

No. 20-1800

IN THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

INGEVITY CORPORATION, INGEVITY SOUTH CAROLINA, LLC,
Appellants,

v.

INTERNATIONAL TRADE COMMISSION,
Appellee,

MAHLE FILTER SYSTEMS NORTH AMERICA, INC., MAHLE FILTER
SYSTEMS JAPAN CORP., MAHLE SISTEMAS DE FILTRACIÓN DE
MEXICO S.A. DE C.V., MAHLE FILTER SYSTEMS CANADA ULC,
KURARAY CO., LTD., CALGON CARBON CORPORATION,
Intervenors.

On Appeal from the International Trade Commission in Inv. No. 337-TA-1140
Administrative Law Judge Cameron Elliot

PETITION FOR PANEL REHEARING AND REHEARING *EN BANC*

Jeffrey T. Thomas
Taylor W. King
GIBSON, DUNN & CRUTCHER LLP
3161 Michelson Drive
Irvine, CA 92612
(949) 451-3800

Mark A. Perry
Principal Attorney
Brian M. Buroker
GIBSON, DUNN & CRUTCHER LLP
1050 Connecticut Avenue, N.W.
Washington, D.C. 20036
(202) 955-8500

Counsel for Appellants
Ingevity Corporation and Ingevity South Carolina, LLC

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF INTEREST

Case Number 20-1800

Short Case Caption Ingevity Corporation v. ITC

Filing Party/Entity Ingevity Corporation and Ingevity South Carolina, LLC

Instructions: Complete each section of the form. In answering items 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance. **Please enter only one item per box; attach additional pages as needed and check the relevant box.** Counsel must immediately file an amended Certificate of Interest if information changes. Fed. Cir. R. 47.4(b).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 09/07/2021

Signature: /s/ Mark A. Perry

Name: Mark A. Perry

<p>1. Represented Entities. Fed. Cir. R. 47.4(a)(1).</p>	<p>2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2).</p>	<p>3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3).</p>
<p>Provide the full names of all entities represented by undersigned counsel in this case.</p>	<p>Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p>	<p>Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.</p> <p><input type="checkbox"/> None/Not Applicable</p>
<p>Ingevity South Carolina, LLC</p>		<p>Ingevity Corporation</p>
<p>Ingevity Corporation</p>		<p>None</p>

Additional pages attached

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

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Mangum Ririe LLP	Eric T. Syu	Nathanial R. Scharn
Stuart Rosenberg	Shuo Josh Zhang	Spencer W. Ririe
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5. Related Cases. Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

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Ingevity Corp. v. MAHLE Filter Systems North America, Inc., (1:18-cv-04920) (N.D. Ill.)	Ingevity Corporation et al. v. MAHLE Filter Systems North America, Inc. (1:18-cv-06158) (N.D. Ill.)	
Ingevity Corp. v. BASF Corp., (1:18-cv-01072-RGA) (D. Del.)	BASF Corp. et al. v. Ingevity South Carolina, LLC (IPR2019-00202) (PTAB)	
Ingevity Corp. et al. v. BASF Corp., (1:18-cv-01391-RGA) (D. Del.)	MAHLE Filter Systems North America, Inc. et al. v. Ingevity South Carolina, LLC et al. (IPR2019-00960) (PTAB)	

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

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CONTINUATION PAGE

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Gibson, Dunn & Crutcher LLP: Brett M. Long*, and Jessica Altman*.

* No longer with respective firm.

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STATEMENT OF COUNSEL

The panel engaged in independent factfinding based on its own review of the evidentiary record to sustain a decision of the International Trade Commission on a basis not adopted by the agency, in contravention of the fundamental principle that this Court must review a decision by an administrative agency only on the grounds invoked by that agency. *SEC v. Chenery Corp.*, 332 U.S. 194, 196 (1947).

Pursuant to this Court's Rule 35(e)(1)(F), undersigned counsel submits that the panel overlooked the following point of law and fact: The panel's ruling that the alleged prior inventors had to appreciate the limitations of the claimed invention to establish invalidity under 35 U.S.C. § 102(g)(2) required vacatur of the ITC decision because the ALJ made no finding that they had the requisite appreciation and the trial evidence on this point was conflicting.

Pursuant to this Court's Rule 35(b), and based on his professional judgment, undersigned counsel believes the panel decision is contrary to *Chenery* and this Court's precedents applying the *Chenery* doctrine—including in ITC cases. *See, e.g., InterDigital Commc'ns, LLC v. ITC*, 690 F.3d 1318, 1329 (Fed. Cir. 2012). By applying a standard of review applicable to district court judgments, but unavailable in agency cases, the panel erroneously sustained an ITC decision of invalidity that must be vacated under the reasoning set forth in the panel decision itself.

/s/ Mark A. Perry
Mark A. Perry

BACKGROUND

On Ingevity's complaint, the Commission instituted an investigation to determine whether several entities ("Respondents") were violating Section 337 of the Tariff Act, 19 U.S.C. § 1337, by importing fuel vapor canisters or components thereof that infringe U.S. Patent No. RE38,844 ("the '844 patent"). The '844 patent is directed to methods and systems for reducing evaporative emissions by adsorbing fuel vapors using at least two fuel vapor canisters. One common adsorbent used in fuel vapor canisters is "activated carbon," which is a form of carbon that is processed to be highly porous and can come in a "honeycomb" shape. Appx350 (Q/A 27); Appx2617. Importantly, the '844 patent requires the subsequent adsorbent volume to have an incremental adsorption capacity between vapor concentrations of 5 vol % and 50 vol % ("IAC") of less than 35 g n-butane/L at 25° C. *See* Appx324 ('844 patent at 10:36–44). The '844 patent also teaches that effective butane working capacity ("BWC") is "a good predictor of the canister working capacity for gasoline vapors." Appx320 ('844 patent at 2:8–12).

Ingevity's predecessor, Westvaco Corporation, developed the invention claimed in the '844 patent over several years, culminating in the filing of a provisional application in 2001 that eventually led to that patent. While Westvaco was working on the claimed invention, three Delphi engineers—Thomas Meiller, Susan LaBine, and Charles Covert—constructed and tested a device referred to as

the Delphi Epsilon Canister System (“DECS”) by January 2000. Appx145. The DECS included an auxiliary canister containing adsorbent activated carbon honeycombs developed and provided confidentially by Westvaco. Appx148. The ALJ found it was a “reasonable inference” that the BWC of those honeycombs would “have been 3.7 g/dL,” *id.*, which the ALJ further found to correlate to an IAC below 35 g/L, Appx152. The Delphi engineers, however, were not concerned with the adsorption capacity of the honeycombs, instead attributing the emission efficiency benefits of their invention to the canister’s shape, including the “long flow length” of the canister. Appx1449. The DECS was never accessible to the public and never offered for sale. *See* Appx1572–1573 (321:10–322:2). Accordingly, neither the DECS nor the confidential “Record of Invention” describing it is prior art to the ’844 patent. The Delphi engineers did patent the invention they made, claiming the shape (not the adsorptive capacity) of the secondary canister. Appx1435–1445. That patent concededly does not anticipate the ’844 patent because it does not disclose the IAC below 35 g/L limitation.

The proceedings before the Commission ALJ culminated in an Initial Determination issued on January 28, 2020. As pertinent to this petition, the ALJ concluded that claim 1 of the ’844 patent is invalid under 35 U.S.C. § 102(g)(2)—and, by extension, all of the challenged claims are anticipated or rendered obvious—in light of the development and testing of the Delphi DECS invention. Appx162.

Although Ingevity explained that “the Delphi Inventors ‘were unaware of, and indeed agnostic to, the BWC of the honeycombs,’” the ALJ ruled, as a matter of law, that “the Delphi Inventors need not be aware of the [adsorptive capacity] property of the honeycombs if they appreciate the benefit the honeycombs contributed to the DECS.” Appx151. The ALJ concluded that “the requisite appreciation is met under section 102(g)(2)” because “the Delphi Inventors certainly appreciated the bleed emissions benefit a honeycomb in a subsequent, auxiliary position gave the DECS, even if they did not appreciate which property of the honeycomb to credit.” Appx154 (citing *Teva Pharm. Indus. Ltd. v. AstraZeneca Pharms. LP*, 661 F.3d 1378, 1385 (Fed. Cir. 2011)).

The Commission determined not to review the ALJ’s conclusion of invalidity under Section 102(g)(2), and on the basis of that unreviewed conclusion alone determined to terminate the investigation with a finding of no violation of Section 337. Appx3.

Ingevity appealed the Commission’s final determination to this Court. A panel consisting of Chief Judge Moore and Judges Schall and Taranto “agree[d] with Ingevity that [Respondents] were required to prove by clear and convincing evidence that the Delphi Inventors appreciated that the auxiliary canister of the Delphi Prior Invention included an adsorbent that had an IAC of less than 35 g/L, or its correlative for purposes of this appeal: a BWC of less than 8 g/dL.” Op. 12. The panel thus

implicitly rejected the ALJ's ruling that *Teva* did not require Respondents to prove the claimed property of the adsorbent in the auxiliary canister.

The panel then independently analyzed three pieces of evidence in the record: First, the panel cited an October 28, 1999 letter from Westvaco to the Delphi engineers that included an attachment with the "basic properties" of the two honeycomb samples Westvaco provided to Delphi. Op. 12–13. One of those listed properties was a "'Volumetric Butane Working Capacity, g/[dL]' of '3.7.'" Op. 13 (brackets in original). Second, the panel cited a December 7, 1999 letter from Westvaco to the Delphi engineers, which states that the honeycomb samples provided by Westvaco were given "the Sample Number 445-S-99." *Id.* Lastly, the panel cited a physical canister exhibit introduced during the proceedings before the ALJ that bore the same sample number referenced in the second letter.

The panel concluded that "the two letters and the physical auxiliary canister constitute substantial evidence that the Delphi Inventors appreciated that the honeycombs of the Delphi Prior Invention had the pertinent adsorptive capacity." Op. 13. Ingevity had pointed out the lack of any finding by the ALJ concerning the Delphi engineers' appreciation of the claimed adsorptive capacity. Blue Br. 47, 55. The panel asserted that "the ALJ did so find," pointing to the ALJ's statement that "[t]he record shows that the individuals associated with the DECS sufficiently appreciated their invention under 102(g)(2)." Op. 14 (quoting Appx150).

ARGUMENT

The Court should grant rehearing and vacate the Commission’s final determination that the asserted claims of the ’844 patent are invalid under 35 U.S.C. § 102(g)(2) because the reasoning adopted by the panel was not articulated by the ALJ and did not form the basis of the agency’s invalidity determination. Rather, the panel’s reasoning was based on its independent review of the evidence in the administrative record. The panel decision, therefore, contravenes one of the most basic principles of appellate review of administrative decisions—the *Chenery* doctrine. Ingevity raised this point in its panel briefing, Blue Br. 28; Gray Br. 2–3, 17, 20, but the panel neither cited nor applied *Chenery* or its progeny. Rather, the panel accepted Respondents’ invitation to apply a standard of review applicable to district court judgments, *see* Resp. Br. 66–67 (citing *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 164 (Fed. Cir. 1985)); Gray Br. 2–3, and thereby erred because agency decisions are subject to a different standard.

1. As the Supreme Court explained in *Chenery*, it is a “fundamental rule of administrative law . . . that a reviewing court, in dealing with a determination or judgment which an administrative agency alone is authorized to make, must judge the propriety of such action solely by the grounds invoked by the agency.” *SEC v. Chenery Corp.*, 332 U.S. 194, 196 (1947). “If those grounds are inadequate or improper, the court is powerless to affirm the administrative action by substituting

what it considers to be a more adequate or proper basis.” *Id.* The Supreme Court has consistently reaffirmed this principle. *See, e.g., Dep’t of Homeland Sec. v. Regents of the Univ. of Cal.*, 140 S. Ct. 1891, 1907 (2020) (“It is a ‘foundational principle of administrative law’ that judicial review of agency action is limited to ‘the grounds that the agency invoked when it took the action’” (quoting *Michigan v. EPA*, 576 U.S. 743, 758 (2015))); *Motor Vehicle Mfrs. Ass’n of U.S., Inc. v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 50 (1983) (“It is well-established that an agency’s action must be upheld, if at all, on the basis articulated by the agency itself” (citing *Chenery*, 332 U.S. at 196)).

This Court and its sister Circuits have faithfully followed the *Chenery* doctrine when reviewing agency decisions (including those of the Commission) in other cases. *See, e.g., Bd. of Trs. of Leland Stanford Junior Univ. v. Chinese Univ. of Hong Kong*, 860 F.3d 1367, 1376 (Fed. Cir. 2017) (explaining that “[w]e must base our review on the analysis presented by the Board” and vacating PTAB decisions where the Board failed to make adequate factual findings); *InterDigital Commc’ns, LLC v. ITC*, 690 F.3d 1318, 1329 (Fed. Cir. 2012) (“[U]nder well-settled principles of administrative law, we are not free to accept Nokia’s invitation to uphold the [Commission’s] decision on a ground not ruled on by the agency”); *In re Sang Su Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002) (refusing to accept alternative grounds on which to affirm a decision by the Board of Patent Appeals and Interferences because

“review of an administrative decision must be made on the grounds relied on by the agency”); *see also N.C. Wildlife Fed’n v. N.C. Dep’t of Transp.*, 677 F.3d 596, 604 (4th Cir. 2012) (rejecting an agency’s attempt to rely on subsequent litigation statements to support its action because an appellate court “cannot” accept “post hoc rationalizations for agency action rather than judging the propriety of the action solely by the grounds invoked by the agency” (cleaned up)); *Pinto v. Massanari*, 249 F.3d 840, 847–48 (9th Cir. 2001) (rejecting an alternative basis to affirm a denial of social security benefits because a court of appeals cannot “affirm the denial of benefits on a ground not invoked by the [agency] in denying the benefits originally”).

Under the *Chenery* doctrine, appellate review of agency decisions is markedly different from review of district court decisions. An appellate court “may affirm [the district court] on any basis the record supports, including one the district court did not reach.” *Herring v. FDIC*, 82 F.3d 282, 284 (9th Cir. 1995); *see also Pappalardo v. Stevins*, 746 F. App’x 971, 973 (Fed. Cir. 2018) (unpublished) (same). That is because “[w]hen an appeal is from the judgment of a district court, it is the judgment, not the trial court’s opinion, that is on appeal.” *Secure Access, LLC v. PNC Bank Nat’l Ass’n*, 859 F.3d 998, 1013 (Fed. Cir. 2017) (Plager, J., concurring in the denial of panel rehearing).

“By contrast, when the appeal is from an administrative agency—and the [Commission] is such an agency—the appellate court can only review the record on

appeal and the decision of the agency in light of that record.” *Secure Access*, 859 F.3d at 1013 (Plager, J., concurring). To be sure, this Court “will uphold a decision of less than ideal clarity if the agency’s path may reasonably be discerned.” *In re Applied Materials, Inc.*, 692 F.3d 1289, 1294 (Fed. Cir. 2012) (quoting *Bowman Transp., Inc. v. Ark.-Best Freight Sys., Inc.*, 419 U.S. 281, 285–86 (1974)). But this Court “may not affirm on a basis containing any element of discretion—including discretion to find facts . . .—that is not the basis the agency used, since that would remove the discretionary judgment from the agency to the court.” *ICC v. Bhd. Of Locomotive Eng’rs*, 482 U.S. 270, 283 (1987); *see also Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1365–66 (Fed. Cir. 2015) (recognizing that this Court “must not . . . make factual and discretionary determinations that are for the agency to make” and vacating where the Court could not “confidently discern whether the [Patent Trial and Appeal] Board . . . was actually relying on a legally proper ground”). Thus, this Court “cannot stray afield to determine how the matter at issue could have been resolved had the agency explained its decision differently, perhaps under a different theory.” *Secure Access*, 859 F.3d at 1013 (Plager, J., concurring). “It is what the agency said it decided that is the subject of the appeal.” *Id.*

2. In this case, the panel departed from *Chenery* by independently evaluating the evidence in the record and sustaining the conclusion of invalidity on a basis that

was not adopted or articulated by the ALJ. The panel first “agree[d] with Ingevity that [Respondents] were required to prove by clear and convincing evidence that the Delphi Inventors appreciated that the auxiliary canister of the Delphi Prior Invention included an adsorbent that had an IAC of less than 35 g/L.” Op. 12. In so doing, the panel necessarily concluded that the ALJ was wrong in determining, based on *Teva*, that the Delphi engineers did not need to appreciate the claimed adsorptive property of the secondary canister.

The panel then pointed to three pieces of evidence in the record that could support a finding that the Delphi engineers had the requisite appreciation. Op. 12–13 (discussing two Westvaco letters and the physical auxiliary canister exhibit). The panel drew from this evidence the factual inference that “the Delphi Inventors appreciated that the honeycombs of the Delphi Prior Invention’s auxiliary canister had the pertinent adsorptive capacity.” Op. 14.

The panel decision is inconsistent with the *Chenery* appellate review standard because it adopts a reasoning that was not put forth by the ALJ and differs materially from the ALJ’s actual finding, which was that the Delphi engineers appreciated the *benefit of their* invention (DECS) instead of the “pertinent adsorptive capacity” claimed in the ’844 patent. *See* Appx150–154. The Delphi engineers understood *their* invention to involve the shape of the canister, not its adsorptive capacity.

The portion of the initial determination containing the ALJ’s analysis of appreciation under Section 102(g)(2) focused solely on whether the Delphi engineers appreciated the *benefits* of their DECS auxiliary canister (i.e., the fact that emissions were reduced). See Appx151 (stating that “the Delphi Inventors need not be aware of the property of the honeycombs if they appreciate the *benefit* the honeycombs contributed to the DECS” and citing evidence that they appreciated the “competitive *benefits*” (emphasis added)); Appx151–152 (citing evidence of higher bleed emission efficiency); Appx152–153 (stating that the Delphi engineers’ “appreciation of [the *benefit*] in the DECS is very similar to the *benefit* the [’]844 patent discloses” (emphasis added)); Appx154 (finding “clear, convincing, and consistent evidence that the Delphi Inventors not only appreciated the *benefit* from introduction of an auxiliary honeycomb to a fuel vapor canister, but appreciated the *same benefit* as the [’]844 patent inventors” (emphasis added)); see also Blue Br. 46–47.

The ALJ’s reasoning was based on his misreading of this Court’s decision in *Teva*, which the ALJ believed was “[d]irectly applicable” to the Section 102(g)(2) analysis here. Appx151. Ingevity explained in its opening brief why *Teva* does not support the ALJ’s invalidity determination. Blue Br. 46–48. The panel implicitly agreed in ruling that the Delphi engineers had to appreciate the adsorptive property of the secondary canister. Yet, nowhere in his analysis of Section 102(g)(2) did the ALJ make any factual findings as to the Delphi engineers’ appreciation of the

claimed adsorptive capacity or rely on the three pieces of record evidence cited by the panel. The ALJ's conclusion that "the requisite appreciation is met under section 102(g)(2)," Appx154, was solely (and erroneously) based on his finding that the Delphi engineers appreciated the benefits of their DECS invention, which in his view was sufficient under *Teva*.

Contravening *Chenery* and decades of administrative law precedent from this Court and others, the panel substituted its own reasoning based on an independent review of the evidentiary record. Specifically, the panel described three pieces of evidence—the two letters from Westvaco to the Delphi engineers and the physical auxiliary canister exhibit—as "critical" to the Section 102(g)(2) appreciation analysis. Op. 12. The panel then held "that the two letters and the physical auxiliary canister constitute substantial evidence that the Delphi Inventors appreciated that the honeycombs of the Delphi Prior Invention had the pertinent adsorptive capacity." Op. 13. The panel even went so far as to make its own *factual* finding based on this evidence that was never made by the ALJ: that "the [Delphi] inventors . . . *knowingly* utilized . . . an adsorbent that they had been informed met in substance the second adsorbent step of claim 1 [of the '844 patent]." *Id.*

The ALJ, however, mentioned these three pieces of evidence merely in the course of describing Respondents' arguments, and only made "a reasonable inference" as to what the adsorptive capacity of the honeycombs used in the DECS

would have been. *See* Appx145–148. The ALJ made *no* finding that the Delphi engineers appreciated the adsorptive property of the honeycombs—and he certainly did not make the finding attributed to him by the panel. Indeed, the ALJ expressly stated that in his view, as long as the Delphi engineers “appreciated the bleed emissions *benefit* a honeycomb in a subsequent, auxiliary position gave the DECS,” it did not matter “if they did not appreciate which *property* of the honeycomb to credit”—i.e., the adsorptive capacity claimed by the ’844 patent. Appx154 (emphasis added); *see also* Blue Br. 47, 55. Respondents even conceded as much, agreeing in the Red Brief that “[t]he ALJ did not require . . . [an] appreciation of any specific adsorptive property.” Red Br. 44.

Here, even if a trier of fact *could* make from the evidence in the record a finding of the requisite appreciation by the Delphi engineers of the claimed adsorptive capacity, that evidence does not *compel* such a finding under the clear and convincing evidence standard applicable to invalidity determinations. Indeed, there was considerable fact and expert witness testimony introduced at the hearing before the ALJ (evidence that was not cited in the panel opinion) that showed the Delphi engineers did *not* know or appreciate the adsorptive capacity of the honeycombs used in the DECS. *See, e.g.*, Appx1516 (95:13–21); Appx1520 (112:11–17); Appx1765 (citing relevant testimony); Appx10194 (514:18–20); *see also* Blue Br. 54–55; Gray Br. 23–25. This was a hotly disputed factual issue that

could have come out either way on the trial record; yet, because of his misinterpretation of *Teva*, the ALJ never made an express finding whether the Delphi engineers appreciated the adsorptive properties of the secondary canister.

In an administrative appeal, it was beyond the panel's prerogative to make a finding of appreciation (and, thus, invalidity) *ab initio*. The discretion to make that finding (or not) resides with the ALJ in the first instance. That is particularly true where, as here, the challenger bore the burden of proof by clear and convincing evidence. By substituting its own rationale in place of the ALJ's faulty reasoning, the panel improperly "ma[de] factual and discretionary determinations that are for the agency to make"—the very thing this Court has recognized that it "must not" do. *Ariososa*, 805 F.3d at 1365.

In response to Ingevity's objection that the ALJ made no finding concerning the Delphi engineers' appreciation of the claimed adsorptive capacity, the panel quoted the ALJ's conclusory statement that "[t]he record shows that the individuals associated with the DECS sufficiently appreciated *their* invention under 102(g)(2)." Op. 14 (quoting Appx150) (emphasis added). But as the panel itself recognized, Section 102(g)(2) requires a finding that the Delphi engineers appreciated Ingevity's claimed invention—including the claimed adsorptive capacity—not *their* own invention. The Delphi engineers' invention (as embodied in the DECS) turned on the shape of the adsorbent, not its adsorptive properties.

In any event, the ALJ's reference to "sufficient[] appreciat[ion]" at best refers to his finding that the Delphi engineers appreciated the *benefits* of their invention because the ALJ's statement directly precedes that analysis. To make the leap that the ALJ's statement instead somehow suggests that he made a finding concerning the Delphi engineers' appreciation of the claimed adsorptive capacity, the panel once again fell back on "the substantial evidence" it found in the record—the two Westvaco letters and the physical exhibit. Op. 14. But the panel's independent assessment of that evidence is improper in view of *Chenery* and thus cannot support its conclusion. And without more, the ALJ's statement alone is inadequate because "*Chenery* requires not only findings but an explanation." *Sealed Air Corp. v. ITC*, 645 F.2d 976, 997 (C.C.P.A. 1981) (Nies, J., concurring in part and dissenting in part).

The panel did *not* endorse the ALJ's flawed reasoning regarding the validity of the asserted claims of the '844 patent under Section 102(g)(2). Instead, the panel identified a different ground on which a factfinder could—but need not—find the asserted claims invalid. Because the ALJ did not make that finding, the only path available to the panel was to vacate the Commission decision and remand for further administrative proceedings. By going farther and forging its own path, the panel contravened *Chenery* and its progeny.

CONCLUSION

Ingevity respectfully requests that the Court grant rehearing, vacate the panel decision and the underlying Commission decision, and remand this matter for further administrative proceedings.

Dated: September 7, 2021

Respectfully submitted,

/s/ Mark A. Perry

Mark A. Perry
Principal Attorney
Brian M. Buroker
GIBSON, DUNN & CRUTCHER LLP
1050 Connecticut Avenue, N.W.
Washington, D.C. 20036
(202) 955-8500

Jeffrey T. Thomas
Taylor W. King
GIBSON, DUNN & CRUTCHER LLP
3161 Michelson Drive
Irvine, CA 92612
(949) 451-3800

Counsel for Appellants
Ingevity Corporation and Ingevity
South Carolina, LLC

ADDENDUM

Opinion and Judgment, *Ingevity Corp., et al. v. Int'l Trade Comm'n*, No. 20-1800 (Fed. Cir. July 21, 2021)

NOTE: This disposition is nonprecedential.

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

**INGEVITY CORPORATION, INGEVITY SOUTH
CAROLINA, LLC,**
Appellants

v.

INTERNATIONAL TRADE COMMISSION,
Appellee

**MAHLE FILTER SYSTEMS NORTH AMERICA,
INC., MAHLE FILTER SYSTEMS JAPAN CORP.,
MAHLE SISTEMAS DE FILTRACIÓN DE MÉXICO
S.A. DE C.V., MAHLE FILTER SYSTEMS CANADA
ULC, KURARAY CO., LTD., CALGON CARBON
CORPORATION,**
Intervenors

2020-1800

Appeal from the United States International Trade
Commission in Investigation No. 337-TA-1140.

SEALED OPINION ISSUED: July 21, 2021

PUBLIC OPINION ISSUED: August 6, 2021*

MARK ANDREW PERRY, Gibson, Dunn & Crutcher LLP, Washington, DC, argued for appellants. Also represented by BRIAN BUROKER; TAYLOR KING, JEFFREY T. THOMAS, Irvine, CA.

RONALD TRAUD, Office of the General Counsel, United States International Trade Commission, Washington, DC, argued for appellee. Also represented by DOMINIC L. BIANCHI, WAYNE W. HERRINGTON.

JEANNE MARIE GILLS, Foley & Lardner LLP, Chicago, IL, argued for intervenors MAHLE Filter Systems North America, Inc., MAHLE Filter Systems Japan Corp., MAHLE Sistemas de Filtración de México S.A. de C.V., MAHLE Filter Systems Canada ULC. Also represented by DANIEL FLAHERTY, RICHARD SPENCER MONTEI; JUSTIN SOBAJE, Los Angeles, CA.

RAYMOND ALAN MILLER Troutman Pepper Hamilton Sanders LLP, Pittsburgh, PA, for intervenors Kuraray Co., Ltd., Calgon Carbon Corporation.

Before MOORE, *Chief Judge*** , SCHALL and TARANTO,
Circuit Judges.

SCHALL, *Circuit Judge*.

* This opinion was originally filed under seal and has been unsealed in full.

** Chief Judge Kimberley A. Moore assumed the position of Chief Judge on May 22, 2021.

DECISION

Ingevity Corp. and Ingevity South Carolina, LLC (collectively, “Ingevity”) are the owners of U.S. Patent No. RE38,844 (“the ’844 patent”). On November 8, 2018, Ingevity filed a complaint before the International Trade Commission (“the Commission”) alleging a violation of 19 U.S.C. § 1337 (“section 337”) due to the importation of products that infringed one or more claims of the ’844 patent. In an amended complaint filed on March 28, 2019, Ingevity named MAHLE Filter Systems North America, Inc., MAHLE Filter Systems Japan Corp., MAHLE Sistemas de Filtración de México S.A. de C.V., MAHLE Filter Systems Canada, ULC, Kuraray Co., Ltd., and Calgon Carbon Corporation (collectively, “Intervenors”) as Respondents.¹ Thereafter, following proceedings that included an evidentiary hearing before an administrative law judge (“ALJ”), on April 7, 2020, the Commission determined that Intervenors did not violate section 337 because the asserted claims of the ’844 patent were invalid under 35 U.S.C. § 102(g)(2) and/or 35 U.S.C. § 103(a)² in view of a prior invention by engineers at non-party Delphi Technologies, Inc., or over the combination of that prior invention and other prior art. *In the Matter of Certain Multi-Stage Fuel Vapor Canister Systems and Activated Carbon Components Thereof*, Inv. No. 337-TA-1140, 2020 WL 1700337

¹ Nagamine Manufacturing Co., Ltd. was also named as a respondent in Ingevity’s amended complaint, but is not a party to this appeal.

² This appeal is governed by 35 U.S.C. §§ 102(g)(2) and 103(a) as they existed prior to changes made by the America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011). *See Polara Eng’g Inc. v. Campbell Co.*, 894 F.3d 1339, 1344 n.2 (Fed. Cir. 2018); *Solvay S.A. v. Honeywell Int’l Inc.*, 742 F.3d 998, 1000 n.1 (Fed. Cir. 2014); 35 U.S.C. §§ 102(g)(2), 103(a) (2002).

(U.S.I.T.C. Apr. 7, 2020) (Not. of Comm’n Determination to Review in Part, Take No Position on the Issues Under Review, and Affirm in Part) (“*Commission Determination*”); see also *In the Matter of Certain Multi-Stage Fuel Vapor Canister Systems and Activated Carbon Components Thereof*, Inv. No. 337-TA-1140, 2020 WL 1026313 (U.S.I.T.C. Jan. 28, 2020) (Initial Determination) (“*Initial Determination*”). Ingevity now appeals the Commission’s final determination. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(6). Because we are unpersuaded by Ingevity’s arguments, we *affirm*.

BACKGROUND

I.

The ’844 patent is directed to a method for reducing emissions resulting from gasoline evaporation from automobile fuel systems. ’844 patent col. 1 ll. 27–34; col. 3 ll. 43–64. These emissions, which sometimes are referred to as “bleed emissions,” typically occur when a vehicle has been parked and subjected to diurnal temperature changes over a period of several days. *Id.* col 2 ll. 45–46; col. 4 ll. 42–44. These temperature changes cause pressure fluctuations in the vehicle’s fuel tank, which in turn cause gases to flow in and out of the fuel tank vent. *Initial Determination*, 2020 WL 1026313, at *6. One way to control bleed emissions is via “adsorption” and the storage of hydrocarbon vapors in a canister, followed by “desorption,” facilitated by passing fresh air through the canister to purge the adsorbed hydrocarbons back into the fuel system, where they are burned in the internal combustion process. *See id.* at *6–7; ’844 patent col. 1 ll. 32–38. In the relevant time period, adsorbents were commonly characterized in terms of their “butane working capacity,” or “BWC.” BWC describes the inherent ability of materials to adsorb and desorb hydrocarbons. *See id.* col. 2 ll. 1–16.

The ’844 patent describes a method for controlling bleed emissions that uses two adsorbents. The first

adsorbent is closer to the fuel source (from which the vapors are coming) than the second adsorbent, which is closer to the vent (from which the vapors are being emitted). The '844 patent generally describes the adsorption abilities of its two adsorbents in terms of “incremental adsorption capacity” (“IAC”), as opposed to BWC. Although there are differences between how IAC and BWC are calculated, both measure the mass of adsorbate that is adsorbed by a unit of adsorbent at a particular temperature and vapor concentration. *Initial Determination*, 2020 WL 1026313, at *95. The adsorptive properties of an adsorbent can be characterized using an “isotherm,” a series of measured adsorption capacities of an adsorbent for various concentrations of an adsorbate at a specific temperature, which can be represented graphically. *See id.* at *53.

The '844 patent describes the first, fuel-side adsorbent as preferably being a “standard high working capacity carbon[.]” '844 patent col. 3 ll. 46–47. The second, vent-side adsorbent preferably “exhibits a flat or flattened adsorbent isotherm on a volumetric basis[,] in addition to certain characteristically desirable adsorptive properties across broad vapor concentrations.” *Id.* col. 3 ll. 47–51. These properties include “relatively low incremental capacity at high concentration vapors compared with the fuel source-side adsorbent volume.” *Id.* col. 3 ll. 51–53. According to the '844 patent, using a vent-side adsorbent with a flatter adsorption isotherm results in “giv[ing] up less vapor into the purge stream and this purge will then be more efficient in reducing vapor concentrations deeper into the bed.” *Id.* col. 4 ll. 31–55.

Claim 1 of the '844 patent is representative.³ It recites:

³ Ingevity makes no arguments for claims other than claim 1, so the case rises or falls on that claim.

1. A method for reducing fuel vapor emissions in automotive evaporative emissions control systems comprising the steps of contacting the fuel vapor with an initial adsorbent volume having incremental adsorption capacity at 25° C. of greater than 35 g n-butane/L between vapor concentrations of 5 vol % and 50 vol % n-butane and at least one subsequent adsorbent volume having an incremental adsorption capacity of less than 35 g n-butane/L between vapor concentrations of 5 vol % and 50 vol % n-butane.

'844 patent col. 10 ll. 36–44. We refer to the two steps of claim 1 as the “first adsorbent step” and the “second adsorbent step,” respectively.

II.

In the 1999–2000 timeframe Delphi was working on reducing evaporative emissions. This work led to the development of Delphi’s own fuel canister system (variously referenced in the record as the “Delphi Prior Invention,” “Delphi Epsilon Canister System,” or “DECS”). The parties agree that the Delphi Prior Invention was reduced to practice prior to the '844 patent’s priority date. The Delphi Prior Invention included a conventional carbon canister and an auxiliary canister containing carbon honeycombs. *Initial Determination*, 2020 WL 1026313, at *89. The Delphi engineers, Thomas Meiller, Susan LaBine, and Charles Covert, determined that the Delphi Prior Invention improved bleed emissions, and sought and received their own patent. *Id.* at *89, 93; see U.S. Patent No. 6,896,852 to Meiller et al. (“Meiller”). We refer to Mr. Meiller, Dr. LaBine, and Mr. Covert as the “Delphi Inventors.”

III.

In its complaint, Ingevity alleged violation of section 337 based upon infringement of claims 1–5, 8, 11, 13, 18,

19, 21, 24, 31, 33, 36, 38, 43, 45, 48, and 50⁴ of the '844 patent.⁵ As noted, Ingevity subsequently amended the complaint to include Intervenors as Respondents. In due course, the Commission instituted proceedings, and the matter was assigned to an ALJ.

In the *Initial Determination*, dated January 28, 2020, the ALJ held that the asserted claims of the '844 patent were anticipated by the Delphi Prior Invention and/or obvious in view of the Delphi Prior Invention or the combination of the Delphi Prior Invention and other references. 2020 WL 1026313, at *97. The ALJ also held, *inter alia*, that the asserted claims were rendered obvious over Meiller and/or U.S. Patent No. 5,914,294 to Park et al. ("Park") and other references. *Id.* at *103.

Before the ALJ, the parties do not appear to have disputed that the Delphi Prior Invention met the first adsorbent step limitation of claim 1. Considering the second adsorbent step limitation of claim 1, in view of evidence suggesting that the Delphi Inventors were supplied with honeycombs having a BWC of 3.7 g/dL, the ALJ found it to be "a reasonable inference that the BWC of the honeycombs contained in the DECS would also have been 3.7g/dL," which the ALJ found to correlate "to an IAC of under 35 g/L," thereby satisfying the requirements of the second adsorbent step limitation of claim 1. *Initial Determination*,

⁴ Initially, Ingevity also asserted claims 15, 28, 40, and 52 of the '844 patent. Ingevity later withdrew its assertions of infringement with respect to those claims.

⁵ Section 337 prohibits the "importation into the United States, the sale for importation, or the sale within the United States after importation" of articles that "infringe a valid and enforceable United States patent." 19 U.S.C. § 1337(a)(1)(B).

2020 WL 1026313, at *89, 96.⁶ The ALJ also determined that the Delphi Inventors appreciated that they had constructed a canister system that improved bleed emissions performance relative to conventional carbon canisters and did not “abandon, suppress, or conceal their invention.” *Id.* at *89–93.

Both Ingevity and Intervenors petitioned for the Commission to review various aspects of the ALJ’s *Initial Determination*. In addition to other issues, Ingevity petitioned for review of the ALJ’s determination that the Delphi Prior Invention rendered the asserted claims invalid and the ALJ’s determination that the asserted claims were invalid over the combination of Meiller, Park, and/or other references. The Commission determined to review the issue of obviousness over Meiller, Park, and/or other references, as well as six other issues. However, the Commission determined not to review the ALJ’s ruling of invalidity based on the Delphi Prior Invention. *Commission Determination*, 2020 WL 1700337, at *2–3. Ultimately, the Commission decided “to take no position on the issues under review.” *Id.* The Commission found no violation of section 337 “based on the unreviewed findings of the [*Initial Determination*] that the asserted claims have been shown to be invalid under 35 U.S.C. [§] 102 and/or 35 U.S.C. [§] 103 over the Delphi [P]rior [I]nvention, or the combination of the Delphi [P]rior [I]nvention with other references.” *Id.* at *3. This appeal followed.

DISCUSSION

I.

We review the Commission’s final determination under the standards of the Administrative Procedure Act, 5

⁶ For purposes of this appeal, Ingevity does not challenge the ALJ’s finding that a BWC of 8 g/dL roughly correlates with an IAC of 35 g/L. Appellant’s Br. 55 n.5.

U.S.C. § 706; *Mayborn Grp., Ltd. v. Int'l Trade Comm'n*, 965 F.3d 1350, 1353 (Fed. Cir. 2020). We review the Commission's legal determinations *de novo* and its factual findings for substantial evidence. *Id.* "Priority of invention and its constituent issues of conception and reduction to practice are questions of law predicated on subsidiary factual findings." *Singh v. Brake*, 317 F.3d 1334, 1350 (Fed. Cir. 2003). Patent invalidity is an affirmative defense to an action for infringement before the Commission. *Mayborn*, 965 F.3d at 1355 (citations omitted). "All factual propositions and inferences underlying an invalidity defense must be proven by clear and convincing evidence." *Id.* (citing *Microsoft Corp. v. i4i Ltd. P'ship*, 564 U.S. 91, 95 (2011)).

II.

As noted, the pre-AIA version of 35 U.S.C. § 102(g)(2) governs this appeal. Pre-AIA § 102(g)(2) provided:

A person shall be entitled to a patent unless—

...

(g) . . . (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

In order to establish an actual reduction to practice, the prior inventor must have (1) constructed an embodiment or performed a process that met all the limitations of the claim(s) at issue and (2) determined that the invention would work for its intended purpose. *Mycogen Plant Sci. v.*

Monsanto Co., 243 F.3d 1316, 1332–33 (Fed. Cir. 2001).⁷ Consistent with this second requirement and the requirement of conception that inventors must form in their minds a “definite and permanent idea of the complete and operative invention,” *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1376 (Fed. Cir. 1986), an alleged prior invention will not anticipate under 35 U.S.C. § 102(g) unless the alleged prior inventors “appreciated” the invention. *See Dow Chem. Co. v. Astro-Valcour, Inc.*, 267 F.3d 1334, 1341 (Fed. Cir. 2001). Specifically, “the inventor must contemporaneously appreciate that the embodiment worked and that it met all the limitations of the [claims].” *Cooper v. Goldfarb*, 154 F.3d 1321, 1327 (Fed. Cir. 1998). However, it is not required that “[a prior inventor] establish that he recognized the invention in the same terms as those recited in the [claims]. The invention is not the language of the [claims] but the subject matter thereby defined.” *Dow Chem.*, 267 F.3d at 1341 (quoting *Silvestri v. Grant*, 496 F.2d 593, 597 (C.C.P.A. 1974)).

For purposes of its appeal, Ingevity does not argue that the Delphi Prior Invention did not satisfy the limitations of claim 1 of the ’844 patent.⁸ Ingevity also does not dispute

⁷ We refer to the claims of the ’844 patent as representing the invention at issue, as opposed to an interference “count,” because this is not an interference proceeding under pre-AIA 35 U.S.C. § 135. *Mycogen*, 243 F.3d at 1332–33.

⁸ To the extent that counsel for Ingevity suggested otherwise at oral argument, *see, e.g.*, Oral Arg. at 39:13–40:35 (Mar. 4, 2020), available at http://oralarguments.cafc.uscourts.gov/default.aspx?fl=20-1800_03042021.mp3, we find this argument to have been waived because it was not set forth in Ingevity’s opening brief. *See SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1319 (Fed. Cir. 2006).

that Delphi did not abandon, suppress or conceal its invention. And finally, as noted above, there is no dispute that Delphi's reduction to practice of the Delphi Prior Invention was prior to Ingevity's earliest priority date. Instead, Ingevity argues that Intervenor did not meet their burden of establishing, by clear and convincing evidence, that the Delphi Inventors appreciated that the Delphi Prior Invention included all the limitations of claim 1 of the '844 patent for purposes of establishing a prior reduction to practice, and thus an anticipating prior invention under § 102(g)(2).

III.

As seen, claim 1 of the '844 patent is a method claim having two steps. The first adsorbent step involves contacting the fuel vapor "with an initial adsorbent volume having incremental adsorbent capacity . . . of greater than 35 g n-butane/L." In pertinent part, the second adsorbent step is contacting the fuel vapor with "at least one subsequent adsorbent volume having an incremental adsorption capacity of less than 35 g n-butane/L." '844 patent col. 10, ll. 37–44. Ingevity's principal contention on appeal is that the ALJ erred in determining that the Delphi Inventors appreciated that the Delphi Prior Invention performed the second adsorbent step. According to Ingevity, without having contemporaneously recognized and appreciated that step, the Delphi Inventors merely accidentally duplicated the invention defined by the claims of the '844 patent. Specifically, Ingevity argues that nowhere in his *Initial Determination* did the ALJ "find (or even suggest)" that the Delphi Inventors appreciated that the honeycombs in the auxiliary canister of the Delphi Prior Invention had an IAC below 35 g/L. See Appellant's Br. 30 ("Because the Delphi engineers never appreciated the claimed limitations—particularly the IAC of the honeycombs in the secondary canister—they did not conceive of the invention claimed in the '844 Patent."); *id.* at 49–50 ("[N]ot having appreciated a subsequent adsorbent volume with an IAC below 35 g/L, the Delphi engineers did not conceive of or appreciate the

entirely different invention disclosed and claimed by Ingevity”); *id.* at 51 (“In sum . . . the prior inventor must have appreciated a subsequent adsorbent volume with an IAC below 35 g/L.”); *id.* at 54 (“Nowhere in its discussion of Respondents’ Section 102(g)(2) invalidity defense did the ALJ find (or even suggest) that the Delphi engineers appreciated that the DECS’s honeycombs had an IAC below 35 g/L.”); *id.* at 55 (“The ALJ did not find that the Delphi engineers appreciated that the BWC of the DECS’s honeycombs was below 8 g/dL.”).⁹

IV.

We agree with Ingevity that Intervenor was required to prove by clear and convincing evidence that the Delphi Inventors appreciated that the auxiliary canister of the Delphi Prior Invention included an adsorbent that had an IAC of less than 35 g/L, or its correlative for purposes of this appeal: a BWC of less than 8 g/dL. *See Mycogen*, 243 F.3d at 1336. We conclude, however, that substantial evidence supports the finding that Intervenor carried that burden.

There are several critical pieces of evidence bearing on this point. First is a letter dated October 28, 1999, from James R. Miller, Ph.D., Technical Manager for New

⁹ At oral argument, counsel for Ingevity also argued that the Delphi Inventors needed to appreciate the causative role played by the Delphi Prior Invention’s honeycombs in reducing bleed emissions. *See, e.g.*, Oral Arg. at 10:05–11:48. Ingevity waived this argument, however, because its briefing was limited to the argument that the Delphi Inventors did not appreciate that the honeycombs in the Delphi Prior Invention’s auxiliary canister had an IAC below 35 g/L. *See SmithKline Beecham*, 439 F.3d at 1319 (“Our law is well established that arguments not raised in the opening brief are waived.”).

Product Development at Westvaco Corporation (“Westvaco”) to Mr. Meiller, one of the three Delphi Inventors. J.A. 11160. Dr. LaBine and Mr. Covert, the other two Delphi Inventors, are copied on the letter. *Id.* In the letter, Dr. Miller informs Mr. Meiller that he is shipping “two developmental honeycomb samples for your work on reducing canister bleed emissions,” and he lists as an attachment to the letter the “basic properties” that Westvaco had measured for the two honeycomb samples. *Id.* Among the “basic properties” listed is “Volumetric Butane Working Capacity, g/[dL]” of “3.7.” J.A. 11161. A second piece of evidence is a letter dated December 7, 1999, from Dr. Miller to Mr. Meiller, and again copying Dr. LaBine and Mr. Covert. J.A. 11162. The letter indicates that “[a]s requested,” Westvaco had “shipped to [Mr. Meiller’s] attention six honeycomb parts [that] have been given the Sample Number 445-S-99.” J.A. 11162–63. The letter states that the honeycomb parts “were made with the same carbon, formation and cell density as the previous parts [Mr. Meiller] tested.” *Id.* The last piece of evidence is the physical auxiliary canister of the Delphi Prior Invention, which was produced at the deposition of Dr. LaBine. The canister has a tag indicating that the honeycombs inside are sample number 445-S-99. 2020 WL 1026313, at *89.

As noted, based upon this evidence, the ALJ found it to be a “reasonable inference” that the honeycombs contained in the Delphi Prior Invention also would have had a BWC of 3.7 g/dL, *Initial Determination*, 2020 WL 1026313, at *89, which the ALJ found to correlate to the IAC of below 35g/L required in the second adsorbent step limitation of claim 1. *Id.* at *96. We believe that the two letters and the physical auxiliary canister constitute substantial evidence that the Delphi Inventors appreciated that the honeycombs of the Delphi Prior Invention had the pertinent adsorptive capacity, regardless of whether they were defined in terms of BWC or IAC. *See Dow Chem.*, 267 F.3d at 1341. That is, the inventors had before them, and knowingly utilized

in a method that they knew worked to reduce fuel vapor emissions, an adsorbent that they had been informed met in substance the second adsorbent step of claim 1. *See Mycogen*, 243 F.3d at 1337 (“Although the amount of evidence regarding appreciation of each specific claim limitation is not extensive, we find that it is legally satisfactory, particularly in light of the extensive evidence establishing that Monsanto performed a process that met all of the limitations of the claims, and that the resulting product was successfully tested and appreciated to work for its intended purpose.”); *see also Invitrogen Corp. v. Clontech Labs., Inc.*, 429 F.3d 1052, 1064 (Fed. Cir. 2005) (“The priority determination requires evidence that the inventor actually first made the invention, and that he understood his creation to have the features that[] comprise the inventive subject matter at bar.”).

Ingevity asserts that the ALJ did not expressly find that the Delphi Inventors appreciated that the honeycombs of the Delphi Prior Invention’s auxiliary canister had the pertinent adsorptive capacity. But we think that the ALJ did so find. The ALJ found: “The record shows that the individuals associated with the DECS sufficiently appreciated their invention under 102(g)(2).” *Initial Determination*, 2020 WL 1026313, at *90; *see also id.* at 93. In view of the substantial evidence illustrating the Delphi Inventors’ appreciation that the honeycombs of the Delphi Prior Invention’s auxiliary canister had the pertinent adsorptive capacity discussed above, we read the ALJ’s statement as making the finding that Ingevity says is missing.

V.

In its second argument on appeal, Ingevity requests that we “make clear” that the determinations of the ALJ that the Commission chose to review, but with respect to which the Commission ultimately took no position, are vacated by operation of law. Appellant’s Br. 56–61. Because it cannot now seek further review of the ALJ’s

determinations due to “happenstance,” Ingevity argues, we should follow the “equitable tradition” that unreviewable decisions should be vacated. *Id.* at 59 (quoting *U.S. Bancorp Mortgage Co. v. Bonner Mall Partnership*, 513 U.S. 18, 25 (1994) and *United States v. Munsingwear, Inc.*, 340 U.S. 36, 39–40 (1950)). Specifically, Ingevity states that it “is concerned that its opponents may attempt to use the ALJ ruling [of obviousness over Meiller, Park, and/or other references] against it in the district court.” Appellant’s Br. 58–59.

We do not agree that the ALJ’s determinations that the Commission chose to review but on which it took no position should be vacated by operation of law. That a judgment may be vacated where the case becomes moot by happenstance while on appeal is a matter “not of constitutional necessity but of remedial discretion.” *LSI Corp. v. U.S. Int’l Trade Comm’n*, 604 F. App’x 924, 930 (Fed. Cir. 2015). We decline to exercise that discretion here. Even if the ALJ’s *Initial Determination* were treated as a final Commission determination, it would “have no preclusive effect in other forums.” *Tex. Instruments Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1569 (Fed. Cir. 1996); see Appellant’s Br. 58. And, to the extent a litigant invokes the ALJ’s decision in another tribunal for the persuasiveness of its reasoning, “the success of that invocation depends on the decision’s content, not its status.” *LSI Corp.*, 604 F. App’x at 930. That tribunal may “decide what if any effect the decision should have.” *Id.*

CONCLUSION

We have considered Ingevity’s other arguments on appeal and find them to lack merit. For the foregoing reasons, we affirm the Commission’s final determination.

AFFIRMED

ADDENDUM

35 U.S.C. 102(g) (pre-America Invents Act)

A person shall be entitled to a patent unless — . . .

(g) (1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

CERTIFICATE OF SERVICE

I, Mark A. Perry, hereby certify that on this 7th day of September, 2021, I caused the foregoing to be filed with the Court using the CM/ECF system. I certify that all participants in the case are registered CM/ECF users and that service will be accomplished by this Court's appellate CM/ECF system.

Dated: September 7, 2020

/s/ Mark A. Perry

Mark A. Perry

GIBSON, DUNN & CRUTCHER LLP

1050 Connecticut Avenue, N.W.

Washington, D.C. 20036

(202) 955-8500

CERTIFICATE OF COMPLIANCE

1. This brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 28. In compliance with Federal Rule of Appellate Procedure 40, this brief contains 3,703 words, excluding the parts of the brief exempted by Federal Circuit Rule 32(b).

2. This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the typestyle requirements of Federal Rule of Appellate Procedure 32(a)(6) because this brief has been prepared in a proportionally spaced typeface using Microsoft Word 2019 in Times New Roman, 14-point font.

Dated: September 7, 2021

/s/ Mark A. Perry

Mark A. Perry
GIBSON, DUNN & CRUTCHER LLP
1050 Connecticut Avenue, N.W.
Washington, D.C. 20036
(202) 955-8500