

DUTY OF CANDOR  
BEFORE THE PTAB,  
FORUM SHOPPING, and  
POST-AMGEN  
ENABLEMENT, *OH MY!*

Presenters:

Monica Arnold

Jennifer Villoria

Catherine Lee

Judge Kewalramani

Chris Hack

Markey IP Inn of Court

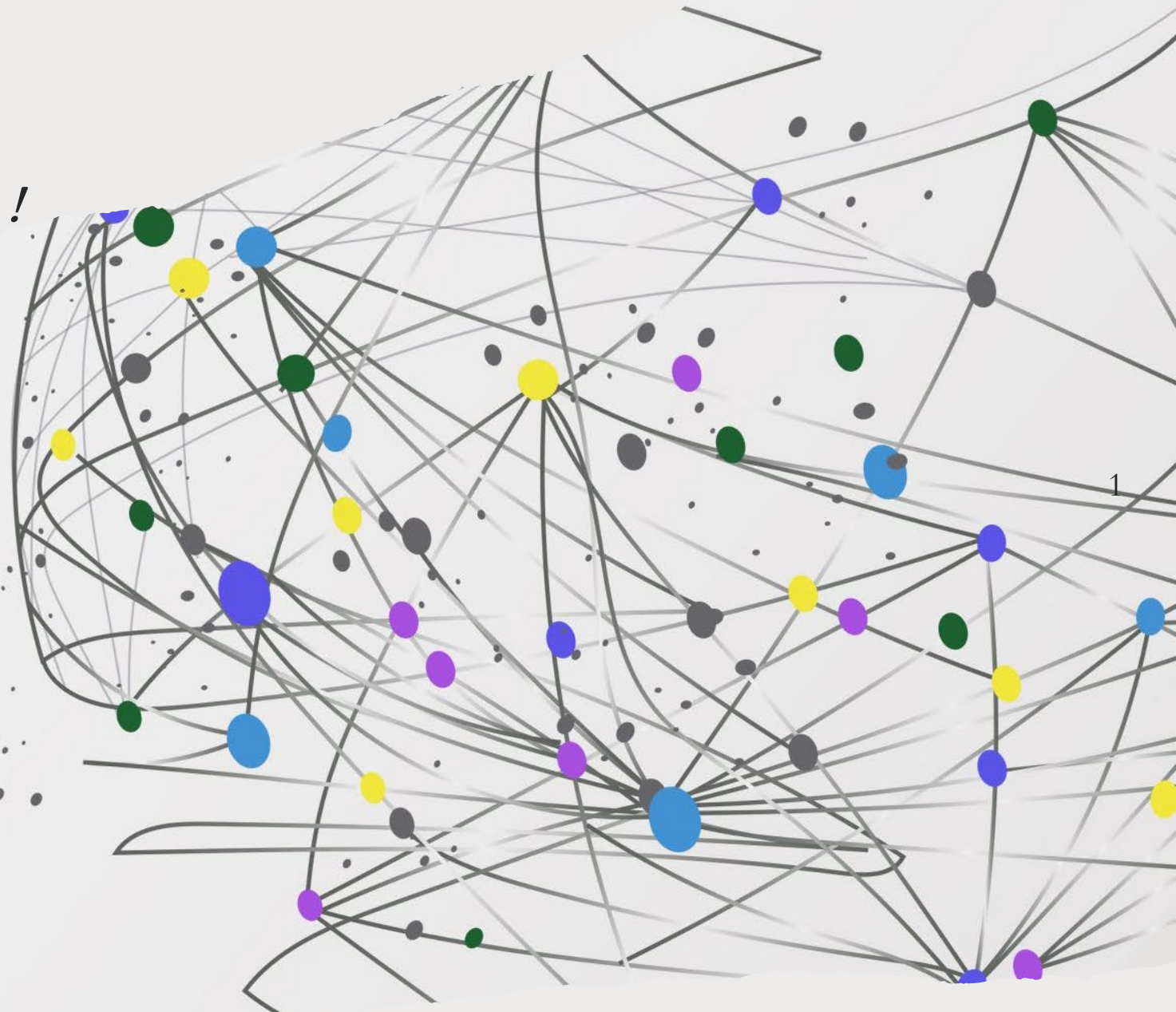
Pupilage Group 2

April 9, 2024

Networking - 6-6:45 PM

Presentation - 6:45 to 7:45 PM

Q&A - 7:45 to 8:00 PM





DUTY OF CANDOR  
BEFORE THE PATENT  
TRIAL AND APPEAL BOARD 2

## 37 C.F.R. § 42.11

(a) ***Duty of candor.*** Parties and individuals involved in the proceeding have a duty of candor and good faith to the Office during the course of a proceeding.

(b) ***Signature.***

(c) ***Representations to the Board.***

(d) ***Sanctions.***

(2) By motion

(3) On the Board's initiative

## 37 C.F.R. § 42.11(a)–(c)

### ⊙ § 42.11 Duty of candor; signing papers; representations to the Board; sanctions.

(a) *Duty of candor.* Parties and individuals involved in the proceeding have a duty of candor and good faith to the Office during the course of a proceeding.

(b) *Signature.* Every petition, response, written motion, and other paper filed in a proceeding must comply with the signature requirements set forth in [§ 11.18\(a\) of this chapter](#). The Board may expunge any unsigned submission unless the omission is promptly corrected after being called to the counsel's or party's attention.

(c) *Representations to the Board.* By presenting to the Board a petition, response, written motion, or other paper—whether by signing, filing, submitting, or later advocating it—an attorney, registered practitioner, or unrepresented party attests to compliance with the certification requirements under [§ 11.18\(b\)\(2\) of this chapter](#).

# 37 C.F.R. § 11.18

## SIGNATURE REQUIREMENTS

### © § 11.18 Signature and certificate for correspondence filed in the Office.

(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, and all documents filed with a hearing officer in a disciplinary proceeding, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Office must bear a signature, personally signed or inserted by such practitioner, in compliance with § 1.4(d) or § 2.193(a) of this chapter.

(b) By presenting to the Office or hearing officer in a disciplinary proceeding (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or knowingly and willfully makes any false, fictitious, or fraudulent statements or representations, or knowingly and willfully makes or uses any false writing or document knowing the same to contain any false, fictitious, or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001 and any other applicable criminal statute, and violations of the provisions of this section may jeopardize the probative value of the paper; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances,

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office;

(ii) The other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions or actions as deemed appropriate by the USPTO Director, which may include, but are not limited to, any combination of—

(1) Striking the offending paper;

(2) Referring a practitioner's conduct to the Director of the Office of Enrollment and Discipline for appropriate action;

(3) Precluding a party or practitioner from submitting a paper, or presenting or contesting an issue;

(4) Affecting the weight given to the offending paper; or

(5) Terminating the proceedings in the Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action.

[73 FR 47689, Aug. 14, 2008, as amended at 74 FR 54912, Oct. 26, 2009; 78 FR 62409, Oct. 21, 2013; 86 FR 28457, May 26, 2021]

# BACK TO § 42.11(d)

(d) *Sanctions* —(1) *In general.* If, after notice and a reasonable opportunity to respond, the Board determines that [paragraph \(c\)](#) of this section has been violated, the Board may impose an appropriate sanction on any attorney, registered practitioner, or party that violated the rule or is responsible for the violation.

(2) *Motion for sanctions.* A motion for sanctions must be made separately from any other motion and must describe the specific conduct that allegedly violates [paragraph \(c\)](#) of this section. The motion must be authorized by the Board under [§ 42.20](#) prior to filing the motion. At least 21 days prior to seeking authorization to file a motion for sanctions, the moving party must serve the other party with the proposed motion. A motion for sanctions must not be filed or be presented to the Board if the challenged paper, claim, defense, contention, or denial is withdrawn or appropriately corrected within 21 days after service of such motion or within another time the Board sets. If warranted, the Board may award to the prevailing party the reasonable expenses, including attorney's fees, incurred for the motion.

(3) *On the Board's initiative.* On its own, the Board may order an attorney, registered practitioner, or party to show cause why conduct specifically described in the order has not violated [paragraph \(c\)](#) of this section and why a specific sanction authorized by the Board should not be imposed.

(4) *Nature of a sanction.* A sanction imposed under this rule must be limited to what suffices to deter repetition of the conduct or comparable conduct by others similarly situated and should be consistent with [§ 42.12](#).

(5) *Requirements for an order.* An order imposing a sanction must describe the sanctioned conduct and explain the basis for the sanction.

## POLL QUESTION

What types of conduct have resulted in the Board cautioning counsel or finding counsel violated its duty of candor?



## EXAMPLES

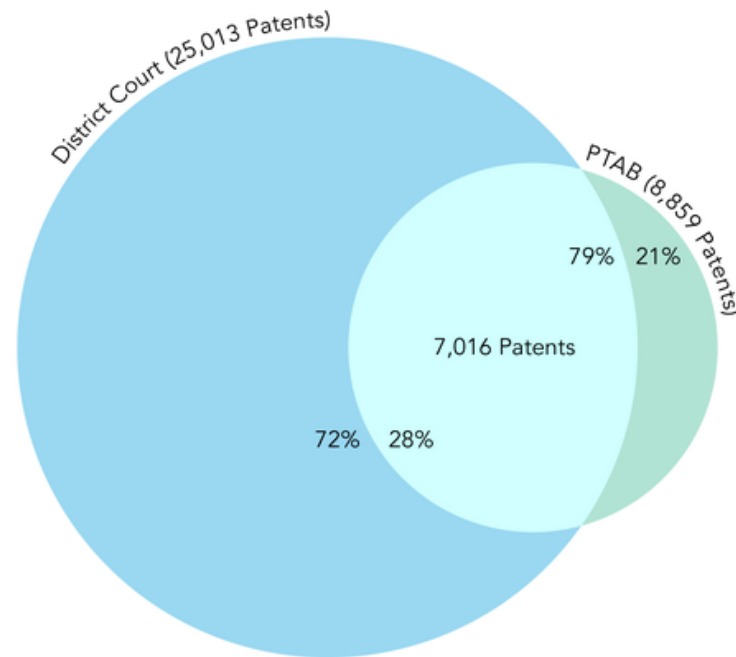
1. Issues with claim construction arguments
2. Not disclosing information related to the *Fintiv* analysis
3. Not disclosing all real parties-in-interest
4. Withholding information material to patentability
5. Misrepresenting precedent / prior art





# DUTY OF CANDOR AND RELATED PROCEEDINGS

Overlap Between Patents Litigated in District Court and Those with IPRs



*Note: Excludes declaratory judgment (DJ) actions and biopharma litigation.*

# *CLAIM CONSTRUCTION ISSUES*

## *POLL: WHICH ARE PROBLEMATIC?*

- ❑ 2017 IPR: Petitioner argues in district court that a claim is indefinite and contains multiple means-plus-function terms. District Court (mostly) agrees. Petitioner argues in concurrent IPR that no claim construction is needed. Petitioner never informs the Board of its arguments at district court or their success....
  
- ❑ 2020 IPR: Petitioner fails to inform the Board that it had argued in District Court a claim term was indefinite. Petitioner made no arguments regarding means-plus-function claiming. The district court had not yet ruled on the term. Before the Board, the Petitioner does not assert the term is indefinite, instead arguing plain and ordinary meaning....
  
- ❑ 2021 IPR: Board provides preliminary construction for two terms. Patent Owner submits evidence based on its preferred constructions of the terms, rather than the Board's....

## THE BOARD FOUND 2 OF THESE SCENARIOS PROBLEMATIC

X 2017 IPR: Petitioner argues in district court that a claim is indefinite and contains multiple means-plus-function terms. District court (mostly) agrees. Petitioner argues in concurrent IPR that no claim construction is needed. Petitioner never informs the Board of its arguments at district court or their success.... *Facebook v. Sound View*

□ 2020 IPR: Petitioner fails to inform the Board that it had argued in district court a claim term was indefinite. Petitioner made no arguments regarding means-plus-function claiming. The district court had not yet ruled on the term. Before the Board, the Petitioner does not assert the term is indefinite, instead arguing plain and ordinary meaning.... *Target v. Proxicom Wireless*

X 2021 IPR: PTAB provides preliminary construction for two terms. Patent Owner submits evidence based on its preferred constructions of the terms, rather than the Board's.... *Spectrum v. Longhorn*



# *FACEBOOK v. SOUND VIEW INNOVATIONS*

- March 1, 2017: Facebook petitioned for *inter partes* review of one claim (claim 19)
- Neither party contended any claim term required construction

- Facebook:

“The Petitioner does not contend that any term from the '486 patent requires an explicit construction in order to understand how the claims apply to the prior art cited below. The Petitioner respectfully requests that the Board adopt the broadest reasonable construction consistent with the ordinary and customary meaning of claim 19.”



## *MEANWHILE, IN DISTRICT COURT...*

- March 9, 2017: Parties filed a joint claim construction statement
  - Facebook (FB): six limitations of claim 19 are **indefinite** under *IPXL*
  - FB: ten limitations of claim 19 contain **means-plus function** language
- May 19, 2017: court issues memorandum opinion on claim construction
  - *Agree* with FB: claim 19 (**the only disputed claim**) is **indefinite** under *IPXL*
  - *Partly Agree* with FB: at least one claim term **indefinite** as **means-plus-function** without structure



## 37 C.F.R. § 42.104(b)(3)

*[T]he petition must set forth:*

(3) How the challenged claim is to be construed. Where the claim to be construed contains a **means-plus-function** or step-plus-function limitation as permitted under 35 U.S.C. 112(f), the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function



# THE BOARD DISCRETIONARILY DENIED INSTITUTION

- “Although not bound by the district court’s *earlier* determination that claim 19 *is* indefinite, we consider it in determining whether we should exercise our discretion and deny institution of an *inter partes* review of the claim.”
- While it may be true that there is nothing improper about agreeing with Patent Owner’s position in the IPR while preserving an alternative argument before the district court, “the challenged claim either *contains* means-plus functions terms or it doesn’t ....”
- “*Clearly, based on its arguments to the district court, Petitioner believes that claim 19 contains a means-plus-function limitation. Nevertheless, Petitioner chose not to provide us with the required construction.*” (cleaned up)
- “*At the very least, Petitioner's failure to inform us of its differing claim construction arguments before the district court raises the specter of lack of candor.*”



## *TARGET v. PROXICOM WIRELESS*

- May 8, 2020: Target petitions for IPR
  - Contended “wide area network” and “local wireless link” “should be interpreted according to the plain and ordinary meaning.”
- Also on May 8, 2020: Target served preliminary claim constructions in the parallel district court proceeding
  - Asserted these terms were indefinite
- Proxicom (relying on *Facebook v. Sound View*) argued the Board should exercise its discretion to deny institution because Target failed to notify the Board of its differing claim construction positions



# *THE BOARD DECLINED TO DISCRETIONARILY DENY INSTITUTION*

- Facts are distinguishable from those in *Facebook*:
  - District court “has not already determined the claims to be indefinite.”
  - Not faced with “means-plus-function claims lacking a proposed construction.”
  - In *Facebook*, there was no reason to proceed because the district court already determined the sole challenged claim was indefinite
  - “Petitioner’s alternative pleading before a district court is common practice, especially where it concerns issues outside the scope of *inter partes* review.”

# *SPECTRUM SOLUTIONS v. LONGHORN VACCINES and DIAGNOSTICS*

- When granting institution, the Board declined to accept Longhorn’s narrow constructions of “*kill pathogens*” and “*not degrade nucleic acids*”
- Post-institution, Longhorn engaged a third-party laboratory to conduct biological testing in support of its Patent Owner Response and Motion to Amend certain claims
- Longhorn initially withheld certain testing results based on (1) attorney work product privilege and (2) its preferred constructions
- Spectrum moved for sanctions

## ***THE BOARD FOUND LONGHORN VIOLATED ITS DUTY OF CANDOR***

- Longhorn relied on its preferred claim construction positions “in determining what it is obligated to disclose in these proceedings. But in ignoring the alternative constructions discussed in the institution decisions, [Longhorn] unduly limits the scope of its obligatory disclosures to the Office and [Spectrum], omitting data and information it should have disclosed under the duty of candor and fair dealing.”
- Adverse judgment entered in the final written decisions
- Declined to impose monetary sanctions
- Director’s *sua sponte* review pending



## *NOKIA OF AMERICA v. SOTO*

- Nokia challenged the patentability of U.S. Patent No. 8,238,754, owned by Soto
- Two consolidated cases in E.D. Tex. where **NextGen**, exclusive licensee, asserted infringement of the '754 Patent
  - *NextGen v. Fujitsu* (“*Fujitsu*”) (lead case)
  - *NextGen v. Nokia* (“*Nokia I*”)
- Pre-institution, both parties argued the impact of the trial date:
  - *Fujitsu* case trial date: May 6, 2024
  - Final written decision: January 20, 2025



## *BUT THEN... EVENTS TRANSPIRED IN THE DISTRICT COURT*

- *Fujitsu* case was stayed
- Next Gen filed a second patent infringement suit against Nokia (“*Nokia II*”)
- *Nokia I* was deconsolidated from *Fujitsu*
- *Nokia I* was consolidated with *Nokia II*



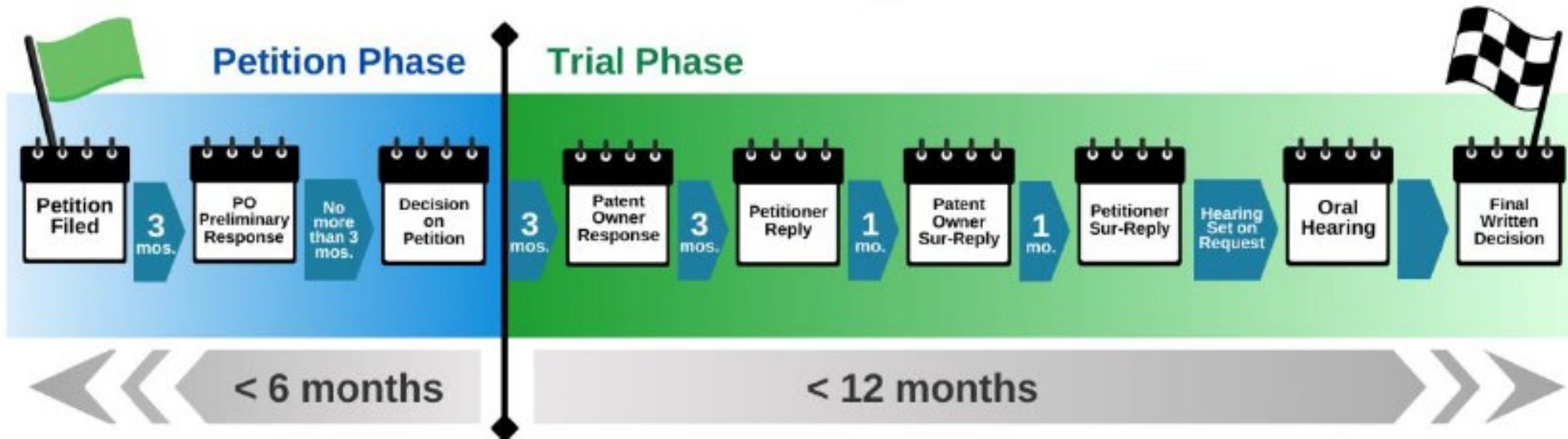
## ***DISCRETIONARY DENIAL UNDER 35 U.S.C. § 314(a)***

Board must balance *Fintiv* factors when determining whether to institute trial—

- (1) whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
- (2) proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
- (3) investment in the parallel proceeding by the court and the parties;
- (4) overlap between issues raised in the petition and in the parallel proceeding;
- (5) whether the petitioner and the defendant in the parallel proceeding are in the same party; and
- (6) other circumstances that impact the Board's exercise of discretion, including the merits.

*DISCRETIONARY DENIAL UNDER  
35 U.S.C. § 314(a)*

**IPR/PGR Proceeding Timeline**



## POLL QUESTION

Must the parties inform the Board of these updates in the parallel district court proceedings?







# A N S W E R

- Board lost confidence in the parties' ability to provide “accurate, timely factual information that the Board needs in order to render a fair, just determination of the *Fintiv* issue and this case.”
- Under 37 C.F.R § 42.11 (d)(3), the parties were ordered to show cause why they should not be sanctioned under 37 C.F.R. § 42.12 (a)(2)-(3)



# MICROSOFT v. SOFTEX

## I. MANDATORY NOTICES

### A. Real Party-In-Interest – § 42.8(b)(1)

Petitioner Microsoft Corporation (“Petitioner”) is the real party-in-interest.

Out of an abundance of caution and without conceding that they are real parties-in-interest, Petitioner discloses that Dell Inc.; Dell Technologies Inc.; HP Inc.; Lenovo (Shanghai) Electronics Technology Co. Ltd.; Lenovo Group, Ltd.; Lenovo Beijing, Ltd.; Lenovo PC HK Limited; and Lenovo (United States), Inc. have been named as defendants in co-pending litigations filed in or after December 2022 (listed below) based, in part, on alleged activities relating to products incorporating Microsoft software. Whether such third parties are real parties-in-interest should not be resolved in this proceeding because it has no impact on this proceeding, including because even a determination that these parties are real parties-in-interest would not result in the application of any estoppel or time-bar under 35 U.S.C. § 315. *Unified Patents, LLC v. MemoryWeb, LLC*, Decision Granting Director Review Vacating-in-part the Final Written Decision and Vacating Board Order, IPR2021-01413, Paper 76, 5 (PTAB May 22, 2023) (citing *SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11, 18 (PTAB Oct. 6, 2020) (precedential)).

### B. Related Matters – § 42.8(b)(2)

#### 1. United States Patent & Trademark Office

U.S. Patent No. 8,506,649 (“the ’649 patent”) claims the benefit of provisional application No. 60/497,182. The ’649 patent is a divisional of application number 10/925,161.

#### 2. District Court Matters

The ’649 patent is at issue in the following pending cases:

- *Softex LLC v. Lenovo (Shanghai) Elecs. Tech. Co. Ltd., et al.*, Case No. 5:23-cv-00090 (E.D.N.C.)
- *Softex LLC v. Absolute Software Corp. et al.*, Case No. 1:22-01308 (W.D. Tex.)
- *Softex LLC v. Dell Tech. Inc. et al.*, Case No. 1:22-01309 (W.D. Tex.)
- *Softex LLC v. HP Inc. et al.*, Case No. 1:22-01311 (W.D. Tex.)

# REAL PARTY-IN-INTEREST (RPI)

35 U.S.C. § 312(a)(2)

## *PETITIONS*

***Requirements of Petition*** – A petition filed under section 311 may be considered only if the petition identifies all real parties in interest

37 C.F.R. § 42.8(B)(1)

## *MANDATORY NOTICES*

Each of the following notices must be filed [by the petitioner and the patent owner]:  
*Real party-in-interest*. Identify each real party-in-interest for the party.



## DETERMINING AN RPI/PRIVY

- The party that desires review of the patent, *e.g.*:
  - A non-party exercises (or could have exercised) control over a petitioner's participation in a proceeding
  - A non-party that funds, directs, and controls an IPR/PGR
- [A] flexible approach that takes into account both equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that has a preexisting, established relationship.”



# PTAB CONSOLIDATED TRIAL PRACTICE GUIDE

The core functions of the “real party-in-interest” and “privies” requirements are to assist members of the Board in identifying potential conflicts, and to assure proper application of the statutory estoppel provisions. The latter, in turn, seeks to protect patent owners from harassment via successive petitions by the same or related parties, to prevent parties from having a “second bite at the apple,” and to protect the integrity of both the USPTO and federal courts by assuring that all issues are promptly raised and vetted.



# WHETHER TO DENY INSTITUTION

## PATENT OWNER

- Contended Dell, HP, and Lenovo are RPIs
- Before entering an appearance, Petitioner's counsel was involved in a HP/Dell district court litigation M/C wherein the same invalidity grounds were served onto PO
- Petitioner "has a long-standing practice of offering indemnification to the PC Manufacturers."

## PETITIONER

- Whether the third parties are RPIs need not be resolved
- Finding these parties RPIs would not result in any estoppel or time bar under section 315.

# *ONE YEAR TIME BAR*

35 U.S.C. § 315

## RELATION TO OTHER PROCEEDINGS

(b) An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.

## POLL QUESTION

Does RPI identification of the three non-parties warrant denial of institution?

- District Court litigations served December 14, 2022
- Microsoft's petition filed July 11, 2023





## *A N S W E R*

“[P]etitioners must comply with [section 312(a)(2)’s] requirements in good faith.”

“Without an implication of time bar or estoppel provisions under 35 U.S.C. § 315 in this proceeding, we decline to decide whether the PC Manufacturers should have been named RPis in this Petition at the institution stage.”



## OTHER EXAMPLES

- Withholding information material to patentability
  - *Spectrum Solutions v. Longhorn Vaccines & Diagnostics*, IPR2021-00847, Paper 107 at 29-46 (P.T.A.B. May 3, 2023) (sanctioning patent owner for failing to comply with section 42.11 by selectively withholding experimental data material to patentability)
- Misrepresenting precedent or prior art
  - *Edwards Lifesciences v. Colibri Heart Valve*, IPR2020-01649, 2021 WL 1158197, at \*20 n.13 (P.T.A.B. March 26, 2021) (citing section 42.11 and cautioning patent owner against any additional misrepresentation of precedent)
  - *Sony Interactive Ent. LLC v. BOT M8, LLC*, IPR2020-0092, 2020 WL 6937848, at \*6 n. 8 (P.T.A.B. Nov. 24, 2020) (citing section 42.12 regarding mischaracterization of a patent)

FORUM  
SHOPPING

# SINGLE-JUDGE DIVISIONS

- Single-judge divisions are not new

- Common in Texas

Texarkana (E.D. Tex.)

Galveston (S.D. Tex.)

Sherman (E.D. Tex.)

Waco (W.D. Tex.)

Amarillo (N.D. Tex.)



# SINGLE-JUDGE DIVISIONS

- None in California (used to be)
- None in Delaware



# JUDICIAL CONFERENCE ACTION

## Texas federal court district rebuffs effort to curb ‘judge-shopping’ tactic

By Tierney Sneed, CNN

🕒 3 minute read · Updated 9:22 AM EDT, Tue April 2, 2024



by where they file a lawsuit.

- Local case assignment plans risk creating an appearance of “judge shopping”
- Value of trying a civil case in nearest division less important when impact may be felt statewide or nationally
- The amended (**voluntary**) policy applies to cases involving state or federal laws, rules, regulations, policies, or executive branch orders

## Item VIII

**U.S. District Judge Alan D. Albright:**

- (a) One hundred percent (100%) of the civil docket in the Waco Division, with the exception of patent cases; and
  
- (b) One hundred percent (100%) of the criminal docket in the Waco Division; and
  
- (c) Patent cases will be assigned as ordered on July 25, 2022, in the Court's Order Assigning the Business of the Court as it Relates to Patent Cases, with the exception that no further cases will be assigned to Senior Judge Frank Montalvo, and until further order of the Court; and
  
- (d) All other proceedings in the Waco Division.

W. D. T E X .

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF TEXAS

§  
§  
§

FILED

JUL 25 2022

CLERK, U.S. DISTRICT COURT  
WESTERN DISTRICT OF TEXAS  
BY [Signature]  
DEPUTY

ORDER ASSIGNING THE BUSINESS OF THE COURT AS IT RELATES TO  
PATENT CASES

Upon consideration of the volume of new patent cases assigned to the Waco Division, and in an effort to equitably distribute those cases, it is hereby ORDERED that, in accordance with 28 U.S.C. § 137, all civil cases involving patents (Nature of Suit Codes 830 and 835), filed in the Waco Division on or after July 25, 2022, shall be randomly assigned to the following district judges of this Court until further order of the Court.<sup>1</sup>

Upon consideration of the volume of new patent cases assigned to the Waco Division, and in an effort to equitably distribute those cases, it is hereby ORDERED that, in accordance with 28 U.S.C. § 137, all civil cases involving patents (Nature of Suit Codes 830 and 835), filed in the Waco Division on or after July 25, 2022, shall be randomly assigned to the following district judges of this Court until further order of the Court.<sup>1</sup>

U.S. District Judge Alan Albright, Waco Division

U.S. District Judge Jason Pulliam, San Antonio Division

Senior U.S. District Judge David Ezra, San Antonio Division

SIGNED this 25<sup>th</sup> day of July 2022.



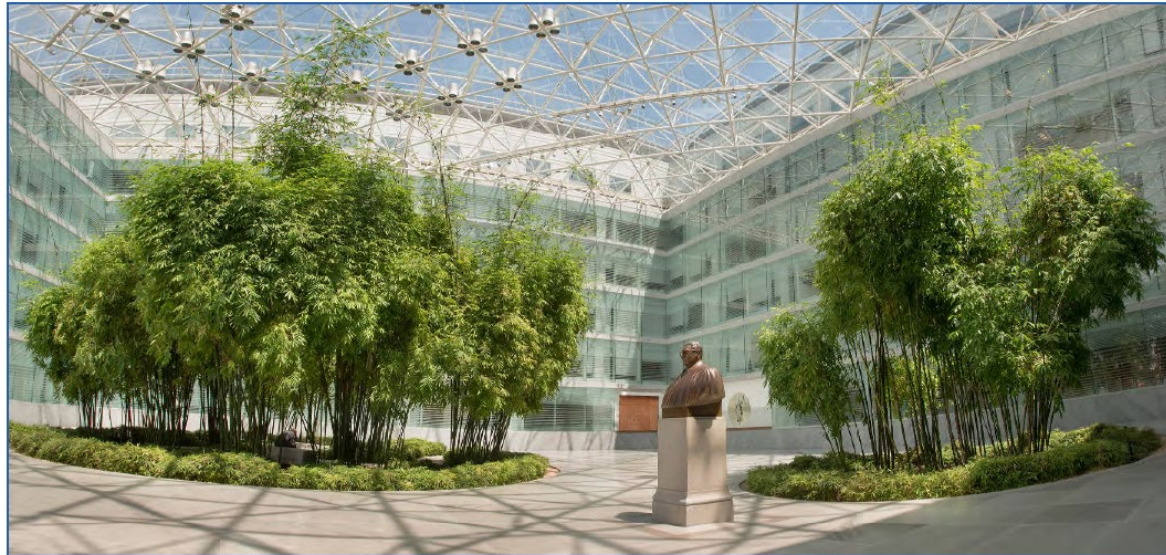
ORLANDO L. GARCIA  
CHIEF UNITED STATES DISTRICT JUDGE

<sup>1</sup> With the exception of new patent assignments addressed herein, the Court's 'Amended Order Assigning the Business of the Court' filed on May 10, 2021, remains in full force and effect.



# BACKGROUND: JUDICIAL CONFERENCE

- In 2021, Chief Justice Roberts took notice of this “arcane but important matter of judicial administration: judicial assignment and venue for patent cases”
- Competing interests: random assignment to generalist judges vs. litigants served by judges tied to their communities
- Committee on Court Admin & Case Management assigned to review the issue



*Thurgood Marshall Federal Judiciary Building, Washington, DC*

cial administration: judicial assignment and venue for patent cases in federal trial court. Senators from both sides of the aisle have expressed concern that case assignment procedures allowing the party filing a case to select a division of a district court might, in effect, enable the plaintiff to select a particular judge to hear a case. Two important and sometimes competing values are at issue. First, the Judicial Conference has long supported the random assignment of cases and fostered the role of district judges as generalists capable of handling the full range of legal issues. But the Conference is also mindful that Congress has intentionally shaped the lower courts into districts and divisions codified by law so that litigants are served by federal judges tied to their communities. Reconciling these values is important to public confidence in the courts, and I have asked the Director of the Administrative Office, who serves as Secretary of the Judicial Conference, to put the issue before the Conference. The Committee on Court Administration and

Case Management is reviewing this matter and will report back to the full Conference. This issue of judicial administration provides another good example of a matter that self-governing bodies of judges from the front lines are in the best position to study and solve—and to work in partnership with Congress in the event change in the law is necessary.

observed: Chief Justice Taft was president in 1900

The agitation with reference to the courts, the general attacks on them, . . . all impose upon us, members of the Bar and upon judges of the courts and legislatures, the duty to remove, as far as possible, grounds for just criticism of our judicial system.

As Chief Justice, Taft took vital steps to ensure that the Judicial Branch itself could take the lead in fulfilling that duty. The Congress of his era appreciated the Judiciary's need for independence in our system of separate and co-equal branches, and it provided a sound structure for self-governance. Since that time, the Judicial Conference has been an enduring success. It is up to the task of addressing the three topics I have highlighted, as well as the many other issues on its agenda. The centennial of the Judicial Conference this year represents 100 years of progress, and the Judiciary should be proud of its accomplish-

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## Conference Acts to Promote Random Case Assignment

*Published on March 12, 2024*

The Judicial Conference of the United States has strengthened the policy governing random case assignment, limiting the ability of litigants to effectively choose judges in certain cases by where they file a lawsuit.

The policy addresses all civil actions that seek to bar or mandate state or federal actions, “whether by declaratory judgment and/or any form of injunctive relief.” In such cases, judges would be assigned through a district-wide random selection process.

the conference. The random case assignment policy deters judge shopping and the assignment of cases based on the perceived merits or abilities of a particular judge. It promotes the

In most of the nation’s 94 federal district courts, local case assignment plans facilitate the random selection of judges. Some plans assign cases to a judge in the division of the court where the case is filed. In divisions where only a single judge sits, these rules have made it possible for a litigant to pre-select that judge by filing in that division.

In a November 2021 letter, Senator Thom Tillis (R-N.C.), and Patrick Leahy, a Vermont senator who since has retired, raised concerns about a concentration of patent cases filed in single-judge divisions.

Chief Justice John G. Roberts, Jr., referenced this letter in his [2021 Year-End Report on the Federal Judiciary \(/news/2021/12/31/chief-justice-roberts-issues-2021-year-end-report\)](#), calling for a study of judicial assignment practices in patent cases.

In submitting the proposed policy to the Judicial Conference, the CACM Committee said that some local case assignment plans risked creating an appearance of “judge shopping.” The committee

## UNDERLYING CONCERNS

- From Patent Cases to Cases Seeking Declaratory and Injunctive Relief
- Prevent Judge Shopping
- Other Concerns Associated with a Single Judge

## BENEFITS OF SINGLE JUDGE DIVISION

- “[T]ies to localized communities” (2021 Year End Report at 5)
- Cost and benefits to litigants
- (Potentially) Specialized Expertise

*ENABLEMENT  
POST-  
AMGEN V. SANOFI,  
598 U.S. 594 (2023)*

**SUPREME COURT OF THE UNITED STATES**

Syllabus

AMGEN INC. ET AL. *v.* SANOFI ET AL.

CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR  
THE FEDERAL CIRCUIT

No. 21–757. Argued March 27, 2023—Decided May 18, 2023



AMGEN V. SANOFI  
598 U.S. 594 (2023)

- Amgen had two patents that together “claim a monopoly over all antibodies that (1) bind to specific amino acids on a naturally occurring protein known as PCSK9, and (2) block PCSK9 from impairing the body’s mechanism for removing LDL cholesterol from the bloodstream.”
- “If a patent claims an entire class of processes, machines, manufactures, or compositions of matter, the patent’s specification must enable a person skilled in the art to make and use the entire class.”
- Unanimously affirmed a panel decision of the Federal Circuit invalidating the claims



# GENERAL NOTES POST-AMGEN

- There have been 27 opinions that have cited to Amgen (as of April 1, 2024)
  - 3 Fed. Cir.
  - 11 D.C. (7 in D. Del.)
  - 13 PTAB
- For reference, there have been about 80 or so decisions that discuss enablement that have NOT referenced Amgen
  - About 25% rate of Amgen citations
- “The Supreme Court recently reaffirmed that a patent's "specification must enable the full scope of the invention as defined by its claims."
  - In Re Entresto Sacubitril/Valsartan Patent Litig.*, 2023 U.S. Dist. LEXIS 117240 (D. Del.) (Andrews, J)
- “At oral argument, both parties agreed the Supreme Court did not disturb the *Wands* factors. We see no meaningful difference between *Wands* ‘undue experimentation’ and *Amgen’s* ‘[un]reasonable experimentation’ standards.”
  - Baxalta Inc. v. Genentech, Inc.*, 81 F.4th 1362, 1367 (Fed. Cir.) (Moore, J.)





FEDERAL CIRCUIT: *IN RE STARRETT*  
2023 U.S. APP LEXIS 14231

- Technology: “The twenty-two claims of the ‘124 application generally recite methods, systems, media, and machines for maintaining augmented telepathic data for telepathic communication as a gadget-free extension of human senses”
- Result: Affirms PTAB rejection of all claims for lack of enablement
- Following a block quote from Amgen, court holds:  
“Here, much is claimed, and little is enabled. Although a finding of enablement is not precluded by a skilled artisan's needing to engage in some measure of experimentation, the extent of that experimentation must be reasonable. The determination as to whether the extent of experimentation is undue or reasonable is informed by the eight *Wands* factors.”



## *OYSTER OPTICS*

2023 U.S. DIST. LEXIS 190950

(N.D. CA.)

- Technology: Fiber Optics Telecommunications Card With Energy Level Monitoring
- Result: Cross-motions for summary judgment of invalidity for enablement denied
- “If a patent claims an entire class of processes, machines, manufactures, or compositions of matter, the patent's specification must enable a person skilled in the art to make and use the entire class. . . . The more one claims, the more one must enable. . . . That is not to say a specification always must describe with particularity how to make and use every single embodiment within a claimed class. For instance, it may suffice to give an example (or a few examples) if the specification also discloses some general quality . . . running through the class that gives it a peculiar fitness for the particular purpose. . . . In some cases, disclosing that general quality may reliably enable a person skilled in the art to make and use all of what is claimed, not merely a subset.”



PTAB: *GILLETTE V. SPHERE*  
2023 PAT. APP. LEXIS 3126

- Technology: Razor with Cutting Blade Rotatable About Multiple Axes
- Result: PGR institution denied because the claims were fully supported and enabled by the grandparent application filed prior to AIA
- “Weighing the evidence underlying the *Wands* factors, including "the nature of the invention and the underlying art” (*Amgen Inc.*, 598 U.S. at 612), we conclude that the grandparent application enables a person having ordinary skill in the art to make and use the full scope of the claimed invention without undue experimentation. Significant to our analysis is the limited number of embodiments covered by the claims, the level of ordinary skill, the description of the one embodiment in the grandparent application, and the fact that the invention at issue is mechanical in nature.”



# WANDS FACTORS

- In *In re Wands*, the court set forth the following factors to consider when determining whether undue experimentation is needed:
  - (1) the breadth of the claims;
  - (2) the nature of the invention;
  - (3) the state of the prior art;
  - (4) the level of one of ordinary skill;
  - (5) the level of predictability in the art;
  - (6) the amount of direction provided by the inventor;
  - (7) the existence of working examples; and
  - (8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure.
- *In re Wands*, 858 F.2d 731, 736-37, 8 USPQ2d 1400, 1402 (Fed. Cir. 1988)

## NEGATIVES OF SINGLE JUDGE DIVISION

- (Potentially) Specialized Expertise
- Perceived Pre-Ordained Outcome
- Perceived Undue Favoritism