

INTELLECTUAL PROPERTY LITIGATION NEWSLETTER

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Case Highlights

New Trial Ordered Due to Erroneously Excluding a Witness to Authenticate Relevant Documents and Failing to Consider Whether Plaintiff Properly Apportioned the Licensed Patents Not Asserted in Damages

Jiaxing Super Lighting Electric Appliance Co. v. CH Lighting Technology Co., No. 23-1715 (Fed. Cir. July 28, 2025) (Judge Dyk, joined by Judges Chen and Hughes) (appeal from W.D. Tex.).

The Federal Circuit remanded the case for a new trial for validity of the asserted patents and damages. As to validity, the Federal Circuit found that, among other things, the district court erred in excluding a witness from authenticating prior art documents. "Although we recognize that district courts have wide latitude to make determinations about the admissibility of evidence at trial, we perceive no reasonable basis for the district court's decision here to exclude a competent witness from authenticating documents previously identified as trial exhibits." As to damages, the defendant argued that the plaintiff's damages expert "[f]ailed to apportion the license fees to account for licensed patents that were not asserted," but the district court failed to provide any explanation in rejecting such argument. Explaining that "expert testimony should be excluded when it fails to allocate license fees among the licensed patents covered by an agreement," the Federal Circuit instructed the district court to "consider whether [the plaintiff] properly apportioned damages" on remand.

Prosecution History Estoppel Inquiry Should Consider the Patent as a Whole, Not Each Claim in Isolation

Colibri Heart Valve LLC v. Medtronic CoreValve LLC, No. 23-2153 (Fed. Cir. July 18, 2025) (Judge Taranto, joined by Judges Hughes and Stoll) (appeal from C.D. Cal.).

The Federal Circuit reversed the district court's denial of judgment as a matter of law of noninfringement because the district court erred in not applying prosecution history estoppel. The Federal Circuit found that "[w]hen evaluating prosecution history estoppel, we do not address each claim in isolation, considering only whether that asserted claim was amended." Instead, the inquiry should be tailored "to the scope of the claims of the patent as a whole, pre- and post-amendment." Here, the Federal Circuit concluded that the *canceled* claim during the prosecution narrowed the patent's scope to the subject matter in question, triggering prosecution history estoppel to apply, which barred the plaintiff's infringement theory under the doctrine of equivalents.

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Other Notable Cases

The PTO's Determination Not to Apply Interference Estoppel Not Reviewable on Appeal

IGT v. Zynga Inc., No. 23-2262 (Fed. Cir. July 22, 2025) (Judge Taranto, joined by Judges Prost and Reyna) (appeal from PTAB).

The Federal Circuit held that the predecessor of the Patent Trial and Appeal Board's (PTAB) determination not to apply interference estoppel was within the general rule of unreviewability and thus, not appealable. Although the Supreme Court in *Cuozzo Speed Technologies, LLC v. Lee*, 579 U.S. 261 (2016) "suggested that there might be exceptions to the general rule of unreviewability where the agency engaged in blatant violations of legal constraints or other 'shenanigans,'" the Federal Circuit found that there was no reversible error on the record that would justify such an exception to the rule.

Defendant Hit With Nearly \$3 Million Sanction for "Duping" the Court into Postponing Trial and Reopening Discovery

Guardant Health Inc. v. Natera Inc., No. 3:21-cv-04062 (N.D. Cal. July 9, 2025) (Judge Chen).

The court sanctioned the defendant with attorneys' fees and costs of almost \$3 million. The court determined that the defendant made deliberate misrepresentation to the court regarding certain evidence that "duped" the court into believing that reopening discovery and postponing trial schedule were warranted. The court agreed with the plaintiff that the attorneys' fees for around 2,000 hours and associated costs were reasonable. The work incurred because of the sanctionable conduct consisted of "written discovery, third-party discovery, preparing, taking, and/or defending the depositions of numerous experts and third-parties, preparing multiple new expert reports, and extensive motion practice." The court deferred whether to apportion the sanctioned amount among the defendant and counsel, and whether to award punitive sanctions, stating that it will appoint a special master to resolve such questions.

Alston & Bird by the Numbers

Alston & Bird secured a win for InterDigital in a high-stakes international arbitration with Samsung. The dispute centered on the valuation of InterDigital's patent portfolio. After a 10-day merits hearing and a full-day closing statement and oral argument, the arbitration panel awarded InterDigital \$1.05 billion for an eight-year patent license.