



ANNUAL REVIEW OF PATENT CASE LAW: 2023 CASES AND IMPLICATIONS FOR IN-HOUSE COUNSEL

Steve Gardner
Kilpatrick Townsend & Stockton LLP

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 Litigation – Intellectual Property (2024, 2022) & Trademark Law (2021)



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 Trademarks: Litigation and Non-Contentious (2023)



Tier One
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About the Speaker

Steve Gardner practices in the areas of intellectual-property disputes, counseling, and transactions. He was co-chair of the firm's patent-litigation group for a decade. He has represented companies in more than 100 lawsuits in federal courts in California, Colorado, Delaware, Florida, Georgia, Illinois, New Jersey, North Carolina, Ohio, Virginia, Texas, and other states.

Steve received a B.S.E.E. and M.S.E.E. from the University of North Carolina at Charlotte, a J.D. from the School of Law at Wake Forest University, where he was editor-in-chief of the law review, and a M.Div. from its School of Divinity. He clerked for the Hon. Frank W. Bullock, Jr., Chief Judge, US District Court for the Middle District of North Carolina, 1994-95, and the Hon. Alvin A. Schall, US Court of Appeals for the Federal Circuit, 1995-96.

For many years, Steve has been elected to *Business North Carolina* magazine's "Legal Elite" List as one of the top patent attorneys in North Carolina based on a survey of members of the North Carolina bar and recognized in *The Best Lawyers in America*® for intellectual property.



Enablement – Undue Experimentation

Amgen v. Sanofi - Supreme Court Decision

Supreme Court affirmed invalidity of Amgen's patent, finding it fails to provide enough information to enable others to make and use the entire class of antibodies claimed.

“If a patent claims an entire class of processes, machines, manufactures, or compositions of matter, the patent's specification must enable a person skilled in the art to make and use the entire class. In other words, the specification must enable the full scope of the invention as defined by its claims.”

“The more one claims, the more one must enable.”



Section 112(a)—Identification Process Disclosure Insufficient

Is this claim—

An isolated antibody or antibody fragment thereof that binds Factor IX or Factor IXa and increases the procoagulant activity of Factor IXa.

—enabled if a) patent discloses amino acid sequence of 11 antibodies in its scope, b) it discloses iterative, trial-and-error process used to discover the 11 so others can find more the same way & c) there's millions of antibodies in its scope?



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No (Baxalta). Fed Cir found indistinguishable from Amgen (S. Ct. 2023): "nothing in the specification [teaches] how to identify any antibodies complying with the claim limitations other than by repeating the same process the inventors used to identify ... examples ... in the specification."



Section 112(a)—Not Even if Disclosed Process Works Every Time

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No (Baxalta). Even if "skilled artisans will generate at least one claimed antibody each time ..., this does not take the process out of the realm of the trial-and-error approaches rejected in Amgen"

"§ 112(a) requires inventors to enable the 'full scope' of the claimed invention without unreasonable experimentation. Here, ... to practice the full scope of the claimed invention, skilled artisans must make candidate antibodies and screen them to determine which ... perform the claimed functions. ... This is the definition of trial and error and leaves the public no better equipped to make and use the claimed antibodies than the inventors were when they set out to discover the antibodies over which they now have an exclusive right. ..." (emphasis added)



Section 112(a)—Common Delineating Quality Weighs in Favor

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Yes (Baxalta). If "that would allow a skilled artisan to predict which antibodies will perform the claimed functions," it would.

This one discloses no "common structural (or other) feature delineating which antibodies will bind to Factor IX/IXa and increase procoagulant activity from those that will not."



Inventorship—Immaterial Claim Construction Unnecessary

Alleged joint inventor must show, as to at least one claim,

1) they "contributed significantly" to either a) "conception—the definite and permanent idea of the invention" or b) reduction to practice; and

2) contribution arose from "some element of joint behavior," e.g., "collaboration or working under common direction" ...

Must a court construe claims before evaluating joint inventorship?



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No (Blue Gentian). As party didn't show "material dispute about claim meaning, ... court did not err by making its inventorship determination without engaging in claim construction."



Inventorship—Claims, Distinguishing Show "Significant"

Is an alleged joint inventor's contribution "significant" if an element or combination of elements that they contributed is 1) reflected in claim language and 2) used by patentee to distinguish the claims from prior art in prosecution and litigation?



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Yes (Blue Gentian). This indicates the contribution is not "insignificant in quality," when "measured against the dimension of the full invention." (quoting Pannu 1998).



Inventorship—That Contributed Elements Are Prior Art Doesn't Mean Insignificant Contribution

If each individual element in a combination of elements contributed by the alleged joint inventor was in the prior art, does that make the contribution non-significant?



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No (Blue Gentian). "The proper lens requires considering the elements in combination, not in isolation. Likewise, it is the significance of [alleged joint inventor's] overall contribution that matters for determining inventorship, not the significance of certain elements standing alone."



Inventorship—Alleged Co-Inventor's Testimony Alone Insufficient

Is alleged joint inventor's testimony enough to establish joint inventorship?



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No (Blue Gentian). Standing alone, it is “insufficient to establish inventorship by clear and convincing evidence.”

Alleged co-inventor must give evidence corroborating their testimony.

Corroborating evidence may take many forms, e.g., contemporaneous documents, physical evidence, circumstantial evidence, and testimony of someone other than the alleged inventor.

“Rule of reason” test is applied to decide if sufficiently corroborated.



Inventorship—One Meeting for Other Purpose is Enough for Joint Inventorship

Can joint inventorship arise based on one meeting, a meeting not for the purpose of inventing but not the purpose of procuring investments and to discuss other topics?



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Yes (Blue Gentian). "People may be joint inventors even though they do not physically work on the invention together or at the same time, and even though each does not make the same type or amount of contribution." (Falana 2012).

Alleged joint inventor "did not need to be intent on inventing the full invention ultimately claimed before he started collaborating."

Collaboration doesn't require "unity of vision [patentee] argues for."



Inventorship—Specification Can Demonstrate Insignificance

Is contributing idea of preheating using an infrared oven significant if, in patent: a) mentioned only once as alternative to a microwave oven, b) recited only in one claim, a Markush group with microwave, infrared, and hot air, c) not in any independent claim, which recite preheating with a microwave, d) minimally discussed; with microwave prominent in spec, claims, and figures, & e) not in examples or figures, which show preheating with a microwave?



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No (Hip). “[S]pecification, claims, and figures ... illustrate ... alleged contribution of preheating ... meat pieces with an infrared oven is 'insignificant in quality' when 'measured against the dimension of the full invention,' which ... focuses on a preheating step using a microwave Thus,... [alleged joint inventor] is not a joint inventor”



Obviousness-Type Double Patenting

Is a patent whose expiration date extends, via Patent Term Adjustment (PTA), beyond other members of its patent family at risk of being invalid if its claims substantially overlap with the claims of other family members who did not receive PTA?



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Yes (In re Collect). “We thus conclude that ODP for a patent that has received PTA, regardless whether or not a terminal disclaimer is required or has been filed, must be based on the expiration date of the patent after PTA has been added. We therefore further conclude that the Board did not err in finding the asserted claims unpatentable under ODP.”



Obviousness-Type Double Patenting

Collect patents:

Collect asserted 4 patents directed to devices that included image sensors, all interrelated, and all claiming priority to a common parent.

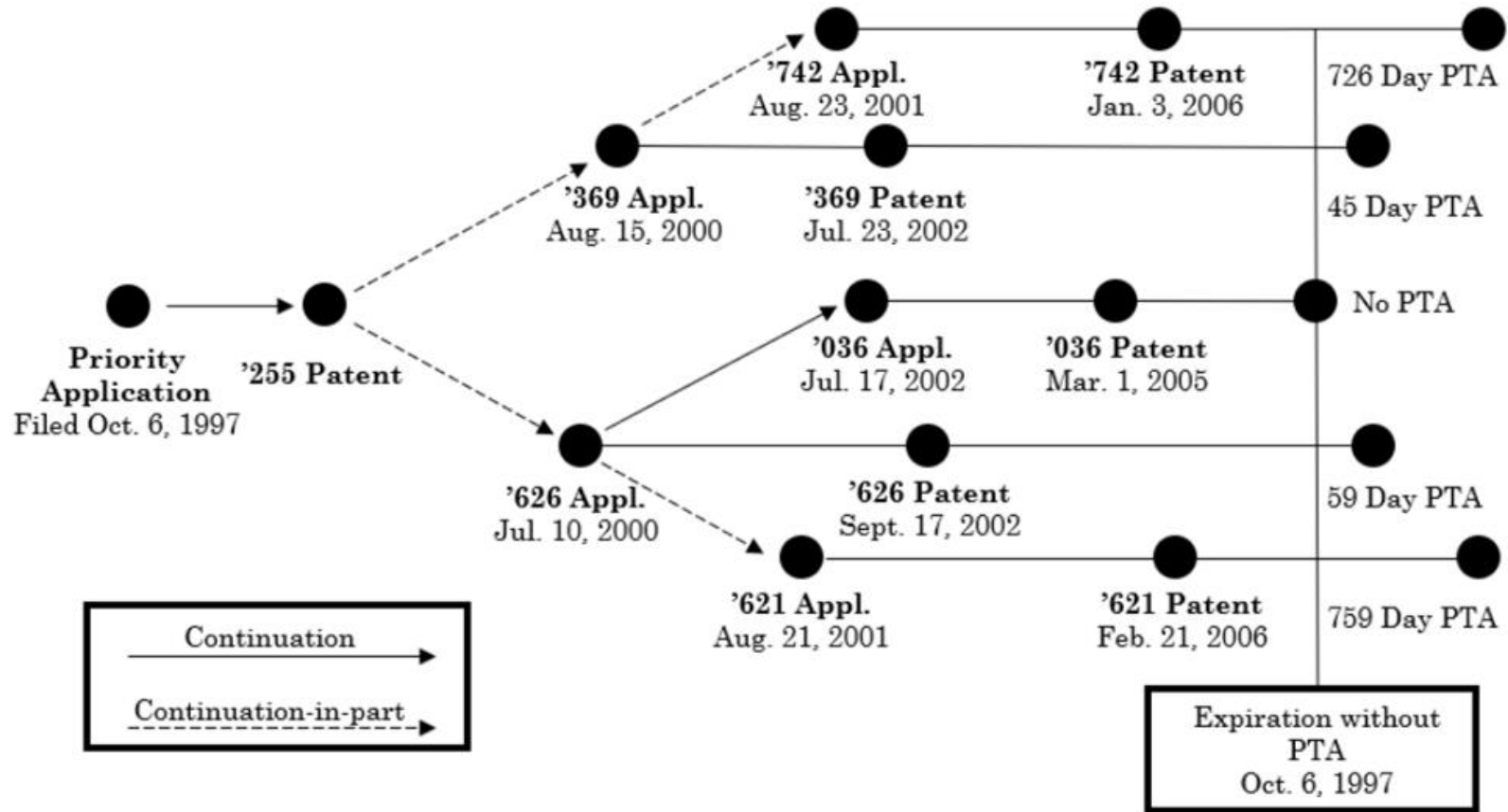
Each was granted Patent Term Adjustment (“PTA”) for USPTO delay during prosecution. Because each family member patent claims priority from the same application, each would have expired on the same day but for PTA.

None of them were subject to terminal disclaimer during original prosecution.

In re-exam, PTO rejected all 4 based on obviousness-type double patenting over an unasserted family member that received no PTA. PTAB affirmed.



Obviousness-Type Double Patenting



Obviousness-Type Double Patenting

Following *Collect*, consider:

- Check for families where this may be a risk
- Terminal disclaimers to obviate the risk
- Divisional filings rather than continuation filings?



Claim Construction—Statements in EPO Equivalent Can Limit US Claims

Can statements made in prosecution of a EPO equivalent of a patent result in disclaimer or surrender of claim scope relative to the claims of the US patent?



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Yes (K-Fee). Particularly in a situation in which the EPO prosecution history is intrinsic evidence, such statements can disclaim or surrender claim scope.

Here, the statements were not specific enough to constitute disclaimer or surrender.



Claim Construction—Statements in EPO Prosecution More Likely to Limit if Disclosed in US Prosecution

Is the prosecution history of an EPO family member of a US patent at issue intrinsic (as opposed to extrinsic) evidence of the meaning of claim terms in the US patent if the prosecution history of the EPO family member is provided to the US Patent Office during prosecution of the US patent?



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Yes (K-Fee). Thus statements made about a claim term in that EPO prosecution is intrinsic evidence of the meaning of that claim term in the US patent.



Claim Construction—Claim in *ParkerVision*

Claim 3:

A wireless modem apparatus, comprising: a receiver for frequency down-converting an input signal including,

a first frequency down-conversion module ...;

a second frequency down-conversion module ...; and

a subtractor module ...;

wherein said ... down-conversion modules each comprise a switch and a storage element.



Claim Construction—Specification Statement in *ParkerVision*

Specification:

[1] FIG. 82A illustrates an exemplary energy transfer system 8202 for down-converting an input EM signal 8204.

[2] The ... system 8202 includes a switching module ... and a storage module illustrated as a storage capacitance [3] The terms storage module and storage capacitance, as used herein, are distinguishable from the terms holding module and holding capacitance, respectively. [4] Holding modules and holding capacitances, as used above, identify systems that store negligible ... energy from an under-sampled input EM signal with the intent of “holding” a voltage value. [5] Storage modules and storage capacitances, on the other hand, refer to systems that store non-negligible amounts of energy from an input EM signal.



Claim Construction—Lexicography From “Terms” & Defining

Patentee can displace a term’s plain & ordinary meaning when acting as its own lexicographer if clearly set forth a) a definition of the term other than plain and ordinary meaning & b) an intent to redefine the term.

Did patentee act as lexicographer for "storage element"? ----



Claim Construction—Lexicography From “Terms” & Defining

Patentee can displace a term’s plain & ordinary meaning when acting as its own lexicographer if clearly set forth a) a definition of the term other than plain and ordinary meaning & b) an intent to redefine the term.

Did patentee act as lexicographer for "storage element"? ----

Yes (ParkerVision). [5] "clearly expresses" intent to define the term.

[3] uses “as used herein” to indicate [4] and [5] are applicable to the patent as a whole rather than to a specific embodiment.

Spec shifts to generally defining “storage module” & “storage capacitance” in [3-5]: not using ref numbers; referring to “terms”; and referring to patent as a whole with “as used herein.” Definition is [5].



Section 101—Claim at Issue in *ChromaDex*

1. A composition comprising:

isolated nicotinamide riboside [(NR)] in combination with one or more of tryptophan ... or nicotinamide,

wherein said combination is in admixture with a carrier comprising a sugar, ... cellulose, ... oil ... [or] buffering agent ...,

wherein said composition is formulated for oral administration and increased NAD⁺ biosynthesis upon oral administration.



Section 101—Advantages of Differentiating Elements, If Not Found in Claim Itself, Not Helpful to Validity

Is claim 1 valid under 101, on summary judgment, if a) isolated NR isn't in natural milk, but other elements, including NR, are & b) isolated NR has advantages over the same quantity of non-isolated NR by allowing much more NAD+ biosynthesis?



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No (ChromaDex). Since milk with non-isolated NR increases NAD+ biosynthesis some, “the claimed compositions do not possess characteristics markedly different from those found in nature....”

Claim 1 does not require a minimum quantity of isolated NR or “attribute the ... increase in NAD+ biosynthesis to the isolated NR”

Since the claim is “broad enough to encompass a product of nature, it is invalid under § 101.”



Section 101—Recognizing Utility & Wisdom of Isolation Not Inventive

In step 2 of Alice/Mayo, are these an "inventive step" in the claim?

Recognizing ... 1] utility of NR for enhancing health and well-being; or
2] wisdom of isolating NR for higher concentrations than in nature.



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2] wisdom of isolating NR for higher concentrations than in nature.

No (ChromaDex). "[R]ecognizing the utility of NR is nothing more than recognizing a natural phenomenon, which is not inventive."

"[A]ct of isolating the NR by itself, no matter how difficult or brilliant it may have been (although the specification makes clear that it was conventional), similarly does not turn an otherwise patent-ineligible product of nature into a patentable invention."



Section 101—Claim at Issue in *Trinity*

1. A poll-based networking system, comprising ... a data processing system having one or more processors and a memory, the memory being specifically encoded with instructions such that when executed, the instructions cause the one or more processors to perform operations of:

receiving user information from a user to generate a unique user profile for the user;

providing the user a...polling question...having a finite set of answers and a unique identification;

receiving and storing a selected answer for the first polling question;

comparing the selected answer against the selected answers of other users, based on the unique identification, to generate a likelihood of match between the user and each of the other users; and

displaying to the user ... profiles of other[s] that have a likelihood of match



Section 101—Do More Than Ask for Construction & Discovery

If defendant moves to dismiss by arguing the patent is invalid under 101, and patentee alleges need for claim construction or discovery, can the district court forego both and grant the motion to dismiss?



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If defendant moves to dismiss by arguing the patent is invalid under 101, and patentee alleges need for claim construction or discovery, can the district court forego both and grant the motion to dismiss?

Yes (Trinity). Patentee must do more than “invoke a generic need” for construction or discovery to avoid dismissal under § 101.

“[P]atentee must [a] propose a specific claim construction or identify specific facts that need development and [b] explain why those circumstances must be resolved before the scope of the claims can be understood for § 101 purposes.”

Here, patentee did not identify a proposed claim construction or specific facts to be discovered that would change the court's analysis.



Section 101–Conclusory Allegations in Complaint Insufficient

Is it proper to dismiss even if the complaint states A) “prior art did not include, alone or in any combination” certain claimed features, B) paragraphs describing that the invention “includes an advance over the prior art and an improvement over a general-purpose computer” because it uses certain claimed features, and C) the invention “represents a significant advance over the art”?



Section 101–Conclusory Allegations in Complaint Insufficient

Is it proper to dismiss even if the complaint states A) “prior art did not include, alone or in any combination” certain claimed features, B) paragraphs describing that the invention “includes an advance over the prior art and an improvement over a general-purpose computer” because it uses certain claimed features, and C) the invention “represents a significant advance over the art”?

Yes (Trinity). “These conclusory allegations that the prior art lacked elements of the asserted claims are insufficient to demonstrate an inventive concept.”



Motion to Dismiss—Evidence Outside Pleadings Can Alter

For a motion to dismiss, if “matters outside the pleadings are presented to and not excluded by the court, the motion must be treated as one for summary judgment” FRCP 12(d): Before converting to a summary judgment motion, court must give parties notice and time for discovery.

If a defendant attaches prior art, a substantive declaration, or something similar (or submits a technical tutorial) for the court to consider, and the court does not mention them when ruling on the motion to dismiss, is it reversible error?



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Maybe (Hawk). Depends on Circuit. In 6th, it’s error for the judge not to expressly reject them (to indicate did not consider). But not reversible error “if the court’s ‘rationale’ in no way ‘hinged on the additional information provided there.’”



Questions?



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Kilpatrick

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