

**FEDERAL CIRCUIT SUMMARY FOR THE WEEK ENDING OCTOBER 20, 2023**

**ABS Global, Inc., Genus PLC v. Cytonome/ST, LLC, No. 2022-1761 (October 19, 2023) (precedential) (3-0); Patent No. 10,583,439 (“the ‘439 patent”)**

**Key points:**

- At least in an open-ended ‘comprising’ claim, the use of ‘a’ or ‘an’ before a noun naming an object requires that the phrase be construed to mean ‘one or more’ unless the context sufficiently indicates otherwise.
- If the specification states that “for the purposes of the present disclosure, the term ‘a’ or ‘an’ entity refers to one or more of that entity,” then the terms ‘a’ or ‘an’, ‘one or more’ and ‘at least one’ can be used interchangeably herein.
- Where the specification instructs as to the meaning of a claim term, ‘the inventor’s lexicography governs.’

**Facts/Background:** Cytonome/ST, LLC owns U.S. Patent No. 10,583,439 (the ‘439 patent), which discloses and claims a microfluidic device for processing particles of interest contained in a sample fluid. ABS Global, Inc. petitioned for *inter partes* review, challenging claims 1, 2, 6, 8, and 9 of the ‘439 patent as anticipated or obvious. ABS challenged claims 1, 2, 6, and 8 as anticipated by Simonnet. According to the Board, the claim phrase “the sample stream” means a single sample stream from the sample entry to inspection. Simonnet disclosed a split sample stream, i.e., multiple streams. Based on this construction, the Board found ABS had failed to meet its burden of proof as to unpatentability. ABS also challenged claim 8 as obvious in light of Simonnet combined with Kim, and claim 9 as obvious in light of Simonnet in combination with Kummrow. The Board disagreed stating that there be only a single stream, not a split stream. This appeal followed.

**Holding:** Affirmed-in-part, vacated, and remanded.

ABS argued that the Board erred in its claim construction by limiting claim 1’s disputed language to a flow channel’s focusing region configured for only a single sample stream, not more than one stream. The Federal Circuit agreed with ABS, holding that there was not a sufficient basis for rejecting the plural-allowing meaning of “a sample stream” in claim 1 because, as a general rule, “a” or “an” does not negate “one or more” and because the specification did not “demand” the singular-only meaning. The appellate court concluded that claim 1 was anticipated.

The appellate court held that the evidence established that Simonnet disclosed claim 8’s additional limitation. Thus, Simonnet also anticipated claim 8. The Court remanded for consideration of claim 9.

The Federal Circuit reversed the Board’s final written decision concerning claims 1 and 8, vacated the decision concerning claims 2, 6, and 9, and remanded the matter to the Board.

**Corephotonics, Ltd., v. Apple Inc., No. 2022-1340, 2022-1341, 2022-1455, 2022 (October 16, 2023) (precedential) (3-0); Patent Nos. 9,661,233, 10,230,898, 10,326,942, 10,356,332 (“Challenged Patents”)**

**Key points:**

- In establishing obviousness, it may be clear from the IPR petition’s description of the references and the challenged claims that prior art is in the same field of endeavor as the challenged patent, or the pertinence of the prior art to the problem solved by the invention may be implicit in the petition’s discussion of the challenged claims and why a person of ordinary skill would be motivated to combine the prior art reference with a reasonable expectation of success.
- An IPR petitioner is not required to anticipate and raise analogous art arguments in its petition; instead, a petitioner can use its reply to respond to, for example, arguments raised in a patent owner response.

**Facts/Background:** Corephotonics owns the Challenged Patents and sued Apple, alleging infringement. Apple filed IPR petitions. In its petitions, Apple said Golan and Martin “are analogous prior art and are in the *same field of endeavor* about imaging systems generating video output images using two imaging sections having different points of view.” Corephotonics argued it was unclear whether Apple stated that Golan and Martin are in the same field of endeavor as the Challenged Patents, or are in the same field of endeavor as one another. There was no explicit contention that Golan and Martin are analogous *because* they are pertinent to the problem faced by the inventors of the Challenged Patents. Apple argued in its replies that Golan is analogous art because it is in the same field of endeavor as the Challenged Patents and is pertinent to the problem faced by the inventors. The Board found the Challenged Patents were invalid.

This appeal followed.

**Holding:** Vacated, and remanded.

Corephotonics challenged the Board’s analogous art finding, arguing that the Board made two procedural errors: (1) permitting Apple to cure the legally flawed analogous art contention it made in its petition and (2) making analogous art findings that deviated from the contentions Apple advocated for in its petition and reply. Corephotonics also claimed the Board erred because Golan and Martin are not analogous art.

The Federal Circuit found no procedural error in the Board’s conclusion that Golan is analogous art. But the Federal Circuit remanded for further proceedings to determine whether Martin is analogous art stating that the Board must explain why Martin is (or is not) analogous art and how this finding affects its overall conclusion as to obviousness.

**Cyntec Company, Ltd., v. Chilisin Electronics Corp., No. 2022-1873 (October 16, 2023) (precedential) (3-0); Patent Nos. 8,922,312, and 9,481,037.**

**Key points:**

- Courts abuse their discretion when they admit the testimony that is both unreliable and speculative (e.g., unreliable and speculative calculations provided by an expert).
- It is better to send the issue to the jury first, and then rule on the JMOL. Because JMOL requires that the court views the evidence in the light most favorable to the nonmoving party and draws all reasonable inferences in that party's favor, the district court erred in granting JMOL and not giving the issue of invalidity to the jury. If there are factual disputes that should have been given to the jury, then JMOL should not be granted.

**Facts/Background:** Cyntec sued Chilisin for patent infringement. Chilisin unsuccessfully moved to exclude Cyntec's damages expert, asserting the opinions were unreliable because they assumed that all 310 third-party products across all 27 customers infringed, although there was no third-party discovery or testing from a technical expert to see if the third-party products contained the accused chokes. The expert sought to corroborate the assumption with third party research data applied to six of the 27 customers. The district court construed a "by means of" limitation, rejecting Chilisin's construction that hardness is the primary – or "but for" – cause of the claimed reduced formation temperature and construing the claim to only require that the hardness difference impacts the reduced formation temperature. During trial, Chilisin's technical expert opined that Japanese Unexamined Patent Application No. 2005-294458 ("Nakamura") discloses embodiments of electronic devices similar to those claimed in Cyntec's patents and that a skilled artisan would have been motivated to "improve the performance" of devices disclosed in US Patent No. 6,460,244 ("Shaffer") by using the approach as taught by Nakamura. But, in a JMOL ruling prior to sending the case to the jury, the district court held that Shaffer did not disclose what was argued and that Chilisin's evidence was not clear or convincing, granting JMOL that the asserted claims were not invalid as obvious. The case then went to the jury, which held Chilisin infringed and awarded damages consistent with the testimony of Cyntec's expert.

This appeal followed.

**Holding:** Affirmed-in-part, reversed-in-part, vacated-in-part, and remanded.

The Federal Circuit agreed with Chilisin that the district court erred in granting JMOL that the asserted claims were not invalid as obvious because there were factual disputes that should have been given to the jury. The Federal Circuit explained that even under a clear and convincing evidence standard, it was unconvinced that Chilisin's evidence was so meritless as to warrant JMOL. In contrast, the appellate court agreed with the district court's construction and held the district court did not err in denying Chilisin's motion for JMOL of noninfringement as there was substantial evidence to support the infringement. But the Federal Circuit held that the district court abused its discretion in admitting the damage calculations, because they were based on assumptions which were both unreliable and speculative.

**Dali Wireless Inc., v. Commscope Technologies LLC, Commscope Holding Company, Inc., No. 2022-1699 (October 18, 2023) (nonprecedential); Patent No. 8,682,338**

**Key point:**

- The claim term “translating ... as appropriate” is not a conditional term and requires translation each time the method is performed.

**Facts/Background:** At trial, the district court construed “translating the uplink and downlink signals between RF and baseband as appropriate” to require translation each time the method is performed. The district court rejected Dali’s argument that the claim language was conditional. The district court construed “packetizing the uplink and downlink based band signals” as referring to the baseband signals produced by the previous “translating” step and requiring the downlink RF signals to be translated to the baseband before the packetizing step. The district court construed “routing and switching and packetized signals among the one or more remote radio units via the at least one digital access unit,” as referring to “the packetized signals” produced by the “packetizing” step and including both uplink baseband signals and downlink baseband signals that were previously packetized. Based on the “translating” construction, Dali stipulated to noninfringement.

This appeal followed.

**Holding:** Affirmed.

Dali challenged the construction of “translating ... as appropriate,” arguing that “translating ... as appropriate” does not require translation each time the method is performed. According to Dali, the phrase “as appropriate” at the end of the translating limitation means that the translating step is only performed when necessary. However, the Federal Circuit agreed with the district court that the claimed translating step is not conditional. The claim does not recite “translating ... as needed.” Nor does the claim recite “translating unless not needed.”

The appellate court also agreed with the district court that the antecedent basis for “the uplink and downlink based band signals” is the “baseband” signals referred to in the required “translating” step. Hence, the downlink RF signals must be translated to the baseband before the packetizing step. The appellate court explained this construction is consistent with the specification, which states the object of the “present invention” is “to facilitate conversion and transport of several discrete relatively narrow RF bandwidths.”

Furthermore, the reviewing court agreed with the district court that “the routing and switching” limitation includes both uplink and downlink packetized signals. The claim language recites “routing and switching the packetized signals.” The antecedent basis for “the packetized signals” includes the signals produced in the previous packetizing step, which recites both “uplink and downlink baseband signals.”

**Great Concepts, LLC, v. Chutter, Inc., No. 2022-1212 (October 18, 2023) (precedential) (2-1); Trademark “DANTANNA’S” Registration No. 2929764 (’764 Registration)**

**Key point:**

- Section 14 of the Lanham Act, 15 U.S.C. § 1064, does not permit the TTAB to cancel a trademark’s registration due to the owner filing a fraudulent Section 15 declaration to acquire incontestability status for its already-registered mark, although fraudulent declaration may affect the registration’s incontestable status.

**Facts/Background:** Great Concepts obtained a trademark registration for DANTANNAS as a mark for a steak and seafood restaurant in 2005. Chutter’s predecessor-in-interest, Dan Tana, petitioned the TTAB to cancel the ’764 Registration based on an alleged likelihood of confusion with Mr. Tana’s common law “DAN TANA” mark for restaurant services. The cancellation proceeding was suspended during the pendency of civil action, in which Mr. Tana sued Great Concepts for trademark infringement. After the district court granted summary judgment in favor of Great Concepts and the Eleventh Circuit affirmed the ruling, the Board dismissed Mr. Tana’s cancellation proceeding “based on petitioner’s apparent loss of interest,” because he failed to respond to the Board’s order to show cause. Meanwhile, Great Concept’s former attorney filed a combined declaration of use under Section 8 of the Lanham Act and a declaration of incontestability under Section 15 with the PTO. The attorney declared, among other things, “there is no proceeding involving said rights pending and not disposed of either in the USPTO or in the court.” The statement was false because, when filing the declaration, the cancellation proceeding in the PTO and the Eleventh Circuit appeal from Mr. Tana’s district court action was still pending.

Chutter subsequently petitioned to cancel Great Concept’s registration based on the false Section 15 affidavit. The TTAB granted the petition.

This appeal followed.

**Holding:** Reversed and remanded.

Section 14 of the Lanham Act, 15 U.S.C. § 1064, sets out the grounds on which the registration of a mark may be challenged. At the outset, the Federal Circuit held Great Concepts had adequately presented its contentions to the Board that while an allegedly fraudulent Section 15 affidavit may affect a registration’s incontestability status, it cannot be used as a basis under Section 14 to cancel the registration. As an aside, the Federal Circuit opined that even if the issue had been waived, the reviewing court had the discretion to consider it since it was an issue of law and was fully vetted by the parties on appeal. Unlike the dissent, the panel majority rejected Chutter’s argument that the case involved a fraudulent Section 8 declaration.

Turning to the merits, the Federal Circuit held that Section 14 does not permit the TTAB to cancel a trademark’s registration due to the owner filing a fraudulent Section 15 declaration to acquire incontestability status for its already-registered mark. Section 14 is limited to situations where the registration is “obtained fraudulently.”

**FEDERAL CIRCUIT SUMMARY FOR WEEK ENDING OCTOBER 20, 2023****Monterey Research, LLC v. STMicroelectronics, Inc, Nos. 2022-1435, 2022-1771 (October 16, 2023) (nonprecedential); Patent No. 6,651,134****Key point(s):**

- Obviousness is a mixed question of fact and law and is subject de novo review while factual findings are reviewed for substantial evidence.

**Facts/Background:** Monterey Research, LLC (“Monterey”) owns the 6,651,134 (the ‘134) patent. The ‘134 patent is directed to “memory devices generally and, more particularly, to a memory device that transfers a fixed number of words of data with each access.” STMicro filed an IPR against claims of the ‘134 patent as obvious over U.S. Patent No. 6,115,280 (“Wada”) and U.S. Patent No. 5,584,033 (“Barrett”). Qualcomm filed a separate IPR against claims 1–7 and 9–21 of the ‘134 patent, asserting the claims were anticipated by U.S. Patent No. 5,600,605 (“Schaefer”) and obvious over Schaefer and other references. The Board issued two final written decisions, in favor of STMicro and Qualcomm and holding the claims invalid. Monterey appealed. Qualcomm withdrew from the appeal and the Patent and Trademark office intervened to defend the Board’s decision.

**Holding:** Affirmed. The Federal Circuit held that the ‘134 patent was obvious over the combination of Wada and Barrett and that the Board’s decision was supported by substantial evidence. The Board defined substantial evidence as relevant evidence that a reasonable mind might accept as adequate to support a conclusion. Based the Federal Circuit finding that the ‘134 patent was obvious over the combination of Wada and Barrett, the Federal Circuit declined to address the anticipation or obviousness challenge over Schaefer or to determine whether STMicro is a proper party for appeal.

**WSOU Investments LLC v. Google LLC., No. 2022-1063 (October 19, 2023) (nonprecedential); Patent Nos. 8,965,045 and 9,335,825**

**Key point(s):**

- A claim limitation when combined with an adequate description of what code is intended to accomplish does not invoke § 112 ¶ 6.

**Facts/Background:** WSOU owns U.S. Patent nos. 8,965,045 ('045 patent) and 9,335,825 ('825 patent). The '045 patent relates to image tracking and capture. Its claim limitation at issue is a “processor configured to” perform functional language. The '825 patent relates to controlling a device using gestures. Its claim limitation at issue is “at least one memory including computer program code, where the at least one memory and the computer program code are configured, with the at least one processor to cause the apparatus to . . .” perform certain functional language. The district court determined that the disputed limitations in both patents were written in means-plus function format, were subject to § 112 ¶ 6, and that the patents’ specifications did not disclose corresponding structure to perform the claimed functions. Thus, that the claims were indefinite. Based on the district court’s claim construction, the parties stipulated to final judgment that claims 1–17 of the '045 patent and claims 1–2 and 12 of the '825 patent are invalid as indefinite. This appeal followed.

**Holding:** Affirmed-in-part, reversed-in-part, and remanded. The Federal Circuit performed a two-step analysis. Step one determines whether the claim is written in means-plus function format. If so, step two determines what structure, if any, disclosed in the specification corresponds to the claimed function. With respect to step one, if the word “means” is not used, there is a rebuttable presumption the claim was not drafted in means-plus function format. This can be overcome if the challenger demonstrates that the claim term fails to recite a sufficiently definite structure, or recites function without reciting a sufficient structure for performing that function. On appeal, WSOU argued that the district court erred in its analysis of both steps. The appellate court affirmed the district court's holding on the '045 patent. The “processor” was written in means-plus function format because the specification described a processor as software, hardware, or a combination of the two. The specification also only described the processor in terms of its function. The reviewing court did not address step two because WSOU had not argued step two at the district court. The Federal Circuit reversed and remanded the district court's holding on the '825 patent, opining that Google failed to rebut the presumption of step one. The claim language itself provided structural guidance, reciting multiple elements and their connections to one another. Claim limitations like the recited “computer program code,” when combined with a description of what the code is intended to accomplish, convey definite structure to the skilled artisan. The broad claim terms, *i.e.*, “processor,” “memory,” and “computer program” did not invoke § 112 ¶ 6 because the claims provided structure and the specification described what each claim term was intended to accomplish.

**Cosmic Crusaders LLC v. Andrusiek, No. 2023-1150 (October 19, 2023) (nonprecedential), Reg Nos. 4,782,920**

**Key point(s):**

- Public association of a word or phrase may be inferred by the fact finder on the basis of indirect evidence regarding the opposer’s use of the word or phrase in advertising.

**Facts/Background:** Both parties sell comic books under the mark CAPTAIN CANNABIS, which is also the name of the main character. On April 2, 2014, Cosmic Crusaders filed for and eventually received Registration No. 4,782,920 for the mark CAPTAIN CANNABIS. Andrusiek filed a petition for cancellation, alleging his prior use of the same mark reached back into the 1970s. At the TTAB, both parties agreed the same mark was used on the same good, so the only dispute was priority. Cosmic Crusaders used its 2014 registration to evidence priority. Andrusiek did not have an existing registration, but argued his common law use started in January of 1999 due to sale activities at a trade fair in Louisiana and a commercial sale of a comic book to a customer in Florida in 2006. The Board first found that the priority claim rested on two separate arguments: actual trademark use and use of the mark analogous to trademark use. The Board ruled in favor of Andrusiek and found he engaged in analogous use of the mark starting in 2006 and engaged in “actual trademark use” in 2017, and that the actual trademark use was within a reasonable period of time after the analogous use. Cosmic Crusaders appealed.

**Holding:** Affirmed. The Federal Circuit held the TTAB did not abuse its discretion. Andrusiek explicitly distinguished his analogous use (i.e., repetitive use of the mark to create an association with the source of the product with potential purchasers before the product becomes available) and actual trademark use and gave fair notice of both uses by presenting evidence such as the marketing activities at the fair, and the bona fide commercial sale. Cosmic Crusaders did not seek to exclude the analogous use argument at the TTAB. The Federal Circuit also held that substantial evidence supported the TTAB’s findings regarding analogous use. Cosmic Crusaders argued that Andrusiek did not provide any evidence showing the public’s association of CAPTAIN CANNABIS and that the Board did not make sufficient findings about the specific size of the comic book market or number of marijuana consumers. The appellate court disagreed, reasoning that a fact finder can infer public association based on the opposer’s use of the word or phrase in advertising and that Andrusiek’s public use was well supported by the record by evidence of his promotion of his comic books via multiple appearances at tradeshows, promotional materials he circulated at tradeshows, interviews, shipping records, multiple news and magazine articles associating CAPTAIN CANNABIS with Andrusiek’s comic books, and the like. Cosmic Crusaders also argued that the Board lacked substantial evidence to conclude that Andrusiek ever used CAPTAIN CANNABIS as an actual trademark and the Board is using a title of a single comic book as the source identifier. The Federal Circuit disagreed, reasoning Cosmic Crusaders misstated the record and the TTAB relied on multiple pieces of evidence to determine Andrusiek used CAPTAIN CANNABIS as a mark.



**VirnetX Inc., v. Vidal, No. 2022-1523 (October 20, 2023) (nonprecedential); Patent No. 7,418,504****Key point(s):**

- The Federal Circuit will not vacate a decision from the Board absent a reason why the unreviewed Board decision would require the discretionary remedy of vacatur.

**Facts/Background:** VirnetX Inc. (“VirnetX”) owns US Patent No. 7,418,504 (’504 patent). Apple filed an IPR to invalidate claims 1-60 of the ’504 patent. The Board found that claims 1–2, 5–6, 15–16, 27, 33, 36–37, 39–40, 51, 57, and 60 were unpatentable. VirnetX appealed.

**Holding:** Dismissed. In particular, VirnetX challenged the Board’s determination that claim 5 is unpatentable. VirnetX argued the Board’s decision with respect to claims 36–37, 39–40, 51, 57, and 60 was moot in view of the Federal Circuit’s affirmance of rejections of claims 36–37, 39–40, 51, 57, and 60 in *VirnetX Inc. v. Apple Inc.*, 931 F.3d 1363 (Fed. Cir. 2019). VirnetX also argued the Board’s decision with respect to claims 1–2, 6, 15–16, 27, and 33 was moot based on the Federal Circuit’s affirmance of rejections of claims 1–2, 6, 15–16, 27, and 33 in *VirnetX Inc. v. Cisco Systems, Inc.*, 776 F. App’x 698 (Fed. Cir. 2019). During oral argument VirnetX also argued that if the Federal Circuit affirms the Board’s ruling in *VirnetX Inc. v. Cisco Systems, Inc.*, No. 22-2234, which was argued the same day as this case, then this case would be entirely moot. The Federal Circuit affirmed the Board’s decision in *VirnetX Inc. v. Cisco Systems, Inc.*, No. 22-2234. The Federal Circuit declined to vacate the Board’s decision in the case at hand because VirnetX has not offered any reason as to why the unreviewed Board decision would require the discretionary remedy of vacatur.

**FEDERAL CIRCUIT SUMMARY FOR WEEK ENDING October 20, 2023****Ottah v. Verifone System Inc., No. 2023-1219 (October 18, 2023) (nonprecedential); Patent No. 7,152,840****Key point(s):**

- Causes of action are the same for claim preclusion if the accused products are “essentially the same” and “the same patents are involved in both suits”.
- New arguments or infringement theories do not provide a meritorious basis to avoid the application of claim preclusion.

**Facts/Background:** Mr. Ottah filed a patent infringement suit against VeriFone, alleging that VeriFone’s mounts for electronic display screens infringe the ‘840 patent. The district court granted summary judgement of non-infringement, both as to literal infringement and infringement under the doctrine of equivalents. Mr. Ottah appealed and the Federal Circuit Affirmed. Eight years later, Mr. Ottah filed a new suit against VeriFone, again alleging infringement of the ‘840 patent. VeriFone filed a motion to dismiss based on the doctrine of claim preclusion. The district court granted the motion to dismiss. This appeal by Mr. Ottah followed.

**Holding:** Affirmed. The district court correctly concluded that that requirements for application of claim preclusion are satisfied: (1) both suits involve the same parties: Mr. Ottah and VeriFone; (2) the district court’s decision granting summary judgement of noninfringement is a judgement on the merits; and (3) both lawsuits involve the same cause of action since both allege infringement of the ‘840 patent by the same taxi display mount product. The Federal Circuit rejected the argument that claim preclusion does not apply because the patentee was asserting new arguments and infringement theories. The Federal Circuit agreed with the district court that the causes of action were the same because the accused products are essentially the same and the same patents were involved in both suits. Thus, claim preclusion bars adjudication of the lawsuit.

**VirnetX Inc., v. Cisco Systems, Inc., No. 2022-2234 (October 20, 2023) (nonprecedential); Patent No. 7,418,504**

**Key point(s):**

- Passages of a reference relied on by the patent holder do not “outweigh or limit the express disclosure” of the reference.

**Facts/Background:** VirnetX owns the ‘504 patent, which is directed to a domain name service that facilitates secure communication links between devices in a computer network. In an IPR proceeding, the Federal Circuit vacated the Board’s initial decision affirming an Examiner’s rejection of dependent claims 5, 12, and 13, and remanded to the Board with instructions to consider whether the Lendenmann reference disclosed the use of its remote procedure call (RPC) mode of communication. On remand, the Board again rejected claims 5, 12, and 13 and denied rehearing. The Board determine that the Examiner’s finding that Lendenmann uses the RPC mode of communication between a user and the CDS is supported by a preponderance of the evidence. The Board denied rehearing, explaining that the passages of Lendenmann that VirnetX relied on “did not outweigh or limit the express disclosures of Lendenmann” that were cited by the Board. This appeal followed.

**Holding:** Affirmed. VirnetX argued that the Board failed to: (1) support its reasoning with substantial evidence; (2) adequately explain its determination; and, (3) adequately consider VirnetX’s arguments. First, the Federal Circuit held that substantial evidence supported the Board’s affirmance of the rejection of claims 5, 12, and 13. Rather than directly challenging the Board’s findings, VirnetX repeatedly pointed to examples elsewhere in Lendenmann allegedly establishing that the CDS is merely involved in the process of making an RPC and that the RPC is executed only after the request to the CDS has already been made. VirnetX, however, did not reconcile its position with the Board’s contrary understanding of Lendenmann or meaningfully address the specific portions of Lendenmann relied on by the Board. Second, the Board adequately explained its reasoning. The Board identified and quoted parts of Lendenmann supporting its determination that a preponderance of evidence supports the Examiner’s findings. Third, the Board adequately responded to VirnetX’s argument. The Board’s decision acknowledged VirnetX’s argument but nonetheless found that the Examiner and Cisco’s position were more persuasive. The Board’s decision on rehearing further explained that the Board did not find VirnetX’s arguments sufficient to outweigh the evidence presented in the *Board Decision*. Therefore, the Federal Circuit was not persuaded that the Board erred in finding that Lendenmann discloses the claimed subject matter, and affirmed the Board’s affirmance of the Examiner’s rejection of claims 5, 12, and 13.

**VirnetX Inc., v. Apple Inc., No. 2022-1523 (October 20, 2023) (nonprecedential); Patent No. 6,502,135**

**Key point(s):**

- When a reference incorporates another document, the two references must be treated as one for anticipation purposes.
- Neither the PTO regulations, nor the APA, required the Commissioner or the Board to provide an explanation for a decision to deny rehearing.

**Facts/Background:** An *inter partes* reexamination proceeding was initiated on the ‘135 patent. At the conclusion of reexamination, the Examiner found several claims invalid for anticipation and obviousness. The Board reversed some of the Examiner’s rejections, but affirmed the rejections of claim 10-14 and 17-18. The Board upheld the Examiner’s rejection of claim 18 for obviousness on a combination of Beser, Kent, and Blum. The Board upheld the Examiner’s rejection of claim 18 for anticipation based on BinGO. The Board upheld the Examiner’s rejection of claims 10 and 12 as anticipated by BinGO. The Board upheld the Examiner’s rejection of claim 11 as obvious over a combination of BinGO and the reference Reed. This appeal followed.

**Holding:** Affirmed. VirnetX argued: (1) the Board “recrafted” claim 18, ignored the actual claim language, and failed to address the limitations set forth in the claim; (2a) the Board’s anticipation analysis relied on two separate references; (2b) the Board committed error when it relied on a finding that a person of ordinary skill in the art would have envisaged a limitation that is missing from the anticipating reference; (3a) the Board’s failure to render a decision itself on a request for rehearing violated 37 C.F.R. § 41.79(d); (3b) the Commissioner’s order did not adequately explain the basis for his denial of a request for rehearing; and (3c) it is unclear whether the Commissioner reviewed the request for rehearing on the merits rather than simply concluding that Director review is unavailable in *inter partes* reexamination proceedings. The Federal Circuit disagreed with VirnetX’s first argument, regarding the characterization of the Board’s treatment of claim 18. The Board walked through the limitations of claim 18 and pointed out how BinGO satisfied each of them. Throughout that analysis, the Board neither recrafted claim 18 nor misconstrued its limitations. The Federal Circuit held, regarding VirnetX’s argument 2a, the Board found that the User Guide incorporates the Extended Feature Reference and thus the two references must be treated as one for anticipation purposes. The Federal Circuit explained, with regard to VirnetX’s argument 2b, the appellate court has made clear that a reference can anticipate, even when it does not expressly recite a claimed limitation, if a person of ordinary skill in the art “would reasonably understand or infer from the prior art reference’s teaching that every claim [limitation] was disclosed in the single reference.” The Federal Circuit asserted in response to VirnetX’s argument 3a that, following the Supreme Court’s decision in *Arthrex*, VirnetX could have made clear that it wished to have the Board rule on its request for rehearing rather than seeking Director review, but it did not. Regarding arguments 3b and 3c, the Federal Circuit asserted that neither the PTO regulations, nor the APA, required the Commissioner or the Board to provide an explanation for a decision to deny rehearing.