Nos. 22-1136; -1186

United States Court of Appeals for the Federal Circuit

C.R. BARD, INC. and BARD PERIPHERAL VASCULAR, INC.,

Plaintiffs-Appellants

v.

MEDICAL COMPONENTS, INC.,

Defendant-Cross-Appellant.

Appeal from the United States District Court for the District of Utah,
Case No. 2:12-cv-00032-RJS-DAO, Chief District Judge Robert J. Shelby

COMBINED PETITION FOR PANEL REHEARING AND REHEARING *EN BANC* OF DEFENDANT-CROSS-APPELLANT MEDICAL COMPONENTS, INC.

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Dated: March 20, 2023

CERTIFICATE OF INTEREST

Counsel for Medical Components, Inc. ("MedComp") hereby certifies the following:

1. The full name of every party or amicus represented by me is: Medical Components, Inc.

2. The name of the Real Party in interest (Please only include any real party in interest NOT identified in Question 3) represented by me is: None.

3. All parent corporations and any publicly held companies that own 10% or more of the stock of the party or amicus curiae represented by me are: None.

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court (and who have not or will not enter an appearance in this case) are:

- MONTGOMERY McCRACKEN WALKER & RHOADS LLP: Alfred W. Zaher, Aaron S. Haleva, Brianna Vinci*, John J. Powell, Peter Breslauer, Stephanie K. Benecchi, Joseph C. Monahan*, Maryellen Madden, Patrick J. Farley, Joseph E. Samuel, Jr.

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5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal: *C.R. Bard, Inc., et al. v. Medical Components, Inc.*, C.A. No. 2:17-cv-00754-HCN-DAO (D. Utah); *C.R. Bard, Inc. et al. v. Smiths Medical ASD, Inc.*, C.A. No. 20-1543-CFC (D. Del.); *C.R. Bard, Inc. et al. v. AngioDynamics, Inc.*, C.A. No. 20-1544-CFC (D. Del.). This civil action previously came before this Court on a petition for writ of mandamus concerning an unrelated issue. *See* Order, *In re Medical Components, Inc.*, Case No. 13-148 (Fed. Cir. Aug. 2, 2013). The panel was comprised of Judges Rader, Bryson, and Wallach.

6. Information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees): Not applicable.

Dated: March 20, 2023

/s/ Alfred W. Zaher
Alfred W. Zaher

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES

Cases

Table of Authorities
(*continued*)

Statutes

STATEMENT OF COUNSEL

Based on my professional judgment, I believe the Panel's decision is contrary to at least the following precedents of this Court or the U.S. Supreme Court:

- *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012)
- *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208 (2014)
- *Ex Parte Abraham*, 1869 C.D. 59 (Comm. Pat. 1869)
- *In re Russell*, 18 C.C.P.A. 1184, 48 F.2d 668 (1931)
- *In re McKee*, 20 C.C.P.A. 1018, 64 F.2d 379 (1933)
- *In re Miller*, 418 F.2d 1392 (C.C.P.A 1969)
- *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983)
- *In re Ngai*, 367 F.3d 1336 (Fed. Cir. 2004)
- *AstraZeneca LP v. Apotex, Inc.*, 633 F.3d 1042 (Fed. Cir. 2010)
- *King Pharms., Inc. v. Eon Labs, Inc.*, 616 F.3d 1267 (Fed. Cir. 2010)
- *In re Distefano*, 808 F.3d 845 (Fed. Cir. 2015)
- *Secured Mail Sols. LLC v. Universal Wilde, Inc.*, 873 F.3d 905 (Fed. Cir. 2017)
- *Praxair Distribution, Inc. v. Mallinckrodt Hosp. Prod. IP Ltd.*, 890 F.3d 1024 (Fed. Cir. 2018)
- *In re Marco Guldenaar Holding B.V.*, 911 F.3d 1157 (Fed. Cir. 2018)
- *Chamberlain Grp., Inc. v. Techtronic Indus. Co.*, 935 F.3d 1341 (Fed. Cir. 2019)
- *Simio, LLC v. Flexsim Software Products, Inc.*, 983 F.3d 1353 (Fed. Cir. 2020)

Dated: March 20, 2023

/s/ Alfred W. Zaher
Alfred W. Zaher

PRELIMINARY STATEMENT

Panel rehearing is necessary to clarify the Panel's unbounded statement that the asserted claims "are eligible under § 101." The only issue before the Panel was whether Bard's asserted claims were eligible after the district court *assumed Bard's proposed construction* for purposes of summary judgment under § 101. Whether they are eligible when *properly* construed after a *Markman* hearing—which has not yet occurred—was not before the Panel. Rehearing and clarification on this point is essential, as both parties have conflicting proposed constructions for the very claim terms upon which the eligibility of all Bard's asserted claims rely.

En banc rehearing is necessary because *C.R. Bard, Inc. v. AngioDynamics, Inc.*, 979 F.3d 1372 (Fed. Cir. 2020) ("*Angio*"), which the Panel openly criticized but nonetheless felt "bound" to follow, cannot be reconciled with controlling Supreme Court and Federal Circuit precedent. *Angio* should be overruled.

For nearly a century, this Court and its predecessor held that unpatentable "printed matter" includes both the "*matter*" itself and the information conveyed thereby.[1] *Angio*, by contrast, disregarded this controlling precedent and separated

[1] *See In re Marco Guldenaar Holding B.V.*, 911 F.3d 1157 (Fed. Cir. 2018) (Chen, J.); *Praxair Distribution, Inc. v. Mallinckrodt Hosp. Prod. IP Ltd.*, 890 F.3d 1024, 1032 (Fed. Cir. 2018) (Lourie, J.) (reinforcing that printed matter doctrine is broad in scope and precludes patenting mere conveyance of information "using any medium"); *In re Distefano*, 808 F.3d 845 (Fed. Cir. 2015) (Prost, J.); *King Pharms., Inc. v. Eon Labs, Inc.*, 616 F.3d 1267 (Fed. Cir. 2010); *AstraZeneca LP v. Apotex, Inc.*, 633 F.3d 1042 (Fed. Cir. 2010); *In re Ngai*, 367 F.3d 1336 (Fed. Cir. 2004); *In*

the information conveyed from "the means by which that information is conveyed," now giving those "means" patentable weight. *Angio* at 1384. That conflicts with this Court's precedent: "markings" on dice were deemed unpatentable printed matter just two years earlier, even though the means of the markings were separate from the information conveyed. *See Marco Guldenaar*, 911 F.3d at 1161. Likewise, *Angio* conflicts with the holding that "labels" on drugs were not entitled to patentable weight even though labels are the "means" by which the information was conveyed. *See King Pharms.*, 616 F.3d at 1279; *AstraZeneca*, 633 F.3d at 1064-65; *Ngai*, 367 F.3d at 1338-39.

The Panel recognized *Angio*'s flaws at oral argument.[2] Judge Hughes stated his belief that "the whole analytical framework in *AngioDynamics* is nuts[.]" *Id.* at 30:04. When questioning counsel for Plaintiff-Appellant C.R. Bard, Inc. ("Bard"), Judge Wallach suggested the Court could "distinguish [*Angio*], or we could ask for an *en banc*." *Id.* at 17:49. And Judge Chen, exploring a hypothetical with Bard's counsel, astutely noted that "in all our printed matter cases … we never said, 'oh,

re Gulack, 703 F.2d 1381 (Fed. Cir. 1983); *In re Miller*, 418 F.2d 1392 (C.C.P.A 1969); *In re McKee*, 20 C.C.P.A. 1018, 64 F.2d 379 (1933); *In re Russell*, 18 C.C.P.A. 1184, 48 F.2d 668 (1931); *see also Ex Parte Abraham*, 1869 C.D. 59 (Comm. Pat. 1869).

[2] Oral Argument Recording, *C.R. Bard, Inc. v. Medical Components, Inc.*, No. 22-1136, accessible at https://oralarguments.cafc.uscourts.gov/default.aspx?fl=22-1136_02102023.mp3 (citations to timestamps of recording).

you know, the ink is the means for conveying the information and so therefore … that will get patentable weight but the information that is being conveyed by the ink does not get patentable weight.'" *Id.* at 06:23. But this is exactly how *Angio* departed from prior controlling precedent.

The Panel recognized that in this case, the sole claimed advance was putting information – in the form of a radiographic message (i.e., a message having the quality of being visible under X-ray) – on an old device, somehow making that old device patentable because the message (the "ink") is a "means" for conveying information. *Angio* should be overruled because it makes an old product patentable simply by placing a message on it. This cannot be the law.

Even if the Court declines to overrule *Angio* for contradicting controlling precedent, it should correct the Panel's misapplication of *Angio*. The Panel erred by ignoring the stark and significant differences between the district court records in *Angio* and in this case. Those differences compel a different outcome. At step *one* of *Alice*—not just step two, as Bard argued—the Court must first ask "what the patent asserts to be *the focus of the claimed advance over the prior art*," so as to determine the claim's "character as a whole." *Simio, LLC v. Flexsim Software Products, Inc.* 983 F.3d 1353, 1359 (Fed. Cir. 2020) (emphasis added). Here, had the Panel thoroughly followed this step one analysis, it would have faced significant and undisputed evidence in this case that was nowhere in the *Angio* record. This

undisputed evidence establishes that the claimed "means" for conveying information (i.e., radiopacity – the quality of being visible under X-ray) has been routinely and conventionally used on implantable medical devices for decades and cannot be the "focus of the claimed advance." The Panel then would have been driven to the proper conclusion that the *only possible* "focus of the claimed advance over the prior art" in Bard's patents is the patent ineligible information conveyed. Even if this Court deems *Angio* correctly decided, it is not controlling here as to evidence-dependent facts.

Additionally, in holding that it was "bound" by *Angio* and that the asserted claims of all three Bard patents (the '302, '022, and '615 patents) were eligible under § 101, the Panel completely overlooked another critical difference between *Angio* and this case. That is, it failed to address the asserted claim of the '615 patent, which has no counterpart in the claims asserted in *Angio* as it is not directed to and does not claim any radiographic marker. Even if *Angio* compelled a finding of eligibility as to the asserted claims of the '302 and '022 patents, it has no bearing on the asserted '615 patent claim. Rather, cases like *Marco Guldenaar* or *Praxair* are far closer and clearly compel a different result.

ARGUMENT

I. Because The Court Merely Assumed Bard's Proposed Construction, The Panel Should Make Clear It Did Not, Because It Could Not, Hold The Claims Were Eligible No Matter How Construed.

For purposes of MedComp's motion for summary judgment, the district court did not construe the asserted claims; instead, it *assumed Bard's proposed construction*. This Panel reversed the grant of summary judgment based on this Bard construction, but that does not mean that once the claims are construed, they are eligible. The Panel should clarify that it did not decide what it could not decide, which is that the claims are categorically eligible under *any* construction. *See Bancorp Servs., LLC v. Sun Life Assur. Co. of Canada (U.S.)*, 687 F.3d 1266, 1273-74 (Fed. Cir. 2012) ("it will ordinarily be desirable—and often necessary—to resolve claim construction disputes prior to a § 101 analysis, for the determination of patent eligibility requires a full understanding of the basic character of the claimed subject matter."). This is especially true where, as here, Bard did not move for affirmative summary judgment of eligibility. Rather, Bard simply opposed MedComp's motion for summary judgment of *ineligibility*.

To avoid confusion on remand regarding the scope of the panel's decision, the Panel should clarify that it held only that the claims are eligible under § 101 using Bard's *proposed* construction at summary judgment, prior to any *Markman* hearing.

II. *En Banc* Rehearing Is Necessary To Correct *Angio*'s Erroneous Separation Of The "Means" Of Conveying Information From The "Content" Of That Information

Angio's core holding—that the "content of the information conveyed" by a claim limitation is printed matter, but "the means by which that information is conveyed" is not—was a complete departure from decades of printed matter jurisprudence. This line of cases, usually involving §§ 102 or 103, held that "printed matter must be *matter claimed for what it communicates*." *Distefano*, 808 F.3d at 850 (emphasis added). The *Angio* panel had no authority to overturn prior precedent. Indeed, the *Angio* panel's divorce of "content" from "means" cannot be reconciled with at least the following precedential decisions (in reverse chronological order):

- ***Marco Guldenaar***, where the Court held that "markings" on dice "constitute[d] printed matter" because the markings "communicate[d] information" about whether a player won or lost. 911 F.3d at 1161. That such "markings" were "the means by which that information is conveyed," as *Angio* put it, was of no moment.

- ***Distefano***, where the Court noted that "[s]ince 1931, both our predecessor court and our court have consistently limited the printed matter rule to *matter* claimed for its communicative content." 808 F.3d at 849 (emphasis added).

- ***AstraZeneca***, where the Court held that "a label instructing not more than once-a-day dosing" of a drug was non-functional printed matter. 633 F.3d at 1064-65. Again, the fact that a "label" is a "means" for conveying this dosage information had no relevance. Instead, the Court properly considered—and properly rejected—AstraZeneca's argument that "a drug label is essential to

physicians when prescribing a drug and, therefore, is functionally related to the drug." *Id.* at 1064.

- ***In re Ngai***, a case very similar to *AstraZeneca* where the Court affirmed the rejection of a claim reciting a kit comprising instructions to amplify ribonucleic acids. 367 F.3d at 1339.

- ***In re Gulack***, where this Court held that "digits imprinted on [a] band or ring" were printed matter, but were entitled to patentable weight because they had a functional relationship to the band or ring. 703 F.2d at 1385-86. The "means" of imprinting the digits had no place in this analysis.

- ***In re Miller***, where the Court of Customs and Patent Appeals held that "indicia" and a "legend" that conveyed volumetric units on measuring spoons constituted printed matter, but were entitled to patentable weight because they had a functional relationship to the measuring spoons. 418 F.2d at 1395-96. As in *Gulack*, nowhere in this printed matter analysis did the Court consider that "volume measuring indicia" etched into the spoon or "a legend attached to said spoon" are "means" for conveying information.

- ***In re Russell***, where the Court of Customs and Patent Appeals held that an "alleged novel arrangement of names in directories and dictionaries" was non-patentable printed matter. 48 F.2d at 1185-86. This too is a "means" of conveying information and was claimed as such. *Id.*

Each of these cases is irreconcilable with *Angio*'s holding that the "content of the information conveyed" by a claim limitation is printed matter but "the means by which that information is conveyed" is not. Even *Ex Parte Abraham*, 1869 C.D. 59 (Comm. Pat. 1869), which this Court recognized as the genesis of the printed matter

doctrine in *Distefano*, is incompatible with *Angio*. *See Distefano*, 808 F.3d at 849. In *Abraham*, the Commissioner of Patents held that coupons with various kinds of stamps and figures were not patentable subject matter. 1869 C.D. 59. It made no difference that stamps and figures are "means" of conveying information.

Instead of divorcing the information conveyed by printed matter from the matter itself, this long line of cases clearly established that printed matter *in any medium* is not afforded patentable weight unless it bears a functional relationship to its substrate. *Praxair*, 890 F.3d at 1032 (citing *DiStefano*, 808 F.3d at 850). In *Miller*, for example, the "indicia" etched into measuring spoons and a "legend" attached to the spoons—in other words, the "means" for conveying the spoons' volume—constituted printed matter but were afforded patentable weight because they added new fractional-measurement functionality to the spoons. 418 F.2d at 1395-96. In other words, the spoons only worked because of the printed matter.

Contradicting its own logic, *Angio* actually performed this functional relationship analysis regarding Bard's radiographic markers *and found against Bard*. *Angio* at 1382. The Court rejected Bard's contention "that the information conveyed by the markers provides new functionality to the port." *Id.* The *Angio* Court even stated as follows:

> A conclusion that mere identification of a device's own functionality is sufficient to constitute new functionality for purposes of the printed matter doctrine would eviscerate our established case law that "simply adding

> new instructions to a known product" does not create a functional relationship.

Id. (citing *AstraZeneca*, 633 F.3d at 1065; *Ngai*, 367 F.3d at 1339). But *Angio* then went on to afford the radiographic markers patentable weight anyway, finding that the printed matter at issue is merely "the content of the information conveyed," not "the means by which that information is conveyed." *Id.* at 1384.

These two propositions, both contained within the same *Angio* opinion, are irreconcilable and further demonstrate *Angio*'s legal error. Identifying and then separating the "means" by which information is conveyed is simply another way of determining whether that information bears a functional relationship to its substrate. This is confirmed by the sentence immediately following *Angio*'s core holding:

> When each claim is read as a whole, the focus of the claimed advance is not solely on the content of the information conveyed, but also on the means by which that information is conveyed. *In particular, the claimed invention is described in the patents as satisfying a specific need for easy vascular access during CT imaging, and it is the radiographic marker in the claimed invention that makes the claimed port particularly useful for that purpose because the marker allows the implanted device to be readily and reliably identified via x-ray, as used during CT imaging.*

Angio at 1384 (emphasis added). This passage directly conflicts with *Angio*'s earlier holding, in the same opinion, that the radiographic marker does not improve the port's function. Indeed, the Court's description of the radiographic marker's "particular[] useful[ness]" *depends* on the information conveyed. In other words,

the marker would not have the usefulness the Court ascribes to it if it did not convey the conventional port's power injectable capability. The means and the content of this information are inseparable.

Angio is both (1) irreconcilable with the Court's prior printed matter precedents and (2) irreconcilably inconsistent within the opinion itself. While *Angio* was a § 101 case, litigants will use (or abuse) Angio's divorce of the "content" of information and the "means" of conveying that content in any future printed matter cases going forward unless this Court overrules or clarifies its holding.

III. The Panel Misapplied The Holding In *Angio* By Failing To Consider the Stark Differences Between the Lower Court Records And Further Failing To Perform The Required Analysis Under *Alice*.

Even if the Court declines to overrule or clarify *Angio*, it should nevertheless correct the Panel's error in summarily applying as *Angio*'s "holding" what are actually fact-dependent findings on a very different record. Although noting that "[w]e review an 'ultimate conclusion on patent eligibility de novo,'" Opinion at 5 (citing *Marco Guldenaar*), the Panel failed to perform any review of Judge Shelby's separate and independent *Alice* analysis, focusing solely on printed matter.[3] Because

[3] This omission was especially glaring here, because the district court first found Bard's asserted claims ineligible by applying *Angio* and the printed matter doctrine, but then *confirmed* their ineligibility by starting the analysis over again to find, under *Alice*, that the claims were directed to the abstract idea of communicating information and lacked any inventive concept, a separate and independent grounds of ineligibility. Appx00029-40 (citing *Secured Mail Sols., LLC v. Universal Wilde*,

the Panel failed to review the *Alice* issues, it ignored the voluminous new evidence—never presented in *Angio*—demonstrating that it was well-known, routine, and conventional to use radiopaque letters and markings on implantable medical devices[4] at the time of the filing of the Bard patents.

Thus, under a proper *Alice* step one inquiry, radiopaque characters and messages cannot plausibly serve as "the focus of the claimed advance." *See Chamberlain Grp., Inc. v. Techtronic Indus. Co.*, 935 F.3d 1341, 1346 (Fed. Cir. 2019) (Chen, J.) ("*At step one*, we look at the focus of the claimed advance *over the prior art* to determine if the claim's character as a whole is directed to excluded subject matter.") (emphasis added; internal quotation omitted). Even if the claims in *Angio* are "substantially similar to the asserted claims here" (Opinion at 5), the record is very different. *Angio* cannot be "binding precedent" for its *factual findings*, and MedComp cannot be forced to pay the price here for a factual record that was never fully developed in *Angio*, which did not even involve the same patents or

Inc., 873 F.3d 905, 910 (Fed. Cir. 2017) (Reyna, J.). This second, distinct analysis had nothing to do with the printed matter doctrine or *Angio*.

[4] MedComp notes that implantable medical devices generally, not just a specific vascular access port device, are the relevant "field" for purposes of an *Alice-Mayo* analysis. *See Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 73 (2012) ("we find that the process claims at issue here … involve well-understood, routine, conventional activity previously engaged in by researchers *in the field*.") (emphasis added).

patent family. *See Stevenson v. Sears, Roebuck & Co.*, 713 F.2d 705, 710 (Fed. Cir. 1983) ("We also add, as stated earlier, that the prior holding of validity is not necessarily inconsistent with the subsequent holding of invalidity. In one action, the defendants did not overcome the statutory presumption of validity; in the other they did. The difference in result could be attributable to many neutral facts: e.g., different prior art references or different records.").

The Panel effectively applied issue preclusion to MedComp's § 101 challenge, which is procedurally improper. *See In re Trans Tex. Holdings Corp.*, 498 F.3d 1290, 1297-98 (Fed. Cir. 2007) ("We have never applied issue preclusion against a non-party to the first action."); *see also Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 327 n.7 (1979) ("It is a violation of due process for a judgment to be binding on a litigant who was not a party or a privy and therefore has never had an opportunity to be heard."). *Angio* held (based on a significantly different record) that the claimed advance of Bard's asserted patents was "a radiographic marker." However, Bard's asserted '302 and '022 patents in this case do not claim a "radiographic marker." Rather, they claim "radiopaque identification features," "radiopaque alphanumeric message[s]," and "radiopaque alphanumeric characters." Thus, the present claims are *even more abstract* than the "marker" analyzed in *Angio.* Further, they do not recite any implementational details of either the radiopacity or the claimed message.

Based on MedComp's voluminous and uncontroverted evidence, the trial judge found that "radiopaque identifiers were routinely used as information conveyors throughout the implantable medical device industry at the time of Bard's asserted patents." Appx00037. This evidence included well known devices such as pacemakers, Bard's own commercially available nitinol biliary stents, implantable defibrillators, surgical swabs, and sponges dating back to the 1960s. Appx00034-35; Appx02524; Appx02527; Appx02534-02553. Given the longstanding ubiquity of "radiopaque" identifiers, there was nothing left in the claims as even a *possible* claimed advance except *information itself*. As a result, the district court entered summary judgment of ineligibility at *Alice* step one, and found no redeeming features at *Alice* step two. Appx00037.

"Patent eligibility under 35 U.S.C. § 101 is a question of law," but it "may contain underlying issues of fact." *Marco Guldenaar*, 911 F.3d at 1159 (citing *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1365 (Fed. Cir. 2018). On a very different record, the district court found those issues of fact in MedComp's favor. Appx00037. Under this Court's precedent, the district court was correct to distinguish *Angio* at *Alice* step one based on this additional evidence:

> Contrary to the dissent's suggestions, we do not hold today that it is impermissible for courts to "look[ ] outside the intrinsic evidence" as part of their Alice step one inquiry … or that all evidence presented by the parties that doctors have long used the claimed techniques would be irrelevant to the inquiry in this case. It is within the trial court's

> discretion whether to take judicial notice of a longstanding practice where there is no evidence of such practice in the intrinsic record.

CardioNet, LLC v. InfoBionic, Inc., 955 F.3d 1358, 1373 (Fed. Cir. 2020).

The Panel erred by refusing to consider the plethora of MedComp's additional evidence showing that radiopaque identifiers have been widely known and routinely used on implantable medical devices for *decades*. If the Panel had properly considered such evidence, even under *Angio* it would have been compelled to determine, as did the district court, that the only possible focus of the claimed advance is the claimed content of information. Information alone, under this Court's well-established jurisprudence, is just not patentable.

IV. The Panel Should Perform an Independent Analysis of Subject Matter Eligibility of the '615 Patent.

Finally, panel or en banc rehearing is also necessary to correct the Court's analysis in view of the asserted claim of Bard's '615 patent. The Panel held that the asserted claims of *all three* Bard patents (the '302, '022, and '615 patents) were eligible under § 101, because it was "bound" by *Angio*. But the '615 patent does not claim any "radiographic marker" as was at issue in *Angio*. Indeed, the '615 patent has nothing to do with radiopacity. It claims the use of *shape* to convey information.

More particularly, the Panel erred in categorically stating that *Angio* "also involved patents directed to radiopaque markers that could be used to identify venous access ports as power injectable, and the claims at issue were substantially

similar to the asserted claims here." Opinion at 5. Rather than any radiographic or radiopaque markers, the '615 patent claims "at least one concave side surface" that "identifi[es] the access port as being power injectable subsequent to subcutaneous implantation." The focus of the claimed advance in the '615 patent is not and cannot be the use of shape identifiers, which, as shown by MedComp's voluminous and unrefuted evidence, have also long been routinely and conventionally used in the implantable medical device field. *See* Appx00039; Appx02554-2560. Rather, the '615 patent's focus of the claimed advance over the prior art is solely on "identifying" the access port as power injectable.

The patents before *Angio* bear no factual similarity to the '615 patent. Instead, the facts of *Marco Guldenaar* are far closer and compel a different result. There, this Court held that markings on dice were "directed to information" and "do not cause the die itself to become a manufacture with new functionality." *Guldenaar*, 911 F.3d at 1161. This Court there concluded that these markings were "the only arguably unconventional aspect of the recited method" and were "printed matter, which falls outside the scope of § 101." *Id.* at 1162. Likewise, the '615 patent's concave sides are the claimed port assembly's "only arguably unconventional aspect" and constitute non-patentable printed matter. The Court should grant rehearing and reach this conclusion as to the '615 patent.

CONCLUSION

For the above reasons, Panel rehearing is necessary to clarify whether the asserted claims "are eligible under § 101" prior to claim construction and *en banc* rehearing is necessary to consider whether *Angio* should be overturned. Even if the Court does not wish to overrule or clarify *Angio*, it should grant rehearing for a proper determination of whether this case's more fulsome district court record compels a different result from *Angio* and to correct the Panel's over-application of *Angio* to the '615 patent.

Respectfully submitted,

Dated: March 20, 2023

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CERTIFICATE OF COMPLIANCE

1. This petition complies with the type-volume limitation of Federal Rule of Appellate Procedure 35(b)(2)(A). This brief contains 3,877 words, excluding the parts of the petition exempted by Federal Rule of Appellate Procedure 32(f) and Federal Circuit Rule 32(b).

2. This petition complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6). This Brief has been prepared in a proportionally spaced typeface using Microsoft Word 2010 in 14-point font New Times Roman.

Respectfully submitted,

Dated: March 20, 2023

/s/ Alfred W. Zaher
Alfred W. Zaher

Counsel for Medical Components, Inc.

ADDENDUM

NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

C.R. BARD, INC., BARD PERIPHERAL VASCULAR, INC.,
Plaintiffs-Appellants

v.

MEDICAL COMPONENTS, INC.,
Defendant-Cross-Appellant

2022-1136, 2022-1186

Appeals from the United States District Court for the District of Utah in No. 2:12-cv-00032-RJS, Judge Robert J. Shelby.

Decided: February 17, 2023

KATHLEEN M. SULLIVAN, Quinn Emanuel Urquhart & Sullivan, LLP, Los Angeles, CA, argued for plaintiffs-appellants. Also represented by WILLIAM ADAMS, MATTHEW A. TRAUPMAN, New York, NY; STEVEN CHERNY, Boston, MA; GREGORY MIRAGLIA, Austin, TX; OMAR KHAN, Wilmer Cutler Pickering Hale and Dorr LLP, New York, NY; THOMAS SAUNDERS, Washington, DC.

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& Rhoads LLP, Philadelphia, PA, argued for defendant-cross-appellant. Also represented by JOHN J. POWELL, JOSEPH E. SAMUEL, JR; AARON S. HALEVA; CLINTON EARL DUKE, JAMES MARK GIBB, Durham Jones & Pinegar, PC, Salt Lake City, UT; JOSEPH MONAHAN, Gordon Rees Scully Mansukhani LLP, Philadelphia, PA.

JEFFREY COSTAKOS, Foley & Lardner LLP, Milwaukee, WI, for amicus curiae Smiths Medical ASD, Inc. Also represented by MICHELLE A. MORAN, REBECCA JAN PIROZZOLO-MELLOWES.

DANIELLE VINCENTI TULLY, Cadwalader, Wickersham & Taft LLP, New York, NY, for amicus curiae AngioDynamics, Inc. Also represented by JOHN T. AUGELLI, JOHN MOEHRINGER, MICHAEL BRIAN POWELL.

Before CHEN, WALLACH, and HUGHES, *Circuit Judges*.

HUGHES, *Circuit Judge*.

Plaintiffs-Appellants C.R. Bard Inc. and Bard Peripheral Vascular, Inc. appeal a decision from the United States District Court for the District of Utah finding the asserted claims for three asserted patents ineligible under 35 U.S.C. § 101. Defendant-Cross-Appellant Medical Components, Inc. cross-appeals a decision from the same court, also finding the asserted claims of its asserted patent ineligible under § 101. Because the district court's opinions are contrary to our binding precedent in *C R Bard Inc. v. AngioDynamics, Inc.*, we reverse the district court's opinion in the lead appeal (22-1136) and vacate and remand the district court's opinion in the cross-appeal (22-1186).

I

Plaintiffs-Appellants C.R. Bard Inc. and Bard Peripheral Vascular, Inc. (collectively, Bard) own three patents at issue in the lead appeal that are directed to

radiopaque markings and structural features that can be used to identify whether a venous access port is power injectable. Specifically, U.S. Patent Nos. 7,785,302 and 7,947,022 are directed to a venous access port with an alphanumeric message that can be seen on an X-ray and that identifies the port as power injectable. Representative claim 5 of the '302 patent claims:

> A venous access port assembly for implantation into a patient, comprising:
>
> > a housing having an outlet, and a needle-penetrable septum, the needle penetrable septum and the housing together defining a reservoir, wherein:
> >
> > > the assembly includes a radiopaque alphanumeric message observable through interaction with X-rays subsequent to subcutaneous implantation of the assembly, and
> > >
> > > the alphanumeric message indicating that the assembly is power injectable.

'302 patent at 13:8–18. U.S. Patent No. 7,959,615 is directed to a venous access port that includes a concave structure designed to be palpated through the skin, and that also identifies the port as power injectable. Claim 8 of the '615 patent claims:

> An access port for providing subcutaneous access to a patient, comprising:
>
> > a body defining a cavity accessible by inserting a needle through a septum, the body including a plurality of side surfaces and a bottom surface bounded by a bottom perimeter, the bottom surface on a side of the port opposite the septum, the bottom perimeter including a concave portion, the side surfaces including a first

> side surface through which an outlet stem extends; and
>
> at least one structural feature of the access port identifying the access port as being power injectable subsequent to subcutaneous implantation, at least one structural feature comprising at least one concave side surface in a second side surface different from the first side surface, the concave side surface extending to the bottom perimeter concave portion.

'615 patent at 13:23–14:7.

Medical Components, Inc. (MedComp) owns U.S. Patent No. 8,021,324 which, like Bard's patents, is directed to a venous access port assembly that includes characters that can be seen via X-ray inspection and that identify the port as power injectable. Representative claim 1 claims:

> An implantable venous access port assembly, comprising:
>
> a needle-penetrable septum; and
>
> a housing securing the needle-penetrable septum, the housing comprising a housing base having a bottom wall and X-ray discernable indicia embedded in the bottom wall, the X-ray discernable indicia comprising one or more characters that visually indicate, under X-ray examination, a pressure property of the port assembly.

'324 patent at 4:37–45.

Both parties moved for summary judgment, each asserting that the respective asserted patents were invalid under 35 U.S.C. § 101. The district court found that the asserted claims in each of Bard's three patents were ineligible under § 101 because the claims were solely directed to non-functional printed matter and because the

claims were directed to the abstract idea of "[using] an identifier to communicate information about the power injectability of the underlying port" with no inventive concept. *C.R. Bard, Inc. v. Medical Components, Inc.*, 550 F. Supp. 3d 1202, 1225 (D. Utah 2021). The district court then found the asserted claims of MedComp's '324 patent ineligible under § 101 based on the same analytical framework that it used for Bard's asserted patents. *C.R. Bard, Inc. v. Medical Components, Inc.*, 569 F. Supp. 3d 1164, 1170–71 (D. Utah 2021).

Both parties cross-appealed. This court has jurisdiction under 28 U.S.C. § 1295(a)(1).

II

We review orders granting summary judgment under the law of the regional circuit, while applying our own law to issues unique to patent law. *Centrak, Inc. v. Sonitor Techs., Inc.*, 915 F.3d 1360, 1365 (Fed. Cir. 2019). The Tenth Circuit reviews orders granting summary judgment de novo. *Birch v. Polaris Indus., Inc.*, 812 F.3d 1238, 1251 (10th Cir. 2015). We review an "ultimate conclusion on patent eligibility de novo." *In re Marco Guldenaar Holding B.V.*, 911 F.3d 1157, 1159 (Fed. Cir. 2018).

III

We are bound by our precedent in *C R Bard Inc. v. AngioDynamics, Inc.*, 979 F.3d 1372 (Fed. Cir. 2020). There, we considered a case that is virtually identical to the one before us now. *AngioDynamics* also involved patents directed to radiopaque markers that could be used to identify venous access ports as power injectable, and the claims at issue were substantially similar to the asserted claims here. Furthermore, that case asked to consider the exact same question that is before us now: whether claims that include non-functional printed matter could be eligible under § 101. The court in *AngioDynamics* concluded that, although the asserted claims contained some non-

functional printed matter, they were nonetheless eligible under § 101 because the claims were not solely directed to non-functional printed matter—they were also directed to "the means by which that information is conveyed." *Id.* at 1384. Given these similarities, we must reach the same conclusion here as in *AngioDynamics*.

Because we are bound by our precedent, we conclude that the asserted claims in Bard's three patents are directed to eligible subject matter under § 101. Accordingly, we reverse the district court's opinion in the lead appeal and find that the asserted claims of the '302, '022, and '615 patents are eligible under § 101. And because the district court applied the same erroneous § 101 analysis to MedComp's '324 patent, we vacate and remand the district court's opinion in the cross appeal and direct the district court to reconsider its findings in the first instance, consistent with this opinion.

REVERSED-IN-PART, VACATED-IN-PART AND REMANDED

COSTS

No costs.

United States Court of Appeals for the Federal Circuit

C.R. BARD, INC., BARD PERIPHERAL VASCULAR, INC.,
Plaintiffs-Appellants

v.

MEDICAL COMPONENTS, INC.,
Defendant-Cross-Appellant

2022-1136, 2022-1186

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JUDGMENT

THIS CAUSE having been considered, it is

ORDERED AND ADJUDGED:

REVERSED-IN-PART, VACATED-IN-PART AND REMANDED

FOR THE COURT

February 17, 2023
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

CERTIFICATE OF SERVICE

I, Alfred W. Zaher, hereby certify that on this 20th day of March, 2023, a true and correct copy of the foregoing Combined Petition for Panel Rehearing and Rehearing En Banc (with Addendum) has been filed electronically and is available for viewing and downloading from the ECF system. I further certify that I caused a true and correct copy of same to be served on all counsel of record via ECF filing.

Respectfully submitted,

Dated: March 20, 2023

/s/ Alfred W. Zaher
Alfred W. Zaher

Counsel for Medical Components, Inc.