

PRESENTED AT

27th Annual Advanced Patent Law Institute

October 20-21, 2022

Austin, TX

**Recent Developments in Patent Law
(Fall 2022)**

Mark Lemley

Erich Remiker

RECENT DEVELOPMENTS IN PATENT LAW (Fall 2022)

UPDATED THROUGH 10/14/2022

Mark Lemley¹ & Erich Remiker²

PATENTABLE SUBJECT MATTER	5
Software and Business Method Cases	5
Unpatentable	5
<i>In re Killian</i> , 45 F.4th 1373 (Fed. Cir. Aug. 23, 2022)	5
Patentable	6
<i>CosmoKey Solutions GmbH & Co. K v. Duo Security LLC</i> , 2021 WL 4515270 (Fed. Cir. Oct 4, 2021)	6
<i>Coop. Ent., Inc. v. Kollektive Tech., Inc.</i> , 2022 WL 4488902 (Fed. Cir. Sept. 28, 2022)	7
DISCLOSURE	9
Definiteness	9
<i>Nature Simulation Systems, Inc. v. Autodesk, Inc.</i> , 23 F.4th 1334 (Fed. Cir. Jan. 27, 2022)	9
<i>Niazi Licensing Corp. v. St. Jude Medical S.C., Inc.</i> , 30 F. 4th 1339 (Fed. Cir. Apr. 11, 2022)	10
Means-Plus-Function Claiming - Definiteness	11
<i>Dyfan, LLC v. Target Corp.</i> , 28 F.4th 1360 (Fed. Cir. Mar. 24, 2022)	11
<i>VDPP LLC v. Vizio, Inc.</i> , 2022 WL 885771 (Fed. Cir. Mar. 25, 2022)	12
Written Description	13
<i>Indivior UK Ltd. v. Dr. Reddy's Laboratories S.A.</i> , 18 F.4th 1323 (Fed. Cir. Nov. 24, 2021)	13
<i>Biogen International GMBH v. Mylan Pharmaceuticals Inc.</i> , 18 F.4th 1333 (Fed. Cir. Nov. 30, 2021)	14
INVENTORSHIP	16
<i>Thaler v. Vidal</i> , 43 F.4th 1207 (Fed. Cir. 2022)	16

¹ William H. Neukom Professor, Stanford Law School; Partner, Durie Tangri LLP.

² J.D. expected 2023, Stanford Law School.

NOVELTY	18
<i>LG Elecs. Inc. v. ImmerVision, Inc.</i> , 39 F.4th 1364 (Fed. Cir. July 11, 2022).....	18
<i>Sunoco Partners Mktg. & Terminals L.P. v. U.S. Venture, Inc.</i> , 32 F.4th 1161 (Fed. Cir. April 29, 2022)	20
OBVIOUSNESS	21
<i>Adapt Pharma Operations Ltd. v. Teva Pharmaceuticals USA, Inc.</i> , --- F.4th ---, 2022 WL 402133 (Fed. Cir. Feb. 10, 2022)	21
<i>Teva v. Corcept</i> , 18 F.4th 1377 (Fed. Cir. Dec. 7, 2021).....	22
<i>Auris Health, Inc. v. Intuitive Surgical Operations, Inc.</i> , 32 F.4th 1154 (Fed. Cir. Apr. 29, 2022)	23
<i>Best Med. Int'l, Inc. v. Elekta Inc.</i> , 46 F.4th 1346 (Fed. Cir. Aug. 29, 2022)	24
CLAIM CONSTRUCTION	25
<i>Astrazenca AB v. Mylan Pharmaceuticals Inc.</i> , 19 F.4th 1325 (Fed. Cir. Dec. 8, 2021)	25
<i>Pavo Sols. LLC v. Kingston Tech. Co., Inc.</i> , 35 F.4th 1367 (Fed. Cir. June 3, 2022)	26
<i>Kaufman v. Microsoft Corp.</i> , 34 F.4th 1360 (Fed. Cir. May 20, 2022)	27
INFRINGEMENT	28
Inducement	28
<i>GlaxoSmithKline LLC v. Teva Pharmaceuticals UA, Inc.</i> , 7 F.4th 1320 (Fed. Cir. Aug 5, 2021)	28
<i>Roche Diagnostics Corp. v. Meso Scale Diagnostics, LLC</i> , 30 F.4th 1109 (Fed. Cir. Apr. 8, 2022)	29
<i>Niazi Licensing Corp. v. St. Jude Medical S.C., Inc.</i> , 30 F. 4th 1339 (Fed. Cir. Apr. 11, 2022)	30
DEFENSES	32
Assignor Estoppel	32
<i>Hologic, Inc. v. Minerva Surgical, Inc.</i> , 44 F.4th 1358 (Fed. Cir. Aug. 11, 2022)..	32
REMEDIES	34
Damages	34

<i>California Institute of Technology v. Broadcom Ltd.</i> , 25 F.4th 976 (Fed. Cir. Feb. 4, 2022)	34
<i>Apple Inc. v. Wi-LAN Inc.</i> , 25 F.4th 960 (Fed Cir. Feb. 4, 2022)	35
<i>Roche Diagnostics Corp. v. Meso Scale Diagnostics, LLC</i> , 30 F.4th 1109 (Fed. Cir. Apr. 8, 2022)	35
<i>Pavo Sols. LLC v. Kingston Tech. Co., Inc.</i> , 35 F.4th 1367 (Fed. Cir. June 3, 2022)	36
Attorneys' Fees	37
<i>Realtime Adaptive Streaming LLC v. Netflix, Inc.</i> , 41 F.4th 1372 (Fed. Cir. July 27, 2022)	37
PRACTICE AND PROCEDURE	38
Standing	38
<i>Apple Inc. v. Qualcomm Incorporated</i> , 2021 WL 5227094 (Fed. Cir. Nov. 10, 2021)	38
Personal Jurisdiction	39
<i>Apple Inc. v. Zipit Wireless, Inc.</i> , 30 F. 4th 1368 (Fed. Cir. Apr. 18, 2022).....	39
Venue and Transfer	40
<i>In re: Volkswagen Group of America</i> , 28 F.4th 1023 (Fed. Cir. Mar. 9, 2022)	40
PTO AND PTAB PROCEDURE	42
Patent Extensions and Continuations	42
<i>Hyatt v. United States Pat. & Trademark Off.</i> , 48 F.4th 1347 (Fed. Cir. Sept. 8, 2022)	42
<i>SawStop Holding LLC v. Vidal</i> , 48 F.4th 1355 (Fed. Cir. Sept. 14, 2022).....	43
Reissue	45
<i>In re McDonald</i> , 43 F.4th 1340 (Fed. Cir. Aug. 10, 2022)	45
Inter Partes Review Procedure	46
<i>California Institute of Technology v. Broadcom Ltd.</i> , 25 F.4th 976 (Fed. Cir. Feb. 4, 2022)	46
<i>Qualcomm Inc. v. Apple Inc.</i> , 24 F.4th 1367 (Fed. Cir. Feb. 1, 2022).....	46
<i>Hunting Titan, Inc. v. DynaEnergetics Europe GmbH</i> , 28 F.4th 1371 (Fed. Cir. Mar. 24, 2022).....	47
PTAB and Choice of Forum	48
<i>Nippon Shinyaku Co., Ltd. v. Sarepta Therapeutics, Inc.</i> , 25 F.4th 998 (Fed. Cir. Feb. 8, 2022).....	48

Constitutionality and Jurisdiction..... 50
Arthrex, Inc. v. Smith & Nephew, Inc., 35 F.4th 1328 (Fed. Cir. May 27, 2022) .. 50
Polaris Innovations Ltd. v. Brent, 48 F.4th 1365 (Fed. Cir. Sept. 15, 2022)..... 51

PATENTABLE SUBJECT MATTER

Software and Business Method Cases

Unpatentable

In re Killian, 45 F.4th 1373 (Fed. Cir. Aug. 23, 2022)

In this appeal from the PTAB, the Federal Circuit affirmed the rejection of a method to determine eligibility for social security disability insurance on 101 grounds.³ The patent application claimed a computerized method of providing access to Federal and state databases through a network, creating an electronic data record of someone in the state database who was receiving treatment for developmental disabilities, matching it with the federal database on social security number, gathering information from a caseworker, and seeing if the person was receiving SSDI benefits.⁴ The examiner rejected on 101, the inventor appealed to the PTAB, the PTAB affirmed.⁵

The Federal Circuit affirmed the denial, noting that this case “does not present such a close case.”⁶ At step one of *Alice* the Court held that since the identification of an individual and determination of if they were receiving proper benefits could be performed in the human mind, the application was directed at an abstract idea.⁷ All the steps were performed on a generic computer, which did not save the invention at *Alice* step two.⁸

The appellant made several arguments directed at 101 overall. First, he argued that the *Alice/Mayo* standard is inherently indefinite, rendering all decisions under the standard arbitrary and capricious.⁹ The Federal Circuit rejected this, noting that the APA does not apply to courts.¹⁰ The Court also rejected the request for a single definition or limiting principle for abstract idea and inventive concept, noting that there is no single inflexible rule, and that the Court had provided considerable guidance.¹¹

The appellant next argued that comparing this case to other cases in which the Court considered patent eligibility under 101 violates his due process rights.

³ *In re Killian*, 45 F.4th 1373 (Fed. Cir. 2022).

⁴ *Id.* at 1377-78.

⁵ *Id.*

⁶ *Id.* at 1381.

⁷ *Id.* at 1379.

⁸ *Id.* at 1380.

⁹ *Id.* at 1380.

¹⁰ *Id.* at 1381. This is a curious response since the appeal was from a PTO decision.

¹¹ *Id.* at 1381-83.

This was rejected, as to repudiate it would be to repudiate the common law system itself.¹²

Killian next argued that *Alice* step two's inventive concept doctrine was improper because Congress did away with the "invention" requirement in the Patent Act of 1952.¹³ The Court rejected this, on the grounds that the Supreme Court has told the Federal Circuit they are required to look for an inventive concept in *Alice*.¹⁴ The same rebuttal answered the appellant's argument that the mental steps doctrine was abolished in modern patent law, with a cite to *Mayo*.¹⁵ Lastly, Killian argued that the PTO failed to provide any evidence that the computer usage was routine and conventional.¹⁶ The Federal Circuit pointed to the claim in the specification that the method could be done on any computer system.¹⁷ Thus, the Court affirmed the 101 denial.¹⁸

Patentable

***CosmoKey Solutions GmbH & Co. K v. Duo Security LLC*, 2021 WL 4515270 (Fed. Cir. Oct 4, 2021)**

In this appeal from the District of Delaware, the Federal Circuit reversed a district court finding that the asserted claims were invalid for failing to provide an inventive concept.¹⁹ CosmoKey owns the '903 patent, a method patent for authenticating the identity of a user performing a transaction at a terminal.²⁰ The idea behind the invention is to have the authentication function be normally inactive, and only activated by the user for the transaction, and when the channel communicates that the authentication is active, to deactivate the authentication function, thereby using time of authentication as a second security method.²¹ CosmoKey sued Duo for infringement, and Duo moved for judgment on the pleadings arguing that the claims were directed to the abstract idea of authentication.²² The lower court agreed that the claims were directed to the abstract idea of authentication, and analogizing to *Prism*, a case where claims

¹² *Id.* at 1383.

¹³ *Id.*

¹⁴ *Id.*

¹⁵ *Id.* at 1384.

¹⁶ *Id.* at 1384-86.

¹⁷ *Id.* at 1385.

¹⁸ *Id.* at 1386.

¹⁹ *CosmoKey Solutions GmbH & Co. K v. Duo Security LLC*, 2021 WL 4515270 (Fed. Cir. Oct 4, 2021). Full disclosure: Lemley represented Duo Security in this appeal.

²⁰ *Id.* at *1.

²¹ *Id.*

²² *Id.* at *2.

Find the full text of this and thousands of other resources from leading experts in dozens of legal practice areas in the [UT Law CLE eLibrary \(utcle.org/elibrary\)](https://utcle.org/elibrary)

Title search: Recent Developments in Patent Law (Fall 2022)

First appeared as part of the conference materials for the
27th Annual Advanced Patent Law Institute session
"Year in Review"