

INTELLECTUAL PROPERTY LITIGATION
NEWSLETTER

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Case Highlights

Any Incongruity Between the Inventors of the Prior Reference and the Patent at Issue Renders the Prior Reference “By Another” Under Pre-AIA Sections 102(a) and (e)

Merck Serono S.A. v. Hopewell Pharma Ventures Inc., No. 25-1210 (Fed. Cir. Oct. 30, 2025) (Judge Linn, joined by Judges Hughes and Cunningham) (appeal from PTAB).

The Federal Circuit clarified its precedent on the interpretation of the phrase “by others” or “by another” under pre-AIA 35 U.S.C. §§ 102(a) and (e) when a reference and the patent-in-suit identify overlapping inventors: “when the patented invention is the result of the work of joint inventors, the portions of the reference disclosure relied upon must reflect the collective work of the same inventive entity identified in the patent to be excluded as prior art.” The Federal Circuit further clarified that “[a]ny incongruity in the inventive entity between the inventors of a prior reference and the inventors of a patent claim renders the prior disclosure ‘by another,’ regardless of whether inventors are subtracted from or added to the patent.”

Secret Sales of Prior Art Devices That Embody the Claimed Invention Can Trigger On-Sale Bar Under Section 102(b)

Cisco Systems Inc. v. Ramot at Tel Aviv University Ltd., No. 1:21-cv-01365 (D. Del. Oct. 23, 2025) (Judge Williams).

The court found that “[s]ecret sales by third parties, even sales where there is no disclosure of the claimed invention, can trigger [35 U.S.C. § 102(b)]’s on-sale bar if the sold product embodies the claimed invention.” The court distinguished devices embodied by the claims from the devices manufactured by a claimed process. If the prior art device was merely *manufactured* using a method claimed in the asserted patents, then the device would not qualify as prior art under Section 102(b)’s on-sale bar. On the other hand, if the prior device *practices* a method claimed in the asserted patent, it may be considered a “sale of the process *per se*,” qualifying it as prior art. For the latter, the court determined that even if the circuitry of the prior art device is not discernable by the public or purchaser, it may still qualify as prior art under Section 102(b).

Other Notable Cases

Judicial Estoppel Argument Forfeited in Appeal for Failure to Develop Any Argument for Such Application in the District Court

Aortic Innovations LLC v. Edwards Lifesciences Corporation, No. 24-1145 (Fed. Cir. Oct. 27, 2025) (Judge Reyna, joined by Judges Prost and Chen) (appeal from D. Del.).

The Federal Circuit rejected the patentee’s argument that the defendant should be judicially estopped from taking a claim construction position in front of the district court that was contrary to the position taken in front of the Patent Trial and Appeal Board (PTAB). Although the patentee noted to the district court that the defendant took a contrary position in the PTAB, the patentee failed to develop any argument for application of judicial estoppel. This was even after the defendant preemptively addressed the patentee’s lack of an estoppel-based argument to the district court. Accordingly, the Federal Circuit held that the patentee’s “judicial-estoppel argument as not having been raised before the district court and thus forfeited in this appeal.”

Claims Dismissed Before Trial for Purposes of Narrowing the Patent Case Should Be with Prejudice

Nexus Pharmaceuticals Inc. v. Exela Pharma Sciences LLC, No. 1:22-cv-01233 (D. Del. Oct. 21, 2025) (Judge Williams).

The court held that the claims the plaintiff dismissed before trial for purposes of narrowing the patent case should be dismissed with prejudice, rejecting the plaintiff’s argument that the dismissal should be without prejudice. The court determined that it was not unfair to require the plaintiff to give up certain claims before trial because “the case narrowing process in the instant action was even-handed and fair since it required [the plaintiff] to narrow its asserted claims and required [the defendant] to narrow its asserted defenses.” Importantly, the court observed that “[t]he fact that [the plaintiff] was unsuccessful at trial should not allow [the plaintiff] to get a second bite at the apple by now asserting those claims that it dismissed prior to trial.” The court found that this finding would avoid undermining the certainty of the trial process and the resulting endless litigation.

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