but agrees that the patent owner must produce some evidence to support its argument that a particular third party should be named a real party in interest.</i>	
§ 11:27	Yeda Research & Development Co., Ltd. v. Mylan Pharmaceuticals Inc.	314
	<i>PTAB may rely on non-prior art evidence for indicating the level of ordinary skill in the art, what certain terms would mean to a POSITA, and how a POSITA would have understood a prior art disclosure.</i>	

Chapter 12 District Court Jurisdiction and Procedure 315

- § 12:1 Aatrix Software, Inc. v. Green Shades Software, Inc. 315

Federal Circuit (Judge Reyna concurred in the disposition) vacates district court’s dismissal of complaint under Rule 12(b)(6), where the district court failed to resolve factual disputes, failed to construe the claims, and refused to allow filing of an amended complaint before dismissing the complaint, finding that the asserted claims were drawn to patent-ineligible subject matter. Federal Circuit panel majority: district court erred in denying motion to file proposed second amended complaint where amended complaint raised fact issues on Alice step two. Federal Circuit panel majority implies that claim construction “may” be a prerequisite to deciding Alice step two. Circuit Judge Reyna dissents-in-part urging that panel majority went overboard in finding fact issues, and doing so opens section 101 enquiry, ultimately an issue of law, to extensive list of factual contentions that could essentially preclude decision at Rule 12(b) stage.

- § 12:2 AbbVie Inc. v. MedImmune Ltd. 318

In general, “a litigant may not use a declaratory-judgment action to obtain piecemeal adjudication of defenses that would not finally and conclusively resolve the underlying controversy.”

- § 12:3 AIDS Healthcare Foundation, Inc. v. Gilead Sciences, Inc. 320

Time consumed by litigation of a potential future controversy does not meet the “immediacy and reality” requirements for declaratory judgment jurisdiction. Potential of future litigation does not meet the immediacy and reality requirements for declaratory judgment jurisdiction. An interest in buying an infringing product is not an adverse legal interest for declaratory judgment jurisdiction. Absence of a covenant-not-to-sue does not create a declaratory judgment controversy.

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§ 12:4 *In re* BigCommerce, Inc. 322
“A domestic corporation incorporated in a state having multiple judicial districts ‘resides’ for purposes of the patent-specific venue statute, 28 U.S.C. § 1400(b), only in the single judicial district within that state where it maintains a principal place of business, or failing that, the judicial district in which its registered office is located.”

§ 12:5 *Disc Disease Solutions Inc. v. VGH Solutions, Inc.* 325
Federal Circuit concludes that original complaint complied with the “Iqbal/Twombly” standard even though it had been drafted pursuant to Form 18.

§ 12:6 *Exmark Manufacturing Co. v. Briggs & Stratton Power Products Group, LLC*..... 326
District Court erred by granting summary judgment that no reasonable juror could find the asserted claims invalid as anticipated or obvious because the claims had survived three reexaminations.

§ 12:7 *Exmark Manufacturing Co. v. Briggs & Stratton Power Products Group, LLC*..... 328
District court erred in excluding evidence of the validity of the asserted claim or how closely the asserted claim tracked the prior art.

§ 12:8 *Flexuspine, Inc. v. Globus Medical, Inc.*..... 329
District court does not abuse its discretion in declining to enter judgment on a portion of a jury’s verdict where the jury did not follow “stop instructions.”

§ 12:9 *In re* HTC Corp. 332
“Unlike a defendant challenging the denial of a § 1404(a) transfer motion, a defendant aggrieved by the denial of an improper-venue motion has an adequate remedy on appeal from a final judgment”—namely, an objection to improper venue, if not waived, may be asserted on appeal. Writs of mandamus cannot be used as substitutes for appeals “even though hardship may result from delay and perhaps unnecessary trial.” Federal Circuit reaffirms that foreign

corporations may be sued in any judicial district, and the “long-established rule that suits against aliens are wholly outside the operation of all the federal venue laws, general and special.”

§ 12:10 Hyatt v. United States Patent and Trademark Office 335

Federal Circuit reverses district court’s decision that it lacked subject matter jurisdiction over Hyatt’s petition for rule-making, but affirmed the district court’s grant of summary judgment in favor of the PTO on other grounds.

§ 12:11 Jack Henry & Associates, Inc. v. Plano Encryption Technologies LLC 338

District court has personal jurisdiction over party sending letters charging multiple banks with infringement. “An indemnitor has standing to participate in an action that could determine its liability.” Circuit Judge Stoll, joined by Circuit Judge Wallach, urges that Federal Circuit’s 1998 decision in Red Wing Shoe Co. should be revisited as contrary to Supreme Court precedent.

§ 12:12 John Bean Technologies Corp. v. Morris & Associates, Inc. 341

As a matter of first impression, district court abused its discretion in finding equitable estoppel based on activity beginning in 2002, twelve years prior to issuance of a reexamination certificate in 2014 on substantively amended or added claims.

§ 12:13 Knowles Electronics LLC v. Cirrus Logic, Inc. 344

Question whether PTAB is bound by prior court claim construction is avoided by panel majority—Circuit Judge Newman in dissent urges that PTAB is so limited.

§ 12:14 M-I Drilling Fluids UK Ltd. v. Dynamic Air Ltda. 346

Exercise of personal jurisdiction under Rule 4(k)(2) of the Federal Rules of Civil Procedure held proper over Brazilian company alleged to infringe U.S. patents aboard U.S. flagged ships operating in international waters. Judge Reyna’s concurrence, albeit in dicta, discusses application of U.S. patent law to U.S.-flagged ships in international waters.

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§ 12:15 Maxchief Investments Ltd. v. Wok & Pan, Ind., Inc. 350

Because a declaratory judgment action arises out of a patentee’s contacts with forum state only if those contacts relate in some material way to the enforcement or defense of a patent, minimum contacts prong requires some enforcement activity in forum state by patentee.

§ 12:16 *In re* Oath Holdings Inc. 351

Federal Circuit issues writ of mandamus directing district court to dismiss or transfer the case where district court, after a first remand, declined to follow Micron, and concluded that the defendant had waived venue. Issues of waiver or forfeiture of patent venue rights are governed by Federal Circuit law.

§ 12:17 SimpleAir, Inc. v. Google LLC (*SimpleAir V*) 353

District court errs in finding claim preclusion without comparing presently asserted patent claims to previously adjudicated patent claims. Claims in continuation application may be broader than claims in parent application, even though subject to a terminal disclaimer—thus differing from claims in reexamination. Filing of terminal disclaimer does not settle issue of claim preclusion. “A court may not presume that assertions of a parent patent and a terminally-disclaimed continuation patent against the same product constitute the same cause of action. Rather, the claim preclusion analysis requires comparing the patents’ claims along with other relevant transactional facts.” Whether subsequent suit is barred by Kessler doctrine requires comparing presently asserted patent claims to previously adjudicated patent claims.

§ 12:18 Vanda Pharmaceuticals Inc. v. West-Ward Pharmaceuticals International Ltd. 358

A district court has jurisdiction under the Hatch-Waxman Act over an action in which the asserted patent issued after an ANDA was filed and the complaint was filed before the ANDA applicant submitted a Paragraph IV certification for the asserted patent.

§ 12:19 Voter Verified, Inc. v. Election Systems & Software LLC 360
Federal Circuit concludes that Alice did represent an intervening change in the law from Mayo. Nevertheless, the Federal Circuit concludes that issue preclusion did not apply because section 101 in prior litigation had not been actually litigated.

§ 12:20 XY, LLC v. Trans Ova Genetics, L.C. 361
When the Federal Circuit affirms PTAB’s final written decision in co-pending IPR proceeding, it has collateral estoppel effect on all pending or co-pending actions.

§ 12:21 In re ZTE (USA) Inc. 363
As a matter of first impression, the Federal Circuit holds that Federal Circuit law, as opposed to otherwise applicable regional circuit law, governs placement of the burden of persuasion on proper venue under section 1400(b). As a matter of first impression, the Federal Circuit holds that, as a matter of Federal Circuit law, upon a motion by a defendant challenging venue in a patent case, the plaintiff bears the burden of establishing proper venue.

Chapter 13 Appellate Court Jurisdiction and Practice 367

§ 13:1 Altaire Pharmaceuticals, Inc. v. Paragon Biotech, Inc. 367
Federal Circuit panel majority concludes that, under the facts of the case, a petitioner for post-grant review (PGR) has Article III standing to appeal PTAB decision finding that the asserted claims had not been proved to be unpatentable.

§ 13:2 Arthrex, Inc. v. Smith & Nephew, Inc. 371
Federal Circuit concludes that a right of appeal exists under 28 U.S.C. § 1295 even though there was no “final written decision” under section 119.

§ 13:3 E.I. duPont de Nemours & Co. v. Synvina C.V. 373
Competitor who “is engaged or will likely engage in an [] activity that would give rise to a possible infringement

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suit” has Article III standing to appeal an adverse decision by PTAB in an IPR. A petitioner who appeals from an IPR decision need not face “a specific threat of infringement litigation by the patentee” to establish jurisdiction. Rather, the petitioner must generally show a controversy “of sufficient immediacy and reality” to warrant the requested judicial relief.

§ 13:4	Hamilton Beach Brands, Inc. v. f real! Foods, LLC.....	375
	<i>“[A] party must file a cross-appeal when acceptance of the argument it wishes to advance would result in a reversal or modification of the judgment rather than an affirmation.”</i>	
§ 13:5	Impax Laboratories Inc. v. Lannett Holdings Inc.....	377
	<i>In a “close case,” Federal Circuit may defer to the district court’s fact findings and legal conclusion of nonobviousness.</i>	
§ 13:6	Jazz Pharmaceuticals, Inc. v. Amneal Pharmaceuticals, LLC.....	379
	<i>Federal Circuit concludes that it has jurisdiction to consider an appeal involving “instituted” claims and grounds and is not required to remand for the PTAB to consider “non-instituted” claims and grounds where neither party requested the same.</i>	
§ 13:7	JTEKT Corp. v. GKN Automotive Ltd.	380
	<i>Appellants must demonstrate Article III standing in appeals to the Federal Circuit. In appeals in IPRs by petitioner from PTAB decisions concluding challenged claims are not unpatentable, the petitioner must show the requisite injury in fact for Article III standing. That a petitioner has no product on the market does not preclude Article III standing if there is requisite potential infringement liability. A petitioner that is not currently engaging in infringing activity must establish that it has concrete plans for future activity that creates a substantial risk of future infringement or likely cause the patentee to assert a claim of infringement.</i>	

§ 13:8	Nantkwest v. Iancu	381
	<i>Federal Circuit, en banc, reverses earlier panel opinion and holds that an applicant taking a section 145 appeal does not compel an applicant to pay the PTO’s attorney’s fees.</i>	
§ 13:9	PGS Geophysical AS v. Iancu	383
	<i>After SAS, the Federal Circuit concludes that: (1) SAS requires a yes or no decision to institute IPR, and if yes, that includes all claims and all grounds alleged in a petition; (2) it has jurisdiction to review a PTAB decision that addressed less than all of the challenged claims; and (3) it need not, and will not, sua sponte, revive the “non-instituted” claims and grounds.</i>	
§ 13:10	Wi-Fi One, LLC v. Broadcom Corp.....	385
	<i>Federal Circuit en banc overrules Achates and concludes that time-bar determinations under section 315(b) are appealable.</i>	
§ 13:11	Xitronix Corp. v. Kla-Tencor Corp.....	388
	<i>Federal Circuit concludes that, after Gunn v. Minton, it does not have appellate jurisdiction in a case solely alleging a Walker Process monopolization claim based on alleged fraud on the PTO.</i>	

Chapter 14 Ownership Agreements and Inventorship 391

§ 14:1	Advanced Video Technologies LLC v. HTC Corp.....	391
	<i>Divided Federal Circuit concludes various provisions in several agreements, including “will assign” language, were insufficient to transfer an inventor’s ownership interest. Circuit Judge O’Malley, in a concurrence, reiterates her view that Federal Circuit precedent regarding involuntary joinder under Rule 19 is wrong, and requires en banc review.</i>	
§ 14:2	James v. j2 Cloud Services, LLC.....	394
	<i>Agreement assigning or agreeing to assign copyright claims in computer software does not necessarily convey patent rights. Federal Circuit questions (but does not decide)</i>	

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whether “hired to invent” doctrine of Dubilier and Standard Parts applies to “two artificial legal entities” to which the inventor was not personally a party. Federal Circuit concludes that individual asserting inventorship rights in software-based invention has Article III standing despite a software development agreement that purportedly assigns copyright rights in computer code.

Chapter 15 Design Patents 399

§ 15:1 **Advantek Marketing, Inc. v. Shanghai Walk-Long Tools Co., Ltd.** 399

Prosecution history estoppel may apply to non-elected embodiments after a restriction requirement where no further application is filed on the non-elected embodiments. Prosecution history estoppel does not bar infringement action when accused product falls outside the scope of the purported surrender. Federal Circuit, in concluding that prosecution history estoppel does not apply because accused product falls outside the scope of purported surrender and because accused product incorporates a “component” of the patented design, potentially misapplies Supreme Court’s Samsung decision.

§ 15:2 **In re Maatita**..... 403

Federal Circuit concludes that a single, two-dimensional plan-view drawing of a shoe bottom design is sufficient to meet the definiteness requirement.

Chapter 16 Miscellaneous..... 407

§ 16:1 **Raytheon Co. v. Indigo Systems Corp.**..... 407

Federal Circuit issues an opinion addressing California trade secret law and a claim for attorney’s fees under the Texas Theft Liability Act (TTLA).

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