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I. Patentability Requirements

A. Inventorship/Invention and Priority Dates

1. Limitation-by-Limitation Analysis

“Further, given that BearBox must demonstrate that Mr. Storms contributed significantly to the conception or reduction to practice of at least one claim, we see no error with the district court’s limitation-by-limitation approach in this case.” BearBox LLC v. Lancium LLC, 2023-1922, 1/13/25 (citation omitted).

B. Prior Art Invalidity

1. Reference Disclosure

a. Inherency

i. Optional Discloses Not Present

“[Appellant]’s contention that [the reference] confirms arrhythmias using only PPG – and not, as the claims of the Challenged Patents do, using ECG – is incorrect. As the Board recognized, [the reference] states that when an irregular heart condition is detected, the PPG measurement “*preferably* continues,” which the Board fairly read to indicate that [the reference] teaches embodiments in which the PPG measurement has not continued.” AliveCor, Inc. v. Apple Inc., 2023-1512, 3/7/25 (emphasis added) (citation omitted).

ii. Product By Process Claims

“Restem argues inherency is automatic for product-by-process claims, and the Board legally erred in finding Majore did not inherently anticipate claim 1 of the ’176 patent. We do not agree.” Restem, LLC v. Jadi Cell, LLC, 2023-2054, 3/4/25.

b. Disclosure to POSITA

i. Not Explicit

“And Samsung’s argument was based on the knowledge of a person of ordinary skill in the art, as explained above. Therefore, even if Lynk Labs is correct that Martin does not explicitly disclose determining the forward voltage of the LEDs based on the peak voltage of a rectified voltage, that is of no consequence based on the facts and argument before us.” Lynk Labs, Inc. v. Samsung Elecs. Co., 2023-2346, 1/14/25.

2. Anticipation (§ 102)

a. Publications/Patents

i. Public Accessibility – repository documents

“There can be little doubt that published patent applications are publicly accessible within the meaning of our precedent.” *Lynk Labs, Inc. v. Samsung Elecs. Co.*, n.5, 2023-2346, 1/14/25.

b. Published/Issued Application Under 102(e)

If a “published non-provisional application [] properly claims priority to [a] Provisional Application . . . , whether [it] qualifies as prior art under pre-AIA § 102(e) turns on whether [that non-provisional application] is entitled to the priority date of the provisional application” when the critical date of the patent being challenged falls between. *In re Riggs*, 2022-1945, 3/24/25.

“Even if one demonstrates that a provisional application provides written description support for one claim of the non-provisional application or patent, the provisional application must also provide written description support for the specific portions of the patent specification identified and relied on in the prior art rejection.” *In re Riggs*, 2022-1945, 3/24/25.

3. Obviousness (§ 103)

a. Relationship to Anticipation

“In according *any* weight to the mere fact that there is a difference in the basis sequence tables in the Philips reference and ’718 patent, the Board committed legal error by “deviat[ing] impermissibly from the invalidity theory set forth in [the] petition.”” *Honeywell Int’l, Inc. v. 3G Licensing S.A.*, 2023-1354, 1/2/25 (emphasis in original) (quoting *M & K Holdings, Inc. v. Samsung Elecs. Co., Ltd.*, 985 F.3d 1376, 1385 (Fed. Cir. 2021)).

b. Differences Between the Prior Art and the Claims at Issue

i. Means Plus Function Limitations

For “a means-plus-function limitation under 35 U.S.C. § 112, ¶ 6 [Appellant] primarily argues that [the prior art] does not teach the claimed structure [but] admitted before the Board that [the prior art] discloses [an] operation of the feature data generation unit in a form of software.” Despite “silence on how” that operation was structurally implemented, there was substantial evidence because obviousness art need not “enable its own disclosure.” *Apple Inc. v. Gesture Tech. Partners, LLC*, 2023-1475, 3/4/25 (quoting *Raytheon Techs. Corp. v. General Elec. Co.*, 993 F.3d 1374, 1380 (Fed. Cir. 2021)).

ii. Recognizing Need for a Solution

“[I]t does not follow that a claimed solution to an unknown problem is *necessarily* non-obvious.” “Accordingly, that the specific problem the inventors [] purported to solve via the claimed dosing regimen was unknown does not necessarily mean that the dosing regimen itself was not obvious.” *Immunogen, Inc. v. Stewart*, 2023-1762, 3/6/25.

iii. Claimed Subject Matter/Properties

“Moreover, the Challenged Patents’ machine learning claims, accorded their plain and ordinary meaning in light of the specification, do not require any specific type of machine learning algorithm or a precise method for inputting and analyzing data to detect arrhythmias. [The prior art’s] descriptions of machine learning algorithms provide sufficient evidentiary support for the Board’s obviousness findings, findings that were made at the same level of specificity as the claims.” *AliveCor, Inc. v. Apple Inc.*, 2023-1512, 3/7/25.

c. Motivation/Apparent Reason to Combine/Modify

i. Limited equally viable options

“By failing to recognize that the claimed modification needed only to be desirable in light of the prior art and not the “best” or “preferred” approach, the Board committed legal error.” *Honeywell Int’l, Inc. v. 3G Licensing S.A.*, 2023-1354, 1/2/25.

ii. Known Reason to Combine

“Requiring the motivation to modify to be the same motivation as that of the patent inventor has no basis in obviousness doctrine.” *Honeywell Int’l, Inc. v. 3G Licensing S.A.*, 2023-1354, 1/2/25.

d. Reasonable Expectation of Success

i. Unclaimed Requirements

“[T]he obviousness inquiry is generally agnostic to the particular motivation of the inventor . . . the district court was not required to determine that a person of ordinary skill in the art would have had a reasonable expectation of eliminating ocular toxicity . . . ; indeed, the claims are silent as to any ocular toxicity problem.” *Immunogen, Inc. v. Stewart*, 2023-1762, 3/6/25.

C. Invalidity Based on § 112

1. Enablement (§ 1)

a. Full Scope of the Claim

i. Open-Ended Limitations

“Intervenors argue that the recited “unleached portion” in the asserted claims demonstrates a lack of enablement because that element “broadly claims every process that does not include leaching” . . . the claimed PDC is not a process claim, and the recitation of “unleached portion” simply distinguishes the claimed PDC from leached diamond tables.” *US Synthetic Corp. v. Int’l Trade Comm’n*, 2023-1217, 2/13/25.

b. Timing of Analysis

“The later-discovered valsartan-sacubitril complexes, which arguably may have improved upon the “basic” or “underlying” invention claimed in the ’659 patent, cannot be used to “reach back” and invalidate the asserted claims.” *Novartis Pharms. Corp. v. Torrent Pharma Inc.*, 2023-2218, 1/10/25 (quoting *In re Hogan*, 559 F.2d 595, 606 (CCPA 1977)).

2. Written Description (§ 1)

a. Preamble and Jepson Limitations

“[T]he limiting preamble of a Jepson claim must be supported with sufficient written description, and what constitutes sufficiency varies depending on the knowledge of the pertinent person of ordinary skill in the art. A patentee has the burden of providing written description; in a Jepson claim, that burden extends to the limiting preamble.” *In re Xencor, Inc.*, 2024-1870, 3/13/25.

b. Claimed Measurement Range

“We have affirmed findings of adequate written description for “open-ended claims” where the upper bound “would be limited by what a person skilled in the art would understand to be workable” and where the patent’s specification adequately supported that range.” *Regeneron Pharms., Inc. v. Mylan Pharms. Inc.*, 2024-1965, 1/29/25, quoting *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1576 (Fed. Cir. 1985).

D. Double Patenting

1. Obviousness-Type

“[T]he fact that the ’865 patent’s narrower stability limitation is “encompassed” by the reference patent’s stability limitation does not change the outcome: We have made clear that “domination”—where one patent with a broader claim reads on an invention defined by another patent’s narrower claim, as a genus does a species, it “dominates” the latter

patent—“by itself[] does not give rise to ‘double patenting.’” Regeneron Pharms., Inc. v. Mylan Pharms. Inc., 2024-1965, 1/29/25.

E. Section 101

1. Abstract Idea Exclusion

a. Manufacture/Composition

“[T]he asserted claims [] are not directed to an abstract idea. Rather, the claims are directed to a specific, non-abstract composition of matter—a PDC—that is defined by its constituent elements (i.e., diamond, cobalt catalyst, substrate), particular dimensional information (i.e., grain size, lateral dimension of the diamond table), and quantified material properties (i.e., coercivity, specific permeability, and specific magnetic saturation), whereby the material properties correlate to the diamond table’s structure and thereby further inform a skilled artisan about what the claimed PDC is.” US Synthetic Corp. v. Int’l Trade Comm’n, 2023-1217, 2/13/25.

“[T]he claimed PDC is not an abstract result of generic computer functionality, but instead is a physical composition of matter defined by its constituent elements, dimensional information, and inherent material properties.” US Synthetic Corp. v. Int’l Trade Comm’n, 2023-1217, 2/13/25.

F. Timing of Expiration

1. Term Extension

a. FDA Extensions

“[I]n the context of reissued patents, the Hatch-Waxman Act contemplates PTE for those patents and only those patents with claims directed to drug products whose period of exclusivity was delayed by FDA review. That purpose applies in this case, since construing “the patent” in subsection 156(c) as the original patent compensates Merck for the period of exclusivity lost due to regulatory delay. On the other hand, Aurobindo’s construction denies Merck compensation for all but a small period of the delay. There is no reason why the Hatch-Waxman Act’s purpose would be served by disabling extensions of the unexpired term solely based on a *patent holder’s decision to seek reissue*, and Aurobindo offers none.” “[W]e agree with the district court that the RE’733 reissue patent was entitled to the five-year PTE based on the ’340 patent’s issue date.” Merck Sharp & Dohme B.V. v. Aurobindo Pharma USA, Inc., 2023-2254, 3/13/25 (emphasis added).

II. Other Defenses

A. Lack of Personal Jurisdiction

1. Over Accused Infringer

a. aBLA-Based Complaints

“The record as a whole supports the district court’s finding that SB intends to distribute SB15 nationwide, including in West Virginia.” “SB has signed multiple contracts with Biogen covering numerous aspects of the commercialization of SB15 within the U.S. and detailing the two companies’ responsibilities and rights.” “But there is simply no good reason, under the constitutional standard, for demanding such singling-out evidence [as to the West Virginia forum] as a substitute for persuasive evidence of nationwide targeting without a carve-out.” *Regeneron Pharms., Inc. v. Mylan Pharms. Inc.*, 2024-1965, 1/29/25.

III. Literal Infringement

A. Reverse Doctrine of Equivalents

“We find Steuben’s arguments compelling, but need not decide whether RDOE survived the 1952 Patent Act.” “The jury heard conflicting testimony from experts regarding the principle of operation of claim 26 of the ’591 patent. Dr. Sharon’s testimony constitutes substantial evidence for the jury’s rejection of RDOE.” *Steuben Foods, Inc. v. Shibuya Hoppmann Corp.*, 2023-1790, 1/24/25.

B. Scope of ITC Infringement Analysis

Finding of infringement affirmed where tests in China showed claimed range and peer review articles and expert testimony supported finding that any changes during transport and storage would be unlikely to take the product out of the claimed range at the point of importation. *Wuhan Healthgen Biotechnology Corp. v. Int’l Trade Comm’n*, 2023-1389, 2/7/25.

IV. DOE Infringement

A. Substantial Equivalence

1. Function-Way-Result Test

a. “Way” Analysis

“For the identified structure of conveyor 106, Dr. Sharon testified the way conveyor 106 performs its role in the overall function of the claim limitation is by moving the bottles via rotating around a pulley system, causing the bottles to move along the machine. Dr. Sharon testified the accused product’s rotary wheels¹ operate in substantially the same way by “rotat[ing] to bring the bottles from . . . one station to the next.”” “This is substantial evidence by which the jury could find infringement.” “Dr. Sharon’s testimony went

directly to the “way” the structures operate in the context of the claimed function, and provided the jury substantial evidence with which to find infringement.” *Steuben Foods, Inc. v. Shibuya Hoppmann Corp.*, 2023-1790, 1/24/25 (citation omitted).

B. Vitiation Bar/Specific Exclusion

1. Opposite Feature/Element/Step

“[A] finding of infringement under DOE would vitiate the claim limitation. Something that is done non-continuously cannot be the equivalent of something done continuously.” *Steuben Foods, Inc. v. Shibuya Hoppmann Corp.*, 2023-1790, 1/24/25.

V. Relief

A. Entire Market Value Rule/Convoyed Sales

1. Convoyed Sales

“Where, as here, the issue is incremental damages for portions of products *not* covered by the patent, the proper inquiry is whether the unpatented components are convoyed sales.” *Wash World Inc. v. Belanger Inc.*, n.5, 2023-1841, 3/24/25 (emphasis in original).

Expert and fact witness testimony that disputed components are part of a “typical set of components that are sold with a [] system” and “approximately three quarters of [] customers purchased [those components] already installed” “does not demonstrate the requisite functional relationship.” “As [appellee] has not directed us to any other evidence of a functional relationship between [the patented portion] and the listed additional components, we conclude that there is no evidence in the record that could support awarding damages for convoyed sales.” *Wash World Inc. v. Belanger Inc.*, n.5, 2023-1841, 3/24/25.

B. Injunction

1. Preliminary Injunction

a. Irreparable Harm

i. Causal Nexus

Even though defendant’s aBLA included noninfringing scope, “[t]here is no evidence that SB possesses or plans to sell or offer to sell a non-infringing biosimilar under its approved aBLA.” “[T]he fact that the scope of SB’s approved aBLA is broader than that of the ’865 patent’s claims does not defeat causal nexus; Regeneron’s harms are likely to flow from SB’s *infringing* conduct.” *Regeneron Pharms., Inc. v. Mylan Pharms. Inc.*, 2024-1965, 1/29/25 (emphasis in original).

b. Likelihood of Success

i. Invalidity

Determination that patentee was likely to withstand OTDP challenge affirmed based on claim differences. “It suffices for us to conclude that two claim differences—“at least 98%” stability and glycosylation—render the ’865 and ’594 claims patentably distinct.” *Regeneron Pharms., Inc. v. Mylan Pharms. Inc.*, 2024-1965, 1/29/25.

ii. Impact of Short Patent Term Remaining

“Bearing in mind the little time left before the preliminary injunction expires and that the district court’s claim constructions may well change after it conducts a Markman hearing, we discern no abuse of discretion in the district court’s preliminary determinations on likelihood of success.” *Power Probe Grp., Inc. v. Innova Elecs., Corp.*, 2024-1166, 3/13/25 (nonprecedential).

C. Lost Profits

1. Non-Plaintiff Lost Profits

“Mr. Tamura’s conclusory testimony provided no basis for the jury to find that Roland U.S.’s profits inherently flowed to Roland during the relevant period other than the fact that Roland U.S. is a wholly owned subsidiary. In *Mars*, we rejected the notion that such a corporate relationship, without more, was sufficient to recover the subsidiary’s lost profits. *Mars*, 527 F.3d at 1367. Mr. Tamura did not, for example, explain who controlled Roland U.S.’s distribution of profits or what corporate controls were in place to ensure that Roland U.S.’s profits became those of Roland Japan. Nor did Roland present documentary evidence of Roland’s and Roland U.S.’s historical financial information showing an unwavering flow of profits. We need not delineate what types of evidence would be sufficient to establish inexorable flow. Suffice it to say, under *Mars*, the testimony presented at trial falls short of substantial evidence to support the jury’s lost profits award.” *Roland Corp. v. inMusic Brands, Inc.* 2023-1327, 3/27/25 (nonprecedential).

VI. Claim Construction

A. Claim Language

1. Plain and Ordinary Meaning

a. Time Frame

“Because valsartan-sacubitril complexes were undisputedly unknown at the time of the invention, the ’659 patent could not have been construed as claiming those complexes as a matter of law.” *Novartis Pharms. Corp. v. Torrent Pharma Inc.*, n.5, 2023-2218, 1/10/25. (but see *Innogenetics*).

b. Statutory subject matter type: system v. device v. method v. computer-readable medium

“The Board properly rejected Gesture’s narrow construction of “apparatus” as precluding a distributed system because the term’s plain meaning “include[s] either a singular device or a combination of devices.”” In re Gesture Tech. Partners LLC, 2024-1037, 1/27/25 (nonprecedential).

c. Exceptions

i. Prosecution/Specification Disavowal

“This high bar [for specification disavowal] is not satisfied here where, at most, the specification identifies shortcomings in the prior art that are not specifically directed to the handle.” IQRIS Techs. LLC v. Point Blank Enters., Inc., 2023-2062, 3/7/25.

d. Negative Limitations

“We do not read “avoid” as requiring affirmative activity such as discontinuing [specific medicines]. The plain and ordinary meaning of “avoid” is also consistent with claim coverage in situations in which patients are simply not taking [specific medicines].” In re Strongbridge Dublin Ltd., 2023-2302, 3/10/25 (nonprecedential).

2. Open/Closed Claims, Generic and Negative Limitations

a. Comprising

i. No negative limitation

“Under the plain and ordinary meaning of the term, we conclude that “a plurality of LEDs connected in series” may include either a plurality of individual LEDs or a plurality of LED circuits connected in series because both include a “plurality of LEDs.”” Lynk Labs, Inc. v. Samsung Elecs. Co., 2023-2346, 1/14/25.

b. Conjoined or Additional Elements

“[T]he district court did properly engage with the claims, consistent with *Phillips* and established claim construction principles. It did so by evaluating, under *Becton*, whether the implication of separateness applied, which necessarily requires a review of the claims themselves.” Regeneron Pharms., Inc. v. Mylan Pharms., Inc., 2024-2351, 3/14/25.

“Because the claims and specification of the ’865 patent only reinforce that the claimed components are distinct, we agree with the district court that the implication of separateness has not been overcome, and the claimed “VEGF antagonist” and “buffer” are distinct limitations.” Regeneron Pharms., Inc. v. Mylan Pharms., Inc., 2024-2351, 3/14/25.

“[I]t is difficult to envision Becton’s clear implication of separateness being overcome without at least a suggestion of non-separateness in the intrinsic evidence.” *Regeneron Pharms., Inc. v. Mylan Pharms., Inc.*, 2024-2351, 3/14/25.

c. Defining/Positioning/Connecting Terms

In the absence of “claim language [that] suggests the claim is limited to direct connections,” the claim term “mounted” “encompasses both indirect and direct connections” even if “the specification . . . only depicts embodiments having a direct connection.” *Wash World Inc. v. Belanger Inc.*, 2023-1841, 3/24/25.

3. Effect of Other Limitations in Claim

a. No Surplusage

Court referenced the principle that a claim construction that gives meaning to all the terms of the claim is preferred over one that does not do so and concluded that limiting the construction with a “single entity” requirement does that, and it does so in a way that reflects a relevant dictionary definition.” *Lashify, Inc. v. Int’l Trade Comm’n*, 2023-1245, 3/5/25.

b. Different structural limitations are physical distinct

“[T]he district court did properly engage with the claims, consistent with *Phillips* and established claim construction principles. It did so by evaluating, under *Becton*, whether the implication of separateness applied, which necessarily requires a review of the claims themselves.” *Regeneron Pharms., Inc. v. Mylan Pharms., Inc.*, 2024-2351, 3/14/25.

c. Meanings of different terms should be sensibly related

i. Different Levels of Specificity Retained

“The ’033 patent claims use precise language, i.e., the recitation of another element, when referencing materials in their compound form.” “This suggests that the ’033 patent uses explicit language to refer to a compound when a compound is intended, and when no such language is included, only the elemental form is intended.” *HD Silicon Sols. LLC v. Microchip Tech. Inc.*, 23-1397, 2/6/25.

“Dependent claim 12 refers to a “chlorine-based etchant,” which the specification defines as including both chlorine compounds and elemental chlorine. That further demonstrates that when the ’033 patent references “tungsten” on its own, it is referring to tungsten in its elemental form.” *HD Silicon Sols. LLC v. Microchip Tech. Inc.*, 23-1397, 2/6/25 (citations omitted).

B. Written Description

1. Lexicography

a. Definition by Intrinsic Use

Intrinsic use disregarded. “[T]he specification refers to element (16), which is directly pulled, as a “pull cord,” but refers to element (18), which is indirectly pulled, simply as a “cord.” In our view, this is the strongest evidence in support of the district court’s construction. While this is a close question, we are not inclined under our precedent to limit the term “pull cord.” “Given the claim language and absence of lexicography or disavowal, we do not adopt the district court’s interpretation requiring a pull cord to be directly pulled by a user.” *IQRIS Techs. LLC v. Point Blank Enters., Inc.*, 2023-2062, 3/7/25.

“[W]hen referencing the properties of tungsten that make it a desirable material for use in a local interconnect, the specification refers to properties unique to tungsten itself—not compounds of tungsten— such as low resistivity and chemical stability.” Court narrowly construed “comprising tungsten” as not covering compounds. *HD Silicon Sols. LLC v. Microchip Tech. Inc.*, 23-1397, 2/6/25.

b. Overcome by Prosecution History

“Although the specification states “the term ‘isolated cell’ refers to a cell that has been isolated from the subepithelial layer of a mammalian umbilical cord,” the claim scope was narrowed during prosecution to a “cell population.”” *Restem, LLC v. Jadi Cell, LLC*, 2023-2054, 3/4/25.

2. Background

“Lynk Labs argues that the first quote does not define “match” but instead is an embodiment from prior-art reference Allen. But even “prior art cited in a patent . . . constitutes intrinsic evidence.” *V-Formation, Inc. v. Benetton Grp. SpA*, 401 F.3d 1307, 1311 (Fed. Cir. 2005) (citation omitted). Therefore, this first quote is relevant intrinsic evidence of the meaning of “matches” in the art.” *Lynk Labs, Inc. v. Samsung Elecs. Co.*, 2023-2346, 1/14/25.

C. Prosecution History

1. Related Applications

a. Not Applicable to Patent at Issue

“[I]f the limitations at issue are dissimilar, we generally cannot accept, without more support, that an applicant’s disclaimer with respect to one claim would be equally applicable to another claim.” “[W]e must not divorce the analysis from the claim language at issue by looking more broadly to the claims’ subject matter.” *Maquet Cardiovascular LLC v. Abiomed Inc.*, 2023-2045, 3/21/25.

2. Examiner's Statements

“The examiner issued a second notice of allowance, noting that Völker lacks several features of the invention.” “[Applicant]’s silence in response to the examiner’s second notice of allowance, is not, under these circumstances, a clear and unmistakable claim disavowal of a guide wire running through the rotor blades.” Maquet Cardiovascular LLC v. Abiomed Inc., 2023-2045, 3/21/25.

D. Extrinsic Evidence

1. Other Patents

“The invention of the ’659 patent, as construed by the district court, is a composition in which valsartan and sacubitril are administered “in combination.” As explained above, the patent does not claim as its invention valsartan-sacubitril complexes. Indeed, Novartis obtained separate, later patents to such complexes.” Novartis Pharms. Corp. v. Torrent Pharma Inc., 2023-2218, 1/10/25.

E. Limited, Technical, and Ordinary Meaning Constructions

1. Construction Language Addressing Legal Issue

“The district court’s construction of the seed-delivery-system terms at claim construction was the same construction read to the jury. The “no disclaimer” language was not part of the district court’s construction of the seed-delivery-system terms. This language merely indicated that the district court rejected AGCO’s disclaimer argument.” Deere & Co. v. AGCO Corp., 2023-1811, 1/24/25 (citation omitted) (nonprecedential).

VII. Procedural Law

A. Applicable Circuit Law

1. Request for New Judge on Remand

CAFC ordered a new judge on remand under 4th circuit law where “the trial judge’s statements indicate that he did not intend to manage a fair trial with respect to the issues in this case.” Trudell Med. Int’l v. D R Burton Healthcare LLC, 2023-1777, 2/7/25.

B. Preclusion

1. Issue Preclusion - Collateral Estoppel

a. Same Party

Where the party in the prior appeal is identified as the real party in interest for the present appeal, the “prior action featured full representation of the estopped party” requirement is met. In re Riggs, 2022-1945, 3/24/25.

C. New Trial; Altering or Amending Judgment (Rule 59)

1. Conditional After JMOL Grant

“Because the district court did not provide any basis for granting a new trial that is not subsumed by our analysis regarding the JMOLs, we reverse the conditional grant of a new trial on infringement.” *Steuben Foods, Inc. v. Shibuya Hoppmann Corp.*, 2023-1790, 1/24/25.

D. Rule 41(b) Dismissal for Failure to Prosecute

Rule 41(b) can be triggered by delay after a mistaken order closing the case. “To be clear, the district court was mistaken in its belief that there were no remaining issues in the case. But mistaken or not, the district court made clear that it regarded the case as over.” *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 2023-1772, 2/28/25 (nonprecedential).

E. Preemption

“[W]hen determining whether federal patent law preempts a state law cause of action, we do not mechanically compare the required elements of the state law claim to the objectives embodied by federal patent law.” “[T]he conversion claim is replete with “patent-like” language typically invoked when a party asserts inventorship or infringement of a patent.” “[W]e affirm the district court’s determination that federal patent law preempts BearBox’s state law conversion claim.” *BearBox LLC v. Lancium LLC*, 2023-1922, 1/13/25.

F. Discovery/Evidence

1. Expert Testimony

a. Extent of Required Expert Credentials

“Given the nature of the claims, and the fact that the Board only relied on [the expert] (in this context) for the general applicability of machine learning, the Board concluded that more advanced expertise in computer science and machine learning were “not prerequisites for qualifying a person of ordinary skill in the art.” We discern no error in this holding.” *AliveCor, Inc. v. Apple Inc.*, 2023-1512, 3/7/25 (citation omitted).

b. Applying Claim Construction

The court identified how the expert’s declaration assigned meanings to claim terms contrary to the claim construction. “The methodological unsoundness of [the expert]’ declaration provides an independent basis by which the district court abused its discretion in allowing [the expert] to testify at trial.” *Trudell Med. Int’l v. D R Burton Healthcare LLC*, 2023-1777, 2/7/25.

c. Excluding Late Reports

“[I]n his reply report, Dr. McClellan acknowledged and generally disagreed with Lancium’s proposed constructions yet failed to go one step further and apply and analyze Lancium’s proposed constructions until his untimely supplemental report. On this record, the district court’s rejection of BearBox’s proffered justification for its delay does not constitute an abuse of discretion.” *BearBox LLC v. Lancium LLC*, 2023-1922, 1/13/25 (citation omitted).

2. Exclusion for Discovery Failures (Rule 37)

Expert’s “seven-page declaration, to the extent it could be considered an expert report, was submitted almost a month after the close of discovery on September 30, 2022. Under Rule 37, therefore, the proper result is exclusion of Dr. Collins’ noninfringement testimony absent a showing that the failure to disclose was either substantially justified or harmless.” *Trudell Med. Int’l v. D R Burton Healthcare LLC*, 2023-1777, 2/7/25.

“[A]fter the district court amended the case schedule, D R Burton indicated it did not intend to submit a noninfringement expert report. The accelerated case schedule therefore does not provide substantial justification for D R Burton’s failure to disclose.” *Trudell Med. Int’l v. D R Burton Healthcare LLC*, 2023-1777, 2/7/25 (citation omitted).

“The scheduling order indicated that after the close of discovery, “[n]o other expert reports will be permitted without either the consent of all parties or leave of the Court.” Thus, BearBox was required either to seek leave of the court or to obtain consent from Lancium to serve the supplemental report. But BearBox sought “neither.”” “Where a party fails to comply with the court’s scheduling order, the district court has the authority to sanction a party by “prohibiting the disobedient party from . . . introducing designated matters in evidence,” i.e., otherwise admissible testimony. Fed. R. Civ. P. 37(b). On this record, the district court did not err in concluding that this factor weighs in favor of exclusion.” *BearBox LLC v. Lancium LLC*, 2023-1922, 1/13/25 (citations omitted).

3. Protective Orders and Sealed Papers

Speculation as to potential violations of a protective order inadequate to block access to source code. In re *Micron Tech. Inc.*, 2025-117, 2/26/25.

G. International Trade Commission/Customs

1. Domestic Industry

“The provision covers significant use of “labor” and “capital” without any limitation on the use within an enterprise to which those items are put, i.e., the enterprise function they serve. In particular, there is no carveout of employment of labor or capital for sales, marketing, warehousing, quality control, or distribution.” *Lashify, Inc. v. Int’l Trade Comm’n*, 2023-1245, 3/5/25.

“[T]he Commission must count [a complainant]’s employment of labor and capital even when they are used in sales, marketing, warehousing, quality control, or distribution, and the Commission must make a factual finding of whether those qualifying expenses are significant or substantial based on “a holistic review of all relevant considerations.”” *Lashify, Inc. v. Int’l Trade Comm’n*, 2023-1245, 3/5/25.

“The investment-to-revenue ratio can indicate whether an investment is significant and substantial. A high ratio signals the company is investing heavily in the industry despite comparatively low revenue, highlighting the industry’s importance and value to the company, which can be predictive of a significant market.” *Wuhan Healthgen Biotechnology Corp. v. Int’l Trade Comm’n*, 2023-1389, 2/7/25.

“Though the dollar amounts of Ventria’s Optibumin investments are small, the Commission found all of the investments are domestic, all market activities occur within the United States, and the high investment-to-revenue ratios indicate this is a valuable market. Under these circumstances, there is substantial evidence for the Commission’s finding that the domestic industry requirement is satisfied.” *Wuhan Healthgen Biotechnology Corp. v. Int’l Trade Comm’n*, 2023-1389, 2/7/25 (citation omitted).

H. Transfer to New Judge or Venue

Reassignment under 4th circuit law where “the trial judge’s statements indicate that he did not intend to manage a fair trial with respect to the issues in this case.” *Trudell Med. Int’l v. D R Burton Healthcare LLC*, 2023-1777, 2/7/25.

1. Sources of Proof Factor

“The court also reasonably declined to assign significant weight to the compulsory process or the sources of proof factors given Databricks’s failure to identify any witness in NDCA unwilling to come to trial or any source of proof that was not also readily accessible from EDTX.” *In re Databricks, Inc.*, 2025-113, 3/4/25 (nonprecedential).

2. Compulsory Process/Unwilling Witness Factor

“The court also reasonably declined to assign significant weight to the compulsory process or the sources of proof factors given Databricks’s failure to identify any witness in NDCA unwilling to come to trial or any source of proof that was not also readily accessible from EDTX.” *In re Databricks, Inc.*, 2025-113, 3/4/25 (nonprecedential).

3. Judicial Economy Consideration

“[T]he district court could reasonably find that the judicial economy considerations here (combined with all other factors) were strong enough to support retaining this case, given gained familiarity through relatively recent, substantive hearings construing the patent claims in other cases.” *In re Databricks, Inc.*, 2025-113, 3/4/25 (nonprecedential).

VIII. Federal Circuit Appeals

A. New Arguments/Issues on Appeal/Forfeiture/Waiver/Judicial Estoppel

1. District Court/ITC Appeals

a. Judicial Estoppel

“Given that [appellee] prevailed on [appellant]’s renewed motion based, in part, on [appellee]’s argument that the court could identify the amount of damages the jury awarded based on convoyed sales, it would be inequitable to allow [appellee] to prevail on appeal by telling us, in direct contradiction, that we cannot determine the amount of damages that were based on convoyed sales.” *Wash World Inc. v. Belanger Inc.*, 2023-1841, 3/24/25.

b. Evidence Proffer

“Here, following the district court’s ruling from the bench that the testimony was hearsay, counsel for BearBox made no offer of proof as to what Mr. Storms’ response would have been if he had been permitted to answer the questions. That failure is fatal.” *BearBox LLC v. Lancium LLC*, 2023-1922, 1/13/25 (citation omitted).

c. Claim Construction Forfeiture/Waiver

i. Failure to Identify a Claim Construction Dispute

“We see no reason to absolve Wash World of the consequences of its decision not to pursue, in a timely manner in the trial court, the claim construction it now wishes us to adopt.” *Wash World Inc. v. Belanger Inc.*, 2023-1841, 3/24/25.

ii. Small v. Large Difference

“The closest Wash World came was when it stated in its claim construction brief, ‘Therefore, the term ‘cushioning’ should be construed to require a softening or protective function to the outer sleeve.’ Even here, however, its contention was that the construction should be based on the function of the sleeve, which was either to soften or to protect – and Wash World never argued that only soft and resilient sleeves could protect. Wash World also failed to show that even a ‘softening’ could only be accomplished by a ‘soft’ material.” *Wash World Inc. v. Belanger Inc.*, n.1, 2023-1841, 3/24/25 (citation omitted).

“To be sure, a party is not always confined to the precise wording of the constructions it advanced below, and on appeal it may ‘present[] new or additional arguments in support of the scope of [its] claim construction.’” *Wash World Inc. v. Belanger Inc.*, 2023-1841, 3/24/25 (quoting *O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1359 (Fed. Cir. 2008)).

d. Waiver by Stipulation

“Logically, by referring to the district court’s ‘construction of these terms,’ the parties were not referring to the portion of the district court’s construction they both agreed was correct but rather to those portions in dispute.” “As such, the parties’ joint stipulation of non-infringement does not implicate requirement one of claim 1.” *Maquet Cardiovascular LLC v. Abiomed Inc.*, 2023-2045, 3/21/25.

e. Exceptions

i. Discretion Not to Apply Waiver

Where judicial estoppel applies, “even if the remittitur issue had been forfeited in the district court, and it was not, we would excuse such forfeiture based on exceptional circumstances.” *Wash World Inc. v. Belanger Inc.*, 2023-1841, 3/24/25.

f. Alternative Bases for Affirmance

“Abiomed next argues that the judgment of non-infringement of claim 1 should be affirmed regardless of any claim construction dispute because its accused products do not infringe the “guide mechanism” limitation of claim 1.” “The question of infringement was not at issue below, and we decline to address it in the first instance.” *Maquet Cardiovascular LLC v. Abiomed Inc.*, 2023-2045, 3/21/25.

g. Correction of Verdict Damages

No forfeiture where appellant “indisputably preserved its objection to [appellee] obtaining any lost profits damages for convoyed sales” and “all the specific data supporting [appellant]’s request for remittitur was included in its opening brief in support of its renewed motion for judgment as a matter of law” even though “[a]t no point in the district court did [appellant] plainly and expressly request a reduction of a specific amount . . . or set out the number of infringing units . . . or lost-profits-per-unit that it wanted deducted from the jury’s verdict.” *Wash World Inc. v. Belanger Inc.*, 2023-1841, 3/24/25.

2. PTO Appeals

a. New Arguments at the Federal Circuit

“[Appellant] never brought the discovery issue to the Board’s attention, a choice it seeks to excuse by pointing to [Appellee]’s rejection of [Appellant]’s request to raise the issue with the Board. But [Appellee]’s posture did not relieve [Appellant] of its obligation to present its concern to the Board and seek relief there rather than raising these matters with us, for the first time, on appeal.” *AliveCor, Inc. v. Apple Inc.*, 2023-1512, 3/7/25.

“[W]e hold that Gesture has forfeited its real party in interest/privy argument ‘because it failed to present those arguments before the Board.’” *Apple Inc. v. Gesture Tech. Partners, LLC*, 2023-1475, 3/4/25 (quoting *Acoustic Tech.*, 949 F.3d at 1364).

3. Improper Arguments in Cross-Appellants Reply Brief

“[I]ssues related to the main appeal should not be argued in the fourth brief because it is effectively a sur-reply. Yet here, [cross-appellant] responded to [appellant]’s arguments related to [appellant’s appeal] in both its cross-appellant brief and its cross-appellant reply brief. As such, we view [cross-appellant]’s arguments related to [appellant’s appeal] in its crossappellant reply brief as an improper sur-reply.” *Apple Inc. v. Gesture Tech. Partners, LLC*, n.3, 2023-1475, 3/4/25.

4. Mischaracterizations of Reviewed Decision

“Labcorp’s first argument—that the Board imposed an improperly heightened standard for obviousness—mischaracterizes the analysis of the Board in an attempt to reframe factual issues as legal ones.” *Lab’y Corp. of Am. Holdings v. Ravgen, Inc.*, 2023-1342, 1/6/25 (nonprecedential).

B. Appellate Jurisdiction

1. Jurisdiction Requirements for ITC Petition for Review

a. Decisions Committed to Agency Discretion

“[T]he Commission’s decision not to enter a show cause order sua sponte is a decision committed to agency discretion and is thus unreviewable.” “We see no further support for Realtek’s view that discretionary agency actions under § 701(a)(2) become reviewable under the APA if the agency fails to provide reasoning.” *Realtek Semiconductor Corp. v. Int’l Trade Comm’n*, 2023-1095, 3/18/25.

2. PTO Rulings

a. Interference Rulings

“Setting aside that the provision at issue is a regulation issued by an executive agency, and not a statute enacted by Congress, this regulation makes no clear statement, let alone discusses, this court’s authority to hear an appeal of an inter partes review. Thus, this regulatory provision is not jurisdictional in nature.” *AMP Plus, Inc. v. DMF, Inc.*, 2023-1997, 3/19/25 (citation omitted).

C. Cross-Appeals v. Alternate Bases for Affirmance

1. Alternative Basis for Jury Verdict

No affirmance based on alternative damages model because patentee’s expert “never presented the jury with any damages figure that excluded convoyed sales, and the jury verdict is equal to the bottom number in [that expert]’s proposed range, it is overwhelmingly likely that the jury adopted all components of [that expert]’s opinion, and did not coincidentally reach the same figure as he did by some alternative, independent calculation.” *Wash World Inc. v. Belanger Inc.*, 2023-1841, 3/24/25.

D. Scope of Claim Construction Review

1. Implicit Claim Construction Disputes

“While neither the parties nor the district court expressly referenced ‘claim construction,’ they were plainly addressing the scope of the claims and were, thereby, engaging in claim construction.” *Wash World Inc. v. Belanger Inc.*, 2023-1841, 3/24/25.

2. Claim Construction Modified on Appeal

a. Affirmed/Reversed Under New Construction

i. PTAB

“Although we conclude that the Board’s claim construction was erroneous, we determine that that error was harmless.” *HD Silicon Sols. LLC v. Microchip Tech. Inc.*, 23-1397, 2/6/25.

b. Vacate and Remand in View of New Construction

“Because we reject the district court’s claim construction, we vacate the judgment of noninfringement. We leave to the district court on remand the task of applying the correct claim construction in the first instance under appropriate factual development, including the issues of literal infringement and infringement under the doctrine of equivalents.” *IQRIS Techs. LLC v. Point Blank Enters., Inc.*, 2023-2062, 3/7/25 (citation omitted).

E. Relief Outside Appeal Process

1. Mandamus

a. Barred for Adequate Appeal Remedy

“[C]ourts have found mandamus unavailable to review rulings on motions to dismiss for want of personal jurisdiction, because a post-judgment appeal is an adequate remedy.” *In re Lenovo Group Ltd.*, 2025-111, 3/4/25 (nonprecedential).

F. Harmless Error

1. Harmless Error in Providing Demonstrative to Jury

“Because Roland’s claim chart did not substantively and materially differ from admitted testimonial and documentary evidence, any error by the district court in providing Roland’s chart to the jury was harmless and does not entitle inMusic to a new trial.” *Roland Corp. v. inMusic Brands, Inc.* 2023-1327, 3/27/25 (nonprecedential).

2. Flawed Claim Construction

“Although we conclude that the Board’s claim construction [allowing tungsten compounds] was erroneous [elemental tungsten required], we determine that that error was

harmless.” “The Board found that Trivedi discloses both a tungsten-silicide and an elemental tungsten layer, and either disclosure would render the “second film comprising tungsten” limitation of claim 1 obvious.” *HD Silicon Sols. LLC v. Microchip Tech. Inc.*, 23-1397, 2/6/25.

G. Precedent

1. Affirmance v. Not Reaching Issue

“[Appellee] argues that we ‘must’ affirm the district court’s judgment of non-infringement as to the ’238 patent because [Appellant] has not appealed it.” “However, since [Appellant] did not appeal the portion of the judgment concerning the ’238 patent or raise any argument in its opening brief on this issue, we decline to reach that portion of the judgment.” *Maquet Cardiovascular LLC v. Abiomed Inc.*, 2023-2045, 3/21/25.

2. Context

“These cases must therefore be understood in context when ascertaining the scope of “printed publications” in § 311(b) and whether that term excludes published patent applications treated as prior art under § 102(e)(1).” *Lynk Labs, Inc. v. Samsung Elecs. Co.*, 2023-2346, 1/14/25.

H. Remand Determination

1. Remand for Sufficient Reasoning to Review

“The district court did not provide any reasoning for conditionally granting a new trial specific to validity for us to review. We therefore cannot assess whether the district court abused its discretion in the conditional grant. We vacate the conditional grant of a new trial on invalidity and remand for further proceedings.” *Steuben Foods, Inc. v. Shibuya Hoppmann Corp.*, 2023-1790, 1/24/25 (citation omitted).

2. Remand for New Damages Determination

“inMusic argues for JMOL of no damages, while Roland argues for a new trial. We believe the fairer option is to afford Roland a new trial on both lost profits and reasonable royalties. The district court imposed its time constraints on examination of the parties’ damages experts shortly before Roland began its examination of Ms. Heinemann. Roland’s damages case may have suffered as a result of the unusually brief time it was afforded for expert examination. We therefore remand for a new trial on damages.” *Roland Corp. v. inMusic Brands, Inc.* 2023-1327, 3/27/25 (nonprecedential).

3. Resolution in the First Instance

a. Issue of Fact

“As an appellate court, we may not decide questions of fact in the first instance on appeal.” *Apple Inc. v. Gesture Tech. Partners, LLC*, 2023-1475, 3/4/25 (citing *Middleton v. Dep’t of Def.*, 185 F.3d 1374, 1383 (Fed. Cir. 1999)).

4. No Resolution of Issues in the First Instance

a. Expert Qualifications

“Whether Mr. Bates’ experience suffices to meet the requirements for a person of skill in the art is a question of fact that we will not decide in the first instance, and we thus vacate for Board consideration of this issue.” *Sierra Wireless, ULC v. Sisvel S.p.A.*, 2023-1059, 3/10/25.

IX. Patent Office Proceedings

A. Inter Partes Review

1. Constitutionality

a. Forfeited

“Odyssey’s forfeiture is even clearer than those in the previous cases because it never raised its Appointments Clause challenge on direct appeal and only argued this point in its collateral challenge to the Board’s decision.” *Odyssey Logistics & Tech. Corp v. Stewart*, 2023-2077, 3/6/25 (emphasis in original).

2. Prior Art to be Considered

a. Patent Applications

“[B]ecause a published patent application is a “printed publication,” § 102(e)(1) treats *this* type of printed publication as prior art as of a time before it became publicly accessible—i.e., as of its filing date.” “Therefore, the plain language of §§ 311(b) and 102(e)(1) permits IPR challenges based upon published patent applications, and such published patent applications can be deemed prior art in IPRs as of their filing date.” *Lynk Labs, Inc. v. Samsung Elecs. Co.*, 2023-2346, 1/14/25 (emphasis in original).

3. Petition Requirements

Appellant argued that “its petition sufficiently showed that this limitation was obvious. We disagree. The petition provides an analysis of why Limitation M was obvious over Imtra 2011 and Imtra 2007, ground two of the petition. This analysis, however, does not discuss Limitation M’s requirement for “coupl[ing] to electricity from an electrical system of a

building in which the compact recessed lighting system is installed.”” AMP Plus, Inc. v. DMF, Inc., 2023-1997, 3/19/25 (citations omitted).

4. Appeal

a. Claim Construction

i. No Implied Construction

“We do not agree with Restem that the Board’s analysis constituted an implicit construction of the “placing” step beyond its stated construction. Instead, the Board made factual findings that supported its anticipation analysis. The Board’s analysis of differences between Majore’s process and the claimed process provided support for its factual finding that Majore’s process steps do not necessarily produce cells with the claimed cell marker expression profile.” Restem, LLC v. Jadi Cell, LLC, 2023-2054, 3/4/25.

“We agree the Board implicitly construed “isolated cell” as “a cell population,” but see no error in the Board’s construction, which is supported by intrinsic evidence.” Restem, LLC v. Jadi Cell, LLC, 2023-2054, 3/4/25.

b. Reversal of PTAB

i. Obviousness

“Requiring the motivation to modify to be the same motivation as that of the patent inventor has no basis in obviousness doctrine.” “There is accordingly no evidence in the record from which a reasonable mind could conclude that the petition failed to show that a person of ordinary skill in the art would not understand that the modification of the Philips reference would have increased protection for the MSB, a goal that the Philips reference itself recognized.” “By failing to recognize that the claimed modification needed only to be desirable in light of the prior art and not the “best” or “preferred” approach, the Board committed legal error.” “For the foregoing reasons, the decision of the Board is reversed.” Honeywell Int’l, Inc. v. 3G Licensing S.A., 2023-1354, 1/2/25.

c. Jurisdiction Over Appeals Challenging PTAB Decisions

i. Standing Evidence

“In the supplemental declaration, CQV alleges facts showing that it “is obligated to indemnify its customer[] from infringement liability,”” “Because the standard for establishing standing under the Declaratory Judgment Act is the same as the standard for establishing Article III standing, CQV has shown that it has standing to pursue this appeal.” CQV Co., Ltd. V. Merck Patent GmbH, 2023-1027, 3/10/25 (citation omitted).

d. Standard for Reviewing Findings

i. Expert Testimony

“We do, however, agree with Appellants that the Board abused its discretion by relying on the testimony of Sisvel’s expert Mr. Bates, absent a finding that he is qualified as an ordinarily skilled artisan.” *Sierra Wireless, ULC v. Sisvel S.p.A.*, 2023-1059, 3/10/25.

e. Remand to Consider Relevant Arguments/Evidence in Record

Issue in PGR is whether “the Xirallic® lot used for Sample C qualifies as prior art.” “CQV raised highly material and un rebutted evidence that Sample C would have been made available to the public within a few weeks of being placed into quality control, which the Board discarded without explanation.” “Because we cannot discern whether the relevant evidence was properly evaluated, we remand to the Board for further consideration and explanation of its analysis.” *CQV Co., Ltd. V. Merck Patent GmbH*, 2023-1027, 3/10/25.