

# Preserving issues for appeal: how a prison litigation case may affect patent law

By Deirdre M. Wells, Esq., William H. Milliken, Esq., and Kristina Caggiano Kelly, Esq., Sterne, Kessler, Goldstein & Fox PLLC

MAY 4, 2023

On Monday, April 24, 2023, the U.S. Supreme Court heard argument in *Dupree v. Younger*. *Dupree* is a prisoner civil-rights suit that presents a seemingly dry question of civil procedure more apt to induce drowsiness than interest in your average court-watcher: “Whether to preserve the issue for appellate review a party must reassert in a post-trial motion a purely legal issue rejected at summary judgment.” But, in this case, appearances are deceiving. The Court’s ultimate resolution of the question presented in *Dupree* may prove enormously consequential for litigators — patent litigators in particular.

To understand what’s at stake, a brief review of the facts of *Dupree* itself is helpful. *Dupree* arose when Younger, a Maryland prisoner, accused Dupree, a prison official, of using unconstitutionally excessive force against him. Dupree raised at summary judgment an exhaustion defense: He argued that Younger could not maintain his civil suit because he had not pursued internal grievance remedies at the prison, as he was required to do under the Prison Litigation Reform Act of 1995 (PLRA).

The district court denied Dupree’s motion for summary judgment. The court held that, because there was undisputedly an ongoing internal investigation into the assault that had been initiated by the prison, it was unnecessary for Younger to have pursued any additional internal grievance procedures before filing suit. The case proceeded to trial, where the jury returned a verdict in favor of Younger.

Dupree appealed, again raising the PLRA exhaustion defense. The 4th U.S. Circuit Court of Appeals held that Dupree had forfeited that challenge by failing to re-raise it in a post-trial motion for judgment as a matter of law. In so doing, the 4th Circuit contributed to an entrenched circuit split regarding whether a litigant can preserve a legal issue merely by moving for summary judgment on it, or whether the litigant must instead raise the issue again post-trial.

Based on the *Dupree* oral argument, most of the Justices appear inclined to hold that “purely legal” issues decided against a party at summary judgment need not be re-raised post-trial in order to preserve them for appeal. The majority of the Court seems to view a requirement that such issues be renewed as a meaningless formality at best and an appellate-preservation trap for the unwary at worst.

But, as is often the case with these sorts of things, the devil is in the details — and, specifically here, the details about what counts as a “purely legal” issue. Dupree argues that his exhaustion defense was “purely legal” because it was “resolved with reference only to the undisputed facts.” Younger, however, takes the position that the exhaustion defense was not “purely legal” because it depended on underlying facts, such as the details of the internal investigation initiated by the prison.

---

*The Court’s ultimate resolution of the question presented in Dupree may prove enormously consequential for litigators — patent litigators in particular.*

---

There is an enormous difference between those two positions. Dupree’s definition would encompass many — possibly even most — issues raised at summary judgment (after all, parties typically move for summary judgment when they believe they have an issue that they can win based on the undisputed facts). Younger’s definition, in contrast, is quite narrow; there are very few issues that are “purely legal” in the sense that they do not depend on the underlying facts of the case at all.

So why is this important for patent litigators? The answer is that many of the most important issues in patent cases are legal issues but may or may not be “purely legal” depending on the way that phrase is defined. Accordingly, the ultimate outcome in *Younger* — and, in particular, any guidance from the Court concerning what constitutes a “purely legal” issue — could have an enormous impact on the way patent cases are litigated.

To illustrate, consider the following hypothetical.

Patentee Patty sues Infringer Ingrid for infringement of the ‘000 patent. Ingrid contests infringement and also argues that Patty’s patents are invalid. Ingrid raises defenses under § 101 (eligibility), § 102 (anticipation), and § 112 (written description and enablement). Prior to trial, Patty and Ingrid file the following motions for summary judgment, which are all denied.

- (1) Patty argues that the ‘000 patent claims are not directed to a patent-ineligible concept — meaning the claims are eligible for

patenting as a matter of law under Step One of the Supreme Court's *Alice* test for patent eligibility — and therefore that Patty is entitled to summary judgment of no invalidity under § 101.

The district court denies this motion because it holds, contrary to Patty's argument, that the '000 is directed to a patent-ineligible concept.

(2) Patty argues that Ingrid's allegedly anticipating reference is not prior art because the undisputed facts — admitted by Ingrid's expert at deposition — establish that the reference was not publicly available before the critical date, and therefore that Patty is entitled to summary judgment of no invalidity under § 102.

The district court denies this motion because it disagrees with Patty's interpretation of the law on public availability and concludes that the "undisputed facts" pointed to by Patty do not in fact establish that the reference was not publicly available.

(3) Ingrid argues that the '000 patent's claims, as construed by the district court, cover an unbounded range. Ingrid further argues that the undisputed facts — admitted by Patty's expert at deposition — establish that the specification does not enable a skilled artisan to practice the full scope of the unbounded range, and therefore that Ingrid is entitled to summary judgment of invalidity under § 112.

The district court does not address the merits of this motion but instead denies it because Ingrid's motion did not comply with the court's page limit for summary-judgment motions.

Which issues do Patty and Ingrid need to litigate at trial and then re-assert post-trial in order to preserve the corresponding issues for appeal?

If the Supreme Court answers the question presented in the affirmative — i.e., holds that even purely legal issues decided at summary judgment must be re-raised post-trial to preserve them for appeal — then the answer is all of them.

If the Supreme Court answers the question presented in the negative and adopts Younger's definition of a purely legal issue (an issue that does not depend on the underlying facts of the case), then motions (2) and (3) will need to be re-asserted at trial. The argument in motion (1) *might* be preserved, depending on whether

one views *Alice* Step One as a "purely legal" issue in the sense argued by Younger and whether the district court's analysis denying the motion involved resolving any disputes of fact (for example, which expert's § 101 testimony to credit).

If the Supreme Court answers the question presented in the negative and adopts Dupree's definition of a purely legal issue (an issue that can be resolved with reference only to the undisputed facts), the picture is a lot murkier. Can the motions above all be resolved with reference only to the undisputed facts?

---

*Based on the Dupree oral argument, most of the Justices appear inclined to hold that "purely legal" issues decided against a party at summary judgment need not be re-raised post-trial in order to preserve them for appeal.*

---

The movants think so; otherwise they wouldn't have brought the motions. But, as to motion (1), what if the district court considered competing expert testimony on what the '000 patent is "directed to"? As to motion (2), public availability is an intensely fact-specific question, but the basis of the district court's denial was a disagreement with Patty about the legal standard. Was this issue "purely legal"? As to motion (3), what is the effect of the district court's non-merits denial of Ingrid's enablement motion on Ingrid's responsibilities for preservation? Enablement is a question of law, but it depends on underlying issues of fact (albeit issues of fact that Ingrid thinks are, in relevant part, undisputed). Is this a "purely legal" issue in the sense argued by Dupree?

As should be evident by now, even a stylized hypothetical like this one can get complicated in a hurry, depending on the rule of preservation one applies. In a real-life litigation, the potential permutations are endless — and the Court's ultimate decision in *Dupree* will affect all of them.

*The writers are regular, joint contributing columnists on intellectual property law for Reuters Legal News and Westlaw Today.*

## About the authors



**Deirdre M. Wells** (L) is a director in **Sterne, Kessler, Goldstein & Fox's** trial and appellate practice group. She has patent litigation experience before federal district courts, the International Trade Commission, and the U.S. Court of Appeals for the Federal Circuit, and has represented clients in fields including Hatch-Waxman Paragraph IV pharmaceuticals, chemical arts, medical devices, biotechnology, data storage devices, internet search technology, electrical connectors, wireless broadband technology, telephone systems, and mobile content delivery. She has a

continuing focus on design patent enforcement and can be reached at [dwells@sternekessler.com](mailto:dwells@sternekessler.com). **William H. Milliken** (C) is a director in the firm's trial and appellate practice group. His practice focuses on patent litigation in U.S. district courts and the Federal Circuit, with a particular emphasis on cases arising under the Hatch-Waxman Act. He has experience drafting appellate briefs filed in the U.S. Courts of Appeals, briefing and arguing complex motions before the federal district courts, and assisting with trial preparation in Hatch-Waxman and other patent infringement litigation. He can be reached at [wmilliken@sternekessler.com](mailto:wmilliken@sternekessler.com). **Kristina Caggiano Kelly** (R) is a director in the firm's trial and appellate practice group, representing clients in all stages of litigation before the Patent Trial and Appeal Board, International Trade Commission, district courts, Federal Circuit, and Supreme Court. She has experience in both inter partes disputes and patent prosecution in a variety of technological areas, including Hatch-Waxman filings, interference practice, and opinion work. She can be reached at [kckelly@sternekessler.com](mailto:kckelly@sternekessler.com). The authors are based in Washington, D.C.

This article was first published on Reuters Legal News and Westlaw Today on May 4, 2023.

© 2023 Thomson Reuters. This publication was created to provide you with accurate and authoritative information concerning the subject matter covered, however it may not necessarily have been prepared by persons licensed to practice law in a particular jurisdiction. The publisher is not engaged in rendering legal or other professional advice, and this publication is not a substitute for the advice of an attorney. If you require legal or other expert advice, you should seek the services of a competent attorney or other professional. For subscription information, please visit [legalsolutions.thomsonreuters.com](https://legalsolutions.thomsonreuters.com).