Anticipation—Prior Art—Inventor’s Own Work. In *Lacks Indus. v. McKechnie Vehicle Components USA, Inc.* (Fed. Cir.), the patentees had disclosed certain subject matter in a corporate annual report and later claimed that subject matter in the patent at issue. The IPR challenger argued that the patented invention was anticipated by a third party’s earlier-filed, later-issued patent, which disclosed a summary of the patentee’s disclosure in the annual report. However, because the earlier-filed patent’s summary was the only portion of that patent’s disclosure that was pertinent to the anticipation challenge, the disclosure was not “by another” and, thus, not relevant to the question of anticipation. For a discussion of the exclusion of an inventor’s own work from anticipation challenges, see § 2A.3[1].

Written description—Negative Limitations. In *Novartis Pharm. Corp. v. Accord Healthcare, Inc.* (Fed. Cir.), the court, granting a petition for rehearing and vacating its original decision, concluded that the lower court had clearly erred in holding that the negative limitation at issue was supported by the patent’s specification, which was silent about the limitation. The court was clear that a specification silent about a negative limitation could nonetheless satisfy the written description requirement if one skilled in the art would understand from the specification that the limitation was necessarily excluded from the claimed invention, but concluded that such was not the case for the limitation at issue. For a discussion of the written description requirement for negative limitations, see § 2D.4[3][c1].
**Defenses—Invalidity—Assignor Estoppel.** *Hologic, Inc. v. Minerva Surgical, Inc.* (Fed. Cir.) addresses assignor estoppel in the context of a later-patented claim that the assignor had elected not to pursue in response to a restriction requirement. The court concluded that assignor estoppel applied to the assignor’s validity challenge because, in the circumstances, the non-elected claim, which remained viable notwithstanding the assignor’s election not to pursue it, was assigned with the application and because the assignor had represented that he was unaware of any reason why the assigned matter would be deemed invalid or unenforceable. For a discussion of assignor estoppel, see § 4.2[5][a].

**Reissue—Recapture Rule—Ineligibility Rejections.** *In re McDonald* (Fed. Cir.) considered a reissue application rejected on the ground that the applicant sought to recapture subject matter that he had surrendered in order to overcome a section 101 ineligibility rejection. The applicant argued that the rule was limited to subject matter surrendered to overcome prior art rejections, but the court, although acknowledging that its previous decisions had addressed only rejections in view of the prior art, held that given the public’s interest in being able to rely on a patent’s public record, the recapture rule also applied where subject matter was surrendered in order to overcome an ineligibility rejection. For a discussion of the recapture rule, see § 10.2[4].
Licensing—Assigning an Agreement. In *Drut Techs., Inc. v. Microsoft Corp.* (W.D. Wash), the court concluded that the “irrevocable” license granted to defendant remained in force notwithstanding defendant’s failure to make certain payments due under its license agreement because the agreement did not provide that the payments were a condition precedent to the irrevocability of the license. In support of that conclusion, the court observed that its construction of the license agreement was consistent with the nature of technology licensing inasmuch as a licensee will seek an irrevocable license to avoid losing the right to use a technology on which it may become reliant. For a discussion of irrevocable licenses, see § 12.

Licensing—Assigning an Agreement. In *Whitaker v. On the Right Track Sys.* (S.D.N.Y. Mar. 14, 2022), plaintiff inventor formed a corporation and assigned her patent to it in order for the corporation to enter into a license agreement with defendant, which, after plaintiff voluntarily dissolved the corporation, stopped paying royalties. Plaintiff sued for breach of the agreement arguing, among other things, that she was the assignee of the license agreement, but because the agreement unambiguously provided that it could only be assigned with the consent of the other party or to a successor in interest and plaintiff had not alleged either, the court rejected her argument. For a discussion of provisions restricting assignment of a license agreement, see § 12.5[5].
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