
Federal Circuit Patent Watch: Prosecuting Attorney's Knowledge of Abandonment Does Not Mean Patentee's Abandonment is Intentional

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Precedential and Key Federal Circuit Opinions

1. [FRESHUB, INC. v. AMAZON.COM, INC. \[OPINION\]](#) (2022-1391, 2/26/2024) (Reyna, Taranto, and Chen)

Taranto, J. The Court affirmed the District Court's decision 1) denying Freshub's post-trial motions challenging the jury verdict, and 2) finding that Amazon failed to prove inequitable conduct by clear and convincing evidence. Freshub appealed the post-trial ruling, arguing that it sought a new trial overall because of assertedly prejudicial statements by Amazon at trial. Amazon cross-appealed seeking reversal of the District Court's finding that it failed to prove inequitable conduct, alleging the original assignee of the '153 patent made a false representation to the USPTO that the patent application was not intentionally abandoned.

First, the Court considered Freshub's new trial motion. Freshub primarily argued that the District Court should have granted a new trial because Amazon invoked the filing dates of the asserted patents in a prejudicial manner. Freshub had argued in a motion *in limine* that Amazon would, at trial, use the dates to suggest that Freshub had filed the applications for the asserted patents specifically to target Alexa unfairly. The District Court denied the motion. On appeal, Freshub now argues that Amazon did just that at trial, and that the District Court therefore abused its discretion in denying the motion *in limine* and in denying a new trial. The Court, however, explained that Freshub failed to show an abuse of discretion in denying a new trial because it failed to object properly to the mention of the filing dates, as required in this context by Fifth Circuit law.

Second, the Court considered Amazon's cross appeal, which sought reversal of the District Court's rejection of its inequitable-conduct defense. During prosecution the prosecuting counsel for Ikan, Freshub's parent company, made statements to the USPTO that "the abandonment [of a patent application] was not intentional on Ikan's part." Amazon alleged that this statement constituted inequitable conduct because the prosecuting counsel, prior to the statements at issue, was aware of USPTO notices sent, including a Notice of Abandonment, and their typical practice was to

communicate such developments to clients such as Ikan. However, the District Court found that Amazon did not clearly and convincingly prove Ikan's intentional abandonment because Ikan's prosecuting counsel testified that the intent behind the abandonment was not deceptive. On appeal, the Court explained that nothing established Ikan knew its prosecuting attorney received communications and intended to abandon the patent application. Thus, based on the facts, the District Court's finding was not clearly erroneous and the District Court could therefore reasonably hold deceptive intent not proven under the governing legal standard.

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