

## Precedential Patent Case Decisions During March 2021

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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

#### **In re Board of Trustees of the Leland Stanford Junior University, 2020 1288 (Fed. Cir. 3/25/2021).**

This is a decision on an appeal by Stanford in PTAB case 13/486,982. The PTAB held the claims to be directed to patent ineligible subject matter. Stanford appealed. The Federal Circuit affirmed.

**Legal issue: 35 USC 101, patent eligible subject matter, algorithm providing improved accuracy of prediction.**

The Federal Circuit concluded that a predictive algorithm providing improved accuracy of a mathematically calculated statistical prediction did not qualify as patent eligible subject matter.

Stanford separately suggests that another claimed advance is that the claim steps result in more accurate haplotype predictions. *See, e.g.*, Appellant’s Br. 21–22, 29–34, 43, 46. Specifically, Stanford argues that the alleged increase in haplotype prediction accuracy renders claim 1 a practical application rather than an abstract idea. *See id.* at 30. Stanford’s cited cases do not support its argument because the cases involve practical, technological improvements extending beyond improving the accuracy of a mathematically calculated statistical prediction. \*\*\* The different use of a mathematical calculation, even one that yields different or better results, does not render patent eligible subject matter. [In re Board of Trustees of the Leland Stanford Junior University, 2020-1288 (Fed. Cir. 3/25/2021).]

This is a rather straightforward decision on 101 and therefore provides a good review of the Federal Circuit’s decisional process. I excerpt below the decision process in the sequence in which it was applied by the Federal Circuit.

The Federal Circuit restated the applicable standards of review.

We review Board decisions in accordance with the Administrative Procedure Act (“APA”). 5 U.S.C. § 706(2); *Dickinson v. Zurko*, 527 U.S. 150,

152 (1999). Under the APA, we review the Board’s legal conclusions de novo and its factual findings for substantial evidence. *ACCO Brands Corp. v. Fellowes, Inc.*, 813 F.3d 1361, 1365 (Fed. Cir. 2016). Substantial evidence is “such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.” *In re Gartside*, 203 F.3d 1305, 1312 (Fed. Cir. 2000) (quoting *Consol. Edison Co. v. NLRB*, 305 U.S. 197, 229 (1938)). [In re Board of Trustees of the Leland Stanford Junior University, 2020-1288 (Fed. Cir. 3/25/2021).]

The Federal Circuit restated the applicable substantive 35 USC 101 eligibility case law.

The Supreme Court has articulated a two-step analysis to determine patent eligibility under 35 U.S.C. § 101. *Alice*, 573 U.S. at 217–18. In the first step, we examine whether a claim is directed to patent ineligible subject matter, such as an abstract idea. *Id.* If so, we turn to the second step and examine whether the claims contain an inventive concept sufficient to transform the abstract idea into patent eligible subject matter. *Id.* at 221. In this second step we consider the claim elements individually and as an ordered combination to determine whether any additional limitations amount to significantly more than the ineligible concept. *Id.* at 217–18, 221. A patent eligible claim must do more than simply recite the abstract idea “while adding the words ‘apply it.’” *Id.* at 221. [In re Board of Trustees of the Leland Stanford Junior University, 2020-1288 (Fed. Cir. 3/25/2021).]

The Federal Circuit applied *Alice* step 1 to the claim.

We conclude, at *Alice* step one, that the reviewed claims of the ’982 application are directed to patent ineligible abstract ideas. Specifically, the claims are directed to the use of mathematical calculations and statistical modeling. \*\*\* Claim 1 is drawn to a “computerized method of inferring haplotype phase in a collection of unrelated individuals.” \*\*\* In addition to these mathematical steps, claim 1 recites steps of receiving genotype data, imputing an initial haplotype phase, extracting the final predicted haplotype phase from the data structure, and storing it in a computer memory. *See id.* These generic steps of implementing and processing calculations with a regular computer do not change the character of claim 1 from an abstract idea into a practical application. Claim 1 recites no application, concrete or otherwise, beyond storing the haplotype phase. [In re Board of Trustees of the Leland Stanford Junior University, 2020-1288 (Fed. Cir. 3/25/2021).]

Stanford separately suggests that another claimed advance is that the claim steps result in more accurate haplotype predictions. *See, e.g.*, Appellant’s Br. 21–22, 29–34, 43, 46. Specifically, Stanford argues that the alleged increase in haplotype prediction accuracy renders claim 1 a practical application rather than

an abstract idea. *See id.* at 30. Stanford’s cited cases do not support its argument because the cases involve practical, technological improvements extending beyond improving the accuracy of a mathematically calculated statistical prediction. \*\*\* The different use of a mathematical calculation, even one that yields different or better results, does not render patent eligible subject matter. [In re Board of Trustees of the Leland Stanford Junior University, 2020-1288 (Fed. Cir. 3/25/2021).]

The Federal Circuit applied *Alice* step 2 to the claim.

We find no inventive concept that would warrant treating the use of the claimed algorithms and mathematical calculations as patent eligible subject matter. Further, the recited steps of receiving, extracting, and storing data amount to well-known, routine, and conventional steps taken when executing a mathematical algorithm on a regular computer. Using a conventional computer to receive, extract, and store information does not transform an abstract idea into patent eligible subject matter. *See, e.g., In re Greenstein*, 774 F. App’x 661, 664 (Fed. Cir. 2019) (explaining that the claims only invoke a computer as a generic tool to store information and record transactions). \*\*\* Nor does claim 1 require or result in a specialized computer or a computer with a specialized memory or processor. [In re Board of Trustees of the Leland Stanford Junior University, 2020-1288 (Fed. Cir. 3/25/2021).]

Stanford argues the Board erred by failing to consider all the elements of claim 1 as an ordered combination. \*\*\* According to Stanford, it is the specific combination of steps recited in claim 1 “that makes the process novel” and “that provides the increased accuracy over other methods.” \*\*\* The Board correctly determined that claim 1 simply appends the abstract calculations to the well-understood, routine, and conventional steps of receiving and storing data in a computer memory and extracting a predicted haplotype. \*\*\* Nor is novelty the touch-stone of patent eligibility. That a specific or different combination of mathematical steps yields more accurate haplotype predictions than previously achievable under the prior art is not enough to transform the abstract idea in claim 1 into a patent eligible application. *See SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1170 (Fed. Cir. 2018)(holding that an advance in financial mathematical techniques does not constitute an inventive concept). [In re Board of Trustees of the Leland Stanford Junior University, 2020-1288 (Fed. Cir. 3/25/2021).]

**[Mylan Laboratories Ltd. V. Janssen Pharmaceutical, N.V., 2021-1071 \(Fed. Cir. 3/12/2021\).](#)**

This is a decision on appeal from PTAB case IPR2020-00440. The PTAB denied institution of Mylan’s IPR petition. Mylan both appealed and petitioned for mandamus relief from that denial. The Federal Circuit dismissed the appeal and denied the request for mandamus.

**Legal issue: 28 USC 1295(a)(4)(A) jurisdiction over an appeal from a PTAB denial to institute and IPR.**

The Federal Circuit held that the 35 USC 314(d) no appeal provision stripped the Federal Circuit of jurisdiction to hear an appeal from a denial of an IPR petition.

Our general grant of jurisdiction, 28 U.S.C. § 1295(a)(4), and the appeal bar, 35 U.S.C. § 314(d), are most relevant here. Read together, those statutes preclude direct appeal from a decision denying institution: \*\*\* At a first glance, the “appeal from a decision” language in § 1295(a)(4) seems broad, perhaps broad enough to reach an appeal from a decision denying institution. But § 314(d), the more specific statute, dispels any such notion. *See, e.g., Morales v. Trans World Airlines, Inc.*, 504 U.S. 374, 384 (1992) (“[I]t is a commonplace of statutory construction that the specific governs the general.”). Section 314(d) prevents “appeal” from a decision denying institution. Without the ability to “appeal,” parties cannot make use of § 1295(a)(4)’s jurisdictional grant. [Mylan Laboratories Ltd. V. Janssen Pharmaceutical, N.V., 2021-1071 (Fed. Cir. 3/12/2021).]

**Legal issue: 28 USC 1651(a) All Writs jurisdiction over an appeal from a PTAB denial to institute and IPR.**

The Federal Circuit held that it had 1651(a) jurisdiction to hear an appeal from a denial to institute an IPR petition because that was necessary to protect its prospective jurisdiction.

While there is no avenue for direct appeal of decisions denying institution, we conclude that judicial review is available in extraordinary circumstances by petition for mandamus. \*\*\* When institution is denied, the appeal bar in § 314(d) prevents any direct appeal. But that statute is silent with respect to mandamus. There is no reason, therefore, to think § 314(d) also divests us of mandamus jurisdiction. In fact, when the Board denies institution, our mandamus jurisdiction is especially important. Like unreasonable delay of agency action, a decision denying institution “defeats [our] prospective jurisdiction.” *Cf. Int’l Union, United Mine Workers of Am. v. U.S. Dep’t of Labor*, 358 F.3d 40, 43 (D.C. Cir. 2004) (holding mandamus review is available when an agency withdraws a proposed rule and the court had exclusive jurisdiction to review any promulgated rule). A decision denying institution prevents the Board from issuing any final decision that falls within our direct appellate jurisdiction. We must, therefore, be able to protect our prospective jurisdiction through mandamus. [4] We conclude that challenges to the denial of institution fall within the *TRAC* rubric. To protect our future jurisdiction, we have jurisdiction to review any petition for a writ of mandamus denying institution of an IPR. [Mylan Laboratories Ltd. V. Janssen Pharmaceutical, N.V., 2021-1071 (Fed. Cir. 3/12/2021).]

Ultimately, Mylan triggered our exclusive jurisdiction by petitioning for

IPR. It set the administrative machinery into motion and opened an avenue for appellate jurisdiction, no matter how “prospective or potential that jurisdiction might be.” *Tennant*, 359 F.3d at 529. And we may consider any petition for a writ of mandamus in order to protect that jurisdiction. Accordingly, we have jurisdiction to consider Mylan’s request for mandamus on the merits. [Mylan Laboratories Ltd. V. Janssen Pharmaceutical, N.V., 2021-1071 (Fed. Cir. 3/12/2021).]

**Legal issue: 28 USC 1651(a), requirements for mandamus from an IPR petition denying institution.**

The Federal Circuit held that the Director’s exercise of his discretion to deny institution of an IPR petition was *unreviewable*, except for colorable constitutional claims. This holding encompassed the issue of whether the PTAB’s adoption of an reliance upon its POP *Fintiv* precedent and factors was reviewable.

Mylan believes it is entitled to mandamus relief based on two statutory challenges and one constitutional challenge. First, it faults the Patent Office for adopting the *Fintiv* standard through a precedential Board decision, rather than notice-and-comment rulemaking. By doing so, Mylan claims, the Board exceeded the scope of its statutory authority. See 35 U.S.C. § 316(a)(2). Second, Mylan argues the *Fintiv* standard unlawfully shortens the limitations period for filing an IPR. *Id.* § 315(b). Finally, Mylan contends the *Fintiv* standard is unconstitutional as applied here. It claims that its due process rights were violated when the Board relied on the Teva litigation to deny institution. [Mylan Laboratories Ltd. V. Janssen Pharmaceutical, N.V., 2021-1071 (Fed. Cir. 3/12/2021).]

When a mandamus petition challenges a decision denying institution, the mandamus standard will be especially difficult to satisfy. The scope of our review of a mandamus petition over a denial of institution is very narrow. As the Supreme Court has explained, “the [Patent Office]’s decision to deny a petition is a matter committed to the Patent Office’s discretion. See [5 U.S.C.] § 701(a)(2); 35 U.S.C. § 314(a) (no mandate to institute review).” *Cuozzo*, 136 S. Ct. at 2140. The Director is permitted, but never compelled, to institute an IPR. And no petitioner has a right to such institution. For example, the Director is free, as in this case, to determine that for reasons of administrative efficiency an IPR will not be instituted, as agencies generally are free, for similar reasons, to choose not to initiate enforcement proceedings. *Heckler v. Chaney*, 470 U.S. 821, 830–32 (1985). And the Supreme Court has determined that such a decision is committed to agency discretion by law. *Cuozzo*, 136 S. Ct. at 2140. Given this determination and the statute’s bestowal of discretion on the Director combined with its prohibition on appeal of such decisions, we conclude that there is no reviewability of the Director’s exercise of his discretion to deny institution except for colorable constitutional claims. *Cf., e.g., Webster v. Doe*, 486 U.S. 592, 603–04 (1988)

(holding that a “colorable” constitutional claim was reviewable in district court even where the substance of the underlying termination decision was not); *Woodward v. United States*, 871 F.2d 1068, 1072 (Fed. Cir. 1989) (“While the statute and cited authorities indicate that the Secretary’s discretion is generally unfettered, employment actions claimed to be based on constitutionally infirm grounds are nevertheless subject to judicial review.”). [5] [Mylan Laboratories Ltd. V. Janssen Pharmaceutical, N.V., 2021-1071 (Fed. Cir. 3/12/2021).]

While we need not explore the outer contours of possibility, it is difficult to imagine a mandamus petition that challenges a denial of institution and identifies a clear and indisputable right to relief. Certainly, this is not such a petition. Mylan lacks a clear and indisputable right to review of the Patent Office’s determination to apply the *Fintiv* factors or the Patent Office’s choice to apply them in this case through adjudication rather than notice-and-comment rulemaking. Given the limits on our reviewability, Mylan’s ultra vires argument cannot be a basis for granting the petition for mandamus. Mylan’s time bar argument under § 315(b) fails for the same reason. [Mylan Laboratories Ltd. V. Janssen Pharmaceutical, N.V., 2021-1071 (Fed. Cir. 3/12/2021).]

Finally, Mylan fails to state a colorable claim for constitutional relief. It does not identify a deprivation of “life, liberty, [or] property,” so any procedural due process challenge is foreclosed. *Stone v. F.D.I.C.*, 179 F.3d 1368, 1375 (Fed. Cir. 1999) (“Procedural due process requires that certain substantive rights—life, liberty, and property—cannot be deprived except pursuant to constitutionally adequate procedures.”); *see also* Oral Arg. at 44:38–46:15 (questioning whether deprivation of a property right is required for a due process claim, but not identifying any property right). To be sure, we have held that a judgment must not bind a person “who was not party or privy and therefore has never had an opportunity to be heard.” *See, e.g., In re Trans Tex. Holdings Corp.*, 498 F.3d 1290, 1297 (Fed. Cir. 2007). But that rule is inapposite here. Mylan will not be bound by the Teva litigation; it is free to litigate the ’906 patent claims’ validity in its own district court case. [Mylan Laboratories Ltd. V. Janssen Pharmaceutical, N.V., 2021-1071 (Fed. Cir. 3/12/2021).]

Likewise, we are aware of no “history [or] tradition” that supports a fundamental right to have the Board consider whether to institute one’s IPR petition based only upon co-pending litigation to which you are a party. *Washington v. Glucksberg*, 521 U.S. 702, 720–21 (1997). That is, Mylan had no right for its petition to be considered without reference to the Teva litigation and no right to an IPR. Thus, Mylan has also failed to state a colorable claim under substantive due process. [Mylan Laboratories Ltd. V. Janssen Pharmaceutical, N.V., 2021-1071 (Fed. Cir. 3/12/2021).]

**Depuy Synthes Products, Inc., v. Veterinary Orthopedic Implants, Inc., 2020-1514 (Fed. Cir. 3/12/2021).**

This is a decision on an appeal from the M.D. Fla. district court case 3:18-cv-01342-HES-PDB. The district court ordered the court clerk to unseal an amended complaint. Defendant VOI objected, and appealed the order. The Federal Circuit affirmed.

**Legal issue: Jurisdiction, collateral order doctrine, applicability to unsealing an amended complaint filed under seal.**

The Federal Circuit concluded that the “public’s right to access judicial filings on the public docket” was an important issue completely separate from the merits of the action, and therefore the Federal Circuit had collateral-order-doctrine jurisdiction.

The courts of appeals “have jurisdiction of appeals from all final decisions of the district courts.” 28 U.S.C. § 1291. The collateral order doctrine is a narrow exception to the usual rule of finality and allows an interlocutory appeal when a trial court’s order “affect[s] rights that will be irretrievably lost in the absence of an immediate appeal.” *Apple Inc. v. Samsung Elecs. Co.*, 727 F.3d 1214, 1220 (Fed. Cir. 2013) (quoting *Richardson-Merrell, Inc. v. Koller*, 472 U.S. 424, 430–31 (1985)); *see also Cohen v. Benefit Indus. Loan Corp.*, 337 U.S. 541, 545–47 (1949) (recognizing the doctrine). For the collateral order doctrine to apply, an order must meet three requirements; it must (1) “conclusively determine the disputed question”; (2) “resolve an important issue completely separate from the merits of the action”; and (3) “be effectively unreviewable on appeal from a final judgment.” *Apple*, 727 F.3d at 1220 (quoting *Richardson-Merrell*, 472 U.S. at 431). [*Depuy Synthes Products, Inc., v. Veterinary Orthopedic Implants, Inc.*, 2020-1514 (Fed. Cir. 3/12/2021).]

The district court’s order unsealing the amended complaint satisfies all three conditions. First, the order conclusively determined that the information VOI seeks to protect does not merit sealing or redaction and should be filed on the public docket. Second, the sealing issue is unrelated to the merits of DePuy’s infringement claim but implicates the “important balance between the public’s interest in understanding judicial proceedings and the parties’ right to access the courts without being unduly required to disclose confidential information.” *See id.* Third, the order could not be meaningfully reviewed after a final judgment because the information in the amended complaint, once disclosed to the public, could not be made confidential again. *Id.*; *see also In re Kellogg Brown & Root, Inc.*, 756 F.3d 754, 761 (D.C. Cir. 2014) (holding that appeal of disclosure order after final judgment “will often come too late” because “the cat is out of the bag”); *Ameziane v. Obama*, 620 F.3d 1, 5 (D.C. Cir. 2010) (holding that disclosure of redacted text would be “effectively unreviewable” because “the disclosure cannot be undone”); *In re Sims*, 534 F.3d 117, 129 (2d Cir. 2008) (noting that “a remedy after final judgment cannot unsay the confidential information that has been revealed”); *In re Copley Press, Inc.*, 518 F.3d 1022, 1025 (9th Cir. 2008)

(“Secrecy is a one-way street: Once information is published, it cannot be made secret again.”). We therefore have jurisdiction under the collateral order doctrine. [Depuy Synthes Products, Inc., v. Veterinary Orthopedic Implants, Inc., 2020-1514 (Fed. Cir. 3/12/2021).]

DePuy relies heavily on *Awuah v. Coverall North America, Inc.*, 585 F.3d 479 (1st Cir. 2009), in arguing that the order here is not appealable because it does not present an important issue sufficient to confer jurisdiction under the collateral order doctrine. In *Awuah*, the issue was not about public disclosure, but whether certain discovery material needed to be disclosed to the plaintiffs without being subject to the protective order; this apparently affected the plaintiffs’ ability to show the information to experts and potential witnesses. *See id.* at 483. Here, by contrast, the district court’s order implicates the public’s right to access judicial filings on the public docket. We find this right sufficiently important to distinguish this case from cases involving routine discovery orders governing disclosures between parties to a case. [Depuy Synthes Products, Inc., v. Veterinary Orthopedic Implants, Inc., 2020-1514 (Fed. Cir. 3/12/2021).]

**In re Board of Trustees of the Leland Stanford Junior University, 2020-1012 (Fed. Cir. 3/11/2012).**

This is a decision on an appeal from PTAB case 13/445,925.

The PTAB held the claims directed to patent ineligible subject matter. Stanford appealed. The Federal Circuit affirmed.

**Legal issue: 35 USC 101, eligibility, novel abstract idea.**

The Federal Circuit restated that a novel abstract idea is not patent eligible subject matter.

Stanford argues that claim 1 is not directed to an abstract idea because the specific application of the steps is novel and enables scientists to ascertain more haplotype information than was previously possible. *See, e.g.*, Appellant’s Br. 5 (“While the ‘trio’ method may be able to provide long-range haplotype phasing for approximately 80% of heterozygous positions, the method of the present invention provides accurate, long-range phasing at 97.9% of all heterozygous positions.” (citing the ’925 application at ¶¶ 91–92)). Even accepting the argument that the claimed process results in improved data, we are not persuaded that claim 1 is not directed to an abstract mathematical calculation. *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016) (“[A] claim for a new abstract idea is still an abstract idea.”); *SAP*, 898 F.3d at 1170 (“[P]atent law does not protect such claims, without more, no matter how groundbreaking the advance.”). [In re Board of Trustees of the Leland Stanford Junior University, 2020-1012 (Fed. Cir. 3/11/2012).]

The Federal Circuit restated that a storing and displaying information resulting from use of a novel abstract idea was patent ineligible.

Because claim 1 is directed to a patent ineligible mathematical algorithm, we turn next to *Alice* step two. We conclude that claim 1 is not transformed at step two into patent eligible subject matter. Claim 1 recites no steps that practically apply the claimed mathematical algorithm; instead, claim 1 ends at storing the haplotype phase and “providing” it “in response to a request.” Simply storing information and providing it upon request does not alone transform the abstract idea into patent eligible subject matter. *See, e.g., In re Greenstein*, 774 F. App’x 661, 664 (Fed. Cir. 2019) (explaining that the claims at issue only invoked a computer as a generic tool to store information and record transactions). [*In re Board of Trustees of the Leland Stanford Junior University*, 2020-1012 (Fed. Cir. 3/11/2012).]

***Uniloc 2017 LLC v. Facebook Inc.*, 2019-1688, 2019-1689 (Fed. Cir. 3/9/2021).**

This is a decision on appeals from PTAB cases IPR2017-01427 and IPR2017-02087; and PTAB cases IPR2017-01428, IPR2017-02088.

The PTAB found claims unpatentable, as obvious. Uniloc appealed. The Federal Circuit affirmed.

**Legal issue: 35 USC 314(d), reviewability of PTAB decisions based upon 35 USC 315(e)(1), estoppel-triggering event arising after institution.**

The Federal Circuit held that 314(d) does not preclude review of PTAB 315(e)(1) estoppel decisions when the estoppel-triggering event occurred after institution.

With that background, we turn now to the question in this case of whether we may review the Board’s decision that LG is not estopped from maintaining its challenge against claims 1–6 and 8. Considering the strong presumption of reviewability of agency action, we see no indication that § 314(d) precludes judicial review of the Board’s application of § 315(e)(1)’s estoppel provision in this case, in which the alleged estoppel-triggering event occurred after institution. Such a holding is a natural consequence of our reasoning in *Credit Acceptance*. We concluded there that we could review the patent owner’s challenge to the Board’s decision that the petitioner was not estopped from maintaining a patentability challenge under a nearly identical statutory estoppel provision, albeit as applied to the CBM scheme. *See Credit Acceptance*, 859 F.3d at 1050–51. [*Uniloc 2017 LLC v. Facebook Inc.*, 2019-1688, 2019-1689 (Fed. Cir. 3/9/2021).]

As the Supreme Court elucidated in *Northcross v. Board of Education of Memphis City Schools*, when one statute “tracks the wording of” another, this is a “strong indication that the two statutes should be interpreted *pari passu*,” particularly if the two provisions share a common purpose. 412 U.S. 427, 428 (1973) (per curiam) (interpreting the language of the Emergency School Aid Act of 1972 to allow for the ordinary award of attorneys’ fees because the relevant provision of the Act “tracks the wording” of the similarly focused Civil Rights Act of 1964, which the Court had previously interpreted as providing for such

ordinary award). Thus, just as we concluded for the CBM estoppel provision of § 325(e)(1) in *Credit Acceptance*, we likewise interpret the similarly worded and focused IPR estoppel provision of § 315(e)(1) as not so closely tied to institution to render judicial review precluded when the estoppel-triggering event arises after institution. *See* 859 F.3d at 1049–52 (considering the Supreme Court’s caselaw on reviewability under § 314(d) and concluding that the appellant’s challenge under § 325(e)(1) “is neither a challenge to the Board’s institution decision, nor is it ‘closely tied’ to any ‘statute[] related to the Patent Office’s decision to initiate [CBM] review.’” (quoting *Cuozzo*, 136 S. Ct. at 2141) (modifications in original))). Section 315(e)(1)’s use of “maintain” contemplates that the estoppel provision “governs at any stage of a subsequent proceeding before the PTO—its application is not limited to the institution stage.” *Credit Acceptance*, 859 F.3d at 1050. [*Uniloc 2017 LLC v. Facebook Inc.*, 2019-1688, 2019-1689 (Fed. Cir. 3/9/2021).]

Critically, the particular circumstances in *Credit Acceptance*, i.e., one in which no cause for termination at the time of petition existed and the basis for termination developed while the proceeding was ongoing, is exactly that which happened here. When the Board instituted review in the ’1427 IPR, no estoppel could apply because no final written decision had been reached in the Apple IPR. Though the Board’s institution decision ordered supplemental briefing regarding the potential, future applicability of § 315(e)(1)’s estoppel provision, due to its awareness of the advanced state of the Apple IPR, the Apple IPR final written decision did not issue until months after institution in this proceeding. The Board’s “no estoppel” decision thus was later than and separate from its earlier institution decision, and, consistent with the facts and reasoning of *Credit Acceptance*, is a decision we may review. *See Credit Acceptance*, 859 F.3d at 1049–52; *see also Windy City*, 973 F.3d at 1332 (explaining that § 315(c) joinder challenges are reviewable by this court despite § 314(d) because “the joinder decision is made after a determination that a petition warrants institution, thereby affecting the manner in which an IPR will proceed”) (citation omitted)). [*Uniloc 2017 LLC v. Facebook Inc.*, 2019-1688, 2019-1689 (Fed. Cir. 3/9/2021).]

**Legal issue: 35 USC 315(e)(1), whether a copycat petitioner (copied IPR and motion under 315(c) to join) is per se a real party in interest or privy of the original petitioner.**

The Federal Circuit declined to conclude that a copycat petitioner was *per se* an RPI or privy of the copied petition’s petitioner.

35 USC 315(e)(1) reads:

The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), *or the real party in interest or privy of the petitioner*, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the

petitioner raised or reasonably could have raised during that inter partes review.

The Federal Circuit stated:

We decline, as the Board too did, to conclude that LG is estopped as result of Facebook’s participation in the Apple IPR, merely by way of its joinder as a party in this later proceeding. Uniloc suggests that the Board, in reaching this conclusion, failed to address its arguments regarding *Kofax, Inc. v. Uniloc USA, Inc.*, No. IPR2015-01207, 2016 WL 8944779 (P.T.A.B. July 20, 2016).<sup>13</sup> Appellant’s Br. at 21–23. Uniloc asserts that *Kofax* held that “co-petitioners” are automatically RPIs or privies of one another, but this misunderstands that decision. *Kofax*, which is non-binding on this court, determined that co-petitioners Ubisoft and Zebra in an IPR proceeding were RPIs of one another because Ubisoft had named Zebra as an RPI in its filings to the Board, due to a preexisting relationship between them. 2016 WL 8944779, at \*1–2. Thus, once Ubisoft was estopped from maintaining the IPR by its role as a petitioner in an earlier, different IPR, Zebra, as an undisputed RPI, was also estopped. *Id.* This situation is not the same as that here because Facebook did not list LG as an RPI in the ’1427 IPR making LG unlike Zebra. [Uniloc 2017 LLC v. Facebook Inc., 2019-1688, 2019-1689 (Fed. Cir. 3/9/2021).]

The Board’s determination that LG is not an RPI or privy of Facebook is supported by substantial evidence. Uniloc’s somewhat conclusory arguments never attempt to differentiate its position as to RPI and privy, instead simply asserting that LG must be one or the other. But just because LG expressed an interest in challenging the ’433 patent’s patentability, through its filing of its own IPR petition and joinder motion, does not by itself make LG an RPI to Facebook’s IPR. The record lacks any evidence that LG exercised any control over Facebook’s decision to file for inter partes review (either in the Apple IPR and in this IPR) or Facebook’s arguments made during the proceedings, and vice versa. Moreover, nothing in the record suggests that Facebook recruited LG to join as a party to the Facebook IPR, thereby making LG an agent advancing Facebook’s interests. That is, we see no evidence in the record to suggest that LG is acting “as a proxy [in the ’1427 IPR] for [Facebook] to relitigate the same issues” Facebook already presented in the Apple IPR. *WesternGeco*, 889 F.3d at 1319 (citing *Taylor*, 553 U.S. at 894–95). Instead, the record shows that LG, through its own counsel, filed its own IPR petitions in an effort to be recognized as an additional party to the proceeding here, seeking to assert its own interests. [Uniloc 2017 LLC v. Facebook Inc., 2019-1688, 2019-1689 (Fed. Cir. 3/9/2021).]

The record likewise does not present evidence that LG and Facebook, beyond their relationship as joined parties in this proceeding, have any sort of “preexisting, established relationship” that indicates coordination amongst the two

regarding the Apple IPR. *See Applications in Internet Time*, 897 F.3d at 1351. Without such evidence of control, in addition to no evidence of joint funding, or even any evidence of substantial coordination between the parties as to their respective decisions to bring these proceedings, a finding that LG is an RPI of or in privity with Facebook here would be improper. *See WesternGeco*, 889 F.3d at 1320–21 (explaining, in finding no privity, that the evidence demonstrated the parties were represented by different counsel, had no control over each other, had no collective funding, and lacked substantive involvement with each other). The mere fact that the Board procedurally required LG and Facebook to consolidate their arguments and evidence in combined filings in this proceeding does not, without more, make them privies of each other such that one petitioner automatically loses its rights to assert its challenge once the other petitioner loses its rights through estoppel. [*Uniloc 2017 LLC v. Facebook Inc.*, 2019-1688, 2019-1689 (Fed. Cir. 3/9/2021).]

Uniloc’s estoppel theory for LG relies in part on its assertion that LG “unequivocally represent[ed] that it would be bound by the Board’s decisions as to the original petitioners and that it would not advance any separate arguments from those advanced by [Facebook].” Appellant’s Br. at 24. But that argument misunderstands LG’s position, as LG’s joinder motion in the ’1427 IPR makes clear that LG had its own interests in challenging the ’433 patent and that it would continue to pursue the IPR even if Facebook, for any reason, was no longer a petitioner. *See* J.A. 3345; *see also* J.A. 3340 (“[LG’s] interests may not be adequately protected in the Facebook IPR proceedings, particularly[, for example,] if the Facebook Petitioner settles with the Patent Owner. [LG] should be allowed to join in a proceeding affecting a patent asserted against it.”). [*Uniloc 2017 LLC v. Facebook Inc.*, footnote 12, 2019-1688, 2019-1689 (Fed. Cir. 3/9/2021).]

**Legal issue: 35 USC 315(e)(1), whether partial estoppel violates the requirement to institute on all challenged claims or deny institution.**

The Federal Circuit held that partial estoppel as to some but not all challenged claims due to a FWD in an earlier case did not violate the statutory requirement to institute on all claims or deny institution.

Uniloc relies on *SAS Institute* as suggesting that the Board’s partial dismissal of Facebook results in an improper partial institution. Appellant’s Br. at 25. We disagree. *SAS Institute* rejected the Board’s decision there to grant only “partial institution” of a petition for inter partes review because such a practice was inconsistent with 35 U.S.C. § 318(a)’s mandate that “the Patent Trial and Appeal Board shall issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner.” *See* 138 S. Ct. at 1354 (internal quotation marks omitted) (quoting § 318(a)). Unlike *SAS Institute*, the Board here

reached a final written decision on all the petitioned claims, due to LG’s status as a petitioner. That fact alone is enough to dismiss Uniloc’s argument and render irrelevant Facebook’s partial dismissal from the ’1427 IPR. [Uniloc 2017 LLC v. Facebook Inc., 2019-1688, 2019-1689 (Fed. Cir. 3/9/2021).]

**Edgewell Personal Care Brands, LLC v. Munchkin, Inc., 2020-1203 (Fed. Cir. 3/9/2021).**

This is a decision on an appeal from the C.D. Ca. district court case 2:18-cv-03005-PSG-JPR. The district court entered SJ of no infringement. Edgewell appealed. The Federal Circuit vacated-in-part, reversed-in-part, and remanded.

**Legal issue: 35 USC 271, DOE infringement, evidence sufficient to support SJ of no DOE infringement.**

The Federal Circuit held that the district court erred by failing to evaluate the evidence to determine whether a reasonable juror could find that the accused products perform substantially the same function, in substantially the same way, achieving substantially the same result as the claims.

Although the district court correctly construed “annular cover” as being a single structure, the district court erred in concluding that Edgewell’s theory of infringement under the doctrine of equivalents vitiates or renders meaningless the “annular cover” claim element. Vitiating has its clearest application “where the accused device contain[s] the antithesis of the claimed structure.” *PlanetBingo, LLC v. GameTech Int’l, Inc.*, 472 F.3d 1338, 1345 (Fed. Cir. 2006). But as we explained in *Deere & Co.*, 703 F.3d at 1356–57, “[c]ourts should be cautious not to shortcut this inquiry by identifying a ‘binary’ choice in which an element is either present or ‘not present.’” *See also Cadence Pharms. Inc. v. Exela PharmaSci Inc.*, 780 F.3d 1364, 1372 (Fed. Cir. 2015) (“The determination of equivalence depends not on labels like ‘vitiating’ and ‘antithesis’ but on the proper assessment of the language of the claimed limitation and the substantiality of whatever relevant differences may exist in the accused structure.”). Applying these concepts to the facts of this case, we conclude that the district court erred in evaluating this element as a binary choice between a single-component structure and a multi-component structure, rather than evaluating the evidence to determine whether a reasonable juror could find that the accused products perform substantially the same function, in substantially the same way, achieving substantially the same result as the claims. *See, e.g., Bio-Rad Labs., Inc. v. 10X Genomics, Inc.*, 967 F.3d 1353, 1368 (Fed. Cir. 2020) (limiting question of infringement under doctrine of equivalents to a “binary choice between ‘flourinated’ and ‘non-flourinated’ micro-channels” was improper where a reasonable juror could have found negligibly-flourinated microchannel performed substantially the same function). [Edgewell Personal Care Brands, LLC v. Munchkin, Inc., 2020-1203 (Fed. Cir. 3/9/2021).]

The element at issue is the claimed “annular cover.” Edgewell’s expert, Mr. Jobin, opined that the accused products’ annular covers perform the same function, in the same way, to achieve the same result as the claimed annular cover. \*\*\* Likewise, Mr. Jobin opined that the annular cover of Munchkin’s Third Generation cassettes performs the same function as the claimed annular cover because the accused cover “extends over the annular housing and retains the pleated tubing stored within, but still allows for access to the pleated tubing.” \*\*\* This detailed application of the function-way-result test, supported by deposition testimony from Munchkin employees, is sufficient to create a genuine issue of material fact for the jury to resolve and, therefore, is sufficient to preclude summary judgment of noninfringement under the doctrine of equivalents. [Edgewell Personal Care Brands, LLC v. Munchkin, Inc., 2020-1203 (Fed. Cir. 3/9/2021).]

**Rain Computing, Inc. v. Samsung Electronics America, Inc., 2020-1646, 2020-1656 (Fed. Cir. 3/2/2021).**

This is a decision on appeals from the D. Mass. district court case 1:18-cv-12639-RGS. The district court entered a final judgement of noninfringement and that the claims were not indefinite. Both parties appealed. The Federal Circuit reversed the judgement that the claims were not indefinite, and dismissed the appeal of noninfringement as moot.

This decision is all about the procedure and substance of construing MPF recitations.

**Legal issue: 35 USC 112, MPF, whether a method claims can invoke MPF claim construction.**

The Federal Circuit held that a claim term nested in a method claim may be construed as a MPF recitation.

...Applicants are free to invoke § 112 ¶ 6 for a claim term nested in a method claim. We have never held otherwise. *See, e.g., Media Rights*, 800 F.3d at 1374 (holding “compliance mechanism” nested in a method claim was a means-plus function term); *On Demand Machine Corp. v. Ingram Indus., Inc.*, 442 F.3d 1331, 1340 (Fed. Cir. 2006) (holding “providing means for a customer to visually review” nested in a method claim was a means-plus-function term).

[Rain Computing, Inc. v. Samsung Electronics America, Inc., 2020-1646, 2020-1656 (Fed. Cir. 3/2/2021).]

**Legal issue: 35 USC 112, MPF, whether a computer readable medium or storage device can correspond to the structure providing the function of a MPF recitation defining an algorithm performed by a general purpose computer.**

The Federal Circuit held, somewhat generally, that a computer readable medium or storage device cannot correspond to sufficient structure providing disclosure the means of a MPF recitation defining an algorithm performed by an otherwise general purpose computer.

For means-plus-function claims “in which the disclosed structure is a

computer, or microprocessor, programmed to carry out an algorithm,” we have held that “the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm.” *WMS Gaming, Inc. v. Int’l Game Tech.*, 184 F.3d 1339, 1349 (Fed. Cir. 1999). \*\*\* The district court erred, however, in concluding that the disclosure of computer-readable media or storage devices provided sufficient structure for the “control access” function. *Id.* These computer-readable media or storage devices amount to nothing more than a general-purpose computer. *See, e.g., HTC Corp. v. ICom GmbH & Co., KG*, 667 F.3d 1270, 1280 (Fed. Cir. 2012) (the disclosed “processor and transceiver amount[ed] to nothing more than a general-purpose computer”). \*\*\* Rather, some special programming, i.e., an algorithm, would be required to control access to the software application packages. [**Rain Computing, Inc. v. Samsung Electronics America, Inc., 2020-1646, 2020-1656 (Fed. Cir. 3/2/2021).**]

**Legal issue: 35 USC 112, MPF, whether the existence of open source software known to implement an algorithm that can perform the function of a MPF recitation moots the requirement for disclosure in the specification of the algorithm.**

The Federal Circuit implicitly held that the existence of open source software known to implement an algorithm that can perform the function of a MPF recitation does not moot the requirement for disclosure of the algorithm in the specification of the patent.

...And the inventor agreed that “there are certain algorithms out there” such as “open source software that can implement” the user identification module. J.A. 297–99. Under these circumstances, where a general purposes computer is the corresponding structure and it is not capable of performing the controlling access function absent specialized software, an algorithm is required. [**Rain Computing, Inc. v. Samsung Electronics America, Inc., 2020-1646, 2020-1656 (Fed. Cir. 3/2/2021).**]

**Lakshmi Arunachalam v. International Business Machines Corporation, 2020-1493 (Fed. Cir. 3/1/2021).**

This is a decision on an appeal from the D. Del. district court case 1:16-cv-00281-RGA. The district court granted-in-part IBM’s fees motions and denied Arunachalam’s miscellaneous motions.

Arunachalam appealed, *pro se, inter alia* from the fees awards. The Federal Circuit affirmed.

The Federal Circuit began its description of the background thus: “The relevant facts are numerous and colorful.” And so it is, with the facts showing the *pro se* appellant failed to understand the law and made a horrible mess of her litigation and appeal.

**Legal issue: Forfeiture on appeal of insufficiently developed arguments of unconstitutionality.**

The Federal Circuit held that Anunachalam had forfeited the argument that the attorney

fee awards were unconstitutional.

Dr. Arunachalam's counterargument is unpersuasive. Dr. Arunachalam contends, without offering more, that we cannot "affirm the District Court's sanctions and attorneys' fees without offending the Constitution," Appellant's Br. 55, specifically, her rights under the First, Fifth, Eighth, and Fourteenth Amendments, *id.* at. 2–3. Dr. Arunachalam's assertions are insufficiently developed. "In order for this court to reach the merits of an issue on appeal, it must be adequately developed." *Monsanto Co. v. Scruggs*, 459 F.3d 1328, 1341 (Fed. Cir. 2006); *see id.* (holding that undeveloped arguments are "deemed waived"); *United States v. Dunkel*, 927 F.2d 955, 956 (7th Cir. 1991) ("A skeletal 'argument', really nothing more than an assertion, does not preserve a claim."). This argument is, accordingly, waived. [Lakshmi Arunachalam v. International Business Machines Corporation, 2020-1493 (Fed. Cir. 3/1/2021).]

**Legal issue: Misconduct during a *pro se* appeal, presenting baseless, outlandish, and irrelevant invective in briefing.**

The Federal Circuit concluded that, Arunachalam's baseless, outlandish, and irrelevant invective was misconduct (and warranting sanctions).

The Federal Circuit concluded that an appropriate sanction was striking the baseless, outlandish, and irrelevant invective passages of Arunachalam briefing, in view of the monetary sanctions already imposed below and the Arunachalam's *pro se* status.

Dr. Arunachalam's briefing before us is replete with scandalous and baseless allegations similar to those she made below, all presented without a semblance of factual support. \*\*\* Further, Dr. Arunachalam makes multiple demonstrably false statements of fact in her briefing. \*\*\* Dr. Arunachalam's bizarre and scandalous statements extend to this court, the Judiciary, and indeed the Government as a whole. \*\*\* Further, Dr. Arunachalam's scandalous and unsupported statements are largely irrelevant to the issues on appeal and take up the vast majority of her briefing, hindering our ability to review her pertinent arguments, if any. \*\*\* Accordingly, the scandalous and irrelevant statements in Dr. Arunachalam's briefs alleging, *inter alia*, "obstruction of justice," "a corrupt criminal enterprise," "libel," "willful misrepresentations," and "fraud" by the District Court, Judges Stark and Andrews, and Appellees' counsel, Appellant's Br. 2–17, as well as "treason," collusion in a "collateral estoppel farce," and "fraud" by the PTAB, this Court and its Judges, and "the Courts" generally, *id.* at 13–17, are stricken. [Lakshmi Arunachalam v. International Business Machines Corporation, 2020-1493 (Fed. Cir. 3/1/2021).]

During the course of its sanctions analysis, the Federal Circuit restated relevant law.

The scandalous and irrelevant statements in Dr. Arunachalam's briefing

raise the judicial management concerns the Supreme Court identified in *Chambers*. See 501 U.S. at 43 (describing the courts’ need “to achieve the orderly and expeditious disposition of cases” (internal quotation marks and citation omitted)); *Finch v. Hughes Aircraft Co.*, 926 F.2d 1574, 1578 (Fed. Cir. 1991) (“[A]ppellate courts must consider the importance of conserving scarce judicial resources.”) . To this end, courts are “vested, by their very creation,” with “certain implied powers.” *Chambers*, 501 U.S. at 43 (internal alterations, quotation marks, and citation omitted); see *Micron Tech., Inc. v. Rambus Inc.*, 645 F.3d 1311, 1326 (Fed. Cir. 2011) (stating that “courts have the inherent power to control litigation by imposing sanctions appropriate to rectify improper conduct by litigants” (internal quotation marks and citation omitted)). These powers are wide-ranging. See *Chambers*, 501 U.S. at 43 (“[A] federal court has the power to control admission to its bar and to discipline attorneys who appear before it.”); *id.* at 44 (holding that courts may punish for contempt those who are “disobedien[t] to the orders of the Judiciary”); *id.* 44–46 (holding that courts “may bar from the courtroom a criminal defendant who disrupts a trial[,]” may “assess attorney[s]’ fees when a party has acted in bad faith, vexatiously, wantonly, or for oppressive reasons,” and “may act *sua sponte* to dismiss a suit for failure to prosecute” (internal quotation marks and citation omitted)). [Lakshmi Arunachalam v. International Business Machines Corporation, 2020-1493 (Fed. Cir. 3/1/2021).]

Particularly relevant here, while these “inherent powers must be exercised with restraint and discretion,” “[a] primary aspect of that discretion is the ability to fashion an appropriate sanction for conduct which abuses the judicial process.” *Id.* at 44–45; cf. FED.R.APP.P. 38 (providing that this court may impose sanctions if we “determine[] that an appeal is frivolous”); *Nat’l Org. of Veterans Advocates, Inc. v. Sec’y of Veterans Affs.*, 710 F.3d 1328, 1335 (Fed. Cir. 2013) (“[W]hile sanctions must be fashioned with restraint and discretion, courts of justice can fashion appropriate monetary and nonmonetary sanctions to rectify misbehavior.”). [Lakshmi Arunachalam v. International Business Machines Corporation, 2020-1493 (Fed. Cir. 3/1/2021).]

Even according Dr. Arunachalam wider latitude in view of her *pro se* status, her baseless, outlandish, and irrelevant invective degrades the dignity and decorum of the court and hampers “the orderly and expeditious disposition of cases.” *Chambers*, 501 U.S. at 43 (internal quotation marks and citation omitted). Sanctions are appropriate to address and discourage such abusive conduct. See *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1554 (Fed. Cir. 1983) (imposing sanctions and explaining that “we are duty-bound to guard our segment of the judicial process against abuse”). We have considered the range of sanctions discussed above. See *Chambers*, 501 U.S. at 43–46. In view of the fact that monetary sanctions have already been assessed in the underlying case, as well as the form of Dr. Arunachalam’s misconduct, we conclude that a lesser sanction is

appropriate. [Lakshmi Arunachalam v. International Business Machines Corporation, 2020-1493 (Fed. Cir. 3/1/2021).]

Finally, the Federal Circuit placed Anunachalam on notice that further misbehavior before the Federal Circuit could result in further monetary sanctions.

**Bayer Healthcare LLC v. Baxalta Inc., 2019-2418, 2020-1017 (Fed. Cir. 3/1/2021).**

This is a decision on appeals from the D. Del district court case 1:16-cv-01122-RGA. The jury found that the asserted claims were enabled and Baxalta infringed, and that Bayer was entitled to reasonable-royalty damages. Baxalta appealed.

The district court held, as a matter of law, that Baxalta's conduct did not meet the requirements for willfulness and denied Bayer's motion for a new trial on willfulness. Bayer appealed.

The Federal Circuit affirmed.

**Legal issue: 35 USC 284, damages, expert testimony, testimony supporting a range of royalty rates.**

The Federal Circuit found no precedent precluding testimony of a damages expert witness presenting a range of possible hypothetical negotiation royalty rates.

... While an expert must use reliable methodology for determining the range of possible hypothetical negotiation royalty rates, we are aware of no precedent that requires an expert to provide a single proposed royalty rate. As an initial matter, a jury is "entitled to choose a damages award within the amounts advocated by the op-posing parties" and is "not bound to accept a rate proffered by one party's expert but rather may choose an intermediate royalty rate." *Powell v. Home Depot U.S.A., Inc.*, 663 F.3d 1221, 1241 (Fed. Cir. 2011) (quoting *Spectralytics, Inc. v. Cordis Corp.*, 649 F.3d 1336, 1347 (Fed. Cir. 2011)). In addition, we have previously held that a jury's damages award that fell within the range suggested by the patentee's damages expert was supported by substantial evidence. See *Rembrandt Wireless Techs., LP v. Samsung Elecs. Co.*, 853 F.3d 1370, 1382 (Fed. Cir. 2017). [Bayer Healthcare LLC v. Baxalta Inc., 2019-2418, 2020-1017 (Fed. Cir. 3/1/2021).]

**Legal issue: FRE 702, admissibility of damages witness expert testimony on a range of reasonable royalties.**

The Federal Circuit held that the district court did not err in admitting damages expert witness testimony on a range of reasonable royalties.

...In granting-in-part Baxalta's Daubert motion, the district court determined that Dr. Addanki's expert report included "substantial analyses to determine 'end points of the bargaining range for the hypothetical negotiation,'" including "deriv[ing] a maximum royalty rate from the incremental profits Baxalta would expect to earn from Adynovate, and a minimum royalty rate from

the profits Bayer would expect to lose by granting a license to Baxalta.” *Daubert* Order, 2019 WL 330149, at \*7. Dr. Addanki’s testimony further demonstrates that he considered and discussed the appropriate *Georgia-Pacific* factors at length in determining the range of reasonable royalties, *see* J.A. 962–1020, and Bayer in its closing statement explained to the jury that its damages award should fall within that range, J.A. 1728 (Tr. 1507:16–25). Moreover, the district court permitted Baxalta to cross-examine Dr. Addanki on his end points and range and to present the testimony of its own damages expert. Under these circumstances, we conclude that the district court did not err in allowing the jury to hear Dr. Addanki’s testimony regarding a range of possible hypothetical reasonable royalty rates instead of a single proposed royalty rate. [Bayer Healthcare LLC v. Baxalta Inc., 2019-2418, 2020-1017 (Fed. Cir. 3/1/2021).]

**Legal issue: 35 USC 284, damages, jury verdict selecting from a within the range encompassed by the record.**

The Federal Circuit held that substantial evidence supported a jury verdict finding damages within the range encompassed by the record.

Third, Baxalta appears to challenge the jury’s determination of the amount of damages, which is an issue of fact that we review for substantial evidence. *Amgen*, 944 F.3d at 1341 (citing *Lucent Techs., Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1310 (Fed. Cir. 2009)). “A jury’s damages award ‘must be upheld unless the amount is grossly excessive or monstrous, clearly not supported by the evidence, or based only on speculation or guesswork.’” *Id.* (quoting *Lucent*, 580 F.3d at 1310). We agree with the district court that substantial evidence supports the jury’s 17.78% royalty rate, which was “within the range encompassed by the record as a whole.” JMOL Op., 407 F. Supp. 3d at 480 (quoting *Unisplay, S.A. v. Am. Elec. Sign Co.*, 69 F.3d 512, 519 (Fed. Cir. 1995)). Dr. Addanki provided ample guidance to the jury to help it determine the royalty rate. E.g., J.A. 962–67 (explaining the *Georgia-Pacific* factors, the concept of the hypothetical negotiation, and determining maximum and minimum points in a range), J.A. 967–68, 970–1005, 1008–13 (explaining how he applied the hypothetical negotiation analysis and determined the specific end points of 5.1% and 42.4% in this case), J.A. 1014–20 (discussing each of the *Georgia-Pacific* factors and explaining whether and how each one applied in his analysis). [Bayer Healthcare LLC v. Baxalta Inc., 2019-2418, 2020-1017 (Fed. Cir. 3/1/2021).]

**Legal issue: 35 USC 284, damages, expert testimony.**

The Federal Circuit restated that expert testimony is not required to support a damages award.

...A party need not present expert testimony on damages or, as a corollary, on every aspect of damages, such as a single royalty rate. *See Dow Chem. Co. v.*

*Mee Indus., Inc.*, 341 F.3d 1370, 1382 (Fed. Cir. 2003) (“[S]ection 284 is clear that expert testimony is not necessary to the award of damages, but rather ‘may [be] receive[d] . . . as an aid.’” (annotations in original) (quoting 35 U.S.C. § 284)). [Bayer Healthcare LLC v. Baxalta Inc., 2019-2418, 2020-1017 (Fed. Cir. 3/1/2021).]

**Legal issue: Seventh amendment of the Constitution, right to a jury trial, judicial application of pre-verdict supplemental damages**

The Federal Circuit held that applying the jury’s royalty rate to the undisputed actual infringing pre-verdict sales did not violate the defendant’s seventh amendment rights.

We turn to the final issue raised in Baxalta’s appeal—whether the district court violated Baxalta’s Seventh Amendment right to a jury trial by amending its judgment under Rule 59 to award Bayer pre-verdict supplemental damages. We disagree with Baxalta that the Seventh Amendment right to a jury trial attaches to the award of pre-verdict supplemental damages in this case. We also conclude that the district court acted within its discretion in awarding supplemental damages. \*\*\* Baxalta cites *Dimick v. Schiedt*, 293 U.S. 474 (1935), for the proposition that “a court has no power to consider new facts to award additional damages that are not part of the verdict, as it would invade the constitutional right to a trial by jury.” \*\*\* Calculating pre-verdict supplemental damages in this case merely required applying the jury’s royalty rate to the undisputed actual infringing sales base. \*\*\* Under these circumstances, we are not persuaded that the district court’s award constitutes an impermissible additur or an otherwise “bald addition of something which in no sense can be said to be included in the verdict.” *Id.* at 486. [Bayer Healthcare LLC v. Baxalta Inc., 2019-2418, 2020-1017 (Fed. Cir. 3/1/2021).]

**Legal issue: 35 USC 284, willful infringement, requisite evidence of intent**

The Federal Circuit held that knowledge of the asserted patent and evidence of infringement were necessary, but insufficient, for a finding of willfulness.

Even when accepting Bayer’s evidence as true and weighing all inferences in Bayer’s favor, we conclude that the record is insufficient to establish that Baxalta’s “conduct rose to the level of wanton, malicious, and bad-faith behavior required for willful infringement.” *SRI Int’l, Inc. v. Cisco Sys., Inc.*, 930 F.3d 1295, 1309 (Fed. Cir. 2019). The evidence adduced at trial merely demonstrates Baxalta’s knowledge of the ’520 patent and Baxalta’s direct infringement of the asserted claims. Knowledge of the asserted patent and evidence of infringement is necessary, but not sufficient, for a finding of willfulness. Rather, willfulness requires deliberate or intentional infringement. *Eko Brands, LLC v. Adrian Rivera Maynez Enters., Inc.*, 946 F.3d 1367, 1378 (Fed. Cir. 2020). [Bayer Healthcare LLC v. Baxalta Inc., 2019-2418, 2020-1017 (Fed. Cir. 3/1/2021).]

