

## Precedential Patent Case Decisions During August 2020

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### I. Introduction

This paper abstracts what I believe to be the significant new points of law from the precedential decisions in patent cases this month. Cases captions relating to the PTAB are in **red** text. Case captions of extraordinary importance are in **blue** text.

### II. Abstracts and New Points of Law

#### **Egenera, Inc. v. Cisco Systems, Inc., 2019-2015, 2019-2387 (Fed. Cir. 8/28/2020).**

This is a decision on appeals from the D. Mass. district court case 1:16-cv-11613-RGS. The district court held the asserted patent invalid. Egenera appealed. The Federal Circuit vacated and remanded. (The decision does not address why it identifies two appeals.)

**Legal issue: 35 USC 256, correction of a patent’s inventorship, meaning of “error,” post-AIA, in 256.**

The Federal Circuit restated that the error requirement included both honest and dishonest errors and, post-AIA, meant any incorrect listing of inventors.

Our precedent provides that “error” in § 256 includes “all varieties of mistakes—honest and dishonest”—rather than only unintentional inaccuracy. *Stark v. Advanced Magnetics, Inc.*, 119 F.3d 1551, 1554–56 (Fed. Cir. 1997). \*\*\* Indeed, § 256 is a savings provision, functioning to prevent invalidation when correction is available. It is the inequitable-conduct rules that provide a safety valve in the event of deceit. *Id.* at 1555–56. \*\*\* We hold that the AIA did not narrow the meaning of “error.” Accordingly, § 256 does not exclude “considered acts,” or even “deceptive intention,” from the meaning of “error.” *Cf. Judicial Estoppel Decision*, 348 F. Supp. 3d at 102 n.1. “Error” is simply the incorrect listing of inventors. [*Egenera, Inc. v. Cisco Systems, Inc.*, 2019-2015, 2019-2387 (Fed. Cir. 8/28/2020).]

**Legal issue: Judicial estoppel, based upon the act of filing a request to correct inventorship pursuant to 35 USC 256.**

The Federal Circuit held, narrowly, that a § 256 petition, without more, does not count as persuasion of a court for judicial-estoppel purposes.

And on the facts of the case, the Federal Circuit concluded that “The district court legally erred as to each *New Hampshire* factor,” and held that “the district court abused its discretion by applying judicial estoppel.”

First, the Federal Circuit defined its choice of law.

For questions of judicial estoppel, we apply the law of the regional

circuit—here the First Circuit. *Akamai Techs., Inc. v. Limelight Networks, Inc.*, 805 F.3d 1368, 1374 (Fed. Cir. 2015). The legal effect of representations to the PTO and statutory interpretation of the Patent Act, however, are issues of Federal Circuit law. *See Endo Pharm. Inc. v. Teva Pharm. USA, Inc.*, 919 F.3d 1347, 1352 (Fed. Cir. 2019). Under First Circuit law, we review a district court’s application of judicial estoppel for abuse of discretion. *Akamai*, 805 F.3d at 1374 (citing *Knowlton v. Shaw*, 704 F.3d 1, 9–10 (1st Cir. 2013)). We accept underlying findings of fact unless they are clearly erroneous and review the resolution of legal questions de novo. *Id.* The First Circuit “treat[s] a material mistake of law as a per se abuse of discretion.” *Perry v. Blum*, 629 F.3d 1, 8 (1st Cir. 2010). [*Egenera, Inc. v. Cisco Systems, Inc.*, 2019-2015, 2019-2387 (Fed. Cir. 8/28/2020).]

Second, the Federal Circuit identified the relevant law.

Judicial estoppel is an equitable doctrine that prevents a litigant from taking a litigation position inconsistent with one successfully asserted in an earlier court proceeding. *See id.* “The purpose of the doctrine is to protect the integrity of the judicial process.” *Id.* Although the “contours of judicial estoppel are hazy,” and its application is case-dependent, the First Circuit applies the *New Hampshire* factors. *RFF Family P’ship v. Ross*, 814 F.3d 520, 527–28 (1st Cir. 2016) (Souter, J., sitting by designation). Accordingly, a court examines (1) whether a party’s earlier and later positions are “clearly inconsistent”—that is, “mutually exclusive”; (2) whether the party “succeeded in persuading a court to accept” the earlier position; and (3) whether the party would “derive an unfair advantage or impose an unfair detriment” on the other side if not estopped. *New Hampshire v. Maine*, 532 U.S. 742, 750–51 (2001). [*Egenera, Inc. v. Cisco Systems, Inc.*, 2019-2015, 2019-2387 (Fed. Cir. 8/28/2020).]

On the first factor, the Federal Circuit found that Egenera’s requesting the PTO remove an inventor, ex parte, and then later move the district court to add the inventor back in once the claims had been construed contrary to the patentee’s contentions, not clearly inconsistent.

On the third factor, the Federal Circuit found that Egenera obtained no advantage by filing in the PTO its request to remove the inventor, because the PTAB in an IPR petition on the same patent never the issue to which the inventorship related (ability to swear behind a reference relied upon in the IPR petition), and the Federal Circuit found noted that Cisco had not explained how any advantage would be unfair.

On the second factor, the Federal Circuit stated that:

Second, Egenera did not succeed in persuading a court or court-like tribunal to accept its first position. “‘Acceptance’ in this context is a term of art.” *Perry*, 629 F.3d at 11. That is, “a party need not show that the earlier representation led to a favorable ruling on the merits . . . but must show that the court adopted and relied on the represented position either in a preliminary matter

or as part of a final disposition.” *Id.* And “[t]he showing of judicial acceptance must be a strong one.” *Id.* In this factor, we ask whether the earlier tribunal’s acceptance implicated the “truth-seeking function of the court.” *Id.* at 11 (quoting *Teledyne Indus., Inc. v. NLRB*, 911 F.2d 1214, 1218 (6th Cir. 1990)). This requirement aligns with the doctrine’s purpose of “safeguard[ing] the integrity of the courts by preventing parties from improperly manipulating the machinery of the judicial system.” *New Hampshire*, 532 U.S. at 750. The district court concluded that “[t]he PTO accepted these representations”—referring to the inventorship petition. *Judicial Estoppel Decision*, 348 F. Supp. 3d at 102. As an initial matter, the inventorship petition contained no underlying statements of fact—simply statements that Mr. Schulter’s listing was erroneous and that all the colisted inventors agreed or did not disagree. *See* J.A.9367–80. The PTO did not cast these statements into the crucible of examination. Rather, it agreed that all the signatures and fees were in order. *See* J.A. 9388; MPEP § 1481.02. [*Egenera, Inc. v. Cisco Systems, Inc.*, 2019-2015, 2019-2387 (Fed. Cir. 8/28/2020).]

Under 37 C.F.R. § 1.324(b), the PTO examines a request only for the presence of supporting statements and the required fee. *See also* MPEP § 1481.02; J.A. 9388. No substantive examination occurs, and the PTO does not consider the substantive adequacy of the petition. Cisco argues that the First Circuit has rejected a “ministerial” exception. But in explanation, Cisco points out that unexamined identification of assets during bankruptcy proceedings can ground judicial estoppel in a later bankruptcy proceeding. *See* Appellee’s Br. 45 (citing *Guay v. Burack*, 677 F.3d 10, 17 (1st Cir. 2012)). We find Cisco’s arguments unpersuasive: bankruptcy schedules occur in the context of a bankruptcy court—they are specific representations of fact before a tribunal. [8] And as *Egenera* argues, Cisco’s chosen administrative judicial-estoppel precedents involve “inconsistent statements about an objective fact, such as the existence of bankruptcy assets or a claimed disability” rather than “context-related legal conclusions.” Reply Br.19. [9] Accordingly, even though we agree that judicial estoppel can occur in an administrative tribunal,[10] we disagree that a § 256 petition, without more, counts as “persuasion” of a “court” for judicial-estoppel purposes. [*Egenera, Inc. v. Cisco Systems, Inc.*, 2019-2015, 2019-2387 (Fed. Cir. 8/28/2020).]

This determination is narrow. We do not hold that judicial estoppel cannot apply to statements made during substantive prosecution, ex parte reexamination, or other quasi-adjudicatory proceedings—an issue not before us. And we do not go so far as to say that other theories of estoppel cannot apply to ministerial filings or representations before the PTO. But judicial estoppel cannot be stretched beyond persuading a tribunal, and it does not apply here. [*Egenera, Inc. v. Cisco Systems, Inc.*, 2019-2015, 2019-2387 (Fed. Cir. 8/28/2020).]

**Phytelligence, Inc. v. Washington State University, 2019-2216 (Fed. Cir. 8/27/2020).**

This is a decision on an appeal from the W.D. Wash. district court case 2:18-cv-00405-RSM. The district court entered SJ in favor of Washington. Phytelligence appealed. The Federal Circuit affirmed.

**Legal issue: Contract law, definition of an agreement to agree.**

The Federal Circuit distinguished between an unenforceable “agreement to agree,” and an enforceable “agreement with open terms.”

Here, the Federal Circuit concluded that the existing agreement provided an option that turns on a future contract between the parties, and thus required “a further meeting of the minds of the parties,” and therefore was merely an unenforceable an agreement to agree.

“An agreement to agree is an agreement to do something which requires a further meeting of the minds of the parties and without which it would not be complete. Agreements to agree are unenforceable in Washington.” *P.E. Sys., LLC v. CPI Corp.*, 289 P.3d 638, 644 (Wash. 2012) (internal quotation marks omitted). Underlying this rule is the fundamental principle that Washington courts are unable to fix the liability of parties based on agreements that are “too indefinite and uncertain.” *Sandeman v. Sayres*, 314 P.2d 428, 430 (Wash. 1957) (internal quotation marks omitted); *see also Keystone Land & Dev. Co. v. Xerox Corp.*, 94 P.3d 945, 949 (Wash. 2004); *Setterlund v. Firestone*, 700 P.2d 745, 746 (Wash. 1985) (“[A]greements must be definite enough on material terms to allow enforcement without the court supplying those terms.”) . A court will not enforce an indefinite agreement in order “to avoid trapping parties in surprise contractual obligations.” *Keystone*, 94 P.3d at 949 (internal quotation marks omitted). [Phytelligence, Inc. v. Washington State University, 2019-2216 (Fed. Cir. 8/27/2020).]

By contrast, “[u]nder an agreement with open terms, the parties intend to be bound by the key points agreed upon with the remaining terms supplied by a court or another authoritative source, such as the Uniform Commercial Code.” *P.E. Sys.*, 289 P.3d at 644 (quotation marks omitted). Any missing or open term can therefore be “easily” discerned by the court. *Id.* [Phytelligence, Inc. v. Washington State University, 2019-2216 (Fed. Cir. 8/27/2020).]

Here, Section 4 of the Propagation Agreement provides that Phytelligence is “hereby granted an option,” but that Phytelligence “will need to sign a separate contract with [WSU], or an agent of [WSU], to exercise this option.” J.A. 51. Thus, the plain terms of the agreement provide that Phytelligence’s option turns on a future contract between the parties, and thus “a further meeting of the minds of the parties” is required before Phytelligence can commercialize WA 38. *P.E. Sys.*, 289 P.3d at 644. This renders Section 4 an unenforceable agreement to agree. [Phytelligence, Inc. v. Washington State University, 2019-2216 (Fed. Cir. 8/27/2020).]

**Baxalta Inc. v. Genentech, Inc., 2019-1527 (Fed. Cir. 8/27/2020).**

This is an appeal from the D. Del. district court case 1:17-cv-00509-TBD. The district court entered judgement of non-infringement based upon its claim construction order. Baxalta appealed arguing the claim construction was erroneous. The Federal Circuit vacated the judgement of non-infringement and remanded.

**Legal issue: 35 USC 112, claim construction, defining terms in the specification.**

The Federal Circuit concluded that the district court, erred, primarily by not considering the specification as a whole and instead focusing only on a passage only arguably defining the term “antibody.”

Regarding the district court’s analysis, the Federal Circuit noted:

The district court determined that this portion of the written description defined the term “antibody.” While this is a plausible reading of the excerpt in isolation, claim construction requires that we “consider the specification as a whole, and [] read all portions of the written description, if possible, in a manner that renders the patent internally consistent.” *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1379–80 (Fed. Cir. 2001). When considered in the context of the remainder of the written description and the claims, we read the excerpt in column 5 as a generalized introduction to antibodies rather than as a definitional statement. We also note that these general statements do not include terms we have held to be limiting in other contexts such as “the present invention includes . . .” or “the present invention is . . .” or “all embodiments of the present invention are . . .” *Luminara Worldwide, LLC v. Liown Elecs. Co.*, 814 F.3d 1343, 1353 (Fed. Cir. 2016). Beyond this general description in column 5, the written description provides specific disclosures regarding bispecific, chimeric, and humanized antibodies and methods of production thereof, all of which do not comport with the district court’s construction. [*Baxalta Inc. v. Genentech, Inc.*, 2019-1527 (Fed. Cir. 8/27/2020).]

The Federal Circuit found another factor significant, which was that the district court’s construction would result in invalidation of several dependent claims on the basis that they were inconsistent with the narrow construction the district court ascribed to independent claim 1. The Federal Circuit explained:

The dependent claims confirm that “antibody” is not so limited. The dependent claims confirm that “antibody” is not so limited. For example, dependent claim 4, recites “[t]he antibody or antibody fragment according to claim 1, wherein said antibody or antibody fragment is selected from the group consisting of . . . a chimeric antibody, a humanized antibody, . . . [and] a bispecific antibody.” Each of these claimed “antibodies” falls outside of the district court’s construction because each does not “only bind[] to the antigen that induced its synthesis or very similar antigens.” [3] A “bispecific antibody” also does not satisfy the district court’s construction of “antibody” because a bispecific

antibody does not consist of two identical H chains and two identical L chains. Dependent claim 19 further limits claims 1 and 4 by claiming that the “antibody is a humanized antibody,” which again does not fall within the district court’s construction of “antibody.” The district court’s construction which excludes these explicitly claimed embodiments is inconsistent with the plain language of the claims. [4] See *Intellectual Ventures I LLC v. T-Mobile USA, Inc.*, 902 F.3d 1372, 1378 (Fed. Cir. 2018); see also *Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc.*, 520 F.3d 1358, 1362 (Fed. Cir. 2008) (rejecting a construction that would “render several dependent claims meaningless”). [*Baxalta Inc. v. Genentech, Inc.*, 2019-1527 (Fed. Cir. 8/27/2020).]

**Security People, Inc. v. Iancu, 2019-2118 (Fed. Cir. 8/20/2020).**

This is a decision on an appeal from the N.D. Ca. case 4:18-cv-06180-HSG. Security appealed. The Federal Circuit affirmed.

**Legal issues: Constitution, Fifth Amendment, due process, collateral attack on an inter partes review decision.**

The Federal Circuit held that the statutory scheme separately establishes an adequate remedy in a court for a constitutional challenge, which satisfies due process therefore precludes collateral attack.

We first reject Security People’s argument that, because the Board purportedly lacks the authority to decide constitutional claims, constitutional questions raised by an IPR final written decision must be reviewable in district court under the APA. Even accepting as true Security People’s assertion that the Board may not decide a constitutional question, this court—which Congress designated to conduct judicial review of the Board’s final written decisions—can meaningfully address constitutional questions on appeal. See *Elgin*, 567 U.S. at 17 (citing *Thunder Basin Coal Co. v. Reich*, 510 U.S. 200, 215 (1994)). [*Security People, Inc. v. Iancu*, 2019-2118 (Fed. Cir. 8/20/2020).]

The presence of disputed factual questions does not change that calculus. *Elgin* remains instructive. \*\*\* The Court then explained that—for the rare occasions when a constitutional claim “requires the development of facts beyond those that [we] may judicially notice”—“the [Civil Service Reform Act] empowers the MSPB to take evidence and find facts for Federal Circuit review.” *Elgin*, 567 U.S. at 19 (citing 5 U.S.C. § 1204(b)(1)–(2) (empowering MSPB members, administrative law judges, and designated employees to administer oaths, examine witnesses, take depositions, receive evidence, issue subpoenas for both persons and evidence, and order depositions)). The PTAB has similar fact-finding authority to the MSPB, also allowing it to resolve disputed factual questions, even if it cannot decide the legal question for which those factual questions are relevant. See 35 U.S.C. §§ 24 (providing for the issuance of subpoenas in contested cases before the PTO), 316(a)(5) (authorizing the PTO

Director to promulgate regulations for discovery of relevant evidence in IPRs, including “what is otherwise necessary in the interest of justice”); 37 C.F.R. § 42.100(a) (“An inter partes review is a trial subject to the procedures set forth in [37 C.F.R. §§ 42.1–42.80].”); see also 37 C.F.R. §§ 42.52 (governing the compulsion of testimony by the Board), 42.53 (providing procedures for taking both compelled and uncompelled testimony). [Security People, Inc. v. Iancu, 2019-2118 (Fed. Cir. 8/20/2020).]

More generally, we agree with the district court that the statutes providing for exclusive review of the Board’s final written decisions in this court preclude district courts from exercising APA jurisdiction over claims challenging the constitutionality of a final written decision. \*\*\* Like the statutory schemes in *ThunderBasin* and *Elgin*, the AIA “does not foreclose all judicial review of . . . constitutional claims, but merely directs that judicial review shall occur in the Federal Circuit,” which “is fully capable of providing meaningful review” of the types of constitutional claims asserted here. *Elgin*, 567 U.S. at 10. [T]he APA authorizes judicial review of final agency actions only if “there is no other adequate remedy in a court.” *Pregis*, 700 F.3d at 1356 (quoting 5 U.S.C. § 704). The agency action here—the final written decision of an IPR—is reviewable by statute, but in the Federal Circuit, not in an APA-based collateral attack in a district court. And, as explained above, the judicial review afforded Security People in this court under 35 U.S.C. § 141(c) offers an adequate remedy for any meritorious constitutional claims. *Cf. Pregis*, 700 F.3d at 1360 (holding that a party aggrieved by the result of an inter partes reexamination had an adequate remedy in a court because it “may obtain judicial review of . . . [a reexamination] decision . . . by appealing to the Board and then, if necessary, to this court”). [Security People, Inc. v. Iancu, 2019-2118 (Fed. Cir. 8/20/2020).]

Note: This decision indicates that a party to a PTAB proceeding would have to request discovery during the PTAB proceeding to support a constitutional challenge, even if the PTAB lacks authority to decide that challenge.

**Godo Kaisha IP Bridge 1 v. TCL Communication Technology, 2019-2215 (Fed. Cir. 8/4/2020).**

This is a decision on an appeal from the D. Del. district court case 1:15-cv-00634-JFB-SRF. A jury found TCL liable for infringement. TCL moved for JMOL of no infringement. The district court denied TCL's motion. TCL appealed. The Federal Circuit affirmed.

**Legal issue: 35 USC 271, proof of infringement, standards essentiality, relationship to proof of infringement, question of fact.**

The Federal Circuit held that it was proper to submit to a jury the questions (1) whether the patent claims are essential to mandatory aspects of a standard and (2) whether accused products practice that standard. The Federal Circuit clarified prior holdings to the extent that this

procedure was proper only when the patent claims are essential to mandatory aspects of a standard.

We recognized in *Fujitsu* that the fact that a patent’s claims cover an industry standard does not necessarily establish that all standard-compliant devices implement the standard in the same way. And we noted that an asserted patent claim might not cover all implementations of an industry standard. In such cases, we guided, infringement must be proven by comparing the claims to the accused products, or by proving that the accused devices “implement any relevant optional sections of the standard.” *Id.* at 1328. Thus, *Fujitsu* teaches that where, but only where, a patent covers mandatory aspects of a standard, is it enough to prove infringement by showing standard compliance. [Godo Kaisha IP Bridge 1 v. TCL Communication Technology, 2019-2215 (Fed. Cir. 8/4/2020).]

In this appeal, the parties dispute whether the patentee was permitted to prove that the Appellants’ products infringed the claims of the asserted patent by showing that: (1) the patent claims are essential to mandatory aspects of the Long-Term Evolution (“LTE”) standard; and (2) the accused products practice that standard. \*\*\* We find no error in the submission of these questions to the jury in the context of an infringement trial. [Godo Kaisha IP Bridge 1 v. TCL Communication Technology, 2019-2215 (Fed. Cir. 8/4/2020).]

This appeal presents a question not expressly answered by our case law: who determines the standard-essentiality of the patent claims at issue—the court, as part of claim construction, or the jury, as part of its infringement analysis? \*\*\* Essentiality is, after all, a fact question about whether the claim elements read onto mandatory portions of a standard that standard-compliant devices must incorporate. This inquiry is more akin to an infringement analysis (comparing claim elements to an accused product) than to a claim construction analysis (focusing, to a large degree, on intrinsic evidence and saying what the claims mean). [Godo Kaisha IP Bridge 1 v. TCL Communication Technology, 2019-2215 (Fed. Cir. 8/4/2020).]

**Illumina, Inc. v. Ariosa Diagnostics, Inc., 2019-1419 (Fed. Cir. 8/3/2020).**

This is a decision on rehearing of an appeal from the N.D. Cal. case 3:18-cv-02847-SI. The district court decided that the claims were invalid under 35 USCX 101 as directed to an ineligible natural phenomenon. Illumina appealed. The Federal Circuit reversed.

**Legal issue: 35 US 101, patent eligibility, method of preparation, changing a composition of a mixture.**

The Federal Circuit concluded that the claimed method of preparation requiring “producing a fraction of the DNA extracted” in a prior step, that changed the composition of a mixture, was patent eligible.



...The claims include physical process steps that change the composition of the mixture, resulting in a DNA fraction that is different from the naturally occurring fraction in the mother's blood. \*\*\* The inventors in *CellzDirect* did not invent hepatocytes or impart to hepatocytes an ability to survive cycles of freezing and thawing. *Id.* at 1045. Rather, they discovered that hepatocytes naturally have that ability, and they exploited that phenomenon in a patent-eligible method. So too here, the inventors of the '751 and '931 patents obviously did not invent cell-free fetal DNA or the relative size distribution of fetal and maternal cell-free DNA in maternal blood. And, like in *CellzDirect*, the inventors used their discovery to invent a method of preparing a fraction of DNA that includes physical process steps with human-engineered size parameters to selectively remove some maternal DNA in blood to produce a mixture enriched in fetal DNA. [*Illumina, Inc. v. Ariosa Diagnostics, Inc.*, 2019-1419 (Fed. Cir. 8/3/2020).]

**Bio-Rad Laboratories, Inc. v. 10x Genomics Inc., 2019-2255, 2019-2285 (Fed. Cir. 8/3/2020).**

This is a decision on appeals from the D. Del. district court case 1:15-cv-00152-RGA. Relevant here, the Federal Circuit reversed the district court's construction of the asserted claims of the '407 and '193 patents and vacated the judgment of infringement of those patents.

**Legal issue: 35 USC 112, claim construction, preamble, limiting effect, the preamble reciting the location of reaction.**

The Federal Circuit concluded that the fact that the claim relied for antecedent on the preambular recitations "reaction" and "microfluidic systems," and indicated the "drafters intended to limit the claimed ..., using both the preamble and the body of the claim to define the claimed invention."

The preamble at issue recites "[a] method for conducting a reaction in plugs in a microfluidic system, comprising the steps of . . . ." '407 patent, col. 78 ll. 54–55. 3 At the *Markman* stage, the district court found that the preamble was limiting "only to the extent that it provides an antecedent basis for the terms 'microfluidic system' and 'reaction.'" *Raindance Techs., Inc. v. 10X Genomics, Inc.*, No. 1:15-CV-00152-RGA, 2017 WL 382235, at \*7 (D. Del. Jan. 26, 2017)). It found that the preamble at issue "states an intended use for the invention, 'followed by the body of the claim, in which the claim limitations describing the invention are recited.'" *Id.* (quoting *TomTom, Inc. v. Adolph*, 790 F.3d 1315, 1324 (Fed. Cir. 2015)). It also found that the invention, as claimed, was "'structurally complete' without the remaining preamble language." *Id.* [*Bio-Rad Laboratories, Inc. v. 10x Genomics Inc.*, 2019-2255, 2019-2285 (Fed. Cir. 8/3/2020).]

The district court's application of *TomTom* to the facts before it is erroneous. In *TomTom*, we held that the district court erred in determining that it had to construe the entire preamble if it construed a portion of it. *TomTom*, 790 F.3d at 1322–24. The two-part preamble of the asserted claim recited: "[1] [a]

method for generating and updating data [2] for use in a destination tracking system of at least one mobile unit comprising . . . .” *Id.* at 1322 (alteration omitted). We held that the first part of the preamble, “method for generating and updating data,” was not limiting and did not provide an antecedent basis for any claim terms. *Id.* at 1323–24. We also found that the term did not recite essential structure or steps, or give necessary life, meaning, and vitality to the claim; rather, it stated “a purpose or intended use.” *Id.* At the same time, we held that the second part of the preamble, “destination tracking system of at least one mobile unit,” was limiting because it provided antecedent basis for “the mobile unit” recited in the body of the claims. *Id.* Thus, we found that *TomTom* involved a partially-limiting preamble. [Bio-Rad Laboratories, Inc. v. 10x Genomics Inc., 2019-2255, 2019-2285 (Fed. Cir. 8/3/2020).]

Crucially, unlike *TomTom*, the preamble in this case cannot be neatly packaged into two separate portions. Nor does it simply recite a method for an intended use or purpose. The district court held that the preamble terms “reaction” and “microfluidic systems” provide antecedent basis for the use of those terms in the body of the claim. We agree with the court on this point. But we disagree that these limiting terms can be read separately from the remainder of the preamble. The language relied upon for antecedent basis in the preamble at issue is intertwined with the rest of the preamble. The term “conducting” in the preamble is not analogous to the non-limiting language at issue in *TomTom*. [Bio-Rad Laboratories, Inc. v. 10x Genomics Inc., 2019-2255, 2019-2285 (Fed. Cir. 8/3/2020).]

We also are disinclined to sanction finding a preamble “partially” limiting by splicing it as the district court did here. The fact that the terms “reaction” and “microfluidic systems” provide antecedent basis for these terms in the body of the claim is a strong indication that the preamble acts “as a necessary component of the claimed invention.” *Eaton Corp. v. Rockwell Int’l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003). Based on the antecedent relationship, it is clear the claim drafters intended to limit the claimed methods to on-chip reactions, using both the preamble and the body of the claim to define the claimed invention. [4] Accordingly, we conclude that the district court’s claim construction is erroneous. Under the correct construction, the claimed methods are limited to on-chip reactions. [Bio-Rad Laboratories, Inc. v. 10x Genomics Inc., 2019-2255, 2019-2285 (Fed. Cir. 8/3/2020).]

The prosecution history of the patent, although not dispositive in this case, provides additional support for construing the claims as limited to reactions in a microfluidic system. During prosecution, the examiner amended both the preambles and the titles of the patents to specify that the reactions are conducted “in plugs in the microfluidic system.” J.A. 8625–29; J.A. 8632. [Bio-Rad

Laboratories, Inc. v. 10x Genomics Inc., 2019-2255, 2019-2285, footnote 4 (Fed. Cir. 8/3/2020).]

Note: I find the decisions reasoning fuzzy and off point. It is as if the decision failed to consider that the preamble could expressly define a limitation, without linking to the body of the claim. The decision criticizes the district court's reliance on *TomTom*, rather than clearly explaining why the claimed recitation is limiting. The preamble recites conducting a reaction in plugs "in a microfluidic system," which limits the location of the reaction to be "in" whatever is the "microfluidic system." I do not see the decision addressing this point. Elsewhere, the decision equates in a microfluidic system with "on-chip," stating "reactions inside a microfluidic system, i.e., to 'on-chip' reactions only." So it is pretty clear that the preamble, by expressly reciting conducting the reaction in the microfluidic system, was limiting.