



*Intellectual Property Patent and
Copyright Law Evolution:
Opinions from the United States
Federal Appellate Courts and U.S.
Supreme Court 2024 - 2025*



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About the Presenter

ADRIENNE B. NAUMANN

Adrienne B. Naumann established her own practice in 1996 which is exclusively intellectual property law. Ms. Naumann's practice includes individual entrepreneurs and start-up companies, as well as small and medium sized businesses. Her issued patents include a broad range of technologies including: a razor handle, board game, agricultural method, pneumatically driven trench shoring device, floral containers, electromechanical lock, laminar flow nozzle, portable exercise devices, mechanical bag holder and shelving. She has also filed successful patent application appeals in the Patent & Trademark Office on behalf of clients.

Ms. Naumann has obtained trademarks, copyrights, and design patents on behalf of artists, writers, and companies. In addition to obtaining intellectual property protection through government agencies, Ms. Naumann advises and drafts documents on matters of ownership, shop rights, work for hire, transfers of rights, licenses, permissions, rescission, consents, non-disclosure agreements, releases, trade secrets, proprietary information, and web sites.

Ms. Naumann judges the Illinois Institute of Technology Interprofessional Projects Program in Chicago. Ms. Naumann also serves on the Board of the University of Chicago, Chicago Women's Alliance and on the e-Discovery committee for the Seventh Circuit Court of Appeals

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Course Description

Intellectual Property Patent Law Evolution: Opinions from the United States Federal Appellate Courts and U.S. Supreme Court 2024/25

Course Presentation

PATENTS

This presentation will include important updates in patents, trademarks, copyrights, trade secrets, social media and related topics from July 2024 through June 2025. In particular this presentation will include, although not exclusively, United States federal appellate court decisions, United States Supreme Court decisions, and other important legal developments as, although not exclusively, new federal statutes and statute amendments. Topics will include litigation related changes as well as transactional changes.

This presentation discusses appeals involving Patent cases initially reviewed through Inter Partes Review (IPR). It explains the complexities and the difficulties of appealing an IPR result.

Critical patent cases are discussed, including those involving computer-implemented inventions, double patenting, claim construction, and IPR decisions. The presentation also touched on issues like insufficient written descriptions, obviousness, and the doctrine of equivalence.

The course explores legal areas including the False Claims Act and updates to design patent obviousness standards. The course emphasizes the importance of detailed documentation, understanding patent statutes, and staying updated on changes in patent law.

This course will also discuss updates on how to draft United States patent applications, replies to patent examiners, appeal briefs in both federal litigation and to the patent office administrative board.

COPYRIGHTS

This presentation will discuss copyright cases for 2024-2025. These cases involve challenges to the Digital Media Copyright Act, including the Safe Harbor Provision and transformative use of copyrighted material in digital format. They will also discuss copyright infringement, fixed Tangible Media and Human Being Authored submissions versus submissions authored by Artificial Intelligence (AI) and copyright infringement as it relates to photos put on Instagram.

COURSE MATERIALS

This material is intended to be a guide in general and is not legal advice. If you have any specific question regarding the state of the law in any particular jurisdiction, we recommend that you seek legal guidance relating to your particular fact situation.

The course materials will provide the attendee with the knowledge and tools necessary to identify the current legal trends with respect to these issues. The course materials are designed to provide the attendee with current law, impending issues and future trends that can be applied in practical situations.

Course Learning Objectives and Outcomes

PATENTS

This course is designed to provide the following learning objectives:

The Learner will become knowledgeable of important updates in patents, and related topics from July 2024 through June 2025

The participant will learn about the latest United States federal appellate court decisions, United States Supreme Court decisions, and other important legal developments regarding Intellectual property law and patents.

The Learner will become familiar with new federal statutes and statute amendments in Intellectual Property patent Law.

Learners will gain knowledge about litigation related changes as well as transactional changes in Intellectual Property patent Law.

The Attorney will become knowledgeable about the function of the Patent Trial Appeals Board (PTAB)

The Attorney will become familiar with Inter Parte Review (IPR)

The Learner will learn about how the concept of “person of ordinary skill in this art” plays a part in the decisions of the Patent Trial Appeals Board

The Learner will understand the concept of Obvious Double Patency (ODP)

After this course, the Participant will understand the duties, roles, and responsibilities of counsel in situations involving Intellectual Property.

Counsel will gain more knowledge about what kinds of situations to look for when drafting United States patent applications, and updates for replying to patent examiners.

The Attorney will learn updates on writing appeal briefs in both federal litigation and to the patent office administrative board.

COPYRIGHTS

The Learner will become knowledgeable of important updates in trademarks, copyrights, trade secrets and related topics from July 2024 through June 2025.

The participant will learn about the latest United States federal appellate court decisions, United States Supreme Court decisions, and other important legal developments regarding Intellectual property law.

The Learner will become familiar with new federal statutes and statute amendments in Intellectual Property Law.

Learners will gain knowledge about litigation related changes as well as transactional changes in Intellectual Property Law.

After this course, the Participant will understand the duties, roles, and responsibilities of counsel in situations involving Intellectual Property.

The attorney will learn about the transformative use of copyrighted material in digital format

The attorney will learn about copyright infringement through the several cases that are discussed in the presentation

The Learner will be informed about regarding Fixed Tangible Media in regards to copyright

The Learner will become familiar with the Digital Millennium Copyright Act

The Attorney will learn about the Safe Harbor Provision of the Digital Millenium Copyright Act

The Attorney will learn about the Human Being authored submissions of copyright versus Artificial Intelligence (AI) authored submissions

The Attorney will learn about how copyright affects posts that are put on social media

Timed Agenda:

Presenter Name: Adrienne Naumann

CLE Course Title: Intellectual Property Patent and Copyright Law Evolution: Opinions from the United States Federal Appellate Courts and U.S. Supreme Court 2024/25

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00:14:47	Contour IP Holding LLC v. GoPro, Inc., 113 F.4th 1373 (Fed. Cir. 2024)
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Course Material

Intellectual Property Patent, Copyright, Trademark, Trade Secrets, Social Media, and Internet Law 2024 – 2025 Updates from the United States Federal Appellate Courts and U.S. Supreme Court

I. Patents

A. SoftView LLC v. Apple, Inc. et al., 108 F.4th 1366 (Fed. Cir. 2024)

1. Outcome: The inter parte review (IPR) decision was affirmed in part, vacated and remanded in part.
2. Background
 - a. 37 C.F.R 42.73(a) [the regulation] prohibits a patent owner
 - (1) from taking action inconsistent with the adverse judgement in an IPR, and
 - (2) thereby obtaining a claim that is not patentably distinct from a cancelled claim.
 - b. in an IPR brought by Apple, and challenging Softview's patent, the Patent Trial and Appeal Board [PTAB] found all the claims obvious over the prior art.
 - c. during a subsequent re-examination Softview amended these same cancelled claims
 - (1) to include subject matter from claims found unpatentable in IPR, and
 - (2) in particular this subject matter exclusively comprised limitations from multiple canceled IPR claims.

d. the PTAB reversed the examiner's obviousness determination from the re-examination, and entered a new ground of rejection, i.e.,

(1) the amended and unamended claims in the re-examination were patentably indistinct from

(2) the claims found obvious in the earlier IPR, and so

(3) these amended claims were invalid.

e. on appeal SoftView challenged the PTAB's application of 37 C.F.R. 42.73(d)(3)(i) to amended and unamended claims

3. Federal Circuit analysis

a. the U.S. Patent Office has statutory authority under the America Invents Act to issue this substantive regulation, because

(1) cancelled and rejected claims

(i) should not be presented at a subsequent proceeding as patentably indistinct amended claims.

(2) the regulation specifically prohibits obtaining claims which were cancelled or finally rejected in an earlier IPR.

b. issued claims are not subject to this regulation which applies exclusively to 'obtaining' a claim, that is, amending claims.

c. for amended claims the correct inquiry is: Are these amended claims patentably distinct from

(1) cancelled claims, or

(2) claims which were finally rejected in the earlier IP

B. Sanho Corporation v. Kaijet Technology International Limited, Inc., 108 F.4th 1376 (Fed. Cir. 2024)

1. Outcome: Affirmed the IPR final written decision regarding prior art status.

2. Background

a. AIA 35 U.S.C. 102(b)(2)(b) provides that

(1) if subject matter is publicly disclosed by the inventor..., before such subject matter (the published U.S. patent application) was effectively filed under 102 (a)(2),

(i) then that subject matter is not prior art.

b. Sanho's patent addressed a port extension apparatus for devices such as a laptop computer.

c. Kaijet commenced an IPR against this patent based upon obviousness, and

(1) in doing so, relied upon a specific published U.S. patent application

(2) the PTAB concluded that this particular reference was prior art under 35 U.S.C. 102(b)(2)(B), and

(i) found all the claims were unpatentable on this basis.

d. Sanho appealed and contended that this reference was not prior art, because

(1) the inventor publicly disclosed the invention through a sale between itself and Kaijet, and

(2) this sale predated the published patent application's effective filing date.

3. Federal Circuit analysis

a. section 102(b)(2)(B) exclusively applies to prior U.S. patent filings of another, and

(1) these prior filings of another do not comprise prior art if

(i) the subject matter has previously been publicly disclosed by the inventor

(ii) before the effective filing date of the patent application publication by another.

b. here there was a sale exclusively between two parties, and this sale did not expose the invention's features to the public.

c. consequently, the reference published patent application was prior art because it did not qualify for the 102(b) (2)(B) exemption

(1) that is, Sanho did not establish that the invention's features were publicly disclosed by the inventor or his direct associates,

(i) prior to the effective filing date of this particular reference (published U.S. patent application), so

(2) this U.S. patent publication was prior art and its disclosure resulted in obviousness of all the disputed claims.

[C. Allergan USA, Inc. et al. v. MSN Laboratories Private Ltd. et al., 111 F.4th 1358 \(Fed. Cir. 2024\)](#)

1. Outcome: Reversed the final judgment of obviousness double patenting

2. Background

a. Allergan sued Sun Pharmaceuticals for patent infringement after Sun requested permission from the FDA

(1) to market a generic version of Allergan's patented pharmaceutical.

b. the asserted patent had acquired patent term adjustment (PTA), so

(1) its expiration date was later than those of two later filed and later issued related patents with common ownership, but

(2) this asserted patent was the earliest filed and the earliest issued.

c. the district court concluded that one claim of the asserted patent was invalid based solely upon its later expiration date, and

(1) Allergan appealed.

3. Federal Circuit analysis

a. with *In re Collect*, 81 F.4th 1216 (Fed. Cir. 2023) this court held that PTA determines an expiration date for an obvious double patenting (ODP) analysis (emphasis added).

b. however, *Collect* did not address whether a first filed, first issued patent with a PTA is invalid for ODP, when it expires last within a series of related patents, but where

(1) the later filed but earlier issuing related patents have the same priority date and ownership as the asserted patent.

c. here there is no second later expiring patent directed to patentably indistinct subject matter, because

(1) the later expiring patent was the first patent application to be filed and the first patent to issue, so

(2) there is no improper extension of the term of the first filed patent, because

d. under these circumstances the priority date is key, and not the issue date (emphasis added).

D. [Platinum Optics Technology, Inc. v. Viavi Solutions, Inc.](#), 111 F.4th 1378 (Fed. Cir. 2024).

1. Outcome: The appeal was dismissed because there was no Article III standing

2. Background

a. Viavi owns a patent for optical bandpass filters.

b. Viavi sued Platinum for infringement of this patent, but claims were dismissed with prejudice on two occasions.

c. in an IPR commenced prior to Viavi's infringement lawsuits, the PTAB concluded that Platinum did not establish that Viavi's claims were unpatentable.

d. in its appeal to the Federal Circuit, Platinum contended it had Article III standing based upon potential infringement liability to Viavi, because Platinum

(1) creates its own bandpass filters for distribution, and

(2) is developing other models of bandpass filters.

e. in support, a Platinum executive's declaration averred that Platinum was developing new bandpass filters, and

(1) anticipated selling them within the next few years.

3. Federal Circuit analysis

a. for Article III standing there should be injury in fact or imminent injury in fact

b. for imminent injury in fact based upon a potential lawsuit, there should be concrete plans for Platinum's future activity resulting in

(1) substantial risk of future infringement, or

(2) likely causation resulting in an infringement lawsuit.

c. there was no evidence of imminent infringement risk from Viavi based upon Platinum's distribution of bandwidth filters, because

(1) Viavi's previous two infringement lawsuits against Platinum had been dismissed with prejudice.

d. there was also no evidence of future litigation based upon Platinum's band width development.

(1) the bandpass filter development description in Platinum's affidavit was vague, and

(2) for imminent injury, Platinum required evidence of detailed development plans, features of new models, as well as

(3) how newly developed models related to Viavi's patent.

(4) furthermore, Platinum's bandwidth filters were still undergoing changes in Platinum's facilities.

e. without imminent injury in fact, there is no standing for Platinum to appeal to the Federal Circuit as an Article III judicial entity.

E. Contour IP Holding LLC v. GoPro, Inc., 113 F.4th 1373 (Fed. Cir. 2024)

1. Outcome: Reversed and remanded the grant of a motion for summary judgment based upon patent ineligibility under 35 U.S.C. section 101.

2. Background

a. Contour's patents disclose a hands-free video camera

(1) which implements wireless technology so video is transmitted from a positioned camera (such as upon a user's ski helmet)

(i) to a remote device such as a user's cellphone

(2) the camera itself comprises capability to generate a low-quality video stream and a high-quality video stream

(i) thereby preserving band width, and (ii) where the low quality video stream is viewed in real time while the high-quality stream is viewed subsequently, and

(3) the user and also adjust camera parameters such as light and audio in real time

b. Contour sued GoPro for infringement of these patents.

c. the district court concluded at summary judgment that

(1) under the Alice v. Corporation v. CLS Bank International, 573 U.S. 208 (2014) test [hereinafter Alice], at step 1

(i) the claims were directed to the abstract idea of creating and transmitting video at two different resolutions and adjusting the video settings remotely, and

(2) at Alice step 2 there was only functional, result oriented claim language for basic generic tasks.

d. Contour appealed.

3. Federal Circuit analysis

a. at Alice step 1, the asserted claim is directed to a specific means that improves the relevant technology such as:

(1) low and high-quality parallel data streams where the low-quality streams to the remote device for viewing and adjustment,

(i) with lesser bandwidth limitations; as well as

(2) wireless transfer of data to a remote device

(3) use of audio and video adjustment before or during the sporting activity.

b. use of common components does not necessarily mean that the claim is directed to an abstract idea at step 1, and

c. moreover, this patented camera was not a long-known or fundamental occurrence in the relevant industry prior to its patenting.

1. Outcome: Affirmed the grant of a motion to dismiss based upon patent ineligibility under 35 U.S.C. section 101

2. Background:

a. Aviation owned a patent for predicting aircraft landings during airport data outages.

(1) the method and system comprise implementing an aircraft's altitude and speed data, and

(i) then computing a taxiing status for this particular aircraft.

b. Aviation sued SH for patent infringement, and

(1) SH replied that the asserted claims were patent ineligible under Alice.

(2) the district court agreed that the asserted claims were patent ineligible and dismissed the complaint.

c. Aviation appealed.

3. Federal Circuit analysis

a. at Alice step 1, the asserted claims are directed to collecting and analyzing information

(1) therefore, they are directed to an abstract idea.

b. at Alice step 2

(1) the asserted claims merely automate or otherwise make a conventional method more efficient

(2) there are no technical improvements to generic computers, and

(3) the absence of complete pre-emption
does not demonstrate patent eligibility

c. although the U.S. patent office concluded that
asserted claims were patent eligible, this fact was
not raised in the complaint.

G. Vascular Solutions LLC et al. v. Medtronic, Inc. et al., 117 F.4th
1361 (Fed. Cir. 2024)

1. Outcome: Vacated the final judgment and remanded for
further proceedings.

2. Background

a. Vascular Solutions' asserted patents are directed
to a co-axial guide catheter with a (i) side opening
and (ii) a rigid sidewall section/segment [rigid
segment]

(1) in some claims the side opening was
located within the rigid segment, while

(2) in other claims the opening was distal to
this same rigid segment.

(3) however, in all claims the segment was
rigid and there was a side opening

b. after Vascular Solutions sued Medtronic for
patent infringement,

c. the district court concluded that independent
claims of the patents were mutually exclusive and
therefore indefinite, because

(1) although they each comprised a rigid
segment (of the co-axial guide catheter),

(2) one asserted infringing device could not
simultaneously infringe

(i) two sets of claims wherein the
opening could be either interior, or
exterior, to the rigid segment

d. Vascular Solutions appealed.

3. Federal Circuit analysis

a. a claim should indicate to a person of ordinary skill in this art (POSA) where the boundaries of the protected subject matter begin and end.

b. however, the extent/boundary of the rigid segment need not be consistent from claim to claim, especially if

(1) a claim limitation term such as “rigid” only requires that a predetermined area be very stiff, and

(i) not necessarily comprising fixed dimensions or physical boundaries

(2) in this instance each claim individually, in and by itself, has clear boundaries to a POSA, i. e., a rigid segment which may or may not comprise an opening.

[H. Osseo Imaging LLC v. Planmeca USA Inc., 116 F.4th 1335 \(Fed. Cir. 2024\)](#)

1. Outcome: Affirmed the denial of a motion for judgment as a matter of law (JMOL)

2. Background

a. Osseo sued Planmeca for infringement of its dental imaging patents.

b. the jury was instructed that a POSA would have a bachelor’s degree in electrical or computer engineering,

(1) plus, three to five years experience working in a diagnostic imaging environment using technologies described in the asserted patents.

(2) the jury concluded that Planmeca had infringed

c. Planmeca moved for a JMOL, because

(1) Osseo's expert was not a POSA at the time of the invention.

d. the district court denied the motion and

(1) Planmeca appealed.

3. Federal Circuit analysis

a. it was undisputed that the expert was presently a POSA.

b. an expert could acquire the necessary skill after the time of invention, and

(1) hereby possess a POSA's knowledge at the time of the invention after acquiring the necessary skill.

(2) an expert need not have the requisite skill prior to the invention, to testify as a POSA.

c. in this case, the expert also properly testified to what was known at the time of the invention.

I. [Provisur Technologies, Inc. v. Weber, Inc. et al.](#), 119 F.4th 948 (Fed. Cir. 2024), cert. denied 2025 U.S. Lexis 636 (Feb. 24, 2025)

1. Outcome: Reversed in part the denial of Weber's motion for JMOL and remanded for a new trial.

2. Background

a. one of Provisur's patents addressed a device for slicing and loading meat into packages by implementing assembly line pockets.

b. although there are two methods by which to fill the pockets with meat:

(1) the advance to fill conveyer and method comprise the embodiment in the asserted claim (emphasis added)

c. a jury found that Weber willfully infringed Provisur's patents

(1) Weber moved for JMOL, but

(2) the court denied the motion.

d. Weber appealed.

3. Federal Circuit analysis

a. Provisur did not prove that Weber's asserted infringing device satisfied the 'advance to fill' limitation for Provisur's claimed device,

(1) where the accused Weber device actually comprised a retract to fill conveyer (emphasis added).

(2) according to Provisur's expert, Weber's human/ machine interphase (HMI) screens could be reconfigured so

(3) the accused device could function as an advancing device.

b. however, to infringe: an accused device must be readily

configurable by customers to the advance to fill embodiment.

c. Provisur did not establish that

(1) Weber's accused device could be reconfigured with an advance to fill conveyer,

(2) instead, the expert testimony established that reconfiguration of Weber's device requires

- (i) HMI screens which were not accessible to Weber's customers
- d. moreover, a source code expert testified that only one HMI screen was available to Weber's customers for reconfiguration
- e. there was also no evidence that Weber's device was never actually modified by either technicians or customers to the advance to fill configuration.

J. Lashify, Inc. v. International Trade Commission et al., (ITC)
130 F.4th 948 (Fed. Cir. 2025)

1. Outcome: Vacated the ITC's decision and remanded.
2. Background
 - a. Lashify owns several U.S. utility and design patents.
 - b. although its products are manufactured abroad,
 - (1) Lashify's search, development, headquarters and marketing facilities are located in the United States, and
 - (2) Lashify is a U.S. company.
 - c. Lashify filed a complaint at the ITC under 19 U.S.C. section 1337 to prevent asserted infringing imports from entering the United States.
 - d. section 1337 comprises a domestic industry requirement for the complainant, such as Lashify, as a precondition for standing before the ITC
 - (2) under 1337(a)(3)(B) for standing there must be significant capital and labor invested in the United States related to the patented products.
 - e. the ITC concluded that Lashify did not have standing, because

- (1) Lashify's patented products were not manufactured in the United States, and
- (2) consequently, Lashify did not meet the domestic industry requirement for standing at the ITC.
- (3) so Lashify petitioned for review.

3. Federal Circuit analysis

- a. the ITC's interpretation of the domestic industry requirement is much too narrow for the plain meaning of section 1337(a)(3)(B).
- b. this section reads in relevant part:
 - (1) "significant employment of labor or capital," and
 - (2) there is no statutory requirement that a "stock of accumulated goods" be manufactured in the United States.
- c. warehousing, distribution, quality control, sales and marketing expenses meet the statutory requirement
 - (1) if these activities comprise significant employment of labor and capital.
- d. the legislative history of section 1337 also supports this more expansive interpretation.

[K. Fuel Automation Station LLC v. Energera, Inc., 119 F.4th 1214 \(10th Cir. 2024\)](#)

- 1. Outcome: Affirmed the district court's pre-trial rulings and final judgment.
- 2. Background
 - a. Fuel Automation and Energera compete in the manufacture of automated fuel delivery equipment and related services.

(1) Energera holds patents for fracking equipment, and

(i) sued Fuel Automation for infringement of two of these patents.

(2) Energera and Fuel Automation ultimately concluded this earlier patent infringement suit with a single settlement agreement comprising mutual covenants not to sue over the asserted patents.

b. subsequently Fuel Automation sold or leased products to other companies

(1) where these products embodied the patents covered by settlement agreement

c. Energera sued these other companies for patent infringement, based upon their use of Fuel Automation's equipment,

(1) because according to Energera, Fuel Automation's equipment infringed Energera's patents.

d. Fuel Automation then sued Energera for

(1) breach of the covenant not to sue, and

(2) for a declaratory judgement that:

(i) the covenant not to sue included immunity from patent infringement liability for downstream third parties

e. Energera contended that the mutual covenants did not include third parties.

(1) the jury found that Energera breached the covenant not to sue,

(2) the court issued a final judgment thereon, and

(3) Energera appealed this final judgment.

3. Appellate court analysis for downstream users and the patent exhaustion doctrine

a. the covenant not to sue unambiguously protects Energera and Fuel Automation from suing each other for infringement of these particular patents

b. however, the covenants not to sue do not address infringement liability of downstream third parties

(1) although Exhibit C (a press release) of the settlement agreement expressly states that the parties could sell and lease the patented equipment to downstream third parties.

c. under the patent exhaustion doctrine, the initial authorized sale or use of a patented item terminates all patent rights in that specific item.

(1) if the rights of downstream third parties are not specifically disclaimed, then

(i) the patent exhaustion doctrine determines whether these downstream third parties are immune from infringement lawsuits.

d. because the settlement agreement was silent on downstream third person liability, and was otherwise broadly worded,

(1) the patent exhaustion doctrine automatically fills the 'gap,' and

(i) prohibits Energera from suing downstream third parties, because

(2) Fuel Automation authorized use of the tangible items of patented equipment to downstream third parties

e. takeaway: Very analogous to statutes for estate distribution and partnership agreements: If the agreement or will are silent on a particular point,

(1) then the statute adds its own provisions, and

(i) not necessarily the provisions which parties would have preferred.

L. Telefonaktiebolaget LM Ericsson (United States) Inc. et al. v. Lenovo, Inc. et al., 120 F.4th 814 (Fed. Cir. 2024) [Ericsson and Lenovo]

1. Outcome: Vacated and remanded the denial of a motion for an antisuit injunction

2. Background

a. both Ericsson and Lenovo owned standard essential patents which they originally intended to license to each other

(1) under the European Telecommunications Standards Institute rule for licensing of standard essential patents, and to which they both were parties, and

(2) they each contractually promise to negotiate licensing terms in good faith (FRAND commitment).

b. when licensing negotiations ceased, Lenovo sued Ericsson for (i) infringement of Lenovo's standard essential patent, and (ii) breach of the FRAND commitment,

(1) in several jurisdictions including the United States.

c. Ericsson obtained injunctions against Lenovo in Columbia and Brazil

d. in the U.S. lawsuit Lenovo sought a judicial declaration that

(1) Ericsson breached the FRAND contract terms and conditions for fair negotiation of a standard essential patent license.

e. Lenovo also moved for an anti-suit injunction in the United States to prohibit Ericsson from enforcing its Columbian and Brazilian injunctions.

f. the district court denied Lenovo's motion, stating that an anti-suit injunction was not dispositive of the foreign litigation, because

(1) an antisuit injunction would not inevitably result in a cross-global essential standard patent license

(2) Lenovo appealed.

3. Federal Circuit analysis

a. the district court legally erred when it reasoned that, for the foreign anti-suit injunction to be dispositive,

(1) the U.S. lawsuit must necessarily result in a global cross-license.

b. based upon precedent, the dispositive requirement was met here, because

(1) the FRAND contract/commitment requires that a standard essential patent holder negotiate a license in good faith, so

c. the contract issue is dispositive, because

(1) a FRAND party should not proceed to an injunction unless

(i) it has established that it attempted a cross-license with

another FRAND participant in good faith.

d. upon remand the U.S. court must address

(1) whether Ericsson negotiated a cross-license in good faith as a condition to obtaining injunctive relief.

M. Lynk Laboratories, Inc. v. Samsung Electronics Co., Ltd.,
125F.4th 1120 (Fed Cir. 2025)

1. Outcome: Affirmed PTAB's IPR unpatentability decision.

2. Background

a. Samsung filed an IPR petition, contending that Link's patent was obvious under 35 U.S.C. 103, and

(1) relied upon a specific U.S. published patent application as prior art when combined with other references, and

(i) where this published patent application apparently never became a patent

b. Lynk contended that the published patent application did not qualify as prior art, because

(1) this published application, although filed earlier than Lynk's own application, was not publicly accessible prior to

(i) the effective filing date of its own patent application (which became the asserted patent).

c. however, the PTAB decided the published patent application was prior art, so

d. the issue on appeal was whether the (i) filing date or (ii) publication date of the published patent application determines prior art status.

3. Federal Circuit analysis

a. published patent applications qualify as printed publications and thereby are qualified references for IPR proceedings.

b. 35 U.S.C. section 102(e)(1) is directed exclusively to published patent applications, and

(1) expressly states that published applications comprise prior art as of their filing dates, and

(2) even if a published application was not publicly available on its filing date.

N. [US Synthetic Corporation v. International Trade Commission \(ITC\)](#), 128 F.4th 1272 (Fed. Cir. 2025)

1. Outcome: Reversed ITC's conclusion that composition of matter claims were not patent ineligible under 35 U.S.C. section 101

2. Background

a. US Synthetic's patent is directed to a diamond particulate solid attached to a metal substrate such as cobalt-cemented tungsten carbide.

b. in this patent US Synthetic described its diamond composition in terms of quantified materials, physical parameters, and in particular

(1) diamond grain size and quantified magnetic properties.

c. the ITC administrative law judge concluded that the claims were directed to an abstract idea with no inventive concept, and

(1) the ITC Commission affirmed.

3. Federal Circuit analysis

a. the asserted claim is directed to specific tangible constituent elements, as well as

(1) quantified dimensions and quantified material properties, and

(2) where the material properties correlate to the diamond composition's structure.

(3) for example, the quantified parameters inform a POSA about the 'mean free path' between diamond grains, and

(i) provides the specific diamond grain to diamond grain bonding

(ii) the quantified magnetic properties, and

(iii) this composition's physical structure

b. there are also specific working examples in the patent's specification, and

(1) this specification sufficiently discloses the quantified relationship

c. moreover, by law an issued patent is presumed valid, so

(1) the court should presume patent eligibility until there is appropriate evidence to the contrary, and which was not the case here.

[O. Contour IP Holding LLC v. GoPro, Inc., 113 F.4th 1373 \(Fed. Cir. 2024\)](#)

1. Outcome: Reversed and remanded the grant of the motion for summary judgment to GoPro.

2. Background

a. Contour's patents were directed to portable hands-free digital video cameras.

(1) features of these patented cameras a wireless technology so

(i) the camera sends real time video to a remote device (such as a cell phone)

(ii) the user immediately views the video on the cellphone, and

(iii) may adjust this video view immediately (example: where the camera is mounted upon a skier's helmet).

(2) another feature comprises

(i) one low quality video stream, and

(ii) a parallel second higher quality video stream where

(iii) the lower quality video stream is sent to the cell phone (or other remote device) in real time, and thereby preserves bandwidth

b. Contour sued GoPro for patent infringement of these cameras

(1) the district court concluded that the patented cameras were not patent eligible, because

(2) the claims were directed to abstract ideas with no inventive concept.

c. Contour appealed

3. Federal Circuit analysis

a. the claimed features comprise specific technical improvements to a technical problem under Alice

Corporation v. CLS Bank International, 573 U.S. 208 (2014), that is,

(1) a dual recording portable handsfree camera comprising a wireless operative connection, and

(i) a high-quality video stream, and

(ii) a low-quality video stream for instant playback while preserving band with

b. so this camera

(1) records wireless two video streams in parallel, and

(2) wirelessly transfers only the lower quality video stream to a remote device in real time, so

(3) the claimed camera is patent eligible.

P. Recentive Analytics, Inc. v. Fox Corporation et al., 134 F. 4th 1205 (Fed. Cir. 2025)

1. Outcome: Affirmed the dismissal of a patent infringement case based upon patent ineligibility

2. Background

a. Recentive owned two sets of patents

(1) one set of patents address a machine learning model trained with, for example, historical data and

(i) which generates an optimized output schedule with any suitable machine learning technique.

(2) the network map patents, uses training data with a machine learning model to generate optimized network maps

b. training data for these two patent sets originated from previous live events,

(1) which were then implemented with any suitable machine learning technique, and

(2) generic computer equipment

c. the district court granted Fox's motion to dismiss under Alice, 573 U.S. 208 (2014)

3. Federal Circuit analysis

a. this is a case of first impression regarding machine learning

b. under Alice Step 1: all the asserted patents rely upon machine learning,

(1) which is described generically in the patents.

(2) furthermore, the patents do not claim a specific technical method for improving

(i) the mathematical algorithm or (ii) machine learning process.

(3) the only change disclosed in the patent is that machine learning occurs in a new environment, such as network maps, but

(i) a new environment for an abstract idea is insufficient for patent eligibility.

(4) otherwise, these patents claim mere abstract information collection, and

(5) claims are not patent eligible simply because

(i) the claimed subject matter collects information for conventional transactions more rapidly than humans.

c. for Alice step 2: there is no inventive concept which is significantly more than applying generic machine learning.

Q. In re Floyd, 2025 U.S. App. Lexis 9504 (Fed. Cir. April 22, 2025) [non-precedential].

1. Outcome: Affirmed PTAB decision affirming the examiner's rejection of a design patent application.

2. Background

a. Ms. Floyd submitted a U.S. utility patent application for

(1) a cooling blanket comprising arrays of compartments.

(2) the specification stated that

(i) the blanket could comprise embodiments with diverse compartment arrays

(ii) "many other variations are possible" and "...can be made in any size suitable for cooling."

(3) the specification of the utility application contained drawings of two embodiments,

(4) each embodiment in Figures 1 and 1A comprised (i) a different size compartment, and (ii) a different number of compartments from the remaining embodiment

(5) the utility patent application was subsequently published online

b. subsequently Ms. Floyd submitted a design patent application for a warming blanket with a specific number and size of compartments

(1) this claimed design differed from each of the two utility applications illustrated

embodiments with respect to size and number of compartments.

(2) Ms. Floyd designated the submission date of the earlier published utility application as the priority date for the design application

c. the examiner found there was no written support under 35 U.S.C. section 112 from the utility application for the design application, because

(1) the specific design for the design patent was not disclosed in the utility application

(2) instead, the utility application comprised prior art under 35 U.S.C. section 102, and

(i) the design application was rejected.

d. the PTAB affirmed.

3. Federal Circuit analysis

a. the specification statement designating 'any size' could mean that

(1) the rectangular sections could vary in size rather than requiring additional compartments.

b. even with "simple" technology, section 112 requires

(1) a complete specific description of the design within the utility patent application,

(i) which matches the design in the design patent application,

(ii) to qualify for the earlier filing date of the utility patent.

c. the utility application's two illustrated embodiments differ with respect to multiple parameters, so

(1) they comprise distinct embodiments, and not a range as they differ in more than one parameter, i.e., number and shape of compartments within a single blanket.

(2) in particular, Figures 1 and 1A of the utility patent disclose diverse numbers and columns as well as compartment shapes.

(3) even if there is a range, nevertheless there is insufficient written description for evidencing a particular embodiment within this range.

d. as to inherency, a POSA would not necessarily recognize that

(1) Ms. Floyd possessed the specific later claimed design at the time she submitted the utility application.

e. there was no evidence that the number of blanket compartments is functional, i.e., related to how the blanket operates, because

(1) the specification states that the blanket could be any size, and

(2) which could mean that the blanket functions with any number of compartments.

f. in sum, the predictability of the technology does not necessarily mean a specific design is predictable, and

(1) where the subsequent design may range from straightforward to ornate (emphasis added).

1. Outcome: Affirmed the ARP finding (a special panel comprising the Director of the U.S. Patent & Trademark Office, Commissioner for Patents and the PTAB Chief Judge) that there was insufficient 35 U.S.C. section 112 written description

a. to support a Jepson claim preamble.

2. Background

a. the application comprised a Jepson claim directed to an improved method for treating a patient

(1) by dosing with a specific antibody.

b. the examiner, PTAB and the ARP rejected the claim, because

(1) the claim preamble lacked an adequate written description in the application

(i) of the subject matter which Xencor asserted was well known in the technology

3. Federal Circuit analysis for Jepson claim

a. for a Jepson claim, the inventor must provide sufficient written description to show possession of

(1) the claimed improvement, and

(2) the preamble's prior art to which the claimed improvement applies and impliedly asserts to be well known, because

(i) they are both integral components of a single claim.

b. the applicant must establish that subject matter implicitly asserted to be well known in the prior art of the preamble

(1) is adequately described in the patent application.

c. here the specification did not show possession of the claimed improvement compared to what was known in the art.

(2) in particular, there was a large number of possible antibodies in this genus,

(i) without evidence that any of these antibodies were well known in this technology.

[S. Ingenico, Inc. v. Ioengine, LLC, 136 F.4th 1354 \(Fed. Cir. 2025\)](#)

1. Outcome: Affirmed the denial of a motion for JMOL and for a new trial.

2. Background

a. Ioengine's asserted patents addresses a device, such as a USB thumb drive,

(1) with a processor that implements communications with a network server.

b. Ioengine sued PayPal Holdings, Inc. for patent infringement

(1) because Ingenico supplies the accused products to PayPal.

c. prior to trial Ingenico initiated an IPR proceeding

(1) the PTAB found most of Ioengine's asserted claims unpatentable based upon specific prior art patents and printed publications.

d. thereafter at trial on the remaining claims, Ingenico presented the same prior art from the IPR, as evidence of

(1) sales and public use by third parties, as well as

(i) knowledge of others prior to the invention date.

e. the jury found the claims infringed but invalid as anticipated or obvious.

f. loengine moved for a JMOL or new trial, but the court denied these motions.

g. loengine appealed, contending that

(1) Ingenico was estopped from introducing same the prior art at trial which was introduced as evidence at the IPR.

3. Federal Circuit analysis

a. the scope of an IPR is limited to grounds that could be raised under sections 102 or 103, but

(1) for an IPR, by statute evidence is limited to patents and printed publications as proof for the liability theory of

(i) obviousness and/ or

(ii) anticipation

(2) the statutory term 'grounds' are those theories raised or reasonably could have been raised during an IPR, i.e., IPR estoppel (emphasis added)

(3) however, IPR estoppel does not prevent reliance upon the same patents and printed publications as evidence,

(i) to assert grounds during court litigation which by statute could not be raised in the IPR

(i) such as an on sale or public use bar, etc. (emphasis added)

b. therefore the district court properly dismissed the motion for a JMOL and new trial.

T. University of California et al. (UC)v. Broad Institute, Inc. et al.,
136 F.4th (Fed. Cir. 2025)

1. Affirmed the PTAB decision in part, vacated in part and remanded for a priority of invention decision under the Federal Circuit's conception criteria

2. Background

a. UC and Broad each asserted first inventorship of RNA engineered molecules, known as CRISPR systems, more specifically CRISPR-Cas9, and

(1) which edit DNA in eukaryotic cells, and which includes human cells.

(2) under pre-AIA law applicable here, the first inventor(s) is entitled to the patent for the invention.

(3) in a pre-AIA proceeding known as an interference,

(i) the PTAB concluded that Broad invented CRISPR systems operable in eukaryotic cells prior to UC.

b. UC appealed, contending that the PTAB had erred as a matter of law in its criteria for conception, and where conception comprises the most significant portion of an inventorship analysis.

(1) upon this second appeal the issue was

(i) whether UC conceived of a successfully operative CRISPR in eukaryotic cells ahead of Broad's conception thereof.

(2) in reaching its conclusion on this second appeal, the PTAB primarily relied upon

evidence that UC had expressed doubts about its experimental procedures

(i) for achieving operable CRISPR systems in eukaryotes, and

(3) where UC modified its experiments prior to obtaining successful results in fish prior to the Broad's asserted conception date.

3. Federal Circuit analysis regarding conception

a. invention requires

(1) conception: a complete mental picture of the invention without undue experimentation to alter the final subject matter thereof, and

(i) with experimental methods of a POSA

(2) reduction to practice (either actual or constructive), such as

(i) a tangible operative embodiment of the conceived subject matter, or

(ii) a detailed description of the subject matter in a U.S. utility patent application; and

(3) due diligence in reducing the invention to practice after conception

b. conception is complete only when the innovative idea is so clearly defined in the inventor's mind that

(i) only ordinary skill in the industry is necessary to reduce the invention to practice without extensive research or experimentation.

c. the PTAB legally erred by relying upon

(1) UC's statements of uncertainty without considering whether UC scientists modified their experiments

(i) to substantively change UC's original idea.

(2) instead, the proper legal inquiry is: Was UC's idea in sufficiently final form that

(i) only the exercise of ordinary skill was necessary to reduce the idea to practice without extensive research or experimentation.

(3) here the PTAB did not consider routine methods or skill.

d. moreover, an inventor need not know that his invention will be operable for its intended purpose for conception to be complete, so

(1) PTAB also legally erred by categorically disregarding

(i) evidence of purported experimental success by others, and

(ii) UC's disclosed routine methods or skill at asserted conception dates, as well as

(iii) whether UC used routine methods or skill in purportedly successful experiments.

4. Takeaway: Although this analysis for inventorship dates was necessary for pre-AIA law, it remains important today for inventorship status disputes.

II. Copyright

A. Green et al. v. United States Department of Justice et al., 111 F.4th 81 (D.C. Cir. 2024)

1. Outcome: Affirmed dismissal of a facial challenge to the Digital Millenium Copyright Act (DMCA) section 1201(a)

2. Background

a. the DMCA, section 17 U.S.C. 1201(a), prohibits

(1) circumvention of “digital locks” (such as encryption and passwords) upon copyright registered works; and

(2) creation of “digital keys” which circumvent these digital locks, and

(i) where these digital keys have no substantially non-infringing uses.

b. however, section 1201(c) preserves the fair use defense.

c. Dr. Matthew Green and another individual initially asserted that section 1201(a) is unconstitutional as applied because it violates the First Amendment.

d. they subsequently changed this assertion and instead contended that

(1) section 1201(a) is facially overbroad and a prior restraint on speech

e. this subsequent position was grounded in

(1) the asserted right to access digital works for fair use, and

(2) violation of the First Amendment by both (i) section 1201(a) and (ii) the Library of Congress regulation for creating fair use exemptions on a case-by-case basis

f. the district court dismissed the First Amendment claims under section 1201(a), and

g. Dr. Green appealed

3. Appellate court analysis

a. section 1201(a) is not facially overbroad,

(1) because it regulates conduct and not speech.

b. in particular, section 1201(a) does not base its prohibition of electronic circumvention upon speech content, and

(1) therefore, section 1201(a) is viewpoint neutral and content neutral.

(2) the Librarian of Congress' adoption of temporary exemptions from section 1201 is not a prior restraint on speech

(i) because the statute authorizes the Librarian to do so; and

(ii) an as applied' challenge can be raised if a particular exemption, or denial thereof, appears content or viewpoint based.

c. trafficking, i.e., creation of circumvention tools and prohibited by section 120(a), is similarly not inherently expressive, and

(1) therefore, the anti-trafficking portion of section 1201(a) also lies outside the scope of the First Amendment.

d. fair use is not necessarily protected by the First Amendment,

(1) because the First Amendment does not provide unimpeded access to every copyright registered work.

(2) there are alternative procedures by which to obtain lawful access to copyright registered works for fair use.

B. Hachette Book Group, Inc. et al. v. Internet Archive, 115 F.4th 163 (2nd Cir. 2024).

1. Outcome: Affirmed the summary judgment finding of no fair use.

2. Background

a. The not for profit Internet Archive scanned complete physical copies of Hachette's books for consumers to 'rent' without paying a fee, and without Hachette's consent.

b. Hachette sued Internet Archive for copyright infringement.

c. the district court concluded there was no fair use, granted summary judgement to Hachette, and

(1) Internet Archive appealed.

3. Appellate court analysis for transformative use factor in fair use defense.

a. Archive's lending of Hachette's entire books in digital format, and in a commercial manner, undercuts the market of the original e-book publishers such as Hatchett.

b. transformative use comprises:

(1) criticism, commentary or additional information about the original work, or

(2) alteration of the original work with new expression, meaning or message

c. the purported fair use must comprise more than reformatting the original tangible copyright protected work to an online digital form, because

(1) merely reformatting without more
comprises a derivative work, and not a
transformative work.

d. because there is no transformation here,

(1) Archive's free digital library supplants
the original works with unchanged copies,

(2) the unchanged copies unduly impinge
on derivative work rights, and thereby
comprise copyright infringement.

C. [UMG Recordings, Inc. et al. v Grande Communications Networks LLC](#), 115 F.4th 163 (Fifth Cir. 2024), rehearing denied and en banc, [UMG Recordings, Inc. v. Grande Communications Networks, LLC](#), 2024 U.S. App. Lexis 30948, petition for cert. filed March 6, 2025.

1. Outcome: Affirmed the judgment finding Grande liable
for contributory copyright infringement.

2. Background

a. Grande is an internet platform where subscribers
share files on a peer-to-peer basis.

b. consulting company Rightscope, was retained by
Grande to identify infringing subscribers, but

(1) Rightscope required Grande to provide
names and contact information for the
infringing subscriber's true identities

c. although Rightscope sent numerous
infringement alerts,

(1) Grande did not terminate the accounts
of repeat infringers which

(2) Rightscope by itself could only identify
by fictitious mail addresses.

d. however, Grande possessed the technology to terminate thousands of accounts for non-payment of Grande's monthly subscriber fees.

e. the jury concluded that Grande was liable for willful contributory copyright infringement, and the court entered a final judgement thereon

(1) Grande appealed

3. Appellate Court analysis

a. Grande's conduct comprised more than a mere failure to prevent infringement, and

(1) was more analogous to aiding and abetting under criminal law

b. here Grande

(1) affirmatively and deliberately chose to continue services to known infringing subscribers

(2) rather than implementing a simple remedy to prevent infringement, i.e., termination of their accounts, and

(3) where this remedy was identical to Grande's termination of thousands of accounts for non-payment.

[D. Tangle, Inc. v. Aritzia, Inc. et al., 125 F.4th 991 \(9th Cir. 2025\)](#)

1. Outcome: Reversed the dismissal of a copyright claim at the pleading stage.

2. Background

a. Tangle owns the U.S. copyright registrations for kinetic and manipulable sculptures

(1) made of connected tubular segments which may create different three-dimensional configurations.

b. Tangle sued Artizia for copyright infringement, because

(1) Artizia placed similar sculptures in its retail store windows without Tangle's authorization

c. the district court concluded that sculptures capable of numerous three-dimensional configurations were not copyright eligible, because

(1) they were not 'fixed' in a tangible medium required by 17 U.S.C. section 501(a).

d. Tangle appealed.

3. Appellate court analysis

a. no U.S. appellate court has held that expression involving motion, or alternative poses and configuration, is copyright ineligible, because

(1) the expression is not 'fixed' in a tangible medium

b. the sculptures are material tangible objects so they qualify as copies under 17 U.S.C. 101; and

(1) these copies can be perceived and reproduced for more than a transitory period.

c. other 'moving' works which are recognized as copyright eligible include motion pictures, symphonies and choreography, because

(1) they are fixed in a tangible medium

(i) even though they change three-dimensional, two dimensional or one-dimensional configurations within the tangible medium

(2) such as a dancer's tangible moving arms and legs.

E. Capital Records LLC et al. v. Vimeo LLC. et al., 125 F.4th 409 (2nd Cir. 2025)

1. Outcome: Affirmed summary judgment for Vimeo under the Digital Millennium Copyright Act (DMCA) safe harbor provision.

2. Background

a. Vimeo is a service provider with a website which uploads videos from third party users

b. the DMCA provides 'safe harbors' for internet service providers who

(1) do not possess actual knowledge of specific copyright infringement on their sites; or

(2) do not financially benefit from infringing activity of videos even if the service provider has oversight and control. 17 U.S.C. 512(c)(1).

c. Capitol Records and other copyright owners sued Vimeo for copyright infringement, because

(1) numerous uploaded videos on Vimeo's website comprised copyright registered music without the copyright owners' permission.

d. Capitol Records contended that Vimeo had awareness of the infringement, but

(1) failed to quickly remove the infringing videos

(2) furthermore, Vimeo benefitted financially from the infringing activity,

although it has the right and ability to control the infringement.

e. on summary judgment the district court concluded that Vimeo qualified for the safe harbor, so Capitol Records appealed.

3. Appellate court analysis

a. Vimeo's employees did not possess the requisite knowledge of United States copyright law

(1) to recognize infringing videos or unauthorized performances within a tsunami of incoming videos arriving to the platform.

(2) the ratio of videos actually reviewed compared to the number of new incoming videos arriving at the platform was very small.

b. similarly, there was no in-depth review of each video by Vimeo or its employees, and

c. Vimeo employees also did not possess the education or experience to recognize a fair use of any uploaded music.

F. *Thaler v. Perlmutter*, 130 F.4th 1039 (D.C. Cir. 2025)

1. Outcome: Affirmed denial of U.S. copyright registration

2. Background

a. Dr. Thaler is a computer scientist working with artificial intelligence (AI).

b. he submitted a copyright registration application for visual art to the U.S. copyright office, and

(1) designated his AI device as the sole author without himself or another natural person as a co-author.

c. the copyright office examiner rejected the application, asserting that a machine/device cannot be an author under the U.S. copyright statute, and

(1) the copyright office administrative appeal officers affirmed

(2) the district court affirmed the copyright office decision, and

d. Dr. Thaler appealed

3. Appellate court analysis

a. the U.S. copyright statute requires all registered works to be authored by human beings, and

b. multiple statutory provisions confirm this conclusion

(1) a machine cannot own property, such as copyright;

(2) in many circumstances copyright duration depends upon the author's(s) lifespan;

(3) the copyright statute inheritance provision leaves property to a surviving spouse or heirs, but

(4) a machine does not have a surviving spouse and heirs;

(5) machines do not have domiciles or a national identity;

(6) machines do not have intention (with respect to joint works); and

(7) the statute presumes machines have an owner regarding maintenance, service and repair.

1. Outcome: Affirmed dismissal of Mr. Woodland's copyright infringement complaint.

2. Background

a. Mr. Woodland a male model, alleged that Mr. Hill, another male model, infringed his copyright

(1) publicly posting photographs of himself on Instagram that closely resembled Mr. Woodland's publicly posted self-photographs on Instagram

b. Mr. Woodland asserted that Mr. Hill accessed Mr. Woodland's images because they each posted on Instagram, and

(1) the substantial similarity between the two sets of photos evidenced unlawful copying.

c. the district court dismissed the complaint, holding that

(1) Mr. Woodland did not plausibly allege either access or substantial similarity, so

(2) Mr. Woodland appealed.

3. Appellate court analysis

a. availability of Mr. Woodland's images on Instagram did not, by itself, plausibly demonstrate that Mr. Hill observed them on that site, and

(1) even if they each owned Instagram accounts.

b. for example, Mr. Woodland did not plausibly allege that Mr. Hill followed, liked, or otherwise interacted with Mr. Woodland's posts

Program Transcript

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Hi, everybody. Welcome to this presentation of 2024 to 2025 updates from the United States federal appellate courts and U.S. supreme courts. It was hard to select all the cases that I wanted to talk about. So I did the best I could to select the ones I thought would be most noteworthy and something we could all learn something about.

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So I'm going to start right away with patents. The first one is soft U versus Apple. And the outcome was, inter-party inter-party review decision was affirmed in part and remanded in part. The background of this case has to do with the regulation that's cited in your written materials, which prohibits a patent owner from taking action inconsistent with an adverse judgment in an IPR proceeding, and thereby obtaining a claim that is not patentable, distinct from a finally refused or canceled claim.

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So, we had an IPR brought by Apple challenging the Suffuse patent and the Patent Trial and Appeal Board found the claims obvious over the prior art. The soft few subsequently did a reexamination where they amended the claims that were that the board found invalid. Unfortunately, the amended claims exclusively comprised limitations from the canceled claims from the IPR.

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So the board reversed the examiner's obvious determination and entered a new ground of rejection. That is that the, both the amended and the unamended claims in the IPR were passed in the present proceeding were patently indistinct from the claims found in the early IPR, and so the amended claims were invalid, on appeal. So if you challenge the board's application of the regulation, the Federal Circuit agreed with the board.

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At first of all, it said that the US Patent Office has statutory authority for this regulation. Because canceled and rejected claims should not be presented at a subsequent proceeding as patentable industry and distinct amended claims. And this regulation specifically prohibits getting claims which were canceled or finally rejected. However, it was that the board was overbroad because issued claims are not subject to this regulation, which only prohibits obtaining claims, and if you have issued claims, you're not obtaining them anymore.

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Next is San Ho versus Skagit Technology, which affirmed another IPR decision regarding prior art status. So, 35 U.S.C. 102 B to small B provides that subject matter publicly disclose if subject matter is publicly disclosed to the inventor by the inventor before the subject matter is in a published patent, the application, then that subject matter is not prior art.

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San Jose Pat and the addressed an extension apparatus, to an extension apparatus for laptops. Cage. It commenced an IPR against the patent bears based on obviousness. In doing so, it relied upon a specific published, United States application. The board concluded that this reference was prior art and found all the claims were patentable.

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San ho appealed and contended this reference was not prior art, because the inventor publicly disclosed the invention through a sale, and this sale predated this reference. Published. This referenced published patent applications. Effective filing date. So this case on the facts is a little more convoluted than the previous two, at least in my professional opinion. So this requires a really good knowledge of the statute.

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35 U.S.C. 102. And this particular section exclusively applies to prior U.S. patent filings. And says these prior filings of another should not comprise five prior art if the subject matter has not been publicly disclosed by the inventor. I'm sorry, has previously been disclosed by the inventor publicly before the effective filing date of the patent application publication.

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What the Federal Circuit said was. So the whole thing in this case hinges on whether the asserted sale or offer for sale was actually public. So that became a big issue. Here, there was a sale exclusively between two parties, which did not expose the invention to the public. So it wasn't a public sale. And since it wasn't a public sale, the exception doesn't apply.

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So the reference publication was prior art, and there was obviousness on that basis. Next we have another double patenting case. Really the next big one, following in Ray's select and the patent term extension, conundrum here, the Federal Circuit reversed the finding of obviousness, double patenting. Here, aliens sued Sun Pharmaceuticals for patent infringement.

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Through the procedure where you go to the, the alleged infringer goes to the FDA for approval to market a generic of a patent to pharmaceutical. The asserted patent had acquired patent term extension. So its expiration date was later than those of two later filed, and it later issued related patents with common ownership.

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But it was also the parent application. It was the earliest filed and the earliest issued. The district court concluded that one claim of the asserted patent was invalid, based solely upon the asserted patents. Later expiring date and alien Allergan appeal. So, of course, the Federal Circuit looked, referred to in Race Select. That was two years ago where the court held that patent term expenditure determines patent term adjustment, and determines an expiration date for obvious double patenting analysis.

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The Federal Circuit then pointed out that Select did not address whether a first filed, first issued patent with a patent term extension is invalid for obvious double pattering when it expires within, it expires last within a series of related patents. But where the later issued but earlier the later filed but earlier issuing related patents have the same priority date and ownership as the asserted patents.

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Here there is no second later expiring patent directed to patentable indistinct subject matter. Because the later expiring patent was the first patent to be filed and the first patent issue. So there's no improper extension of the term of the first patent. So under these circumstances, the priority date is key and not the issue date. Perhaps a better way of saying this is if there's something if an application becomes the parent, the parent is the parent, then there's no way that that patent is going to claim an indistinct patent, because it was the first patent in the first application.

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So anything after that may have that any application filed thereafter may have that problem with patent term adjustment. But the first patent does not. Next we have platinum optics versus VAB where the appeal was dismissed because there was no article three standing. This issue came up, in my previous discussion about what happens when you go from the administrative patent court, to the Federal Circuit.

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In the vast number of cases you're going to have, article three standing, it's not even going to be addressed. But every once in a while you get somebody appealing, which who doesn't is found not to have the requisite standing requirements for adjudication in a federal court. And this was one of those where the court didn't get to the merits because the appeal was dismissed.

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Because there was no article three standing. So what happened here was VAB owns a patent for optical band pass filters, and VAB sued platinum for infringement. And twice these claims were dismissed with prejudice with respect to there wasn't any infringement. So two times the federal district court said there was no infringement of the patent and a subsequent IPR.

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IPR commenced prior to VAB infringement suits. The board concluded that platinum did not establish that VAB claims were patentable, so they just have one proceeding saying the claims are fine. You have another proceeding where they said there was no infringement. So the glass was half full for everybody. In its appeal to the Federal Circuit, platinum contended it had article three standing

based upon potential infringement liability because platinum creates its own bandpass filters and is developing more for sale and distribution in the future.

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To support this, brief in support of standing, Platinum's executive, submitted a declaration that averred that VAB was collaborating. I'm sorry that VAB, a platinum executive's declaration, averred that platinum was collaborating with customers to develop new filters and anticipated selling them within the next few years. The Federal Circuit did not agree, for it.

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First, it laid out what you need for article three standing in the federal courts. No matter what kind of law you're practicing, there should be injury in fact, or imminent injury. In fact, for imminent injury based upon a potential lawsuit, there should be concrete plans for Platinum's future activity resulting in substantial risk of future infringement or causation, resulting in an infringement lawsuit.

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Here, there was no evidence of an imminent infringement from VAB based on this particular patented prod product, because they had already been to infringement lawsuits, which had both been dismissed with prejudice. There was also no evidence of future litigation based upon Platinum's bandwidth development. Here's where platinum really didn't have the evidence for standing, the development description in the affidavit was vague, and for imminent injury, platinum required evidence of detailed development plans.

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Features of the new models, as well as how newly developed models related to VR V's patent. And that would have been difficult because Platinum's bandwidth filters were still being developed and modified in its facilities. So without any concrete evidence of imminent injury, there was no standing in the appeal. Next, we have a 101 case that doesn't have to do with software, a computer.

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So that's, kind of a way to fill in, how, you know, whether something is going to be vulnerable to a section 101 attack. Here and contour, we have Contour Holdings versus GoPro, which reversed and remanded a grant of a motion for summary judgment based on section 101, contours patterns to disclose a hands

free video camera where that are really for, intended for sports enthusiasts, but they're not limited to that where, for example, somebody would have their cell phone out while they're skiing and they have a camera on their helmet or their ski cap, and the camera can be adjusted from the phone while somebody is skiing.

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It's kind of like a moving selfie, a video selfie. You can adjust it remotely from your phone to wherever you've hooked the camera. And in addition to that, the camera has two streams, of the kind of video that's sent back to the phone. One of them is low quality video, which you look at right away, and the other is a high quality video, which you look at subsequently, and it's the low quality that you can, you can adjust in real time if you don't like the way things are looking while you're skiing, for example.

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And that also, the low and high quality preserves bandwidth, although they didn't go into a lot of technical detail, how that happens. So those are some of the technical improvements to this camera. Contour sued GoPro for infringement. The court concluded its summary judgment under Ellis, the Ellis test at step one. The claims were directed to the abstract idea of creating and transmitting video at two different resolutions, and at step two, there was only functional result oriented language in the claims for basic generic tasks, contour appeals and the Federal Circuit reversed that.

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It said that at Ellis step one, the asserted claim is directed to a specific means that improves the relevant technology primarily the high and low quality parallel data streams that lessened bandwidth limitations, as well as the wireless transfer of data to a remote device and being able to adjust the settings on the camera from your phone while you're, for example, skiing.

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It also noted that use of common components does not necessarily mean that the claim is directed to an abstract idea, and not only that, the evidence showed that the patent camera was not a long known or fundamental occurrence in the relevant industry prior to its patent. So with 101 cases, which still continue to haunt patent attorneys, my feeling about it is that the best way to figure out

whether your device is patent eligible or not is really to keep up with the 101 cases and consider each of them a data point.

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And hopefully you get enough data points where you can figure out whether what your client brings you is patent eligible. That has to do that would, have to do with software and computers as well as, tangible devices such as such as cameras. And we'll have a few more of those in a few minutes. Next we have Aviation Capital Partners versus SRH advisors.

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Affirmed a grant of motion to dismiss, which is also, a 100. So it's also a 101 case. Aviation owned a patent for predicting aircraft landings during airport data outages. And the method and system comprised implementing an aircraft's altitude and speed data and then computing a taxing status for this particular aircraft. Aviation sued SRH for patent infringement, and SRH replied that the claims were patent ineligible, and the district court agreed and dismissed the complaint.

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The Federal Circuit agreed, et al. Step one. The asserted claims were directed just to collecting and analyzing information which many decisions have reiterated is not a patent eligible method. So they're directed to an abstract idea, at Alice's step to the asserted claims. It merely automates or otherwise makes a conventional method more efficient. There's no technical improvements to generic computers, and the absence of complete preemption does not demonstrate patent eligibility.

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Apparently the U.S. Patent Office had let this thing, issue this application issue as a patent. But this point wasn't raised, in the pleadings. So it wasn't addressed by the court, for anybody, just as an aside for anybody who watches the Smithsonian Channel and airs the show Airport disasters, you know, that altitude and speed come up in every show.

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That's the first thing that the investigators look at is altitude and speed. And so this is really, really, really nothing new at all

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Next, we have Vascular Solutions versus MC Medtronic, which vacated the final judgment. So Vascular Solutions asserted patents are directed to, not surprisingly, a medical device, which is a guide catheter that has a rigid section and an opening. And there's at least two embodiments. In one embodiment, the opening is within the rigid section of the catheter. In the other embodiment, its exterior and then another location, to the rigid section.

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However, in all of the claims, there was a rigid portion, after Vascular Solution sued Medtronic for patent infringement, a court concluded that the patent was in turn, the claims were internally inconsistent. One was for a catheter with the hole with the opening outside the rigid section. And then there was another independent claim for the opening being within the rigid section.

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The court said that there could not be two conflicting independent claims that you couldn't have one device that simultaneously infringes both of those claims. I think that's where he went off track, because it only had to infringe one of the claims. But anyway, the vascular solution appealed, and the Federal Circuit didn't even get to that part.

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It said each claim just merely has to inform the person of ordinary skill in the art that of the boundaries of the claim and what it protects and what it doesn't protect. And, it doesn't have to be numerical. You could say there's a rigid segment and you don't have to say that you don't require the dimensions as long as you say there's a rigid segment.

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And as far as the dimensions go, it doesn't matter that each independent claim had a different embodiment as long as each claim gave a very clear picture of what was protected and what was not protected, which was the case here. So that was remade. I think we've all done claims like that, especially when there's different embodiments in the app originally in the application.

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So, that's still the way it was. Next we have RCO imaging versus plan MCA, which affirmed the denial of a motion for judgment as a matter of law. Asco sued Mecca for infringement of its dental patterns. The asserted infringer had a problem with the, with osseous, expert because the person didn't become an expert until after the infringement occurred.

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And so they said, well, that's not right. He had to be an expert at the time of the infringement. And the Federal Circuit said, no, he doesn't. He or she does not have to do that. They could acquire the knowledge of a person of ordinary skill after the infringement or filing of the application, which whichever you choose and, it was undisputed that the expert was presently a person of ordinary skill, and that could be retroactive back to what a person of the ordinary skill would have recognized, at the time of the infringement or the application.

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And in this case, the expert also properly testified, and was very accurate in his testimony. So that was not a very helpful thing to raise on appeal in this particular case. Next, we have professor versus Weber, which partly reversed the denial of motion. Webber's motion for judgment as a matter of law, one of professor's patents addressed a device for slicing meat.

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And as it goes by on a conveyor belt, pressing it into packets. There were two ways to do this in the industry. The one that's at issue here was the advanced silk conveyor, and method to fill the pockets with me from a conveyor. So the jury found that while Weber had willfully infringed professors patents, on appeal, the federal Circuit said, it didn't agree with the district court or the jury.

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This was to infringe on Webber's device. Had to have an advance to fill the conveyor belt. But the Weber device, which was the accused infringing device, actually had one where it retracted to fill instead of advance to fill. So professor, it said, well, it could be easily configured to be advanced to fill. But to make a long story short, they didn't have any evidence that you could do that easily.

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According to expert testimony, there were several parts of the Weber, asserted device that were not missing, that a consumer would need to reconfigure the device. And, nobody had actually tried it. So this one, really this one went down the tubes, really, for lack of evidence that the asserted device could be reconfigured. But it's a good thing to remember that sometimes things that don't look like they're going to infringe, if they're easily reassembled to something that infringes on you're going to have you may have a problem.

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Next we have the last Jaffe versus the internal International Trade Commission. Last year I owned several patents in this country. Although its products were mostly manufactured overseas, it had a lot of facilities for marketing in this country with significant employment and investment in these facilities. And it's also a U.S. company. Last year, five filed a complaint under, at the U.

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Is that the ITC under section 1337 to prevent asserted infringing imports? The thing about section 1337, is that it comprises a domestic industry requirement as a precondition for getting any kind of remedy at the ITC. Under perspective, specific section of 1337. There must be significant capital and labor invested in the United States related to the products.

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So the ITC concluded that there was no standing because nothing was manufactured in the United States in the Federal Circuit said, no, no, no, that's that's too narrow an interpretation. The section reads in relevant part, significant employment of labor capital. So there's no statutory requirement that the patented product be manufactured in the United States. So warehousing, distribution quality controls and sales meet the statutory requirement at which were present in this case.

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So, that's a good thing if you do a lot of work before the ITC. Presumably it goes a little faster than proceedings in the courts. You don't get any money. The problem is you don't get any money. You get orders keeping things out of the country that infringe. But if you have something going on in this country that uses a lot of capital and labor, then you will have standing

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Next, we have fuel automation versus Energizer, which the district court.

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Fuel automation and Energizer. Our competitors in the automated fuel delivery equipment industry, Energizer holds patents for fracking equipment and sued Fuel Automation for infringement of these. Of two of these patterns.

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So these products that were sold were the subject of the patent infringement settlement agreement. So enter Jira.

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Who had promised not to sue fuel automation sued its affiliates and the other third parties for patent infringement because their position was. We had an agreement not to sue each other. We don't have an agreement not to sue. Third parties. So that's why we're doing this.

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Fuel Automation then sued Inter Jira for breach of the covenant, not to sue, and for a declaratory judgment that the covenant not to sue included immunity for downstream. Third parties. While predictably, energy are contended that mutual covenants did not include third parties and the settlement.

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Agreement was totally silent on this. Although there was an exhibit C, which was a press release stating that there they were each free to sell and lease the equipment, which was the.

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Subject of the settlement. The jury found that energy was a breach, the covenant, not to sue. There was a final judgment on that. And energy appealed. So they were with him.

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Of these cases, there's several.

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Zero in on the 1 or 2 that I think are most interesting and,

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Noteworthy. This one was for downstream users and.

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The patent exhaustion.

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Document doctrine. So the Federal Circuit agreed.

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Covenant ad to sue unambiguously protects energy and fuel automation for suing each other, but it's just doesn't.

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Say anything about.

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Liability for downstream third parties.

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So they looked at something called the patent exhaustion doctrine. And under that doctrine, if you sell, for example, one tangible piece of equipment to somebody in that one piece of tangible equipment, there's no where you can't infringe the sale of that equipment, because the patent rights in that one tangible item have been exhausted. They don't exist anymore.

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That's why we can buy and sell things and not have to worry hopefully about it.

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Patent.

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Infringement for buying and selling that.

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Particular item. So under the patent exhaustion doctrine, the rights of downstream third parties are going to be preserved.

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If they're not specifically disclaimed in the settlement, since they weren't, the patent exhaustion doctrine steps in and fills the void. And so it was perfectly okay for these third parties to purchase and use these, assertively infringing products because there's nothing to stop them in the patent exhaustion doctrine.

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There's no rights that have been transferred to them or infringed by that.

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So I feel like.

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I believe this is a very interesting case.

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Because, having practiced for a while, I find it very analogous to other statutes where if you don't put something in the contract, where it's appropriate to do so and, you where you can override what the law would be that the default law would be otherwise, if you don't add it yourself, the law will add it for you.

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And it may not be something that you want. And in that respect, it's like a lot of other statutes that aren't actually patent statutes. For example, in Illinois, which is where I practice, this happens with the intestacy intestate statute. If you don't leave, the intestate statute will tell, and will dictate where your assets go. They may go to someone you don't like very much, but if you don't have a will, explicitly give it away and say that you don't want it to go to a particular person.

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Which is always the best thing to do.

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Then you're going to have a problem. Another good example of that in Illinois is the partnership statute, because a lot of people, in my experience, have come to my office and they say they're partners. They don't have a partnership agreement. If they continue down that road and something goes wrong, then the Illinois partnership statute is going to tell them what they have to do to dissolve the business.

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And it's always kind of a nasty surprise. They don't think they can, a lot of people are under the impression you can just walk away. But unfortunately, that's not the case. And it gets.

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Very complicated very quickly. So the next case has a very long name. I don't even know what that language is. Maybe it's German. So I'm just going to.

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Call it.

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Ericsson versus Lenovo. And this vacated and remanded the denial of a motion for an anti suit injunction.

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An anti-suit injunction would stop proceedings. Injunction proceedings in other countries, with a court order. Obviously it would be difficult to do that if it's another country, but at least they wouldn't be able to do it in this country if you get one.

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So, both Ericsson and Lenovo owned.

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Standard essential patents, which are those kinds of patents are involved and, and, all kinds of standards for technology and industry. So they belong to a group in Europe where you sign up to license cross license standard essential patents on the condition that you negotiate them, especially the rates in good faith. And that's called a friend commitment free and.

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So Lenovo and Ericsson were.

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Negotiating and it wasn't going.

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Anywhere. So, Lenovo sued Ericsson in several jurisdictions, including the United States. And in turn, Ericsson obtained injunctions against Lenovo in Colombia and Brazil. In the unite.

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Meanwhile, back in the.

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In the United States, Lenovo sought a judicial declaration that Ericsson breached the Frand contract. Terms and conditions for negotiation of one of these, patent licenses, and Lenovo also moved for an anti suit injunction in the United States. The District court denied Lenovo's motion.

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Because it believed that an anti-suit in junction would not resolve the litigation, and he thought, resolving the litigation meant that it would have to result in creating a cross licensing agreement to, cross license.

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And that would not inevitably result.

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If you just had this injunction.

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Issue. So Lenovo appealed in the Federal Circuit, and agreed with Lenovo that the.

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League, the district court aired because despite being dispositive it didn't have to result and cross like global cross licensing to be effective. Also the anti suit injunction had to resolve whether the injunctions were obtained improperly because there was no negotiation in good faith. And that's considerably narrower than, expecting that motion to result in a cross licensing agreement, final cross licensing agreement.

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So it was remanded to the district court in this country, to determine.

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Whether any of these injunctions were legally valid. And that meant that they had to look at evidence of whether the parties had negotiated in good faith for, for a standard, essential licensing.

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Of their patents.

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That one was kind of hard to follow. The facts were kind of convoluted, but really.

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At the end of the day, it's just a contract issue and had nothing to do with infringement at that point.

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In the proceedings. Next we have Link Laboratories versus Samsung Electronics. Samsung filed an IPR contending that Link's patent was obvious, and in.

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Doing so.

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It relied upon.

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A US published patent application.

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That apparently never became a patent. Link contended that the publisher.

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Pat application.

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Did not qualify as prior art because it.

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Was not publicly.

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Accessible prior to the effective filing date of its own.

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Patent application, which became the asserted patent.

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However, the board decided that the published patent application was prior art.

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Actually, on appeal, the issue was very straightforward and expressly answered in the patent.

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And that was the filing.

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Date or publication date of the published application.

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The application determined prior art status, and the Federal Circuit very politely said, the published patent application.

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Qualifies.

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As a print, as printed publication, as a printed publication, and thereby is a qualified reference.

00:44:11:13 - 00:44:12:13

For IPR.

00:44:12:13 - 00:44:16:02

Proceedings. Section 102.

00:44:18:07 - 00:44:29:22

Is directed exclusively to published patent applications. Is prior art, and expressly states that published applications comprise.

00:44:29:22 - 00:44:55:06

Prior art as of their filing date, which is counter intuitive because presumably no one's going to know its there, or as of its filing date, because it doesn't become public for at least 18 months thereafter. But that's what's in the statute. It appears somebody overlooked that.

00:44:55:09 - 00:45:21:05

Because that's very straightforward. Next we have the U.S synthetic Corporation versus again, the International Trade Commission. U.S synthetic patent is directed to a diamond particulates solid, with a metal substrate and which is tungsten carbide.

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Very elaborate, technical, tangible.

00:45:23:26 - 00:45:37:27

Description of what this material is. It describes its diamond composition in terms of quantified materials, physical parameters, and diamond grain size.

00:45:37:27 - 00:45:57:05

Quantified magnetic properties. If you work in this, if you're a patent attorney in this kind of industry, you probably be impressed by all kinds of different parameters for these tangible materials in the patent disclosed.

00:45:57:05 - 00:46:01:10

In the patent. But the ITC administration.

00:46:01:10 - 00:46:02:17

Law judge.

00:46:02:19 - 00:46:09:24

Didn't think so and said that the claims were directed to an abstract.

00:46:09:24 - 00:46:10:26

Idea with no.

00:46:10:26 - 00:46:35:05

Inventive concept. And the commissioners agreed. So there was an appeal. And the Federal Circuit said the claims are directed to specific, tangible constituent elements, quantified dimensions of these tangible elements, their material properties, which are.

00:46:35:06 - 00:46:36:10

Also correlates.

00:46:36:10 - 00:46:41:24

To the diamond composition structure, terms such as mean free.

00:46:41:24 - 00:46:43:24

Paths, which are used.

00:46:43:26 - 00:46:52:27

In this particular industry specific diamond grades. Their bonding magnetic properties.

00:46:53:00 - 00:47:01:10

And their specific working examples. This was clearly patent eligible. And so the.

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ITC, was reversed.

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Next we have re Santa Analytics versus Fox Corporation which affirmed the dismissal of a case again based on patent ineligibility. Receipt of own two sets of patents. One well addressed a machine learning model trained with historic data and which generates an optimized output schedule with any emphasis on any suitable machine learning technique. And the network map patents, which also uses training data with any machine learning model to generate organized network maps.

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Training data originated from live events, which were then implemented with any suitable machine learning technique. And generic computer equipment. The district court granted the motion to dismiss under Alice. Step one. The federal circuit agreed. Well, it made this a noteworthy case. It was a case of first impression with artificial intelligence that the Federal Circuit had before it.

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This was the first case regarding machine learning under Alice. Step one. All the asserted patents rely on machine learning. But since it was any machine learning and any computer, everything, was this described generically? They don't claim a specific technical method for improving the algorithm or machine learning process. The only change is that machine learning was used in a new environment.

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But this in and of itself is insufficient to make the AI, or the machine learning process, eligible. And because this claims subject matter, collects information more rapidly than humans. That's an old sore. That's always been patent ineligible going back many years prior to Alice. So that's what happens if you're writing AI patent applications, among all the other things you have to keep in mind when doing that?

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You're going to really have to get into the weeds to show that there's some kind of technical improvement. If there is one. Next we have Ray Floyd, which is back to our garden variety inventions. No glamorous AI, but even though this is a non precedential case, I find in my professional opinion, it really, has a very good

analysis of how to analyze some of these 112, detailed descriptions that are necessary.

00:50:45:01 - 00:51:47:09

It might be considered a quote unquote, in the Floyd case that may be considered a quote unquote simple device, but, to me, that always makes me reach for my wallet, because the simple ones are often the most challenging to adequately describe and claim. In this case, Miss Floyd originally submitted a U.S. utility patent for an application for a, blanket with cooling compartments, and it disclosed to embodiments with different sized compartments and different numbers of compartments and the blankets and the text of the application made it very clear that you could have different numbers of compartments, different sizes.

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It was worded very broadly to catch everything that was a cooling blanket with those kinds of compartments in it. After she filed that, it was published 18 months later. She subsequently, submitted an application for a design patent where she had the design of a cooling blanket, which had a different number and size of compartments, and she claimed the priority date of the blankets in her utility application.

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So big trouble is coming. The examiner found that the design patent, not only wasn't entitled, was not entitled to the priority date because a blanket with the exact number of compartments and size was not disclosed in the utility application. So there was no written descriptions, support for the design application, but there was enough in the utility application to anticipate her design application.

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So she, that's why it was rejected. So she appealed. And the Federal Circuit agreed with the examiners and the board, which had affirmed, the rejection of the design application. And it went through very and it went through all of her reasons that she possessed knowledge of that exact number of compartments and size of compartments in her original utility application.

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She had a lot of issues and she raised a lot of issues about that. Well, the court said, first of all, the specification specifically says the compartments could be any size. So that's an infinite number of compartment differences right there. The sections could vary in size rather than requiring additional compartments. Even with this quote unquote simple technology you had to have in the utility application a blanket with the same number of compartments and the same size of compartment, which to match the design in the subsequent application.

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She also asserted that the two embodiments were the endpoints of a range of blankets, cooling blankets, and hers was in the range. The one in the design patent was in the range. And they said, first of all, those two that you illustrated in your utility patent are not endpoints of range because they each have different parameters moving, changing the size of the compartments and the number of them.

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So it's not just two end points where you just changed one parameter. There was, two parameters involved. And even if they were endpoints, there's so many possible variations in embodiments between those two endpoints that no one would be convinced that you were aware or had possession of this specific one in your design application. As to inherent see which, Miss Floyd also raised a person of ordinary skill would not necessarily recognize that she possessed the necessary, specific later claim design at the time she submitted the utility application.

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In other words, her utility application did not necessarily result in the disclosure of the specific, cooling blanket blanket design in her design application, and there was no evidence that the number of blanket compartments was functional because the specification stated that the blanket could be any size. So again, yeah, it looks simple, but lots of detailed analysis.

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So when an inventor comes to my office, six times out of ten they're going to say, oh well this is really simple. And then I get a little nervous because again, those could be very, very, difficult cases. So what to take away is that the predictability of the technology does not necessarily mean a specific design is predictable.

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And where the subsequent design may be straightforward, too ornate. Next we have the Zen core. Where? Which firm? The board and a special commission from the board, to reject a claim. A claim, a Jepsen claim, because the preamble didn't have a specific sufficient written description which may surprise people who aren't aware of this case.

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So this is a good one to keep. Also, keep in mind, in relevant part, the application comprised a Jepsen claim directed to a method for treating a patient by dosing with a specific antibody. The examiner or the board and the board's commissioners, rejected the claim because the preamble didn't have specific, written support under section 112.

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Specifically, what it didn't have was, with the Jepsen claim the body of the claim is supposed to be an improvement over what is well known, which you put in the prelim preamble. But there was nothing in the specification to demonstrate that what was in the preamble was well known at the time of the application submission.

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So the Federal Circuit agreed. It said that the inventor must provide sufficient written description to show possession of both the claimed improvement and the prior to which the claimed improvement applies, and which it's compared to the claim. Preamble. Not forgetting that the preamble and the body of the claim, both integral components of the same sentence. So you have to establish that the subject matter implicitly inserted to be well known in the preamble is adequately described in the specification.

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The disclosure did not show possession of the claimed improvement to what was known in the prior art. This was especially problematic here, where if you think back to the Amgen, Supreme Court case, we're talking about a large genus of antibodies, which included this particular antibody. That was the improvement in treating patients. And there was no evidence that out of this huge genus, this particular species was well known.

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So without that evidence, the whole claim was invalid because, there was no way to show that what was in the preamble, was the way that people did things commonly, prior to the improvement. So that's also a good thing to keep in mind, especially if you're in the pharmaceutical industry and you have that analogous problem to the one that was in the Amgen case two years ago.

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Next we have Ingenico versus I o engine, which affirmed the denial of a motion for Judge judgment as a matter of law. Iowa engines asserted patents addresses a device, such as a thumb drive with a processor that implements communications with the network server. That's really all you have to know for this, I do engine sued PayPal for a patent infringement, because Ingenico supplied the products to people.

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Prior to trial, Ingenico initiated an IPR where the pat. The board found that most Iowa engines asserted claims on patentability based upon specific patents and printed publications there. After a trial, Ingenico trotted out the same published applications and prior patents as used that were used as evidence in the IPR.

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But they were used for a different purpose. They were used as evidence of sales, public use by third parties, and as well as knowledge of others. Prior to the invention date, which they could not raise at the IPR because by statute you're not allowed to, the jury found the claims infringed invalid but invalid as anticipated or obvious.

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My engine moved for a judgment as a matter of law, which was denied. So I went to appeal their main one of the issues on appeal was that the sued infringer was stopped from using the same documents and evidence at trial that were used at the IPR and the Federal Circuit disagreed, and again referred to the statutory language.

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The scope of an IPR, by statute, is limited to any ground that could be raised under sections 2 or 3, 1 or 2 or 1 or 3. That is, any legal theory. So for an IPR. But the problem with an IPR is you're limited. You're the kind of evidence you can use to show obviousness or anticipation is limited to printed publications, including patents.

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So the key word here is grounds. Grounds are issues that could have raised or reasonably been raised during the IPR. So the estoppel provision in the statute does not prohibit using the same evidence. It and the new grounds that were raised were not prior use by others on sale by others which cannot be raised in an IPR proceeding.

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So it was perfectly proper for them to raise those at trial. And it was their decision. What kind of evidence to use, because the evidence is not grounds. They wanted to use the same evidence to confirm different theories of liability. They could do that because they couldn't raise those legal theories in the IP during the IPR.

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And that's pretty much what that case says, which means you should not confuse evidence with a legal theory, because you can use the evidence again. But, you can't raise the legal theories unless they weren't used. They weren't allowed in an IPR.

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Next, for those of you who have been following this litigation for years and years and years, we have the University of California versus the Broad Institute. This is the Crispr Cas9 litigation started several years ago, where the University of California and the Broad Institute, which is actually a joint venture between Em and I am it and Harvard, each concluded that they were the first to invent this particular RNA, Crispr RNA molecule.

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That's much better at manipulating, manipulating, molecules, biomolecules. And therefore it is that immense importance in commercial value in medical technologies, you see and broad both asserted inventor first inventor ship. The

signature feature of this particular Crispr molecule was that it would operate successfully in eukaryotic cells, eukaryotic cells being, primarily animal cells and would include, human cells as well.

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And that's pretty much all you need to know for this legal analysis under the CAA law, which is what this began under. First, Envi inventor is entitled to the patent for the invention that for more recent, patent attorneys not first to file it was actually, first to invent. And that was just a whole, a whole procedure, for determining who was first to invent.

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And so this went through all those, permutations who, they started out with the board, finding, determining who was what is known as the senior user. And then it went back up to the Federal Circuit, and then it came down again to determine who was the first to invent. So before, the Federal Circuit, this Federal Circuit decision in your, in your notes went back to the board, and the board decided that fraud was first to invent.

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So then it went back up to the Federal Circuit. We waited around a few years, and then that decision, the most recent decision came down, two months ago, in May. And it turned it vacated what the board said was the right date of conception, because being an inventor or inventing first. Really? That's the same, pretty much the same criteria.

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You need conception, which is having a really, really detailed idea of what the invention should be. And then we do something called reducing it to practice, which could either be, legally compliant application or an actual embodiment of the invention. And you have to reduce it to practice in a reasonable period of time after you have the idea, your conception date is going to be influenced by how much you had to change.

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What was in your head to be able to file the application or make the tangible embodiment? In this case, it was the tangible embodiment. So it said that the board had aired as a matter of law in its criteria for considering the conception

component. It said that the board should not have relied on statements that the University of California scientists had made in the records about, every time they, many times when they finish, round of experiments, they'd say, well, gee, I'm not sure that's going to work.

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I'm not sure that that one worked or just kind of had notes of uncertainty, undertones of uncertainty and what they were doing. So they should have looked at where you see modified its experiments prior to abstaining. Successful results in Fred in Fish prior to Broad's asserted conception day because it was the decision that goes into great detail with the course, the email correspondence between the people in California and their colleagues in France.

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Whether any of these experiments were working, specifically, there was some with fish embryos where they claimed that some of the embryos turned into chimeras the way they were supposed to, which means they were kind of funny looking, funny looking baby fish. And the Federal Circuit said this was not the correct criteria for whether they conceived the molecules ahead of broad and they're reiterated.

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Conception is a complete mental picture of the invention without undue experimentation to alter the final subject matter with experimental methods of biotechnology. The average biotechnology scientist in this, in this case, and that's all they were really looking at, conception as far as the priority of the inventorship, conception is complete only when the fate of the idea is so clearly defined that someone of ordinary skill could do it without extensive research.

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So the board aired, they only looked at statements of uncertainty. They should have looked at whether C's conception was in sufficiently final form that only the exercise of ordinary skill was necessary to reduce their idea of how to make this molecule without extensive research or experimentation. And since the board did not consider routine methods or scale, it has to be remanded to the board to redo the conception analysis.

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At the very least. They also said that, for conception, the inventor need not know that his invention will be operable for its intended or intentional purpose. And the board should look at evidence of third parties who also claim to have produced this molecule, around the same time and see whether they used routine methods. You may be thinking, well, it hasn't been first to invent the law, hasn't been first to invent for quite a while.

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So why would we even follow this case? Well, it is a pretty interesting case especially for people in the biotech industry, but I think it still has a lot of significance because you still have inventorship disputes. You have to decide who the inventors are because it could be, the patent could be invalid if you don't have the right inventors.

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So it's really good to stay updated on how you determine inventorship status. Even if you don't need a priority date.

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So now we've gone through our patent section. We're going to start with US copyright. Our first case is a little bit of a holdover from, our last trip to the federal appellate courts in *Green v. DOJ*, which affirmed the dismissal of a facial challenge to the digital millennium Copyright Act, section 1201A so that section of the EC makes it unlawful to circumvent, quote unquote, digital locks online that are there to protect, copyrighted protected works, generally with, encryption and, and or passwords.

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And it also prohibits the creation of any device to circumvent the encryption and passwords. So one of them's method and the other one's known in the case is trafficking, which is the digital they call the digital keys to circumvent the encryptions, which have, these particular devices or code or passwords, have no, no have no substantial, not infringing uses.

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That's part of the statute as well. However, section 1201C does preserve the, affirmatively preserves the affirmative defense of fair use. And therein lay Doctor Green's manner of raising this issue. They originally Mister Doctor Green and

another individual originally asserted at 12 01A is unconstitutional as applied to them because it violates the First Amendment.

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They subsequently change this to, 12 01A is facially overbroad and a priori spidering and speech. And this was, based on their assertion that the, asserted right to access digital works for was for fair use and violation, and so prohibiting it was a violation of the First Amendment, as well as the Library of Congress regulation, which, selects exemptions for that section and has the statutory authority, to make exemptions for folks who, actually do use these kinds of, digital keys.

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The district court dismissed the First Amendment claims. Doctor Green appealed. The appellate court agreed with the district court. Section 12 01A is not facially overbroad. Its first and foremost reason was that it's content neutral and regulates not only that, it regulates conduct. In that speech. It does base its prohibition, does not, does not breach bases.

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Prohibition, upon speech content. It's content neutral. And the Library of Congress says adoption of the exemption is not a prior restraint, because it's authorized by statute that isn't a prior restraint. And if they have, still concerned about the statutory provision as applied to them, they can raise it as an improper or proper exemption, for the Library of Congress to decide.

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And as a matter of track fixing, creation of circumvention tools is not inherently expressive. Therefore, the anti-trafficking or that is making these devices, is not in the scope of the First Amendment. And on another note, the court observed that fair use is not a means to indiscriminately access every single item of registered, copyrighted work, because the First Amendment does not guarantee that you're going to be able to access every single item that a private person has encrypted.

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And there are alternate procedures for obtaining works for fair use. And that's how you do that. Fair use is not a blank check. That's really what they wanted to

say. Next is Hatchet Book Group versus Internet Archive, which affirmed summary judgment, finding no fair use. The not for profit Internet Archive took entire tangible books from hatchet and its other publishers, scanned them and put them online for people to use without paying a fee.

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So hatchet sued for copyright infringement. The district court said there was no fair use. An Internet Archive appealed. So there were more than one issue in this case, the one that came up in the way. Andy, for the Warhol Supreme Court decision, was the trans transformative use here. Transformative use was also key, as well as the fact that, hatchet was undermining.

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I'm sorry. Internet archives were undermining the market for hatchets, public hate, for profit books. Getting back to the transformative factor archives, lending of hatchets, entire books in digital format and in a digital manner undercuts the market. Published original e-book market publishers. Transformative use is for criticism, commentary, additional information alteration of the original with new expression or meaning or message, and must comprise more than reformatting.

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So this is where internet archives fell down on the job because all they did was scan something. They didn't add anything. They didn't do anything else with the work. So it became very straightforward since they just reformatted it. It wasn't trans, it wasn't fair use. It wasn't transformed. It was a derivative work, and it was by copyright attorneys.

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No, only the copyright owners are allowed by law to create reformatted works as derivative works. But, my observation, my professional observation is, because the Supreme Court went into analysis of the Andy Warhol paintings compared to photographers' photographs, and they looked almost identical. Then people keep trying to which, of course, the Supreme Court said there was no transformative use.

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But you still get folks trying to push the envelope, especially when it comes to transformative use. So that's what we had there. Next, we have UMG recordings

versus Grand de communications, which affirmed the judgment, finding grounds liable for copyright infringement. Grand A is an internet platform where subscribers share files the concert Grand A hired, a consulting company to identify infringing subscribers.

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But to do its job correctly scope the consulting company once they got the fictitious names of the people online, of the people who were repeat infringers, they couldn't go any further because Grand wouldn't give the actual names and contact information. And this just went on for a really long time. They didn't terminate any of the accounts of any of the repeat infringers, and they could have easily taken care of this, because if a subscriber defaulted on their payments, they and they immediately terminated those accounts.

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So I guess what you could say is they could do it if they felt like it. Financially, I guess, the jury concluded that Grand was, willfully, copyright infringing. There was a final judgment on that, and Grand appealed. The appellate court was not impressed by Grand Day's behavior and said their conduct comprised more than a mere failure to prevent infringement, it affirming a grand a affirmatively and deliberately continued providing services to known infringers rather than just getting rid of them from the site and where this this remedy was identical to what they do for people who didn't pay their subscription fee.

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So clearly financially motivated, not a surprise. Okay, next we have tangled versus Aritzia, which reversed the district court's dismissal of a copyright claim at the pleading stage. So, tangle owns registrations, fur sculptures made out of components that can be reconfigured, in this case, two different three dimensional poses. And apparently, Aritzia thought these were really cool and copied them and put them in their store windows without asking for permission.

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Of course.

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The district court concluded that there was no viable claim because since the sculptures could be manipulated into different three dimensional configurations,

even though they were tangible, they were not fixed in a tangible medium, and therefore they weren't protected by copyright. So Tangle appealed, and the appellate court said nobody's no one in the federal courts, and certainly not the appellate courts have ever held that expression involving motion is copyright ineligible merely because the expression is not fixed in it.

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That's not how we've interpreted, fixed in a tangible medium here. The sculptures clearly are copyright eligible because they are material, tangible objects. So they qualify as copies under section 101 of the copyright statute. These copies can be perceived and reproduced for more than a transitory period. And even more than that, there's so many other kinds of works that are copyright eligible.

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They're people aware the parts are moving. You can think of choreography, symphonies and motion pictures, which are moving in two dimensions, but it's the same point. They are fixed in a tangible medium, even though they change dimensions within the tangible medium or within the chance for medium, such as a dancer's tangible moving arms and legs.

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Yeah, it looks like someone had to clarify what fixed in a tangible medium means. But again, there's so many categories of copyright eligible work where everything's moving. It seems like that would just be very analogous. Next, we have Capital Records versus Vimeo, which affirms summary judgment for video under the Digital Millennium Copyright Act, safe harbor provision.

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Vevo is a service provider with a website which uploads videos from third party users. I mean, there's a lot of that. The act provides safe harbors for internet service providers who do not have actual knowledge of infringement on their sites and do not financially benefit from the infringing activity, even if they have oversight and control. Nevertheless, Capital Records and other copyright owners sued Vimeo for infringement because a great many of the uploaded videos from third parties included music, which was pirated and they didn't have the consent of the copyright owner to use this music.

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Capital Records asserted that Vevo had actual knowledge of specific acts of infringement and failed to quickly remove the infringing videos, and that it benefited financially. In summary judgment, the district court concluded that Vimeo qualified for the safe harbor, so capital records appealed and the appellate court agreed with what Vimeo said via Vimeo. Employees that are the gatekeepers for uploading these videos were not hired because they had knowledge of U.S. copyright law.

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They didn't know as they were going through this, these huge piles, for want of a better word, piles of uploaded videos where which ones were infringing. They had no way to know that. And again, even if there weren't as many as there were, they still didn't have the knowledge. And then there was just so many of them you couldn't spend too much time on most of them.

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And the ratio of videos that were actually reviewed compared to the number they were receiving and posting was, was very, very small. So there was no in-depth review of the vast majority of them. And as far as fair use, the employees certainly didn't. They wouldn't recognize it. And if they thought there was a fair use limit, issue with the particular video, under the most ideal of circumstances, they would have no idea whether that was fair use.

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I mean, lawyers argue about what's fair use. So what would one of these, presumably, entry level, people know about it? It's just not plausible or workable. So the appellate court reversed that one.

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Next, we have Thaler versus Perlmutter. Patent attorneys in the audience. Probably aware that Doctor Thaler attempted to submit a patent application with his AI system. Is the sole inventor. And, that was, he was told that that wasn't going to go anywhere. You needed a human. So he also filed a copyright application where he listed his AI system, is the sole author, and he got the same result.

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His petition for rehearing was denied. He's a computer scientist working with AI, and he submitted this copyright registration for visual art. And the only author was his AI, and they rejected the application. And the administrative appeal officers affirmed the examiner's rejection, and the district court affirmed the rejection. So Doctor Thaler appealed, and the appellate court affirmed the rejection, by saying the U.S. copyright statute requires all registered works to be authored by human beings.

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And you can look at all kinds of sections from the statute that confirm this, such as, you know, they presume that great owners own property such as copyright, copyright duration depends, in many cases on the author's life span. There is an inheritance provision. There is a provision for surviving spouses and heirs domiciles, whether the coauthors have the intention to work together and.

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I think that's a good sample from your notes. So far I cannot be an inventor or an author. That doesn't mean you can't patent them or use them for an invention or not. A work under copyright law. It just means you can't list them as an author or an inventor. Next we have woodland versus Hill, which affirmed dismissal.

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Mr. Wood, one's copyright infringement complaint. Complaint? So what we have going on here are two young bodybuilders who are posting images of themselves in their respective Instagram accounts. Mr. Woodland. Sorry. Yeah. Mr. Woodland alleged that Mr. Hill infringed copyright in his photos by publicly posting his own photos in his own Instagram account that looked like his.

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And in pleading this, infringement. Mr. Woodland asserted that Mr. Hill had access to his images because they each posted on Instagram and not only was there access, but there was substantial similarity evidencing unlawful copying. The district court dismissed the complaint, saying that Mr. Woodland didn't plausibly allege either access or substantial similarity. The appellate court agreed with the district court on the, first on the access required.

01:36:43:11 - 01:37:33:04

I'm sorry, the access requirement for copyright infringement. And the court said just because they both have Instagram accounts doesn't mean that Mr. Woodland and Mr. Hill were looking at each other's photos. There's nothing in either account. There's no likes, there's no follows. There's no, none of indications of any kind of interaction, between the two Instagram accounts, for example, Mr. Woodland did not plausibly allege that Mr. Hill followed, liked or otherwise interacted with Mr. Woodland's posts.

01:37:33:06 - 01:38:11:00

As to the substantial similarity. As to the substantial similarity, they were both the same age, the same height. They were both, they were both young Afro-American bodybuilders. They were bound to use the same poses as the other, because there's really a limited number of poses that you would post publicly. And so it's really, we really can't rely on substantial similarity.

01:38:11:00 - 01:38:17:15

So that's why his case was dismissed.

01:38:17:18 - 01:38:24:28

So that concludes the end of this presentation on recent updates. Thank you very much for your attendance.

Resources

Resources Specific to this Course

In addition, please see the resources cited within the material.

Resources for the Legal Professional

ABA Center for Professional Responsibility - www.abanet.org/cpr

Chicago Bar Association - www.chicagobar.org

Commission on Professionalism - www.2civility.org

Judicial Inquiry Board - <http://www.illinois.gov/jib>

Illinois Board of Admissions to the Bar - www.ilbaradmissions.org

Illinois Department of Financial and Professional Regulation - www.idfpr.com/default.asp

Illinois Lawyers' Assistance Program, Inc - www.illinoislap.org

Illinois State Bar Association - www.isba.org

Illinois Supreme Court - www.state.il.us/court

Lawyers Trust Fund of Illinois - www.ltf.org

MCLE Program - www.mcleboard.org