

RECENT DEVELOPMENTS IN PATENT LAW (Fall 2024)

UPDATED THROUGH 9/29/2024

Mark Lemley,¹ Aidan Faustina² & Jack Gleiberman³

PATENTABLE SUBJECT MATTER	5
Software and Business Method Cases	5
<i>Unpatentable</i>	5
International Business Machines Corporation v. Zillow Group, Inc., 2024 WL 89642 (Fed. Cir. Jan. 9, 2024)	5
AI Visualize, Inc. v. Nuance Communications, Inc., 97 F.4th 1371 (Fed. Cir. Apr. 4, 2024)	5
Beteiro, LLC v. Draftkings Inc., 104 F.4th 1350 (Fed. Cir. June 21, 2024).....	6
<i>Patentable</i>	7
Contour IP Holding LLC v. GoPro, Inc., 113 F.4th 1373 (Fed. Cir. Sept. 9, 2024)	7
IOENGINE, LLC v. Ingenico Inc., 100 F.4th 1395 (Fed. Cir. May 3, 2024)	7
Astellas Pharma, Inc. v. Sandoz Inc., 2024 WL 4219374 (Fed. Cir. Sept. 18, 2024) ..	8
DISCLOSURE	9
Definiteness.....	9
Maxell, Ltd. v. Amperex Technology Limited, 94 F.4th 1369 (Fed. Cir. Mar. 6, 2024)	9
Janssen Pharmaceuticals, Inc. v. Teva Pharmaceuticals USA, Inc., 97 F.4th 915 (Fed. Cir. Apr. 1, 2024).....	9
Vascular Solutions LLC v. Medtronic, Inc., 2024 WL 4195130 (Fed. Cir. Sept. 16, 2024)	10
Written Description	11
Rai Strategic Holdings, Inc. v. Philip Morris Products S.A., 92 F.4th 1085 (Fed. Cir. Feb. 9, 2024)	11
NOVELTY.....	12
<i>Celanese International Corp. v. International Trade Commission</i> , 111 F.4th 1338 (Fed. Cir. Aug. 12, 2024)	12

¹ William H. Neukom Professor, Stanford Law School; of counsel, Lex Lumina PLLC.

² J.D. 2024, Stanford Law School. Aidan Faustina contributed to this paper through May 2024 only.

³ J.D. expected 2026, Stanford Law School.

Sanho Corp. v. Kaijet Technology International Ltd., Inc., 108 F.4th 1376 (Fed. Cir. July 31, 2024).....	12
OBVIOUSNESS.....	14
Virtek Vision International ULC v. Assembly Guidance Systems, Inc., 97 F.4th 882 (Fed. Cir. Mar. 27, 2024)	14
Inline Plastics Corp. v. Lacerta Group, LLC, 97 F.4th 889 (Fed. Cir. Mar 27, 2024) 14	
Janssen Pharmaceuticals, Inc. v. Teva Pharmaceuticals USA, Inc., 97 F.4th 915 (Fed. Cir. Apr. 1, 2024).....	15
Salix Pharmaceuticals, Ltd. v. Norwich Pharmaceuticals Inc., 98 F.4th 1056 (Fed. Cir. Apr. 11, 2024).....	16
Allergan USA, Inc. v. MSN Laboratories Private Ltd., 111 F.4th 1358 (Fed. Cir. Aug. 13, 2024)	17
CLAIM CONSTRUCTION.....	17
Janssen Pharmaceuticals, Inc. v. Teva Pharmaceuticals USA, Inc., 97 F.4th 915 (Fed. Cir. Apr. 1, 2024).....	17
Actelion Pharmaceuticals LTD v. Mylan Pharmaceuticals Inc., 85 F.4th 1167 (Fed. Cir. Nov. 6, 2023)	19
Google LLC v. EcoFactor, Inc., 92 F.4th 1049 (Fed. Cir. Feb. 7, 2024).....	19
Chewy, Inc. v. International Business Machines Corporation, 94 F.4th 1354 (Fed. Cir. Mar. 5, 2024).....	20
<i>UTTO Inc. v. Metrotech Corp., No. 2023-1435, 2024 WL 4522564, at *7 (Fed. Cir. Oct. 18, 2024)</i>	20
INFRINGEMENT	22
Doctrine of Equivalent	22
<u>NexStep, Inc. v. Comcast Cable Commc'ns, LLC</u> , 2024 WL 4558613 (Fed. Cir. Oct. 24, 2024)	22
Inducement	23
H. Lundbeck A/S v. Lupin Ltd., 87 F.4th 1361 (Fed. Cir. Dec. 7, 2023).....	23
§271(e)(1)	24
Edwards Lifesciences Corporation v. Meril Life Sciences Pvt. Ltd., 96 F.4th 1347 (Fed. Cir. Mar. 25, 2024)	24
INTERNATIONAL TRADE COMMISSION	25

Zircon Corp. v. International Trade Commission, 101 F.4th 817 (Fed. Cir. May 8, 2024)	25
DEFENSES	27
License Defense	27
VLSI Technology LLC v. Intel Corporation, 87 F.4th 1332 (Fed. Cir. Dec. 4, 2023)27	
Inequitable Conduct and Unclean Hands.....	27
<i>Freshub, Inc. v. Amazon.com, Inc.</i>, 2024 WL 761779 (Fed. Cir. Feb. 24, 2024)	27
Luv n’ Care, Ltd. v. Laurain, 98 F.4th 1081 (Fed. Cir. Apr. 12, 2024).....	28
Staton Techiya v. Samsung, No. 21-cv-00413, Dkt. No. 933 (E.D. Tex. May 24, 2024)	29
REMEDIES	31
Damages	31
Brumfield, Trustee for Ascent Trust v. IBG LLC, 97 F.4th 854 (Fed. Cir. Mar. 27, 2024)	31
EcoFactor, Inc. v. Google LLC, 104 F.4th 243 (Fed. Cir. June 3, 2024)	32
Willfulness	34
PRACTICE AND PROCEDURE.....	36
Venue and Transfer	36
In re Samsung Electronics Co., Ltd., 2023 WL 8642711 (Fed. Cir. Dec 14, 2023)...	36
In re Honeywell International Inc., 2024 WL 302397 (Fed. Cir. Jan. 26, 2024).....	36
In re Datanet LLC, 2024 WL 4141612 (Fed. Cir. Sept. 11, 2024)	37
In re Apple Inc., 2024 WL 3886316 (Fed. Cir. Aug. 21, 2024)	38
Xockets v. Nvidia, No. 24-cv-453, Dkt. 61 (W.D. Tex. Sept. 17, 2024).....	38
Disclosure of Controlling Entities.....	39
Nimitz Technologies LLC v. CNET Media, Inc., 2023 WL 8187441 (D. Del., Nov. 27, 2023)	39
Backertop Licensing LLC v. Canary Connect, Inc., 107 F.4th 1335 (Fed. Cir. July 16, 2024)	40
Incorporation by Reference	41
Medtronic, Inc. v. Teleflex Life Sciences Limited, 86 F.4th 902 (Fed. Cir. Nov. 16, 2023)	41
Promptu Systems Corporation v. Comcast Corporation, 2024 WL 649221 (Fed. Cir. Feb. 16, 2024)	41

Attorney’s Fees	42
Realtime Adaptive Streaming v. Sling, 113 F.4th 1248 (Fed Cir. Aug. 23, 2024).....	42
Dragon Intellectual Property LLC v. DISH Network L.L.C., 101 F.4th 1366 (Fed. Cir. May 20, 2024).....	42
Personal Jurisdiction	43
SnapRays v. Lighting Defense Group, 100 F.4th 1371 (Fed. Cir. May 2, 2024)	43
Expert Qualifications	45
Osseo Imaging, LLC v. Planmeca UCA Inc., __ F.4th __, 2024 WL 4031140 (Fed. Cir. Sept. 4, 2024).....	45
ParkerVision, Inc. v. Qualcomm Inc., __ F.4th __, 2024 WL 4094640 (Fed. Cir. Sept. 6, 2024)	45
PTO AND PTAB PROCEDURE	47
Inter Partes Review Procedure	47
DK Crown Holdings, Inc. v. Diogenes Limited, IPR2023-00268, Paper 11, (PTAB Nov. 7, 2023) (Director Decision)	47
American Honda Motor Co., Inc. v. Neo Wireless LLC, IPR2023-00797, Paper 27, (PTAB March 22, 2024) (Director Decision)	47
Constitutionality and Jurisdiction	47
Allgenesis Biotherapeutics Inc. v. Cloudbreak Therapeutics, LLC, 85 F.4th 1377 (Fed. Cir. Nov. 7, 2023).....	47
Purdue Pharma L.P. v. Collegium Pharmaceutical, Inc., 86 F.4th 1338 (Fed. Cir. Nov. 21, 2023)	48
DESIGN PATENTS	50
<i>LKQ CORP. V. GM GLOB. TECH. OPERATIONS LLC, 102 F.4TH 1280 (FED. CIR. 2024) (EN BANC)</i>	50

PATENTABLE SUBJECT MATTER

Software and Business Method Cases

Unpatentable

***International Business Machines Corporation v. Zillow Group, Inc.*, 2024 WL 89642 (Fed. Cir. Jan. 9, 2024)**

In this appeal from the Western District of Washington, the Federal Circuit affirmed the district court’s finding that all the claims in two patents held by appellant IBM were subject matter ineligible.⁴ The first patent was directed to a “graphical user interface for a customer self-service system that performs resource search and selection” and the second to a method of “annotating resource results obtained in a customer self-service system”⁵ With regards to the first patent, the court found that its claims did nothing more than “[i]dentify[], analyz[e], and present[] certain data to a user,” which is not a computer-specific technical improvement.⁶ Therefore, it found that this claim was “directed to a patent-ineligible abstract idea” under *Alice* step one.⁷ The court also found that IBM failed to prove inventiveness under *Alice* step two, as it merely offered conclusory allegations of inventiveness that did not connect to specific portions of the patent.⁸

With regards to the second patent, the court found it was directed to the “abstract idea of displaying and organizing information” under *Alice* step one, as it addressed “improving a user's experience when viewing search results but [did] not contain any specific mechanism for doing so.”⁹ At *Alice* step two, IBM again failed to allege any inventive concept sufficient to make the claims patent-eligible, as the patent contained no “specific, discrete implementation of the abstract ideas” it was directed towards.¹⁰ Therefore, the district court’s finding that both patents were directed towards ineligible subject matter was upheld.¹¹

***AI Visualize, Inc. v. Nuance Communications, Inc.*, 97 F.4th 1371 (Fed. Cir. Apr. 4, 2024)**

In this appeal from the District of Delaware, the Federal Circuit affirmed a finding that four patents owned by plaintiff AI Visualize and directed to the advanced

⁴ *International Business Machines Corporation v. Zillow Group, Inc.*, 2024 WL 89642 (Fed. Cir. 2024).

⁵ *Id.* at *1.

⁶ *Id.* at *4.

⁷ *Id.*

⁸ *Id.*

⁹ *Id.* at *5.

¹⁰ *Id.*

¹¹ *Id.* at *6

visualization of medical scans via a web application were subject matter ineligible.¹² The court explained that, for computer-based technologies, the “claimed advances over the prior art” must be focused on “an improvement in computer technologies, rather than the mere use of computers” to avoid being categorized as directed to an abstract idea under *Alice* step one.¹³ It concluded that the claims at issue did not meet this test and were merely directed to the “abstract idea of data manipulation,” as they recited the idea of “creating” visualizations based on an existing dataset, rather than explaining how to create those views from a technological perspective.¹⁴

Having found the claims directed to an abstract idea under *Alice* step one, the court proceeded to analyze whether the claims recited something “significantly more” than that abstract idea to make them patent-eligible under *Alice* step two.¹⁵ In order for a claim to recite “significantly more” than an abstract idea, the nature of the claim must be “transformed” by elements or combinations thereof that go beyond “elements that are routine, conventional, or well-known” in the art.¹⁶ Here, however, the Federal Circuit found that AI Visualize made no arguments for inventive concepts in its claims that reached beyond the creation of “a virtual view,” which itself was the abstract idea addressed under step one and was a well-known concept in the art.¹⁷ Thus, the claims failed at both steps of the *Alice* test and were ultimately deemed patent ineligible.¹⁸

***Beteiro, LLC v. Draftkings Inc.*, 104 F.4th 1350 (Fed. Cir. June 21, 2024)**

In this appeal from the District of New Jersey, the Federal Circuit affirmed a finding that four patents owned by Beteiro were subject matter ineligible.¹⁹ The patents were all directed at facilitating live, remote gambling activity via communication devices based on a user’s GPS-determined location.²⁰ At *Alice* step one, the Federal Circuit held that the claims were directed to an abstract idea because they recited generic steps for retrieving information based on location,²¹ used “result-focused functional language” without specificity on how the invention achieved those results,²² and were rooted in a “fundamental and longstanding economic activity.”²³ In so holding, the Federal Circuit rejected Beteiro’s contention that the claims improved computer technologies; instead, the claims merely involved the use of computers as a tool, without any improvement in the computer-related technology itself.²⁴

¹² *AI Visualize, Inc. v. Nuance Communications, Inc.*, 97 F.4th 1371 (Fed. Cir. 2024).

¹³ *Id.* at 1378.

¹⁴ *Id.* at 1379.

¹⁵ *Id.*

¹⁶ *Id.*

¹⁷ *Id.* at 1380.

¹⁸ *Id.* at 1381.

¹⁹ *Beteiro, LLC v. Draftkings Inc.*, 104 F.4th 1350 (Fed. Cir. 2024).

²⁰ *Id.* at 1353-54.

²¹ *Id.* at 1355-56.

²² *Id.* at 1356.

²³ *Id.* at 1356-57.

²⁴ *Id.* at 1357.

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

Title search: RECENT DEVELOPMENTS IN PATENT LAW (Fall 2024)

Also available as part of the eCourse
[2024 Advanced Patent Law \(Austin\) eConference](#)

First appeared as part of the conference materials for the
29th Annual Advanced Patent Law Institute session
"Year in Review"