

No. 2023-2134

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

CLEARPLAY, INC.,

Plaintiff-Appellant.

v.

DISH NETWORK L.L.C., ECHOSTAR TECHNOLOGIES LLC,

Defendants-Appellees.

*Appeal from the U.S. District Court for the District of Utah,
Case No. 2:14-cv-00191-DN, Judge David Nuffer*

**COMBINED PETITION FOR PANEL REHEARING
AND REHEARING EN BANC**

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June 26, 2026

CERTIFICATE OF INTEREST

Pursuant to Fed. Cir. R. 47.4(a), Counsel for Plaintiff-Appellant ClearPlay, Inc. certifies the following:

1. The full names of the parties represented by undersigned counsel in this case: ClearPlay, Inc.

2. The full names of all real parties in interest for the entities if different from the represented entities: None/Not Applicable.

3. The full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities: None/Not Applicable.

4. The 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, but who have not already entered an appearance in this Court, are:

Beus Gilbert McGroder PLLC: Leo R. Beus, David Alexander Neal, K. Reed Willis,
Ray Quinney & Nebeker P.C.: Samuel C. Straight,
Foley & Lardner LLP: David L. Mortensen,
Kirton McConkie P.C.: James T. Burton, Brian D. Tucker, Joshua S. Rupp,
Newman Jones PLLC: Daniel Joseph Anderson,
The Jon Corn Law Firm: Lee M. Andelin,
Mills + Wood Law PLLC: Thomas A. Connelly, and
Ernst, Brown, and Draper PLLC.

5. 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:

VidAngel LLC v. ClearPlay Inc., 2:14-cv-00160 (D. Utah).

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):
None/Not Applicable.

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STATEMENT OF COUNSEL UNDER FEDERAL CIRCUIT RULE 35(b)

Based on my professional judgment, I believe the panel decision conflicts with the following decisions of the Supreme Court: *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605 (1950), and *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997).

Based on my professional judgment, I believe this appeal requires an answer to the following precedent-setting question of exceptional importance: whether the Federal Circuit’s requirement of “particularized testimony and linking argument,” as applied to set aside a jury’s equivalence verdict resting on panel-credited limitation-specific testimony and on *Warner-Jenkinson* enumerated factors, conflicts with *Warner-Jenkinson* and *Graver Tank*.

Respectfully Submitted,

/s/ Robert Greenspoon

Robert Greenspoon

*Counsel for Plaintiff-Appellant
ClearPlay, Inc.*

INTRODUCTION

A jury found that DISH’s AutoHop feature infringed claim 12 of the ’799 Patent under the doctrine of equivalents. The district court granted judgment as a matter of law, and the panel affirmed. This petition seeks rehearing of the doctrine-of-equivalents holding on the ’799 Patent alone. The question is one of law: not whether the evidence was weighty, but which legal standard governed it.

The panel set aside a verdict that rested on testimony *the panel itself credited*. ClearPlay’s expert gave nonconclusory, limitation-specific testimony as to the shared filtering action and the shared configuration identifier. A verdict based on creditable (*i.e.*, nonconclusory) equivalency testimony is a posture this Court’s law on equivalence is meant to protect, and it is the posture absent from *NexStep, Inc. v. Comcast Cable Communications, LLC*, 119 F.4th 1355 (Fed. Cir. 2024), on which the panel relied. *NexStep* rejected an expert who supplied none of the requirement’s criteria; the panel here rejected an expert who supplied them. Thus a new thread exists in Federal Circuit doctrine of equivalence law that at least comes close to appellate fact finding, seeming to overlook the constitutional command in the Seventh Amendment not to reexamine facts found by juries.

The decision marks a new reach for the “particularized testimony and linking argument” requirement. The formalism has now been applied to displace a factor the Supreme Court itself enumerated (“known interchangeability”) that the jury was

instructed to weigh, which *NexStep*'s record never implicated, and which the panel decision never engages. Judge Newman warned of this drift in 1991; Judge Reyna warned of it again in 2024; the panel's decision confirms it. The petition presents two independent grounds, each of which requires rehearing: the panel overlooked the governing factor and misapprehended the credited testimony (Part I), and it morphed "particularized testimony and linking argument" into deeper conflict with *Graver Tank* and *Warner-Jenkinson* (Part II). The panel's alternative vitiating ground does not save the judgment (Part III).

BACKGROUND

The jury found infringement of claim 12 of the '799 Patent under the doctrine of equivalents and returned its verdict under Instruction No. 35, which set out two equivalence frameworks: function-way-result and insubstantial differences. Instruction No. 35 identified known interchangeability as an objective factor bearing on substantial sameness. Appx274–275. The district court granted judgment as a matter of law, and the panel affirmed in a nonprecedential opinion, resolving equivalence on function-way-result, *see Mylan Institutional LLC v. Aurobindo Pharma Ltd.*, 857 F.3d 858, 866 (Fed. Cir. 2017), and on categorical “in kind, not degree” vitiation, *see Freedman Seating Co. v. American Seating Co.*, 420 F.3d 1350, 1361 (Fed. Cir. 2005). The opinion cited *NexStep* but neither *Warner-Jenkinson* nor Instruction No. 35. The nonprecedential disposition attaches to this application; the requirement it applied is precedential and entrenched.

ARGUMENT

I. THE PANEL OVERLOOKED THE GOVERNING FACTOR AND MISAPPREHENDED THE CREDITED TESTIMONY.

A. The panel misapprehended testimony it credited.

The panel paraphrased the expert’s testimony as an efficiency rationale, namely that repeating the configuration identifier and filtering action for every navigation object “would be inefficient,” so the announcement file carries each only once. The panel rebutted it on the ground that “whether a particular method is wise

does not bear on” function, way, and result. That paraphrase compressed out the expert-delivered facts that gave the jury proper function/way/result mappings. The expert explained (quoted *infra*, section II.C) that the configuration identifier functions as an equality test, evaluated once against a single recipient set-top box, so that checking the shared value once and repeating it for every object produce the same operation given a single recipient. This was not a better design, it was the same one. He then tied the two limitations together expressly, resting his configuration-identifier opinion on “the same logic, same argument, that we used for the 0x08 announcement files.” (Tr. 663–64, Appx18568–69). That incorporation is the linking argument. The panel credited the testimony but paraphrased it in a way that misapprehended the evidence on which the verdict rested. Fed. R. App. P. 40.

On a motion for judgment as a matter of law the court must review all the evidence and draw all reasonable inferences for the verdict winner. *Reeves v. Sanderson Plumbing Products, Inc.*, 530 U.S. 133, 150 (2000); accord *Bay v. Anadarko E&P Onshore LLC*, 73 F.4th 1207, 1215 (10th Cir. 2023). The inference that the difference is one of degree, not kind, was owed to ClearPlay; the panel drew the opposite, and did so by misapprehending the testimony that compelled it.

B. The panel overlooked the factor the charge supplied.

Having found no claim-construction error, the panel announced it would “rely here on the jury instructions themselves” in considering whether judgment as a

matter of law was appropriate. It then engaged the '799 claim-term instructions but never Instruction No. 35, the only instruction stating the doctrine-of-equivalents standard on which the judgment turned, and the instruction that identified known interchangeability as a factor the jury could weigh. A verdict “must be tested by the charge actually given.” *Hewlett-Packard Co. v. Mustek Systems, Inc.*, 340 F.3d 1314, 1321 (Fed. Cir. 2003). Resolving equivalence on function-way-result alone, without reaching the known-interchangeability factor the charge supplied, overlooked the governing standard. The point of this section is not that the requirement of particularized testimony is illegitimate; it is that the requirement was satisfied and the factor ignored.

II. THE REQUIREMENT, SO APPLIED, CONFLICTS WITH *GRAVER TANK* AND *WARNER-JENKINSON* AND PRESENTS A QUESTION OF EXCEPTIONAL IMPORTANCE.

A. The governing standard is open and multi-factor.

Equivalence is a question of fact for the jury. *Graver Tank*, 339 U.S. at 609. It “is not the prisoner of a formula,” and proof “can be made in any form.” *Id.* The Supreme Court has identified several objective factors bearing on substantial sameness, known interchangeability among them, and has held that the particular framework employed “is less important than whether the test is probative of the essential inquiry.” *Warner-Jenkinson*, 520 U.S. at 36, 40. No single formulation is mandatory.

B. Treating the absence of an FWR-form linking argument as a legal-sufficiency defect displaces that standard.

By treating the absence of a function-way-result linking argument as a defect of legal sufficiency, enforced de novo through judgment as a matter of law, the decision converts the open, multi-factor, any-form factual showing the Supreme Court authorized into the formula *Graver Tank* forbade. The conflict is sharpest here because the formalism was applied not merely to supplant function-way-result, but to displace a factor (known interchangeability) that *Warner-Jenkinson* itself enumerates. A court-made rule of proof has thus been used to reexamine a factual finding of the jury reliant on equivalence showings the Supreme Court’s own criteria authorize.

C. The decision continues a pattern the Supreme Court has repeatedly corrected.

This is not the first time a flexible Supreme Court standard has been recast as a rigid formula. The Court has corrected the same move in obviousness, *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007); in exceptional-case fee awards, *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 572 U.S. 545 (2014); in enhanced damages, *Halo Electronics, Inc. v. Pulse Electronics, Inc.*, 579 U.S. 93 (2016); and in injunctive relief, *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006). The Court should align the rule for proving equivalence with *Graver Tank* in the same way, by examining *en banc* for the very first time if “particularized

testimony and linking argument” as applied by this Court conflicts with controlling precedent.

This Court birthed the “particularized testimony and linking argument” framework in a pair of cases in 1989 and 1991: *Lear Siegler v. Sealy Mattress*, 873 F.2d 1422, 1426 (Fed. Cir. 1989) and *Malta v. Schulmerich Carillons, Inc.*, 952 F.2d 1320 (Fed. Cir. 1991). Its use has drifted materially, from a requirement on how to organize evidence, to appellate court license to reweigh it. In *Lear Siegler*, the framework stood for the noncontroversial principle (derived directly from *Graver Tank*) that a patentee must provide evidence on all three prongs: function, way and result. 873 F.2d at 1426 (holding the case was “not so guided” for the express reason that the patentee “did not elicit testimony explicitly comparing the claimed and accused devices as to all three elements of equivalence”). *Malta* is where the phrase was used for the first time (over a dissent) to assess the legal sufficiency of fact-bound equivalency evidence. There, the panel found evidence wanting because, though a “function” was properly linked in the testimony, it was “conclusory.” *Malta*, 952 F.2d at 1327 (expert solely testifying the accused instrumentalities “function like buttons” without further detail, leaving the jury “little guidance” and leaving it “to its own imagination on the technical issue of equivalency”). As it happens, “function like buttons” is (without more) expert testimony that is facially conclusory, thus disregardable on substantial evidence review even *without* layering

atop a legal standard it supposedly fails. *Malta* had no need in the first place to reach for “particularized testimony and linking argument” as a formulation for reaching its result on its facts.

This jurisprudential drift continued in later years, with “particularized testimony and linking argument” doing real work, permitting appellate reweighing of jury verdict outcomes even when (unlike *Malta*) an expert has provided fulsome and robust analyses for a jury to digest, that cannot reasonably fit the descriptor of “conclusory.” By the time this Court decided *NexStep*, 119 F.4th at 1371-75, also like *Malta* over a dissent, the “particularized testimony and linking argument” framing became the open door for intense (and to parties and the patent system, unpredictable) scrutiny of an expert’s equivalency-verdict-supporting testimony. The drift described here operates as a one-way ratchet working only against patent holders, raising costs and uncertainties of litigation, and coming close to (or passing beyond) disfavored reexamination of facts found by a jury, in contravention of Seventh Amendment principles.

This case presents an excellent vehicle for three reasons: (1) the testimony is linked to the function/way/result elements (satisfying *Lear Siegler*), (2) the testimony was not conclusory (satisfying *Malta*), and (3) the testimony was credited by the panel (unlike *NexStep*). At trial, asked whether, “if the jury were to find” that the shared 0x08 arrangement “is substantially different from the navigation object

limitation of the ‘799 patent,” Feamster testified: “It’s not substantially different.” Tr. 649:4–13; Appx18554; accord Tr. 650:19–25; Appx18555. He explained (Tr. 651–52; Appx18556–18557):

So the question I think being asked is, well, it only shows up once. There’s only one -- you’ve said 0x08 is a filtering action, but it’s only there once, so how can we have a plurality of navigation objects? . . . And what I’m asserting is that you don’t need it there every single time. Like anyone who is basically writing code in the same way would recognize that to be an inefficient and pretty bad way of writing the code. So putting it there once basically is achieving the same function in the same way, to achieve the same result, as just repeating 0x08 for every single navigation object in the file.

He described the configuration identifier’s operation as an equality test (Tr. 663; Appx18568) (emphasis added):

It’s comparing the model targeting descriptor, in other words, those bits that we were just seeing to -- to the configuration identifier of the decoder. So it’s *basically just an equality test*. It’s like, “Okay, I know what my model number is.” I -- now I basically see that this configuration -- that this announcement file is targeting specific models. Am I one of those models? Like am I basically one of those models that this announcement file is saying, this is for me? If there’s a match -- well, yeah. If there’s a match, then we process the announcement file. And if there is no match, then we do not.

And asked whether, absent literal infringement, the shared configuration identifier was substantially different from the configuration-identifier limitation of the ‘799 Patent, he testified (Tr. 663–64; Appx18568–69) (emphasis added):

I do have an opinion. My opinion is that it’s *not substantially different*. And my opinion is based on the same – the same logic, same argument, that we used for the 0x08 announcement files. So remember in that case the question was, well, 0x08 only appears once and the file has this

plurality of navigation objects. Doesn't it have to appear for every pair of start and end offsets? And remember I talked us through why my opinion was that it didn't need to do that to achieve the same function in the same way, to achieve the same results, *which is doctrine of equivalents*. It's the same argument here, just like there's only one 0x08, but you could achieve the same thing with one versus one for each pair. There's only one configuration identifier in the announcement file. There's only one model targeting descriptor. But we know you're sending it to the – you're sending it to one set-top box. The set-top box that's received it, there's only one of them that's processing it at that time, it would be silly to check every pair of segment bookmarks to see, oh, does this one apply to me? Does this one apply to me? No, that would just be a ridiculous way to write your code. Like the better way to write it is to check it once, and then we know either all these apply or each and every one of them applies or none of them apply.

Because that opinion expressly carried the 0x08 filtering-action rationale across, it supplies both elements Instruction No. 35 identifies for known interchangeability: skilled-artisan recognition and substantial sameness in function, way, and result. The panel credited that testimony. At slip op. 8, the panel paraphrased Feamster: "Feamster further testified that it would be inefficient to write code that repeatedly defined the same filtering method and configuration identifier, and that to avoid that inefficiency, each segment bookmark pair relied on the same filtering action and configuration identifier, both of which were contained in the announcement file itself." And at slip op. 9, the panel stated it was "[c]rediting that testimony." The panel thus credited the substance, not rejecting it on credibility, yet answered in function-way-result terms, compressing out the "would recognize" framing, reweighing conclusions from the testimony reached by the jury, and citing

no authority on (nor acknowledging the presence of) known interchangeability.

D. The Seventh Amendment confirms the gravity of the conflict.

Because equivalence is a fact found by the jury, the “particularized testimony and linking argument” standard should be, at most, a requirement that gates legal sufficiency on the form in which proof is cast rather than on the substance of the evidence. Used more broadly (as it was here), this standard permits a found fact to be set aside not for want of evidence but for want of preferred vocabulary. That is in tension with the Seventh Amendment’s command that no fact tried by a jury be otherwise reexamined. Ordinary review of whether substantial evidence supports a verdict is constitutional, but conditioning legal sufficiency on the form in which credited evidence is cast is not.

E. This case presents the question free of the features that made *NexStep* deniable.

As mentioned, while the present panel decision is non-precedential, the legal standards in question are precedential. *NexStep* confirms this is so, albeit having supplied a far less suitable vehicle for this Court’s *en banc* engagement. In *NexStep*, the testimony was found conclusory and the patentee sought an exemption from the particularity and linkage requirement for “easily understandable” technologies. Neither feature is present here. ClearPlay’s expert gave limitation-specific testimony, credited by the panel, with express incorporation across limitations. This

is precisely what *Paice LLC v. Toyota Motor Corp.*, 504 F.3d 1293, 1305–06 (Fed. Cir. 2007), holds sufficient. Affirming on the ground that the record contained “no *other* particularized testimony and linking argument” (where the word “other” is verbatim within the panel decision) therefore raised the bar above the requirement’s own criteria. It also conflicted with the framework of substantial evidence review, where all evidence (and reasonable inferences therefrom) that the jury might credit must receive weight, and if such evidence is that which a reasonable mind might accept as adequate to support the conclusion, the verdict must stand.

F. The question recurs and is squarely presented.

The objection that the “particularized testimony and linking argument” requirement displaces the Supreme Court’s standard and the jury’s role has divided judges of this Court for more than three decades, from Judge Newman’s dissent in *Malta*, 952 F.2d 1320, 1331-46 (Fed. Cir. 1991), to Judge Reyna’s dissent in *NexStep*, 119 F.4th at 1381-86. The same question was presented to the Supreme Court in *NexStep*, No. 24-1137 (cert. denied June 16, 2025), and it persists, now in a posture where the linking argument was present and credited, and where the expert presented to the jury a factor never acknowledged by the panel (“known interchangeability”), but one the Supreme Court named as important.

III. THE ALTERNATIVE VITIATION GROUND DOES NOT SUSTAIN THE JUDGMENT.

The panel’s alternative holding that ClearPlay’s theory fails because the ’799

Patent treats the single-object and shared-element structures as differing “in kind, not degree” applied categorical vitiation as a threshold (albeit, without using the word “vitiating”). That is error. Vitiating “is not an exception or threshold determination,” but a legal conclusion of no equivalence based on the evidence and theory presented. *Bio-Rad Laboratories, Inc. v. 10X Genomics Inc.*, 967 F.3d 1353, 1367–68 (Fed. Cir. 2020). Specific exclusion exists only where the equivalent is “the opposite of, or inconsistent with, the recited limitation”; literal failure to meet a limitation does not establish it. *Augme Technologies, Inc. v. Yahoo! Inc.*, 755 F.3d 1326, 1335 (Fed. Cir. 2014). The credited expert testimony shows the shared and per-object structures operating the same way, and both experts treated them as design alternatives. This is nothing like the structural opposition that drove *Freedman Seating*, where the accused member was rotatably mounted and could not slide at all. This Court applied the specific-exclusion test to an analogous structural-counting allegation in *Lite-Netics, LLC v. Nu Tsai Capital LLC*, 60 F.4th 1335, 1347 (Fed. Cir. 2023), finding no specific exclusion absent specification language making the structure inconsistent with the claims. The ’799 specification contains no such language, and neither the order below nor the panel decision identifies any.

CONCLUSION

The Court should grant panel rehearing, vacate the doctrine-of-equivalents portion of the opinion, and remand for the panel to engage the known-

interchangeability factor and the credited testimony; or, in the alternative, grant rehearing en banc to realign application of the “particularized testimony and linking argument” standard with Supreme Court precedent and the Seventh Amendment Reexamination clause.

Dated: June 26, 2026

Respectfully Submitted,

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Addendum

NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

CLEARPLAY, INC.,
Plaintiff-Appellant

v.

**DISH NETWORK L.L.C., ECHOSTAR
TECHNOLOGIES LLC,**
Defendants-Appellees

2023-2134

Appeal from the United States District Court for the
District of Utah in No. 2:14-cv-00191-DN, Senior Judge Da-
vid Nuffer.

Decided: May 26, 2026

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Before LOURIE and PROST, *Circuit Judges*, and
BURROUGHS, *District Judge*.¹

BURROUGHS, *District Judge*.

After a jury found that DISH Network L.L.C. (“DISH”) and Echostar Technologies LLC infringed patents owned by ClearPlay, Inc. (“ClearPlay”), and awarded ClearPlay damages, the United States District Court for the District of Utah granted Defendants-Appellees’ motion for judgment as a matter of law (“JMOL”). ClearPlay appealed. For the following reasons, we *affirm*.

BACKGROUND

ClearPlay’s patents are directed to methods for filtering multimedia content. At issue are claims 28 and 33 of U.S. Patent No. 7,577,970 (“the ’970 Patent”) and claim 12 of U.S. Patent No. 6,898,799 (“the ’799 Patent”).

Claim 27 of the ’970 Patent describes dividing media into “navigation objects,” each of which defines “a start position,” “a stop position,” and “a specific filtering action to

¹ Honorable Allison D. Burroughs, District Judge, United States District Court for the District of Massachusetts, sitting by designation.

be performed.” J.A. 340, 23:37–40. The method then filters the media by “disabling . . . one or more of the navigation objects such that the specific filtering action specified by the disabled navigation object is ignored” during playback. J.A. 340, 23:41–43. Claim 28, which depends from claim 27, provides that the “filtering action is skipping the portion of multimedia content,” J.A. 340, 23:59–61, and claim 33, which depends from claim 28, further specifies that “skipping” comprises “terminating the decoding of the multimedia content at the start position of the particular navigation object; advancing to the stop position of the particular navigation object; and resuming the decoding of the multimedia content.” J.A. 340, 24:10–16. In sum, the method described by the claims involves dividing a program into individual chunks called navigation objects, assigning a filtering action to each navigation object, and then playing the media, with navigation objects playing only if their filtering actions have been disabled.

Claim 12 of the ’799 Patent relies on a similar method, but provides further that the media content is “transferr[ed] . . . to an output device . . . excluding each [filtered] portion,” J.A. 372, 22:13–17, using an “object store [that] can be loaded into a memory of [a] consumer computer system.” J.A. 372, 21:58–59. The object store must include “a plurality of navigation objects,” and each navigation object must have a “configuration identifier” that indicates whether that “particular navigation object applies to the decoder.” J.A. 372, 21:60, 22:18, 22:20–21.

In March 2014, ClearPlay filed a complaint accusing DISH’s AutoHop feature of infringing the ’970 and ’799 Patents, as well as asserting other claims that were resolved prior to trial. The district court issued a claim-construction order in August 2019, and thereafter the case proceeded to trial.

At trial, expert testimony presented by the parties established the following. AutoHop’s commercial filtering

begins with DISH employees manually noting when a recorded television show goes to commercial and when it returns. Those points in time, called “segment bookmarks,” identify exactly when the program stops and when it resumes. Then, for each recorded episode, DISH transmits the segment bookmarks in an “announcement file” over satellite broadcast. When a viewer watches the recorded program with AutoHop enabled and the media reaches the “stop” position of one segment, the playback automatically skips ahead to the “start” position of the next segment, thereby bypassing commercials. If, on the other hand, AutoHop is not enabled, the program plays back normally, showing all commercials, and even with AutoHop enabled, a user can manually rewind or fast-forward into a commercial and the commercial will not be skipped.

During trial, Defendants-Appellees moved for JMOL of noninfringement. In March 2023, a jury found infringement of both patents and awarded damages to ClearPlay. Following the jury verdict, the district court granted Defendants-Appellees’ JMOL motion.

ClearPlay appealed. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

DISCUSSION

ClearPlay argues that in granting JMOL, the district court (1) applied claim constructions not given to the jury and (2) applied the wrong standard to its review of the trial evidence.

A. Claim Construction

A jury verdict “must be tested by the charge actually given and by giving the ordinary meaning of the language of the jury instruction.” *Hewlett-Packard Co. v. Mustek Sys., Inc.*, 340 F.3d 1314, 1321 (Fed. Cir. 2003). That said, a district court, in deciding a JMOL motion, does not commit error if it “clarifie[s] [a] previous construction that was already present in the jury instructions.” *Mformation*

Techs., Inc. v. Rsch. in Motion Ltd., 764 F.3d 1392, 1398 (Fed. Cir. 2014); *accord Cordis Corp. v. Bos. Sci. Corp.*, 658 F.3d 1347, 1357 (Fed. Cir. 2011).

i. '970 Patent

ClearPlay argues that the JMOL order used a different construction of the “disabling” limitation of the '970 Patent from the one used in the jury instructions. We disagree. The jury was instructed that the '970 Patent required “directly disabl[ing] a navigation object so that its filtering action is ignored, as opposed to disabling something other than the navigation object that results in the navigation object’s filtering action being ignored.” J.A. 267. In the JMOL order, the court pointed out that the limitation did not include “acting on or disabling something else that indirectly affects the segment bookmark or simply results in the segment bookmarks being ignored.” J.A. 64. That further explanation did not change the claim construction being applied. It simply restated, with slightly different phrasing, the same distinction between acting on an object itself and acting on something upstream of the object.

ii. '799 Patent

ClearPlay also argues that the JMOL order deviated from the jury instructions in its construction of the “object store” limitation of the '799 Patent. Again, we find that argument unpersuasive. The jury was instructed that a “navigation object” within the meaning of that patent required “the start, stop, and filter elements that comprise the navigation object [to] be contained within the same object, file, or data structure,” J.A. 266–67, and that a “configuration identifier” within the meaning of that patent needed “to be contained within the navigation object,” J.A. 267. The JMOL order required “each particular navigation object [to] define its own start position, stop position, and filtering action, and contain its own configuration identifier,” J.A. 74, and referred to this construction as a “single-object approach,” J.A. 73. Neither the addition of “its own”

nor the reference to a “single-object approach” changed the operative claim construction. These were superficial differences in word choice that did not alter the underlying meaning of the claim constructions—that every navigation object needed to contain a start position, a stop position, a filtering action, and a configuration identifier within itself, as opposed to those elements being defined outside of the navigation object.

B. Judgment as a Matter of Law

There was no error in the claim constructions employed by the district court in granting JMOL. Nonetheless, for the avoidance of doubt, we rely here on the jury instructions themselves in considering whether the trial record entitled Defendants-Appellees to JMOL.

“We review a district court’s grant of JMOL de novo, applying the law from the regional circuit.” *Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1356 (Fed. Cir. 2012) (citing *Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241, 1248 (Fed. Cir. 2005)). In the Tenth Circuit, JMOL “is appropriate only if the evidence points but one way and is susceptible to no reasonable inferences which may support the nonmoving party’s position.” *Bay v. Anadarko E&P Onshore LLC*, 73 F.4th 1207, 1215 (10th Cir. 2023) (quoting *Escue v. N. Okla. Coll.*, 450 F.3d 1146, 1156 (10th Cir. 2006)). Accordingly, we “draw all inferences from the evidence in favor of the nonmoving party, [without] . . . weigh[ing] the evidence or judg[ing] witness credibility.” *Id.* (quoting *Henry v. Storey*, 658 F.3d 1235, 1238 (10th Cir. 2011)).

i. ’970 Patent

ClearPlay argues that there was adequate evidence at trial to support the jury verdict regarding the infringement of the ’970 Patent. We disagree.

To show infringement of the ’970 Patent, ClearPlay needed to prove that AutoHop caused a navigation object

to be “*directly* disable[d]” (emphasis added), as opposed to “something other than the navigation object” being disabled with the result that “the navigation object’s filtering action [is] ignored.” ClearPlay argues that AutoHop infringes the ’970 Patent’s disabling-navigation-objects limitation because AutoHop’s commercial skipping can be negated, either by not enabling it in the first place, resulting in all commercials playing, or by fast-forwarding or rewinding into a commercial, thus allowing that particular commercial to play.

The trial evidence established that the AutoHop code runs in the background even when a viewer has not enabled the AutoHop feature, but that AutoHop only skips commercials if (1) a user has enabled it prior to starting an episode and (2) the episode is playing, not in fast-forward or rewind. These two conditions (AutoHop on and episode playing) are encoded in separate variables within the AutoHop source code. When AutoHop encounters a segment bookmark, it checks whether both conditions are satisfied. If the user has enabled commercial skipping *and* the device is not in rewind or fast-forward, AutoHop skips the commercial; otherwise, it lets the commercial play.

That evidence permitted only one conclusion: AutoHop did not provide for the direct disablement of navigation objects. The conditions discussed above render AutoHop active or inactive on a categorical basis. At the end of a given segment, AutoHop does not check whether the *next commercial* has been enabled or disabled, it checks whether commercial skipping is enabled writ large and if the device is in play mode. Those background conditions, rather than the direct disablement of particular segments, determine AutoHop’s behavior, and for that reason, AutoHop does not directly disable navigation objects.

ii. '799 Patent

ClearPlay also argues that there was adequate evidence at trial to support the jury verdict as to infringement of the '799 Patent. Again, we disagree.

To show infringement of the '799 Patent, ClearPlay needed to prove that AutoHop makes use of an “object store” containing a “collection . . . [of] navigation objects,” J.A. 268, that “the start, stop, and filter elements that comprise the navigation object . . . be contained within the same object, file, or data structure,” J.A. 266–67, and that a “configuration identifier . . . be contained within the navigation object,” J.A. 267. ClearPlay argues that AutoHop infringed the '799 Patent’s method of transmitting navigation objects in an “object store” structure, because the AutoHop announcement files contain all of the elements of an object store.

The evidence at trial established that the segment bookmark pairs identified points with the first being when AutoHop would skip ahead (at the “end” marker of one segment) and the second being when it would resume (at the “start” marker of the next segment). No evidence was introduced in support of the conclusion that each segment bookmark pair was actually accompanied by an individual configuration identifier and filtering action. Rather, ClearPlay’s expert witness, Nicholas Feamster, noted that each announcement file contained a single configuration identifier that matched that announcement file to the particular set-top box, and that the code did not check this pairing again each time a new segment bookmark was encountered. Feamster further testified that it would be inefficient to write code that repeatedly defined the same filtering method and configuration identifier, and that to avoid that inefficiency, each segment bookmark pair relied on the same filtering action and configuration identifier, both of which were contained in the announcement file itself. Crediting that testimony, it is still not possible to

conclude that AutoHop infringed the '799 Patent, because the operative claim construction required that each navigation object “contain” a filtering action and configuration identifier. If those objects are simply inherited or implied from another part of the code, they do not fit that limitation.

Nor is it possible to set aside that distinction under the doctrine of equivalents, as ClearPlay argues in the alternative. Though Feamster testified that assigning each segment bookmark pair its own configuration identifier and filtering action would be “ridiculous,” whether a particular method is wise does not bear on whether that method “performs ‘substantially the same function in substantially the same way to obtain the same result’” as the other. *Mylan Institutional LLC v. Aurobindo Pharma Ltd.*, 857 F.3d 858, 866 (Fed Cir. 2017) (quoting *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608 (1950)). Here, the trial record does not contain any other “particularized testimony and linking argument as to the insubstantiality of the differences between” AutoHop’s announcement files and the structure described by the '799 Patent. *NexStep, Inc. v. Comcast Cable Commc’ns, LLC*, 119 F.4th 1355, 1371 (Fed Cir. 2024) (quoting *VLSI Tech. LLC v. Intel Corp.*, 87 F.4th 1332, 1343 (Fed Cir. 2023)). Moreover, ClearPlay’s theory would erase the claims’ meaningful structural and functional distinction between a “single-object” approach and one that shares elements across multiple objects, even though the '799 Patent treats that distinction as one “in kind,” not degree. *Freedman Seating v. Am. Seating*, 420 F.3d 1350, 1361 (Fed. Cir. 2005) (citation omitted). We thus reject ClearPlay’s alternative argument.

CONCLUSION

We have considered ClearPlay’s remaining arguments and find them unpersuasive. For the foregoing reasons, we *affirm* the district court’s decision granting JMOL of

noninfringement of claims 28 and 33 of the '970 Patent and claim 12 of the '799 Patent.

AFFIRMED

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