

Nos. 2020-1921, -1922, -1943, -1944

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**United States Court of Appeals  
For the Federal Circuit**

ZAXCOM, INC., Appellant,

v.

LECTROSONICS, INC., Cross-Appellant,

v.

ANDREI IANCU, Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office, Intervenor

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*Appeals from the United States Patent and Trademark Office, Patent Trial and  
Appeal Board in Nos. IPR2018-01129 and IPR2018-01130.*

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**CORRECTED**

**BRIEF OF AMICUS CURIAE PAUL R. MICHEL, U.S. CIRCUIT JUDGE  
(RET.), SUPPORTING NEITHER PARTY**

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December 16, 2020

FORM 9. Certificate of Interest

Form 9 (p. 1)  
July 2020

UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

**CORRECTED CERTIFICATE OF INTEREST**

Case Number Nos. 2020-1921, -1922, -1943, -1944

Short Case Caption Zaxcom, Inc. V. Lectrosonics, Inc.

Filing Party/Entity Hon. Paul R. Michell Amicus Curiae

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## RULE 29 STATEMENT<sup>1</sup>

Amicus Curiae is a former U.S. Circuit Judge of the U.S. Court of Appeals for the Federal Circuit, appointed in 1988 and serving until his retirement as Chief Judge in 2010. This case concerns Amicus because the 5103 rulings-at-issue threaten to undercut patent law and its innovation-promoting goals.

## ARGUMENT

On the issue of § 103 objective-indicia evidence and the presumption of a nexus with the patentee's claims, the panel should read this Court's recent Fox Factory decision in the context of two basic but animating principles, applicable to every case: (1) "in the setting of the particular case[] and as the product of preoccupation with their special facts," see *Freeman v. Hewit*, 329 U.S. 249, 252 (1946), overruled on *other* grounds; and (2) the categorical rule that one panel decision—such as *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1374 (Fed. Cir. 2019)—cannot overrule, disregard or conflict with this Court's prior en-banc or panel decisions. Under the earliest-case rule, the prior decision is indeed controlling if Fox Factory conflicts with it on these nexus-presumption issues. See, e.g., *Newell Cas., Inc. v. Kenney Mfg. Co.*, 864 F.2d 757, 765 (Fed. Cir. 1988) (explaining that

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upon a direct conflict between Federal Circuit decisions, “the precedential decision is the first” and its principles control); *Kimberly—Clark Corp. v. Ft. Howard Paper Co.*, 772 F.3d 860, 863 (Fed. Cir. 1985) (“Counsel is apparently unaware that a panel of this court is bound by prior precedential decisions unless ... overruled en banc.”).

Accordingly, and to the extent the panel addresses the issue, it should clarify Fox Factory so that it properly resides within this Court’s longstanding nexus-presumption precedents, as explained below. Alternatively, under Federal Circuit Rule 35, the panel should sua sponte seek to have this case taken en *banc* on the limited issue of addressing the nexus-presumption rules that governed before Fox Factory imposed its admittedly new “essentially”-identical requirement:

To be sure, we have never held that the existence of one or more unclaimed features, standing alone, means nexus may not be presumed. \*\*\* [that we do [now] *require* is *that* the *patentee demonstrate that the product* is essentially the claimed invention.

944 F.3d at 1374, 1376.<sup>2</sup> That is to say, after some 30 years of settled precedent on this nexus-presumption, Fox *Factory* added for the patentee new burdens “never” previously required by this Court’s case law—most notably, Fox Factory’s requirement that the claim-at-issue not only cover or “correspond[ ]” to the product for which there exists objective evidence (such as commercial success or—as asserted in this case—Oscar— and Emmy—award—winning praise in the industry); but

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<sup>2</sup> All emphasis added unless otherwise noted.

also that the product in turn not have any “significant” un—claimed features. E.g., Fox Factory, 944 F.3d at **1374-75**. Given this backdrop, the analysis of the Patent Trial and Appeal Board’s decision here, and its consideration of the nexus-presumption specifically, should adhere to the following precedential rules.

I. **A Patentee Meets its Prima Facie Burden and Establishes a Presumption-of—Nexus by Showing the Product is an “Embodiment[] of the Invention as Claimed in the Asserted Claims.”**

First, this Court’s precedents have long settled how a patentee meets its burden to obtain this presumption of a nexus between the proffered objective evidence of non-obviousness and the claim—at-issue; namely, by showing that (1) its “proffered objective evidence relates to” a specific product; and (2) this product (or products) “are embodiments of the invention as claimed in the asserted claims.” *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1329, 1331 (Fed. Cir. 2016) (“At trial, WBIP presented evidence that specific products ... are embodiments of the invention as claimed in the asserted claims. And its proffered objective evidence relates to these specific products,” including evidence on commercial success and industry praise); *J.T. Eaton & Co. v. Atl. Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed. Cir. **1997**) (same); *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, **1392-93** (Fed. Cir. **1988**). “This [two-part] showing—that the specific products are embodiments of the claimed invention and that the proffered objective evidence relates to these products—is *sufficient* to *establish* the presumption of



*nexus* for the objective considerations at issue ....” *WBIP*, 829 F.3d at 1330; *accord Apple Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034, 1057-58 (Fed. Cir. 2016) (en banc) (reversing panel opinion that initially held the trial evidence didn’t establish a nexus between objective considerations and the patentee’s asserted claims; “[a]t trial, [patentee] Apple’s expert ... testified that the iPhone practiced the asserted claims”).

Tellingly, in explaining its new nexus—presumption rules, Fox Factory all but ignored this two-part test. See 944 F.3d at 1373-75, 1377 (repeatedly justifying its new “insignificant”-features requirement based on precedential phrase that the “product ‘is the invention disclosed and claimed’”) (quoting *Demaco*, 851 F.2d at 1392) (emphasis in original). And to be sure, a court errs if it requires that the patentee also prove that other unclaimed features or factors didn’t contribute to that product’s success or other objective factors:

A patentee is not required to prove as part of its prima facie case that the commercial success of the patented invention [for example] is not due to factors other than the patented invention. \*\*\* A requirement for proof of the **negative** of all imaginable contributing factors *would* be unfairly burdensome, and contrary to the **ordinary rules** of evidence.

\*\*\* By placing the burden on [the patentee] to prove that commercial success was not due primarily to advertising or other factors such as technical service to licensees and the licensing of other products, the district court put the shoe on the wrong foot. [The accused infringer] *Demaco* did not meet its burden of rebutting the prima facie case of nexus between the [patentee’s] patented invention and its commercial success, and the district court clearly erred in its contrary finding.

Demaco, 851 F.2d at 1393-94 (citation omitted). In short, imposing proof requirements on the patentee beyond the two-part test recited above is error. E.g., id.; WBIP, 829 F.3d at 1329—31.

II. The Presumption-of-Nexus is Not Precluded for *a* Claim's Product "Even When the Product Has ***Additional***, Unclaimed Features."

Second, and decades before the December 2019 Fox Factory decision, this Court's precedents established that this nexus-presumption still applies "even when the product has additional, unclaimed features." PPC Broadband, 815 F.3d at 747 (reversing Board's finding that the nexus-presumption was inapplicable; "[b]ecause the evidence shows that the SignalTight connectors are 'the invention disclosed and claimed in the patent,' we presume that any commercial success of these products is due to the patented invention. This is true even when the product has additional, unclaimed features"); Ecolochem, 227 F.3d at 1378 (applying nexus-presumption when embodiment had unclaimed mobility feature); J.T. Eaton, 106 F.3d at 1571 (presumption applicable even when product has additional, unclaimed features). Thus, insofar as the parties dispute the law here and how the Board handled this particular nexus issue, this Court's *pre-Fox Factory* precedents have addressed it.

III. Given this Court's Precedents, such as WBIP, the **Panel** Should **Clarify** Certain Points about Fox Factory.

Third, and as noted at the outset, this Court's earlier-case rule requires that its earlier decisions, see, e.g., *WBIP*; *PPC Broadband*; *Demaco*, *supra*, trump any

inconsistent requirements that a later decision such as Fox Factory purportedly imposed. In that respect, the panel should clarify four points about Fox Factory, whether in its opinion here or via its sua sponte authority under Rule 35, to ensure that Fox Factory properly fits within this Court's nexus-presumption jurisprudence.

1. The Fox Factory panel decision purportedly established a new “presumption” requirement—*viz.*, that the embodiment relating to the objective evidence must be “essentially” identical to the invention recited in the claim-at-issue in all respects—with no additional un-claimed features between them. See 944 F.3d at 1374-75. But as demonstrated above, any such Fox holding conflicts with this Court's precedents, which hold that the nexus-presumption arises upon proof of the two-part test recited above—and “*even when the product has additional, unclaimed features.*” E.g., *PPC Broadband*, 815 F.3d at 747; *Ecolochem*, 227 F.3d at 1378; *J.T. Eaton*, 106 F.3d at 1571. Indeed, a patentee need only show that the product to which the objective evidence relates is an “embodiment[] of the invention as claimed in the asserted claims.” *WBIP*, 829 F.3d at 1329-31; *J. T. Eaton*, *supra*.

2. To make that point clearer still, this Court has repeatedly deemed it an error of law to require that a patentee also prove that the product has no additional, un-claimed features—or that those un-claimed features didn't contribute to the product's success or other supporting objective evidence. E.g., *Demaco*, 851 F.2d at 1393-94 (“A patentee is not required to prove as part of its *prima facie* case that the

commercial success of the patented invention [for example] is not due to factors other than the patented invention. \*\*\* By placing the burden on [the patentee] to prove that commercial success was not due primarily to advertising or other factors ..., the district court put the shoe on the wrong foot”). As noted, the two-part test recited above is all a patentee need show in order to trigger the rebuttable nexus presumption. E.g., *WBIP*; *Demaco*, *supra*. Requiring more than that—including Fox Factory’s proof of an “essentially”-identical or “insignificant”-differences “requirement” between claim and commercial product—is putting the reversible-error “shoe on the wrong foot.” See, e.g., *Demaco*, 851 F.2d at 1393—94.

3. Fox *Factory* justified its ratcheting-up of this nexus-presumption standard based on its misreading of *Demaco*. Specifically, it thrice emphasized *Demaco*’s phrase that, for the presumption to apply, the patentee must show that the relevant “product is the invention disclosed and claimed.” *F0x Factory*, 944 F.3d at 1373-74, 1377 (quoting *Demaco*, 851 F.2d at 1392) (emphasis in original). But that terse *Demaco* phrase does not mandate that, for the presumption to apply, the product and claim cannot have any differences, let alone any additional, un—claimed features. Indeed, as just noted, this Court’s precedents hold to the contrary. E.g., *PPC Broadband*, 815 F.3d at 747 (nexus—presumption applicable “even when the product has additional, unclaimed features”); *J. T. Eaton*; *Ecolochem*, *supra*.



Properly read, Demaco and its progeny at most say what the patent law routinely says in this circumstance; namely, that the claim covers an embodiment so long as it has the elements recited by the claim-at-issue. *PPC Broadband*, 815 F.3d at 747 (reversing Board’s rejection of nexus-presumption when “[t]he Board ... did not explain why the SignalTight connectors fail to embody the claimed features, or what claimed features in particular are missing from the SignalTight connectors”); *WBIP*, 829 F.3d at 1329, 1331 (nexus—presumption established when “WBIP presented evidence that specific products ... are embodiments of the *invention* as *claimed* in the asserted claims”). As with nearly everything in patent law, the focus is on what the patent “claims” about the “invention” and what claim elements are or are not missing in the product—at-issue—not on freestanding notions about additional un-claimed features or what the “the invention is.” See, e.g., *id.*; *Apple Inc. v. Motorola, Inc.*, 757 F.3d 1286, 1298 (Fed. Cir. 2014) (“[T]he name of the game is the claim”). Indeed, even as recounted by Fox Factory, this Court’s *pre-Fox* case law didn’t spell-out any obligation to show that the product—at-issue have each-and-every element of the asserted claim; having a claim “tied to [the] specific product” sufficed, as did a sufficient “correspondence between the objective evidence and the claim scope.” 944 F.3d at 1373 (quoting, *inter alia*, *Henry Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1332 (Fed. Cir. 2019) and *Demaco*, *supra*).



In any event, and even putting aside these watered-down “tied-to” and “correspondence” tests, one may reasonably read Fox Factory as requiring that the patentee also prove that the product is “essentially” identical to the claimed invention—with no additional unclaimed features—or that these unclaimed features are “insignificant.” 944 F.3d at 1374. Either way, in imposing these new-and-additional burdens on the patentee, Fox Factory contradicts this Court’s nexus-presumption precedents. See, e.g., *WBIP*, 829 F.3d at 1329-31; *J.T. Eaton*, 106 F.3d at 1571; *Demaco*, 851 F.2d at 1392–94; *Apple v. Samsung*, 839 F.3d at 1057-58. Given the earlier-case rule, see, e.g., *Newell; Kimberly—Clark*, *supra*, this Court should clarify and properly limit Fox Factory to its facts.

4. Last, Fox Factory’s new “insignificant” requirement is precedent-defying for another reason; viz., it addresses potentially different questions than this Court’s precedent might otherwise address. That is, under this Court’s 30-year-plus case law, a patentee triggers the nexus—presumption upon meeting the two—part test recited above. E.g., *Demaco*, 851 F.2d at 1393-94. The *accused* infringer may then rebut the presumption by showing that url-claimed features or factors such as marketing contributed to, e.g., the claimed product’s commercial success, industry praise, or other objective indicia of non—obviousness. *Id.* Depending on the circumstances, Fox Factory’s new “insignificant” test might be assessing the technical significance of a patent’s particular claim elements to the invention or prior art as a Whole—When

the *relevant* dispute under Demaco and other still-controlling precedent might have focused on, e.g., industry praise. The broader point is that *Fox Factory* had no need or authority to change Demaco's two-part test and procedural framework. The panel, accordingly, should clarify and confine *Fox Factory* on this point as well, thus ensuring that this 2019 panel decision doesn't impermissibly enjoy the en-banc power to disregard all the binding cases that preceded it. See, e.g., Demaco; *WBIP*; PPC Broadband; *Ecolochem*; *JT Eaton*; *Apple v. Samsung* (en banc), *supra*.

### CONCLUSION

For the foregoing reasons, Amicus Curiae, retired Circuit Judge Michel, respectfully requests that the Court explicitly clarify its presumption-of-nexus precedents, as set forth herein.

Respectfully submitted,

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December 17, 2020

**CERTIFICATE OF COMPLIANCE**

I hereby certify that, using the Word program's word-count feature, this brief contains 2328 words, in compliance with Federal Rule of Appellate Procedure 27(d)(2).).

/s/ John T. Battaglia—

**CORRECTED CERTIFICATE OF SERVICE**

I hereby certify that, on December 17, 2020, an electronic copy of the **CORRECTED** foregoing document was filed with the Clerk of Court for the U.S. Court of Appeals for the Federal Circuit, using the CM/ECF system, Which thereby served a copy upon all counsel of record.

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