

2021-153

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

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**IN RE: DMF, INC., A CALIFORNIA CORPORATION,  
*Petitioner.***

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On Petition for a Writ of Mandamus to  
the United States District Court for the Central District of California  
in Case No. 2:18-CV-07090 CAS (GJSx),  
Senior Judge Christina A. Snyder

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**PETITIONER DMF INC.'S  
COMBINED PETITION FOR PANEL REHEARING AND REHEARING EN BANC**

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October 12, 2021

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## Certificate of Interest

Counsel for Petitioner DMF, Inc. certifies the following:

- 1. Represented Entities.** The full name of every Party represented by me. Fed. Cir. R. 47.4(a)(1).

  - DMF, Inc.
- 2. Real Party in Interest.** The name of Real Party in interest (Please only include any real party in interest NOT identified in Question 3) represented by me. Fed. Cir. R. 47.4(a)(2).

  - Not applicable.
- 3. Parent Corporations/Stockholders.** Parent corporations and publicly held companies that own 10% or more of stock in the party. Fed. Cir. R. 47.4(a)(3).

  - Not applicable.
- 4. Legal Representatives.** 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). Fed. Cir. R. 47.4(a)(4)

  - Not applicable
- 5. Related Cases.** 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).

  - *AMP Plus, Inc. dba Elco Lighting v. DMF, Inc.*, Nos. 21-1595, 21-1636 (Fed. Cir.) (appeal from inter partes review proceeding of patent-in-suit).
- 6. Organizational Victims and Bankruptcy Cases.** Provide 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).

  - None.

Dated: October 12, 2021

/s/   
David W. Long  
Attorney for Petitioner, DMF, Inc.

## Table of Contents

Certificate of Interest .....	i
Table of Authorities .....	iii
Table of Abbreviations.....	v
Federal Circuit Rule 35(b)(2) Statement of Counsel.....	vi
I. Pertinent Facts Necessary To Understand The Issues Presented .....	1
A. ‘266 Patent, Intra prior art and <i>plurality of elements</i> dispute .....	2
B. IPR and District Court Proceedings .....	5
II. Points of Law and Fact Overlooked By The Panel .....	8
III. Argument .....	9
A. <i>Schlagenhauf</i> mandamus review .....	10
B. First Factor: No adequate remedy absent mandamus review .....	12
C. Second Factor: Petitioner establishing legal right.....	14
D. Third Factor: Mandamus review appropriate under the circumstances .....	17
IV. Conclusion .....	18
Certificate of Compliance	
Certificate of Service	

**Table of Authorities**

**Cases**

*Amgen, Inc. v. Genetics Institute, Inc.*,  
98 F.3d 1328 (Fed. Cir. 1996) .....16

*Bogosian v. Gulf Oil Corp.*,  
738 F.2d 5587 (3d Cir. 1984) .....10

*Bourns, Inc. v. U.S.*,  
537 F.2d 486 (Ct. Cl. 1976).....15

*Cheney v. U.S. Dist. Ct. for D.C.*,  
542 U.S. 367 (2004).....9

*Digital Equipment Corp. v. Desktop Direct, Inc.*,  
511 U.S. 863 (1994)..... 8, 13

*In re BigCommerce, Inc.*,  
890 F.3d 978 (Fed. Cir. 2018) .....11

*In re Bulow*,  
828 F.3d 94 (2d Cir. 1987) .....10

*In re Cement Antitrust Litig.*,  
688 F.2d 1297 (9<sup>th</sup> Cir. 1982) .....10

*In re Cray Inc.*,  
871 F.3d 1355 (Fed. Cir. 2017) .....17

*In re Deutsche Bank Trust Co. Americas*,  
605 F.3d 1373 (Fed. Cir. 2010) .....11

*In re Google LLC*,  
949 F.3d 1338 (Fed. Cir. 2020) .....17

*In re Micron Tech., Inc.*,  
875 F.3d 1091 (Fed. Cir. 2017) .....11

*In re Queen’s Univ. at Kingston*,  
820 F.3d 1287 (Fed. Cir. 2016) .....11

*In re Regents of Univ. of Cal.*,  
497 F.3d 1360 (Fed. Cir. 2007) .....11

*In re U.S.*,  
669 F.3d 1333 (Fed. Cir. 2012) .....11

*La Buy v. Howes Leather Co.*,  
353 U.S. 249 (1957).....11

*Lighting Ballast Control LLC v. Philips Electronics North America Corp.*,  
744 F.3d 1271 (Fed. Cir. 2014) (*en banc*) .....18

*Medline Indus., Inc. v. C.R. Bard, Inc.*,  
Case No. 17-C-7216,  
2020 WL 512132 (N.D. Ill. Sep. 14, 2020) .....12

*Ohio Willow Wood Co. v. Alps South, LLC*,  
735 F.3d 1333 (Fed. Cir. 2013) .....16

*Schlagenhauf v. Holder*,  
379 U.S. 104 (1964).....10

*South Corp. v. United States*,  
690 F.2d 1368 (Fed. Cir. 1982) .....15

*Souverain Software LLC v. Victoria’s Secret Direct Brand Management, LLC*,  
778 F.3d 1311 (Fed. Cir. 2015) .....16

*Sporck v. Peil*,  
759 F.2d 312 (3d Cir. 1985) .....10

*SynQor, Inc. v. Vicor Corp.*,  
988 F.3d 1341 (Fed. Cir. 2021) .....16

*Wasica Finance GmbH v. Schrader Int’l, Inc.*,  
432 F. Supp. 3d 448 (D. Del. 2020).....11

**Statutes**

35 U.S.C. §315(e)(2)..... 1, 8, 12

**Other Authorities**

157 Cong. Rec. S952 (daily ed. Feb. 28, 2011).....12

H.R. Rep. No. 112-98 pt. 1 (2011).....12

H.R. Rep. No. 98 Pt. 1, 112<sup>th</sup> Congr., 1<sup>st</sup> Sess. (2011).....13

S. Rep. No. 110-259 (2008).....12

### Table of Abbreviations

'266 Patent	U.S. Patent No. 9,965,266 at issue here
DMF	Petitioner DMF, Inc.
ELCO	Respondent AMP Plus, Inc. dba Elco Lighting
Panel Op. at x	Panel Order Denying Petition (Fed. Cir. Dkt No. 10)
Pet. at x	DMF's Petition for Writ of Mandamus (Fed. Cir. Dkt No. 2.1)
Opp. at x	Respondent ELCO's Response to Petition (Fed. Cir. Dkt No. 8)
Reply at x	DMF's Reply Supporting Petition (Fed. Cir. Dkt No. 9)

### Federal Circuit Rule 35(b)(2) Statement of Counsel

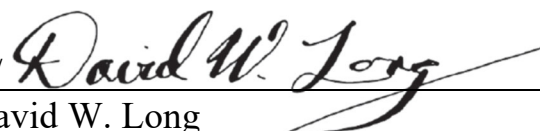
Based on my professional judgment, I believe that the Panel decision is contrary to the following precedents of this Court or the Supreme Court:

- *Digital Equipment Corp. v. Desktop Direct, Inc.*, 511 U.S. 863, 879-880 (1994), which ruled, “[w]hen a policy is embodied in a ... statutory provision entitling a party to immunity from suit (a rare form of protection), there is little room for the judiciary to gainsay its ‘importance’” in deciding whether to grant interlocutory appellate review (emphasis added).
- *Schlagenhauf v. Holder*, 379 U.S. 104 (1964), which requires mandamus review to provide appellate guidance on issues of first impression in which district courts are divided, such as the IPR estoppel standard at issue here.

Based on my professional judgment, I believe this appeal requires an answer to the following precedent-setting question of exceptional importance:

- Whether *inter partes* review (IPR) estoppel under 35 U.S.C. §315(e)(2) bars an IPR petitioner from using a physical product to relitigate in district court the same invalidity issue that the IPR petitioner litigated in an IPR based on a printed publication’s description of that product?

Dated: October 12, 2021

/s/   
David W. Long  
Attorney for Petitioner, DMF, Inc.

Petitioner DMF, Inc. (“DMF”) respectfully seeks Panel or En Banc rehearing on an important issue of first impression dividing the district courts on whether and to what extent 35 U.S.C. §315(e)(2) *inter partes* review (“IPR”) estoppel applies to validity challenges based on a physical product that is described in a printed publication raised in an IPR.

When creating the controversial IPR proceedings, Congress enacted IPR estoppel to ensure that patent owners would not be burdened with relitigating in district court the same invalidity issues litigated in an IPR. Because IPRs cannot consider physical products, however, some litigants try to skirt IPR estoppel by using physical products in district court to litigate the identical invalidity issue they had litigated in an IPR based on a publication that described the product. Almost all prior art physical products have associated prior art publications describing them (manuals, catalogs, marketing materials, etc.). The promise of IPR estoppel is thus illusory if easily circumvented by using a physical product in lieu of a publication describing that product when there are no (or only trivial) differences between the product and publication with respect to the invalidity dispute. That’s the issue presented here.

#### **I. Pertinent Facts Necessary To Understand The Issues Presented**

DMF sued AMP Plus, Inc. dba ELCO Lighting (“ELCO”) in district court for infringing U.S. Patent No. 9,965,266 (“the ’266 Patent”). ELCO filed an *inter*



*partes* review (IPR) petition based on a 2011 Imtra Marine Lighting product catalog (“Imtra 2011 catalog”) describing an Imtra lighting product called Hatteras (“Hatteras product”). ELCO raised those same IPR invalidity grounds in district court, but relied on the physical Hatteras product in lieu of (or in addition to) the Imtra 2011 catalog.<sup>1</sup>

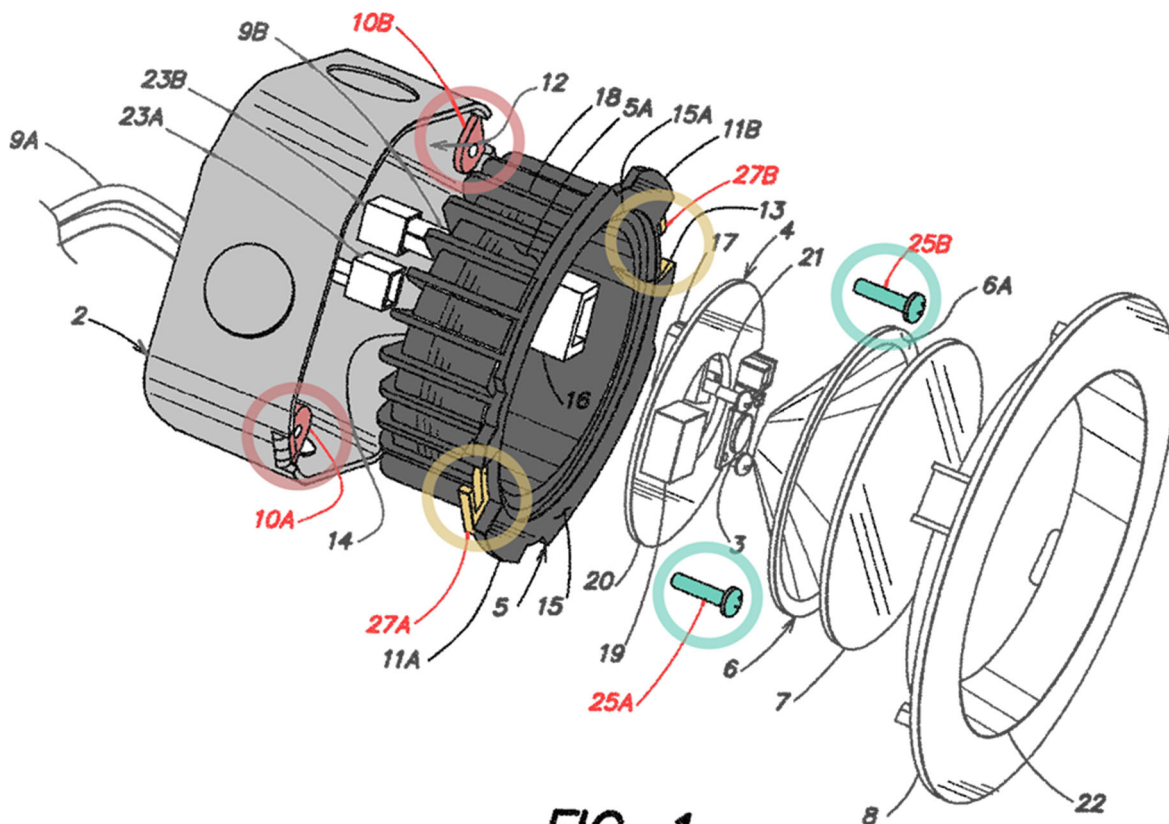
**A. ‘266 Patent, Imtra prior art and *plurality of elements* dispute**

DMF’s ‘266 Patent discloses a *unified casting* (in black below) placed within a standard-sized junction box (silver) where the *unified casting* has a *plurality of elements* (27A, 27B in orange) with slots/holes positioned to align with holes in the junction box tabs (10A, 10B in red) through which screws (25A, 25B in green) are inserted:<sup>2</sup>

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<sup>1</sup> Pet. at 6-9.

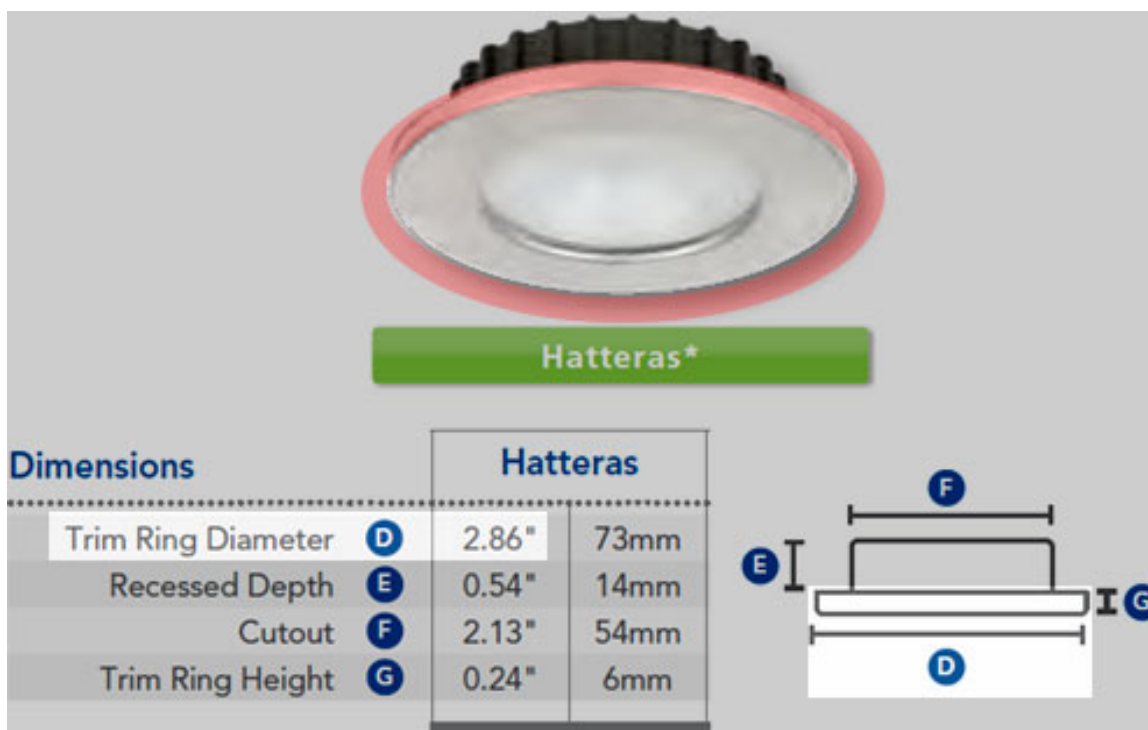
<sup>2</sup> Pet. at 1-2.



**FIG. 1**

ELCO argued that the Imtra Hatteras product had screw holes meeting or teaching the *plurality of elements* limitation. The Imtra 2011 catalog text refers to the screw holes and, although the photographs do not also show them, both parties agreed they were underneath and within the 2.86-inch outer diameter of the product’s “stainless steel trim ring” (circled red below), which agreement was noted by the PTAB:<sup>3</sup>

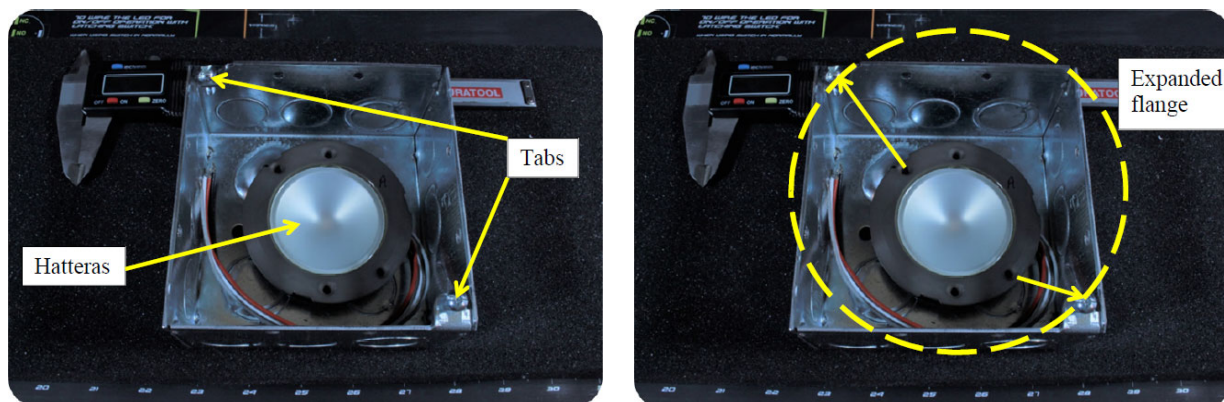
<sup>3</sup> Pet. at 4-5, 32; Reply at 4-6.



Because the tabs of a standard-sized junction box are spaced further apart than the Hatteras product's 2.86-inches outer diameter, the screw holes within that diameter would not align with the junction box tabs as required by the *plurality of elements* limitation.<sup>4</sup> So the physical Hatteras product and its description in the Imtra 2011 catalog presented the identical patentability issue for the *plurality of elements* limitation based on that small 2.86-inch diameter. Indeed, ELCO used the physical Hatteras product itself to demonstrate ELCO's *plurality-of-elements* argument in the IPR: See images below from ELCO's IPR brief where the physical Hatteras

<sup>4</sup> Pet. at 5-6; Reply at 5-6.

product’s 2.86-inch diameter does not reach both junction box “Tabs” (left image), so the outer diameter must be increased (right image).<sup>5</sup>



## B. IPR and District Court Proceedings

The IPR validity disputes concerned only two claim limitations: the *driver* and *plurality of elements*; no other claim limitations were at issue.<sup>6</sup> The PTAB confirmed the patentability of all challenged claims having the *plurality of elements* limitation, because any screw holes within the Hatteras product’s 2.86-inch outer diameter would not extend far enough to align with the tabs of a standard-sized junction box and there was no “credible” reason to modify the product to provide such alignment.<sup>7</sup>

ELCO asserted the identical IPR invalidity challenges in district court, but used the physical product in lieu of or in addition to the Imtra 2011 catalog.<sup>8</sup>

<sup>5</sup> Pet. at 5-6.

<sup>6</sup> Pet. at 6-8.

<sup>7</sup> Pet. at 7-8.

<sup>8</sup> Pet. at 8-10.

Neither ELCO nor DMF asserted any difference between the Hatteras product and the Imtra 2011 catalog's description of that product.<sup>9</sup> As in the IPR, the invalidity disputes concerned only the *driver and plurality of elements* limitation; DMF did not dispute whether the Hatteras product or Imtra 2011 catalog's description of the product disclosed other claim limitations.<sup>10</sup>

DMF moved the district court to apply IPR estoppel to bar ELCO's Hatteras product invalidity challenges because there was no "substantive difference between the product and the printed prior art [Imtra 2011 catalog] that is germane to the invalidity dispute at hand."<sup>11</sup> DMF explained that "IPR estoppel ... is akin to common law *res judicata* doctrines of claim and issue preclusion that bar relitigating the same disputed issues."<sup>12</sup> ELCO could not relitigate "the identical invalidity dispute" by simply swapping the Hatteras product for the Imtra 2011 catalog—*e.g.*, relitigate the *plurality of elements* patentability issue that is the same for the Hatteras product and catalog's description of that product as having a 2.86-inch outer diameter, which was too small to reach both junction box tabs.<sup>13</sup>

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<sup>9</sup> Pet. at 9-10.

<sup>10</sup> Pet. at 9-10.

<sup>11</sup> Pet. at 10 (emphasis added).

<sup>12</sup> *Id.* (emphasis added).

<sup>13</sup> *Id.*

ELCO did not assert that there was any difference between the product and catalog relevant to the *plurality of elements* limitation, which was dispositive in the IPR.<sup>14</sup> Rather, ELCO argued—for the first time—that the catalog’s description of the Hatteras product did not disclose two limitations shown by the product itself: *closed rear face* (of the *unified casting*) and *closer to* limitations.<sup>15</sup> DMF argued that—even if true—IPR estoppel still applied because those two limitations were not the subject of any dispute in the IPR (or district court) invalidity grounds.<sup>16</sup>

But the district court rejected the IPR estoppel standard asserted by DMF. The court ruled that ELCO could avoid IPR estoppel based on ELCO’s newly-alleged differences between the product and publication relating to the two undisputed claim limitations, stating:

DMF asserts that the differences ELCO cites are not “germane to the invalidity dispute at hand” because DMF does not dispute that the Imtra Hatteras, Imtra 2011, and Imtra 2007 references meet the “unified casting” and “closer to” limitations that ELCO relies on the physical product to demonstrate. In so arguing, DMF reads the caselaw too narrowly. The court in *CalTech II* explicitly rejected a standard that required “that certain claim limitations be independently satisfied by prior art in a way that is different from an associated prior art patent or printed publication.” To hold otherwise would permit the party asserting estoppel to concede that a disputed limitation is met in a particular prior art reference to bring it into the scope of the estoppel. Here, it is enough that there is some substantive, germane

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<sup>14</sup> Pet. at 11.

<sup>15</sup> *Id.*

<sup>16</sup> Reply at 2-3; Pet. at 12-13.

difference between the Imtra Hatteras reference and the Imtra 2011/Imtra 2007 references for each asserted claim.<sup>17</sup>

The district court case was taken off of trial calendar due to COVID, no trial date has been set and any trial date is expected to be after May 2022.

## II. Points of Law and Fact Overlooked By The Panel

The Panel's September 9, 2021 decision denying mandamus review overlooked or misapprehended the following points of law or fact:

**First**, the Panel overlooked cited Supreme Court precedent that, in deciding whether to grant interlocutory appellate review, “there is little room for the judiciary to gainsay [the] ‘importance’” of “a statutory provision entitling a party to immunity from suit (a rare form of protection)” and such statutory rights can be “irretrievably lost” if appellate review were to await final judgment.<sup>18</sup> IPR estoppel under 35 U.S.C. §315(e)(2) provides such “rare” statutory immunity from suit that Supreme Court precedent presumes to be important enough for interlocutory appellate review. But the Panel decision did not discuss—and is inconsistent with—that Supreme Court precedent in ruling that “DMF has not shown that a post-judgment appeal is an inadequate remedy for asserting a statutory estoppel argument.”<sup>19</sup>

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<sup>17</sup> Pet. at 3.

<sup>18</sup> *Dig. Equip. Corp. v. Desktop Direct, Inc.*, 511 U.S. 863, 873-874 (1994).

<sup>19</sup> Panel Op. at 3.

**Second**, the Panel decision misapprehended whether the district court applied the same IPR estoppel standard argued by DMF. The decision states: “Significantly, DMF agreed to the legal standard for assessing statutory estoppel applied by the district court.”<sup>20</sup> That is not correct. Rather, as discussed above, the district court expressly refused to apply the legal standard argued by DMF.

**Third**, because the Panel decision erroneously assumed that DMF agreed with the district court’s IPR estoppel standard, the decision did not consider or apply the Supreme Court’s *Schlagenhauf* mandamus review standard for disputed legal issues of first impression in which district courts are divided, as is the case here with the IPR-estoppel standard.

### III. Argument

*Cheney* mandamus review is granted where:

- (1) petitioner does not have any other method of obtaining relief—*e.g.*, a post-judgment appeal is not an adequate remedy;
- (2) petitioner has a clear and indisputable legal right; and
- (3) the writ is appropriate under the circumstances.<sup>21</sup>

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<sup>20</sup> Panel Op. at 3 (emphasis added).

<sup>21</sup> *Cheney v. U.S. Dist. Ct. for D.C.*, 542 U.S. 367, 380-81 (2004).



But this is not a simple *Cheney* mandamus case. DMF seeks *Schlagenhauf* mandamus review because the IPR estoppel standard presents an issue of first impression on which district courts are divided, as explained further below.

**A. *Schlagenhauf* mandamus review**

In *Schlagenhauf*, the Supreme Court reversed the Seventh Circuit’s decision to deny mandamus review of a district court ruling that “appears to be the first of its kind in any reported decision in the federal courts under Rule 35, and ... only one such modern case in the state courts.”<sup>22</sup> The Court required mandamus review to provide appellate guidance on the “undecided” legal issue.<sup>23</sup>

Regional circuits thus exercise *Schlagenhauf* mandamus review to clarify legal issues of first impression, which “comport[s] with the instructional goals of mandamus”<sup>24</sup> and “the court’s supervisory function”<sup>25</sup> because failing to “resolve a significant question of first impression” may “adversely affect the efficient operation of the district courts.”<sup>26</sup> This Court also has granted *Schlagenhauf* mandamus review on issues of first impression to “avoid further inconsistent

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<sup>22</sup> *Schlagenhauf v. Holder*, 379 U.S. 104, 110 (1964).

<sup>23</sup> *Schlagenhauf* at 110.

<sup>24</sup> *Bogosian v. Gulf Oil Corp.*, 738 F.2d 5587, 591-92 (3d Cir. 1984).

<sup>25</sup> *Sporck v. Peil*, 759 F.2d 312, 315 (3d Cir. 1985).

<sup>26</sup> *In re Cement Antitrust Litig.*, 688 F.2d 1297 (9<sup>th</sup> Cir. 1982); see also *In re Bulow*, 828 F.3d 94, 96-98 (2d Cir. 1987).

development” of the law and to “further supervisory or instructional goals [of appellate courts] where issues are unsettled and important.”<sup>27</sup>

*Schlagenhauf* mandamus review should be granted here. Judge Stark lamented the lack of Federal Circuit guidance on whether IPR estoppel precludes a party from raising a validity challenge based on a physical product described in a publication, stating that conflicting interpretations were “reasonable” as shown “by the division amongst District Courts that have considered this (or a closely-related) question.”<sup>28</sup> Last September, Judge Ellis similarly lamented that “[t]he contours of IPR estoppel are hard to define,” “[n]either the Supreme Court nor the Federal Circuit has squarely addressed the issue before the Court, and district courts that

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<sup>27</sup> *In re Queen’s Univ. at Kingston*, 820 F.3d 1287, 1291-92 (Fed. Cir. 2016); accord *La Buy v. Howes Leather Co.*, 353 U.S. 249, 259-60 (1957) (mandamus review appropriate under “supervisory control of the District Courts by the Courts of Appeals [that] is necessary to proper judicial administration in the federal system.”); see also *In re Regents of Univ. of Cal.*, 497 F.3d 1360, 1388 (Fed. Cir. 2007) (mandamus review would avert future error and provide a logical method to supervise the administration of justice within the Circuit); *In re Deutsche Bank Trust Co. Americas*, 605 F.3d 1373, 1375, 1377 (Fed. Cir. 2010); *In re U.S.*, 669 F.3d 1333, 1336-37 (Fed. Cir. 2012); *In re BP Lubricants USA Inc.*, 637 F.3d 1307, 1313 (Fed. Cir. 2011); *In re Micron Tech., Inc.*, 875 F.3d 1091, 1095-96 (Fed. Cir. 2017) (mandamus “important to proper judicial administration”); *In re BigCommerce, Inc.*, 890 F.3d 978, 981 (Fed. Cir. 2018) (exercising *Schlagenhauf* mandamus review “to further supervisory or instructional goals where issues are unsettled and important.”).

<sup>28</sup> *Wasica Finance GmbH v. Schrader Int’l, Inc.*, 432 F. Supp. 3d 448, 453-54 (D. Del. 2020) (see cases cited therein)

have addressed the issue (or a similar one) have come to various conclusions.”<sup>29</sup>

So far, over ten different IPR estoppel standards in district court decisions are floating around the void of appellate guidance.<sup>30</sup>

**B. First Factor: No adequate remedy absent mandamus review**

IPR estoppel under 35 U.S.C. §315(e)(2) provides patent owners statutory immunity from relitigating patentability issues decided in an IPR, stating:

The petitioner in an inter parties review of a claim in a patent ... that results in a final written decision ... may not assert ... in a civil action ... that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during the inter partes review.

The legislative history explains the statute’s purpose is to provide “a strengthened estoppel standard to prevent petitioners from raising in a subsequent challenge the same patent issues that were raised or reasonably could have been raised in a prior challenge.”<sup>31</sup> Rather, IPRs “generally serve as a complete substitute for at least some phase of the litigation” and “provid[e] quick and cost effective alternatives to litigation.”<sup>32</sup> The purpose of IPR estoppel is to provide “quiet title to patent owners to ensure continued investment resources”; so allowing “repeated litigation

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<sup>29</sup> *Medline Indus., Inc. v. C.R. Bard, Inc.*, Case No. 17-C-7216, 2020 WL 512132, \*3-\*5 (N.D. Ill. Sep. 14, 2020) (see cases cited therein).

<sup>30</sup> See DMF Reply at 11-12 (identifying different IPR estoppel standards so far).

<sup>31</sup> 157 Cong. Rec. S952 (daily ed. Feb. 28, 2011) (emphasis added).

<sup>32</sup> S. Rep. No. 110-259 at 67 (2008) (emphasis added); H.R. Rep. No. 112-98 pt. 1 at 48 (2011) (emphasis added).

... would frustrate the purpose of this section as providing quick and cost effective alternatives to litigation” and “would divert resources from the research and development of inventions.”<sup>33</sup>

Absent mandamus review, DMF must first divert resources away from innovation in order to relitigate patentability issues to judgment, and then seek post-judgment appellate review. By then it’s too late: the resources already have been spent on litigation rather than innovation, frustrating the statutory purpose of IPR estoppel.

That is precisely why the Supreme Court considers a statutory “immunity from suit” (like IPR estoppel) to be important enough for interlocutory appellate review to enforce “an explicit statutory ... guarantee that trial will not occur”:

When a policy is embodied in a...statutory provision entitling a party to immunity from suit (a rare form of protection), there is little room for the judiciary to gainsay its “importance.”...Where statutory ... rights are concerned, irretrievabl[e] los[s] can hardly be trivial, and the collateral order doctrine might therefore be understood as reflecting the familiar principle of statutory construction that when possible, courts should construe statutes (here § 1291 [final judgment rule]) to foster harmony with other statutory...law.<sup>34</sup>

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<sup>33</sup> H.R. Rep. No. 98 Pt. 1, 112<sup>th</sup> Congr., 1<sup>st</sup> Sess. at 498 (2011) (emphasis added).

<sup>34</sup> *Digital Equipment Corp. v. Desktop Direct, Inc.*, 511 U.S. 863, 879-880 (1994) (emphasis added).

The Panel decision that post-judgment appeal would be an adequate remedy here, however, overlooked this Supreme Court precedent that presumes statutory immunity from suit (like IPR estoppel) is important enough for interlocutory appellate review.

**C. Second Factor: Petitioner establishing legal right**

“Significant[.]” to the Panel’s decision was a misapprehension of whether DMF agreed with the IPR estoppel standard used by the district court, the decision stating:

Significantly, DMF agreed to the legal standard for assessing statutory estoppel applied by the district court. In essence, DMF is challenging the district court’s application of that standard and its findings that ELCO was not judicially estopped<sup>35</sup> from raising its arguments based on actions before the Patent Office.<sup>36</sup>

But the district court expressly rejected the IPR estoppel standard asserted by DMF. This case thus squarely presents a dispute on the legal standard for IPR estoppel standard.

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<sup>35</sup> Judicial estoppel was an alternative argument concerning the two undisputed limitations—*i.e.*, even if undisputed limitations were relevant (and DMF argued they were not) ELCO successfully argued in the IPR that the Imtra 2011 catalog disclosed both of those two undisputed limitations in Claim 17 that was found anticipated, so ELCO cannot now argue that the catalog does not disclose those two limitations.

<sup>36</sup> Panel Op. at 3 (emphasis added).

DMF's proposed standard is consistent with general estoppel principles, because whether IPR estoppel applies depends on whether the outcome of the IPR would have changed if the Petitioner were allowed to assert the physical product in the IPR. In this case, the dispute and outcome of the IPR would not have changed even if ELCO could have relied on the Hatteras product as evidence (and not just a demonstrative), because there was no difference between the product and Imtra 2011 catalog's description of that product for the only two limitations in dispute: *driver* and *plurality of elements* (which was dispositive).

DMF's proposed standard follows well-established *res judicata* principles, such as collateral estoppel (also called issue preclusion) where this Court's long-standing *Bourns* precedent explains that "[i]t is the identity of the issues litigated and decided, and which were essential to the prior judgment, that determines whether the estoppel should be applied."<sup>37</sup> Thus estoppel applies to even different patent claims if they present the identical invalidity issue resolved in a prior adjudication: "If the differences between the unadjudicated patent claims and adjudicated patent claims do not materially alter the question of invalidity,

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<sup>37</sup> *Bourns, Inc. v. U.S.*, 537 F.2d 486, 651 (Ct. Cl. 1976). The Federal Circuit adopted as precedent Court of Claims decisions. *South Corp. v. United States*, 690 F.2d 1368 (Fed. Cir. 1982).

collateral estoppel applies.”<sup>38</sup> It follows that IPR estoppel precludes ELCO from relitigating the identical and dispositive validity issue of whether the Hatteras product disclosed the *plurality of elements* limitation regardless of other claim limitations.

The district court’s standard, however, is inconsistent with general estoppel principles. The district court’s standard gives ELCO a do-over to relitigate the dispositive *plurality of elements* dispute resolved in the IPR because ELCO alleges that the Hatteras product discloses (and the catalog does not disclose) two other limitations that were never in dispute.

The Panel decision thus erred in stating “Significantly, DMF agreed to the legal standard for assessing statutory estoppel applied by the district court.” Rather, there are significant substantive differences between the IPR estoppel standard argued by DMF and the standard applied by the district court.

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<sup>38</sup> *Ohio Willow Wood Co. v. Alps South, LLC*, 735 F.3d 1333, 1341-43 (Fed. Cir. 2013); *see also Soverain Software LLC v. Victoria’s Secret Direct Brand Management, LLC*, 778 F.3d 1311, 1319-1320 (Fed. Cir. 2015) (Claim held invalid under collateral estoppel for different claims where “patentee failed to explain how the additional limitation would change an invalidity analysis”, because “[c]omplete identity of claims is not required to satisfy the identity-of-issues requirement for claim preclusion.”); *Amgen, Inc. v. Genetics Institute, Inc.*, 98 F.3d 1328, 1329, 1332 (Fed. Cir. 1996) (collateral estoppel bars relitigating identical issue of validity based on lack of enablement determined in a prior case with different patent claims because “enablement was fully litigated for the identical product on the identical specification”); *SynQor, Inc. v. Vicor Corp.*, 988 F.3d 1341, 1353 (Fed. Cir. 2021) (applying collateral estoppel even though prior litigated patent claims were not identical).

This misunderstanding of the dispute also led the Panel decision to overlook the *Schlagenhauf* mandamus review standard for resolving disagreements on legal issues of first impression. Under *Schlagenhauf* mandamus review, showing clear legal error by the district under the second *Cheney* factor may not be required or even possible because the legal standard is uncertain (which uncertainty is why *Schlagenhauf* mandamus review is being sought). Thus, this Court has granted *Schlagenhauf* mandamus review where “the law was unclear and the error understandable,” rather than requiring a showing of clear error.<sup>39</sup> DMF believes the district court’s IPR estoppel ruling was clear error and, in any event, *Schlagenhauf* mandamus review is warranted here given uncertainty of the legal standard.

**D. Third Factor: Mandamus review appropriate under the circumstances**

Because the Panel decision mistakenly thought the IPR estoppel standard was agreed upon and not disputed, the decision did not address whether *Schlagenhauf* mandamus review was proper in these circumstances. As discussed, this case indisputably presents an issue of first impression for this Court in which district courts are divided regarding whether and to what extent an IPR petitioner

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<sup>39</sup> *In re Cray Inc.*, 871 F.3d 1355, 1360 (Fed. Cir. 2017); *see also In re Google LLC*, 949 F.3d 1338, 1341 (Fed. Cir. 2020) (citing *Schlagenhauf* in ruling decision on “undecided” legal questions may constitute “clear abuse of discretion”).



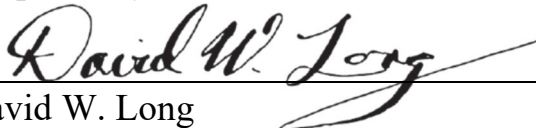
may assert invalidity grounds based on a physical product described in a publication raised in the IPR.<sup>40</sup> *Schlagenhauf* mandamus review is particularly important here, because no other appellate court will clarify this patent law issue and the “central purpose” of this Court “is to reduce the widespread lack of uniformity and uncertainty of legal doctrine that exist in the administration of patent law.”<sup>41</sup>

#### IV. Conclusion

DMF respectfully requests rehearing for the reasons discussed above, including much-needed precedential guidance on the IPR estoppel standard that has divided the district courts.

Dated: October 12, 2021

Respectfully submitted:

/s/ 

David W. Long  
*Attorney for Petitioner*  
*DMF, Inc.*

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<sup>40</sup> See also Pet. at 19-20; Reply at 11-12.

<sup>41</sup> *Lighting Ballast Control LLC v. Philips Electronics North America Corp.*, 744 F.3d 1271, 1282 (Fed. Cir. 2014) (*en banc*).

**Addendum – Panel Decision**

NOTE: This order is nonprecedential.

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

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**In re: DMF, INC., a California corporation,  
*Petitioner***

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2021-153

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On Petition for Writ of Mandamus to the United States District Court for the Central District of California in No. 2:18-cv-07090-CAS-GJS, Senior Judge Christina A. Snyder.

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**ON PETITION**

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Before LOURIE, BRYSON, and TARANTO, *Circuit Judges*.

PER CURIAM.

**O R D E R**

DMF, Inc. petitions for a writ of mandamus challenging the district court's ruling that AMP Plus, Inc., dba ELCO Lighting ("ELCO") was not statutorily estopped from raising a particular ground of invalidity. ELCO opposes. DMF replies.

This petition concerns the scope of statutory estoppel under 35 U.S.C. § 315(e)(2). A petitioner in an *inter partes* review may request to cancel as unpatentable one or more claims of a patent only "on the basis of prior art consisting

of patents or printed publications.” 35 U.S.C. § 311(b). Section 315(e)(2) provides that the “petitioner in an *inter partes* review of a claim in a patent . . . may not assert . . . in a civil action . . . that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that *inter partes* review.”

DMF is the owner of U.S. Patent No. 9,964,266 (“the ’266 patent”) directed to certain compact recessed lighting products. In August 2018, DMF filed this suit in the United States District Court for the Central District of California, alleging ELCO infringes various claims of the ’266 patent. ELCO raised several invalidity grounds, including arguments premised on a boating light product sold under the name Hatteras that had been featured in a product catalog published in 2011 by Imtra Marine Lighting.

In May 2019, ELCO petitioned for *inter partes* review of the ’266 patent. The Patent Trial and Appeal Board instituted review of all the challenged claims on three grounds based on the Imtra 2011 catalog either alone or in combination with other references. In its final written decision, the Board held that ELCO had not proved that all the challenged claims were unpatentable. Following the Board’s decision, DMF moved the district court under § 315(e)(2) to bar ELCO from asserting invalidity in the litigation based on the Hatteras product itself.

The parties agreed that section 315(e)(2) estoppel was to be assessed based on whether there was a substantive difference between the physical Hatteras product relied upon by ELCO in this case and the description of the product in the 2011 Imtra catalog germane to the invalidity dispute. *See* Appx6; Appx112 (DMF’s reply brief in support of motion) (“The parties appear to agree that courts in this District and elsewhere require that—as stated in ELCO’s own Opp. at 7—there be some substantive difference between the product and the printed prior art that is germane

IN RE: DMF, INC.

3

to the invalidity dispute at hand” (internal quotation marks and emphasis omitted)).

Applying that standard, the district court denied the motion. Relying on DMF’s own prior argument that the Imtra reference could not anticipate the claims because ELCO’s invalidity contentions mixed and matched components from various products disclosed in the catalog, the district court found that anticipation arguments based solely on the Hatteras product were substantively, germanely different. The court added that ELCO was relying on the physical product as a reference for various limitations because the descriptions in the Imtra catalog did not disclose all of the Hatteras product’s features.

Mandamus is “reserved for extraordinary situations.” *Gulfstream Aerospace Corp. v. Mayacamas Corp.*, 485 U.S. 271, 289 (1988) (citation omitted). Under the well-established standard for obtaining such relief, the petitioner must: (1) show it does not have any other method of obtaining relief; (2) show that it has a clear and indisputable legal right; and (3) convince the court that the “writ is appropriate under the circumstances.” *Cheney v. U.S. Dist. Ct. for D.C.*, 542 U.S. 367, 380–81 (2004) (citation omitted). We cannot say that DMF has satisfied that standard.

DMF has not shown that a post-judgment appeal is an inadequate remedy for asserting a statutory estoppel argument. See *In re Verinata Health, Inc.*, No. 2017-109, 2017 WL 1422489, at \*2 (Fed. Cir. Mar. 9, 2017). Nor has DMF shown that it has a clear and indisputable right to relief. Significantly, DMF agreed to the legal standard for assessing statutory estoppel applied by the district court. In essence, DMF is challenging the district court’s application of that standard and its findings that ELCO was not judicially estopped from raising its arguments based on actions before the Patent Office. We are not convinced that DMF has met its heavy burden of showing that the district

4

IN RE: DMF, INC.

court's rulings in these regards are clearly and indisputably erroneous.

Accordingly,

IT IS ORDERED THAT:

The petition is denied.

FOR THE COURT

September 09, 2021  
Date

/s/ Peter R. Marksteiner  
Peter R. Marksteiner  
Clerk of Court

s29

**Addendum – 35 U.S.C. § 315(e)(2)**

**§315. Relation to other proceedings or actions**

...

**(e) ESTOPPEL. —**

...

**(2) CIVIL ACTIONS AND OTHER PROCEEDINGS.—**

The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not assert either in a civil action arising in whole or in part under section 1338 of title 28 or in a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

### Certificate of Compliance

The undersigned certifies that the foregoing complies with the relevant type-volume limitation of the Federal Rules of Appellate Procedure and Federal Circuit Rules because the filing has been prepared using a proportionally-spaced typeface Times New Roman size 14 font and includes 3,602 words as counted automatically by Microsoft Word, which is under the 3,900 word limit of Federal Rule of Appellate Procedure 40(b)(1).

Dated: October 12, 2021

*/s/ David W. Long*  
David W. Long  
*Attorney for Petitioner*  
*DMF, Inc.*

### Certificate of Service

I certify that, on the date indicated below, I electronically filed the foregoing with the Clerk of the United States Court of Appeals for the Federal Circuit using the CM/ECF System and served the foregoing via electronic mail on counsel of record.

Dated: October 12, 2021

*/s/ David W. Long*  
David W. Long  
*Attorney for Petitioner*  
*DMF, Inc.*