

## **Flip It and Reverse It: Relation Back Requires Notice of Claims Arising out of Same Conduct, Transaction, Occurrence**

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Addressing the application of the relation-back doctrine, the US Court of Appeals for the Federal Circuit revived a lawsuit, finding that damages were available because the amended complaint that asserted new patents related back to the original complaint since there was complete overlap in the parties, some overlap in the accused products, and substantial overlap in the underlying science and technology. *Anza Tech., Inc. v. Mushkin, Inc.*, Case No. 19-1045 (Fed. Cir. Aug. 16 2019) (Bryson, J).

Anza owns a patent that describes tools for bonding electronic components such as semiconductor chips to substrates and printed circuit boards using “wire bonding” (wires connecting a face-up chip to the substrate) or “flip-chip bonding” (directly soldering face-down chip to the substrate). Despite the two techniques disclosed in the specification, the claims of the patent are directed to a flip-chip bonding technique. Anza sued Mushkin, alleging infringement of the flip-chip bonding claims. During mediation, Mushkin provided a declaration that its products did not use flip-chip bonding and moved to dismiss the case. Anza agreed. Based on Anza’s concession, the district court granted Mushkin’s motion to dismiss, but permitted Anza to file an amended complaint.

Anza filed an amended complaint removing the originally asserted patent and alleging infringement of two new patents having claims directed to wire bonding techniques. The amended complaint included six of the 16 products that had been accused in the original complaint and added two new products that had not been previously accused. Mushkin filed a motion to dismiss, arguing that the new patent claims in the amended complaint did not relate back to the date of Anza’s original complaint because the claims did not arise out of the conduct, transaction or occurrence set out in the original complaint. The district court granted the motion, finding that the amended complaint did not relate back to the original complaint because the new claims did not relate to identical products and technology, and proof of infringement would require different evidence. Because Anza acknowledged that the infringing activity took place more than six years before the filing of the amended complaint, the district court found that the effect of the ruling was that the asserted claims in the amended complaint were time-barred. Anza appealed.

As a threshold issue, the Federal Circuit found that Federal Circuit law applied because determining whether newly alleged infringement claims relate back to the original complaint turns on “an analysis

of the accused acts of infringement.” After providing a survey of the relation-back doctrine, the Court found that determining whether newly alleged claims in a different patent relate back to the date of the original complaint requires analyzing:

- The overlap of parties
- The overlap in the accused products
- The underlying science and technology
- Time periods
- Any additional factors that might suggest a commonality or lack of commonality between the two sets of claims.

Applying the five-factor test, the Federal Circuit found complete overlap in the parties, some overlap in the accused products, and substantial overlap in the underlying science and technology because the patents shared the same underlying technology and were focused on solving the same problem with the same solution of using a bonding tool with a tip of dissipative material. The Court found that the specific type of bonding technique claimed in the patents (flip-chip bonding versus wire bonding) was of secondary importance. The Court rejected the district court’s conclusion that proving infringement would require evidence of how the tools were used, instead of just that certain bonding tools were used, and found that determination would not be likely to result in a substantially different evidentiary showing to prove infringement of the claims asserted in the amended complaint.

Accordingly, the Federal Circuit concluded that the claims in the amended complaint that related to the six originally accused products related back to the date of the original complaint, and that § 286 did not wholly bar an award of damages. The district court’s dismissal as to those products was reversed. The Court also vacated the dismissal for the products that were added for the first time in the amended complaint and remanded that issue of whether the allegations regarding those products should relate back to the filing date of the original complaint (based on the five-factor test articulated in the decision) back to the district court.

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