

# The Fed. Circ. In 2024: 5 Major Rulings To Know

By **Jeremiah Helm and Sean Murray** (January 21, 2025)

*This article is part of a monthly column that highlights an important patent appeal. In this installment, we examine 2024's most significant rulings.*

Sometimes the U.S. Court of Appeals for the Federal Circuit has a year in which its decisions reveal a broad theme or trend in the court's jurisprudence. 2024 was not such a year. But while the patent issues at play varied greatly in the court's 2024 rulings, the year included several significant decisions that helped clarify distinct areas of law.

In some cases, this clarification resulted in the overhaul of decades-long precedent. Below is a selection of noteworthy rulings from the past year that are poised to influence the Federal Circuit — and patent law as a whole — in 2025 and beyond.

## 1. LKQ v. GM Global Technology Operations

One such impactful decision was LKQ Corp. v. GM Global Technology Operations LLC, the court's only en banc decision in a patent case last year. The May ruling in the LKQ case announced a major shift by adopting an entirely new standard for design patent obviousness.

In the three decades before the court's en banc ruling, the Federal Circuit applied what was typically called the Rosen-Durling test for assessing the obviousness of design patents. That test imposed a high standard for proving obviousness, one that required near identity between the prior art and the challenged design patent.

The Federal Circuit took the LKQ case en banc to correct what it perceived to be a conflict between the Rosen-Durling test and the U.S. Supreme Court's 2007 holding in KSR International Co. v. Teleflex Inc., which required a flexible approach to obviousness for utility patents.

The LKQ ruling eliminated the rigid "basically the same" standard used in the Rosen-Durling test. Instead, the LKQ opinion explained that the motivation to combine different prior art references to achieve the claimed design could come from a range of sources, as long as an ordinary designer in the field would have modified the prior art to create the same overall appearance as the claimed design. The LKQ ruling thus harmonized the law of obviousness applied to design patents with the law of obviousness applied to utility patents.

What this harmonization means in practical terms will take time and additional cases to suss out, but the LKQ ruling fundamentally changed how design patents will be litigated and will likely result in many more successful validity challenges to design patents.

## 2. EcoFactor v. Google

The Federal Circuit's June decision in EcoFactor Inc. v. Google LLC will also have important consequences moving forward. The EcoFactor ruling dealt with the complicated issue of



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reconciling the jury's role as the sole finder of fact, and the judge's role as the gatekeeper who ensures that expert testimony presented to the jury is sufficiently reliable to be admissible under Rule 702 of the Federal Rules of Evidence and the Supreme Court's 1993 *Daubert v. Merrell Dow Pharmaceuticals Inc.* ruling.

The majority in the *Ecofactor* opinion held that the U.S. District Court for the Western District of Texas properly admitted expert testimony on damages that was based on three prior licensing agreements. In the majority's view, the jury could assess the factual underpinnings of that testimony and make credibility determinations about the degree to which the licensing agreements supported the expert's opinion.

U.S. Circuit Judge Sharon Prost, however, dissented from the majority's analysis, and suggested that the issue of whether the expert testimony could be supported by the licenses was part of the admissibility analysis required by Rule 702. Judge Prost explained that, in her view, the district court erred by allowing the expert testimony to be presented to the jury and suggested the testimony should have been excluded as part of the court's gatekeeping role under *Daubert*.

The *Ecofactor* ruling took on additional importance after the Federal Circuit granted a petition for en banc review in September and ordered briefing on the district court's application of Rule 702 and *Daubert*. *Ecofactor* thus has the potential to fundamentally change how judges approach expert testimony in patent cases.

### **3. Allergan v. MSN Laboratories**

The Federal Circuit's August ruling in *Allergan USA Inc. v. MSN Laboratories Private Ltd.* addressed the interaction of the doctrine of obviousness-type double patenting and the statutorily mandated "patent term adjustments."

Typically, patents are given a term of 20 years from the date of filing. But delays in the U.S. Patent and Trademark Office may lead to a substantially shorter effective term. When the patent office causes a delay in issuing a patent, it gives the patentee an additional patent term in the form of a patent term adjustment. Previously the Federal Circuit held that obviousness-type double patenting could invalidate the patent term adjustment granted for patent office delay.

The *Allergan* ruling, however, clarified that when the extra time is applied to the earlier-filed patent, and earlier issued claims, there was no unjust extension of the patent term, and therefore obviousness-type double patenting did not apply.

This result comports with the general goal of the obviousness-type double patenting doctrine, which aims to prevent a patentee from unjustly receiving an extension of patent term by filing multiple applications that claim similar variations of an invention. When the first patent filed and first claims issued have the longest term, any concerns related to unjust extension of the patent term using sequential patent filings are considerably decreased. the *Allergan* ruling's carveout thus preserves an importance source of patent term for such earlier-filed patents.

### **4. Sanho v. Kaijet Technology**

The Federal Circuit's July ruling in *Sanho Corp. v. Kaijet Technology International Limited Inc.* clarified the interaction between the America Invents Act and the impact of secret sales of a product before patent filing.

Typically, an aspiring patentee must seek patent protection before publicly disclosing the invention or selling a product embodying the invention. The AIA, which went into effect in 2012, changed the rules about what categories of prior art can invalidate patent claims. Notably, the AIA provided a safe harbor that encourages inventors to publicly disclose their invention before they file their patent application. Such a public disclosure invalidates any prior art published or filed between the public disclosure and the inventor's patent application, as long as the patent application is filed within a year of that public disclosure.

Sanho argued that its inventor publicly disclosed its invention — and triggered the safe harbor — by selling devices that embodied the invention. But the sale in Sanho was a "secret" sale, and not the type of public disclosure contemplated by the AIA. The Federal Circuit focused on the policy reasons underlying the Patent Act and the AIA, and held that only a public disclosure of the invention may qualify for the AIA's one-year grace period. The Sanho ruling thus provides an important warning to inventors that selling the invention could start the one-year clock running, but not trigger the protections of the safe harbor during that period.

## **5. Weber v. Provisur Technologies**

Finally, the Federal Circuit's February ruling in *Weber Inc. v. Provisur Technologies Inc.* clarified the circumstances where a product manual can serve as a printed publication. This question is important because one of the most popular ways for a patent challenger to seek invalidation of a patent is via the inter partes review process at the patent office. The patent office, however, can only base its review on patents or printed publications.

Weber brought an inter partes review against Provisur's patent, and argued that its own operating manuals rendered the Provisur patent obvious. The patent office, however, held that the operating manuals were not publicly available printed publications. The Federal Circuit disagreed.

Although the Weber operating manuals had been provided to only a few customers, the court explained that manuals were intended to be provided to the public. Moreover, members of the public were able to obtain the manuals — and did obtain them — by purchasing the Weber product or requesting the manual from Weber directly.

That Weber's customers were not allowed to further disseminate the manuals did not make them any less available. The Weber ruling thus expands the range of materials that could invalidate a patent in an inter partes review.

## **Conclusion**

In sum, 2024 provided a number of important clarifications to distinct areas of Federal Circuit law. Looking forward, 2025 is likely to continue that trend. The upcoming *Ecofactor* en banc ruling, in particular, will be a key decision to watch in 2025.

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