

EXHIBIT A



Neutral

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[Niazi Licensing Corp. v. St. Jude Med. S.C., Inc.](#)

United States Court of Appeals for the Federal Circuit

April 11, 2022, Decided

2021-1864

Reporter

30 F.4th 1339 *, 2022 U.S. App. LEXIS 9597 **

NIAZI LICENSING CORPORATION, Plaintiff-Appellant
v. ST. JUDE MEDICAL S.C., INC., Defendant-Appellee**Prior History:** **[**1]** Appeal from the United States District Court for the District of Minnesota in No. 0:17-cv-05096-WMW-BRT, Judge Wilhelmina M. Wright.

[Niazi Licensing Corp. v. St. Jude Med. S.C., Inc., 2021 U.S. Dist. LEXIS 54618, 2021 WL 1111074 \(D. Minn., Mar. 23, 2021\)](#)

[Niazi Licensing Corp. v. St. Jude Med. S.C., 2020 U.S. Dist. LEXIS 167562 \(D. Minn., Sept. 14, 2020\)](#)

[Niazi Licensing Corp. v. St. Jude Med. S.C., Inc., 2020 U.S. Dist. LEXIS 117914, 2020 WL 3638771 \(D. Minn., July 6, 2020\)](#)

[Niazi Licensing Corp. v. St. Jude Med. S.C., Inc., 2020 U.S. Dist. LEXIS 58153, 2020 WL 1617879 \(D. Minn., Apr. 2, 2020\)](#)

Disposition: AFFIRMED-IN-PART, REVERSED-IN-PART, AND REMANDED.

Core Terms

catheter, infringement, inner, outer, district court, vein, induced, steps, indefinite, inserting, summary judgment, resilient, pliable, damages, written description, terms, sanctions, coronary, skilled, recite, sinus, discovery, invalid, royalty, wire, exclusion order, patent, monetary sanctions, reasonable certainty, magistrate judge

Case Summary

Overview

HOLDINGS: [1]-The record provided objective boundaries by which a skilled artisan could determine

and "pliable" were not purely subjective terms; the terms "resilient" and "pliable" would have had broad but understood meanings to a skilled artisan; [2]-The trial court properly excluded expert testimony because the witness did not even attempt to explain why a royalty based on use of the method would be impractical, he did not attempt to value any patient health advantages, nor did he identify evidence relating to the value of the claimed method relative to other methods or explain why such a valuation would not be possible.

Outcome

The judgment was affirmed in part, reversed in part, and remanded.

LexisNexis® Headnotes

Patent Law > Jurisdiction & Review > Standards of Review > De Novo Review

Patent Law > ... > Specifications > Definiteness > Fact & Law Issues

Patent Law > ... > Specifications > Enablement Requirement > Standards & Tests

Patent Law > Infringement Actions > Prosecution History Estoppel > Prosecution Related Arguments & Remarks

Patent Law > ... > Defenses > Patent Invalidation > Grounds

[HNT](#) [Standards of Review, De Novo Review](#)

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Definiteness is a statutory requirement for patentability. Under [35 U.S.C.S. § 112](#), a patent's specification must conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. A claim is indefinite only if, when read in light of the specification and prosecution history, it fails to inform, with reasonable certainty, those skilled in the art about the scope of the invention. Definiteness is a question of law that an appellate court reviews de novo. The reasonable certainty standard strikes a balance, affording clear notice of what is claimed while recognizing inherent limitations. Otherwise there would be a zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims. While the legal test for definiteness does not require that a potential infringer be able to determine ex ante if a particular act infringes the claims, the public notice function underlying this patentability requirement demands that a patentee apprise the public of what is still open to them. This serves an important policy goal—providing clarity such that a person of ordinary skill in the art could determine whether or not an accused product or method infringes the claim. The definiteness requirement thus mandates clarity, while recognizing that absolute precision is unattainable.

Patent

Law > ... > Specifications > Definiteness > Precision Standards

[HN2](#) **Definiteness, Precision Standards**

While there must be objective boundaries, a patentee need not define his invention with mathematical precision in order to comply with the definiteness requirement. Indeed, patentees often use descriptive words to avoid a strict numerical boundary to the specified parameter. And courts have recognized that claim language employing terms of degree has long been found definite where it provided enough certainty to one of skill in the art when read in the context of the invention. True, descriptive words (or terms of degree) in a claim may inherently result in broader claim scope than a claim defined with mathematical precision. But a claim is not indefinite just because it is broad. For purposes of the definiteness inquiry, the problem patentees face by using descriptive words in their claims is not the potential breadth of those claims. It is whether the use of descriptive phrasing in the claim results in a claim that fails to inform, with reasonable certainty,

those skilled in the art about the scope of the invention.

Patent Law > Infringement Actions > Claim Interpretation > Aids & Extrinsic Evidence

[HN3](#) **Claim Interpretation, Aids & Extrinsic Evidence**

Terms of degree render a patent claim indefinite where the intrinsic evidence (or extrinsic evidence, where relevant and available) provides insufficient guidance as to any objective boundaries for the claims—including where the claims are purely subjective such that their scope cannot be determined with reasonable certainty.

Patent Law > Infringement Actions > Claim Interpretation > Aids & Extrinsic Evidence

Patent Law > Infringement Actions > Claim Interpretation > Scope of Claim

Patent Law > Infringement Actions > Prosecution History Estoppel > Prosecution Related Arguments & Remarks

Patent Law > Infringement Actions > Claim Interpretation > Construction Preferences

[HN4](#) **Claim Interpretation, Aids & Extrinsic Evidence**

Ultimately, patent claims with descriptive words or terms of degree must provide objective boundaries for those of skill in the art in the context of the invention to be definite. As with any question of claim construction, the intrinsic record—the patent's claims, written description, and prosecution history—along with any relevant extrinsic evidence can provide or help identify the necessary objective boundaries for claim scope.

Civil Procedure > ... > Summary Judgment > Entitlement as Matter of Law > Appropriateness

Patent Law > Infringement Actions > Summary Judgment > Appeals

Civil Procedure > Judgments > Summary Judgment > Entitlement as Matter of Law

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Civil Procedure > ... > Summary
 Judgment > Summary Judgment
 Review > Standards of Review

Civil Procedure > ... > Summary
 Judgment > Entitlement as Matter of Law > Genuine
 Disputes

[HN5](#) Entitlement as Matter of Law, Appropriateness

An appellate court reviews the district court's summary judgment under the law of the regional circuit. The Eighth Circuit reviews a grant of summary judgment de novo. Summary judgment is appropriate if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law. [Fed. R. Civ. P. 56\(a\)](#).

Patent Law > Infringement Actions > Summary
 Judgment > Claim Evaluation

Patent Law > Infringement Actions > Claim
 Interpretation > Fact & Law Issues

Patent Law > Jurisdiction & Review > Standards of
 Review > De Novo Review

Patent Law > ... > Defenses > Inequitable
 Conduct > Fact & Law Issues

Patent Law > Infringement Actions > Infringing
 Acts > Intent & Knowledge

[HN6](#) Summary Judgment, Claim Evaluation

A determination of patent infringement generally requires a two-step analysis—the court first determines the scope and meaning of the claims asserted, and then the properly construed claims are compared to the allegedly infringing device (for an apparatus claim) or allegedly infringing act (for a method claim). For induced infringement under [35 U.S.C.S. § 271\(b\)](#), the two steps become three. In addition to showing direct infringement by some party (e.g., a comparison of the properly construed claims to the allegedly infringing act), the patentee must also show that the alleged infringer knowingly induced infringement and possessed specific intent to encourage another's infringement. The first step—claim construction—is a question of law an appellate court reviews de novo to the extent it is

allegedly infringing act includes all the steps of the properly construed claim is a question of fact. Likewise, whether an alleged infringer knowingly induced and possessed specific intent to encourage that direct infringement is a question of fact. Summary judgment of noninfringement is appropriate when no reasonable juror could find that every step of a properly construed method claim was performed by the accused direct infringer.

Civil Procedure > Appeals > Standards of
 Review > Abuse of Discretion

[HN7](#) Standards of Review, Abuse of Discretion

An appellate court reviews a district court's decision to sanction a litigant under [Fed. R. Civ. P. 37](#) under the law of the regional circuit. The Eighth Circuit reviews a district court's entry of sanctions under [Rule 37](#) for an abuse of discretion.

Civil Procedure > Discovery &
 Disclosure > Disclosure > Mandatory Disclosures

[HN8](#) Disclosure, Mandatory Disclosures

[Fed. R. Civ. P. 37\(c\)\(1\)\(A\)](#) allows courts to impose reasonable expenses, including attorney fees for failure to provide information or identify a witness as required by [Rule 26\(a\)](#) or [\(e\)](#), specifying that the party is not allowed to use that information or witness to supply evidence on a motion, at a hearing, or at a trial unless the failure was substantially justified or is harmless.

Civil Procedure > Discovery &
 Disclosure > Disclosure > Mandatory Disclosures

Civil Procedure > Discovery &
 Disclosure > Discovery > Misconduct During
 Discovery

[HN9](#) Disclosure, Mandatory Disclosures

Even absent a court order excluding the nondisclosed information, where a party has failed to provide information or identify a witness as required by [Fed. R. Civ. P. 26\(a\)](#) or [\(e\)](#), [Fed. R. Civ. P. 37\(c\)\(1\)\(A\)](#) permits a court to impose monetary sanctions caused by the

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Civil Procedure > Appeals > Standards of Review > Abuse of Discretion

Evidence > Admissibility > Procedural Matters > Rulings on Evidence

[HN10](#) Standards of Review, Abuse of Discretion

An appellate court reviews a district court's decision to exclude expert testimony for an abuse of discretion.

Patent Law > Remedies > Damages > Infringer's Profits

[HN11](#) Damages, Infringer's Profits

Damages should be apportioned to separate out non-infringing uses, and patentees cannot recover damages based on sales of products with the mere capability to practice the claimed method. Rather, where the only asserted claim is a method claim, the damages base should be limited to products that were actually used to perform the claimed method.

Counsel: MICHAEL T. GRIGGS, Boyle Fredrickson, S.C., Milwaukee, WI, argued for plaintiff-appellant. Also represented by ADAM BROOKMAN, MARRIAM LIN, TIMOTHY NEWHOLM.

KALPESH SHAH, Benesch Friedlander Coplan & Aronoff, Chicago, IL, argued for defendant-appellee. Also represented by SAMUEL RUGGIO.

Judges: Before TARANTO, BRYSON, and STOLL, Circuit Judges.

Opinion by: STOLL

Opinion

[*1342] STOLL, CIRCUIT JUDGE.

This appeal asks us to resolve numerous issues: validity and infringement of various claims of U.S. Patent No. 6,638,268; several evidentiary rulings; and the appropriateness of the U.S. District Court for the District of Minnesota's entry of sanctions against Appellant Niazi Licensing Corporation. First, Niazi appeals the district court's determination that all but one of the asserted

claims of the '268 patent are invalid as indefinite. We conclude that, when read in light of the intrinsic evidence, a person of ordinary skill in the art would understand the scope of the claims with reasonable certainty. Accordingly, we reverse that determination and remand for the district court to resolve **[**2]** whether Appellee St. Jude Medical S.C., Inc. (St. Jude) has infringed those claims and whether its remaining invalidity defenses are applicable. Second, Niazi appeals the district court's summary judgment of no induced infringement of the only asserted claim it did not hold indefinite. We agree with the district court that Niazi failed to prove direct infringement—a necessary element of Niazi's inducement claim—and therefore affirm that judgment. Third, Niazi appeals the district court's sanction excluding portions of Niazi's technical expert **[*1343]** and damages expert reports because Niazi failed to disclose the predicate facts during fact discovery and granting monetary sanctions. Because Niazi points to no abuse of discretion, we affirm the district court's entry of sanctions. Finally, Niazi appeals the district court's exclusion of portions of its damages expert report as unreliable. Because we agree that the damages opinion was conclusory and legally insufficient, we affirm that exclusion as well.

BACKGROUND

Congestive heart failure is a common medical condition leading to hospital admission in the United States. Heart failure is frequently a result of the left and right sides of the heart **[**3]** contracting out of sync. There are different methods available for treating heart failure, such as medication or a heart transplant. Another method is resynchronization therapy, which uses electrical leads (called pacing leads) to help keep the two sides of the heart contracting with regularity and in sync.

According to the '268 patent, at the time of the invention, physicians accomplished resynchronization therapy by inserting a catheter into the coronary sinus¹ and its branch veins (i.e., cannulating) to place pacing leads on the hearts of patients with heart failure. '268 patent col. 1 ll. 29-35. Because the target coronary branch veins arise at acute angles to the coronary sinus and because heart failure can cause changes in the heart's anatomy

¹The coronary sinus is a major vein that "forms a part of the

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