

FEDERAL CIRCUIT SUMMARY FOR WEEK ENDING MAY 5, 2023**HIP, Inc. v. Hormel Foods Corporation, No. 2022-1696 (May 2, 2023) (precedential) (3-0); Patent No(s). 9,980,498****Key point(s):**

- A single reference in the specification and a single claim limitation was insufficient to warrant adding an additional inventor to an already issued patent.

Facts/Background: The claims of Hormel’s ’498 patent relate to methods of precooking bacon and meat pieces. The patent as issued named four Hormel employees as inventors. HIP sued Hormel, seeking to have David Howard added as a co-inventor. The claims require a two-step method including a first preheating step selected from a group consisting of a microwave oven, infrared oven, or hot air, and a second, higher-temperature cooking step. Hormel argued Howard’s alleged contribution of preheating was not significant when measured against the scope of the full invention. Hormel contended Howard’s testimony was insufficiently corroborated. And Hormel asserted Howard’s contribution was disclosed in a prior printed publication, U.S. Patent App. Pub. 2004/0131738 (“Holm”). The issuance of a patent creates a presumption that the named inventors are the true and only inventors. HIP argued that Howard was a joint inventor because, under the three *Pannu* factors, he (1) contributed in some significant manner to the conception of the invention; (2) made a contribution to the claimed invention that is not insignificant in quality, when that contribution is measured against the dimension of the full invention; and (3) did more than merely explain to the real inventors well-known concepts and/or the current state of the art. The district court held Howard to be a joint inventor of the ’498 patent. Hormel appealed.

Holding: Reversed. Inventorship is a question of law that is reviewed without deference to the district court. Under the second *Pannu* factor, the inventor must “make a contribution to the claimed invention that is not insignificant in quality, when that contribution is measured against the dimension of the full invention.” Howard’s alleged contribution of preheating meat pieces using an infrared oven was insignificant in quality to the claimed invention because heating with an infrared oven is only mentioned once in the specification and once in a single (independent) claim and the figures depict a microwave oven instead of infrared heating. The failure to meet any one factor is dispositive on the question of inventorship. Due to this, the Federal Circuit declined to address the issue of if Holm constitutes the state of the art or the question of corroboration.

Guardant Health Inc. v. Vidal, No. 2021-1104 (May 5, 2023) (nonprecedential); Patent No. 9,834,822**Key point(s):**

- Multiple definitions of a term within a specification may defeat an argument that a patentee is his own lexicographer.

Facts/Background: The claims of the '822 patent relate to a process for detecting mutations in cfDNA by converting sample polynucleotides into tagged parent polynucleotides. Foundation Medicine, Inc. (FMI) petitioned for inter partes review (IPR) of claims 1–13 and 17–20 of the '822 patent, arguing the claims would have been obvious over a combination including U.S. Patent No. 9,752,188 (Schmitt) and non-patent literature. The Board instituted IPR and held all petitioned claims, except claim 12, would have been obvious.

Holding: Vacated and Remanded. Guardant argued the Board erroneously construed “converting the population of cfDNA molecules into a population of non-uniquely tagged parent polynucleotides” to mean “the number of different identifiers can be at least 2 and fewer than the number of polynucleotides in the sample.” Guardant asserted (1) that the limitation should be construed as “the number of different identifiers can be [] at least 2 and fewer than the number of polynucleotides that map to the mappable base position,” as written in the specification. Departure from plain and ordinary meaning only occurs in two instances: lexicography and disavowal. Lexicography applies only where the patentee “clearly set[s] forth a definition of the disputed claim term” and “clearly express[es] an intent” to redefine the term. Guardant also argued (2) the Board’s finding that Schmitt teaches non-uniquely tagged parent polynucleotides was not supported by substantial evidence and (3) Schmitt’s method was “poorly suited for cfDNA” and a skilled artisan therefore would not have reasonably expected to successfully apply Schmitt’s method to a population of cfDNA molecules. Guardant also argued (4) the Board erroneously found a lack of evidence that its commercial embodiment, Guardant360, is not coextensive with the claimed invention and therefore was not entitled to a presumption of a nexus. The appellate court agreed with the Board on the first three points. For (1), the '822 patent does not clearly set forth a definition of non-uniquely tagged parent polynucleotides that displaces the term’s plain and ordinary meaning. Elsewhere in the specification, the '822 patent does not describe the population of polynucleotides as only those that map to a mappable base position. The court held (2) that substantial evidence supports the Board’s finding that Schmitt teaches non-uniquely tagged parent polynucleotides and (3) substantial evidence supported the Board’s finding that a skilled artisan would have a reasonable expectation of success in using Schmitt’s hybrid method to analyze cfDNA. However, the case was remanded because the Board erred (4) when they required Guardant’s articles to establish a nexus without expert testimony linking the articles’ discussion of Guardant360 to claim 1 of the '822 patent.

Larry v. Intel Corporation, No. 2023-1257 (May 5, 2023) (nonprecedential); Patent Nos. 7,385,497, 8,106,752, 9,096,189, 9,589,439, 10,163,287, 10,984,619, RE43,891

Key point(s):

- General, conclusory remarks are insufficient to bring an antitrust suit.
- To survive a Rule 12(b)(6) motion in a patent infringement case, more than a mere listing of the patent claims and the defendant's products is required.
- It may not be an abuse of discretion for a district court to dismiss a frivolous suit with prejudice.

Facts/Background: Mr. Golden owns a family of patents concerning a system for locking, unlocking, or disabling a lock on vehicles or other apparatuses upon the detection of chemical, radiological, and biological hazards. Mr. Golden alleged patent infringement and related antitrust violations. Intel moved to dismiss the patent infringement claims for failure to state a claim under Rule 12(b)(6) of the Federal Rules of Civil Procedure, and his antitrust claims for lack of Article III and antitrust standing under Rules 12(b)(1) and 12(b)(6). To have Article III standing, a plaintiff must establish (1) an actual, concrete injury, that is (2) fairly traceable to the defendant's conduct and (3) likely to be redressed by a favorable decision. To enforce Section 2 of the Sherman Act, a plaintiff must have antitrust standing, for which the Supreme Court has identified several factors: (1) the nature of the plaintiff's alleged injury; that is, whether it was the type [of injury] the antitrust laws were intended to forestall; (2) the directness of the injury; (3) the speculative measure of the harm; (4) the risk of duplicative recovery; and (5) the complexity in apportioning damages. In his complaint, Mr. Golden merely made conclusory allegations about "Intel's exclusionary anticompetitive practices made it possible for Intel to maintain its monopoly." The district court held that Mr. Golden lacked both Article III standing and antitrust standing under Section 2 of the Sherman Act to bring his antitrust claims. The district court further dismissed the matter with prejudice. Surviving a Rule 12(b)(6) motion to dismiss requires well-pleaded facts, not legal conclusions, that plausibly give rise to an entitlement to relief. Mr. Golden's patent infringement complaint was simply a list of the patent claims and accused products manufactured by Intel, without even conclusory allegations of infringement. This appeal followed.

Holding: Affirmed. Mr. Golden's vague, conclusory allegations as to antitrust violations and allegations of injury were inadequate to allege either Article III standing or antitrust injury. The Federal Circuit held that the conclusory allegations also were insufficient to identify what products infringe and how those products infringe Mr. Golden's patents. In his appeal, Mr. Golden did not argue as to why "it would not be futile for him to amend his complaint." The appellate court held that the district court did not abuse its discretion in dismissing Mr. Golden's complaint with prejudice.