

Case Nos. 2018-2338 (L), -2339, -2395, -2396

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United States Court of Appeals  
for the Federal Circuit

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NETWORK-1 TECHNOLOGIES, INC.,

*Plaintiff - Appellant*

v.

HEWLETT-PACKARD COMPANY,  
HEWLETT PACKARD ENTERPRISE COMPANY,

*Defendants – Cross-Appellants*

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Appeal from the United States District Court for the Eastern District of  
Texas, Case Nos. 6:11-cv-00492-RWS-KNM and 6:13-cv-00072-RWS,  
Judge Robert Schroeder, III

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**BRIEF OF *AMICUS CURIAE* T-MOBILE USA, INC., IN SUPPORT OF  
DEFENDANTS – CROSS-APPELLANTS HEWLETT-PACKARD  
COMPANY AND HEWLETT PACKARD ENTERPRISE COMPANY, ON  
THE ISSUE OF ESTOPPEL UNDER SECTION 315(E)**

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April 5, 2019

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**CERTIFICATE OF INTEREST**

Counsel for *Amicus Curiae* T-Mobile, USA, Inc. certifies the following:

**1. The full Name of every party or amicus represented by me is:**

T-Mobile USA, Inc.

**2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:**

T-Mobile USA, Inc.

**3. Parent corporations and publicly held companies that own 10% or more of stock in the party:**

T-Mobile USA, Inc. is a wholly owned subsidiary of T-Mobile US, Inc., which is a publicly traded company. Deutsche Telekom Holding B.V., a limited liability company (besloten vennootschap met beperkte aansprakelijkheid) organized and existing under the laws of the Netherlands (“DT B.V.”), owns more than 10% of the shares of T-Mobile US, Inc.

**4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court (and who have not or will not enter an appearance in this case) are:**

Klarquist Sparkman, LLP, Sarah E. Jelsema, Andrew M. Mason, and John D. Vandenberg.

T-Mobile USA, Inc., Sarah J. Kalemeris.

**5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court’s decision in the pending appeal. *See* Fed. Cir. R. 47.4(a)(5) and 47.5(b). (The parties should attach continuation pages as necessary).**

None known.

Date: April 5, 2019

/s/Andrew M. Mason  
Andrew M. Mason

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**INTEREST OF AMICUS CURIAE<sup>1</sup>**

Amicus T-Mobile USA, Inc. (“T-Mobile”) is the nation’s third-largest wireless service provider, with a customer base of approximately 65 million subscribers and annual revenues of \$32 billion. T-Mobile operates a network that is built with the equipment of many suppliers. T-Mobile sells and/or provides cellular service for mobile devices and tablets manufactured by a number of companies. T-Mobile is regularly involved in patent disputes before the PTAB, the district courts, and this Court.

T-Mobile’s interest lies in ensuring fair and predictable application of the estoppel provisions of Section 315(e) of the Patent Act. *See* HP Principal Brief (Dkt. 35) at 52–61. This brief explains why litigants, district courts, and the PTAB would benefit from additional guidance on Section 315(e) estoppel and proposes several factors that should be considered when deciding whether an IPR petitioner “reasonably could have raised” a prior-art-unpatentability ground.

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<sup>1</sup> Pursuant to Fed. R. App. P. 29(a) and Fed. Cir. R. 29(c), all parties have consented to the filing of this brief. This brief was not authored in whole or in part by a party or a party’s counsel. No monetary contribution to the preparation or submission of this brief was made by any person or entity other than the amicus curiae or its counsel.

## ARGUMENT

### **I. PARTIES NEED BETTER GUIDANCE ON SECTION 315(E)’S “REASONABLY COULD HAVE RAISED” STANDARD**

#### **A. Before SAS, Tribunals Did Not Apply Section 315(e) Estoppel Consistently**

Under 35 U.S.C. § 315(e), if an inter partes review of “a claim in a patent” results in a final written decision adverse to the petitioner,<sup>2</sup> then the petitioner, any real party in interest, and the petitioner’s privies are all estopped from asserting certain unpatentability or invalidity grounds. This case involves Section 31 (e)(2), which extends estoppel to any district court or ITC argument that “the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review.” Section 315(e)(1) contains identical “raised or reasonably could have raised during that [IPR]” language, but extends estoppel to “proceeding[s] before the [Patent] Office” with respect to that claim.

This Court interpreted the “raised during that [IPR]” language of Section 315 (e) in *Shaw Industries Group, Inc. v. Automated Creel Systems, Inc.* 817 F.3d 1293, 1299–1300 (Fed. Cir. 2016). *Shaw* held that estoppel does not apply to unpatentability grounds asserted in a petition but not instituted, because such grounds were neither raised nor reasonably could have been raising “during” the IPR

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<sup>2</sup> Whether the final written decision must be adverse to the petitioner is an issue on appeal to the Court in *BTG Int’l Ltd. v. Amneal Pharms. LLC*, Case No. 2019-1147.



proceeding. *Id.* *Shaw* was predicated on the existence of partial institution, i.e., that the PTAB could institute on fewer than all grounds presented in the petition.

For roughly two years before the Supreme Court decided *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1360 (2018), the *Shaw* decision served as guidance on the issue of estoppel. *Shaw* was relied on by both the PTAB applying Section 315(e)(1) and district courts applying Section 315(e)(2). The Supreme Court's *SAS* decision eliminated partial institution, making *Shaw* less significant. Nonetheless, *Shaw*'s brief history as controlling case law shows how different courts applied the estoppel provision in different ways when not provided with more specific guidance.

Some found *Shaw* dictated a *narrow* estoppel that applies only to prior art presented in those grounds that were part of a final written decision. *E.g.*, *Verinata Health, Inc. v. Ariosa Diagnostics, Inc.*, No. 12-cv-05501-SI, 2017 WL 235048, at \*3 (N.D. Cal. Jan. 19, 2017) (“[E]stoppel applies only to those arguments, or potential arguments, that received ... proper judicial attention.”).

Others adopted a *broader* estoppel, namely that estoppel applies to all prior art unless the petition presented that art in a ground for which institution was denied. *E.g.*, *Milwaukee Elec. Tool Corp. v. Snap-On Inc.*, 271 F. Supp. 3d 990, 1029–30 (E.D. Wis. 2017).

Others applied an *even broader* estoppel, strictly cabined by the particular facts of *Shaw* and extending to all prior art unless the art was presented in a petition

ground for which institution was denied *for procedural reasons*. *E.g.*, *Biscotti Inc. v. Microsoft Corp.*, No. 2:13-CV-01015-JRG-RSP, 2017 WL 2526231, at \*4–8 (E.D. Tex. May 11, 2017).

**B. Post-SAS, Courts And The PTAB Applying Section 315(e)  
Focus More On The “Reasonably Could Have Raised” Language**

After SAS eliminated partial institution, courts and the PTAB turned away from *Shaw* and began developing a different approach to estoppel. *E.g.*, *SiOnyx, LLC v. Hamamatsu Photonics K.K.*, 330 F. Supp. 3d 574, 602–03 (D. Mass. 2018). That approach is reflected in the district court decision in this case, which held that when “a party has knowledge of an invalidity position that *could* be included in an IPR petition but it *chooses* to omit that ground from its filing, estoppel attaches because it ‘reasonably could have raised’ the invalidity ground in its IPR.” Appx0088.

The post-SAS application of Section 315(e) has been driven by a narrow focus on comments in the legislative history made by Senator Kyl:

The present bill also softens the could-have-raised estoppel that is applied by inter partes review against subsequent civil litigation by adding the modifier ‘reasonably.’ . . . Adding the modifier ‘reasonably’ ensures that could-have-raised estoppel extends only to that prior art which a skilled searcher conducting a diligent search reasonably could have been expected to discover.

157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011).

For example, in *SiOnyx*, the district court applied a diligent search test that involved (1) identifying “the search string and search source that would identify the

allegedly unavailable prior art”; and (2) presenting “evidence, likely expert testimony, why such a criterion would be part of a skilled searcher’s diligent search.” 330 F. Supp. 3d at 602–03. Another district court largely followed *SiOnyx* in analyzing estoppel as to non-petitioned grounds, noting that “the issue goes back to the choices made by the petitioner itself.” *Cal. Inst. of Tech. v. Broadcom Ltd.*, No. CV 16-3714, 2018 WL 7456042, at \*7 (C.D. Cal. Dec. 28, 2018).

The PTAB too has followed suit, with at least one panel finding that *Shaw* provided guidance only for “pre-SAS Board procedures” and then estopping the petitioner from requesting or maintaining an IPR petition based on three references “that reasonably could have been raised in its earlier petition” or in a simultaneously-filed “sibling petition.” *Kingston Tech. Co. v. Spex Techs., Inc.*, No. IPR2018-01002, 2018 WL 5861976, at \*3–4 (P.T.A.B. Nov. 6, 2018).

**C. Uncertainty Remains, And The Time Is Ripe For Further Guidance On The “Reasonably Could Have Raised” Test**

While SAS may have simplified the analysis to a degree, there is still uncertainty on the scope of estoppel under Section 315(e). Esch et al., *Petitioner Estoppel from Patent Trial and Appeal Board Proceedings after SAS Institute Inc. v. Iancu*, 18 Chicago-Kent J. Intell. Prop. 10, 12 (2019) (analyzing post-SAS estoppel and noting that “uncertainty remains for ... *non-petitioned* claims and grounds”), available at <https://scholarship.kentlaw.iit.edu/cgi/viewcontent.cgi?article=1227&context=ckjip>; *id.* at 22 (concluding that “until more district courts take up this

question, or until the Federal Circuit revisits *Shaw* in light of *SAS*, uncertainty regarding the estoppel effects of AIA reviews remains”).

Given the new focus on the statute’s “reasonably could have raised” language, the Court should now provide litigants, the district courts, and the PTAB with guidance on how to determine whether a party “reasonably could have” raised an unpatentability ground during an earlier IPR. While the present case focuses on joinder, it provides the Court an opportunity to provide more general guidance on estoppel. Providing this guidance now would give more certainty, reduce undue broad (or narrow) application of Section 315(e)’s estoppel provisions, and help ensure consistent application of the statute across district courts.

**D. The Court Should Prescribe Considerations For Determining Whether A Ground “Reasonably Could Have” Been Raised**

To date, the courts and PTAB have been guided largely by comments of a single Senator in the legislative history. But a standard based only on Senator Kyl’s “skilled searcher conducting a diligent search” comments unreasonably ignores the realities of IPR and litigation strategy and would unfairly prejudice petitioning defendants in many circumstances—the instant case being an extreme example.

Moreover, at least some courts appear to be reading the word “reasonably” out of the statute, resulting in an overbroad application of estoppel. *See* Appx0088 (holding that the statute’s “reasonably could have raised” language is satisfied “[w]hen a party had knowledge of an invalidity position that *could* be included in an

IPR petition”). The statute does not extend estoppel to any ground that *could* have been raised, but rather to any ground that “*reasonably* could have [been] raised.” A petitioner certainly *could* file IPRs on every prior art reference it comes across, but that would not be reasonable given cost and other considerations. The Court should provide guidance that avoids reading the word “reasonably” out of the statute. *See Sharp v. United States*, 580 F.3d 1234, 1238 (Fed. Cir. 2009) (“We therefore reject [an] interpretation, which would violate the canon that we must ‘give effect, if possible, to every clause and word of a statute.’”).

The PTAB and district courts should apply a holistic test that accounts for the various factors that dictate whether a ground “reasonably could have [been] raised.” Those factors include the number of claims and infringement theories asserted in litigation, cost considerations, and whether the apparent scope of the challenged claims is a moving target.

## **II. PROPOSED CONSIDERATIONS FOR THE ESTOPPEL ANALYSIS UNDER SECTION 315(E)**

Whether a petitioner “reasonably could have raised” a particular unasserted unpatentability ground against a patent claim should turn on practical strategic considerations and related equities, including the extent to which the petitioner:

1. knew or should have known of the unasserted ground’s prior art, and clear status as prior art, as of the petition’s filing date;

2. knew or should have known of the claim scope that is now asserted by the patent owner or established by the tribunal;
3. had the ability and reasonable motivation to develop and assert in the IPR that unasserted ground; and
4. had a reasonable belief that the unasserted ground could have harmed either (a) the petition's chances of success or (b) the petitioner's defenses in a parallel district court or ITC litigation, such as a defense of noninfringement.

Amicus urges the Court to adopt such considerations for the Section 315(e) statutory estoppel analysis, and in the following sub-sections provides exemplary scenarios applicable to each consideration.

**A. First Consideration: Petitioner Knew Or Should Have Known Of The Prior Art As Of The Petition's Filing Date**

The first consideration is whether a petitioner knew or should have known of the prior art, *and its clear status as prior art*, as of the petition's filing date. Circumstances where this factor will weigh in favor of finding estoppel include (1) where the defendant petitioner included clear Section 102(b) publication art in invalidity contentions that were served before or shortly after filing the petition, (2) where other evidence shows that petitioner was in possession of a clear Section 102(b) prior art publication before filing its petition, or (3) where evidence shows that a petitioner failed to conduct a diligent search or was willfully blind to the existence of the art in question. Here, the diligent searcher test discussed above may

be an appropriate inquiry for determining whether a petitioner should have known of a prior art publication.

In some situations, however, at the time of a petition's filing there may be open questions regarding the prior art status of a publication. For example, a petitioner may need further discovery to establish the public availability of a Section 102(b) publication or to confirm that patent owner is unable to swear behind a publication that is prior art under Section 102(a) or 102(b). Existence of such open questions makes it reasonable to not pursue a ground and should weigh against estoppel. Post-SAS, courts and the PTAB have looked at the petitioner's knowledge of publications, but not considered whether the petitioner could have clearly established them as prior art before filing the petition (or a short time thereafter).

While a relevant factor, the reasonableness inquiry should not end with this factor. As discussed in the next three sections, other considerations may make it unreasonable for a petitioner to have raised a prior art ground in an IPR, even if it knew of the art forming that ground.

**B. Second Consideration: Petitioner Knew Or Should Have Known Of The Claim Scope Now Asserted By The Patent Owner Or Established By The Tribunal**

Another consideration is whether a petitioner knew or should have known of the claim scope asserted by the patent owner or established by the tribunal. Claim scope is a key factor for petitioners selecting prior art for inclusion in an

unpatentability ground presented in a petition, as a petitioner bears the burden to show satisfaction of each claim element *as properly construed*. See 37 C.F.R. § 42.24(b)(3-4) (specifying requirements that petition identify “[h]ow the challenged claim is to be construed” and “[h]ow the construed claim is unpatentable”); *see also Tasco, Inc. v. Pagnani*, No. IPR2013-00103, 2013 WL 5947703, at \*5 (P.T.A.B. May 23, 2013) (quoting 37 C.F.R. § 42.104 and noting that “the burden is on the petitioner” to meet its requirements).

A piece of prior art that satisfies the claims under one construction may seem less favorable under a different construction. Thus, this factor may dictate a finding of no estoppel, or at least weigh against finding estoppel, when the PTAB or a district court issues a claim construction that is substantially different than petitioner’s proposed, and reasonable, construction. This is especially so for petitions filed after November 12, 2018, when the PTAB switched to using the same claim construction standard as district courts. A common standard now makes it more likely that a surprising construction in one forum may then be adopted in the other.

At the PTAB, a petitioner’s choice of prior art grounds depends on its proposed claim construction. If that construction was reasonable, but the Board adopted a significantly different construction, whether narrower or broader, that may substantially increase the relative significance of an omitted prior art ground. This



should weigh against estoppel to avoid rewarding the patent owner for drafting unclear patent claims.

In addition, where a petition is filed before infringement contentions are served, this weighs against estoppel. Without infringement contentions, a plaintiff's stance on claim scope may be unclear, making it more difficult for defendant petitioners to identify the "best" prior art for an IPR challenge. And for various reasons, e.g., a statutory bar, a slower case schedule, or stayed litigation, a party may have no choice but to file a petition before receiving infringement contentions or patent owner's claim construction positions. *Cf. Smart Search Concepts LLC v. Buy.Com Inc.*, 1:13-cv-01034 GMS (D. Del.) (Dkt. 5, 16) (complaint served June 2013 and initial scheduling conference not set until May 2014).

Thus, if the petition reasonably was filed before plaintiff served infringement contentions, this fact should weigh against estoppel. Similarly, if plaintiff is allowed, post-petition, to serve amended infringement contentions, then this may weigh against estoppel, because amended infringement contentions could change what a petitioner reasonably could have expected in terms of claim scope. *Cf. Adaptix, Inc. v. Dell Inc.*, No. 5:14-CV-01259-PSG, 2015 WL 13747892, at \*4 (N.D. Cal. Feb. 24, 2015) (finding that patent owner's delay in seeking to amend its infringement contentions "stripped Defendants of the opportunity to seek *inter partes* review from the PTAB as to prior art consistent with" those contentions).

On the other hand, if the petitioner correctly predicted the scope of the claims—as construed by the district court, or by the PTAB—then this may weigh in favor of finding estoppel.

Another instance where defendant petitioners lack notice regarding claim scope, thus weighing against estoppel, is when a plaintiff patent owner voluntarily dismisses its complaint shortly after service. Service of the complaint starts the clock on the Section 315(b) statutory bar for filing an IPR, yet dismissal leaves petitioner facing only a vague cloud of infringement without the more specific knowledge of patent owner’s allegations afforded by discovery. *E.g.*, *Uniloc 2017 LLC v. Microsoft Corp.*, 8:18-cv-01279 (C.D. Cal.) (Dkt. 1, 10, 14) (complaint served July 26, 2018, alleging infringement of U.S. Pat. No. 6,993,049, but that patent dropped unilaterally by plaintiff in amended complaint filed only fifteen days later). Thus, despite lacking the notice regarding claim scope provided by the typical infringement contentions and exchange of proposed constructions, petitioners must either file an IPR prior to the one-year bar or lose that opportunity altogether. *See Click-To-Call Techs., LP v. Ingenio, Inc.*, 899 F.3d 1321, 1328, n.3 (Fed. Cir. 2018) (en banc) (holding that 35 U.S.C. § 315(b)’s time bar applies even when a district court action is voluntarily dismissed without prejudice).

**C. Third Consideration: Petitioner Had The Ability And Reasonable Motivation To Develop And Raise The Ground In The IPR**

Even when the Petitioner was aware of certain prior art, it may have lacked the ability or reasonable motivation to assert that art as part of an IPR ground. For example, here HP had no ability to raise additional grounds, as its first joinder motion that would have added new grounds was denied. HP Principal Brief (Dkt. 35) at 58. That motion was not denied on the merits of the grounds, but because of the added burden of dealing with additional grounds. *See Sony Corp. of Am. v. Network-1 Sec. Sols., Inc.*, No. IPR2013-00386, 2013 WL 5970093, at \*6 (P.T.A.B. July 29, 2013).

Because HP effectively was barred from asserting additional grounds for procedural reasons (similar to the facts of *Shaw*), it should not have been estopped from asserting the additional grounds in litigation. For joining petitioners, there should be a presumption of no estoppel, especially when, as here, the PTAB expressly did not allow the petitioner to add additional grounds beyond those presented in the original IPR proceeding. Such PTAB denials of joinder are not uncommon. *See, e.g., Medtronic, Inc. v. Endotach LLC*, No. IPR2014-00695, 2014 WL 4854767, at \*6 (P.T.A.B. Sept. 25, 2014) (denying joinder motion to add grounds petitioner allegedly uncovered after receiving patent owner's infringement contentions).

Another example of when a party could not assert certain prior art grounds—thus weighing against estoppel—is when a defendant petitioner filed multiple petitions but the PTAB denied institution of one or more of the petitions. For the same reasons set forth in *Shaw*, when a party files multiple petitions challenging the same patent and only a subset are instituted and proceed to final written decision, there should be a presumption against estoppel because the petitioner was not allowed to raise—and thus could not have raised—the grounds presented in the non-instituted petition. This scenario is similar to, but much less common than, the partial institution decisions that existed pre-SAS. Such institution-stage denials are often made for procedural reasons, e.g., the grounds are perceived as cumulative to other arguments presented to the Office or the petition fails to meet a procedural requirement such as failing to identify sufficient structure for a means-plus-function element.

Similarly, where a plaintiff patent owner voluntarily dismisses its complaint (*supra* Section II.B), this impacts a petitioner's reasonable motivation to spend resources to identify and assert multiple grounds in multiple petitions at the PTAB. Preparing and filing an IPR involves prior art searching, attorneys' time and fees, expert witness fees, and more than \$30,000 in filing fees for each petition. The median cost of preparing and filing a single petition is about \$100,000, and the median cost through decision is about \$250,000. *See* AIPLA 2017 Report of the

Economic Survey, June 2017, at 51; “IPRs: Balancing Effectiveness vs. Cost,” June 17, 2016, available at <https://www.rpxcorp.com/intelligence/blog/iprs-balancing-effectiveness-vs-cost>. Nonetheless, given the Section 315(b) statutory bar, defendants must file an IPR or forever lose that opportunity. But without a pending litigation, it may not be a reasonable allocation of resources to pursue all possible prior art grounds. This file-and-dismiss strategy gives patent owners an unfair advantage and, thus, further weighs against estoppel should the patent owner later re-commence its infringement suit.

For similar reasons, where a patent owner asserts a large number of claims in litigation, this weighs against estoppel. As noted above, each petition costs significant resources to create and file. In addition, the PTAB has word limits that restrict the number of grounds that can reasonably be asserted in any one petition. 37 C.F.R. § 42.24(a). When a patent owner asserts an unreasonably large number of claims in litigation, it necessarily reduces the number of prior art grounds that a defendant petitioner can *reasonably* be expected to include in its IPR challenges.

Conversely, where a patent owner asserts a low number of claims in litigation, this makes it more reasonable for a petitioner to raise multiple grounds in a petition. Thus, a low number of asserted claims (perhaps 5 or fewer) should tend to weigh in favor of estoppel.

**D. Fourth Consideration: Petitioner Reasonably Believed That A Ground, If Raised, Would Decrease The Petition's Chances Of Success Or A Litigation Defense's Chances Of Success**

Finally, a petitioner's reasonable belief—even if it was aware of an unasserted ground—that the ground would have either decreased a petition's chance of success or decreased the chances of success of a litigation defense should weigh against a finding of estoppel. These considerations may make it reasonable to not raise a particular prior art ground via IPR.

For example, defendants often face infringement allegations based on a claim construction that implicates one body of prior art, yet maintain noninfringement defenses based on a different (and reasonable) construction that implicates another body of prior art. In these situations, an IPR challenge embracing patent owner's proposed construction could undermine (or eliminate) a party's noninfringement defenses, given the common *Phillips* standard. At the same time, the PTAB denies petitions if they do not fully embrace a proposed claim construction. This leaves petitioners with “*an untenable Hobson's choice* of adopting [a patent owner's] proposed constructions from the district court proceeding (which may not necessarily be favorable to its non-infringement positions) in order [to] be allowed to present its unpatentability arguments in [IPR].” *Hologic, Inc. v. Enzo Life Sciences, Inc.*, No. IPR2018-00019, 2018 WL 1897623, at \*4 (P.T.A.B. Apr. 18, 2018) (Paulraj, A.P.J., dissenting) (emphasis added); *see also id.*, \*3–4 (denying

institution because the petition only explained how the claims were unpatentable under patent owner's proposed district court constructions and noted petitioner's disagreement with those constructions).

Such facts weigh against estoppel because a defendant petitioner should be allowed to challenge a patent in an IPR under what it contends is the proper claim scope without risking district court estoppel on prior art that is closer to patent owner's interpretation of the claims. This is especially so when the prior art bears a high similarity to the accused product.

Other circumstances where this factor weighs against finding estoppel include when the art is not a patent or published application and there may be some uncertainty as to whether the art was a "printed publication" or published early enough to qualify as prior art under Sections 102(a) or 102(e). For example, pre-petition discovery may uncover a potential prior art document, but confirmation that this document was publicly accessible may require further discovery such as a deposition. *Cf. Adobe Sys. Inc. v. Grecia*, No. IPR2018-00419, 2018 WL 3105411, at \*4 (P.T.A.B. June 21, 2018) (denying institution on finding insufficient evidence that thesis was publicly available, and distinguishing from case where "declaration from the university librarian ... detailed the library's procedures for receiving, cataloging, and shelving of theses"). Given the requirements to show authentication and public availability, it may not be reasonable for a petitioner to raise an

unpatentability ground based on such art. Similarly, it may not be reasonable to expect a petitioner to raise an unpatentability ground based on Section 102(a) or Section 102(e) prior art before knowing the extent of patent owner's evidence on invention date.

### **CONCLUSION**

*Amicus* T-Mobile urges the Court to seize this opportunity to provide clear guidance to the district courts and PTAB on estoppel under Section 315(e), so that these bodies analyze statutory estoppel in a consistent and fair manner.

Respectfully submitted.

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April 5, 2019



**CERTIFICATE OF SERVICE**

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