Spotlight on Upcoming Oral Arguments - November 2021

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Monday, November 1, 2021

The following telephone arguments will be available to the public live. Access information will be available by 10 AM ET each day of argument at this link.

Monday, November 1, 2021

Hunting Titan, Inc. v. DynaEnergetics Europe GmbH, No. 20-2163

Hunting petitioned for inter partes review (“IPR”) of U.S. Patent No. 9,581,422, alleging the challenged claims were invalid as both anticipated and obvious. Following institution, DynaEnergetics filed a motion to amend the ’422 patent contingent on the Patent Trial and Appeal Board (“Board”) finding the original claims unpatentable. Hunting opposed, arguing the amended claims were obvious (but not
anticipated). In its Final Written Decision, the Board found both the original and amended claims to be anticipated.

DynaEnergetics sought review of the Board’s decision by the Precedential Opinion Panel (“POP”), arguing the Board improperly raised *sua sponte* anticipation of the amended claims. The POP granted review and agreed with DynaEnergetics. Citing *Nike Inc. v. Adidas AG*, the POP held that while “the Board may, in certain rare circumstances, raise a ground of unpatentability that a petitioner did not advance, or insufficiently developed, against substitute claims proposed in a motion to amend,” those circumstances were not present. The POP vacated the Board’s decision and granted DynaEnergetics’ motion to amend. Hunting appeals.

Hunting argues the POP improperly reversed the Board’s decision because the entire record shows the amended claims are unpatentable. According to Hunting, *Nike*, the Board’s procedures, and 35 U.S.C. § 318(a) indicate the Board should determine the patentability of amended claims based on the entire record, but the POP addressed only Hunting’s opposition to DynaEnergetics’ motion. Hunting argues DynaEnergetics had notice and an opportunity to respond to the anticipation ground applied by the Board to the amended claims because the Board instituted on this anticipation ground and DynaEnergetics’ motion was a response to this instituted ground. Hunting argues the POP denied it notice and an opportunity to respond by declining to follow *Nike*.

DynaEnergetics responds the POP’s decision should be affirmed because Hunting waived any argument that the prior art anticipated the amended claims. It argues Hunting’s reading of *Nike* would require the Board to act *sua sponte* in every case involving a motion to amend, but *Nike* permits the Board not to in most cases. According to DynaEnergetics, 35 U.S.C. § 316 confirms that the Board is not required to examine substitute claims.

The USPTO intervenes to defend the POP’s decision, arguing it was consistent with *Nike*.

**Tuesday, November 2, 2021**

*Arsus, LLC v. Unified Patents, LLC, No. 21-1648*

Unified petitioned for *inter partes* review of Arsus’s U.S. Patent No. 10,259,494 ("the ‘494 patent"). Following institution, Arsus statutorily disclaimed the challenged claims and moved to dismiss the IPR. The Board construed Arsus’s disclaimer as a request for adverse judgment, which it granted. Arsus filed a “Demand” that the Board vacate the adverse judgment, arguing the disclaimer deprived the Board of subject matter jurisdiction over the IPR. The Board declined to vacate its adverse judgment. Arsus appeals.

Arsus argues the Federal Circuit held in *Sanofi-Aventis U.S., LLC v. Dr. Reddy’s Labs., Inc.* that, following a statutory disclaimer, the disclaimed claims are “effectively eliminated” and it is “as though the disclaimed claim(s) had never existed,” which “moot[s]” a case or controversy. Under *Sanofi*, it argues, the Board should have acted as if its disclaimed claims never existed and dismissed the IPR. Arsus also
highlights *Facebook, Inc. v. Skky, LLC*, where it argues the Board declined to exercise jurisdiction over disclaimed claims.

Unified and the USPTO respond that 37 C.F.R. § 42.73(b) explicitly provides for disclaimer as a request for adverse judgment. They argue *Sanofi* concerned the Article III case or controversy requirement, which does not apply to agency proceedings, such as IPRs.

**Thursday, November 4, 2021**

*BOS GmbH & Co. KG v. Macauto USA, Inc., No. 21-1793*

BOS sued Macauto in the Eastern District of Michigan, alleging infringement of U.S. Patent No. 7,188,659 ("the '659 patent"). Macauto moved for summary judgment on invalidity, while BOS moved for summary judgment of no invalidity. In finding the '659 patent invalid and granting Macauto’s motion, the district court noted the absence of “expert testimony comparing the prior art references to the asserted claims” but took judicial notice of the asserted prior art references. The court found summary judgment of invalidity was appropriate in the absence of expert testimony because the '659 patent and the prior art references were “easily understandable.” BOS appealed.

BOS argues summary judgment of invalidity was inappropriate because although the district court may have been able to take judicial notice of the existence of prior art references, it could not take judicial notice of the content of them. It argues the collection of prior art references, without expert testimony, is not clear and convincing evidence upon which a jury could reasonably base a finding of obviousness.

Macauto counters that the district court properly judicially noticed the prior art references and what they teach. According to Macauto, there were no disputed issues of material fact precluding summary judgment. It notes BOS had the opportunity to dispute the content of the prior art but did not.

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