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Education

John Marshall Law School, LL.M.,
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1975, Illinois

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Kenneth R. Adamo

Ken Adamo is the owner of the Law Office of KRadamo. Ken has extensive trial experience as lead counsel in jury and nonjury cases before state and federal courts and before the United States International Trade Commission, as well as *ex parte* and post-grant PTAB experience in the U.S. Patent and Trademark Office. He has had substantial experience as lead counsel in arbitrations and other alternative dispute resolution proceedings, and actively practices before the U.S. Court of Appeals for the Federal Circuit, having appeared in over 45 appeals to date.

In 2011, Ken was named to *IAM Patent Litigation 250 - The World's Leading Patent Litigators*, ranked as a top attorney in the "Individuals - U.S. International Trade Commission," and, as a Band 1 lawyer in "Individuals - Illinois" and "Individuals - National" categories. He was recognized as a "true leader and luminary trial lawyer" who is "sharp and extremely effective both in federal district court litigation and before the ITC." In 2012, in *IAM's The World's Leading Patent Practitioners 1000*, he was again named a top attorney in Individuals - US International Trade Commission, and was named to Gold Band Individuals - Litigation in Illinois. In 2013, he continued in the *IAM 1000* publication as a Gold Band Individual - Litigation in Illinois, being described as "a 'brash and bold winner' who secures superb results for clients." In 2014 and 2015, Ken maintained those rankings (as he did thru 2019), with *IAM* saying he's a "Nationally renowned trial lawyer . . . [who] has a tremendous amount of energy and is a commanding presence in the courtroom" and "is a polished trial lawyer with extensive district court, ITC, appellate, alternative forum and Patent Trial and Appeal Board (PTAB) experience." In 2016, *IAM* noted that "You can't be too dazzled by the depth and strength of the firm's bench of first-chair trial lawyers. Ken Adamo is another big name in the group; he litigates high-stakes cases across the IP spectrum and excels at all levels and in all forums, including the ITC and PTAB". *IAM 1000 - The World's Leading Patent Professionals 2017*, named Ken as a best-in-class advocate: "Ken practiced patent litigation well before it came into vogue, and has unrivalled experience and a rare depth of substantive patent law knowledge. He takes the time to get to know your business and goals, and will protect your interests zealously. He does a good job training and developing new talent for the next generation of representation for his clients - a lot of senior lawyers take their eye off that particular ball, but not Ken." Among his peers, he is lauded as a "laser-focused, high-energy lawyer who does an awful lot of work without ever getting flustered." In *IAM 1000 - The World's Leading Patent Professionals 2018 / 2019*, Ken was again praised for his courtroom practice: "[Ken] Adamo's name resonates with the business elite, not only because of its synonymy with trial and appellate excellence, but also its association with integrity, commercial expertise and encyclopedic patent law knowledge".

Who's Who Legal Patents 2014, 2015, and 2016, named him as one of its Most Highly Regarded Individuals, saying that "the 'phenomenal' Kenneth Adamo . . . is widely acknowledged as a 'frontrunner' of US patent litigation. He regularly appears as lead counsel before state and federal courts and before the International Trade Commission, and recently acted in high profile infringement cases for clients including IBM, Samsung . . .".

IP Stars Illinois 2017 noted that a peer said that Ken is "a very strong patent litigator and very good in the courtroom," adding that "even though he has a New York lawyer personality, he does well in the East Texas courtroom," and, further, that he is "very strategic in how he approaches cases and has a good understanding of the technology so it's easy for him to simplify."

The 2017 edition of *Chambers USA, America's Leading Lawyers for Business*, ranked Ken Band 1 Individuals - Patents in Illinois for the seventh consecutive year, noting that he is "incredibly seasoned, very experienced," and "has an encyclopaedic understanding of patent law." The 2019 edition, ranking him Band 1 in Illinois for the ninth consecutive year, noted sources describing him as "one of the best patent trial lawyers in the US".

In *Chambers Global, The World's Leading Lawyers for Business 2016*, sources say Ken "brings an incredible understanding of the law and a depth of experience that few, if any, other practitioners can offer." In 2010, *Chambers* ranked Ken as a Star Performer in Ohio and Band 1 in Texas, with clients remarking that he "has unparalleled stature as a patent litigator and is 'incredibly smart with a strong presence that makes him very persuasive to a judge and jury.'" "He's got the energy, the eye for detail and the courtroom presence - he's just a superb trial lawyer".

Major representations in intellectual property litigation as lead counsel have included U.S. federal court and ITC cases for Citicorp, CQG, IBM, JP Morgan Chase, MediaTek, Procter & Gamble, Otter Products, Samsung, TEL, Texas Instruments, TSMC, and Xilinx.



Clint Mehall is partner at Davidson, Davidson & Kappel, LLC in New York City, and his practice mainly focuses on patent prosecution and counseling. Mr. Mehall utilizes patent analytics to guide his prosecution strategy and has an aptitude for identifying when a patent examiner will not issue claims of a reasonable scope. He has filed over a hundred ex parte appeals with the USPTO Patent Trial and Appeals Board, where he has an exceptional win rate. Mr. Mehall graduated Cum Laude from DePaul University College of Law and received a Bachelors of Science in biological engineering from the University of Missouri-Columbia.



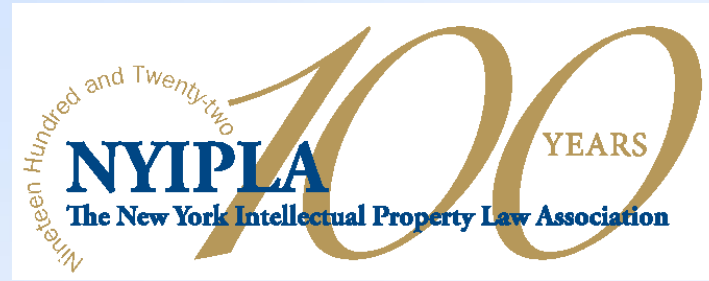
Joy Goudie is a patent attorney currently heading the law firm of Goudie, PLLC and also serves as an independent board member at Daxor Corporation, following twelve-years as Senior Patent Counsel for Revlon leading cross-functional teams in the US and Spain. In addition, she served as Vice President managing Revlon's global R&D portfolio and driving recent technologies.

Prior to joining Revlon, Joy was Senior Patent Counsel at Wyeth Pharmaceuticals in Pearl River, NY, where she managed the oncology patent portfolio.

A published scientist, Joy has worked with patients and R&D teams in the development of new antibiotics and small molecules for treatment of solid tumor cancers. Her research also included work in the areas of stroke and Parkinson's disease. Research data analysis included collecting and analyzing big data using automated intelligence (AI), computer programming and molecular modeling.

Joy has an undergraduate degree in medical technology and a graduate degree in chemistry.

Joy is co-chair of the NYIPLA Patent Law & Practice Group.



NYIPLA Fall 2022 CLE

CAFC Patent Law Developments and Updates

November 9, 2022

Joint Presentation by the PTAB and Patent Law & Practice Committees

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Joy S. Goudie - Goudie, PLLC

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Patent Eligible/Ineligible Subject Matter

In *In re Board of Trustees of the Leland Stanford Junior University*, 991 F.3d 1245 (Fed. Cir. 2021), the Federal Circuit affirmed the PTAB 's decision, which had affirmed an examiner's decision to reject the patent application method claims as being ineligible subject matter.

The method claims were directed to mathematical calculations and statistical modeling related to haplotype phasing (i.e., a process for determining from which parent certain genes are inherited), associated mental processes, and generic computer implementation steps (e.g., receiving, storing, and extracting data). **Because there was nothing that changed the character of the claims into a practical application, the Federal Circuit deemed them to be directed to patent-ineligible abstract ideas under step one of the two-part *Alice* test.** The Federal Circuit also determined that the specification did not demonstrate an improvement of a technological process, **rejecting Stanford's argument that increased accuracy saved the claims at step one** and instead concluding that improving computational accuracy is different from improving an overall technological process. **Regarding *Alice* step two, because the record demonstrated that the claimed method was performed using known, generic computer technology, the Federal Circuit affirmed the PTAB 's step two.**

“Decisions in Brief,” *Landslides* (Sept./Oct. 2021), p. 58.

Patent Eligible/Ineligible Subject Matter

(cont.)

American Axle

In a well-written, succinct summary of the latest round of the *Mayo/Myriad Genetics/Alice* trilogy regarding 35 U.S.C. § 101, Sunstein, in *Sunstein Insights* (July 26, 2022), reported on the latest disappointment delivered by the U.S. Supreme Court in “Supreme Court Won’t Fix the Patentability Mess it Created A Decade Ago:”

In fact, the Federal Circuit’s decision in *American Axle* is only half of the story, because **the decision was built, however flimsily, on a set of controversial Supreme Court decisions**, including *May Collaborative Servs. V. Prometheus Labs., Inc.* (2012), dealing with a diagnostic method (which we discuss here), *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.* (2013), also dealing with a diagnostic method, and *Alice Corp. Pty. Ltd. V. CLS Bank International* (2014), dealing with a computer-implemented business method (which we discuss here).

Patent Eligible/Ineligible Subject Matter

(cont.)

In 2019 the Federal Circuit reached the extraordinary conclusion, in *American Axle & Manufacturing, Inc. v. Neapco Holdings LLC* . . . that a patent for a method of making a drive shaft was invalid because it was directed to a natural law. This year, the Supreme Court asked the Solicitor General for the government's views on this case.

Patent Eligible/Ineligible Subject Matter

(cont.)

Before appealing to the Supreme Court, American Axle sought a rehearing *en banc* from the Federal Circuit . . . The request was denied, with six judges in favor of a review and six opposed. **Judge Pauline Newman wrote a dissent that was joined by four judges in which she said: "The court's rulings on patent eligibility have become so diverse and unpredictable as to have a serious effect on the innovation incentive in all fields of technology. The victim is not only this inventor ... ; the victims are the national interest in an innovative industrial economy, and the public interest in the fruits of technological advance."** With such a major split within the Federal Circuit bench, **the Supreme Court had a responsibility to clean up the mess promptly unless** the Solicitor General felt that this was not a good test case for clarifying the question of patent eligibility.

Patent Eligible/Ineligible Subject Matter

(cont.)

The Court did in fact hear from the Solicitor General. In a filing made on May, 24, 2022, she opined that "[t]he court of appeals erred in applying" principles of patent eligibility to the American Axle patent. She agreed with dissenting Judge Moore of the Federal Circuit that the patent claim in question is patent eligible because it "recites an 'industrial process' that entails a concrete application of Hooke's law in a particular setting." **The Solicitor General noted, in discussing particulars, that "[t]his is only the most recent Section 101 case that has fractured the Federal Circuit," and opined that it was a good opportunity for the Court to clarify the law.**

On June 30, 2022, the Supreme Court nevertheless slammed the door on American Axle and the Solicitor General by denying review of the Federal Circuit's decision. Given the Court's unwillingness to address the fog of uncertainty created by its decisions, it would be valuable for users of the patent system to rekindle efforts made in Congress over the past decade to bring clarity to patent eligibility determinations.

Patent Eligible/Ineligible Subject Matter

(cont.)

Immediate blog response was heavy, heavy-hearted, and disappointed, frustrated . . . and, well, despondent if not desperate.

For example, Matsui, et al, in Morrison & Foerster's Federal Circuitry blog, "Supreme Court Refuses (again) to jump back into the 101 Fray" (June 30, 2022), said that:

Although expectations were high for a cert. grant, the denial was not entirely a surprise. To be sure, the Supreme Court had called for the views of the Solicitor General in the case a year ago, which is usually a sign of at least some interest in the case at the Court. And when the Solicitor General finally filed her brief, she urged the Court to grant the petition. When the Solicitor General recommends a grant of certiorari, the Court almost always does so.

So why are we not surprised (or at least not shocked)? Well, two years ago the Supreme Court had a similar opportunity to clarify 101 in *Hikma* or *Athena*, and it declined. Like *American Axle*, the Court called for the views for the Solicitor General in *Hikma*. And while the Solicitor General didn't recommend granting in that case, the government said the Court's 101 standards needed clarification and identified another case (*Athena*) that the Court should review. At the time, the betting money would have expected a grant. Instead, the Court said no. We wondered then if the Court wanted to just take itself out of the 101 business . . .

Patent Eligible/Ineligible Subject Matter

(cont.)

All of this begs the question of what happens next given the sharp division in the Federal Circuit on 101. It could be that the Supreme Court is just waiting for the right vehicle to address the issue. It didn't need to call for the views of the Solicitor General if it really was just opting out of 101 after denying cert. in *Athena*, which the Solicitor General said should have been granted two years ago. And while the propeller shaft manufacturing claims in *American Axle* involve a relatively accessible technology in the mechanical arts-like the gas pedal claims in *KSR*- the Court might have concluded that the mechanical arts are not where 101 guidance is really needed . . .

Going forward, the truth is we don't know what the Supreme Court's appetite will be for these kinds of patent cases. Justices Kennedy and Breyer seemed particularly interested in patent cases. But now that they've retired, we don't know if the current Court will have that same affinity in the future.

Patent Eligible/Ineligible Subject Matter

(cont.)

The Federal Circuit came right back on July 18, 2022 in a precedential decision in *CareDx, Inc. v. Natera, Inc.*, which affirmed a D. Del summary judgment invalidating claims as patent ineligible.

As reported by the FCBA Bench & Bar Watch List (July 29, 2022):

CareDx sued Natera for violating a patent on an organ transplant rejection test. Natera moved to dismiss this suit for failure to state a claim due to a lack of patent-eligible subject matter. **A magistrate judge recommended that Natera's motion be denied because the patented claims were new and unconventional.** The trial court vacated the magistrate judge's recommendation on Natera's action but-adopted and modified the reasoning of the magistrate judge on a similar motion by a co-defendant. After expert discovery, Natera and the co-defendant moved for a summary judgment of patent ineligibility, which the trial court denied because there was a factual dispute at issue. The court then stated that it would reconsider its denial of the summary judgment motions. **Upon reconsideration, the court granted a summary judgment of ineligibility because the claims recited only conventional techniques. CareDX appealed.**

Patent Eligible/Ineligible Subject Matter

(cont.)

The Federal Circuit affirmed the court's summary judgment. **The Federal Circuit found that there was no new measurement technique or method of preparation involved in CareDx's patents.** The Federal Circuit found that the discovery underlying CareDx's patents was conventional and well-known prior to CareDx filing the patents at Issue. **The Federal Circuit found that method patents the Supreme Court had rejected in binding precedent and the Federal Circuit had rejected in the past for being conventional were indistinguishable from the patents at issue in this case.** The Federal Circuit found that, in this case as in past cases, conventional methods applied to natural phenomena were not patentable. The Federal Circuit found that a conventionality analysis applied to step one of the *Alice/Mayo* test as well as step two because the two steps of the test were plainly related and so a bright line cannot be drawn between them.

The Federal Circuit also found that CareDx's procedural arguments that the trial court did not explain its disagreement with the magistrate Judge and that the trial court reversed its initial denial with an erroneous analysis of the facts at issue were both unmerited because that court did explain its reasons for differing from the magistrate judge and was entitled to reconsider its decision on summary judgment and decide that there was no genuine issue of material fact to resolve.

Patent Eligible/Ineligible Subject Matter

(cont.)

Weisner v. Google - October 2022, first of 2 noteworthy Fed. Cir. 101 decisions dropped in a few days

- first set of claims involve recording "physical location histories" of "individual member[s]" that visit "stationary vendor member[s]" in a "member network."
- Fed Cir agreed with district court determined that the patent claims are directed to "collect[ing] information on a user's movements and location history [and] electronically record[ing] that data."
– i.e., "creating a digital travel log"
- Weisner asserted it "improves the functionality of the underlying system" by "[1] automatically recording physical interactions and [2] limiting what is recorded to only specific types of interactions that are pre-approved and agreed to by an individual member and a vendor member."
- Court found this was mere automation of conventional method of creating a travel log
- Also do not "focus on a specific means or method that improves the relevant technology"

Patent Eligible/Ineligible Subject Matter

(cont.)

Weisner v. Google - cont.

-second set of claims involve using physical location histories to improve computerized search results

-Fed Cir found the claims were directed to an abstract idea, but that they recite “a specific implementation of the abstract idea that purports to solve a problem unique to the Internet”

- Searching algorithm is conventional, but recite a new technique for prioritizing the results of the conventional search
 - describes how the physical relationship is established—the system searches the physical location histories of both a reference individual and the searching person to determine whether they have visited a common location
 - the system then prioritizes search results that the reference individual has visited
 - different from conventional methods of ranking results, according to the specification

Patent Eligible/Ineligible Subject Matter

(cont.)

IBM v. Zillow - October 2022, first of 2 noteworthy Fed. Cri. 101 decisions dropped in a few days

-claims '789 patent is a method for coordinated geospatial and list-based mapping where a user draws a shape on a map to select that area of the map, and the claimed system then filters and displays data limited to that area of the map, while also **synchronizing which elements are shown as "selected" on the map and its associated list.**

-District court concluded that "the '789 Patent is directed to the abstract idea of responding to a user's selection of a portion of a displayed map by simultaneously updating the map and a co-displayed list of items on the map."

- method "could be performed by hand, using a printed map and related list of items on the map, a transparent overlay, a wet-erase marker, a blank sheet of opaque paper, and a knife or scissors"
- specifically one could:
 - put the transparent overlay on the map, draw on it with the marker, and then block off the "unselected area" of the map and corresponding list items with the opaque paper
 - to choose a different "selection area," the user would erase the previous marking, remove the paper, and start over.
 - "alterations to hardcopy materials were made or auditioned in this manner" long before the invention of the computer, and thus concluded that "[t]he '789 patent merely contemplates automation using a computer."

Patent Eligible/Ineligible Subject Matter

(cont.)

IBM v. Zillow - cont.

- Fed Cir agreed, finding that claims of 789 patent fail to "recite any assertedly inventive technology for improving computers as tools," and are instead directed to "an abstract idea for which computers are invoked merely as a tool" – i.e., mere automation of manual processes
 - IBM asserted that the patent improves "the ability of users to identify and analyze relevant data in otherwise large data sets"
 - Fed Cir rejected, saying that this was not enough "without more"
 - Claims did not "recite any assertedly inventive technology for improving computers as tools"
 - "Identifying, analyzing, and presenting certain data to a user is not an improvement specific to computing"
 - Claim was in "result-based functional language" that "does not sufficiently describe how to achieve these results in a non-abstract way"

Patent Eligible/Ineligible Subject Matter

(cont.)

IBM v. Zillow - cont.

- Fed Cir also agreed that claims of '389 patent were patent ineligible
 - the '389 patent claims a method of displaying objects in visually distinct layers; objects in layers of interest can be brought to and emphasized at the top of the display while other layers are deemphasized
 - District court said method “could be similarly performed using colored pencils and translucent paper; each sheet of paper would display a 'layer' within the meaning of the '389 Patent, and the sheets could be arranged, rearranged, and perhaps redrawn as desired to highlight particular objects or groups of objects.”
 - Fed Cir agreed for essentially the same reasons as the '789 patent
 - “do not improve the functioning of the computer, make it operate more efficiently, or solve any technological problem. Instead, they recite a purportedly new arrangement of generic information that assists [users] in processing information more quickly.”
 - Claim used functional language that is result-oriented
 - Problem is not specific to computer environment; automates manual activities

Doctrine of Equivalents/Means-Plus Function Indefiniteness

In *Traxcell Technologies, LLC v. Sprint Communications Co.*, 15 F4th 1121, (Fed. Cir. 2021), the Federal Circuit affirmed the trial court's grant of summary judgment and indefiniteness. Regarding infringement, one of the asserted patents included a means-plus-function limitation with the "structure" being a very detailed algorithm disclosed in the patent's written description. **The trial court held that the allegedly infringing structural equivalent (*i.e.*, an allegedly equivalent algorithm) did not satisfy the "way" prong or the function-way-result test. The Federal Circuit affirmed, finding that Traxcell only addressed the allegedly equivalent structure at a generalized level and lacked sufficient evidence to sustain its infringement contentions.** The Federal Circuit also affirmed the trial court's claim constructions and, in turn, affirmed that court's remaining noninfringement rulings. The Federal Circuit also affirmed the trial court's findings, concluding that the claims at issue were indefinite for two independent reasons: (1) lack of reasonable certainty, and (2) inadequate supporting structure in the specification for certain means-plus-function limitations.

"Decisions in Brief," *Landslide* (March/April 2022), pg. 57.

Enablement/Written Description

LifeSciences Written Description Cases 2021-22.

- Juno Therapeutics, Inc. v. Kite Pharma, Inc., 10 F.4th 1330 (Fed. Cir. 2021)
- Biogen Int'l GmbH v. Mylan Pharms., Inc., 2021 U.S. App. LEXIS 35254 (Fed. Cir. 2021), pet. for reh 'g filed Dec. 30, 2021
- Novartis Pharms. Corp. v. Accord Healthcare, Inc., 2022 U.S. App. LEXIS 58 (Fed. Cir. Jan. 3, 2022)
- Indivior UK Ltd. v. Reddy's Labs. S.A., 18 F .4th 1323 (Fed. Cir. 2021)

Enablement/Written Description (cont)

In *Pacific Biosciences of California, Inc. v. Oxford Nanopore Technologies, Inc.*, 996 F.3d 1342 (Fed. Cir. 2021), the Federal Circuit affirmed the trial court's judgment that the asserted patents were invalid for lack of enablement, holding that the jury's task was not to view one piece of evidence in isolation, but to consider all the evidence. The patentee focused primarily on the fact that the accused infringer's expert testified on cross-examination that a relevant artisan, having a particular piece of prior art (Akeson), could perform the method of the claimed invention. **In affirming the trial court's judgment of invalidity for lack of enablement, the Federal Circuit held that the jury could reasonably have understood the accused infringer's expert testimony to mean that a relevant artisan could perform the claimed method successfully on the particular subset of nucleic acids addressed in the Akeson grant, but could not make and use the full scope of the invention.**

"Decisions in Brief," *Landslide* (Dec./Jan. 2022) pg. 58.

Enablement/Written Description (cont)

In *Juno Therapeutics, Inc. v. Kite Pharma, inc.*, 10 F.4th 1330 (Fed. Cir. 2021), the Federal Circuit reversed the trial court's finding of infringement, finding the patent invalid for lack of written description. The Federal Circuit found that **the description contained scant details about the claimed invention. By merely providing two examples of single-chain antibody variable fragments that would bind to two different antigens, the description did not provide information to a skilled artisan on identifying the species capable of binding to the limitless number of targets as the claims required.**

“Decisions in Brief,” *Landslide* (March/April 2022) pg. 59.

Enablement/Written Description (cont)

In *Biogen International GmbH v. Mylan Pharmaceuticals Inc.*, 18 F.4th 1333 (Fed. Cir. 2021), the trial court did not clearly err in finding that Mylan established by clear and convincing evidence that the asserted claims were invalid for lack of written description. A skilled artisan would not have recognized that the compound at issue, which was only mentioned once in the specification, would have been efficacious in the claimed treatment. The specification lacked a written description of the DMF dosage for MS treatment because identified range appeared at the end of one of a series of ranges. Too much focus on basic research and broad DMF dosage ranges.

In *Indivior UK Ltd. v. Dr. Reddy's Laboratories S.A.*, 18 F.4th 1323 (Fed. Cir. 2021), **the PTAB did not err in finding that the claims lacked written description support for a claimed range, where the range was closed or bounded, even though the range could be calculated based on values in a table in the specification.** The tables detailed examples that fell within the claimed ranges, but % were not expressly disclosed. As a result, based on the claims' effective filing date, the PTAB did not err in finding the claims invalid as anticipated.

Enablement/Written Description (cont)

In *Novartis Pharmaceuticals Corp. v. Accord Healthcare, Inc.*, 21 F.4th 1362 (Fed. Cir. 2022), the Federal Circuit affirmed the trial court's finding that the claims did not fail the written description requirement and that a party's ANDA application infringed the patent at issue. The patent application included a prophetic trial that described dosing human patients at the claimed dosage. The application also included a model using a lower dosage in rats, and expert testimony was provided that the lower dosage for rats would convert to a similar dosage as that claimed for humans.

“Decisions in Brief,” *Landslide* (June/July 2022) pg. 56.

Enablement/Written Description (cont)

Enablement for a Genus

Amgen, Inc. v. Sanofi, Aventisub LLC.

Functional claim limitations "post high hurdles in fulfilling the enablement requirement.

"Court was concerned not "simply with the number of embodiments but also with their functional breadth."

Have to consider the three-dimensional structure of the antibody and predict how substitutions in that structure affect the antibody's ability to bind and block function.

There was inadequate guidance in the specification "beyond the narrow scope of the working examples."

Claims encompassed millions of candidates and it would be necessary to generate each one and then screen each for its ability to (1) bind; and (2) block function.

Claims NOT enabled.

Enablement/Written Description (cont)

Not Obvious To Try

Teva Pharm. U.S. v. Corcept Therapeutics (Fed. Cir. 2021)

Method of treating Cushing's Syndrome with mifepristone and a strong CYP3A4 inhibitor by reducing dose of mifepristone to 600 mg/day (from 900-1200 mg/day) when taken with the strong CYP3A4 inhibitor.

Prior Art Ref 1 noted safety risk & unknown effect of combined administration.

Prior Art Ref 2 was mifepristone prescribing label warning against use with strong CYP3A4 inhibitor & limiting dose to 300 mg/day when used in combo with strong CYP3A4 inhibitor.

Clear motivation to test whether 300 mg/day or 600 mg/day dose okay. No expectation of success for doses over 300 mg/day. Prior art made a clear case for both the "obvious to try" motivation and the unpredictability.

Enablement/Written Description (cont)

Non-Life Sciences Written Description

Cases: 2021-22

In re Huping Hu, the court affirmed the PTO's rejection of claims to a method of producing quantum entanglement explaining that when a patent claims "concepts that strain scientific principles," the PTO can "properly h[o]ld" the claims "to a heightened standard."⁶

In *Flash-Control, LLC v. Intel Corp.*, the court affirmed a trial court's grant of summary judgment that a claim to a computer memory system had insufficient written description support for one of the memory storage elements.⁷

In *Sanofi-Aventis Deutschland GmbH v. Mylan Pharmaceuticals Inc.*, an IRP appeal, the Federal Circuit found that Sanofi's substitute claims lacked written description support in the earliest priority application, and it found that there was intervening, anticipating prior art.⁹

⁶ *In re Huping Hu*, 848 F. App'x 416 (Fed. Cir. 2021).

⁷ *Flash-Control, LLC v. Intel Corp.*, 2021 WL 2944592 (Fed. Cir. 2021).

⁹ *Sanofi-Aventis Deutsch/and GmbH v. Mylan Pharmaceuticals Inc.*, Appeal No. 20-2066 slip op. (Fed. Cir. Dec. 29, 2021).

Indefiniteness

In *Infinity Computer Products, Inc. v. Oki Data Americas, Inc.*, 987 F.3d 1053 (Fed. Cir. 2021), **the claim terms "passive link" and "computer" were held to be indefinite because the patentee took conflicting positions on the endpoint of the "passive link" during prosecution.** The Federal Circuit found that a skilled person would not be able to determine the beginning and the end of the "passive" link based on the conflicting statements during prosecution.

In *Rain Computing, Inc. v. Samsung Electronics America, Inc.*, 989 F.3d 1002 (Fed. Cir. 2021), the Federal Circuit reversed the trial court's finding that the claims reciting a "user identification module" were not indefinite. The patent was directed to efficiently delivering software packages to a client terminal in a network based on user demands. **The Federal Circuit agreed with the trial court that the "user identification module" invoked 35 U.S.C. § 112, ¶ 6 because the term "module" is a well-known nonce word and "user identification" merely describes the function of the module. The Federal Circuit disagreed with the trial court's finding that sufficient structure was disclosed, reasoning that the specification disclosed only a general purpose computer without disclosing any specialized software/algorithm for performing the recite function.**

In *Synchronoss Technologies Inc. v. Dropbox, Inc.*, 987 F.3d 1358 (Fed. Cir. 2021), the Federal Circuit affirmed the trial court's findings that all asserted claims were either invalid for indefiniteness or not infringed. **Regarding one patent, the patentee admitted that the claims included an impossibility, thus rendering the claims indefinite.** The claims of the second patent were indefinite because the specification did not disclose sufficient structure to construe a claim term. The remaining patent was found to be not infringed.

"Decisions in Brief," *Landslide* (Sept./Oct. 2021) p. 58.

Indefiniteness (cont)

In *Nature Simulation Systems, Inc. v. Autodesk, Inc.*, 23 F.4th 1334 (Fed. Cir. 2022), the Federal Circuit reversed and remanded the trial court's holding that claims of two patents were invalid for claim indefiniteness. **First**, the Federal Circuit took issue with the trial court's "unanswered questions" standard. Specifically, the trial court held that definiteness required that any claim questions be answered in "the claim language, standing alone," and therefore declined to consider information in the specification. **Instead, the Federal Circuit held that the correct standard was that patent claims are viewed and understood in light of the specification, the prosecution history, and other relevant evidence, and determined that, when looking at the specification, the "unanswered questions" were resolved.** **Second**, the Federal Circuit explained that the trial court had rejected the patent examiner's conclusion as to indefiniteness regarding the pertinent claim language and thus **gave no weight to the prosecution history showing the resolution of indefiniteness. This was error, as the trial court had failed to provide the patent examiner's indefiniteness analysis and conclusion appropriate deference.**

"Decisions in Brief," *Landslide* (June/July 2022) p. 55.

Indefiniteness (cont)

In *Niazi Licensing Corp. v. St. Jude Medical SC Inc.*, Appeal No. 21-1864, slip op. (Fed. Cir. April 11, 2022), the Federal Circuit overturned a trial court decision that Niazi's claims were invalid. The patent claimed a "double catheter" with an inner and outer catheter for placing electrical leads to resynchronize the heart in patients with heart failure. **Niazi argued that the trial court erred in finding the claim terms "resilient" and "pliable" indefinite. The Federal Circuit agreed.**

Although the claims used terms of degree, they "inform[ed] those skilled in the art about the scope of the invention with reasonable certainty." **Claim language and the written description provided guidance about the meaning of the term "resilient" and provided "exemplary resilient materials" that could be used to make the outer catheter. Claim language provided less guidance concerning the meaning of "pliable," but there were "numerous examples of a 'pliable' inner catheter" in the written description, including an exemplary material and guidance that "the inner catheter is more flexible than the outer."** Taken as a whole, this was sufficient to "provide objective boundaries by which a skilled artisan could determine the scope of the claims." **Extrinsic evidence such as dictionary definitions of the terms further supported this determination.**

Indefiniteness (cont)

O'Connell, et al., Prosecution First, "Relative Terms Sufficient for Reasonable Certainty," Lexology (April 22, 2022), discussed the indefiniteness portion of *Niazi*, offering a well-drafted set of takeaways:

Using words of degree arise may raise questions regarding whether a person of ordinary skill in the art could understand with "reasonable certainty" how the claim would be infringed. Relative terms such as "above," "below," "close," "near," "only," "when," "longer," "shorter," "substantial," "insignificant," "increase," "decrease," "greater," and "lesser" must be treated as carefully as technical terms of art. This case provides a good example of a patent owner meeting the *Nautilus* standard of "reasonable certainty" for relative terms by providing sufficient explanation and examples in the specification.

Indefiniteness (cont)

Clearly, an ounce of prevention in drafting the specification may be worth many pounds of cure. The practitioner's challenge is to spot relative terms in a draft specification. If such terms do not appear to be defined in the specification, the practitioner should ask the inventor(s) what they mean to the skilled artisan generally and to the inventor(s) specifically. It may well be that a such an investigation will satisfy the practitioner that the term is as definite as the art permits or is otherwise art-recognized. **Additionally, out of an abundance of caution, the practitioner can develop and include a definition for the term or even a definitions section in the specification.**

Relative terms or adjectives might be defined using ranges or a functional outcome. Further, during prosecution or litigation, an expert declaration may help explain how one of ordinary skill in the art would have understood a term.

Indefiniteness (cont)

Similarly, Dunker, IP Update, “ Terms of Degree Not Always Indefinite,” Lexology (April 21, 2022), commented in regard to *Niazi* that:

In reaching its decision on indefiniteness, the Federal Circuit focused on the terms "resilient" and "pliable" as used in a claim directed to a double catheter structure. Citing the 2014 Supreme Court decision in *Nautilus v. Biosig Instruments*, **the Federal Circuit explained that language has "inherent limitations," and stated that a "delicate balance" must be struck to provide "clear notice of what is claimed" and avoid the "zone of uncertainty" relating to infringement.** The Court noted that under *Nautilus*, claims must provide "objective boundaries," but the Court distinguished the present case from those in which "subjective boundaries" created uncertainty and rendered the claim indefinite. The Court pointed to its 2005 decision in *Datamize v. Plumtree Software* as a **"classic example" of subjectivity where the term "aesthetically pleasing" was deemed indefinite because the patent provided no way to provide "some standard for measuring the scope of the phrase."** The Court also noted that a patent's claims, written description and prosecution history-along with any relevant extrinsic evidence-can provide or help identify the necessary objective boundaries for claim scope.

Indefiniteness (cont)

The Federal Circuit concluded that there was sufficient support in the intrinsic evidence, both in the claims themselves and the written description, to allow a skilled artisan to determine the scope of the claims with reasonable certainty. The Court explained that the claim at issue recited "an outer, resilient catheter having shape memory" that "itself provides guidance on what this term means-the outer catheter must have 'shape memory,' and 'sufficient stiffness.'" **The Court also cited to "[n]umerous dependent claims [that] further inform the meaning of this term by providing exemplary resilient materials of which the outer catheter could be made The written description provides similar guidance** Thus, a person of ordinary skill reading the claims and written description would know of exemplary materials that can be used to make a resilient outer catheter, i.e., one that has shape memory and stiffness such that it can return to its original shape."

The Federal Circuit distinguished this case from *Datamize*, where the claim scope depended on the eye of each observer, finding it more akin to its 2017 decision in *Sonix Technologies*. **In that case, the Court found that the claim term "visually negligible," while a term of degree, was, in the context of the claim provided, "an objective baseline through which to interpret the claims"- i.e., whether it could be seen by the normal human eye.**

Indefiniteness (cont)

Dunker closed with a short, helpful Practice Note:

When analyzing claims for definiteness, practitioners should focus on how a term of degree affects the objective and subjective nature of the claim scope to determine whether there is an objective way a skilled artisan can determine the scope of the claim.

See also Brachman, “CAFC Clarifies Analysis of Intrinsic Evidence on Indefiniteness, Affirms PTAB’s Denial of Sanctions,” IPWatchdog (June 2, 2022).

Trial Court Ability to Correct Patent Claim Errors

At issue in *PAVO Solutions LLC v. Kingston Technology Company Inc.*, Appeal No. 21-1834, slip op. (Fed. Cir. June 3, 2022), was the ability of correction at the trial court level of a “clerical error” in a patent claim.

Shah, et al., Prosecution First blog, “Federal Circuit Upholds \$13.6 Million Jury Verdict of Willful Infringement After Affirming The District Court’s Correction of Claims,” Lexology (Aug 5, 2022), provided a very complete analysis of *PAVO Solutions*, focusing upon the claim limitation correction.

A short synopsis of the relevant facts and events opened the post:

Trial Court Ability to Correct Patent Claim Errors (cont)

Pavo Solutions sued Kingston for infringement of the '544 patent. Pavo Solutions argued that the infringement was willful because Kingston continued with its USB device sales despite notice of infringement in 2012. Kingston then challenged the '544 patent at the Patent Trial and Appeal Board ("Board"). The Board upheld many of the challenged claims and found several others were unpatentable for obviousness.

During claim construction, the trial court found that the phrase "pivoting the case with respect to the flash memory main body," had a clerical error and corrected the claim language by replacing the word "case" with the word "cover." *Pavo Sols., LLC v. Kingston Tech. Co.*, Case No. SACV 14-1352, 2018 WL 5099486, at *4 (C.D. Cal. Sept. 10, 2018) ("Claim Construction Order"). The trial court determined that the error was "evident from the face of the patent" because the case was part of the main body and therefore would not be able to pivot. *Id.* Furthermore, "[t]he correction was not subject to reasonable debate ... because Kingston's proposed alternative construction-replacing 'flash memory main body' with 'cover' so that the claim reads 'pivoting the case with respect to the cover'-resulted in the same claim scope." *Id.* at *3. Additionally, the court noted that the prosecution history was consistent with the correction, unlike Kingston's expert testimony which was inconsistent with the intrinsic record. *Id.* at *4.

Trial Court Ability to Correct Patent Claim Errors (cont)

The jury found that Kingston infringed three claims of the '544 patent that the PTAB upheld, awarding \$7.5 million in damages, half of the damages that Pavo Solutions originally sought. The trial court later added \$3.8 million in damages to the jury award, along with \$2.3 million in interest.

There then followed a thorough yet well-focused review of the law applicable to the error correction issue, with an analysis of the Federal Circuit's various holdings:

Trial Court Ability to Correct Patent Claim Errors (cont)

A district court may correct "obvious minor typographical and clerical errors in patents." *Novo Indus., L.P v. Micro Molds Corp.*, 350 F.3d 1348, 1357 (Fed. Cir. 2003). **Correction is appropriate "only if (1) the correction is not subject to reasonable debate based on consideration of the claim language and the specification and (2) the prosecution history does not suggest a different interpretation of the claims."** *Id.* at 1354. The error must be "evident from the face of the patent," *Grp. One, Ltd. v. Hallmark Cards, Inc.*, 407 F.3d 1297, 1303 (Fed. Cir. 2005), and the determination "must be made from the point of view of one skilled in the art," *Ultimax Cement Mfg. Corp. v. CTS Cement Mfg. Corp.*, 587 F.3d 1339, 1353 (Fed. Cir. 2009). In deciding whether a particular correction is appropriate, the court "must consider how a potential correction would impact the scope of a claim and if the inventor is entitled to the resulting claim scope based on the written description of the patent." *CBT Flint Partners, LLC v. Return Path, Inc.*, 654 F.3d 1353, 1359 (Fed. Cir. 2011).

Pavo Solutions, at *7-8.

Trial Court Ability to Correct Patent Claim Errors (cont)

The Federal Circuit upheld the trial court's correction of "case" to "cover" in the claims. **First**, the error was an obvious minor typographical or clerical error because it was clear from the full context of the claim language and the specification. Under these circumstances, the district court properly corrected the claim language, even if the correction altered the claimed structure. **Second**, the Federal Circuit agreed that the correction was not subject to reasonable debate because both the trial court's correction and Kinston's proposed correction would result in the same claim scope. **Additionally, the Federal Circuit held that the prosecution history does not suggest a different interpretation** of the claims because the applicant, the examiner, and the Board consistently characterized the claims as describing "pivoting the case [] within the cover" ... "allowing the cover to pivot," ... and "a cover ... having a hinge element functioning with the case," despite the errors in the claims. *Id.* At * 14.

Trial Court Ability to Correct Patent Claim Errors (cont)

The Federal Circuit distinguished *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, (Fed. Cir. 2004). In *Chef America*, **the Federal Circuit refused to construe the phrase "heating the resulting batter-coated dough to a temperature in the range of about 400° F. to 850 ° F," to refer to the oven temperature, rather than the dough temperature, because the original claim language clearly and unmistakably referred to the dough temperature.** *Id.* at 1374. Unlike in *Chef America*, the Federal Circuit concluded that the errors in the claims of *Pavo Solutions* were obvious in light of the entire claim language and the specification. The claim in *Pavo Solutions* also did not make sense facially while the claim in *Chef America* described a realistic but undesirable result. In addition, unlike *Pavo Solutions*, the patent owners in *Chef America* made no attempt to correct the error.

As to the trial court's finding of willful infringement, the Federal Circuit affirmed and held that Kingston could not hide behind the obvious minor clerical error to escape the jury verdict of willful infringement.

Trial Court Ability to Correct Patent Claim Errors (cont)

Finally, Shah, et al. set out a quite exhaustive set of “takeaways” for the reader:

- Mistakes and errors can occur in the prosecution of a patent application and the printing of a patent. **These errors, which appear in the granted patent, range from minor errors, like it can only simple spelling errors, that arise in the printing process, to errors that result in claims that cover a different scope than what the inventors had a right to claim.**
- **In terms of correction by a district court, if the error is obvious from the "face of the patent" and be corrected in one way (i.e., no ambiguity in how the claim should read), then a district court is allowed to correct the error via claim construction.** As noted by the Federal Circuit in *Hoffer v. Microsoft Corp.* , 405 F.3d 1326, 1331 (Fed. Cir. 2005):

This error in dependency of claim 22 is apparent on the face of the printed patent, and the correct antecedent claim is apparent from the prosecution history Absent evidence of culpability or intent to deceive by delaying formal correction, patent should not be invalidated based on an obvious administrative error **When a harmless error in a patent isn't subject to reasonable debate, it can be corrected by the court, as for other legal documents.**

Trial Court Ability to Correct Patent Claim Errors (cont)

- **Correction procedures are not available to cure some fatal defects in the granted patent.** For example, procedures are not available to cure § 112 shortcomings, such as the failure of the specification to supply an enabling disclosure, an adequate description of the invention, or the best mode contemplated by the inventor with respect to the invention claimed in the patent. The AIA removed the need to correct the best mode with its amendment to 35 U.S.C. §282 removing failure to disclose the best mode as grounds for invalidity or unenforceability for proceedings commenced on or after September 16, 2011, although the statute does not define what is the meaning of "proceedings."
- **If correcting an error, such as a typographical error, would amount to redrafting the claim, the court will refuse to make such a correction and the error can be fatal.** For example, in *Novo Industries, L.P. v. Micro Molds Corp.*, 350 F.3d 1348 (Fed. Cir. 2003), the Federal Circuit held that the district court erred in correcting "formed on a rotatable with said support fingers" to read "formed on and rotatable with said support finger" because, while it was clear that the claim contained an error, it was not indisputably clear that the error should be corrected by changing "a" to "and." *Id.* at 1357-58. **Without knowing what correction was necessarily appropriate, or how the claim should have been interpreted, the Federal Circuit held the claim invalid for indefiniteness.**

Trial Court Ability to Correct Patent Claim Errors (cont)

- **Judicial correction is available** for obvious minor typographical and clerical errors in patents, **only** if (1) the correction is not subject to reasonable debate based on consideration of the claim language and the specification, and (2) the prosecution history does not suggest a different interpretation of the claims.
- **If these conditions are met, even corrections that alter the structure of the claimed invention may be appropriate.** See *Lemelson v. General Mills, Inc.*, 968 F.2d 1202, 1203 (Fed. Cir. 1992); *ITS Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429, 441-43 (1926). The change in the structure of the claimed invention does not necessarily indicate a change in claim scope. The courts also are not limited to correcting errors that result in linguistic incorrectness. *Pavo Solutions*, at * 10.

Trial Court Ability to Correct Patent Claim Errors (cont)

- **The stricter approach in *Chef America*, however, remains a warning for claim drafters.** There is a line of case law where the court refused to correct a claim, finding that the patent drafter should bear the responsibility for any error in drafting. *See, e.g., Halliburton Energy Services, Inc. v. M-1 LLC*, 514 F.3d 1244 (Fed. Cir. 2008) ("We note that the patent drafter is in the best position to resolve the ambiguity in the patent claims[.]"); *Sage Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420 (Fed. Cir. 1997) ("Given a choice of imposing the higher costs of careful prosecution on patentees, or imposing the costs of foreclosed business activity on the public at large, this court believes the costs are properly imposed on the group best positioned to determine whether or not a particular invention warrants investment at a higher level, that is, the patentees."); *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573, 1581 (Fed. Cir. 1996) (when there is an equal choice between a broad and narrow meaning of a claim, the public notice function is better served by interpreting the claim more narrowly).
- **An accused infringer cannot escape willful infringement merely because an asserted claim contained an obvious error.** When drafting an opinion of counsel for a claim containing an error, be sure to address infringement issues based on the corrected claim language.

Trial Court Ability to Correct Patent Claim Errors (cont)

See Stewart, “The Fed. Cir. In June: A Few Decisions To Know,” Law360 (July 1, 2022) (discussion of *PAVO Solutions v. Kingston Technology*); McIntyre, Oblon blog, “Can a Court Rewrite Claim Language During Claim Construction? IF You Don’t Ask For It, You’ll Never Know (*Pavo Solutions*, Part 1)” (Aug 3, 2022); “Sure, A court Can Rewrite Claims, But Can It Change A Disclosure?” (*Pavo Solutions*, Part II) (Aug 8, 2022); “Does Claim Construction for Patent Opinions Now Require a Crystal Ball?” (*Pavo Solutions*, Part III) (Aug. 16, 2022).

PTAB: Use of Applicant Admitted Prior Art in IPR Proceedings

Qualcomm - Federal Circuit Backdrop to Updated AAPA Guidance

Qualcomm Inc. v. Apple, Inc., 24 F.4th 1367 (Fed. Cir. 2022)

- "[T]he 'patents or printed publications' that form the 'basis' of a ground for inter partes review must themselves be prior art to the challenged patent. That conclusion excludes any descriptions of the prior art contained in the challenged patent."
- **However, "it does not follow that AAPA is categorically excluded from an *inter partes* review."**
 - "Even though evidence such as expert testimony and party admissions are not themselves prior art references, they are permissible evidence in an *inter partes* review for establishing the background knowledge possessed by a person of ordinary skill in the art."
- "AAPA may not form the 'basis' of a ground in an *inter partes* review, and it is therefore **impermissible for a petition to challenge a patent relying on solely AAPA without also relying on a prior art patent or printed publication.**"

PTAB: Use of Applicant Admitted Prior Art in IPR Proceedings (cont)

In a precedential opinion the Federal Circuit held that Applicant Admitted Prior Art ("AAPA") does not constitute "prior art consisting of patents or printed publications" under 35 U.S.C. § 311(b) and thus cannot be the basis of a ground in an *inter partes* review. *Qualcomm Inc. v. Apple*, Case Nos. 2020-1558, -1559 (Fed. Cir. Feb. 1, 2022), Slip at 3. **This decision affirmed Guidance issued by the US PTO Director on August 18, 2020 regarding the use of AAPA.**

In the underlying proceedings, one of Petitioner 's grounds relied on the combination of a U.S. patent publication and AAPA acknowledging that most of the limitations of the challenged claims were known. Slip at 3. In particular, the challenged patent described a prior art method of remedying a known problem. Slip at 3-4. The patent owner conceded that the proposed combination teaches each element of the challenged claims. Slip at 7. **Patent owner also acknowledged that "general knowledge and non-Section 311(b) art [e.g., AAPA] may have a role to play in IPR proceedings," but argued that it cannot form "the basis" of a ground. Slip at 9. The USPTO, as intervener, requested remand so that the Board could apply the Director's Guidance. Slip at 9.**

PTAB: Use of Applicant Admitted Prior Art in IPR Proceedings (cont)

The Federal Circuit noted that the language of § 311 (b) is identical to that in the *ex parte* reexamination statute, 35 U.S.C. § 301(a). Further, the language in § 301(a) has been interpreted to exclude patents which themselves are not prior art. Slip at 11. Thus, the preclusion of AAPA in *ex parte* reexaminations applies equally to *inter partes* review. The Federal Circuit held that while AAPA may be considered in an *inter partes* review, it may not form the basis of a ground of review. Slip at 13. The Federal Circuit remanded the case to the Board to address the issue of whether the AAPA formed the basis of the ground. Slip at 16.

PTAB: Use of Applicant Admitted Prior Art in IPR Proceedings (cont)

See Alemanni, et al., “Federal Circuit Confirms that AAPA May Not Form the Basis of a Ground in an IPR,” AIPLA (Feb. 3, 2022).

2022 Alemanni, et al., citing to the existing USPTO Guidance, noted that:

The best practice since the Guidance issued in 2020 was to avoid the use of AAPA as the basis of a ground in a petition for *inter partes* review. This decision confirms that strategy and thus should not significantly impact the preparation of new petitions. However, this decision provides another basis for patent owners to challenge petitions relying on AAPA, including petitions filed before the Guidance, many of which are still subject to rehearing, director review, or appeal.

PTAB: Use of Applicant Admitted Prior Art in IPR Proceedings (cont)

Incorporating a fulsome discussion of the August 18, 2020 USPTO binding memorandum, “Treatment of Statements of the Applicant in the Challenged Patent in *Inter Partes* Review Under § 311 “(the Memo); Engel, et al, IP Law Watch,” Federal Circuit Rules AAPA in challenged patent does not qualify as prior art under 35 U.S.C. § 311(b) but signals AAPA can play role in 3103 analysis,” (Feb. 3, 2022), Engel et al. rationalized the “new state of play post *Qualcomm v. Apple*:

The Federal Circuit's treatment of AAPA in *Qualcomm* is consistent with the treatment described in the Memo, as acknowledged in the Opinion itself. Both the *Qualcomm* decision and the Memo acknowledge the critical role that can AAPA play in an obviousness analysis, however, both also **acknowledge the limiting function of § 311 (b) by noting that AAP A cannot alone form "the basis" of an IPR challenge.**

PTAB: Use of Applicant Admitted Prior Art in IPR Proceedings (cont)

Specifically, the Opinion distinguishes between using AAPA as “the basis” (*i.e.*, the prior art reference in a ground) of an IPR challenge and using AAPA as factual support in an obviousness analysis during an IPR proceeding. In support of the latter usage of AAPA, the *Qualcomm* decision cites several related Federal Circuit decisions. **For example**, Federal Circuit case law provides AAPA can be used as a factual foundation of what a skilled artisan would have known at the time of invention. **Additionally**, AAPA can be used to furnish a motivation to combine and/or supplying a missing claim limitation that was "within the general knowledge of a skilled artisan."

From a practical standpoint, patentees should be cognizant of the fact that AAPA, although it cannot form "the basis" of IPR challenges, is still binding on patentees and can be used to support a petition and an obviousness theories presented in the petition. In particular, AAPA can be used, like expert testimony, to reinforce the interpretation of prior art, but cannot serve as the sole reason for unpatentability. On the Patent Owner and Applicant side, patentees should be precise with their characterization of the state of the art as well specific prior art references to mitigate later unintended effects of AAPA.

PTAB: Use of Applicant Admitted Prior Art in IPR Proceedings (cont)

Kass, “Fed. Cir. Raises The Bar For ‘Admitted’ Prior Art in IPRs,” Law360 (Feb. 9, 2022), was quick to confirm that, “build[ing] off the Federal Circuit’s January 2020 decision in *Koninklijke Philips v. Google*, where the court held that ‘general knowledge of a skilled artisan can’t be used as grounds to invalidate a patent,’ petitioners will no longer be able to use so-called applicant admitted prior art as a basis for invalidating a patent after a Federal Circuit decision against Apple last week, leaving those arguing in inter partes reviews to come up with new strategies.

The Federal Circuit's Feb. 1 **decision** in *Qualcomm v. Apple* saw the appeals court present, for the first time, **its view that applicant admitted prior art cannot be used as the basis of an obviousness or anticipation challenge to a patent.** The prior art required for those challenges is still limited, by statute, to other patents and printed publications.

PTAB: Use of Applicant Admitted Prior Art in IPR Proceedings (cont)

On the date of the Kass Law360 posting, the USPTO issued Updated AAPA Guidance, replacing the 2020 Guidance:

Director Vidal's Updated AAPA Guidance (June 9, 2022)

- Supersedes prior guidance from August 2020
- However, some provisions remain largely unchanged:
 - AAPA can be used **in combination** with one or more prior art patents or printed publications in an obviousness ground to supply a missing claim limitation, to support a motivation to combine, to demonstrate a POSITA's knowledge, or for any other purpose related to patentability.
 - AAPA alone cannot form the basis of a prior art ground in an IPR.
 - Prior guidance interpreted § 311 (b) to require that the "basis" of an IPR ground include **prior art** patents or **prior art** printed publications.
 - Updated guidance maintains this view, following decision in *Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367 (Fed. Cir. 2022).

PTAB: Use of Applicant Admitted Prior Art in IPR Proceedings (cont)

- Explains that 37 C.F.R. § 42.104(b)(4) does not preclude the use of AAPA to supply a missing claim limitation, despite requirement for the petition to “specify where each element of the claim is found in the prior art patents or printed publications relied upon.”
- **Key Change in Updated Guidance**
 - Eliminates requirement from August 2020 guidance for a prior art patent or printed publication to form the "foundation or starting point" of an IPR ground.
 - "Board panels should not exclude the use of admissions based on the number of claim limitations or claim elements the admission supplies or the order in which the petition presents the obviousness combination (e.g., prior art modified by admission or admission modified by prior art)."

Infringement Notice Letters and Personal Jurisdiction

In *Apple Inc. v. Zipit Wireless, Inc.*, Appeal No. 2021-1760, slip op. (Fed. Cir. April 18, 2022), the Federal Circuit overturned a N.D. Cal. Judgment that it lacked personal jurisdiction over Zipit. Apple argued that the trial court erred in “applying a bright-line rule that patent infringement notice letters and related communications can never form the basis for personal jurisdiction.” The Federal Circuit agreed.

Judge Stoll, writing for the panel, explained that settlement-promoting policy was “relevant,” but “the facts of each case must [always] be weighed.” Zipit had the requisite minimum contacts with California: it had sent multiple demand letters and related correspondence over several years, held multiple telephone calls, and made two trips to California related to the dispute. Apple’s declaratory judgment suit “directly stems from these enforcement efforts.” Zipit had not presented “a compelling case that jurisdiction would be unreasonable.” Inconvenience related to litigating in California was not “so unreasonably burdensome as to be unconstitutional,” and previous travel to the state related to the dispute “reinforce[d] the reasonable foreseeability of suit there.” And, although four years had passed since Zipit’s last contact with Apple in the state, “it is Zipit who reignited the parties’ contacts by filing suit for patent infringement.”

IPO Daily News, “District Court Erred in Dismissing Patent Suit for Lack of Personal Jurisdiction (April 19, 2022).”

Infringement Notice Letters and Personal Jurisdiction(cont)

See also Kass, “Fed. Circ. Says Notice Letter Justifies Patent Venue for Apple,” Law360 (April 18, 2022); Deedar, “CAFC Reverses District Court Finding That Apple Lacked Personal Juris Over Zipit,” IPWatchdog (April 19, 2022); Cordani, et al., “Mailer’s Remorse: Notice Letters and Personal Jurisdiction for Declaratory Judgment Lawsuits,” IPWatchdog (May 12, 2022).