

No. 19-1918

**United States Court of Appeals
for the Federal Circuit**

—————
In re: PERSONALWEB TECHNOLOGIES LLC,

PERSONALWEB TECHNOLOGIES LLC,

Plaintiff - Appellant

LEVEL 3 COMMUNICATIONS, LLC,

Plaintiff

v.

PATREON, INC.,

Defendant - Appellee

AMAZON.COM, INC., AMAZON WEB SERVICES, INC.,

Intervenors

PERSONALWEB TECHNOLOGIES LLC,

Plaintiff - Appellant

LEVEL 3 COMMUNICATIONS, LLC,

Plaintiff

v.

DICTIONARY.COM, LLC,

Defendant - Appellee

AMAZON.COM, INC., AMAZON WEB SERVICES, INC.,

Intervenors

PERSONALWEB TECHNOLOGIES LLC,

Plaintiff - Appellant

LEVEL 3 COMMUNICATIONS, LLC,

Plaintiff

v.

VOX MEDIA, INC.,

Defendant - Appellee

AMAZON.COM, INC., AMAZON WEB SERVICES, INC.,

Intervenors

PERSONALWEB TECHNOLOGIES LLC,

Plaintiff - Appellant

LEVEL 3 COMMUNICATIONS, LLC,

Plaintiff

v.

VICE MEDIA, LLC,

Defendant - Appellee

AMAZON.COM, INC., AMAZON WEB SERVICES, INC.,

Intervenors

PERSONALWEB TECHNOLOGIES LLC,

Plaintiff - Appellant

LEVEL 3 COMMUNICATIONS, LLC,

Plaintiff

v.

OATH INC.,

Defendant - Appellee

AMAZON.COM, INC., AMAZON WEB SERVICES, INC.,

Intervenors

PERSONALWEB TECHNOLOGIES LLC,

Plaintiff - Appellant

LEVEL 3 COMMUNICATIONS, LLC,

Plaintiff

v.

BUZZFEED, INC.,

Defendant - Appellee

AMAZON.COM, INC., AMAZON WEB SERVICES, INC.,

Intervenors

PERSONALWEB TECHNOLOGIES LLC,

Plaintiff - Appellant

LEVEL 3 COMMUNICATIONS, LLC,

Plaintiff

v.

POPSUGAR, INC.,

Defendant - Appellee

AMAZON.COM, INC., AMAZON WEB SERVICES, INC.,

Intervenors

PERSONALWEB TECHNOLOGIES LLC,

Plaintiff - Appellant

LEVEL 3 COMMUNICATIONS, LLC,

Plaintiff

v.

ZIFF DAVIS, LLC,

Defendant - Appellee

AMAZON.COM, INC., AMAZON WEB SERVICES, INC.,

Intervenors

**On Appeal from the United States District Court
for the Northern District of California, San Jose
Honorable Beth Labson Freeman
Case Nos. 5:18-cv-05599; 5:18-cv-05606;
5:18-cv-05969; 5:18-cv-05970; 5:18-cv-06044;
5:18-cv-06046; 5:18-cv-06612; 5:18-cv-07119**

**RESPONSE OF DEFENDANTS-APPELLEES AND INTERVENORS TO
COMBINED PETITION OF PERSONALWEB TECHNOLOGIES, LLC
FOR PANEL REHEARING AND REHEARING EN BANC**

Jeffrey H. Dean
AMAZON.COM, INC.
440 Terry Avenue, North
Seattle, WA 98109
(206) 740-0521

Todd R. Gregorian
FENWICK & WEST LLP
555 California Street
12th Floor
San Francisco, CA 94104
(415) 875-2300

J. David Hadden
Saina S. Shamilov
Ravi Ranganath
FENWICK & WEST LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041
(650) 988-8500

*Counsel for Defendant-Appellees
and Intervenors*

October 23, 2020

CERTIFICATE OF INTEREST

For Intervenors Amazon.com, Inc. and Amazon Web Services, Inc.

Counsel for Amazon.com, Inc. and Amazon Web Services, Inc. certifies the following under Federal Circuit Rule 47.4:

1. The full names of all entities represented by undersigned counsel in this case:

Amazon.com, Inc. and Amazon Web Services, Inc.

2. The full names of all real parties in interest for the entities (if the entities named are not the real parties in interest):

As indicated in Item 1.

3. All parent corporations for the entities and any publicly held companies that own 10 percent or more of the stock for the entities:

Amazon.com, Inc. has no parent corporation and no publicly held corporation is known to own 10% or more of its stock. Amazon Web Services, Inc. is a wholly owned subsidiary of Amazon.com, Inc.

4. All law firms, partners, and associates that appeared for the entities in the originating court or agency or are expected to appear in this court for the entities that have not already entered an appearance:

Melanie Mayer and Chieh Tung of Fenwick & West LLP.

5. The case titles and numbers of any case known 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 following cases in the United States District Court, District of Northern California, will be directly affected by this Court's decision in the appeal:

- *Amazon.com, Inc. et al. v. PersonalWeb Technologies, LLC et al.*, No. 5:18-cv-00767;
- *PersonalWeb Technologies, LLC et al. v. Airbnb, Inc.*, No. 5:18-cv-00149;
- *PersonalWeb Technologies, LLC et al. v. Amicus FTW, Inc.*, No. 5:18-cv-00150;
- *PersonalWeb Technologies, LLC et al. v. Atlassian, Inc.*, No. 5:18-cv-00154;
- *PersonalWeb Technologies, LLC et al. v. Cloud 66, Inc.*, No. 5:18-cv-00155;
- *PersonalWeb Technologies, LLC et al. v. Curebit, Inc.*, No. 5:18-cv-00156;

- *PersonalWeb Technologies, LLC et al. v. Doximity, Inc.*, No. 5:18-cv-00157;
- *PersonalWeb Technologies, LLC et al. v. Fandor, Inc.*, No. 5:18-cv-00159;
- *PersonalWeb Technologies, LLC et al. v. Goldbely, Inc.*, No. 5:18-cv-00160;
- *PersonalWeb Technologies, LLC et al. v. GoPro, Inc.*, No. 5:18-cv-00161;
- *PersonalWeb Technologies, LLC et al. v. Heroku, Inc.*, No. 5:18-cv-00162;
- *PersonalWeb Technologies, LLC et al. v. Leap Motion, Inc.*, No. 5:18-cv-00163;
- *PersonalWeb Technologies, LLC et al. v. Melian Labs, Inc.*, No. 5:18-cv-00165;
- *PersonalWeb Technologies, LLC et al. v. MyFitnessPal, Inc.*, No. 5:18-cv-00166;
- *PersonalWeb Technologies, LLC et al. v. Quotient Technology, Inc.*, No. 5:18-cv-00169;
- *PersonalWeb Technologies, LLC et al. v. Reddit, Inc.*, No. 5:18-cv-00170;
- *PersonalWeb Technologies, LLC et al. v. Roblox Corp.*, No. 5:18-cv-00171;
- *PersonalWeb Technologies, LLC et al. v. Stitchfix, Inc.*, No. 5:18-cv-00173;
- *PersonalWeb Technologies, LLC et al. v. Teespring, Inc.*, No. 5:18-cv-00175;
- *PersonalWeb Technologies, LLC et al. v. Tophatter, Inc.*, No. 5:18-cv-00176;
- *PersonalWeb Technologies, LLC et al. v. Venmo, Inc.*, No. 5:18-cv-00177;
- *PersonalWeb Technologies, LLC et al. v. Webflow, Inc.*, No. 5:18-cv-00178;
- *PersonalWeb Technologies, LLC et al. v. Square, Inc.*, No. 5:18-cv-00183;
- *PersonalWeb Technologies, LLC et al. v. Vend, Inc. et al.*, No. 5:18-cv-00196;
- *PersonalWeb Technologies, LLC et al. v. Merkle, Inc.*, No. 5:18-cv-00409;
- *PersonalWeb Technologies, LLC et al. v. Spokeo, Inc.*, No. 5:18-cv-02140;
- *PersonalWeb Technologies, LLC et al. v. Yotpo Ltd.*, No. 5:18-cv-03452;
- *PersonalWeb Technologies, LLC et al. v. Lesson Nine GMBH*, No. 5:18-cv-03453;
- *PersonalWeb Technologies, LLC et al. v. Fiverr International Ltd.*, No. 5:18-cv-03455;
- *PersonalWeb Technologies, LLC et al. v. MWM My Wedding Match Ltd.*, No. 5:18-cv-03457;
- *PersonalWeb Technologies, LLC et al. v. Capterra, Inc.*, No. 5:18-cv-03458;
- *PersonalWeb Technologies, LLC et al. v. Karma Mobility Inc.*, No. 5:18-cv-03459;
- *PersonalWeb Technologies, LLC et al. v. Match Group, LLC et al.*, No. 5:18-cv-03462;
- *PersonalWeb Technologies, LLC et al. v. WeddingWire, Inc.*, No. 5:18-cv-03463;
- *PersonalWeb Technologies, LLC et al. v. BDG Media Inc. et al.*, No. 5:18-cv-03571;
- *PersonalWeb Technologies, LLC et al. v. Bitly, Inc.*, No. 5:18-cv-03572;
- *PersonalWeb Technologies, LLC et al. v. Blue Apron, LLC*, No. 5:18-cv-03573;
- *PersonalWeb Technologies, LLC et al. v. Centaur Media USA, Inc. et al.*, No. 5:18-cv-03577;

- *PersonalWeb Technologies, LLC et al. v. Fab Commerce & Design, Inc.*, No. 5:18-cv-03578;
- *PersonalWeb Technologies, LLC et al. v. Food52, Inc.*, No. 5:18-cv-03579;
- *PersonalWeb Technologies, LLC et al. v. Panjiva, Inc.*, No. 5:18-cv-03580;
- *PersonalWeb Technologies, LLC et al. v. FanDuel Inc. et al.*, No. 5:18-cv-03582;
- *PersonalWeb Technologies, LLC et al. v. RocketHub, Inc. et al.*, No. 5:18-cv-03583;
- *PersonalWeb Technologies, LLC et al. v. Spongecell, Inc.*, No. 5:18-cv-03584;
- *PersonalWeb Technologies, LLC et al. v. Kickstarter, PBC*, No. 5:18-cv-03997;
- *PersonalWeb Technologies, LLC et al. v. Cloud Warmer Inc.*, No. 5:18-cv-03998;
- *PersonalWeb Technologies, LLC et al. v. Atlas Obscura, Inc.*, No. 5:18-cv-04037;
- *PersonalWeb Technologies, LLC et al. v. Braze, Inc.*, No. 5:18-cv-04624;
- *PersonalWeb Technologies, LLC et al. v. Kongregate, Inc.*, No. 5:18-cv-04625;
- *PersonalWeb Technologies, LLC et al. v. Shopify, Inc. et al.*, No. 5:18-cv-04626;
- *PersonalWeb Technologies, LLC et al. v. Strava, Inc.*, No. 5:18-cv-04627;
- *PersonalWeb Technologies, LLC et al. v. Peek Travel, Inc.*, No. 5:18-cv-04628;
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- *PersonalWeb Technologies, LLC et al. v. NRT LLC et al.*, No. 5:18-cv-05201;
- *PersonalWeb Technologies, LLC et al. v. ShareFile LLC*, No. 5:18-cv-05202;
- *PersonalWeb Technologies, LLC et al. v. StartDate Labs, Inc.*, No. 5:18-cv-05203;
- *PersonalWeb Technologies, LLC et al. v. Tastytrade, Inc.*, No. 5:18-cv-05204;
- *PersonalWeb Technologies, LLC et al. v. Treehouse Island, Inc.*, No. 5:18-cv-05205;
- *PersonalWeb Technologies, LLC et al. v. Valassis Communications, Inc.*, No. 5:18-cv-05206;
- *PersonalWeb Technologies, LLC et al. v. Wework Companies Inc.*, No. 5:18-cv-05272;
- *PersonalWeb Technologies, LLC et al. v. Dollar Shave Club*, No. 5:18-cv-05373;
- *PersonalWeb Technologies, LLC et al. v. Brooklyn Brewery Corp.*, No. 5:18-cv-05436;
- *PersonalWeb Technologies, LLC et al. v. Goodreads LLC*, No. 5:18-cv-05595;
- *PersonalWeb Technologies, LLC et al. v. Imgur, Inc.*, No. 5:18-cv-05596;
- *PersonalWeb Technologies, LLC et al. v. Slack Technologies, Inc.*, No. 5:18-cv-05600;
- *PersonalWeb Technologies, LLC et al. v. Intuit Inc.*, No. 5:18-cv-05611;
- *PersonalWeb Technologies, LLC et al. v. Twitch Interactive, Inc.*, No. 5:18-cv-05619;
- *PersonalWeb Technologies, LLC et al. v. Upwork Global Inc.*, No. 5:18-cv-05624;

- *PersonalWeb Technologies, LLC et al. v. Zoom Video Communications, Inc.*, No. 5:18-cv-05625;
- *PersonalWeb Technologies, LLC et al. v. RetailMeNot, Inc.*, No. 5:18-cv-05966;
- *PersonalWeb Technologies, LLC et al. v. Trip Advisor LLC*, No. 5:18-cv-05967;
- *PersonalWeb Technologies, LLC et al. v. Urban Dictionary, LLC*, No. 5:18-cv-05968;
- *PersonalWeb Technologies, LLC et al. v. Vimeo, Inc.*, No. 5:18-cv-06042;
- *PersonalWeb Technologies, LLC et al. v. Trello, Inc.*, No. 5:18-cv-06043;
- *PersonalWeb Technologies, LLC et al. v. Stack Exchange, Inc.*, No. 5:18-cv-06045;
- *PersonalWeb Technologies, LLC et al. v. Optimizely, Inc.*, No. 5:18-cv-06614; and
- *PersonalWeb Technologies, LLC et al. v. Hootsuite Inc.*, No. 5:18-cv-06615.

6. Any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

Not applicable.

October 23, 2020

FENWICK & WEST LLP

By: /s/ J. David Hadden
J. David Hadden

*Counsel for Intervenors
Amazon.com, Inc., Amazon Web
Services, Inc.*

CERTIFICATE OF INTEREST

For Defendants-Appellees Patreon, Inc., Dictionary.com, LLC, Vox Media, Inc., Vice Media, LLC, Oath Inc., BuzzFeed, Inc., Popsugar Inc. and Ziff Davis, LLC

Counsel for Defendants-Appellees Patreon, Inc., Dictionary.com, LLC, Vox Media, Inc., Vice Media, LLC, Oath, Inc., BuzzFeed, Inc., Popsugar, Inc. and Ziff Davis, LLC certify the following under Federal Circuit Rule 47.4:

1. The full names of all entities represented by undersigned counsel in this case:

Patreon, Inc., Dictionary.com, LLC, Vox Media, Inc., Vice Media, LLC, Oath, Inc., BuzzFeed, Inc., Popsugar, Inc. and Ziff Davis, LLC

2. The full names of all real parties in interest for the entities (if the entities named are not the real parties in interest):

As indicated in Item 1.

3. All parent corporations for the entities and any publicly held companies that own 10 percent or more of the stock for the entities:

Patreon, Inc.: Patreon, Inc. has no parent corporation and no publicly held corporation is known to own 10% or more of its stock.

Dictionary.com, LLC: Dictionary.com, LLC is wholly owned by Dictionary Holdco LLC, which in turn is wholly owned by Rock Holdings, Inc.

Vox Media, Inc.: NBCUniversal Media, LLC, a wholly-owned indirect subsidiary of Comcast Corporation, owns more than 10% of Vox Media, Inc.

Vice Media, LLC: Vice Media, LLC is wholly owned by Vice Holding, Inc., which is wholly owned by Vice Group Holding Inc. The Walt Disney Company indirectly owns more than 10% of Vice Group Holding Inc.

Oath Inc.: Oath Inc. is a wholly owned subsidiary of Verizon Communications Inc.

Buzzfeed, Inc.: NBCUniversal Media, LLC, a wholly-owned indirect subsidiary of Comcast Corporation, owns more than 10% of BuzzFeed, Inc.

Popsguar Inc.: Popsugar Inc. has no parent corporation and no publicly held corporation is known to own 10% or more of its stock.

Ziff Davis, LLC: Ziff Davis, LLC is a wholly owned subsidiary of j2 Global, Inc.

4. All law firms, partners, and associates that appeared for the entities in the originating court or agency or are expected to appear in this court for the entities that have not already entered an appearance:

For Patreon, Inc., Dictionary.com, LLC, Vox Media, Inc., Vice Media, LLC, Oath, Inc., BuzzFeed, Inc., and Ziff Davis, LLC: None

For Popsugar, Inc.: Chieh Tung of Fenwick & West LLP.

5. The case titles and numbers of any case known 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 following cases in the United States District Court, District of Northern California, will be directly affected by this Court's decision in the appeal:

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- *PersonalWeb Technologies, LLC et al. v. Airbnb, Inc.*, No. 5:18-cv-00149;
- *PersonalWeb Technologies, LLC et al. v. Amicus FTW, Inc.*, No. 5:18-cv-00150;
- *PersonalWeb Technologies, LLC et al. v. Atlassian, Inc.*, No. 5:18-cv-00154;
- *PersonalWeb Technologies, LLC et al. v. Cloud 66, Inc.*, No. 5:18-cv-00155;
- *PersonalWeb Technologies, LLC et al. v. Curebit, Inc.*, No. 5:18-cv-00156;
- *PersonalWeb Technologies, LLC et al. v. Doximity, Inc.*, No. 5:18-cv-00157;
- *PersonalWeb Technologies, LLC et al. v. Fandor, Inc.*, No. 5:18-cv-00159;
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- *PersonalWeb Technologies, LLC et al. v. GoPro, Inc.*, No. 5:18-cv-00161;
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- *PersonalWeb Technologies, LLC et al. v. Leap Motion, Inc.*, No. 5:18-cv-00163;
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- *PersonalWeb Technologies, LLC et al. v. MyFitnessPal, Inc.*, No. 5:18-cv-00166;

- *PersonalWeb Technologies, LLC et al. v. Quotient Technology, Inc.*, No. 5:18-cv-00169;
- *PersonalWeb Technologies, LLC et al. v. Reddit, Inc.*, No. 5:18-cv-00170;
- *PersonalWeb Technologies, LLC et al. v. Roblox Corp.*, No. 5:18-cv-00171;
- *PersonalWeb Technologies, LLC et al. v. Stitchfix, Inc.*, No. 5:18-cv-00173;
- *PersonalWeb Technologies, LLC et al. v. Teespring, Inc.*, No. 5:18-cv-00175;
- *PersonalWeb Technologies, LLC et al. v. Tophatter, Inc.*, No. 5:18-cv-00176;
- *PersonalWeb Technologies, LLC et al. v. Venmo, Inc.*, No. 5:18-cv-00177;
- *PersonalWeb Technologies, LLC et al. v. Webflow, Inc.*, No. 5:18-cv-00178;
- *PersonalWeb Technologies, LLC et al. v. Square, Inc.*, No. 5:18-cv-00183;
- *PersonalWeb Technologies, LLC et al. v. Vend, Inc. et al.*, No. 5:18-cv-00196;
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- *PersonalWeb Technologies, LLC et al. v. Spokeo, Inc.*, No. 5:18-cv-02140;
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- *PersonalWeb Technologies, LLC et al. v. MWM My Wedding Match Ltd.*, No. 5:18-cv-03457;
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- *PersonalWeb Technologies, LLC et al. v. WeddingWire, Inc.*, No. 5:18-cv-03463;
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- *PersonalWeb Technologies, LLC et al. v. Blue Apron, LLC*, No. 5:18-cv-03573;
- *PersonalWeb Technologies, LLC et al. v. Centaur Media USA, Inc. et al.*, No. 5:18-cv-03577;
- *PersonalWeb Technologies, LLC et al. v. Fab Commerce & Design, Inc.*, No. 5:18-cv-03578;
- *PersonalWeb Technologies, LLC et al. v. Food52, Inc.*, No. 5:18-cv-03579;
- *PersonalWeb Technologies, LLC et al. v. Panjiva, Inc.*, No. 5:18-cv-03580;
- *PersonalWeb Technologies, LLC et al. v. FanDuel Inc. et al.*, No. 5:18-cv-03582;
- *PersonalWeb Technologies, LLC et al. v. RocketHub, Inc. et al.*, No. 5:18-cv-03583;
- *PersonalWeb Technologies, LLC et al. v. Spongecell, Inc.*, No. 5:18-cv-03584;
- *PersonalWeb Technologies, LLC et al. v. Kickstarter, PBC*, No. 5:18-cv-03997;
- *PersonalWeb Technologies, LLC et al. v. Cloud Warmer Inc.*, No. 5:18-cv-03998;

- *PersonalWeb Technologies, LLC et al. v. Atlas Obscura, Inc.*, No. 5:18-cv-04037;
- *PersonalWeb Technologies, LLC et al. v. Braze, Inc.*, No. 5:18-cv-04624;
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- *PersonalWeb Technologies, LLC et al. v. Peek Travel, Inc.*, No. 5:18-cv-04628;
- *PersonalWeb Technologies, LLC et al. v. Cars.com, LLC*, No. 5:18-cv-05195;
- *PersonalWeb Technologies, LLC et al. v. Curious.com, Inc.*, No. 5:18-cv-05198;
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- *PersonalWeb Technologies, LLC et al. v. NRT LLC et al.*, No. 5:18-cv-05201;
- *PersonalWeb Technologies, LLC et al. v. ShareFile LLC*, No. 5:18-cv-05202;
- *PersonalWeb Technologies, LLC et al. v. StartDate Labs, Inc.*, No. 5:18-cv-05203;
- *PersonalWeb Technologies, LLC et al. v. Tastytrade, Inc.*, No. 5:18-cv-05204;
- *PersonalWeb Technologies, LLC et al. v. Treehouse Island, Inc.*, No. 5:18-cv-05205;
- *PersonalWeb Technologies, LLC et al. v. Valassis Communications, Inc.*, No. 5:18-cv-05206;
- *PersonalWeb Technologies, LLC et al. v. Wework Companies Inc.*, No. 5:18-cv-05272;
- *PersonalWeb Technologies, LLC et al. v. Dollar Shave Club*, No. 5:18-cv-05373;
- *PersonalWeb Technologies, LLC et al. v. Brooklyn Brewery Corp.*, No. 5:18-cv-05436;
- *PersonalWeb Technologies, LLC et al. v. Goodreads LLC*, No. 5:18-cv-05595;
- *PersonalWeb Technologies, LLC et al. v. Imgur, Inc.*, No. 5:18-cv-05596;
- *PersonalWeb Technologies, LLC et al. v. Slack Technologies, Inc.*, No. 5:18-cv-05600;
- *PersonalWeb Technologies, LLC et al. v. Intuit Inc.*, No. 5:18-cv-05611;
- *PersonalWeb Technologies, LLC et al. v. Twitch Interactive, Inc.*, No. 5:18-cv-05619;
- *PersonalWeb Technologies, LLC et al. v. Upwork Global Inc.*, No. 5:18-cv-05624;
- *PersonalWeb Technologies, LLC et al. v. Zoom Video Communications, Inc.*, No. 5:18-cv-05625;
- *PersonalWeb Technologies, LLC et al. v. RetailMeNot, Inc.*, No. 5:18-cv-05966;
- *PersonalWeb Technologies, LLC et al. v. Trip Advisor LLC*, No. 5:18-cv-05967;
- *PersonalWeb Technologies, LLC et al. v. Urban Dictionary, LLC*, No. 5:18-cv-05968;
- *PersonalWeb Technologies, LLC et al. v. Vimeo, Inc.*, No. 5:18-cv-06042;
- *PersonalWeb Technologies, LLC et al. v. Trello, Inc.*, No. 5:18-cv-06043;
- *PersonalWeb Technologies, LLC et al. v. Stack Exchange, Inc.*, No. 5:18-cv-06045;

- *PersonalWeb Technologies, LLC et al. v. Optimizely, Inc.*, No. 5:18-cv-06614; and
- *PersonalWeb Technologies, LLC et al. v. Hootsuite Inc.*, No. 5:18-cv-06615.

6. Any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

Not applicable.

October 23, 2020

FENWICK & WEST LLP

By: /s/ J. David Hadden

J. David Hadden

*Counsel for Intervenors
Amazon.com, Inc., Amazon Web
Services, Inc.*

TABLE OF CONTENTS

	Page
CERTIFICATES OF INTEREST -----	i
TABLE OF CONTENTS-----	x
TABLE OF AUTHORITIES -----	xi
INTRODUCTION-----	1
ARGUMENT -----	2
I. THE PANEL CORRECTLY APPLIED CLAIM PRECLUSION TO BAR PERSONALWEB FROM RE-ASSERTING THE SAME CLAIMS.-----	2
A. The panel did not need to compare PersonalWeb’s infringement theories because PersonalWeb accused the same product in both cases. -----	3
B. PersonalWeb’s claim preclusion arguments are foreclosed by the record, which shows it expressly accused both the multipart upload and cache control features of Amazon S3 in the original case.-----	7
II. THE PANEL CORRECTLY APPLIED <i>KESSLER</i> PRECLUSION TO BAR CLAIMS ARISING AFTER THE ORIGINAL JUDGMENT. -----	10
A. Every decision of this Court to consider the question has rejected the argument that <i>Kessler</i> preclusion applies only to issues litigated and decided in a prior action.-----	10
B. PersonalWeb’s assorted “policy” arguments do not warrant rehearing. -----	13
CONCLUSION-----	16
CERTIFICATE OF SERVICE -----	17
CERTIFICATE OF COMPLIANCE -----	18

TABLE OF AUTHORITIES

CASES	PAGE(S)
<i>Abbey v. Mercedes Benz of N. Am., Inc.</i> , 138 F. App'x 304 (Fed. Cir. 2005)-----	6
<i>Acumed LLC v. Stryker Corp.</i> , 525 F.3d 1319 (Fed. Cir. 2008)-----	passim
<i>Ashcroft v. Iqbal</i> , 556 U.S. 662 (2009)-----	6
<i>Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.</i> , 672 F.3d 1335 (Fed. Cir. 2012)-----	5, 6
<i>Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation</i> , 402 U.S. 313 (1971)-----	13
<i>Brain Life, LLC v. Elekta Inc.</i> , 746 F.3d 1045 (Fed. Cir. 2014)-----	4, 10, 11, 16
<i>D-Beam v. Roller Derby Skate Corp.</i> , 316 F. App'x 966 (Fed. Cir. 2008)-----	6
<i>e.Digital Corp. v. Futurewei Techs., Inc.</i> , 772 F.3d 723 (Fed. Cir. 2014)-----	14
<i>Foster v. Hallco Mfg. Co.</i> , 947 F.2d 469 (Fed. Cir. 1991)-----	5
<i>Grasty v. U.S. Patent & Trademark Office</i> , 211 F. App'x 952 (Fed. Cir. 2007)-----	6
<i>In re PersonalWeb, Techs., LLC</i> , Case No. 5:18-md-02834 (N.D. Cal. Oct. 6, 2020)-----	9
<i>Kessler v. Eldred</i> , 206 U.S. 285 (1907)-----	passim
<i>Mars Inc. v. Nippon Conlux Kabushiki-Kaisha</i> , 58 F.3d 616 (Fed. Cir. 1995)-----	6
<i>Molinaro v. Am. Tel. & Tel. Co.</i> , 460 F. Supp. 673 (E.D. Pa. 1978), <i>aff'd</i> , 620 F.2d 288 (3d Cir. 1980)-----	12
<i>Nystrom v. Trex Co.</i> , 580 F.3d 1281 (Fed. Cir. 2009)-----	5
<i>Senju Pharm. Co. v. Apotex Inc.</i> , 746 F.3d 1344 (Fed. Cir. 2014)-----	3, 6

SimpleAir, Inc. v. Google LLC,
884 F.3d 1160 (Fed. Cir. 2018)-----4, 15

Sowinski v. California Air Res. Bd.,
971 F.3d 1371 (Fed. Cir. 2020), *pet. for reh'g en banc denied*,
Oct. 23, 2020 (No. 019-1558)----- 11

SpeedTrack, Inc. v. Office Depot, Inc.,
791 F.3d 1317 (Fed. Cir. 2015)-----*passim*

Young Engineers, Inc. v. U.S. Int'l Trade Comm'n,
721 F.2d 1305 (Fed. Cir. 1983)----- 15

STATUTES AND RULES

Fed. R. Civ. P. 41----- 14

INTRODUCTION

PersonalWeb sued Amazon and its customer Dropbox almost nine years ago in the Eastern District of Texas, alleging infringement by Amazon's Simple Storage Service, or "S3." PersonalWeb voluntarily dismissed those claims with prejudice. Years later, after the patents expired, PersonalWeb sued more than eighty Amazon customers alleging infringement of the same patents based on their use of the same Amazon S3 technology. The district court presiding over these cases in multidistrict litigation held that claim preclusion and the *Kessler* doctrine barred PersonalWeb from relitigating these claims. A unanimous panel from this Court affirmed.

In its first holding, the panel ruled that claim preclusion barred PersonalWeb's claims through the date of the final judgment in Texas because PersonalWeb accused the same Amazon S3 product of infringing the same patents, and it was undisputed that the operation of Amazon S3 had not changed since the first lawsuit. The panel made no error in this assessment. Nor did the panel misapply the test for determining whether an accused product is "*essentially* the same" as the product accused in a prior lawsuit, as PersonalWeb argues, because the panel had no need to reach that question. The panel ruled also that the differences between two Amazon S3 features that PersonalWeb identified were irrelevant, because PersonalWeb had accused both features in the original lawsuit.

The panel next held that *Kessler* preclusion barred PersonalWeb's claims

arising after the final judgment in Texas. *Kessler* preclusion originated to fill a gap between claim and issue preclusion and shares aspects of both doctrines. Seizing on that fact, PersonalWeb argues that, like issue preclusion, *Kessler* should require a specific ruling of non-infringement from the first court and not just a dismissal with prejudice. But every decision of this Court to consider this question has held that *Kessler* preclusion does not require a specific issue to have been decided, much less necessary to support the prior judgment.

The record below is an especially poor vehicle to revisit those decisions. PersonalWeb actually, fully and fairly litigated the issue of infringement in the prior Texas case—resulting in a *Markman* order that had the same practical effect as an order granting summary judgment. True, PersonalWeb voluntarily dismissed its case. But that is a distinction without any real difference. Nothing in *Kessler* or its progeny suggests that a litigant may resuscitate claims that have been fully and fairly litigated, and then rejected on the merits, simply because the plaintiff beats the district judge to the clerk’s office—voluntarily dismissing its case before final judgment can be entered. The Court should deny the petition.

ARGUMENT

I. THE PANEL CORRECTLY APPLIED CLAIM PRECLUSION TO BAR PERSONALWEB FROM RE-ASSERTING THE SAME CLAIMS.

This case did not present a difficult question of claim preclusion. PersonalWeb asserted the same patents against Amazon S3 in both the original

Texas case and in its new ones against Amazon’s customers. PersonalWeb still argued that it had not accused the “same product or process.” Opinion (“Op”) at 17. It claimed that it had accused only the “multipart upload” feature of Amazon S3, while in the new customer cases it accused a feature it called “cache control.” These different features, it argued in turn, constitute different products or processes for purposes of claim preclusion. *See id.*

The panel rejected this argument for two straightforward reasons: (1) PersonalWeb’s argument showed at most that it was asserting a new infringement *theory* against the same *product*—a theory that PersonalWeb could have asserted in the first case, and thus was merged into and barred by the prior dismissal (Op19); and (2) PersonalWeb’s supposedly new theory was in fact old, having been expressly advanced in the original case (Op17-19). The panel’s reasoning is correct and creates no conflict in this Circuit’s precedent.

A. The panel did not need to compare PersonalWeb’s infringement theories because PersonalWeb accused the same product in both cases.

When a cause of action is resolved by a judgment on the merits, claim preclusion bars a plaintiff from relitigating it in a second lawsuit. *Senju Pharm. Co. v. Apotex Inc.*, 746 F.3d 1344, 1348 (Fed. Cir. 2014) (quoting *Lawlor v. Nat’l Screen Serv. Corp.*, 349 U.S. 322, 326 (1955)). In the patent infringement context, the doctrine bars reasserting the same patent rights against the same or essentially the same product or process. *Acumed LLC v. Stryker Corp.*, 525 F.3d 1319, 1324 (Fed.

Cir. 2008); *SimpleAir, Inc. v. Google LLC*, 884 F.3d 1160, 1165 (Fed. Cir. 2018). Two products or processes are “essentially the same” where “the differences between them are merely ‘colorable’ or ‘unrelated to the limitations in the claim of the patent.’” *Acumed*, 525 F.3d at 1324.

Here, PersonalWeb accused the same Amazon S3 product that it accused in the original case, and thus PersonalWeb’s infringement *theories* related to that product were all merged and barred. Op19. Claim preclusion bars relitigating not only the legal theories that were brought in the earlier lawsuit, but also those that could have been brought. Op15 (citing *Lucky Brand Dungarees, Inc. v. Marcel Fashions Grp., Inc.*, 140 S. Ct. 1589, 1594-95 (2020); *Brain Life, LLC v. Elekta Inc.*, 746 F.3d 1045, 1053 (Fed. Cir. 2014)). PersonalWeb was therefore not entitled to cleave off specific infringement theories about Amazon S3 that were available during the first lawsuit to save them for future cases. Op19; *see also* Op17.

PersonalWeb contends that, under *Acumed*, the panel needed to compare differences in PersonalWeb’s infringement theories to the claim limitations to determine whether it had accused “essentially the same” product or process as in Texas. Petition (“Pet”) at 15-16. This argument is irrelevant, as it rests on alleged differences between two aspects of S3 that the panel concluded were both accused in the first lawsuit. But PersonalWeb’s argument is still incorrect.

Acumed concerned a patent for an orthopedic nail that treated bone fractures.

525 F.3d at 1322. The plaintiff originally sued the defendant over its “T2 PHN” nail. *Id.* During that suit, the plaintiff learned that the defendant had developed a different version of the nail, the “T2 Long.” *Id.* When the plaintiff later accused the T2 Long of infringing the same patent, the district court held that claim preclusion barred the suit. *Id.* This Court reversed. Claim preclusion bars re-asserting the same cause of action, *i.e.*, one that arises from the same transactional facts. *Id.* at 1326. Accused devices must be “essentially the same” for it to be said that infringement claims against them concern the same transactional facts. *Id.* at 1326-27. Because the T2 Long was different in a way material to the infringement analysis, the infringement claims against it were not precluded. *Id.*

Acumed thus explained how to determine whether infringement claims against two different accused devices were the “same” claim for purposes of claim preclusion. *See also Foster v. Hallco Mfg. Co.*, 947 F.2d 469, 480 (Fed. Cir. 1991).¹ This case does not present that question because only one accused product was ever at issue. PersonalWeb’s original complaint alleged infringement through the “manufacture, use, sale, importation, and/or offer for sale of the Amazon S3 product.” Op19. And it was undisputed that nothing material about Amazon S3 or

¹ PersonalWeb also cites *Nystrom v. Trex Co.*, 580 F.3d 1281 (Fed. Cir. 2009), but this Court has clarified that decision is better understood as applying issue preclusion. *See Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d 1335, 1343 (Fed. Cir. 2012).

its operation changed after the first lawsuit. As the panel ultimately concluded, then, there was no need to compare Amazon S3 to itself. *Id.* This ruling tracks that of other panels of this Court, which have observed that asking whether products are “essentially the same” is unnecessary where no new accused product is at issue. *See D-Beam v. Roller Derby Skate Corp.*, 316 F. App’x 966, 969 (Fed. Cir. 2008); *see also Senju Pharm.*, 746 F.3d at 1350; *Abbey v. Mercedes Benz of N. Am., Inc.*, 138 F. App’x 304, 307 (Fed. Cir. 2005).

PersonalWeb argues that defining the “transactional facts” by looking to the product named in the complaint is improper. Pet15. But this Court has affirmed claim preclusion rulings at the motion to dismiss stage that turned solely on a comparison of the pleadings. *E.g., Grasty v. U.S. Patent & Trademark Office*, 211 F. App’x 952, 953-54 (Fed. Cir. 2007). Such a practice is fair because the plaintiff is the master of its pleadings. When the plaintiff has foreclosed the claims through its own drafting, there is no reason to allow the case to proceed.

PersonalWeb filed its original complaint in December 2011. But the above point applies with equal force to complaints preceding *Ashcroft v. Iqbal*, 556 U.S. 662 (2009). The same patent may not be asserted twice against the same product or process, and a plaintiff may not sue on a selection of claims from a patent and then, after losing, bring a new suit on the omitted claims. *See Mars Inc. v. Nippon Conlux Kabushiki-Kaisha*, 58 F.3d 616, 619 (Fed. Cir. 1995); *Aspex*, 672 F.3d at

1341. Given that, where two lawsuits admittedly concern the same accused product, the allegations offered to satisfy *Iqbal*—*i.e.*, the explanation of *how* the same technology meets each claim limitation—are irrelevant. They relate only to the plaintiff’s *theory of liability* and do not introduce any new or different transactional facts. *See id.*; *see also Acumed*, 525 F.3d at 1326. But again, this case does not turn on these arguments, because the panel looked beyond the complaint to confirm that both the same product and its same functions were accused in both cases. Op13-14, 18.

B. PersonalWeb’s claim preclusion arguments are foreclosed by the record, which shows it expressly accused both the multipart upload and cache control features of Amazon S3 in the original case.

The panel’s application of claim preclusion is uncontroversial. But what makes the issue particularly inappropriate for rehearing is that the panel ruled also that PersonalWeb’s arguments have no factual support in the record. PersonalWeb argued that in the first case it had accused only the multipart upload feature of Amazon S3, not the feature it now calls “cache control.” As the panel recognized (Op18-19), this was akin to a shell game. Of course, PersonalWeb’s complaint never distinguished between these features. And in all events, PersonalWeb in fact previously accused the same HTTP function—what PersonalWeb would later call “cache control” PersonalWeb had earlier called “conditional operations.”

Amazon S3 provides web-based storage using the Hypertext Transfer Protocol (HTTP) standard. *See* Resp. Br. at 4-5. For each file it stores, S3 applies a

function to the data in the file to create an “ETag.”² In the accused operation, the ETag is used to determine whether a remote computer has the current version of the file. To do so, the remote computer sends a request (a GET request that includes a conditional parameter called an “If-None-Match” header) and the ETag value for its local file, which S3 then compares to the ETag for the version on the S3 server. *See id.* at 7. Here, the asserted patents are directed to locating and controlling access to files in a computer system by using names computed from the data in a file. In PersonalWeb’s infringement theory, the ETag is the name and the conditional operation (*i.e.*, the conditional GET request) is the process that allegedly uses the name to locate and control access to files.³

The panel held correctly that PersonalWeb accused the same function in the first suit. PersonalWeb represented to the Texas court that “the accused functionalities of S3 include but are not limited to its ‘multipart upload’ feature *and* ‘conditional operations.’” Op10 (quoting Appx2045, emphasis added). And PersonalWeb’s infringement contentions from that case accused the same use of

² In the multipart upload feature, a large file is uploaded in several parts. S3 creates ETags for each uploaded part as well as one for the complete file. Resp. Br. at 11.

³ PersonalWeb asserted this same theory also against Amazon CloudFront and the website of Twitch Interactive, Inc., and the district court granted summary judgment of non-infringement. That order is currently on appeal. *See In re PersonalWeb, Techs., LLC*, Nos. 20-1566, 20-1568, 20-1569.

conditional GET requests with ETags from the HTTP specification described above. *Id.*; *see also* Appx3212; Appx352; Appx354.

PersonalWeb next argues that while its first lawsuit may have accused these conditional operations generally, it did not include operations that included “If-None-Match” headers or that involved downloading. Pet14-16. These arguments are part of the same tactic of emphasizing different words to make the same accused process appear different. PersonalWeb accused conditional operations using “If-None-Match” headers in its original lawsuit. *See* Appx3212 (infringement contentions accusing GET request using “If-None-Match”); *see also* Appx2050 (written discovery requesting related documents); Appx361 (requesting related deposition testimony). And PersonalWeb asserted claims that expressly require downloading. Appx19, citing Appx806 (asserting ’310 patent, claim 24). The panel correctly held there is no factual support for PersonalWeb’s argument against claim preclusion, because PersonalWeb accused Amazon S3’s same use of conditional operations in the Texas case that ended in a final adverse judgment.⁴

⁴ The district court awarded attorney fees based in part on evidence that PersonalWeb witnesses knew that it had accused the same conditional operations in Texas but testified otherwise. *See In re PersonalWeb, Techs., LLC*, Case No. 5:18-md-02834, (N.D. Cal. Oct. 6, 2020) at 29:1-10 (finding it “implausible” that PersonalWeb’s principal “was unaware of the involvement of “conditional GET” allegations” and that related testimony was “uncorroborated and self-serving”); *see also id.* at 27:3-29:23.

II. THE PANEL CORRECTLY APPLIED *KESSLER* PRECLUSION TO BAR CLAIMS ARISING AFTER THE ORIGINAL JUDGMENT.

Under the *Kessler* doctrine, “a party who obtains a final adjudication in its favor obtains ‘the right to have that which it lawfully produces freely bought and sold without restraint or interference.’” *SpeedTrack, Inc. v. Office Depot, Inc.*, 791 F.3d 1317, 1323 (Fed. Cir. 2015) (quoting *Rubber Tire Wheel Co. v. Goodyear Tire & Rubber Co.*, 232 U.S. 413, 418 (1914)). Here, the parties disputed whether PersonalWeb’s voluntary dismissal with prejudice was a judgment on the merits such that Amazon should be treated as an “adjudicated non-infringer” for *Kessler* preclusion to attach. PersonalWeb argues that, like issue preclusion, *Kessler* should require a specific non-infringement ruling from the first court for a prior judgment to have preclusive effect. But this Court has never understood *Kessler* as a species of issue preclusion. Instead, it is a “gap filler” doctrine enlarging the protections of both claim and issue preclusion, with its own justification and requirements. *Brain Life*, 746 F.3d at 1056. And as the panel observed, the Federal Circuit has “treated the *Kessler* doctrine as a close relative to claim preclusion, without its temporal limitation, rather than as an early version of non-mutual collateral estoppel, as PersonalWeb characterizes it.” Op21.

A. Every decision of this Court to consider the question has rejected the argument that *Kessler* preclusion applies only to issues litigated and decided in a prior action.

Every panel of this Circuit that has considered a similar question has ruled consistently with the panel here. In *Brain Life*, the original suit ended in a judgment

of non-infringement of the asserted apparatus claims. 746 F.3d at 1049-50. The Court held that *Kessler* barred an exclusive licensee from asserting the method claims from the patent against the same devices, even though those claims were not previously litigated. *Id.* at 1055-59. Because of the judgment, the accused products “acquired the status of non-infringing products as to the [asserted] patent, *i.e.*, all claims that were *brought or could have been brought* in the first suit.” *Id.* at 1059-60 (emphasis added). Similarly, in *SpeedTrack*, the patentee sued for infringement and lost on summary judgment. 791 F.3d at 1319. The Court held that *Kessler* barred a later suit against customers asserting a doctrine of equivalents theory not previously litigated. *Id.* at 1321. The original defendant had a right that its customers should “be let alone” by the plaintiff. *Id.* at 1325.

PersonalWeb observes that in these two cases there was a finding of non-infringement on *some* theory underlying the original judgment. But that makes no difference. A final judgment is treated as an adjudication of the merits whether it rests on a voluntary dismissal with prejudice or a specific infringement finding. Regardless, *Kessler* operates to bar litigation of issues that could have been but were not decided in the prior lawsuit. For example, in *Sowinski v. California Air Res. Bd.*, 971 F.3d 1371, 1373 (Fed. Cir. 2020), *pet. for reh’g en banc denied*, Oct. 23, 2020 (No. 019-1558), the Court held that a dismissal based on the plaintiff’s failure to respond to a motion to dismiss precluded the plaintiff from asserting the same

claims as to conduct after the original judgment. The Court did not require a specific non-infringement ruling in the original suit that ended in a final judgment; it was sufficient that the plaintiff had the opportunity to pursue its claims. *Id.* at 1376. The only other court to consider this issue held similarly: A final judgment gives rise to *Kessler* preclusion irrespective of the specific infringement theories raised or adjudicated. *See Molinaro v. Am. Tel. & Tel. Co.*, 460 F. Supp. 673, 676 (E.D. Pa. 1978), *aff'd*, 620 F.2d 288 (3d Cir. 1980).

Put another way, it is unremarkable when claim preclusion bars past disputes even when no issue was actually decided in the past dispute. That result does not become remarkable, much less unfair, when *Kessler* bars future disputes about the same product under the identical circumstances. If claim preclusion does not require issues to be actually decided, then neither should *Kessler*—the only distinction between the two doctrines is temporal, not substantive. Indeed, extending claim preclusion’s temporal reach was one of the very purposes of *Kessler*. Claim preclusion and *Kessler* were intended to be symmetrical in scope, and there is no policy reason, much less textual support, for treating the two doctrines differently.

Were *Kessler* concerned only with issue preclusion, the Supreme Court could have identified the mutuality of estoppel rule as the problem it sought to address. It did not. Instead, the Court sought to curb abusive customer litigation and the “diminish[ed] ... opportunities for sale” caused because “[n]o one wishes to buy

anything if with it he must buy a law suit.” *Kessler v. Eldred*, 206 U.S. 285, 289 (1907). It noted that the prior judgment “must be recognized in every way” and the supplier who prevailed must have “the right to sell his wares freely, without hindrance...” *Id.* The *Kessler* Court therefore did not limit the preclusive effect to issues actually decided in the original suit; instead, the Court held that the final judgment “settled finally and everywhere” the right *to sell the accused product*. *Id.* In other words, *Kessler* did not just abrogate the strict mutuality-of-parties rule. It also allowed a customer to assert preclusion of un-litigated issues even where the customer was not in privity with the manufacturer, or where the conduct at issue occurred after the original judgment. *See Speedtrack*, 791 F.3d at 1328.

Moreover, if *Kessler* was intended to address only the mutuality of estoppel rule, then the Supreme Court’s decision in *Blonder–Tongue Laboratories, Inc. v. University of Illinois Foundation*, 402 U.S. 313, 349 (1971) (authorizing non-mutual collateral estoppel) would have made *Kessler* unnecessary. But as this Court has noted, the Supreme Court “does not normally overturn, or so dramatically limit, earlier authority sub silentio,” and *Blonder–Tongue* did not so much as mention, much less criticize *Kessler*. *See SpeedTrack*, 791 F.3d at 1328 (quoting *Shalala v. Ill. Council on Long Term Care, Inc.*, 529 U.S. 1, 18 (2000)).

B. PersonalWeb’s assorted “policy” arguments do not warrant rehearing.

PersonalWeb makes the hyperbolic claim that the panel’s opinion “does away

with” the doctrine of issue preclusion for non-infringement. Pet8-9. But that argument is refuted by this very case, in which PersonalWeb litigated its same infringement theory about the ETags and conditional GET requests against products *other* than Amazon S3. That was possible only because the Texas case was voluntarily dismissed with prejudice without a specific ruling of non-infringement, and thus issue preclusion did not prevent PersonalWeb from reasserting its theory. Likewise, non-infringement may be established through issue preclusion where a claim construction from an earlier lawsuit forecloses the plaintiff’s infringement theory against a new defendant. *See Digital Corp. v. Futurewei Techs., Inc.*, 772 F.3d 723, 727 (Fed. Cir. 2014) (collateral estoppel applies to claim constructions).

As the panel recognized (Op25), the *Kessler* doctrine does not interfere with the ability of parties to settle patent litigation. Parties can always agree to limit the preclusive effect of a dismissal. *Id.* (citing *Hallco Mfg. Co. v. Foster*, 256 F.3d 1290, 1295 (Fed. Cir. 2001); *Pactiv Corp. v. Dow Chem. Co.*, 449 F.3d 1227, 1231 (Fed. Cir. 2006)). Moreover, the federal rules already embody a policy judgment about when a plaintiff should be able to dismiss its claims unilaterally without preclusive effect, including giving the district court discretion to grant that relief as appropriate. Fed. R. Civ. P. 41(a)(1)-(2). A plaintiff that loses confidence in its ability to prevail after forcing the district court to preside over its infringement claims through claim construction is not such a party. And here, of course, the result PersonalWeb seeks

is even more drastic. It suggests that a patent plaintiff, after becoming unimpressed with the potential recovery at stake in a case, may dismiss the case *with prejudice* only to wait and see if the accused product becomes commercially more successful or, worse still, decide that more money can be made by suing eighty customers instead of the manufacturer.⁵

PersonalWeb argues that the panel created a new claim preclusion rule for patent cases that conflicts with other claim preclusion precedent. But the panel carefully distinguished its claim preclusion and *Kessler* doctrine holdings. Op21. This Circuit has expressed the view that claim preclusion applies to bar claims arising from conduct before the original judgment (but not afterwards), while *Kessler* preclusion may bar claims arising from the same conduct after the original judgment (but not before). *See, e.g., SimpleAir*, 884 F.3d at 1165. The panel's opinion does not disturb that view.

Similarly, the panel's opinion does not contradict the Supreme Court's preference for consistency between patent law and other areas. Pet13. Here, the Supreme Court itself created the *Kessler* doctrine. Irrespective of the panel's

⁵ This aspect of the panel's decision does not conflict with *Young Engineers, Inc. v. U.S. Int'l Trade Comm'n*, 721 F.2d 1305 (Fed. Cir. 1983). *See* Pet12. *Young Engineers* considered only whether claim preclusion barred ITC claims arising after the original final judgment and in absence of any showing that the accused devices were the same as in the original suit. *Id.* at 1316.

opinion, the doctrine is distinct from both claim and issue preclusion, and it applies to acts after the prior judgment, but without requiring that judgment rest on a ruling about the infringement theory asserted in the new lawsuit. *See, e.g., Brain Life*, 746 F.3d at 1059; *Speedtrack*, 791 F.3d at 1328-29. If this departs from the preclusion rules for non-patent cases, this Court “must follow *Kessler* unless and until the Supreme Court overrules it.” *SpeedTrack*, 791 F.3d at 1329.⁶

CONCLUSION

For these reasons, the Court should deny the petition for rehearing.

October 23, 2020

FENWICK & WEST LLP

By: /s/ J. David Hadden
J. David Hadden

*Counsel for Defendant-Appellees
and Intervenors*

⁶ The Supreme Court recently declined to review this Court’s approach to *Kessler* preclusion. *See SpeedTrack, Inc. v. Office Depot, Inc.*, 136 S. Ct. 801 (2016).

CERTIFICATE OF SERVICE

The undersigned certifies that a complete copy of this **RESPONSE OF DEFENDANTS-APPELLEES AND INTERVENORS TO COMBINED PETITION OF PERSONALWEB TECHNOLOGIES, LLC FOR PANEL REHEARING AND REHEARING EN BANC** was served on all counsel in this action via CM/ECF delivery, on October 23, 2020.

FENWICK & WEST LLP

By: /s/ J. David Hadden
J. David Hadden

*Counsel for Defendant-Appellees
and Intervenors*

CERTIFICATE OF COMPLIANCE

1. This brief complies with the type volume limitation of Federal Circuit Rule 32(a). This brief contains 3,900 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(f) and Federal Circuit Rule 32(b).

2. The brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Civil Procedure 32(a)(6). The brief has been prepared in a proportionally spaced typeface using Microsoft Office Word Version 2010 in 14-point Times New Roman.

October 23, 2020

FENWICK & WEST LLP

By: /s/ J. David Hadden
J. David Hadden

*Counsel for Defendant-Appellees
and Intervenors*