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IP WEBINAR SERIES

BETTER SAFE THAN SORRY

IMPORTANT PATENT CASES IN 2022

January 23 |

Jitsuro Morishita
jitsuro.morishita@morganlewis.com

1. *Amgen v. Sanofi*
2. *Thaler v. Vidal*
3. *Caltech v. Broadcom*
4. *Opensky v. VLSI*
5. Update on WDTX

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AMGEN V. SANOFI

Amgen v. Sanofi (U.S. 21-757)

実施可能要件 - Enablement

35 U.S.C. § 112 – Specification

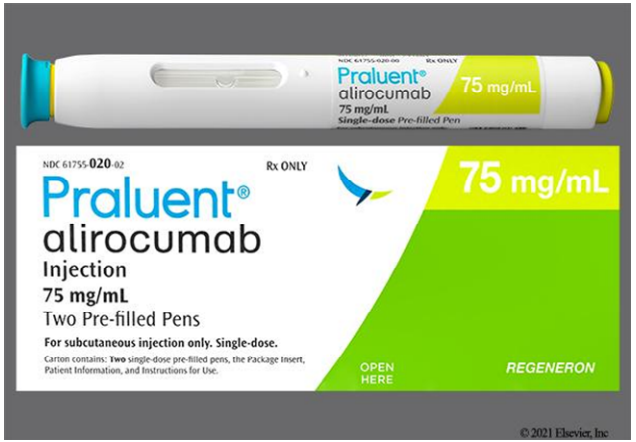
(a) IN GENERAL.—The specification shall contain a written description of the invention, and of **the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains**, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

Amgen v. Sanofi (U.S. 21-757)

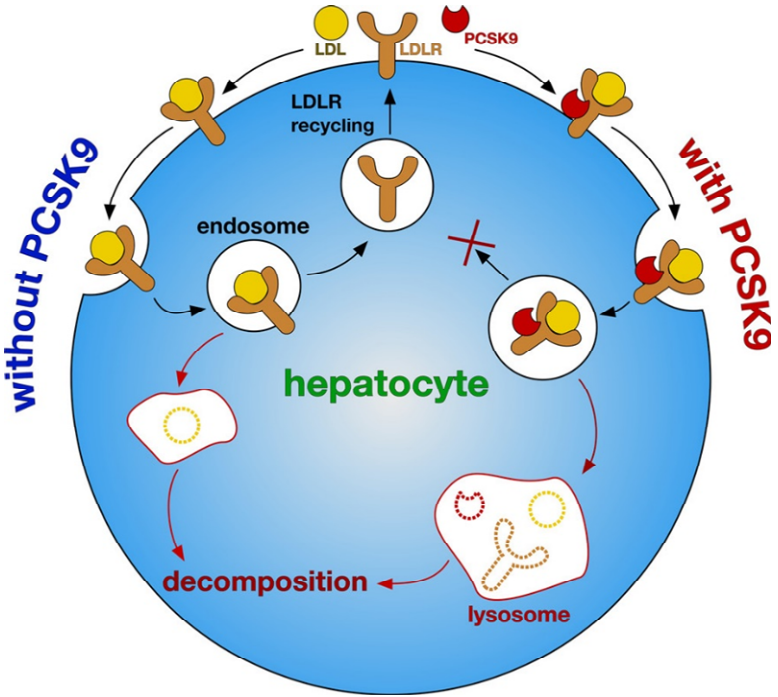
US8,829,1165

Claim 29. A pharmaceutical composition comprising an isolated monoclonal antibody,

wherein the isolated monoclonal antibody binds to at least two of the following residues S153, I154, P155, R194, D238, A239, I369, S372, D374, C375, T377, C378, F379, V380, or S381 of PCSK9 listed in SEQ ID NO:3 and blocks the binding of **PCSK9 to LDLR** by at least 80%.



Amgen v. Sanofi (U.S. 21-757)

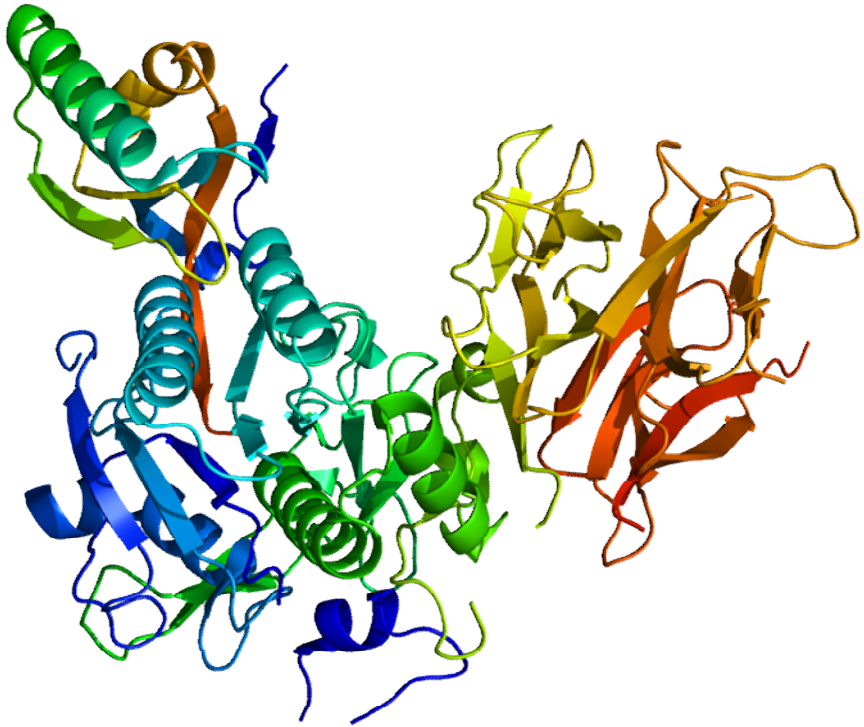


PCSK9: ヒトプロタンパク質転換酵素サブチリシン
LDLR: LDL(コレストロール)受容体タンパク質

Amgen v. Sanofi (U.S. 21-757)

US8,829,1165

…wherein the isolated monoclonal antibody binds to at least two of the following residues S153, I154, P155, R194, D238, A239, I369, S372, D374, C375, T377, C378, F379, V380, or S381 of PCSK9 listed in SEQ ID NO:3 and blocks the binding of PCSK9 to LDLR by at least 80%.



*No recitation of any structural limitations of the ***antibody***

Amgen v. Sanofi (Fed. Cir. 2021)

"What emerges from our case law is that the enablement inquiry for claims that include functional requirements can be particularly focused on the breadth of those requirements, especially where predictability and guidance fall short. In particular, it is important to consider the quantity of experimentation that would be required to make and use, **not only the limited number of embodiments that the patent discloses, but also the full scope of the claim**."

Amgen v. Sanofi (U.S. 21-757)

Issue: Whether enablement is governed by the statutory requirement that the specification teach those skilled in the art to "make and use" the claimed invention, or whether it must instead enable those skilled in the art "to reach the full scope of claimed embodiments" without undue experimentation—i.e., to cumulatively identify and make all or nearly all embodiments of the invention without substantial "time and effort."

THALER V. VIDAL

Thaler v. Vidal (Fed. Cir. 2022)

AIの発明者要件 – AI as an Inventor

35 U.S.C. § 112 – Inventor's oath or declaration

(a) NAMING THE INVENTOR; INVENTOR'S OATH OR DECLARATION. —An application for patent that is filed under section 111(a) or commences the national stage under section 371 shall include, or be amended to include, the name of the inventor for any invention claimed in the application. Except as otherwise provided in this section, **each individual** who is the inventor or a joint inventor of a claimed invention in an application for patent shall execute an oath or declaration in connection with the application.

Thaler v. Vidal (Fed. Cir. 2022)

Stephen L. Thaler, Ph.D.,

President & CEO, Imagination Engines, Inc.

Brightest Technical Moments:

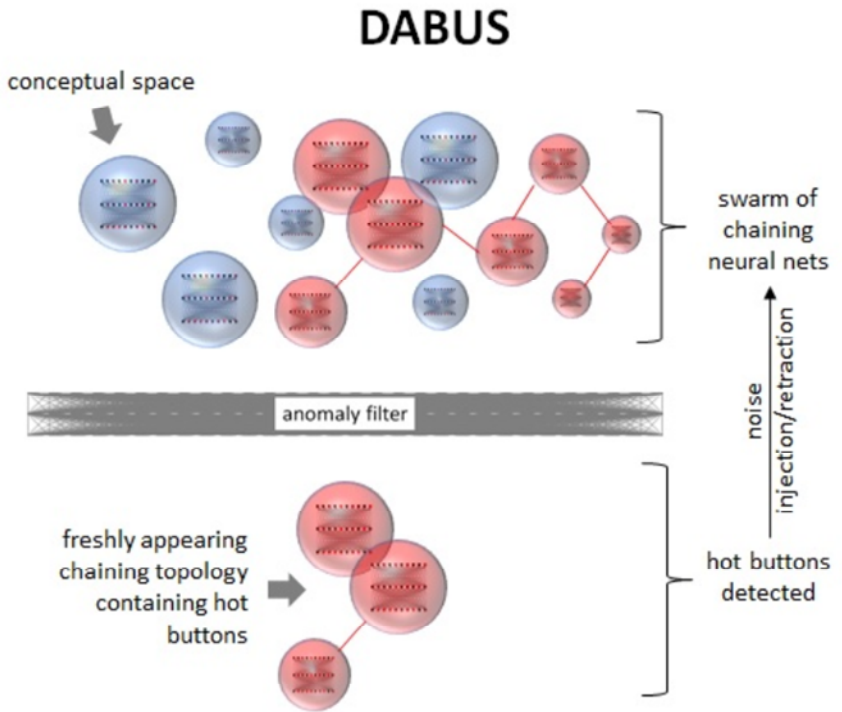
Diamonds - While employed as a materials scientist for aerospace giant McDonnell Douglas in 1986, Thaler invented the fastest diamond deposition technique in the world. Using high-energy lasers borrowed from the 'Star Wars' initiative, Thaler was able to grow single crystals of diamond as well as convert the native carbon within tungsten carbide and high-speed steel tools to the diamond phase. Of course, at the root of his success was the use of artificial neural networks to determine the sweet spots for diamond growth within a high-dimensional process space.

Brain Trauma and Death - In 1992, Thaler shocked the world with bizarre experiments in which the neurons within artificial neural networks were randomly destroyed. Guess what? The nets first relived all of their experiences (i.e., life review) and then, within advanced stages of destruction, generated novel experience. From this research emerged both a compelling mathematical model of near-death experience (NDE) and the basis of truly creative and contemplative artificial intelligence.

Thaler v. Vidal (Fed. Cir. 2022)

U.S. App. No. 16/524,350:
Flickering light that mimics neural activity

U.S. App. No. 16/524,532:
Fractal drink container for robots



Thaler v. Vidal (Fed. Cir. 2022)

Patent Act expressly provides that inventors must be "individuals".

When used "[a]s a noun, 'individual' ordinarily means a human being, a person."

Inventors must be *natural persons* and cannot be corporations or sovereigns.

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CALTECH V. BROADCOM

Cali. Inst. of Tech. v. Broadcom Ltd. (Fed. Cir. 2022)

IPR禁反言 – IPR Estoppel

35 U.S.C. § 351 – Relation to other proceedings or actions

(e)ESTOPPEL.—(1)PROCEEDINGS BEFORE THE OFFICE.—The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, **may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review**.

Cali. Inst. of Tech. v. Broadcom Ltd. (Fed. Cir. 2022)

Los Angeles Times

BUSINESS

Caltech wins a $1.1-billion patent verdict against Apple and Broadcom

Caltech's win is the biggest jury verdict of any kind so far this year and the sixth-largest patent verdict of all time, according to Bloomberg data. Apple and Broadcom plan to appeal. (Ricardo DeAratanha / Los Angeles Times)

Cali. Inst. of Tech. v. Broadcom Ltd. (Fed. Cir. 2022)

Both parts of § 315(e) create estoppel for arguments "on any ground that the petitioner raised or reasonably could have raised *during* that inter partes review." Shaw raised its Payne-based ground in its petition for IPR. The PTO denied the petition as to that ground, thus no IPR was instituted on that ground…Thus, Shaw did not raise — nor could it have reasonably raised — the Payne-based ground *during* the IPR. The plain language of the statute prohibits the application of estoppel under these circumstances.

See Shaw Industries Group, Inc. v. Automated Creel Systems, Inc. (Fed. Cir. 2016)

"[W]e take this opportunity to overrule *Shaw* and clarify that estoppel applies not just to claims and grounds asserted in the petition and instituted for consideration by the Board, but to all claims and grounds not in the IPR but which reasonably could have been included in the petition.

Cali. Inst. of Tech. v. Broadcom Ltd. (Fed. Cir. 2022)

Errata to the opinion:

"[W]e take this opportunity to overrule *Shaw* and clarify that estoppel applies not just to claims and grounds asserted in the petition and instituted for consideration by the Board, but to all ~~claims and~~ grounds not stated in the ~~IPR~~ petition but which reasonably could have been ~~included in the petition~~ asserted."

*Estoppel does not apply to claims not in the IPR petition.

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OPENSKY V. VLSI TECHNOLOGY

OpenSky Indus. LLC v. VLSI Tech. LLC (IPR 2022)

USPTO長官レビュ – Director Review

- Former patent litigator and **managing partner** for a large law firm in Silicon Valley
- Technical background in **electrical engineering**
- Master's thesis was about **artificial intelligence**
- Worked for **GE** and **Lockheed Martin** before practicing law
- Industry reaction has been mostly positive, although some have expressed concern about **Vidal's close connections to Silicon Valley**

OpenSky Indus. LLC v. VLSI Tech. LLC (IPR 2022)

ars TECHNICA BIZ & IT TECH SCIENCE POLICY CARS GAMING & CULTURE STO

BILLION WITH A B —

Intel hit with $2.2 billion patent judgment

Patents claim methods of varying voltages and clock frequencies to save power.

TIMOTHY B. LEE - 3/3/2021, 7:33 AM

David Paul Morris/Bloomberg via Getty Images

OpenSky Indus. LLC v. VLSI Tech. LLC (IPR 2022)

v.

intel®

OpenSky Industry LLC

OpenSky Indus. LLC v. VLSI Tech. LLC (IPR 2022)

"Viewed as a whole, OpenSky's conduct has been an **abuse of the IPR process**, the patent system, and the Office. The totality of OpenSky's conduct evinces a singular focus on **using an AIA proceeding to extort money**, from any party willing to pay, and at the expense of the adversarial nature of AIA proceedings."

"**The Director will ensure that the remedy suits the wrongdoing**, both in this specific case and more generally when faced with evidence of an abuse of process or conduct that thwarts, rather than advances, the goals of the Office and the AIA."

OpenSky Indus. LLC v. VLSI Tech. LLC (IPR 2022)

"I recognize that some may believe that **I am allowing Intel to benefit** from OpenSky's wrongdoing by not immediately terminating the proceeding. However, there is no evidence that Intel was complicit in OpenSky's abuse. I therefore focus on a principled, replicable approach that is **in the best interest of the public and advances the USPTO and AIA goals** to "consider . . . the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings." 35 U.S.C. § 316(b).

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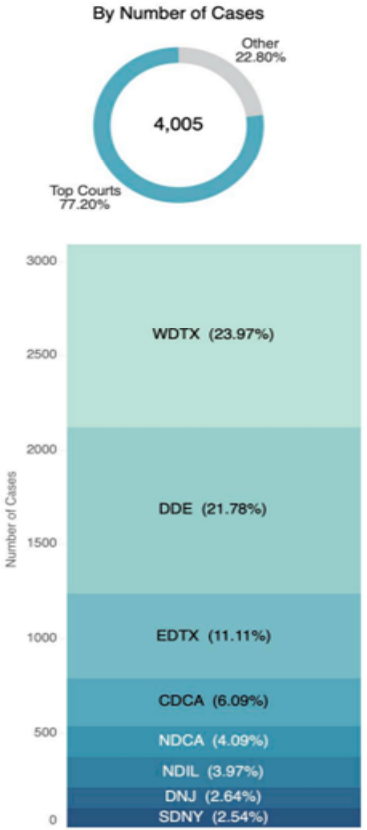
WDTX UPDATE

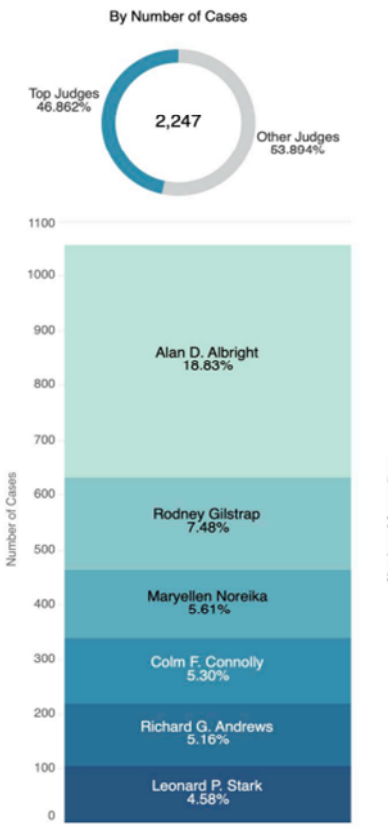
Western District of Texas: Waco

Judge Albright (62)
Appointed by President Trump in 2018

1 in 5

Number of patent cases nationwide assigned to Judge Albright





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Reaction from the U.S. Congress

NEWS

Sens. Leahy and Tillis Slam the Nation's Busiest Patent Judge, Calling for Study of 'Actual and Potential Abuses'

Sens. Patrick Leahy, left, D-Vermont, and Thom Tillis, right, R-North Carolina.

United States Senate
COMMITTEE ON THE JUDICIARY
WASHINGTON, DC 20510-6275

VIA ELECTRONIC TRANSMISSION

November 2, 2021

The Honorable Chief Justice John Roberts
Presiding Officer
Judicial Conference of the United States
One Columbus Circle, NE
Washington, D.C. 20544

Dear Mr. Chief Justice:

We write you to express our concern about problems with forum shopping in patent litigation. Our understanding is that in some judicial districts, plaintiffs are allowed to request their case be heard within a particular division. When the requested division has only one judge, this allows plaintiffs to effectively select the judge who will hear their case. We believe this creates an appearance of impropriety which damages the federal judiciary's reputation for the fair and equal administration of the law. Worse still, such behavior by plaintiffs can lead individual judges to engage in inappropriate conduct intended to attract and retain certain types of cases and litigants.

We are particularly concerned with this problem in the context of patent litigation. In the last two years our nation has seen a consolidation of a large portion of patent litigation before a single district court judge in Texas. In 2016 and 2017, this single district court heard only, on average, one patent case per year.[1] Last year, however, nearly 800 patent cases were assigned to one judge in this district.[2] This year, this district appears to be on track to have more than 900 cases.[3] This means that roughly 25% of all the patent litigation in the entire United States is pending before just one of the nation's more than 600 district court judges.[4]

The concentration of patent litigation is no accident. We understand that a single judge in this district has openly solicited cases at lawyers' meetings and other venues and urged patent plaintiffs to file their infringement actions in his court.[5] Our understanding is that this single

[1] *See* Anderson & Gugliuzza, "Federal Judge Seeks Patent Cases," 71 Duke Law Journal __ (2021) (forthcoming), available at https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3668514, at 2.
[2] *See* Dani Kass, "Judge Albright Now Oversees 20% Of New US Patent Cases," Law360, March 10, 2021 (noting that 793 patent cases were assigned to Judge Albright in 2020).
[3] Ryan Davis, "WDTX Now Has 25% Of All US Patent Cases," Law360, Jul. 2, 2021 (noting that "nearly all" of the 489 cases filed in W.D. Tex. have been assigned to Judge Albright).
[4] *Id.* (noting that over the past six months roughly 25% of U.S. patent cases have filed in W.D. Tex. and that almost all of these have been assigned to Judge Albright).
[5] *See* Anderson & Gugliuzza, *supra* n. 1, at 3, 29 (noting that since his appointment, Judge Albright "has spoken at patent law conferences, been the keynote speaker at dinners hosted by patent valuation companies, appeared on law firm webcasts about patent litigation, and presented at numerous patent bar events, all with the express purpose of encouraging patentees to file suit in his court.").

1

Chief Justice Roberts

"I have asked the Director of the Administrative Office, who serves as Secretary of the Judicial Conference, to put the issue before the Conference."

FILED

JUL 25 2022

CLERK, U.S. DISTRICT COURT
WESTERN DISTRICT OF TEXAS
BY _____
DEPUTY

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

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.[1]

Chief U.S. District Judge Orlando Garcia, San Antonio Division

U.S. District Judge Fred Biery, San Antonio Division

U.S. District Judge Alia Moses, Del Rio Division

U.S. District Judge Lee Yeakel, Austin Division

U.S. District Judge Kathleen Cardone, El Paso Division

U.S. District Judge Frank Montalvo, El Paso Division

U.S. District Judge Xavier Rodriguez, San Antonio Division

U.S. District Judge Robert Pitman, Austin Division

U.S. District Judge David Counts, Midland/Odessa and Pecos Divisions

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 25th day of July 2022.

ORLANDO L. GARCIA
CHIEF UNITED STATES DISTRICT JUDGE

December 16, 2022
CLERK, U.S. DISTRICT COURT
WESTERN DISTRICT OF TEXAS

BY: R. Amaro
DEPUTY

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

§
§
§

AMENDED ORDER ASSIGNING THE BUSINESS OF THE COURT

Pursuant to Section 137 of Title 28, United States Code, and to streamline previous orders, all cases, proceedings, and matters shall be assigned to the district judges of this Court as follows:

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

SIGNED this 16th day of December 2022.

ALIA MOSES
UNITED STATES DISTRICT JUDGE

Morgan Lewis

ANNOUNCEMENTS

SEPTEMBER, 2022

発明 THE INVENTION

Special Reports　令和４年度全国発明表彰 恩賜発明賞受賞者にきく

ニッポンのモノづくりと知財部を応援する 月刊「発明」

米国特許技術論争の論点整理

第１回　Preamble ～権利範囲か権利範囲でないか

米国特許の技術論争に際してクレームを読み解く特許実務者が最初に突き当たる論点の一つに、クレーム前文（Preamble）がある。Preambleを限定と解すか否かは対象クレームの侵害性と有効性に関わってくるため、技術論争を行う際には必須の検討事項であるといえる。この米国特許法特有の論点に関し、押さえるべき基本的な考え方と留意すべき例外事項について、実際の判例および筆者の経験に基づいて解説する。

森下 実郎
Morgan, Lewis & Bockius LLP
California/Washington D.C. 弁護士、
外国法事務弁護士

1．はじめに

昨今クライアント企業とお話をさせていただくなかで、特許係争自体の減少や新型コロナウイルス感染症の影響で対面での交渉機会が減っていることから、若手社員が技術論争を経験する機会が少なくなってきており、いざ事が起こった際にきちんと対応できるかどうか不安だ、という声を数多く耳にしてきました。また、技術論争を経験している者が減っていることは、権利行使に耐え得る強い米国特許クレームの創出にも悪影響を及ぼしているのではないか、との問題意識を共有されることも度々ありました。

幸いなことに筆者は、国内企業の知的財産部で計10年間渉外業務に携わってきたなかで、国内外のグローバル企業を相手に米国特許の侵害性、有効性を争う数々の技術論争を経験することができました。現在、米国弁護士として特許権侵害訴訟や出願業務に関わる際に、相手の特許クレームを攻撃するウィークポイントの見いだし方や、相手に付け込まれない隙のないクレームを作り上げる作業工程のなかで、知財部員としてくぐり抜けてきた技術論争で得た知見や経験が、自身のバックボーンとして大いに役立っていることを実感し、大変感謝しています。

上記クライアント企業の問題意識に応える目的と自身の恩返しの意味も込めて、2022年から国内企業の知財部員同士が会社対抗でシミュレーション的に技術論争を行う演習をスタートさせ、ありがたいことに大きな反響をいただきました。本号から連載させていただく本論考は、当該演習の際に用いた技術論争における基本的な論点に係る講義資料をベースにしたものです。米国特許クレームの攻撃と防御に関する基本的な論点をおさらいして将来の技術論争に備えるとともに、より隙のない強い米国特許クレームを書き上げるためのキーポイントについてヒントを得ていただくことを目指しています。

対象読者としては経験年数５～10年程度の若手の知財部員（渉外部門・権利化部門）を想定していますが、それ以上の経験を有するベテランの方にも自身の知見の点検と新たな気付きを得ていただければ望外の幸せです。

2．Preambleに関する基本的な考え方

（1）Preambleのクレーム解釈原則

「Preambleの目的は、クレームされた発明の一般的な性質を示すことにある。一般的に、クレームされた発明の権利範囲の境界を画定するための限定要因として意図されたり、使用されたりすることはない」[注1]

上記判例趣旨のとおり、米国特許法におけるクレーム前文（Preamble）の解釈を行う際の基本的な原則は「権利範囲として取り扱わない」というものであり、請求項全体を権利範囲とする日本特許法上の原則とは大きく異なります。特に、Preambleが発明の目的や用途を記載しただけの場合、一般的に当該目的や用途（例：サトウの切り餅事件「焼き網に載置して焼き上げて食する」）は権利範囲になりません。

IP Webinar Series: Better Safe than Sorry 2023

No. 1: Important IP Cases	(2023.01.23)
No. 2: Preamble	**(2023.03.13)**
No. 3: A-C Privilege	(2023.05.22)
No. 4: Means Plus Function	(2023.07.24)
No. 5: Extraterritorial Activity	(2023.09.25)
No. 6: US Litigation Basics	(2023.11.20)

Biography

Jitsuro Morishita
Partner
Tokyo: 03-4578-2530
Mobile: 070-1498-0066
Jitsuro.morishita@morganlewis.com

Jitsuro Morishita devotes his practice to resolving complex global disputes in the areas of intellectual property, antitrust, governmental investigations, environmental issues, and labor.

Early in his career, he worked in-house for two global technology companies, Pioneer Corporation and Fujifilm Corporation, bringing unique expertise to advocate using profound understanding of Japanese company cultures.

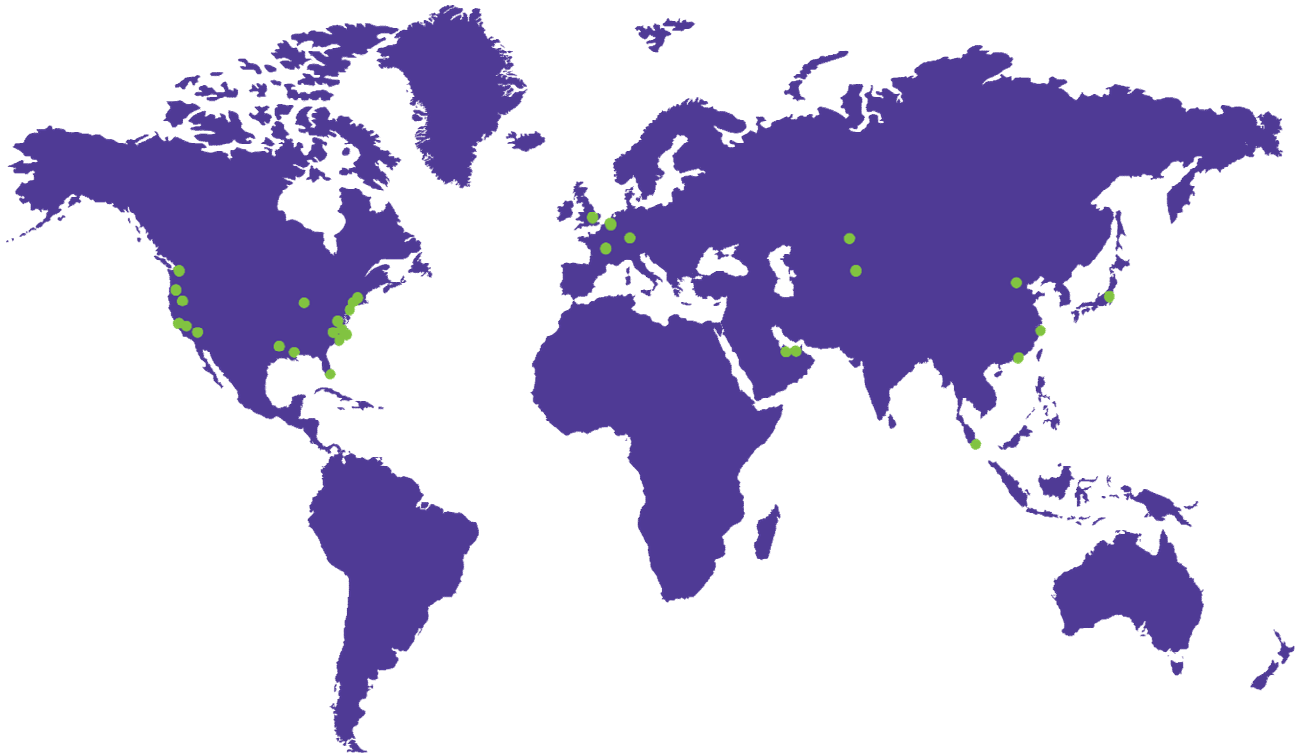
Jitsuro is devoted to bringing his clients (i) easy communication using excellent communication skills, (ii) pleasant surprises from creative and out-of-the-box ways of thinking, and (iii) deep satisfaction through great results and client-friendly experiences.

Our Global Reach

Africa
Asia Pacific
Europe
Latin America
Middle East
North America

Our Locations

Abu Dhabi
Almaty
Astana
Beijing*
Boston
Brussels
Century City
Chicago
Dallas
Dubai
Frankfurt
Hartford
Hong Kong*
Houston
London
Los Angeles
Miami
New York
Orange County
Paris
Philadelphia
Pittsburgh
Princeton
San Francisco
Seattle
Shanghai*
Silicon Valley
Singapore*
Tokyo
Washington, DC
Wilmington



Morgan Lewis

THANK YOU