

2022-1016

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

CLICK-TO-CALL TECHNOLOGIES LP,

Plaintiff-Appellant,

v.

INGENIO, INC., dba Keen, ETHER, THRYV, INC.,

Defendants-Appellees.

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS, JUDGE LEE YEAKEL
1:12-CV-00465-LY

**CORRECTED PLAINTIFF-APPELLANT'S RESPONSE TO
DEFENDANTS-APPELLEES' COMBINED PETITION FOR
PANEL REHEARING AND REHEARING EN BANC**

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October 25, 2022

CERTIFICATE OF INTEREST

Counsel for Plaintiff-Appellant Click-to-Call Technologies LP certifies as follows:

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

Click-to-Call Technologies LP

- 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:**

N/A

- 3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party represented by me are:**

N/A

- 4. The names of all law firms and the partners or associates that appeared for the party now represented by me in the trial court or are expected to appear in this court and have not entered an appearance are:**

Ashley Lauren Denton McMillian
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- 5. Other than the originating case number(s), 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 are:**

N/A

- 6. Information required by Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees):**

N/A

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I. INTRODUCTION

The Court should deny Appellee’s petition for panel rehearing and rehearing *en banc* (“Rehearing Petition”).

The weakness of Ingenio’s Rehearing Petition is apparent from Ingenio’s Statement of Counsel, which maintains:

Based on my professional judgment, I believe the panel decision is contrary to these precedents: *Cal. Inst. Of Tech. v. Broadcom Ltd.*, 25 F.4th 976 (Fed. Cir. 2022); *Intuitive Surgical, Inc. v. Ethicon LLC*, 25 F.4th 1035 (Fed. Cir. 2022); *Shaw Industries Group, Inc. v. Automated Creel Systems, Inc.*, 817 F.3d 1293 (Fed. Cir. 2016), *overruled by California Institute of Technology v. Broadcom Ltd.*, 25 F.4th 976 (Fed. Cir. 2022).

Reh’g Pet. *vi*. The statement beggars belief. The Panel Decision held that IPR estoppel applies to an invalidity ground that reasonably could have been raised (but was not) for a claim challenged in the IPR petition. *Click-to-Call Techs. LP v. Ingenio, Inc.*, 45 F.4th 1363, 1368–69 (Fed. Cir. 2022). *Caltech* held that IPR estoppel applies “not just to claims and grounds asserted in the petition and instituted for consideration by the [Patent Trial and Appeal] Board, but to all grounds not stated in the petition but which reasonably could have been asserted against the claims included in the petition.” *California Inst. of Tech. v. Broadcom Ltd.*, 25 F.4th 976, 991 (Fed. Cir. 2022) [*Caltech*]. That cannot be described as contrary. *Intuitive Surgical* held that “§ 315(e)(1) estops a petitioner as to invalidity grounds for an asserted claim that it failed to raise but ‘reasonably could have raised’ in an earlier

decided IPR.” *Intuitive Surgical, Inc. v. Ethicon LLC*, 25 F.4th 1035, 1041 (Fed. Cir. 2022). That also cannot be described as contrary. As for *Shaw*, this Court has recognized that “*Shaw* did not . . . directly speak to the impact of estoppel on grounds never raised in petitions,” *id.* at 1042, so *Shaw* too is not contrary. In any event, *Caltech* overruled *Shaw*’s approach to IPR estoppel, as Ingenio’s statement concedes. Moreover, Ingenio expressly waived any reliance on *Shaw* at oral argument. Oral Arg.¹ at 19:29–34 (The Court: “You’re not relying on *Shaw* at all, right?” Ingenio Counsel: “No, we are not.”). In short, there is not even an arguable tension between the Panel Decision on IPR estoppel and this Court’s precedent.

The Panel Decision on IPR estoppel is fully consistent with the statutory language, Supreme Court precedent, and precedential decisions of this Court. Further, Ingenio’s own waivers preclude the arguments it is making now. Accordingly, the Rehearing Petition should be denied.

II. ARGUMENT

A. **Ingenio’s statutory arguments fail because they contradict the plain language of the statute and Supreme Court precedent.**

The plain language of 35 U.S.C. § 315(e)(2) applies to Ingenio’s attempts to assert Dezonno against Claim 27. That provision states:

¹ Citations to the Oral Argument refer to the audio file at: https://oralarguments.cafc.uscourts.gov/default.aspx?fl=22-1016_06092022.mp3.

The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision . . . may not assert . . . in a civil action arising in whole or in part under section 1338 of title 28 . . . that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

35 U.S.C. § 315(e)(2). The facts are beyond dispute: Ingenio’s IPR included Claim 27, the IPR resulted in a final written decision, and the grounds at issue reasonably could have been raised during the IPR.² Therefore, IPR estoppel applies.

Ingenio’s arguments that the IPR did not include Claim 27 defy both the statute and Supreme Court law. Whether or not the Board addressed Claim 27 in the Final Written Decision, the claim unquestionably was part of the IPR because Ingenio made it so in its IPR petition. According to the Supreme Court, “the statute tells us that the petitioner’s contentions, not the Director’s discretion, define the scope of the litigation all the way from institution through to conclusion.” *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348, 1357 (2018); *see also Caltech*, 25 F.4th at 990 (citing *SAS*, 138 S. Ct. at 1357–58) (“[I]t is the petition, not the institution decision, that defines the scope of the IPR.”). That the Board’s Final Written Decision addressed only some of the claims that Ingenio put into issue in the IPR may have been improper under *SAS*, but it does not affect IPR estoppel. The

² Ingenio was aware of the Dezonno reference but opted to assert only another reference (Freeman) against Claim 27 while asserting the Dezonno reference against other claims in the IPR. *Click-to-Call*, 45 F.4th at 1366, 1368.

applicability of § 315(e)(2) is not conditioned on the content of a final written decision, only on its issuance, and that unquestionably happened here.

Ingenio’s accusations that the Panel Decision rewrote the statute fail because the statute as written imposes IPR estoppel here. It is Ingenio that seeks to rewrite the statute. Ingenio made this plain during the oral argument, maintaining:

So as we noted in our response brief, plain language of the statute says that the petitioner in an IPR is barred with respect to a claim that appears in the final written decision for any grounds it could have raised against that claim.

Oral Arg. at 15:45–16:03; *see also* Reh’g Pet. 5 (“IPR estoppel only applies to claims that result in, and are addressed by, a final written decision.”). Thus, Ingenio’s proposed revision of § 315(e)(2) is:

The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision that addresses the claim . . . may not assert . . . in a civil action arising in whole or in part under section 1338 of title 28 . . . that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

Nothing supports such rewriting of the statute.³

Ingenio’s complaint that the Panel “neither mentioned footnote 5 [of *Caltech*] nor even acknowledged the significant procedural differences between this case and

³ Likewise, Ingenio has it backwards when arguing that the Panel Decision “suggest[s] that Section 315(e)(2) changes meaning depending on whether a matter was pre- or post-SAS.” Reh’g Pet. 16. Ingenio is the one arguing for different treatment based on its IPR reaching a Final Written Decision prior to SAS.

Caltech with respect to the timing of the *SAS* opinion,” Reh’g Pet. 7, finds no purchase. Footnote 5 of the *Caltech* decision merely left open whether IPR estoppel should apply “in cases in which the Board declined to institute on all grounds and issued its final written decision pre-*SAS*.” *Caltech*, 25 F.4th at 991 n.5. There was nothing substantive in the footnote for the Panel Decision to address. Also, Ingenio omits that it forewent its opportunity to raise any issue about Footnote 5 by withdrawing its request to file a sur-reply brief addressing the *Caltech* decision. *See* Doc. No. 20, at 2 (Ingenio motion requesting authorization to file sur-reply to address Footnote 5); Doc. No. 24, at 1 (Ingenio letter withdrawing request). Further, the Panel Decision refuted Ingenio’s argument that there were “significant procedural differences” by pointing out that Ingenio had the opportunity to seek a remand after *SAS* issued. 45 F.4th at 1369–70. This made any supposed “procedural differences” inconsequential.

Finally, Ingenio’s arguments in Part I.B of its Rehearing Petition all presume—contrary to *SAS* and *Caltech*—that the scope of an IPR is limited to the claims addressed in the final written decision. *See* Reh’g Pet. 8 (“Recognizing that Claim 27 was never part of the final written decision—and thus not part of the IPR in a pre-*SAS* world—the Panel has improperly expanded IPR estoppel . . . to *claims* that reasonably could have included [*sic*] in the IPR.”). As a result, those arguments

fail from the outset. Further, nothing in the Panel Decision states that IPR estoppel applies to claims that the petitioner excluded from the IPR.

B. Ingenio’s argument about the unavailability of post-SAS relief from the Board was waived during oral argument and is wrong.

Ingenio contends in its Petition—for the first time in this case—that a post-SAS remand, which would have allowed the Board to rectify any issue with IPR estoppel arising from the partial institution, was impossible. But Ingenio admitted the opposite during oral argument and further stated that Ingenio had opted not to pursue such relief because it did not want to risk revisiting the Final Written Decision, as reflected in this portion of the argument:

[The Court:] Why didn’t you go back to the PTO and say, “Hey, SAS says that you need to institute on all grounds. You should institute on all grounds.” Why didn’t you take that option when it was open to you?

[Ingenio Counsel:] Well, frankly, because we had won at the IPR. We didn’t want them to reopen and reconsider anything. And additionally, that’s not required.

[The Court:] You could have had Claim 27 considered?

[Ingenio Counsel:] **We could have.**

Oral Arg. at 18:30–19:10. Given Ingenio’s admission, there is no “law or fact that . . . the court has overlooked or misapprehended” that could warrant rehearing.

FED. R. APP. PROC. 40(a)(2).

Further, Ingenio’s new position does not withstand scrutiny. Ingenio maintains that, because the Federal Circuit lacked jurisdiction over the appeal of the

Final Written Decision, it could not have remanded the case to the Board to address the SAS issue. Reh’g Pet. 12–13. But Ingenio also states that “the PTAB was divested of jurisdiction over the matter as soon as Click-to-Call filed its Notice of Appeal” of that Decision. *Id.* at 13 n.1. Then the Federal Circuit dismissed the appeal, as the Supreme Court directed, thereby freeing the Board to take up any post-SAS reconsideration without interfering with a pending appeal. *See Click-To-Call Techs., LP v. Ingenio, Inc.*, 810 F. App’x 881, 882 (Fed. Cir. 2020) (dismissal order). Whether this is described as remanding to the Board or merely returning jurisdiction is a distinction without a difference: Either way, Ingenio had the opportunity to raise any SAS issue with the Board but made a strategic decision not to before seeking judgment on Claim 27 in the trial court based on the Final Written Decision.

Ingenio’s argument that the Federal Circuit was powerless to order the Board to take up the SAS issue when dismissing the appeal is irrelevant. Regardless what the Federal Circuit had power to do, Ingenio by its own admission (in the oral argument passage above) could have raised the issue with the Board on its own. And this Court has recognized the authority of the Board to take up such issues. *See Atlanta Gas Light Co. v. Bennett Regulator Guards, Inc.*, 33 F.4th 1348, 1355 (Fed. Cir. 2022) (holding that the Board “retains ‘inherent authority’ to reconsider its decisions regarding institution, including after a remand from our court” affirming such a decision).

Ingenio’s argument that “any post-*SAS* petition to the Board would have been futile” because “the agency’s announced policy would have been to dismiss” the IPR proves itself false. Reh’g Pet. 1–2, 14. By arguing that the result would have been dismissal of the IPR—thereby wiping out the Final Written Decision and any IPR estoppel effect—Ingenio admits it would have succeeded in avoiding IPR estoppel. That is the very opposite of futility. To be sure, there would have been a cost, namely undoing other results of the Final Written Decision that were in Ingenio’s favor. While Ingenio may not have wanted to take the bitter with the sweet to avoid IPR estoppel, that was the option Ingenio had. By its own admission, Ingenio made a calculated decision not to take that option, and Ingenio must live with the consequence of that decision: IPR estoppel.

C. The Court should reject Ingenio’s request for the Court *en banc* to defy Supreme Court precedent.

The Court should reject Ingenio’s invitation to use this case as a “vehicle” to overrule *Caltech* in favor of *Shaw*. Ingenio ignores that this Court already passed on the best vehicle for that—namely, the *Caltech* case in which the Court denied a petition for rehearing *en banc* on the IPR estoppel issue earlier this year. *California Inst. of Tech. v. Broadcom Ltd.*, No. 20-2222, Doc. No. 70 (Fed. Cir. May 9, 2022) (order denying petition). In any event, for the reasons set forth above, overruling *Caltech* would directly contradict the Supreme Court’s holding in *SAS*. Accordingly, the Rehearing Petition should be denied.

III. CONCLUSION

For the foregoing reasons, the Court should deny the Rehearing Petition.

Dated: October 25, 2022

Respectfully submitted,

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ADDENDUM

35 U.S.C. § 315 – Relation to other proceedings or actions

(e) Estoppel.—

(1) Proceedings before the office.—

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 request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

(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 SERVICE

I hereby certify that, on this 25th day of October 2022, I filed the foregoing *Corrected Plaintiff-Appellant's Response to Defendants-Appellees' Combined Petition for Panel Rehearing and Rehearing En Banc* with the Clerk of the United States Court of Appeals for the Federal Circuit via the CM/ECF system, which will send notice of such filing to all registered CM/ECF users.

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**CERTIFICATE OF COMPLIANCE
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The foregoing filing complies with the relevant type-volume limitation of the Federal Rules of Appellate Procedure and Federal Circuit Rules because:

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