

IP LITIGATION NEWSLETTER

March 2024

Despite the PTAB's Statement That It Did Not Engage in Claim Construction, Its Claim Scope Assessment Qualified as Claim Construction



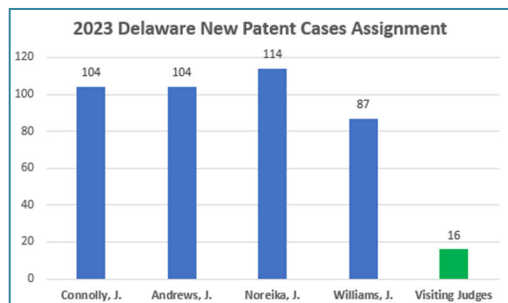
The Federal Circuit found that the PTAB's (Patent Trial and Appeal Board's) statement that it was not engaging in claim construction was "not dispositive as to whether claim construction occurred." *Google LLC v. EcoFactor, Inc.*, 92 F.4th 1049 (Fed. Cir. Feb. 7, 2024). "We have found implicit claim constructions even when the [PTAB] does not recognize that it is construing a claim." Because the PTAB's assessment established the scope of the limitation at issue, such assessment "qualified as claim construction." The Federal Circuit further found that the PTAB's claim construction was erroneous as it was improperly narrow.

Operating Manuals Created for Dissemination to the Interested Public Constitutes Printed Publications That Are Publicly Accessible Despite Confidentiality Restrictions

The Federal Circuit reversed the PTAB's finding that the operating manuals at issue were not sufficiently publicly accessible to constitute as printed publications under pre-AIA 35 U.S.C. § 102. *Weber, Inc. v. Provisur Techs., Inc.*, 92 F.4th 1059 (Fed. Cir. Feb. 8, 2024). The operating manuals were "created for dissemination to the interested public to provide instructions about how to assemble, use, clean, and maintain [the product]" The PTAB erroneously put "inordinate emphasis on alleged confidentiality restrictions," which stemmed from copyright and other intellectual property notices. These notices did not negate the fact that the operating manuals were provided when the products were purchased and shown at trade shows and showrooms.

Patent Litigation Trends

In 2023, only 16 new patent cases were assigned to visiting judges in Delaware, as compared to 87-114 new cases assigned to each Delaware district court judge. The 16 cases were assigned among nine visiting judges.



Source: Docket Navigator

Notable Court Decisions

New Trial on Patent Damages Ordered for Material Concerns About Jury Confusion Regarding the Form of Reasonable Royalty Awarded (Running Royalty versus Lump Sum)

G+ Comms., LLC v. Samsung Elecs., Co., No. 22-cv-00078-JRG, 2024 WL 896343 (E.D. Tex. Mar. 1, 2024) (Gilstrap, J.)

The court *sua sponte* ordered a new trial on damages because it had "material concerns about jury confusion regarding the form of the reasonable royalty awarded herein—i.e., that the jury may have awarded damages in the form of a running royalty when it intended to award them as a lump sum." Because both parties failed "to develop and educate the jury about these very different concepts during the trial, the jury's verdict on damages [was] not sufficiently reliable." Both sides "equally failed throughout the trial to explain to the jury what constituted a running royalty or how it differed from a lump sum. Further, neither party's damages expert substantially addressed this matter in their testimony."

The Methodology Using Forward Citations to Determine Relative Value of the Patents Does Not Require Accounting for Patent Age

Regents of Univ. of Minn. v. Sprint Solutions, Inc., No. 14-04669-JRT-TNL, 2024 WL 844579 (D. Minn. Feb. 28, 2024) (Tunheim, J.)

After confirming that "forward-citation methods are still accepted as a method to determine the relative value of the patents," the court rejected the defendants' argument that the plaintiff's damages expert's forward-citations methodology should be excluded for failure to account for patent age. "The standard does not explicitly instruct that a forward-citation method must account for patent age but rather that the method be 'sufficiently tied to the facts of the specific case.'" Under this standard, the court found that the defendants "presented insufficient evidence justifying exclusion because of a failure to account for patent age."